



<b>Responsible Officer</b>		Deputy Vice-Chancellor (Research)	
<b>Contact Officer</b>		Office of the DVC (Research)	
<b>Superseded Documents</b>			
<b>Review</b>			
<b>File Number</b>		961781	
<b>Associated Documents</b>		Notification of Intellectual Property Development	
<b>Version</b>	<b>Authorisation</b>	<b>Approval Date</b>	<b>Effective Date</b>
1.2	Approved by UNSW Council CL04/81	21 June 2004	21 June 2004

## 1. INTRODUCTION

This policy provides guidance for staff (academic and general) and students (undergraduate and postgraduate) on the practices of the University of New South Wales with respect to Intellectual Property. Matters considered include the nature of Intellectual Property, its ownership, exploitation and the specific procedures adopted within the University.

The goal of UNSW's research is to inform and improve its teaching and produce outcomes of benefit to Australia and the world. Intellectual property generated by UNSW researchers should be used to maximise the flow of benefits to society, particularly Australia, and to enhance the reputation of the University and encourage and assist staff in their careers.

The University is committed to providing an environment where scholarship and innovation can flourish and those participating can be justly rewarded for their efforts. At the same time, recognising that certain Intellectual Property is developed as a result of the environment provided by the University and that special relationships exist between the University and its staff and students, the University wishes, where appropriate, to gain benefit from the activity, with the benefits flowing on to future generations of staff and students. The University also intends that negotiations with research funding bodies, government and industry partners and outside institutions should be facilitated by this policy.

In developing the present policy, which draws on past practice, the University has been guided by Intellectual Property policies elsewhere and by statements provided by stakeholders, including the National Tertiary Education Union and the Council of Australian Postgraduate Associations. It acknowledges, in particular, input provided by a publication of the Australian Vice-Chancellors' Committee and has adopted some of the wording provided in that document.

The University reserves the right to modify or add to this policy at any time, provided that such change will only apply to works, inventions and other subject-matter in which Intellectual Property rights subsist that come into being after the effective date of the change.

## 2. INTERPRETATION

In this Policy:

**2.1 Course Materials** means all materials produced in the course of or for use in teaching in any form (including digital, print, video and visual material) and all Intellectual Property in such materials and will include lectures, lecture notes and material, syllabi, study guides, assessment materials, images, multi-media presentations, web content and course software;

**2.2 Exceptional University Resources** means resources of the University which, for the avoidance of doubt, includes facilities, funds, services, equipment, paid leave, staff time and support staff in excess of those normally used or available to staff for producing Course Materials;

**2.3 Intellectual Property** means all statutory and other proprietary rights (including rights to require information be kept confidential) in respect of inventions, copyright, trade marks, designs, patents, plant breeder's rights, circuit layouts, know-how, trade secrets and all other rights as defined by Article 2 of the Convention establishing the World Intellectual Property Organisation of July 1967, all rights to apply for the same and, for the avoidance of doubt, includes:

- Patents under the Patents Act 1990 (Cth.);
- Copyright and moral rights vesting by virtue of the Copyright Act 1968 (Cth.) in literary works (including computer programs), dramatic works, musical works, artistic works, films, sound recordings, broadcasts, published editions and certain types of performances;
- Trade marks registered under the Trade Marks Act 1995 (Cth.);
- Designs registered under the Designs Act 2003 (Cth.);
- New plant varieties under the Plant Breeder's Rights Act 1994 (Cth.);
- Circuit layouts (computer chips) under the Circuit Layouts Act 1989 (Cth.); and
- Trade secrets and other confidential material; and

**2.4 Specifically Commissioned** means where particular consideration (which includes but is not limited to financial consideration or relief from teaching or other duties) is provided or offered by the University by agreement.

### 3. OWNERSHIP OF INTELLECTUAL PROPERTY

#### 3.1 Ownership by the University of Intellectual Property

Except as otherwise agreed in writing by an authorised officer of the University, or stated in this Policy, the University asserts legal and beneficial ownership of Intellectual Property:

- (a) created by academic or general staff in the course of their employment by the University;
- (b) created by students of the University where:
  - (i) generation of the Intellectual Property has required use of University resources;
  - (ii) generation of the Intellectual Property has resulted from the use of pre-existing Intellectual Property owned by the University;
  - (iii) the Intellectual Property belongs to a set of Intellectual Property generated by a team of which the student is a member ;
  - (iv) the Intellectual Property has been generated as a result of funding provided by or obtained by the University;
- (c) created by Visitors, Adjunct or Conjoint appointees where:
  - (i) generation of the Intellectual Property has required use of University resources;
  - (ii) generation of the Intellectual Property has resulted from the use of pre-existing Intellectual Property owned by the University;
  - (iii) the Intellectual Property belongs to a set of Intellectual Property generated by a team of which this person is a member and other members are University employees;
  - (iv) the Intellectual Property has been generated as a result of funding provided by or obtained by the University.

In the absence of any written agreement to the contrary, Visitors, Adjunct and Conjoint appointees who create Intellectual Property falling under this clause will be treated as academic staff for the purposes of this Policy.

### **3.2 Ownership of Course Materials and scholarly works not Specifically Commissioned or created with use of Exceptional University Resources**

The University does not assert its right to ownership of any Intellectual Property in scholarly books, articles, Course Materials, or other scholarly works or subject matter generated (whether in written or any other form) by staff or students, other than:

- (a) where Specifically Commissioned by the University;
- (b) where produced with the assistance of Exceptional University Resources.

The staff member grants to the University a non-exclusive right to use such Course Materials, works or subject matter generated by that staff member for the University's teaching purposes should the staff member leave the University.

### **3.3 Ownership of Course Materials Specifically Commissioned**

The University asserts legal and beneficial ownership of all Course Materials which are Specifically Commissioned. The University may, at its discretion, give the creator(s) of Specifically Commissioned Course Materials a non-exclusive licence to use the Course Materials for teaching purposes only provided that such a licence will not extend to use of the Course Materials for a course in direct competition with a course of the University.

Where the University does not commercialise commissioned Course Materials the creator may request assignment of the rights to the creator for commercialisation by that individual (or team) subject to agreement including a non-exclusive licence to the University for educational purposes.

### **3.4 Ownership of Course Materials created with the use of Exceptional University Resources**

Where Course Materials are or may be created in whole or in part with the use of Exceptional University Resources, a written agreement should be developed between the staff member and the University as soon as practicable which specifies ownership of the Intellectual Property in the Course Materials and rights to revenue in the event of any commercialisation of the Course Materials and any Intellectual Property generated from the production of the Course Materials.

In the absence of a written agreement, the University will own the Course Materials, but the staff member(s) who provided content for the Course Materials will be entitled to at least 33% of the net benefits of any commercialisation of the Course Materials by the University. Where more than one staff member provided content for the Course Materials, the benefits should be shared in proportions as may be agreed by them or in the absence of agreement, in accordance with the degree of their respective contributions as determined by the Vice-Chancellor.

### **3.5 Ownership of artistic, musical, dramatic or creative works**

The University does not assert any right or claim to ownership of the Intellectual Property in artistic, musical, dramatic or other creative works created or composed by its staff or students, except where these works have been Specifically Commissioned by the University, or are created in whole or in part with the use of exceptional University resources.

### **3.6 Assignments of Intellectual Property**

The University and staff members will execute, in a timely manner, all assignments of Intellectual Property necessary to give effect to the ownership provisions set out above and to allow for the use and commercialisation of the Intellectual Property by the University in accordance with this Policy.

### **3.7 Effect of this Policy on existing arrangements**

Despite any contrary provision in this Policy, all contracts and arrangements existing at the time of the adoption of this Policy between the University and governments, corporations or other external organisations, which relate to Intellectual Property and in which the University has an interest, will remain in full force and effect, including those where the ownership of developed Intellectual Property is vested in a third party.

### **3.8 Assignment of ownership by the University**

The University reserves its right to transfer the ownership of its Intellectual Property to third parties in accordance with this Policy, or otherwise, where practicable, following consultations with the creator(s) of the Intellectual Property.

### **3.9 Dealings by staff members or students**

Except where expressly permitted under this Policy no staff member or student may apply for in their own name, assign, license or otherwise deal with Intellectual Property which is the property of the University without the written consent of the University.

## **4. STUDENTS**

### **4.1 Conditions to apply to Students**

Where students are involved in activities that could lead to the development of Intellectual Property over which the University or a third party may claim ownership, the following conditions will apply:

- (a) participation in the research should not interfere with the assessment of the student's academic performance;
- (b) the student's rights in Intellectual Property in any thesis or publications arising from the research should be protected;
- (c) the student should receive considerations and returns commensurate with those provided for staff, including a say as to the integrity of the Intellectual Property;
- (d) the student's future career choices should not be closed by the choice to work in a confidential area of research;
- (e) it should be made clear to students what the nature of the work is before they undertake the activity that leads to the claimable Intellectual Property;
- (f) any confidentiality and ownership of Intellectual Property agreement should only be signed by students after they have been first advised to obtain independent advice;
- (g) any delays in publication of the thesis that arise from a confidentiality agreement should be limited to a maximum of two years.

### **4.2 Student research at other Institutions**

Where students of the University may be involved in research at institutions which are affiliated with the University or at institutions other than the University, agreement should be reached with that institution regarding the rights of the student to Intellectual Property

with a view to ensuring that the student's rights under this Policy are maintained as far as practicable.

### **4.3 Supervisors**

Where reasonably practicable, supervisors electing to supervise a student in an area likely to lead to claimable Intellectual Property should ensure a confidentiality and Intellectual Property assignment agreement is completed with the student before the work is commenced.

## **5. EXPLOITATION OF INTELLECTUAL PROPERTY OWNED BY THE UNIVERSITY**

### **5.1 Completion of a Notification Form**

Where a staff member or student develops Intellectual Property over which the University claims ownership (excluding Intellectual Property referred to in Section 3.2 and 3.5), the staff member or student must complete and return a confidential notification form (Notification of Intellectual Property Development) to be provided by the Office of the Deputy-Vice-Chancellor (Research) or its nominee to the [Research Office and Unisearch] (a Notification). A confidential register of Notifications will be maintained by the Research Office.

### **5.2 Importance of non-disclosure for Intellectual Property protection**

In order for the University to comply with 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 prior to completing a Notification and consideration of the need to obtain intellectual property protection.

### **5.3 Determination by Unisearch as to commercialisation**

All Notifications will be made available to Unisearch Limited which will decide within a period of two months of receiving the Notification whether or not it wishes to exploit the Intellectual Property commercially.

### **5.4 Notice of determination by Unisearch and assignment to Unisearch**

Unisearch will advise the staff member or student and the University of its decision and, if it elects to proceed, will request that the staff member or student, and the University, complete an assignment of their interests in the Intellectual Property to Unisearch in the form of contracts that specify the rights that will accrue to the staff member or student and the University.

### **5.5 Assignment to staff members or students**

If Unisearch decides not to proceed with the exploitation of the Intellectual Property for a particular Notification, subject to the staff member or student having complied with this Policy the staff member or student may request the University/Unisearch (as applicable) to assign the Intellectual Property to them. Upon assignment the staff member or student will be free to protect and exploit the Intellectual Property at his/her discretion and cost, subject to the interests of any third parties. It is a condition of assignment of the Intellectual Property to the staff member or student that the University receives a benefit amounting to 20% of the revenue received from the exploitation of the Intellectual Property after costs have been recovered [and that the University retains a non-exclusive right to use the Intellectual Property for education and research purposes]. The University and (where necessary) Unisearch will complete an agreement to this effect with the staff member or

student.

## **5.6 Sharing in the benefits of commercialisation**

The share of any net benefit (being benefits after costs are recovered and the legitimate claims of any third parties are satisfied) flowing to a staff member or student who is the creator of Intellectual Property commercialised through Unisearch will be determined by negotiation between Unisearch and the staff member or student involved, with the guideline being that the staff member should receive at least 33% of the net benefits. Where more than one staff member or student has created the Intellectual Property, the agreed benefit should be shared in proportions as may be agreed by them. Taxation obligations associated with benefits flowing to creators of Intellectual Property are the responsibility of the individuals involved. For the avoidance of doubt, benefits may take the form of a revenue, equity or shares, a right to convert to equity or shares or other non-cash benefits, dependent upon the commercialisation path.

Student creators of Intellectual Property will be treated equivalently to staff members in determining their share of benefits flowing from the commercialisation of Intellectual Property.

## **5.7 Commercialisation by Unisearch**

Without limiting Unisearch's discretion in undertaking commercialisation of Intellectual Property, in commercialising the Intellectual Property, it will consult with the creator of the Intellectual Property before determining the appropriate commercialisation pathway to be taken. This may include the filing of patent applications, the identification of possible licensees or the formation of a limited liability company to exploit the Intellectual Property.

## **5.8 Assistance to Unisearch**

The creators of Intellectual Property being commercialised by Unisearch must provide Unisearch with all reasonable assistance in the exploitation of the Intellectual Property including by providing information promptly, attending meetings and executing appropriate documents without delay.

## **5.9 Commercialisation of Specifically Commissioned Works**

The procedures outlined in this Section 5 do not apply to Specifically Commissioned Works. For such works a contract will be developed prior to the work being commenced, with the assistance of the University's Legal Office, and a copy of the contract will be maintained on the Intellectual Property register held by the Research Office.

## **5.10 Commercialisation of works for which ownership is not asserted by the University**

Notwithstanding the exclusions to ownership of Intellectual Property in Sections 3.2 and 3.5, the University reserves the right to approach staff authors of works which fall within those Sections which are not Specifically Commissioned and which have not been created with the use of Exceptional University Resources where the net return from exploitation in any one year exceeds \$50,000 for a work, to negotiate with the staff member involved a benefit for the University which would flow to the UNSW Foundation.

## **5.11 Collaborative research partners**

Notwithstanding the need for the University to ensure an equitable return on Intellectual Property, the University acknowledges that, in the context of collaborative research, flexibility in the approach to Intellectual Property negotiation is necessary to ensure that the rights of the third party collaborator are respected.

## 6. MORAL RIGHTS

The University recognises the moral rights of the originators of Intellectual Property in accordance with the Copyright Act 1968 (Cth.). These include the right of fair attribution of authorship or invention, the need for work not to be altered or used in such a way that it harms the reputation of the originator, and an opportunity for the originator to be involved in determining the final outcome of his/her labours.

The University will use its best endeavours to assist authors in asserting their moral rights in cases where clear breaches of accepted academic conventions occur.

## 7. RESOLUTION OF DISAGREEMENTS OVER IP OWNERSHIP

### 7.1 UNSW Intellectual Property Committee Membership

The membership of this Committee will consist of:

- Members of the Senior Management Group with responsibility for research and/or education as nominated by the Vice-Chancellor
- 2 Associate Deans (Research)/(Education)
- A nominated member of the Committee on Research
- Research Student Representative from the Committee on Research/Education
- University Solicitor or Research Office Solicitor
- Unisearch Representative

### 7.2 Terms of reference for the Committee

The Committee will have the following terms of reference:

- (a) To make recommendations within the framework of this policy on Intellectual Property matters that are contentious or, due to exceptional circumstances, fall outside this Policy.
- (b) To review this Policy from time to time to ensure it is consistent with best practice.
- (c) To make recommendations on Intellectual Property involving students matters where there is a dispute.

### 7.3 Resolution of disputes regarding ownership of intellectual property

In the first instance, the UNSW Intellectual Property Committee will be the arbiter as to whether the University has a legitimate claim to Intellectual Property developed by staff or students. Where a member of staff or a student believes that he/she may have grounds to contest the University's claims to ownership of any Intellectual Property, they should bring the dispute to the attention of the Intellectual Property Committee at the time that the development of the Intellectual Property is notified or as soon as practicable. Should he/she disagree with the decision of the Intellectual Property Committee, they may ask the Vice-Chancellor to refer the matter to an independent expert, who will be agreed upon by all the parties. The decision of this independent expert will be conducted according to all principles of procedural fairness, and shall be regarded as final and binding on all parties. The process of determining the ownership of Intellectual Property should be completed expeditiously and, except in unusual circumstances, within one month.

### 7.4 Resolution of disputes regarding arrangements with Unisearch

Where a staff member or a student is unable to reach agreement with Unisearch with respect to the exploitation of Intellectual Property under Section 5.5, they may refer their grievance to the Deputy-Vice-Chancellor (Research) or to the Officer appointed by the Vice-Chancellor for that purpose who will attempt to resolve the dispute by mediation within a period of one month. In the event of a continuing grievance, the matter will be determined by an independent expert nominated by the Vice-Chancellor.

## 7.5 Confidentiality of disputes

All matters associated with the resolution of Intellectual Property disputes under this Section will be held confidential.

\* "Ownership of *Intellectual Property in Universities* Australian Vice-Chancellors' Committee, February 2002

Archived Document



## Appendix A: History

Version	Authorised by	Approval Date	Effective Date	Sections modified
Guide	Vice-Chancellor	October 1983	October 1983	Section 2.10.3: Inventions and Patents within the <i>Guide to Procedures: For official University use only</i>
1.0	UNSW Council (CL97/4)	3 February 1997	3 February 1997	
1.1	UNSW Council (CL000/34)	22 May 2000	22 May 2000	Clause 3.3 amended
1.2	UNSW Council (CL04/81)	21 June 2004	21 June 2004	Revised section 2, section 3.3, and re-formatting

Archived Document