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## 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 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 itself wishes, where appropriate, to gain benefit from the activity, with the benefits flowing on to future generations of staff and students.

In developing the present policy, which draws heavily 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 recent 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. NATURE OF INTELLECTUAL PROPERTY

For the purpose of this policy document, the term "Intellectual Property" means and includes:

- Patents under the *Patents Act 1990*
- Copyright vesting by virtue of the *Copyright Act 1968* 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*.
- Designs registered under the *Designs Act 1996*.
- New plant varieties under the *Plant Breeder's Rights Act 1994*.
- Circuit layouts (computer chips) under the *Circuit Layouts Act 1989*.
- Trade secrets and other confidential material

"Ownership of Intellectual Property in Universities" Australian Vice-Chancellors' Committee February 1995

### 3. OWNERSHIP OF INTELLECTUAL PROPERTY

3.1 Except as otherwise agreed in writing or stated in this policy, the University asserts ownership of Intellectual Property:

- created by academic and general staff as a result of their employment by the University.
- created by students where:
  - generation of the intellectual property has required substantial use of institutional resources
  - generation of the intellectual property has resulted from the use of pre-existing intellectual property owned by the University
  - the intellectual property belongs to a set of intellectual property generated by a team of which the student is a member
  - the intellectual property has been generated as a result of funding provided by or obtained by the institution

3.2 In keeping with its past practice, the University does not assert its right to ownership of any Intellectual Property in scholarly books, articles, audiovisuals, lectures or such other scholarly work or subject matter generated (whether in written or any other form) by staff or students, other than that specifically commissioned by the University. However, it reserves the right to use works of subject matter generated by a staff member for its teaching purposes should the staff member leave the University.

3.3 The University does assert ownership of commissioned courseware (lecture notes, radio broadcasts, audiovisual material and the like) which have been developed to further its teaching function and result in specific considerations to the staff member(s) or student(s) involved. Such commissions [which may include financial benefit or a relief from teaching duties] are to be based on a contract and, should the author of courseware relocate at another institution, he/she may, at the discretion of the commissioning unit, be granted a non-exclusive licence to use the courseware for sole teaching purposes, but not for the implementation of a course in direct competition with that at UNSW.

3.4 The University does not assert any right or claim to ownership of the Intellectual Property in artistic works, musical, dramatic or other creative works created or composed by its staff or students, save where these works have been specifically commissioned by the University.

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

3.6 The University reserves its right to transfer the ownership of Intellectual Property claimed under the above provisions to third parties, following consultations, where possible, with the creator(s) of the intellectual property.

## **4. INVOLVEMENT OF STUDENTS IN ACTIVITIES LIKELY TO LEAD TO THE GENERATION OF INTELLECTUAL PROPERTY**

**4.1** Where students, both undergraduate and postgraduate, 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 should apply:

- participation in the research should not interfere with the assessment of the student's academic performance and the student's rights in intellectual property in the thesis and publications arising from the research should be protected
- the student should receive considerations and returns commensurate with those provided for staff, including a say as to the integrity of the intellectual property
- the student's future career choices should not be closed by the choice to work in a confidential area of research
- 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
- any confidentiality and ownership of intellectual property agreement should only be signed by students after they have been first advised to obtain independent advice
- any delays in publication of the thesis that arise from a confidentiality agreement should be limited to a maximum of two years

**4.2** As a general rule, the University requires supervisors electing to supervise a student in an area likely to lead to claimable intellectual property to complete a confidentiality and intellectual property assignment agreement with the student before the work is commenced.

## **5. EXPLOITATION OF INTELLECTUAL PROPERTY**

**5.1** Where a staff member or student develops intellectual property over which the University claims ownership (i.e. intellectual property not excluded by Section 3.2 and 3.4), he/she will complete and return a confidential notification form (Notification of Intellectual Property Development) which will be provided by the Office of the Deputy Vice-Chancellor (Research and International). A confidential register of intellectual property developments will be maintained by this Office.

**5.2** The notification will be made available to Unisearch Limited which will decide within a period of two months whether or not it wishes to commercially exploit the intellectual property.

**5.3** Unisearch will advise the staff member or student of its decision and, if it elects to proceed, will request that the staff member or student complete an assignment of the intellectual property to Unisearch for a consideration in the form of a contract that specifies the rights that will accrue to the staff member or student. At this time the University will also be advised of Unisearch's decision.

**5.4** Should Unisearch decide not to proceed with the exploitation of the intellectual property, the staff member or student will be free to protect and exploit the intellectual property at his/her discretion, subject to the interests of any third parties and a requirement 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. The University will complete an agreement to this effect with the staff member or student and will assign its interest in the intellectual property to this person(s).

**5.5** The share of any net benefit [i.e. benefit after costs are recovered and the legitimate claims of any third parties are satisfied] flowing to a staff member who is the innovator of intellectual property commercialised through Unisearch should be

determined by negotiation between Unisearch and the staff member involved, with the guideline being that the staff member should receive at least 33% of the net benefits resulting. Where more than one staff member is involved, the benefits should be shared in proportions as may be agreed by them. Taxation obligations associated with benefits flowing to innovators of intellectual property are the responsibility of the individuals involved.

**5.6** Student innovators of intellectual property shall be treated equivalently to staff members in determining their share of benefits flowing from the commercialisation of intellectual property.

**5.7** Where Unisearch commercialises intellectual property, it will consult with the innovator before determining, as it sees fit, the appropriate action 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** The innovators of intellectual Property being commercialised by Unisearch shall provide it with all reasonable assistance in the exploitation of the process, by providing information promptly, attending meetings and executing appropriate documents without delay.

**5.9** The procedures described above will not apply to commissioned works for which the provisions of the Copyright Act would normally apply. For such cases a contract will be developed prior to the work being commenced, with the assistance of the University's Legal Officer being obtained, and a copy of the contract being maintained on the intellectual property register held in the Office of the Deputy Vice-Chancellor (Research and International).

**5.10** Notwithstanding the exclusions to claim of ownership of developed intellectual property in Sections 3.2 and 3.4, the University reserves the right to approach staff authors of non-commissioned work where the net return in anyone year exceeds \$50,000 for anyone piece of work, to negotiate with the staff member involved a benefit for the University which would flow to the University Endowment.

## **6. MORAL RIGHTS**

**6.1** The University recognises the moral rights of the originators of intellectual property. 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. It is noted that moral rights are not enshrined in Australian legislation on intellectual property. Nonetheless, 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. DISPUTE RESOLUTION**

**7.1** In the first instance, the Deputy Vice-Chancellor (Research and International) will be the arbiter over whether the University has a legitimate claim over intellectual property developed by staff or students. Where staff or students believe that they have grounds to contest the University's claims under the policies described in Section 3 above, they should bring the situation to the attention of the Deputy Vice-Chancellor (Research and International) at the time that the development of the intellectual property is notified. Should they disagree with the ruling of the Deputy Vice-Chancellor, they may address their case to an independent arbiter agreed to by the Vice-Chancellor and by the parties in dispute. The decision of this arbiter will be final and bind all parties. The process of determining the ownership of intellectual property

should be completed expeditiously and, except in unusual circumstances, within one month.

**7.2** Where staff members or students are unable to reach a mutually satisfactory accommodation over the exploitation of intellectual property with Unisearch, they may refer their grievance to the Deputy Vice-Chancellor (Research and International) who will attempt to resolve the difficulty by mediation within a period of one month. In the event of a continuing grievance, the matter will be determined by an independent arbiter recommended by the Vice-Chancellor, with the recommendations of this arbiter being binding on all parties.

**7.3** All matters associated with the resolution of intellectual property disputes will be held confidential.

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## Appendix A: History

Version	Authorised by	Approval Date	Effective Date	Sections modified
Guide	Vice-Chancellor	October 1983	October 1983	Section <b>2.10.3: Inventions and Patents</b> within the <i>Guide to Procedures: For official University use only</i>
1.0	UNSW Council (CL97/4)	3 February 1997	3 February 1997	

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