



**UPM**  
UNIVERSITI PUTRA MALAYSIA  
BERILMU BERBAKTI

**UNIVERSITI PUTRA MALAYSIA**  
AGRICULTURE • INNOVATION • LIFE

*Kursus Penyelidikan dan Khidmat Sosial bagi  
Kumpulan Pengurusan dan Profesional (Akademik) Siri 1/2019*

# Intellectual Property Rights

by

Dr Zahira Mohd Ishan

23 January 2019

*11.00 a.m – 1.00 p.m*

# Contents

- IP and IPRs
- Importance of protecting IP
- Role of Bhg Putra IP, PSP
- Disclosure requirements to University via Bhg Putra IP UPM
- Evaluation Procedures in UPM
- What's next after IP protection?



## Intellectual Property: Concept & Overview

**Intellectual Property (IP) refers to “*all rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields*” (WIPO).**



# Intellectual Property: Concept & Overview

## IP v IPRs

### Intellectual Property

- IP refers to **creation of the minds**: incl. inventions; literary & artistic works; designs; and symbols, names & images used in commerce
- An intangible asset

(WIPO,2017)

### Intellectual Property Rights

- **Rights given** to persons over the creations of their minds
- Creators get exclusive rights over the use of his creation
- Only for a certain period of time

(WTO,2015)

IP

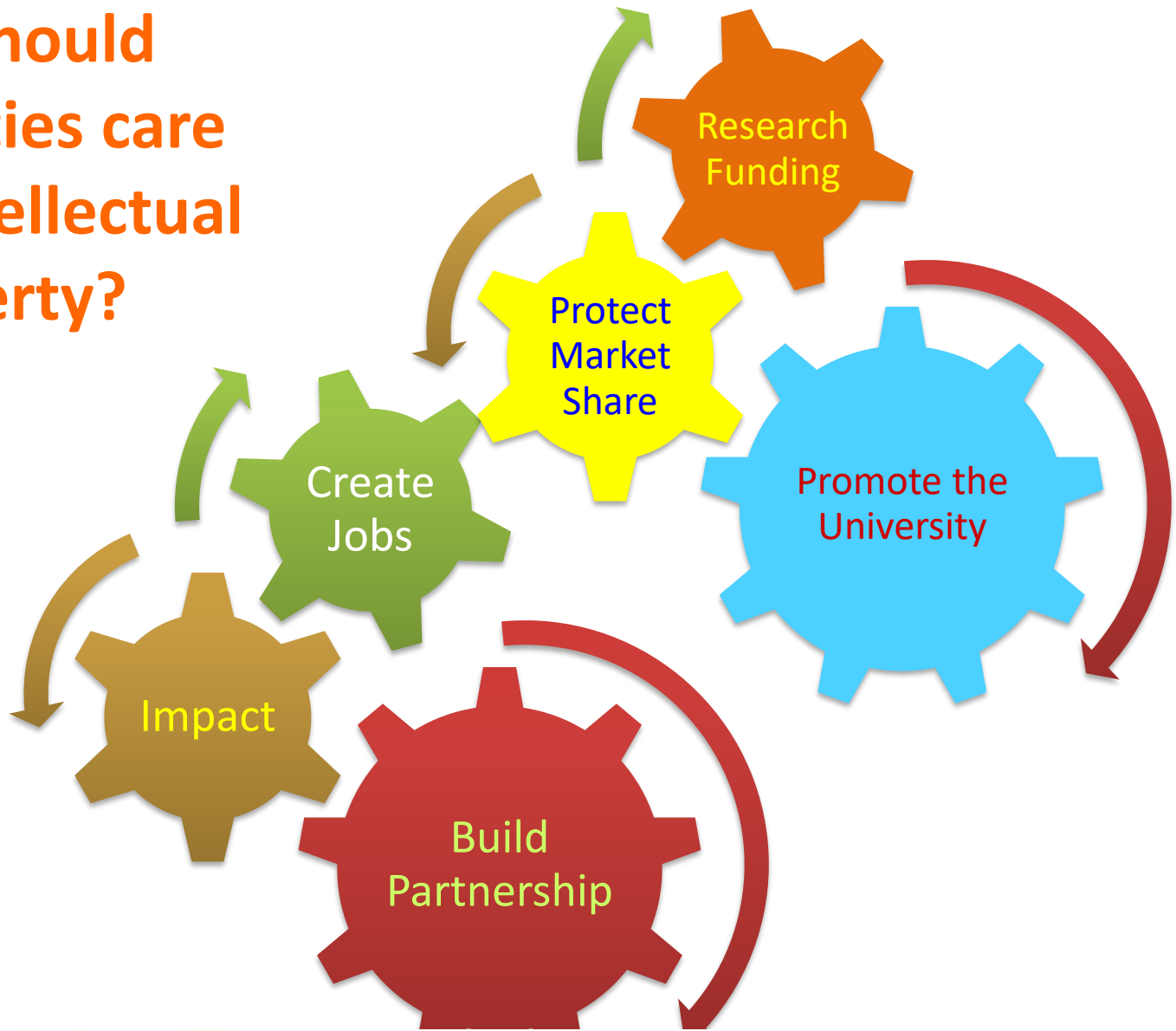
Type of IP  
and relevant  
laws

- Patent
- Industrial Design
- Copyright
- Trademark
- New Plant Variety
- Trade secret

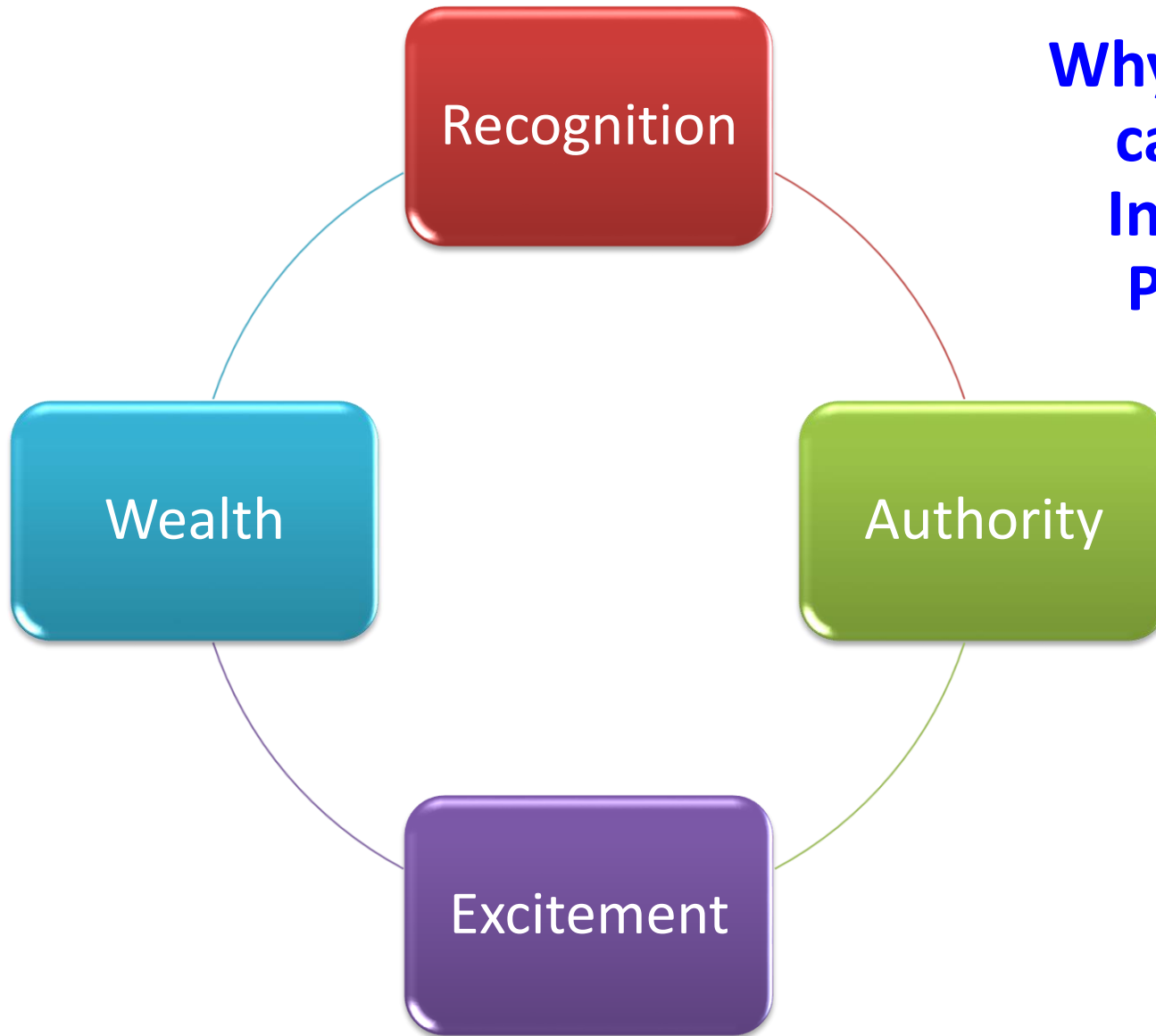
How the  
Rights exist?

- Sole research
- UPM's institutionalized research
- Commission  
/Consultancy work

# Why should Universities care about Intellectual Property?



# Why should we care about Intellectual Property?



# Intellectual Property: Acknowledgement

The screenshot shows the PRIMS (Putra Research & Innovation Management System) portal. On the left, there is a navigation menu with categories like 'Utama', 'Profil Akademik', 'Geran Penyelidikan', and 'Penerbitan'. The 'Penerbitan' menu is expanded, showing sub-categories such as 'Archived Exhibitions', 'Editorial Work - Books', 'Publication - Books', etc. On the right, a search results page is displayed for 'Intellectual Property: Trade Mark'. The search criteria include 'ZAHIRA BINTI MOHD ISHAN' and 'PERANAN : PENYELIDIK UPM'. The results table shows one entry with the title 'Intellectual Property: Trade Mark'.

## MODUL PENERBITAN (PRIMS)

Bagi pensyarah FEM mereka boleh memasukkan Modul yang berkaitan contohnya :

Fakulti Ekologi Manusia

- Recorded Music, Music Score dan Concert

Bagi pensyarah FRSB mereka boleh memasukkan Modul yang berkaitan contohnya :

Fakulti Rekebentuk dan Senibina

- Arts & Design Catalogue, Arts & Design Catalogue Chapters dan etc.

This screenshot shows the 'Penerbitan' (Publication) menu in the PRIMS system. The menu items are listed vertically, and a red box highlights the following items: 'Music Score', 'Concert', and 'Recorded Music'. Other items in the menu include 'Archived Exhibition', 'Editorial Work - Books', 'Publication - Books', etc.

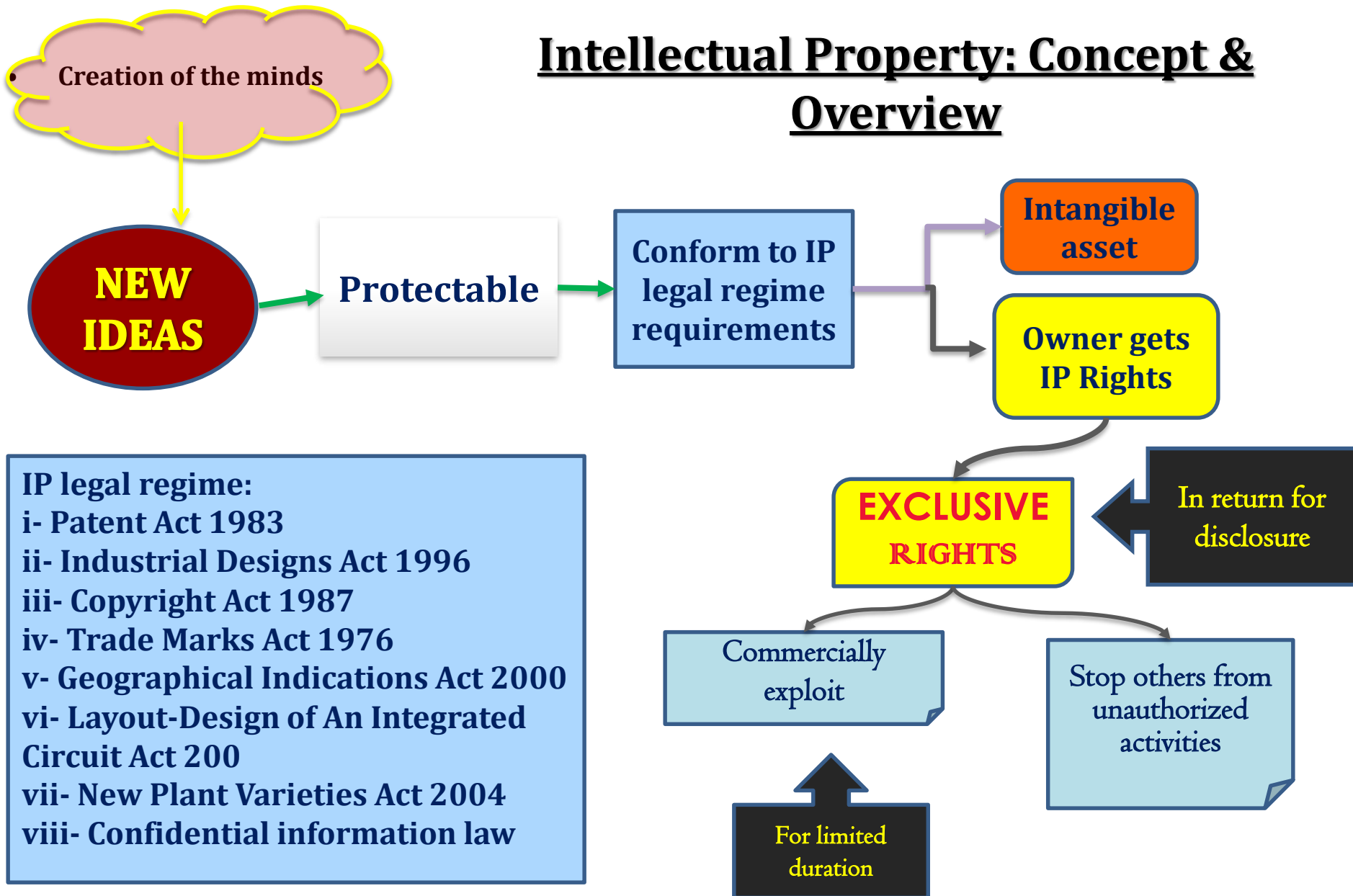
This screenshot shows the 'Penerbitan' (Publication) menu in the PRIMS system. The menu items are listed vertically, and a red box highlights the following items: 'Art & Design Catalogue Chapter' and 'Designed Artifacts'. Other items in the menu include 'Archived Exhibition', 'Editorial Work - Books', 'Publication - Books', etc.

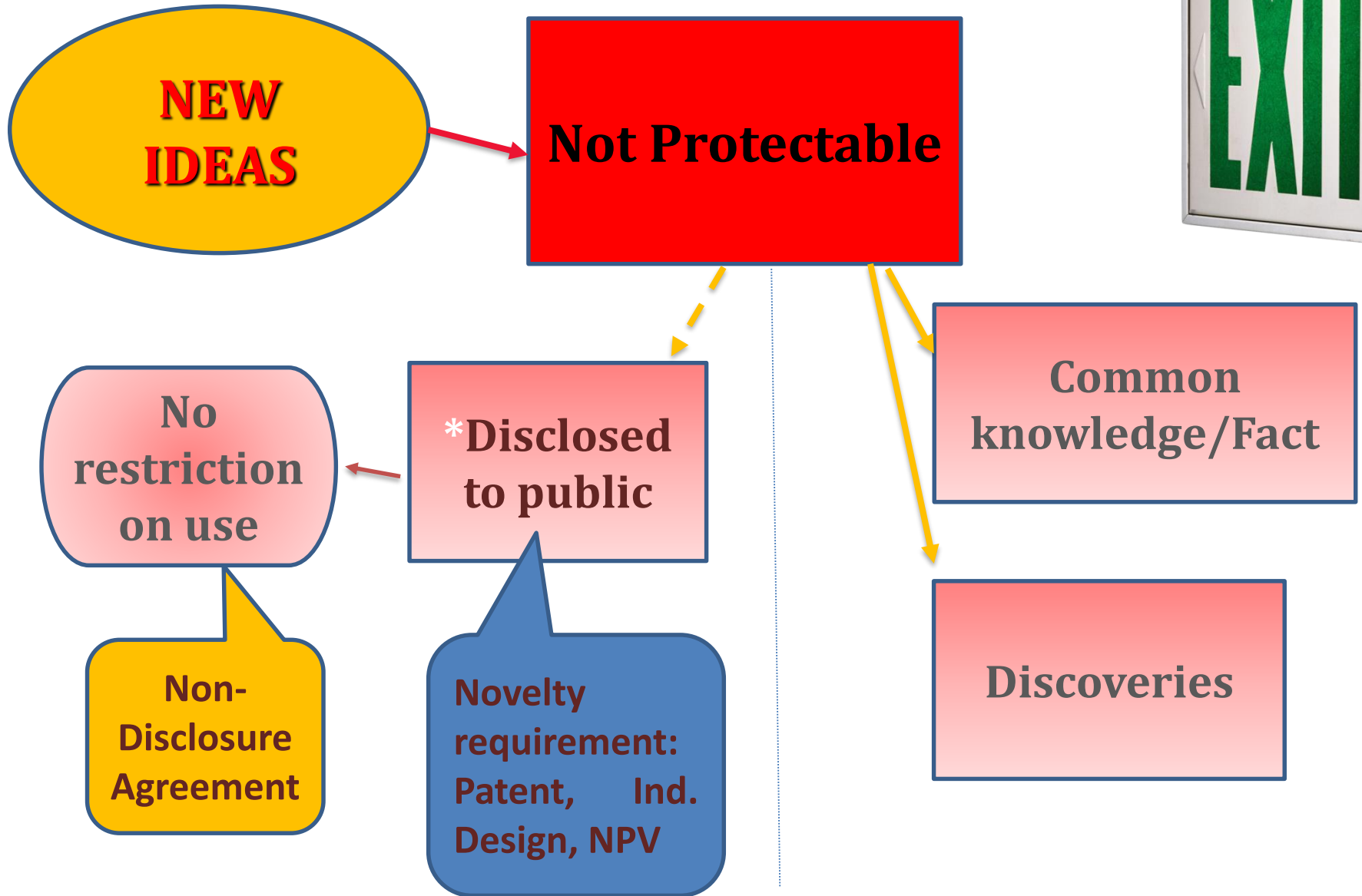
			Penyelia Bersama	CV	Supervision of Student
Penyelidikan - Input	1.	Kuantiti Penyelidikan	Kuantiti Penyelidikan	KM	Research Grant
Penyelidikan - Output	1-2.	Kuantiti Penerbitan dan Kualiti Penerbitan	Jurnal Berwasit Terujuk	KM	Publication - Citation-indexed Journals
			Jurnal Berwasit Tidak Terujuk	KM	Publication - Non Citation-indexed Journals
			Buku	KM	Publication - Books
			Bab dalam Buku	KM	Publication - Book Chapters
			Penulisan Popular	KM	Publication - Popular Writing
			Penerbitan Makalah Akademik dan Profesional	KM	Publication - Academic or Professional Magazines
			Polisi	KM	Publication - Unpublished Material
			Classified Report	KM	Publication - Unpublished Material
			Movie Directed, Drama Directed, Movie Script, Drama Script, Musical	KM	Other Publications

			Score, Concert, Artistic Work		
			Modul, Manual, Nota, Buku Kerja	KM	Other Publications
			Patent	KM	Intellectual Property Patent
Khidmat Klinikal	1.	Kuantiti Khidmat Klinikal	Wad, Klinik, Rawatan bedah/Prosedur, Makmal dan Radiologi	CV	Clinical Services
Khidmat Professional	1.	Penglibatan	Perundingan	CV	Consultancy
			Pengembangan	CV	Professional Services Involvement
			Penasihat Projek	CV	Professional Services Involvement
			Pakar Rujuk	CV	Professional Services Involvement
			Pemeriksa Dalam (Projek)	CV	Professional Services Involvement
			Pemeriksa Dalam (Tesis)	CV	Examiner to Students



# Intellectual Property: Concept & Overview





**NEW  
IDEAS**

**Not Protectable**

**No  
restriction  
on use**

**Non-  
Disclosure  
Agreement**

**\*Disclosed  
to public**

**Novelty  
requirement:  
Patent, Ind.  
Design, NPV**

**Common  
knowledge/Fact**

**Discoveries**

*Patent*

Technology that solve specific problem

*Industrial design*

Outer appearance of article with aesthetic value

*Trademark*

Sign, symbol @ expression use in course of trade

*New Plant Variety*

Clearly distinguishable

*Copyright*

Artistic creations in material form

*Geographical indication*

Quality, reputation, characteristics of goods attributable to geographical origin

*Integrated Circuit of Layout-Design*

3D disposition of elements of an IC

# Intellectual Property Protection

**Comes into existence  
upon REGISTRATION**

- Patents
- Industrial Designs
- Trademarks
- Geographical Indications
- New Plant Varieties

**NO  
REGISTRATION  
required**

- Copyright
- Layout-Design of  
Integrated Circuits



PATENT



Patent, Trade Mark,  
Industrial Design &  
Geographical Indication  
Applications via IP Online Portal



- Home
- Individual
- Agent
- Contact
- FAQ
- Login

## Patent Search

Keyword

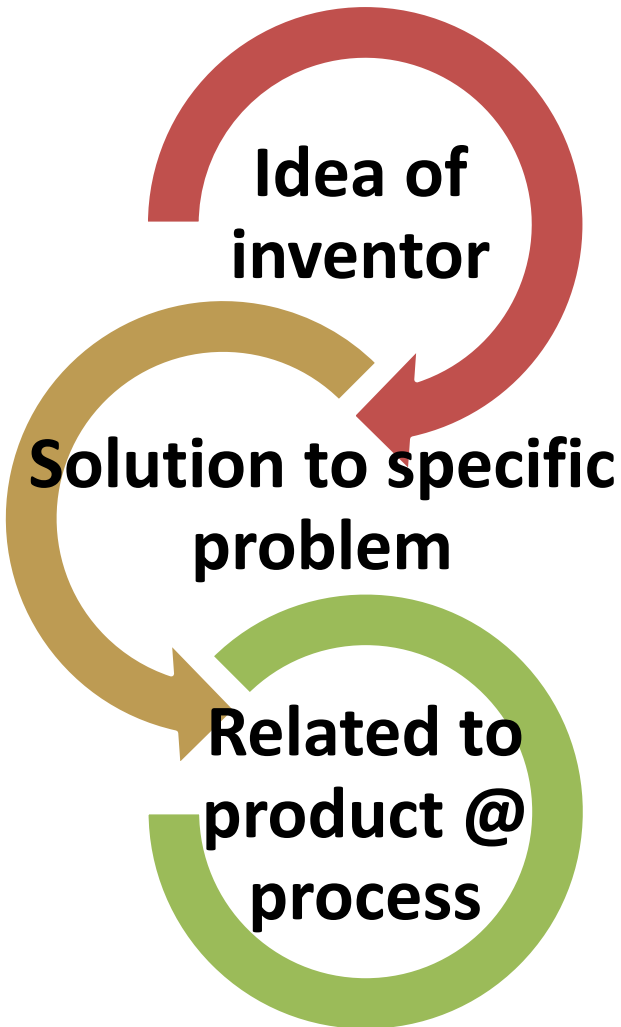
[Search](#)

[Click here for Advanced Search](#)

673 Records Found, Displaying 1 to 20

No.	App No.	Title	Filing Dt.	Legal Status	Details
1.	PI 20060550	MANNHEIMIA HAEMOLYTICA VACCINE	09/02/2006	Granted	<a href="#">Q</a>
2.	PI 20042640	BIOASSAY FOR HEAVY METALS	02/07/2004	Substantive Examination In Progress	<a href="#">Q</a>
3.	PI 20042722	HYPOCHOLESTEROLEMIC NUTRACEUTICAL OIL	08/07/2004	Clear Full Subst. examination	<a href="#">Q</a>
4.	PI 20042788	DETECTION OF HEPATITIS B SURFACE ANTIGEN	13/07/2004	Granted	<a href="#">Q</a>
5.	PI 20043830	REVTMENT BLOCK	20/09/2004	Published as lapsed	<a href="#">Q</a>
6.	PI 20044302	TURN BRIDGE	19/10/2004	Published as lapsed	<a href="#">Q</a>
7.	PI 20061883	PRENATAL SCREENING OF DOWN SYNDROME	25/04/2006	To Be Deemed Refused	<a href="#">Q</a>
8.	PI 20062343	LED-BASED SCHLIEREN MIRROR SYSTEM	22/05/2006	Deemed Refused	<a href="#">Q</a>
9.	PI 20062344	NOZZLE AND SEAT GEOMETRY FOR DIRECT INJECTION	22/05/2006	Substantive Examination In Progress	<a href="#">Q</a>
10.	PI 20062475	THERAPEUTIC AGENT FOR TREATING CANCER	30/05/2006	Substantive Examination In Progress	<a href="#">Q</a>
11.	PI 20063916	PRE-CAST INVERTED TRIANGULAR SHELL FOOTING	14/08/2006	Deemed withdrawn	<a href="#">Q</a>

# PATENTABLE INVENTION



## Novelty

**-compare to closest prior art**

**: MyIPO, Patentscope, Espacenet, Patent Lens, Google Patent**

# Freedom to operate

- Just because you can get a patent does not mean you can use it.



- You patent the bike frame, others patent the wheel.



# Freedom to operate

- Just because you can get a patent does not mean you can use it.
  - We can use others patent, if:
    - Allowed via licensing;
    - Patent in public domain,
    - Patent not protected in country of intended use



# Unpatentable Invention:

- ❑ Discoveries, Scientific theories, Mathematical methods;
- ❑ Plant @ animal varieties @ essentially biological processes for the production thereof;
- ❑ Method for doing business, performing purely mental acts @ playing games;
- ❑ Treatment @ diagnostic method on human @ animal body.

Except apply to products used in any such methods

# Protection for Inventions

## ***PATENT***

- **New**
- **Involves an Inventive Step (non-obvious)**
- **Capable of Industrial Application**

## ***UTILITY INNOVATION***

- **New**
- **Capable of Industrial Application**

# Priority Date:

- First-to-File principle: Owner is the person who files first.
  - ~ **Do NOT disclose before filing.**
- *What happen if we disclose before filing?*
  - ~ ‘Disclose’ includes publish, share to others orally or in writing, or clearly indicated in photos. “You can kill your own patent”.
  - ~ Grace period varies per country.

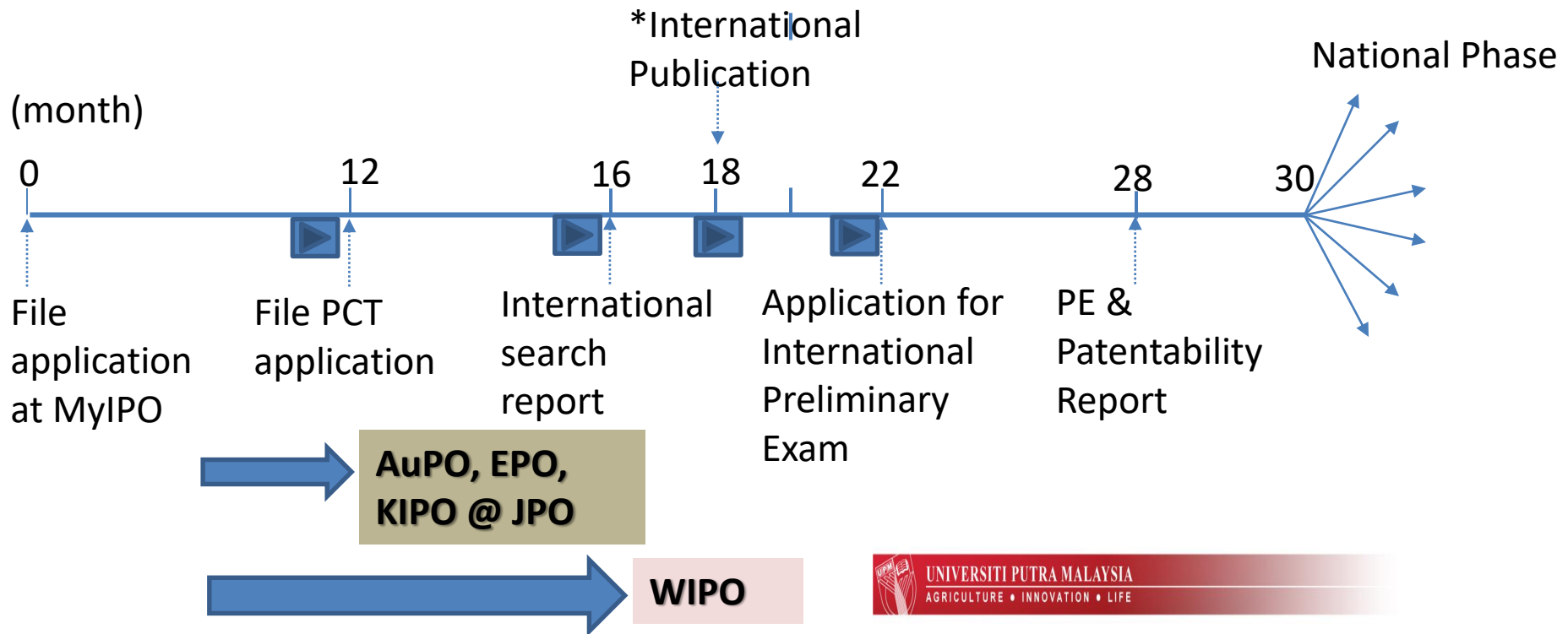


# International Application:

## Patent Cooperation Treaty (PCT)

PCT system is a patent application “filing” system, not patent “granted” system.

~ No PCT patent or international patent granted.





# INDUSTRIAL DESIGN



## Registrable Industrial Design:

- **Fulfill the interpretation of ID**

~ features of shape, configuration, pattern or ornament applied to an article by any process or means; finished article appeal to the eye & judged by the eyes..

- **New in Malaysia & elsewhere (NOVELTY)**

~ 6 months grace period (post 1/7/2013)

~ Compare with existing designs: [Google image](#), [WIPO Global Design Database](#)

- **Not contrary to public order or morality**



# Locarno Classification

## INTERNATIONAL CLASSIFICATION FOR INDUSTRIAL DESIGNS

under the *Locarno Agreement*  
Tenth Edition

- [Search](#)
- [Preface](#)
- [Locarno Agreement](#)
- [Recommendations](#)
- [Guidance for the User](#)
- [List of Classes](#)
- [List of Classes and Subclasses with Explanatory Notes](#)

### LIST OF CLASSES

<a href="#">CLASS 1</a>	FOODSTUFFS
<a href="#">CLASS 2</a>	ARTICLES OF CLOTHING AND HABERDASHERY
<a href="#">CLASS 3</a>	TRAVEL GOODS, CASES, PARASOLS AND PERSONAL BELONGINGS, NOT ELSEWHERE SPECIFIED
<a href="#">CLASS 4</a>	BRUSHWARE
<a href="#">CLASS 5</a>	TEXTILE PIECEGOODS, ARTIFICIAL AND NATURAL SHEET MATERIAL
<a href="#">CLASS 6</a>	FURNISHING
<a href="#">CLASS 7</a>	HOUSEHOLD GOODS, NOT ELSEWHERE SPECIFIED
<a href="#">CLASS 8</a>	TOOLS AND HARDWARE
<a href="#">CLASS 9</a>	PACKAGES AND CONTAINERS FOR THE TRANSPORT OR HANDLING OF GOODS
<a href="#">CLASS 10</a>	CLOCKS AND WATCHES AND OTHER MEASURING INSTRUMENTS, CHECKING AND SIGNALLING INSTRUMENTS
<a href="#">CLASS 11</a>	ARTICLES OF ADORNMENT
<a href="#">CLASS 12</a>	MEANS OF TRANSPORT OR HOISTING
<a href="#">CLASS 13</a>	EQUIPMENT FOR PRODUCTION, DISTRIBUTION OR TRANSFORMATION OF ELECTRICITY
<a href="#">CLASS 14</a>	RECORDING, COMMUNICATION OR INFORMATION RETRIEVAL EQUIPMENT
<a href="#">CLASS 15</a>	MACHINES, NOT ELSEWHERE SPECIFIED
<a href="#">CLASS 16</a>	PHOTOGRAPHIC, CINEMATOGRAPHIC AND OPTICAL APPARATUS
<a href="#">CLASS 17</a>	MUSICAL INSTRUMENTS
<a href="#">CLASS 18</a>	PRINTING AND OFFICE MACHINERY
<a href="#">CLASS 19</a>	STATIONERY AND OFFICE EQUIPMENT, ARTISTS' AND TEACHING MATERIALS
<a href="#">CLASS 20</a>	SALES AND ADVERTISING EQUIPMENT, SIGNS
<a href="#">CLASS 21</a>	GAMES, TOYS, TENTS AND SPORTS GOODS
<a href="#">CLASS 22</a>	ARMS, PYROTECHNIC ARTICLES, ARTICLES FOR HUNTING, FISHING AND PEST KILLING
<a href="#">CLASS 23</a>	FLUID DISTRIBUTION EQUIPMENT, SANITARY, HEATING, VENTILATION AND AIR-CONDITIONING EQUIPMENT, SOLID FUEL
<a href="#">CLASS 24</a>	MEDICAL AND LABORATORY EQUIPMENT
<a href="#">CLASS 25</a>	BUILDING UNITS AND CONSTRUCTION ELEMENTS
<a href="#">CLASS 26</a>	LIGHTING APPARATUS
<a href="#">CLASS 27</a>	TOBACCO AND SMOKERS' SUPPLIES
<a href="#">CLASS 28</a>	PHARMACEUTICAL AND COSMETIC PRODUCTS, TOILET ARTICLES AND APPARATUS
<a href="#">CLASS 29</a>	DEVICES AND EQUIPMENT AGAINST FIRE HAZARDS, FOR ACCIDENT PREVENTION AND FOR RESCUE
<a href="#">CLASS 30</a>	ARTICLES FOR THE CARE AND HANDLING OF ANIMALS
<a href="#">CLASS 31</a>	MACHINES AND APPLIANCES FOR PREPARING FOOD OR DRINK, NOT ELSEWHERE SPECIFIED
<a href="#">CLASS 32</a>	GRAPHIC SYMBOLS AND LOGOS, SURFACE PATTERNS, ORNAMENTATION

Classes	A-Z
1   2   3   4   5	
6   7   8   9   10	
11   12   13   14   15	
16   17   18   19   20	
21   22   23   24   25	
26   27   28   29   30	
31   32	



## Filing Requirements:

- **Registration and examination system**
  - applied the principle of “first to file”
  - protection rights for initial 5 years from the date of filing (renewable terms 5+5+5+5 years): Max 25 years
- **Right of priority under the Paris Convention** - allows to claim the earliest date of filing application within the 6 months period



## NOT Industrial Design:

- 1) A method or principle of construction
- 2) The features of the article are dictated solely by function
- 3) The features depend upon the appearance of another article which forms the integral part of that article
- 4) It differs only in immaterial details or features
- 5) The features do not have a clear aesthetic appearance

TRADE MARK

TM

SM

®



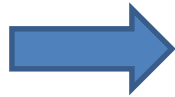
***s. 3(1) of TMA 1976: “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof;***

“trade mark” ...to indicate a connection in the course of trade between the goods or services & the proprietor or registered user....

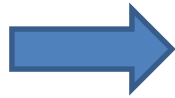


# What is a Trade Mark?

Device



Wording



Signature



Slogan



Numbers



Combination



## Securing the Trade Mark:

- 1) Registrability: **NOT** generic , immoral, descriptive of quality or character, geographical name or surname  
*[eg: Kleenex ; Oomphies ; Mee Sedap; Serdang; Tamin; Putra]*
  
- 2) Availability:
  - **NOT** identical or confusingly similar to a prior registered mark
  - **NOT** used in the same market & in connection with similar goods or service

# Trademarks Dispute

- Similar / confusing logo
- Using others logo without license on product / service of same class
- Counterfeit products with logo of others
- Using of non-use logo of others
- Domain name (cybersquatting)



Genuine Canon product  
Clear Canon logo



Counterfeit product  
Top of the logo is blurred



Al Baik Fast Food Distribution Co SAE v El Baik Food Systems Co S A

life.love.  
**LION**

CLASS : 21

2011055561 21 December 2011

Dental floss; tooth picks; toothbrushes; interdental toothbrushes; denture brushes; toothbrushes [electric]; toothbrush cases; toilet cases; hair brushes; brushes for hair washing; brushes for dish washing; sponges for dish washing; sponges for household purposes; cockroach traps; insect traps; cleaning tools and washing brushes; shoe brushes; shoe brushes for pets; night-soil disposal sheet for pets; night-soil disposal materials for pets; night-soil disposal equipment for pets; trays (litter -) for pets; feeding vessels for pets; all included in Class 21.

**LION CORPORATION;** 3-7, Honjo 1-chome, Sumida-ku, Tokyo 130-8644, , , JAPAN

**AGENT:** Linda Wang Chaw Ling, Tay & Partners 6th. Floor, Plaza See Hoy Chan 50200 Kuala Lumpur

**EXAMPLE**

CLASS : 21



2012000005 03 January 2012

*The trade mark is limited to the colours as shown in the representation on the form of application.*

*Registration of this trade mark shall give no right to the exclusive use of letters "u" and "s" and the symbol "@".*

Pots, kettles, woks, cake moulds, containers and other kitchen utensils made of aluminium or other non precious metal for household use; all included in Class 21.

2011019879 11 November 2011

*International priority date claimed : 26 September 2011, United States Of America*

Yarns and threads, for textile use; all included in Class 23.

**SABIC Holding Europe B.V.;** Europa Boulevard 1 Sittard NL-6135LD , , THE NETHERLANDS

**AGENT:** Yew Woon Chooi, Rodyk & Davidson I.P. Services Sdn. Bhd. T109, 3rd Floor, Centrepoint Bandar Utama 47800 Petaling Jaya

CLASS : 24



08024859 18 December 2008

*Registration of this trademark shall give no right to the exclusive use of the word 'baby cashmere'*

Textiles and textile good, not included in other Classes; bed and table covers; all included in class 24.

**LORO PIANA s.p.A.;** CORSO ROLANDI, 10, 13017 QUARONA (VERCELLI) , , ITALY

CLASS : 24



2011018121 13 October 2011

*Registration of this trade mark shall give no right to the exclusive use of the letter "z".*

Covers for pillow and pillow cases; all included in Class 24.

**Scalarco Sdn. Bhd.;** Suite 1208, Level 12, Amcorp Tower Amcorp Trade Centre No. 18, Persiaran Barat 46050, PETALING JAYA, SELANGOR MALAYSIA



# **Nice Classification:**

## **45 Classes**

**-goods (1- 34); services (35-45)**

***\*refer to MyIPO website or WIPO website***





INTERNATIONAL CLASSIFICATION OF GOODS AND SERVICES **Nice Classification**

UNDER THE NICE AGREEMENT TENTH EDITION **Class Headings**

- Search
- Preface
- Nice Agreement
- Legal Texts Relevant to Trademarks
- Guidance for the User
- General Remarks
- Class Headings
- List of Classes with Explanatory Notes

**GOODS**

<a href="#">Class 1</a>	Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
<a href="#">Class 2</a>	Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
<a href="#">Class 3</a>	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
<a href="#">Class 4</a>	Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
<a href="#">Class 5</a>	Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth; dental wax; disinfectants; preparations for destruction of vermin; preparations to prevent frostbite; preparations for the hair; medicinal preparations for dermatological use; preparations for destroying noxious weeds.
<a href="#">Class 6</a>	Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
<a href="#">Class 7</a>	Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs; automatic vending machines.
<a href="#">Class 8</a>	Hand tools and implements (hand-operated); cutlery; side arms; razors.
<a href="#">Class 9</a>	Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmitting or reproducing by wire, optical, or electro-magnetic means, sound, images or information; apparatus for telephony, telegraphy, radiotelephony, cinematography, television, radio, radio-telephony, radio-telegraphy, radio-diffusion, television-diffusion, sound-diffusion, image-diffusion, or for the transmission of data; apparatus for the transmission of signals; apparatus for the transmission of images or sound; apparatus for the transmission of information; apparatus for the transmission of data; apparatus for the transmission of information; apparatus for the transmission of data; apparatus for the transmission of information; apparatus for the transmission of data.
<a href="#">Class 10</a>	Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.
<a href="#">Class 11</a>	Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
<a href="#">Class 12</a>	Vehicles; apparatus for locomotion by land, air or water.
<a href="#">Class 13</a>	Firearms; ammunition and projectiles; explosives; fireworks.
<a href="#">Class 14</a>	Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
<a href="#">Class 15</a>	Musical instruments.
<a href="#">Class 16</a>	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); toys; games.
<a href="#">Class 17</a>	Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.
<a href="#">Class 18</a>	Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips; harness and saddlery.
<a href="#">Class 19</a>	Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.
<a href="#">Class 20</a>	Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.
<a href="#">Class 21</a>	Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.
<a href="#">Class 22</a>	Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.
<a href="#">Class 23</a>	Yarns and threads, for textile use.
<a href="#">Class 24</a>	Textiles and textile goods, not included in other classes; bed covers; table covers.
<a href="#">Class 25</a>	Clothing, footwear, headgear.
<a href="#">Class 26</a>	Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.
<a href="#">Class 27</a>	Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

# Fact of TM in UPM

UPM, Putra , Uniputra trademarks was registered by Bhg Komunikasi Korporat in 2002

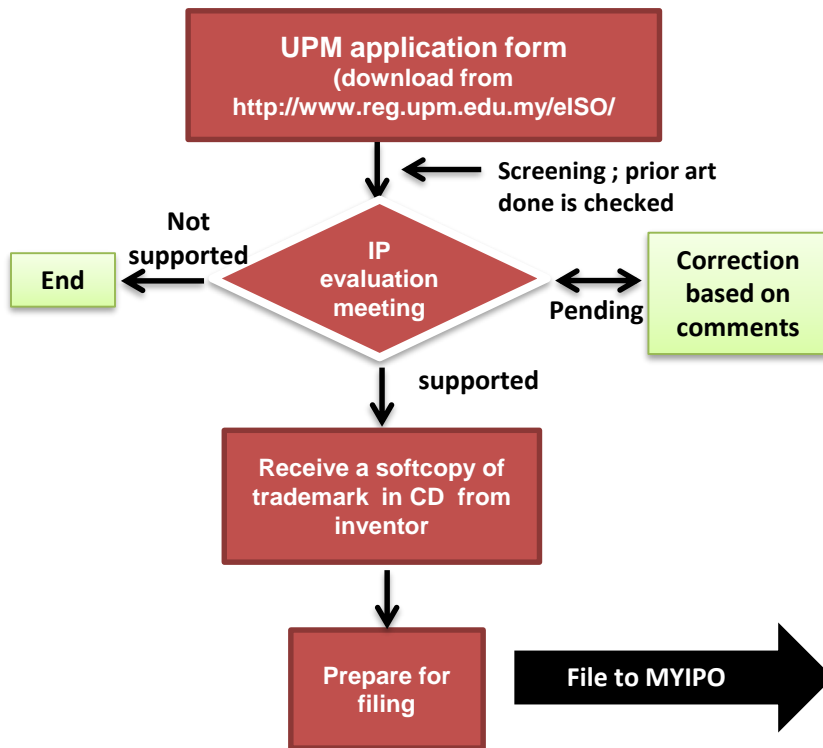
Then in 2007 & 2008:

PUTRA : Class 32, 41 & 16;

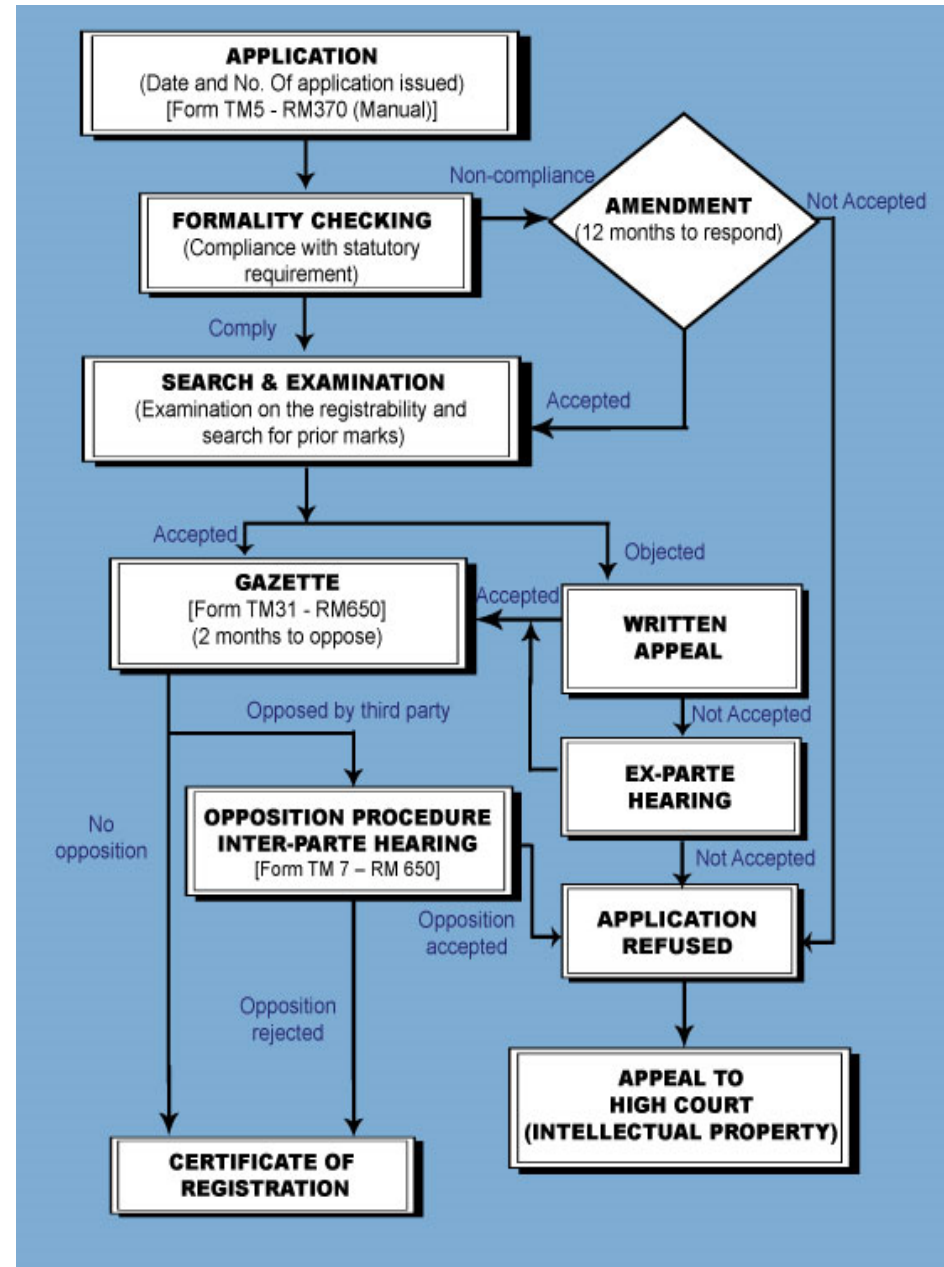
UPM Logo: Classes 9, 14, 18,16, 25, 38, 41

UPM Universiti Putra Malaysia (word) :  
Classes 9, 14, 16, 25,38, 41





# TRADEMARK APPLICATION



\* Please refer to Trade Marks Regulations for details procedures.

©

COPYRIGHT



*Goodyear Tire & Rubber Company & Anor. v. Silverstone Tire and Rubber Co. Sdn. Bhd.*  
[1994]

“Copyright laws are **not concerned with reproduction of ideas** however original they are **but are merely concerned with the reproduction of the forms in which the ideas were expressed**”

# Categories of Copyright Work

## *Literary Work*

- Includes any form of writings, play, dramas, script, pantomime, works of reference, lectures, sermon, letters, tables, compilation, computer program (excl. official texts of Government/ statutory bodies of legislative /regulatory in nature / judicial decisions)

## *Musical Work*

- Any musical work, & incl. works composed for musical accompaniment

## *Artistic Work*

- Graphic work, photograph, sculpture, collage irrespective of artistic quality; Architectural work (building / its model); work of artistic craftsmanship

## *Film*

- Fixation of a sequence of visual images on material of any description

## *Sound Recording*

- Any fixation of a sequence of sound excluding soundtrack

## *Broadcasting*

- Transmission by wire or wireless means

## *Derivative Work*

- Translation, adaptation, arrangement , collection of works / mere data that constitute intellectual creation

## “computer programs”

means an expression, any language, code or notation of a set of instructions (whether with or without related information) intended to cause **a device having an information processing capability** to perform a particular function either directly or after either or both of the following:

- (a) Conversion to another language, code or notation;
- (b) Reproduction in different material form



## **“Musical works”** means

any musical work, and includes works composed for musical accompaniment

## **“Artistic works”** means

- a) A graphic work, photograph, sculpture or collage irrespective of artistic quality;
- b) A work of architecture being a building or a model for a building; or
- c) A work of artistic craftsmanship

# “Derivative works”

- The following derivative works are protected as original works:
  - (a) translations, adaptations, arrangements and other transformations of works eligible for copyright; and
  - (b) collections of works or collections of mere data, whether in machine readable or other form, works eligible for copyright which, by reason of the selection and arrangement of their contents, constitute intellectual creation.

*arranged and selected in an original manner*

**\*No registration requirement; Automatic upon expression of idea / creation of work**

### **Literary, Musical & Artistic Work**

- Sufficient effort (skill, expertise & judgement)
- Work written down, recorded / otherwise reduced to material form
- Duration: Lifetime + 50 years

### **Films, Sound recording, Broadcast, Published editions**

- Duration: 50 years

- Derivative works: for collection of works / compilation of mere data in machine readable / other form: ~need to prove as an intellectual creation via selection & arrangement of the contents



Idea/  
Concept

Procedure

Math  
concept

Facts

Findings

Operational  
Method

Not Copyrightable

# Fair Dealing

- A permissible act done by a non-owner;
- Only for purposes of non-profit research, private study, criticism, review or the reporting of current events,
- if such use is public, it is accompanied by an acknowledgement of the title of the work and its authorship

# Good practice

- Write at the footnote:

1) *The Copyright Symbol* (either © ; (C); the word “Copyright”)

2) *The Year of the Creation*

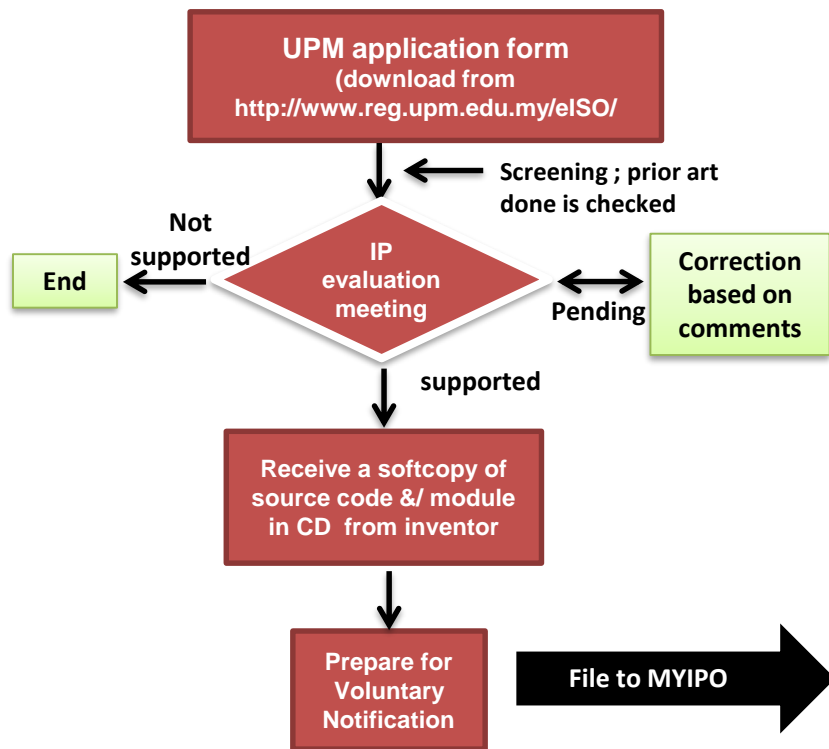
(when it was published. When it cover several years like blogs or course syllabus, can use hyphen to designate a range; eg “2005-2015”)

3) *The Name*

(use to identify yourself. Can also be business name, site name, pseudonym / any appropriate name that designates who the copyright holder is).

4) *A Rights Statement*

(“All Rights Reserved”[if don’t wish to allow copying]; may use Creative Commons license with “Some Rights Reserved”)



- Form CR1/CR2/CR3
- Statutory declaration
- Deposit the work
- Payment of fee
- One off- no renewal, only updating information
- ‘Sijil Pemberitahuan Hakcipta’ – prima facie evidence

## Copyright Voluntary Notification



# New Plant Varieties





Section 13(1)(b) of the Patents Act 1983:  
**plant or animal varieties or essentially biological processes for the production of plants or animals, other than man-made living micro-organisms, micro-biological processes and the products of such micro-organism processes, cannot be patented.**



# New Plant Varieties

Not under  
MyIPO, but  
MoA

New Plant  
Varieties Act  
2004

Variety: plant grouping of same species.

- Expression of the characteristics resulting from a given genotype / a combination of genotypes
- Distinguishable, plant grouping by the expression of characteristics
- As a unit with regard to its suitability for being propagated unchanged

Product of plant varieties resulted from:

i- grafting

ii- cross pollination

iii- genetic engineering

Condition	Requirements	Duration for Protection (From Date of Filing)
S. 14 (1) of PNPV Act 2004	New, Distinct, Uniform, Stable & of Suitable Denomination	Trees & vines: 25 yrs Other crops: 20 yrs
S. 14 (2) of PNPV Act 2004	New, Distinct, Identifiable & of Suitable Denomination for plant variety bred / discovered & developed by a farmer/ local community/ indigenous people	Trees & vines: 15 yrs Other crops: 15 yrs

## Novelty / New

If on the filing date of application:

- the propagating or harvested material has not been sold or otherwise disposed off on a **commercial basis** by or with the consent of the breeder :

- ~ within Malaysia earlier than one year (>1 yr),
  - ~ in other countries earlier than six years (>6 yrs)
- in respect of trees and vines and
- ~ earlier than four years (>4 yrs) in respect of other plant varieties

Disclosure



## Does not cover the following 6 acts done for:

(a) **Privately use** for a non-commercial basis;

(b) **Experimental** purpose;

(c) Breeding **other** plant varieties

(d) Propagation **by small farmers** using the harvested material of the registered plant variety planted, **on their own holdings**;

(e) **Exchange of reasonable amounts** of propagating materials among small farmers; and

(f) The **sale of farm-saved seeds** by small farmer who cannot make use of it **due to factors beyond the control** of the small farmer, if the amount sold < in his own holding.

(Size of a holding  $\leq$  2 hectares)



# Trade Secret

- any confidential business information
- provides an enterprise a competitive edge
- encompass manufacturing, industrial and commercial secret



FORMULA Design to a device  
RECIPE Piece of software  
General know-how

Listerine; WD-40; Lena  
Blackburne's Baseball  
Rubbing Mud  
KFC; Coke; Big Mac Special  
Sauce,  
Google's proprietary search  
algorithm, [PageRank](#).

Cadbury and Rowntree Candy espionage

DuPont Co.'s secrets for cleanly manufacturing  
the ubiquitous white pigment found in paper  
and plastics

# Trade Secret

- No procedural formalities for protection
- Protectable for unlimited time; provided the holder observe

## As a guideline:

Art. 39 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement):

- The information **must be secret** (i.e. it is not generally known among, or readily accessible to, circles that normally deal with the kind of information in question).
- It must **have commercial value** because it is a secret.
- It must have been **subject to reasonable steps by the rightful holder of the information to keep it secret** (e.g., through confidentiality agreements).

Source: WIPO, 2014



# SUMMARY of IP



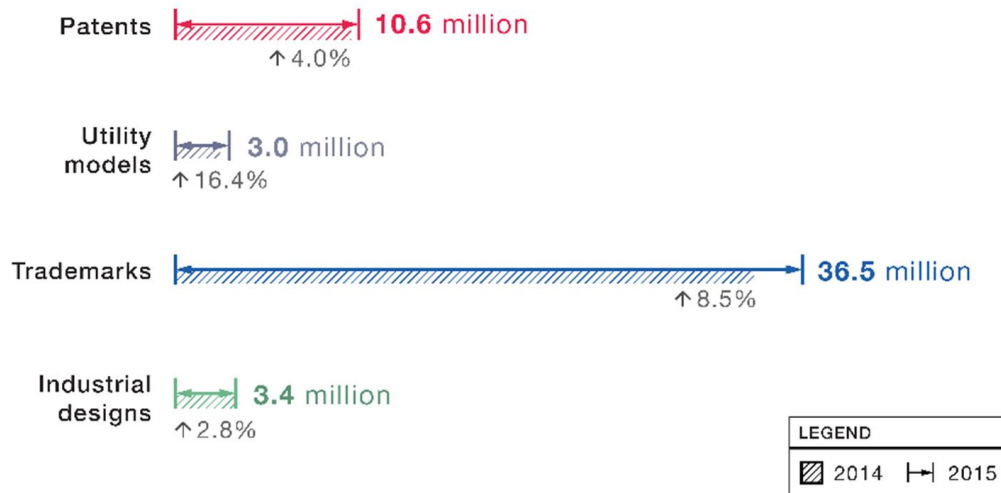
<i>Type of IP</i>	<i>Legislation</i>	<i>Salient Features</i>	<i>Duration of Protection / Registration</i>	<i>Beware</i>
<b><i>Patent</i></b>	Patents Act 1983	<ul style="list-style-type: none"> <li>▪ Solution to technical problem</li> <li>▪ Product or Process</li> </ul>	<ul style="list-style-type: none"> <li>▪ 20 years from date of filing</li> <li>▪ Require registration</li> </ul>	<ul style="list-style-type: none"> <li>▪ Disclosure defeat novelty (but with grace period: 12 months)</li> </ul>
<b><i>Industrial Designs</i></b>	Industrial Designs Act 1996.	<ul style="list-style-type: none"> <li>▪ Aesthetic designs of an article (non-functional aspect)</li> <li>▪ 2D: Colours, lines &amp; patterns</li> <li>3D: Shape &amp; surface</li> </ul>	<ul style="list-style-type: none"> <li>▪ 5 years (+ renewable 4 times): max .25 years</li> <li>▪ Require registration</li> </ul>	<ul style="list-style-type: none"> <li>▪ Disclosure defeat novelty (but with grace period : 6 months)</li> </ul>
<b><i>Copyright</i></b>	Copyright Act 1987	<ul style="list-style-type: none"> <li>▪ Literary, artistic &amp; musical works</li> <li>▪ Related rights: Film, sound recording, broadcast &amp; derivative work.</li> </ul>	<ul style="list-style-type: none"> <li>▪ Lifetime+ 50 years;</li> <li>▪ 50 years from the date of publication;</li> <li>▪ No registration; advisable to have voluntary notification or Statutory Declaration</li> </ul>	<ul style="list-style-type: none"> <li>▪ Cannot stop others from practising it</li> <li>▪ Can get copyright by infringing other's copyright.</li> </ul>

<b>Type of IP</b>	<b>Legislation</b>	<b>Salient Features</b>	<b>Duration of Protection / Registration</b>	<b>Beware</b>
<b>Trade mark</b>	Trade Marks Act 1976	<ul style="list-style-type: none"> <li>Words, device, symbol, logo, brand, signature, letters, numeral &amp; combination thereof.</li> </ul>	<ul style="list-style-type: none"> <li>10 years + renewable as long as used in the market.</li> <li>Advisable to register</li> </ul>	<ul style="list-style-type: none"> <li>Avoid descriptive mark for words, describing quality of goods or service; identical or similar mark in same class of goods or service</li> </ul>
<b>Geographical Indication</b>	Geographical Indications Act 2000	Sign used on product with geographical significance. Product bear unique characteristics linked to place of origin.	<ul style="list-style-type: none"> <li>10 years + renewable as long as used in the market.</li> <li>Advisable to register</li> </ul>	<ul style="list-style-type: none"> <li>Avoid arbitrary use of name of country, region or locality.</li> </ul>
<b>New Plant Variety Protection</b>	New Plant Variety Protection Act 2004	<ul style="list-style-type: none"> <li>New plant variety developed by plant breeders</li> </ul>	<ul style="list-style-type: none"> <li>Trees &amp; vines: 25 yrs; Other crops: 20 yrs</li> <li>When bred / discovered &amp; developed by a farmer/ local community/ indigenous people: Trees &amp; vines: 15 yrs; Other crops: 15 yrs</li> <li>Require registration</li> </ul>	<ul style="list-style-type: none"> <li>Avoid propagate protected new plant variety for commercial purpose.</li> <li>Not sold / disposed off on commercial basis: local &lt;1 yr; foreign &lt;6 yrs in respect of trees and vines and <ul style="list-style-type: none"> <li>~ &lt;4 yrs in respect of other plant varieties</li> </ul> </li> </ul>



<i>Type of IP</i>	<i>Legislation</i>	<i>Salient Features</i>	<i>Duration of Protection / Registration</i>	<i>Beware</i>
<i>Trade secret</i>	Common law (Confidential information law) & law of contract	<ul style="list-style-type: none"> <li>Valuable / material information unknown to public</li> </ul>	<ul style="list-style-type: none"> <li>As long as keep secret</li> <li>No registration</li> </ul>	<ul style="list-style-type: none"> <li>Sign non-disclosure agreement (NDA)</li> </ul>

There are now well over 50 million IP rights in force



### 3. IP rights in force

Source: WIPO Statistics Database, October 2016.

### Note:

- Who should determine the terms of the NDA?
- Where to obtain the draft NDA in UPM?
- Who has the authority to sign in UPM?

How the IP Rights  
exist?

UPM is empowered by the **Universities & University Colleges Act 1971 (Act 20)** to create a policy / guideline relating to Research & Innovation

(Zinatul & Norliah, 2013)

# Intellectual Property Rights

- *Owner/ Creator got exclusive rights:*
  - ~ for a legally prescribed duration
  - ~ to exclude / prohibit unauthorised use by others
  - ~ can sell, grant licence / rent with monetary consideration / royalty

*Protection within prescribed duration:*

- promote publication & dissemination of information / knowledge.
- Period expired ~ becomes public domain.



# Intellectual Property Rights

- *Owner/ Creator got exclusive rights:*

Are you an owner?

*Protection within prescribed duration:*

- promote publication & dissemination of information / knowledge.
- Period expired ~ becomes public domain.



# Ownership of IP

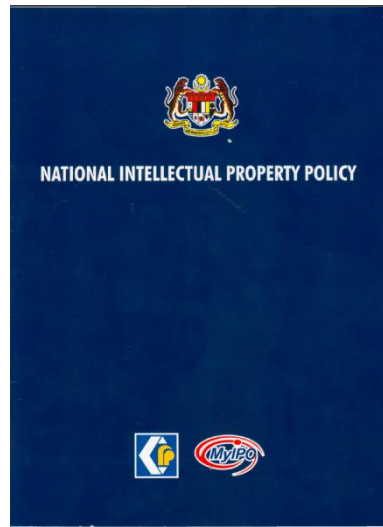
- Inventor may / may not be the owner
- *Non- owner:*
  - *Employee in the course of employment & within the scope of employee's duties*
  - *Employee using employer's facilities (subject to remuneration)*
  - *Person receiving commission*



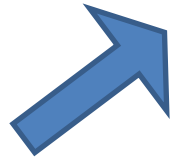
\*subject to any provisions to the contrary in the agreement between them

- Institutional policy on ownership

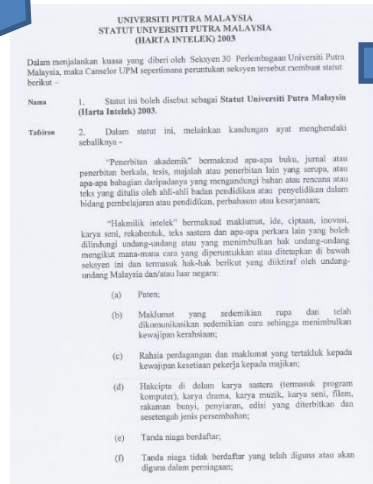
# National IP Policy



# The Legal Framework



# UPM IP Policies



Old





UNIVERSITI  
PUTRA  
MALAYSIA  
**(RESEARCH)**  
RULES

2012

## Rules Arrangement

Part A	Preliminary
Part B	Implementation and Management
Part C	Ethics and Disciplines in Research
Part D	Dissemination of Research Output and Confidentiality
Part E	Intellectual Property Right
Part F	Conflict of Interest and Its Disclosure
Part G	Misconduct
Part H	Miscellaneous

UNIVERSITI  
PUTRA  
MALAYSIA  
**(RESEARCH)**  
RULES  
2012



**PART E - INTELLECTUAL PROPERTY RIGHT**

7. (1) The right to the intellectual property generated through institutionalized research shall belong to the University. The right to the intellectual property produced or generated by the teacher, student or staff, or any other person including visitors involved in the programme of the University shall also belong to the University unless provided otherwise by these Rules or any other Rules of the University which is in force from time to time.
- (2) (a) Institutionalised research are:
- (i) research that involves the University as the main party to a research agreement;
  - (ii) research that utilizes the resources and expertise of the University in discharging the contractual obligations of the University with the other third party;
  - (iii) research that specifically utilizes fund or grant of the University;
  - (iv) research that utilizes facilities of the University and administered by the University;
  - (v) research that involves a group of teachers, students or staff for a long period of research.

**Generally, IP produced by the teacher, student or staff, & any other person incl. visitors involved in the University's programme shall belong to the University**

**Institutionalised research scope**

- (b) A teacher, student or staff who has been charged with the responsibility or instructed or employed to undertake the contractual obligation of the University shall be deemed to have undertaken such obligation on behalf of the University.
- (c) For the avoidance of doubt, a teacher, student or staff who has obtained the permission of the University to carry out research with other third party, in which the research is not an institutionalized research, the said teacher, student or staff shall bear any liability thereof personally without involving the University.
- (d) Any intellectual property right produced or generated from the activities of institutionalized research shall belong to the University.
- (e) A teacher, student or staff who has obtained permission of the University to carry out research with other third parties, and the said teacher, student or staff utilizes resources and infrastructure facilities of the University, then any intellectual property produced or generated from the research of the said teacher, student or staff thereof shall belong to the University.

Part E

Part E

- (f) Whether the rights to the intellectual property is claimed or owned or entitled to be owned by the University for the institutionalized research or uninstitutionalized research, the University has the right to have access to and may use the information resulting from the said research for academic purposes.

#### **Protection of the Intellectual Property Right of the University**

- (3) The right to the intellectual property produced or generated from the research owned by the University shall be protected in accordance with the law related to intellectual property, which is in force from time to time, by the University, including:-
  - (a) taking appropriate measures to protect the said intellectual property by way of patent, registration of trademark, registration of industrial design, protection of trade secret or by entering into any necessary agreement for the purpose of protection of such intellectual property right.
  - (b) not disclosing any information, data and discovery related to the research owned by the University to other third parties which may be prejudicial to the measures taken to protect the intellectual property right.

- (c) claiming and/or defending through litigation any infringement of intellectual property right belonging to the University.

#### Ownership of Intellectual Property Right of the University

- (4) (a) All intellectual property rights in research carried out by the teacher, student or staff including patentable rights, know-how, domain name or trade secret shall belong to the University.
- (b) The intellectual property right of the University may be shared with other third party with the permission of the University and an agreement containing terms relating to the sharing of such intellectual property right shall be entered into with the third party in accordance with the Rules relating to the intellectual property right of the University.
- (c) The intellectual property right relating to copyright produced by the teacher, student or staff for a work other than journal articles and books shall belong to the University and may be assigned to the said teacher, student or staff in accordance with the Rules relating to intellectual property right of the University.

Part E

Part E

#### Commercialisation of Intellectual Property Right of the University

- (5) (a) Only the University may commercialize the intellectual property rights of the University.
- (b) If the intellectual property right of the University is commercialized by the University, the University may consider the distribution of the profit of such commercialization with the teachers, student or staff who are the inventor of the intellectual property according to the rates prescribed by the University from time to time.
- (c) Teacher, student or staff shall give cooperation to enable University to commercialize the intellectual property right of the University and shall enter into any instrument relating to the obligation of the teachers, student or staff for purpose of such commercialization.

#### Misconduct

- (6) Any violation of the provisions relating to intellectual property right provided in paragraph 7 of these Rules by any teacher, student or staff shall amount to an act of misconduct in research which shall be dealt under paragraph 9 of these Rules.

**PART F - CONFLICT OF INTEREST AND ITS DISCLOSURE**

8. (1) Any situation of conflict of interest which may be encountered by a teacher, student or staff while carrying out research shall be avoided to preserve the integrity and honesty in the relationship among researchers and with the University.
- (2) conflict of interest is a situation in which the teacher, student or staff gains profit or personal interest either in real or by presumption, in research activities, in which such profit or interest, influences the conduct of his official duties.
- (3) In a situation where the teacher, student or staff:-
- (a) has any conflict of interest; or
- (b) unsure or doubtful whether there is a conflict of interest in the activity carried out;
- teacher, student or staff shall disclose the research activity together with the interest in the said research activity and refrain himself from further involvement in the research activity before the University permits it in writing.
- (4) Any conflict of interest and its disclosure shall be dealt in accordance with the Rules relating to the University's conflict of interest and disclosure.

Part F

**PART G - MISCONDUCT**

9. (1) An act amounting to misconduct in research under paragraph 4(4)(b), 5(3), 6(7), 7(6) and 8(5) may be taken administrative action by the University through Jawatankuasa Salahlaku Penyelidikan Universiti or may be taken disciplinary action by Jawatankuasa Tata tertib Universiti.
- (2) Any act held as misconduct under these Rules shall be the basis for denial to any claim of privilege or benefit awarded by the University on the achievement of the teacher, student or staff in research.

Part G


# UPMIP

- Visit [www.upmip.upm.edu.my](http://www.upmip.upm.edu.my)
- Register as 'Researcher' (login using UPM ID)
- Once approved, login (using UPM ID) and fill in the relevant Form
- Submit after correctly filled in all parts of the form



www.upmip.upm.edu.my

Gmail Putra UGroup Bernama Utusan Berita Mstar YouTube



**INTELLECTUAL PROPERTY CORPORATION OF MALAYSIA**

**REMINDER**

No.	Title	Project Leader	Faculty	Due Date	Status & Date
1.	Portable Aquaponics System	INDASTRI BIN SAION	FAKULTI REKABENTUK DAN SENIBINA		Drafting (20-07-2016)

**LOGIN**

Username

Password

Login Register

RSS | Dasar Privasi | Dasar Keselamatan | Penafian | Notis Hakcipta | Peta Laman | Bantuan | Copyright 2014 Universiti Putra Malaysia. All Right Reserved. Jumlah Pelawat: 5916758. Paparan terbaik menggunakan Internet Explorer, Safari, Firefox, Google Chrome dengan resolusi 800 x 600 dan 1024 x 768 (S). Kemaskini Terakhir: 17 Jul 2014

http://www.upmip.upm.edu.my/

UPM Intellectual Property

UPM

**FACTS & FIGURES**

**PATENT GRANTED**  
 Malaysia 129  
 Other Countries 106

**PATENT PENDING**  
 Malaysia 502  
 Other Countries 226

**PCT 118**

**COPYRIGHT PROTECTION**  
 Malaysia 78  
 Other Countries 0

**TRADE MARK GRANTED**  
 Malaysia 2  
 Other Countries 0

**TRADE MARK PENDING**  
 Malaysia 34  
 Other Countries 0

UPM Intellectual Property

Researcher

Utama

APPLICATION OF PATENT

APPLICATION OF COPYRIGHT

APPLICATION OF TRADE MARK

APPLICATION OF INDUSTRIAL DESIGN

APPLICATION OF NEW PLANT VARIETY

UPM Intellectual Property

Researcher

Utama

HOME

Main

List of IP

Application Form

My IP

My Reminder

My IP Presentation

User Setting

LOG OUT

IP Reminder

No	Title	Filing No	Project Leader	Faculty
*Latest session display				

IP Presentation

Agent

#	Title	Agency Name	Agent Name

# ***Recommended!***

- Plan your research journey to commercialization: Know the freedom to operate;
- Get the grants: RMC, TNCPI
- What's next after filing the IP?
  - ~ Licence, Next grant for prototype /upscaling, Innohub?
  - What is PSP's role?



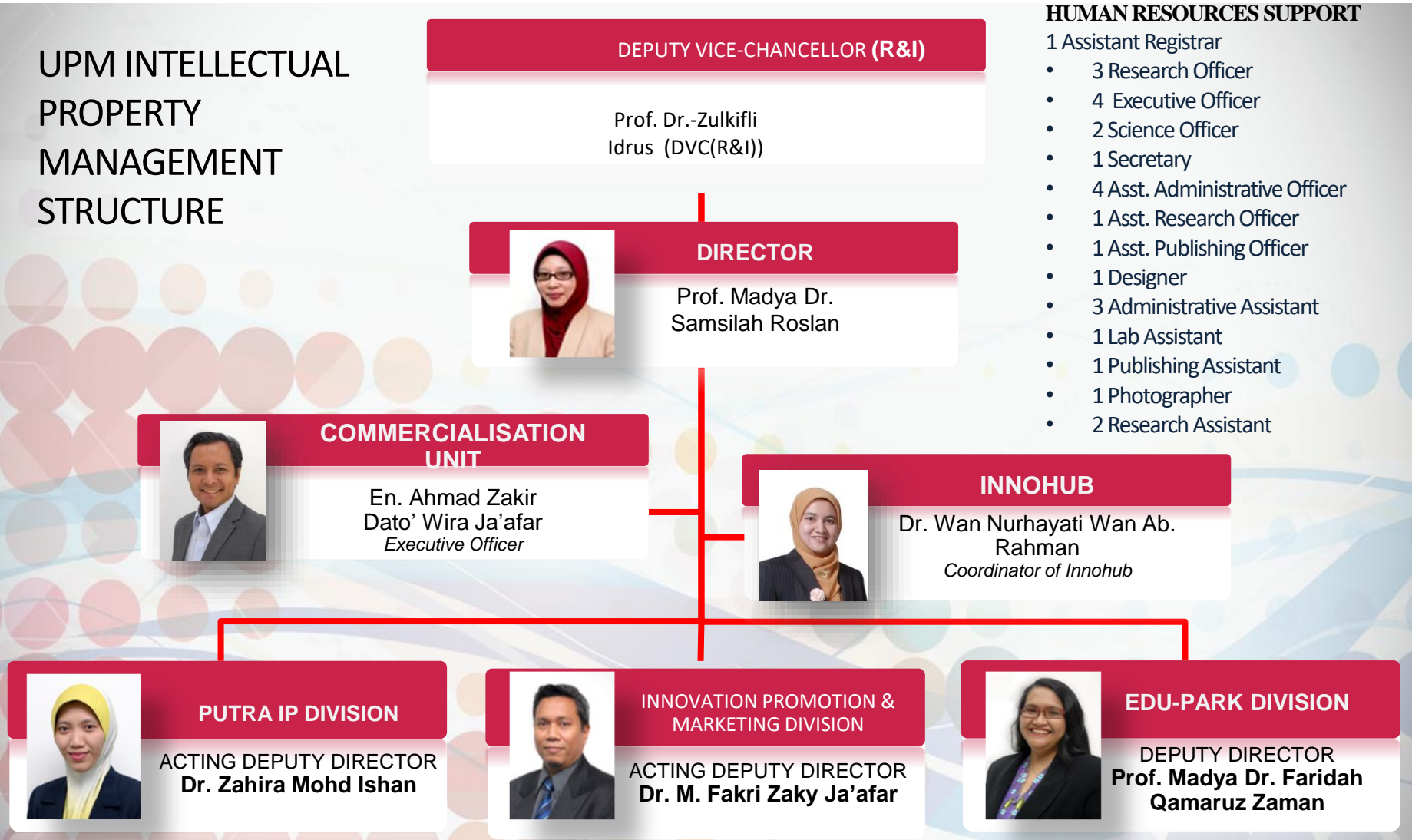
**UPM**  
UNIVERSITI PUTRA MALAYSIA  
BERILMU BERBAKTI

# PUTRA SCIENCE PARK (PSP) UPM's Technology Management Office



# INTELLECTUAL PROPERTY MANAGEMENT PROGRAM

## UPM INTELLECTUAL PROPERTY MANAGEMENT STRUCTURE



# FUNCTIONS OF PSP

## Administrative Division

- Commercial Consultancy Services
- Innovative Human Capital Development
- Coordinate accreditation, services & promotion of centralized equipments & facilities

## PUTRA IP Division

- Manage UPM's IP protection and maintenance
- Increase IP protection awareness
- Manage technology transfer process
- Manage and monitor licensing documentation

## Innovation Promotion & Marketing Division

- Promote and market UPM's research and innovation
- Manage IP Pre-Commercialization (C & D)
- Promote UPM's laboratory facilities and equipment
- Market Intelligence and Strategic Planning

## eDU-Park Division

- Manage and coordinate Edu-Park programs
- Promote and manage UPM R,D,C & E road to visitors





**UNIVERSITI PUTRA MALAYSIA**  
AGRICULTURE • INNOVATION • LIFE

*Thank You*

*Contact:*

**Putra IP Division  
Putra Science Park  
Office of DVC (Research & Innovation)  
Universiti Putra Malaysia**

***03-89471286***