

# Disclosing and Exploiting Intellectual Property (IP) Procedure

## Purpose

The purpose of this procedure is to set out the principles and practices of The University of New South Wales with respect to disclosing and exploiting IP. Matters considered in this procedure include the disclosure of IP, the assignment of IP and the associated specific procedures adopted within the University to manage IP

This procedure is made in accordance with the UNSW [Intellectual Property \(IP\) Policy](#) and is compliant with the University's obligations under the *National Principles of Intellectual Property Management for Publicly Funded Research*.

## Scope

This procedure applies to all staff (academic, professional, technical and administrative) and affiliates of the University and students (undergraduate and postgraduate).

This procedure is incorporated by reference in the terms and conditions of the contract of employment of staff, letters of appointment of Affiliates and in the conditions of enrolment of Students.

The [Intellectual Property \(IP\) Policy](#), [Disbursement of Net Revenue from IP Commercialisation Guideline](#) and the [Guidelines for Copyright Ownership](#) form part of this procedure.

This procedure and the IP Policy come into effect on the Effective Date. IP created prior to that date will be governed by the IP Policy in place at the time.

This procedure and the [Disbursement of Net Revenue from IP Commercialisation Guideline](#) will apply to all IP formally disclosed to the University through NewSouth Innovations (NSi) from the Effective Date and, to the extent that there is no conflict with prior IP Policies or existing agreements, to all IP previously notified to NSi.

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## 1. Introduction

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, Deputy Vice-

Chancellor Research and Enterprise and their delegates, and NewSouth Innovations Pty Limited (NSi) and its officers.

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 the Division of Research and Enterprise, Industry and Innovation and staff or students must not engage in any commercial discussions without Division of Research and Enterprise – Industry and Innovation's involvement.

Only delegated officers and employees in the Division of Research and Enterprise – Industry and Innovation have the authority to deal with or make any commitments relating to IP that has been notified or assigned to the University and/or NSi.

## **2. Pre-Existing IP**

Pre-existing Intellectual Property means IP that is owned by a staff member or a student prior to the date of their employment or enrolment at UNSW. The University does not assert ownership over Pre-Existing IP. Staff and students must advise the Industry and Innovation Office (Division of Research and Enterprise) of the existence of Pre-Existing IP that a staff member or student brings to the University within 30 days of their employment or enrolment.

Staff and students must complete a [Pre-existing Intellectual Property Notification Form](#) (with full, complete, and accurate information that is available to them as may reasonably require to enable a fair assessment of the nature, value, and ownership of that IP) and provide this to the Industry and Innovation Office. 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.

## **3. 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.

Industry and Innovation 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 assignment documentation is the responsibility of the Deputy Vice-Chancellor, Research and Enterprise.

## **4. 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.

## **5. 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 has the right to commercialise and Exploit such IP in accordance with the [Intellectual \(IP\) Property Policy](#), he/she must complete and return a confidential IP Notification form (*Notification of Intellectual Property Development*) to NSi through Industry and Innovation (an IP Notification) as soon as possible after its creation.

All Creators must provide in the IP Notification such full, complete and accurate information that is available to each Creator as may reasonably be required to enable a fair assessment of the ownership, commercial potential

and protection that might be applicable to that IP. A confidential Register of IP Notifications will be maintained by NSi.

## **6. Determination of Student IP ownership**

Industry and Innovation can assist students in determining their right to own, commercialise and Exploit IP developed by them.

Industry and Innovation 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 [Intellectual Property \(IP\) Policy](#).

## **7. Determination by Industry and Innovation as to commercialisation and Creatorship**

Industry and Innovation will decide, as soon as reasonably practicable after receiving an IP Notification whether or not it wishes to protect and/or commercialise and Exploit the IP. Industry and Innovation will use all reasonable efforts to make this determination and advise the Creators of its decision within three months of receiving the IP Notification. Industry and Innovation 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 Intellectual Property 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 Industry and Innovation in commercialising or Exploiting the IP or prevent them from retaining the right to do so.

## **8. Notice of Determination by Industry and Innovation and assignment to NSi**

Industry and Innovation will advise the Creators of its decision as to whether to proceed with commercialisation. If Industry and Innovation 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 with the commercialisation of that IP.

## **9. Commercialisation by Industry and Innovation**

Industry and Innovation will determine the best strategy to commercialise and Exploit IP, however, it will consult with the Creator(s) of the 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.

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

Industry and Innovation will keep the Creators informed of any developments in the commercialisation of their IP.

### **9.1. Assistance**

The Creators of IP being commercialised or being considered for commercialisation by Industry and Innovation must provide it 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.

## **10. Assignment of IP back to staff where commercialisation does not proceed**

If Industry and Innovation decides not to proceed with, or continue with, the commercialisation of the IP in a particular IP Notification, it will advise the Creators of its decision, in writing, in a timely manner. Subject to the

Creators having complied with the [Intellectual Property \(IP\) 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, and will be at the discretion of Deputy Vice Chancellor, Research and Enterprise or its delegate. 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 and/or UNSW, should there be a decision 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/enrolment 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 Deputy Vice-Chancellor, Research and Enterprise.

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.

## 11. Sharing in the Benefits of Commercialisation

Where a Staff member or Student develops IP which has been commercialised by the University, the [Disbursement of Net Revenue from IP Commercialisation Guideline](#) will apply.

## 12. Taxation Obligations

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

**Version:** 1.6

**Effective:** 6 August 2024

**Responsible:** Deputy Vice-Chancellor, Research and Enterprise

**Lead:** Director, Business Development and Commercialisation

## Appendix 1: Roles and responsibilities

### Authority for procedures and instructions

The following UNSW officers are authorised to maintain and change the procedure sections of this policy in accordance with the *Policy Framework Policy*:

1. Director, Business Development and Commercialisation

### Legislative compliance

1. This Procedure supports the University's compliance with the following legislation:
  - 1.1. University of New South Wales Act 1989 (NSW)

### Related documents

- Disbursement of Net Revenue from IP Commercialisation Guideline
- IP Notification Forms
- Pre-existing Intellectual Property Notification Form

### Version history

- **Version 1.0** approved by Vice-Chancellor on 24 May 2010 effective 1 July 2010. New procedure.
- **Version 1.1** approved by Head, Governance Support on 8 August 2012 effective 8 August 2012. Section 3, 3.1, 3.2, 3.9 and 4: position titles
- **Version 1.2** approved by Head, Governance Support on 13 February 2013 effective 13 February 2013. Section 3.1: link to Pre-existing Intellectual Property Notification Form.
- **Version 1.3** approved by Deputy Vice-Chancellor Enterprise on 27 July 2018 effective 27 July 2018. Administrative update to senior position titles.
- **Version 1.4** approved by Director of Governance on 7 October 2021 effective 7 October 2021. Administrative update to senior position titles.
- **Version 1.5** approved by Director of Governance on 11 October 2023 effective 11 October 2023. Amendment to definition and link to Pre-existing Intellectual Property Notification Form in section 2.
- **Version 1.6** approved by Director of Governance on 1 August 2024 effective 6 August 2024. Administrative updates to outdated titles, links and references to policy.

## Appendix 2: Procedure for Exploiting & Commercialising IP

