



MRANTI

# START-UP IP: POWER UP YOUR INNOVATION

SHERRY SOKMUM  
LEAD, IP & POLICY MANAGEMENT  
29th OCTOBER 2024

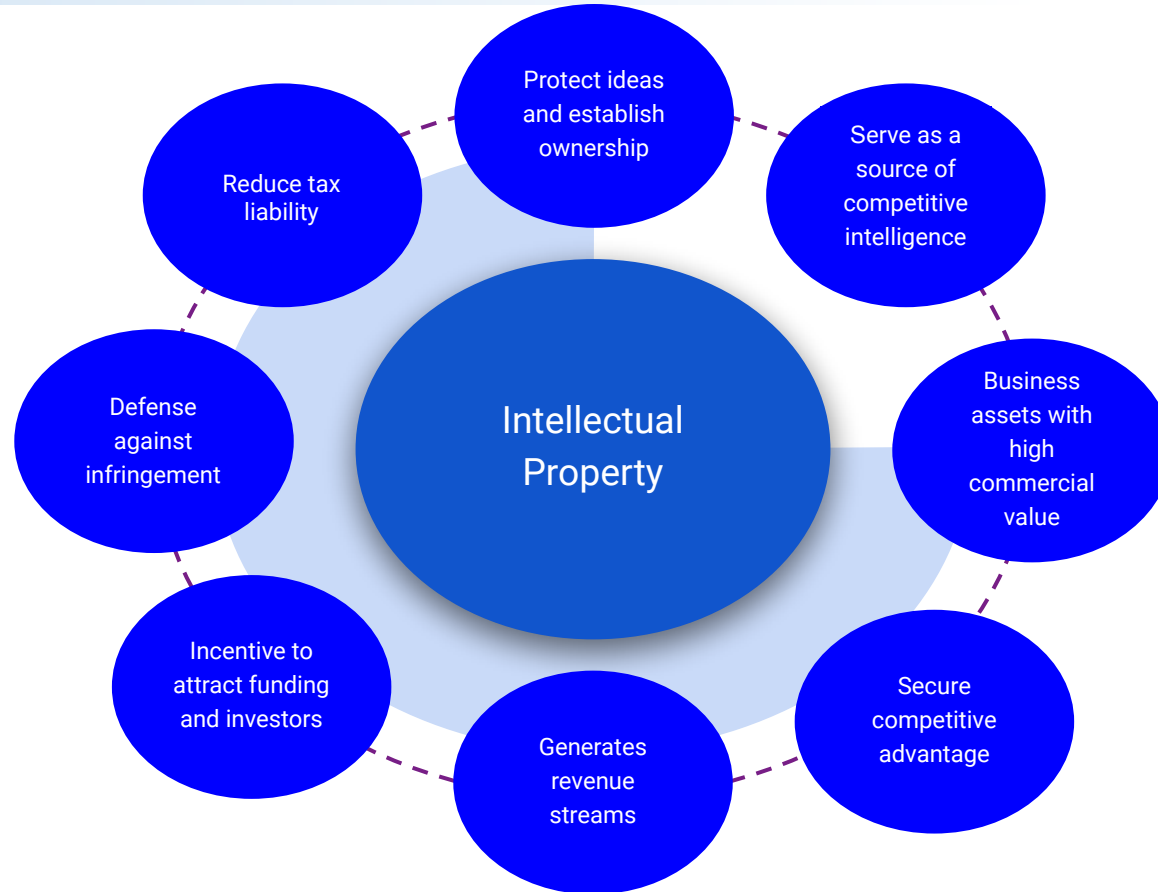


@mymranti

- [illegible]



# WHY IP IS ESSENTIAL FOR YOUR START-UP



## WAYS TO MONETIZE IP

01

Commercialisation by IP owner

02

Licensing/Merchandising/Financing

03

Assignment sale

04

Strategic  
alliance/Collaboration/Co-existence

05

Financing/Funding

# COMMON IP DISPUTES IN BUSINESS



1. Ownership claim by employee/ independent contractor
2. Moral rights claims
3. Substantial similarity not just quantitative
4. Improper assignment
5. Not registering and being restricted to area of reputation
6. Assuming rights in corporate names and tradenames
7. Adopting non-descriptive marks
8. Losing distinctiveness through loss of control and improper licensing
9. Lack of ownership agreement
10. Public disclosure

**PATENT** ●————● Inventive ideas in providing solutions

**TRADEMARK** ●————● Business identifier

**INDUSTRIAL DESIGN** ●————● Shape aesthetic, Visual appearance

**COPYRIGHT** ●————● Expression of ideas

**TRADE SECRET** ●————● Secret/confidential information  
with commercial value



## Patents Act 1983

To protect a new and non-obvious invention/innovation, which maybe a product or process that provides new way of doing something or offers a new technical solution to a problem

New, Inventive Step & Industrial applicable



## Trademarks Act 2019 (Statutory)

Common Law (based on use, goodwill)

To protect "sign" which identifies a particular source for goods/ services & distinguishes such goods/ services from other undertakings.



## Copyright Act 1987

To protect "recorded" expression of ideas in the form of various works.

Literary, artistic, musical works, films, sound recordings, broadcast, derivative works- software, photos, reports.



## Industrial Designs Act 1996

To protect "features of shape, configuration, pattern or ornament" applied to an article by industrial process.

Appeal to & judged solely by the eye.

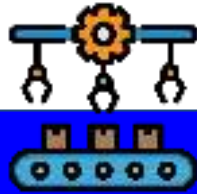
New in Malaysia & elsewhere.



## Contracts and/or Common Law

To protect confidential & proprietary information by way of identifying, limiting access, keeping it confidential.

By using NDAs or contractual terms to legally bind employees, third parties & business partners to confidentiality obligations.



## **Manufacturing Process**

A single act or a set of actions of step

Example:



## **Product**

Changing the feature of raw or prepared

materials

Example:

## **Machine**

A physical object made up of pieces or a  
creation of devices

Example:



## **Software**

Software program that transforms data

Example:





## NOVEL

- Not disclosed anywhere in the world
- Disclosure- can be any form of written publication, oral disclosure, use or in any other way



## INVENTIVE STEP

- Not obvious to a person skilled in the art

## INDUSTRIALLY APPLICABLE

- Has at least one use/application in any industry

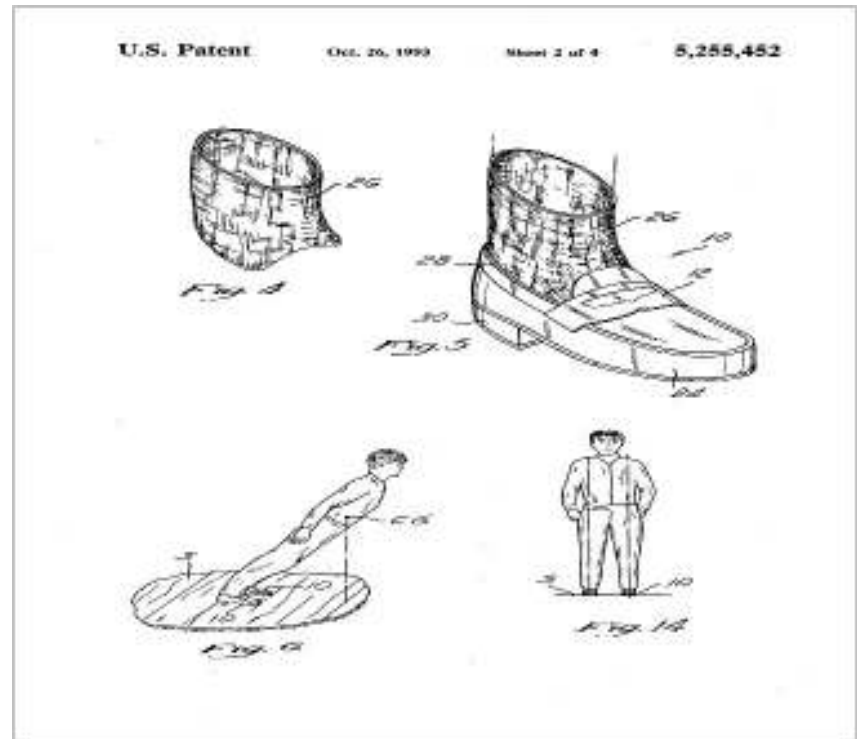


## DO YOU KNOW?



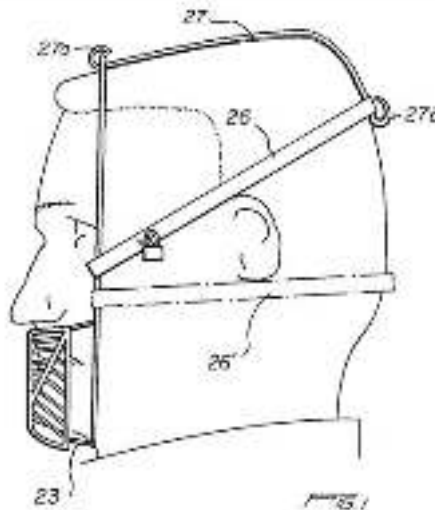
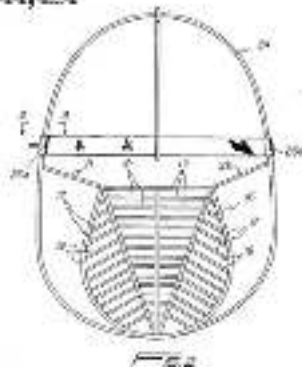
King of Pop: Smooth Criminal

Method and Means for Creating an  
Anti-Gravity Illusion  
US Patent 5,255,452  
System Claim



## DO YOU KNOW?

LUCY L. BARMBY  
ANTI-EATING FACE MASK  
Patented August 17, 1982  
No. 4,344,424



“Anti-eating face mask”, mainly for those who are “exposed to food constantly, such as chefs, cooks, restaurant personnel or the like”. The device allows the wearer to breathe and talk, it locks with a small padlock, and can be used to fight unhealthy habits from overeating to smoking.

- **Protect new devices, new methods that offer technical solutions.**
- **Sequence of novelty, inventive step & industrial applicability.**
- **20 years from the date of filing**
- **Multiple claims allowed.**

- **Protect an improvement of a device, a method.**
- **Novelty and industrial applicability.**
- **10 years from the date of filing.**
- **Only one claim.**

**TM**

Trademark

vs



Registered

### Collective Mark

Serve as a badge of origin of a particular association

### Certification Mark

Serve as a badge of quality to guarantee that goods/services have been certified to have a certain characteristic or quality

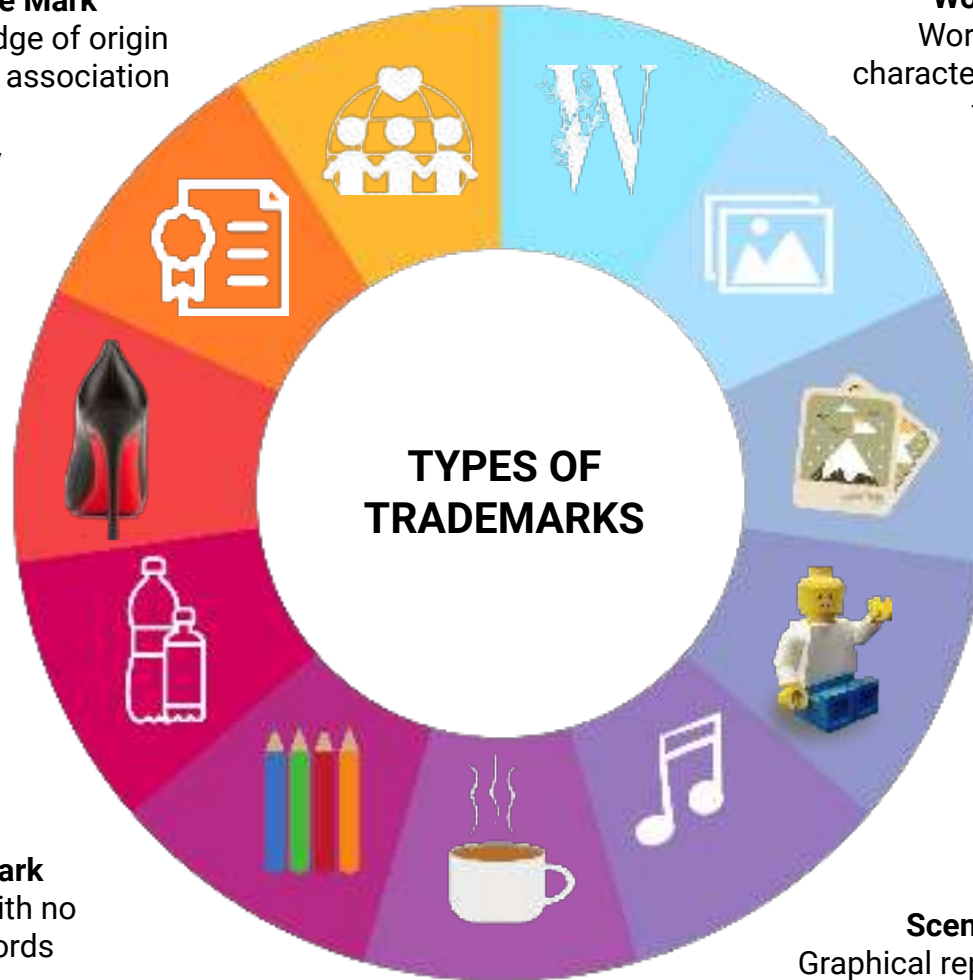
### Position Mark

Combination of words/characters and images/graphics

**3D Shape** of goods/ packaging represented by line drawings or actual photos showing different views

### Colour Mark

Colour(s) with no picture/words



### Word Mark

Words of any characters that can be typed

### Figurative Mark

Pictures, images or graphics

### Combination Mark

Combination of words/characters and images/graphics

### Aspect of Packaging

Shape of goods or packaging in which goods are sold

### Sound mark

Graphical representation is required

### Scent mark

Graphical representation is required

## TRADE DRESS

- Protect to the overall look and feel of a business of product
- Common example of trade dress include the distinctive appearance of certain chain restaurants (McDonald's) or retail stores (Apple stores)
- Also refer to a product's distinctive packaging (although it must be non-functional) or unique elements associated with the product's design.



## INFAMOUS TRADEMARKS

MRANTI









## INFAMOUS TRADEMARKS

MRANTI



# SPECTRUM OF DISTINCTIVENESS

	LEAST LIKELY TO REGISTER		MOST LIKELY TO REGISTER		
Mark	GENERIC MARK	DESCRIPTIVE MARK	SUGGESTIVE MARK	ARBITRARY MARK	FANCIFUL MARK
Description	The common name of the product or service.	A basic description of the product or service.	A name or phrase that suggests the product or service.	A name with no intrinsic ties to the product or service.	An entirely made-up name or symbol that is to represent the product or service.
Examples	An ice cream company trying to trademark the term "ice cream".				
Chance of Registration	None	Unlikely without 5 years of consecutive use	Possible	Likely	Very Likely
Level of Protection	None	The Narrowest Scope Of Protection	A Broader Scope of Protection than a Descriptive Trademark	A Broad Scope of Protection	The Broadest Scope of Protection

# COPYRIGHT

A work that is eligible is protected automatically upon fulfillment of the following conditions:

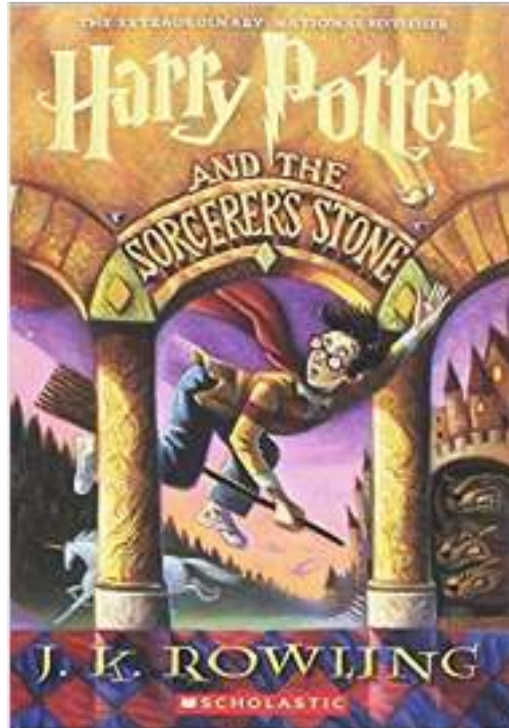
**ORIGINAL**- Sufficient effort has been expected to make the work original in character

**TANGIBLE**- The work has been written down, recorded or reduced to a material form

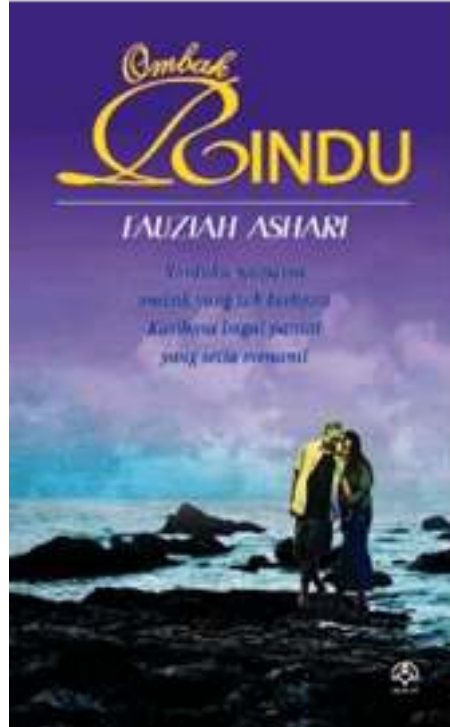
**OWNERSHIP**- The author is a qualified person or the work is made in Malaysia or the work first published in Malaysia



## EXAMPLES OF ORIGINAL → DERIVATIVE WORKS

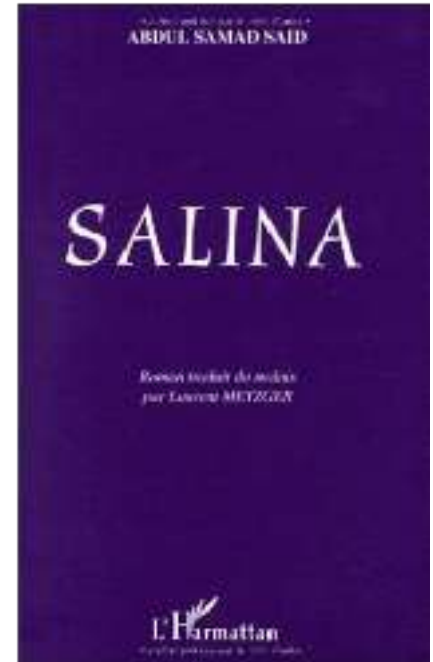
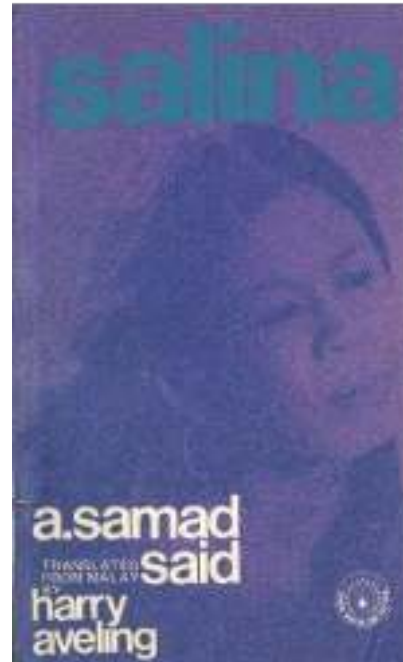
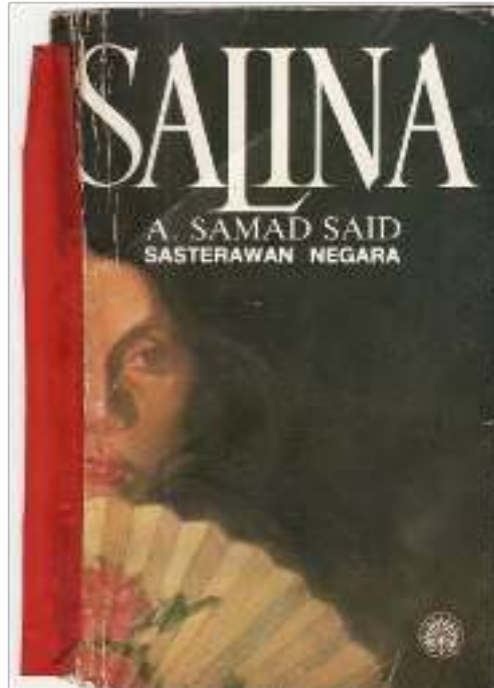


## EXAMPLES OF ORIGINAL → DERIVATIVE WORKS





## EXAMPLES OF ORIGINAL → DERIVATIVE WORKS





The visual features of shape, configuration, pattern or ornament (or any combination of these features) applied to a finished article made by hand, tool or machine



Protect the visual appearance of a product (2D or 3D)  
eg: lines, contours, colours, shape, texture or materials of product or its ornamentation

## Shape and Configuration (3D)

MRANTI

The novelty of the design for which protection is sought lies in the shape and configuration of the **article**





## Pattern and Ornamentation (2D)

MRANTI

The novelty of the design for which protection is sought lies in the pattern and ornamentation of the article as shown in the representations



Wall paper



Packaging  
- surface

## 3D & 2D

The novelty of the design for which protection is sought lies in the **shape and configuration** and **pattern and ornamentation** of the article, as shown in the representations



Trade secrets are **confidential information** that has **commercial value** by virtue of being **kept secret** and reasonable steps have been taken to keep it secret.





## INFORMATION

Only applies to “information” and cannot be applied to things that are not classified as “information)



## NOT GENERALLY KNOWN

The information that is a secret, i.e. is not generally known or readily accessible to those who usually deal with such information.



## ECONOMIC VALUE

The information that has commercial value because it is a secret



## VALUABLE TO OTHERS

The information must have value to others who do not have the information.



## REASONABLE MEASURES

The information that is subject to reasonable measures by the rightful holder of the data to keep it secret.

Trade secrets can include any information that is secret and valuable.  
For a business this can include:

- Customer data
- Computer programs
- Financial records
- Future or proposed products or services
- Marketing plans
- Raw data
- Schematics
- Source code
- Supplier identities
- Research & Development plans







recipe for its Coca-Cola is one of the most famous trade secrets in the world. It's a trade secret because only a select few within the Coca-Cola Corporation know the exact recipe for the soft drink.



algorithm for its search engine is also a very valuable trade secret. Google uses an algorithm that ranks websites based on many factors including inbound links, page rank, relevant text, anchor tags, etc. processes that Intel uses to make its integrated circuits for computers.



likely has patents on many of these processes, but certain aspects of the processes may very likely not be patented and are simply left "secret" to others.

## LOSING TRADE SECRET STATUS



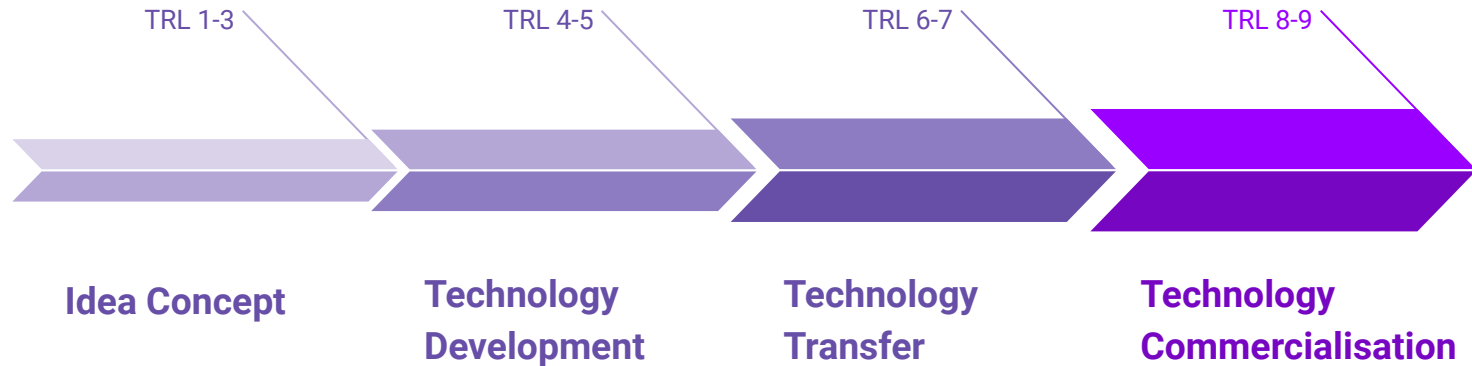
As long as this information is kept secret it can be a trade secret. This means that trade secrets can last forever.

**F O R E V E R**

Until... they don't. Despite best efforts, sometimes trade secret become known and lose their trade secret status.

~~**F O R E V E R**~~

# INNOVATION CHAIN





Something that comes from ONE's mind based on the following:

- Personal Experience
- Study
- Serendipity



It is the process where an idea/concept has come to life from hypothesis into a usable product or inventions.

These inventions can be tagged as IP or can be kept as Trade Secret.



**A process of sharing knowledge, skills and technology from one organisation or individual to another.** The process can involve the changing ownership and control over an invention from the creator to a party intending to generate a commercial product or service.

Technology Transfer drivers: **Market Pull** (demand from receiver) and **Technology Push** (foreseen demand by provider)

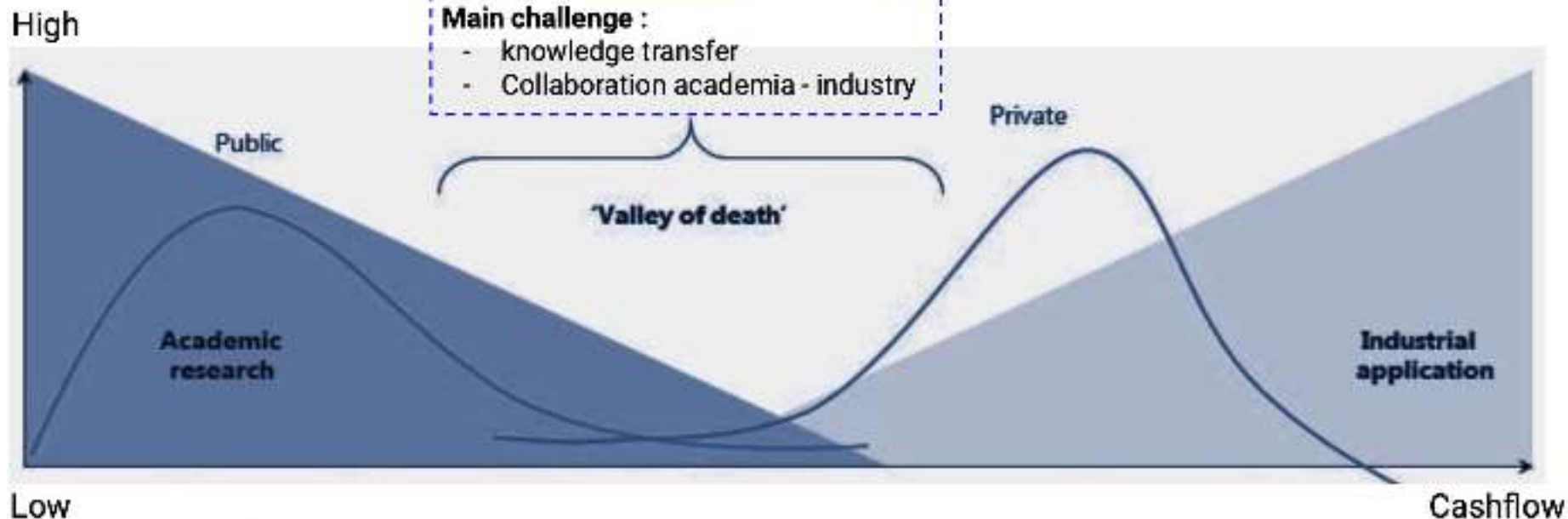
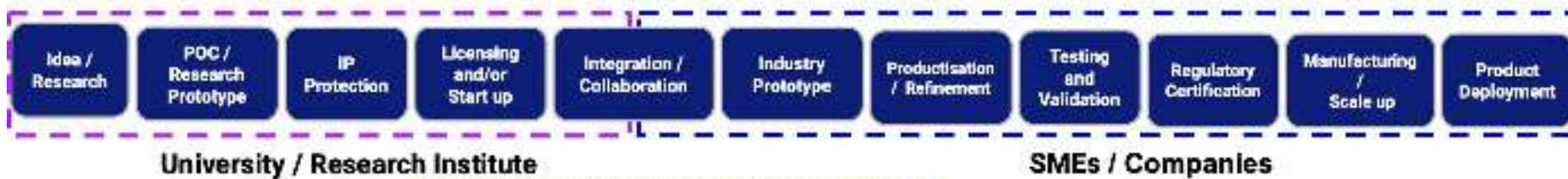
## THE SIGNIFICANCE OF TECH COMMERCIALIZATION



A specific case of Technology Transfer.

It occurs when the party transferring the technology receives goods (money, consideration etc) in exchange for giving up some or all their rights to the technology.

# TECHNOLOGY COMMERCIALISATION PROCESS



# COMMERCIALISATION STRATEGY

Doing everything yourself  
SALES/ EXPORT



Sharing activities with someone else  
PARTNERING/ COLLABORATING



Letting someone else do all or some  
LICENSING/ FRANCHISING



Selling the IP ASSIGNMENT



Equity Investment in a Startup/Spinoff



EXCLUDING THIRD PARTIES				
	Registration	Scope	Actions against third parties' rights	Actions against infringers
Patents	Mandatory	Inventions: technical solutions (Products, processes or uses)	Oppose/cancel third parties applications or registrations based on lack of novelty or inventiveness	Civil/ criminal actions against use or commercialisation of the invention
Trademarks	Mandatory*	Brands, signs used to distinguish commercial origin	Oppose/ cancel third parties applications or registrations based on likelihood of confusion – similarities between signs and goods/services	Civil/ criminal actions against exploitation of identical or confusingly similar signs
Industrial Designs	Mandatory**	External appearance of a product	Oppose/cancel third parties applications or registrations based on lack of novelty	Civil/ criminal actions against use or commercialisation
Copyright	Not mandatory, advisable	Scientific, artistic and literary works	Originality of the work can be challenged in the framework of infringement proceedings	Civil/ criminal actions against unauthorised reproduction, distribution, communication to the public

What drives economic value for your business?

Is the Economic Value Derived From Your:

- Brand?
- Software Code?
- Product Design?
- Technology Features?
- Relationships/Contracts?



## DETERMINE HOW IP PROTECTION SUPPORT THIS

- How do you protect your business drivers?
- How will your IP strategy need to change as your business evolves?
- Sound IP Strategy today allows for your business to evolve tomorrow

*Caution: Don't fall in love with your IP*

*Even if you don't understand the competitive landscape, you should know how your product works and how you plan to make money.*





**THANK YOU!**



@mymranti