

# INTELLECTUAL PROPERTY (IP) POLICY

<b>Responsible Officer</b>	Professor Les Field Vice-President and Deputy Vice-Chancellor (Research)		
<b>Contact Officer</b>	Bronwyn Greene Executive Officer (Research Policy) Office of the Vice-President and Deputy Vice-Chancellor (Research) Email: <a href="mailto:b.greene@unsw.edu.au">b.greene@unsw.edu.au</a> Phone: 9385 2983		
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<b>Associated Documents</b>	Research Code of Conduct National Principles of Intellectual Property Management for Publicly Funded Research Procedure for Disclosing and Exploiting IP Guidelines for the Disbursement of Commercialisation Revenue Guidelines for Copyright Ownership <a href="#">Pre-existing Intellectual Property Notification Form</a>		
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## 1. PREAMBLE

One of the functions of the University under *The University of New South Wales Act 1989* is the development and commercialisation of Intellectual Property and the transfer of technology via the practical application of research.

IP generated by University researchers is used to maximise the flow of benefits to society, particularly to Australia, and to enhance the reputation of the University and encourage and assist Staff and Students 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. Recognising that certain IP 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 existing and future generations of Staff and Students.

### 1.1 Purpose

This Policy sets out the principles and practices of The University of New South Wales with respect to IP. Matters considered in this Policy include the nature of IP, its ownership, exploitation and the associated specific procedures adopted within the University to manage IP.

## 2. SCOPE

This Policy applies to all Staff (academic, professional, technical and administrative) and Affiliates of the University and Students (undergraduate and postgraduate).

This Policy 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 Guidelines for the Disbursement of Net Revenue from IP Commercialisation, the Procedure for Disclosing and Exploiting IP and the Guidelines for Copyright Ownership form part of this Policy.

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

The Guidelines for the Disbursement of Net Revenue from IP Commercialisation and Procedure for Disclosing and Exploiting IP will apply to all IP formally disclosed to 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.

## 3. DEFINITIONS

For the purposes of this Policy:

**Affiliates** means Conjoint, Adjunct, Emeritus, Honorary and Visiting appointments made in accordance with the relevant UNSW Policies and Procedures.

**Background IP** means any IP owned by the University or NSi that exists at the time new IP is created.

**Commercialisation Costs** means all costs and disbursements incurred by NSi in connection with the commercialisation of specific IP that has been identified and formally assigned to NSi. Commercialisation costs include the costs of managing, registering, protecting and enforcing IP rights, creation of prototypes, models and samples, research and development, proof of concept development, insurance, legal, financial and technical advice, marketing and travel, and other such expenses associated with carrying out that business activity.

**Commercialisation Revenue** means the gross revenue actually received and retained by NSi from the commercialisation and Exploitation of specific IP assigned to NSi, after

the payment of any withholding, goods and services or other taxes, bank fees, transaction fees and other charges. Commercialisation Revenue does not include income received from the provision of research, consultancy or other services.

**Course Materials** means all materials produced in the course of, or for use in, teaching in any form and all IP in such materials including lectures, lecture notes and material, syllabi, study guides, assessment materials, images, multi-media presentations, web content and course software.

**Conjoint/Honorary/Adjunct/Visiting Staff** means individuals appointed to those positions at UNSW in accordance with the relevant UNSW Policy for Appointing Conjoint/Honorary/Adjunct/Visiting Staff.

**Creator** means any of the following:

- a) in the case of a patentable invention subject to the *Patents Act 1990* (Cwlth): the Inventor;
- b) in the case of a literary or artistic work or similar subject to the *Copyright Act 1968* (Cwlth) : the Author;
- c) in the case of designs registrable under the *Designs Act 2003* (Cwlth): the Designer;
- d) In the case of Plant Breeders Rights, under the *Plant Breeders' Rights Act 1994* (Cwlth): the Principal Breeder;
- e) in the case of circuit layouts, under the *Circuits Layouts Act 1989* (Cwlth), the Designer;
- f) in the case of software and computer code: the Software Author; and
- g) in the case of trade secrets and know how: the Contributors to that body of knowledge.

**Exploit means:**

- a. in relation to an Intellectual Property right: the exercise of all the rights exclusively granted to the holder of such Intellectual Property rights by the laws of the jurisdiction in which the Intellectual Property right subsists, including where permitted the right to sub-license those rights;
- b. in relation to a product, kit, apparatus, substance, documentation or information resource (or any part of such materials): to make, distribute, market, sell, hire out, lease, supply, or otherwise dispose of it; and
- c. in relation to a method or process: to use the method or process or to make, distribute, market, sell, hire out, lease, supply, or otherwise dispose of a product, kit or apparatus the use of which is proposed or intended to involve the exercise of the method or process;

and **Exploitation** is similarly defined.

**Intellectual Property (IP)** 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* (Cwlth.);

- Copyright and moral rights vesting by virtue of the *Copyright Act 1968* (Cwlth.) 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* (Cwlth);
- Designs registered under the *Designs Act 2003* (Cwlth);
- New plant varieties under the *Plant Breeder's Rights Act 1994* (Cwlth);
- Circuit layouts (computer chips) under the *Circuit Layouts Act 1989* (Cwlth); and
- Trade secrets and other confidential material under Common Law

**Invention** means any IP that is patentable under the *Patent Act 1990* (Cwlth).

**Net Revenue** means the monetary amount retained by NSi from the Commercialisation Revenue received from the commercialisation of IP after:

- a) total Commercialisation Costs have been recovered or deducted from Commercialisation Revenue ; and
- b) the legitimate claims of third parties are satisfied.

**NSi** means NewSouth Innovations Pty Limited, a UNSW controlled entity that commercialises research and technologies developed at The University.

**Pre-existing Intellectual Property** means tangible IP that UNSW agrees is owned by a Staff member or a Student prior to the date of their employment or enrolment at UNSW in accordance with the Procedure for Disclosing and Exploiting IP.

**Specifically Commissioned** means work requested by the University by agreement, where particular consideration is given. This may include financial consideration or relief from teaching or other duties.

**Staff** means the officers, employees and Affiliates of The University.

**Student** means any Student enrolled in an approved course at The University of New South Wales.

**The University** means The University of New South Wales (UNSW).

**University Resources** means resources of the University which includes without limitation facilities, funds, services, equipment, paid leave, Staff time and support Staff.

## 4. OWNERSHIP OF INTELLECTUAL PROPERTY

### 4.1 Ownership by the University of Intellectual Property developed by Staff

Except as otherwise agreed in writing by the President and Vice-Chancellor, Vice-President and Deputy Vice-Chancellor (Research), or as stated in this Policy, the University asserts legal and beneficial ownership rights over all IP and to ensure that such ownership rights vest in the University Staff must assign to the University all IP:

- (a) created by academic, professional, technical or administrative Staff in the "course of their employment" by The University. Created in the "course of their employment" means the generation, creation or realisation of any act, work, research or idea by reason of:
  - (i) the use of University Resources;
  - (ii) participation in any project or program supported by funding obtained or provided by the University;

- (iii) a course of research being undertaken at the University, either in collaboration with other Staff members or any third party
- (b) created by Affiliates where:
  - (i) generation of the IP has required use of University Resources; or
  - (ii) generation of the IP has resulted from the use of Background IP owned by the University or NSi; or
  - (iii) the IP is a component of IP generated by a team of which this person is a member and other members are University Staff; or
  - (iv) the IP has been generated as a result of any funding provided by or obtained by the University.

#### **4.2 Ownership by the University of Intellectual Property developed by Students**

The University does not assert ownership of IP created by Students unless the IP:

- (i) consists of teaching materials; and/or
- (ii) has been separately assigned to UNSW under a specific agreement with the Student; and/or
- (iii) has been jointly developed with University Staff and the Student is deemed to be a co-Creator; and/or
- (iv) is the subject of an existing agreement between The University and/or NSi with a 3<sup>rd</sup> party (usually associated with industry-sponsored research programs).

The University and/or NSi will have the sole right to protect and commercialise any IP over which it asserts legal and beneficial ownership and may assign or license such IP to third parties, with the right to sub-license, unless otherwise agreed in writing.

#### **4.3 Ownership by the University of Intellectual Property developed by Students who are also Staff**

Except as otherwise agreed in writing by the President and Vice-Chancellor, Vice-President and Deputy Vice-Chancellor (Research), or as stated in this Policy, the University asserts legal and beneficial ownership of IP developed by Students who are also Staff where the IP has been developed as a direct result of their employment.

#### **4.4 Ownership of Pre-Existing Intellectual Property**

The University does not assert ownership over Pre-Existing IP. Staff and Students must advise the Vice-President and Deputy Vice-Chancellor (Research) 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 (refer to the [Pre-existing Intellectual Property Notification Form](#)). If no such advice is received by the Vice-President and Deputy Vice-Chancellor (Research) then any IP developed or disclosed during the period of employment or enrolment will be treated as University owned IP.

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

The University does not assert ownership of any IP in scholarly books, journal articles, Course Materials, or other scholarly works or subject matter generated (whether in written or any other form) by Staff or Students, except where the work is:

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

Subject to the above exclusions, the ownership of IP in scholarly books, articles, Course Materials, or other scholarly works or subject matter generated is retained by the Creator.

The Creator grants to The University a perpetual, royalty free, non-exclusive licence to use such scholarly books, journal articles, Course Materials, or other scholarly works or subject matter generated by that Creator for the University's teaching and research purposes. The non-exclusive licence to use such scholarly books, journal articles, Course Materials, or other scholarly works or subject matter persists should the Creator leave the employ of The University.

#### **4.6 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, provided that such a licence will not extend to the use of the Course Materials for any purpose which is in direct competition to the University.

Where The University does not wish to commercialise Specifically Commissioned Course Materials and advises the Creator(s) accordingly, the Creator(s) may request the assignment of the ownership rights of those Course Materials to the Creator(s) or any one of them. The University will retain a non-exclusive licence for educational purposes.

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

The University does not assert any right or claim to ownership of the IP 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 University Resources.

### **5. COPYRIGHT**

The University has in place Guidelines for Copyright. Further information on Copyright can be obtained from <http://www.gs.unsw.edu.au/copyright/index.html>.

#### **5.1 Copyright ownership statement**

All material in which the University owns the Copyright must include the following Copyright statement:

© Copyright The University of New South Wales [year]

### **6. ASSIGNMENTS OF INTELLECTUAL PROPERTY**

At the request of The University and/or NSi, Creators who are Staff members will execute, in a timely manner, all such deeds of assignment and other documentation necessary to give effect to the IP ownership, protection, use, and commercialisation provisions set out in this Policy.

#### **6.1 Effect of this Policy on Existing Arrangements**

Despite any contrary provision in this Policy, all existing legally binding contracts, deeds and agreements entered into by The University and/or NSi at the Effective Date of this Policy, will remain in full force and effect. Their terms will prevail in the event that a conflict arises with this Policy.

#### **6.2 Assignment of IP Ownership by the University**

The University may assign its rights, title and interests in IP owned by it to NSi and to third parties in accordance with this Policy.

#### **6.3 Dealings by Staff or Students**

No Staff member or Student may act on behalf of The University, or act in their own name, to assign, license, protect or otherwise deal with IP which is the property of, The University or NSi, or over which The University asserts rights under this Policy, unless specifically delegated to do so in writing.

Where a Student owns IP and there are no other Staff or Student Creators, a Student may in their own name, assign, license, protect or otherwise deal with that IP in accordance with the Procedure for Disclosing and Exploiting IP.

## **7. STUDENTS**

### **7.1 Conditions to apply to Students**

Where Students agree to be involved in research activities that could lead to the development of IP over which the University, NSi or a third party may claim ownership or other rights, the following conditions will apply:

- (a) the supervisor or course coordinator will make it clear to Students what the nature of the work and the conditions of their involvement are before they undertake the research activity; and
- (b) participation in the research will not interfere with the assessment of the Student's academic performance; and
- (c) any confidentiality and/or IP assignment agreement should only be signed by Students after they have been first advised to obtain independent advice; and
- (d) the Student must formally assign, in advance, all right, title and interest they may have in any IP to the University or NSi before the Student will be permitted to engage in such research; and
- (e) the Student's copyright and moral rights in any thesis or publications arising from the research will be retained by the Student, unless subject to a third party agreement; and
- (f) the Student will receive consideration and other rights commensurate with those that a Staff member would otherwise have under the Policy, unless subject to a third party agreement; and
- (g) subject to the confidentiality provisions that may be contained in any third party agreement, the student's future career choices will not be restricted by the choice to work in a confidential area of research; and
- (h) any delays in publication of the thesis or any part thereof that arise from a confidentiality and/or assignment agreement will be limited to a maximum of two years, unless otherwise approved by the Dean of Graduate Research.

### **7.2 Student research at other Institutions**

Where Students may be involved in research carried out at institutions which are affiliated with the University or at other institutions independent of the University and where the University does not assert ownership of IP, agreement must be reached in writing between the Student and the host institutions regarding the rights of the Student to IP.

### **7.3 Research Supervisors**

Supervisors electing to supervise a Student in an area whose research activities are covered by third party agreements must ensure a confidentiality and IP assignment agreement is completed between UNSW and/or NSi and the Student before the work is commenced.

Some projects may not be available to Students who choose not to sign a confidentiality and/or IP assignment agreement.

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

Where a Staff member or Student develops IP over which the University asserts ownership rights under this Policy they must follow the Procedure for Disclosing and Exploiting IP.

## **9. DISBURSEMENT OF NET REVENUE FROM COMMERCIALISATION**

Any Net Revenue from IP commercialisation will be disbursed 1/3 to the Creators, 1/3 to NSi (NSi) and 1/3 to The University.

The Guidelines for the Disbursement of Net Revenue from IP Commercialisation will apply.

## **10. VICE-CHANCELLOR AS ATTORNEY**

A Creator will, as required by The University, complete all documentation or any other action that the University or NSi deems necessary for the commercialisation and Exploitation of IP owned by the University or NSi. If a Creator fails to complete any documentation or any other action that the University or NSi deems necessary for the commercialisation and Exploitation of IP owned by the University or NSi, the Vice-Chancellor has the right to execute all such documents and do all such acts as their attorney. The Vice-Chancellor may exercise such power of attorney even if The University benefits from this power. This Power of Attorney does not extend to instances where failure to complete documentation is a result of conflicts as to ownership of the IP, or where there is a dispute between the Creators and NSi. In these instances, the Section dealing with the Resolution of Disputes will apply (Section 10).

## **11. MORAL RIGHTS**

The University recognises the moral rights of the Creators of IP in accordance with the *Copyright Act 1968* (Cwlth.). 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 Creator, and an opportunity for the Creator to be involved in determining the final outcome of their labours.

## **12. DISPUTES OVER IP OWNERSHIP**

### **12.1 Resolution of disputes**

Disputes between Staff, between Students or between Staff and Students arising under this Policy will be dealt with under the Staff Complaint Procedure, Procedure for Handling Allegations of Research Misconduct, Student Complaint Procedure, or Disciplinary Procedures where appropriate.

### **12.2 Resolution of disputes regarding arrangements with NSi**

Where a Staff member or a Student is unable to reach agreement with NSi with respect to the commercialisation or Exploitation of IP or disbursement of Net Revenue, they may refer their grievance to the Vice-Chancellor or to an Officer appointed by the Vice-Chancellor for that purpose. That Officer 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.

## **13. LEGAL & POLICY FRAMEWORK**

The following related UNSW Codes/Policies/Procedures and Guidelines include:

- Research Code of Conduct
- UNSW Code of Conduct
- Conflict of Interest Policy
- Staff Complaint Procedure
- Student Code Policy and Student Complaint Procedure
- Paid Outside Work by Academic Staff Policy



## 14. IMPLEMENTATION

### 14.1 Roles & Responsibilities

The Office of the Vice-President and Deputy Vice-Chancellor (Research) is responsible for the development and implementation of this Policy.

NSi is responsible for the administration of the IP Policy, for the Exploitation and commercialisation of UNSW IP, for the management of the University's IP assets and for the disbursement of Net Revenue.

### 14.2 Support & Advice

Support and advice related to this Policy can be obtained from:

#### For general Policy information and assistance contact:

Bronwyn Greene

Executive Officer (Research Policy)

Office of the Vice-President and Deputy Vice-Chancellor (Research)

Ph: 02 9385 2983

Email: [b.greene@unsw.edu.au](mailto:b.greene@unsw.edu.au)

#### For specific IP and commercialisation information and assistance contact:

Dr Kevin Cullen

CEO, NewSouth Innovations Pty Ltd

Ph: 02 9385 6505

Email: [k.cullen@nsinnovations.com.au](mailto:k.cullen@nsinnovations.com.au)

#### For Copyright information and assistance contact:

Director, Digital Library Services

Ph: 02 9385 3479

Email: [copyright@unsw.edu.au](mailto:copyright@unsw.edu.au)

### 14.3 Communication

This Policy will be communicated through the Policy@UNSW Website, UNSW Research Gateway and NSi website.

## 15. REVIEW

This Policy will be reviewed every 3 years. The Guidelines and Procedures associated with this Policy may be reviewed at any time at the discretion of the Vice-President and Deputy Vice-Chancellor (Research).

## 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
1.3	UNSW Council (CL05/163)	12 December 2005	13 December 2005	Section 1; 7; and Unisearch changed to NewSouth Innovations in all applicable sections.
2.0	Vice-Chancellor	24 May 2010	1 July 2010	Full review
2.1	Vice-Chancellor	30 June 2010	1 July 2010	Section 4.1
2.2	Administrative update by Head, Governance Support	6 March 2013	6 March 2013	Section 3, 4.1, 4.3, 4.4, 13, 14.1, 14.2 and 15

Archived Document