

**UNIVERSITY OF WOLLONGONG
INTELLECTUAL PROPERTY POLICY
GUIDELINES**

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1. INTRODUCTION

These Guidelines explain the background and purpose of the provisions in UOW's Intellectual Property Policy, apart from:

- (a) Student assignment of IP, which is dealt with in UOW's Student Assignment of Intellectual Property Policy and associated Guidelines; and
- (b) commercialisation revenue sharing, which is dealt with in UOW's Commercialisation Revenue Policy and associated Guidelines.

The Guidelines use the same definitions of terms provided in the Intellectual Property Policy.

2. APPLICATION TO STAFF MEMBER AND STUDENTS

The contents of the Intellectual Property Policy apply to both UOW Staff Members and to UOW Students (both under-graduate and post-graduate). Sometimes Students are also employed by UOW. In such cases, if the IP is developed as part of the course of employment of a person, even if they are also a Student, that person will be considered a Staff Member for the purposes of the Intellectual Property Policy.

3. BACKGROUND- WHAT IS INTELLECTUAL PROPERTY?

3.1 An Overview of Intellectual Property

Intellectual Property (IP) is any original product of the creator's mind or intellect and is commonly developed through research or creative efforts. IP rights are the rights given to the creators of IP to help prevent others from using the original ideas. In practical terms, IP rights can be in the form of a:

- patent;
- copyright, including a moral right;
- trade mark;
- registered design;
- plant breeders right;
- circuit layout right; or
- confidential application of the idea (know-how or trade secrets).

Table 1. Forms of IP protection and their related governing legislation.

Intellectual Property T	Governing Legislation
▪ Patents	▪ <i>Patents Act 1990 (Cth)</i>
▪ Copyright and Moral Rights	▪ <i>Copyright Act 1968 (Cth)</i>
▪ Trade marks	▪ <i>Trade Marks Act 1995 (Cth)</i>
▪ Designs	▪ <i>Designs Act 2003 (Cth)</i>
▪ New plant varieties	▪ <i>Plant Breeder's Rights Act 1994</i>
▪ Circuit layouts (computer cl	▪ <i>Circuit Layouts Act 1989 (Cth)</i>
▪ Trade secrets and know-hc	▪ Common Law

In terms of trade, an IP right forms the proprietary knowledge that is a vital component of business success and its business importance means that it is a highly valuable commodity that can be bought and sold just like any other asset. As shown above in Table 1, there are many ways that IP can be protected and creators should contact their Faculty Manager of Innovation and Commercial Development (MICD) for advice on the most appropriate method to protect their IP.

3.2 Patents

Patent protection provides the right to exclude others from making, using, selling or importing the invention covered by the claims in the patent.

In Australia, there are two types of patents: 1) a standard patent; and 2) an innovation patent (similar to the old petty patent system). An innovation patent provides a quicker and cheaper method of protection than a standard patent, however it only lasts 8 years and can only contain up to 5 claims. In the University environment, a standard patent will be the preferred patent option in most cases.

To obtain a patent, an invention must:

- include patentable subject matter, that is, include a “manner of manufacture”. This covers both products and processes. Patentable subject matter includes machines, industrial methods, drugs, hardware and software, methods for making drugs, toys, and algorithms. Examples of non-patentable subject matter are discoveries, scientific theories and principles, pure mathematical models and theories, and artistic creations;
- be novel (i.e. must not have been publicly disclosed or used elsewhere anywhere in the world prior to filing for the patent); and
- be inventive (for a standard patent) or innovative (for an innovation patent). There is an inventive step if it is not obvious to a person skilled in an area of expertise relevant to the invention. An innovative step occurs if there is a difference between the invention and what is currently known about the technology and this difference makes a substantial contribution to the functioning of the invention.

The *Patent Act 1990* provides for patent protection, registration and enforcement in Australia and its territories. Patent protection can last for up to 20 years or up to 25 years in the case of pharmaceutical patents.

Obtaining patent protection and drafting a patent is a very complex task that requires the use of expert Patent Attorneys. If a patent is not drafted correctly, it may be easy for someone else to work around the

¹ Article 2 of the Convention establishing the World Intellectual Property Organisation, July 1967

patent or improve it. It is also very important to assess the commercial potential of a patent prior to obtaining protection as the process is lengthy, fraught with legal restrictions, and expensive. A patent can cost \$500,000 to establish and maintain over its 20 year lifespan and thus UOW reserves the right to commence and continue patent protection as a commercial decision.

3.3 Copyright and Moral Rights

Copyright protects the way that thoughts are expressed on paper, in electronic form or in other reproducible ways, such as broadcasts, artistic works, plays, musical compositions etc. Only the copyright owner or someone with their permission can reproduce the copyrighted material.

Copyright protects the expression of an idea, not the idea itself. For example, two researchers can publish the same research conclusions but each will own the way in which they have expressed their conclusions. Also, one party may own the written form of the ideas but others may own the publication in which those ideas appear.

The *Copyright Act 1968* provides for copyright protection. In Australia a “©” copyright logo is not required to afford copyright protection but the logo, the owner’s name and the date of production is required to ensure Copyright protection internationally. In Australia, copyright protection is automatically conferred when the idea is recorded and the protection can last as long as the lifetime of the owner plus seventy years.

Generally, unauthorized use of the copyright material will breach the Copyright Act unless an exclusion applies. The fair dealing section of the Copyright Act allows a certain amount of copying or reproduction without infringing copyright. For example, UOW’s statutory licenses allow the copying and communication of third party copyright material for educational purposes.

UOW has a separate Copyright Policy.

Copyright owners also have “moral rights” which ensure that they have the right of:

- integrity of authorship (i.e. someone cannot add their name as an author of someone else’s work without permission or amend someone’s work so that the context is changed but the original author still remains as the acknowledged author);
- the right of attribution of authorship (i.e. where someone’s work is reproduced it must be attributed to the true author); and
- the right against false attribution (i.e. someone cannot put another person’s name as the author of copyright material unless the other person is a true author).

3.4 Trade Marks

A trade mark is used to identify a particular product and can include a:

- letter(s) (e.g. BMW);
- name (e.g. McDonalds);
- word (e.g. Reebok);
- signature;
- phrase (e.g. “Just do it”);
- logo (e.g. a Centre logo, such as the National Centre of Excellence in Functional Foods’ logo);
- picture;
- colour (e.g. Cadbury’s purple);
- scent;
- label (e.g. Coca-Cola bottle); or
- any combination of the above.

A trade mark is most useful when there is a certain image or perception of quality associated with it. This gives it potential as a marketing tool.

The *Trade Marks Act 1995* provides for registration and protection of trade marks within Australia and its territories. If regular fees are paid, a trade mark can remain registered indefinitely.

Common law (i.e. unregistered) trade marks can also exist but are not protected by statute. They are however protected by the tort of “passing off” (this protects you from others trying to use your business reputation to sell their product) and are also recognised under Section 52 (Misleading and Deceptive Conduct) of the *Trade Practices Act 1974*.

3.5 Registered Designs

A registered design protects the shape, configuration and/or pattern and ornamentation applied to an article or object. Once registered, the design owner has an exclusive right to that design for a manufactured product. This protection does not cover how the product works or is manufactured. It protects the visual appearance of the article/object and must be judged by the eye. For example, you may be able to register a design for a particular shape of a motor vehicle but you are not protecting the basic concept of the vehicle (e.g. four wheels, engine, steering wheel etc.).

In order to obtain design protection, the design must:

- embody a feature of shape, configuration, pattern or ornamentation;
- have distinct features that are visible to someone looking at the article;
- be new or original;
- not have already been shown in public; and
- be used or conceptually applied to an article of manufacture.

The following concepts cannot be protected as registered designs:

- items that are primarily artistic or literary works (these would be protected by copyright);
- a method or principle of construction;
- how the article works or functions; and
- an article that can only have one design (e.g. an ordinary tap washer).

The Designs Act 1996 provides for design protection and an Australian design registration scheme. Original protection is for a 12 month period but can be extended for up to 16 years of protection.

3.6 Plant Breeder Rights

Plant breeder’s rights provide an exclusive right to Commercialise a registered plant variety, including the exclusive right to:

- produce or reproduce the variety;
- clean, coat, sort, package or grade the variety for the purpose of propagation;
- direct production, sale, distribution and marketing of the variety;
- stock the variety for any of the above purposes;
- receive royalties from the sale of the variety; and
- sell the plant breeder’s right.

Only new or very recently (i.e. sold with the owner’s consent for up to 12 months in Australia and up to six years overseas) exploited varieties can be registered. The applicant for a plant breeder’s right must also be able to show that the variety is distinct, uniform and stable. This is usually demonstrated through comparison to the most commonly known similar variety.

Despite registration, others can use the variety for the purposes of:

- private or non-commercial use;
- experimental purposes; and
- breeding new plant varieties.

The *Plant Breeder’s Rights Act 1994* provides for plant breeder’s rights and the Act is administered by the Plant Breeder’s Rights Office (PBRO) of Agriculture, Forestry and Fisheries Australia (AFFA). Plant breeder’s rights last for 25 years (from date the right is granted) for tree and vine varieties and 20 years for all other varieties.

3.7 Circuit Layout Rights

Circuit layout rights, sometimes referred to as computer chip or semi-conductor chip designs, protect the layout designs, topographies or plans of integrated circuits used in computer-generated equipment. The right is granted to the layout and not the circuit itself. The holder of the right is able to:

- make an integrated circuit from the layout design;
- copy the layout in material form; and
- commercially exploit the layout in Australia.

Circuit layout rights are similar to copyright, in that the rights are automatically granted upon creation and do not require registration.

Others can use the layout for the purposes of:

- private use;
- research or teaching purposes; or
- evaluation of the layout.

The Circuit Layouts Act 1989 provides for circuit layout rights. Protection can be provided for up to 20 years from date of creation.

3.8 Confidential Information (Know-How and Trade Secrets)

Information that one party possesses, but is not generally known by other parties, is termed “confidential information” and includes “know-how” or “trade secrets”. It is the information that distinguishes one party’s expertise from those of their competitors or colleagues. Examples can include:

- particular testing methodologies;
- recipes;
- manufacturing techniques;
- chemical formulations;
- experimental conditions; or
- production methods.

Know-how and trade secrets can only be protected by keeping this information confidential. This means that the information is not made public and prior to any disclosure, a confidentiality or non-disclosure agreement must be signed by the person who is to receive the information.

4. INTELLECTUAL PROPERTY OWNERSHIP

4.1 General Overview of Ownership

Generally at law, if a person creates IP in the course of their employment using time, opportunity, information or facilities of their employer, the employer is entitled to the benefits of the IP, especially in the case of technical areas of work. This position has been confirmed in several statutes, including the *Copyright Act 1968*² and cases (e.g. *Triplex Safety Glass Co v Scorch* [1938] Ch 211). Although the *Patents Act 1990* and the *Trade Marks Act 1995* do not contain such a provision, the common law supports the employer’s general rights to own an invention developed by an employee (e.g. see *Sterling Engineering Co Ltd v Patchet* [1955] AC 534).

Students are not employees of UOW so ownership rights and assignment processes differ between UOW Staff Members and Students. Students should read the Student Assignment of Intellectual Property Policy for more information.

There are situations in which UOW will:

- need to be the sole legal owner of IP developed by Students.
For example, if there is an overriding obligation in a contract with a third party (such as an industry partner or other research institution) and UOW will be in breach of that contract unless it owns the IP

² See section 35(6) *Copyright Act 1968* (Cth); s.16(2) *Circuit Layouts Act 1989* (Cth); s.19(3) *Designs Act 1906* (Cth); s.3(1)(c) *Plant Breeders Rights Act 1994* (Cth)

developed by the Student. UOW may also require sole ownership of IP that has importance for continuity of research. An example where this might occur is where a supervisor provides a data set (which may have been developed over a period of several years) to a Student for use in the Student's PhD project on the condition that any additions that the Student makes to the dataset are owned by UOW. This may be required in order that the dataset is then able to be made available by UOW to future Students. In cases where UOW would need to be the legal owner of IP developed by Students, UOW may as a condition of the Student participating in that project, ask the Student to assign his or her IP to UOW before they commence on the project or to sign a licence (access to data) agreement before accessing UOW data. Any assignment would still have to be done freely and with the consent of the Student. The Student is able to make a decision on whether or not they would be willing to assign their IP or would prefer to work on a different project where they can retain ownership of the IP.

- assert a financial interest in IP developed by Students.
Where UOW has invested considerable sums in capital equipment or services, it may seek consideration for having provided that support if the resultant research outcomes end up generating an income from Commercialisation. This would also be the case when UOW financially supports a project (e.g. through a Student scholarship, support fund etc) or gains support from a third party for the project (e.g. through a grant, government scholarship or industry funding).
- share ownership of IP.
If the Student develops IP jointly with Staff Members or uses IP owned or licensed by UOW, UOW may have a legal right to share ownership of the IP.
- need to be the owner of IP for commercial reasons.
UOW and the Student may co-own IP and may agree that Commercialisation responsibility should vest in UOW. In order for UOW to successfully commercialise IP, UOW will need to solely own the IP and will ask the Student to assign their IP to UOW in exchange for a share of commercial returns. Such an assignment would have to be done with the approval and knowledge of the Student.
- not have any rights to assert an interest in the IP developed by Students.
This would occur where the Student has developed the IP solely and has not received funding from UOW and has not made Exceptional Use of University Resources.
- consider negotiating agreements regarding IP ownership with a Student's employer.
This may occur where the Student is an employee of a third party (this could include being an employee of another University) and the Student's research project will use pre-existing IP owned by their employer or the project may form part of their normal work duties. In such cases, UOW may consider allowing IP to vest in the third party.

4.2 Ownership of Copyright in Teaching Material

It is important that UOW retains the right to use Teaching Material developed by Staff Members in order to maintain continuity of resources and course structures over time, regardless of staff movement. Therefore, UOW retains a perpetual non-exclusive licence to Teaching Material in order to maintain the stability of its degrees and courses.

However, in recognition that Teaching Material also forms part of a Staff Member's core expertise and possibly part of their resume, Staff Members will retain ownership of the Copyright in Teaching Material. This means that Staff Members leaving the employment of UOW are able to take with them the right to use any Teaching Material that they solely developed at UOW.

In its use of Teaching Material, UOW will consider the reputation of the Creators. For example, by removing out-of-date information, attributed to the author, from course notes.

4.3 Ownership of Administration Material

It is important that UOW retains ownership of Administration Material developed by Staff Members as this material is vital to the successful management and operations of UOW itself. Since this material is very specific to the administration of UOW and in many cases will be commercially sensitive, ownership of it is not likely to be of significance to a Staff Member's core expertise. Therefore, UOW will not allow Staff Members to use administrative material outside their course of employment at UOW. This does not prevent Staff Members from displaying examples of their work in a portfolio, except where this material is considered by UOW to be commercial in confidence.

4.4 Records Management for Administration Material and Teaching Material

In order to efficiently conduct University business, the storage, retrieval and management of these information reserves is a significant issue. Staff should consult the Records Management Policy for their record keeping obligations in relation to Administrative Material and Teaching Material.

4.5 Ownership of Creative Material and Copyright in Scholarly Material

UOW wishes to encourage Staff Members and Students to actively produce Scholarly Material and recognises that this is an important component of improving and maintaining UOW's reputation. UOW also recognises that the production of Scholarly Material is an important activity for Staff Members and Students to develop their own careers. Therefore, UOW will not make any claims of ownership of the Copyright subsisting in Scholarly Material except where:

1. it has itself commissioned the development of this work. In such cases, section 6 of the Policy would apply (Ownership of Copyright in Commissioned Works); or
2. the scholarly work forms part of a teaching program. For example, where a Staff Member includes an abstract of a journal article (that they have written) in the course notes for a particular teaching subject. In such cases, this would mean that the abstract from the scholarly work has become Teaching Material and UOW would require that the Creator grant UOW a non-exclusive licence to use the Teaching Material. This would be required to maintain stability of the teaching course. UOW would waive this right where the material has already been published or will be published by a publisher who has been granted an exclusive license or has been assigned the Copyright.

4.6 Cautionary Notes Regarding Student Copyright

It is important to note that Students, including under-graduate Students, own the Copyright subsisting in any material that they develop. Therefore, their permission must be obtained if the work is to be used in any manner (other than the purpose for which they submitted the work, i.e. in most cases for the purposes of being examined) by UOW.

For example, a supervisor cannot reproduce part of a Student's assignment for teaching purposes unless they obtain the Student's prior approval. Preferably, this approval should be provided in writing via a consent form. UOW's Copyright Officer can provide further advice regarding Copyright issues.

Staff Members need to be cautious in their use of text matching systems (i.e. anti-plagiarism services), such as Turnitin. UOW provides further advice on use of Turnitin on its website. When Turnitin finds that text from one document matches another, the user will be notified that there is a match but the exact text of the matching document is not provided. However, a request to obtain a full copy of the matching document can be sent to the nominated contact person for the matching document. If such a request is sent to a UOW Staff Member it is vital that the permission of the Student who developed the work is gained before providing a copy of the Student's document to a third-party. This is because UOW does not necessarily own the copyright or IP vested in the document so should keep it confidential on behalf of the Student.

4.7 Moral Rights

Moral rights are not transferable rights and so these vest in the Creator. However, UOW will seek to protect the Moral Rights of Creators wherever possible and wherever it is in the control of UOW to do so.

Sometimes, in research agreements, a client may ask Staff Members or Students to waive their moral rights. This often occurs where UOW is asked to prepare a report for the client as part of the contract. The client may want to extract aspects of the report and use it in their own organisation's material without attribution. In some cases this may be a reasonable request but in other cases it may be an onerous request. UOW will consult with Creators before negotiating Moral Rights terms in a contract with a client.

4.8 Assignment of Intellectual Property

As described in section 4.1, the law is that the employer owns IP created by an employee in the course of the employee's employment. Therefore, Staff Members are expected to sign any documents that are required in order to provide UOW with effective ownership of IP (including IP Assignment Deeds or Letters of Confirmation). There is not a similar obligation on Students. So, for projects where the Student

will be working with a third party (e.g. industry partner, client, other research institution) and UOW has agreed to IP ownership (or confidentiality of IP) conditions with that third party, it is *vital* that UOW also signs an IP Assignment and/or Confidentiality Agreement with the Student to ensure that UOW has the rights to the Student IP and that third party IP is kept confidential, in accordance with UOW's Intellectual Property Policy. This should be done before the Student commences work on the project so that the Student can make a decision not to become involved in that particular project if they are not willing to assign their IP to UOW.

It is possible that a Student develops IP solely and independently of their supervisor or that the supervisor and the Student co-develop IP. It is impossible for a supervisor to have solely developed IP in a Student project (otherwise it would not be a Student project, though the supervisor may solely develop IP that is related to the Student project). Where a Student and their supervisor co-develop IP, UOW will assert joint ownership in the IP with the Student.

To avoid any potential IP conflicts, the following actions should occur:

- supervisors and their Students should discuss their IP ownership expectations prior to the commencement of the project and record what each party will contribute to the project (in terms of pre-existing IP, resources, ideas etc);
- when a third party (industry partner, other research institution, Student employer) is involved and that third party has an expectation of owning or accessing the project results, the supervisor should ensure that their MICD has negotiated an IP Assignment Deed and/or Confidentiality agreement with the Student BEFORE the Student commences work on the project (or that part of the project that is of interest to the third party). The Student is then able to make a decision on whether or not they would be willing to assign their IP or would prefer to work on a different project where they can retain ownership of the IP;
- where the project is likely to lead to commercial outcomes or where it involves IP that UOW or the Student would want to protect for other reasons, the relevant Faculty MICD should be consulted to provide advice on appropriate IP arrangements;
- where a Student project has already commenced and it is realised part way through that IP with Commercialisation Expectations or some other reason for protection has been developed, supervisors should ensure that the notification process described in Section 11 of the Intellectual Property Policy is followed. This does not apply to IP that the Student has developed solely;
- supervisors should make Students aware of the Intellectual Property Policy, Commercialisation Revenue Policy and Student Assignment of IP Policy and direct the Student to their Faculty MICD if they have any questions regarding these policies; and
- Students can seek clarifications and explanations from their Faculty MICD or the Legal and Commercial Unit, but should seek their own independent legal advice before signing any agreements (see Student Assignment of IP Policy for information on how Students can receive financial support to obtain this independent legal advice for IP Assignment Deeds).

The Student Assignment of Intellectual Property Policy deals with Student assignments of IP in more detail.

Following an IP assignment, UOW will take on the responsibility of Commercialisation and will give the Creators the right:

- to continue to use the IP for Research Purposes; and
- to share in any returns that UOW obtains from Commercialisation of that IP.

5. COMMERCIALISATION OF INTELLECTUAL PROPERTY

5.1 Notification of Intellectual Property

In order for UOW to protect the IP, it has to know that the IP has been created. Formal notice is given by completing an IP Notification Form for IP that may have commercial value. The form should then be submitted to the relevant Faculty MICD. Ideally, however, the MICD should be contacted as soon as the IP is developed or when the research looks as though it is going to yield results with commercial application. For IP that will not have commercial value but it is important to protect for other reasons, the Creator should contact their Faculty MICD before completing an IP Notification Form. The MICD will be

able to provide early advice on how to best protect the IP and will evaluate if there is any commercial value in the IP.

The formal notification process can also serve as a formal record of invention. In Australia, the people who are first to file a patent are the people entitled to hold that patent. However, in the USA, the people who are the first to invent the patentable concept are the people entitled to hold the patent. Therefore, the right to patent something will often rely upon evidence of who was the first to invent, and written documentation of a formal notification of IP (e.g. via the IP Notification Form) can be considered as evidence of this.

When completing the IP Notification Form, it is important to correctly identify the creators of the IP as they will be considered potential “inventors” on a patent. When a patent application is filed, it must identify one or more inventors. According to the Practical Guide to Australian Patent Law (Chris O’Sullivan and Carolyn Rolls, 2003), an inventor is a person whose contribution, solely or jointly with others had a material effect on the final *concept* of the invention.

If the incorrect inventors are named on the patent application then it can be invalidated and in many countries the misidentification is considered fraud against the Patent Office. A patent application that incorrectly identifies inventors is defective and must be corrected or it provides a basis for invalidating the patent.

It is important to understand that inventorship is a legal matter, rather than a collegiate matter and not all authors on a paper will necessarily be inventors on a patent. “Inventorship” is a legal notion that varies from country to country and is very different to the notion of a collaborator. A collaborator may make a vital contribution to the successful development of the technology but still not be an inventor. The contribution of collaborators, who have played an important role in developing a technology, can be recognized in other ways, such as authorship and sharing of net returns from commercialisation.

The lead investigator is almost always going to be an inventor but it is often not so clear whether or not collaborators, technicians, PhD Students, post-docs etc are also inventors. One way to identify who an inventor may be is to determine whether or not the person contributed to the creation of the idea that is the basis of one or more of the patent claims. Another way is to determine who conceived the original ideas mentally as the reduction into practice in a physical sense does not involve invention (except where it leads to the creation of additional original ideas). Inventors may use the services of others to implement or test their ideas and the service provider will not be considered an inventor. Inventors can also seek advice from collaborators skilled in the art without the collaborator becoming an inventor.

Since matters of inventorship evolve through case law, and patent laws tend to be open to interpretation, it is important that a patent attorney is involved in determining inventorship when there is more than one likely inventor. The key researchers will be able to identify likely inventors but since inventorship is a legal notion, only someone skilled in the law (and not the technology) can make this determination. Although researchers may in good faith identify themselves as inventors, University Staff Member (including Commercialisation Staff Members) are not experts in patent law and so must rely upon advice from patent attorneys who are experts in this area.

Ultimately, definitive inventorship can only be determined by a court of law but a patent attorney or patent lawyer can provide legal advice on inventorship that can be relied upon in any subsequent court actions and indeed can be used as evidence to avoid a court case. Although court action is unlikely to occur, serious investors and licensees will ask what due diligence process UOW has undertaken to sort out inventorship on its patents. Accordingly, as part of its patent due diligence process, UOW will use patent attorneys to undertake formal inventorship determinations for all its patent applications where there is a possibility of more than one inventor.

5.2 Evaluation

After receiving an IP Notification Form, UOW will assess the commercial potential of the invention. More written information, such as drafts of journal papers or grant applications, may be required and will be used to develop an initial assessment of commercial potential.

The overall competitive advantages and marketability of the invention will be assessed. If the initial assessment indicates commercial potential, UOW will then engage professionals to undertake a search of the prior art (i.e. search patent, academic and commercial literature to see if anything similar already exists or has already been patented). The ease of developing a market-ready product and the size of the market itself will also be investigated and an IP protection strategy will be developed. In most cases, a patent will be the method of protecting the IP.

UOW will use professional patent attorneys to prepare and file the patent application, working with the researcher. The cost of patent protection will be funded by UOW.

The most common alternative to patenting is protecting the information as confidential know-how or as a trade-secret. In such cases, the invention would only ever be discussed with third parties if they had first signed a confidentiality agreement prepared by UOW. The strength of this approach is dependent upon:

1. keeping the information secret through non-disclosure; and
2. a high level of difficulty for third parties to reverse engineer the outcome or deduce the trade secret (e.g. through chemical analyses to determine composition or being able to pull apart a product and work out the method of manufacture and assembly).

Once the IP has been protected, UOW will determine the best Commercialisation path for the technology. Generally, this will be to either licence the technology to an existing company or to create a new company (referred to as a “spin-out”, “spin-off” or “start-up”) to take the product to the market.

In the process of evaluating the IP, UOW will consider the Creator’s interests in publishing Scholarly Works as well as UOW’s community obligation to disseminate research findings. Similarly, UOW will consider the Creator’s views on the wider research strategy and how this will fit with the various Commercialisation pathways. Creators should discuss with the relevant faculty MICD, any publication or research strategy issues that they have.

In the majority of cases, a Commercialisation strategy can be developed that will still allow the Creators to develop Scholarly Works and for research outcomes to be shared publicly. Even if an idea is patented, a publication would only be delayed and not stalled indefinitely (though a publication may need to be adapted to protect confidential information, trade secrets or confidential know-how).

Wherever reasonably possible, UOW will endeavour to provide three months notice of its intention not to continue with a patent and during this period will continue to pay ongoing patent application or granted patent costs in jurisdictions already entered. However, this is limited to ongoing payments and does not extend to initial national phase entry costs for each patent jurisdiction or initial filing costs for a complete specification or provisional specification. That is, UOW will not pay the costs to draft and lodge a provisional patent application, complete patent application or national phase entry application. It will, however, pay ongoing maintenance fees in order to keep the patent application or granted patent in force.

Where UOW decides not to proceed with the protection or Commercialisation of IP (including a decision not to Commercialise in a particular field of application), or if a decision is made to cease commercialising at a later stage, UOW will allow the Creators the opportunity to seek funding and commercial partners and will assign or license the IP to the Creators, provided that the Creators have been cooperative during UOW’s Commercial evaluations and have fully disclosed the full extent of the IP. In such cases, the Commercialisation Revenue Committee would determine what share of returns from Commercialisation UOW would seek.

Attachment 1: CONFIDENTIAL

University of Wollongong

Intellectual Property (“IP”) Notification Form

Details of Intellectual Property Rights Claimed

1. Background Details

- Full Name of Creator(s):** 1.
(include position- e.g. Student, Staff 2.
Member title, external title & employer) 3.
- Nationality of Creators(s):** 1.
(for patent purposes) 2.
3.
- Home address of Creator(s):** 1.
(for patent purposes) 2.
3.

2. Overview of Technology

Title (for reference purposes):

Date of Creation:

Details of any collaboration with external parties (e.g. industry, academics from other institutions), relevant contracts or funding sources (e.g. grants, clients etc):

Details of any disclosure or publication of the IP (e.g. abstracts submitted, presentations, or discussions with any non-creators and the date of these disclosures):

List of technical/other documentation attached (e.g. draft journal articles, lab notes, photographs, diagrams- and please attach these):

3. Description of the Technology

Please provide:

- an overview of the field and general state of the art (i.e. what is already known about the overall field and how advanced is it).
- a detailed description of the technology (aimed at the educated layperson)
- advantages or improvements of the technology over existing technologies
- disadvantages or limitations of the technology
- applications of the technology (i.e. how it can be used)
- details of what further development work is required in order to apply the technology

4. Development of the Technology

Please provide:

- a summary of how the technology was developed
- details of each Creator’s role in development of the technology
- any involvement of Students or external people in development of the technology

I/We hereby declare that the information I/we have provided above is true, and that to the best of my/our knowledge, information and belief, I/we am/are not aware of any prior claim to the IP described above, in respect of which I/we hereby make claim.

.....
Signature of Creator 1

.....
Date

.....
Signature of Creator 2

.....
Date

.....
Signature of Creator 3

.....
Date

Please attach any relevant documentation and submit to your Faculty Manager of Innovation and Commercial Development (MICD). You should also contact your MICD to organise a meeting to discuss this form or contact them if you need any assistance filling it in. If you are a Student, please also provide a copy to your supervisor:

Engineering, Law and Science- TBA

Informatics, Creative Arts and Commerce- Mr Craig Peden (Ph: 4221 5407, cpeden@UOW.edu.au)

Health and Behavioral Science, Arts and Education- Mr Aapo Skorulis (Ph: 4221 4578, aapo@UOW.edu.au).

.....
Date Received by MICD

.....
Signature and Name of MICD