Policy Hierarchy link | Intellectual Property Policy
---|---
Responsible Officer | Vice-President and Deputy Vice-Chancellor (Research)
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Superseded Documents | Version 1.0
File Number | 2005/2767

Associated Documents | Intellectual Property Policy
| Guidelines for Disbursement of Net Revenue from IP Commercialisation
| IP Notification Forms

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1. PURPOSE AND SCOPE
These Procedures are made in accordance with the UNSW Intellectual Property Policy, and are compliant with the University’s obligations under the National Principles of Intellectual Property Management for Publicly Funded Research.

2. DEFINITIONS
This Procedure relies on the definitions in the UNSW Intellectual Property Policy.

3. PROCEDURE
In addition to NewSouth Innovations Pty Limited (NSi) and its officers, the only officers of the University authorised to initiate or proceed with the protection or Exploitation or make commitments in relation to, or otherwise deal with UNSW IP are the President and Vice-Chancellor, Vice-President and Deputy Vice-Chancellor (Research) and their delegates.

Creators cannot act on behalf of themselves or The University in dealing with UNSW or NSi owned IP. Any commercial enquiries in relation to the right to Exploit IP owned by The University or NSi received by Staff or Students must be referred to NSi and Staff or Students must not engage in any commercial discussions without NSi’s involvement.

Only NSi and its delegated officers have the authority to deal with or make any commitments relating to IP that has been notified or assigned to NSi.
3.1 Pre-Existing IP

Staff and Students must advise the University of the existence of Pre-Existing IP that they bring to The University within 30 days of their employment, engagement or enrolment.

Staff and Students must complete a Notification of Pre-Existing IP form and provide this to the Vice-President and Deputy Vice-Chancellor (Research). NSi will assess the nature of that IP, and will provide a report to the Vice-President and Deputy Vice-Chancellor (Research). The Vice-President and Deputy Vice-Chancellor (Research) will make a determination and will notify the Staff member or Student of the outcome. NSi will maintain a confidential register of Pre-Existing IP which will be taken into consideration when new IP is developed by that Staff member or Student in the course of their employment or enrolment at UNSW.

Staff or Students must provide to NSi such full, complete and accurate information that is available to them as NSi may reasonably require to enable it to fairly assess the nature, value and ownership of that IP.

3.2 Assignment of Student IP

The assignment of IP by a Student is not a condition of enrolment but may be a condition of participating in certain (usually industry sponsored) research projects. Where the University asserts ownership of Student IP, Students will be required to assign IP to the University.

Where a student chooses not to assign IP to the University for a project where this is a requirement, the Student will be provided with a choice of alternative projects that do not require an assignment of IP.

NSi is responsible for the process of execution of assignment of Student IP. Prior to deciding whether to assign their IP, a higher degree research Student can receive advice on options from the Dean of Graduate Research. Undergraduate and Postgraduate Coursework Students should consult with their Course Coordinator.

The execution by The University of the NSi approved assignment documentation is the responsibility of the Vice-President and Deputy Vice-Chancellor (Research).

3.3 Non-Disclosure for IP Protection

In order for the University to comply with the National Principles of Intellectual Property Management for Publicly Funded Research, Staff members and Students should be conscious of the need to avoid premature disclosure of research results to third parties, including any form of publication of those results, prior to completing a Notification of Intellectual Property Development (an IP Notification) and considering the need to obtain IP protection.

3.4 Completion of a Notification of IP Development Form

Where a Staff member or Student develops IP which The University owns, or over which The University has the right to assert ownership, or where NSi has the right to commercialise and Exploit such IP in accordance with the IP Policy, he/she must complete and return a confidential notification form (Notification of Intellectual Property Development) to NSi (an IP Notification) as soon as possible after its creation.

All Creators must provide to NSi such full, complete and accurate information that is available to each Creator as NSi may reasonably require to enable it to fairly assess the ownership, commercial potential and protection that might be applicable to that IP. A confidential Register of IP Notifications will be maintained by NSi.

3.5 Determination of Student IP ownership

NSi can assist Students in determining their right to own, commercialise and Exploit IP developed by them.
NSi can provide commercialisation services to Students who own their own IP. In this event, Students will be required to assign their IP to NSi and will be afforded the same rights as Staff under the IP Policy.

3.6 Determination by NSi as to commercialisation and Creatorship

All completed IP Notifications will be made to NSi after having been first signed by all Creators and approved by the Head of School. NSi will decide, as soon as reasonably practicable whether or not it wishes to protect and/or commercialise and Exploit the IP. NSi will use all reasonable efforts to make this determination and advise the Creators of its decision within three months of receiving the IP Notification. NSi will also make a determination in relation to the validity of any claim made by a Staff member or Student that they are the true Creator(s) of that IP and in relation to their rights under the UNSW IP Policy.

A decision made at the time not to proceed with or delay a patent application or other applicable form of IP protection may not necessarily exclude an ongoing interest by NSi in commercialising or Exploiting the IP, or prevent NSi from retaining the right to do so.

3.7 Notice of Determination by NSi and Assignment to New South Innovations

NSi will advise the Creators of its decision as to whether to proceed with commercialisation. If NSi elects to commercialise, the Creators will formally assign (Researcher IP Commercialisation Deed) any right, title or interest they may have in that IP to NSi in the form of a contract that specifies the rights that will accrue to the Creators and The University and the obligations they will have to assist NSi with the commercialisation of that IP.

3.8 Commercialisation by NSi

NSi will determine the best strategy to commercialise and Exploit IP, however, NSi will consult with the Creator(s) of that IP before determining the most appropriate commercialisation pathway to be taken. The commercialisation pathway may or may not include the filing of patent applications or other forms of IP protection, the identification of possible licensees, the formation of a limited liability company or some other vehicle or strategy to Exploit the IP.

NSi may decide to suspend or cease supporting the commercialisation or protection of any IP in any market of jurisdiction where, in NSi’s reasonable opinion, the outcomes and benefits to be gained are insufficient to justify further investment.

NSi will keep the Creators informed of the development of the commercialisation of their IP.

3.8.1 Assistance to NewSouth Innovations

The Creators of IP being commercialised or being considered for commercialisation by NSi must provide NSi with all reasonable assistance in the assessment and commercialisation of the IP. This includes the provision of information promptly, providing opinions and assessments frankly preventing premature public disclosure of the IP, attending meetings, giving presentations and executing appropriate documents, as required.

3.9 Assignment of IP back to Staff where NSi does not proceed

If NSi决定 not to proceed with, or continue with, the commercialisation of the IP defined in a particular IP Notification, NSi will advise the Creators of its decision, in writing, in a timely manner. Subject to the Creators having complied with the IP Policy and any Researcher IP Commercialisation Deed entered into, the Creators may request that such IP be assigned to them.

The assignment of IP to the Creators will be considered on a case-by-case basis taking into consideration the overall commercialisation and IP protection strategy of NSi, and will be at the discretion of NSi. Upon assignment, the Creators will be free to protect and commercialise the IP at his/her discretion and cost. The University will not normally direct further resources into this process or the further development of that IP.
In the event that not all of the Creators of specific IP wish to have that IP assigned to them, then those who wish to proceed with the commercialisation of that IP in their own right, and accept the costs and risks of doing so, will have the commercialisation rights and benefits assigned to them by NSi, or UNSW, should NSi decide to do so.

The assignment of IP to the Creators will only relate to that IP specifically described in the IP Notification. The assignment will not cover IP included in other IP Notifications in the same area of research or any improvements/developments made to the assigned IP by the Creators in the course of their employment/enrollment at the University. The Creators shall own any improvements/developments of IP assigned to them that are developed independently of the University.

It will be a condition of assignment of the IP to the Creators that the University or NSi will receive a future benefit amounting to 20% of the net revenue received by the Creators from the Exploitation of the IP after reasonable costs of IP protection and commercialisation by the Creators have been recovered by them, unless otherwise agreed to by the Vice-President and Deputy Vice-Chancellor (Research).

As a condition of assignment to a Creator, the University and/or NSi will retain a non-exclusive right to use the IP for education and/or research purposes. The University and (where necessary) NSi will complete an agreement to this effect with the Staff member or Student. Such an agreement will also require the Creator(s) to report regularly to NSi in relation to progress made with the Exploitation of the assigned IP and the revenue entitlements of UNSW or NSi.

3.10 Sharing in the Benefits of Commercialisation

Where a Staff member or Student develops IP which has been commercialised by NSi, the Guidelines for Disbursement of Net Revenue from IP Commercialisation will apply.

3.11 Taxation Obligations

Taxation obligations associated with the payment of any Net Revenue to Creators of IP are the responsibility of the individuals involved.

4. REVIEW & HISTORY

These Guidelines will be reviewed every three years together with the UNSW Intellectual Property Policy, or earlier if required at the discretion of the Vice-President and Deputy Vice Chancellor (Research).
## Appendix A: History

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<td>24 May 2010</td>
<td>1 July 2010</td>
<td>This is a new procedure.</td>
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<td>Section 3, 3.1, 3.2, 3.9 and 4: position titles</td>
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Appendix B – Procedure for Exploiting & Commercialising IP.

New IP Developed by Staff

Creators complete IP Notification Form

IP Notification Form signed by Head of School

Notification of IP added to NSi Register

NSi assesses ownership of IP and evaluates commercial potential of the IP

NSi decides to Exploit the IP

NSi assessment of commercialisation pathway

Creators sign IP Commercialisation Deed

NSi manages, protects and Exploits IP

33% Net Revenue retained by NSi

33% Net Revenue distributed to Creators

33% Net Revenue distributed to UNSW

NSi decides not to Exploit the IP

NSi re-assessment of the IP

NSi may assign IP to the Creators

Creators commercialise IP

20% Net Revenue returned to UNSW

NSi re-assessment of the IP

75% distributed to Faculty where IP created

25% retained by DVC (Research)