



AUSTRALIAN CATHOLIC UNIVERSITY

INTELLECTUAL PROPERTY POLICY

**Approved by Academic Board
19 May 2004**

INTELLECTUAL PROPERTY POLICY

1. INTRODUCTION AND OBJECTIVES

1.1 Australian Catholic University ('University') Intellectual Property Policy wishes to establish a sound framework for the encouragement of invention, creative work and technology transfer. The policy sets out how the University will manage intellectual property rights and issues so as to best meet its policy objectives. Those objectives are:

- to create the climate for innovation and invention;
- to provide a framework whereby staff and students are stimulated to identify, protect and exploit potentially valuable research results and other creative work and to successfully engage in technology transfer;
- to create a better understanding of the various rights which the law gives for the protection of creative effort and thereby stimulate the proper protection of the University's economic investment in that effort;
- to allow for various forms of commercial development of intellectual property created within the University;
- to provide financial incentives and returns to individuals and organisational units to encourage research and to develop and pursue commercial projects;
- to recognise student rights to intellectual property generated in the course of their study at the University while at the same time asking certain students at postgraduate level to assign or licence rights to the University in exchange for being included in research programs so that the University can properly manage intellectual property rights arising through such programs.

1.2 The University may need to change or add to this policy if it considers it necessary to meet the changing legal and university environment. Any changes to this policy will only apply to works, inventions and other subject matter that come into being after the effective date of the change.

2. DEFINITIONS

2.1 For the purpose of this policy:

'Commercial development' means any means of exploiting Intellectual Property (including to make, adapt copy, publish, sell, assign, licence, sub-licence, franchise, market, distribute or otherwise use or dispose of Intellectual Property and any manufacture based on Intellectual Property) for the purpose of commercial gain.

'Intellectual Property' includes, but is not limited to:

- copyright protected under the Copyright Act 1968, including copyright in literary works (including computer programs), dramatic works, musical works,

artistic works, sound recordings, cinematographic films, television and sound broadcasts and tapes and published editions as defined in the Copyright Act;

- circuit layouts protected under the Circuits Layout Act 1989;
- designs registered or registrable under the Designs Act 1906;
- patents registered or registrable under the Patents Act 1990;
- plant varieties registered or registrable under the Plant Breeder's Rights Act 1994;
- trade marks registered or registrable under the Trade Marks Act 1955 and trade marks or names protected at common law or under the Trade Practices Act;
- works developed for teaching purposes, including but not restricted to study guides, laboratory manuals, TVI tapes, CAL and CML programs and other electronic courseware, radio and TV broadcasts, audiovisual materials and the like which have been developed to further the University's teaching function;
- any information which is regarded by the University as confidential and as having a commercial value;

and includes such rights to the extent that they are added to or varied from time to time by legislation which amends or replaces, in whole or in part, any of the above mentioned Acts.

'Invention' means an invention (whether or not qualifying for registration) under the Patents Act 1958 or the Patents Act 1990.

'Moral Rights' means the right of integrity of authorship (that is, not to have a work subjected to derogatory treatment), the right of attribution of authorship of a work and the right not to have authorship of a work falsely attributed, which rights are created by the Copyright Act 1968 and, if the works are used in any jurisdiction other than Australia, any similar right capable of protection under the laws of that jurisdiction.

'Staff member' means and includes all academic, research and general staff who are employees of the University or on assignment by religious orders to the University, whether full-time or part-time, but does not include staff who are consultants or seconded to the University if they are not employees under contracts of service, and does not include students except if they are also employed as academic staff, in which case it will include them in that capacity alone.

'Commissioned' as in **'University commissioned'** or **'Commissioned by the University'** means generic tasks performed under an employment contract or appropriate position description, and which may be performed by any staff member with similar qualifications and position description. **'Specifically commissioned works'** are individually defined tasks identified in an employment or other contract, and may be a subset of or different from the generic tasks. The difference is that they have been specifically defined, or limited by contract.

3. OWNERSHIP OF INTELLECTUAL PROPERTY

3.1 The University will assert ownership of Intellectual Property if that Intellectual Property is:

- commissioned by the University to assist in the operation, administration and/or management of the University's affairs and course planning (including memoranda, letters, administrative reports, meeting minutes, course outlines, final examinations and lab manuals); or
- produced in printed or other form by or on behalf of the University or a Faculty/Directorate; or
- a database or similar collection of information collected or obtained primarily by or on behalf of the University or a Faculty/Directorate; or
- created pursuant to specific sponsored or contract research activities, the ownership of which shall be governed (in whole or in part) by the sponsor's regulations or the terms of the contract; or
- the subject of a written, ownership-sharing agreement between the staff member and the University; or
- other Intellectual Property created by staff members in pursuance of the terms of their employment, unless otherwise stated in this Policy.

3.2 The University will not assert ownership of Intellectual Property in:

- books, articles, audiovisual materials prepared for individual use or conference presentation or other such scholarly work or subject matter generated, whether in written or other form, by staff;
- artistic works created by staff members in fine art or design; and
- in musical, dramatic, cinematographic film, video, and sound recordings or other creative works written, created or composed by staff members;

unless the creation of such Intellectual Property has been specifically commissioned by the University.

3.3 The University may use any Intellectual Property created by staff members in the course of their employment for the purposes of teaching (including distance and computer-aided courses), research, University administration (including accreditation) and promotion of the University and/or its courses.

3.4 The University is entitled to receive from the Copyright Agency Limited ('CAL') any remuneration collected by CAL in respect of the reproduction of any materials (other than books) created by its employees in the course of their employment.

- 3.5 With respect to students, the University lays no claim for undergraduate students. Postgraduate students may be asked, prior to embarking on their course of study, to grant a non-exclusive licence substantially in the form of that contained in Appendix 1 to the University in respect of specified Intellectual Property which may be generated by them in the course of their studies.
- 3.6 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 University Intellectual Property, shall remain in full force and effect. If University Intellectual Property arises out of or in connection with a project that is the subject of an agreement with a third person which provides for the ownership of such Intellectual Property and the University has agreed in writing to the provisions of that agreement, then, despite any contrary provision in this policy, the provisions of that agreement will govern ownership of all rights in the Intellectual Property.

4. DEVELOPMENT OF INTELLECTUAL PROPERTY PROCEDURES IN CASE OF INVENTIONS

- 4.1 Where a staff member creates Intellectual Property, other than that to which the University will not claim ownership as the result of the operation of Clause 3, which in his/her opinion is capable of commercial exploitation, he/she will report its existence to his/her Dean or Director and to the Pro-Vice-Chancellor (Research). Students will follow procedures outlined in any applicable assignment or licensing agreement that they have entered into with the University.
- 4.2 Following consultation with the staff member and the Dean or Director, the Pro-Vice-Chancellor (Research) shall determine whether the University wishes to become involved in the development of any Intellectual Property which is reported under Clause 4.1 or is otherwise brought to notice.
- 4.3 The University shall decide within eight weeks of the initial contact by the staff member whether it wishes to be associated with the development of the Intellectual Property. If the University has not given notice within that period that it wishes to be involved in the development of the relevant Intellectual Property then it will be deemed to have decided not to be. Confidentiality shall be preserved throughout this process. If the University does not wish to be involved in the exploitation of any particular Intellectual Property then:
- the staff member shall be free to protect and develop the Intellectual Property or otherwise at his/her discretion, subject to the interests of any third parties; and
 - if the staff member so requests, the relevant University Intellectual Property rights will be promptly assigned to the staff member, in return for the University receiving a mutually agreed percentage of future income, in order to enable the staff member to take such action as he/she sees fit.
- 4.4 Where the University decides to be involved in the commercial exploitation of the Intellectual Property in any Invention it will consult with the staff member(s) involved in the creation of the Invention before determining, as it sees fit, the

appropriate action to be taken. This may include, without limitation, one or more of the following:

- the filing of Patent application in the name of the University with the staff member(s) as named inventor(s);
- the identification of potential licensees;
- the assignment of the rights to a third party such as the Australian Technology Group;
- the formation of a limited liability company to exploit the technology;
- and shall address any need for confidentiality by the University and/or the staff member(s). In determining the appropriate course of action for the commercial development of an Invention, the Pro-Vice-Chancellor (Research) or his/her nominee may consult, on a confidential basis, with appropriate experts and advisers.

4.5 In any case where the University is the owner of any Intellectual Property in an Invention and wishes to participate in the commercial exploitation of that Invention, then any staff member involved in the Invention, whether as inventor, owner, or otherwise, agrees that the University will be deemed to have an irrevocable authority to act on his or her account and to execute such documents as the University deems necessary for the purposes of the commercial development of that Invention consistent with the objectives of this policy.

4.6 Where the University decides to be involved in the development of Intellectual Property in any Invention, the staff member(s) shall provide all reasonable assistance in the development process by, for example, providing information promptly on request, attending meetings with potential licensees and advising on further development. The University will assist the staff member to meet such requests for information, and will not contribute to any undue delay in the development process.

4.7 Net income received by the University as a result of the development of Intellectual Property in any Invention shall be distributed as follows:

Return after Outgoings	Inventor %	Faculty/Directorate %	University %
For the first \$25,000	70	10	20
For the next \$75,000	50	15	35
For the amount over \$100,000	30	20	50

The Pro-Vice-Chancellor (Research) will determine modes of payment for the above. Only those staff members involved in the creation of the relevant Intellectual Property in an Invention and who comply with their obligations under this policy will be entitled to any distribution of University income pursuant to this clause. Net income means sale, royalty, licensing and other income received from the commercial development of the Intellectual Property in any Invention less legal and other fees and expenses in establishing and protecting the Intellectual Property and in negotiating and concluding any licensing or other agreements relating to the Intellectual Property. Where more than one staff member is involved the distribution of their share of the income between

themselves will be a matter for them to determine save that where there is failure to agree then income shall be distributed in proportions to be determined by the Pro-Vice-Chancellor (Research).

- 4.8 Distribution of net revenue and any direct payments to staff members under clause 4.7 will be made in accordance with all applicable tax laws and are inclusive of any GST. For the purposes of this clause, 'GST' has the same meaning as 'GST' as defined in *A New Tax System (Goods and Services Tax) Act 1999*.
- 4.9 The revenue sharing arrangements in Clause 4.7 above shall not be available to staff members who are specifically contractually obliged to create and develop Intellectual Property or Inventions on behalf of the University so far as that Intellectual Property or those Inventions are concerned. Any payments to staff members in this category, other than payments governed by their engagements contracts, shall be the subject of *ad hoc* determination by the Pro-Vice-Chancellor (Research) and the appropriate Dean or Director at the time of receipt of income.
- 4.10 The sole authorised signatories on behalf of the University on matters relating to Intellectual Property shall be the Vice-Chancellor or the Pro-Vice-Chancellor (Research). Agreements executed under seal should be subject to the University's usual procedures.

5. MORAL RIGHTS

- 5.1 The University shall observe the Moral Rights of its staff members in accordance with the provisions of the Copyright Act 1968.

6. THIRD PARTY INTELLECTUAL PROPERTY

- 6.1 Staff members and students must ensure that they do not infringe the Intellectual Property rights of third parties. Intellectual Property belonging to third parties shall not be used unless there is a clear right to do so.
- 6.2 The University and its staff members have certain rights to make reproductions of works and television broadcasts and to communicate them, under Part V of the *Copyright Act 1968*. Staff members must observe all requirements of the *Copyright Act 1968* and the University in relation to compliance with the University's obligations under the Act and its agreement with CAL in this regard.

7. DISPUTES

- 7.1 The University wishes to resolve disputes arising with respect to matters covered by its Intellectual Property Policy quickly, fairly and, wherever possible, without resort to litigation or other public dispute resolution procedure. The intent is to reduce the strains that such disputes and their resolution place on the parties so as to affect the work and relationship of those involved as little as possible.
- 7.2 If any dispute arises between the University and a staff member, student or other individual covered by this policy (including former staff members and former

students) with respect to the application of this policy then it shall be resolved under this Clause 7.

- 7.3 If any dispute arises under Clause 7.2, then the University will attempt to agree with the other party/parties to first attempt to resolve the dispute by mediation.
- 7.4 If the dispute is not settled within a reasonable time by mediation, the University will submit the dispute to expedited arbitration administered by, and in accordance with the Arbitration Rules of, the Australian Commercial Disputes Centre (ACDC). Failing agreement as to the arbitrator ACDC would be given power to appoint a person (who is not the same person as the mediator) as arbitrator.
- 7.5 Any mediation or arbitration should be held in conference where an Australian Catholic University campus is located at the convenience of the individual(s) involved.
- 7.6 Nothing in this procedure removes the right of a staff member, former staff member, student, or former student to seek other recourse available under law.

APPENDIX 1

POSTGRADUATE LICENCE

The following is subject to the terms of any agreement that a student may be required to observe where funding is provided by a third party:

[Student] hereby grants to the University a non-exclusive, royalty-free, irrevocable and perpetual licence:

- (i) to use for teaching and research purposes; and
- (ii) subject to the payment of the royalty or fee referred to below, to commercially develop whether by licence or otherwise;

any Intellectual Property (as defined by the University Intellectual Property Policy) the student creates or invents or otherwise acquires rights to in the course of his/her postgraduate study and research with the University.

If the student creates or invents or otherwise acquires Intellectual Property in the course of his/her postgraduate study and research with the University which is in his/her opinion capable of commercial development, then he/she will report its existence to his/her Dean and to the Pro-Vice-Chancellor (Research).

If the University wishes to commercially develop the Intellectual Property then it will notify the student and the student will be recompensed on the same basis as University academic staff would be under the University Intellectual Property Policy, as amended from time to time, if they had an entitlement to remuneration for the same Intellectual Property under the provisions of that policy.

The licence shall not extend to any Intellectual Property the student may own or acquire rights to in respect of:

- (a) books, articles, theses, dissertations and other written works created in the course of the student's study or research and not reasonably considered to possess commercial potential other than where those specific courses and related materials were created at the express request of the University;
- (b) computer programs (in any code) and related materials which have been created during the student's study or research and are not reasonably considered to possess commercial potential other than where those specific programs and related materials were created at the express request of the University;
- (c) artistic works created in the course of the student's research or study other than where those specific works have been created upon the express request of the University;
- (d) musical or dramatic works other than those specific works which have been created at the express request of the University or which are published, performed, broadcast, funded or otherwise supported by University resources.

[The student] acknowledges that the University reserves the right, prior to the student participating in any research project in which University staff are also involved or in which University equipment, facilities or resources will be used, or as a condition of the student's continued participation in any such project, to require the student to assign any Intellectual

Property arising or subsisting in or in respect of any invention, work or other material that the student may in future author, invent or create in the course of working on that project as a condition of the student's participation or continued participation in it.