

Intellectual Property: Transfer of Rights to Creators - Procedures

1. Purpose

1.1 These procedures outline the process for transfer of Intellectual Property (IP) rights from the University to creators.

1.2 These procedures comply with the University's obligations under the *National Principles of Intellectual Property Management for Publicly Funded Research* must be read in conjunction with the linked Intellectual Property – Governing Policy and Intellectual Property: Commercialisation of Research Outcomes – Procedures.

2. Scope and application

2.1 These procedures provide guidance to staff, students, and invited scholars.

3. Definitions

3.1 Refer to the University's Glossary of Terms for definitions of terms as they specifically relate to policy documents.

4. Expectations of creators or contributors

4.1 The University relies on staff, students, and invited scholars to identify potentially commercial IP so that prospects can be evaluated

4.2 When teaching materials and education resources are identified as having potential commercial value, creators of IP must report the matter to the Deputy Vice-Chancellor (Academic).

4.3 When other University IP (subject to the restrictions of third-party agreements) are identified as having potential commercial value, creators of IP must report the matter to the Office of Research.

5. Assessment of transfer of IP rights

5.1 The Deputy Vice Chancellor (Research and Innovation) can decide to provide a license or assign the University's IP to creators where it does not breach a legal commitment to another party. This can occur after the clauses in this procedure have been observed, the University has evaluated the various considerations in clause 6 below, and the University formally advises that it no longer will pursue commercialisation of the University's IP.

5.2 When one or more creators do not wish to have the University's IP assigned to them, any other creators who wish to proceed with the commercialisation of the University's IP can request an assignment or license to them. By exception, the University can agree to assign or license the commercialisation rights and benefits to the creators, on the basis that the assignees undertake to meet all costs and risks associated with commercialisation of the University's IP and agree to any other reasonable conditions specified by the University.

5.3 The Deputy Vice-Chancellor (Research and Innovation) informs the creators of the decision not to pursue commercial and external engagement or additional research funding opportunities to further develop the IP. This decision is conveyed to the creators within 180 days from full and complete disclosure of the IP, subject to exceptions as the circumstances dictate.

5.4 When the University elects to discontinue its efforts later in the process, similar arrangements apply, with the decision period reduced to 60 days.

5.5 Within 30 days of receiving advice from the University, each creator can request in writing to the Deputy Vice-Chancellor (Research and Innovation), that the IP be Licensed with an Option to Assign (LOA) to them.

5.6 Upon such request, the Deputy Vice Chancellor (Research and Innovation) considers that request, and makes a decision within 30 days, and advise the creators in writing of that decision.

APPROVAL AUTHORITY

Deputy Vice-Chancellor (Research and Innovation)

RESPONSIBLE EXECUTIVE MEMBER

Deputy Vice-Chancellor (Research and Innovation)

DESIGNATED OFFICER

Director, Office of Research

FIRST APPROVED

28 September 2018

LAST AMENDED

4 September 2024

REVIEW DATE

28 June 2026

STATUS

Active

5.7 When an LOA request is approved, the University offers specific rights back to creators accepting the offer, subject to the applicable terms and conditions under the circumstances.

6. When will the decision not to pursue commercialisation occur?

6.1 The decision to not pursue commercialisation or additional research funding opportunities to further develop the IP is made after an assessment the commercialisation prospects for the IP where:

- (a) there has been full disclosure by the creators regarding the relevant IP;
- (b) the creators have fully cooperated with the assessment of the IP by the University; and
- (c) the creators have fully complied with their obligations under the University's IP policies and Codes of Conduct.

6.2 The transfer of rights to creators cannot be considered where:

- (a) a determination is made that the IP requires further work before it is possible to complete a proper assessment of commercialisation prospects;
- (b) there are significant negative impacts on future research activities or the interests of other creators or contributors; or
- (c) it is not in the best interests of the University to do so in the view of the responsible officer.

7. Factors considered when making a LOA

7.1 The University and the creators must consider the following factors, before an LOA can be developed:

- (a) whether the University's IP is at a stage where a reasonably skilled person could properly evaluate its commercial potential;
- (b) any encumbrances on the University's IP (verbal or written understandings, agreements or arrangements with third parties);
- (c) any effects on the University's ability to engage in education, teaching or research using the IP, including in collaborations with third parties;
- (d) actual, perceived or potential conflicts of interest relating to the University's IP or LOA; and
- (e) any impact on the University's ability to enter into research funding or other agreements with third parties to further develop the IP or publish the results.

7.2 A LOA cannot be considered for development when:

- (a) the IP is not developed to a stage where a reasonably skilled person can properly evaluate its commercial potential;
- (b) the IP is encumbered by verbal or written understandings, agreements or arrangements with third parties; or
- (c) the University's ability to engage in education, teaching or research using the IP, including in collaborations with third parties, would be blocked.

8. Terms of the LOA

8.1 The University requires the following terms under the LOA:

- licences to the creators transfer certain IP rights to those creators that have accepted the offer in a reasonable period of time;
- LOAs include a grant back to the University to use the IP internally for research and teaching purposes, and the ability to sub-license its research collaborators on like terms;
- an option to impose a condition requiring the payment of a royalty to the University by the creators or contributors in the event of future successful commercialisation outcomes;
- as this is a condition of the LOA, the creators will affirm that they have fully assisted the University in their commercial and external engagement efforts, including disclosing the IP in full and all licensing, contract research, consulting and collaboration leads, enabling the University to engage such licensing, contract research, consulting and collaboration leads to gauge their interest. Any breach of this condition will render the LOA void;
- creators must disclose a potential new conflict of interest to the Deputy Vice-Chancellor (Academic) or Office of Research as a result of taking a LOA to the University's IP and comply with all conflicts of interest policies and any conflict management plans;
- creators will indemnify the University for any liability or loss suffered or incurred (including third party claims and indirect and consequential loss) in connection with the LOA or exercise of any of the rights granted under the licence, or subsequent assignments, including any products or services made or sold which are derived from the exploitation of the IP rights;

- creators acknowledge that subsequent related IP (including improvements to the licensed IP) made at the University or within the scope of employment are not subject to the LOA;
- creators acknowledge and confirm that they will not use the facilities of the University or devote time during normal working hours at the University towards exploitation of the IP covered by the LOA, without the written approval of the Deputy Vice Chancellor (Research and Innovation);
- creators acknowledge that they will be responsible for all future IP protection and commercialisation expenses (for example, patent costs, legal fees, marketing costs);
- creators must waive all rights to any share of personal income that would otherwise be due to them under the Intellectual Property – Governing Policy for revenues received by the University as a result of the LOA; and
- creators shall provide periodic reporting to the University of royalties and revenues earned from exploiting the licensed or assigned IP rights.

9. Authorities and Responsibilities

9.1 The Deputy Vice-Chancellor (Research and Innovation) is authorised to make these procedures and related guidelines for the operation of University policy. These procedures and related guidelines must be compatible with the provisions of the Intellectual Property – Governing Policy.

9.2 The Director, Office of Research is authorised to make associated documents to support the application of policy documents. These must be compatible with the provisions of the respective policy document.

9.3 These procedures operate from the Last Amended date, will all previous procedures related to IP and the transfer of rights to creators are replaced and have no further operation from this date.

9.4 All records relating to IP and the transfer of rights to creators must be stored and managed in accordance with the Information Management – Governing Policy.

9.5 These procedures must be maintained in accordance with the Policy Framework – Procedures and reviewed on the shortened two-year policy review cycle.

9.6 Any exception to these procedures to enable a more appropriate result must be approved in accordance with the Policy Framework – Procedures prior to deviation from the policy document.

9.7 Refer to Schedule C of the Delegations Manual in relation to the approved delegations detailed within this policy document.

END

RELATED DOCUMENTS

- Data Governance - Operational Policy
- Intellectual Property - Procedures
- Intellectual Property: Commercialisation of Research Outcomes - Procedures
- Intellectual Property: Commercialisation Revenue - Procedures
- Intellectual Property: Student IP - Procedures
- University Policy Documents - Governing Policy
- University Policy Documents - Procedures

LINKED DOCUMENTS

- Intellectual Property - Academic Policy

RELATED LEGISLATION / STANDARDS

- National Principles of IP Management for Publicly Funded Research