



## Intellectual Property - Ownership and Commercialisation Policy and Procedures

### 1. PURPOSE

To provide certainty about and to govern the ownership of Intellectual Property.

### 2. APPLICATION

All Staff

All Students

All parties participating in a University Project whether as Staff Member, Student, University Associate, Visitor, Adjunct Appointee; and

Any party who agrees to be bound by this Policy.

### 3. EXCEPTIONS

*Nil*

### 4. DEFINITIONS

(Noted: Commonly defined terms are located in the [Curtin Common Definitions](#). Any defined terms below are specific to this document)

#### **Academic Staff**

Means employees of the University appointed to continuing or fixed term contracts as academic staff.

#### **Adjunct Appointee**

Means an individual who makes a regular and significant contribution to the teaching, research or other activities of the University.

#### **Artistic Works**

Means a painting, sculpture, drawing, engraving, photograph or any other work of artistic craftsmanship created or made for the sole purpose of aesthetic or artistic merit.

#### **Candidacy**

Means the process in which students undertaking a Higher Degree by Research have their research program, supervisory arrangements and on-going progress approved by the Faculty Graduate Studies Committee in accordance with the Rules for Degree of Master by Research or Degree of Doctor by Research.

#### **Collaborative Project**

Means:

1. a program of work conducted by more than one Originator, where each Originator's contribution to the Intellectual Property cannot be separated from that of the other Originators'; or
2. a program of work that originates from, or is an improvement to, University IP, whether registered or not.

#### **Commercial Enterprise**

Means a company, organisation or institution whose business interests or substantial part business interests include the publication, marketing and/or Commercialisation of Intellectual Property.

#### **Commercialisation or Commercialise**

Is relation to Intellectual Property means to make, sell, copy, adapt, apply, publish, develop, use, assign, license or otherwise utilise the Intellectual Property for the purpose of generating financial or other commercial gains. For the purposes of this Policy, this definition shall exclude fees paid by students enrolled in courses leading to the award of a Curtin degree or diploma.

#### **Computer Works**

Includes without limitation:

- computer software in any form and on any medium;
- multi-media works in any form which are accessible wholly or partly by means of a computer;
- web pages and web sites; and
- Copyright Works created with the intention of accessing them primarily by computer.

#### **Copyright**

Has the meaning ascribed to it in the Copyright Act 1968 (Cwlth) as amended from time to time.

**Copyright Work**

Means any work as defined in the Copyright Act 1968 (Cwlth) including but not limited to artistic, literary, dramatic, or musical work, sound recording, cinematograph film, television broadcast, sound broadcast, published edition of a work, photograph, video recording, CD ROM or Computer Works. For the purpose of this Policy, Copyright Work shall also include Course Materials, monographs and Scholarly Works.

**Course Materials**

Means

- (i) any Copyright Work whether in electronic, written or any other form of media created by a Staff Member specifically for use in, or in connection with a course, subject or unit offered or to be offered by or on behalf of the University or by an affiliated open learning or distance education agency; or
- (ii) any materials commissioned by the University specifically for use in, or in connection with a course, subject or unit offered or to be offered by or on behalf of the University or by an affiliated open learning or distance education agency.

**Course of Duties**

For a Staff Member, means the scope of duties as a Staff Member as set out in the terms and conditions of any relevant enterprise bargaining agreement, contract of employment, duty statement or any other agreement between the Staff Member and the University in effect at the time at which University IP or other IP was generated.

**Deputy Vice-Chancellor, Research**

Means the executive manager responsible for research management at Curtin University.

**Director, IP Commercialisation**

Means the executive manager responsible for commercialisation of University Intellectual Property.

**Faculty**

Means any organisational unit of the University having responsibility for teaching or research in a particular field or fields of knowledge, and includes University Research Institutes. For the purposes of this Policy, it shall also include organisational units within the administrative function of the University.

**Faculty Graduate Studies Committee**

Means the faculty committee responsible for the admission, enrolment, candidature and examination of Higher Degree by Research candidates and which makes recommendations to the University Graduate Studies Committee during the period of the candidate's enrolment.

**Head of School**

Means Head of School or equivalent line manager appointed or elected in accordance with University policy, or the person acting in that position.

**Indigenous Work**

Means a work created predominantly by people of Aboriginal and Torres Strait Islander descent having spiritual, cultural or traditional value.

**Intellectual Property (IP)**

Includes any rights in relation to:

- a circuit layout or semi-conductor chip layout or design or eligible layout as defined in the Circuit Layouts Act 1989 (Cwlth);
- a Copyright Work as defined in the Copyright Act 1968 (Cwlth);
- a design as defined in the Designs Act 1906 (Cwlth);
- a patent, application for a patent, invention, manner, method or process of manufacture, or method or principle of construction as defined in the Patents Act 1990 (Cwlth);
- a plant variety as defined in the Plant Breeders' Rights Act 1994 (Cwlth);
- a trade mark as defined in the Trade Marks Act 1995 (Cwlth); and including related rights and confidential information and know-how in relation to the above rights, or as otherwise determined by the University.

The definition of Intellectual Property may be amended from time to time consistent with Commonwealth legislation and international conventions.

**Net Revenue**

Means, in relation to a particular item or related items of Intellectual Property (IP), the Revenue remaining after the deduction by the University of its reasonable costs incurred in the protection and Commercialisation of University IP in that particular item or related items of Intellectual Property.

**Originator**

Means any party who authors, creates, develops or makes, whether or not in conjunction with another person, any Intellectual Property.

**Purposes**

Means the purposes of the University from time to time as expressed in the University's Statement of Vision, Mission, Values and Goals.

**Resources**

Includes but is not limited to physical infrastructure, facilities, apparatus, equipment, technical support and administrative, financial, human and legal resources.

**Revenue**

Means the gross proceeds of Commercialisation of University IP received by the University within each calendar year. This shall include but not be limited to any amount in the form of upfront fees, milestone payments, royalties, dividends and the proceeds from sale of shares. However, it will specifically exclude R&D funds, grants and direct investments or donations from the University, Sponsors or other third parties.

**Scholarly Works**

Means any article, book, manual monographs, manuscripts, lecture notes and other materials prepared or created by Staff Member, for educational or scholarly purposes, in his or her Course of their Duties but does not include Course Materials or Computer Works.

**Scholarship**

Means a payment made to a student, or on behalf of a student, to assist with expenses associated with study at the University.

**School**

Means any organisational unit of the University having responsibility for teaching or research in a particular field or fields of knowledge, and includes University Research Institutes. For the purposes of this Policy, it shall also include organisational units within the administrative function of the University.

**Specific Contribution**

In relation to the creation of Intellectual Property, means funding or resources which are contributed by the University, but excludes a scholarship awarded by the University as a contribution to a specific University Project.

**Spin-Out Company**

Means a company which is established or exists to Commercialise University IP.

**Sponsor**

Means a third party, external agency or industry partner which has entered into an agreement with the University to undertake research or other services which are likely to generate potentially valuable Intellectual Property.

**Staff Member**

Means a person who has been offered and has accepted a contract of employment from Curtin University.

**Staff or Staff Member**

Means the Academic Staff and non-academic staff of the University.

**Student**

Means a person who is enrolled in a unit, course or program of study approved by the University, and which leads to, or is capable of leading to, an academic award of the University. An academic award of the University is an award contained in the "List of Academic Awards of Curtin University" approved by the Academic Board twice each year.

**Supervisor**

Means the supervisor of a postgraduate research student or person acting with the authority of the University in such a capacity or the Staff Member (normally the Head of School or nominee) supervising an undergraduate student or postgraduate coursework student in a course of studies.

**Thesis**

Means a scholarly report on an original research project(s) based on or manifested in rigorous experimental, theoretical, creative, empirical and/or design inquiry.

**University Associate**

Means a person who is neither a staff member nor principally a student of the University, but who has an association with the University by virtue of their involvement in University activities.

**University IP**

Means Intellectual Property which is owned by the University according to the terms of this Policy or otherwise as a matter of law.

**University Project**

Means a self-contained program of work or research administered by or on behalf of the University which:

- (a) is funded wholly or in part by a Sponsor;
- (b) is funded wholly or in part by a Specific Contribution; or
- (c) is a Collaborative Project.

**Visitor**

Means an individual who is a member of another educational or research institution, and is engaged in teaching, research or other activities of the University.

**5. POLICY STATEMENT**

Subject to the terms set out in this Policy:

- 5.1 Ownership of all Intellectual Property created by a Staff Member in their Course of Duties shall vest in the University EXCEPT for Intellectual Property in the following:
  - 5.1.1 Artistic Works;
  - 5.1.2 Indigenous Works;
  - 5.1.3 Scholarly Works; and
  - 5.1.4 Any other work where a Staff member has entered into a written agreement with the University which provides otherwise.
- 5.2 Ownership of Intellectual Property created by Students shall vest in the Students EXCEPT where such Intellectual Property;
  - 5.2.1 arises from participation in a University Project; or
  - 5.2.2 incorporates University IP.
- 5.3 Where the University decides to commercialise University IP, the Net Revenue received by the University will be shared between the University and the Originator pursuant to clause 7.27 and 7.28.
- 5.4 Where the University decides not to commercialise University IP or to discontinue commercialisation already undertaken, it may assign ownership in the Intellectual Property to the Originator.

**6. OBJECTIVES**

To facilitate and adhere to good practice in the identification, protection, management and the commercialisation of that Intellectual Property, including (without limitation) compliance with National Principles of Intellectual Property Management of Publicly Funded Research for the advancement and wealth creation of the University, its Staff and Students.

**7. PROCEDURES****PROCEDURES - INTELLECTUAL PROPERTY AND STAFF MEMBERS****7.1 Ownership of Intellectual Property created in the Course of Duties**

- 7.1.1 Subject to the terms set out in this Policy, ownership of all Intellectual Property created by a Staff Member in their Course of Duties shall vest in the University EXCEPT for any Intellectual Property specified in this Policy as belonging to the Staff Member. For the purpose of this clause, the University shall own all Intellectual Property created by a Staff Member regardless of whether or not:
  - (a) the Intellectual Property was created inside and outside working hours and on and off University premises; and
  - (b) University Resources were used in the creation of the Intellectual Property.

- 7.1.2 If a Staff Member has created any Intellectual Property that is not related in any way to the work in their Course of Duties, and, he or she, has not used any significant level of University Resources in creating that Intellectual Property, then ownership of such Intellectual Property shall vest in the Staff Member, unless otherwise specified in this Policy or agreed in writing between the parties.
- 7.1.3 If there is any dispute about whether or not Intellectual Property was created in accordance with clauses 7.1.1 or 7.1.2, the Staff Member must in the first instance seek the advice of the relevant Head of School or equivalent line manager who may then refer it to the Deputy Vice-Chancellor, Research. If no agreement can be reached between the parties at this stage then the matter will be resolved in accordance with the Dispute Resolution Process outlined in this policy.

## **7.2 Ownership of Copyright in Artistic Works, Indigenous Works or Scholarly Works**

- 7.2.1 The University recognises:
- (a) the emotional and spiritual link which may exist between the creator of an Artistic Work or Indigenous Work and the work itself; and
  - (b) the importance of the scholarly contribution to knowledge as a significant aspect of the duties of an Academic Staff Member.
- 7.2.2 For the reasons given in clause 7.2.1, a Staff Member who is the Originator of Artistic Works, Indigenous Works or Scholarly Works will own Copyright in such works except where:
- (a) the Artistic Work has been commissioned by the University, in which event the University shall own the Copyright in the Artistic Works;
  - (b) the University and the Staff Member, agree in writing that the Copyright in the Artistic Works, Indigenous Works or Scholarly Works is owned by the University.
- 7.2.3 For the purpose of this Policy, if there is any doubt or dispute as to what works constitute Artistic Works, Indigenous Works or Scholarly Works, the matter will in the first instance be referred to the Deputy Vice-Chancellor, Research, who will consult with relevant groups within the University in an attempt to resolve the issue. If no agreement can be reached between the parties at this stage then the matter will be resolved in accordance with the Dispute Resolution Process outlined in this policy.

## **7.3 Ownership of Copyright in Course Materials**

- 7.3.1 The University will own the Copyright in Course Materials unless:
- (a) a Staff Member creates the Course Materials by incorporating a Copyright Work that already exists and the Staff Member is the owner of the Copyright in that Copyright Work; or
  - (b) the University and the Staff Member agree in writing that the Copyright in the Course Materials shall be owned by the Staff Member.
- 7.3.2 If Copyright Works are created in accordance with 7.3.1(a) and the University wishes to use such Copyright Works, the Staff Member must grant the University a licence to use the Copyright Work in those Course Materials upon the terms set forth in clause 7.6.
- 7.3.3 Course Materials may only be published on a University controlled website or any other website with the prior written permission of the relevant Head of School or equivalent line manager.

## **7.4 Ownership of Copyright Works commissioned by the University**

- 7.4.1 If a Staff Member is the Originator of a Copyright Work and there is no applicable provision for ownership of that Copyright Work in this Policy or any other agreement, then the University shall own the Copyright Work if the University has specifically commissioned the Copyright Work.

## **7.5 Ownership of Copyright Works created in the course of a University Project**

- 7.5.1 If a Staff Member is the Originator of a Copyright Work and there is no applicable provision for ownership of that Copyright Work in this Policy or any other agreement, then the University will own the Copyright Work, if the Copyright Work was created as a result of the Staff Member's participation (whether significant or not) in a University

Project.

## **7.6 Licence to University**

- 7.6.1 With respect to a Copyright Work created by a Staff Member during the course of his or her employment with the University and if the Staff Member is the owner of the Copyright in that Copyright Work pursuant to this Policy, the following shall apply:
- (a) The Staff Member shall grant the University a non-exclusive, royalty-free and irrevocable licence to publish and use the Copyright Work for its educational and research purposes or those of any joint venture "partner" where the joint venture is specifically established for educational or research purposes, or, in relation to any contract collaborative teaching arrangements entered into by the University with external partners.
  - (b) The University's licence under clause 7.6.1(a) is terminated within fourteen days of receipt of the notice as provided for in clause 7.6.1(c).
  - (c) The Staff Member is required to notify the University immediately in writing of the date of the assignment of copyright ownership in the Copyright Work to a Commercial Enterprise.
  - (d) The University is entitled to access that Copyright Work in order to enable the University to freely exercise the licence granted to it under clause 7.6.1(a)
  - (e) The Staff Member may be required and shall be actively encouraged to lodge a copy of the Copyright Work with the library. The costs of such lodgement shall be the responsibility of the Originator of the Copyright Work.
- 7.6.2 The University will endeavour to exercise its rights under clause 7.6.1(a) in a manner consistent with its recognition of the matters set out in clause 7.2.1.
- 7.6.3 The University must consult with the Originator of an Artistic Work, Indigenous Work or Scholarly Work before making any use of the work under clause 7.6.1(a).

## **7.7 Moral Rights**

- 7.7.1 The University will observe any obligations which it may have in relation to moral rights as may be provided in the Copyright Act 1968 from time to time. In any case, the University will seek to protect the rights of attribution and integrity in relation to Copyright Works which it seeks to Commercialise.

## **PROCEDURES - INTELLECTUAL PROPERTY AND STUDENTS**

### **7.8 Ownership of Intellectual Property created by Students**

- 7.8.1 Subject to the terms set out in this Policy, a Student shall own Intellectual Property created by the Student in the course of his or her enrolment, EXCEPT, where such Intellectual Property:
- (a) arises from participation in a University Project; or
  - (b) incorporates University IP.
- in which event the University shall own the Intellectual Property unless otherwise agreed.
- 7.8.2 If there is any dispute about the University's claim of ownership of the Intellectual Property in accordance with clauses 7.8.1(a) or (b), the Student must in the first instance seek the advice of the relevant Head of School who may then refer the matter to the Deputy Vice-Chancellor, Research. If no agreement can be reached between the parties at this stage then the matter will be resolved in accordance with the Dispute Resolution Process outlined in this policy.

### **7.9 Ownership of Copyright in Thesis**

- 7.9.1 Notwithstanding any other provision in this Policy, Students will own the Copyright in their Thesis, unless the Student and the University otherwise agree in writing.
- 7.9.2 The University and the Student may, in certain circumstances, be required to determine the extent and the term to which confidentiality requirements are to be attached to the Thesis pursuant to the University's Higher Degree by Research Regulations or other University Regulations as they may apply from time to time.

## **7.10 Ownership of Intellectual Property in Sponsored research works**

7.10.1 A Student whose research program is supported in whole or part by a Sponsor will be required to assign ownership in their Intellectual Property to the University, unless there is a separate agreement between the Student, the University and Sponsor, in which case the ownership of any Intellectual Property shall be determined by that agreement.

## **7.11 University ownership of Intellectual Property created by Students**

7.11.1 As far as practical, the Student and the University should enter into an agreement contemplated under clause 7.29.1 prior to the commencement of any Student participation in a University Project, which has potential to generate valuable Intellectual Property.

7.11.2 Where the ownership of Intellectual Property created by a Student vests in the University pursuant to clauses 7.8.1(a) or 7.8.1(b) or 7.10.1, then the Student will be accorded the same rights and obligations as a Staff Member for the purposes of this Policy.

7.11.3 Where clause 7.11.2 applies the Student will be entitled to receive payments from the Net Revenue of Commercialisation of the Intellectual Property received by the University in accordance with clause 7.27 and 7.28.

7.11.4 Where clause 7.11.2 applies:

- (a) the University will enter into a separate agreement with the Student which will set out appropriate entitlements to such proceeds;
- (b) the University will ensure that the academic progress of a Student affected by this Policy is not hindered by the provisions of this Policy;
- (c) the University will ensure that the examination of a Thesis is not affected by this Policy without the consent of the Student.

## **7.12 Requirement to consult on Ownership of Intellectual Property**

7.12.1 The Student shall consult the Supervisor regarding the ownership of the Intellectual Property which the Student has created.

7.12.2 The Student and the Supervisor shall be required to attest to an appropriate arrangement for the ownership of any Intellectual Property developed by the Student and which is related to the work done by the Student in the course of their studies. This is necessary in cases in which the University or the Supervisor has contributed significantly to the generation of the Intellectual Property.

7.12.3 The Student, in consultation with the Supervisor, shall also be required to register the Intellectual Property in accordance with the provisions of clause 7.19.

## **7.13 Postgraduate Research Students and Candidacy**

7.13.1 A postgraduate research student, as part of the process of applying for Candidacy, must as far as it is practicable register any Intellectual Property which is or may be developed, in accordance with the provisions of clause 7.19.

## **PROCEDURES - INTELLECTUAL PROPERTY AND OTHER PARTIES**

### **7.14 Visitors and Adjunct Appointments to the University**

7.14.1 A Visitor or an Adjunct Appointee to the University or persons with an adjunct appointment to the University will not be affected by the terms of this Policy otherwise than specified in this clause.

7.14.2 The ownership of any Intellectual Property created by a Visitor or an Adjunct Appointee during the course of any visit or adjunct appointment at the University shall be determined by consultation between the University and the Visitor or an Adjunct Appointee.

7.14.3 If a Visitor or an Adjunct Appointee uses University IP or participates in a University Project:

- (a) the Visitor or Adjunct Appointee must at the request of University sign a confidentiality agreement; and
- (b) the obligations under the confidentiality agreement shall continue to apply for a

period of time as determined under the terms of the agreement and may extend beyond the term or the termination of the visit, adjunct appointment or involvement with the University.

- 7.14.4 An Adjunct Appointee should consult with the relevant Head of School at the time of appointment regarding access to and use of University IP under this Policy.
- 7.14.5 If Intellectual Property with the potential for Commercialisation is created or developed during the course of an adjunct appointment or visit to the University, and no consultation has occurred under this clause 7.14, the Visitor or an Adjunct Appointee must report such development to the Deputy Vice-Chancellor, Research as soon as possible and consult as to the ownership rights and use of such Intellectual Property. The University may require such persons to enter into an agreement with the University regarding the ownership and use of the Intellectual Property and related matters.
- 7.14.6 Upon termination of any visit, appointment or involvement with the University Project, a Visitor or an Adjunct Appointee should consult with the Deputy Vice-Chancellor, Research if they wish to continue to use or have access to any University IP.

## **PROCEDURES - BRINGING INTELLECTUAL PROPERTY TO UNIVERSITY**

### **7.15 Bringing prior Intellectual Property to the University**

- 7.15.1 Where a Staff Member or Student brings, or intends to bring, Intellectual Property to the University which was created:
- (a) prior to enrolment in a course of study; or
  - (b) prior to the commencement of employment with the University; or
  - (c) outside their Course of Duties
- to be used in their Course of Duties or course of studies or otherwise, the Staff Member or Student may be required to assist the University in determining whether that Intellectual Property is entirely owned by the Staff Member or Student by providing the University with:
- (a) an inventory of that Intellectual Property;
  - (b) all documents relating to the ownership of such Intellectual Property, including without limitation any contract, agreement, licensing agreement, or another institution's intellectual property policy;
  - (c) written warranties that the use of such Intellectual Property to the best of their knowledge does not infringe the rights of any third parties.

**7.16** The University recognises that Intellectual Property brought into the University in accordance with clause 7.15.1 is owned by the Originator or a third party if applicable. However, subsequent incremental Intellectual Property created by a Staff Member during his or her Course of Duties or a Student during his or her course of enrolment, will be owned by the University in accordance with the terms set out in this Policy.

**7.17** If the Originator wishes the University to Commercialise the Intellectual Property brought into the University in accordance with clause 7.15.1, the Originator must assign or licence the Intellectual Property to the University as required by the University or obtain such assignments or licences from third parties if applicable.

**7.18** If clause 7.17 applies, the University and the Originator may negotiate a Net Revenue sharing arrangement and enter into an appropriate agreement to give effect to the assignment or licence as the case may be.

## **PROCEDURES - COMMERCIALISATION OF INTELLECTUAL PROPERTY**

### **7.19 Registration of the Creation or Development of Intellectual Property**

- 7.19.1 Where a Staff Member creates or develops University IP and that University IP may be capable of Commercialisation, the Staff Member must register the existence of that University IP by written disclosure to the Director, IP Commercialisation or equivalent containing information outlined in Schedule A.
- 7.19.2 Where a Student creates University IP and that University IP may be capable of Commercialisation, the Student must register the existence of that University IP with their Supervisor who must then provide written disclosure to the Director, IP



Commercialisation or equivalent containing information outlined in Schedule A.

7.19.3 The Director, IP Commercialisation or equivalent will respond to the written disclosure in accordance with Schedule B

## **7.20 Use of University IP prior to Registration**

7.20.1 In order to ensure that University IP is protected, before the University IP is registered, Staff Members and Students must:

- (a) keep confidential and not hold any discussions with any person external to the University concerning the University IP and any work that may result in Intellectual Property being created, which upon creation would belong to the University pursuant to this Policy or any other agreement; and
- (b) not disseminate nor publish any information about any University IP, including but not limited to presenting information about the University IP at a conference or submitting it for publication in a journal article or Thesis, unless:
- (c) prior written consent of the University has been obtained;
- (d) required by any funding or University Project agreement;
- (e) required by law;
- (f) required for the purpose of obtaining legal advice; or
- (g) in the case of publication in a Thesis, appropriate confidentiality obligations apply in accordance with clause 7.9.2

## **7.21 Notification of Intention to Commercialise Intellectual Property**

7.21.1 If the University wishes to commercialise any University IP, the Director, IP Commercialisation will formulate a plan of action in consultation with the Originator of that University IP as soon as possible after the Originator has been notified of the decision.

7.21.2 The plan of action may necessitate the protection of the University IP by (without limitation) applying for patents as appropriate and entering Commercialisation agreements with third parties.

7.21.3 Prior to making application for patent protection, a written assignment will be entered into between the Originator and the University and, where appropriate, any third party that has contributed to the creation of the University IP.

7.21.4 The Director, IP Commercialisation shall be responsible for the implementation of the plan of action as outlined in clause 7.21.1

## **7.22 Assessment of University IP**

7.22.1 Where the Director, IP Commercialisation is required to make an assessment of University IP, the Director, IP Commercialisation must make reasonable efforts to consult, on a confidential basis, an appropriate expert in the relevant field in order to obtain an independent evaluation of the University IP in relation to its Commercialisation.

## **7.23 Duty to Assist**

7.23.1 Where the University decides to commercialise University IP, the Originator of that University IP must provide the University with reasonable assistance in the process of Commercialisation including, but not limited to, making reasonable efforts to provide information promptly, attending meetings with potential licensees and commercial partners, and providing advice on further developments.

## **7.24 Conflict of Interest**

7.24.1 If a Staff Member or Student has or may have a conflict of interest, or believes that such a conflict may arise, the Staff Member or Student should refer to the University Conflict of Interest Policy. (An example of such a conflict of interest is a personal interest in a transaction or potential transaction in relation to which the persons concerned are advising the University.)

## **7.25 Reporting Infringements of University IP**

7.25.1 Any Staff Member or Student who becomes aware of the unauthorised use of

University IP must promptly inform the Deputy Vice-Chancellor, Research in writing of the relevant details.

## **7.26 Duty not to act Contrary to the University's Rights**

7.26.1 A Staff Member or Student who does not own the Intellectual Property vested in a particular work must not:

- (a) apply for any form of protection for that Intellectual Property; or
- (b) Commercialise or otherwise deal with that Intellectual Property; or
- (c) do any act or thing in a manner inconsistent with the University's rights under this Policy.

## **7.27 Distribution of Revenue received from Commercialisation of University IP**

7.27.1 Revenue received from a third party as result of Commercialisation of University IP

- (a) Where Revenue is received from a third party as a result of the Commercialisation of University IP, the Originators will receive 50 per cent of the Net Revenue;
- (b) Net Revenue is determined by deducting the University's external costs for the protection, development and Commercialisation of the University IP, including but not limited to an appropriate allowance for risk, from the Revenue prior to distribution of proceeds in accordance with clause 7.27.1(a);
- (c) Where there is more than one Originator involved in the creation or development of the relevant University IP, each member of the group of Originators is entitled to receive an equal share of any payment made under this clause, unless an agreement entered into between the group of Originators and made available to the University states otherwise. If the members of the group are unable to agree on the apportionment of Net Revenue, the matter will be referred, in the first instance, to the Deputy Vice-Chancellor, Research. If no agreement can be reached between the parties at this stage then the matter will be resolved in accordance with the Dispute Resolution Process outlined in this policy.
- (d) The distribution of Revenue described in this clause 7.27.1 will apply to all Revenue generating arrangements, including but not limited to; licensing, sales and leasing, unless a separate agreement has been entered into between the University and the Originator(s) or a Spin-Out Company has been established in accordance with clause 7.28

## **7.28 Spin-Out Companies**

In some instances the University may decide that the most appropriate avenue for Commercialisation is through establishment of a Spin-Out Company. In such cases, the contribution of Originators may be recognised through the issue of shares in the Spin-Out Company. All proposals to establish a Spin-Out Company for the purpose of Commercialisation must conform with the Universities Governance Requirements – Interests in Entities Procedures.

## **PROCEDURES - ASSIGNMENT OF INTELLECTUAL PROPERTY**

### **7.29 Assignment of Intellectual Property to the University**

7.29.1 If requested by the University, Staff Members and Students must execute, in a timely fashion, all assignments of Intellectual Property or such deed of acknowledgement of ownership of Intellectual Property, necessary to give effect to the University's ownership of Intellectual Property as set out in this Policy or any other agreement.

7.29.2 Originator may have University IP Assigned

- (a) University IP may only be assigned with the approval of the Deputy Vice-Chancellor, Research.
- (b) Where the Deputy Vice-Chancellor, Research considers that the University should not be involved in the Commercialisation of Intellectual Property or has determined that it has not been successful in doing so, then the University may, subject to clause 7.30.2, assign the rights of ownership in the Intellectual Property to the Originator of Intellectual Property under the provisions of this Policy.

### **7.30 Special Conditions applying to Assignment of Copyright in Computer Works and Course Materials**

- 7.30.1 When considering a request to assign ownership of copyright in Computer Works or Course Materials, the University shall have due regard to its commercial and educational interests in determining if such a request should be granted. The Deputy Vice-Chancellor, Research shall seek advice from the Head of School and other senior staff as required in making such a determination.
- 7.30.2 If the University assigns to a Staff Member the copyright in any Computer Works or Course Materials, the University retains a royalty-free licence to produce, publish or use for its purposes those Course Materials or Computer Works until such time as the Staff member has the work published by a Commercial Enterprise.
- 7.30.3 When such Copyright Works become available for sale to Students, the licence granted to the University under clause 7.30.2 will cease.
- 7.30.4 If the above work is recommended for use by Students at the University in connection with any course of study, the work shall be purchased and sold by the University bookshop in the same manner as prescribed texts, as appropriate. However, the University does not guarantee that a text produced and published by a Staff member will be prescribed or continue to be prescribed as a text for Students at the University.

### **7.31 Procedure for Assignment of Ownership of Intellectual Property**

- 7.31.1 A Staff Member or Student who wishes to be assigned the ownership of Intellectual Property referred to in 7.30 created by them, should submit a request in writing to the Deputy Vice-Chancellor, Research, through the relevant Head of School or equivalent line manager stating:
- (a) that the Intellectual Property is original and solely the work of the Staff Member or Student concerned or, if produced jointly, the names of other persons involved; and
  - (b) the purpose for and the conditions under which the Intellectual Property was created, if appropriate.

### **7.32 Conditions, Fees and Royalties applying to the Assignment of University IP**

- 7.32.1 The University reserves the right to impose any conditions it may determine on the assignment of ownership of University IP to a Student or Staff Member, including but not limited to, payment of a royalty or fee determined by the Deputy Vice-Chancellor, Research in the event that the Student or Staff Member Commercialises the Intellectual Property.
- 7.32.2 Any royalty or fee imposed under clause 7.32.1 shall not be unreasonable and reflect as far as practicable;
- (a) Resources spent by the University to develop the University IP;
  - (b) Funds spent by the University on development and protection of Intellectual Property and/or commercialisation of the University IP.
- 7.32.3 The University recognises that Intellectual Property assigned in accordance with 7.29 to 7.32 is owned by the assignee/s. However, subsequent incremental Intellectual Property generated by a Staff Member during his or her Course of Duties will be owned by the University in accordance with this Policy, unless otherwise agreed between the University and the assignee/s.
- 7.32.4 After assignment of the University IP in accordance with 7.29 to 7.32, a Staff Member may continue using such Intellectual Property for further research provided that this is aligned with the Staff Member's and the University's research interests and that the Staff Member continues to attract research funding and produce research publications.
- 7.32.5 Notwithstanding 7.32.4, the Originator may not use the University's Resources for Commercialisation purposes.

## **PROCEDURES - CONFLICTS WITH OTHER AGREEMENTS**

### **7.33 Ownership of Intellectual Property and Other Agreements**

- 7.33.1 Where a Staff Member or Student at the University participates in a University Project that is fully or partly funded by an external party, and a written agreement has been

entered into between the external party and the University which governs the Intellectual Property, ownership of Intellectual Property produced during the course of that University Project will be governed by that agreement and such arrangements will override this Policy.

7.33.2 Where a Staff Member or Student of the University participates in an activity which is funded by the University and a written agreement has been entered into between the Staff Member or Student and the University, then the ownership of Intellectual Property produced in the course of that activity will be determined by that agreement.

7.33.3 Any written agreement between an external party, Student or Staff Member and the University which makes provision for the ownership of Intellectual Property produced in the course of research or any other work funded by that external party will override the provisions of this Policy.

#### **7.34 University to consult where practicable**

7.34.1 If the University wishes to enter into an agreement with an external party concerning the funding and ownership of Intellectual Property produced in the course of a University Project, the University will as far as practicable:

- (a) consult with the Staff Members and Students who will be affected by that agreement; and
- (b) ensure that the agreement reflects the terms of this Policy unless otherwise agreed by the Staff Member or Student as the case may be.

#### **7.35 Assignments and Confidentiality Undertakings**

7.35.1 Where the University enters into an agreement with an external party as contemplated in clause 7.34.1 or otherwise, and:

- (a) the agreement contains obligations concerning the ownership of Intellectual Property or the authorised use or access to confidential information; and
- (b) Staff Members, Students or other persons are involved in activities or have obligations on behalf of the University under that agreement; and
- (c) as a result of those activities or obligations, Intellectual Property or confidential information is or may be created or disclosed,

then each Staff Member, Student or other person must complete such agreements as are required to give effect to the obligations as the University may determine.

### **PROCEDURES - NOTIFICATION OF THIS POLICY AND DISPUTE RESOLUTION**

#### **7.36 Advising Staff and Students on their Rights and Obligations**

7.36.1 The University will take reasonable steps to ensure that this Policy is communicated to Staff and Students.

- (a) At the time of the promulgation of this Policy, the University will:
  - (i) inform Staff Members and Students of their rights and responsibilities in relation to the ownership, assignment and use of Intellectual Property;
  - (ii) conduct educational seminars or otherwise provide access to advice which will assist Staff and Students in furthering their understanding of those rights and responsibilities.
- (b) At the time of enrolment and of application for Candidacy, the University will:
  - (i) inform Students of their rights and responsibilities in relation to the ownership, assignment and use of Intellectual Property under this Policy;
  - (ii) conduct educational seminars or otherwise provide access to advice which will assist Students in furthering the understanding of those rights and responsibilities;
- (c) At the time of commencement of employment or within a reasonable period thereafter, new Staff Members will be:
  - (i) informed of their rights and responsibilities in relation to Intellectual Property under the Policy;
  - (ii) provided with access to educational seminars or advice which will assist in

the understanding of those rights and responsibilities.

### 7.37 Dispute Resolution Process

- 7.37.1 If a dispute arises under this Policy, the parties must use their best endeavours to resolve the dispute amicably between themselves.
- 7.37.2 If the dispute cannot be resolved in this way, the Deputy Vice-Chancellor, Research may, after consultation with the University Grievance Resolution Officer, appoint a mediator who can assist the parties in resolving their dispute.
- 7.37.3 If such a dispute cannot be resolved through the assistance of a mediator, the Deputy Vice-Chancellor, Research may, after consultation with the University Grievance Resolution Officer, appoint an arbitrator to investigate and decide the matters in dispute. The arbitrator may adopt whatever procedure he or she sees fit, provided each party is given a fair hearing.
- 7.37.4 A mediator appointed under this Policy who facilitates an agreement between the parties must record the terms of the agreement in writing. An arbitrator who makes a decision in a dispute under this Policy must provide the parties with written reasons for the decision.
- 7.37.5 In selecting a mediator or arbitrator, the Deputy Vice-Chancellor, Research must, as far as is reasonably practicable, choose a person who is acceptable to all parties and has appropriate expertise to mediate or arbitrate on the matter.
- 7.37.6 The decision of the arbitrator will be final and binding on the parties.

## 8. LIST OF SCHEDULES

Schedule A - Contents of Report Registering the Creation of University IP

Schedule B - Time Limit for Director, IP Commercialisation to respond to Registration

## 9. OTHER RELEVANT DOCUMENTS/LINKS

[Complaints Procedures](#)

[Governance Requirements – Interests in Entities Procedures](#)

National Principles of Intellectual Property Management of Publicly Funded Research

<b>Policy Compliance Officer</b>	<a href="#">Rohan McDougall</a> , Director, Intellectual Property Commercialisation   Office of Research and Development
<b>Policy Manager</b>	Deputy Vice-Chancellor, Research
<b>Approval Authority</b>	Academic Board
<b>Review Date</b>	1 <sup>st</sup> April 2014

## REVISION HISTORY

Version	Approved/ Amended/ Rescinded	Date	Committee / Board / Executive Manager	Approval / Resolution Number	Key Changes and Notes
D001/1.1	Approved	29/09/2000	University Academic Board	UAB 132/00	Document No UAB 79/00
D001/1.1A	Amended	01/12/2000	University Academic Board	UAB 179/00	Updated Approval Authorities, effective 1 January 2001
A005/P1.3	Amended	09/05/2007	Council	C 58/07	Document No 00390/07

D001/1.2	Amended	28/05/2007	Director, Legal and Compliance Services		Formatting Amendment & Reference to Fraud Policy Changed to Corruption and Crime Commission Policy and Procedures
	Administratively Updated	20/03/2008	Director, Legal and Compliance Services		Reformatted and Amended to Reflect Organisational Chart
	Amended	25/03/2011	Academic Board	AB 39/11	Attachment 1 to Document No 00336/11
	Administratively Updated	06/10/2015	Director, Legal and Compliance Services	EC 76/15	Executive Manager Title Changes

## Contents of Report registering the Creation of University IP

1. A written disclosure registering the creation of University IP under clause 7.19 should contain the following details.
  - a) A brief description of the Intellectual Property and its potential for commercial application including;
    - i) the technical advantages of the Intellectual Property compared to current or existing technologies
    - ii) the developmental stage of the Intellectual Property
    - iii) known competitors and potential partners of the Intellectual Property
  - b) The date upon which the Intellectual Property was created.
  - c) The identity of any person or persons who contributed to the creation of the Intellectual Property.
  - d) The identity of any students involved and details of their involvement.
  - e) The Details of any pre-existing and/or previously registered Intellectual Property which was used in creating the Intellectual Property.
  - f) Details of any person other than the Originator/creator who claims any entitlement or interest in the Intellectual Property.
  - g) Details of any University facilities and/or external resources used to create the Intellectual Property, especially grant monies or other research funding.
  - h) Details of any known or existing or partial use or Commercialisation of the Intellectual Property.
  - i) Information on any written and/or oral disclosure of the Intellectual Property.
  - j) Any information which would assist in evaluating, protecting or commercialising the Intellectual Property.
2. The Director, IP Commercialisation may ask the Originator to provide such additional information as is reasonably required and the Originator has a duty to assist and must not withhold any information.

## Schedule B

### **Time Limit for Director, IP Commercialisation to respond to Registration**

1. Within 12 weeks of the receipt of any registration of University IP in accordance with clause 7.19, the Director, IP Commercialisation or equivalent, must respond in writing to the Originator on:
  - a) whether or not the Intellectual Property is considered to be owned by the University; and
  - b) whether or not the University intends to evaluate such Intellectual Property for the purposes of possible Commercialisation.
2. If the Director, IP Commercialisation or equivalent decides under clause 1(b) that such Intellectual Property should be evaluated, then that evaluation must be made and reported to the Originator within 12 weeks of that decision.
3. In relation to clauses 1(a) and 1(b), the Director, IP Commercialisation, as far as is practicable, will respond expeditiously to the registration of, and following evaluation of, University IP.