Knowledge Assets and Intellectual Property Policy

Section 1 - Overview

This Policy covers the identification, protection, transfer and disposal of Knowledge Assets, and covers all aspects of Knowledge Asset Transfer for the purpose of protecting Knowledge Assets as Intellectual Property.

The University owns all Knowledge Assets created by staff in the course of their employment.

(1) Any benefits derived from a protected and commercialised Knowledge Asset (Intellectual Property) will be shared with the Creator(s) in line with the provisions of this policy. The University will assign any Knowledge Assets it is not interested in commercialising back to the Creator(s). Knowledge Assets that can be commercialised (Intellectual Property) will be protected by the University.

The University does not assert ownership over Knowledge Assets created by students but will insist on assignment of the Intellectual Property where required for on-going research, teaching or Knowledge Asset Transfer. Students retain ownership of the copyright in their thesis. However, confidentiality may restrict publication.

Section 2 - Policy

Identification

(2) Identification of Knowledge Assets includes recording those assets, their ownership and if relevant their creators before, during the course of, and at the conclusion of

a. employment with the University;
b. undertaking a project as a student;
c. conduct of a research project with an external party; or
d. working at or for the University as a volunteer, visiting scholar or independent contractor.

(3) Uncommissioned Knowledge Assets must still be disclosed where they fall under either the Paid Outside Work or Conflict of Interest policies.

(4) The Creator(s) of a Knowledge Asset includes

a. any person who is rightfully listed as an "Inventor" on a Patent or Patent Application;
b. any person who is the author of an original work; and
c. any other person who the Creators jointly identify as having contributed materially to the creation of the Knowledge Asset and to whom they can ascribe a definable share of the creation.

(5) A Creator may be a member of staff, including Emeritus, Adjuncts, honorary staff, etc., or a student of the University, or an external collaborator. The Creator(s) will be determined when the Knowledge Asset is identified, and at subsequent additions to that Knowledge Asset.

Protection

(6) When a new Knowledge Asset is identified as having potential commercial value, it must be kept confidential until protected, if necessary, and at this point the Knowledge Asset becomes Intellectual Property.

Copyright

(7) The University is the owner of Knowledge Assets created by staff in the course of their employment, unless agreement to the contrary has been made with the author. Materials prepared for teaching in the course of employment, e.g. course notes, cd roms, websites, are owned by the university.

(8) Copyright is a set of exclusive rights automatically granted to authors and creators of original works, such as literary works, film, musical works, sound recordings, paintings, photographs, software, and industrial designs that are expressed in tangible or material form. It does not protect the ideas themselves.

(9) Books and other scholarly works which University staff wish to publish, must be disclosed to the university and approved for publication as designated in the appropriate discipline area.

Moral Rights

(10) Moral Rights apply to any work in which copyright subsists, except for those films and works included in a film made prior to December 2000. The rights are

a. the right of attribution;
b. the right to not have authorship falsely attributed;
c. and the right of integrity.

(11) These rights remain with the Creator, irrespective of the ownership of copyright and remain in force for the duration of the copyright protection of the work see Moral Rights Guidelines: www.une.edu.au/copyright/moral_rights.htm

Knowledge Asset Transfer

(12) Knowledge Asset Transfer or transfer of knowledge relates to the process of taking Knowledge Assets from within the University environment, protecting it, and/or providing it to others. Knowledge Asset Transfer may occur through publication (dissemination to the general public), teaching (dissemination to students of the University). Protected Knowledge Assets (IP) can be transferred through "Commercialisation" (transferring the knowledge, or inventions for profit) or "Technology Transfer" (transferring the knowledge for no cost or on a cost recovery basis).

(13) Knowledge Asset Transfer may include external communication of new Knowledge Assets by written or oral disclosure, media interviews or articles, submission of a conference paper, publication or a thesis, information in electronic or hardcopy format.

(14) Commercialisation includes sale, licence, franchise, joint venture/strategic alliance, company formation (start-up, spin-off or spin out) or in-house production.

(15) Before engaging in Commercialisation, the University will require

a. formal assignment of the new Knowledge Asset; and
b. formal agreement on benefit sharing as set out in clause 19.

(16) The University as the owner of the Knowledge Asset has the right to commercialise the Knowledge Asset. Creators of the Knowledge

(17) Asset may be involved in the commercialisation of the Knowledge Asset by such activities as

a. providing technical input to patent applications;
b. assisting with the transfer of the technology to third parties; and
c. providing market and end user advice where needed.

(18) The University will manage the Knowledge Asset as appropriate.

Roles and Responsibilities

(19) The individual Staff Member will be responsible for

a. keeping new Knowledge Assets, including teaching materials, confidential until they have been identified, if necessary protected and approved by the University for Knowledge Asset Transfer (see also clause 5);
b. disclosing the Knowledge Asset and providing sufficient information to the Intellectual Property Officer to allow assessment of the Intellectual Property;
c. making the proposal for Knowledge Asset Transfer;
d. where the Knowledge Asset is to be commercialised
    i. providing technical input to patent applications;
    ii. assisting with the transfer of the technology to third parties; and
    iii. providing market and end user advice where needed.

(20) The Supervisor / Line Manager / Head of School / PVC will be responsible for assessing the transfer proposal.

(21) The Deputy Vice-Chancellor Research or delegate is the Intellectual Property Officer, who is delegated to exercise the University's powers and functions under this policy, and is responsible for

a. providing resources to audit and facilitate the capture of IP;
b. assessing Knowledge Asset for status as IP;
c. authorising formal protection if required;
d. providing final sign off for commercialisation of the IP; and
e. approving or rejecting recommendations for disposal.

(22) Research Services will be responsible for

a. maintaining a register of current Disclosure Forms and IP;
b. assisting with market intelligence, protection strategy, patenting or other required protection; and
c. providing assistance with the transfer process from proposal to implementation.

(23) The Legal Services will be responsible for providing advice, and negotiating and drafting agreements where required.

Auditing

(24) Knowledge Asset audits and the protection of a Knowledge Asset will be reviewed regularly by the University.

(25) Continued protection of the Knowledge Asset will only be required where the University decides to commercialise the Knowledge Asset.

Benefits

(26) Benefit value is calculated as the net return to the University following the "commercialisation" of Intellectual Property.

(27) A benefit of 1/3 of the net return to the University from the commercialisation will flow through to the creator(s). This does not apply to "teaching materials" as set out in clause 6.

(28) Benefit sharing will be dependent on correct identification of Creator(s) because incorrect identification can invalidate formal protection mechanisms such as patents.

(29) The benefit to a UNE employee may be paid, as directed by the creator(s)

a. through the payroll system in which case tax will be deducted;
b. to a trust set up for the purpose of receiving the funds; or
c. into a designated University Special Purpose Account.

(30) The proportion of funds to be shared by each of the Creators will be determined at the time that the IP is assigned to the University.

Disposal

(31) Knowledge Assets which cease to have value to the University may be disposed of by the University.

(32) Disposal of a Knowledge Asset will involve

a. the assignment of the Intellectual Property in the Knowledge Asset to its Creator(s); or
b. deletion of the Intellectual Property from applicable registers within the University.

Dispute Resolution

(33) Disputes on matters contained in this policy will be handled by the Deputy Vice-Chancellor Research in the first instance.

(34) Where the dispute has not been able to be resolved through this process, the matter may be referred by either party to a person or process that is mutually agreed (between the University and staff member concerned). In such a case agreement will not be unreasonably withheld.

Section 3 - Procedures

(35) New Knowledge Assets must be disclosed to the University through the Head of a Cost Centre, reporting to the Deputy Vice-Chancellor Research.

(36) For Knowledge Assets which are not expected to have a commercial implication for the University, approval will be the responsibility of the Deputy Vice-Chancellor Research.

(37) Where a staff member of the University has conceived and developed a system, product or process which is deemed to be new and innovative and which may have commercial potential, (i.e. Intellectual Property), then Form Intellectual Property Disclosure must be completed and lodged with the Deputy Vice-Chancellor Research or delegate within five working days of realising the potential of the discovery. It is the responsibility of the staff member to act in the interest of the University.

(38) On receipt of this information, the University will make a decision regarding the commercial viability of the IP.

Within 20 working days the University may elect to

a. approve their publication; or
b. protect those Knowledge Assets; or approve Knowledge Asset Transfer.

(39) Where appropriate, the University will make services and financial resources available to protect and commercialise the IP. The University may require staff members and other parties to sign a confidentiality agreement.

(40) There will be a centrally co-ordinated data collection each year. This information, coordinated by the Deputy Vice-Chancellor Research or delegate, will be provided to the Vice-Chancellor and Chief Executive Officer in February each year.

Section 4 - Definitions

(41) Knowledge Asset is a broad descriptive term meant to encompass any result of intellectual effort which is considered by the University to have value for ongoing teaching and research endeavours. The value need not be economic, it may be knowledge of cultural significance or social interest. The term is used to express the breadth of knowledge which the policy is aiming to cover.

(42) Intellectual Property is a Protected Knowledge Asset(s) which can be commercialised. Intellectual Property may include, but not be limited to:

a. copyright and related rights (including, but not limited to, future copyright, copyright in editions of works and moral rights) existing by virtue of the Copyright Act 1968 (C'th);
b. common law and registered trade marks registered under the Trade Marks Act 1995 (C'th), which are devices used to distinguish goods and services provided by one trader from those provided by another (e.g. letters, numbers, words, smells, phrases, sounds, shapes, logos, pictures or combinations of these);
c. registered designs, protect the way a manufactured product (not a work of art) looks or can be judged by the eye, as set out under the Designs Act 2003 (C'th);
d. undisclosed inventions;
e. patents registered and unregistered, protect new, inventive and useful devices, substances, methods or processes, as set out in the Patents Act 1990 (C'th);
f. plant breeders rights, protect new varieties of plants or associated reproductive materials, as set out under the Plant Breeder's Rights Act 1994 (C'th);
g. trade secrets and know-how;
h. semiconductor or circuit layouts, as set out under the Circuit Layouts Act 1989 (C'th) automatically protect original layout designs for integrated circuits;
i. confidential information - new Knowledge Assets which have not been publicly disclosed, including through conference presentations, submission of papers, web publication, pod casting or media releases; and
j. all other intellectual property as defined in Article 2 of the convention of 1967 establishing the World Intellectual Property Organisation.

Section 5 - Appendix 1

Intellectual Property

Asset Management Diagram (click here for Asset Management Diagram)

(43) This diagram may assist with the visualisation of the asset management process.

Circle 1 - Knowledge

(44) The circle zone represents Knowledge to which the University does not ascribe a value and is therefore not the subject of this policy.

Examples:

a. Undisclosed knowledge created within the University
b. Information in the Public Domain
c. Expired Patents

Box 2 — Knowledge Asset

(45) Box 2 contains Knowledge + Value = a Knowledge Asset. The University is interested in using it for further research or for Knowledge Asset Transfer. It must remain confidential until the University decides what to do with it. If at some point a Knowledge Asset in Box 2 loses its value to the University (although it may have value to others), then it slips into circle 1 zone and the University may dispose of it.

Examples:

a. Disclosed Knowledge Assets
b. Background Knowledge Assets upon which future research will be based
c. Data in databases
d. Other experimental results

Box 3 - Protected Knowledge Assets (Intellectual Property)

(46) The Knowledge Asset in Box 3 is knowledge with a value which the University has taken steps to protect (or, if covered by copyright or circuit layout rights, is protected upon creation) because the University intends to use it for further research or Knowledge Asset Transfer. It is described as Protected Knowledge Assets. Box 3 includes all of the confidential information, patents, trade marks, copyright, which are critical for further research or Knowledge Asset Transfer. If, at some point, the Knowledge Asset in Box 3 ceases to have value to the University, the University may then dispose of it.

(47) It should be emphasised that Protected Knowledge Assets (Box 3) is a subset of Knowledge Assets (Box 2) that the University is managing for the purposes of further research or Knowledge Asset Transfer.

Examples:

a. Knowledge protected on creation such as through Copyright or Circuit Layout rights.
b. Teaching notes / course materials/ electronic and hardcopy formats /Confidential Information
c. Patents or Patent Applications
d. Plant Breeders Rights Trademarks

(48) Knowledge Assets with no value to the University, will be disposed of.

Examples:

a. Non-commercial patents / applications
b. Copyright material which has been cleared for publication

Section 6 - Appendix 2

Intellectual Property

Case Study 1 - Commercialisation

(49) Marcus, an academic in the School of Law developed software that can be used as an assessment feedback tool for monitoring, assessing and providing feedback for the performance of Students and staff.

(50) Marcus and UNE signed a confidentiality and intellectual property rights assignment agreement to capture any background IP brought by Marcus to UNE. Deputy Vice-Chancellor Research and Marcus negotiated a split of net commercialisation income for commercialisation and a royalty sharing deed was signed. The Legal Services applied to IP Australia for a trade mark in UNE's name to protect the logo (designed by Marcus).

(51) A meeting with Patent Attorneys was held to discuss and instruct them to draw up specifications and to file provisional patent with IP Australia to protect the software.

(52) Confidentiality deeds were sent to interested education providers and a demonstration of the software was presented. As a result license terms (including royalties) were negotiated and licenses made with several educational institutions.

(53) As a result of his royalty sharing agreement with the university, Marcus received a stream of royalties from the licensing of the software he developed.

Case study 2 — PhD students

(54) Lee and Evelyn undertook PhDs through the School of Environmental and Rural Science. Lee's topic coincided with a UNE project which had been running for several years, while Evelyn's aligned with an Australian Cotton CRC sponsored project involving CSIRO Plant Industry and the UNE.

(55) Both Lee and Evelyn were requested to assign any intellectual property they may create while working on the project to the UNE. Lee refused to do so and was offered an alternative topic in another area. Evelyn signed an intellectual property rights assignment deed prepared by the UNE Legal Services after receiving independent legal advice from Evelyn's family solicitor.

(56) Evelyn's work assisted the project team to obtain an Australian provisional patent, which eventually led to patents in the United States and parts of the European Union, paid for by the joint venturers in the Australian cotton CRC, including the university. (The level of costs is beyond the resources of most post graduate students.)

(57) Due to the contribution of a useful idea, Evelyn was named on the patent granted to the UNE as one of the inventors. Along with the other inventors, Evelyn signed a royalty sharing deed with the UNE under which Evelyn was to receive 8% of the inventors' share.

(58) After Lee and Evelyn were awarded their PhDs, the project Evelyn worked on was successfully commercialised. Evelyn received a small amount of income from the royalties but, more importantly, Evelyn's participation in the project enhanced her CV and assisted with obtaining a post-doctoral position in the United States.

Case study 3 — PhD student

(59) Vivian undertook a PhD in English Literature. The thesis focused on the themes in Mary Shelley's Frankenstein and from where Shelley drew her inspiration. One of the reviewers of the thesis suggested to Vivian that it would, with some rewriting, make an excellent non-fiction book

(60) During the course of the PhD, Vivian and Vivian's supervisor had recorded each person's IP contributed to the thesis. When publication is contemplated Vivian's supervisor agrees to waive his/her rights over the IP so that Vivian is able to proceed with the rewriting for publication.

(61) Through a literary agent, Vivian contacted a publisher who agreed to publish the final manuscript. As the UNE makes no claim over the copyright in a student's thesis, and the IP issues have been resolved between Vivian and her supervisor, Vivian is free to publish the book and will be the sole recipient of royalties from its sales.

Case study 4 — Academics

(62) Jessie, an academic with the UNE, completed the development of a new process to assist seeds to germinate more quickly. The work was part of an ongoing project conducted by the UNE which Jessie took over from another academic at an advanced stage. Jessie was employed, in part, to take over the project because of special expertise in the subject area.

(63) Jessie, without reference to the UNE, applied for a provisional patent over the process and set up a company to commercialise it. On behalf of the company, Jessie negotiated with several organisations to acquire licenses to use the process. One of those organisations undertook due diligence on the patent and, after discovering that intellectual property arose from a UNE project, declined to take a license.

(64) Having run short of funds, Jessie convinced several friends to invest in the company in exchange for equity in the form of shares. Finally, Jessie succeeded in licensing the process and the licensee agreed to take over the payments for the patents.

(65) When the UNE became aware that Jessie had failed to disclose the patent and set up the company to commercialise it, the UNE commenced a civil action against Jessie and the company. The court found in favour of the UNE, ruling that it was entitled to a constructive trust over Jessie's shares in the company and Jessie was required to account to the UNE for sales of shares and for the royalties received under the license. In addition, the UNE conducted a misconduct hearing into Jessie's actions which resulted in Jessie being demoted.

Case study 5 — Academic / Student — publish or protect?

(66) Simon is working on a cutting edge PhD project building on several years of research by his supervisor Caroline.

a. They completed the initial and the six monthly reviews of IP contributions throughout the course of Simon's PhD studies. (This acknowledged the initial major contribution of Caroline's background IP, but built Simon's share through the contribution of his PhD studies.)
b. At the start of the project they completed assignment and benefit sharing agreements with the University. (The IP is owned by the University, but the inventors benefits are in proportion to their respective contributions.)

(67) Having just analysed the results of their latest experiment Simon realises that they have discovered a new class of chemicals which will provide the basis for new research directions as well as a variety of veterinary and medical treatments. On consulting with Caroline their first impulse is to publish the results in the next issue of their discipline journal.

(68) Scenario 1 —Publish.

a. Simon and Caroline write up their results and submit them directly to the journal.
b. The paper is accepted and appears on the web immediately after refereeing.
c. Simon and Caroline are contacted by a wide variety of potential collaborators from other research institutions and a number of international pharmaceutical companies.
d. On hearing that the chemicals are not protected, but are now in the public domain all the companies regretfully

withdraw from negotiations.

e. Simon and Caroline set up a number of collaborations with other researchers and earn a reputation as the discoverers of the compounds.

(69) Scenario 2 —Protect

a. Simon and Caroline write up their results which are submitted to the Intellectual Property Officer who suggests that a patent attorney review their findings.
b. A Provisional Patent Application is filed protecting the discovery described in their paper.
c. The paper is submitted to the journal.
d. The paper is accepted and appears on the web immediately after refereeing.
e. Simon and Caroline are contacted by a wide variety of potential collaborators from other research institutions and a number of international pharmaceutical companies.
f. Simon and Caroline set up a number of collaborations with other researchers and earn a reputation as the discoverers of the compounds.
g. An international pharmaceutical company negotiates with the University to license the use of the compounds in a particular range of treatments.
h. Caroline is promoted internally and Simon leaves to take up a Post Doc position overseas.
i. Several years later (after a multi million dollar development and regulatory program) the company returns a royalty stream to the University.
j. Based on the benefit sharing agreement with the University, Caroline and Simon, receive royalties, distributed according to their individual contributions.

(70) Case study 6 — publishing course materials

(71) John, an academic in the School of Humanities, Arts and Social Sciences, came across some course materials from a course no longer offered at UNE. John felt that, with some updating and judicious editing, the course materials would make an excellent textbook. John contacted a colleague at the University of New South Wales who said that John's proposed textbook would make an excellent resource for a course which she intended to set up at UNSW next year.

(72) John, being somewhat cautious, wondered whether the University still had any claim over the course materials, since he'd noticed a copyright claim by the University on the front cover of the old materials. On checking the University's homepage, John discovered that there was an Intellectual Property Policy and that it was administered by the PVC (R).

(73) On talking to the Deputy Vice-Chancellor Research, John was informed that the University did indeed hold the copyright to the course materials. John was amazed to discover that the University's copyright would last for over sixty years and that some of the original contributors possessed enforceable Moral Rights over the course materials.

(74) After some discussion, the Deputy Vice-Chancellor Research and John negotiated an agreement under which he would convert the course materials into a textbook. Under the agreement drafted by the Legal Services, the University and John would share the royalties from sales of the book.

(75) In line with the legislative requirements, the agreement also required John to honour the Moral Rights of two original contributors to the course materials by contacting them and obtaining their written permission to amend their works before including them in the textbook. One of the original contributors wrote back to John waiving her Moral Rights on the grounds that the chapter of the book based on her work would be almost entirely rewritten and the contribution felt that she couldn't really make a claim over it. The other contributor insisted that he be named as an author for that chapter of the book, which John did.

(76) With the help of the Legal Services, John negotiated and signed a publishing contract. The book was published

and many copies sold through the UNSW bookshop. As a result John enjoyed a share (along with the university) of the stream of royalty payments on sales.

Section 7 - Appendix 3

Intellectual Property Process

Flow Chart of the Process (click here for flow chart)

Section 8 - Appendix 4

Intellectual Property Disclosure form (click here for form)

Status and Details

Status	Current
Effective Date	27th July 2015
Review Date	27th July 2015
Approval Authority	Vice-Chancellor and Chief Executive Officer
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Expiry Date	To Be Advised
Unit Head	Chris Armstrong Deputy Vice-Chancellor Research carmst22@une.edu.au
Author	Heiko Daniel
Enquiries Contact	Office of the Deputy Vice-Chancellor (Research) +61 2 6773 3715

Glossary Terms and Definitions

"Student" - Is an admitted student or an enrolled student, at the relevant time: 1. an admitted student is a student who has been admitted to a UNE course of study and who is entitled to enrol in a unit of study or who has completed all of the units in the UNE course of study; 2. an enrolled student is a student who is enrolled in a unit of study at UNE.