



## University of South Australia's Intellectual Property Guidelines

### **Purpose**

These Guidelines are created in accordance with the *University's Intellectual Property: Ownership and Management Policy* for the purposes of administration, management and commercialisation of IP under that Policy and are to be read in conjunction with the University's [IP Principles](#).

### **The University of Enterprise**

UniSA is Australia's *University of Enterprise* and is committed to supporting the effective generation, management and transfer of IP. As a key element to supporting the teaching and research undertaken at the University, UniSA has a key focus on the appropriate utilisation of IP as a means of knowledge creation and dissemination. Importantly, UniSA considers it a priority for IP developed at the University to be utilised appropriately to deliver social and economic benefits to our communities. Where this relates to the commercialisation of IP, the University has implemented a framework of support mechanisms for Students and Staff to facilitate this commercialisation process that is flexible, agile and responsive to the needs of the beneficiaries of the IP.

With an ever increasing amount of attention paid to IP and the importance of IP in the research translation process it is important that the University has a clearly articulated framework of support for students and staff of the University and to make it clear to groups outside the University how we will approach and support doing business and fostering mutually beneficial relationships.

### **Productive partnerships**

Productive and mutually beneficial relationships with the end-users of research are fundamental in supporting the appropriate commercialisation pathway for IP. This may be through transferring IP rights to existing companies and leveraging these relationships for and further development of the opportunity through direct funding provided by these companies and/or industry-linked grants.

### **Encouraging entrepreneurship**

An alternative pathway for commercialisation is through the formation of new companies as spin-outs of the University. UniSA encourages Students and Staff to play an active role in this process and also for Students and Staff to take the lead in commercialisation of IP and research outcomes as entrepreneurs.

IP may also be licensed to existing companies for which there are commercial returns made but not an ongoing partnership or collaboration, which still serves as an important conduit to effect the translation of research outcomes.

In supporting research translation and in encouraging entrepreneurship amongst University Students and Staff a set of [IP Principles](#) has been developed that outline the University's approach to commercialising IP, which serve as our public declaration and pledge to achieving this goal.

## **1. Roles**

### **1.1. Role of Creators**

- 1.1.1. The role of the Creator(s) in the IP protection and commercialisation process is vital. At a minimum, the Creator(s) must promptly disclose the creation of University IP to UniSA Ventures (via an Invention Disclosure Form), as well as to the appropriate line manager/Division manager,

and provide all reasonable assistance required in relation to the assessment and protection of IP (including the signing of legal forms, assisting with written patent specifications and conducting novelty searches). Beyond this the Creator(s) will be encouraged to be involved in the commercialisation process. This will vary on the basis of the nature and stage of development of the University IP, but will involve working with UniSA Ventures to map out an appropriate commercialisation pathway, identify commercialisation partners, securing funding to support further development of the IP, working with commercial partners to support the technology transfer process and structuring and supporting new spinout companies where this is the agreed commercialisation path.

- 1.1.2. The Creator(s) of University IP are responsible for ensuring appropriate confidentiality of the IP prior to and during its assessment and protection. UniSA Ventures will provide guidance in relation to confidentiality issues.
- 1.1.3. The Creator(s) are to work collaboratively with UniSA Ventures to assist the assessment and commercialisation of University IP, including executing IP assignments and other related documents as required by UniSA Ventures.
- 1.1.4. The Creator(s) will, as required by the University or UniSA Ventures, execute all documents and do all acts that may be necessary or desirable to give full effect to the provisions of these Guidelines and the intellectual property ownership and management Policy. This includes but is not limited to an IP assignment deed and Deed of Distribution (refer section 6.4.1).
- 1.1.5. Commercialisation of IP provides a platform that may lead to many opportunities and benefits not only for research end users and the community generally but also for Creators to continue to contribute and participate as valuable stakeholders in new ventures. UniSA Ventures welcomes and encourages proposals from entrepreneurial Creator(s) who wish to participate in opportunities arising from commercialisation and the commercialisation process.

## **1.2. Role of UniSA Ventures**

- 1.2.1. The role of [UniSA Ventures](#) is to identify and protect Commercialise IP assets, confirm legal ownership rights by appropriate documentation, manage commercialisation risks and facilitate technology transfer, for the benefit of the University.
- 1.2.2. UniSA Ventures is also responsible for the implementation and operation of the University's [IP Principles](#).
- 1.2.3. UniSA Ventures requires an [Invention Disclosure Form](#) to be completed by University Staff and Students with the assistance of UniSA Ventures staff. Information provided in this form will assist UniSA Ventures to assess the commercial potential for the IP and devise a suitable Commercialisation strategy. [Invention Disclosure Forms](#) are available on the UniSA Ventures website and/or through contacting UniSA Ventures directly.

Contact	Location
W: <a href="http://www.unisa.edu.au/unisaventures">www.unisa.edu.au/unisaventures</a>	GP Building, GP1 - 15
E: <a href="mailto:unisaventures@unisa.edu.au">unisaventures@unisa.edu.au</a>	Mawson Lakes Campus
P: 08 8302 5300	Mawson Lakes SA 5095

- 1.2.4. Commercialisable IP will be managed, developed and commercialised by UniSA Ventures. In conjunction with the Creator(s) and Division Managers, UniSA Ventures will develop an IP management plan to enhance the value and commercial potential of the IP. The plan may include protection, third party commercial arrangements, further development and/or further investment in the IP.

- 1.2.5. UniSA Ventures will determine the appropriate form of protection of University IP, if any. In making a decision in this regard, UniSA Ventures may take into account the cost of such protection including patenting, against the value and likelihood of any commercial benefit.
- 1.2.6. UniSA Ventures will determine whether commercialisation of University IP should occur and decide on the appropriate mechanism for commercialisation. UniSA Ventures may invest funding for commercial development of IP, in accordance with applicable eligibility and funding criteria as determined by UniSA Ventures.
- 1.2.7. In the event that UniSA Ventures declines to pursue commercialisation of University IP, or decides to withdraw support for University IP that UniSA Ventures has invested resources in and attempted to commercialise over time without success, it is possible for the Creator(s) to reach agreement with UniSA Ventures for the Creator(s) to accept ownership and responsibility for University IP, subject to final agreement by the Deputy Vice Chancellor: Research and Innovation.

## **MANAGEMENT OF IP**

### **2. *Use of Intellectual Property owned by an external party***

- 2.1. All UniSA staff and students will actively endeavour to avoid infringing the IP rights of others. In all instances IP may not be used if there is good reason to believe that such infringement may occur. The University's right to use third party IP rights generally involves obtaining a written consent or licence from the third party for such use. Advice can be obtained from the Copyright Coordinator in relation to copyright material or from UniSA Ventures in relation to other forms of IP. UniSA Ventures' consent or licence must be obtained for use of IP where UniSA Ventures has undertaken commercialisation activities.

### **3. *Bringing Intellectual Property into the University***

- 3.1. IP independently created by Staff or Students outside the scope of the University's ownership, including prior to employment by the University, may not be used for University purposes until the University is satisfied that appropriate rights are legitimately granted to it in the form of a written agreement between the University and the owner of the IP.
- 3.2. A staff member or Student who wishes to bring IP into the University will inform the line manager or Supervisor (as appropriate) of the ownership details of that IP and provide reasonable assistance to verify ownership. In some instances a warranty stating that the use of the IP by the University will not infringe any third party rights may be required. The line manager or Supervisor (as appropriate) shall maintain a record of IP brought into the University and this will also be recorded and deposited in the Consolidated University IP Register maintained by RIS.
- 3.3. Line managers shall ensure that new staff members are aware that IP cannot be brought into the University until the University is satisfied that appropriate rights are legitimately granted to the University. Where expert advice is required the line manager shall refer the matter to their Commercial Manager who will confer with RIS and UniSA Ventures.
- 3.4. UniSA Ventures is available to negotiate and secure valid legal access to IP from the external party(ies) with appropriate documentation as required.

### **4. *Use of University owned Intellectual Property***

- 4.1. Staff may use University IP in the course of their duties; however, Staff are responsible for ensuring that this use does not interfere with the protection or commercialisation of that University IP, by enquiring with their line manager before utilising the University IP.
- 4.2. University IP rights will only be conferred to third parties in accordance with the Vice Chancellor's Authorisations or by UniSA Ventures in the context of dealing with Commercialisable IP. Proposals to confer Commercialisable IP rights to third party entities for commercial use shall be assessed by

UniSA Ventures who will work in conjunction with the researcher and Division Managers to assess the proposal.

4.3. A Creator or other person wishing to use Teaching Materials for non-University purposes must apply to the Provost & Chief Academic Officer for approval.

## **5. Publication**

5.1. Knowledge creation and dissemination by publication (for example: peer reviewed publication, conference abstract and/or presentation) is part of the fundamental mission of the University. However, publication of University IP may affect existing and further commercial uses of that IP in some circumstances. Therefore, an assessment of University IP by UniSA Ventures should occur before publication. Staff should notify UniSA Ventures of proposed publications of University IP at least 30 days before publication. This period will be used by UniSA Ventures to assess the commercialisation potential for the IP in the manuscript prior to public disclosure in the form of a conference abstract/presentation and or publication. In particular, publication of information relating to inventions and other confidential information may not occur until after assessment by UniSA Ventures and the filing of appropriate patent or other protection. UniSA Ventures will make every reasonable effort to not delay or postpone publication or presentation of research outcomes that are the subject of Commercialisable IP, where possible.

## **COMMERCIALISATION REVENUE**

### **6. Sharing of Commercialisation Benefits**

6.1.1. The successful commercialisation of IP may involve considerable input from participants in the commercialisation process. As acknowledgement of involvement and contribution in the commercialisation of IP the Net Revenue received from commercialisation of IP will be shared with the Creator(s).

#### **6.2. Net Revenue**

6.2.1. Net revenue received for the commercialisation of University IP is the financial return received by UniSA Ventures from the commercialisation of Commercialisable IP less all costs incurred by UniSA Ventures for the protection, commercialisation, further development of and investment in the IP in accordance with the policies and conditions of funding from UniSA Ventures including payment of any applicable government taxes. Subject to Clause 6.4 the sharing of Net Revenue will be as follows:

- a) 40% to the Creator(s) of the IP and other approved stakeholders, in accordance with the Deed of Distribution (refer Section 6.4.2)
- b) 20% to the UniSA coordinating Schools/Centres or Institutes where the IP was generated (for the purposes of furthering research and development), and
- c) 40% held by UniSA Ventures for the benefit of the University.

#### **6.3. Equity Interests**

6.3.1. Providing equity interests in a spin-off company is another means by which returns from commercialisation may be distributed in some instances.

6.3.2. UniSA Ventures is responsible for establishment of new companies to facilitate commercialisation and spin-off companies created as a vehicle to advance and extract value from Commercialisable IP, under policies and processes approved by its Board of Directors.

6.3.3. Where commercialisation involves equity investment and loan transactions in spin-off companies and other entities, the Creator(s) may hold an equity interest upon the recommendation of UniSA Ventures and with the approval of the DVC: Research and Innovation.

- 6.3.4. The proportion of UniSA Ventures' equity interests in spin-off companies transferred to the Creator(s) will be consistent with total commercialisation benefits of a maximum of 40% of Net Benefit, as outlined in 6.2.1 for sharing of Net Revenue.
- 6.3.5. Where the Creator(s) wish to take an active role in driving and supporting the operation of the spin-off company the proportion of UniSA Ventures equity transferred to Creator(s) will be negotiated on a case-by-case basis having consideration for the extent of inputs and supports provided by the Creator(s) to the spin-off company and be subject to the final approval of the DVC: Research and Innovation.
- 6.3.6. Where capital is invested into the spin-off company as part of its formation or later capital raising requirements of the spin-off company by UniSA Ventures, this capital is invested 'at risk' and is not included or considered in the final sharing of Net Benefit or Net Revenue with Creator(s) or the relevant School, Centre of Institute. Similarly, Creator(s) may invest capital in the spin-off company, which is 'at risk' and is also not included or considered in the final sharing of Net Benefit or Net Revenue with Creator(s).
- 6.3.7. In the event that IP is transferred to a spin-off company by way of an IP License or Assignment Agreement that carries with it up-front, milestone, royalty or other such payments, these will be shared with Creator(s) and Schools/Centres/Institutes as outlined under 6.2.1 for sharing of Net Revenue, in addition to the eligibility for equity in the spin-off company.
- 6.3.8. It is the responsibility of individual Creator(s) to obtain their own financial and legal advice in relation to holding equity in a spin-off company, and to fulfil their personal legal and taxation obligations.

#### **6.4. Determination of Benefits**

- 6.4.1. Returns to more than one Creator will not be distributed until a basis of distribution acceptable to all Creators and the University has been agreed. This information will be captured in a Deed of Distribution to be signed by all Creators and the University. If the stakeholders are unable to agree on the apportionment of Net Revenue and/or Net Benefit, the matter will be determined by the DVC: Research and Innovation. The DVC: Research and Innovation will take into account the contributions of each stakeholder to the creation and Commercialisation of the IP.

#### **6.5. University Share of Benefits**

- 6.5.1. UniSA Ventures receives and holds the University's share of Net Revenue and equity interests on the University's behalf and may include this in its annual calculation and distribution of profit to the University, as appropriate and subject to approval by the Board of UniSA Ventures.
- 6.5.2. The Vice Chancellor may redirect returns within the University to ensure the efficient allocation of resources.

### **7. Conflicts of Interest**

- 7.1. Where Creator(s) are actively engaged in supporting the commercialisation of University IP through:
- (a) accepting ownership and responsibility for University IP as outlined in 1.2.7;
  - (b) holding equity in and/or investing personally in a new spin-off company as outlined in 6.3;
  - (c) undertaking an active role in the spin-off company to support its operations, or
  - (d) another means conflicts of interest are likely to result.
- 7.2. Any active engagement in commercialisation of University IP by Staff, Students and other persons that may result in Conflict of interest with their University duties are subject to prior approval and appropriate mechanisms in place to remove or manage the Conflict, in accordance with the University's Conflict of Interest Policy [**Policy under development**].

## 8. *Dispute resolution*

- 8.1. Where a dispute arises between Creators, the dispute shall be handled for Staff in accordance with the University's Staff Appeals Policy (HR-6) and for students the matter shall be resolved in accordance with the Students Complaints Resolution Policy (C-17). If no resolution is reached, the relevant Supervisor or Pro Vice Chancellor will attempt to resolve the dispute and will meet with each aggrieved party within 30 days of notification of the dispute. If no resolution is reached, the DVC: Research and Innovation should be notified of, and will attempt to resolve, the dispute. If no resolution is reached within 60 days the matter shall be sent to external mediation. The costs of any such mediation shall be deducted from any returns accruing to the disputing Creator(s).

## 9. *Definitions*

**Commercialisable Intellectual Property (IP)** comprises IP and IP rights assessed by UniSA Ventures as suitable for commercialisation, or which if further developed may become suitable for commercialisation. University IP that is to be the subject of a third party commercial licence or assignment is considered to be Commercialisable IP.

**Commercialise/Commercialisation** is any means of transfer or exploitation of IP (including to make, sell, assign, apply, give away, adapt, copy, publish, manufacture, licence, sub-licence, franchise, exploit, market, distribute or otherwise use or dispose of Intellectual Property) for the purpose of commercial gain. The use and exploitation of Teaching Materials by the University whether in its programs, alliances or other educational activities does not constitute commercialisation under this Policy notwithstanding that the University may receive returns from such use.

**Teaching Materials** means any IP created for use in or in relation to a University program, course or short course, whether leading to the award of a degree or not, including for use by an affiliate or partner of the University. Teaching Materials include lecture notes, course notes, slides, presentations, handbooks, spreadsheets, course outlines, course reading lists, computer programs used for teaching purposes, maps, photographs, broadcasts, tutorials, questions, exams, online materials, films and all other materials created, developed, used or supplied for the purpose of learning and teaching at UniSA.

**Creator(s)** means any staff member or Student who creates IP, whether singularly, or in conjunction with others.

**Intellectual Property (IP)** means and includes all forms of IP rights whether arising under legislation or existing at law. IP includes all rights resulting from intellectual activity across all fields, including the right to apply for registration of such rights, and includes all rights in relation to circuit layouts, copyright, confidential information (including trade secrets and know how), designs, inventions and patents, plant varieties, plant breeders rights and trademarks.

**Moral Rights** include the right to be identified as the creator of a work, the right not to have authorship falsely attributed and the right to integrity of authorship of a work (the author's right to object to derogatory treatment of his or her work which prejudicially affects his or her honour or reputation).

**Net Benefit** is UniSA Ventures' equity interest in spin-off companies.

**Net Revenue** means the return received by UniSA Ventures from the commercialisation of Commercialisable IP less all direct costs incurred by UniSA Ventures for the protection, commercialisation and further development of and investment in the IP in accordance with the policies and conditions of funding from UniSA Ventures and including payment of any applicable government taxes.

**Staff or staff member** means any employee of the University at the time of creation of IP. This includes former staff members employed at the time of creation of the IP but will generally exclude adjunct

appointments, Students and visitors (refer Section 4.5, *Intellectual Property: Ownership and Management Policy*).

**Student** means an undergraduate or postgraduate student of the University at the time of creation of IP. Where a student creates IP in the capacity of a University employee, the student will be considered a staff member in relation to that creation.

**Supervisor** means a Pro Vice Chancellor, Head of School, Director of Institute, Centre or Unit, Manager of Area or other appropriate person to whom a staff member immediately reports and in the case of a student means the staff member who supervises the student's studies. A supervisor must also be suitably authorised pursuant to the Vice Chancellor's Authorisations in each instance.

**University IP** means all IP (excluding moral rights):

- a) Generated by staff in the course of or incidental to their employment;
- b) That under common law would be deemed to be owned by the University as an employer;
- c) Arising from the use by Staff of University premises, facilities, resources or pre-existing University IP; or
- d) Generated by Students or Staff as part of a Project funded by an external organisation and/or the Project is subject to a commercial agreement with an external organisation.