

POLICY



Intellectual Property Policy

Purpose	To describe how the University intends to identify, claim and manage the Intellectual Property (“IP”) of the University, its employees, students and third parties.
Overview	<p>The primary aim of the Policy is to provide a framework to declare and protect the rights of the University and University Members while enabling access and engagement by industry, government and the community on the use and exploitation of the University’s IP for national and global benefit.</p> <p>This Policy is based on principles aimed at facilitating the efficient and timely transfer of our research to industry, government and the community in a form which is capable of creating impact for the community at large and rewarding our employees, students and stakeholders in a commensurate manner.</p> <p>These principles are that the Policy must be:</p> <ol style="list-style-type: none">1. Business friendly2. Commercially reasonable,3. Supportive of entrepreneurial activity, and4. Operationally efficient. <p>In addition, the University is obligated to adhere to the “National Principles of Intellectual Property Management for Publicly Funded Research” prepared in 2001. It is a condition of funding from the Australian Research Council (ARC), the National Health & Medical Research Council (NHMRC) and other research funding agencies that the University observes the National Principles.</p> <p>In order to meet the obligations set out in the National Principles, the University must be able to clearly identify, claim and demonstrate ownership of its Intellectual Property in order to manage and accordingly grant its Intellectual Property rights to third parties (such as commercial partners, employees and students or funding organisations) on a case-by-case basis.</p> <p>DEFINITIONS</p> <p>“Administration Material” is material that is created/generated by the administrative processes of the University, and includes all material that is not teaching or research.</p> <p>“Associate” means any person other than a University Employee or</p>

Student of the University who takes part in any research project or scholarly activity that is conducted by any University Employee or Student of the University, or who visits any part of the University to conduct research, scholarship or any related activity during which time he or she creates IP. Examples of Associates include; Adjuncts, Visiting Lecturers, Honorary staff, Emeritus Professors, Visiting Researchers, Persons employed to undertake research at the University by controlled entities.

“Confidential Information” means all information of a confidential nature, and may include technical, proprietary and operational information, drawings, techniques, processes, know-how, trade secrets, business plans, customer lists and other commercially valuable information of any kind.

“Incidental Use” means the routine use of office, library or other publicly available information, technical facilities, desktop workstations and communication and storage servers.

“Intellectual Property (IP)” includes all copyright and all rights in relation to inventions (including patent rights), registered and unregistered trademarks (including service marks), registered and unregistered designs, Confidential Information, and circuit layouts and all other intellectual property rights resulting from intellectual activity in the academic, industrial, scientific, literary and artistic fields recognised in domestic law anywhere in the world.

“Intellectual Property and Commercialisation Advisory Committee (IPCAC)” is a University Committee responsible for the development of strategy and policy in the areas of IP, innovation and commercialisation. It advises the Deputy Vice Chancellor (Research) on strategic matters relating to the University’s IP and the commercialisation thereof. The Office of Commercialisation oversees the day-to-day management of IP and commercialisation process and will give effect to the decisions of the IPCAC.

“Office of Commercialisation” is an office of the University reporting directly to the Deputy Vice Chancellor (Research) which has delegated authority to undertake Research Commercialisation on behalf of the University.

“Moral Rights” are a sub-category of rights set out in the *Copyright Act 1968* which protect the right of a creator of original copyright works and cinematograph films to be recognised as the creator of those works (the Right of Attribution) and to object to the derogatory treatment of those works (the Right of Integrity) and the right not to have someone else falsely attributed as the creator of those works (the Right of Protection Against False Attribution). Furthermore, moral rights vest in the creator irrespective of his/her employment status and the ownership of the copyright in the work.

“Scholarly Work” is work that includes any article, book, manual,

	<p>musical composition, creative writing or like publication or any audio, digital or electronic media that contains material written by an individual (University Employee, Student or Associate) based on that individual's scholarship, learning or research, but does not include Teaching Material or Administration Material.</p> <p>“Student” means any undergraduate, postgraduate or Non-Award student duly enrolled in the University, whether based on or off-campus.</p> <p>“Teaching Material” means all information, documents, materials or digital or electronic objects created or used for the purposes of teaching and education at the University and includes lecture notes that are made available to students, computer-generated presentations, course guides, overhead projector notes, examination scripts, examination marking guides, course data bases and websites, including personal teaching and lecture notes made available to students.</p> <p>“University Background IP” is Intellectual Property owned or controlled by the University prior to the creation of IP by a Student during the term of their enrolment.</p> <p>“University Employee” means all persons appointed to the academic or professional staff of the University who receive remuneration, whether they hold full-time, part-time or casual appointments.</p> <p>“University Member” means a University Employee, Student and Associate.</p> <p>Document Structure</p> <ol style="list-style-type: none"> 1. Policy Objectives 2. Key Principles 3. Identification and Disclosure of IP 4. Ownership of IP <ol style="list-style-type: none"> 4.1 University Employees 4.2 Students 4.3 Associates 4.4 Independent Contractors 5. Commercialisation 6. Procedural aspects 7. Compliance and Breaches
Scope	All University Members
Policy	<p>1. POLICY OBJECTIVES</p> <p>This Policy has the following objectives:</p> <ol style="list-style-type: none"> a. To encourage originality and innovation for the development of IP by employees, students and their stakeholders including commercial partners;

- b. To facilitate the efficient transfer of University innovation arising from our research to industry, government and the general community;
- c. To appropriately acknowledge and protect the interests of University Members in the development of IP while recognising the investment, input and rights of the University and its stakeholders including commercial partners;
- d. To obtain a commercially reasonable return to the University community from valuable IP by appropriate commercialisation procedures (including establishing an optimal environment for obtaining research funding);
- e. To develop awareness and appreciation within the University community of significant issues in relation to IP, including potential commercialisation, the need not to publicly disclose work until the IP has been appropriately protected, the need to avoid infringing third party rights in the compilation and exploitation of IP, and the need to maintain appropriate records on IP development; and
- f. To be consistent with sound academic and commercial practice, the University's responsibilities, applicable legislative requirements and legal principles.

2. KEY PRINCIPLES

This Policy acknowledges the following basic principles:

2.1 Identification and Disclosure of IP

- a. The University respects the academic rights of University Employees and Students to publish the results of their research or otherwise disseminate those results freely. However, such publishing is subject to compliance with requirements of contracts with third parties pertaining to the research. In addition, where the University Member believes it advantageous to commercially exploit any IP, the IP associated with the research should be appropriately protected before publication.
- b. Confidential Information of the University or third parties contracting with the University must be maintained by University Members.

2.2 Ownership of IP

- a. Unless the employment contract provides otherwise, IP created by a University Employee in their course of employment is the property of the University;
- b. The University will negotiate with any Associate, on a case-by-case basis, to commercialise and share on reasonable terms the

benefits of any IP developed by the Associate during their time working with the University and therefore, in certain circumstances an Associate may be asked to assign her/his IP to the University;

- c. subject to appropriate waiver provisions all University Students enrolled in Higher Degree Research projects and other Students who have a research component formally integrated into their program of study are required to assign their IP rights to the University upon enrolment in return for the same IP benefits as Employees;
- d. The University commits to recognise, respect and protect Indigenous spiritual and cultural beliefs and traditional knowledge as the IP of Aboriginal and Torres Strait Island peoples and other Indigenous peoples;
- e. The University acknowledges the Moral Rights of creators under the Copyright Act 1968.

2.3 Commercialisation of IP

Commercialisation of IP will be considered carefully, with full regard to and in consultation with, the creators and/or IP owners and with:

- a. Recognition of the interests of stakeholders including commercial partners and the community;
- b. Regard to any contractual obligations existing or arising between the University and those stakeholders;
- c. Recognition of the intellectual input of stakeholders including commercial partners;
- d. Assessment of the value of the IP to the University, the community and to its stakeholders including commercial partners; and
- e. Due reward to University Members who created the IP.

3. IDENTIFICATION AND DISCLOSURE OF IP

Subject to the National Principles of IP Management for Publicly Funded Research http://www.arc.gov.au/about_arc/principles_ip.htm and any contracts the University may enter into with third parties that delay, or limit or restrict public dissemination of information, University Employees are entitled to decide whether the results of any research undertaken by them in the course of their employment with the University shall be published or disseminated to other persons to use freely or disclose as they wish in accordance with normal academic practice.

However, if University Members decide that associated IP should be

exploited commercially, it is a requirement of the University that they notify the Office of Commercialisation in a timely manner and agree to be bound by reasonable directions issued by the IPCAC.

3.1 Importance of correctly identifying contributors

It is crucial that creators of IP are correctly identified during the disclosure process. IP protection may be lost if a creator is not correctly identified, for example, failure to name the correct inventors may invalidate a patent.

Correct and complete identification is also required to enable procedures on the distribution of net proceeds/benefits arising from commercialisation of that IP as set out in University policies.

3.2 Treatment of Confidential Information

The University requires that all University Members maintain the confidentiality of Confidential Information. University Employees should also consult the Staff Code of Conduct.

The treatment of Confidential Information is particularly important in the following contexts:

- a. For commercial projects and research that have results that may be protected by way of a patent or other form of registrable IP, successful protection may depend upon keeping the results or invention confidential until the patent (or other registrable IP) application has been lodged;
- b. The University may develop valuable know-how which is not capable of being protected by patent or other forms of registrable IP, but which nevertheless has potential commercial benefits. This know-how can only be protected by upholding comprehensive confidentiality restrictions; and
- c. In circumstances where Members become aware of Confidential Information concerning the University's strategic plans or other information that could affect the commercialisation of IP, or where the University is contractually bound to keep confidential Confidential Information (whether the University's or a third party's).

Under certain circumstances University Employees, Students and/or Associates may be asked to enter into specific confidentiality agreements. University Members are advised not to sign these documents without prior consultation with the Deputy Vice Chancellor (Research) or his/her nominee. This is to protect University Members from assuming unnecessary legal obligations. Independent external legal advice may be arranged if this is warranted. For the avoidance of doubt, the Office of General Counsel serves the best interests of the University and as such is unable to provide any advice to individuals in their personal capacity.

3.3 Respecting third party rights

Under this Policy, University Members are required to respect the rights of third parties in relation to IP, including those belonging to commercial partners. University Members may be required to provide certain information and otherwise co-operate in processes designed to protect third party rights.

Respect for the rights of third parties may involve:

- a. Correctly identifying the ownership of underlying material (or rights therein) for any new development;
- b. Correctly acknowledging the contribution of third parties, including previous employers of University Employees, current employers of Students or other third parties;
- c. Not infringing the Moral Rights of third parties; and
- d. Being respectful of and correctly acknowledging Indigenous spiritual and cultural beliefs. Traditional knowledge or other IP of Indigenous people must be accessed on terms that are fair and with the agreement of the Indigenous people through whom the knowledge or IP is accessed. The right to use or access traditional knowledge (including making a written, visual or audio record) must be respectful of the secrecy or confidentiality obligations imposed on the material by the traditional owners.

3.4 Pre-existing IP

The University must ensure that it treats pre-existing IP appropriately and does not claim rights that it does not have.

To ensure that IP created by a University Member prior to their employment, association or enrolment with the University is appropriately identified, University Members are required to disclose and register all pre-existing IP to the extent that she/he is legally and contractually permitted to do so, within 30 days of commencing at the University.

As part of this process, University Members must inform the University if that IP is subject to any third party rights, for example the rights of the University Employee's previous employer, a Student's current or former employer, or a publisher.

Existing University Members are also required to make a similar disclosure if they become aware that anything that they have developed is based on pre-existing IP or third party rights.

The University will assume that anything not so disclosed is IP of the University, unless evidence to the contrary can be demonstrated.

4. OWNERSHIP OF IP

4.1 University Employees

IP created by University Employees in their course of employment is

the property of the University. For the purposes of clarity, any and all Teaching Materials, in any form, that have been developed by a University Employee in their course of employment at the University will be owned by the University as the employer.

Where IP created by a University Employee has not been created in the course of employment, the University Employee may still have obligations, such as fiduciary obligations, to the University in relation to such IP. This may arise, for example, where the IP has been created using University resources or through use of an opportunity provided by the University, or through the use of IP belonging to the University. The University does not waive any rights it may have in relation to such IP.

Where University Employees work on personal projects (these are projects that are not considered to be part of their course of employment) the University advises that such employees immediately discuss these projects with their academic supervisor or line manager so as to assist in identifying whether any issues in relation to the ownership of IP may arise (including any potential conflict of interest).

4.1.1 Existing University Employees

The University may agree with an existing University Employee carry out a particular project beyond the scope of that University Employee's normal duties. This may or may not be for additional payment or under a separate employment contract. In such circumstances, the individual remains an employee of the University. For example, if a University Employee is asked to work on a project and is relieved of teaching duties, work on the project will be treated as being in the Course of Employment of the University Employee and not as a separate contract.

4.1.2 Scholarly Work

The University will not assert ownership of copyright in Scholarly Work created by University Employees, except under any of the following circumstances:

- a. Where the Scholarly Work has been specifically commissioned by the University, including work commissioned as a result of contractual arrangements between the University and third parties;
- b. If the University agrees to assist with the publication or other commercial development of the Scholarly Work, the University will negotiate an appropriate distribution of all income arising from that process, including recovery of the University's costs; or
- c. Where the University is the publisher of a work, then the University will own the copyright in that work and any benefits arising therefrom.

4.2 Students

Generally, Students retain ownership of IP created by them in the

course of their study at the University.

However, on enrolment Higher Degree Research Students and other Students who have a research component formally integrated into their program of study will be required to provide an assignment of IP in the projects which they undertake or are associated with as Students. For the avoidance of doubt, such assignments will not include IP developed solely by the student without any use of University resources or IP and without reliance on IP included in the assignment.

Any Student may submit a request to the University to waive this assignment and each request will be considered on its merits. HDR Candidates please refer to the *Request a Waiver of HDR Candidate IP Assignment Procedure*. Other Students should consult their faculty Associate Dean (Teaching and Learning).

In addition, Students may also be requested to provide an assignment of IP in the projects which they undertake as Students in the following circumstances:

- a. The work that led to the creation of the IP was funded by a third party and which the University has a contractual obligation to transfer IP rights to that third party or protect IP rights for the benefit of that third party: or
- b. A specific contract has been negotiated to the contrary.

In each of the circumstances above the Student will have the right to decline involvement in the projects associated with the contracts and an assignment will not be necessary.

In any other case where the IP developed by a Student is an adaptation of the University's IP, or where a University Employee or Associate (e.g. PhD supervisor) is a joint creator of the IP, then the University will retain its rights in any IP owned by it and the University does not waive any rights that it may have in that regard. In addition the Student may be requested to assign his/her rights in the IP to the University or third party as required under contract.

In cases where IP was created by a Student through the use of University resources (other than mere Incidental Use) the Student may be requested to assign his or her rights to the IP.

In all cases, Students will retain ownership of copyright in their theses or other submissions (subject to the rights of the University or third parties in any underlying work or development on which the submission is based). Students who assign their IP to the University will be acknowledged as having the same rights (to the benefits of commercialisation) as University Employees.

At any time during the course of a Student's studies or after a Student candidature has been completed or terminated he/she may submit a

request to the University to acquire rights to exploit IP developed by him/her and previously assigned to the University. In all cases the request will be considered on its merits. The nature of the rights granted may vary depending on the merits. Examples are an assignment up front or an option to exploit subject to the satisfaction of reasonable performance criteria. HDR Candidates should refer to the *Request to Transfer IP Rights to HDR Candidate Procedure* for further information. Other Students should contact the Office of Commercialisation directly.

4.2.1 Student employees

Students who are employed as research assistants or in other positions by the University will be treated on the same basis as other University Employees.

4.2.2 Student placements with external institutions

The University actively encourages Students to participate in work or educational experiences with external institutions. Examples include the Professional and Community Engagement Program (PACE) and Internships.

Ownership in IP developed by a Student while he/she is participating in a student placement with an external institution (“the host”) is considered by the University to be owned by the Student except in the following circumstances:

- a. A specific contract (including any assignment executed pursuant to clause 8) has been negotiated to the contrary;
- b. A Student has used University resources (beyond Incidental Use);
- c. A Student has used University Background IP, or
- d. Where the University supervisor has contributed substantially to the project.

In these circumstances, the University will assert its rights in any IP developed and does not waive any rights that it may have as the owner of the IP.

4.2.3 Student Advice

Students uncertain of their rights relating to IP ownership should seek advice from the Office of the Deputy Vice-Chancellor (Research). This office may organise independent legal advice for Students where appropriate. For the avoidance of doubt, the Office of General Counsel cannot provide such advice in case such advice is contrary to the best interests of the University.

4.3. Associates

While having due regard to an Associate’s obligations to a third party, for example an employer, Macquarie University will negotiate with any Associate, on a case-by-case basis, to commercialise and share on

reasonable terms the benefits of any IP developed by the Associate during their participation in any research project or scholarly activity at the University.

In certain circumstances, Associates may be asked to assign their IP rights to the University.

4.4 Independent Contractors

Independent contractors are not necessarily obliged to transfer IP ownership in material they may develop under a contract with the University nor abide by confidentiality restrictions in material received or developed under the contract.

However, University contracts will ordinarily vest IP in material developed under the contract with the University and require the independent contractor to maintain confidentiality.

5. COMMERCIALISATION

5.1 Commercialising IP

IPCAC will consult with the creators of the IP and determine if there is a favourable opportunity for commercialisation of the IP. In general, the management of individual commercialisation projects will be undertaken by the Office of Commercialisation with reasonable consultation with the creators of the IP.

Where the decision is made by the University not to proceed with the protection or commercialisation of IP, or if a decision is made to cease commercialising at a later stage, the University will, on request, licence or assign the IP to the creator/s of the IP on reasonable commercial terms. These may include the recovery of commercialisation costs incurred and a share of revenue subsequently received by the creators. Approval for any request received will not be unreasonably withheld and upon approval the creators will not be permitted to use University resources in exploiting the IP except in an incidental fashion or as explicitly agreed in writing. Refer to the *Request to Handback IP to University Member Procedure*.

For the avoidance of doubt, where the University considers that continuing to hold but not exploit the IP is strategically important or commercially reasonable, it will have reasonable grounds for rejecting the request.

Subject to clause 5.2, IP ownership will remain with the University. As IP owner, the University may, at its discretion, contract for the subsequent licensing, assignment or other dealing of the IP as it considers appropriate.

5.2 Transfer of IP to Third Parties

The University may have contractual agreements with third parties, including private and government enterprises and other research

entities (e.g. CSIRO and RIRDCs), which provide for IP developed by an Employee or a Student to be commercialised by the third party (or at least that third party has first option of rights to commercialise).

Where a contractual agreement with a third party involves University Employees and/or Students, the terms of that agreement will determine the IP rights of those University Employees or Students.

In cases where it is commercially reasonable or strategically important to do so, the University may agree to assign IP rights to another entity either immediately or sometime in the future on achievement of milestones. Please refer to the *Request to Assign IP Rights to Third Party Procedure* for the criteria the University may apply in determining whether to assign University IP to a third party. Any such decision will in all cases be consistent with the Overview to this Policy.

Alternatively, the University may, with the creator's endorsement (which will not be unreasonably withheld), determine that the benefits derived from commercialisation may be optimised other than through a direct income stream such as a licence fee (e.g. the opportunity to derive increased profile, develop a strategic relationship or flow-on contract research income). In these circumstances the decision may be taken to grant a royalty-free licence to a third party.

5.3 Rewards and Recognition

As a general position, the University will reward University Members who have created valuable IP by sharing in the benefits arising therefrom. The reward system will be reviewed on a regular basis to ensure the congruence of the overall aims of the University in its commercialisation activities and the needs of individual creators.

In relation to financial rewards, the University will distribute any net proceeds from a commercialisation project as follows:

- a. It will first deduct its costs, including costs of registering and otherwise protecting the IP (such as patenting expenses), costs of establishing the licensing arrangement or creating a company (including legal and valuation costs), external costs in commercialising the technology (such as marketing reports and business planning), and repayment of any external investments. In some cases the University may need to retain an amount on account of forecast costs; and
- b. It will then, subject to any written agreement to the contrary, distribute the proceeds in the following manner:
 - i. 50% to be apportioned among all members of the University community who are the creators of the IP that has been commercialised (and any other person agreed to between the University and the relevant members of the University community), in accordance with any agreement amongst them or, if there is no agreement, in shares equal to the degree of contribution as determined by the University; and

- ii. 50% to the University including the Division(s) or Office(s) involved.

The term “proceeds” in b. above may take the form of cash, holding shares (directly or indirectly), or other arrangements such as surpluses made by the University as a result of applying competitive neutrality principles to contract research agreements. It should be noted that, all other considerations being equal, while the University will endeavour to take account of the most effective tax regimes for the creators in each case, the primary driver will be deriving an arrangement that will facilitate a successful project outcome. The University does not provide financial or legal advice to individual members of the University community, who should obtain their own independent advice on such matters.

6. PROCEDURAL ASPECTS

6.1 Conflict of Interest

A conflict of interest is likely to arise in situations occurring with the commercialisation of research and teaching proposals. A conflict of interest is where an individual/s may benefit personally from decisions made by the University in undertaking a commercial proposal. University Members should refer to the Conflict of Interest Policy.

6.2 Dispute resolution

Subject to the Grievance Management Policy and the Student Grievance Handling Procedure, any University member who wishes to raise any dispute or difference of opinion about the application of this Policy may request a review of the issue by the IPCAC. If the issue cannot be resolved by the IPCAC, then the IPCAC will refer matter to the Vice-Chancellor or his / her nominee through the Deputy Vice Chancellor (Research).

6.3 Regular review of policy

This Policy will be regularly reviewed to ensure that it is up-to-date and that it addresses the needs of University Members. The Policy, as amended from time to time, will be incorporated into appropriate documents, with effect from its effective date. All IP created prior to the effective date of a Policy will be governed by the terms of the Policy in force at that time. If a University Member wishes to make a submission in relation to suggesting improvements to the Policy, please contact the IPCAC.

7. COMPLIANCE AND BREACHES

The University may commence applicable disciplinary procedures if a person to whom this Policy applies breaches this Policy (or any of its related procedures).

Contact Officer	Director of Commercialisation
Date Approved	30 October 2014
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Date of Commencement	30 October 2014
Amendment Dates	n/a
Date for Next Review	October 2017
Related Documents	<p>Intellectual Property Procedures:</p> <ul style="list-style-type: none"> • Request a Waiver of HDR Candidate IP Assignment • Request to Assign IP Rights to Third Party • Request to Handback IP to University Member • Request to Transfer IP Rights to HDR Candidate <p>IP Commercialisation Guideline (under development) Research Indirect (Overheads) Costs Policy Conflict of Interest Policy (under development) Responsible Conduct of Research Code Staff Code of Conduct Student Code of Conduct Grievance Management Policy Student Grievance Handling Procedure</p>
Policies/Rules Superseded by this Policy	Intellectual Property Policy V:3.1 Approved by Council - 20 October 2006
Keywords	Intellectual Property, Commercialisation