

Intellectual Property: Transfer of Rights to Creators

- Procedures



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Definitions

Please refer to the University's Intellectual Property - Governing Policy and Glossary of Terms for policies and procedures for terms and definitions used in these procedures. These are critical to its interpretation and effectiveness.

1. Purpose of procedures

This document sets out USC's procedures in relation to the transfer of Intellectual Property rights, which allows for the conditional transfer of Intellectual Property rights on a case by case basis, from USC to the Creators in certain circumstances.

It provides guidance to Staff, Students, and Invited Scholars that have created USC Intellectual Property about the framework at USC for dealing with the return of Intellectual Property rights.

These procedures complement USC's Intellectual Property - Governing Policy and are compliant with the University's obligations under the National Principles of Intellectual Property Management for Publicly Funded Research.

2. When will these procedures apply?

Upon Creators complying with the expectations in clause 5 below and after USC has evaluated the various considerations in clause 6 below, and it advises that it will not further pursue Commercialisation of USC Intellectual Property, the Deputy Vice Chancellor (Research and Innovation) may decide to license or assign USC Intellectual Property to Creators where it does not breach a legal commitment to another party.

In the event that one or more Creators do not wish to have the USC Intellectual Property to them, any other Creators who wish to proceed with the Commercialisation of USC Intellectual Property can request an assignment or license to them. USC may 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 USC Intellectual Property, and subject to any other reasonable conditions specified by USC.

3. Assessment of transfer of intellectual property rights

For those intellectual property transactions that USC is responsible for managing, and for which it decides that it will not pursue commercial and external engagement or additional research funding opportunities to further develop the Intellectual Property (which decision will normally be made within 180 days from full and complete disclosure of the intellectual property, subject to exceptions as the circumstances dictate), it will inform the Creators accordingly. In cases where USC elects to discontinue its efforts later in the process (e.g. not proceeding to National Phase Entry in the case of a patent application), similar arrangements will apply, with the decision period reduced to 60 days.

Within 30 days of receiving advice from USC, each Creator may then request that the Intellectual Property be Licensed with an Option to Assign (LOA) to them by USC by writing to the Deputy Vice Chancellor (Research and Innovation). Upon such request, the Deputy Vice Chancellor (Research and Innovation) will consider that request, make a decision within 30 days, and advise the Creators in writing of that decision. If the request is approved, USC will offer specific rights back to Creators, and will effect University LOAs to all those accepting the offer, subject to the applicable terms and conditions under the circumstances.

4. When will the decision not to pursue Commercialisation occur?

The decision not to further pursue Commercialisation or additional research funding opportunities to further develop the Intellectual Property may be taken after USC and its advisors have assessed the Commercialisation prospects for the Intellectual Property and may be made only where the Deputy Vice Chancellor (Research and Innovation) is satisfied that there has been full disclosure by the Creators regarding the Intellectual Property and where the Creators have fully cooperated with the assessment of the Intellectual Property by USC. The Intellectual Property must also have been developed to a stage where a reasonably skilled person could properly evaluate its commercial potential.

5. Expectations upon creators and/or contributors

USC relies on Staff, Students, and Invited Scholars to identify commercialisable USC Intellectual Property in consultation with USC

USC Intellectual Property Creators must disclose the following:

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

11 January 2019

REVIEW DATE

28 September 2023

STATUS

Active

usc.edu.au/policy

- fully disclose USC Intellectual Property with potential commercial value, to the Deputy Vice-Chancellor (Academic) in the case of education resources or to the Office of Research in the case of other USC Intellectual Property (subject to restrictions of third party agreements). USC's Intellectual Property: Commercialisation - Procedures describe how identification and disclosure of USC Intellectual Property occurs. These procedures must be fully complied with in order for USC to make a proper assessment of the Commercialisation prospects;
- all licensing, contract research, consulting and collaboration leads, enabling USC to engage such licensing, contract research, consulting and collaboration leads to gauge their interest;
- disclose an existing and/or potential new conflict of interest promptly to the Deputy Vice-Chancellor (Academic) as a result of taking a LOA to USC Intellectual Property and comply with all of USC's Conflicts of Interest policies and any conflict management plans the Head of School/Department or Deputy Vice-Chancellor (Academic) deem necessary.

Please note, all Staff, Students and Invited Scholars have an obligation to comply with USC's Code of Conduct in dealing with USC Intellectual Property and an obligation to comply with the above.

6. What factors will USC consider when making a LOA?

Whilst there are numerous factors to be weighed by the University and the Creators and/or before undertaking such action, the following considerations shall be assessed:

- Whether the USC Intellectual Property is at a stage where a reasonably skilled person could properly evaluate its commercial potential;
- Any encumbrances on the USC Intellectual Property (verbal or written understandings, agreements or arrangements with third parties);
- Any effects on USC's ability to engage in education, teaching or research using the Intellectual Property, including in collaborations with third parties;
- Conflicts of interest or potential conflicts of interest in regard to the USC Intellectual Property or LOA; or
- Any impact on USC's ability to enter into research funding or other agreements with third parties to further develop the Intellectual Property or publish the results.

For the avoidance of doubt,

- No LOAs may be made for Intellectual Property that is not developed to a stage where a reasonably skilled person could properly evaluate its commercial potential.
- No LOAs may be made for Intellectual Property that is encumbered by verbal or written understandings, agreements or arrangements with third parties.
- No LOAs may block USC's ability to engage in education, teaching or research using the Intellectual Property, including in collaborations with third parties.

7. Terms of the LOA

USC will require the following under the LOA:

- Licences to the Creators will transfer certain Intellectual Property rights to those Creators that have accepted the offer in a reasonable period of time.
- The LOAs will also include a grant back to USC to use the Intellectual Property internally for research and teaching purposes, and the ability to sub-license its research collaborators on like terms.
- USC may at its option impose a condition requiring the payment of a royalty to USC by the creators or contributors in the event of future successful Commercialisation outcomes.
- As this is a condition of the LOA, the Creators and/or shall affirm that they have fully assisted USC in their commercial and external engagement efforts, including disclosing the Intellectual Property in full and all licensing, contract research, consulting and collaboration leads, enabling USC 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 shall promptly disclose a potential new conflict of interest to the Deputy Vice-Chancellor (Academic) as a result of taking a LOA to USC Intellectual Property and comply with all of USC's Conflicts of Interest policies and any conflict management plans the Deputy Vice-Chancellor (Academic) deems necessary.
- Creators shall indemnify USC 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 Intellectual Property rights.
- Creators acknowledge that subsequent related intellectual property (including improvements to the licensed Intellectual Property) made at USC or within the scope of employment are not subject to the LOA.

- Creators acknowledge and confirm that they will not use the facilities of USC or devote time during normal working hours at USC towards exploitation of the Intellectual Property 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 Intellectual Property protection and Commercialisation expenses (e.g. patent costs, legal fees, marketing costs, etc.).
- Creators must waive all rights to any share of personal income that would otherwise be due to them under the IP Policy for revenues received by USC as a result of the LOA.
- Creators shall provide periodic reporting to USC of royalties and revenues earned from exploiting the licensed or assigned Intellectual Property rights.

The role of staff and the Deputy Vice Chancellor (Research and Innovation) is outlined in the Intellectual Property - Governing Policy.

END

RELATED DOCUMENTS

[Intellectual Property - Governing Policy](#)

LINKED DOCUMENTS

[Intellectual Property - Governing Policy](#)

RELATED LEGISLATION / STANDARDS

[National Principles of IP Management for Publicly Funded Research](#)