

Disclosing and Exploiting Intellectual Property Procedure

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Purpose

This procedure mandates operational activities and assigns responsibilities to support the implementation of the Intellectual Property (IP) Policy.

Scope

This procedure applies to all Staff (academic, professional, technical and administrative), affiliates of the University, and all students (postgraduate and undergraduate).

Legislative Context

- [Federation University Australia Act 2010](#)
- [Federation University Australia Statute 2021](#)
 - Part 7 - Intellectual Property
- [Federation University Australia \(Operations\) Regulations 2022](#)
 - Part 4 - Intellectual Property
- [Copyright Act 1968 \(Cth\)](#)
- [Patents Act 1990 \(Cth\)](#)
- [Designs Act 2003 \(Cth\)](#)
- [Plant Breeders' Rights Act 1994 \(Cth\)](#)
- [Circuits Layouts Act 1989 \(Cth\)](#)

Definitions

A complete list of definitions relevant to this procedure is contained within the Intellectual Property Policy.

A further list of definitions **specifically** relevant to this procedure is included below:

| TERM | DEFINITION |
|----------------------------------|---|
| Background intellectual property | Any Intellectual Property owned by the University that exists at the time new Intellectual Property is created |
| Commercialise/commercialisation | To exploit commercially and includes: <ol style="list-style-type: none"> a. in relation to an IP right; the exercise of all the rights exclusively granted to the holder of such IP rights by the laws of the jurisdiction in which the IP right subsists, including where permitted the right to sub-license those rights b. in relation to a product, kit, apparatus, substance, documentation or information resource (or any part of such materials): to make, distribute, market, sell, hire out, lease, supply, or otherwise dispose of it; and c. in relation to a method or process: to use the method or process or to make, distribute, market, sell, hire out, lease, supply, or otherwise dispose of a product, kit or apparatus the use of which is proposed or intended to involve the exercise of the method or process |
| Commercialisation revenue | The gross revenue actually received and retained by Federation University from the Commercialisation and Exploitation of specific IP owned by the University, after the payment of any withholding, goods and services or other taxes, bank fees, transaction fees and other charges. Commercialisation Revenue does not include income received from the provision of research, consultancy or other services |
| Contributor | A Staff member, Affiliate or Student who is a Creator or is a person that contributed to the creation, development or invention of the relevant IP, as determined in accordance with the relevant process |

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| Course materials | All materials produced in the course of, or for use in, teaching in any form and all IP in such materials including but not limited to lectures, lecture notes and material, syllabi, study guides, assessment materials, images, multi-media presentations, web content, case studies and course software |
| Creator | Any of the following: <ul style="list-style-type: none"> a. in the case of a patentable invention subject to the Patents Act 1990 (Cth): the Inventor b. in the case of a literary or artistic work or similar subject to the Copyright Act 1968 (Cth) : the Author c. in the case of designs registrable under the Designs Act 2003 (Cth): the Designer d. in the case of Plant Breeders Rights, under the Plant Breeders' Rights Act 1994 (Cth): the Principal Breeder e. in the case of circuit layouts, under the Circuits Layouts Act 1989 (Cth): the Designer |
| Indigenous Traditional Knowledge | Indigenous Australians' rights to their heritage, consisting of intangible and tangible aspects of the whole body of cultural practices, resources and knowledge systems developed nurtured and refined by Indigenous people and passed on by them as part of expressing their cultural identity, including distinctive signs and symbols, practices, know-how and skills |
| Intellectual property (IP) | All statutory and other proprietary rights (including rights to require information be kept confidential) in respect of inventions, copyright, trademarks, designs, patents, plant breeder's rights, circuit layouts, know-how, trade secrets, data, materials and all other rights as defined by Article 2 of the Convention establishing the World Intellectual Property Organisation of July 1967, all rights to apply for the same and, for the avoidance of doubt, includes: <ul style="list-style-type: none"> a. Patents under the Patents Act 1990 (Cth) b. Copyright which subsists in original works under the??? c. Trade marks registered under the Trade Marks Act 1995 (Cth) d. Designs registered under the Designs Act 2003 (Cth) e. New plant varieties under the Plant Breeders' Rights Act 1994 (Cth) f. Circuit layouts (computer chips) under the Circuit Layouts Act 1989 (Cth); and g. Trade secrets and other confidential material under Common Law |
| Invention | Any IP that is patentable under the Patents Act 1990 (Cth) |
| Net revenue | The monetary amount retained by Federation University from the Commercialisation Revenue received from the commercialisation of IP after the legitimate claims of third parties are satisfied |
| Pre-existing intellectual property | Tangible IP that the University agrees is owned by a Staff member, a Student or a third party prior to the date of their employment or enrolment at Federation University |

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| Specifically commissioned | Work requested by the University by agreement, where particular consideration is given. This may include financial consideration or relief from teaching or other duties |
| University resources | Resources of the University and its controlled entities which includes without limitation facilities, funds, services, equipment, paid leave, staff time and support staff |

Actions

1. Authorised Officers

The only officers of the University authorised to:

- initiate;
- proceed with the protection of;
- exploit;
- make commitments in relation to, or
- otherwise deal with Federation University Australia IP

are the Vice-Chancellor and the IP Officer.

Creator(s) cannot act on their own behalf or on behalf of the University when dealing with University owned IP. Any commercial enquiries in relation to the right to exploit IP owned by the University received by Staff or Students must be referred to the IP Officer. Staff or Students must not engage in any commercial discussions without involvement of the IP Officer.

2. Pre-Existing IP

Staff and students must advise the University of the existence of pre-existing IP that they bring to the University within 30 days of their employment, engagement or enrolment.

Staff and students must complete and submit a **Notification of Pre-Existing IP form**. The University will assess the nature of that IP, make a determination and notify the staff member or student of the outcome. The University will maintain a confidential register of pre-existing IP which will be taken into consideration when new IP is developed by that staff member or student in the course of their employment or enrolment at Federation University.

Staff or students must provide the University with detailed and accurate information to enable a fair assessment of the nature, value and ownership of that IP.

To submit a Notification of Pre-Existing IP Form, follow the steps listed below:

| | ACTIVITY | RESPONSIBILITY | STEPS |
|----|---|-------------------------------------|--|
| A. | Completing Notification of Pre-Existing IP Form | Staff member/student (Creator/s) | Complete the notification form, within 30 days of employment with the University. Provide detailed and accurate information. |
| B. | Submitting the form | Creator/s | Submit the complete form to the IP Officer |

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| C. | Completing assessment of Notification of Pre-Existing IP Form | IP Officer Vice-Chancellor | Undertake an assessment of the nature, value and ownership of the reported IP. |
| D. | Providing outcome to creator/s | IP Officer | Provide an outcome of the assessment to the creator/s, in writing, within 6 weeks of receipt of the notification. |

3. Assignment of Student IP

The assignment of IP by a student is not a condition of enrolment but may be a condition of participating in certain (usually industry sponsored) research projects. Where the University asserts ownership of student IP, students will be required to assign IP to the University.

Where a student chooses not to assign IP to the University for a project where this is a requirement, the student will be provided with a choice of alternative projects that do not require an assignment of IP.

The IP Officer, in consultation with the Vice-Chancellor, is responsible for the process of execution of assignment of student IP. Prior to deciding whether to assign their IP, a higher degree research student can receive advice on options from the Dean of Graduate Studies. Undergraduate and Postgraduate Coursework students should consult with their Course Coordinator.

The execution by the University of the assignment documentation is the responsibility of the IP Officer, in consultation with the Vice-Chancellor.

4. Non-disclosure for IP Protection

In order for the University to comply with the *National Principles of Intellectual Property Management for Publicly Funded Research*, staff members and students should be conscious of the need to avoid premature disclosure of research results to third parties, including any form of publication of those results, prior to completing a **Notification of Intellectual Property Development** (an IP Notification) and considering the need to obtain IP protection.

5. Completion of a Notification of IP Development Form

Where a staff member or student develops:

- IP which the University owns; or
- IP which the University has the right to assert ownership; or
- IP the University has the right to commercialise and exploit in accordance with the Intellectual Property Policy,

A confidential **Notification of IP Development Form** should be completed and returned as soon as is reasonably practicable after its creation. All IP Notification forms must be authorised by the Dean of School before submission.

All Creator(s) must provide detailed and accurate information to enable a fair assessment of the ownership, commercial potential and protection that might be applicable to that IP. A confidential Register of IP Notifications will be maintained by the IP Officer.

To submit a **Notification of IP Development Form**, follow the steps listed below:

| | ACTIVITY | RESPONSIBILITY | STEPS |
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| A. | Complete the IP Notification Form | Staff member/student Creator | Complete the notification form, as soon as possible after the creation of the IP. Provide detailed and accurate information. |
| B. | Obtain authorisation to submit | Creator Dean of School | Obtain the authorisation of the relevant Dean of School. |
| C. | Submit the form | Creator | Submit the form to the IP Officer. |
| D. | Complete assessment of Notification of IP Development Form | IP Officer Vice-Chancellor | Undertake assessment of the ownership, commercial potential and protection that might be applicable to the IP. |
| E. | Provide outcome to Creator(s) | IP Officer | Provide an outcome of the assessment to the Creator(s), in writing, within 12 weeks of receipt of the notification. |

6. Determination of Student IP ownership

| | ACTIVITY | RESPONSIBILITY | STEPS |
|----|------------------------|-----------------------|--|
| A. | Determine right to own | Student IP Officer | The IP Officer can assist students in determining their right to own, commercialise and exploit IP developed by them. The IP Officer can provide commercialisation services to students who own their IP. In this event, the student will be required to assign their IP to the University and will be afforded the same rights as staff under the Intellectual Property Policy. |

7. Determination as to commercialisation and Creatorship

| | ACTIVITY | RESPONSIBILITY | STEPS |
|----|---|-------------------------------|---|
| A. | Determine as to commercialisation and Creatorship | IP Officer Vice-Chancellor | Upon submission of an IP Notification, the IP Officer, in consultation with the Vice-Chancellor, will decide whether or not it wishes to protect and/or commercialise and exploit the IP. The IP Officer will advise the Creator(s) of its decision within 12 |

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| | | | <p>weeks of receiving the IP Notification. The IP Officer will also make a determination in relation to the validity of any claim made by a staff member or student that they are the true Creator(s) of that IP and in relation to their rights under the Intellectual Property Policy.</p> <p>A decision made at the time not to proceed with or delay a patent application or other applicable form of IP protection may not necessarily exclude an ongoing interest by the University in commercialising or exploiting the IP, or prevent the University from retaining the right to do so.</p> |
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8. Notice of determination and assignment to Federation University

| | ACTIVITY | RESPONSIBILITY | STEPS |
|----|-------------------------------|-------------------------------|---|
| A. | Notify Creator(s) of decision | IP Officer Vice-Chancellor | The University will advise the Creator(s) of its decision as to whether to proceed with commercialisation. |
| B. | Assign rights | Creator(s) IP Officer | If the University elects to commercialise, the Creator(s) will formally assign any right, title or interest they may have in the IP to the University in the form of a contract that specifies the rights that will accrue to the Creator(s) and the University and the obligations they will have to assist the University with the commercialisation of the IP. |

9. Commercialisation strategy

| | ACTIVITY | RESPONSIBILITY | STEPS |
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| A. | Determine commercialisation strategy | IP Officer Creator(s) | The University will determine the best strategy to commercialise and exploit the IP, however, the University will consult with the Creator(s) of that IP before determining the most appropriate |

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| | | | <p>commercialisation strategy to be taken. The commercialisation strategy may or may not include:</p> <ul style="list-style-type: none"> • Filing of patent applications or other forms of IP protection; • Identification of possible licensees; • Formation of a limited liability company; or • Alternative strategy to exploit the IP. |
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10. Assistance from Creator(s)

| | ACTIVITY | RESPONSIBILITY | STEPS |
|----|--------------------|----------------|--|
| A. | Provide assistance | Creator(s) | The Creator(s) of IP being commercialised or being considered for commercialisation by the University must provide the University with all reasonable assistance in the assessment and commercialisation of the IP. This includes the provision of information promptly, providing opinions and assessment frankly, preventing premature public disclosure of the IP, attending meetings, giving presentations and executing appropriate documents, as required. |

11. Assignment of IP back to Creator(s) where the University does not proceed

| | ACTIVITY | RESPONSIBILITY | STEPS |
|----|-------------------------------------|----------------|---|
| A. | Assignment of IP back to Creator(s) | IP Officer | If the University decides not to proceed with, or continue with, the commercialisation of the IP defined in a particular IP Notification, the Creator(s) will be advised of its decision, in writing, in a timely manner. Subject to the Creator(s) having complied with the Intellectual Property Policy and any Researcher IP Commercialisation Deed entered into, the Creator(s) may request that such IP be assigned to them. |

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| | | | <p>The assignment of IP to the Creator(s) will be considered on a case-by-case basis taking into consideration the overall commercialisation and IP protection strategy of the University. Upon assignment, the Creator(s) will be free to protect and commercialise the IP at their discretion and cost. The University will not normally direct further resources into this process or the further development of that IP.</p> <p>In the event that not all of the Creator(s) of specific IP wish to have that IP assigned to them, then those who wish to proceed with the commercialisation of that IP in their own right, and accept the costs and risks of doing so, will have the commercialisation rights and benefits assigned to them by the University, should the University decide to do so.</p> <p>The assignment of IP to the Creator(s) will only relate to that IP specifically described in the IP Notification. The assignment will not cover IP included in other IP Notifications in the same area of research or any improvements/developments made to the assigned IP by the Creator(s) in the course of their employment/enrolment at the University. The Creator(s) shall own any improvements/developments of IP assigned to them that are developed independently of the University.</p> <p>It will be a condition of assignment of the IP to the Creator(s) that the University will receive a future benefit amounting to 20% of the net revenue received by the Creator(s) from the exploitation of the IP after reasonable costs of IP protection and commercialisation by the Creator(s) have been recovered by them, unless</p> |
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| | | | <p>otherwise agreed to by the Vice-Chancellor and the IP Officer.</p> <p>As a condition of assignment to a Creator, the University will retain a non-exclusive right to use the IP for education and/or research purposes. The University will complete an agreement to this effect with the staff member or student. Such an agreement will also require the Creator(s) to report regularly to the University in relation to progress made with the exploitation of the assigned IP and the revenue entitlements of the University.</p> |
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12. Sharing in the benefits of commercialisation

Where a staff member or student develops IP which has been commercialised by the University, the [Disbursement of Net Revenue from Intellectual Property Commercialisation Procedure](#) will apply.

Taxation obligations associated with the payment of any Net Revenue to Creator(s) of IP are the responsibility of the individuals involved.

Supporting Documents

- [Research and Research Training Policy](#)
- [Operations Governance Policy](#)
- [Intellectual Property Procedure](#)
- [Disbursement of Net Revenue from Intellectual Property Commercialisation Procedure](#)

Forms.

- [Notification of IP Development](#) (DOTX 189.0kb)
- [Notification of Pre-Existing IP](#) (DOTX 182.2kb)

Responsibility

- The Chief Operating Officer (*as the Approval Authority*) is responsible for monitoring the implementation, outcomes and scheduled review of this procedure.
- The Director, Research and Innovation (*as the Document Owner*) is responsible for maintaining the content of this procedure as delegated by the Approval Authority.

Promulgation

This procedure will be communicated throughout the University community via:

1. A FedNews announcement and on the 'Recently Approved Documents' page on the University's Policy Central website.

Implementation

This procedure will be implemented throughout the University via:

1. A FedNews announcement and on the 'Recently Approved Documents' page on the University's Policy Central website.

Records Management

| Document Title | Location | Responsible Officer | Minimum Retention Period |
|--|-------------------|---------------------|--------------------------|
| Notification of Pre-Existing IP form (IP Notification) | Research Services | IP Officer | Permanent |
| Notification of IP Development Form | Research Services | IP Officer | Permanent |