MALAYSIA
APAA ANTI-COUNTERFEITING COMMITTEE REPORT –
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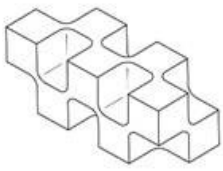
Special Topic: Protection of Product Shapes/Configurations

To protect shapes/configurations it is generally understood that design registration should be secured first, and that once the product shape itself has become well known, protection may then be available in many countries through registration as a 3D trademark if it acquires distinctiveness through use.

In practice, however, rights holders often face a gap in protection: after a product has been launched and begins to achieve commercial success, counterfeit products may emerge at a point when the novelty required for design protection has already been lost, while the level of recognition necessary for trademark protection has not yet been established.

In light of this reality, the Japanese Group proposes to study what anti-counterfeiting measures may be available in each jurisdiction under these circumstances.

By way of example, please see below several Japanese trademark registrations consisting of 3D product shapes/configurations:

Beverage bottle	Arm chair.	Bag	3D cube puzzle
			
JP TM Reg. 5225619	JP TM Reg. 5446392	JP TM Reg. 6711392	JP TM Reg. 5855350
Eraser/rubber	Watch	Motorcycle	Chocolate confectionery
			
JP TM Reg. 5444010	JP TM Reg. 6711392	JP TM Reg. 5674666	JP TM Reg. No. 6031305

We would like to examine and compare how product shapes/configurations such as those above are protected and enforced in each APAA member country or region.

1. <u>Whether such product shapes/configurations are protected under copyright law, unfair competition laws and/or passing-off doctrines;</u>

a) Copyright law

Legal framework

Copyright protection in Malaysia is governed by the Copyright Act 1987 (CA). Section 7(1) identifies the eligible categories of works, including artistic works. Section 7(2) provides that eligibility is irrespective of quality and purpose. Under sections 7(3)(a) and (b), sufficient effort must have been expended to make the work original in character, and the work must have been written down, recorded or otherwise reduced to material form. Section 7(2A) excludes ideas, procedures, methods of operation and mathematical concepts. The applicable qualification requirements must also be satisfied. Section 7(5) excludes copyright in a design registered under industrial design legislation; it does not merely refer to designs capable of registration. Copyright in drawings must be distinguished from the right to prevent manufacture of the depicted article. Section 13A limits infringement claims based on design documents or models for anything other than an artistic work or a typeface. Section 13B separately addresses industrial exploitation of artistic works and the specified permitted activities after its twenty-five-year period. The former fifty-reproduction rule in section 7(6) has been deleted. Accordingly, mass production does not automatically extinguish copyright upon production of more than fifty articles.

Authorities

Case	Court	Judge	Subject matter	Extracts from Judge	Remarks
***Siti Khadijah Apparel Sdn Bhd v Ariani Textiles & Manufacturing (M) Sdn Bhd* [2019] 7 MLJ 478**	HC	Wong Kian Kheong J	Telekung (Muslim prayer outfit)	**[19]** Under **s 3 of the Copyright Act (CA) 1987**, an artistic work includes a graphic work and a work of artistic craftsmanship, regardless of its artistic quality, a graphic work includes drawings. **[21]** In *George Hensher Ltd v Restawile Upholstery (Lancs) Ltd* [1975] RPC 31, a work of artistic craftsmanship generally requires: (1) a work which "any substantial section of the public genuinely admires and values for its appearance and gets pleasure or satisfaction,	- The Court held that the 2D drawings of the telekung constituted "graphic works" and that the 3D telekung itself was capable of constituting an "artistic work" under the Copyright Act 1987. - The functional purposes of a work do not, in itself, preclude copyright protection. Copyright may therefore subsist in the design of a functional product where the statutory requirements for

				whether emotional or intellectual, from looking at it"; (2) a question of fact to be decided objectively based on the evidence, and involves more than simply looking at it; (3) the work must be considered as a whole and normally requires special skill, training and knowledge to produce; and (4) whether a work is "artistic" or not is for the judge to decide, not witnesses or experts. **[22]** The word "includes" in s 3 means that the definition of graphic work is wide and not exhaustive. Therefore, other forms of graphic works may also fall within the definition. **[23]** The HC held that the three-dimensional plaintiff's telekung (produced based on two-dimensional SP1's drawings), could itself qualify as an artistic work under s 3(a) of the CA. **[26]** The court in *Flamelite (S) Pte*	an artistic work are satisfied. - Originality does not require novelty, but sufficient independent skill, labour and effort must have been expended in the creation of the work.

				Ltd and Others v Lam Heng Chung and Others held that the whole work must be considered, including its originality, simplicity and functional purpose. The fact that an object has a practical function does not automatically prevent copyright protection. **[27]** Whether a piece of "artistic work" can be protected by copyright under CA depends on whether all the following conditions are fulfilled: (1) an artistic work shall not be eligible for copyright unless **sufficient effort** had been expended to make the work original in character (s 7(3)(a) of CA). For eg, it was held in *Lau Foo Sun v Government of Malaysia [1974} 1 MLJ 28*, that copyright only protects originality of expression in the work and not originality of ideas or thoughts in the work. In *Kiwi Brands (M) Sdn Bhd v Multiview Enterprises Sdn Bhd [1998] 6 MLJ 38; [1998] 2 CLJ*	

				Supp 194, it was held that the Copyright Acts are not concerned with the originality of ideas, but with the expression of thought, and in the case of a literary work, with the expression of thought in print or writing; (2) the artistic work has been **written down, recorded or reduced to "material form"** (s 7(3)(b) of CA); (3) the artistic work qualifies for copyright protection due to one OR more of the following reasons: (a) the work is made by a "**qualified person"**; (b) the work is "**published"** in Malaysia; and (c) the work is made in **Malaysia**; and (4) there is no copyright protection: (a) for "any idea, procedure, method of operation or mathematical concept"; and (b) if the design has been registered under the **Industrial Designs Act 1996 ("the IDA")**. **[28]** The plaintiff's telekung was not merely an idea or	

				purely functional object. Besides being used for prayer, it provided comfort and elegance. **[29]** The "author" of an "artistic work" (other than photographs) is the "artist" of the work. **[34]** The HC found that the plaintiff owned copyright in the telekung because: (1) sufficient effort has been expended to make the plaintiff's telekung original in character (s 7(3)(a) of CA); (2) the plantiff's telekung has been reduced to "material form" within the meaning of s3; (3) all the three alternative conditions in s10(1), 2(a) and (3) of CA have been fulfilled as follows. (c) the plaintiff's telekung is made in Malaysia; and (4) plaintiff's telekung has not been registered as an industrial design under IDA. **[39]** The definitions of "article" and "industrial design"	

				in s 3 of the IDA are as follows: *"**article**" means any article of manufacture or handicraft, and includes any part of such article or handicraft if that part is made and sold separately* but does not include an integrated circuit or part of an integrated circuit within the meaning of the Layout-Designs of Integrated Circuits Act 2000 [Act 601], or a mask used to make such an integrated circuit; *"**industrial design**" means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged by the eye, but **does not include** —* *a) a method or principle of construction*; *or* *b) features of shape or configuration of an article which —* (i) *are dictated solely by the function which the article has to perform*; *or* (ii) *are dependent upon the*	

				appearance of another article of which the article is intended by the author of the design to form an integral part. **[40]** For a design to be registered under the IDA: (a) it must have features of shape, configuration, pattern or ornament that appeal to the eye; (b) those features must be applied to an article through an industrial process or means; and (c) the features must not fall within the exclusions in s 3 of the IDA.	
DNC Asiatic Holdings Sdn Bhd & Ors v Honda Giken Kogyo Kabushiki Kaisha and other appeals **[2019] MLJU 2170**	CA	Abang Iskandar JCA	Drawings of motorcycle and the three-dimensional form of the motorcycle	**[26]** The HC found that the EX-5 drawing was eligible for copyright protection as the drawing falls within the meaning of s 3 of the CA, and is protected under s 7(1)(c). **[30]** The HCJ held that the three-dimensional EX-5 motorcycle could also be protected by copyright, even though the original work was a two-dimensional drawing. In para [54]-[64], the HCJ: - Relied on *Peko Wallsend* and *Megnaway,* and held that the motorcycle could	- The Court affirmed that the two-dimensional drawing of the Honda EX-5 constituted an "artistic work" and thus, eligible for copyright protection under s 3 and 7(1)(c) of the CA. - Copyright also subsisted in the three-dimensional EX-5 motorcycle, but this copyright had already arisen before the 1996 amendment to the definition of "artistic work".

				qualify for copyright protection as a three-dimensional product derived from the drawing. The motorcycle did not have to be an exact reproduction of the drawing, and it was sufficient that the motorcycle was based on the drawing. - The HCJ accepted the evidence that the EX-5 was developed through a process involving clay models, mock-ups, prototypes and minor modification before commercial production. Although the 2010 model differed materially from the drawing, the basic design and styling remained substantially the same. - Applying the *Dura-Mine* case, the HCJ held that the original drawing and subsequent modification could be considered as a whole, as the works throughout the creation process originated from Honda R&D's employees. Accordingly, copyright subsisted in both the EX-5 drawing and the three-dimensional motorcycle. **[31]** The CA agreed with the HCJ's	It was held that the amendment did not retrospectively extinguish Honda's pre-existing copyright.

				finding on the matter of eligibility and subsistence of copyright in the EX-5 drawing and motorcycle, noting that minor modifications on the EX-5 drawing were cosmetic and did not materially change the design concept. **[32]** Professor Khaw Lake Tee in *Copyright Law in Malaysia* (3rd edn 2008), observed that where a work is three-dimensional and may be bulky or difficult to move, a two-dimensional work, such as a photograph, may constitute a "true copy" for the purposes of section 42.	
Alustil Sdn Bhd v Vitally Sdn Bhd **[2020] 10 MLJ 487**	HC	Wong Chee Lin J	Technical drawings of the shelf profile and the three-dimensional form of the shelf profile	**[10]** Copyright shall not subsist under this Act in any design which is registered under any written law relating to industrial design (s 7(5) of CA). **[11]** Since the plaintiff has pleaded that the defendant's "infringing shelf profile" is the same as the plaintiff's registered design, the plaintiff cannot also claim copyright over the same design.	- The HC held that the technical drawings of the shelf profile were "graphic works" and therefore, artistic works eligible for copyright protection. However, pursuant to s 7(5) of the Copyright Act 1987, copyright did not subsist in the three-dimensional shelf profile as the design had been registered under the

				[13]-[14]: The HC relied on the case of *Oh Boon Thiam v Yan Ming Agricultural Sdn Bhd (Oh Yoke Choon & Anor, third party)* where the plaintiff claimed copyright protection for designs also registered under the IDA. The issue was whether s 7(5) barred the claim. The HC held that s 7(5) excludes copyright protection once a design is registered under the IDA. Section 13B of CA was also inapplicable as it concerns artistic works, not registered industrial designs. **[16]-[20]**: The plaintiff alleged that the defendant had copied and sold its shelf profile, comprising a slider with pre-formed key slots, and L-shaped shelving bracket and an aluminium spline. It asserted copyright in its technical drawings of the slider and bracket, relying on *Dura-Mine* that technical drawings qualify as artistic works. Although part of the shelf profile was protected by a registered industrial design,	Industrial Designs Act 1996. - The HC held that copyright and registered industrial design protection cannot subsist concurrently in the same design.

				the plaintiff contended that the remaining components and the integrated structure were separately protected by copyright. **[39]** The court in *Oh Boon Thiam* held that s 13B only applies to "artistic work" which is non-registrable as industrial designs. Hence, once the plaintiff has registered its alleged works as industrial designs, they fell outside the scope of s 13B. **[40]** The court in *Oh Boon Thiam* further held in [25]-[26] that once a design is registered under the IDA 1996, copyright cannot subsist in the design under s 7(5). Further, s 13A(1)(a) excludes the making, copying or reproduction of an article according to the design from constituting copyright infringement. **[43]** There is no dual protection under both industrial design and copyright law for the same design. **[45]** The plaintiff cannot maintain the	

				present action which is premised upon a claim for copyright infringement in respect of an alleged work which is the subject matter of an industrial design registered in the name of the plaintiff.	

b) Unfair competition law

Legal framework

Malaysia does not have a single comprehensive statute governing unfair competition in the field of intellectual property. Rather, protection against unfair competition is provided through the common law tort of passing off and statutory mechanisms under the Trademarks Act 2019, the Industrial Designs Act 1996, and the Copyright Act 1987.

c) Passing off

Legal framework

Passing off is a common law cause of action protecting a trader's goodwill against misrepresentation. The claimant must establish the classical trinity: (i) goodwill associated with the identifying feature relied upon, which may include a product shape, configuration or overall get-up; (ii) a misrepresentation by the defendant likely to lead the relevant public to believe that the defendant's goods originate from, or are commercially connected with, the claimant; and (iii) resulting damage or a likelihood of damage. Where protection is claimed for the shape itself, commercial success under a prominent word mark does not necessarily demonstrate goodwill in that shape. Mere copying, without actionable misrepresentation and damage, is insufficient.

Authorities

Case	Court	Judge	Extracts from Judge	Remarks
***Mohammad Hafiz bin Hamidun v Kamdar Sdn Bhd* [2021] 4 MLJ 878**	FC	Tengku Maimun Chief Justice	**[30]** In *Reckitt and Colman Products Ltd v Borden Inc and others* [1990] 1 All ER 873 ("*Reckitt*"), three elements were summarised as follows (The "Classic Trinity"): (1) the plaintiff must establish a **goodwill** or reputation	- The Court reaffirmed that a claim in passing-off requires proof of the "classical trinity" of goodwill, misrepresentation and damage.

			attached to the goods or services which he supplies, and that the public associates the particular name, branding, packaging or "get up" with the plaintiff; (2) he must demonstrate a **misrepresentation** by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the plaintiff's; and (3) he must demonstrate that he suffers or is likely to suffer **damage** by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff. **[33]** The term "goodwill" is explained by Lord Macnaghten in *Muller*: … It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start… **[35]** Lord Diplock, in *Star Industrial Company Ltd v Yap Kwee Kor trading as New Star Industrial Company [1976] 1 MLJ 149*: Goodwill, as the subject of proprietary rights, is incapable of subsisting by itself. It had no independent existence apart from the business to which it is attached. **[36]** The FC found that there is goodwill attached to the name "Hafiz Hamidun" so any	- Goodwill must be associated with an identifying get-up, which may comprise a brand name, trade description, or individual features of labelling or packaging. - Mere similarity or copying, without the requisite misrepresentation and likelihood of damage to goodwill, is insufficient to establish passing off.

			misrepresentation of it will cause or is likely to cause damage to the goodwill of a business conducted using it. **[45]** If the goodwill of a particular trade or goods or service or description of those things is capable of being identified geographically, then any trader with sufficient nexus to that business is eligible to sue. **[47]** The name "Hafiz Hamidun" belonged to the plaintiff as the unregistered trademark is identified with the plaintiff, he uses it and it has accumulated goodwill. **[53]** The case of *Irvine* recognises that the misappropriation and deceptive use of a celebrity's name for commercial gain can amount to passing off where it misappropriates the celebrity's identity and creates a misleading commercial association. **[76]** Once goodwill is established, a celebrity or their licensee or related entity has the locus standi to bring a passing off claim against a third party who misappropriates the celebrity's name, image, stage name or other identifying features.	
***Ortus Expert White Sdn Bhd v Nor Yanni bt Adom & Anor* [2022] 2 MLJ 67**	FC	Zabariah Mohd FCJ	**[115]** Unlike trademarks, registered designs and copyright, passing off is not based on legislation and does not need to be registered. Passing off rights are valuable assets of a business, as they protect the value of the brand of the goods ("goodwill"). **[117]** Goodwill refers to the established reputation of a	- The Court confirmed the classical trinity of goodwill, misrepresentation and damage in a passing off action. - Misrepresentation may arise through the imitation of a

			business, which is a valuable property right attached to its trade. It encompasses factors that add value to the business, including its name, reputation, location, customer connections and other commercial advantages (*The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited* [1901] AC 217). **[119]** Passing off is generally harder to prove than trademark infringement because the plaintiff must prove goodwill, misrepresentation and damage. Unlike trademark infringement, where confusion may suffice, passing off requires proof of actual or likely deception of a substantial portion of the public. **[120]** The key issue in passing off is misrepresentation, rather than simply confusion. The misrepresentation must be material and creates a real, tangible risk of damage to the plaintiff (*Consitex SA v TCL Marketing Sdn Bhd* [2008] 3 MLJ 574; [2008] 8 CLJ 444). **[121]** To establish confusion or likelihood of confusion, the plaintiff must show that the defendant's misrepresentation is likely to deceive a substantial number of consumers into believing that the defendant's goods or services originate from, or are connected with, the plaintiff. The likelihood of confusion may be inferred from the surrounding circumstances and only needs to arise in the ordinary course of trade. **[122]** Misrepresentation must be established as a matter of	mark, trade name or get-up associated with the claimant's goods, and mere confusion is insufficient. - In assessing misrepresentation, the court must consider the product's get-up as a whole together with all surrounding circumstances. - Where the parties" goods are in direct competition, damage to goodwill may be inferred through loss of sales or diversion of trade.

			fact. It may be express, but more commonly arises implicitly through the defendant's use or imitation of a mark, trade name or get-up associated with the plaintiff's goods in the minds of the public (*AG Spalding & Bros v AW Gamage Ld*). **[125]** The FC found clear evidence of actual consumer confusion when a customer asked whether "Royal Expert White" and "Real Expert White" were the same product, to which the defendants confirmed that they were. This demonstrated both consumer confusion and the defendants" contribution to the deception, amounting to a clear case of passing off. **[126]** Where the parties" products are in direct competition, the court may readily infer likely damage to the plaintiff's goodwill through loss of sales or diverted trade, as well as loss of exclusive use of its trademark and get-up. **[127]** When deciding whether there is likely confusion or deception, the court must consider the get-up of the product as a whole and all the surrounding circumstances.	

Observation

In Malaysia, product shapes and configurations may be protected by copyright or passing off, depending on the particular work and facts. Copyright eligibility, the scope of infringement and the restrictions in sections 7(5), 13A and 13B must be considered separately. Loss of novelty for design registration does not itself determine copyright eligibility. Passing off may assist where goodwill exists in the shape or get-up and the imitation involves actionable misrepresentation and damage. Malaysia does not have a standalone general unfair competition regime prohibiting imitation of product shapes as such. Consequently, there may remain a genuine protection gap where neither an applicable copyright right nor the necessary goodwill and misrepresentation can be established. The product examples below are illustrative and are not concluded assessments of the depicted products.

Application

Product shapes/ Configurations	Copyright	Unfair competition	Passing-off
Beverage bottle	Possible if the shape qualifies as an artistic work and is not excluded by s 7(5).	No standalone general unfair competition claim. Protection may instead arise under specific statutory rights or passing off.	Possible if the bottle's shape/ get-up has acquired goodwill and the classical trinity test is satisfied.
Arm chair	Possible if the design contains artistic features or qualifies as a work of artistic craftsmanship and is not excluded by s 7(5).	No standalone general unfair competition claim. Protection may instead arise under specific statutory rights or passing off.	Possible if the chair's shape/ get-up is distinctive and goodwill, misrepresentation and damage are established.
Bag	Possible if the design or shape qualifies as an artistic work and is not excluded by s 7(5).	No standalone general unfair competition claim. Protection may instead arise under specific statutory rights or passing off.	Possible if the overall shape of the bag/ get-up has acquired goodwill and imitation gives rise to misrepresentation.
3D cube puzzle	Although artistic expression may be protected, the idea or method of operation might not be protected by copyright.	No standalone general unfair competition claim. Protection may instead arise under specific statutory rights or passing off.	Possible if the overall get-up has become distinctive and the classical trinity test is established.
Eraser/ Rubber	The drawing may qualify as a graphic work; protection of the resulting 3D article depends on whether it independently qualifies as an artistic work and on s 7(5).	No standalone general unfair competition claim. Protection may instead arise under specific statutory rights or passing off.	Possible if the resulting product/ get-up has acquired goodwill and there is misrepresentation causing damage.
Watch	Possible for artistic/ design features, but not merely functional aspects; subject to s 7(5).	No standalone general unfair competition claim. Protection may instead arise under specific statutory rights or passing off.	Possible if the overall shape/ get-up has acquired distinctiveness and goodwill.
Motorcycle	Depends. A 2D drawing may qualify as an artistic work; protection of the 3D product itself depends on the statutory requirements and the historical caveat in Honda.	No standalone general unfair competition claim. Protection may instead arise under specific statutory rights or passing off.	Possible if the shape/ get-up has acquired goodwill and imitation amounts to misrepresentation.
Chocolate confectionery	Possible if the 3D form qualifies as an artistic	No standalone general unfair competition	Possible if the distinctive shape/

	work, such as a sculpture, and is not excluded by s 7(5).	claim. Protection may instead arise under specific statutory rights or passing off.	get-up has acquired goodwill and the classical trinity is satisfied.

2. Whether such product shapes/configurations are enforceable on the grounds of
(i) copyright infringement, and/or
(ii) unfair competition and/or passing off,
through administrative, civil, or criminal actions;

2(i)

Copyright enforcement depends on identifying the protected work and determining whether the acts complained of infringe that work. Original drawings and other qualifying artistic works may enjoy copyright without registration, but protection of a drawing does not necessarily confer a right to prevent manufacture of the article depicted. Section 13A limits claims based on design documents or models recording or embodying designs for anything other than an artistic work or a typeface. Where the article itself qualifies as an artistic work, the analysis may differ, subject to the other statutory requirements and exclusions. Classification as a sculpture or work of artistic craftsmanship requires examination of the particular work; industrial manufacture alone should not be treated as conclusively excluding those categories. Section 7(5) excludes copyright in a registered industrial design. Section 13B separately addresses industrial exploitation of an artistic work, including specified permitted activities after twenty-five years from the end of the calendar year in which the articles were first marketed. There is no current automatic fifty-unit extinguishment rule. Where infringement is established, civil remedies are available under sections 36 and 37. Qualifying dealings in infringing copies may also attract liability under section 41 and statutory investigation, search and seizure. These mechanisms do not create a general prohibition against copying unprotected shapes.

2(ii)

Passing off may provide a civil remedy where the claimant establishes goodwill in the shape or get-up relied upon, misrepresentation and resulting damage or a likelihood of damage. Malaysia has no standalone general unfair competition statute providing a right against slavish imitation merely because a product has been launched or copied. Whether other statutory remedies apply depends on the rights and conduct involved; enforcement does not rely exclusively on passing off where actionable copyright infringement or another independent statutory wrong exists.

Civil Actions

Civil proceedings are the principal route for enforcing passing-off rights. Where copyright infringement is actionable, civil proceedings may also be brought under the Copyright Act 1987. A claimant may seek an interlocutory injunction, subject to the applicable legal requirements and the court's discretion. In appropriate cases, civil search and evidence-preservation relief may be sought, subject to stringent requirements and safeguards; such relief should be distinguished from statutory search and seizure by enforcement authorities. Final relief may include an injunction, damages or an account of profits and, where legally available and appropriate,

delivery-up or disposal orders. No remedy is automatic merely because the defendant's product resembles the claimant's product.

Administrative Actions

The Ministry of Domestic Trade and Cost of Living (KPDN) may investigate conduct within its statutory enforcement powers, including qualifying copyright offences. Passing-off liability is ordinarily determined in civil proceedings, rather than through a standalone administrative adjudication. Consumer protection or trade description legislation may be relevant where the conduct independently satisfies its requirements, but should not be treated as creating a general exclusive right in an unregistered product shape. The available investigative route must be assessed by reference to the particular statutory offence and evidence.

Criminal Actions

Passing off is a civil cause of action and does not itself provide a criminal enforcement route for an unregistered shape. Criminal enforcement may nevertheless be available where the conduct independently satisfies an offence under the Copyright Act 1987, the Trademarks Act 2019 or other applicable legislation. Trademark offences require consideration of the relevant registered trademark and statutory conditions. Section 9 of the Trade Descriptions Act 2011 should not be presented as a mechanism enabling an owner of purely unregistered shape rights to obtain criminal protection: its trademark-based order mechanism concerns registered trademark proprietors. The contemporary trademark offence framework, including sections 99 to 102 of the Trademarks Act 2019, must also be considered. Registration is not required for copyright, but the relevant article must constitute an infringing copy and the elements of the offence must be established.

3. Whether there are any precedents concerning the matters described in item 2 above;

Case	Ground of Enforcement	Nature of Action	Subject Matter	Outcome
Siti Khadijah Apparel Sdn Bhd v Ariani Textiles & Manufacturing (M) Sdn Bhd **[2019] 7 MLJ 478**	Copyright infringement	Civil	Copyright protection and alleged copying of the 2D drawings and 3D telekung design	The High Court allowed the plaintiff's suit with costs and found copyright infringement. Relevant to artistic-work protection for a product, but the statutory provisions considered must be distinguished from the current Act, including the deletion of the former section 7(6). Judgment dated 10 August 2018; reported in 2019. Confirm any subsequent appeal status before submission.
DNC Asiatic Holdings Sdn Bhd & Ors v Honda Giken Kogyo Kabushiki	Copyright infringement	Civil	Honda EX-5 2D drawings and 3D motorcycle	The Court of Appeal affirmed the copyright subsistence findings concerning the drawings and motorcycle, subject to the historical statutory position governing the

***Kaisha and other appeals* [2019] MLJU 2170**				pre-existing rights. This is not an unqualified statement of present-day protection for every manufactured product. Verify the precise appellate disposition, infringement findings and subsequent case status against the full judgment before submission.
***Alustil Sdn Bhd v Vitally Sdn Bhd* [2020] 10 MLJ 487**	Copyright infringement	Civil	Technical drawings and 3D shelf-profile design	Demonstrates the limitation on copyright enforcement where the same design is registered under industrial design legislation. Pursuant to s 7(5) of the Copyright Act 1987, copyright did not subsist concurrently in the registered design.
***Mohammad Hafiz bin Hamidun v Kamdar Sdn Bhd* [2021] 4 MLJ 878**	Passing off	Civil	Use of the celebrity's name and alleged misleading commercial association; not a product-shape dispute.	General Federal Court authority on goodwill, misrepresentation and damage and standing to protect goodwill associated with the celebrity's identity. Relevant to the principles of passing off, but not direct authority for an exclusive right in a product shape.
***Ortus Expert White Sdn Bhd v Nor Yanni bt Adom & Anor* [2022] 2 MLJ 67**	Passing off	Civil	Competing cosmetic products and their overall get-up	Federal Court authority on passing off involving competing cosmetic products and overall get-up. The court considered misrepresentation and the surrounding circumstances and found passing off established. Relevant to product get-up, rather than direct authority for a monopoly in a three-dimensional shape alone.

Observation

The Malaysian precedents identified principally concern civil enforcement of copyright and passing off rights in relation to product designs and get-up. The Copyright Act 1987 nevertheless provides for criminal and administrative enforcement mechanisms which may be relevant where an infringing product shape or configuration constitutes an infringing copy of protected copyright work. Section 41 creates criminal offences relating to the making, sale, distribution, possession and importation of infringing copies, while Section 44 provides powers of entry, search and seizure. Section 50 and 50A further provide investigative and arrest powers respectively, and Section 54 provides for forfeiture of seized articles.

4. Whether and how customs authorities and e-commerce platforms in each jurisdiction can address counterfeiting involving such product shapes/configurations;

Border and online enforcement depend on identifying an applicable right and satisfying the relevant statutory or platform requirements. Registration can assist with trademark and design complaints, but copyright protection does not depend on registration and not every lookalike constitutes counterfeit goods or an infringing copy.

Enforcement by Customs Authorities

Part XIII of the Trademarks Act 2019 provides border measures for registered trademarks, including the application-based restriction-on-importation procedure under section 82 and ex-officio action under section 93. Availability depends on the statutory conditions and the nature of the suspected goods. Section 39 of the Copyright Act 1987 separately provides a mechanism restricting importation of infringing copies; this may assist where the copied product or material infringes subsisting copyright, subject to the design-related limitations discussed above. Passing-off rights alone do not provide access to the registered-trademark border mechanism. Section 39 of the Industrial Designs Act 1996 concerns offences by bodies corporate, not a Customs detention procedure, and should not be relied upon as such.

Enforcement by E-Commerce Platforms

Platforms such as Shopee and Lazada provide IP complaint mechanisms through which rights holders can identify specific listings and submit evidence of ownership and infringement. Registered trademark and design certificates may support a complaint, but do not establish infringement automatically. Removal depends on the platform's assessment and applicable policy. Section 102 of the Trademarks Act 2019 is an offence provision and should not be cited as a general intermediary-immunity rule. The Copyright Act's service-provider provisions must be considered according to the particular activity and statutory conditions, rather than described as unconditional immunity.

Rights holders should monitor listings, preserve their URLs and screenshots, and provide a clearly identified legal basis for each complaint. Platforms may also undertake screening or proactive detection and impose seller sanctions under their contractual policies. A court injunction is therefore not universally required for a platform to suspend a seller or impose a ban.

For registered rights, provide the registration particulars, evidence that the right covers the goods and feature complained of, and a reasoned comparison explaining infringement. The platform may request further information or reject an inadequately supported notice; immediate removal should not be assumed.

Complaints based solely on an unregistered shape or passing off may be harder to resolve because they involve disputed questions of protection, goodwill and misrepresentation. A court order may assist, but should not be described as universally mandatory without checking the relevant platform policy. Rights holders should distinguish an alleged violation of platform rules from a legally established infringement.

Copyright complaints may address unauthorised use of protected photographs, labels, packaging artwork or other works. Removing copied photographs does not itself prevent sale of the physical lookalike where manufacture and sale of that article do not independently infringe a protected right. Conversely, if the article itself infringes qualifying copyright, the complaint need not necessarily be confined to copied imagery.

Practical difficulties may include concealed product details, disputed ownership or infringement, repeat listings and identifying the seller. Preserve evidence and consider a test purchase where appropriate. Distinguish platform counter-notice procedures from the statutory copyright procedure under section 43H. That section provides for removal or disabling access within forty-eight hours of a compliant notice, and restoration not less than ten business days after receipt of a counter-notification unless the prescribed notification of court proceedings is received. Check the statutory requirements and current platform procedure in the particular case; a generic "10 to 14 days" deadline should not be used.

5. <u>What strategic approaches can be taken to protect shapes/configurations once the product has already been commercialized in this manner; and</u>

a) Industrial design protection

First audit the dates and circumstances of disclosure, any earlier application and any valid priority claim. Section 12 of the Industrial Designs Act 1996 governs novelty. Its subsection (3) contains limited six-month exceptions concerning an official or officially recognised exhibition and disclosure arising from an unlawful act; it is not a general grace period for an ordinary commercial launch. Section 17 separately addresses convention priority. If novelty has been destroyed and no exception or priority basis assists, registration of the already-disclosed design may be unavailable. Assess existing rights immediately, while treating evidence-building for shape-mark protection as a longer-term strategy. Consider registration of genuinely new redesigns before disclosure, rather than attempting retrospectively to protect the earlier disclosed shape.

b) Three-dimensional trademark protection

Where a product shape has become capable of distinguishing the proprietor's goods from those of other trades, registration as a three-dimensional trademark under the Trademarks Act 2019 should be considered. The Act recognises the "shape of their goods or their packaging" as a registrable sign. This may be particularly useful after commercialisation, where consistent use, sales, advertising and market exposure have enabled consumers to associate the shape itself with a particular commercial origin.

However, the key difficulty is distinctiveness. A product shape may be visually distinctive but still be perceived merely as the shape of the product. Where the product has only recently been launched and counterfeited, there may be insufficient evidence of consumer association. Registration may therefore depend on proving acquired distinctiveness through use, supported by sales, advertising and market recognition. It is also subject to the absolute grounds for refusal under Section 23, including shapes resulting from the nature of the goods, necessary to obtain a technical result, or giving substantial value to the goods.

c) Copyright protection

Identify whether copyright subsists in the article itself, its drawings, surface artwork or other separate works, and distinguish those rights from the acts that can be restrained. Preserve dated drawings, prototypes, authorship records, employment or commissioning documents and assignments. A voluntary copyright notification may assist the evidential record but does not create copyright or overcome statutory exclusions. Assess sections 7(5), 13A and 13B before relying on copyright against manufacture of a lookalike. Where actionable infringement exists, consider the appropriate civil or statutory enforcement route.

d) Passing off

Assess whether the shape or overall get-up relied upon has acquired goodwill and whether the defendant's conduct misrepresents commercial origin or association. Retain Malaysian sales, advertising, consumer enquiries, evidence of recognition and instances of deception. Sales under a word mark do not necessarily establish goodwill in the shape itself. Use consistent product presentation and advertising that encourages recognition of the shape, without assuming that such activity immediately creates an enforceable shape right.

e) Monitoring, evidence and enforcement

Monitor the market and preserve dated photographs, listings, advertisements, invoices, correspondence and, where appropriate, test-purchase evidence. Identify the seller and assess each copied feature against the particular right relied upon. Prioritise immediately enforceable rights, including copied artwork or misleading branding, while building evidence for longer-term shape protection. Consider civil relief, platform complaints, border measures or statutory investigation only where their respective requirements are satisfied. If neither applicable copyright nor goodwill and misrepresentation can be established, copying of the shape alone may remain outside the available remedies.

6. Whether there may be difficulties even in enforcing trademark rights relating to a 3D mark or design rights against imitation of product shapes/configurations assuming that right holder can obtain these rights.

Registration does not eliminate enforcement difficulties. A defendant may challenge a three-dimensional trademark's validity under section 47 of the Trademarks Act 2019, including by reference to the applicable absolute grounds in section 23. Acquired distinctiveness may overcome the grounds specified in section 23(2), but does not displace the separate shape exclusions in section 23(3), including shapes resulting from the nature of the goods, necessary to obtain a technical result or giving substantial value to the goods.

Infringement must be assessed under the applicable limb of section 54. The identical-sign/identical-goods provision in section 54(1) should be distinguished from the provisions requiring likelihood of confusion in section 54(2). Questions may arise concerning the use of the registered shape in the course of trade, the comparison of the signs and consumers' perception of the goods. A defendant's separate branding and presentation may be relevant, but do not automatically defeat a registered shape-mark claim. The paper should not assert that defendants frequently succeed on this basis without supporting Malaysian authorities.

For registered industrial designs, enforcement disputes may concern validity, prior disclosure, the registered representations, the statement of novelty and whether the defendant has applied the design or a fraudulent or obvious imitation under section 32 of the Industrial Designs Act 1996. Minor alterations do not necessarily avoid infringement. Protection concerns the registered visual features rather than an underlying functional idea, and the comparison must be made within the statutory scope of the registration. Grounds for revocation may also be raised as defences under section 34. Accordingly, scope and validity should be assessed before proceedings are commenced.