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PART 1. INTRODUCTION

1.0 Objectives

- 1.1 Universiti Tunku Abdul Rahman (UTAR) is founded on the philosophy of creation, advancement and dissemination of knowledge. In pursuit of this, UTAR places high importance and value on research and development activities whether conducted by UTAR staff, or in collaboration with third parties.
- 1.2 Recognising that these R&D activities may result in the creation of new inventions, technologies and discoveries which may have potential benefits to the community and society at large as well as command commercial interests, this Policy seeks to establish a clear framework for the encouragement of discoveries and development of new knowledge and inventions, as well as their applications and transfer to industry for the benefit of the public and society. Among others, this Policy aims to achieve the following:
 - (a) to establish and enhance the environment and incentives for the creation and development of new knowledge, innovations and inventions at UTAR;
 - (b) to recognize and protect the interests of individual creators, relevant sponsors of research and scholarships as well as UTAR's creative efforts;
 - (c) to optimize the commercial advantage of the new knowledge, inventions and the Intellectual Property for the mutual benefit of all involved; and
 - (d) to bring the fruits of such research and development into practicable use for the benefit of society as effectively and quickly as possible.

2.0 Implementation

- 2.1. This IP Policy is applicable to all full and part time staff and students of Universiti Tunku Abdul Rahman, including adjunct, visiting and other fixed term or temporary appointees.
- 2.2. This Policy also applies to consultants and other persons generating IP in collaboration with UTAR staff or students, or are engaged by UTAR to undertake a specific activity. It may also apply from time to time to other persons by agreement.
- 2.3 The President is empowered to make exemptions from any section of this Policy as he deems appropriate.
- 2.4 The decision of the President is final on all matters regarding the interpretation of this Policy and related matters.

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- 2.5 The Intellectual Property Management Committee (IPMC) with the assistance and support of the Department of Consultancy and Commercialisation (DCC) shall be responsible for the management and administration of this Policy.

3.0 Intellectual Property Management Committee (IPMC)

- 3.1 To ensure that inventions and creations of UTAR staff and students are managed efficiently and provide optimum benefits to UTAR and the inventors, IP management and commercialisation are amongst the main responsibilities and functions of the Intellectual Property Management Committee (IPMC). The IPMC in turn shall report to the Senior Management Committee (SMC).

- 3.2 Members of IPMC shall consist of:

- Chairman: 1. Vice President in charge of Research
Members: 2. Vice President in charge of Academic Affairs
3. Director, Institute of Postgraduate Studies and Research
4. Director, Division of Finance
5. Head, Department of Consultancy and Commercialisation (DCC)
6. Registrar
7. One academic staff member (with ranking of Associate Professor and above) appointed by the President

Secretariat: Department of Consultancy and Commercialisation

- 3.3 Terms of reference of IPMC in relation to IP management and commercialisation are:

- 3.3.1 Formulate policy guidelines for University Intellectual Property policies for SMC and ensure the implementation of such policies
3.3.2 Commercialisation of research findings after SMC's approval
3.3.3 Consider and recommend any MoUs and agreements pertaining to research collaboration and commercialisation activities for President's approval.

- 3.4 To assist IPMC in performing its responsibilities in relation to commercialisation and IP matters, the Department of Consultancy and Commercialisation shall, amongst others, conduct the following functions:

- 3.4.1 Formulate plans and strategies for IP development and management
3.4.2 Coordinate the implementation of IP policy and strategies
3.4.3 Conduct preliminary assessment and evaluation of inventions
3.4.4 Negotiate, manage and protect UTAR IP rights, benefits and contracts
3.4.5 Optimise the commercialisation of inventions and enhance business development
3.4.6 Upkeep and manage an IP Database

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- 3.4.7 Provide IP training, promote IP awareness, publish and distribute IP materials
- 3.4.8 Monitor any infringement activities and enforce the rights of the University.

3.5 Role of the Department of Consultancy and Commercialisation (DCC)

The DCC is the focal point for any commercialisation efforts and IP matters in UTAR. To ensure the optimum commercialisation of UTAR inventions, it plays the vital role of assuring the effective liaison between inventors and industries, IP offices / agents, IPMC and the senior management of UTAR at all times. In order for it to play its role effectively, DCC upkeeps the databank of IP rights owned by UTAR, as well as maintains a databank of experts in UTAR in their respective fields. It also maintains good working relationships with the industries and IP offices as well as acts as the UTAR resource centre for information related to all IP matters.

4.0 Interpretations and Definitions

For the purpose of this Policy, the following interpretations and definitions shall apply:

- 4.1 “**Author**” means an employee of UTAR, whether academic or administrative and support staff, or another physical person associated with UTAR, who has created a Work, an Industrial Design or a Layout-Design of an Integrated Circuit.
- 4.2 “**Work(s)**” means literary, scientific, technical, dramatic, musical, artistic, architectural work or material and any original production within the purview of the Copyright Act, with the exception of Software.
- 4.3 “**Breeder**” means an employee of UTAR, whether academic or administrative and support staff, or another physical person associated with UTAR, who has developed a new plant variety.
- 4.4 “**Invention**” means any new and useful process, formula, machine, product or composition of matter, within the purview of the Patent Act.
- 4.5 “**Inventor**” means any employee of UTAR, whether academic or administrative and support staff, who is defined as such under patent legislation. In this Policy, the term “Inventor” shall also be used in reference to development of Software. The word “Inventor” shall also include a visiting professor or other non-UTAR staff, temporarily working or doing research at UTAR.
- 4.6 “**Software**” means any set of instructions that is expressed, fixed, embodied or stored in any manner and that can be used directly or indirectly in a computer in order to bring about a specific result.

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4.7 “**Intellectual Property**” (IP) is defined as discoveries, inventions, know-how, show-how, processes, unique materials, copyrightable works, original data and other creative or artistic works which have value. IP includes that which can be protected by statute or legislation and includes physical embodiments of intellectual efforts and which appears capable of being patented and has or is likely to have potential for commercial exploitation in the interests of UTAR, the community and the nation.

4.8 “**Intellectual Property**” includes, but is not restricted to the following:

- (a) patents;
- (b) copyrights;
- (c) trademarks;
- (d) industrial designs;
- (e) layout designs of integrated circuits;
- (f) plant varieties;
- (g) tangible research property
- (h) know-how and confidential information/trade secrets

4.8.1 “**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 specific problem. An invention is patentable if it is new, involves an inventive step and is industrially applicable.

4.8.2 “**Copyright**” is the exclusive right given to the owner of a copyright for a specific period. Copyright protection in Malaysia is governed by the Copyright Act 1987. A work that is eligible is protected automatically upon fulfilment of the following conditions:

- sufficient effort has been expended to make the work original in character;
- the work has been written down, recorded or reduced to a material form;
- the author is qualified person or the work is made in Malaysia or the work is first published in Malaysia

The subject matter of copyright works is primarily concerned with scholarly work, research, published work, artistic expression, creativity, or academic debate.

“**Scholarly Work**” has its natural meaning and includes amongst others, scholarly books, chapters of books, journal articles, conference papers, textbooks, artistic works or other academic works authored by UTAR staff or student.

The basic rule of copyright is that the author of a work is the first copyright owner. One of the exceptions to this basic rule is where an

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employee or a student makes copyright works as defined herein in pursuance to the terms of his employment under a contract of service or apprenticeship and in such an event, ownership of copyright is vested in the employer.

As a policy, UTAR has the first right of ownership of the copyright but allows the staff or student to publish academic papers in reputable journals, conference proceedings or other publications after seeking permission from UTAR on condition that no commercial benefit is received by the staff or student.

- 4.8.3 A “**Trademark**” is a sign which distinguishes the goods and services of one trader from those of another. A sign includes words, logos, pictures, names, letters, numbers or a combination of these. Trademarks serve to identify the trade origin of goods or services, i.e. the trademark informs the public that a particular product or service is the product or service of the owner of the trademark.

The Trade Mark Act 1976 and Trade Mark Regulations 1997 (Amendment 2001) confers protection on registered trade marks only. Unregistered trade mark may still obtain protection under Common Law by virtue of use and reputation. “Passing off” action against an infringer can still be instituted.

- 4.8.4 An “**Industrial Design**” is the ornamental or aesthetic aspect of an article. The design may consist of three-dimensional features such as the shape and configuration of an article, or two-dimensional features, such as pattern and ornamentation. The design features must be applied to an article by any industrial process or means of which the features in the finished article appeal to eye.

- 4.8.5 A “**Layout Design of an Integrated Circuit**” is the three-dimensional disposition of the elements of an integrated circuit and some or all of the interconnections of the integrated circuit or such three-dimensional disposition prepared for an integrated circuit intended for manufacturing. The law that protects layout-designs of integrated circuits is the Layout-designs of Integrated Circuits Act 2000.

- 4.8.6 A “**Plant Variety**” means any living organism in the plant kingdom (but excludes any micro-organism) within a single botanical taxonomy of the lowest known rank which can be defined by the expression of the characteristics resulting from a given genotype or a combination of genotypes.

- 4.8.7 “**Tangible Research Property**” refers to those research results in a tangible form and consists of items like materials, drawings, integrated circuit chips, computer software, computer and other databases, processes,

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prototypes and circuit diagrams, and includes but is not limited to, biological materials or physical devices.

- 4.8.8 “**Know-how and Confidential Information / Trade Secret**” refer to all information or data of a confidential nature (including oral and visual information or data and/or recorded in writing or by any other method and all information which UTAR is under an obligation, whether contractual or otherwise, not to divulge) whether or not such information or data is specifically designated as “Confidential” or with words having like effect.

Confidential information/trade secret is information, including a formula, pattern, compilation, program device, method, techniques, or process, that:

- (a) derive independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means, by other persons who can obtain economic value from its disclosure or use;
 - (b) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.
- 4.9 “**Originator**” refers to the person who contributed intellectually to the creation of the IP and shall include author, breeder and inventor.
- 4.10 “**Spin off**” companies refer to companies set up as a result of an invention or companies formed specifically to commercialise an invention.
- 4.11 “**DCC**” refers to the Department of Consultancy and Commercialisation of Universiti Tunku Abdul Rahman.

PART 2. OWNERSHIP OF INTELLECTUAL PROPERTY (IP) RIGHTS

Notwithstanding the clauses below, the IP creator shall remain as the originator of the IP even though UTAR shall be the owner of the IP as a result of the originator’s employment or contract of service signed between UTAR, the originator and any third parties concerned.

5.0 IP Created by Staff

- 5.1 Unless otherwise agreed, UTAR shall be the absolute owner of all IP created, invented or developed by all persons either in the course of their employment as part of their duties or in fulfilment of their contract of employment with UTAR or through the use of UTAR resources. It includes IP created on business trips or studies overseas.

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- 5.2 As a general rule, the rights of the IP created by UTAR staff during their term of employment shall belong to UTAR even when the originator later leaves UTAR for whatever reasons.
- 5.3 In particular, UTAR shall claim ownership of IP rights developed by its staff in the following circumstances:
 - 5.3.1 When there is use of the University resources
 - 5.3.2 Where UTAR funds are used to specifically support the development of the IP.
 - 5.3.3 When the intellectual property is created by a team involving at least one UTAR staff member.
- 5.4 An originator who leaves UTAR shall continue to share in distributable royalties (if any) arising from IP made while at UTAR.
- 5.5 UTAR asserts ownership of educational and course materials as well as creative and scholarly works created or developed for specific purposes.
- 5.6 Under this Policy, UTAR also asserts the right to retain a copy of any such materials or works for its own use and to meet record-keeping requirements. Staff members must provide copies of such course and educational materials if requested to do so by their supervisor, Head of Department, Dean, a member of the Senior Management of UTAR, or the President.
- 5.7 All IP developed by staff in their own capacity and in their personal time which are neither connected with UTAR research nor developed with the use of UTAR resources, and which do not fall under paragraph 5.3 shall belong to such staff as originators.
- 5.8 When a staff believes that an IP has been conceived, he should immediately notify the Head of the DCC by completing the IP Disclosure Form (**FM-DCC-005**).
- 5.9 Staff who has resigned shall be required to make a final disclosure of any IP not previously disclosed to the Director of Human Resources at the exit interview. A copy of such disclosure, if any, shall be extended to the Head of DCC.

6.0 IP Created by Students

- 6.1 All IP developed by students in their own capacity and in their personal time which are neither connected with UTAR research nor developed with use of UTAR resources and which do not fall under paragraph 5.3 shall belong to such students.
- 6.2 Students shall own the copyright of their theses/project work.
- 6.3 As a condition of candidature, however, UTAR reserves the right, to retain the original or copy of any drawings, models, designs, plans and specifications, essays, theses or other work executed by a student as part of his course of study,

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or submitted for any award or competition conducted by UTAR. Such retention shall not affect any copyright or other IP right that may exist in such student work.

6.4 Where a student's supervisor makes a contribution to the creation of IP, the IP shall be owned jointly by the student and UTAR.

6.5 If a student participates in creating an IP owned by UTAR:

- (a) the student shall share in the net commercialisation revenues, if any, with all other creators/inventors according to prevailing UTAR policies;
- (b) the student shall retain copyright in his thesis/project; and
- (c) the student must not be impeded in submitting a thesis/project report for examination and completing requirements for the award of a degree or other relevant award.

6.6 When a student believes that an IP has been conceived, he should immediately notify the Head of DCC by completing the IP Disclosure Form (**FM-DCC-005**).

7.0 IP Created from Research Collaboration with External Parties

7.1 A written agreement on IP ownership, rights and management must be negotiated between UTAR with the grant / sponsorship / collaborative body or any other external party prior to the commencement of work on the funded / collaborative project. The Head of DCC shall have the responsibility to represent UTAR in these negotiations, guided by the principles given in **Schedule 1**.

7.2 UTAR staff shall ascertain that any collaborative work carried out does not commit to the disclosure or transfer to the company/third party, of any IP belonging to UTAR.

7.3 In any collaborative work, UTAR staff shall not breach the confidentiality obligations to which he is subject by virtue of being an employee of UTAR.

7.4 UTAR staff engaged in external collaborative work shall be responsible for ensuring that agreements emanating from such work are not in conflict with UTAR policy or with UTAR contractual commitments.

8.0 IP Created by or in Collaboration with Visiting, Adjunct or Other Appointees

8.1 Unless otherwise stated in an agreement, the provisions of **Schedule 1** shall apply.

8.2 The provisions of any contract or agreement in writing between UTAR and an external third party shall govern ownership of all rights in IP that arises out of or in connection with the project that is the subject of that agreement, despite any contrary provisions in this Policy.

8.3 All contracts and agreements between UTAR and third parties, which exist at the time this Policy is adopted and which relate to IP, shall remain in full force despite any contrary provisions in this Policy.

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9.0 Pre-existing Intellectual Property

Upon commencing employment with UTAR, staff members are responsible to declare existing IP that they have created prior to the staff member's employment with UTAR. These IPs shall be excluded from this policy.

PART 3. CONFIDENTIALITY

10.0 Confidentiality

- 10.1 Staff and students shall at all times maintain confidentiality of all UTAR research and inventions, and related information and know-how, whether developed individually, or acquired through formal or informal discussions, in collaboration with other UTAR colleagues.
- 10.2 The above confidentiality obligations **shall not** apply if:
 - (a) the disclosure is required by law
 - (b) the information is in the public domain
 - (c) the prior written consent of UTAR has been obtained.
- 10.3 UTAR may require the recipient of IP information to enter into a legally binding confidentiality agreement with UTAR or impose other such terms and conditions as it deems fit prior to giving consent for the disclosure of the information.

PART 4. DISCLOSURE, EVALUATION AND COMMERCIALISATION OF IP

11.0 IP Disclosure

- 11.1 Upon the creation of an IP, staff and students shall, without undue delay:
 - 11.1.1 disclose to DCC in sufficient detail to enable the DCC to make an assessment of the impact of the IP.
 - 11.1.2 disclose the identity of any party interested in the commercial exploitation of the IP.
 - 11.1.3 assign to UTAR the IP created, and execute all appropriate documentation and provide assistance to enable UTAR to:
 - (a) perform its full legal right, title and interest in and to the IP; and
 - (b) secure, maintain, enforce and defend all patents, trademarks, copyrights and other legal protection available to the IP.

12.0 IP Evaluation and Commercialisation

- 12.1 Where a staff or student believes that an IP has been created, he should immediately notify the Head of DCC in writing, by completing and submitting the IP Disclosure Form (**FM-DCC-005**) which includes among others, a description of the IP, pertinent

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sketches or drawings, relevant data, and an explanation of the operation and performance principles of the IP.

- 12.2 Staff and students are required to disclose and submit a completed IP Disclosure Form to DCC before publishing any information regarding the IP, since any publication pertaining to the IP may prejudice any potential IP rights.
- 12.3 Upon receipt of an IP Disclosure Form, DCC shall conduct a preliminary assessment of the IP. If the assessment indicates that the IP warrants more serious examination, then DCC shall seek the approval of IPMC to consult independent experts, conduct a search, undertake market and /or commercial feasibility assessment and studies or undertake any action necessary for determining the viability of patenting and/or licensing or other forms of commercialisation of the inventions as well as conduct preliminary negotiations with interested parties on the commercialisation of the IP.
- 12.4 DCC shall evaluate the technical and economic merits of each disclosure, and subsequently table at the IPMC for consideration and recommendation to the Senior Management Committee for approval to file for IP protection. The process flow is given in **Attachment 1**.
- 12.5 The staff or student shall maintain confidentiality at all times with regards to the details of the IP, particularly during the period UTAR is assessing the viability of patenting and/or licensing and/or commercialisation of the IP.
- 12.6 The Head of DCC shall advise the staff or student in writing normally within one (1) month from the date of receipt of the IP Disclosure form whether UTAR intends to exploit the IP disclosed, or otherwise. DCC may, after getting approval of SMC, extend the one-month assessment period to a maximum of three (3) months.
- 12.7 When UTAR decides to exploit the IP disclosed, the following clauses shall apply:
 - 12.7.1 Any staff or students involved in the creation of the IP, whether as an originator, an owner or otherwise, are taken to have agreed that UTAR has an irrevocable authority to act on their account and to execute any document that UTAR decides as necessary for the purposes of commercial exploitation of the IP, consistent with the objectives of this Policy.
 - 12.7.2 The staff or students must comply with all reasonable directions and provide all reasonable assistance in the processes involved, including maintaining the confidentiality of the information of the IP, providing information promptly on request; attending meetings with potential licensees; and advising on further development.
 - 12.7.3 UTAR may consult, on a confidential basis, with appropriate experts and advisers, before deciding on the appropriate action in relation to the exploitation of the IP. That action may include, but is not limited to:

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- (a) requesting assistance and advice on patenting, funding and other aspects of the commercialisation of the IP;
- (b) the filing of a IP protection application in the name of UTAR with the staff or student named as originator;
- (c) the identification of potential licensees;
- (d) the assignment of rights to a third party.

12.7.4 UTAR shall use all reasonable endeavours to pursue the exploitation of UTAR IP in a timely manner.

- (a) UTAR shall be entitled to approach, negotiate and enter into any binding IP agreement with any third party on such terms and conditions as UTAR, being the legal and beneficial owner of such IP, shall at its sole and absolute discretion, deem fit.
- (b) UTAR shall be entitled to assign rights or grant licences, whether exclusive or otherwise, in respect of the IP for such periods as it shall deem fit, or make such other arrangements relating to such IP as it may deem appropriate, in order to facilitate technology transfer while protecting the rights of UTAR and the originators.
- (c) UTAR may use any means whatsoever, as it shall at its sole and absolute discretion deem fit, to protect any IP owned by UTAR, including but not limited to instituting proceedings concerning patent and licence infringements.
- (d) The originators shall provide all information and render all assistance to UTAR in all phases of the IP protection application and/or commercial exploitation of the IP, as UTAR may from time to time require, including but not limited to, the assessment of the IP, making amendments to the specification and claims of the IP protection applications, negotiations with third parties for the licensing of the IP, and any proceedings concerning IP protection and licence infringements.

13.0 Return of IP to Originators

- 13.1 If UTAR decides not to retain the IP rights for protecting and/or licensing and/or other forms of commercial exploitation, the staff or student and/or the sponsor shall be entitled to undertake measures to protect and/or licensing and/or other forms of commercially exploiting procedures on the IP, provided that the staff or student and/or sponsor agrees that UTAR shall be entitled to a percentage of the royalties and/or fees and/or any benefits generated by the exploitation of the IP. Such percentage shall be discussed and agreed by the parties concerned on a case-by-case basis.
- 13.2 In consideration of UTAR agreeing not to retain the IP rights for protecting and/or licensing and/or other forms of commercial exploitation, the staff or student shall enter

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into an agreement with UTAR on the matter stating the terms and conditions applicable.

- 13.3 If UTAR agrees to assign or license the IP to the staff or student upon commercial terms or terms approved by UTAR, any exploitation of IP by staff or student after IP has been assigned or licensed to them shall be at their own risks and at their own expenses.
- 13.4 The originators shall promptly keep the DCC informed of any IP protection, including commercialisation of the IP. He shall be responsible to inform the DCC on an annual basis, all benefits received by him for distribution.
 - 13.4.1 The originators shall submit to the DCC an annual report in the format required by the UTAR, and keep the DCC informed of the status of each and every IP application filed in connection with the IP.
 - 13.4.2 The originators shall disclose, furnish or otherwise make available to the DCC all information relating to or in connection with such IP applications and/or commercial exploitation of the IP, as and whenever requested by the DCC.
- 13.5 UTAR may request for the IP to be returned to UTAR if the originators fail to commercialise the IP after three (3) years from the date the IP is handed over to the originators.

PART 5. SHARING OF PROCEEDS OF COMMERCIALISATION

14.0 Sharing of Commercialisation Benefits

- 14.1 While UTAR may be the sole or shared owner of an IP right, the originator shall still be entitled to a proportion of benefits, in cash or non-cash form or both, if UTAR so decides to exploit the IP commercially.
- 14.2 The sharing of commercial benefits shall be based on the net revenue arising from the commercial exploitation of UTAR IP as given in **Schedule 1**.
- 14.3 UTAR shall endeavour to distribute the share of net revenue to all parties entitled to it within 90 days from its receipt. However, UTAR shall not be liable to pay any interest for any late or deferred payment due to the parties concerned.
- 14.4 In the event that there is more than one originator, the originators shall have the right to agree to any form of distribution amongst themselves. In the absence of such an agreement, UTAR shall pay the originators' share of net revenue in equal portions to each of the originator. However, UTAR's limit of revenue sharing shall be subject to the rates in **Schedule 1**.

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15.0 Other Benefits

- 15.1 In the likelihood that there arise other benefits accorded in the commercialisation in the form of non-cash consideration, including but not limited to shares, securities, property both tangible and non-tangible or other benefits in kind, shall to the extent practicable and reasonable be valued in good faith for their monetary value and distributed according to the above mentioned rates.
- 15.2 In the event that such non-cash benefits are unable to be valued for its money's worth for any reason, the parties concerned shall negotiate in good faith a mutually agreed distribution of the benefits. In all circumstances, UTAR shall not be obliged to appoint a third party valuer for the purpose.

16.0 Directorship of Spin-Off Companies

Subject to policies and terms and conditions that may be issued by UTAR from time to time, UTAR employee originators may be allowed to accept appointment as non-executive directors in spin-off companies formed to commercialise their IP, subject to prior approval by UTAR.

PART 6. OTHERS

17.0 Conflict of Interest

- 17.1 Staff and students shall, without undue delay, make full and frank disclosure of their interest in the commercialisation of an IP. In general, staff or students who are directors of, or shareholders in the organisation, firm or company which intends to commercialise the IP, shall be deemed to be interested in commercial exploitation of the IP.
- 17.2 Conflict of interest may also arise in various situations relating to technology transfer interactions particularly with the industry. To minimise or prevent such situations from arising, staff shall make full and frank disclosure to, and seek approval of UTAR in the following situations:
 - 17.2.1 deployment of students to do product and/or process research and development for a UTAR staff or his company. This includes a staff member supervising final-year projects and higher degree students working on thesis topics;
 - 17.2.2 transmitting to company information that is not made generally available. This includes withholding or reducing publications after transferring technology to the company, or failing to attend to industry visitors from competing companies;

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- 17.2.3 undertaking or changing the orientation of his research whether supported by UTAR funds or external grants, to serve the research, product development or other needs of the company;
- 17.2.4 using his position at UTAR to participate in the company's activities without authorisation from UTAR;
- 17.2.5 purchasing equipment, instruments, materials or other items for UTAR teaching and/or research from the company in which the staff has an interest;
- 17.2.6 funding by the company of UTAR research projects related to the licensed technology with supervision by the staff;
- 17.2.7 engaging in consultation with a company in which the staff or any person related to him (including without limitation, his parent, spouse, brother, sister, son, daughter, or any person who is holding legal title for the benefit of the staff) has an interest, whether legal, beneficial or otherwise.
- 17.3 In the event of potential conflict of interest, staff or students shall, without undue delay, make full and frank disclosure and seek the written approval of UTAR.
- 17.4 UTAR reserves the right to impose disciplinary or other actions as it deems fit at its sole and absolute discretion, should staff or students fail to declare and/or seek written approval from UTAR concerning their interest in the commercial exploitation of the IP.

PART 7. PROCEDURES

This Part seeks to describe the administrative procedures within UTAR on IP management.

18.0 General Obligation to Report IP

Where any IP to be owned by the UTAR, which is likely to be commercially significant is created, any originator, Dean/Director or other officer who becomes aware of the creation, commercialisation or unauthorised use or infringement of that IP shall promptly inform the Head of DCC in writing of all relevant details of the IP, including but not limited to:

- (a) the date upon which the IP was created;
- (b) the identity of any person or persons who contributed to the creation of the IP;
- (c) the details of any pre-existing IP which was used in creating the IP;
- (d) whether any person other than the originator claims any entitlement or interest in the IP;
- (e) the details of any UTAR facilities or resources used to create the IP, (especially including grant monies or other research funding);

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- (f) the details of any known existing or partial use or commercial exploitation of the IP;
and
- (g) the details of any provisional patent application that may have been filed with regard to the IP.

19.0 Duty Not to Act Contrary to UTAR's Rights

A student or member of employee shall not apply for any form of protection for or commercialise or otherwise deal with any IP, or do any act or thing in a manner inconsistent with UTAR's rights under this policy or otherwise.

20.0 Duty to Consult

Where action is to be, or has been, taken to protect the IP which is likely to be commercially significant, the originator shall consult with the Head of DCC with regard to undertaking in a timely fashion the work necessary to complete the relevant formalities and facilitating the commercialisation of the IP.

21.0 Filing of a Complete Patent Application is Conditional

UTAR shall not normally file a complete patent application unless during the currency of the provisional application a third party undertakes to meet the expected costs of completion of the Malaysian application and/or overseas filings, or the Director of DCC determines a strategy for further development leading to the commercialisation of the IP, including how the costs of patent protection will be met.

22.0 Copyright

22.1 Moral Rights

22.1.1 Acknowledgment of Authorship

22.1.1.1 In the case of a copyright work owned by UTAR pursuant to this policy which UTAR publishes or causes to be published:

- (a) without adaptation or other modification, UTAR shall ensure that the authorship of the work is acknowledged in the publication; or
- (b) with adaptation or other modification, UTAR shall consult with and obtain the agreement of the originator and the adaptor of the work on whether the authorship of the work is to be acknowledged and if so the form of the acknowledgment.

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22.1.1.2 If no agreement exists, UTAR shall be allowed to publish the copyright work, and shall make any form of acknowledgement in a manner deemed appropriate by the University.

22.1.2 UTAR to Bind Others to Acknowledge Authorship

22.1.2.1 Where UTAR proposes to assign or license a copyright work, UTAR shall consult with the originator of the work as to whether UTAR shall ensure that a term of the assignment or licensing agreement requires the purchaser or licensee to acknowledge authorship of the work and if so, the form of the acknowledgment.

22.1.2.2 In cases where there is no acknowledgement made by the purchaser or licensee, UTAR may request such acknowledgement again. However, in the event when that this is not possible, the originator shall need to accept the fact that no such acknowledgement can be made.

22.1.3 Withdrawal of Attribution

22.1.3.1 Where an originator wishes not to be acknowledged as the creator of IP, which has been modified or adapted, UTAR shall take reasonable steps to respect that wish, and to ensure that others respect it.

22.1.4 Modification of Copyright Works

22.1.4.1 Where UTAR uses IP created by an originator, it shall take reasonable steps to consult with the originator before modifying or adapting that IP.

22.1.4.2 If the originator cannot be contacted and/or is not available, UTAR shall have absolute discretion to modify or adapt that IP.

22.2 Need for a Statutory Declaration

22.2.1 As there is no requirement of registration for copyright protection, the use of statutory declaration is highly recommended to attest the works created within UTAR. However, staffs are not expected to declare every piece of work via a statutory declaration. Such declaration is however required for the following works:

(a) Computer Programs developed in UTAR;

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- (b) Publication of any written materials or information for commercial purposes or having any trade secret and confidential information belonging to UTAR (for e.g. business proposals, technical write-ups and drawings, R&D reports and marketing materials etc.);
- (c) Any other form of work as may be determined by the IPMC from time to time.

22.2.2 If any of the above work is created, the procedure for copyrighted protection should be observed.

23.0 Procedure for IP Disclosure and Protection Application in UTAR

23.1 Any UTAR originator (who is the project leader) or employee who wishes to request for IP protection must submit the following forms:

23.1.1 For all types of IP (except Trade Mark):

(a) Intellectual Property (IP) Disclosure Form (**FM-DCC-005**),

and depending on the type of IP protection, any one of these:

- i. Request For Patent Protection (**FM-DCC-005A**)
- ii. Request For Industrial Design Protection (**FM-DCC-005B**)
- iii. Disclosure For Copyright Protection (**FM-DCC-005C**)
- iv. Disclosure For Layout-Design of Integrated Circuit Protection (**FM-DCC-005D**)
- v. Request For Plant Variety Protection (**FM-DCC-005E**)

23.1.2 For Trade Mark:

(a) Application For Trade Mark Registration (**FM-DCC-012**)

23.2 The originator/employee is first required to complete all the related forms and submit them to his Dean or Director.

23.3 Having received these, the Dean or Director will consider the application and make his or her recommendations to the DCC.

23.4 Upon getting the approval from the Dean or Director, the application will be forwarded to DCC for processing.

23.5 DCC will do a preliminary investigation on the novelty and commercialisation potential aspect of the IP.

23.6 DCC will make recommendation and submit the report to IPMC.

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23.7 The IPMC will then deliberate on the application and decide on the merit of the application.

23.8 If approved by IPMC, for:

23.8.1 Patent, Industrial Design, Plant Variety and Trade Mark Protection

23.8.1.1 DCC will engage designated IP Agent to conduct a formal novelty search.

23.8.1.2 The designated IP Agent will submit a novelty search report to DCC.

23.8.1.3 The originator/employee will be provided with a copy of the novelty search report.

23.8.1.4 The originator/employee is required to comment if the novelty search report contains unfavourable opinion from the IP Agent.

23.8.1.5 DCC will make recommendation and submit the novelty search report to IPMC.

23.8.1.6 IPMC will then deliberate on the application and decide on the merit of the application.

23.8.1.7 If approved by IPMC to proceed with IP protection, DCC will engage the designated IP Agent to draft the IP Specification and proceed to submit the IP protection application.

23.8.2 Copyright Protection

23.8.2.1 The author is required to complete the Statutory Declaration (**FMM-DCC-015**) in triplicate and have them signed by the Dean or Director before a Commissioner for Oaths with copy of the work attached.

23.8.2.2 Two copies of the Statutory Declaration (together with a copy of the work created) must be submitted to DCC.

23.8.2.3 DCC will file a voluntary notification at The Intellectual Property Corporation of Malaysia.

23.8.3 Layout-Design of Integrated Circuit Protection

23.8.3.1 The author is required to complete the Statutory Declaration (**FMM-DCC-015**) in duplicate and have them signed by the Dean or Director before a Commissioner for Oaths with copy of the layout-design attached.

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23.8.3.2 One copy of the Statutory Declaration (together with a copy of the layout-design created) must be submitted to DCC.

23.8.4 Trade Secret Protection

23.8.4.1 DCC will ensure that the access to the IP is restricted and is based on the need to know basis.

23.9 The flow chart associated with the IP disclosure and protection procedure is given in Figure 1.

23.10 Academic Thesis Containing Patentable Information

23.10.1 Patentable information can arise from projects undertaken as postgraduate projects, where academic thesis will be written for examination. To safeguard the interest of the industrial partner and employee, the following outlines the steps taken to withhold a student's thesis containing information, which may be used in a patent application:

- (a) the employee concerned informs IPSR and the Head of Department concerned when the subject matter dealt with in a thesis is being considered for a patent, and requests UTAR to withhold public access to the thesis;
- (b) IPSR will inform the examiners and request that the thesis is of a confidential nature and not be freely circulated. IPSR will also withhold the thesis from being placed and catalogued in the library;
- (c) IPSR will inform the industrial partner that the subject matter of the thesis is being considered for a patent and UTAR will withhold public access to thesis.
- (d) the employee concerned will be given 3 months to make a disclosure and a patent application according to the procedures as outlined herein. If UTAR, upon appraisal, decides to proceed with the application, the thesis will be withheld until such time the patent filing date is issued. In the event, however, that the employee fails to apply for the patent within the period specified and an acceptable request to justify an extension of 'cold storage' is not received, the thesis will be released in accordance with the normal procedures of IPSR.

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24.0 Procedure for Public Disclosure

- 24.1 In the event an originator wishes to disclose any research findings be it in the form of a journal article, conference paper or in any other form including but not limited to drawings, diagrams, photos etc. for any purpose whatsoever including but not limited to publishing in any website etc., the originator shall make a written request for such public disclosure to DCC in the given format in Public Disclosure Request Form.
- 24.2 Such application should be made at least two (2) weeks BEFORE submission for acceptance of the article, paper to any body or organisation. Disclosure before filing an IP protection application prejudices any potential IP rights.

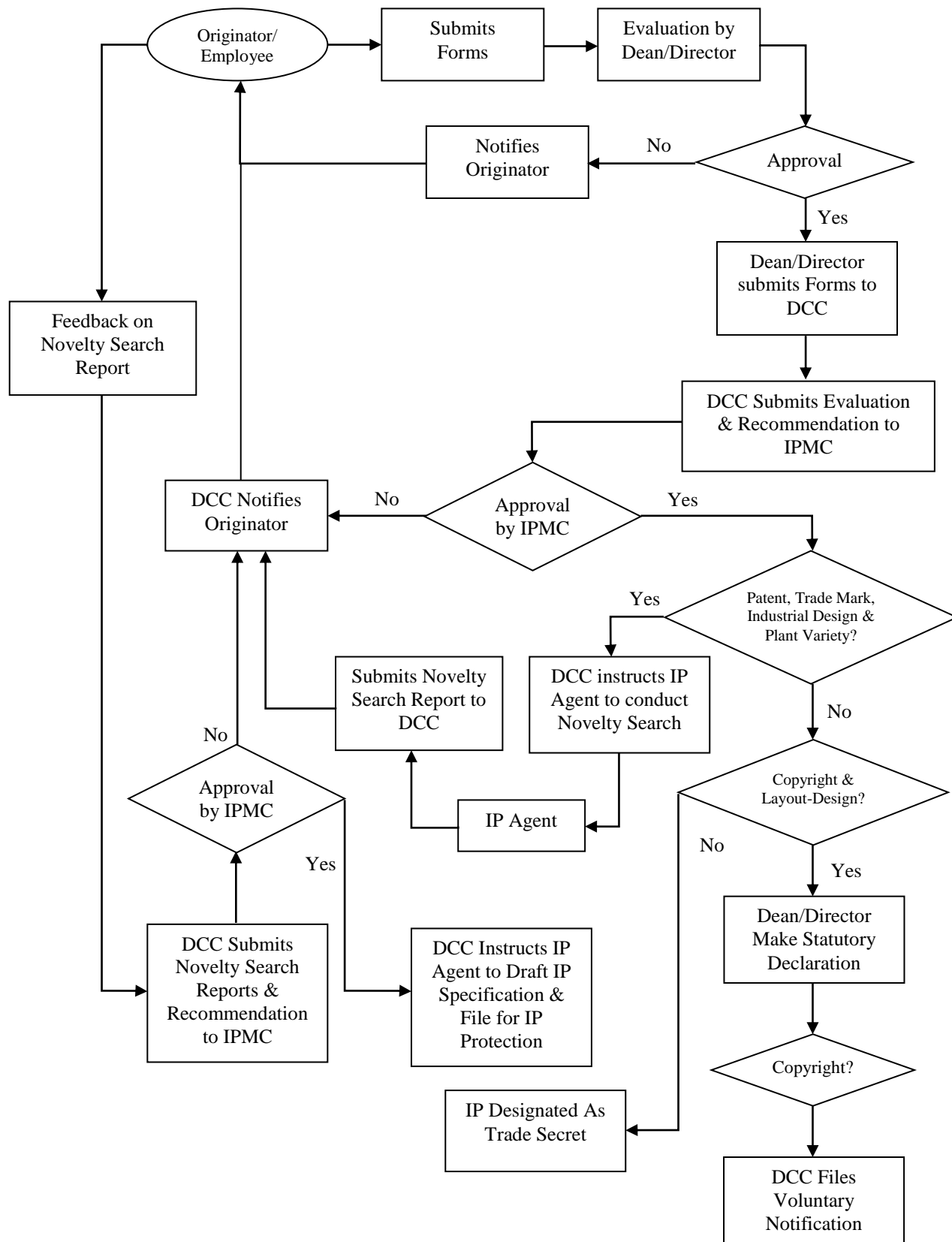


Figure 1: IP Disclosure and Protection Procedure

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PART 8. GENERAL

25.0 Monitoring

It is also important for UTAR to monitor for infringement activities as well as key points to note when enforcing UTAR's IP rights. DCC shall be responsible for monitoring any infringement activities and recommend enforcement actions to IPMC and SMC.

26.0 Dispute Resolution

26.1 Mediation

- (a) In the event of a dispute, controversy, claim or difference of whatever nature arising out of the implementation or operation of the UTAR IP Policy, or in any way relating to the UTAR IP Policy, the UTAR-IPMC 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.
- (b) The mediator shall adopt whatever procedure he deems appropriate in the mediation process provided all parties concerned are given a fair hearing.
- (c) The cost of mediation, if any, shall be borne equally by all parties.

26.2 Arbitration

- (a) In the event the dispute, controversy, claim or difference is not settled, the matter shall, after due consideration by the IPMC, 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, DCC shall serve a notice to that effect on the parties.
- (b) In selecting an arbitrator, the IPMC shall, as far as is reasonably practicable, choose a person who is acceptable to all parties. Where the parties are not able to agree to appointment or where one party fails or refuse to act or is reluctant to act, then the other party or parties may within thirty (30) days from the date 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.
- (c) 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.

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- (d) The language to be used in the arbitral proceeding shall be in English and findings and award, if any, of the arbitrator shall be final and binding on the parties.
- (e) The cost of the arbitration incurred shall be borne equally by all parties.

27.0 Amendments

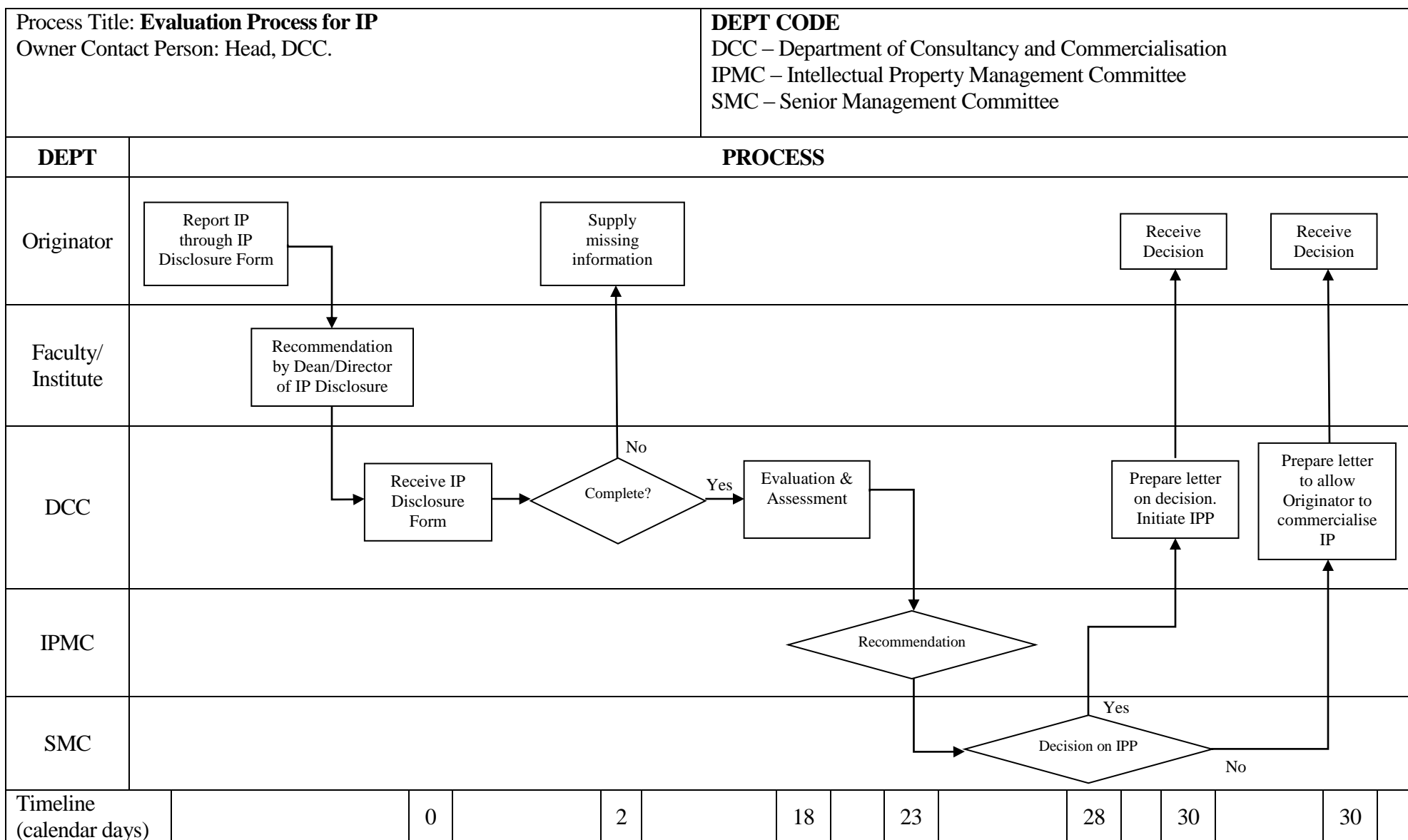
The provisions in this policy may be amended by UTAR from time to time .to bring it in line with any amendments to the UTAR IP Policy and UTAR shall undertake to notify employees as soon as is practicable of the amendments so made. In any case, the amendments shall be in full force and effect on the date the amendments have been announced by UTAR to take effect.

28.0 Waiver

UTAR shall have the discretion to waive any or all of the provisions of these rules in a particular case. A waiver on one occasion and for a particular case shall not be deemed to be a waiver of the same or any other provision on a future occasion or for a future case.

29.0 Overseas and International Applications

Staffs are reminded that various International IP Treaties and Conventions apply to Malaysia including the enforcement of the Patent Co-operation Treaty (PCT) on the Malaysian patent system. Hence applications for international patents need to take cognizance of the PCT system patent lifecycle; the patent strategy; the budgeting strategy; and the filing strategy for protecting UTAR IP outside Malaysia. Refer to the Department of Consultancy and Commercialisation for further details on the PCT application process and PCT filing Chronology.



IP Ownership and Apportionment of Commercialisation Revenue

Unless otherwise defined in a specific agreement, ownership of IP and any commercialisation revenue resulting from the IP shall be distributed according to the formula below:

1.0 When IP is created by UTAR Student

In the event that more than one student is involved, the apportionment set for student below shall be divided among all or according to the agreement amongst the students themselves.

1.1 Research Fully Funded By UTAR

a) When the idea comes from the student:

Apportionment	University (%)	Student (%)
IP ownership	100	0
Net Revenue Distribution	50	50

b) When the idea comes from the supervisor:

Apportionment	University (%)	Student (%)
IP ownership	100	0
Net Revenue Distribution	90	10

1.2 Research Fully Funded By External Party

a) When the idea comes from the student:

Apportionment	University (%)	Student (%)	Ext Party (%)
IP ownership	Joint	0	Joint
Net Revenue Distribution	25	25	50

b) When the idea comes from the supervisor:

Apportionment	University (%)	Student (%)	Ext Party (%)
IP ownership	Joint	0	Joint
Net Revenue Distribution	45	5	50

1.3 Research Co-funded By University and External Party

a) When the idea comes from the student:

Apportionment	University (%)	Student (%)	Ext Party (%)
IP ownership	Joint	0	Joint
Net Revenue Distribution	(University contribution/ total funding) $*0.50*100$	(University contribution/ total funding) $*0.50*100$	(Ext party contribution/ total funding) $*100$

b) When the idea comes from the supervisor:

Apportionment	University (%)	Student (%)	Ext Party (%)
IP ownership	Joint	0	Joint
Net Revenue Distribution	(University contribution/ total funding) $*0.90*100$	(University contribution/ total funding) $*0.10*100$	(Ext party contribution/ total funding) $*100$

1.4 Not Funded by University

a) When the idea comes from the student:

Apportionment	University (%)	Student (%)
IP ownership	0	100
Net Revenue Distribution	0	100

b) When the idea comes from the supervisor:

Apportionment	University (%)	Student (%)
IP ownership	Joint	Joint
Net Revenue Distribution	50	50

1.5 Apportionment to Supervisor

Apportionment	University (%)	Supervisor (%)
IP ownership	100	0
Net Revenue Distribution	50	50

As a proportion of the University's share arising from 1.1 to 1.4 above

2.0 When IP is created by UTAR Staff

2.1 Research Fully Funded By UTAR

Apportionment	University (%)	Staff (%)
IP ownership	100	0
Net Revenue Distribution	50	50

2.2 Research Fully Funded By External Party

Apportionment	University (%)	Staff (%)	Ext Party (%)
IP ownership	Joint	0	Joint
Net Revenue Distribution	25	25	50

2.3 Research Co-funded By University and External Party

Apportionment	University (%)	Staff (%)	Ext Party (%)
IP ownership	Joint	0	Joint
Net Revenue Distribution	(University contribution/ total funding) *0.50*100	(University contribution/ total funding) *0.50*100	(Ext party contribution/ total funding) *100

2.4 Not Funded by University

Apportionment	University (%)	Staff (%)
IP ownership	100	0
Net Revenue Distribution	50	50