

Date Policy Introduced	2011
Date of Review	2013
Contact Office	Office of the Deputy Vice-Chancellor (Research and Innovation)
Related legislation and policies	<ul style="list-style-type: none"> • Trade Marks Act 1976 • Copyright Act 1987 • Patents Act 1983 • Protection of New Plant Varieties Act 2004 • Geographical Indication Act 2000 • Industrial Design Act 1996 • Layout Design of Integrated Circuits Act 2000 • Agensi Inovasi Malaysia Act 2010 • UKM Student Intellectual Property Policy (Supplementary) • UKM Intellectual Property Commercialisation Policy (Supplementary) • Intellectual Property Commercialisation Policy For Research & Development (R&D) Projects Funded By The Government Of Malaysia (June 2009) • National Intellectual Property Policy (2007)
Supporting documents and forms	<ul style="list-style-type: none"> • Invention Disclosure Form • Confidentiality Agreement • UKM Associate Deed of Assignment • Notice Relating to Independent Legal Advice

1. PURPOSE OF POLICY

- 1.1 This Policy applies to all associates of UKM. It sets forth UKM policies in relation to Intellectual Property (IP) arising from Associates' participation and contribution to research projects and activities undertaken at UKM.
- 1.2 This Policy, along with UKM Intellectual Property Policy, UKM Student Intellectual Property Policy (Supplementary) and UKM Commercialisation Revenue Policy (Supplementary) forms part of UKM Intellectual Property Policy framework.

2. DEFINITIONS

For the purpose of this Policy, the following definitions are used:

- 2.1 "Teaching Material" means all works in which copyright subsists which are used by Employee of UKM for teaching purposes and includes all information, documents, materials or digital items in any form created or used for the purposes of teaching and education at UKM. This includes but is not limited to lecture notes that are made available to Students, computer-generated or overhead projector presentations (such as powerpoint presentations), assignments, tutorial problems and solutions, photographs, images, sound recordings, video recordings, musical scores and the related contents of course websites.
- 2.2 "Administrative Material" means any material or document, including policies, business plan, contracts, applications for research grants and/or collaboration, reports, promotional brochures and software that has been developed for the purposes of UKM administration, performance evaluation, marketing as well as legal services.
- 2.3 "Other Financial Assistance" means other means/avenue of funding and does not include External Research Grant.
- 2.4 "External Research Grant" means any financial assistance funded by external organisation, either locally or internationally and does not include financial assistance or research grants funded by UKM, either in form of cash or in kind.
- 2.5 "Non-exclusive rights, royalty-free and perpetual licence" means for the duration of the applicable intellectual property, the Originator grants

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non-exclusive rights to UKM to reproduce and distribute those works (and does not include commercial purpose), without paying any royalty to the originator of the intellectual property. The rights may be exercised in all forms of media, including any future new forms created thereafter.

- 2.6 “Legal Rights” means all rights recognized under any of the statutes relating to copyright, patents, industrial design, trademarks, geographical indications, layout design of integrated circuits and new plants varieties.
- 2.7 “Intellectual Property” (IP) means all forms of intellectual property protected under the laws of Malaysia or other legislations on IP such as copyright, patents, industrial design, trademarks, geographical indication, layout designs of integrated circuits, new plant varieties, know-how and confidential information.
- 2.8 “Home Institution” means the institution which the UKM Associate has primary connection with.
- 2.9 “Commercialisation Expectation” means UKM or its representatives has an expectation that it will manage the commercialisation of the IPs.
- 2.10 “Equitable Interest” means an interest held by virtue of an equitable title (a title that indicates a beneficial interest in property and gives the holder the right to acquire formal legal title) or claimed on equitable grounds, such as the interest held by a trust beneficiary. The equitable interest is a right in equity that, if violated (suffers a harm), is subject to satisfaction by an equitable remedy.
- 2.11 “Commercialisation” means to use, manufacture, assign, license, franchise, market or otherwise use the IP for the purpose of generating income or other financial returns.
- 2.12 “Originator” means creator or author of IP.
- 2.13 “Confidentiality Agreement” means an agreement which creates a confidential relationship between UKM, Originator and/or Associate. By entering into this agreement, the parties must not disclose all confidential information that would be detrimental to UKM to other third parties.
- 2.14 “Associate” includes but not limited to research collaborators, visiting researchers, consultants, fellows, entrepreneur-in-residence or any

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other person, entity or body corporate invited by UKM for academic or research purposes and does not include Employee and Student of UKM.

2.15 “UKM” means Universiti Kebangsaan Malaysia.

3. APPLICATION OF POLICY

This Policy is applicable to all Associates and is not applicable to Salaried Fellows who are considered as Employees of UKM.

4. PARTICIPATION OF UKM ASSOCIATES IN RESEARCH

4.1 UKM encourages participation of Associates in research projects and activities. UKM recognises that Associates may participate in research projects or activities which:

- i. are funded by any research grants, where UKM may or may not have contractual obligations;
- ii. revolve around pre-existing IP which belongs to a research team whose members are Employees of UKM;
- iii. revolve around pre-existing IP owned by UKM or is licensed to UKM;
- iv. are created, developed or otherwise generated using the facilities, material, funds or other resources owned by UKM;
- v. are created with the support of and/or collaboration with Employees of UKM; or
- vi. develop Administrative Material and/or Teaching Material.

4.2 All UKM Associates who participate in any research project, activity or visit at UKM must sign a Confidentiality Agreement.

5. OWNERSHIP OF IP CREATED BY ASSOCIATES

5.1 All IP created by Associates in the course of their research projects, activities or visit at UKM, shall belong to the Associates. However, UKM

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has a non-exclusive right, royalty-free and perpetual licence to use, reproduce and distribute those works in any manner it deems fit.

- 5.2 UKM requires Associate(s) to assign in writing, the IP to UKM, in accordance with UKM Associates IP Policies (Supplementary), when:
- i. the IP is created, developed or otherwise generated using facilities, material, funds or other resources owned by UKM;
 - ii. the IP is created with the support and under supervision of UKM Employee;
 - iii. the IP belongs to a research team whose members are UKM Employee; or
 - iv. the IP is commissioned or created under direct request of UKM.
- 5.3 In the event that the research projects, activities or visit produces a Teaching Material, UKM does not claim IP. However, UKM shall require the Associate to give a non-exclusive, royalty-free and perpetual license to use, reproduce and distribute those materials in delivery of UKM courses. UKM will ensure that such use does not conflict with the moral rights of the authors.
- 5.4 In the event that an Associate has a prior agreement with his Home Institution or under External Research Grant or other than those referred to in Section 4.1, and where that Home Institution or External Research Grant has the rights to any IP created by the Associate, the Associate shall be responsible and has a duty to disclose and ensure that any IP owned by the Home Institution or any other party does not come in conflict with UKM's IP.

6. ASSIGNMENT OF ASSOCIATE'S IP

- 6.1 Notwithstanding Section 5.2 of this Policy, an Associate may choose not to assign his IP to UKM. It is the duty of the Associate to make his decision known in writing to the lead researcher or the UKM Employee hosting the Associate. Thereafter,
- i. the Associate, upon consultation with the lead researcher or the UKM employee hosting the Associate, shall develop a different research project which does not come in conflict with Section 5.2 of this Policy; and
 - ii. the Associate shall not be involved with any research project or activity which:

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- a. UKM has contractual obligations with third party;
 - b. revolves around pre-existing IP owned or licensed to UKM;
 - c. has Commercialisation Expectation; or
 - d. will lead to the development of Teaching Material or Administrative Material.
- 6.2 Where an Associate chooses to assign his IP to UKM in compliance with Section 5.2 of this Policy, he must sign a UKM Associate Deed of Assignment. The Associate may consult an independent legal advice about the nature and effect of the UKM Associate Deed of Assignment and after obtaining such advice, the independent legal advisor must sign a Notice Relating to Independent Legal Advice.

7. DISTRIBUTION OF INCOME

- 7.1 In accordance with Section 7 of UKM IP Policy, all Originators of UKM IP including Associate will receive a share of the income derived from the commercialisation of the IP.
- 7.2 Where Home Institution or an External Research Grant owns the IP created by Associate during his research projects, activities or visit at UKM, UKM will, upon consultation with the Associate, Home institution and/or External Research Grant, take into consideration of any existing contractual arrangement and policies to determine the distribution of income on a case-by-case basis.