Reporting and Managing Intellectual Property Procedure

Section 1 - Purpose

(1) This Procedure outlines the manner by which Intellectual Property (IP), created by University of Canberra (University) Staff, Students and Affiliates in the course of their employment by, or enrolment at, the University or through the use of University Resources, is to be protected, managed and commercialised. This Procedure is made in accordance with the University's Intellectual Property Policy.

Section 2 - Procedure

Notification of Pre-Existing IP

(2) The University does not assert ownership over Pre-Existing IP.

(3) 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 Intellectual Property Officer (IP Officer) of the existence and specific details of any Pre-Existing IP that the staff member, affiliate or student brings to the University.

(4) Notice should be provided within three months from commencement of employment, enrolment, or engagement by the University by completing and submitting the Pre-Existing IP Notification Form to the Intellectual Property Officer. This notice will include a written warranty that the use of Pre-Existing IP does not infringe the rights of any third parties.

(5) 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 Intellectual Property Policy effective at the time of receipt of notice.

Assignment of IP to the University

(6) If not otherwise assigned through the operation of any agreement or law and if assignment is required to enable the University 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.

(7) At the request of the Intellectual Property Officer, or that person's authorised representative, each member of staff, affiliate or student who creates IP ('Creator') will execute any and all documents required by the University to evidence the assignment of that IP to the University.

(8) 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.

(9) Research Services will maintain a record of all Assignment Deeds executed under clauses 6 to 9 of this Procedure.

Student Participation in Externally Funded University Research Projects

(10) 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 Intellectual Property Policy.

(11) 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 a Student Assignment of Intellectual Property Deed Poll (contact EngageUC by email at EngageUC@Canberra.edu.au), which at a minimum will:

a. 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;
b. grant a license to the University to use any Pre-Existing IP owned by the student that is used in the research project; and
c. assign his or her IP arising from his or her participation in the externally funded research project.

(12) 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).

(13) A student who assigns their IP rights and gives consent in respect of any moral rights under clause 11 is, subject to any agreement, entitled to a share of net commercial income in accordance with clause 38.

(14) If the student does not agree to anything required under clause 11 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.

(15) The University shall ensure that the provisions of the Intellectual Property Policy, the Student Assignment of Intellectual Property Deed Poll and any other agreement setting out an appropriate entitlement of the student to any net returns of commercialisation shall:

a. not hinder the academic progress of the student; and
b. not affect the examination of the student thesis.

(16) Research Services will maintain a record of agreements executed by the student under clauses 10 to 16 of this Procedure.

Disclosure of IP

(17) A staff member, affiliate or student, who is a Creator of an IP shall report the creation of that IP to the Intellectual Property Officer and will disclose the details of the new IP by completing the Invention Disclosure Form where:

a. the new IP may be patentable; or
b. disclosure is a legal requirement specified in a contract.

(18) 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.

(19) The disclosed IP will be entered in the IP Register to be maintained by Research Services.

(20) Once the IP is entered in the IP Register, the procedures for protection and commercialisation of disclosed IP

under clauses 21-29 and clauses 30-35 of this Procedure, will apply.

Protection of Disclosed IP

(21) The University Intellectual Property 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.

(22) During the evaluation period, the Intellectual Property Officer, Research Services and the Creator will take all necessary steps to:

a. determine and verify ownership of the Disclosed IP; and
b. evaluate the need for, best mode and cost of Protection of the Disclosed IP. The Creator(s) must assist where required in the verification process.

(23) During the Evaluation Period, the Intellectual Property Officer, Research Services and the Creator(s) will do all things necessary to ensure that the disclosed Intellectual Property is treated as confidential, including by having any persons consulted during that period sign confidentiality agreements.

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

(25) If the University decides to support the protection of IP, the Research Services 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.

(26) The cost of initial IP Protection under clause 25 shall be borne by the University.

(27) 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.

(28) 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 clauses 42 to 46.

(29) A review of the disclosed and protected IP entered in the IP Register will be undertaken by Research Services annually.

Commercialisation of Disclosed IP

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

(31) The Creator(s) will work with the Research Services 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 Intellectual Property Officer for evaluation.

(32) The University Intellectual Property Officer, in consultation with the Creator(s), internal and external expert(s), shall decide whether the University will undertake the commercialisation of the disclosed Intellectual Property by itself

or in collaboration with or through a commercial partner.

(33) 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 38.

(34) The University, through the Research Services, 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).

(35) Should the University Intellectual Property 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 Intellectual Property is a University owned Intellectual Property, it shall be assigned to the Creator following the procedures under clauses 42 to 46.

Disbursement of Net Commercialisation Income

(36) Benefits or proceeds received by the University from the commercialisation of Course Materials will be retained fully by the University to be utilised to support its core mission in teaching and research.

(37) Research Services will work with Finance & Analytics in maintaining a record of any Commercialisation Costs incurred by the University in relation to the Commercialisation of Disclosed IP.

(38) As contemplated in the Intellectual Property Policy, the Net Proceeds of Commercialisation of Disclosed IP received by the University will be disbursed as follows:

a. 40% to the Creator, and if more than one Creator, 40% to be shared among the Creators as per their agreement;
b. 30% to the University; and
c. 30% to the relevant Faculty or Research Centre of the Creator(s).

(39) The Creator(s)'s share as per the above clause 38 (a) shall be deposited in the bank account he/she nominates to Finance & Analytics.

(40) 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.

(41) 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.

Assignment of University IP

(42) The University owned IP will be assigned to the Creator if the University decides not to:

a. protect the disclosed IP as per clause 28 of this Procedure, or
b. proceed with, or continue with, the commercialisation of the disclosed IP as per clause 35 of this Procedure.

(43) The Research Services will discuss and negotiate the terms and conditions of assignment which will include in all cases the following:

a. The University will retain a non-exclusive, royalty-free, world-wide licence to use the Intellectual Property for education and/or research purposes.

b. The University will receive a future benefit amounting to 20% of the net revenue received by the Creator from net commercialisation proceeds.
c. A requirement for the Creator to report regularly to the University in relation to progress made with the exploitation of assigned Intellectual Property and the revenue entitlements of the University.

(44) The assignment of Intellectual Property to the Creator will only relate to that Disclosed IP specifically described in the relevant Invention Disclosure Form. The assignment will not cover Intellectual Property included in other Invention Disclosure Forms in the same area of research submitted by the same Creator.

(45) Research Services working closely with Legal to prepare an agreement with the Creator.

(46) The Research Services will maintain a record of assignment of Intellectual Property agreements executed under this clauses 42 to 46.

Access to Research Outputs

(47) To enable the University to make Research Outputs accessible to the wider community:

a. Staff or affiliates leading Externally Funded Research Projects are required to provide the following information to the Research Services:
    i. the research output(s);
    ii. period of publication;
    iii. the title of the project; and
    iv. funding organisation;
b. Research Services will confirm the correctness of the information received under the above clause 47(a) against the Research Services database, and determine whether the reported Research Outputs comply with the following conditions for inclusion in the University Research Publications Repository:
    i. 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 Higher Education Research Data Collection (HERDC) and Excellence in Research for Australia (ERA);
    ii. 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;
    iii. HDR Committee (HDRC) theses;
c. Research Services will provide the University Study Skills a list of confirmed Research Outputs from Externally Funded Research Projects;
d. University Study Skills shall include the Research Outputs confirmed by Research Services in the University Research Publications Repository and make it accessible by open access, where copyright and other restrictions allow.

(48) Where a publisher embargo or other conditions exist that restrict open access, the University Study Skills will comply with any embargo or restrictions before making the manuscript available by open access.

(49) Depositing research outputs in the University Research Publications Repository under clauses 47 to 52 does not transfer copyright to the University. Copyright remains with the author or publisher as per the publishing contract.

(50) The University Study Skills will not alter the material except as allowed under law to:

a. 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; or

b. make more than one copy of the work(s) for the purposes of security, back-up and preservation.

(51) 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.

(52) Dissemination of knowledge through commercialisation is covered under clauses 30 to 35 of this Procedure.

Dispute Resolution

(53) Student Intellectual Property related disputes will be appealed and considered under the University's Student Grievance Resolution Policy.

(54) In general, concerns, queries and disputes relating to the interpretation or operation of the Intellectual Property Policy and these 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 Executive Dean, or the Director, Research Services, who will endeavour to resolve their concerns, queries and Intellectual Property related disputes as quickly as possible.

(55) If the dispute cannot be resolved informally, the Staff or Affiliate may submit a written notice of the nature and details of the dispute to the Intellectual Property Officer, including any supporting document.

(56) Within 21 days from receipt of the notification of dispute, the Intellectual Property Officer will convene a meeting of all those notified of the existence of the dispute and any other persons which the Intellectual Property Officer believes is able to assist in the speedy and equitable resolution of the dispute.

(57) The University Intellectual Property Officer will issue a written order to:

a. confirm the agreements made to resolve the dispute; or
b. refer the dispute for further determination by the Vice-Chancellor if the dispute us not resolved within 30 days of the meeting convened under above clause 47.

(58) The Vice-Chancellor will evaluate the dispute based on written documents submitted by the Staff member or Affiliate and any findings of the Intellectual Property Officer made available to the Vice-Chancellor.

(59) Within 30 days from receipt of the order of referral, the Vice-Chancellor shall render a decision on the dispute. The Vice-Chancellor's written decision shall be given to the Research Services for recording and delivery to the Staff member or Affiliate concerned.

(60) All documents and discussions associated with the Intellectual Property disputes will be held confidential.

Management of University IP

(61) Subject to the relevant laws and procedures, the University, at its sole discretion, is entitled to manage the Intellectual Property it owns in any manner.

(62) Working with internal and external experts, Research Services is responsible for negotiating contracts between the University and the Staff member, Affiliates, Students and external parties in relation to the:

a. assignment to any other party of the University's right, title, and interest in any Intellectual Property owned by it;
b. prosecution, maintenance and defence of any application or grant of any type of Intellectual Property Protection for any Intellectual Property it owns;

c. appointment of agents to act on behalf of the University regarding the management and Commercialisation of Intellectual Property; and
d. commercialisation of any Intellectual Property in any manner.

(63) A duly authorised agreement between the University and a third party may vary the operation of the Intellectual Property Policy and this Procedure, especially in relation to the ownership of Intellectual Property created in accordance with the terms of the agreement and the rights of the University in relation to ownership, use and management of that Intellectual Property.

(64) Research Services will maintain a record of all actions taken and resulting agreement for all Intellectual Property actioned and managed on behalf of the University.

Information and Education in Relation to IP

(65) Information in relation to the effect and operation of this Procedure may be sought in the first instance from Research Services who may refer a request for information to the University Intellectual Property Officer or such other party as may be deemed appropriate.

(66) The University, through the Director, Research Services will establish a flexible Intellectual Property education program to ensure that the provisions of the Intellectual Property Policy, this Procedure and relevant information on knowledge transfers and Commercialisation are made known to the University community, including through:

a. the People & Culture induction programs;
b. research student education programs;
c. sponsorship of annual workshops or other programs such as the Early Career Academic Researcher Development (ECARD) Program; and
d. the development of the University website, including guidelines on Intellectual Property management and Intellectual Property Commercialisation-related matters.

(67) Research Services will evaluate and report on the effectiveness of the Education Program to the Intellectual Property Officer.

Section 3 - Roles and Responsibilities

Subject Matter	Procedure or Action	Responsibility	Relevant clause
Notification of Pre-Existing IP	Notice (using Pre-Existing IP Notification Form) includes warranty of non-infringement of 3rd party IP rights	Staff, affiliate, student	2 to 4 (inclusive)
	Receipt of notice	University Intellectual Property Officer	2
Assignment of IP to the University	Assignment of IP rights (if requested by University Intellectual Property Officer)	Staff, affiliate, student	7
	Drafting, negotiation and execution and recording of Assignment Deeds	Research Services	9

Subject Matter	Procedure or Action	Responsibility	Relevant clause
Student Participation in Externally Funded Research Projects	Inform student of all requirements for participation in the project	Staff supervising the student	12
	Assignment of IP (using Student Assignment of Intellectual Property Deed Poll)	Student	13
	Drafting, negotiation and execution and recording of Assignment Deeds	Research Services	16
Disclosure of IP	Disclosure of IP (using Invention Disclosure Form)	Staff, affiliate or student	17
	Recording of disclosed IP in a Register	Research Services	19
Protection of Disclosed IP	Evaluation and Assessment of Disclosed IP	University Intellectual Property Officer in consultation with University members and/or external experts as needed	21
	Inventorship determination and evaluate mode of IP protection	Research Services	22
	Render decision to support or not to support IP protection	University Intellectual Property Officer	25 and 27
	Engagement of external expert for IP protection	Research Services	25
	Maintenance of IP Register	Research Services	29
Commercialisation of Disclosed IP	Development of a commercialisation plan for the protected IP	Staff	31
	Render a decision to commercialise	University Intellectual Property Officer in consultation with University members and/or external experts as needed	32
	Engagement of external legal expert for commercialisation	Research Services	34
	Drafting, negotiation and execution and recording of commercial agreement	Research Services and external legal (as needed)	34
Disbursement of Net Commercialisation Income	Recording of commercial cost in relation to IP	Research Services working with Finance & Analytics as needed	37
	Disbursement of Creator's share in net commercialisation income, including holding share in trust for the Creator	Finance & Analytics	39 and 40
Assignment of University IP	Render a decision to assign University IP (including determination of terms of assignment)	University Intellectual Property Officer	42 and 43
	Drafting, negotiation and execution and recording of Assignment Deed	Research Services (working with internal as well as external legal experts as needed)	45

Subject Matter	Procedure or Action	Responsibility	Relevant clause
Access to Research Outputs	Data collection on research outputs	Research Services working with Faculty/University Research Centre	47(b)
	Reporting of research outputs from Externally Funded Research Projects	Staff	47(a)
	Confirmation of correctness of reported research outputs	Research Services	47(c)
	Inclusion of confirmed research outputs in the University Research Publications Repository	Study Skills	47(d)
	Compliance with any publication embargo	Study Skills	48
Dispute Resolution	Resolve student related IP dispute	Faculty Dean or Director, Research Services guided by the SGRP Appeals against decision of Dean/Director to Student Appeals Committee	53, 54
	Informal meetings to resolve IP disputes, queries, concerns	Faculty Dean, Director, Research Centre or Director, Research Services	54
	Convening formal dispute resolution meetings and rendering of decision	Intellectual Property Officer	56
	Decide appealed disputes	Vice-Chancellor	58
Management of IP	Evaluate and undertake commercialisation activities and maintain record of each IP managed	Research Services	61 to 64
Information and Education in relation to IP	Establish and evaluate the IP Education Programme	Research Services	66 and 67

Status and Details

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