



Research and Innovation Division

IP FELLOW, VOLUNTEER AND VISITING STUDENT ASSIGNMENT OF INTELLECTUAL PROPERTY GUIDELINES

Date approved:	6 July 2007	Date Guidelines will take effect:	6 July 2007	Date of Next Review:	July 2010
Approved by:	University Council				
Custodian title & e-mail address:	Director, Research Student Centre research_student_centre@uow.edu.au				
Author:	Dr Troy Coyle				
Responsible Faculty/ Division & Unit:	Innovation and Commercial Research, Research and Innovation Division				
Supporting documents, procedures & forms of these guidelines:	IP Fellow, Volunteer and Visiting Student Assignment of Intellectual Property Policy IP Intellectual Property Guidelines IP Commercialisation Revenue Policy Guidelines IP Student Assignment of IP Policy Guidelines Appointment of Fellows				
References & Legislation:	IP Intellectual Property Policy IP Commercialisation Revenue Policy IP Student Assignment of IP Policy				
Audience:	Public – accessible to anyone				
Expiry Date of Guidelines:	Not Applicable				



Contents

1	Introduction / Background	3
2	Scope / Purpose	3
3	Definitions	3
4	Interactions with Fellows, Volunteers and Visiting Students	3
5	Effect of Fellow, Volunteer or Visiting Student Ownership of Intellectual Property	6
6	Assignment of Intellectual Property by Fellows, Volunteers or Visiting Students and Their Employers/Home Institutions	8
7	Requirements for A Fellow, Volunteer or Visiting Student Deed of Assignment	9
8	Fellow (and/or Their Employer), Volunteer and Visiting Student Free to Choose not to Assign IP	12
9	Determination Whether a Fellow, Volunteer or Visiting Student is in Category 1, 2 or 3 Project	13
10	Roles & Responsibilities	13
11	Version Control Table	13



1 Introduction / Background

1. These guidelines explain the background and purpose of the provisions in UOW's Fellow, Volunteer and Visiting Student Assignment of Intellectual Property Policy.
2. All statements made in relation to a Fellow's employer in these Explanatory Guidelines, should be read to also apply to third parties with rights to IP developed by a Fellow, Volunteer or Visiting Student.

2 Scope / Purpose

Not Available

3 Definitions

1. These guidelines use the same definitions of terms provided in the Fellow, Volunteer and Visiting Student Assignment of Intellectual Property Policy and should be read in conjunction with that Policy.

4 Interactions with Fellows, Volunteers and Visiting Students

Introduction

1. UOW welcomes the collaborative opportunities provided by the appointment of Fellows and hosting of Volunteers and Visiting Students. However, UOW also recognises that certain intellectual property (IP) ownership issues may arise as a result of such interactions.
2. Salaried Fellows are UOW Staff Members and are covered by the UOW Intellectual Property Policy.

Categories of Fellow, Volunteer and Visiting Student Participation

3. Three different categories of cases need to be considered in the context of Fellows, Volunteers or Visiting Students participating in research/teaching and IP ownership:
4. Category 1 - where the Fellow, Volunteer or Visiting Student is involved in a project that:
 - a. is not subject to contractual obligations upon UOW, and/or
 - b. is not likely to lead to IP with commercial potential, and/or
 - c. is not reliant upon pre-existing IP owned or licensed by UOW where UOW would want to maintain ownership of any improvements made to the pre-existing IP, and/or
 - d. may have commercial potential but UOW has no Commercialisation Expectation (e.g. a creative work written or crafted solely by a Visiting Student as part of their course), and/or
 - e. will not lead to the development of material that is used in a UOW course, subject, program or degree.
5. Category 2 - where the Fellow, Volunteer or Visiting Student is involved in a project that:
 - a. is subject to contractual obligations upon UOW, and/or
 - b. has a Commercialisation Expectation, and/or
 - c. is reliant upon pre-existing IP owned or licensed by UOW and UOW wishes to maintain ownership of any improvements to its pre-existing IP, and/or
 - d. will develop Administration Material.



6. Category 3 - where the Fellow, Volunteer or Visiting Student is involved in a project that will lead to the development of Teaching Materials.
7. The implications in these three cases are different, as discussed below.

Category 1: there are no contractual obligations, nor Commercialisation Expectations, nor reliance upon pre-existing IP owned or licensed by UOW.

8. In this case if a Fellow, Volunteer or Visiting Student creates or contributes to creating IP either the Fellow (and/or their employer), Volunteer or Visiting Student will, as discussed below, either:
 - a. solely own the IP; or
 - b. the IP will be owned jointly by the Fellow (and/or their employer), Volunteer or Visiting Student and UOW.
9. Sole ownership (or joint ownership between the Fellow and their employer) will normally be the case where the Fellow, Volunteer or Visiting Student works independently to UOW Staff Members on a project unconnected to any research at UOW (e.g. where the Fellow, Volunteer or Visiting Student is merely using UOW equipment or facilities). In such situations, UOW will not require an IP Assignment.
10. Alternatively, joint ownership may arise because:
 - a. the Fellow, Volunteer or Visiting Student is a member of a research team including UOW Staff Members; or
 - b. the research undertaken by the Fellow, Volunteer or Visiting Student is supervised by a Staff Member, and inventive contributions, to some extent, are made by the supervisor (or other Staff Members); or
 - c. the project that the Fellow, Volunteer or Visiting Student is working on has been funded by UOW or has received funding obtained by UOW; or
 - d. the Fellow, Volunteer or Visiting Student has made significant use of UOW resources (including access to UOW staff) to develop the IP.
11. The fragmentation of ownership of IP jointly in this way impedes UOW's Commercialisation of the IP generated, for the reasons described below (in clauses 5.4 – 5.8). However, since there are no contractual obligations in relation to that project, and there are no Commercialisation Expectations, the Fellow, Volunteer or Visiting Student may participate in the project without being required to assign their share of the IP to UOW.

Category 2: there are contractual obligations or Commercialisation Expectations, or reliance upon pre-existing IP licensed or owned by UOW, or Administration Material will be developed.

12. In this case, UOW:
 - a. has contractual obligations in relation to the project; and/or
 - b. has Commercialisation Expectations in relation to the project; and/or
 - c. needs to maintain ownership of any improvements to pre-existing IP; and/or
 - d. needs to own the project outcome because Administration Material is important to UOW's administration.
13. Accordingly, there is a need to ensure that the relationship with the Fellow (and/or their employer), Volunteer or Visiting Student is such that the Commercialisation Expectation can be achieved, and that the contractual and commercial obligations can be discharged, and UOW is able to protect and own any improvements to its own IP or IP that is important to it.



14. UOW may enter into a contract that grants a licence to exploit the IP to a third party (e.g. industry partner, client or other research institution). In this case, UOW will have contractual obligations to that third party. Those contractual obligations are likely to relate to:
 - a. obligations of confidentiality by members of the research team; or
 - b. the third party having access to the IP that is generated by the research team.
15. Given those contractual obligations upon UOW, the participation of Fellows, Volunteers or Visiting Students in the project needs to be carefully managed. It is essential, for the reasons described below, that a Deed of Assignment be entered into where the Fellow (and/or their employer), Volunteer or Visiting Student assigns IP to UOW.
16. Alternatively, a Fellow (and/or their employer), Volunteer or Visiting Student may choose not to assign IP to UOW. If this happens:
 - a. the Fellow, Volunteer or Visiting Student, in conjunction with their supervisor, will attempt to develop an alternative project that does not have a Commercialisation Expectation and is not subject to contractual obligations to third parties and is not reliant upon pre-existing IP owned or licensed by UOW (where UOW requires ownership of improvements to the pre-existing IP) and will not develop Administration Material; and
 - b. the Fellow, Volunteer or Visiting Student will be excluded from the project that has a Commercialisation Expectation or which is subject to contractual obligations or is reliant upon pre-existing IP owned or licensed by UOW or will develop Administration Material.

Category 3: Teaching Material will be developed

17. In such cases, UOW will need to obtain a licence from the Fellow (and/or their employer) Volunteer or Visiting Student to be able to use this IP. It is important that UOW obtains this right so that it is not breaching third party IP but also in order to maintain continuity of resources and course structures over time. Therefore, UOW will require a perpetual non-exclusive licence from the Fellow (and/or their employer), Volunteer or Visiting Student to use such IP in order to maintain the stability of its degrees and courses.
18. UOW will continue to consider the reputation of the Creators in its use of Teaching Material. For example, by removing out-of-date information, attributed to the author, from course notes.

Category 1 evolves into category 2 or category 3

19. It may be that a project is initially identified as being in Category 1. However, the project may evolve into a Category 2 or 3 project.
20. In this case, because the project commenced as a Category 1 project, no assignment or licence of the IP by the Fellow (and/or their employer), Volunteer or Visiting Student took place at the outset. However, if the project evolves so that:
 - a. contractual obligations are to be created, or
 - b. Commercialisation Expectations arise, or
 - c. the project does require access to pre-existing IP owned or licensed by UOW and UOW wishes to maintain ownership of any improvements to that IP, or
 - d. Teaching Material or Administration Material is developed,
21. As soon as that is identified to be the case, the Fellow (and/or their employer), Volunteer or Visiting Student will be asked to assign/licence their IP.



22. It will be the responsibility of the Fellow, Volunteer or Visiting Student and their supervisor/host to notify the relevant Faculty Manager of Innovation and Commercialisation (MIC) that a change in circumstances as described above is to occur or has occurred. The MIC will then prepare and negotiate the relevant agreement with the Fellow, Volunteer or Visiting Student and, where relevant, any third parties. In the case of contractual obligations being created, supervisors should inform the MIC that it is intended that a Fellow, Volunteer or Visiting Student will be working on the project. Supervisors/hosts should ensure that Fellows, Volunteers or Visiting Students do not access third party IP (including confidential information) or confidential information of UOW until/unless the MIC has negotiated an IP Assignment Deed and/or Confidentiality Agreement with the Fellow, Volunteer or Visiting Student and it has been signed by both UOW and the Fellow (and/or their employer), Volunteer or Visiting Student.
23. A Fellow (and/or their employer), Volunteer or Visiting Student may choose not to assign their IP to UOW or not to sign a confidentiality agreement. However, where that choice is made, for the reasons described below (in section 3):
 - a. this may preclude contractual obligations being created, and this may prevent contract funding of the project, or
 - b. this may preclude Commercialisation, and this also is not in the interests of the project, the Fellow, Volunteer or Visiting Student, or UOW, or
 - c. UOW may not be able to grant the Fellow, Volunteer or Visiting Student access to pre-existing IP.

5 Effect of Fellow, Volunteer or Visiting Student Ownership of Intellectual Property

Fellows, Volunteers and Visiting Students are not employees of UOW

1. The law is that an employer is usually the owner of the IP created by its employees in the course of their employment. However, a Fellow, Volunteer or Visiting Student is not an employee of UOW. This means that when a Fellow, Volunteer or Visiting Student generates IP while at UOW, or contributes to IP while at UOW, that Fellow (and/or their employer- see paragraph below), Volunteer or Visiting Student will either solely own that IP, or will jointly own it with UOW.
2. Where the Fellow is employed by a third party at the time that the relevant IP is created, it is likely that their employer will have some rights to the IP. In such cases, UOW will also ask the Fellow's employer to assign or licence its rights to UOW.
3. Visiting Students and Volunteers will normally have the sole rights to the IP that they develop. However, this may not be the case if they have entered into some other arrangement with their Home Institution (or another party) or if their Home Institution's IP Policy provides otherwise. Where the Visiting Student's Home Institution or a third party has rights to the IP that the Visiting Student or Volunteer develops, UOW will also ask the Visiting Student's Home Institution or the third party to assign or licence its rights to UOW.

Effect upon Commercialisation

4. To successfully Commercialise research outcomes, UOW needs to have ownership of IP. This is also necessary to enable UOW to deal with potential licensees, venture capitalists, and joint venturers.
5. For example, a Fellow, Volunteer or Visiting Student might solely own a software program, and that software program may be a component of a device that UOW seeks to Commercialise. Because of the Fellow's/Volunteer's/Visiting Student's sole ownership of that software program, Commercialisation by UOW of that device is impeded as UOW would not be able to license or sell the device without the software program.



6. When an invention is made jointly by a Fellow, Volunteer or Visiting Student and a UOW Staff Member, ownership will be joint, as between the Fellow (and/or their employer), Volunteer or Visiting Student and UOW. For example:
 - a. where there is a jointly owned patent, UOW cannot license or assign the patent without the prior written consent of the Fellow (and/or their employer), Volunteer or Visiting Student (section 16 of the Patents Act 1990 (Commonwealth));
 - b. where there is jointly owned copyright, such as a computer program, the rights of the copyright owners must be exercised jointly, and this prevents UOW from proceeding to Commercialise; and
 - c. where there is a patent application (which at this stage is only confidential information), equitable duties upon the Creators of that confidential information prevent UOW from proceeding to Commercialise.
7. A Fellow (and/or their employer), Volunteers or Visiting Student with an ownership interest in IP could therefore:
 - a. veto Commercialisation; or
 - b. veto the terms of Commercialisation; or
 - c. seek to participate in Commercialisation negotiations as an independent party.
8. Thus, fragmentation of ownership of IP, and its impact upon the Commercialisation process may hinder and impede the Commercialisation process.

Ownership proportions

9. Where IP is jointly owned by Fellows (and/or their employer), Volunteers or Visiting Students and UOW, that ownership is usually in equal shares. There is no legislation which determines the fractional ownership of IP when it is jointly owned. The Patent Commissioner has in many cases repeatedly declined, in the case of patents, to determine ownership proportions between joint owners. The Patent Commissioner has also repeatedly held that where a patent is jointly owned, it is owned by all the owners in equal proportions, if they cannot otherwise agree. This can have inequitable consequences upon the owners.
10. For example, suppose:
 - a. there is a research team made up of 6 people;
 - b. one is a Fellow or Volunteer (A) who makes a 5% inventive contribution;
 - c. another is a Visiting Student (B) who makes a 10% inventive contribution; and
 - d. the remaining four are staff who between them make an 85% inventive contribution.
11. The result is the following comparative ownership proportions and inventive contributions:

Owner	Inventive Contribution	Ownership Proportion
A	5%	33.3%
B	10%	33.3%
UOW	85%	33.3%

12. The result therefore is that while UOW made an 85% inventive contribution, it owns only one third of the IP. This result is inequitable upon UOW and hence UOW would seek to obtain the Creators' agreement on more equitable ownership arrangements.



Working with industry and investors

13. When a Fellow (and/or their employer), Volunteer or Visiting Student solely owns a component of IP or there is joint ownership between UOW and a Fellow (and/or their employer), Volunteer or Visiting Student, this also impedes UOW's ability to enter into agreements with potential licensees, collaborators, and investors such as venture capitalists.
14. A potential licensee or collaborator will not expend considerable financial resources unless there is a clear, unencumbered and unfragmented title to IP. A venture capitalist in particular, when considering making a venture capital investment in a start up company, will invariably undertake a very rigorous due diligence on IP ownership. Most well informed licensees will also undertake a due diligence on ownership of IP in the course of considering the licensing opportunity.
15. If UOW does not solely own all IP, such as where it is partly owned by Fellows, Volunteers or Visiting Students, this will result in due diligence raising defects in title. This causes delay in a proposed transaction and can create unnecessary confusion. Due diligence defects such as fragmented ownership may cause a potential licensee, collaborator, or investor to be disinclined to proceed. The prospect of a licensee or investor having to negotiate with a Fellow, Volunteer or Visiting Student may also cause a potential licensee, collaborator, or investor to be disinclined to proceed.

Exposure to legal liabilities

16. A licence or assignment invariably contains warranties, or promises, that UOW owns the IP that is being licensed or assigned.
17. Consider the case where the IP is in fact owned wholly by another person, or partly owned by UOW and partly by another person. UOW has no title, or does not have the whole of the title, and therefore has no capacity to license or assign at all. If UOW does license or assign this IP to someone else and warrants that UOW owns the IP, this could lead to a breach of those warranties or promises regarding IP ownership. UOW can therefore have an exposure to legal liabilities if it does not wholly own the IP that is the subject of contractual obligations.

Conclusion

18. To remove the above barriers to Commercialisation, UOW prefers to own the whole of the IP generated at UOW on an unencumbered and unfragmented basis, where it has a Commercialisation Expectation. In order for UOW to achieve unfragmented ownership, Fellows (and/or their employer), Volunteers or Visiting Students will be asked to assign to UOW their interest in IP that they develop at UOW. This is achieved by a Deed of Assignment.

6 Assignment of Intellectual Property by Fellows, Volunteers or Visiting Students and Their Employers/Home Institutions

What is a Deed of Assignment

1. A Deed of Assignment is a document by which IP is assigned, or transferred, from one person to another. A Deed of Assignment prevents the fragmentation of ownership of IP, and this in turn avoids the impediments to Commercialisation described above. The effect of a Deed of Assignment signed by a Fellow, Volunteer or Visiting Student in favour of UOW is that UOW will own the whole of the IP in a project.

Staff Deed of Assignment

2. While a Deed of Assignment signed by an employee to an employer is a very straightforward document, this is not the case in relation to Fellows, Volunteer or Visiting Students.



3. A staff Deed of Assignment is straightforward because the Deed of Assignment does nothing other than record in writing what the law is anyway, namely that an employer owns the IP created by its employees in the course of their employment. A staff Deed of Assignment therefore does not transfer or convey title and ownership to IP, since as a matter of law, the employer already owns the IP. A staff Deed of Assignment only records what the legal effect of the employee/employer relationship is.

Fellow, Volunteer or Visiting Student Deed of Assignment

4. Unlike a staff Deed of Assignment, a Fellow, Volunteer or Visiting Student Deed of Assignment does transfer or convey title and ownership in IP to UOW. It is a contract, as well as being a document of transfer of title in IP.

The law of unconscionable transactions

5. Because a Deed of Assignment signed by a Fellow (and/or their employer), Volunteer or Visiting Student actually transfers title in IP, the effect of the law in relation to unconscionable transactions needs to be considered. Section 51AB of the Trade Practices Act 1974 provides, in part-
 - 5.1. A corporation shall not, in trade or commerce, in connection with the supply or possible supply of goods or services to a person, engage in conduct that is, in all the circumstances, unconscionable.
 - 5.2. Without in any way limiting the matters to which the Court may have regard for the purpose of determining whether a corporation has contravened subsection (1)... the Court may have regard to the relative strengths of the bargaining positions of the corporation and the consumer.
6. There are also common law principles in relation to duress and undue influence which operate in a similar way to the law of unconscionable transactions. If a court holds that there is an unconscionable transaction, the Court can declare the document void, meaning that the document has no legal effect.

Copyright in a thesis and publication

7. Where a Visiting Student assigns IP to UOW, a Deed of Assignment must provide for the Visiting Student to retain copyright in a thesis or university assessment task (e.g. a report or essay). Where a Fellow, Volunteer or Visiting Student assigns IP to UOW, UOW will provide for the Visiting Student, Volunteer or Fellow to retain copyright in any publications unless UOW wishes to commercialise or publish the proposed publication. This is necessary, as publishers of academic papers may require an assignment or license to them of the copyright in the paper. The Visiting Student, Volunteer or Fellow therefore needs to retain copyright to have the capacity to assign copyright to such a publisher.
8. UOW may need to reproduce parts of a thesis or paper in, for example, a patent application. A Deed of Assignment can therefore provide for the Visiting Student, Volunteer or Fellow to grant to UOW a copyright licence for this purpose.

7 Requirements for A Fellow, Volunteer or Visiting Student Deed of Assignment

Reducing the risk of unconscionability

1. A Deed of Assignment can be prepared for signing by a Fellow, Volunteer or Visiting Student in a way that reduces the risk of it being declared void. To reduce this risk, it is important that:
 - a. the terms of the Deed of Assignment are commercial and equitable;



- b. the Fellow, Volunteer or Visiting Student must be free to decline to sign a Deed of assignment (see sections 4.12 - 4.16 and 4.17 – 4.18, and section 8); and
- c. the Fellow, Volunteer or Visiting Student has the opportunity to obtain independent legal advice in relation to the Deed of Assignment.

Equitable financial terms

2. If a Deed of Assignment is not upon equitable terms it risks being declared void. The most important aspect of making a Deed of Assignment upon equitable terms is that a Fellow, Volunteer or Visiting Student be equitably compensated for the assignment of the IP. This is achieved by the Fellow, Volunteer or Visiting Student sharing in Commercialisation Revenues from the Commercialisation of IP, in the same way that UOW's Staff Members or Students share in that Commercialisation revenue.
3. All Australian universities have a commercialisation revenue sharing policy which, broadly, confers upon the creators of IP, who are usually staff, an expectation of receiving a share of Commercialisation revenue from the successful Commercialisation of the IP that they generate. Some Cooperative Research Centres also have these policies. Research institutes generally have such policies, as does UOW.
4. If Fellows, Volunteers or Visiting Students are made beneficiaries of this policy, along with all other inventors, they are compensated for their assignment of their IP, and therefore those terms can be regarded as equitable terms.

Confidentiality

5. While at UOW, Fellows, Volunteers or Visiting Students will become aware of commercially valuable information. UOW's employees are already subject to obligations of confidentiality as part of their general employment obligations.
6. As Fellows, Volunteers and Visiting Students are not employees, employment obligations of confidentiality do not apply. However, confidentiality must be maintained by Fellows, Volunteers and Visiting Students to ensure that:
 - a. legal liabilities are not imposed upon UOW if a Fellow, Volunteer or Visiting Student discloses commercially valuable information, and
 - b. the patenting of new inventions is not prejudiced by confidential information prematurely entering the public domain.
7. Accordingly, where Fellows, Volunteers or Visiting Students are to access confidential information, UOW will ask them to sign a confidentiality agreement or will include a confidentiality clause in the IP Assignment Deed or licence.

Publications by Fellows, Volunteers and Visiting Students

8. UOW encourages Fellows, Volunteers and Visiting Students to publish as, by association, this enhances the academic standing of UOW. UOW supports open access to research outputs via its institutional repository, "Research Online".
9. UOW would not prevent a Fellow, Volunteer or Visiting Student from publishing because of IP protection or Commercialisation issues. Rather, UOW may change the timing of publication, and the contents of a publication, to ensure that the publication objective is achieved as well as the Commercialisation objective, without either hindering the other.
10. Further, prior to publication, UOW may lodge patent applications to protect something that may be included in a publication or UOW may obtain advice from a patent attorney in relation to the contents of a publication.



Obtaining independent legal advice

11. Due to the effect of a Deed of Assignment entered into by a Fellow, Volunteer or Visiting Student, it is important that the Fellow, Volunteer or Visiting Student has the benefit of independent legal advice. In the absence of the opportunity to obtain independent legal advice, a Deed of Assignment, if signed by a Fellow, Volunteer or Visiting Student may be defective, and could be declared void. If that occurs, this could have adverse consequences upon UOW.
12. UOW may, for example, license IP that a Fellow, Volunteer or Visiting Student developed on the basis that it has clear title to that IP. If a Deed of Assignment provided by a Fellow, Volunteer or Visiting Student is subsequently set aside as void by a Court, UOW no longer has that clear title, and will be in breach of its express or implied warranties that it gave to a client or industry partner that it did have title. This could expose UOW to legal liabilities. A Deed of Assignment signed by a Fellow, Volunteer or Visiting Student who has not had the opportunity to be advised by an independent legal adviser therefore exposes UOW to risks and legal liabilities.

Where should Fellows, Volunteers and Visiting Students seek independent legal advice?

13. UOW cannot direct Fellows, Volunteers or Visiting Students to any particular legal adviser. This might affect the legal adviser's independence, or the perception of the legal adviser's independence, with the possible consequence, again, that the Deed of Assignment is set aside and declared void. The Fellow, Volunteer or Visiting Student must choose their own legal adviser.

Is independent legal advice necessary where there is income sharing?

14. Consider the following example:
 - a. a Fellow, Volunteer or Visiting Student makes a 20% contribution to an invention;
 - b. UOW staff make the remaining 80% contribution;
 - c. if the assignment by the Fellow, Volunteer or Visiting Student is set aside and declared void, that Fellow, Volunteer or Visiting Student will be an equal joint owner who is entitled to 50% of commercialisation revenues;
 - d. if the Fellow, Volunteer or Visiting Student assigns their share of the IP, the Fellow, Volunteer or Visiting Student will be entitled to a share of commercialisation income in accordance with UOW's policies. This might be an entitlement to share in the Creator's 50% of nett commercialisation revenues;
 - e. if the assignment by the Fellow, Volunteer or Visiting Student is valid, the Fellow, Volunteer or Visiting Student is entitled to 20% of this one half— approximately 10%; and
 - f. if the assignment by the Fellow, Volunteer or Visiting student is void, the Fellow, Volunteer or Visiting Student is entitled to 50%.
15. Clearly, in this scenario, it would be inequitable upon UOW, and inequitable upon UOW's staff, for the Fellow, Volunteer or Visiting Student to receive a disproportionately high share of revenue and in such a case UOW would be unlikely to take on the considerable financial and organisational responsibility of Commercialisation. Such a scenario makes it essential that there is confidence that the Deed of Assignment is unlikely to be set aside. The opportunity to obtain independent legal advice is the critical element that provides that confidence.

Summary



16. The table below summarises the relevant Assignment, licensing and confidentiality requirements for each category of Fellow, Volunteer or Visiting Student, as well as the requirements for independent legal advice.

Category of Fellow, Volunteer or Visiting Student	Required Documents	Independent Legal Advice Required?
Fellow is an employee of some other Institution or some other organisation and IP is developed in the course of their employment.	Deed of Assignment or licence (e.g. in case of teaching Material) from their employer to UOW. Confidentiality agreement between Fellow and UOW.	No
Fellow is an employee of some other Institution or some other organisation and IP is not developed in the course of their employment.	Deed of Assignment or licence (e.g. in case of Teaching Material) from the Fellow to UOW that incorporates confidentiality requirements.	Yes
Visiting Student or Volunteer has signed a Deed of Assignment with their Home Institution or some other third party.	Deed of Assignment from the Home Institution/third party to UOW. Confidentiality agreement between UOW and the Visiting Student.	No
<i>Visiting student or Volunteer has not signed a Deed of Assignment with their Home Institution or some other third party.</i>	<i>Deed of Assignment from the Visiting Student to UOW that incorporates confidentiality requirements.</i>	Yes

8 Fellow (and/or Their Employer), Volunteer and Visiting Student Free to Choose not to Assign IP

1. For the reasons described in these Guidelines, UOW must adopt a policy that requires, in instances where Fellows, Volunteers or Visiting Students seek to participate in Category 2 projects, that:
 - a. the Fellow (and/or their employer), Volunteer or Visiting Student must be asked to assign their IP to UOW; and
 - b. prior to assignment, the Fellow, Volunteer or Visiting Student must have had the opportunity be advised by an independent legal adviser.
2. Similarly, where Fellows, Volunteers or Visiting Students seeks to participate in a Category 3 project, UOW must adopt a policy that requires that:
 - a. the Fellow (and/or their employer), Volunteer or Visiting Student must be asked to provide a perpetual non-exclusive licence to UOW to use and disseminate that IP in the delivery of UOW courses and degrees; and
 - b. prior to licensing, the Fellow, Volunteer or Visiting Student must have had the opportunity to be advised by an independent legal adviser.



3. UOW cannot require that the Fellow (and/or their employer), Volunteer or Visiting Student assign or licence their IP but if these requirements are not met, UOW regrets that:
 - a. the potential for it to be exposed to unacceptable legal liabilities, and
 - b. the adverse impact upon UOW's commercialisation objectives,
 - c. the adverse impact on UOW's ability to maintain continuity of its courses and administration,
4. makes it necessary for UOW to decline to accept the Fellow, Volunteer or Visiting Student as a participant in a Category 2 or Category 3 project.
5. A Fellow (and/or their employer), Volunteer or Visiting Student may choose not to assign or licence IP to UOW. If a Fellow (and/or their employer), Volunteer or Visiting Student makes this choice the Fellow, Volunteer or Visiting Student, in conjunction with their supervisor or host, will attempt to develop an alternative project that does not have a Commercialisation Expectation, is not subject to a research contract, and is not reliant upon pre-existing IP owned or licensed by UOW (where UOW would want to retain ownership of any improvements to that pre-existing IP) and will not develop Teaching Material or Administration Material.

9 Determination Whether a Fellow, Volunteer or Visiting Student is in Category 1, 2 or 3 Project

1. Whether particular research projects are a Category 1, Category 2 or Category 3 project should easily be recognised. If:
 - a. UOW has a Commercialisation Expectation,
 - b. UOW wants to protect its own pre-existing IP,
 - c. there is a contract that affects the Fellow, Volunteer or Visiting Student project with regard to IP or Confidentiality, or
 - d. Administration Material will be developed,
 then it is a Category 2 project, and a Deed of Assignment needs to be obtained.
2. Examples of contracts that may affect a Fellow, Volunteer or Visiting Student project include research agreements, licences, collaborative agreements, funding agreements, or agreements for a start up company or new venture.
3. If UOW wants to use the IP in delivery of a UOW course, subject, degree or program, then it is a Category 3 project and UOW needs to obtain a licence to be able to use the IP.
4. The determination of whether a project is a Category 1, Category 2 or Category 3 project, will be made by the relevant Faculty Manager of Innovation and Commercialisation (MIC) in consultation with the Fellow, Volunteer or Visiting Student and their supervisor/host.

10 Roles & Responsibilities

Not Available.

11 Version Control Table

Version Control	Date Effective	Approved By	Amendment
1	6 July 2007	University Council	New Guidelines
2	6 May 2009	Vice Principal (Administration)	Migrated to UOW Procedure Template as per Policy Directory Refresh



3	18 August 2010	N/A	Policy Custodian position title and email address changed to reflect new role
4	16 January 2012	Deputy Vice-Chancellor (Research)	Updated to reflect name change from Commercial Research Unit to Innovation and Commercial Research.