INTELLECTUAL PROPERTY POLICY 2016

The Vice-Chancellor and Principal, as delegate of the Senate of the University of Sydney, adopts the following policy.

Dated: 10 May 2016

Signature:

Name: DR MICHAEL SPENCE

CONTENTS

1 Name of policy
This is the Intellectual Property Policy 2016.

2 Commencement
This policy commences on 10 May 2016.

3 Policy is binding
Except to the extent that a contrary intention is expressed, this policy binds the University, staff, affiliates and students.
4 Statement of intent

This policy:

(a) enables the University to identify, protect, manage and (where appropriate) commercially develop its intellectual property, for the benefit of the University and the community;

(b) sets out the entitlements and responsibilities of the University, staff, affiliates, students, and visitors in relation to intellectual property;

(c) supports a research culture in which translational research, technology transfer and entrepreneurial endeavour are rewarded; and

(d) provides for the appropriate distribution of the proceeds of successfully commercialised intellectual property.

5 Application

This policy applies to the University, staff, affiliates and students.

6 Definitions

affiliate

has the meaning given in the Code of Conduct – Staff and Affiliates, which at the date of this policy is:

clinical title holders; adjunct, conjoint and honorary appointees; consultants and contractors to the University; holders of offices in University entities, members of Boards of University Foundations, members of University Committees; and any other persons appointed or engaged by the University to perform duties or functions on its behalf.

An affiliate is not a visitor for the purposes of this policy.

background intellectual property

means intellectual property, other than teaching materials, created prior to, or independently of, a particular research project.

CDIP

means the University’s Commercial Development and Industry Partnerships unit.

course

means any program of study, in whole or part, provided by or on behalf of the University.

creative work

means original material, including:

- artistic works;
- literary works;
- dramatic works;
- musical works;
- films;
- photographs;
- sound recordings;
- broadcasts;
• published editions;
• performances of performing artists;
• phonograms; and
• broadcasts.

**gross development proceeds** means the sum of any lump sum, royalty or other payments received either as a result or by reason of the development or commercialisation of intellectual property. It includes but is not limited to:

• royalties;
• licence fees;
• milestone payments;
• dividends; and
• proceeds from the sale of shares.

**Head of Administrative Unit** means an employee of the University, normally a HEO level 10 or above, who is head of an administrative or equivalent budget unit, and is formally appointed as such by a Dean or Principal Officer of the University.

**Head of School** means an academic employee of the University who leads a school or equivalent budget or disciplinary unit.

**indigenous cultural property** means the rights of indigenous peoples, including but not limited to Aboriginal and Torres Strait Islander Peoples, to their heritage. This heritage consists of tangible and intangible aspects of the whole body of cultural practices, resources and knowledge systems developed, nurtured and refined by indigenous peoples and passed on by them as part of expressing their cultural identity.

**intellectual property** includes rights (including, without limitation, rights of registration or application for registration) relating to:

• literary works (including computer programs), artistic, musical and scientific works;
• multimedia subject matter;
• performances of performing artists, phonograms and broadcasts;
• inventions in all fields of human endeavour;
• scientific discoveries;
• industrial designs;
• trade marks, service marks and commercial names and designations;
• plant varieties;
• circuit layouts.

It does not include any moral right.

**moral right** has the meaning given in the *Copyright Act 1968 (Cth)* and includes:

• an author’s right to be identified as the author of a work (known
as the right of attribution)

• an author’s right to take action against false attribution (known as the right not to have authorship of a work falsely attributed)

• an author’s right to object to derogatory treatment of their work that affects their honour or reputation (known as the right of integrity of authorship).

net development proceeds means gross development proceeds less all external costs directly attributable to the development or commercialisation of intellectual property. Such costs include but are not limited to:

• registration fees;
• legal fees;
• patent attorney fees;
• proof of concept funding;
• financial and technical advice;
• insurance;
• marketing and travel;
• creation of prototypes;
• taxes;
• bank fees; and
• transaction fees.

originator means a person who creates intellectual property which is subject to this policy, whether alone or jointly with another person.

scholarly work means a work intended for academic publication (e.g. article, book, manuscript or manual regardless of format).

staff or staff member means an employee of the University.

substantial contribution means, in relation to the creation of intellectual property, a contribution of 35% or more.

student means a person admitted to candidature in an award course at the University and, where relevant, an exchange student or non-award student.

teaching materials means anything created in any medium by a staff member in pursuance of their employment (regardless of whether or not this occurs under a specific direction to do so) as an aid or tool for instruction in a course. This includes, but is not limited to:

• lecture notes and materials;
• syllabi;
• handouts;
• study guides;
• course software; and
• assessment materials.
University resources includes, but is not limited to:

- background intellectual property;
- premises;
- facilities;
- funds;
- services;
- equipment;
- paid leave;
- staff time; and
- support staff.

Vice Chancellor’s Innovative Development Fund means an internal University account from which funds may be disbursed at the Vice-Chancellor’s discretion for the purpose of supporting innovation and the development of intellectual property.

Visitor means:

- a person given access to University resources for the purpose of teaching, research or other scholarly activity, who is not a staff member, nor a student, and who is not the subject of an agreement with the University addressing intellectual property rights; or
- a corporation given access to University resources for the purposes of undertaking research or development, whether or not in collaboration with the University.

For the purposes of this policy, a person or corporation continues to be a visitor even if the period of their access to University resources has expired.

7 Intellectual property originated by staff or affiliates

Except as otherwise provided in this policy or in a separate agreement, the University owns all intellectual property originated by staff or affiliates:

(a) in the course of employment by the University;
(b) using University resources;
(c) at the specific request or direction of the University; or
(d) as part of a project or program supported by funding obtained or provided by the University.

In the absence of a specific agreement to the contrary, the originator of teaching materials has a non-exclusive, non-transferable, free licence to use such works for the purpose of their own teaching, education or research at other educational institutions, but may not:

(a) sub-license or assign such materials; or
(b) use them to generate royalties or licence fees.
(3) Except as otherwise provided in this policy or in a separate agreement, the University owns all intellectual property in scholarly works or creative works originated by a staff member or affiliate at the specific request or direction of the University.

(4) In all other cases, the originator of scholarly works or creative works owns all intellectual property rights in them, subject to a non-exclusive, free, irrevocable licence to the University to use such works and to sub-licence other parties to do so.

(5) Any work which may be considered to be both:
   (a) teaching materials and scholarly work; or
   (b) teaching materials and creative work
will be treated as teaching materials for the purposes of this policy.

(6) If a staff member wishes to use intellectual property created by them but owned by the University for the purposes of further academic research or teaching other than through the University, they may apply to the Director, CDIP for a licence to do so.
   (a) The decision on whether or not to grant a licence will be made by the Director, CDIP.
   (b) No licence will be granted if, in the reasonable opinion of the Director, CDIP, it would be incompatible with the best interests of the University to do so.
   (c) Any such licence granted must:
      (i) be granted free of charge;
      (ii) be recorded in writing;
      (iii) be limited to use for academic research or teaching, conducted in educational institutions; and
      (iv) provide no right to sub-license or assign.

(7) If a staff member wishes to use intellectual property which has been registered with CDIP in a proposal or application for external funding the staff member must:
   (a) obtain the approval of the Director, CDIP; and
   (b) if the intellectual property in question has multiple originators, inform all other originators the proposed use
at least 14 days before using the intellectual property in that manner.

(8) Any dispute arising as a result of notification given under clause 7(7)(b) must be referred to the Director, CDIP for resolution.

(9) Any staff member or affiliate who believes the provisions of this policy to be in conflict with any obligation owed by them to any third party must provide full details in an ad hoc declaration of external interests, as required by the External Interests Policy 2010.

8 Intellectual property originated by students

(1) Students own the copyright in their theses and scholarly works in the absence of any specific agreement to the contrary.

(2) Students own all other intellectual property they create, except as provided in this policy.

(3) The University owns intellectual property created by students where:
(a) the student has entered into an agreement with the University which specifies University ownership of intellectual property related to or arising from their activities;
(b) the student’s supervisor or any other staff member has made a substantial contribution to the creation of the intellectual property; or
(c) the intellectual property is created using University background intellectual property.

(4) If:
(a) a student wishes to participate in an activity that has, or may in future, create intellectual property; and
(b) funding for the activity has been provided by a third party under an agreement with the University pursuant to which the third party has, or may claim, rights over intellectual property;

then:
(c) the student may be required, as a condition of participation, to enter into an agreement which:
   (i) assigns the student’s intellectual property to the University; and
   (ii) provides consents in relation to any subsisting moral rights.

(5) Where an agreement of the kind referred to in subclause 8(4) is requested:
(a) the student’s supervisor and the person in charge of the activity must:
   (i) explain to the student that participation is conditional on the agreement;
   (ii) advise the student to obtain independent legal advice; and
   (iii) ensure that the student does not commence the activity in the absence of such an agreement;

and
(b) the student must be given a reasonable time to consider and obtain advice on the proposed agreement.

(6) Where the University owns intellectual property originated by a student:
(a) the student will be entitled to share in the net development proceeds as if they were a staff member;
(b) the University will take all possible steps to ensure that the student is not impeded in submitting a thesis for examination or completing the requirements for any course.

(7) Where a student is required to complete a placement with a third party as part of compulsory course requirements, the relevant Dean must satisfy themselves that the terms of the placement agreement:
(a) provide the student and, as required, University staff and examiners with access, on appropriate terms, to such of the third party's intellectual property as may be necessary to enable them to complete the placement satisfactorily;
(b) will not operate to prevent the student from being able to complete their placement or other course requirements; and
(c) do not grant rights to use University intellectual property other than rights to use such University course or teaching materials as are necessary for completing the placement:
   (i) for the purposes the placement only; and
   (ii) for the term of the placement only.

Note: See the Student Placement Policy 2015.

(8) Intellectual property created in the course of employment by students who are also staff members or affiliates is owned by the University, and clause 7 of this policy applies.

9 Intellectual property originated by visitors

(1) Before commencing any teaching, research or other activity at the University, visitors must enter into an agreement with the University which addresses the ownership of intellectual property and protection of confidential information related to or arising from that activity.

(2) CDIP is responsible for ensuring that such agreements are prepared, executed and recorded.

(3) Staff members responsible for collaboration with, or supervision of, visitors must inform CDIP of the following before the visitor commences any activity.
   (a) If the visitor is a corporation:
      (i) its name;
      (ii) its registered address;
      (iii) its ABN;
      (iv) contact details for the person responsible for the relationship;
      (v) the nature of the activity to be undertaken; and
      (vi) the name, qualifications and contact details of all individuals who will be undertaking the activity.
   (b) If the visitor is an individual:
      (i) their name;
      (ii) their address;
      (iii) their qualifications;
      (iv) the nature of the activity to be undertaken.

10 Intellectual property rights and indigenous peoples

(1) The University recognises and respects indigenous cultural rights.

(2) Before undertaking any commercial development resulting from use of aspects of indigenous spirituality or cultural property the Director, CDIP, in consultation with the Deputy Vice-Chancellor (Indigenous Strategy and Services), must:
   (a) negotiate benefit sharing arrangements with the provider(s) of such material which the provider(s) consider to be appropriate and valuable; and
(b) ensure that such arrangements are documented and recorded.

Note: The University Recordkeeping Policy and Recordkeeping Manual apply. See also Values and Ethics: Guidelines for Ethical Conduct in Aboriginal and Torres Strait Islander Health Research (NHMRC) and National Principles of Intellectual Property Management for Publicly Funded Research (ARC).

11 Notifying the University of intellectual property

(1) Any staff member, affiliate, student or visitor who originates intellectual property which:
   (a) is owned by the University under this policy; and
   (b) they believe may be capable of either or both of protection or commercialisation

must notify each of the following, in their capacity as agent for the University, as soon as possible after its creation:
   (c) their supervisor(s), if they are students;
   (d) the relevant Head of School or Head of Administrative Unit; and
   (e) the Director, CDIP.

(2) Upon receiving such a notification, the Director, CDIP may seek further information or clarification, including details of inventive or creative contributions made by any individual or organisation outside the University.

(3) Where notified intellectual property results from the use of aspects of indigenous spirituality or cultural property, the report must also include a full description of the material used and contact details for relevant individuals and communities.

(4) The originator(s) of notified intellectual property must also provide the Director, CDIP with relevant further information (including new particulars, data, results, findings, commercial interactions and updates) as soon as possible after it becomes available.

(5) Any staff member, visitor or student who owns background intellectual property to which the University has no claim, but which is relevant to their proposed activity at the University, must notify and provide details of it to each of the following as soon as possible after employment, enrolment or engagement:
   (a) the relevant Head of School; and
   (b) the Director, CDIP.

12 Protecting, developing and dealing with intellectual property

(1) CDIP is responsible for protecting, commercialising and dealing with intellectual property at the University.

(2) Unless otherwise provided in an agreement or approved by the Director, CDIP, all applications for registration of intellectual property (whether in Australia or not) will be made in the name of the University.

(3) The Director, CDIP will decide whether or not the University wishes to protect intellectual property notified to it under clause 11 of this policy no later than 13 weeks from the later of:
   (a) the date of original notification; or
(b) the latest date on which further information or clarification requested under subclause 11(2) is received.

(4) The 13 week period referred to in subclause 12(3) may be extended with the consent of the originator(s).

(5) Where intellectual property is jointly owned by the University and another institution, the 13 week time period will not apply. The decision about whether or not the University wishes to participate in protecting the intellectual property, and the extent of any such participation, will be made by the Director, CDIP in consultation with the other owner(s) as soon as is practicable.

(6) Until a decision is made under subclauses 12(3) or 12(5), the originator(s) must take all reasonable steps to protect the reported intellectual property and should consult CDIP on how best to do this.

(7) If the Director, CDIP decides that the University wishes to protect the intellectual property, the originator must provide CDIP with all requested assistance, including but not limited to:
   (a) providing on request information relevant to the protection or commercialisation of the intellectual property; and
   (b) executing any agreements or other documents necessary for commercialisation.

(8) Subject to subclause 12(9), if the Director, CDIP decides that the University does not wish to protect or, in the case of copyright material, commercialise the intellectual property, or fails to make a decision within the required time, the University will assign the intellectual property back to the originator(s), who may protect and develop it as they see fit, provided that:
   (a) such protection and development will be at their own expense;
   (b) the University will have a first right to recover any past or continuing costs incurred by the University in relation to the origination or development of the intellectual property out of any gross development proceeds received by or on behalf of the originators; and
   (c) the University will be entitled to 10% of the net development proceeds.

(9) Where the University protects intellectual property, the Director, CDIP must review the merits of continuing protection at least annually, and may decide to discontinue it.
   (a) If the Director, CDIP decides to discontinue protection, the University will, at least 90 days before the next renewal date, offer to assign the intellectual property back to the originator(s).
   (b) An originator who receives an offer of re-assignment must accept it within 20 days of receipt.
   (c) Once intellectual property is reassigned, the originator(s) will be responsible for its protection.

(10) The Director, CDIP may decline to assign intellectual property back to its originator(s) if, in the reasonable opinion of the Director, CDIP, to do so would breach any contractual or other obligations of the University.

(11) If the University agrees with a third party to develop intellectual property jointly owned by that third party, the University will charge an appropriate development fee, which will be deducted from each payment received at the time of receipt.

(12) If a staff member wants the University to develop intellectual property which the University does not own and in which the staff member has a material interest, the
staff member must submit a proposal to the Director, CDIP and provide any further information or clarification that may be requested.

(13) If the Director, CDIP decides that the University should proceed with a proposal made under subclause 12(12) the staff member must:

(a) assign ownership of the intellectual property to the University; or

(b) enter into an agreement with the University and all other interested parties which specifies the terms on which the development is to be undertaken and appropriately manages any inherent conflicts of interests.

Note: See also subclause 13(4).

(14) Except as provided in subclauses 12(12) and 12(13), the University will not protect or develop intellectual property of which it has no ownership.

13 Distributing the proceeds of intellectual property development

(1) Unless otherwise provided in this policy or in any agreement, the net development proceeds from intellectual property owned by, or developed by, the University will be distributed as follows:

(a) the first $250,000 to the originator(s);

and then

(b) one third to the originator(s);

(c) one third to the relevant faculty or business unit;

(d) one third to the Vice-Chancellor’s Innovative Development Fund.

(2) Distributions payable to originator(s) by the University may be set off against debts owed by or on behalf of the originators in relation to the intellectual property, including development costs.

(3) Any agreement which requires the distribution of net development proceeds in a manner inconsistent with the requirements of this policy must be approved in advance by the Deputy Vice-Chancellor (Research).

(4) Where there is more than one originator, all originators must enter into an agreement, in a form approved by CDIP, which specifies the proportions in which the net development proceeds distributable to originators are to be distributed among them, provided that:

(a) CDIP will not distribute any proceeds to originators in the absence of such an agreement;

(b) such an agreement should be entered into as soon as possible after a decision is made to develop the intellectual property; and

(c) if no agreement is entered into within one year of the decision to proceed with development, the Director, CDIP, in consultation with the Deputy Vice-Chancellor (Research), will determine the proportions in which the originators’ share of the proceeds will be distributed.

(5) Where the University develops intellectual property as a result of accepting a proposal under subclause 12(12), the University will distribute the net development proceeds as follows:

(a) one half to the originator(s);

(b) one third to the relevant faculty (or faculties);
the remainder to the Vice-Chancellor’s Innovative Development Fund.

(6) Where the University develops teaching materials, the net development proceeds will be distributed to the relevant faculty (or faculties).

(7) Where the commercial return on development of intellectual property is not in cash, the non-cash asset will be held in the name of the University until it is sold or converted into cash, at which time the proceeds will be distributed consistently with subclause 13(1).

14 On-going obligations of originators

(1) Originators must ensure that appropriate records and documentation relevant to the intellectual property are created and adequately maintained.

Note: The following apply: University Recordkeeping Policy; Recordkeeping Manual; Research Code of Conduct; Research Data Management Policy.

(2) If required by the Director, CDIP, an originator of intellectual property which is being developed must execute any document or do anything reasonably necessary to demonstrate or prove ownership, secure intellectual property protection or assist the University to develop the intellectual property.

(3) If an originator fails to execute any document or take any other step required by the Director, CDIP under subclause 14(3), the Vice-Chancellor has the right to complete any documentation or take any step as the originator’s attorney.

(a) The Vice-Chancellor may exercise this power of attorney even if the University benefits from its exercise.

(b) This power of attorney does not extend to instances where the failure to complete documentation or take specific steps is a result of conflicts about ownership of the intellectual property or where there is a dispute between the University and the originator. In these instances, the provisions of Clause 17 will apply.

(4) Originators who propose to leave the University or who are no longer subject to the terms of an agreement with the University in relation to intellectual property, must ensure that all records and documents relevant to University owned intellectual property are provided to CDIP as soon as is practicable, and consistently with any direction from the Director, CDIP.

(5) Originators of University owned intellectual property must not:

(a) use or disclose intellectual property owned by the University in any manner which would:

(i) prejudice its protection, enforcement, commercialisation or other development; or

(ii) contravene any legislative requirement;

or

(b) apply for any form of protection for, commercialise or otherwise deal with the intellectual property in any manner inconsistent with the University’s rights.
15  Moral rights and acknowledgement of originators

(1) Where the University owns intellectual property (other than copyright) it will take all reasonable steps to ensure that the originator is acknowledged in any relevant documentation.

(2) In the case of copyright material owned by the University, the University will use its best endeavours to:

(a) ensure that the originator is acknowledged;
(b) consult with the originator before modifying or adapting, or authorising modification or adaptation, of the work;
(c) consult with and obtain the agreement of the originator and adaptor as to the attribution provided in any adaptation or modification;
(d) after consultation with the originator, ensure that acknowledgement of the author or performer is a term of any assignment or licence of the material; and
(e) ensure that any wish on the part of the originator not to be acknowledged is respected.

16  Trade marks and business names

(1) CDIP is responsible for administering all trade marks and business names relating to University activities. All such trade mark or business name applications must be made by CDIP, in the University’s name.

(2) Any business unit or staff member who wishes to obtain a trade mark or business name for a University product or activity must submit a request in writing to the Director, CDIP and provide the following details:

(a) a full description of the proposed mark or name, including an image where appropriate; and
(b) a full description of the proposed use of the trade mark or business name.

(3) The Director, CDIP will consult the Director, Marketing and Communications and any other relevant stakeholder before approving a request.

(4) In addition, any use of the University’s name, logo or coat of arms must be approved by the relevant delegate before any application is made.

Note: See University of Sydney (Delegations of Authority – Administrative Functions) Rule 2010 (as amended).

(5) If the Director, CDIP approves a request, CDIP will:

(a) inform the requester of the approval;
(b) prepare and lodge the application;
(c) record the outcome of the application;
(d) inform:
   (i) the requester;
   (ii) the University’s Marketing and Communications unit; and
   (iii) the Group Secretary
   of the outcome.
(6) CDIP will establish and maintain a register of University trade marks and business names.

(7) The costs of obtaining a trade mark or business name obtained as part of the development of other intellectual property will be attributed to the development of that intellectual property.

(8) The costs of obtaining any other trade mark or business name will be charged to the requester’s faculty or business unit.

(9) The proceeds of development or commercialisation of any trade mark or business name will be distributed:
   (a) where associated with the development of intellectual property, in accordance with this policy;
   (b) otherwise, to the relevant faculty or business unit.

17 Dispute resolution

(1) This clause does not apply to disputes:
   (a) normally dealt with under the Research Code of Conduct 2013; or
   (b) involving agreements with third parties, unless all parties to the agreement agree to be bound by the dispute resolution provisions of this policy.

(2) An originator who has concerns about the manner in which this policy is interpreted or applied must notify and provide all relevant details to:
   (a) any other originator; and
   (b) the Director, CDIP.

(3) After notification of a dispute, the University may retain an appropriate adviser to better inform itself about the dispute and its subject matter.

(4) Where an adviser is appointed under sub-clause 17(3):
   (a) University staff and affiliates must co-operate with the adviser, and provide relevant information or assistance on request; and
   (b) Any advice provided by the adviser will be the property of the University alone and, except where statutorily required to do so, the University is not obliged to:
       (i) follow the advice;
       (ii) provide copies of the advice (including any report or written opinion) to any party to the dispute; or
       (iii) disclose the substance of the advice to any party to the dispute.

(5) The Director, CDIP will attempt to resolve the dispute through alternative dispute resolution, including but not limited to mediation. The form of alternative dispute resolution process to be adopted will be determined by the Director, CDIP.

(6) If the matter remains unresolved after mediation has been attempted and for more than 13 weeks from the date of notification to the Director, CDIP, the Director, CDIP will refer the matter to the Deputy Vice-Chancellor (Research).

(7) The Deputy Vice-Chancellor (Research) will appoint an appropriate independent expert to determine the matter. The expert will act as an expert and not as an arbitrator, and the expert’s determination will be final and binding as between the parties.
18 Rescissions and replacements

This policy replaces the University of Sydney (Intellectual Property) Rule 2002 (as amended) which was rescinded by Senate as from 2 May 2016

NOTES

Intellectual Property Policy 2016

Date adopted: 10 May 2016
Date commenced: 10 May 2016
Administrator: Director, Commercial Development and Industry Partnerships
Review date: 10 May 2021
Related documents:

Circuit Layouts Act 1989 (Cth)
Copyright Act 1968 (Cth)
Designs Act 2003 (Cth)
Patents Act 1990 (Cth)
Plant Breeders’ Rights Act 1994 (Cth)
Trade Marks Act 1995 (Cth)

Australian Code for the Responsible Conduct of Research (National Health & Medical Research Council)

National Principles of Intellectual Property Management for Publicly Funded Research (Australian Research Council)

Values and Ethics: Guidance for Ethical Conduct in Aboriginal and Torres Strait Islander Health Research (National Health & Medical Research Council)

University of Sydney (Delegations of Authority – Administrative Functions) Rule 2010 (as amended)

University of Sydney (Higher Degree by Research) Rule 2011

Affiliates Policy

Code of Conduct – Staff and Affiliates

Code of Conduct for Students
External Interests Policy 2010
Outside Earnings of Academic Staff Policy 2011
Policy on the Use of University Information and Communication Technology Resources (ICT Resources)
Research Agreements Policy
Research Code of Conduct 2013
Research Data Management Policy
Supervision of Higher Degree by Research Students Policy 2013
University Recordkeeping Policy

Recordkeeping Manual

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**AMENDMENT HISTORY**

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