



Intellectual Property Policy Universiti Teknologi Malaysia



RESEARCH MANAGEMENT CENTRE
UNIVERSITI TEKNOLOGI MALAYSIA



CERTIFIED TO ISO 9001:2015
Registration No. 2246

Anugerah MPKSN
Institusi Penyelidikan dan
Pembangunan Tahun 2000

Intellectual Property Policy

Universiti Teknologi Malaysia

UTM/RMC/P/001

Research Management Centre
1999

The Intellectual Property Policy has been approved by the University Senate on 2 March 1999
And subsequently endorsed by University Board of Directors on 1 April 1999.

CONTROLLED DOCUMENT

UNIVERSITI TEKNOLOGI MALAYSIA

Intellectual Property Policy

Part 1 Introduction and Objectives

This policy seeks to establish a sound framework for the encouragement of high quality research, invention, creative work and technology transfer. The policy sets out how Universiti Teknologi Malaysia (UTM) proposes to manage intellectual property rights and issues so as to best meet its policy objectives.

UTM's objectives with regard to intellectual property are :

- To create the climate for innovation and invention;
- To provide a framework whereby staff and students are stimulated to identify, protect and exploit potentially valuable research results and other creative work and successfully to engage in technology transfer;
- To create a better understanding of the various rights which the law provides for the protection of creative effort and thereby stimulate the proper protection of the UTM's economic investment in that effort;
- To allow for various forms of commercial exploitation of intellectual property created within UTM;
- To provide financial incentives for individuals, groups, faculties and organisational units to encourage research and to develop and pursue commercial projects;
- To recognise partial rights of students to intellectual property emanating from original research at postgraduate level which will be assigned or licensed to UTM in exchange for being included in research programmes.

UTM reserves the right to modify or add this policy at any time provided that any such change will only apply to works, inventions and other subject matter, in which intellectual property rights subsist, that come into being after the effective date of the change.

Part 2 Definitions

For the purpose of this policy, '*Intellectual Property*' means and includes:

- Patents for inventions granted under the Patents (Amended) Act 1995 and the Regulation made thereunder.

- Copyright as governed by the Copyright Act 1987, Copyright (Amendment) Act 1990 and the Regulations made thereunder which cover 'literary and artistic works'. The forms in which such works are expressed may be words, symbols, music, pictures, three-dimensional objects, or combinations thereof.
- Trademark as governed by Trade Marks Act 1976 and the Regulations made thereunder.
- Industrial designs as governed by the United Kingdom Designs (Protection) Act 1949 for Peninsular Malaysia, United Kingdom Designs (Protection) Chapter 152 for Sabah and Designs (United Kingdom) Ordinance Chapter 59 for Sarawak.
- Confidential information and trade secrets including background and foreground information.

'University' means Universiti Teknologi Malaysia and abbreviated as UTM.

'Staff Member' means and includes all academic, research and general staff or any person who is employed by UTM pursuant to a contract of employment, whether full-time, part-time, contract, sessional or casual, excluding contractors. This also includes persons invited to participate in the research programme of the University as a visiting fellow or research fellow.

'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 form 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 commercialisation of any intellectual property. Income accrued after apportioning all dues to any other third party where applicable.

'University Resources' are defined as all tangible resources provided by UTM to its staff/originators, including office, laboratory, studio space and equipment; computer hardware, software, and support; secretarial service; research, teaching, and 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 staff/originator.

'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.

'Computer Software' is defined as a set of statements or instructions to be used directly or indirectly in a computer to bring about certain result.

'Intellectual Property Committee' is defined in Part 9 of this policy.

'Student' means an enrolled student, as defined by Universities and University Colleges Act (Amendment 1996) / Act A946 as amended or replaced from time to time, who creates a work in which there is intellectual property, in the course of studies or research at the University.

Part 3 Ownership of Intellectual Property Principles

- 3.1 Except as otherwise agreed in writing or stated in this policy, the University claim ownership of all intellectual property, created by staff members in the course of their employment.
- 3.2 The University owns worldwide right, title and interest in any invention made at least in part by University staff, or with substantial use of University resources, and unless otherwise agreed, this policy applies to any invention conceived or first reduced to practice under terms of contracts, grants or other agreements whether or not the staff remain employee of the university.
- 3.3 The University will not assert any right or claim ownership of any intellectual property scholarly books, articles, audiovisuals, lectures or other such scholarly work or subjected-matter generated by researchers or academic staff, other than that specifically commissioned by the University. The University reserves the right to use such works or subject matter for the purpose of its teaching and research.
- 3.4 The University will assert ownership of University commissioned lecture notes, courses, radio broadcasts, audio-visual material and the like which have been developed to further its teaching function pursuant to specific commissions in favour of one or more researchers.
- 3.5 The University will not assert any right or claim of ownership of the intellectual property in artistic works, musical, dramatic or other creative works written, created or composed by researchers or staff, unless these works have been specifically commissioned by the University.

- 3.1 Postgraduate students may be required to enter into an agreement which permits the University to obtain the rights to certain intellectual property which may be generated by them in the course of their studies or research. Such an agreement shall, whenever possible :
- a) be made prior to the student commencing the study or research;
 - b) be explained to the student; and
 - c) treat the student no less favourably than originators who are employed by the University.
- 3.2 The University reserves the right, prior to the student participating in any research project in which University staff are also involved or in which University equipment, facilities or resources will be used or as a condition of the student's continued participation in any such project, to require the student to assign to the University any intellectual property arising or subsisting in or in respect of any invention, work or other material that the student may author, invent or create in the course of working on that project.
- 3.3 Where the University owns intellectual property created by students, the University will ensure that such ownership does not interfere with the assessment of the student's academic performance or the grant or an award. The University will not normally consider assisting a student to patent an invention or otherwise commercialise intellectual property originated by the student unless the student is prepared to assign the patent rights or other intellectual property rights to the University in accordance with this policy.

Part 4 Agreements With Third Party

- 4.1 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.
- 4.2 In negotiating such an agreement with third parties, the University shall ensure :
- a) that the originators are consulted at all stages;
 - b) that the terms of the agreement are consistent with the principles set out in the other provisions of this policy.

- 4.1 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.

Part 5 Exploitation of Intellectual Property

- 5.1 Where a staff member creates University intellectual property, other than that to which the University will not claim ownership, which in his/her opinion capable of commercial exploitation, he/she shall report its existence to the Chairman of the Intellectual Property Committee. Students will follow procedures outlined in any applicable assignment or licensing agreement that they have entered into with the University.
- 5.2 Follow consultation with the staff member, the Intellectual Property Committee shall determine whether the University wishes to become involved in the exploitation of any University intellectual property which is reported or is otherwise brought to notice.
- 5.3 The University reserves the rights to commercialise the intellectual property, and shall undertake the appropriate action to be taken. This may include, but not limited to, one or more of the following :
- a) undertake the appropriate measures to protect the intellectual property;
 - b) the identification of potential licenses;
 - c) the assignment of the rights to a third party;
 - d) the formation of a limited liability company to exploit the technology start up company (subject to separate negotiation).

In the event that the University does not wish to commercialise the intellectual property, the University shall assign its right of the intellectual property ownership to the inventor.

- 5.3 Where the University decides to be involved in the exploitation of University intellectual property, the staff member(s) shall provide all reasonable assistance in the exploitation process by, for example, providing information promptly on request, attending meetings with potential licensees and advising on further development.

Part 6 Income Distribution

- 6.1 Where the University derives any financial return from the commercial exploitation of intellectual property, with the exception of theses for higher degrees, it shall be distributed in accordance with the provision set out in 6.2, unless otherwise specified in agreed contractual arrangement specific to the commercialisation.
- 6.2 After deducting all reasonable costs of protecting, marketing and administering the intellectual property, Net Revenues received by the University shall be distributed as follows :
- | | | |
|----|--|-----|
| a) | Originator/Researcher | 60% |
| b) | University Research Fund | 20% |
| c) | Organisational unit within the University from
Which the intellectual property originates | 20% |
- 6.3 At the request in writing from an originator, the Intellectual Property Committee is empowered but not obliged to vary the distribution of the annual Net Revenues so as to allow room for negotiation on the above distribution in 6.2.
- 6.4 Where the University derives payment from the supplying or selling copies of theses, the payment will be distributed as follows :
- | | | |
|----|--------------------------------|-----|
| a) | Perpustakaan Zultanah Zanariah | 35% |
| b) | Faculty | 35% |
| c) | University Research Fund | 20% |
| d) | School of Graduate Studies | 10% |

Part 7 Moral Rights

- 7.1 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.
- 7.1 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.

- 7.1 Where an originator wishes not to be acknowledge 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.

Part 8 Dispute Resolution

- 8.1 If a dispute arises as to the operation of this policy, or as to any matter on which the operation of this policy relies, the Intellectual Property Committee shall appoint a mediator to assist the parties in resolving their dispute.
- 8.2 If such a dispute cannot be resolved through the assistance of a mediator, the Intellectual Property Committee shall appoint an arbitrator to investigate and decide the matters in dispute. The arbitrator may adopt whatever procedure ha or she deems appropriate, provided each party is given a fair hearing.
- 8.3 In selecting a mediator or arbitrator, the Intellectual Property Committee shall, as far as is reasonably practicable, choose a person who is acceptable to all parties.
- 8.4 The decision of the arbitrator shall be reported to the Intellectual Property Committee without undue delay and the Intellectual Property Committee shall as soon as is practicable convey the decision to the parties to the dispute.
- 8.5 The parties to the dispute shall have the right of appeal against the decision of the arbitrator on the grounds of unfair hearing or a denial of natural justice, only. Any appeal shall be made to the Vice-Chancellor in writing within 30 days of receipt of the decision of the arbitrator.
- 8.6 The Vice-Chancellor shall consult with the parties to the dispute, the arbitrator and such other persons as the Vice-Chancellor shall decide, and shall make a determination on the outcome of the appeal without undue delay.

Part 9 Intellectual Property Committee

- 9.1 The Senate shall appoint The Intellectual Property Committee that have the following membership :

- a) The Deputy Vice-Chancellor (Academic) as Chairman
- b) Dean of Research Management Centre
- c) Director of Innovation and Consultancy Bureau
- d) Dean of School of Graduate Studies
- e) Chief Executive Officer of Uni-Technologies Sdn. Bhd.
- f) Librarian
- g) One representative from post-graduate student, appointed by the student union
- h) Three other persons appointed by the Senate.

The quorum shall be 50% of the committee members.

9.2 The terms of Reference of the Intellectual Property Committee shall be :

- a) To oversee the implementation of this policy, especially the requirements regarding information and education;
- b) To assist in the resolution of disputes;
- c) To conduct a review of this policy at periodic intervals, or as circumstances demand, and make recommendations regarding appropriate changes;
- d) To decide on the commercialisation of the intellectual property;
- e) To set down guidelines, procedures and criteria for reporting to the University, the creation, commercialisation, unauthorised use or infringement of intellectual property to which this policy applies;
- f) To provide advice to the University Senate on intellectual property issues generally.

Part 10 Information and Education

10.1 Upon adoption of this policy, the University shall take all reasonable steps to ensure that it is communicated and explained to staff and students.

10.2 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;
- c) To generate a better understanding of intellectual property issues in general, and so contribute to the creation within the University of a more co-operative and productive environment for teaching, learning and research.

Part 11 Policing and Infringement

- 11.1 This policy may be implemented or supplemented in any way consistent with its terms and those of other University policies.
- 11.2 This policy shall not apply to existing written agreement between the University and/or creator(s) and any external organisation or individual, concerning the development, legal protection, or commercialisation of specific intellectual property, and entered into prior to the date of which this policy is adopted by the University's Senate.
- 11.3 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 organisations 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 authorisation, in connection with any invention.
- 11.4 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.

RESEARCH MANAGEMENT CENTRE
UNIVERSITI TEKNOLOGI MALAYSIA