



Reporting and Managing Intellectual Property Procedure

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In developing this procedure the University had regard to the provisions of section 40B(1)(b) of the Human Rights Act 2004 (ACT).

PURPOSE:

These procedures are made in accordance with the UC Intellectual Property (IP) Policy and they set out the manner by which IP, created by UC Staff, Students and Affiliates in the course of their employment by the University or through use of University Resources, are to be protected, managed and commercialised.

PROCEDURE:

1. Notification of Pre-Existing IP

- 1.1. The University does not assert ownership over Pre-Existing IP.
- 1.2. To ensure clarity and avoid uncertainty that may lead to a dispute, staff, affiliates and students should advise the University by written notice to the University IP Officer of the existence and specific details of any Pre-Existing IP that the staff member, affiliate or student brings to the University.
- 1.3. Notice should be provided within three months from commencement of employment, enrolment, or engagement by the University by completing and submitting to the University IP Officer the *Pre-Existing IP Notification Form (Attachment A)*. This notice will include a written warranty that the use of Pre-Existing IP does not infringe the rights of any third parties.
- 1.4. In the absence of such notice, ownership of Pre-Existing IP used or later disclosed by each member of staff, student or affiliate will be evaluated under the University IP Policy effective at the time of receipt of notice.

2. Assignment of IP to the University

- 2.1. If not otherwise assigned through the operation of any agreement or law and if assignment is required to enable UC to comply with a contractual obligation, a member of staff, affiliate or student must assign to the University all rights, title and interest in the identified IP.
- 2.2. At the request of the University IP Officer, or that person's authorised representative, each member of staff, affiliate or student who creates IP (the 'Creator') will execute any and all

documents required by the University to evidence the assignment of that IP to the University.

2.3. In the event that a Creator fails to complete any documentation or any action deemed by the University to be necessary for the assignment, protection, or management of Commercialisation of IP owned by the University, then the Vice-Chancellor has the right to complete and execute all such documents and do all such acts as their attorney even if the University benefits from this power.

2.4. The RSO will maintain a record of all Assignment Deeds executed under this clause 2.

3. Student Participation in Externally Funded University Research Projects

3.1. A student who wishes to participate in an Externally Funded Research Project under a contract that requires the University to own or assign the IP rights, shall be treated as if he or she is a staff member of the University and therefore will be subject to the relevant provisions of the IP Policy.

3.2. Before a student is allowed to participate in an Externally Funded Research Project undertaken by the University under a contract that requires the University to own or assign the IP rights, the student will be required to execute the *Student Assignment of Intellectual Property Deed* (Attachment B) which at a minimum will:

- 3.2.1. give consent to the University over the student's moral rights subsisting in a work, to the extent that it relates to or affects the research project;
- 3.2.2. grant a license to the University to use any Pre-Existing IP owned by the student that is used in the research project,
- 3.2.3. assign his or her IP arising from his or her participation in the Externally Funded Research Project.

3.3. It is the responsibility of the staff member supervising the student or leading the Externally Funded Research Project (i.e. Chief Investigator) to notify the student about all requirements for participating in the Externally Funded Research Project and to ensure that the student is given reasonable time to review all documentation and seek appropriate advice (including legal advice).

3.4. A student who assigns their IP rights and gives consent in respect of any moral rights under item 3.2 is, subject to any agreement, entitled to a share of net commercial income in accordance with clause 7.3.

3.5. If the student does not agree to anything required under clause 3.2 or else does not respond to the request to do so, then the University may decline to permit the student to participate in that Externally Funded Research Project.

3.6. The University shall ensure that the provisions of the IP Policy, the *Student Assignment of Intellectual Property Deed* and any other agreement setting out an appropriate entitlement of the student to any net returns of commercialisation shall:

- 3.6.1. not hinder the academic progress of the student; and
- 3.6.2. not affect the examination of the student thesis;

3.7. The RSO will maintain a record of agreements executed by the student under this clause 3.

4. Disclosure of IP

4.1. A staff member, affiliate or student, who is a Creator of IP shall report the creation of that IP to the University IP Officer and will disclose the details of the new IP by completing the Invention Disclosure Form (Attachment C) where:

- 4.1.1. the new IP may be patentable, or
- 4.1.2. disclosure is a legal requirement specified in a contract.

4.2. A Creator of IP that is required to be disclosed in accordance with the above shall not disclose the IP to any other person and must take all reasonable steps to maintain and protect the value of that IP.

4.3. The disclosed IP will be entered in the IP Register to be maintained by the RSO.

4.4. Once the IP is entered in the IP Register, the procedures for protection and commercialisation of disclosed IP under clauses 5 and 6, respectively, will apply.

5. Protection of Disclosed IP

5.1. The University IP Officer, in consultation with the Creator(s) and with relevant University staff member(s) or external expert(s), will determine within 30 business days (*evaluation period*) the need for Protection as well as the viability of any commercial opportunity identified for the disclosed IP;

5.2. During the evaluation period, the University IP Officer will instruct the RSO to take all necessary steps to:

5.2.1. determine and verify ownership of the disclosed IP; and

5.2.2. evaluate the need for, best mode and cost of IP protection. *The Creator(s) will assist where required in the verification process.*

5.3. During the evaluation period, the University IP Officer, the RSO and the Creator(s) will do all things necessary to ensure that the disclosed IP is treated as confidential, including by having any persons consulted during that period sign confidentiality agreements.

5.4. The University IP Officer will inform the creator(s) whether IP protection will be supported by the University within thirty (30 days) from receipt of the completed *Disclosure Invention Form*. This period may be extended by the University depending on what is reasonable under the circumstances.

5.5. If the University decides to support the protection of IP, the RSO will facilitate the engagement of an external expert who shall secure the appropriate IP protection for the disclosed IP. The Creator(s) shall do all acts and sign all documents required for the application of IP Protection.

5.6. The cost of initial IP Protection under 5.5 shall be borne by the University.

5.7. During the initial protection period, the Creator will actively seek the engagement of a commercial partner for the protected IP. Payment of maintenance fees for IP Protection shall not be assumed by the University and will depend on receipt of external commercial funding of the protected IP.

5.8. Should the University decide not to proceed with the protection of IP, the Creator(s) will be given the opportunity to seek IP protection. If the disclosed IP is a University owned IP or has been assigned to the University by the Creator, it shall be re-assigned to the Creator(s) following the procedures under clause 8.

5.9. A review of the disclosed and protected IP entered in the IP Register will be undertaken by RSO annually.

6. Commercialisation of Disclosed IP

6.1. The University will deal expeditiously, expertly and thoroughly with opportunities to commercialise the IP in which it asserts rights, and in so doing, seek optimal benefits for the Creators, the University and the wider community.

6.2. The Creator(s) will work with the RSO to develop a commercialisation plan which will include a description of the commercial application and unique competitive advantage, progress to date,

any technical milestones and potential commercialisation opportunities. The commercialisation plan will be submitted to the University IP Officer for evaluation.

6.3. The University IP Officer, in consultation with the Creator(s), internal and external expert(s), shall decide whether the University will undertake the commercialisation of the disclosed IP by itself or in collaboration with or through a commercial partner.

6.4. Where the decision is made to commercialise the disclosed IP, Creators (including students) will have the opportunity to participate in processes associated with the protection and commercial exploitation of IP that they have helped to create and to share in the net commercial proceeds in accordance with clause 7.3.

6.5. The University, through the RSO, may seek external legal advice to ensure correct valuation of the disclosed IP and that the terms and conditions of any commercial agreement entered serve the best interests of the University and the Creator(s).

6.6. Should the University IP Officer decide not to undertake the commercialisation of the disclosed and/or protected IP, the Creator(s) will be given the opportunity to undertake the commercialisation thereof with external parties. If the disclosed IP is a University owned IP, it shall be assigned to the Creator following the procedures under clause 8

7. Disbursement of Net Commercialisation Income

7.1. Benefits received by the University from the commercialisation of Course Materials shall be retained fully by the University to be utilised to support its core mission in teaching and research.

7.2. The RSO will work with the University Financial and Business Services in maintaining a record of any commercialisation cost incurred by the University in relation to a disclosed and/or protected IP.

7.3. The Net Commercialisation Income received by the University pursuant to the IP Policy will be distributed as follows:

7.3.1. forty (40) % to the Creator and if more than one (1) Creator, 40% to be shared among the Creators as per their agreement;

7.3.2. thirty (30) % to the University, and

7.3.3. thirty (30) % to the relevant Faculty or University of Canberra Research Centre.

7.4. The Creator(s)'s share as per 7.3.1 shall be deposited in the bank account he/she nominates to the University Finance and Business Services.

7.5. In the event that it is not practical to distribute any of the Net Commercialisation Income to the Creator, the University may determine other means of distributing the benefit which may include, but is not limited to, the University holding those net proceeds in trust for the Creator.

7.6. This right applies regardless of whether the Creator is still associated with the University. Any such Net Commercialisation Income will be paid to the Creator's estate if the Creator is deceased.

8. Assignment of University IP

8.1. The University owned IP will be assigned to the Creator if the University decides not to:

8.1.1. protect the disclosed IP as per clause 5.8 of this Procedure, or

8.1.2. proceed with, or continue with, the commercialisation of the disclosed IP as per clause 6.6 of this Procedure.

8.2. The RSO will discuss and negotiate the terms and conditions of assignment which will include in all cases the following:

8.2.1. the University will retain a non-exclusive, royalty-free, world-wide licence to use

the IP for education and/or research purposes,

8.2.2. the University will receive a future benefit amounting to 20% of the net revenue received by the Creator from net commercialisation proceeds,

8.2.3. a requirement for the Creator to report regularly to the University in relation to progress made with the exploitation of assigned IP and the revenue entitlements of the University.

8.3. The assignment of IP to the Creator will only relate to that IP specifically described in the *Invention Disclosure Form*. The assignment will not cover IP included in other *Invention Disclosure Forms* in the same area of research submitted by the same Creator.

8.4. The RSO working closely with the University Legal Officer will complete an agreement with the Creator.

8.5. The RSO will maintain a record of assignment of IP agreements executed under this clause 8.

9. Access to Research Outputs

9.1. To enable the University to make Research Outputs accessible to the wider community:

9.1.1. staff or affiliates leading Externally Funded Research Projects are required to provide the following information to the RSO:

- the research output(s)
- period of publication
- the title of the project;
- funding organisation;

9.1.2. RSO will confirm the correctness of the information received under this clause 9.1.1 against the RSO database, and determine whether the reported Research Outputs comply with the following conditions for inclusion in the University Research Publications Repository:

- refereed research outputs and contributions at the post-peer review stage (known as the 'post-print', the 'accepted version' or the 'accepted manuscript') that meet the Department of Education's definition of research and are eligible for inclusion in HERDC and ERA;
- un-refereed research literature, conference contributions, chapters in proceedings, etc. (known as the 'post-print', the 'accepted version' or the 'accepted manuscript') that are not eligible for inclusion in HERDC and ERA;
- Higher Degree by Research (HDR) theses

9.1.3. RSO will provide the University Library a list of confirmed Research Outputs from Externally Funded Research Projects

9.1.4. University Library shall include the Research Outputs confirmed by RSO in the University Research Publications Repository and make it accessible by open access, where copyright and other restrictions allow.

9.2. Where a publisher embargo or other conditions exist that restrict open access, the University Library will comply with any embargo or restrictions before making the manuscript available by open access.

9.3. Depositing research outputs in the University Research Publications Repository under this clause 9 does not transfer copyright to the University. Copyright remains with the author or publisher as per the publishing contract.

- 9.4. The University Library will not alter the material except as allowed under law to:
- 9.4.1. reproduce, electronically communicate and distribute the open access copy, including any open access copies of the publisher version of the specified work(s), online, for free and for non-commercial use,
 - 9.4.2. make more than one copy of the work(s) for the purposes of security, back-up and preservation.
- 9.5. Staff, affiliates and students are enjoined to clearly indicate in their research outputs their affiliation with the University and, to acknowledge any support received in the development of that research output from the University and/or other organisations in compliance with any contractual requirement.
- 9.6. Dissemination of knowledge through commercialisation is covered under clause 6 of this Procedure.

10. **Dispute Resolution**

- 10.1. Student IP related disputes will be appealed and considered under the [Student Grievance Resolution Policy](#) of the University.
- 10.2. In general, concerns, queries and disputes relating to the interpretation or operation of the IP Policy and IP Procedures are best dealt with in the first instance, at an informal level. Thus, staff or affiliates are advised to seek the assistance of their Faculty Dean or University Research Centre Director or the RSO Director who shall endeavour to resolve their concerns, queries and IP related disputes as quickly as possible.
- 10.3. If the dispute cannot be resolved informally, the staff or affiliate shall submit a written notice of the nature and details of the dispute to the University IP Officer, including any supporting documents.
- 10.4. Within 21 days from receipt of the notification of dispute, the University IP Officer will convene a meeting of all those notified of the existence of the dispute and any other persons which the University IP Officer believes is able to assist in the speedy and equitable resolution of the dispute.
- 10.5. The University IP Officer will issue a written order to:
- 10.5.1. confirm the agreements made to resolve the dispute, or
 - 10.5.2. refer the dispute for further determination by the Vice-Chancellor (VC) if the dispute is not resolved within 30 days of the meeting convened under 10.4
- 10.6. The VC shall evaluate the dispute based on written documents submitted by the staff member or affiliate and the findings of the University IP Officer summarised in the written order of referral in clause 10.5.2.
- 10.7. Within 30 days from receipt of the order of referral, the VC shall render an administrative decision on the dispute. The VC's written decision shall be given to the RSO for recording and delivery to the staff member or affiliate concerned.
- 10.8. All documents and discussions associated with the IP disputes will be held confidential.

11. **Management of University IP**

- 11.1. Subject to the relevant laws and procedures, the University, at its sole discretion, is entitled to manage the IP it owns in any manner.
- 11.2. Working with internal and external experts, the RSO is responsible in drafting and negotiating contracts between the University and the staff member, affiliates, students and external parties in relation to the:

11.2.1. assignment to any other party the University’s right, title, and interest, in any IP owned by it;

11.2.2. prosecution, maintenance and defence of any application or grant of any type of IP protection for any IP it owns;

11.2.3. appointment of agents to act on behalf of the University regarding the management and commercial exploitation of IP; and

11.2.4. exploitation of any IP in any manner.

11.3. A duly authorised agreement between the University and a third party may vary the operation of this Policy, especially in relation to the ownership of IP created in accordance with the terms of the agreement and the rights of the University in relation to Managing that IP.

11.4. The RSO will maintain a record of all actions taken and resulting agreement for all IP actioned and managed on behalf of the University.

12. Information and Education in relation to IP

12.1. Information in relation to the effect and operation of this Policy may be sought in the first instance from the Research Services Office of the University who may refer a request for information to the University IP Officer or such other party as may be deemed appropriate.

12.2. The University, through the RSO Director, will establish a flexible IP education program to ensure that the provisions of the IP Policy, IP Procedure and relevant information on knowledge transfers and commercialisation are made known to the UC community, including through:

12.2.1. the Human Resources induction programs;

12.2.2. research student education programs

12.2.3. sponsorship of annual workshops or other programs such as the Early Career Academic Program (ECAP)

12.2.4. development of the University website, including brochures on IP and Knowledge Transfers which includes commercialisation matters.

12.3. The RSO will evaluate and report on the effectiveness of the Education Program to the University IP Officer.

ROLES AND RESPONSIBILITIES:

Subject Matter	Procedure or Action	Responsibility	Relevant clause
Notification of Pre-Existing IP	Notice (using Attachment A) includes warranty of non- infringement of 3rd party IP rights	Staff, affiliate, student	1.1 to 1.3 (inclusive)
	Receipt of notice	University IP Officer	1.1
Assignment of IP to the University	Assignment of IP rights (if requested by University IP Officer)	Staff, affiliate, student	2.2

	Drafting, negotiation and execution and recording of Assignment Deeds	RSO	2.4
Student Participation in Externally Funded Research Projects	Inform student of all requirements for participation in the project	Staff supervising the student	3.3
	Assignment of IP (using Attachment B)	Student	3.4
	Drafting, negotiation and execution and recording of Assignment Deeds	RSO	3.7
Disclosure of IP	Disclosure of IP (using Attachment C)	Staff, affiliate or student	4.1
	Recording of disclosed IP in a Register	RSO	4.3
Protection of Disclosed IP	Evaluation and Assessment of Disclosed IP	University IP Officer in consultation with UC members and/or external experts as needed	5.1
	Inventorship determination and evaluate mode of IP protection	RSO	5.2
	Render decision to support or not to support IP protection	University IP Officer	5.5 and 5.7
	Engagement of external expert for IP protection	RSO	5.5
	Maintenance of IP Register	RSO	5.8
Commercialisation of Disclosed IP	Development of a commercialisation plan for the protected IP	Staff	6.2
	Render a decision to commercialise	University IP Officer in consultation with UC members and/or external experts as needed	6.3
	Engagement of external legal expert for commercialisation	RSO	6.5
	Drafting, negotiation and execution and recording of commercial agreement	RSO and external legal (as needed)	6.5

Disbursement of Net Commercialisation Income	Recording of commercial cost in relation to IP	RSO working with Financial and Business Services as needed	7.2
	Disbursement of Creator's share in net commercialisation income, including holding share in trust for the Creator	Financial and Business Services	7.4 and 7.5
Assignment of University IP	Render a decision to assign University IP (including determination of terms of assignment)	University IP Officer	8.3 and 8.4
	Drafting, negotiation and execution and recording of Assignment Deed	RSO (working with internal as well as external legal experts as needed)	8.5
Access to Research Outputs	Data collection on research outputs	RSO working with Faculty/URC	9.2
	Reporting of research outputs from Externally Funded Research Projects	Staff	9.4.1
	Confirmation of correctness of reported research outputs	RSO	9.4.2
	Inclusion of confirmed research outputs in the University Research Publications Repository	UC Library	9.4.3
	Compliance with any publication embargo	UC Library	9.6
Dispute Resolution	Resolve student related IP dispute	Faculty Dean or Director Research Centre guided by the SGRP Appeals against decision of Dean/Director to Student Appeals Committee	10.1
	Informal meetings to resolve IP disputes, queries, concerns	Faculty Dean, URC Director or RSO Director	10.2
	Convening formal dispute resolution meetings and rendering of decision	University IP Officer	10.5
	Decide appealed disputes	VC	10.7

Management of IP	Evaluate and undertake commercialisation activities and maintain record of each IP managed	RSO	11
Information and Education in relation to IP	Establish and evaluate the IP Education Programme	RSO	12.2 and 12.3

GOVERNING POLICY AND LEGISLATION:

This Procedure is governed by the [Intellectual Property Policy](#).

Documents related to these procedures are:

- [Intellectual Property Policy](#)
- [Charter of Conduct and Values](#)
- [Secondary Employment Policy](#)
- Honorary Appointments Policy
- [Responsible Conduct of Research Policy](#)
- UC Copyright Guide
- [Student Grievance Resolution Policy](#)

SUPPORTING INFORMATION:

A - Pre-Existing IP Notification Form

B - Student Assignment of IP Deed

C - Invention Disclosure Form