Intellectual Property Procedure

Section 1 - Context

(1) The purpose of this document is to support and give effect to the implementation of the University's Intellectual Property Policy and should be read in conjunction with that document.

(2) This Procedure should be read in conjunction with the Intellectual Property Policy (Policy). Accordingly, the scope of the Policy applies equally to this Procedure as does the document specific definitions.

Section 2 - Registration of University IP

(3) Knowledge Exchange & Enterprise will maintain an Intellectual Property Register. A report on the register will be made annually by the Director, Knowledge Exchange and Entrepreneurship to University Council.

(4) The Intellectual Property Register will include the following information:

a. a description of the University IP and its location;
b. the names of originator/s and proportional contribution of inventorship as specified in the invention disclosure for the University IP;
c. any potential or current risks associated with the University IP;
d. where the University has a licence to use a third party's IP: details of the licence, licensor, expiry date and payments;
e. the anticipated costs and any anticipated revenue associated with the University IP; and
f. any other information concerning the University IP which the Deputy Vice-Chancellor (Research and Innovation) indicates is required.

(5) If there is doubt or a dispute amongst the Originators in relation to the proportional contribution of inventorship referred to in clause 4(b) above, the matter will be referred to the relevant University delegate for resolution, who will take advice from suitably qualified and experienced advisors before making a decision.

(6) Where a staff member creates University IP that may be capable of knowledge transfer and/or commercialisation, the staff member must disclose the details of the University IP as soon as possible to Knowledge Exchange & Enterprise through the University Invention Disclosure Portal. The Knowledge Exchange & Enterprise team is available to provide advice and support to staff and students regarding knowledge transfer and the commercialisation of University IP.

(7) Where a student creates University IP which may be capable of knowledge transfer and/or commercialisation, the student must advise their supervisor who must disclose the details of the University IP as soon as possible to Knowledge Exchange & Enterprise through the University Invention Disclosure portal.

(8) Staff or students who create University IP will be required to uphold confidentiality in accordance with the provisions of the Intellectual Property Policy.

(9) Once University IP is entered on the Intellectual Property Register, the procedure for knowledge transfer and/or

commercialisation of University IP will commence.

Section 3 - Procedure for Knowledge Transfer and/or Commercialisation and Translation of University IP

(10) When University IP is entered on the Intellectual Property Register, Knowledge Exchange & Enterprise, in consultation with the originator(s) and any other relevant University member(s) or external expert(s), must, within eight weeks (the determination period), evaluate the potential of the University IP for knowledge transfer and/or commercialisation.

(11) Within the determination period, Knowledge Exchange & Enterprise must ensure that the ownership of the University IP is verified and must take all necessary steps to determine and verify that ownership. The originator(s) must assist where required in the verification process.

(12) Knowledge Exchange & Enterprise must make the determination on the basis of appropriate legal, financial and commercial advice, prior art, third party involvement, potential market and customers, relevance of the intellectual property to the University's purposes, and with reference to the University's Risk Management Framework.

(13) During the determination period, all staff and students must do all things necessary to ensure that the University IP is treated as confidential, including by having any persons consulted during that period sign confidentiality agreements with assistance from Knowledge Exchange & Enterprise as required.

(14) An initial determination of the potential of the University IP for knowledge transfer and/or commercialisation must be communicated to the originator(s) within the determination period and may result in a recommendation to pursue one of the following pathways or other practical application as appropriate:

a. Commercial Licence: a potential commercial licensing opportunity is identified with a third-party licensee and a commercialisation plan will be developed by Knowledge Exchange & Enterprise in consultation with the originator(s);
b. Social and/or not for profit venture: an opportunity exists to create a social venture to maximise public benefit arising from the University IP and create social and economic impact. A plan will be developed by Knowledge Exchange & Enterprise in consultation with the originator(s);
c. Ongoing development: further development of the University IP is required to demonstrate knowledge transfer and/or commercialisation potential; or
d. Spinout: the University IP is suitable for commercialisation through a new spinout company. A plan will be developed by Knowledge Exchange & Enterprise in consultation with the originator(s) and in accordance with the University's Governance Framework for Controlled Entities, Spinout Procedure, and Commercial Activities Policy, where relevant.

(15) Following the determination, Knowledge Exchange & Enterprise will be responsible for leading the knowledge transfer and commercialisation of the relevant University IP. Knowledge Exchange & Enterprise will consult with relevant stakeholders, including the originator(s), and provide advice and support which may include:

a. filing and maintaining patents or other protection method, subject to approval by the relevant delegates;
b. undertaking customer and market research;
c. identifying external partners who may be licensees;
d. recommending funding sources and providing strategic knowledge transfer and commercial advice.

(16) At any time, the University in consultation with the originator(s), Colleges and/or external advisors may re-

evaluate the knowledge transfer and commercial potential of University IP, adjust the preferred translation/commercialisation pathway and translation/commercialisation plan.

(17) From the date of publication of this Procedure, in the event of returns from commercialisation to the University, the net returns will be calculated by Knowledge Exchange & Enterprise and apportioned by the University annually to the Originator/s (50%) in accordance with the agreed proportions of inventorship and the remaining 50% retained by the University. Net returns are returns after deduction of all direct University costs incurred regarding the creation, development and protection of the University IP which typically represents the cost of patenting and/or other protection, any payments to collaborating organisations under relevant agreements, and any external advice obtained with regard to commercialisation of the University IP.

(18) If an originator waives their right to net returns under clause 17 for any reason, including but not limited to circumstances where an originator holds equity in an entity commercialising University IP, that Originator's share of net returns will be retained by the University and allocated in accordance with clause 20, unless otherwise approved by the relevant delegate.

(19) The University may enter into an agreement with one or multiple controlled entities to commercialise University IP on its behalf. In this case, the principles referred to in clause 17 and 20 will apply to those arrangements for any new commercialisation agreements entered into from the date of publication of this Procedure.

(20) Where the University receives a share of the net returns from commercialisation under this Section, unless otherwise agreed in writing by the Deputy Vice-Chancellor (Research and Innovation), this amount will be allocated equally to Financial Services, the Division of Research and Innovation, and the host College of the Originator/s. This will be calculated on an annual basis after deduction of all patent costs and other commercialisation costs incurred by Knowledge Exchange & Enterprise in protecting University IP in the relevant calendar year.

IP and open licensing

(21) There may be instances where University IP will be suitable for the application of an open licence, such as from Creative Commons, in accordance with the University's Open Access Policy. Staff members should not assume that their status as Originator(s) of University IP automatically grants them the ability to apply open licensing. As outlined in the Intellectual Property Policy, not all materials may be suitable for open licensing. Where staff members own the IP, they may choose an open licence that best suits their needs in accordance with the University's Open Access Policy. The relevant delegate must approve the application of an open access licence to University IP.

(22) Where approved course materials have been created as or converted to Open Educational Resources (OER), application of an appropriate open licence is a requirement to allow for the purposes of reuse, retention, revision, remixing, and redistribution that are associated with OER. This will be managed by the University Library.

(23) To give effect to the clauses in this Section, appropriate attribution of the creator/s must be included in the relevant materials, so as to not infringe on their moral rights. The attribution must also extend to any third-party copyright materials included, in accordance with the Copyright Compliance Policy.

Section 4 - Procedure for Assignment of University IP

(24) Originators who wish to have University IP in the form of copyright in computer works assigned to them must apply in writing to the relevant College Pro Vice-Chancellor or Head of Division. The written application must include an assurance from the originator(s) that the intellectual property is the original work of the staff member or student, or if produced jointly, will identify other person(s) involved and their agreement to the request for assignment. After consultation with the Head of School or other senior staff, the College Pro Vice-Chancellor or Head of Division will

make a recommendation to the Deputy Vice-Chancellor (Research and Innovation).

(25) Originators who wish to have University IP in the form of copyright in course materials assigned to them must apply in writing to the College Pro Vice-Chancellor or Head of Division. The written application must include an assurance that the intellectual property is the original work of the staff member or student, or if produced jointly, will identify other person(s) involved and their agreement to the request for assignment. After consultation with the Head of School or other senior staff, the College Pro Vice-Chancellor or Head of Division will make a recommendation to the Deputy Vice-Chancellor (Research and Innovation).

(26) Originators who wish to create or convert course materials owned by the University as Open Educational Resources (OER), must seek consideration and support from the University Library where possible. The application of open licensing for OERs, along with clearance of third-party copyright materials, will require consultation with knowledgeable staff at the University, such as the Senior Librarian, Copyright and Scholarly Publishing.

(27) University IP may only be assigned with the written approval of the relevant delegate on the recommendation of Knowledge Exchange & Enterprise and in circumstances where an acceptable conflict of interest management plan in accordance with the Disclosure of Interest Policy and outside work approval in accordance with the Outside Work Policy, where relevant, is in place.

(28) The relevant delegate will determine whether to grant the assignment and what conditions, if any, will apply.

(29) Where the University elects to assign University IP to the originator(s), the originators and the University will execute an assignment agreement in writing.

Section 5 - Procedure for Bringing Intellectual Property to the University

(30) A staff member or student who brings intellectual property to the University must, within six months of commencement of employment or enrolment, provide documentation to the Knowledge Exchange & Enterprise team that includes the following information which will be used to determine IP ownership:

a. a detailed description of that intellectual property;
b. all documents and evidence relating to the ownership of that intellectual property, including to the extent possible any contract, agreement, licensing agreement or another institution's intellectual property policy; and
c. written warranties to the extent possible that the use of that intellectual property does not infringe the rights of any third parties.

(31) The Knowledge Exchange & Enterprise team will notify the staff member or student of the outcome of the assessment of IP ownership.

Section 6 - Procedure for Dealing with a Copyright Work when a Staff Member Ceases University Employment

(32) Where the University owns a copyright work created by a staff member who is about to leave the employment of the University, the staff member must do all things necessary to ensure that the University's intellectual property in the copyright work is retained and protected, including by:

a. complying with the University's reasonable instructions;
b. ensuring that the copyright work remains with and is accessible by the University; and
c. ensuring that the copyright work is not used by the staff member after leaving the employ of the University, except with the written consent of the University.

(33) The staff member who is leaving the employment of the University may request from Knowledge Exchange & Enterprise a licence of the intellectual property in the copyright work. The University reserves the right to grant a licence on conditions, or to not grant a licence if University purposes would be adversely affected.

Section 7 - Procedure for Student Participation in University Projects

(34) Where a student participates in a project or activity that is specified in Section 7 of the Intellectual Property Policy the University through Knowledge Exchange & Enterprise in consultation with the supervisor of the student must:

a. enter into an agreement with the student setting out an appropriate entitlement of the student to any net returns of commercialisation in accordance with clause 17 of this procedure;
b. ensure that the academic progress of the student is not hindered by the provisions of the Intellectual Property Policy;
c. ensure that the examination of their thesis is not affected by the provisions of the Intellectual Property Policy without the express consent of the student; and
d. ensure that the student is advised to seek independent legal advice before entering into any agreement concerning intellectual property created by the student in the course of their studies.

(35) An agreement between the University and a student entered under this Section must address at a minimum:

a. the terms on which access to University IP will be given;
b. intellectual property ownership;
c. confidentiality requirements;
d. terms governing any potential commercialisation and entitlement to net returns; and
e. any requirements concerning intellectual property at the end of the student's enrolment.

Section 8 - Advising Staff Members and Students of Their Rights and Obligations and Protection the Rights of Students

(36) The University through Knowledge Exchange & Enterprise must take all reasonable steps to ensure that the provisions of the Intellectual Property Policy and Procedure are made known to staff members and students, including through:

a. onboarding, induction and training programs, educational seminars, enrolment handbooks and other published material for staff members and students and through the University's website;
b. specific inclusion in supervisor training programs; and
c. information sessions for students at the time of application for candidature and enrolment.

(37) In any dealings in which students are asked to assign their intellectual property to the University, the University

must assist students to protect their intellectual property by:

a. ensuring that students are advised to seek independent legal advice before entering into any agreement concerning assignment of their intellectual property;
b. referring to the Knowledge Exchange & Enterprise team any students seeking advice about the operation of the Intellectual Property Policy and Procedure;
c. referring students to the Intellectual Property Policy and Procedure to ensure students can inform themselves about their rights and obligations in relation to intellectual property; including updating the available information during the course of the enrolment where there are any changes to the Intellectual Property Policy and Procedure; and
d. ensuring the appropriate recognition of any verifiable contributions by the student and/or their supervisor or any other person in relation to the generation of the intellectual property.

Section 9 - Records Management

(38) All records associated with the registration, determination of ownership, and knowledge transfer/commercialisation of intellectual property, and the apportionment of net returns, must be managed in accordance with the Records Governance Policy.

Section 10 - Dispute Resolution

(39) Staff and students may seek to review the University's decisions under the Intellectual Property Policy and this Procedure.

(40) For staff, the process to review decisions made in relation to intellectual property rights is specified within the relevant enterprise agreement.

(41) Students may submit a complaint under Complaints Management Policy via the student complaints webpage if they have concerns regarding any University decision under the Intellectual Property Policy and its associated Procedure.

Section 11 - Reporting Breaches

(42) Breaches of the Intellectual Property Policy and this Procedure, or the misuse or unauthorised use of University IP, is a serious matter that may amount to misconduct or serious misconduct under the relevant enterprise agreement or the Student Conduct Rule.

(43) A breach as described in clause 41 may be reported to the University by:

a. For breaches by staff, submitting a breach report; and
b. For breaches by students, submitting a report via the mechanisms here.

Status and Details

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Responsible Executive	Craig Simmons Deputy Vice-Chancellor (Research and Innovation)
Enquiries Contact	Alan Broadfoot Pro Vice-Chancellor Industry and Engagement Office of the Pro Vice-Chancellor (Industry and Engagement)

Glossary Terms and Definitions

"University" - The University of Newcastle, a body corporate established under sections 4 and 5 of the University of Newcastle Act 1989.

"Risk" - Effect of uncertainty on objectives. Note: An effect is a deviation from the expected, whether it is positive and/or negative.

"Controlled entity" - Has the same meaning as in section 16A of the University of Newcastle Act 1989.

"Course" - When referring to a course offered by the University, a course is a set of learning activities or learning opportunities with defined, assessed and recorded learning outcomes. A course will be identified by an alphanumeric course code and course title. Course types include core courses, compulsory courses, directed courses, capstone courses and electives. For all other uses of this term, the generic definition applies.

"Student" - A person formally enrolled in a course or active in a program offered by the University or affiliated entity.

"Intellectual property" - Intellectual property (IP), as defined by the World Intellectual Property Organisation, refers to creations of the mind: inventions; literary and artistic works; and symbols, names and images used in commerce. Intellectual property is divided into two categories: Industrial property includes patents for inventions, trademarks, industrial designs and geographical indications; and Copyright covers literary works (such as novels, poems and plays), films, music, artistic works (e.g. drawings, paintings, photographs and sculptures) and architectural design. Rights related to copyright include those of performing artists in their performances, producers of phonograms in their recordings, and broadcasters in their radio and television programs.

"Research" - As defined in the Australian Code for the Responsible Conduct of Research, or any replacing Code or document.

"Senior staff" - Deputy Vice-Chancellor, Pro Vice-Chancellor, Global Innovation Chair, Global Innovation Professorial Fellow, Head of School, Director or equivalent.

"Staff" - Means a person who was at the relevant time employed by the University and includes professional and academic staff of the University, by contract or ongoing, as well as conjoint staff but does not include visitors to the University.

"Intellectual property rights" - All present and future rights to intellectual property including any inventions and improvements, trademarks (whether registered or common law trade marks), designs, copyright, any corresponding property rights under the Laws of any jurisdiction and any rights in respect of an invention, discovery, trade secret, secret process, know-how, concept, idea, information, process, data, or formula.

"College" - An organisational unit established within the University by the Council.

"Delegate" - (noun) refers to a person occupying a position that has been granted or sub-delegated a delegation of authority, or a committee or body that has been granted or sub-delegated a delegation of authority.