

# Management of Intellectual Property Procedure

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## Purpose

This procedure describes how the University:

- a. identifies, manages and uses intellectual property (IP), and
- b. protects Indigenous Cultural and Intellectual Property (ICIP) rights, recognising that Indigenous culture and heritage are not readily protected under Australian IP law.

## Applicable governance instruments

Instrument	Section	Principles
<i>Intellectual Property Policy</i>	All	All
<i>Compliance Policy</i>	2 Conflict of Interest 3 Foreign Influence and foreign interference	All All
<i>Behaviour Policy</i>	1 Behaviour 4 Consequences	1.3 4.2
<i>Academic Freedom and Free Speech Policy</i>	All	All
<i>General Delegations Ordinance</i>		
<i>Copyright Act 1968</i>		

<i>Foreign Influence Transparency Scheme Act 2018 (Cth)</i>		
<i>Designs Act 2003</i>		
<i>Patents Act 1990</i>		
<i>Trade Marks Act 1995</i>		
<i>Circuit Layouts Act 1989</i>		

## Procedure

### 1. Introduction

This procedure supports the principles of the University's *Intellectual Property (IP) Policy* and sets the requirements for the efficient and responsible management of IP. It applies to all forms of IP owned by the University.

IP is any existing or future rights in relation to:

- copyright
- patents or patentable inventions
- designs
- trade marks
- new plant varieties
- circuit layouts
- trade secrets and know-how
- commercially sensitive information.

A creator of IP is any person who creates, conceives, reduces to practice, authors or otherwise makes a substantive intellectual contribution to the creation of IP.

UTAS Holdings, which trades as UTAS Innovation Ventures (UTAS InVent) is the manager of the University's research impact functions, including IP management and advice.

### 2. Scholarly Works

2.1. A "scholarly work" means:

- a. any copyright material that is not a deliverable of, or created pursuant to, the terms of a contract between the University and a third party; and
- b. excludes course materials (see below).

2.2. To the extent that the University owns scholarly work, and subject to any other agreement with the creator, the University grants employee creators a non-exclusive, royalty-free, non-commercial, worldwide licence as follows:

- a. to reproduce, publish, perform, communicate, and adapt the work, or part of it, which they authored, and
- b. solely for the purpose of communicating University research outputs to the public.

### 3. Ownership and Use of IP

- 3.1. The University will foster the most valuable use of IP by industry and commercial ventures, governments and the research sector by means including:
  - a. making the IP openly accessible through licensing and accessibility arrangements with allow for its use and re-use, including potentially for commercial benefit; and
  - b. protecting the IP to provide exclusive opportunities to undertake commercial benefit.

#### *Assignment of IP*

- 3.2. Employees may be requested to formally assign IP to the University on a case-by-case basis consistent with the IP ownership positions described in the *Intellectual Property Policy*.
- 3.3. Students, non-employees, or third parties may be asked to assign IP created by them where:
  - a. it is a requirement of a specific agreement (e.g. a funding agreement, research agreement or scholarship agreement);
  - b. the University will contribute, or has contributed, University resources (such as infrastructure, facilities, equipment, services or IP developed by or through the University) to the development of the IP;
  - c. the University proposes to commercialise the IP or otherwise grant an interest in IP to third parties.
- 3.4. Where a student or non-employee does not agree to assign IP in accordance with section 3.3 above, the University cannot guarantee that they can be involved in the research project or receive an associated scholarship/funding.

#### *Course Materials*

- 3.5. Course materials includes all materials produced solely for the purpose of teaching an accredited course. It excludes materials that are a deliverable of, or created pursuant to, a contract between the University and a third party.
- 3.6. Employees with teaching responsibilities are permitted to use IP in course materials they create during the term of their appointment for University teaching purposes.
- 3.7. To the extent the University has the right to do so, creators of course materials are granted a perpetual, personal, royalty-free, non-exclusive, non-transferable, non-commercial licence to use those materials for their own teaching and research purposes at other educational institutions, subject to the following conditions:
  - a. The creator must attribute all authors of the materials.
  - b. The creator may not commercialise or sublicense the materials to others to generate returns (such as royalties, license fees or commercial returns) except with the express written agreement of the University.

### 4. Reporting and Recording IP Opportunities

- 4.1. UTAS InVent manages the process for evaluating new opportunities involving IP and seeking protection, including registered protection such as patents, registered designs and registered plant breeder's rights and technology-associated trade marks.
- 4.2. The Research Funding team manages the negotiation of IP terms for research agreements, considering the rights and needs of all stakeholders involved in the research, in consultation

with UTAS InVent.

- 4.3. Disclosures of opportunities involving IP are made to UTAS InVent in writing following the process published on the UTAS InVent [intranet page](#).
- 4.4. Employees, students and non-employees must disclose to UTAS InVent, for evaluation, all details of any IP created, or which will be created, using University resources that:
  - a. may have commercial potential, or the potential to solve commercially valuable problems, or create new enterprises;
  - b. may have the potential to improve social and environmental outcomes through establishment of a new product, service or business;
  - c. is required to be reported under an agreement between the University and a third party (such as a research agreement).
- 4.5. UTAS InVent may require further details of the IP to be disclosed in order to evaluate the opportunity and determine ownership, inventorship, commercial or other impact potential, and measures to protect the IP.
- 4.6. Students, the primary supervisor of students, employees, line managers, Heads of Discipline, and Heads of School/Centre/Institute, all have the responsibility to ensure that IP created using University resources is identified and disclosed in this way.

#### *Pre-existing IP*

- 4.7 Pre-existing IP includes IP created prior to, or independently of, a particular University project. Employees, students and non-employees must disclose the details of any pre-existing IP that may be used in the University project at the earlier of:
  - a. commencement of their employment, enrolment, or engagement; or
  - b. when they first have reason to believe that a third party has an interest in the pre-existing IP.

## **5. Record keeping**

- 5.1. University community members must keep records relating to their time at the University, including in accordance with *Research Data Management Procedure* or any data management plan agreed with their supervisor prior to leaving the University.
- 5.2 The Office of Research Services has custody of all copies of research agreements relating to IP.
- 5.3 UTAS InVent keeps a register of disclosed IP and IP for which registered protection has been obtained.

## **6. Management and Protection of IP**

- 6.1. University IP is managed and protected by UTAS InVent and at the University's discretion.
- 6.2. All details of IP disclosed in accordance with section 4.4 above, must be kept strictly confidential for a period which the University considers reasonable, to enable the University to protect the IP. The University is committed to academic freedom and free speech and will not require IP to be kept confidential for longer than is necessary to protect it.
- 6.3. Where there is a need to disclose information relating to an invention prior to finalising formal protection of the invention, a non-disclosure agreement must be put in place between the

University and parties seeking the confidential information. This will be facilitated through UTAS InVent.

- 6.4. UTAS InVent will advise the creator of disclosed IP, if the University proposes to commercially exploit, create other impact, or protect the IP.
- 6.5. The registration and protection of trade marks related to IP opportunities, while managed by UTAS InVent, must be approved by the Chief Marketing Officer, Division of Student Services and Operations, considering consistency with the University brand guidelines and strategy.
- 6.6. UTAS InVent may seek cost sharing arrangements related to the protection and management of IP with the University budget centre in which any creator is based.
- 6.7 Any use of University-owned IP will take into account the rights of all parties involved in the research or other activity from which the IP arose.

## 7. Impact and Commercialisation of University IP

- 7.1. The University's rights in any of its IP may only be waived, assigned or licensed with an express written waiver or agreement from the appropriate University delegate as per the University's *General Delegations Ordinance*.
- 7.2. The University may agree to licence or assign its IP disclosed under section 4.4 above to the creator(s), or a separate entity founded by the creator(s) where UTAS InVent determines this is likely to be the most valuable use of the IP.
- 7.3. Employees, students and non-employees involved in the creation of IP must comply with all reasonable directions from the University and provide all reasonable assistance in the commercialisation or impact creation process, including:
  - a. maintaining the confidence of information incorporating the IP,
  - b. providing information promptly on request,
  - c. attending meetings with potential commercial or enterprise collaborators, licensees or investors, and
  - d. advising as required on further development of the IP.
- 7.4. If the IP is commercialised, the University will share the net commercialisation income between the creator(s) of the IP, the University academic or business unit in which the creator resides, and the Research Division.
- 7.5. Net commercialisation income is any income received by the University less taxes, any costs, expenses or fees incurred either directly or indirectly by the University in its discretion to commercialise IP and any portion which a third party (for example a funding body) claims under an agreement with the University. Costs which may be incurred by the University and deducted from commercialisation income prior to distribution include, but are not limited to:
  - seed income and other support costs incurred by UTAS InVent
  - costs associated with protection of IP
  - obtaining advice from patent attorneys external to UTAS
  - preparing legal briefs using lawyers external to UTAS
  - IP assessment by external consultants

- IP searches
- challenging infringements of patents.

7.6. UTAS InVent will distribute the cumulative net commercialisation income over the life of the IP in the proportions outlined in the following table:

Cumulative Net Commercialisation Income (\$m)	Disbursement Split (%) (for each dollar over the Commercialisation Income bracket)		
	Creator(s)	Academic Unit	University
up to \$10	50	20	30
\$10-\$20	45	20	35
\$20-\$30	40	15	45
\$30-\$40	35	15	50
\$40-\$50	33	10	57
\$50-\$60	33	10	57
>\$60	33	5	62

This table applies in relation to new IP/new patent families registered after the date this procedure is approved.

- 7.7. Where there is more than one creator, the share of net commercialisation income to creators will be apportioned in accordance with each creator’s contribution to the creation of the IP as agreed between the creators. Where no agreement is reached, prior to any distribution of net commercialisation income, the most senior role in UTAS InVent may determine the appropriate proportions after providing each creator a reasonable opportunity to provide evidence of their contribution.
- 7.8. A creator, where permitted by the University, may agree in writing to substitute their share of net commercialisation income for other non-cash benefits such as shares or property.
- 7.9. A creator is not bound to accept non-cash benefits in substitution of a share of net income.
- 7.10. UTAS InVent is the primary contact within the University in relation to any disputes arising regarding an employee, student or non-employee’s use or interest in IP or share of net commercialisation income.
- 7.11. Determinations of UTAS InVent made pursuant to this section 7 may only be appealed on procedural fairness grounds, with such appeals to be determined by the Deputy Vice-Chancellor (Research) or their delegate. A determination made by the Deputy Vice-Chancellor (Research) or their delegate is final.

## 8. Indigenous Cultural and Intellectual Property (ICIP) Rights

- 8.1. The University seeks to adopt best practices in relation to ICIP, which involves respecting and recognizing the rights of Indigenous communities and knowledge holders over their cultural heritage and IP, and consideration of:
- Consultation and Collaboration;
  - Free, Prior, and Informed Consent (FPIC);
  - Respect for Indigenous Laws and Protocols;

- Benefit Sharing and Fair Compensation;
  - Protection of Sacred and Sensitive Knowledge;
  - Education and Awareness; and
  - Review and Continuous Improvement.
- 8.2. Permission must be obtained from Indigenous IP holders prior to a student or employee or non-employee of the University attempting to access, record, use or commercialise ICIP. Applications for permission are made to the Office of the Pro Vice-Chancellor of Aboriginal Leadership in accordance with all guidelines published on the [Aboriginal Business website](#) and in partnership with UTAS InVent.
- 8.3. Where Indigenous people are consulted in matters pertaining to the use of their ICIP, they are to be appropriately reimbursed for their time and expertise.
- 8.4. The University will not hinder the customary use of ICIP by Aboriginal and Torres Strait Islander people in instances which include but are not limited to:
- a. Community events,
  - b. Publications (academic and non-academic),
  - c. Workshops and lectures,
  - d. Public speeches, and
  - e. Websites and podcasts.
- 8.5. Indigenous IP Holders have the right to refuse the use of their ICIP by the University, its students and its agents, whether required by Australian law or not. This decision shall be respected, and further requests should not be submitted for that ICIP.
- 8.6. When ICIP is deemed to be secret knowledge (e.g. women's business) or confidential, that information will not be accessed, recorded, commercialised, or used.
- 8.7. If a staff member or student intentionally or unintentionally is privy to, or becomes in possession of, secret or confidential knowledge, the confidential nature of that information shall be respected. Physical or electronic records of that information must be subsequently destroyed.
- 8.8. If there is a disagreement with Indigenous IP holders in relation to ICIP, staff or students of the University involved will:
- a. Contact the Office of the Pro-Vice Chancellor of Aboriginal Leadership and, as appropriate, UTAS InVent for further advice.
  - b. Contact a representative from the University Legal Office to facilitate the undertaking of mediation.

## 9. Theft (or other loss) of IP

- 9.1. The theft or other loss of University IP represents a significant risk to the University. It is the responsibility of all employees, students, or affiliated non-employees of the University to maintain the security of University IP.
- 9.2. Risk management plans for all new research projects should consider and manage risks to the security of IP (including data, logbooks, notebooks, project results and Indigenous knowledge)

developed or received during the project. Information about potential or actual IP should be captured in one or more of the following forms:

- a. Pre-legal forms submitted to Research Services or legal advice request forms as relevant,
  - b. Higher Degree Research (HDR) Project Approval Form,
  - c. Adjunct, Clinical and Associate Titles Nomination Form for New Appointments, Visiting Fellowships and Visiting Scholarships Program Nomination Form and / or
  - d. where relevant, an Indigenous specific risk management plan.
- 9.3. The University may require that any employees, students, or affiliated non-employees of the University involved in the conduct of research on its behalf undertake training in relation to managing the risk of theft (or other loss) of IP as a precondition to undertaking that research.

## 10. Non-Compliance

- 10.1. The failure of an employee, student, or affiliated non-employee to comply with the terms of this Procedure is a breach of the University's *Behaviour Policy* and may result in consequences described in that Policy (*Behaviour Policy* principles 1.3 and 4.2).

### Related procedures

*Research Data Management Procedure*

*Research Ethics Procedures*

*Authorship Procedure*

*Research Funding Costing Procedure*

### Versions

Version	Action	Approved by	Business Owner/s	Approval Date
1	Approved	Deputy Vice-Chancellor (Research)	Chief Executive Officer, UTAS Innovation Ventures	30 October 2024