



ICLG

The International Comparative Legal Guide to:

Copyright 2015

1st Edition

A practical cross-border insight into copyright law

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Malaysia



Lin Li Lee



Wee Liang Lim

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1 Copyright Subsistence

1.1 What are the requirements for copyright to subsist in a work?

Pursuant to the Copyright Act 1987 (“the 1987 Act”), copyright subsists in a work if it:

- (a) is original;
- (b) is written down, recorded or reduced to material form;
- (c) belongs to one of the categories of the following protected works:
 - (i) a literary, musical or artistic work or film or sound recording first published in Malaysia;
 - (ii) a work of architecture erected in Malaysia or any artistic work incorporated in a building located in Malaysia; or
 - (iii) a broadcast transmitted from Malaysia; and
- (d) satisfies one of the following qualifications for copyright:
 - (i) the author of a work or in the case of joint authorship, one of the authors is a ‘qualified person’;
 - (ii) the work is first published in Malaysia; or
 - (iii) the work is made in Malaysia.

Qualified Person

A ‘qualified person’ in relation to an individual means a citizen of or permanent resident in Malaysia, and in relation to a body corporate, means a body corporate established in Malaysia and vested with legal personality under the laws of Malaysia. The definition of ‘qualified person’ in relation to a literary, musical or artistic work or a film includes a citizen or a permanent resident of, or a body corporate incorporated in Malaysia or in a country which is a member of the Berne Convention for the Protection of Literary and Artistic Works. In relation to sound recordings and broadcasts, a ‘qualified person’ includes a citizen or permanent resident of, or a body corporate incorporated in Malaysia or a member state of the World Trade Organisation.

First Publication in Malaysia

Literary, musical and artistic works or films – a work first published elsewhere but subsequently published in Malaysia within 30 days is deemed a ‘first publication’ in the 1987 Act. All literary, musical or artistic works and films first published in any Berne Union country are also entitled to copyright protection in Malaysia. A work first published in a non-Berne member state will enjoy copyright

protection under the 1987 Act if it is published in Malaysia or any Berne Union country within 30 days of its first publication.

Sound recordings and broadcasts – the first publication rule applies if the work is first published in any member state of the World Trade Organisation.

Published editions of literary, musical or artistic works first published in the United Kingdom – the first publication rule applies if the work is first published in the United Kingdom.

Work Made in Malaysia

In order to determine when a work is made in Malaysia, the courts will take into account the time of the completion of the work.

1.2 On the presumption that copyright can arise in literary, artistic and musical works, are there any other works in which copyright can subsist and are there any works which are excluded from copyright protection?

Other works eligible for copyright protection are broadcasts, works of architecture, artistic works incorporated in a building, derivative works, films, sound recordings, live performances and published editions of literary, artistic or musical work.

Copyright does not subsist in any design which is registered under the following laws relating to industrial design:

- United Kingdom Designs (Protection) Act 1949;
- United Kingdom Designs (Protection) Ordinance of Sabah; and
- Designs (United Kingdom) Ordinance of Sarawak.

The 1987 Act does not exclude works which contain elements that are inflammatory, seditious and immoral from copyright protection although they may affect the type of remedy available. Works are protected irrespective of their quality and the purpose for which they were created.

1.3 Is there a system for registration of copyright and if so what is the effect of registration?

Although there is no system for registration of copyright, there is now a Copyright Voluntary Notification System that came into effect on 21 June 2012. By filing a voluntary notification, the certified extract from the Register of Copyright is admissible in evidence in any court proceedings and will be *prima facie* evidence of the particulars entered therein.

1.4 What is the duration of copyright protection? Does this vary depending on the type of work?

The duration of copyright protection varies according to the category of work.

Categories of Work	Duration of Copyright
Literary, musical and artistic works	Copyright subsists during the life of the author and 50 years after his death. In the event of a joint authorship, the 50-year period starts from the date of the death of the surviving author.
Derivative works of literary, musical and artistic works	Copyright in each individual contributor's derivative work subsists during the life of the contributor and 50 years after his death. Copyright in the whole collection of derivative work subsists during the life of the person who selects and arranges the contents and 50 years after his death.
Unpublished literary, musical and artistic works	Copyright subsists until the expiry of 50 years from the beginning of the calendar year next following the year in which the work was first published. Perpetual copyright subsists if the work remains unpublished.
Literary, musical and artistic works published anonymously or under a pseudonym	Copyright subsists until the expiry of a period of 50 years computed from the beginning of the calendar year next following the year in which the work was first published or first made available to the public, whichever is the latest.
Published editions, sound recordings, broadcasts, films, works of Government and performer's rights	Copyright subsists until the expiry of 50 years computed from the beginning of the calendar year next following the year in which the work was first published.
Works emanating from foreign countries	Foreign work that is first published or made in Malaysia is entitled to copyright protection in Malaysia. The foreign work is protected in Malaysia for the term provided by the 1987 Act.

1.5 Is there any overlap between copyright and other intellectual property rights such as design rights and database rights?

There is an overlap between trade mark and copyright. A logo, device, symbol, word mark, a combination of words, and other works notably artistic and literary works that are used as a trade mark are entitled to copyright protection if they satisfy the requirements outlined under question 1.1.

There is also an overlap between industrial designs and copyright. Three-dimensional articles created out of design drawings are entitled to copyright protection prior to the Copyright (Amendment) Act 1996 that came into effect on 1 September, 1999 which introduced Sections 7(5), 7(6), 13A, 13B and 13C into the 1987 Act. Sections 7(6) and 13C have been repealed and Section 13B has been amended by the Copyright Amendment Act 2012 which came into effect on 1 March, 2012.

Section 7(5) provides that no copyright would subsist in a design which is registered under any written law relating to industrial design.

Although Section 7(6) was repealed by the Copyright Amendment Act 2012, works created prior to the amendment would be still be governed by Section 7(6), which provides that the copyright in a design which is capable of being registered under any written law relating to industrial design but is not so registered would cease as soon as there is any application of that design to an article which has been reproduced more than 50 times by an industrial process. By way of contrast, the amended Section 13B provides that articles derived from an artistic work and made by an industrial process which are marketed in Malaysia or elsewhere enjoy copyright protection for a period of 25 years from the end of the calendar year in which the articles are first marketed.

1.6 Are there any restrictions on the protection for copyright works which are made by an industrial process?

It is not an infringement of any copyright to make any article according to a design document or model recording or embodying a design for anything other than an artistic work or a typeface. However, the copying of a two-dimensional design document itself may infringe the copyright thereof. Section 13A of the 1987 Act is restricted to the three-dimensional reproduction of a design.

Once the copyright owner has made, by an industrial process or other means, articles which are copies of the artistic works, and marketed such articles in Malaysia or elsewhere, he is entitled to copyright protection for only 25 years calculated from the end of the calendar year in which such articles were first marketed. If only part of the artistic work is exploited as aforementioned, the 25-year copyright protection applies to only that part.

See also comments on the repealed Section 7(6) and amended Section 13B of the 1987 Act under question 1.5 above.

2 Ownership

2.1 Who is the first owner of copyright in each of the works protected (other than where questions 2.2 or 2.3 apply)?

Copyright is initially vested in the author.

2.2 Where a work is commissioned, how is ownership of the copyright determined between the author and the commissioner?

Where a work is commissioned by a person who is not the author's employer under a contract of service or apprenticeship, the copyright shall be deemed to be transferred to the person who commissioned the work or the author's employer, subject to any agreement between the parties excluding or limiting such transfer.

2.3 Where a work is created by an employee, how is ownership of the copyright determined between the employee and the employer?

Where the work is made in the course of the author's employment, the copyright shall be deemed to be transferred to the author's employer.

This rule does not apply if the employee did not produce his work in the course of his employment and during his normal working hours.

In determining whether a person is an employee, the courts will look into various factors including the person's duties, the scope of his work as stated in his contract, nature of remuneration, authority

to supervise the person's work, entitlement to leave and rest days and the facts surrounding each case.

2.4 Is there a concept of joint ownership and, if so, what rules apply to dealings with a jointly owned work?

The 1987 Act defines a 'work of joint authorship' as a work produced by the collaboration of two or more authors in which the contribution of each author is not separable from the contribution of the other author or authors.

There must be two or more authors involved in the furtherance of a common design in order for a work to be regarded as a 'work of joint authorship'. There is no requirement for the intention to produce a joint work or that the contribution from each author is equal. It is, however, a requirement that the contribution of the joint author in the work is significant. The significance of the contribution is judged by the joint author's skill and labour qualitatively, regardless of the portion of such contribution. For instance, a person providing a mere contribution of idea to the creation of an artistic work does not render him a joint author as copyright law protects expression of a work and not ideas.

If each author's contribution can be separated from each other, the work is not created out of a joint authorship. In such a scenario, each author is entitled to full copyright protection to his portion of contribution. The person arranging and selecting the contents of all the authors' separate work is entitled to the copyright in the entire work.

An assignment or licence granted to one copyright owner shall have effect as if the assignment or licence is also granted by his co-owner or co-owners, and subject to any agreement between the co-owners, fees received by any of the owners shall be divided equally between all the co-owners.

3 Exploitation

3.1 Are there any formalities which apply to the transfer/assignment of ownership?

For an assignment to take effect, it must be in writing.

3.2 Are there any formalities required for a copyright licence?

All licences must be made in writing.

There is another form of non-exclusive licence for publishing and producing translation in the Malay language and other vernacular languages in Malaysia of a literary work written in any other language. An application for such licence needs to be submitted to the Copyright Tribunal in such form as specified in Part 1 of the Schedule in the Copyright (Licence to Produce and Publish in the National Language a Translation of a Literary Work) Regulations 1987. A separate application shall be made in respect of each literary work and each application shall be triplicated and shall be served by delivering it in person or by sending it by post to the Secretariat to the Tribunal. At the time that the application is made, a fee of 100 Ringgit Malaysia shall be paid to the Secretariat.

3.3 Are there any laws which limit the licence terms parties may agree (other than as addressed in questions 3.4 to 3.6)?

No, there are no such laws in Malaysia.

3.4 Which types of copyright work have collective licensing bodies (please name the relevant bodies)?

Musical sound-recording works and performer's rights have licensing bodies. The relevant bodies are Music Authors' Copyright Protection (MACP) Berhad, Recording Performers Malaysia Berhad and Public Performance Malaysia Sdn Bhd.

3.5 Where there are collective licensing bodies, how are they regulated?

The licensing bodies are regulated by the Act 1987 and the Copyright (Licensing Body) Regulations 2012. A licensing body must apply to the Controller of Copyright to be declared a licensing body.

3.6 On what grounds can licence terms offered by a collective licensing body be challenged?

A 'licensing scheme' relates to licensing schemes operated by licensing bodies in relation to the copyright in any work so far as they relate to licences for:

- Reproducing the work.
- Performing, showing or playing the work in public.
- Communicating the work to the public.
- Rebroadcasting the work.
- The commercial rental of the work to the public.
- Adaptations of the work.

Where there is dispute as to the terms of a licensing scheme between the operator of the licensing scheme and:

- a person claiming that he requires a licence in a case of a description to which the licensing scheme applies;
- an organisation claiming to be representative of such persons; or
- a person who has been granted a licence to which the licensing scheme applies,

the operator of the licensing scheme, the person or the organisation may refer the licensing scheme to the Copyright Tribunal insofar as it relates to cases of that description.

4 Owners' Rights

4.1 What acts involving a copyright work are capable of being restricted by the rights holder?

Copyright owners have the exclusive right to control the following acts in relation to the whole work or a substantial part thereof, either in its original or derivative form:

- Reproduction in any material form.
- Communication to the public.
- The performance, showing or playing to the public.
- The distribution of copies to the public by sale or other transfer of ownership.
- Commercial rental to the public.

4.2 Are there any ancillary rights related to copyright, such as moral rights, and if so what do they protect, and can they be waived or assigned?

The 1987 Act recognises moral rights. Where copyright subsists in a work, no person may, without the consent of the author, or after

the author's or his representative's death, do or authorise any of the following acts:

- present the work, by any means whatsoever, without identifying the author or under a name other than that of the author; and
- distort, mutilate or in any other way modify the work if the distortion, mutilation or modification:
 - i. significantly alters the work; and
 - ii. is such that it might reasonably be regarded as adversely affecting the author's honour or reputation.

The author or, after his death, his personal representative, may exercise the moral rights notwithstanding that the copyright in the work was not at the time of the act vested in the author or personal representative.

A performer enjoys moral rights as well. However, a performer's moral rights only exist if his performance has been fixed in 'phonogram' form. Performances recorded in forms other than phonogram do not enjoy any moral right. 'Phonogram' refers to 'the fixation of the sound of a performance or of other sounds other than in the form of a fixation incorporated in a film or other audio-visual work'.

4.3 Are there circumstances in which a copyright owner is unable to restrain subsequent dealings in works which have been put on the market with his consent?

A copyright owner's exclusive right to distribute copies of its work to the public by sale or transfer of ownership is limited to putting into circulation copies not previously put into circulation in Malaysia and not to any subsequent distribution or importation of those copies into Malaysia.

A copyright owner's exclusive right to commercial rental in relation to films only applies if such commercial rental has led to widespread copying of such work which has materially impaired the exclusive right of reproduction.

5 Copyright Enforcement

5.1 Are there any statutory enforcement agencies and, if so, are they used by rights holders as an alternative to civil actions?

The Minister of the Ministry of Domestic Trade, Co-operatives and Consumerism (MDTCC) is empowered under the 1987 Act to appoint a Controller of Copyright and Deputy and Assistant Controllers to supervise all matters relating to copyright including enforcement of the 1987 Act. The Controllers form part of the Enforcement Unit and are vested with powers of investigation which are shared with the police, although in practice, the police generally carry out an ancillary role. The enforcement officers have the power to:

- enter premises with a warrant (during entry of premises, the enforcement officers may have access to computerised or digitalised data whether stored in a computer or any other medium);
- enter premises without a warrant;
- remove any obstruction to entry;
- detain suspects;
- investigate the commission of any offence;
- forfeit articles seized; and
- intercept or listen to any communications that are likely to contain any information which is relevant for the purpose of any investigation into an offence.

Apart from the criminal enforcement powers under the 1987 Act, the Copyright Tribunal established under the 1987 Act only has power to make the following orders:

- to approve or vary the licensing scheme;
- to determine whether the particular applicants should be granted licences under such schemes;
- to approve or vary the terms of particular licences;
- to hear disputes over which applicants for licence fall within the scheme on the refusals to grant licences; and
- to make orders declaring that the complainant is entitled to a licence.

The Tribunal may of its own motion or shall at the request of a party, refer a question of law arising in proceedings concluded before it for determination by the High Court. A decision of the High Court shall be final and conclusive and no such decision shall be final and shall not be challenged in any other court or before any other authority, judicial or otherwise, whatsoever.

5.2 Other than the copyright owner, can anyone else bring a claim for infringement of the copyright in a work?

An 'exclusive licensee' has the same rights of action and is entitled to the same remedies as the copyright owner as if the licence had been an assignment, and those rights and remedies shall be concurrent with the rights and remedies of the copyright owner. However, the exclusive licensee cannot proceed with the action except with the leave of court unless the owner is joined as a party.

5.3 Can an action be brought against 'secondary' infringers as well as primary infringers and, if so, on what basis can someone be liable for secondary infringement?

A direct/primary infringer is any person who does or causes any other person to do, without the licence of the copyright owner, any act referred to under question 4.1.

Indirect or secondary infringement occurs where any person who, without the consent or licence of the copyright owner (in Malaysia or elsewhere), and where he knows or ought reasonably to know that the making of the article was carried out without the consent or licence of the copyright owner, imports an article into Malaysia for the purpose of:

- selling, letting for hire, or by way of trade, offering or exposing for sale or hire, the article;
- distributing the article for the purpose of trade/any purpose to an extent that it will affect prejudicially the owner of the copyright; or
- by way of trade, exhibiting the article in public.

Therefore, an action can be brought against both direct and indirect infringers.

5.4 Are there any general or specific exceptions which can be relied upon as a defence to a claim of infringement?

The exceptions which can be relied as a defence to a claim of copyright infringement are:

- Fair dealing for purposes of research, private study, criticism, review or the reporting of news or current news provided that it is accompanied by an acknowledgement of the title of the work and its authorship (not applicable if the reporting of news or current events is by means of a sound recording, film or broadcast).
- An act restricted by copyright is done by way of parody, pastiche or caricature.

- Incidental inclusion of a copyright work in an artistic work, sound recording, film or broadcast.
- Reproduction and distribution of copies of any artistic work permanently situated in a place where it can be viewed by the public.
- Incidental inclusion of a work in an artistic work, sound recording, film or broadcast.
- Inclusion of a work in a broadcast, performance, showing or playing to the public, collection of literary or musical works, sound recording or film, if such inclusion is made by way of illustration for teaching purposes and is compatible with fair practice provided the source of the work and the name of the author which appears on the work is mentioned.
- Any use of a work for the purpose of an examination by way of setting the questions, communicating the questions to the candidates or answering the questions provided that a reprographic copy of a musical work shall not be made for use by an examination candidate in performing the work.
- Playing a recording of a broadcast in schools, universities or educational institutions.
- Making a sound recording of a broadcast, or a literary, dramatic or musical work, sound recording or a film included in the broadcast insofar as it consists of sounds if such sound recording of a broadcast is for the private and domestic use of the person by whom the sound recording is made.
- Making a film of a broadcast, or a literary, artistic, dramatic or musical work or a film included in the broadcast insofar as it consists of visual images if such making of a film of the broadcast is for the private and domestic use of the person by whom the film is made.
- Making and issuing copies of any work into a format to cater for the special needs of people who are visually or hearing impaired and the issuing of such copies to the public is by non-profit making bodies.
- Reading or recitation in public or in a broadcast by one person any reasonable extract from published literary work if accompanied by sufficient acknowledgment.
- Use of work by certain public libraries and educational, scientific or professional institutions as the MDTCC may by order prescribe.
- Reproduction of any work by a broadcasting service (government-owned or privately owned) exclusively for a lawful broadcasting and it is destroyed within six months from the date of the reproduction unless a longer period is agreed between the broadcasting service and the copyright owner, but if the reproduction of the work is of exceptional documentary character, it may be preserved in the archives of the broadcasting service and shall not be used for broadcasting or for any other purpose unless consent is obtained from the copyright owner.
- The performance, showing or playing of a work by a non-profit club or institution for charitable or educational purposes in a place where no admission fee is charged.
- Use of work for the purposes of judicial proceedings, royal commission proceedings, a legislative body, a statutory or Governmental inquiry, or for the purpose of the giving of professional advice by a legal practitioner.
- Quotations from a published work if they are compatible with fair practice and their extent does not exceed that justified by the purpose, provided the source of the work and the name of the author which appears on the work is mentioned.
- Reproduction by the press, the broadcasting or the showing to the public of articles published in newspapers or periodicals on current topics, if such reproduction,

broadcasting or showing has not been expressly reserved and provided the source is clearly indicated.

- Reproduction by the press, the broadcasting or the performance, showing or playing to the public of lectures, addresses and other works of the same nature which are delivered in public if such use is for informatory purposes and has not been expressly reserved.
- Commercial rental of computer programs, where the program is not the essential object of the rental.
- Making of a transient and incidental electronic copy of a work made available on a network if the making of such copy is required for the viewing, listening or utilisation of the said work.

5.5 Are interim or permanent injunctions available?

Both are available depending on the circumstances of the applicant's submission of the injunction.

5.6 On what basis are damages or an account of profits calculated?

Where the copyright owner grants licences to others by a royalty or licence fee payment, damages are calculated on the basis of the royalty rate. If the copyright owner and the infringer are direct competitors, damages will be assessed on a basis of the lost profits which the copyright owner would receive had the infringement not occurred. The court may quantify the damages based on impression and not precise assessment of individual items.

The defendant is required to make an account of profits to calculate all revenue he has made out of his infringement, and he is to restore the profits to the plaintiff.

5.7 What are the typical costs of infringement proceedings and how long do they take?

The typical cost of an infringement proceeding is approximately USD 50,000 to USD 100,000 depending on the complexity of the matter and the issues involved.

The estimated time period from the filing of the civil proceedings to the trial of the action is approximately 12 to 15 months.

5.8 Is there a right of appeal from a first instance judgment and if so what are the grounds on which an appeal may be brought?

The right of appeal from a first instance judgment of the High Court is to the Court of Appeal in respect of the whole or any part of judgment, and can be based on a point of fact or law, or both. However, an appeal from the Court of Appeal to a Federal Court judgment can only be based on a point of law, and leave to appeal must be granted by the Federal Court.

5.9 What is the period in which an action must be commenced?

An action for copyright infringement is time-barred after six years from the act of infringement. In the case of continuing infringement, the limitation period is computed from the date of the infringement.

6 Criminal Offences

6.1 Are there any criminal offences relating to copyright infringement?

Yes. The criminal offences relating to copyright infringement are as below:

- a) Making for sale or hire any infringing copy.
- b) Selling, letting for hire or by way of trade, exposing or offering for sale or hire any infringing copy.
- c) Distributing infringing copies.
- d) Having in the infringer's possession, custody or control, otherwise than for his private and domestic use, any infringing copy.
- e) By way of trade, exhibiting in public any infringing copy.
- f) Importing into Malaysia, other than for private and domestic use, an infringing copy.
- g) Making or having in possession any contrivance used or intended to be used for the purposes of making infringing copies.
- h) Circumventing or authorising the circumvention of any effective technological measures that are used by copyright owners in connection with the exercise of their rights under the 1987 Act and that restrict unauthorised acts.
- i) Manufacturing, importing or selling any technology or device for the purpose of the circumvention of any effective technological protection measure.
- j) Removing or altering any electronic rights management information without authority.
- k) Distributing, importing for distribution or communicating to the public, without authority, works or copies of works in respect of which electronic rights management information has been removed or altered without authority.
- l) Operating an audio-visual recording device in a screening room to record any film in whole or in part.

6.2 What is the threshold for criminal liability and what are the potential sanctions?

The standard of proof for criminal liability is proof beyond reasonable doubt.

Any person who is found guilty of the offences stated under question 6.1 is liable to either a fine, or imprisonment, or both.

7 Current Developments

7.1 Have there been, or are there anticipated, any significant legislative changes or case law developments?

In *Microsoft Corporation v. Conquest Computer Centre Sdn Bhd* [2014] 2 MLRH 578, the plaintiff alleged the defendant sold a personal computer without the plaintiff's consent and without providing the plaintiff's original and licensed software in CD-ROMs/discs, the end-user license agreements, manuals, product registration cards and certificates of authenticity (CA) to the purchaser. The defendant contended there was a trial version of the works whereby the software could be used for free for a certain time.

The defendant relied on internet print-outs of articles arguing there was a 'free trial version' of the works and that professionals normally consult or refer to books and articles written regarding their fields. Despite the *prima facie* proof of the articles, the court

held that the plaintiff was successful in proving the defendant had infringed the plaintiff's copyright in the works when the defendant had installed the works on the personal computer without a licence from the plaintiff as there was no CA affixed to the personal computer. The court stated that the defendant could have easily verified the alleged 'free trial version' by logging into the Microsoft website and, in resorting to depend on other websites and articles from the internet to support the defendant's contention, the defendant was merely attempting to 'argue' its way out of an infringement action.

This case sets the record straight for both consumers and traders alike to be mindful of the terms and conditions of downloading and installing any computer program. The court's approach also possibly refutes the general belief among software users that there is such a 'free trial version' that excuses illegal use of computer software.

7.2 Are there any particularly noteworthy issues around the application and enforcement of copyright in relation to digital content (for example, when a work is deemed to be made available to the public online, hyperlinking, etc.)?

Technological Protection Measures

Section 36A of the 1987 Act deals with the circumvention of technological protection measures (e.g. access control and copy control measures). Any circumvention or causing or authorising any other person to circumvent a technological protection measure is an offence. Commercial dealings with any technology, device or component that either has as its main purpose the circumvention of technological protection measures or promotes or facilitates such circumvention is also prohibited.

Rights Management Information

Section 36B of the 1987 Act provides protection against the tampering with rights management information in electronic form or the dealing with copies of works knowing that the electronic rights management information has been removed or altered. The 'rights management information' consists of information that identifies the work, author, owner of any right in the work, terms and conditions of use of the work, and the codes representing such information, when any of these items is attached to a copy of the work or appears in connection with the communication of the work to the public.

Online Service Provider

Section 43C(1) exempts a service provider from liability for copyright infringement if the infringement by its user occurs by reason of any of the following:

- the transmission, routing or provision of connections by the service provider of an electronic copy of the work through its network; or
- any transient storage by the service provider of an electronic copy of the work in the course of such transmission, routing or provision of connections.

The exemption is, however, confined to any of the following situations:

- the service provider did not initiate or direct the transmission of the electronic copy of the work;
- the service provider did not select the electronic copy of the work but the transmission, routing or provision of connections was carried out through an automatic technical process;
- the service provider did not select the recipient of the electronic copy of the work except as an automatic response to the request of another person; or

- the service provider did not modify the electronic copy of the work other than as part of a technical process.

Section 43D(1) of the 1987 Act provides that a service provider shall not be held liable for infringement of copyright for the making of any electronic copy of the work on its primary network if it is:

- from an electronic copy of the work made available on an originating network;
- through an automatic process;
- in response to an action by a user of its primary network; or
- in order to facilitate efficient access to the work by a user,

provided that the service provider does not make any substantive modification to the contents of the electronic copy, other than a modification made as part of a technical process.

Section 43E of the 1987 Act exempts a service provider from liability in the following situations:

- when storing an electronic copy of a work where it is done at the direction of its user; and
- when referring or providing a link or an information location service to its users where an electronic copy of the work is available at an online location of another network,

provided that the service provider does not have knowledge of the infringing activity, does not receive any financial benefit directly attributable to the infringement and it has responded promptly to a notification to take down the infringing copy.

Notice and Take-down Procedure

Section 43H of the 1987 Act provides that, if an electronic copy of a work accessible in a network infringes the copyright of the work, the copyright owner has the right to notify the service provider about the infringement. The copyright owner must compensate the service provider against any damages, loss or liability arising from the compliance by the provider within 48 hours from the receipt of the notification. A service provider who has removed the infringing copy of the work shall notify the person who made available the infringing copy of the action taken by the service provider. The person whose work was removed or to which access has been disabled may send a counter-notice to the service provider. The service provider shall, upon receipt of the counter-notice, promptly provide the issuer of the first notification with a copy of the counter-notice and inform the issuer that the removed work or access to the work will be restored in 10 business days, unless the service provider has received another notification from the issuer of the first notification informing it that he has filed an action seeking a court order to restrain the issuer of the counter notification from engaging in any infringing activity relating to the material on the service provider's network.

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Lin Li is a partner of the firm and the Head of the IP and Technology Department. She handles contentious matters involving patent, trade mark, copyright and industrial design infringement, passing off including seizure and anti-counterfeiting actions, and notably provides strategic advice on settlement negotiations. She also advises on domain name issues and disputes. Lin Li is regularly engaged by clients to advise on cross border transactions involving licensing, technology transfer, assignment and franchising. A major part of her practice consists of advising and working closely with local and international clients on the management and protection of their IP portfolio in various sectors. She also advises clients on franchising laws, and regularly speaks at seminars and workshops on personal data protection. Lin Li read law at the University of Leeds, United Kingdom (second upper) and is admitted as an Advocate and Solicitor of the High Court of Malaya. She is a registered trade mark and industrial designs agent and is listed as a recommended lawyer in the Legal 500 Asia Pacific 2014.

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Wee Liang has assisted in contentious and non-contentious matters exclusively on IP and Information Technology. He advises on transactional IP work such as licensing, franchising, and regulatory advice for cosmetics and food and labelling laws. Wee Liang also advises on trade mark registration and data protection and privacy issues. He has recently assisted in IP enforcement work and drafting policies and agreements for clients from a diverse range of sectors including fashion and retail, food and beverage, luxury products, e-commerce, security system, property development, education, chemical manufacturing and personal care. Wee Liang graduated from the University of Liverpool, United Kingdom (first) and was admitted as a Barrister-at-Law to the Bar of England and Wales. He is a member of the Honourable Society of Lincoln's Inn, London.



Consistently rated as Tier 1 by Legal 500 and in Band 1 by Chambers & Partners in the area of Intellectual Property, Tay & Partners has impressive experience in safeguarding its clients' creative assets and business secrets. We work with our clients to identify, secure, exploit and maintain their valuable IP assets. This includes consulting our clients and formulating strategies for protecting trade secrets and confidential information through internal processes and employment-related procedures. We have particular experience in IP licensing and the negotiation of such agreements across a vast range of technological fields and industries. Our experience extends to the sale or purchase of numerous types of intellectual property as well as perfecting and transferring security interest in IP. We also specialise in franchise, data protection, IT, domain name, communication and multimedia, food and drug regulatory and labelling matters.

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