

A **SITI KHADIJAH APPAREL SDN BHD v. ARIANI TEXTILES
& MANUFACTURING (M) SDN BHD**

HIGH COURT MALAYA, KUALA LUMPUR
WONG KIAN KHEONG J

[CIVIL SUIT NO: WA-22IP-23-06-2017]

B 10 AUGUST 2018

C ***INTELLECTUAL PROPERTY: Copyright – Infringement – Allegation of – Muslim prayer outfit ('telekung') – Whether a telekung constituted a 'graphic work' or a 'work of artistic craftsmanship' within the meaning of s. 3 of the Copyright Act 1987 – Whether plaintiff owned copyright of telekung design – Defendant's failure to adduce evidence of drawings and designs – Whether adverse inference invoked against defendant under s. 114(g) of the Evidence Act 1950 – Whether there was infringement of copyright – Copyright Act 1987, ss. 3 & 7***

D This case concerned a Muslim prayer outfit ('telekung') sold by the plaintiff, who sold 'telekung Siti Khadijah Klasik' ('plaintiff's telekung') and the defendant who sold 'Ariani x WOW telekung Nur Aleesya ('defendant's telekung'). It was the plaintiff's case that the plaintiff's telekung was the first of its kind in the market and had been well received by the public. However, according to the director of the plaintiff ('SP1'), the defendant's telekung was copied from the plaintiff's telekung by way of 'reverse engineering', namely the defendant unstitched the stitches in the plaintiff's telekung and copied the design of the plaintiff's telekung. SP2, another director of the plaintiff, affirmed a statutory declaration which stated that the plaintiff was the owner of copyright in the plaintiff's telekung and that the plaintiff's telekung was sold through, among others, CJ WOW Shop. After the plaintiff discovered the sale of the defendant's telekung through CJ WOW Shop, the plaintiff stopped selling the plaintiff's telekung through the CJ WOW Shop. Hence, the plaintiff suffered loss of sales of the plaintiff's telekung through CJ WOW Shop. The defendant, on the other hand, through its general manager for sales ('SD1') alleged that a telekung was purely functional (for religious reasons). Consequently, copyright could not subsist in a telekung. He also submitted that a telekung was generally available in public, and accordingly any information regarding the design of a telekung was freely available and that the plaintiff was not the owner of copyright in the plaintiff's telekung. The defendant further argued that it did not commit copyright infringement because the defendant's telekung was based on a common design of telekung which was freely available, the defendant's telekung was an 'enhanced' version of commonly available telekung and the lace, cloth and rubber used in the defendant's telekung were very different from those found in the plaintiff's telekung. According to the defendant, this suit was maliciously filed by the plaintiff to hinder the defendant from competing lawfully with the plaintiff in the telekung market. The issues that arose were (i) whether a telekung constituted a 'graphic work' or a 'work of artistic craftsmanship'

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within the meaning of s. 3 of the Copyright Act 1987 ('CA'); (ii) did the plaintiff own copyright of the plaintiff's telekung; and (iii) whether the defendant had infringed plaintiff's copyright.

Held (allowing plaintiff's suit with costs):

- (1) The plaintiff's telekung had been created (not copied) by SP1 because SP1 had expended sufficient effort, time and expense to make the plaintiff's telekung original in character within the meaning of s. 7(3)(a) of the CA. A telekung, such as the plaintiff's telekung, was not solely an 'idea.' Nor was the plaintiff's telekung purely functional (for prayers). The plaintiff's telekung not only enabled its user to pray but also gave comfort and elegance to the user. SP1's three two-dimensional drawings regarding the design of the plaintiff's telekung constituted a 'graphic work' in s. 3(a) of the CA. The three dimensional plaintiff's telekung, in itself, constituted an 'artistic work' in s. 3(a) of the CA. However, the plaintiff had not adduced any evidence to prove that the plaintiff's telekung was a 'work of artistic craftsmanship' in s. 3(c) of the CA. (paras 23, 24 & 28)
- (2) There was ample proof that SP1 was the 'author' of the plaintiff's telekung within the meaning of s. 3 of the CA. SP1 had described in detail how SP1 had designed the plaintiff's telekung over a period of six months. She had used her skill and time, through trial and error, to design, measure, sew, choose the pattern and cloth material for the plaintiff's telekung. SP1 had also incurred expenses in creating the plaintiff's telekung. The plaintiff's telekung also had certain unique features *ie* the use of the plaintiff's telekung would not leave any mark on the user's forehead. The plaintiff thus owned copyright in the plaintiff's telekung because all the conditions had been met (i) in accordance with s. 7(3)(a) of the CA, sufficient effort had been expended by SP1 to make the plaintiff's telekung original in character; (ii) the plaintiff's telekung had been reduced to 'material form' within the meaning of s. 3 read with s. 7(3)(b) of the CA; (iii) all the three alternative conditions in s. 10(1), 2(a) and 3 (CA) had been fulfilled in that the plaintiff's telekung was made by a Malaysian citizen, who was a 'qualified person' under s. 3(a) of the CA, the plaintiff's telekung was first 'published' in Malaysia within the meaning of s. 4(1)(a) of the CA because it was first sold in Malaysia and that the plaintiff's telekung was made in Malaysia. (paras 31 & 34)
- (3) The defendant's telekung was not created by the defendant or the defendant's designers because the defendant did not call the defendant's designers to testify in this case regarding the creation of the defendant's telekung. The drawings and designs of the defendant's telekung by the

- A defendant's designers had not been adduced in court. This court was constrained to draw an adverse inference against the defendant under s. 114(g) of the Evidence Act 1950 for the suppression of material evidence. (para 33)
- B (4) The court had to make a visual comparison between the plaintiff's telekung and the defendant's telekung. The sufficient objective similarity showed that the defendant's telekung had directly copied an identifiable part of the plaintiff's telekung which constituted a substantial part of the plaintiff's telekung. Further, the plaintiff's telekung was introduced in the market before the defendant's telekung and there had been extensive advertisement of the plaintiff's telekung in the mass media. The defendant's lack of knowledge of the plaintiff's copyright was not a defence to copyright infringement. There was thus a cause of action for copyright infringement. (paras 45, 47, 50 & 51)
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- D **Case(s) referred to:**
Chuah Aik King v. Keydonsoft Sdn Bhd [2018] 10 CLJ 354 HC (*refd*)
Designers Guild Ltd v. Russell Williams (Textiles) Ltd [2001] 1 All ER 700 (*refd*)
Dura-Mine Sdn Bhd v. Elster Metering Ltd & Anor [2015] 1 CLJ 887 FC (*refd*)
Elias Idris v. Mohd Syamsul Md Yusof & Ors [2018] 1 LNS 1029 CA (*refd*)
Elster Metering Limited & Anor v. Damini Corporation Sdn Bhd & Anor [2012] 1 LNS 959 CA (*refd*)
- E *F & N Dairies (Malaysia) Sdn Bhd v. Tropicana Products Inc & Other Appeals* [2013] 1 LNS 380 CA (*refd*)
George Hensher Ltd v. Restawile Upholstery (Lancs) Ltd [1975] RPC 31 (*refd*)
Guthrie Sdn Bhd v. Trans-Malaysian Leasing Corp Bhd [1991] 1 CLJ 9; [1991] 1 CLJ (Rep) 155 SC (*refd*)
- F *Hj Abdul Ghani Ishak & Anor v. PP* [1981] 1 LNS 96 FC (*refd*)
Kiwi Brands (Malaysia) Sdn Bhd v. Multiview Enterprises Sdn Bhd [1998] 2 CLJ Supp 194 HC (*refd*)
Lau Foo Sun v. Government of Malaysia [1969] 1 LNS 78 FC (*refd*)
Megnaway Enterprise Sdn Bhd v. Soon Lian Hock (No 2) [2009] 8 CLJ 130 HC (*refd*)
Merlet & Anor v. Mothercare PLC [1984] FSR 358 (*refd*)
- G *Motordata Research Consortium Sdn Bhd v. Ahmad Shahril Abdullah & Ors* [2017] 1 LNS 1142 HC (*refd*)
Munusamy Vengadasalam v. PP [1987] 1 CLJ 250; [1987] CLJ (Rep) 221 SC (*refd*)
Palm Oil Research and Development Board Malaysia & Anor v. Premium Vegetable Oils Sdn Bhd [2004] 2 CLJ 265 FC (*refd*)
- H *Pekan Nenas Industries Sdn Bhd v. Chang Ching Chuen & Ors* [1998] 1 CLJ 793 FC (*refd*)
Radion Trading Sdn Bhd v. Sin Besteam Equipment Sdn Bhd & Ors [2010] 6 CLJ 334 HC (*refd*)
Syarikat Faiza Sdn Bhd & Anor v. Faiz Rice Sdn Bhd & Anor And Another Case [2017] 1 LNS 1648 HC (*refd*)
- I *The New Straits Times Press (Malaysia) Bhd & Anor v. Admal Sdn Bhd* [2013] 9 CLJ 955 CA (*dist*)

Legislation referred to:

Copyright Act 1987, ss. 3(a), (b), (c), 4(1)(a), 6, 7(1)(c), (2A), (3)(a), (b), (5), (6), 10(1), (2)(a), (3), 13(1)(a), (e), 36(1), 37(1)(d), (7)(c), (8)(c), (h), 42(1)(a)

Evidence Act 1950, ss. 4(1), 103, 114(f), (g), 138(4)

Industrial Designs Act 1996, ss. 3(1)(a), (b), 11

Interpretation Acts 1948 and 1967, ss. 2(1)(b), 17A

Trade Descriptions Act 2011, s. 5(1)(a)

Copyright Act 1956 [UK], s. 3(1)

Other source(s) referred to:

The Modern Law of copyright and Designs, Laddie, Prescott & Vitoria, 2nd edn (1995), paras 2-108

For the plaintiff - Ahmad Hafiz Zubir & Nasrul Hadi Mat Saad; M/s Hafiz Zubir & Co

For the defendant - Habizan Rahman Habeeb Rahman, Foong Cheng Leong & Theivini Nayagam; M/s Rahman Rohaida

Reported by Suhainah Wahiduddin

JUDGMENT**Wong Kian Kheong J:****Issues**

[1] This case concerns “telekung” (a Muslim prayer outfit) sold by the plaintiff company (plaintiff) and defendant company (defendant).

[2] The plaintiff sells “telekung Siti Khadijah Klasik” (plaintiff’s telekung) while “Ariani x WOW telekung Nur Aleesya” (defendant’s telekung) is sold by the defendant.

[3] The following issues arise in this case:

(i) whether the court may presume under ss. 4(1) and 114(f) of the Evidence Act 1950 (EA) that the common course of business regarding the plaintiff’s purchase of the defendant’s telekung from “CJ WOW Shop” (a media platform which provides for home shopping through television, online and mobile phones) has been followed in this case;

(ii) should weight be attached to exh. D6 which is not tendered during the cross-examination of SP1 (author of the design of the plaintiff’s telekung)?;

(iii) does a telekung constitute a “graphic work” or a “work of artistic craftsmanship” within the meaning of s. 3 of the Copyright Act 1987 (CA)? I am not able to find any previous Malaysian case which has construed a “work of artistic craftsmanship” in s. 3 CA;

- A (iv) if a telekung constitutes a “graphic work” under s. 3 CA:
- (a) whether a telekung is eligible for copyright under CA in view of its religious function (for prayers). This is a novel question regarding the interpretation of s. 7(2A) and (3)(a) CA; and
- B (b) does the plaintiff own copyright in the plaintiff’s telekung?;
- (v) if the plaintiff owns copyright in the plaintiff’s telekung (plaintiff’s copyright), whether the plaintiff’s copyright has ceased under the then applicable s. 7(6) CA. Sub-section 7(6) CA has now been repealed by Copyright (Amendment) Act 2012 (Act A1402); and
- C (vi) if the plaintiff’s copyright has not ceased under s. 7(6) CA, has the defendant infringed the plaintiff’s copyright (copyright infringement) under the first limb of s. 36(1) CA? In this regard, in a claim of copyright infringement, can the defendant raise as a defence that the defendant is not aware of the plaintiff’s copyright and copyright infringement?

D **Plaintiff’s Case**

[4] The following two witnesses testified for the plaintiff:

- (i) Puan Padzilah bt Enda (SP1); and
- E (ii) Encik Aminuddin bin Mohd Nasir (SP2)

[5] SP1, a director of the plaintiff, testified as follows, among others:

- (i) SP1 took about six months to design the plaintiff’s telekung in 2010;
- (ii) the plaintiff’s telekung is the first of its kind in the market and has been well received by the public. The plaintiff’s telekung has been promoted extensively in newspapers, magazines, television, radio and billboards;
- F (iii) the defendant’s telekung is copied from the plaintiff’s telekung by way of “reverse engineering”, namely the defendant unstitched the stitches in the plaintiff’s telekung and copied the design of the plaintiff’s telekung;
- G and
- (iv) the defendant’s telekung was sold by way of pre-paid television advertisement in CJ WOW Shop.

H [6] SP2 (SP1’s husband) is a director of the plaintiff. According to SP2, among others:

- (i) SP2 has affirmed a statutory declaration on 28 March 2017 which stated that the plaintiff is the owner of copyright in the plaintiff’s telekung (SP2’s SD); and
- I (ii) the plaintiff’s telekung is sold through, among others, CJ WOW Shop. After the plaintiff discovered the sale of the defendant’s telekung through CJ WOW Shop, the plaintiff stopped selling the plaintiff’s telekung through CJ WOW Shop in November 2016. Hence, the plaintiff has suffered loss of sales of the plaintiff’s telekung through CJ WOW Shop.

Defendant's Case

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[7] Encik Shafarhan bin Abdul Kahar (SD1) is the defendant's general manager for sales (sales GM). SD1 gave the following evidence, among others:

- (i) the defendant alleges that a telekung is purely functional (for religious reasons). Consequently, copyright cannot subsist in a telekung; B
- (ii) telekung is generally available in public. Accordingly, any information regarding the design of a telekung is freely available;
- (iii) the plaintiff is not the owner of copyright in the plaintiff's telekung; C
- (iv) the defendant did not commit copyright infringement because:
 - (a) the defendant's telekung is based on a common design of telekung which is freely available;
 - (b) the defendant's telekung is an "enhanced" version of commonly available telekung; and D
 - (c) the lace (renda), cloth and rubber used in the defendant's telekung are very different from those found in the plaintiff's telekung. In particular, the rubber used in the defendant's telekung is very elastic (unlike the one used in the plaintiff's telekung) and that is why the defendant's telekung is available in one "free size"; E
- (v) this suit is maliciously filed by the plaintiff to hinder the defendant from competing lawfully with the plaintiff in the telekung market;
- (vi) exhibit P2 is not the defendant's telekung because the size of the lace on exh. P2 is different from that in the defendant's telekung; and F
- (vii) SD1 adduced exh. D6 as the defendant's telekung. I will discuss in para. [15] below on whether any weight should be attached to exh. D6 in this case.

Evidence

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Exhibits P2, P3 and P4

[8] According to SP1:

- (i) the plaintiff had purchased the defendant's telekung (exhs. P2 and P3) from CJ WOW Shop; H
- (ii) CJ WOW Shop sent exhs. P2 and P3 in a box (exh. P4); and
- (iii) exhibit P4 has a label (marked P4A) which stated as follows:

CJ WOWSHOP

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www.cjwowshop.com.my

WAYBILL COD

- A Sender Account:
MP CJ O Shopping Sdn. Bhd.
...
Receiver: NORASHIKIN OTHMAN
- B ...
Remark
ARIANI X WOW TELEKUNG NUR
...
(emphasis added).
- C **[9]** The defendant has denied that exh. P2 is the defendant's telekung. The defendant further contends as follows:
- (i) the plaintiff had failed to call a witness from CJ WOW Shop to prove that the plaintiff had indeed purchased exh. P2 from CJ WOW Shop;
- D (ii) according to the label (P4A) on exh. P4, the recipient of exh. P2 is one Norashikin Othman (Cik Norashikin). Cik Norashikin was not called by the plaintiff to testify that she had purchased exh. P2 from CJ WOW Shop;
- E (iii) the plaintiff's failure to call the above two witnesses attract an adverse inference against the plaintiff's case under s. 114(g) EA; and
(iv) based on the above reasons, the defendant applied to expunge exhs. P2 and P3 as evidence in this case.
- F **[10]** Firstly, pursuant to s. 114(f) EA, the court may presume that the common course of business has been followed in a particular case - please see the Federal Court's judgment delivered by Edgar Joseph Jr FCJ in *Pekan Nenas Industries Sdn Bhd v. Chang Ching Chuen & Ors* [1998] 1 CLJ 793; [1998] 1 MLJ 465, at 519-520. Relying on s. 114(f) EA as interpreted in *Pekan Nenas Industries*, I find that there is a rebuttable presumption as follows:
- G (i) there had been a purchase of the defendant's telekung in exhs. P2 and P3 from CJ WOW Shop; and
(ii) CJ WOW Shop had sent exhs. P2 and P3 in exh. P4
(rebuttable presumption).
- H **[11]** Section 4(1) EA provides as follows:
Presumption
s. 4(1) **Whenever it is provided by this Act that the court may presume a fact, it may either regard the fact as proved unless and until it is disproved, or may call for proof of it.**
- I (emphasis added).

[12] According to s. 4(1) EA, when the EA provides that the court may presume a fact (such as the facts presumed by an application of s. 114(f) EA), the court may “regard the fact as proved unless and until it is disproved”. Accordingly, based on s. 4(1) read with s. 114(f) EA, once the court presumes that the common course of business (regarding exhs. P2, P3 and P4) has been followed:

- (i) the rebuttable presumption arises and exhs. P2, P3 and P4 are admissible as evidence. Hence, the defendant’s application to expunge exhs. P2, P3 and P4 cannot succeed; and
- (ii) the evidential burden then shifts to the defendant to adduce evidence to rebut the rebuttable presumption. No evidence has been produced by the defendant to rebut the rebuttable presumption. Accordingly, I find that the facts presumed in the rebuttable presumption (please see the above para. 10) have become irrebuttable.

[13] I attach great weight to exhs. P2, P3 and P4 for the following reasons:

- (i) SD1 admitted during cross-examination that the defendant’s telekung was only sold through CJ WOW Shop. According to SD1, CJ WOW Shop would inform the defendant regarding purchases of the defendant’s telekung and would send boxes (such as exh. P4) (CJ WOW Shop’s boxes) to the defendant with details of the purchasers. The defendant would then insert the defendant’s telekung into CJ WOW Shop’s boxes and return such boxes to CJ WOW Shop (for CJ WOW Shop to send to purchasers). There is neither evidence nor reason why CJ WOW Shop would sell counterfeit defendant’s telekung; and
- (ii) if exhs. P2 and P3 were not the defendant’s telekung:
 - (a) the defendant would have complained to CJ WOW Shop regarding exhs. P2, P3 and P4;
 - (b) the defendant should have called a witness from CJ WOW Shop to give evidence to rebut the rebuttable presumption. If CJ WOW Shop does not co-operate with the defendant, the defendant can apply for a subpoena to compel the relevant employee from CJ WOW Shop to testify regarding exhs. P2, P3 and P4; or
 - (c) the defendant should have instituted third party proceedings against CJ WOW Shop for an indemnity for damages and costs (due to exhs. P2, P3 and P4). In fact, the defendant could have filed a counterclaim against CJ WOW Shop for the tort of passing off exhs. P2 and P3 as the defendant’s telekung.

All the matters stated in the above sub-paras. ii(a) to (c) have not been done by the defendant. This can only prove that exhs. P2 and P3 are indeed the defendant’s telekung.

A [14] An adverse inference under s. 114(g) EA may be drawn by the court against a party for suppressing material evidence - please see Mohd Azmi SCJ's judgment in the Supreme Court case of *Munusamy Vengadasalam v. PP* [1987] 1 CLJ 250; [1987] CLJ (Rep) 221; [1987] 1 MLJ 492, at 494. In this case, I cannot draw an adverse inference under s. 114(g) EA against the plaintiff regarding exhs. P2, P3 and P4 because:

- B (i) the plaintiff can rely on ss. 4(1) and 114(f) EA - please see the above paras. 10 to 12; and
- (ii) the plaintiff did not suppress any material evidence in this case.

C *Should Court Attach Weight To Exh. D6?*

[15] I am not able to attach any weight to exh. D6 because:

- D (i) SP1 was cross-examined at length and yet, exh. D6 was not adduced as evidence by the defendant during SP1's cross-examination. Hence, SP1 (creator of the design of the plaintiff's telekung), was deprived of the opportunity to examine exh. D6 and to adduce her testimony regarding exh. D6; and
- (ii) exhibit D6 was only introduced through SD1 after the plaintiff had closed its case. The defendant did not apply to recall SP1 under s. 138(4) EA for further cross-examination regarding exh. D6. Section 138(4) EA provides as follows:
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138(4) **The court may in all cases permit a witness to be recalled** either for further examination-in-chief or **for further cross-examination**, and if it does so, the parties have the right of further cross-examination and re-examination respectively.

F (emphasis added).

G I have not overlooked para. 4 of the consent order dated 28 September 2017 (para. 4) wherein both the plaintiff and defendant have agreed that any failure to put or suggest any fact and proposition to any witness, does not amount to an acceptance of the fact and proposition. Paragraph 4 does not apply to exhibits tendered by parties in this case as evidence for the very first time during the trial. If any weight is attached to exh. D6, there will be an injustice to the plaintiff in this case.

H **Credibility Of Witnesses**

[16] I find as a fact that SP1 is a credible witness. This finding is based on the following evidence and reasons:

- I (i) SP1's testimony is supported by documentary evidence (which I will elaborate in sub-paras. 31(iii) and (iv) below regarding SP1's creation of the design of the plaintiff's telekung); and
- (ii) the cross-examination of SP1 does not show any reason to doubt her veracity.

[17] It is this court's finding of fact that SD1 lacks credibility. This is due to the following evidence and reasons:

- (i) SD1 initially claimed that the defendant's telekung is based on a common design of telekung which is freely available. Such evidence is materially contradicted by SD1's subsequent testimony that the defendant's telekung is an "enhanced" version of commonly available telekung. SD1's credibility is further undermined when he stated that the lace, cloth and rubber used in the defendant's telekung are very different from those used in the plaintiff's telekung. If both the plaintiff's telekung and defendant's telekung are based on common designs which are freely available in the public domain (as alleged by SD1), there should not be any material difference between both telekung;
- (ii) SD1 is now in his tenth year as the defendant's sales GM and yet, when cross-examined, he was unsure how many defendant's telekung have been sold;
- (iii) SD1 admitted during cross-examination that as the defendant's sales GM, he had advised the two designers of the defendant's telekung (defendant's designers). The defendant's designers, according to SD1, are from Bangladesh. SD1 however does not know the names of the defendant's designers. The defendant has disputed that SD1 created the design of the plaintiff's telekung and has instead alleged that the defendant's designers had enhanced commonly available telekung in the defendant's telekung. In such circumstances, it is inconceivable for SD1 (as the defendant's sales GM) not to know the names of the defendant's designers; and
- (iv) during cross-examination, SD1 agreed that the defendant had not adduced any photograph to show that telekung had been in use for many years. SD1 also agreed that the defendant has no evidence that this action has been filed by the plaintiff in a *mala fide* manner. It is difficult to believe a witness who makes bold assertions without any documentary proof.

Whether Telekung Is A "Graphic Work" Or "Work Of Artistic Craftsmanship" Under CA

[18] The defendant has contended that a telekung constitutes a "work of artistic craftsmanship" as explained by the following decisions of English courts:

- (i) the House of Lords's decision in *George Hensher Ltd v. Restawile Upholstery (Lancs) Ltd* [1975] RPC 31; and
- (ii) the High Court's judgment in *Merlet & Anor v. Mothercare PLC* [1984] FSR 358.

A [19] I reproduce the relevant parts of s. 3 CA as follows:

s. 3 Interpretation

“artistic work” means:

(a) a graphic work, ... irrespective of artistic quality;

B ...; or

(c) a work of artistic craftsmanship,

...

“graphic work” includes –

C (a) any... drawing, ...

...”

(emphasis added).

D [20] George Hensher Ltd concerned United Kingdom’s (UK) then applicable Copyright Act 1956 [CA 1956 (UK)]. CA 1956 (UK) has now been repealed by UK’s Copyright, Designs and Patents Act 1988. Section 3(1) CA 1956 (UK) (regarding the definition of an “artistic work” which includes a “work of artistic craftsmanship”) is similar to our definition of “artistic work” (which also includes a “work of artistic craftsmanship”) in
E s. 3 CA. Accordingly, I am of the view that Malaysian courts may refer to *George Hensher Ltd* in the interpretation of “artistic work” and a “work of artistic craftsmanship” in s. 3 CA.

F [21] In *George Hensher Ltd*, the five judges in the House of Lord were not unanimous regarding the meaning of a “work of artistic craftsmanship”. Four views regarding a “work of artistic craftsmanship” have been expressed in *George Hensher Ltd* (four views) as follows:

G (i) Lord Reid, at p. 54, held that a “work of artistic craftsmanship” is a work which “any substantial section of the public genuinely admires and values... for its appearance and gets pleasure or satisfaction, whether emotional or intellectual, from looking at [the work]”;

H (ii) according to Lord Morris, at p. 57, whether a work is one of “artistic craftsmanship” is a question of fact to be decided objectively based on the evidence and this goes beyond a mere appeal to the eye. This view has also been stated by Viscount Dilhorne, at p. 62;

I (iii) Lord Simon, at p. 66, decided that the phrase “work of artistic craftsmanship” is a composite one which “must be construed as a whole” and refers to a work which “at least presupposes special training, skill and knowledge” to produce the work; and

(iv) Lord Kilbrandon, at pp. 71 and 72, firstly held that a “work of artistic craftsmanship” is one which comes into existence as a product of its author “who is consciously concerned to produce” the work. Lord Kilbrandon then decided that whether a work is “artistic” or not, is a question to be decided by the judge and not by witnesses or experts.

[22] The definition of “graphic work” in s. 3 CA uses the term “includes” and not the word “means”. The use of the word “includes” in the definition of “graphic work” has the effect of widening the scope of that definition - please see the Federal Court’s judgment delivered by Raja Azlan Shah CJ (Malaya) (as His Majesty then was) in *Hj Abdul Ghani Ishak & Anor v. PP* [1981] 1 LNS 96; [1981] 2 MLJ 230, at 245-246.

[23] Firstly, I find that SP1’s three two-dimensional drawings regarding the design of the plaintiff’s telekung (SP1’s drawings) constitute a “graphic work” in s. 3(a) CA – please see Azahar Mohamed J’s judgment in the High Court case of *Radion Trading Sdn Bhd v. Sin Besteam Equipment Sdn Bhd & Ors* [2010] 6 CLJ 334, at paras. [20]-[23]. I further find that the three-dimensional plaintiff’s telekung (produced based on two-dimensional SP1’s drawings), in itself, constitutes an “artistic work” in s. 3(a) CA - *Radion Trading*, at paras. [20]-[23].

[24] I find that the plaintiff has not adduced any evidence to prove that the plaintiff’s telekung is a “work of artistic craftsmanship” in s. 3(c) CA within the meaning of any one or more of the four views. As such, based on the evidence in this case, the plaintiff’s telekung is not a “work of artistic craftsmanship” in s. 3(c) CA.

Is Telekung Eligible For Copyright Under CA?

[25] The defendant has relied on Anantham Kasinather JCA’s judgment in the Court of Appeal case of *The New Straits Times Press (Malaysia) Bhd & Anor v. Admal Sdn Bhd* [2013] 9 CLJ 955 (*NST* case) to submit that a telekung is not eligible for copyright under CA due to its religious function (for prayers).

[26] *NST* case concerns the issue of whether the concept of an English spelling competition is eligible for copyright under CA. The Court of Appeal held in *NST* case, at paras. [21]-[24], as follows:

[21] ... it is common ground that all that the respondent did in this case was really to compile information from various sources including from American Spelling Bee competition. This was unreservedly confirmed by PW2 and PW3 themselves ...

[22] In this case, we are not persuaded that the NST Spell It Right although capable of securing copyright is entitled to such protection since it is nothing more than the mere compilation of already existing information widely available in the public sphere. It is not in dispute that the NST Spell It Right concept is really a compilation of rules and regulations to regulate the holding of a spelling competition and such competitions have been around for ages. Indeed, in this case, the

- A respondent readily admitted to having copied the idea and concept behind the NST Spell It Right from the American Spelling Bee competition. This was unreservedly confirmed by PW2 and PW3 themselves. In the face of this admission, in our opinion, it was necessary for the respondent to demonstrate what features were the result of its efforts so as to satisfy the originality test pronounced by Justice Abdul Malik Ishak in *Kiwi Brand (M) Sdn Bhd v. Multiview Enterprises Sdn Bhd (supra)*. With respect, we are unable to discover anything novel or original in the concept behind NST Spell It Right beyond that already available in the public domain
- B
- C [23] In our judgment, *apart from the absence of any originality behind the concept of NST Spell It Right, the learned trial judge failed to take into account the “functional object” behind competitions of this nature. The meaning and relevance of “functional object” in determining infringement of copyright was put this way in the case of Flamelite (S) Pte Ltd and Others v. Lam Heng Chung and Others (supra)*:
- D To answer this question the whole of the work must be considered and in this exercise the originality and simplicity of the plan and its functional object must be borne in mind (paragraph 40).
- ...
- E [24] Applying the principles of law governing the “functional object” test to the concept behind the NST Spell It Right, we are inclined to agree with the written submission of learned counsel for the appellant that the concept is not eligible for copyright because:
- F (i) The concept contains features which relate to the very function of any competition to be held among students residing and schooling in different parts of the country. The fact that this concept concerns a spelling competition does not *per se* give rise to any originality since every competition of this nature must necessarily involve similar rules and regulations with minor variations;
- G (ii) The information in relation to a spelling competition is common knowledge since apart from being available in the public domain, competitions are frequently organised by social clubs such as rotary and the competition is usually organised among schools within the district. The need to alter some features of the competition to accommodate the fact that this is a spelling competition and involves the whole country, with respect, does not detract from the fact that this is a common event and the rules and regulations governing it fairly commonplace;
- H (iii) ...;
- I (iv) It is common ground that spelling competitions have been held and continue to be held throughout the world and the concept of the competition is freely available on television and the internet.
- ...
- (emphasis added).

[27] According to s. 6 CA, no copyright shall subsist otherwise than by virtue of CA. Whether a piece of “artistic work” (as understood in ss. 3 and 7(1)(c) CA) can be protected by copyright under CA depends on whether all the following conditions under CA (conditions) have been fulfilled:

(i) s. 7(3)(a) CA provides that an artistic work shall not be eligible for copyright unless sufficient effort had been expended to make the work original in character. The following cases are relevant in the interpretation of s. 7(3)(a) CA:

(a) in the Federal Court case of *Lau Foo Sun v. Government of Malaysia* [1969] 1 LNS 78; [1974] 1 MLJ 28, Ali FJ held that copyright only protects originality of expression in the work and not originality of ideas or thoughts in the work; and

(b) Abdul Malik Ishak J (as he then was) decided as follows in the High Court in *Kiwi Brands Malaysia Sdn Bhd v. Multiview Enterprises Sdn Bhd* [1998] 2 CLJ Supp 194, at 201-202:

... It seems that copyright subsists only in an original literary work as envisaged under s. 7(3)(a) [CA]. *Halsbury's Laws of England*, 4th edn, vol. 9, at para. 831 expresses an opinion that it is not necessary that “the work should be the expression of original or inventive thought, for 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”.

(emphasis added).

The decision in *Kiwi Brands Malaysia* has been followed by Dr Badariah Sahamid JCA in the recent Court of Appeal case of *Elias Idris v. Mohd Syamsul Md Yusof & Ors* [2018] 1 LNS 1029 (Civil Appeal No. W-02(IPCV) (W) 508-03-2016) (*Elias* case);

(ii) in accordance with s. 7(3)(b) CA, the artistic work has been written down, recorded or reduced to “material form” (defined in s. 3 CA);

(iii) 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” [defined in s. 3(a) and (b) CA as, among others, a Malaysian citizen and Malaysian company respectively] - please see s. 10(1) CA;

(b) the work is first “published” in Malaysia - please see s. 10(2)(a) CA. Section 4(1)(a) CA deems an artistic work to be “published” only if copies of the work have been made available with the consent of the author of the work in a manner sufficient to satisfy the reasonable requirements of the public, whether by sale or otherwise;

(c) the work is made in Malaysia - please see s. 10(3) CA; and

- A (iv) there is no copyright protection:
- (a) for “any idea, procedure, method of operation or mathematical concept” - please see s. 7(2A) CA and *Chuah Aik King v. Keydonesoft Sdn Bhd* [2018] 10 CLJ 354; [2018] MLJU 530, at paras. [18] and [28](ii). Section 7(2A) CA has been inserted by way of Copyright (Amendment) Act 1997. If Parliament has intended that a purely functional work is not protected by copyright, Parliament would have expressly provided as such in s. 7(2A) CA. The Legislature however has chosen not to do so in s. 7(2A) CA. Furthermore, s. 7(2) CA provides that works shall be protected by copyright “irrespective of ... the purpose for which they were created”; and
- B
- C (b) if the design in question has been registered under the Industrial Designs Act 1996 (IDA) - please see s. 7(5) CA.
- D [28] I am of the view that if all the conditions are fulfilled, a telekung (including the plaintiff’s telekung) is eligible for copyright protection under CA. *NST* case did not discuss s. 7(2A) CA. In any event, *NST* case can be easily distinguished from this case as follows:
- E (i) in *NST* case, the information regarding a spelling competition is freely available in public domain and the respondent company had admitted copying the “idea” and compiling information from various sources regarding spelling competitions. As explained in para. [31] below, the plaintiff’s telekung has been created (not copied) by SP1 because SP1 has expended sufficient effort, time and expense to make the plaintiff’s telekung original in character within the meaning of s. 7(3)(a) CA; and
- F (ii) the “idea” regarding a spelling competition cannot be protected by copyright under s. 7(2A) CA - *Chuah Aik King*. However, a telekung, such as the plaintiff’s telekung, is not solely an “idea”. Nor is the plaintiff’s telekung purely functional (for prayers). As testified by SP1 (in sub-paras. 31(i)(a) to (c) below), the plaintiff’s telekung not only
- G enables its user (user) to pray but also gives comfort and elegance to the user.

Whether Plaintiff Owns Copyright In Plaintiff’s Telekung

Who Created Plaintiff’s Telekung?

- H [29] According to s. 3(c) CA, the “author” of an “artistic work” (other than photographs) is the “artist” of the work.
- I [30] At the trial, SP1 has adduced exh. P1 as a piece of the plaintiff’s telekung which has been created by SP1 and sold by the plaintiff. The defendant has not adduced any evidence to rebut the plaintiff’s evidence that exh. P1 embodies the plaintiff’s telekung as created by SP1.

[31] There is ample proof that SP1 is the “author” of the plaintiff’s telekung within the meaning of s. 3 CA. This is clear from the following evidence: A

(i) SP1’s witness statement had described in detail how SP1 designed the plaintiff’s telekung over a period of six months in 2010. SP1 had used her skill and time, through trial and error, to design, measure, sew, choose the pattern and cloth material for the plaintiff’s telekung. SP1 had also incurred expenses in creating the plaintiff’s telekung. According to SP1, the plaintiff’s telekung has the following unique features: B

(a) the use of the plaintiff’s telekung will not leave any mark on the user’s forehead; C

(b) the users will be comfortable when they perform prayers; and

(c) the users will appear elegant;

(ii) at the trial, SP1 gave oral evidence regarding the five essential components of the plaintiff’s telekung. During cross-examination, SP1 testified that she started to design telekung in 2009. SP1 further stated that she has the ability and interest in designing telekung. SP1 also stated that she is the telekung designer for the plaintiff; D

(iii) SP1’s testimony is supported by the following contemporaneous documents: E

(a) SP1’s drawings;

(b) a record of SP1’s measurements (in SP1’s own handwriting) concerning the plaintiff’s telekung (SP1’s measurements); and F

(c) photographs of the different stages of SP1’s design of the plaintiff’s telekung (photographs);

(iv) the January 2011 issue of “Wanita” magazine featured an article with the title “Padzilah (SP1) Terajui Identiti telekung”. This article stated that, among others, SP1 designed the plaintiff’s telekung based on her own creativity. G

An article entitled “TELEKUNG SITI KHADIJAH – kesselesaian diutamakan” (published in the September 2012 issue of “Al-Islam” magazine) stated that, among others, SP1 created the plaintiff’s telekung. H

The above two articles (two articles) had been written by independent third parties with no interest in the outcome of this suit. Furthermore, there is no complaint from any party (including the defendant) that the contents of the two articles were erroneous or false; and

(v) the plaintiff’s telekung has been extensively advertised, promoted and marketed. If SP1 were not the author of the plaintiff’s telekung: I

- A (a) the true creator of the plaintiff's telekung would have filed a suit against the plaintiff and SP1 regarding the authorship and copyright in the plaintiff's telekung. No such action has been instituted; and
- B (b) the true author of the plaintiff's telekung would have lodged a complaint with the Enforcement Division of the Ministry of Domestic Trade, Co-operatives and Consumerism that the plaintiff has committed an offence of applying a false trade description to the plaintiff's telekung under s. 5(1)(a) of the Trade Descriptions Act 2011 (TDA) . Neither investigation nor prosecution under TDA has been instituted against the plaintiff and/or SP1 in this case.
- C [32] During cross-examination, SP1 stated that she had obtained a certificate in "Usuluddin" (Islamic theology) from University of Malaya. SP1 admitted that she did not have any formal qualification in arts or design from any institution. SP1 also assisted SP2's business (to detect underground utilities before commencement of excavation work). Such evidence, in my
- D view, does not negate in any manner SP1's evidence regarding her creation of the plaintiff's telekung because:
- E (i) a creator of a telekung may be innately talented. There is therefore neither necessity nor requirement for formal or academic training and qualification for such a work; and
- (ii) even if a creator of a telekung is not innately talented, he or she may have derived his or her artistic ability from a pursuit of his or her hobby regarding telekung and/or from work experience regarding telekung.
- F [33] I find as a fact that the defendant's telekung is not created by the defendant or the defendant's designers because:
- G (i) the defendant did not call either one of the two defendant's designers to testify in this case regarding the creation of the defendant's telekung;
- (ii) the drawings and designs of the defendant's telekung by the defendant's designers (defendant's drawings) had not been adduced as evidence in this case. Such a fact is admitted by SD1 during cross-examination. I am not able to accept SD1's explanation that the defendant's drawings could not be tendered as evidence in this trial because the defendant has extensive experience in mass production of telekung; and
- H (iii) the defendant has not given any evidence regarding:
- (a) why the defendant cannot call one of the two defendant's designers to give evidence in this case; and
- (b) the failure to produce the defendant's drawings in this case.
- I

In the circumstances, this court is constrained to draw an adverse inference against the defendant under s. 114(g) EA for the suppression of the above material evidence. In *Guthrie Sdn Bhd v. Trans-Malaysian Leasing Corp Bhd* [1991] 1 CLJ 9; [1991] 1 CLJ (Rep) 155; [1991] 1 MLJ 33, at 34-35, Hashim Yeop Sani CJ (Malaya) in the Supreme Court affirmed the High Court's decision which drew an adverse inference under s. 114(g) EA against a defendant.

Whether All Conditions Have Been Fulfilled

[34] I find as a fact the plaintiff owns copyright in the plaintiff's telekung because all the conditions have been met as follows:

- (i) in accordance with s. 7(3)(a) CA, sufficient effort has been expended by SP1 to make the plaintiff's telekung original in character - please see the above sub-para. 31(i);
- (ii) the plaintiff's telekung has been reduced to "material form" within the meaning of s. 3 [any form (whether visible or not) of storage from which the work... or a substantial part of the work ... can be reproduced] read with s. 7(3)(b) CA;
- (iii) all the three alternative conditions in s. 10(1), (2)(a) and (3) CA have been fulfilled as follows:
 - (a) the plaintiff's telekung is made by SP1, a Malaysian citizen, who is a "qualified person" under s. 3(a) CA;
 - (b) the plaintiff's telekung is first "published" in Malaysia within the meaning of s. 4(1)(a) CA because it is first sold in Malaysia on 7 January 2011 (based on SP2's witness statement); and/or
 - (c) the plaintiff's telekung is made in Malaysia; and
- (iv) section 7(2A) and (5) CA do not bar the plaintiff's copyright. SP1 has testified during cross-examination that the design in the plaintiff's telekung has not been registered as an industrial design under IDA.

Effect Of SP2's SD

[35] Additionally or alternatively, pursuant to s. 42(1)(a) CA, SP2's SD "shall be admissible in evidence" and "shall be *prima facie* evidence" that the plaintiff is the owner of copyright in the plaintiff's telekung - please see Jeffrey Tan FCJ's judgment in the Federal Court case of *Dura-Mine Sdn Bhd v. Elster Metering Ltd & Anor* [2015] 1 CLJ 887, at paras. [12] and [29]. Exhibited in SP2's SD are SP1's drawings, SP1's measurements and photographs. I find as a fact that the *prima facie* evidence of the plaintiff's copyright in SP2's SD has not been rebutted by any credible evidence adduced by the defendant. On the contrary:

- A (i) SD1 is not a credible witness (please see the above para. [17]); and
(ii) an adverse inference under s. 114(g) EA is drawn against the defendant for suppressing material evidence regarding the defendant's designers and defendant's drawings (please see the above sub-para. 33(iii)).

B **Has Plaintiff's Copyright Ceased Under s. 7(6) CA?**

[36] Subsection 7(6) CA came into force on 1 September 1999 by way of Copyright (Amendment) Act 1996 and stated as follows:

- C *Copyright in any design which is capable of being registered under any written law relating to industrial design, but which has not been so registered, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process by the owner of the copyright or, with his license, by any other person.*

(emphasis added).

- D [37] The defendant has submitted that even if it was assumed that the plaintiff owned copyright in the plaintiff's telekung, by reason of s. 7(6) CA, the plaintiff's copyright had ceased when more than 50 plaintiff's telekung were reproduced in 2010.

- E [38] With effect from 1 March 2012, Act A1402, among others, repealed sub-s. 7(6). Subsection 7(6) CA is therefore enforceable from 1 September 1999 to 29 February 2012 (enforcement period of s. 7(6) CA).

[39] The definitions of "article" and "industrial design" in s. 3 IDA are as follows:

- F **"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;

- G *"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**

- H (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;**

- I (emphasis added).

[40] I am not able to accept the defendant's contention based on the then applicable s. 7(6) CA. My reasons are as follows: A

(i) subsection 7(6) CA applies to "any design which is capable of being registered" under IDA. Section 11 IDA provides that the "original owner" of an "industrial design" is entitled to apply for the registration of the "industrial design" under IDA. Accordingly, for a design to be registered under IDA, the design must fall within the definition of an "industrial design" in s. 3 IDA which has the following three elements (three elements): B

(a) the first element (first element) is that an "industrial design" means "features of shape, configuration, pattern or ornament" which in the finished article appeal to and are judged by the eye" (eye appeal features); C

(b) the eye appeal features are "applied to an article by any industrial process or means" (second element) ; and D

(c) the eye appeal features cannot include any of the matters stated in s. 3(1)(a) or (b) IDA (third element).

In the Court of Appeal case of *F & N Dairies (M) Sdn Bhd v. Tropicana Products Inc And Other Appeals* [2013] 1 LNS 380; [2013] MLJU 1591, at paras. [24]-[52], Ramly Ali JCA (as he then was) has explained the meaning of the first and third elements; E

(ii) the plaintiff's telekung is not applied to an "article" (as defined in s. 3 IDA) "by any industrial process or means". Accordingly, the second element is not fulfilled in respect of the plaintiff's telekung. On this ground alone, the plaintiff's telekung cannot constitute an "industrial design" in s. 3 IDA and is not "capable of being registered" under IDA within the meaning of s. 7(6) CA; F

(iii) the defendant has alleged a particular fact, namely the plaintiff's copyright has ceased under s. 7(6) CA (particular fact). Under s. 103 EA, the defendant has the burden to prove the particular fact. The defendant has failed to discharge the burden under s. 103 EA to prove the particular fact because no evidence has been led by the defendant to prove the three elements; and G

(iv) assuming that I have erred in giving a literal interpretation of CA and IDA in the above sub-para. (i), I have no hesitation to adopt a purposive interpretation of s. 7(6) CA. The CA and IDA have been enacted after 18 May 1967. As such, Part I of the Interpretation Acts 1948 and 1967 (IA) applies to interpret CA and IDA - please see s. 2(1)(b) IA. Section 17A IA (in Part I of IA) provides as follows: H

I

- A Regard to be had to the purpose of Act
- 17A. *In the interpretation of a provision of an Act, a construction that would promote the purpose or object underlying the Act (whether that purpose or object is expressly stated in the Act or not) shall be preferred to a construction that would not promote that purpose or object.*
- B (emphasis added).
- In *Palm Oil Research and Development Board Malaysia & Anor v. Premium Vegetable Oils Sdn Bhd* [2004] 2 CLJ 265, the Federal Court has relied on s. 17A IA to give a purposive construction of a taxing statute.
- C In accordance with s. 17A IA, I give a purposive and non-literal construction of s. 7(6) CA, the definitions of “article” and “industrial design” in s. 3 IDA by deciding that a telekung is not an “industrial design” in s. 3 IDA and s. 7(6) CA does not therefore apply to a telekung. If I have accepted the defendant’s above submission that a telekung is an “industrial design” in s. 3 IDA (to which s. 7(6) CA applies):
- D (a) this would not “promote the purpose or object underlying” IDA and CA; and
- E (b) an injustice and absurdity would result as follows - for the enforcement period of s. 7(6) CA, owners of copyright in all telekung (which have been produced more than 50 times) would lose their copyright!
- Whether Defendant Has Infringed Plaintiff’s Copyright**
- F [41] Section 36(1) CA provides as follows:
- Infringements
- 36(1) **copyright is infringed by any person who does, or causes any other person to do, without the licence of the owner of the copyright, an act the doing of which is controlled by copyright under this Act.**
- G (emphasis added).
- [42] Section 36(1) CA has two limbs - please see *Motordata Research Consortium Sdn Bhd v. Ahmad Shahril Abdullah & Ors* [2017] 1 LNS 1142; [2017] 7 AMR 560, at paras. [49] and [50]. The two limbs of s. 36(1) CA are:
- H (i) when a person (X) does an act which is controlled by copyright under CA (first limb) ; and
- I (ii) when a person causes X to do an act which is controlled by copyright under CA (second limb).

[43] This case does not concern the second limb. The first limb concerns a copyright infringement regarding “an act the doing of which is controlled by copyright”. The plaintiff’s copyright in the plaintiff’s telekung means that the plaintiff has the following exclusive rights:

- (i) the exclusive right under s. 13(1)(a) CA to control the “reproduction” (defined widely in s. 3 CA) of the plaintiff’s telekung in a “material form” (defined in s. 3 CA); and
- (ii) the exclusive right under s. 13(1)(e) CA to control the distribution of the plaintiff’s telekung to the public by sale or transfer of ownership.

[44] It is not disputed that the defendant has produced and distributed (by way of sale or transfer of ownership) the plaintiff’s telekung. To prove copyright Infringement under the first limb (the defendant has reproduced and distributed the plaintiff’s telekung), the plaintiff has to prove all the following three elements (three elements (first limb)):

- (i) there is a sufficient objective similarity between the plaintiff’s telekung and the defendant’s telekung [first element (first limb)];
- (ii) there is a causal connection between the plaintiff’s telekung and the defendant’s telekung (second element (first limb)); and
- (iii) what has been copied in the defendant’s telekung must constitute a substantial part of the plaintiff’s telekung (third element (first limb)).

The three elements (first limb) has been explained by Low Hop Bing J (as he then was) in the High Court case of *Megnaway Enterprise Sdn Bhd v. Soon Lian Hock (No 2)* [2009] 8 CLJ 130; [2009] 3 MLJ 525, at para. [41]. *Megnaway Enterprise* has been applied by the Court of Appeal in *Elias* case, at para. [31].

[45] To decide the first element (first limb):

- (i) the court has to make a visual comparison between the plaintiff’s telekung and the defendant’s telekung (visual comparison) - *Megnaway Enterprise*, at para. [46];
- (ii) for the purpose of the visual comparison, the plaintiff’s telekung is exh. P1 while the defendant’s telekung is represented by exhs. P2 and P3 (please see the above paras. [8] to [14]). For reasons stated in the above para. [15], I do not give any weight to exh. D6; and
- (iii) based on the visual comparison, I accept the testimonies of SP1 and SP2 that there is a sufficient objective similarity between exh. P1 on the one hand and exhs. P2 and P3 on the other hand (sufficient objective similarity). The sufficient objective similarity is as follows:
 - (a) the design and pattern on the top part of the plaintiff’s telekung and defendant’s telekung are similar;

- A (b) the measurements of the face opening and the forehead part of the plaintiff's telekung and defendant's telekung are similar;
- (c) the position of the tie string on the plaintiff's telekung and defendant's telekung is similar;
- B (d) the material on the forehead part of the plaintiff's telekung and defendant's telekung is similar; and
- (e) the rubber lace liner (pelapik) on the plaintiff's telekung and defendant's telekung is similar.
- C [46] Regarding the second element (first limb):
- (i) once the plaintiff has proven the first element (first limb) (sufficient objective similarity), there is a rebuttable presumption that the defendant has copied the plaintiff's telekung and the evidential burden then shifts to the defendant to disprove the second element (first limb)
- D by proving that the defendant's telekung has been created independently of the plaintiff's telekung - *Megnaway Enterprise*, at para. [43]; and
- (ii) the defendant has not adduced any credible evidence to prove that the defendant's telekung has been created without copying the plaintiff's telekung. On the contrary, I find that the rebuttable presumption
- E (the defendant's telekung is copied from the plaintiff's telekung) is fortified by the following evidence and reasons:
- (a) during cross-examination, SD1 agreed that the defendant's telekung was sold in the market subsequent to the plaintiff's telekung. In other words, the defendant could have easily bought the plaintiff's
- F telekung in the market and could then produce the defendant's telekung by copying the plaintiff's telekung. I rely on the Court of Appeal's judgment in *Elias* case, at para. [39], as follows:
- [39] *It is worthy of note that evidence of a causal connection can be established directly or indirectly In this case, the causal connection is indirect in that the original work had been published and was therefore available to the public. Thus the defendant would have had prior access to the novel. Even if the novel was no longer in the market, it would still presumably be available in libraries and bookstores. If we were to give a restrictive meaning to "causal connection" as the learned Judge did, it would leave a lot of original work unprotected, which is clearly not intended by [CA].*
- G
- H (emphasis added); and
- (b) an adverse inference under s. 114(g) EA is made against the defendant for suppressing material evidence regarding the defendant's designers and defendant's drawings (please see the above
- I sub-para. 33(iii)).

[47] Concerning the third element (first limb):

A

(i) in *Syarikat Faiza Sdn Bhd & Anor v. Faiz Rice Sdn Bhd & Anor And Another Case* [2017] 1 LNS 1648; [2017] MLJU 1595, at sub-para. 59(3), I have referred to the different tests regarding the third element (first limb) as follows:

B

(a) in the House of Lords case of *Designers Guild Ltd v. Russell Williams (Textiles) Ltd* [2001] 1 All ER 700, at 708-709, Lord Millett decided that:

C

(1) whether an impugned work has copied a substantial part of the copyright work depends on the quality (not the quantity) of the features of the copyright work which has been copied by the impugned work (qualitative test); and

D

(2) the features copied by the impugned work need not form a substantial part of the impugned work. The importance of the impugned work is therefore not relevant in deciding whether the third element (first limb) has been fulfilled or not; and

(b) in *Designers Guild*, Lord Scott has distinguished the following two types of copying:

E

(i) the impugned work has copied an identifiable part of the copyright work without any modification (direct copying). In a case of direct copying, whether the third element (first limb) is proven depends on the quality of the copyright work's features which has been copied by the impugned work; and

F

(ii) the impugned work has copied the copyright work with modifications (altered copying). To decide whether the third element (first limb) has been satisfied in an altered copying case, Lord Scott adopted the test stated in "*The Modern Law of copyright and Designs*", Laddie, Prescott and Vitoria, 2nd edn (1995), at paras. 2-108 - has the infringer incorporated in the impugned work a substantial part of the independent skill and labour of the author in creating the copyright work (Laddie's test)?;

G

(ii) based on the qualitative test, I am satisfied that the defendant's telekung has copied a substantial part of the plaintiff's telekung. This is because the features regarding the sufficient objective similarity constitute a substantial part of the plaintiff's telekung; and

H

(iii) additionally or alternatively, applying Lord Scott's decision:

I

(a) the sufficient objective similarity shows that the defendant's telekung has directly copied an identifiable part of the plaintiff's telekung (identifiable part). The quality of the identifiable part constitutes a substantial part of the plaintiff's telekung; or

- A (b) even if it is assumed that there is no identifiable part, this is an altered copying case because, on an application of Laddie's test, the defendant has incorporated in the defendant's telekung a substantial part of SP1's independent skill and labour in creating the plaintiff's telekung.
- B [48] Based on the evidence and reasons elaborated in the above paras. [45] to [47], the plaintiff has proven the three elements (first limb) on a balance of probabilities against the defendant.
- C [49] In the Court of Appeal case of *Elster Metering Limited & Anor v. Damini Corporation Sdn Bhd & Anor* [2012] 1 LNS 959, at para. [12], Ramly Ali JCA (as he then was) held that a defendant cannot rely on the following defences in a copyright infringement suit:
- (i) the defendant has no knowledge of the defendant's infringement of the plaintiff's copyright; and
- D (ii) the defendant has no intention to infringe the plaintiff's copyright.
- [50] Regarding the defendant's defence that the defendant was not aware of the plaintiff's copyright, I find as a fact that the defendant knew of the plaintiff's copyright. This decision is based on the following evidence and reasons:
- E (i) the plaintiff's telekung is introduced in the market before the defendant's telekung; and
- (ii) there has been extensive advertisement of the plaintiff's telekung in the mass media.
- F [51] Even if I have given the benefit of the doubt to the defendant and even if it is assumed that the defendant is oblivious to the plaintiff's copyright, I am of the view that the defendant's lack of knowledge of the plaintiff's copyright is not a defence to copyright infringement. Once a plaintiff has proven the three elements (first limb), there is a cause of action for copyright infringement pursuant to the first limb. Having said that, a defendant's lack of knowledge of a plaintiff's copyright is certainly a relevant factor for the court to decide whether to award the following damages for copyright infringement and their quantum:
- G
- H (i) statutory damages (please see s. 37(1)(d), (8)(c) and (h) CA);
- (ii) additional damages (please see s. 37(7)(c) CA);
- (iii) exemplary damages; and
- (iv) aggravated damages.
- I

Summary Of Court's Decision

A

[52] In summary:

- (i) pursuant to ss. 4(1) and 114(f) EA, there is a rebuttable presumption that the common course of business regarding the plaintiff's purchase of the defendant's telekung (exhs. P2 and P3) from CJ WOW Shop has been followed. There is no evidence adduced by the defendant to rebut the rebuttable presumption and on the facts of this case, the court attaches great weight to exhs. P2 and P3; B
- (ii) no weight is attached to exh. D6 which is not tendered during the cross-examination of SP1 (author of the plaintiff's telekung) and exh. D6 is only adduced after the close of the plaintiff's case; C
- (iii) the plaintiff's telekung is a "graphic work" as understood in s. 3(a) CA and does not constitute a "work of artistic craftsmanship" under s. 3(c) CA; D
- (iv) s. 7(2A) CA does not bar copyright protection of a telekung on the ground that the telekung is purely functional. In any event, the plaintiff's telekung is not purely functional so as to be disentitled to copyright under s. 7(2A) CA; D
- (v) the plaintiff owns copyright in the plaintiff's telekung by reason of: E
 - (a) the fulfilment of all the conditions; and/or
 - (b) SP2's SD which constitutes *prima facie* evidence of the plaintiff's copyright under s. 42(1)(a) CA and such evidence has not been rebutted by the defendant; F
- (vi) the plaintiff's copyright has not ceased under the previously applicable s. 7(6) CA because the plaintiff's telekung does not constitute an "industrial design" under s. 3 IDA which can be registered under IDA; and
- (vii) the defendant has infringed the plaintiff's copyright under the first limb. In this regard, the defendant cannot claim that: G
 - (i) the defendant is not aware of the plaintiff's copyright;
 - (ii) the defendant has no knowledge of the copyright infringement; and H
 - (iii) the defendant does not intend to commit copyright infringement.

[53] The upshot is the plaintiff's suit is allowed with costs.

I