



THE UNIVERSITY OF
NOTRE DAME
A U S T R A L I A

POLICY: INTELLECTUAL PROPERTY

Purpose:	Details ownership of intellectual property [IP]
Responsible Executive:	Provost
Responsible Office:	Office of the Provost
Contact Officer:	Manager, Office of the Provost
Effective Date:	September 2006
Modification History:	

Rationale

- 1.1 The University of Notre Dame Australia's primary object is to provide excellence in teaching, scholarship and research within the context of Catholic faith and values. In pursuing this standard of excellence both employees and students of the University are encouraged to engage in scholarship and research which may result in the creation of intellectual property.
- 1.2 The aim of the Intellectual Property Policy is to create a framework in which research, invention and the creation of intellectual property by employees and students is encouraged, protected and rewarded for the benefit of employees, students and the University. This Policy defines:
 - the circumstances in which the University will claim ownership of Intellectual Property created by employees, students and external participants;
 - the circumstances in which employees and students are entitled to ownership of Intellectual Property created by them in the course of their employment or studies at the University;
 - the extent to which the University is entitled to exploit the rights attaching to any Intellectual Property owned by it; and
 - the extent to which employees, students and the University are entitled to share in the profits in the event that Intellectual Property is commercialised.
- 1.3 The conditions set out in this Intellectual Property Policy may be altered by the Vice Chancellor at any time. Employees and students who create Intellectual Property in the course of their employment or studies are subject to the conditions of this Policy as amended. Commitments in an employee's individual contract or any separate agreement executed between employees, students, a third party and the University for the purpose of dealing with Intellectual Property ownership will not be altered by any changes to the conditions in the Policy without the consent of those parties involved.

Scope

- 2.1 Unless otherwise agreed by written agreement between the University and a person to whom this Intellectual Property Policy applies, the ownership of any Intellectual Property created by that person will be determined by the terms of this Policy.
- 2.2 This Intellectual Property Policy applies to all:
 - Academic and General Employees of the University employed under fixed or maximum term contracts of employment whether employed on a full time or fractional basis;
 - sessional or casual employees of the University;
 - students enrolled in any course or unit at the University; and
 - any other person or corporation who under a contract of service with the University is employed as a consultant or on secondment to the University.
- 2.3 For the purpose of this Policy unless otherwise specified a reference to Intellectual Property means all forms of intellectual property rights whether arising out of legislation or existing at law as amended or replaced from time to time. This includes without limitation, all rights including the right to registration, in relation to:
 - copyright works meaning any work or thing in which copyright may subsist as defined by the Copyright Act 1968 (Cth);
 - inventions including both products and processes which may be patentable under the Patents Act 1990 (Cth) (Patents Act)
 - Patents, whether standard, provisional, application or petty as defined in the Patents Act;
 - plant varieties qualifying for rights under the Plant Breeders' Rights Act 1994 (Cth);

- Trademark whether registered or not as defined by the Trade Marks Act 1995 (Cth);
- eligible layouts as defined by the Circuits Layouts Act 1989 (Cth);
- confidential information meaning any confidential information protected by law either contractual or equitable;
- designs as defined by the Designs Act 1906 (Cth);
- any other intellectual property not expressly dealt with in this Policy.

Definitions

- 2.4 For the purpose of this Policy the following terms have the meaning below:
- ‘in the course of their employment’* means any such duties of an employee set out in and incidental to their contract of employment with the University including involvement in a University Project.
- ‘Course Material’* means any material whether electronic, digital, written or any other form of media created by an employee specifically for use in, or in connection with a course, subject or unit offered by the University including but not limited to all:
- lecture notes;
 - lecture materials including course outlines and reading materials;
 - audio-visual works;
 - on-line material;
 - assessment and examination questions;
 - any computer program written by an employee; and
 - any other copyright works created by an employee for the purpose of teaching a course or unit offered at the University..
- ‘University Project’* means an individual project of work or research administered or commissioned by or on behalf of the University which is funded by:
- the University through a specific allocation of funds or resources (such as equipment, facilities, employees or students), beyond what is normally provided to a School or Division; or
 - a third party external source through a specific allocation of funds or resources (such as equipment, facilities, employees).
- ‘Intellectual Property Agreement (IPA)’* means any written agreement entered into between an employee, student, or Third Party and the University which relates to the ownership and use of any form of Intellectual Property which may arise.
- ‘Commercialisation’* or *‘commercial exploitation’* means any use or exploitation including sub-licensing, franchising or assignment of Intellectual Property for the purpose of generating financial or some other commercial gain.
- ‘Use Substantial University Resources’* means where Intellectual Property has been created by some form of contribution by the University such as through funding, resources, facilities or equipment beyond that which is ordinarily contributed to an employee, student in the course of their employment or studies at the University.

Principles

OWNERSHIP OF INTELLECTUAL PROPERTY

Intellectual Property Ownership and Third Party Sponsors

- 3.1 Where a person or corporation (Third Party) not employed by the University, sponsors research within the University by providing funding or some other substantial resource for work or research to be conducted with the use of University resources (either through the use of

University facilities, employees or students or some other resource) the University shall enter into an Intellectual Property Agreement (IPA) with that Third Party governing the Intellectual Property ownership of any Intellectual Property created as a result of the sponsored research.

- 3.2 Where a Third Party sponsors research in clause 3.1 above and an IPA has been entered into between the Third Party and the University expressly dealing with the ownership of Intellectual Property which would otherwise under this Policy be owned by the University, the provisions of the IPA prevail to the extent of any inconsistency between the IPA and this Policy.
- 3.3 For the purpose of clauses 3.1 and 3.2 sponsored research does not include a specific contribution by a Third Party in the form of a scholarship.

Other External Participants: Visitors or Adjuncts

- 3.4 Subject to clauses 3.5 and 3.6 below Visitors to the University who are not employed under a contract of employment with the University or persons with an adjunct appointment to the University (Visitors) will not be affected by the terms of this Policy.
- 3.5 Unless otherwise agreed between the University and a Visitor, a Visitor will own any Intellectual Property created by him or her in the course of their work at the University provided the Visitor did not:
- Use substantial University resources;
 - Use University owned Intellectual Property;
 - Receive project-specific funding from the University or a third party engaged by the University;
 - Use Intellectual Property owned by another employee of the University; or
 - Participate in a University Project.
- 3.6 As a condition to involvement in a University Project Visitors to the University shall be required to enter into an IPA and /or a confidentiality agreement in relation to any Intellectual Property that may be created as a result of their participation in a University Project.

INTELLECTUAL PROPERTY CREATED BY EMPLOYEES

Ownership of all Intellectual Property Created by Employees

- 4.1 Unless otherwise expressly stated in this Policy the University owns all Intellectual Property and the rights attaching to that Intellectual Property created by an employee in the course of their employment or participation in a University Project.
- 4.2 Where any dispute arises between an employee and the University as to whether Intellectual Property was created within the course of an employee's employment that dispute will be determined by the Vice Chancellor or his or her delegate.
- 4.3 In determining whether the Intellectual Property was created in the course of employment the Vice Chancellor (or his or her delegate) will consider:
- the duties of the employee as set out in their contract of employment; and
 - whether the Intellectual Property has been created by the use of University facilities, equipment or other resources supplied by the University.
- 4.4 Where an employee creates Intellectual Property that falls outside the duties of the employee set out in and incidental to their contract of employment with the University then subject to 4.5 the employee owns the Intellectual Property created and all rights attaching to that Intellectual Property.
- 4.5 Where an employee creates Intellectual Property that falls outside their duties in the course of their employment but the Intellectual Property has been created with the use of substantial University facilities or resources the University is entitled to claim ownership of the Intellectual Property created.

Copyright Ownership of Course Materials and Computer Programs Created by Employees

- 4.6 The University owns the Intellectual Property including the copyright ownership in all Course Materials created by an employee in the course of their employment with the University for the purpose of course delivery at or under the auspices of the University.
- 4.7 The University's ownership of Course Materials created by an employee in the course of their employment is subject to the University using those Course Materials in the course of delivery of educational and administrative programs whether or not the employee who created those works is delivering the programs. Where the University delivers the Course Material for its educational or administrative programs the University will do so with appropriate acknowledgement and with respect to the creator's moral rights in accordance with clause 6 below.
- 4.8 The University shall own the copyright in computer programs created by an employee in the course of their employment. Where an employee has created a computer program and the University owns the copyright in that computer program, the employee must not disclose that program or any information about it other than reasonable disclosure to persons employed by the University without prior approval of the Vice Chancellor.

Waiver of Ownership in Copyright Works Created by Employees

- 4.9 Subject to the conditions below the University waives the right to copyright ownership in favour of an employee who has created one of the following Copyright Works only:

- scholarly work;
- literary work,
- artistic work,
- dramatic work
- musical work
- cinematic film; and
- sound recordings.

the University will not waive the right to ownership in the above Copyright Works where those Works form part of Course Materials created by an employee.

- 4.10 Waiver of copyright ownership to one of the Copyright Works outlined in 4.9 above is subject to the following conditions:

- (i) the University shall retain an automatic, non-exclusive royalty free and irrevocable licence to publish and use the Copyright Work for educational and research purposes;
- (ii) any such licence to publish and use the Copyright Work terminates upon the employee assigning ownership in the Copyright Work to a third Party; and
- (iii) the employee notifying the University immediately in writing of the date of assignment of copyright ownership.

- 4.11 here employees are entitled to claim copyright ownership to the Copyright Works outlined in 4.9 above they shall make available to the University Library or relevant School a copy of the full text of any Copyright Works created during the course of their employment with the University.

Copyright Owned by the University in other Circumstances

- 4.12 The University shall own the copyright in a Copyright Work where an employee is the creator of the Copyright Work and:

- (i) The employee has assigned their ownership rights to the University in an IPA;
- (ii) The University has specifically commissioned the Copyright Work;

- (iii) The Copyright Work was created as a result of the employee's participation in a University Project;
- (iv) The University has contributed other University owned Intellectual Property to the development of the Copyright Work; or
- (v) The University has made a contribution through funding, resources, facilities or equipment beyond that which is ordinarily contributed to an employee in the course of their employment.

Ownership of Discoveries and Patentable Inventions

- 4.13 The University owns all Intellectual Property rights to all discoveries or inventions made by an employee in the course of their employment or arising from an employee's participation in a University Project.
- 4.14 Where an employee has in the course of his or her employment made or created a discovery or invention and the Intellectual Property attaching to that discovery or invention is capable of patentability or some other form of legal protection the University shall make an initial assessment in accordance with clause 8 below on whether to pursue a patent or other legal protection within ninety (90) days of the initial written disclosure by the employee to the University.
- 4.15 Where the University elects to pursue a patent or other legal protection for the discovery or invention in clause 4.13, the University may do so in consultation with the employee and all costs shall be borne by the University or by a sponsor or licensee.
- 4.16 The procedure for patenting and commercialisation of inventions and discoveries is contained in Schedule 1 of this Policy.
- 4.17 Where the University elects not to pursue a patent or other legal protection for a discovery or invention the University may agree to waive all or some of its Intellectual Property rights in respect of that discovery or invention. In such circumstances the University will enter into an IPA with the employee assigning the ownership of the Intellectual Property rights relating to that discovery or invention to the employee who made or created the discovery or invention. See clause 8.5 below.
- 4.18 Where the University owns Intellectual Property arising out of a discovery or invention made by an employee during the course of their employment or participation in a University Project, the employee will be entitled to a return from any commercialisation by the University of the discovery or invention in accordance with clause 9 below.

INTELLECTUAL PROPERTY CREATED BY STUDENTS

Ownership of Intellectual Property Created by Students

- 5.1 Where a student creates Intellectual Property during the course of their studies at the University the student shall, subject to the exceptions below, own that Intellectual Property.

Ownership of Copyright Works Created by Students

- 5.2 Students shall own the copyright in all works created by them during the course of their study at the University except where students:
- Use substantial University resources;
 - Use University owned Intellectual property;
 - Receive project-specific funding from the University or a third party engaged by the University;
 - Use Intellectual Property owned by another employee of the University; or
 - Participate in a University Project.

- 5.3 Where students have created Copyright Works as a result of doing any of those activities set out in 5.2 above the student must enter into an IPA with the University assigning their rights to the Intellectual Property created.
- 5.4 Unless otherwise agreed between a student and the University a student shall own the copyright in their Thesis. Students will, for research purposes only, make available to the University Library a copy of the full text of their Thesis created during the course of their study at the University.

Discovery or Invention by a Student

- 5.5 Where a student in the course of their studies makes a discovery or invention and the Intellectual Property attaching to that discovery or invention is capable of patentability or some other form of legal protection requiring registration the student will own the Intellectual Property and all the rights attaching to that Intellectual Property except where students:
- Use substantial University resources;
 - Use University owned Intellectual property;
 - Receive project-specific funding from the University or a third party engaged by the University;
 - Use Intellectual Property owned by another employee of the University; or
 - Participate in a University Project.
- 5.6 Where a student makes a discovery or invention in the course of their studies the student must notify their Dean and the Office of the Provost of the discovery or invention as soon as the discovery or invention is made.
- 5.7 Where a student owns the Intellectual Property in a discovery or invention made during the course of their studies the student and the University may agree to enter into an IPA to commercially exploit that discovery or invention.

Student Participation in University Projects

- 5.8 A student involved in a University Project will generally be required to enter into a Student IPA with the University assigning any ownership rights to any Intellectual Property arising out of a University Project to the University.
- 5.9 A student's supervisor in any University Project is responsible for ensuring that a Student IPA is signed by a student prior to the commencement of the University Project. The supervisor must ensure that informed consent of the student is obtained prior to a student signing any Student IPA. A student's supervisor means a Dean or other appropriate person who supervises the student's studies.
- 5.10 Any Intellectual Property created as a result of a student's participation in a University Project will be owned by the University whether or not the student has entered into a Student IPA with the University prior to the commencement of the University Project.
- 5.11 Where Intellectual Property is created by a student who has participated in a University Project and the student did not enter into a Student IPA prior to the commencement of the University Project the student will be required to execute a Student IPA with the University at the completion of the University Project. Failure to enter into a Student IPA will not affect the University's ownership rights to any Intellectual Property created as a result of a University Project.
- 5.12 Where the University owns Intellectual Property created by a student in a University Project, the student will be entitled to a return from its commercialisation as would be the case if the student were an employee under this Policy.

Rights

- 6.1 The University shall, in the case of a Copyright Work which is owned by the University or to which the University has a licence in relation to, respect all Moral Rights of the authors as provided for by Pt IX of the Copyright Act 1968 including the right to be identified as the creator of a work, the right to false attribution of authorship and the right to object to any derogatory treatment of the work.
- 6.2 The University will attribute the names of creators of works and take reasonable steps to ensure that creators can disassociate themselves from any modification or amendment to a work.
- 6.3 The University shall exercise its rights in relation to Intellectual Property under this Policy in a manner, which does not detract from, or impede the academic freedom of an employee or student of the University.

Use of Intellectual Property

Use of Intellectual Property owned by a third party

- 7.1 Employees and students of the University have a duty to ensure they do not breach the Intellectual Property rights of third parties in the course of their employment or studies at the University. Employees and students must not use Intellectual Property owned by a third party unless they have written permission to do so or are permitted to do so in accordance with the provisions of the Act or any statutory licence provided for under the Act.

Bringing Intellectual Property into the University

- 7.2 Where an employee or student has created Intellectual Property outside their course of employment or studies and wishes to bring the Intellectual Property owned by them into the University for use in their course of employment or studies the employee or student must obtain approval from the University prior to any use of the Intellectual Property.
- 7.3 An employee or student must first inform the Office of the Provost of the ownership of that Intellectual Property and provide evidence of that ownership. The University will not approve any use of the Intellectual Property by an employee or student in the course of their employment or study until the University is satisfied the use of the Intellectual Property will not infringe any third party rights.

Use of University owned Intellectual Property

- 7.4 Provided the use of University owned Intellectual Property created by an employee or student does not interfere with the protection or commercialisation of that Property, employees and students may use University owned Intellectual Property in the course of their employment or studies with the University provided employees have complied with the reporting obligations set out in clause 7.11.
- 7.5 To ensure that University Intellectual Property is protected employees and students should not:
 - (i) hold any discussions with any person outside the University concerning the Intellectual Property unless those discussions have been approved by the Office of the Provost;
 - (ii) publish in any way or form the Intellectual Property until the Office of the Provost has made an assessment of the validity, protection and commercialisation of the Intellectual Property and approved such publication.
- 7.6 The University recognises that an employee who has created Intellectual Property which is owned by the University may wish to use the Intellectual Property outside the University. In certain circumstances the University may permit an employee who has created University owned Intellectual Property (such as Course Materials) to use the Property for non-University purposes.
- 7.7 Where an employee wishes to use University Intellectual Property in the circumstances in clause 7.6 above the employee must apply to the Office of the Provost for approval of such use. Any

licence granted by the Office of the Provost to use the Intellectual Property is a personal right and is not transferable to an institution which may subsequently employ the employee.

University Name and Logo

- 7.8 The University name and logo are owned by the University.
- 7.9 Employees may use the name and logo of the University for legitimate purposes of the University. Employees wishing to use the name and logo of the University for external purposes must obtain prior approval from the Office of the Provost.
- 7.10 A Third Party will only be permitted to use the University's name or logo with the approval of the Vice Chancellor. Any approval by a Third Party to use the University's name or logo must be obtained prior to any use and will be subject to conditions set down by the Vice Chancellor.

Duty to Report Creation and Infringement of Intellectual Property

- 7.11 Where any Intellectual Property owned by the University is created any employee or student who becomes aware of the creation, commercialisation or unauthorised use or infringement of that Intellectual Property shall immediately inform the Office of the Provost in writing of all relevant details of the Intellectual Property infringement or unauthorised use.
- 7.12 The written notice must state:
- (i) the date on which the intellectual property was created;
 - (ii) the identity of the person or persons who contributed to the creation of the Intellectual Property;
 - (iii) the details of any pre-existing Intellectual Property which was used in creating the Intellectual Property;
 - (iv) whether any person other than the creator claims any entitlement or interest in the Intellectual Property;
 - (v) the details of any University facilities or resources used to create the Intellectual Property;
 - (vi) the details of any known existing or partial use or commercial exploitation of the Intellectual Property;
 - (vii) details of any infringement or unauthorised use of the Intellectual Property.
- 7.13 An employee or student who does not own the Intellectual Property in a particular work must not do any act or thing inconsistent with the University's rights under this Policy including but not limited to applying for any form of protection or commercialisation of that Intellectual Property.

ASSESSMENT OF THE INTELLECTUAL PROPERTY

- 8.1 Any employee or student who creates Intellectual Property owned by the University must inform the Office of the Provost in writing in accordance with clause 7.8 and 7.9 of this Policy.
- 8.2 Once written notice has been provided, The Office of the Provost will undertake an assessment of the Intellectual Property. The Office of the Provost will consider the commercial significance of the Intellectual Property and any appropriate legal protection that may be available to protect that Intellectual Property.
- 8.3 Employees and students must ensure appropriate confidentiality of the Intellectual Property prior to and during the Office of the Provost's assessment of the Intellectual Property. See clause 7.5.
- 8.4 Following an assessment of the Intellectual Property the Office of the Provost will make a determination on the ownership of the Intellectual Property the appropriate form of protection, if any, and the commercialisation of the Intellectual Property.
- 8.5 Where the Office of the Provost decides not to assert ownership of the Intellectual Property the employee or student who created the Intellectual Property will be informed in writing. The

employee or student may then independently assert ownership and undertake commercialisation of the Intellectual Property. In such circumstances the University must enter into an IPA with the employee or student in which it waives its rights to any ownership or commercialisation in the Intellectual Property in favour of the employee or student.

- 8.6 Where the University asserts ownership of the Intellectual Property The Office of the Provost will decide on the appropriate method of commercialisation of the University Intellectual Property and will take control of the management of such commercialisation. Generally an employee or student who created the Intellectual Property will be invited to be involved in any commercialisation of the Property and will be entitled to a share in the profits from any commercialisation.

9. Commercialisation of Intellectual Property

- 9.1 Subject to any other agreement between the University and an employee or student who creates Intellectual Property over which the University claims ownership, the University will share any cumulative Net Revenue received by the University from the commercialisation of Intellectual Property as a reward for the employee or student's involvement and contribution.
- 9.2 For the purpose of this clause the term Net Revenue means the return received by the University from the commercialisation of Intellectual Property after deducting all expenses incurred by the University in the creation, protection, and commercialisation of the Intellectual Property.
- 9.3 In the absence of any IPA or other written agreement dealing with the sharing of Net Revenue from any commercialisation of Intellectual Property by the University, the actual proportion of distribution of Net Revenue shall be determined by the Office of the Provost and shall be shared as follows: The creators, being the employee or student who created the Intellectual Property owned by the University, will receive:
- 85% of the first \$50,000 of Net Revenue;
 - 65% of the next \$100,000 Net Revenue; and
 - 50% of all cumulative Net Revenue thereafter.
- 9.4 The Office of the Provost will return a significant portion of its share of Net Revenue to the employee or student's School or Division. Any remaining Net Revenue apportioned to the University will be set aside for other activities including research and commercialisation.
- 9.5 Notwithstanding clause 9.4 the Vice Chancellor has discretion to redirect the University's share of Net Revenue to other Divisions or Schools within the University to ensure the efficient allocation of resources.
- 9.6 Where there is more than one creator, the share of Net Revenue will be apportioned equitably between them by the Office of the Provost in consultation with the creators. Distribution of Net Revenue will not be made until creators have agreed on the apportionment of Net Revenue where the parties cannot reach agreement the Office of the Provost and the Vice Chancellor will determine the appropriate apportionment.
- 9.7 Distribution of net revenue will be in accordance with all applicable taxation laws.

10 Dispute Resolution

- 10.1 If a dispute arises between an employee and the University under this Policy, the parties to the dispute shall try in good faith to settle the dispute with the assistance in accordance with the Informal Procedure provided in clause 5.1 of The University of Notre Dame Australia's Staff Grievance Resolution Policy and Procedures (Staff Grievance Resolution Policy and Procedures).

10.2 If the Informal Procedure in 10.1 above fails to resolve the dispute the aggrieved party may lodge an Official Complaint in writing in accordance with clause 5.2 of the Staff Grievance Resolution Policy and Procedures.

10.3 Where the dispute remains unresolved or an aggrieved party is not an employee of the University then that party may seek assistance in resolving the dispute through an external agency for Dispute Resolution.

For assistance in locating an external agency:

- (i) Ombudsman Western Australia (<http://www.ombudsman.wa.gov.au>) disputes related to administrative decision making, procedures and conduct.

11. Application and Implementation of this Policy

Breach of Policy

11.1 This Policy applies to all employees and students. A Breach of this Policy by employees will be considered as misconduct and the University may initiate disciplinary proceedings in accordance with the applicable industrial Agreement.

12. Responsible Office

12.1 The Office of the Provost is responsible for the control and administration of the University's Intellectual Property Policy on ownership of Intellectual Property. The Office of the Provost has delegated authority to submit patent applications on behalf of the University.

Schedule 1

Procedure for Patent Application and Commercialisation

- 7.14** If, on conducting its Assessment of the Intellectual Property in accordance with clause 8 of the Policy, the Office of the Provost believes a patent application will be successful and commercially viable, the Office will arrange for a patent attorney to make a final evaluation of the patentability of the invention and prepare a provisional patent application.
- 7.15** The University will pay the costs of the patent attorney and any costs incidental to the provisional patent application.
- 7.16** Disclosures of the invention must not occur until the patent application process is complete.
- 7.17** To ensure that any subsequent or amended patent applications are not compromised any disclosures should be on the basis of a confidentiality agreement. Any agreement must be executed by the University through the Office of the Provost.
- 7.18** During the twelve (12) month period of the provisional patent commercial interest should be sought.
- 7.19** Not later than three months before the expiry of the provisional patent The Office of the Provost must reassess the commercial potential of the invention and decide whether to proceed to file a complete patent specification.
- 7.20** Where no commercial interest has been secured the University will generally not proceed with a complete patent specification.
- 7.21** If the University decides not to proceed with a complete specification it may waive its Intellectual Property rights in favour of the employee or student who created the invention. Any waiver must be evidenced in writing in the form of an Intellectual Property Agreement.
- 7.22** Once the University has assigned its Intellectual Property rights to the creator, the creator may apply for a complete patent. Where the University has divested its ownership rights the creator will be responsible for meeting the costs of any further legal protection sought.
- 7.23** Where the Office of the Provost proceeds with a complete patent specification it will determine whether to register the invention in other countries.