

# Intellectual Property Procedure

## Section 1 - Context

- (1) This document supports the implementation of the University's [Intellectual Property Policy](#) and should be read in conjunction with that document.
- (2) The following procedures will be followed in applying the provisions of the [Intellectual Property Policy](#).

## Section 2 - Procedure for Registration of University IP

- (3) The University will maintain an Intellectual Property Register in the Office of the Deputy Vice-Chancellor (Research and Innovation). A report on the register will be made annually to University Council.
- (4) The Intellectual Property Register will include the following information:-
  - a. a description of the University IP and its location;
  - b. the names of those responsible for the University IP;
  - c. any potential or current risks associated with the University IP;
  - d. where the University has a licence to use a third party's IP: details of the licence, licensor, expiry date and payments;
  - e. the anticipated costs and any anticipated revenue associated with the University IP; and
  - f. any other information concerning the University IP which the Deputy Vice-Chancellor (Research and Innovation) indicates is required.
- (5) Where a staff member creates University IP that may be capable of commercialisation, the staff member will disclose the details of the University IP to the Deputy Vice-Chancellor (Research and Innovation).
- (6) Where a student creates University IP which may be capable of commercialisation, the student will advise the supervisor who will disclose the details of the University IP to the Deputy Vice-Chancellor (Research and Innovation).
- (7) Staff or students who create University IP will be required to uphold confidentiality in accordance with the provisions of the [Intellectual Property Policy](#).
- (8) Once University IP is entered on the Intellectual Property Register, the procedure for commercialisation of University IP will apply.

## Section 3 - Procedure for Commercialisation of University IP

- (9) When University IP is entered on the Intellectual Property Register, the Deputy Vice-Chancellor (Research and

Innovation), in consultation with the originator(s) and any other relevant University member(s) or external expert(s), will determine within eight weeks (the determination period), whether the University wishes to commercialise the University IP.

(10) The Deputy Vice-Chancellor (Research and Innovation) will make the determination on the basis of appropriate legal, financial and commercial advice, relevance of the intellectual property to the University's purposes, and with reference to the University's [risk management framework](#).

(11) Within the determination period, the Deputy Vice-Chancellor (Research and Innovation) will ensure that the ownership of the University IP is verified and will take all necessary steps to determine and verify that ownership. The originator(s) will assist where required in the verification process.

(12) During the determination period, the Deputy Vice-Chancellor (Research and Innovation) and the originator(s) will do all things necessary to ensure that the University IP is treated as confidential, including by having any persons consulted during that period sign confidentiality agreements.

(13) Where a decision is not made about the commercialisation of the University IP within the determination period, or where it is determined that the University does not wish to commercialise the University IP, the ownership of the University IP will be assigned in writing by the Deputy Vice-Chancellor (Research and Innovation) to the originator(s).

(14) If it is determined that the University wishes to commercialise the University IP, the Deputy Vice-Chancellor (Research and Innovation) will seek within two weeks of the end of the determination period to engage The University of Newcastle Research Associates Limited (TUNRA) under an agreement with the University to commercialise the University IP.

(15) If TUNRA declines to enter into an agreement with the University for the commercialisation of the University IP, the Deputy Vice-Chancellor (Research and Innovation) will determine, in consultation with the originator(s), what course of action is then to be followed.

(16) If it is determined that commercialisation will occur, the University will enter into an agreement with the originator(s) and owners of any other intellectual property involved in the commercialisation setting out, at a minimum:-

- a. the ownership of the University IP and any other intellectual property;
- b. the agreed share of any net returns (being net returns after deduction of all direct University costs in the creation, development and protection of the University IP) from the commercialisation; and
- c. any other relevant matters.

(17) The Deputy Vice-Chancellor (Research and Innovation) may, on written application from the originator(s), waive or reduce all or some of the University direct costs referred to in Clause 16, but is not bound to do so.

(18) In the event of returns from commercialisation, unless a separate agreement has been entered into between the University and the originator(s), the net returns will be apportioned by the University as follows:

<b>Apportionment</b>	<b>Originator(s)</b>	<b>University</b>
First \$50,000 of Net Returns	100%	0%
Portion of Net Returns between \$50,000 and \$100,000	65%	35%
Portion of Net Returns exceeding \$100,000	50%	50%

(19) Where the University receives a share of the returns from commercialisation under Clause 18 above, the Deputy

Vice-Chancellor (Research and Innovation) will determine whether that share is to be distributed and, if so, whether the distribution will be

- a. within the University;
- b. to bodies external to the University; or
- c. a combination of (a) and (b) above.

## **Section 4 - Role of TUNRA**

(20) In accordance with the [Intellectual Property Policy](#), TUNRA has the first right of refusal in relation to proposed commercialisation.

(21) Prior to any disclosure of University IP to TUNRA, a staff member must inform, and obtain the consent of, the Deputy Vice-Chancellor (Research and Innovation).

(22) Where TUNRA enters into an agreement with the University under Clause 14 to commercialise University IP, the University will require TUNRA to manage the distribution of net returns, maintain records related to the accrual of net returns and advise the University and the originator(s) when a threshold amount is reached and the appropriate change in the proportion of net returns to be distributed pursuant to this procedure.

## **Section 5 - Procedure for Assignment of University IP**

(23) University IP may only be assigned with the written approval of the Deputy Vice-Chancellor (Research and Innovation).

(24) Where the University elects to assign University IP to the originator(s) under Clause 13, the Deputy Vice-Chancellor (Research and Innovation) will provide the assignment in writing.

(25) An originator(s) who wishes to have assigned to them University IP in the form of copyright in course materials or computer works will apply in writing to the Pro Vice-Chancellor of the College or Head of Division, who after consultation with the Head of School or other senior staff, will advise the Deputy Vice-Chancellor (Research and Innovation). The written application will include an assurance that the intellectual property is the original work of the staff member or student, or if produced jointly, will identify other person(s) involved and their agreement to the request for assignment.

(26) The Deputy Vice-Chancellor (Research and Innovation) will determine whether to grant the assignment and what conditions, if any, will apply.

(27) Where University IP is assigned to a staff member or student, the University reserves the right to require a royalty-free, world-wide licence to the University for use for its purposes and reserves the right to include the licence conditions in any assignment of University IP.

## **Section 6 - Procedure for Bringing Intellectual**

# Property to the University

(28) A staff member or student who brings intellectual property to the University may, on commencement of or at any time during employment or enrolment be required by the Deputy Vice-Chancellor (Research and Innovation) to provide documentation that includes:

- a. a description of that intellectual property;
- b. all documents relating to the ownership of that intellectual property, including any contract, agreement, licensing agreement or another institution's intellectual property policy; and
- c. written warranties that the use of that intellectual property does not infringe the rights of any third parties.

## Section 7 - Procedure for Dealing with a Copyright Work when a Staff Member Ceases University Employment

(29) Where the University owns a copyright work created by a staff member who is about to leave the employment of the University, the staff member will do all things necessary to ensure that the University's intellectual property in the copyright work is protected, including by ensuring that the copyright work:

- a. remains with the University; and
- b. is not used by the staff member after leaving the employ of the University, except with the written consent of the University.

(30) The staff member who is leaving the employment of the University may request a licence of the intellectual property in the copyright work. The University reserves the right to grant a licence on conditions or to not grant a licence if University purposes would be adversely affected.

## Section 8 - Procedure for Student Participation in University Projects

(31) Where a student participates in a University project:

- a. the student will be subject to the provisions of the [Intellectual Property Policy](#) as if the student is a staff member; and
- b. the University will:
  - i. enter into an agreement with the student setting out an appropriate entitlement of the student to any net returns of commercialisation;
  - ii. ensure that the academic progress of the student is not hindered by the provisions of the [Intellectual Property Policy](#);
  - iii. ensure that the examination of the thesis is not affected by the provisions of the [Intellectual Property Policy](#) without the express consent of the student; and
- c. ensure that the student is advised to seek independent legal advice before entering into any agreement concerning intellectual property created by the student in the course of their studies.

(32) In accordance with Clause 31(b)(i), an agreement between the University and a student will address at a

minimum: the terms on which access to University IP will be given; intellectual property ownership; confidentiality requirements; terms governing any potential commercialisation; and any requirements concerning intellectual property at the end of the student's enrolment.

## **Section 9 - Advising Staff Members and Students of Their Rights and Obligations and Protection the Rights of Students**

(33) The University will take all reasonable steps to ensure that the provisions of the [Intellectual Property Policy](#) and Procedure are made known to staff members and students, including through:

- a. induction and training programs, educational seminars, enrolment handbooks and other published material for staff members and students and through the University's web site;
- b. specific inclusion in supervisor training programs; and
- c. information sessions for students at the time of application for candidature and enrolment.

(34) In any dealings involving students and their intellectual property rights, the University will assist students to protect their intellectual property rights by:

- a. ensuring that students are advised to seek independent legal advice before entering into any agreement concerning or assignment of intellectual property rights;
- b. publishing on the University web site the contact details for a staff member in each College or Division from whom students may seek advice about the operation of the [Intellectual Property Policy](#) and Procedure; and
- c. ensuring that students are informed about their rights and obligations in relation to the [Intellectual Property Policy](#) and Procedure and that the information is updated during the course of the enrolment where there are any changes to the [Intellectual Property Policy](#) and Procedure.

## **Section 10 - Protection of University IP**

(35) A staff member or student who becomes aware of any unauthorised use of University IP will promptly inform the Deputy Vice-Chancellor (Research and Innovation).

(36) A staff member or student who uses University IP contrary to this policy or without proper authorisation may, if the Deputy Vice-Chancellor (Research and Innovation) determines, be subject to a referral for action under the relevant Workplace Agreement or [Student Conduct Rule](#).

## **Section 11 - Dispute Resolution**

(37) If there is any dispute on whether intellectual property was created within the course of a staff member's duties, the staff member will consult the Deputy Vice-Chancellor (Research and Innovation), who will investigate the matter, either personally or through a delegate of suitable seniority with no prior involvement in the dispute. The Deputy Vice-Chancellor (Research and Innovation) will provide a determination which will be binding.

(38) A staff member, student or other person having a dispute with the University arising out of the operation of this policy, other than one covered by Clause 37 should consult the University's [Complaint Management Policy](#) to determine how the dispute may be resolved.

(39) The University's Complaints Manager may be consulted for assistance in relation to any complaint or dispute arising from the operation of this policy.

## Status and Details

<b>Status</b>	Current
<b>Effective Date</b>	23rd August 2011
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<b>Expiry Date</b>	Not Applicable
<b>Responsible Executive</b>	Warwick Dawson Pro Vice-Chancellor Industry and Engagement
<b>Enquiries Contact</b>	Warwick Dawson Pro Vice-Chancellor Industry and Engagement <hr/> Office of the Pro Vice-Chancellor Industry and Engagement

## Glossary Terms and Definitions

**"University"** - The University of Newcastle, a body corporate established under sections 4 and 5 of the University of Newcastle Act 1989.

**"Risk"** - Effect of uncertainty on objectives. Note: An effect is a deviation from the expected, whether it is positive and/or negative.

**"Candidature"** - The period of time between acceptance of offer and termination, withdrawal from, or completion of a higher degree by research program, including periods when a candidate is not enrolled.

**"Complaint"** - As defined in Australian/New Zealand Standard - Guidelines for complaint management in organisations.

**"Student"** - A person formally enrolled in a course or active in a program offered by the University or affiliated entity.

**"Dispute"** - Any dispute, difference or issue between the parties concerning or arising out of or in connection with or relating to an agreement or the subject matter of an agreement or the breach, validity, rectification, frustration, operation or interpretation of an agreement.

**"Intellectual property"** - Intellectual property (IP), as defined by the World Intellectual Property Organisation, refers to creations of the mind: inventions; literary and artistic works; and symbols, names and images used in commerce. Intellectual property is divided into two categories: Industrial property includes patents for inventions, trademarks, industrial designs and geographical indications; and Copyright covers literary works (such as novels, poems and plays), films, music, artistic works (e.g. drawings, paintings, photographs and sculptures) and architectural design. Rights related to copyright include those of performing artists in their performances, producers of phonograms in their recordings, and broadcasters in their radio and television programs.

**"Program"** - When referring to learning, a program is a sequence of approved learning, usually leading to an Award. For all other uses of this term, the generic definition applies.

**"Senior staff"** - Deputy Vice-Chancellor, Pro Vice-Chancellor, Global Innovation Chair, Global Innovation Professorial Fellow, Head of School, Director or equivalent.

**"Staff"** - Means a person who was at the relevant time employed by the University and includes professional and

academic staff of the University, by contract or ongoing, as well as conjoint staff but does not include visitors to the University.

**"Supervisor"** - Staff members with direct supervisory responsibility for other staff within the workplace (a Supervisor may also be member of Senior Management, with duties as an Officer as defined in the Work Health and Safety Act 2011, or any replacing legislation).

**"Term"** - When referring to an academic period, term means a period of time aligned to an academic year for the delivery of a course in which students enrol and for which they are usually charged fees for example semesters, trimesters, summer, winter or full-year term. The academic year for a term is determined by the academic year in which the course commences, not concludes. For all other uses of this term, the generic definition applies.

**"Third party"** - A person or group other than the University or any of the University's partner institutions.

**"College"** - An organisational unit established within the University by the Council.