

University Activities - Intellectual Property: Ownership and Commercialisation Guidelines

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University Activities - Research and Consultancy

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Authorship Policy (RES-12.0)
Risk Management Policy (C-24)
Staff Appeals Policy (HR-6.3)
Vice Chancellor's Authorisations
Applicable Industrial Instruments

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Preamble

1.1 These guidelines describe the basis on which the University claims an interest in and commercialises Intellectual Property created by staff, students and others. As a general rule the University claims ownership of Intellectual Property created by staff members in the course of their employment.

1.2 The University seeks to achieve a legal and equitable balance between the interests of staff, students, the University and external parties in relation to Intellectual Property. Where appropriate the University will allow staff and students to use its Intellectual Property for academic purposes.

1.3 Returns from the commercialisation of Intellectual Property will be shared in accordance with these guidelines.

1.4 The [University Commercial Manual](#) should be consulted by staff and students undertaking research. Advice on commercial matters, including these guidelines can be obtained from [Business Development Managers](#) and/or ITEK Pty Ltd.

Objectives

2.1 The objectives of these guidelines are to:

- create an innovative culture which fosters the creation and commercialisation of Intellectual Property;
- define the circumstances in which the University claims ownership of Intellectual Property created by staff, students and external participants and the procedures required to do so;
- require the identification and reporting of commercialisable Intellectual Property;
- outline the sharing of profits with staff and students who have created commercialised Intellectual Property;
- ensure that staff and students consider the protection of valuable Intellectual Property prior to discussing or otherwise publishing the results of research

2.2 In the circumstance of Intellectual Property created by the University as part of a project involving an external party, University Activities - Research and Consultancy requires that a written agreement outlining the ownership of such Intellectual Property be entered into between the University and the external party. This agreement must be executed prior to the commencement of any such project. These guidelines are subject to the provisions of such agreement.

Definitions

3.1 The following words have the meanings given below:

Business Development Managers are responsible for working with staff and students to identify and report valuable Intellectual Property and assist ITEK Pty Ltd to protect and commercialise Intellectual Property.

commercialise/commercialisation is any means of transfer or exploitation of Intellectual Property (including to make, sell, assign, apply, give away, adapt, copy, publish, manufacture, licence, sub-licence, franchise, exploit, market, distribute or otherwise use or dispose of Intellectual Property) for the purpose of commercial gain and **commercialisable** shall be similarly construed. The use and exploitation of Course Materials and other Intellectual Property by the University whether in its programs, alliances or other standard business activities does not constitute commercialisation under these guidelines notwithstanding that the University may receive returns from such use.

Conventional Scholarly Output means copyright material which is the output of conventional scholarly work. Examples of such Conventional Scholarly Output include academic publications, journal articles, presentations, papers, paintings, books and other creative works. Conventional Scholarly Output does not include Course Materials, software or reports prepared for research and consultancies.

Course Materials means any Intellectual Property created for use in or in relation to a University program, course or short course, whether leading to the award of a degree or not, including for use by an affiliate or partner of the University. Course Materials include course notes, tutorials, questions, exams, online materials and reading booklets. Course Materials do not include materials developed by a student as part of the assessment requirements of a course.

creator means any staff member/s or student/s who create Intellectual Property, whether singularly or in conjunction with others.

External Participant means any person other than a student or staff member who takes part in any research or scholarly output that is being conducted through the University, or who visits any part of the University in which research or scholarship is conducted. This includes adjunct appointees.

Intellectual Property means and includes all forms of intellectual property rights whether arising under legislation or existing at law. Intellectual Property includes all rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields, including the right to apply for registration of such rights, and includes all rights in relation to circuit layouts, copyright, confidential information, designs, inventions and patents, plant varieties and trade marks.

ITEK Pty Ltd or **ITEK** is a wholly owned subsidiary of the University. ITEK is responsible for the assessment, protection and commercialisation of Intellectual Property.

Moral Rights include the right to be identified as the creator of a work, the right not to have authorship falsely attributed and the right to integrity of authorship of a work (the author's right to object to derogatory treatment of his or her work which prejudicially affects his or her honour or reputation).

Net Revenue means the return received by the University/ITEK from the commercialisation of Intellectual Property after deducting all expenses incurred by the University/ITEK in the protection, and commercialisation of that Intellectual Property.

publication means the public disclosure of information on a non-confidential basis by any means (print, digital, audio, video, oral etc) and in any format.

Staff or staff member means any employee of the University at the time of creation of Intellectual Property. This includes former staff members employed at the time of creation of the Intellectual Property but will generally exclude adjunct appointments, students and visitors.

Student means an undergraduate or postgraduate student of the University at the time of creation of Intellectual Property. Where a student creates Intellectual Property in the capacity of a University employee, the student will be considered a staff member in relation to that creation.

Supervisor means a Head of School, Director of Institute or Unit, Director: Centre for Regional Engagement, Manager of Area, Pro Vice Chancellor/Executive Director or other appropriate person to whom a staff member immediately reports and in the case of a student means the staff member who supervises the student's studies. A supervisor must also be suitably authorised pursuant to the Vice Chancellor's Authorisations in each instance.

University-Student Project means a project involving a student where:

- The use of University or University obtained resources, including funding, equipment, Intellectual Property and services, is beyond the level normally made available towards a student's studies (excluding scholarship payments); or
- The project is undertaken for or in collaboration with a staff member, a research team (including other students) or an outside body.

Ownership of intellectual property

4.1 Ownership of Intellectual Property created by staff

4.1.1 The University owns all Intellectual Property created by staff in the course of their employment.

4.1.2 The University owns all Course Materials created by staff members. The use of Course Materials by the University is not considered as commercialisation. These guidelines do not affect the standard distributions established for use of Course Materials. Heads of School are responsible for ensuring that staff maintain details of all Course Materials created within the School. The Director of the Flexible Learning Centre is responsible for ensuring that details of all Course Materials created in the Flexible Learning Centre are maintained.

4.1.3 Unless prior agreement has been reached, the University claims ownership of all Intellectual Property which has been produced through the use of a significant level of University facilities, resources or pre-existing Intellectual Property.

4.1.4 Subject to the other provisions of these guidelines, the University waives its right to ownership of Conventional Scholarly Output in favour of the staff member/s who have created such Conventional Scholarly Output provided that:

4.1.4.1 The Conventional Scholarly Output is not based upon other valuable Intellectual Property owned by the University;

4.1.4.2 The University is provided with a royalty free right to use the Conventional Scholarly Output for its purposes until such stage as the staff member informs the University that copyright in the Conventional Scholarly Output has been transferred; and

4.1.4.3 Where a substantial level of University resources have been used in creating that Conventional Scholarly Output, the staff member distributes any financial return greater than \$20,000 received from the sale, publication or other commercialisation of the Conventional Scholarly Output in accordance with paragraph 11 of these guidelines.

4.2 Ownership of Intellectual Property created by Students

4.2.1 Except as described in paragraph 4.2.2 the University will not generally claim an interest in the Intellectual Property developed by a student.

4.2.2 The University claims ownership of Intellectual Property arising from University-Student Projects.

4.2.3 Where the University owns Intellectual Property created by a student, the student will be entitled to a return from its commercialisation upon the same basis as a staff member.

4.3 Student Intellectual Property Agreements

4.3.1 A student involved in a University-Student Project will generally be required to enter into a Student Intellectual Property Agreement with the University.

4.3.2 The student's supervisor is responsible for ensuring that a Student Intellectual Property Agreement is signed by the student as a precondition to involvement in the University-Student Project. The supervisor must ensure that:

4.3.2.1 Participation will not interfere with the student's right to assessment and academic participation; and

4.3.2.2 Informed consent is obtained. The student should be advised to obtain independent legal advice.

4.3.3 Student Intellectual Property Agreements may be obtained from the Legal Officer, Research Services. Upon completion an original should be sent to the Legal Officer for filing.

4.4 Student Theses and Assessment Materials

4.4.1 Notwithstanding any other provision of these guidelines, the University claims no ownership of copyright in a student's coursework (theses, assignments etc). Where coursework relates to a University-Student Project, the University is entitled to a royalty-free licence to such coursework for the University's purposes, including commercialisation and the filing of patent applications.

4.4.2 Nothing in these guidelines will restrict the rights of a student to assessment. Where a student's coursework contains commercially sensitive information developed by a student, the University may require examiners to execute an appropriate confidentiality agreement. In such circumstances the University may require the publication of such work to be limited or restricted for a maximum period of two years to enable any results to be commercialised.

4.5 External Participants; Visitors and Adjuncts

4.5.1 As a condition of involvement in a University project, an External Participant may be required to sign a confidentiality agreement and/or an Intellectual Property agreement. Such agreement should be considered where confidential information may be obtained or valuable Intellectual Property may be developed by the External Participant. The University staff member authorising the involvement of the External Participant is responsible for ensuring that the relevant agreements are obtained from the Legal Officer and completed.

4.5.2 Failing completion of an agreement the University claims no interest in any Intellectual Property developed by an External Participant other than that to which it is legally entitled.

4.6 University Name and Logo

4.6.1 The University name and logo are owned by the University.

4.4.2 Staff members may use the name and logo of the University for the legitimate purposes of the University.

4.4.3 Approval for third parties to use the University name or logo is provided in accordance with the Vice-Chancellor's Authorisations. The distribution of any Net Revenue arising from such use will be determined by the Vice-Chancellor.

Moral rights

5.1 The University complies with the provisions of the Copyright Act (1968), including in relation to moral rights. Moral rights include the right to be identified as the creator of a work, the right to object to false attribution of authorship and the right to object to any derogatory treatment of the work. The University will use its best endeavours in accordance with accepted academic conventions to ensure that moral rights are upheld. Where possible the University will attribute the names of creators to works and take reasonable steps to ensure that creators can disassociate themselves from any modification or amendment to a work.

Creation of intellectual property

6.1 The [University Commercial Manual](#) describes best practice procedures for undertaking research likely to lead to the creation of valuable Intellectual Property. These include prior invention searches, confidentiality of results until protection and detailed notetaking. Where possible these best practice procedures should be adhered to.

6.2 Students and staff should agree to their rights to jointly written publications prior to undertaking such work. Authorship of publications will be determined in accordance with the University's [Authorship Policy](#) (RES-12.0).

Use of intellectual property

7.1 Use of Intellectual Property owned by a third party

7.1.2 Staff and students must ensure that they do not breach the Intellectual Property rights of third parties. In all instances Intellectual Property may not be used unless there is certainty about the right to undertake such use, generally in the form of written permission. Advice can be obtained from the [Copyright Officer](#) in relation to copyright material or the Legal Officer in relation to other forms of Intellectual Property.

7.2 Bringing Intellectual Property into the University

7.2.1 Intellectual Property created by staff or students outside the University's ownership, including prior to employment, may not be used for University purposes until the University is satisfied that appropriate rights are legitimately granted to it.

7.2.2 A staff member or student who wishes to bring Intellectual Property into the University will inform the supervisor of the ownership details of that Intellectual Property and provide reasonable assistance to verify ownership. In some instances a warranty stating that the use of the Intellectual Property by the University will not infringe any third party rights may be required. The supervisor shall maintain a record of Intellectual Property brought into the University.

7.2.3 Each supervisor shall ensure that new staff members are aware that Intellectual Property cannot be brought into the University without the approval of the supervisor. Where expert advice is required the supervisor shall refer the matter to the Legal Officer.

7.3 Use of University owned Intellectual Property

7.3.1 Staff may use University Intellectual Property in the course of their duties. This should generally not interfere with the protection or commercialisation of that University Intellectual Property.

7.3.2 Publication of commercialisable Intellectual Property should not generally occur until an assessment of that Intellectual Property has been made. In particular, publication of information relating to inventions and other confidential information may not occur until after assessment by ITEK and the filing of appropriate patent protection. Procedures for publications where patent protection is obtained are described in Schedule 1.

7.3.3 University Intellectual Property rights will only be conferred to third parties in accordance with the [Vice Chancellor's Authorisations](#) or by ITEK in the context of commercialisation.

The University recognises that a creator may wish to use University Intellectual Property outside the University. A creator wishing to use University owned Intellectual Property (including Course Materials) for non-University purposes must apply to ITEK (PVC Access and Learning Support in the case of Course Materials) for approval. ITEK/PVC (ALS) will decide whether approval is granted and upon what conditions. Unless stipulated otherwise any licence granted is a personal right and is not transferable to an institution which subsequently employs the creator.

7.4 Infringement of University owned Intellectual Property

7.4.1 Any staff member or student who becomes aware of the unauthorised use of University Intellectual Property must promptly inform ITEK.

ITEK Pty Ltd

8.1 ITEK is the University's commercialisation company and is responsible for the assessment, protection and commercialisation of University Intellectual Property. ITEK is authorised to assign, licence or otherwise deal with University Intellectual Property of a non-operational nature for the purposes of commercialisation.

Disclosure of intellectual property

9.1 A staff member or student who believes they may or have created commercialisable Intellectual Property over which the University may claim an interest shall disclose the Intellectual Property to the Pro Vice Chancellor: Research & Innovation, PVC(R&I), who will advise ITEK. Staff members should generally inform the [Business Development Manager](#) of the creation. Business Development Managers will assist in the disclosure process. Students may inform their supervisor/team leader of the creation. The supervisor/team leader should assist with the appropriate disclosure.

9.2 The PVC(R&I) should also be informed of all work undertaken at the University resulting in the filing of a patent or other form of registrable Intellectual Property protection by any third party.

9.3 Staff will disclose all Intellectual Property they have created which they believe is not owned by the University for assessment of ownership. The procedure is described in Schedule 2.

9.4 All Intellectual Property disclosures will be made in the format requested by the PVC(R&I)/ITEK and will be treated on a strictly confidential basis.

Assessment and commercialisation of intellectual property

10.1 Creators of commercialisable Intellectual Property are responsible for ensuring appropriate confidentiality of the Intellectual Property prior to and during its assessment and protection. ITEK will provide guidance in relation to confidentiality issues.

10.2 Following the initial disclosure ITEK may request the creator to be involved in a group to undertake a preliminary assessment of the Intellectual Property and opportunity.

10.3 ITEK shall have 90 days to assess the complete Intellectual Property disclosure.

10.4 ITEK will make a determination of the ownership of the Intellectual Property. Where the University does not assert ownership in the Intellectual Property the creator/s will be informed. The creator/s may then independently undertake commercialisation provided that the requirements in Schedule 2 are met.

10.5 ITEK will determine the appropriate form of protection of University Intellectual Property, if any. Procedures relating to the patenting of University owned Intellectual Property are described in Schedule 1.

10.6 ITEK will determine whether commercialisation of University Intellectual Property should occur. In some instances further development may be required. In others commercialisation may not be warranted.

10.7 Creator/s may request the right to undertake commercialisation independently of the University where ITEK determines not to proceed with commercialisation. The grant of such rights will be at the discretion of the University and upon conditions deemed suitable by ITEK. The requirements in Schedule 2 must be met.

10.8 ITEK will decide on the appropriate mechanism for commercialisation of University Intellectual Property and will manage such commercialisation. ITEK will form a group to progress commercialisation. Members of this group may include the creator/s, a representative of the area in which the Intellectual Property was created and an ITEK representative.

10.9 It is recognised that the role of creators in the commercialisation process can be vital. At a minimum creators must provide all reasonable assistance required in relation to the assessment and protection of Intellectual Property (including the signing of legal forms, assisting with written patent specifications and conducting novelty searches). Beyond this creators will generally be invited to be involved in the commercialisation process.

Sharing of net revenue from commercialisation

11.1 The successful commercialisation of Intellectual Property will often involve considerable input from various parties, including the creator(s) of that Intellectual Property. The University is therefore generally willing to share the Net Revenue received from commercialisation of Intellectual Property as a reward for involvement and contribution.

11.2 After all development, protection and commercialisation costs are recovered Net Revenue will be distributed to the various stakeholders involved in the creation and commercialisation of the Intellectual Property. The sharing of Net Revenue will be discussed with each of the contributing parties and agreed at an early stage. The actual proportion of distribution of Net Revenue will be determined by the PVC(R&I) upon the advice of ITEK. Consideration will be given to the contributions made to the creation, registration, protection and commercialisation of the Intellectual Property by each stakeholder.

11.3 The sharing of Net Revenue with the creator of Intellectual Property will generally be up to a maximum payment of 100% of the first \$20,000 and up to 40% thereafter of the total accumulated Net Revenue. The PVC(R&I) may agree to a different distribution upon the advice of ITEK.

11.4 Providing equity interests in a spin-off company is another means by which returns from commercialisation may be distributed. Where ITEK has determined to undertake commercialisation through a spin-off company, the creator may hold an equity interest in the company upon the recommendation of ITEK and with the approval of the PVC(R&I). The PVC(R&I) will consider any conflicts of interest arising through the equity interest. Equity interests in spin-off companies and the impact upon distributions of Net Revenue will be agreed in each instance.

11.5 Distribution of Net Revenue to creators will be made in accordance with all applicable taxation laws. Staff will not have a personal claim to any Net Revenue in a University cost centre. However, a supervisor may authorise Net Revenue to be expended on the work related activities of a staff member including the pursuit of teaching, research and scholarship.

11.6 Returns to more than one creator will not be distributed until a basis of distribution acceptable to the creators and the University has been agreed. If the creators are unable to agree on the apportionment of Net Revenue, the matter will be determined by the PVC(R&I). The PVC(R&I) will take into account the contributions of each creator to the creation and commercialisation of the Intellectual Property.

11.7 The University's share of Net Revenue will be distributed as determined from time to time by the PVC(R&I) upon the advice of ITEK. A normal distribution would be equally between ITEK, the University and the area in which the Intellectual Property has been created. ITEK receives and holds the University's share of Net Revenue on its behalf and includes this in its annual calculation and distribution of profit to the University.

11.8 The Vice-Chancellor may redirect returns within the University to ensure the efficient allocation of resources.

Dispute resolution

12.1 Any unresolved dispute in relation to these guidelines must initially be directed to the attention of the PVC(R&I) for resolution. A meeting with any aggrieved parties shall occur within 14 days of notification of the dispute. If no resolution is reached, the matter shall be resolved in accordance with the applicable industrial instrument in relation to matters dealt with by that Agreement and otherwise in accordance with the University's [Staff Appeals Policy](#) (HR - 6.4).

12.2 Where a dispute arises between creators, the relevant supervisor or Pro-Vice-Chancellor will attempt to resolve the dispute and will meet with each aggrieved party within 14 days of notification of the dispute. If no resolution is reached the PVC(R&I) should be notified of and will attempt to resolve the dispute. If no resolution is reached within 60 days the matter shall be sent to external mediation. The costs of any such mediation shall be deducted from any returns accruing to the disputing creators.

Application of guidelines

13.1 These guidelines apply to all staff *and students*. Breaches of these guidelines by staff will be considered as misconduct and the University may initiate disciplinary proceedings in accordance with the applicable industrial instrument.

Schedule 1

Patenting and commercialisation of inventions

1.1 If it is believed that a patent application will be successful and commercially viable, ITEK will arrange for a patent attorney to make a final evaluation of the patentability of the invention and to prepare a provisional patent application.

1.2 Disclosures of the invention should not occur until a provisional patent is filed. It is possible to amend and refile provisional patents provided that the invention has not been publicly disclosed. Where refiling occurs the priority of the original filing date will be lost. To ensure that filing options are not restricted all

disclosures of the invention should be on the basis of a confidentiality agreement. The prior approval of the relevant Business Development Manager must be obtained for any publications during the provisional period. Such publications should be reported to ITEK by the Business Development Manager.

1.3 During the twelve month period of the provisional patent commercial interest should be sought. Nine months after the filing of the provisional, the commercial potential of the invention shall be reassessed by ITEK to determine whether to proceed to the filing of a complete patent specification. Where commercial interest has not been secured in relation to the invention ITEK will only authorise the filing of a complete specification in exceptional circumstances.

1.4 ITEK will determine whether to register the invention in other countries. Registration in other countries will generally proceed through the Patent Cooperation Treaty (PCT) registration process twelve months after the filing of the provisional patent. This allows a single international application to be filed in Australia, effectively deferring individual country filing by up to thirty months.

Schedule 2

Assessment and commercialisation - non-university Intellectual Property

Assessment

1.1 Staff will disclose to the PVC(R&I) - who will advise ITEK - all Intellectual Property they have created which they believe is not owned by the University for assessment of ownership.

1.2 If ITEK determines that the University does claim an interest in the Intellectual Property, the Intellectual Property will be disclosed and assessed in accordance with paragraphs 9 and 10 of these University Activities - Intellectual Property and Commercialisation Guidelines.

1.3 If the University claims no interest in the Intellectual Property the staff member may undertake commercialisation independently of the University provided that the below requirements are met.

Independent commercialisation

2.1 Where the University claims no interest in Intellectual Property, the creator may commercialise the Intellectual Property independently of the University. The University will not accept any responsibility for the commercialisation. In particular:

- The creator may not use the resources, facilities, name or repute of the University unless approved by the PVC(R&I) on an appropriate commercial basis;
- The creator will not be covered by the University's insurance; and
- In some instances the creator may be required to provide an indemnity protecting the University from any claims, loss or liabilities arising from such commercialisation.