

## **Intellectual Property Policy Part 1 - General**

### **Previous policies replaced**

- 1.1 From the date of endorsement, this document will replace the University's Intellectual Property Policy, which was endorsed on **July 17 1998**.

### **Objectives and principles**

- 1.2 The University's Intellectual Property Policy seeks to establish a clear and sound framework for the encouragement of invention, creative work and technology development. It provides a framework for managing the University's policy objectives, which are:
- to establish and enhance the climate for innovation and invention;
  - to set out how the University will protect its creative effort and thereby stimulate the proper protection of the University's economic investment in that effort;
  - to assist the University to take commercial advantage of its Intellectual Property;
  - 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 to assign rights to the University in exchange for being included in research programs and receiving benefits, so that the University can properly manage Intellectual Property arising through such programs.

### **Modification of policy**

- 1.3 The University reserves the right to modify or add to this policy. Issues arising will be considered in the light of all relevant circumstances, including the policies in place at the time.

### **Discretion in application of policy**

- 1.4 The Pro-Vice-Chancellor (Research) may vary or depart from the terms of this policy in order to achieve the University's objectives in special cases or unforeseen circumstances, after consultation with the Vice-Chancellor.

## **PART 2 Definitions and Explanation**

- 2.1 For the purposes of this policy document, **Intellectual Property** is given a broad meaning, and includes Copyright existing under the *Copyright Act 1968* in literary works (including computer programs), course materials, dramatic works, musical works, artistic works, films, sound recordings, television and radio broadcasts, and published editions of works (as defined in the Copyright Act). Copyright vests automatically under the Copyright Act without the need for registration, provided the material meets the requirements of an *original work* within the meaning of the Copyright Act.
- Examples of typical activities that may result in copyright include: writing a book or article, writing a dramatic work, writing a thesis, writing teaching materials, writing a manual, designing a form or questionnaire, composing music, writing of computer software, creating a database, making an original videotape, making a multi-media production, making an audio visual production, and creating a work of art.

- Patents for inventions registered or registrable under the *Patents Act 1990*. Patent rights must be secured by lodging an application for registration, before publication or disclosure, with the Australian Industrial Property Organisation.
- Designs registered or registrable under the *Designs Act 1990*. New designs must be registered to be protected. Designs relate to the creation of a new appearance, either two or three dimensional, which can enhance mass-produced articles. Examples include the area of textile design or a machine.
- Trade Marks registered under the *Trade Marks Act 1995*. Trademarks must also be registered to be protected. The marketing of products and the provision of services may lead to the creation of names or logos associated with those products or services. These names or logos can constitute trademarks, some of which may be registrable.
- Unregistered trademarks or names used or intended for use in business.
- New plant varieties, breeding or genetically engineering a new strain of certain plants may be registrable under the *Plant Breeder's Rights Act 1994*.
- Circuit layouts are protected under the *Circuit Layouts Act 1989*. This protects the lay out of integrated circuits (such as designs for computer chip products). Protection under the Circuit Layouts Act is automatic.
- Information that is confidential, including trade secrets. Confidential information can arise by classification in contract or at common law by the circumstances in which information was divulged and received. Information cannot be confidential if it is generally available in the public arena at the time of its disclosure or if it is required to be disclosed by law.

- 2.2 Background Intellectual Property means University Intellectual Property existing prior to, or created independently of a particular project .
- 2.3 Commercially Exploit means to licence, lease, sell or otherwise deal with for the purpose of economic return.
- 2.4 Scholarly Work has its natural meaning and includes for example: scholarly books, chapters of books, journal articles, conference papers, textbooks, artistic works or other academic works authored by University Staff. However, for the purpose of this policy Scholarly Work **does not** include printed or web base course material such as lecture notes, manuals and readers that are developed for the purposes of fulfilling the University's teaching function.
- 2.5 University Staff means - all staff who are employees of the University, whether full-time or part-time, but does not include honorary appointees or those who are consultants or seconded to the University, if they are not employees under contracts of service with the University. (If the University seeks to own or use Intellectual Property created by honorary appointees, consultants or secondees, the University will generally need an assignment or a licence).
- 2.6 University for the purposes of this policy means the University of Tasmania.
- 2.7 The University recognises the moral rights of authors to protect their reputation in connection with their works, which in Australia means:

- the right to be attributed or credited for their work;
- the right not to have their work falsely attributed;
- the right of integrity of authorship of work and not to have their work treated in a derogatory way, for example by distorting or modifying it.

### **Part 3: Policy**

#### **3.1 General rule**

- 3.1.1 As a general rule, the University will assert ownership of Intellectual Property created by University Staff in the course of their employment (excluding copyright in Scholarly Works). Intellectual Property, which the University asserts ownership of, is called **'University Intellectual Property'**.
- 3.1.2 Generally the University will not assert ownership of Intellectual Property rights developed by students, however in consideration of benefits granted to students pursuant to clause 3.1.5, the University may seek to claim ownership of Intellectual Property rights developed by students in the following circumstances:
- a) when Intellectual Property (except copyright in a thesis) arises from a student's project AND Background Intellectual Property is made available by the University for the purposes of the project; and
  - b) when Intellectual Property (except copyright in a thesis) arises from a project which has in whole, or in part, been funded by an external party, or where an external party has some other interest in a project.

The University or the external party may require an assignment of a student's Intellectual Property rights to the University.

- 3.1.3 Where the University does seek to claim ownership of Intellectual Property in accordance with clause 3.1.2 the University will notify the student on enrolment or as soon as possible in writing.
- 3.1.4 Where the University notifies a student that it seeks to claim ownership of Intellectual Property in accordance with clause 3.1.3, the student will:
- a) maintain the confidence of the materials incorporating the Intellectual Property;
  - b) be required to execute an assignment in the form attached at Appendix 1; or
  - c) undertake to work on another project if they do not agree to (a) or (b).
- 3.1.5 Where the University claims ownership of Intellectual Property in accordance with clause 3.1.2, students will be accorded the same rights as staff regarding the distribution of income under clause 4.3.

#### **3.2 Agreements with third parties prevail over this policy**

- 3.2.1 The provisions of any contract or agreement in writing between the University and a third party govern ownership of all rights in Intellectual Property that arises out of or in connection with the project that is the subject of that agreement, despite any contrary provisions in this policy.
- 3.2.2 All contracts and agreements between the University and third parties, which exist at the time this policy is adopted and which relate to Intellectual Property, remain in full force despite any contrary provisions in this policy.

#### **Part 4: Exploitation of University Intellectual Property**

##### **4.1 Notice of creation of University Intellectual Property**

- 4.1.1 Where University Staff develop University Intellectual Property that may have commercial potential they or their Head of School should notify the Pro-Vice-Chancellor (Research).
- 4.1.2 Information disclosed under clause 4.1.1 must be kept confidential until the Pro-Vice-Chancellor (Research) advises otherwise.
- 4.1.3 The Pro-Vice-Chancellor (Research) will advise University Staff who have an interest in University Intellectual Property, whether or not the University wants to exploit University Intellectual Property disclosed under clause 4.1.1.
- 4.1.4 If the University does not wish to be involved in the exploitation of University Intellectual Property disclosed under clause 4.1.1, it may agree to assign or licence it to University Staff upon commercial terms or terms approved by the Pro-Vice-Chancellor (Research). Any exploitation of University Intellectual Property by University Staff after it is assigned or licensed to them will be at their own risk.

##### **4.2 Exploitation of University Intellectual Property**

- 4.2.1 This clause applies when the University decides it wants to exploit University Intellectual Property.
- 4.2.2 Any University Staff involved in the creation of University Intellectual Property, whether as an inventor, an owner or otherwise, must be taken to have agreed that the University has an irrevocable authority to act on their account and to execute any document that the University decides is necessary for the purposes of commercial exploitation of University Intellectual Property consistent with the objectives of this policy.
- 4.2.3 University Staff must comply with all reasonable directions and provide all reasonable assistance in the exploitation process, including maintaining the confidence of information incorporating the Intellectual Property, providing information promptly on request; attending meetings with potential licensees; and advising on further development.
- 4.2.4 The University may consult on a confidential basis, with appropriate experts and advisers, before deciding on the appropriate action in relation to the exploitation of University Intellectual Property. That action may include, but is not limited to:
- a) requesting assistance and advice on patenting, funding and other aspects of the commercialisation of Intellectual Property;

- b) the filing of a patent application in the name of the University with the University Staff named as inventor;
- c) the identification of potential licensees;
- d) the assignment of rights to a third party;
- e) the formation of a limited liability company to exploit the Intellectual Property.

4.2.5 The University must use all reasonable endeavours to pursue the exploitation in a timely manner.

### **4.3 Distribution of income**

4.3.1 The Pro-Vice-Chancellor (Research) will distribute the University's share of income arising from the exploitation of University Intellectual Property (after deducting the costs associated with commercial exploitation) as follows:

- (a) **50%** to the University Staff members involved in the creation of the Intellectual Property;
- (b) **20%** to the school or division in which the University Staff involved in the creation of the Intellectual Property is deployed;
- (c) **30 %** to the University, to be used at the discretion of the Pro-Vice-Chancellor (Research).

4.3.2 The Pro-Vice-Chancellor (Research) may review the basis upon which the University's share of income from the commercial exploitation of University Intellectual Property is distributed in relation to a particular project, taking into account all the relevant circumstances.

### **5. Non-compliance**

The failure of University Staff to comply with the terms of this policy may result in disciplinary action being taken against them.

### **6. Dispute Resolution**

6.1 Disputes arising under this policy will in the first instance be referred to the Pro-Vice-Chancellor (Research) who will make a determination.

6.2 A person aggrieved by the Pro-Vice-Chancellor (Research) determination may refer the matter to an independent mediator appointed by the President of the Law Society of Tasmania. If the matter is referred to mediation, the parties will agree to abide by the decision of the mediator.

## Appendix 1

### Deed of Assignment

This Deed is made on the [date].

Between

[name of assignor] of [insert address] ("the Assignor").

and

The University of Tasmania ABN 30, 764,374,782 a body corporate, established under the University of Tasmania Act, 1992, Churchill Avenue, Sandy Bay, Tasmania ("the University").

#### Introduction

- A. The Assignor is a student/Honorary Appointee at the University.
- B. In the course of the Project the Assignor has or will create Project Results.
- C. In consideration of benefits granted to the Assignor under the Intellectual Property Policy, the Assignor agrees to assign all Intellectual Property rights in the Project Results to the University.

#### Operative provisions

##### 1. Definitions and interpretation

###### 1.1 Definitions

In this Deed, unless the context requires another meaning:

**"Confidential Information"** means the Project Results and any information designated by the University as confidential or which the Assignor knew or ought to have known was confidential, but does not include information, which:

- (a) is already in the public domain;
- (b) is received by the Assignor from a party who is lawfully in possession and has the power to disclose the information; or
- (c) becomes available to the Assignor other than by a breach of this Deed;
- (d) the Assignor is required to disclose by law.

**"Intellectual Property Policy"** means the Intellectual Property Policy of the University at the date of signature of this Deed.

**"Intellectual Property"** has the meaning given to it by the Intellectual Property Policy.

**"Project"** means the [identify project].

**"Project Results"** means those results of the Project, which have or will be created by the Assignor, as result of the Project.

**"University Staff"** has the meaning given to it by the Intellectual Property Policy.

## **1.2 Interpretation**

In this Deed, unless the context requires another meaning a reference:

- (i) to the singular includes the plural and vice versa;
- (ii) to a document (including this Deed) is a reference to that document (including any Annexures) as amended, consolidated, supplemented, novated or replaced;
- (iii) Where a word or phrase is defined, its other grammatical forms have a corresponding meaning.

**1.3** To the extent of any inconsistency between the Intellectual Property Policy and the terms and conditions of this deed, this Deed will prevail.

## **2. Assignment**

**2.1** The Assignor assigns to the University, absolutely, all of their Intellectual Property rights, existing now and in the future, in the Project Results (other than copyright in the Assignor's doctoral or masters thesis), throughout the world.

**2.2** The Assignor agrees to disclose the Project Results to the University, or any person nominated by the University, and to provide all other assistance and relevant information in order to assist the University, its contractors, agents or assigns to commercially exploit the Project Results.

**2.3** Without limiting the University's rights, the University may assign the Intellectual Property in the Project Results to a third party for the purposes of commercial exploitation.

## **3. Publication**

The Assignor agrees to withhold publication of their doctoral or masters thesis (other than for the purposes of examination), or other publication relating to the Project, until the written permission of the University is obtained, which shall not be unreasonably withheld.

## **4. Application of Intellectual Property Policy**

The Assignor agrees that, in respect of the Project Results, they will comply with the Intellectual Property Policy as though they were University Staff and the Project Results were created in the course of their employment.

## **5. Distribution of Income**

The Assignor agrees that paragraph 4.3 of the Intellectual Property Policy will govern the distribution of income resulting from the exploitation of the Project Results.

## **6. Non-disclosure**

To the extent that the Intellectual Property rights in the Project Results are in the nature of confidential information, the Assignor agrees:

- (a) that they will not, without the prior written consent of the University communicate or otherwise make available the Project Results to any third party;
- (b) use the Project Results for any purpose other than in their continued involvement in the Project, except to the extent necessary for the submission of their doctoral thesis for examination purposes; and
- (c) that they will not, without the prior written consent of the University, disclose the terms of this Deed.

**7. Appointment of attorney**

The Assignor undertakes at the expense of the University to do all acts and execute all documents necessary or desirable for giving effect to this Deed and in case of default the Assignor hereby irrevocably appoints the University as its attorney for such purpose.

**8. Warranties**

The Assignor represents, warrants and undertakes to the University that to the best of their knowledge, they have the right and authority to enter into this Deed.

**9. Entire Agreement**

This Deed and any documents referred to in this Deed or executed in connection with this Deed is the entire agreement of the parties about the subject matter of this Deed and supersedes all other representations, negotiations, arrangements, understandings or agreements and all other communications. No party has entered into this Deed relying on any representations made by or on behalf of the other, other than those expressly made in this Deed.

**10. Costs**

The University will pay the stamp duty chargeable on this Deed.

**11. Governing Law**

This Deed shall be governed by and construed in accordance with the laws of the State of Tasmania.

**Executed as a deed**

Signed sealed and delivered )  
by **[specify]** )  
in the presence of: )

\_\_\_\_\_  
Signature of witness

\_\_\_\_\_  
Signature of **[specify]**

\_\_\_\_\_  
Name of witness (please print)

**Signed** for and on behalf of )  
**the University of Tasmania** )  
by its duly authorised representative )  
in the presence of: )

\_\_\_\_\_  
Signature of witness

\_\_\_\_\_  
Signature of authorised representative

\_\_\_\_\_  
Name of witness (please print)

\_\_\_\_\_  
Name of authorised representative  
(please print)