

BENGKEL HAKCIPTA DAN HARTA INTELEK,INQKA

Dewan Serbaguna,OIA,UITM,Shah
Alam

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Harta Intelek

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Creation of work/innovation

- Why do you want to protect it?
- At what moment in time do you need to protect it?
- What will happen if you fail to protect your work/invention
- The laws protecting it

Intellectual property



COPYRIGHT

**INDUSTRIAL
PROPERTY**

Patent

Trade Marks

**Industrial
Designs**

**Geographical
Indication**

**Confidential
information**

**Layout designs
of integrated
circuit**

The IPR legislation

- **The Copyright Act 1987**
- **The Patent Act 1983**
- **The Trade Marks Act 1976**
- **The Industrial Designs Act 1996**
- **The Geographical Indications Act 2000**
- **The Layout Designs of Integrated Circuit Act 2000.**

Supporting laws

- New Plant Varieties Act 2004
- Common law:
 - - passing off
 - - confidential information

International Convention for IP

- Paris Convention for Protection of Industrial Property 1967 (1989)
- Berne Convention for the Protection of Literary and Artistic Works 1971 (1990)
- Trade-related aspects of Intellectual Property Agreement 1994 (1995)
- WCT /WPPT(digital agenda)(2012)
- PCT 2006
- Nice Agreement
- Vienna Agreement

IP as intangible property

- Tangible property
- Land, houses, estates, car
- Intangible property
- -intellectual property
- Intangible wealth, easily appropriated and reproduced, once created the marginal cost of reproduction is negligible

The role of IP as intangible property

- 1. economic rights of creators
- 2. commercial exploitation of owner of IP
- 3. capital expenditure
- 4. transfer of technology
- 5. cultural development

Why IP protection is given

- Capital expenditure for new products
- R and D
- Marketing and advertisement
- No free loaders
- Maintaining loyal followers
- profit

IP as a property

- Can be sold
- Can be bought
- Can be lease or rent
- Can pass under a will
- Can be assigned

Tangible assets

- Tangibles assets :-
- land,
- Labour/human resources
- Timber
- oil
- and capital

Intangible assets

- Knowledge
- Information
- Creativity
- inventiveness

The rise of intangibles assets

- Intangibles assets :-
- Knowledge,information,creativity,inventiveness
- The rise of intangibles
- Illustration :
- Trade mark value

The Changing of the norm

- Traditional economic theory:-
 - The economic development of a nation requires capital, land (natural resources) and labour are the only driving forces of economic and social well being.
 - The theory of Development today – progress in technology and innovation are the catalyst for the economic growth.
- Examples: Switzerland, Japan Norway

The IP Eco-system

- imagination
- innovation
- creation
- protection
- innovation
- commercialization

The problem with intangible assets

- “Difficult to create. Once created it is so easy to copy”

Universal natural resources

- Creativity and innovation
- Knowledge based economy
 - stimulant for innovation and creativity.
 - “ the IP system has a vital role to play in leveraging the inventive activity particularly among the younger generation”
 - meeting national and global challenges.

Development and growth

- Development of infrastructure
- Development of skilled workforce
- Changing of mind set:-
 - “Imagination is more important than knowledge” (Albert Eistein)
 - history evidenced the fact that imagination brought about innovation and creativity.

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Economics and IP

- 1990's sees policy makers recognizing the important role of the IP system in encouraging investment in R and D for science and industrial field.
- A healthy IP system encourages FDI.
- Eg India – reform of patent and trade mark system
- Brazil- industrial property law reform 1996.

COPYRIGHT

- Literary,
- Artistic,
- Musical,
- Sound recording
- Film
- Broadcast

PATENT

- Innovation
- Invention
- Product
- Process
- Novelty
- Inventive step
- Industrial application

INDUSTRIAL DESIGNS

- Features of shape
- Configuration
- Pattern
- Ornament - Applied to an article

TRADE MARKS

- Words
- Devices
- Names - for goods and services

GEOGRAPHICAL INDICATION

- Indication of product from a particular locality

Protection for Copyright

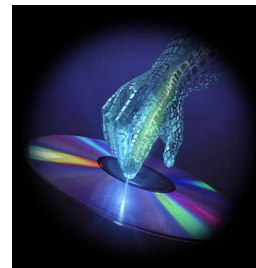
- Protection given by law for a term of years to the composer, author etc... to make copies of their work..
- Work include literary, artistic, musical, films, sound recordings, broadcasts.
- Commercial and moral rights.
- A voluntary notification system.

Definition of copyright

An exclusive right given by law for a determinable time period to the author or composer to make copies of their work.

Copyright and the creative industries

- Musical industries has no boundaries.
- Computer software
- Books, newspapers, journals and all manner of publication
- Film.



Copyright Act 1987 and the Various Copyright Convention and Treaty

- Berne Convention.
- Universal Copyright Convention
- WIPO Copyright Treaty
- WPPT
- The Rome Convention
- TRIPS Agreement

Basic Principles of Copyright

Originality

- Meaning of originality
 - - not the same as novelty
 - - originating from the author
 - - can have two work which are similar but not a copy

Does not protect idea

- Protection only for expression of idea
- What is meant by expression?
- Forms of expression

Sufficient labour and skill

- Meaning of labour and skill
- - sweat of the brow

The idea-expression dichotomy

- When is an idea?
- When is an expression of idea?
- The counter argument
 - - merely taking idea (the infringer)
 - - infringing expression of idea(the plaintiff)

Additional prohibition

- Procedure
- Method of operation
- Mathematical concept

Material form

- Meaning of reduction into material form
- -tangible
- -written down
- -recorded

No registration provision

- Free of any formality
- C notis
- UCC
- Not Berne
- Voluntary notification

A bundle of right

- More than one right in one work
- Example : film,
- Sound recording/musical work
- Interactive material
- Books/literary/artistic
- Can have different ownership
- Different duration/term of protection

Works given copyright protection

- Section 6
 - - copyright a creature of statute.” No copyright shall subsist otherwise than by virtue of this Act”
- Section 7 (list of work eligible for copyright)

- Literary works
- Musical works
- Artistic works
- Films
- Sound recordings
- broadcast

Literary works

- Meaning of literary works
- Not literature
- -work that you read and write
- - include computer program
- -includes report, memoranda, essays,articles
- Lectures, addresses

Cases

- 1.University of London Press Ltd. 1916 2 Ch.601
- Petersen ‘ Literary work are work that are written down or printed’
- Mohd.Ramly v Sarimah Film Production Sdn.Bhd.
- manuscripts
- Syed Alwi v Dewan Bahasa Pustaka
- Plays
- Lau Foo Sun v Government of Malaysia “drawing”

Musical works

- Accompaniment of sound
- Song (lyrics and music)
- Lyrics = literary work
- Music = musical work

Artistic works

- Meaning and coverage
- Architecture works

Sound recording

- Musical work
- compilation

Film

- Definition of film
- Include soundtrack
- Anti-camcording provision.
- Section 43A

Broadcast.

- Meaning of broadcast.
- Broadcast service
- Rebroadcast
- Rights of broadcast
- “ a protection over signal”
- Nature of copyright in broadcast section 15
- Broadcasting of works incorporated in films section 16

Derivative works

- Section 8
- Protected as original work
- Include translation, adaptations, arrangement and other transformation of work eligible for copyright
- Collection of works or collections of mere data which by reason of the selection and arrangement of their contents constitute an intellectual creation.
- Protection without prejudice to any protection given to the existing works used

Published editions

- Meaning
- Limited rights

Works that get no copyright

- Offensive
- Immoral
- No provision in the Copyright Act.

Rights granted

- The economic rights
- The moral rights

The economic rights

- Commercial exploitation in all possible manner

The exclusive rights

- Section 13 CA:-
- “the exclusive right to control in Malaysia the following:-
 - - the reproduction in any material form
 - - the communication to the public
 - - the performance, showing or playing to the public
 - - the distribution of copies by sale or other transfer of ownership
 - - the commercial rental to the public

The extent of rights

- To control the whole work
- To control a substantial part part of the work
- Either in its original form or a derivative form

Acts of infringement

- Section 36 (1) “ Copyright is infringed by any person who does or causes any other person to do without the license of the owner of copyright, an act the doing of which is controlled by copyright”
- - the person who does the infringing act.(the primary infringer)
- - the person who authorizes another person to do the infringing act.

The secondary infringer

- Selling, letting for hire, or by way of trade ,offering or exposing for sale or hire the article;
- Distributing the article for the purposes of trade or any other purpose to an extent that it will effect prejudicially the owner of the copyright; or
- By way of trade exhibiting the article in public.

Substantial taking

- Meaning of substantial taking
- “ quality rather than the quantity “
- “what ever that is prima facie worth copying is prima facie worth protecting”
- - unaltered copying
- - extents of defendants alteration
- - character of plaintiff or defendants work
- -Nature of the plaintiff effort

- The extent of the plaintiff effort
- The manner in which the defendant has taken advantage of the plaintiff work
- Defendants use will interfere with the plaintiff exploitation of his work

Offences under section 41

- Makes for sale or hire any infringing copy
- Sells, lets for hire or by way of trade, exposes or offers for sale or hire any infringing copy
- Distributes any infringing copies
- Possesses, otherwise than for his private and domestic use, any infringing copy

- Removes or alters any electronic rights management information without authority
- Distributes, imports for distribution or communicates to the public without authority, works or copies of works in respect of which electronic rights management information has been removed without authority.

Meaning of moral rights.

- The rights of the author over his works irrespective of the commercial exploitation
- of the said works.
- Note :-
- Duration lies on life of the author.

2 types of moral rights.

- 1. right of paternity
- Section 25 (2a)
- - the right to claim authorship of work.
- 2. right of integrity
- Section 25 (2b)
- - right to object to distortion/ mutilation if:-
- - significantly alters the work
- -adversely affecting the authors honour or reputation.



The Philosophy of the Patent System

- The State grants the inventor an exclusive monopoly for a limited time in his invention in return for his disclosure of the invention so that the public at large will be able to practice the invention once the patent expires.

The Patent Legal Landscape

- International Convention
 - - Paris
 - - TRIPS
 - - PCT
- Domestic legislation
 - - The Patent Act 1983 and Regulations.

The legal requirements

- The Patents Act 1983
- The Patents (Amendment) Act 2003
- The Patents (Amendment) Act 2006
- The Patents Regulation (Amendment) 2006.

The Role of MyIPO

- Receiving patent application and fees
- Examination as to form
- Publication of the application
- Examination as to substance
- Refusal or grant
- Maintenance of patents

Coming to the IP office

- Malaysian has right of appearance without an agent.
- Foreigners must appear via an agent.

Procedure to apply

- Submission of patent application
- Legal requirement to submit to MyIPO first.
- Section 23A Application by resident to be file in Malaysia first/
- Penalty : Application in contravention is an offence. Liable on conviction to a fine RM15000 or 2 years prison.

exception

- Apply for permission to Registrar to submit elsewhere . Get Registrar consent in writing. Then file.
- Or
- File for invention in Malaysia. Then wait 2 months then file elsewhere.

Application for patent

- After evaluation and decision made to patent
- Decide on a trusted patent agent/ patent drafter
- Patent agent must do total and complete discovery evaluation
- Need to identify all previous known document relating to patent

Search made

- Novelty search
- State of the art search
- Search for inventiveness

Time frame

- Filing of application
- - certificate of filing
- - 24 hrs after filing
- - formality examination
- - within 1 month of application
- - request for substantive examination within 15 months from date of filing.

Priority date

- 12 months from date of filing
- Given for all convention country application
- - copy of original filing from office of filing must be presented at a later date as evidence of first filing.

Priority date

- Section 27 A
- Priority date = filing date
- - only for first filing
- Subsequent filing with a right to claim priority date for purpose of novelty
- Regulation 20

Quick summary of application

- Filing
- Preliminary examination
- Substantive examination
- Grant
- -advance report
- Rejected
- - a communication
- - a correction
- - resubmitted
- -examine again
- - adverse
- -refuse
- -clear
- grant

Strategic trade marks use

- increasing sales of product
- maintaining customers loyalty
- income and profits
- extending market shares
- differentiating products
- promotion of franchise

Malaysian franchise

- Sugar Bun
- Marrybrown Fried Chicken
- Secret Receipe
- D'Tandoor
- Seng Hup

Francais Malaysia











- Sugar Bun
- Marrybrown Fried Chicken
- Secret Receipe
- D'Tandoor
- Seng Hup
- Satay Hj Samuri
- Ani Sop Utara
- Smart Reader

Developing a national brand

- - Petronas
- - ‘Malaysia truly Asia’
- - MAS
- - Selangor pewter.
- - Bonia
- - Produa
- - Proton





Brand	Industry	Brand Value (USD)
 PETRONAS	Oil&Gas	2,154
 Maybank	Banks	1,645
 TM	Telecommunications	1,393
 H&M	Entertainment	1,069
 CIMB GROUP	Banks	916
 TENAGA NASIONAL	Electric	910
 maxis.	Telecommunications	858
 PUBLIC BANK	Banks	767
 Sime Darby	Holding Companies	753
 Malaysia Airlines	Airlines	637

International brands





The full range of collectables



Industrial Designs



Legislation and Convention

- Industrial Designs Act 1996
- Industrial Designs Regulations 1999
- Paris Convention for the Protection Of Industrial Property 1883
- Locarno Agreement (International Classifications for Industrial Design)

What is an industrial Designs?

Definition: Section 3(1) IDA 1996

“Industrial Designs” means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to the eye and are judged by the eyes....”

'Article'

Section 3(1) IDA 1996

any article of manufacture or handicraft, and includes any part of such article or handicraft if that part is made and sold separately

Appeal to and judged by the eye

- Eye appeal test.
- “influencing customer preference”
- Case: Amp Inc. v Utilux Pty 1972 RPC 103
- Lord Pearson “ It is not reasonable to suppose that the only limitation is that the features are visible in the finished article.
- Case: Ferrero’ and SpA’s Application 1978 RPC 473.

Registrable Industrial Design

- Fulfill the interpretation of ID (Sec 3)
- New in Malaysia and elsewhere (Sec 12)
- Not contrary to public order or morality (Sec 12)

Characteristic of protection

- Shape and Configuration
- Pattern and Ornamentation
- Combination of both

Protection for industrial designs

- Protection for industrial designs that are new or original
- Design are feature of shape, configuration, pattern or ornament
- The design must be applied to an article
- The design must be applied by an industrial process.
- Appeal to the eye.

Shape and Configuration (3D)



Shape and Configuration (3D)



Shape and Configuration (3D)



Indian 402 1930

Shape and Configuration (3D)



Shape and Configuration (3D)

Nokia series of collection – Industrial Designs evolution



Shape and Configuration (3D)

COCA COLA series of collection –
Industrial designs evolution





Pattern and Ornamentation (2D)



Pattern and Ornamentation (2D)



Pattern and Ornamentation (2D)



3D & 2D



What is NOT considered as industrial design?

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

1. A method or principle of construction



3. Integral Parts

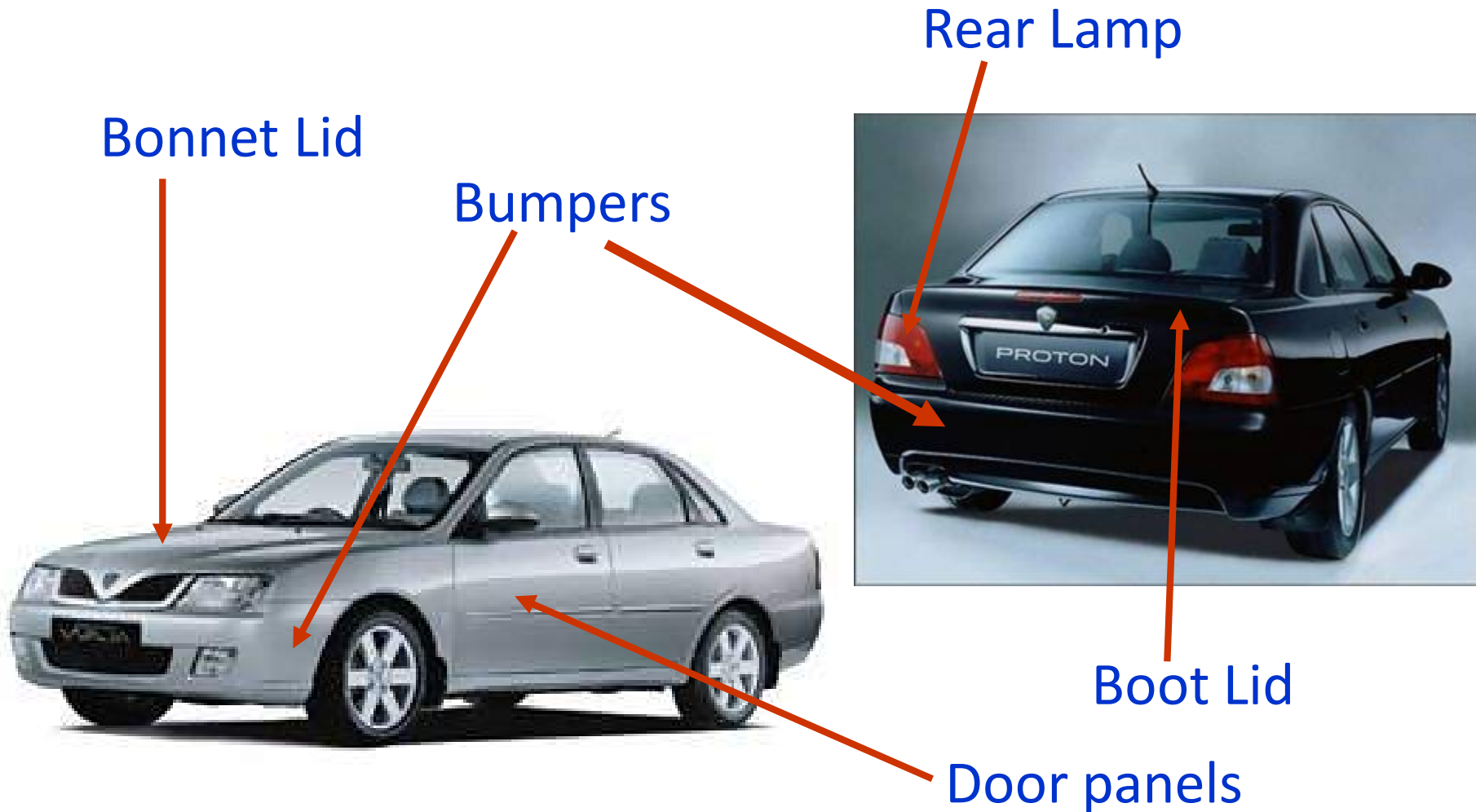
Must fit:

.i.e. no other feature is possible in order to maintain the function of the object.

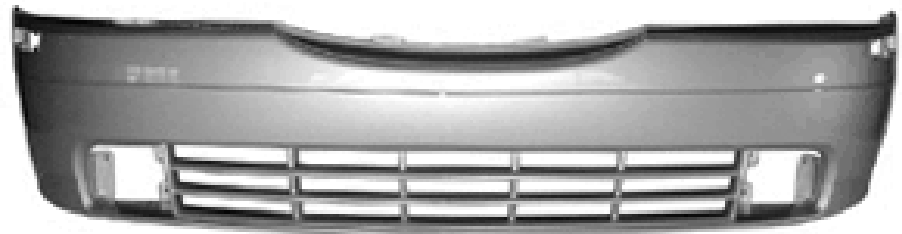
Must match:

Design features must not be dependent upon the appearance of another article

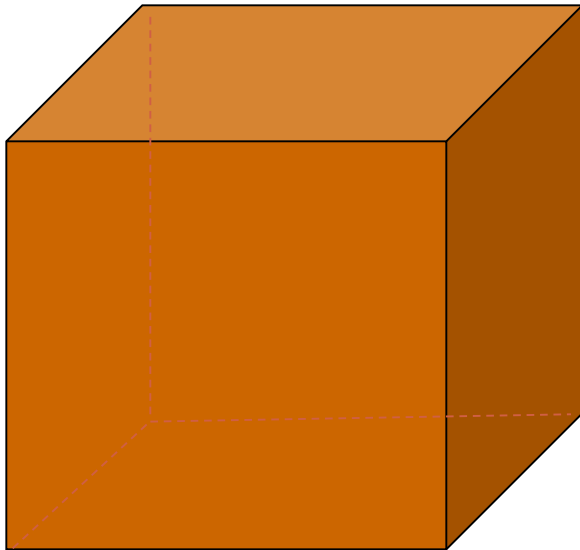
3. Integral Parts ?



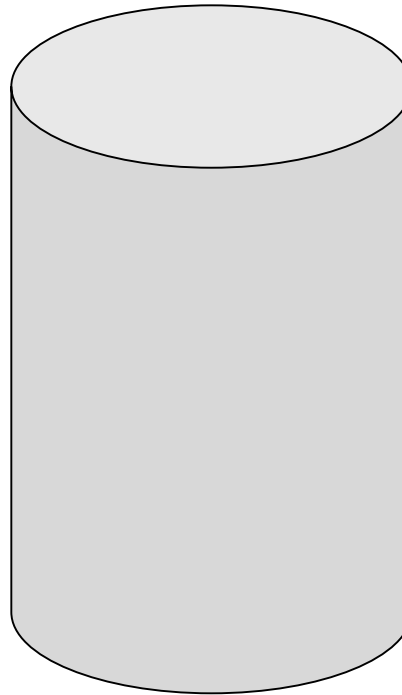
3. Integral Parts ?



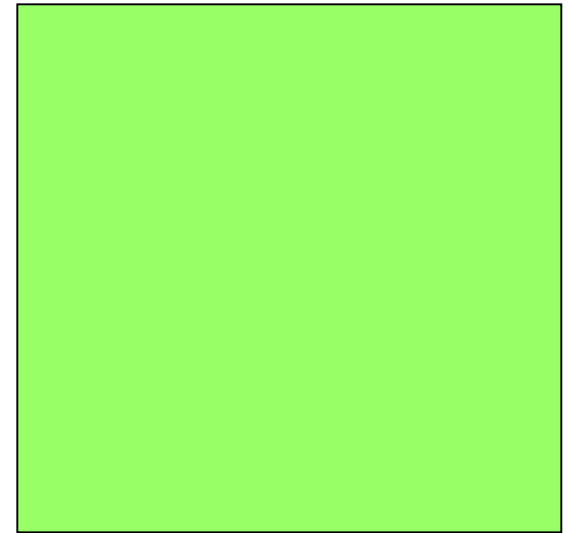
5. The features of the article do NOT have a clear aesthetic appearance.



Box



Can



Plain wall paper

Unregistrable design

Designs contrary to public order or morality

(Sec 13)

- Inclusive religion and moral standards

The requirement of novelty

- Absolute novelty.
- Avoid use before application.
- Case: The Teik Boay v Chuah Saik Loo 1962 28 MLJ.80.
- Case: Besalon International Ltd and 2 others v South Strong Industries Sdn. Bhd. 1997 2 AMR 1333.
- Case: Ang Lay See & Others v Solite Impex Pte, Ltd 1998 2 SLR 365.

Priority Date

- The filing date of the application
- The earliest date of an earlier applications filed by an applicant in any of the member states of the Paris Convention for the Protection of Industrial Property
- Convention priority claim must be within 6 months from such earliest date

Priority Date

**Application filed by A
in UK 1 Jan 2012**

**Last date to claim
priority in M'sia
1 July 2012**

**Application filed
by A in Malaysia
28 June 2012**

6 months

**Application filed by B
in Malaysia 25 Jan 2012**

Period of Registration

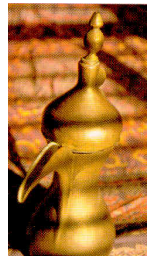
- Upon grant of certificate, 5 years from the filing date
- Option to be extended for further two consecutive terms of 5 years each
- Total period of protection is 15 years

Protection for geographical indications

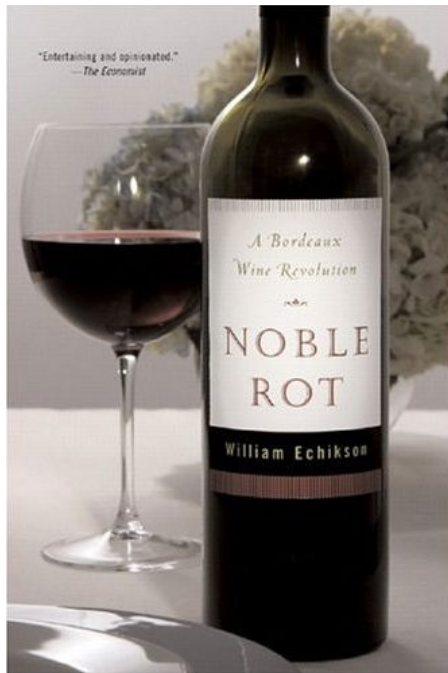
- Meaning “ an indication which identifies any goods as originating in a country or territory, or a region or locality where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin”

Geographical indication

- Product identifiable with a particular locality.
- Added value for quality assurance and market acceptance.
- Products that are acceptable internationally are able to fetch higher value.
- Example : Jasmin rice from Thailand sold for RM2.80 a kilo in Thailand but at RM22.80 per kilo internationally.



Examples of GI



"Bordeaux Wine"



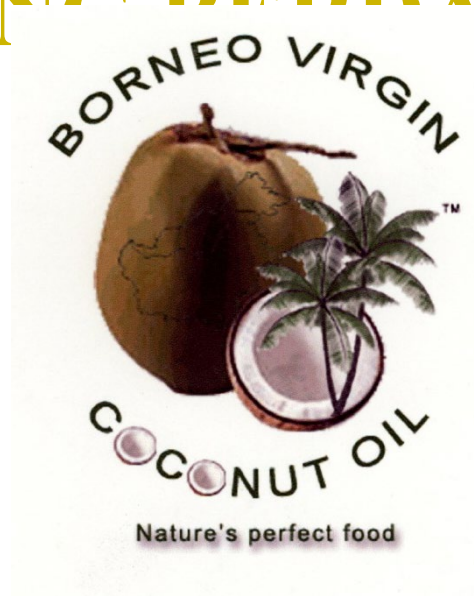
"Darjeeling Tea"



"Tuscany Olive Oil"

CONTOH PETUNJUK GEOGRAFI YANG BERDAFTAR DI MALAYSIA

**“Borneo Virgin
Coconut Oil”**



“Sarawak Pepper”



“Sabah Tea”



“Tenom Coffee”

Protection under the law of Tort

- Based on common law
- There is no legislation pass by Parliament
- Enforced by court's decision.
- Strict application of precedent.

Passing-off

- For trade mark (registered and unregistered)
- Started from the tort of deceits.
- The deceiver, the audience and the victim.
- Requirement of “goodwill”

Confidential information

- Protection under the law of tort
- Protection for confidential information under contract, employer-employee relationship, husband and wife, etc
- Need to show:-
 - - information are confidential
 - - recipient who obtained the information uses it
 - - damages suffered by the owner

IP compliance: Trade secret

- Ensure employee are subject to appropriate restrained of trade covenant.
- Employee having access to confidential information must signed written non disclosure agreements and understand their duties to keep information secure.
- Marks all files
- limit access.
- Sign NDA

Qualification for protection of Intellectual property in Malaysia.

- Protection are territorial.
- Procedural requirement must be met.
- Intellectual Property Corporation Malaysia act as the governing body.
- Forms submitted,search made,prescribe time period observed.
- Abiding to International Convention.

Duration of protection

- Life + 50
- 50
- 20
- 15
- 10
- Payment of statutory fee.

Ownership

- Who is the owner?
- Proper plaintiff rule.
- -employer and employee relationship
- - independent contractor.
- - government employee.
- - joint-ownership.
- Commissioned works

Enforcing IP rights

- civil action
- Criminal prosecution
- Cost in litigation
- Assistance from Enforcement Division
- Being vigilant/ self help

Civil action

- Starting a civil action
- Advantages
- Liability for cost
- Monetary compensation in term of damages

Criminal prosecution

- Making a complaint
- Police or enforcement division
- Cost borne by the government
- No monetary compensation
- Remedy in term of fines or imprisonment for the offender

IP infringement

- Primary infringement
 - - who does or causes
 - -making the product
- Secondary infringement
 - - commercial activities
 - - selling,distribution for sale etc

Secondary infringement

- sells, lets for hire or by way of trade exposes or offer for sale or hire any infringing copies.
- Distribute infringing copies.
- Importing into Malaysia

IPR as an economic tools

- The Role of IP :-
- “The intellectual property system must be able to converts innovation into assets”
 - innovations
 - entrepreneurship
 - profit
 - reward.
 - economic growth

Protection of IP

- IP audit
- registration(national and international)
- IP and technology diligence intelligence.
- IP litigation or arbitration

Management of IP

- Integrate corporate strategy
- IP portfolio analysis
- Develop strategic plans
- develop risk management framework.

Exploitation of IP

- Licensing
- assignment
- investment
- replicate
- manufacture
- alliances

Finance

- Valuation
- collateralize
- securitize
- capitalize