



UniMAP
**INTELLECTUAL
PROPERTY**
Policy ———

Universiti Malaysia Perlis

**UniMAP
Intellectual
Property Policy**

UniMAP Intellectual Property Policy

**Unit Penyelidikan dan Pembangunan
Jabatan Canselori**



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Penerbit
Universiti Malaysia Perlis
2007

First Printing 2007

Published by :

Penerbit UniMAP
Perpustakaan Universiti Malaysia Perlis
Tingkat 1, Bangunan KWSP,
Jalan Bukit Lagi,
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Layout and Cover Design by : Baha Design & Advertising

Printed by: Public Press Sdn. Bhd.

UniMAP INTELLECTUAL PROPERTY POLICY

1. OBJECTIVES

Intellectual property policy should bring harmony to the conflicting interests of all the stakeholders in the generation and commercialization of an intellectual property. Universities institutions should be dedicated to teaching and research, and to the dissemination of all new knowledge generated. The objectives of the Intellectual Property Policy (hereinafter referred to as the 'Policy') of the Universiti Malaysia Perlis (UNIMAP - hereinafter referred to as the 'University') are in general to achieve the following:

- creation of an environment that encourages and expedites the dissemination of discoveries, creations and new knowledge generated by researchers for the greatest public benefit;
- protection of the traditional rights of scholars to control the products of their scholarly work;
- ensuring that the commercial results, financial or others, are distributed in a fair and equitable manner that recognizes the contributions of the inventors and the institution as well those of as any other stakeholders;
- promotion, preservation, encouragement of and assistance to scientific investigation and research;
- establishment of standards for determining the rights and obligations of a university, the creators of intellectual property and their sponsors, with respect to inventions, discoveries and works created at the institution;
- encouragement of, assistance to and the provision of mutually beneficial rewards for a university and its members who transfer intellectual property to the public through commercialization and licensing;

2. DEFINITIONS

'Employee of the University' means any person employed by the University under the University's Constitution and any other Statutes and includes any officer, teacher or staff of the University.

'Officer' means all administration staff including the Chancellor, Pro-Chancellor, Vice-Chancellor, Deputy Vice-Chancellor, Dean and Deputy Dean of a School, a Centre, an Academy, and an Institute, Program Chair of a School, Registrar, Bursar, Chief Librarian and holder of any other office created by the University's Constitution and any Statutes, or otherwise.

'Teacher' means an appointed academic staff in accordance with the University's Constitution, and includes a senior professor, professor, associate professor, senior lecturer, lecturer, language teacher, vocational training officer (PLV) and tutor.

'Student' means a registered student of the University.

'Research Officer' means a person appointed to carried out research and financially supported by university or grant money, includes research officer, research assistant, graduate assistant and post doctorate.

'University' means the Universiti Malaysia Perlis (UNIMAP).

'Visitor' means any person officially invited by the University for such academic or research purposes and duration as may be agreed upon by the parties other than an Employee, a Research Officer or a Student of the University.

'Invention' means and includes any new and useful improvement of a process, machine, product or other manufactured item or composition of matter whether or not it is patentable and whether or not it has been reduced to writing or any other forms of

expression and includes any related know-how and any documents, computer software or other medium in which any such invention is described or comprised.

'*Net Revenues*' means revenues after deducting all costs relating to the development, protection, marketing and administration of the intellectual property and includes, any direct and indirect costs associated with further development for commercialization of any intellectual property. Income accrued after apportioning all dues to any third party where applicable.

'*University Resources*' are defined as all tangible resources provided by UNIMAP to its employees, including office, laboratory, studio space and equipment, computer hardware, software, technical support, secretarial service, laboratory assistants, supplies, utilities, funding for research and teaching activities, travel and other funding or reimbursement. University resources do not include salary, insurance or retirement plan contribution paid to or for the benefit of employees.

'*Commissioned Work*' means generic tasks performed under an employment contract or appropriate position description, and which may be performed by any staff member with similar qualifications and position description.

3. COVERAGE OF INTELLECTUAL PROPERTY POLICY

A. Intellectual Property Rights

- i. Intellectual Property (hereinafter referred to as 'IP') comprises all tangible output which results from the exercise of the human brain, such as ideas, inventions, designs, drawings, paintings, written works and music. It also includes computer programs, layout-designs of integrated circuits, plant varieties, and databases.

- ii. The following are the types of intellectual property that are considered by the university under this intellectual property policy:
 - patents;
 - utility models;
 - industrial designs;
 - layout-Design of Integrated Circuits
 - copyright in literary and artistic works;
 - geographical indications;
 - trade and service marks;
 - new plant varieties;
 - trade secrets.

B. Patents

- i. A patent is an exclusive right granted for an invention, which is a product or a process that provides a new way of doing something, or offers a new technical solution to a problem. The protection is granted for a limited period, usually 20 years (as stipulated in the TRIPS agreement 1994). The patent is a title of ownership.
- ii. Patent protection means that the invention cannot be made, used, distributed or sold on a commercial scale without the patent owner's consent. These patent rights are usually enforced in a court, which in most systems holds the authority to stop patent infringement. Conversely, a court can also declare a patent invalid where it is successfully challenged by a third party. On registration and the grant of rights, annual fees are charged by the relevant authorities to maintain them.
- iii. A patent does not give its owner the positive right to use the patented invention. Third parties may have to be requested.

A patent owner has the right to decide who may or may not use the patented invention throughout the period during which the invention is protected. The patent owner may give permission to other parties, or license them, to use the invention on mutually agreed terms. The owner may also sell the right to the invention to someone, who then becomes the new owner of the patent.

- iv. Patents are granted only country by country, some regionally, and may also be used in non-patented territories. Once a patent expires, the protection ends, and the invention becomes part of the public domain, in the sense that the owner no longer holds exclusive rights in it, and it becomes available for commercial exploitation, free of charge, by others.

C. Utility Models

In general terms, a utility model is an invention that does not meet all the requirements of patentability but has an industrial use. The inclusion of utility models into the intellectual property system in some countries has the primary objective of nurturing the rapid evolution of indigenous innovativeness, particularly in small and medium-scale enterprises and among private persons.

D. Trademarks

- i. A trademark is a distinctive sign that identifies certain goods or services as those produced or provided by a specific person or enterprise. The system helps consumers identify and purchase a product or service because its nature and quality, indicated by its unique trademark, meets their needs. A trademark affords protection to the owner of the mark by ensuring his exclusive right to use it to identify goods or services, or to authorize another to use it against payment.

The period of protection varies, but a trademark can be renewed indefinitely beyond the time limit on payment of additional fees. Trademark protection is enforced by the courts, which in most systems have the authority to block trademark infringement. In a larger sense, trademarks promote initiative and enterprise worldwide by rewarding the owners of trademarks with recognition and financial profit. Trademark protection also hinders the efforts of unfair competitors, such as counterfeiters, to use similar distinctive signs to market inferior or different products or services. Trademarks may be one or more words, letters or numerals or a combination of all three. They may consist of drawings, symbols, three-dimensional shapes such as the outward form and packaging of goods, audible signs such as music or oral distinguishing features or smells.

- ii. On registration of a trademark, apart from registration fees, there are annual fees payable to the relevant institution for maintenance of the trademark rights.

E. Copyright

- i. Copyright is a legal term describing rights given to creators for their literary and artistic works. The kinds of work covered by copyright include literary works, such as novels, poems, plays, reference works, newspapers, computer programs, databases, films, musical compositions and choreography, artistic works such as paintings, drawings, photographs and sculpture, architectural works, advertisements, maps and technical drawings. The creators of original works protected by copyright, and their heirs, have certain basic rights. They have the exclusive right to use or authorize others to use the work on agreed terms. They can prohibit or authorize:
its reproduction in various forms, including printed

- publication or sound recording;
 - its public performance, as in the case of a play or musical work;
 - its recording, for example on compact disc, cassette, or videotape;
 - its broadcasting, whether by radio, cable or satellite;
 - its translation into other languages, or its adaptation, such as that of a novel into a screenplay.
- ii. Many creative works protected by copyright require mass distribution and communication, and financial investment for that dissemination to take place (as in the case of publications and computer programs), so universities and R&D institutions that create an intellectual property system more often than not need to sell the rights in their works to individuals or companies better placed to market the works in return for payment. Copyright protection also includes moral rights, including the right to claim authorship of a work, and the right to oppose changes to it that could harm the creator's reputation. The creator - or the owner of the copyright in a work - can enforce rights administratively and in the courts, by inspection of premises for evidence of production or possession of illegally made "pirated" goods related to protect works. The owner may obtain court orders to stop such activities, as well as seek damages for loss of financial rewards and recognition.

F. Trade Secrets

- i. Trade secrets consist of confidential data, information or compilations used in research, business, commerce or industry. Universities and R&D institutions, government agencies, business entities and individuals may own and use trade secrets. The information may include confidential scientific and technical data and business, commercial or

financial information not publicly known that is useful to an enterprise and confers competitive advantage on one having a right to use it. The secrecy of the information must be maintained to conserve its trade secret status.

- ii. Trade secret information may be disclosed or shared under the terms of a confidentiality agreement. Confidential information may be created in sponsored research projects. In that case the sponsor will generally require the university or R&D institution and the creator to preserve the secrecy of the information. Trade secrets in the form of know-how may be vital to the working of patented inventions and other innovations. Trade secret information may have considerable value by itself or in conjunction with other forms of intellectual property.
- iii. A familiar example of a trade secret is the formula for Coca-Cola. If the formula had been patented, it would no longer be a secret, as patent law requires public disclosure of the invention. Anyone who independently and legitimately discovers the secret of the Coca-Cola formula can use that discovery, and the Coca-Cola Company would have no legal means of stopping them.
- iv. Some universities, however, may have reservations regarding trade secrets protection, arguing that it is hard to reconcile with openness in knowledge sharing, which is part of the academic mission.

G. Layout-Designs of Integrated Circuits

- i. The Layout-Designs of Integrated Circuits Act 2000 protects original three-dimensional disposition, however expressed, of the elements of an integrated circuit and some or all of the interconnections of the integrated circuits. An original

layout-design is one that is the result of the creator's own intellectual effort and is not commonplace at the time of creation. The Act protects all independently created layout-designs even if they are identical.

- ii. Protection is not dependent on registration and is available for a period of ten (10) years from the date the layout-design is first commercially exploited in Malaysia or elsewhere. However, where the layout-design is not commercially exploited, and notwithstanding its commercial exploitation, the protection will lapse fifteen (15) years after the date of creation.
- iii. The right holder of a protected layout-design is entitled to reproduce the layout-design and to commercially exploit it. However, there is no right to prevent any reproduction for purposes of, among others, evaluation, analysis, research or teaching.

H. Industrial Designs

- i. An industrial design is the ornamental or aesthetic appearance of an article. The design may consist of three-dimensional features of the article, such as its shape or surface, or of two-dimensional features such as patterns, lines or color. Industrial designs are embodied in a wide variety of products of industry and handicraft, from technical and medical instruments to watches, jewellery and other luxury items, from household ware and electrical appliances to vehicles and architectural structures and from textile designs to leisure goods.

- ii. To be protected under most national laws, an industrial design must appeal to the eye. This means that it is primarily of an aesthetic nature, and does not protect any technical features of the article. Industrial designs are what make an article attractive and appealing and thereby add to its commercial value and increase its marketability. When an industrial design is protected, the owner- the person or entity that has registered the design - is assured of an exclusive right against unauthorized copying or imitation of the design by third parties, and in some countries (like in the European Union), is even protected in an absolute sense, like a patent against unauthorized use by others. Industrial designs can be relatively simple and inexpensive to develop, and they are easily accessible to small and medium-sized enterprises as well as to craftsmen, in both industrialized and developing countries. In most countries an industrial design must be registered in order to qualify for protection under industrial design law. The duration of protection varies from country to country and may be as long as 25 years (like in the European Union).

I. New Plant Varieties

- i. Currently, most Universities and R&D institutions in developing countries are involved in research in areas such as crop production, livestock and animal health, forestry, fisheries and crop storage. Research efforts in these areas have led to a number of specific achievements e.g. varieties of many crops, which are capable of producing high yield, more adapted to specific farming systems, resistant or tolerant to main diseases and pests, etc. These varieties are made available to farmers through existing seed services. For each variety, descriptive data are also available. They give a brief description of the variety: origin (group, pedigree, common name, etc.), agricultural

characteristics (farming system, vegetative cycle, adaptability to biotic and/or abiotic stresses, yield, grain quality,...), etc. These data facilitate the choice of a specific variety for a relevant type of farming system.

- ii. Under the International Convention for the Protection of New Varieties of Plants ("UPOV Convention"), an intellectual property right, namely "Plant Breeder's Right", can be granted to a breeder, if the obtained variety is considered to be new, distinct, uniform, stable and has a suitable denomination. The breeder's right means that, the authorization of the breeder is required before accomplishing some acts in respect of the propagating material of the protected variety. The UPOV Convention contains important exceptions to the breeder's right: The use of protected varieties in subsistence farming does not require the breeder's authorization. Protected varieties are available without the breeder's authorization for research and plant breeding and Contracting Parties to the Convention may, within certain limits, permit farmers (other than subsistence farmers) to use for propagating purposes the product of the harvest which they have obtained from the protected variety.
- iii. By granting a plant breeder's right, the development of new varieties of plants is encouraged in order to contribute to the enhancement of agricultural, horticultural and forestry productivity and, therefore, improvement of income and overall development.

4. OWNERSHIP RIGHT

A. Employee of the University and Research Officer

- i. Except as otherwise agreed in writing or stated in this Policy, the University asserts and claims worldwide right, title and interest to or in all IPRs in all works, inventions, designs and other subject matter
 - a. Created by Employees of the University:
 - in the course of and as a result of their employment with the University, or
 - at the expressed request or direction of the University, or
 - subject to Section 5, pursuant to any agreement with a third party to which the University is a party;
 - b. Created, developed, generated or otherwise brought into existence by Employees of the University with the use or the support of any facilities, material, funds or other resources provided or obtained by or through the University; or
 - c. Commissioned by or on behalf of the University for any purpose whatsoever.
- ii. The University does not assert or claim any right, title or interest to or in any IPRs in scholarly books, articles, conference papers, creative works, texts, proceedings, audiovisuals, lectures or such other academic work or subject matter generated (whether in written or any other form), or artistic, musical, dramatic works, performances or other creative works composed or created by Employees of the University other than those specifically commissioned

- by the University. However, the University retains a non-exclusive, royalty-free, perpetual license to use, develop or reproduce; in whatever manner it deems fit, in any of those works or subject matter generated by an Employee of the University for its teaching purposes, which license shall continue even after the Employee of the University has left the University.
- iii. The University asserts and claims all worldwide right, title and interest to or in all IPRs in any commissioned courseware (lecture notes, radio broadcast, audiovisual and digitally encoded material and the like) which have been developed to further its teaching function and result in specific considerations to the Employee of the University. Such commission, which is based on contract, may include financial benefit or relief from teaching duties. Should the author or courseware relocate to another institution, the University, in its absolute discretion, may grant him/her a non-exclusive license to use the courseware for the sole purpose of teaching but not for the implementation of any course in direct competition with that at the University.
- iv. The University does not assert or claim any right, title or interest to or in any IPRs in any works, inventions, designs or other subject matter created by Employees of the University outside the scope of their employment and which was created, developed, generated or otherwise brought into existence without the use or support of any facilities, materials, funds or other resources, including pre-existing IP owned by the University, provided or obtained by the University. Employees of the University may if so desired, assign or transfer all rights, title or interest to or in the IP to the University, subject to mutually agreed upon terms and conditions.

- v. Despite any contrary provision in this Policy, all contracts and arrangements existing at the time of the adoption of this Policy which are between the University and governments, corporations and other external organizations, and which relate to IPRs in which the University has an interest shall remain in full force and effect, including those where the ownership of IPRs is vested in a third party.
- vi. The University reserves its right to transfer the ownership of IPRs claimed under the above provisions to third parties with written approval from the inventor.
- vii. If the university cannot, or decides not to, proceed in a timely manner to patent and/or license an invention, it may reassign ownership to the inventor at the latter's request. In this case, the institutions would notify the inventor in writing of the assignment of rights. In all cases in where the invention is assigned to the inventor, the university will retain the right to a non-exclusive, non-transferable, irrevocable, royalty-free, worldwide license on the invention for research and educational purposes.
- viii. Generally the patents right in an invention made by an individual in his own time and without the use of the university resources belong to the inventor. In such cases the university claims no royalties.
- ix. If an inventor makes, creates or discovers intellectual property without significant use of the institutions' resources, but the intellectual property closely resembles a specific research project that the inventor has conducted at the institution, it may be argued that the intellectual property was developed using the institution's resources. Under these circumstances a conflict could arise between the institution and the inventor (or a company for whom the

inventor consults) over ownership of the intellectual property. This would be particularly true when the intellectual property gained substantial commercial value. In order to avoid these potentially litigious situations, members of staff should be obliged to disclose to their institutions any intellectual property that closely resembles a specific research project at the institutions. This should be accompanied by an explanation that the intellectual property did not arise through use of the institution's resources. The institution should ask the inventor for documentation supporting the claim that there was no significant use of its resources. If the institution is satisfied, it will then give the inventor a written acknowledgement that it has no claim on ownership of that intellectual property.

B. Student

- i. Except as otherwise agreed in writing or stated in this Policy, the University does not assert or claim any right, title or interest to or in any IP created by Students in the course of their studies or research at the University. However, in certain circumstances, the University may require Students to enter into an agreement which permits the University to obtain rights to IP which may be generated, created or developed by them in the course of their research or studies.
- ii. Notwithstanding Section 4(B)(i), the University asserts and claims any worldwide right, title, interest to or in any IP generated or created by Students where,
 - a. Generation of the IP has required use or support of Employees of the University, facilities, materials, funds or other resources provided or obtained by or through the University;

- b. Generation of the IP has resulted from the use of pre-existing IP owned by the University;
 - c. The IP belongs to a set of IP generated by a team of which the Student is a member; or
 - d. Generation of the IP in the course of and as a result of employment with the University.
- iii. Where the University owns IP created by Students, the University will ensure that, such ownership does not interfere with the assessment of the Student's academic performance or grant or award. The University reserves the right to place such restrictions or rules on the disclosure, dissemination or other dealings with respect to any work containing such IP for such period as may be appropriate for the purposes of IP protection.
- iv. The texts of all student theses and dissertations, and works derived from such works, are considered Exempted Scholarly Works. Therefore, the students will own copyright in the scholarly work subject to a royalty-free license to the institution to reproduce and publish. Students are normally allowed to publish their theses and dissertations unless they have agreed in writing to restrictions that preclude or delay publication.

C. Visitor

- i. Except as otherwise agreed in writing or stated in this Policy, the University does not assert or claim any right, title or interest to or in any IP created by Visitors at the University.

- ii. However, where such IP was generated, created or developed using facilities, materials, funds or other resources provided or obtained by or through the University Visitor shall disclose any IP that he or she creates and the University reserves the right to claim ownership or any other rights to the IP. In the exercise of its rights under this subparagraph, the University may be guided, though not necessarily bound, by the provisions of this Policy.

5. AGREEMENTS WITH THIRD PARTY

- i. It is envisaged that the University shall be involved in projects with other parties and that other parties may sponsor research within the University by providing funding. The University may enter with other parties, into an agreement which governs the ownership and exploitation of intellectual property. Where the intellectual property does not rest with the University, the consent of the originators shall be obtained before any such negotiation is entered into.
- ii. In negotiating such an agreement with third party, the University shall ensure;
 - a. that the originators are consulted at all stages; and
 - b. that the terms of the agreement are consistent with the principles set out in the other provisions of this policy.
- iii. Where such an agreement requires the originators to assign intellectual property to the University or to some other party, the University shall as far as practicable, ensure that the terms of the agreement are brought to the attention of those originators before they commence the work to which the agreement refers.

- iv. Employees of the University will not, whether directly or indirectly, make available to any third party, who is not a member of the University, any University facilities, materials or other resources for the purpose of creating IP except with the prior written approval of the Vice-Chancellor.

6. MANAGEMENT OF IPR

- i. There shall be constituted an Intellectual Property Committee (IPC) comprising the following:

Deputy Vice-Chancellor in charge of R&D affairs –
Chairman

Deputy Vice-Chancellor in charge of academic affairs –
Deputy Chairman

Head of commercialization unit - secretary

Dean of R&D Unit

Two (2) members of Senate for a term of two (2) years
(appointed by Senate)

Three (3) individual members for a term of two (2) years
(appointed by the Vice-Chancellor based on their
expertise)

One (1) of University legal affairs officer

Registrar

Bursar

- ii. The functions of the IPC shall be as follows:
 - a. To oversee the implementation of the Policy;
 - b. To manage and to take all necessary steps to formalize protection of IPRs belonging to the University;

- c. To advise the University on all matters relating to IPRs, including the assessment of risks, commercialization and exploitation of IPRs;
 - d. To disseminate and explain the Policy to Employees of the University, Students and Visitors;
 - e. To assist the University in the resolution of disputes relating to IPRs or arising from the implementation of the Policy;
 - f. To review and recommend, as and when the need arises, revisions to the Policy;
 - g. To appoint such sub-committees or persons as may be necessary to assist the University or the IPC in the technical evaluation or assessment of risks or commercialization or exploitation of the IPRs belonging to the University; and
 - h. To do all other things as may be necessary for the implementation of the Policy.
- iii. Where an Employee of the University creates, generates, develops or otherwise brings into existence any IP to which the University asserts or claims title, interest or other rights, the Employee shall report in writing of its existence to the IPC.
 - iv. The IPC shall recommend, after taking into account the report, evaluations and all other material considerations, to the Standing Finance Committee whether or not the University should exploit the IP which is reported or is otherwise brought to its notice.

- v. Where the IP involved is an invention or a design, no publication or announcement regarding the IP shall be made until a decision has been taken whether or not to exploit the relevant IP.
- vi. The Standing Finance Committee, after taking into account all financial considerations, shall have the absolute discretion to decide the following and to recommend accordingly to the Board of Directors of the University:
 - a. Whether to register or otherwise formalize the protection of the IP in the name of the University and in the countries or regions as may be thought necessary; or
 - b. To sell or otherwise dispose of the IP in a manner thought fit; or
 - c. To surrender the IP to the creator or inventor, as the case may be, on such terms and conditions as may be imposed; or
 - d. To make such decisions as may be appropriate in the interests of the University.
- vii. In the event a decision is made to commercialise or exploit the IP, the University, through the IPC, shall ensure that all necessary and appropriate actions are taken to implement its decision. This may include, without limitation, one or more of the following:
 - a. Taking appropriate measures to formalise the protection and the management of the IP;
 - b. Identification of potential licensees;

- c. Assignment of rights to third parties.
- viii. Where the University decides to be involved in the commercialization or exploitation of the IP,
 - a. It shall be responsible, subject to Section 8 (ii) below, for all costs and expenses in connection with the registration, protection, maintenance, marketing and management of the IPRs; and
 - b. The Employee of the University, Student or Visitor concerned shall provide all reasonable assistance in the commercialization or exploitation process by, among other things, providing information promptly upon request, attending meetings with potential licensees and generally advising of further development.

7. DISTRIBUTION OF INCOME

- i. Where the University derives any income from the commercialization or exploitation of IP, and unless otherwise agreed, such income, whether in the form of one lump sum or periodic payments, shall be distributed in accordance with paragraph 7(ii).
- ii. After deducting all costs and expenses in connection with the development, registration, protection, maintenance, marketing and management of the IPRs, including any other direct and indirect costs associated with the commercialisation or exploitation of the IPRs, the income shall be distributed as follows:

Inventor/Creator - 80% and University - 20% for the first RM 250,000.00

Inventor/Creator - 75% and University - 25% for the next RM 250,000.00

Inventor/Creator - 60% and University - 40% for the next RM 500,000.00

Inventor/Creator - 50% and University - 50% for more than RM 1,000,000.00

Provided always that where the inventor or creator is an Employee of the University, if he/she has resigned 'without permission' or is dismissed or his services are terminated, he shall not be entitled to any income which has not accrued at the date of the resignation (without permission), dismissal or termination, or any periodic payment due after the date of the resignation (without permission), dismissal or termination, unless the University in its absolute discretion decides otherwise.

The above proviso does not apply to an Employee who has retired or resigned 'with permission' from the University, who shall continue to receive such income or periodic payment, as the case may, as may be due and payable to him.

8. MORAL RIGHTS

- i. The University shall take reasonable steps to respect the right of an originator to be acknowledged as the creator of intellectual property, and to endeavour to ensure that others respect that right.

- ii. Where the University uses intellectual property created by an originator, it shall take reasonable steps to consult with the originator before modifying or adapting that intellectual property, except in the case of external teaching materials in which it is the owner of the copyright. In such case the University may modify or adapt the materials at its sole discretion for the purpose of producing modified or adapted external teaching materials.
- iii. Where an originator wishes not to be acknowledged as the creator of intellectual property which has been modified or adapted, the University shall take reasonable steps to respect that wish, and to endeavour to ensure that others respect it.

9. DISPUTE RESOLUTION

- i. In the event of a dispute, controversy, claim or difference of whatever nature arising out of the implementation or operation of the Policy, or in any way relating to the Policy, the IPC shall try and resolve the dispute, controversy, claim or difference, failing which, it shall appoint a mediator, whose appointment shall be agreed upon by all parties, to assist the parties to resolve the issue.
- ii. The mediator shall adopt whatever procedure he deems appropriate in the mediation process provided all parties concerned are given a fair hearing.
- iii. The costs of mediation, if any, shall be borne equally by all parties.
- iv. If the dispute, controversy, claim or difference is not settled, the matter shall at the sole option of the University, through

- the IPC, be referred to arbitration; to be conducted as may be determined by a single arbitrator, who shall be appointed by agreement between the parties. Where a decision has been reached to refer the dispute, controversy, claim or difference to arbitrator, the IPC shall serve a notice to that effect on the parties.
- v. Where the parties are not able to agree on the appointment or where one party fails or refuses to act or is reluctant to act, then the other party or parties may within thirty (30) days from the date of the notice apply to the Director of the Kuala Lumpur Regional Centre for Arbitration to appoint an arbitrator and such arbitrator so appointed shall be deemed to be appointed with the agreement of the parties.
 - vi. The arbitration shall be held in Kuala Lumpur at the Kuala Lumpur Regional Centre for Arbitration and shall be conducted in accordance with the Arbitration Rules of the Regional Centre for Arbitration, Kuala Lumpur.
 - vii. The language to be used in the arbitral proceedings shall be in English or Malay and the findings and award, if any, of the arbitrator shall be final and binding on the parties.

10. INFORMATION AND EDUCATION

- i. Upon adoption of this policy the university shall take all reasonable steps to ensure that it is communicated and explained to staff and students.
- ii. The University shall establish on an annual basis an intellectual property education programme with the following objectives:

- a. To alert new staff and students to their rights, responsibilities and opportunities in relation to intellectual property;
- b. To alert staff and students as to any changes to this policy; and
- c. To generate a better understanding of intellectual property issues in general and so contribute to the creation within the University of more cooperative and productive environment for teaching, learning and research.

11. POLICING AND INFRINGEMENT

- i. This policy may be implemented or supplemented in any way consistent with its terms and those of other University's policies.
- ii. This policy shall not apply to existing written agreement between the university and/or creator(s) and any external organization or individual, concerning the development, legal protection or commercialization of specific intellectual property and entered into prior to the date of which this policy is adopted by the university's senate.
- iii. University personnel will not engage in any activity in conflict with the university's interests including:
 - a. signing of intellectual property agreements with outside persons or organizations which may abrogate the right of the University as stated in this policy or which otherwise conflict with this policy and
 - b. using the name of the University or any of its faculties, institute or centres without prior authorization in connection with any invention.

- iv. **University units and personnel are responsible for knowing applicable regulations, monitoring their continuing evaluation and conducting their activities in full compliance with the applicable laws and regulations related to patent and copyright infringements. The responsibility to avoid penalties for non-compliance or infringements extends to all personnel who carry out activities which involve transmission, communication or duplication of materials protected by copyright.**

12. INVENTION DISCLOSURE TO INTELLECTUAL PROPERTY COMMITTEE

- i. **Submitting a disclosure of the invention to Intellectual Property Committee (using the Patent Application Form as in Appendix A) is the first formal step in obtaining proper intellectual property protection. Inventors are required to submit Invention Disclosure early in their invention development process to avoid any potential problems. Inventions conceived and first reduced to practice by school or staff in furtherance of University research should be promptly disclosed in writing to Intellectual Property Committee (IPC).**
- ii. **University Invention Disclosure Form is designed to ensure that information which is essential to obtain intellectual property is available. The disclosure forms are available at R&D unit.**
- iii. **The Invention Disclosure Form should be submitted with a written description of the invention (explanatory drawings, data, abstracts and summaries). The description can be brief and should state what the invention is, what it does and why it appears significant. Sketches or diagrams**

typically are helpful as well as the description of the most relevant existing technology known to the inventor is also useful. The written description must be in sufficient detail to allow a patent searcher and patent professional to understand the invention and to assess its patentability. There are other related information requested in the Invention Disclosure Form. One such information is regarding any industry collaboration or sponsorship involved in the development of the invention.

13. RISK OF PREMATURE DISCLOSURE

- i. It is essential that IPC is informed of any publications, or planned publications that disclose the invention. This will determine the time frame for filing a patent application if a decision is made to do so. It is important to note that, 'premature disclosure' through any type of publication may disqualify an invention for patentability and may result in loss of patent rights. University researchers should contact IPC early and often to determine appropriate steps in this regard. Publications may include abstracts, poster sessions, shelved theses or even certain talks describing an invention to an open audience even if given by someone who is ultimately judged not to be the inventor.
- ii. University would discourage agreements which withhold or unduly delay publication of research results. IPC and the inventor can cooperate through appropriate timing of disclosure, patent filing and publication to preserve commercial value and still meet any sponsor obligations without hindering dissemination of research results. University researchers are strongly advised not to negotiate their invention with third party without notifying IPC. Any negotiation with third party should be guided by appropriate

technology transfer and R&D commercialization personnel from University.

14. PRIOR ART SEARCH AND MARKET EVALUATION

- i. For every disclosure received, IP Committee will open a Docket File for the invention and based on the disclosure materials submitted, the IP Committee will decide whether to approve Prior Art Search and Novelty Search for the invention. An internal or outside patent searcher will be engaged by IP Committee to search relevant patents and related literature. The inventors are also encouraged to do their own search using free search in the internet and supply any literature that describes other technology which is directly relevant to the invention. The results of this search permit preliminary opinion as to whether the invention disclosed appears to be patentable and if so, to what extent.

- ii. The formal Prior Art search Report or Novelty Search Report will be provided to the inventor who will be asked to comment on the search and its conclusions. If in the opinion of the IP Committee that the invention is not patentable, the inventor is notified and the Docket File will be closed. If the invention is patentable the IP Committee will begin to determine the commercial viability of the invention.

- iii. It is essential that any patentable invention be analysed for its industrial relevance and commercial potential. The IP Committee, together with the inventor, will try to answer the following questions:
 - Does the technology offer a cheaper and better way of accomplishing something?
 - How much better is our invention compared to any existing technologies?

- Does it provide a technological answer to an existing problem?
 - Does it have the potential of creating a new market?
 - How much investment (time and money) will be required to bring the invention to the marketplace?
 - Will the inventors continue work on the invention?
 - What will be the potential pay-off for a company that makes an investment in development of the invention?
- iv. These and other questions related to commercial potential must be answered in order to justify the investment to obtain a patent and to develop a strategy for licensing the technology to a commercial partner. Many inventions do not lend themselves to simple answers and one should not assume that, absolute certainty of a market is required in order to file a patent application. It is not unusual for a technology to be marketed extensively for many years before a licensee is found and in some cases, even after extensive effort no licensee can be found.

15. PATENTABILITY AND MARKETABILITY DETERMINATION

- i. In terms of technology market assessment, an invention could lead to either of the followings:
 - A product or service that performs a new function
 - Improved performance of an existing product
 - Additional functions of an existing product
 - An existing product in new market
 - Integration of two existing products
- ii. The decision to file a patent application is based on a complex set of factors that includes an integration of patentability and marketability. Legal, technical and business perspectives must be incorporated arrive at a conclusion.

If the invention is patentable and marketable, the IP Committee will instruct one of its internal or external patent agents to prepare a patent application.

16. THE PATENT APPLICATION

Upon authorization by the IPC, a patent agent prepares a draft of a patent application to be submitted to the MyIPO. Inventors must review the application for correctness and completeness which are essential requirements for patentability. There are several important elements of the patent application process:

- i. **The Declaration (Inventorship):** The inventor states that, he or she has reviewed and understood the contents and believes that he or she is the original, first, and sole or joint inventor. The inventor is the person or persons who conceived the invention and must have made a significant contribution to the original concept and first reduction to practice. Joint inventors need not have worked together or at the same time, but they must have communicated and been aware of each other's work. The contribution of the joint inventors need not be equal but it must be original. The input of labour does not qualify for inventorship. For example, carrying out experiments, under instruction, does not rise to the level of inventorship. Similarly, authorship of a scientific paper does not qualify inventorship.
- ii. **The Patent Specification:** The inventor describes the background of the invention including the problem solved, materials and methods necessary to make the invention. Since one cannot claim an invention that has not been described, it is important that the description be written as positively as the experimental data permits. The description of the best mode or preferred embodiment of the invention must be sufficiently full, clear, concise and exact to enable

any person skilled in the art to make and use the invention. The inventor will liaise with the appointed patent agent in preparing the specification.

- iii. **The Claims:** The Claims, which are always found at the end of the patent document. It constitutes the legal description of the exact property which is covered by the patent. The Claims establish a contractual relationship between the owner of the invention and the Malaysian Government which defines the legal limits of the invention to which the owner is entitled protection. While the specification must meet all disclosure standards, ultimately, it is the Claims which will dictate the value of the patent. Even if the invention is described, if it is not covered by the Claims, there are no patent rights exist. Because of their significance, the inventor must thoroughly review the Claims with the authorized patent agent and discuss their implications with legal advisors appointed by the University.
- iv. **Drawings:** Explanatory drawings accompanying the Specification are essential for most patent applications, especially mechanical and electrical inventions.
- v. **Filing Fee:** The University, assisted by IPC, will pay all filing costs as well as subsequent prosecution and maintenance fees.

17. PATENT PROSECUTION

- i. Patent prosecution is the process of convincing a Patent Examiner of the patentability of an invention over his or her assertions to the contrary. When a patent application is received by the Intellectual Property Division a filing date is assigned to a Patent Examiner with expertise in the field of

the invention. The Examiner reviews the patent and conducts a patent and literature search.

- ii. The Patent Examiner will uncover other patents, within Malaysian or foreign, or other publications that impact on the invention. The Examiner will normally challenge the patent claims or sometimes reject the application. At this point, the patent agent engaged by IPC will contact the inventor for assistance in drafting a response to the rejections or examiner's queries. This interplay between patent agent and the examiner is done primarily in writing and is referred to as the "Prosecution" of the patent. The patent agent attempts to Claim the invention as broadly as possible, while the Examiner tries to narrow down the Claims. The patent agent must ultimately try to retain in the application, the broadest claims since the eventual commercial potential will be based on the breadth of the invention. In order to obtain the optimal patent coverage, the inventor must assist IPC and the appointed patent agent in responding to the opinions and conclusions of the Patent Examiner.

REFERENCES:

1. Guidelines on Developing Intellectual Property Policy for Universities and R&D Organizations, by WIPO
2. Garis Panduan Paten di Kalangan Institut Pendidikan Tinggi (IPT), by Ministry of Education in 1995.
3. Garis Panduan Bagi Pengurusan Harta Intelek Yang Dimiliki oleh Kerajaan Dan Agihan Saguhati Hasil Penyelidikan Yang Dikomersilkan Kepada Pegawai-pegawai Awam, Pekeliling Perkhidmatan Bil. 5 tahun 1999, by the Public Services Department.

And IP policies of the following Universities:

4. University Malaya
5. Kolej University Tun Hussein Onn (KUiTTHO)
6. Universiti Sains Malaysia
7. Columbia University
http://www.stv.columbia.edu/guide/policies/app_1.html
8. Indiana University Intellectual Property Policy
<http://www.indiana.edu/~ovpr/respol/intprop.html>
9. Massachusetts Institute of Technology
<http://web.mit.edu/policies/13.1.html>
10. Oxford University
<http://www.admin.ox.ac.uk/rso/policy/intpol.shtml>
11. Stanford University
<http://snf.stanford.edu/Labmembers/IntelProp.html>
12. Washington University
<http://www.wustl.edu/policies>
13. University of Massachusetts Intellectual Property Policy
<http://www.umass.edu/research/intelfac.html>
14. University of Sydney
<http://www.usyd.edu.au/blo/staff/manual/iplu.shtml>
15. University of Texas
<http://www.utsystem.edu/OGC/IntellectualProperty/polguide.htm>

APENDIX A



U MAP

BORANG PERMOHONAN PATEN / PATENT APPLICATION FORM

1. **MAKLUMAT PERIBADI / PERSONAL INFORMATION**

Nama Pemohon / Name of Applicant :

Jawatan / Designation :

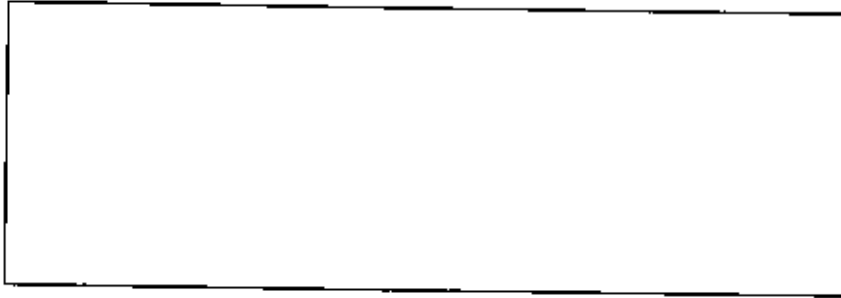
Pusat Pengajian / Pusat / Jabatan
School / Centre / Department :

2. **KETERANGAN MENGENAI CIPTAAN YANG AKAN
DIPATEN / DESCRIPTION OF INVENTION TO BE
PATTERNED**

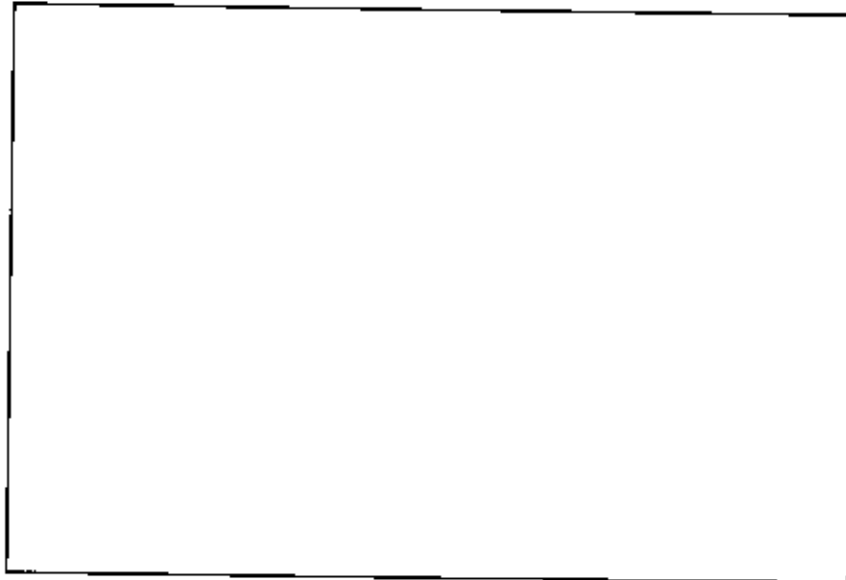
(Sila terangkan mengenai ciptaan anda secara jelas dan tepat mengikut tajuk-tajuk kecil yang diberikan di bawah: / Please describe the invention in a clear and concise manner according to the sub-heading given below)

(i) Tajuk / Title:

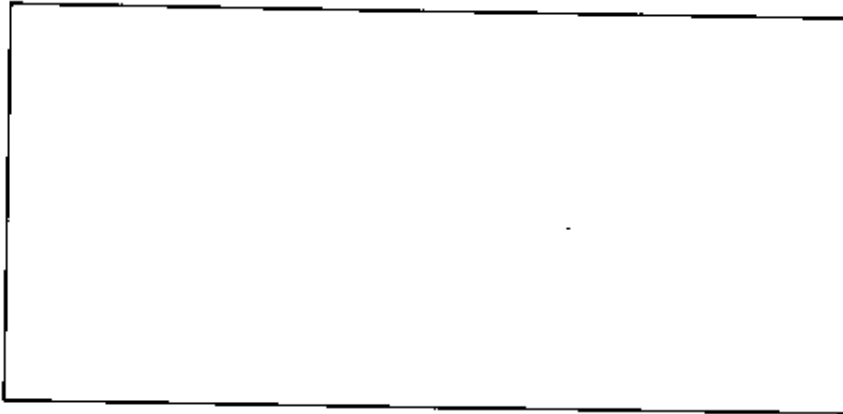
- (ii) Bidang Teknikal (Kenyataan am mengenai barangan atau teknologi di mana ciptaan itu ada berkaitan) / *Technical aspects of invention (General description of the technical or technological aspect related to the invention)*



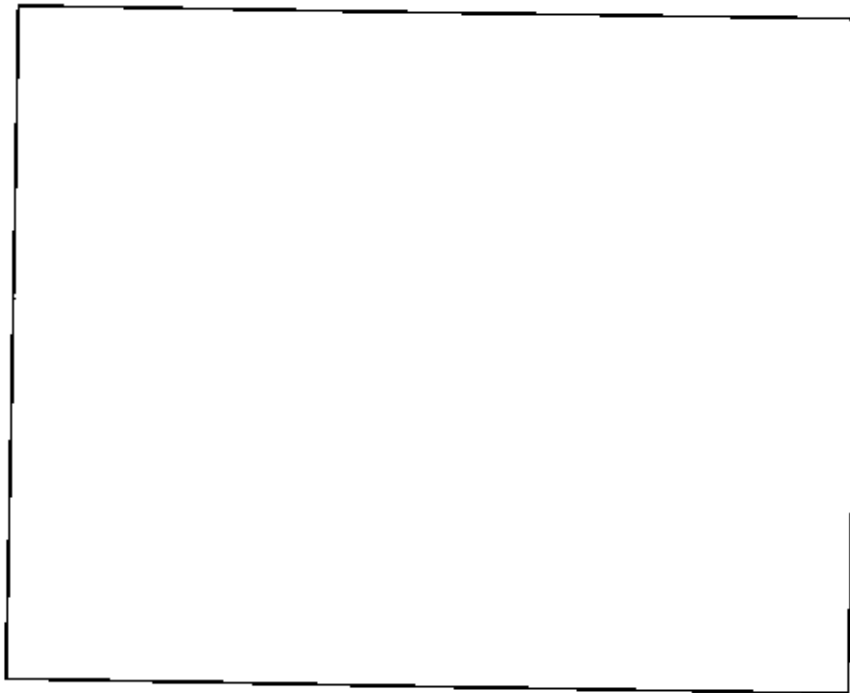
- (iii) Keterangan lengkap mengenai ciptaan (termasuk gambarajah aliran, lukisan dan bahan lain seumpamanya) / *complete description of invention (including flowchart, drawing and other similar descriptive material)*



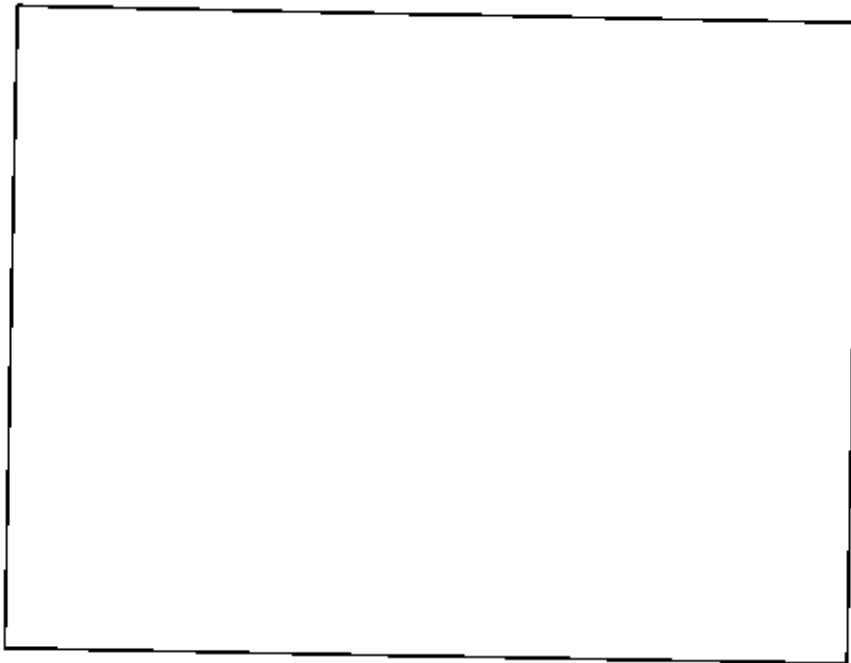
(iv) Ringkasan mengenai ciptaan / *Summary of invention*



(v) Contoh Khusus Penggunaan / *Specific Application Example:*



(vi) Tuntutan / *Claims*:



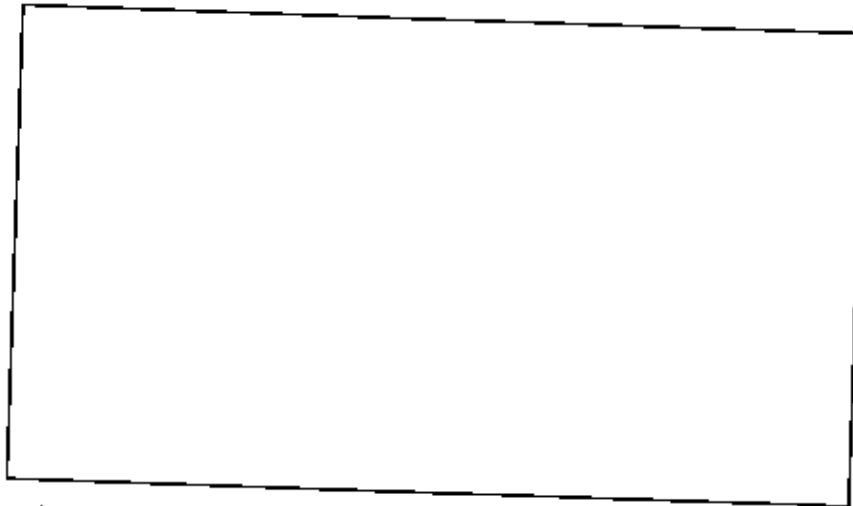
**3. MAKLUMAT-MAKLUMAT AM UNTUK MEMBANTU
JAWATANKUASA MEMBUAT KEPUTUSAN / GENERAL
INFORMATION FOR HELPING PATERN COMMITTEE**

1. Adakah maklumat mengenai ciptaan ini pernah diterbitkan / *Has any information regarding this invention been published:*
 - i) Melalui penerbitan bertulis atau sebarang pendedahan seumpamanya / *Via written publication or any similar disclosure.*

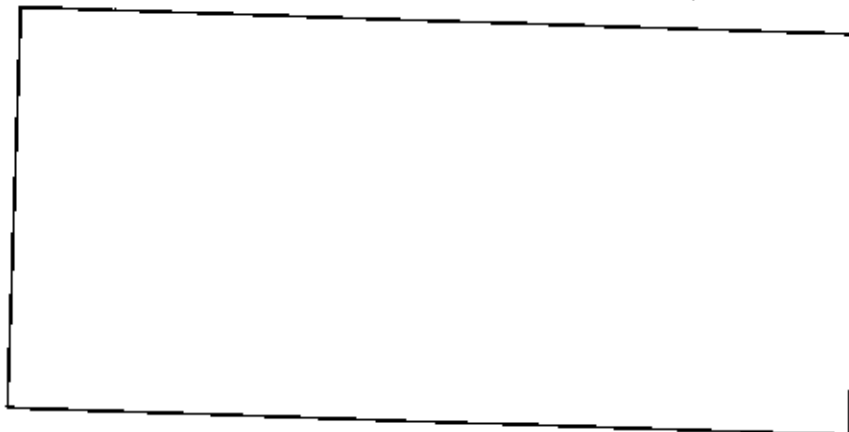
- ii) Melalui bengkel atau kilang pembuatan tanpa mengambil langkah-langkah untuk merahsiakan ciptaan ini / *Via any workshop or manufacturer without confidential measures being taken.*
- iii) Secara lisan kepada mana-mana pihak atau orang perseorangan / *Orally to any organization or individual.*

2. Adakah sebarang 'carian novel' telah dilakukan mengenai ciptaan ini? / *Has any novelty search been conducted regarding the invention?*

3. Sekiranya ciptaan ini, hasil usaha daripada satu kumpulan, sila nyatakan nama-nama mereka yang berhak ke atas Paten / *if this invention is a joint work, please state the name (s) of those who are eligible to be named as inventor (s).*



4. Sila nyatakan sebarang kerjasama dengan industri atau penajaan yang terlibat dalam membangunkan ciptaan ini / *Please state any industrial collaboration or sponsorship involved in the development of the invention.*



5. Sila nyatakan pelanggan yang berpotensi untuk ciptaan ini
/ Please state the potential clients for the Invention.

4. **ULASAN PENGERUSI IPC/ COMMENTS BY CHAIRMAN
OF IPC:**

Tandatangan / Signature:

.....

Nama & Cop Jawatan /
Name & Seal:



Penerbit
Universiti Malaysia Perlis
www.unimap.edu.my
E-mail: penerbitan@unimap.edu.my