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## Book Review

### *Intellectual Property Law in Malaysia* by Tay Pek San

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#### Bibliographic Information

Tay Pek San, *Intellectual Property in Malaysia* (2nd edn, Sweet & Maxwell 2020), ISBN: 978-967-2339-89-2

#### Introduction

The Malaysian law publisher, Sweet & Maxwell, has finally brought us the much-awaited update to Dr Tay Pek San's intellectual property law textbook. This happened just before Dr Tay went on retirement after more than two decades of service at the Faculty of Law, University of Malaya.

In the interval of seven years between the first edition and the current edition, many new developments have appeared in the intellectual property law landscape in Malaysia. The old Trade Marks Act 1976 has been replaced by the Trademarks Act 2019. Both the Copyright Act 1987 and Industrial Designs Act 1996 have been amended. Furthermore, with greater awareness of intellectual property rights among the business community and the setting up of the Intellectual Property Court in Kuala Lumpur in 2007, more reported judgments are coming forth in recent years. This new edition takes account many of them.

The new edition also carries an innovation in publishing, at least in Malaysia. Each copy of the book comes with a unique scratch-off code to access an ebook format of the book through Thomson Reuters' ProView platform. This is a timely value-added service because it makes the text of the book searchable and offers a handier reading format on an electronic device such as a tablet or a smartphone. The ebook can be read both online through a web



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browser and offline through an app. Apart from the availability of the book in ebook format, the publisher has also added content known as ProView Extra with appropriate indicators throughout the book. Unfortunately, this reviewer was expecting the fulltext of cases in ProView Extra, but found only one-paragraph summaries of some cases. Perhaps, the fulltext of cases are too valuable as a separate product to be given away for free.

## **Content**

By and large, very minimal reorganisation of the chapters has been made in the second edition. With the introduction of the Trademarks Act 2019, some rewriting was necessary due to new legal concepts in the 2019 Act. Also, Malaysia has finally switched to the Americanised version of the word 'trademark' and this has been reflected throughout the new edition.

One of the major changes in trademark law is the registrability of unconventional marks such as shapes, sounds and colours. Since much of the development in this area occurred in the European Union, it is unavoidable for us to refer to ECJ decisions. Hence, we see more references to ECJ decisions in this edition. One jurisdictional conundrum remains. In the past, we referred to non-common law decisions either on the ground that our written laws are *in pari materia* to those of other jurisdictions, examples of which are competition law and data protection law, or that we were indirectly importing ECJ decisions into Malaysian law through the United Kingdom when the latter was part of the EU. However, with UK having completely left the EU by the end of 2020, it is conceptually more difficult to argue for the *raison d'être* of our continual reference to ECJ decisions in the future.

A much-welcomed addition to the new edition is a chapter on the registration process for trademarks and a section for patent applications. They are important because the practice of intellectual property law is not confined to resolving disputes in the courts as litigators, but more importantly, encompasses the obtaining of appropriate intellectual property protection via applications to the Intellectual Property Corporation of Malaysia (MyIPO). Related to this are the various international applications that can be made through MyIPO under Madrid Protocol for trademarks and Patents Corporation Treaty for patents, all of which have been touched on but a more detailed discussion is welcomed.

Although geographical indications are given a complete treatment in the book, other less conventional intellectual property rights such as layout-designs of integrated circuits and protection of new plant varieties got only a passing mention. What this reviewer hoped to see in the future, should there be a new edition, is a deeper discussion on the role of other legislative arsenals such as the Optical Discs Act 2000 and Trade Descriptions Act 2011 in enforcing intellectual property rights. In fact, a separate generic chapter on enforcement covering aspects such as a Norwich Pharmacal order may be very useful. Other theoretical discussions such as the intersection between intellectual property rights and competition law, and extra-jurisdictional enforcement on the Internet, may be increasingly relevant to readers of the text.

## **Conclusion**

As a comprehensive text on intellectual property law in Malaysia, this timely book by Tay Pek San is without rival. It makes a good text for students of intellectual property law in a one-trimester course or even an extended year-long course. The language is clear and comprehensible, and the discussions and analyses rigorous. Some readers may prefer a 'cases and materials' text to a more conventional legal textbook, but the beauty of a text such as this is that it offers a complete map to this terrain called 'intellectual property law' so that the eager explorer is not lost in the myriad details of case laws and statutory provisions. •

