Intellectual Property Regulations 2013

Part - Preliminary

1. Objective

The objective of these Regulations is to make further provision in relation to intellectual property, in accordance with the Governance, Academic and Student Affairs Statute 2013.

2. Authorising provision

These Regulations are made under the Governance, Academic and Student Affairs Statute 2013 and sections 28, 29 and 30 of the Victoria University Act 2010 (Vic).

3. Definitions

In these Regulations-

a. "commercialisation" means any activity or initiative undertaken with the objective of exploiting (or that could contribute to the development or exploitation of) intellectual property in ways that might generate or are intended to generate commercial returns or other material benefits to the owners of the intellectual property. Commercialisation includes selling, hiring, licensing or otherwise disposing of or dealing with intellectual property (other than the use of teaching or learning materials in the delivery of a University course), including-
    i. its-

        (1) design;

        (2) development;

        (3) manufacture;

        (4) marketing;

        (5) distribution; or

    ii. provision of any product or service based on or incorporating the intellectual property.

b. "creator" means a person who authors, originates, invents or otherwise causes to be created any form of University intellectual property, whether alone or in conjunction with other persons;

c. "teaching or learning materials" means information, documents, materials or digital objects used in delivering (or made available to students for the purpose of) a course, including use in lectures, tutorials, seminars, workshops, field or laboratory classes, and other teaching activities conducted by the University. Such materials include all lecture notes, overhead transparencies, presentations, slides, photographs, maps, diagrams, handbooks, manuals, course outlines, exercises, examination scripts, examination marking guides, websites, computer programs and multimedia works that serve a teaching or learning function.

d. "University intellectual property" has the same meaning as in section 43 of the Governance, Academic and Student Affairs Statute 2013.

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Part 2 - Ownership of Intellectual Property

4. Ownership of intellectual property by University staff members

(1) With the exception of University intellectual property which is comprised of computer programs, teaching or learning materials and material whose creation or performance has been specifically commissioned by the University, the University assigns the copyright in books (including novels and scripts), scholarly articles and other literary works and in creative works, films and recordings that have a dominant artistic, musical or dramatic character such as paintings, sculptures, drawings, engravings, musical compositions or works involving a performance to the authors, creators or performers of that subject matter, where those individuals are University staff members at the time of creation, unless otherwise agreed in a specific instance.

(2) Where a staff member is also a student of the University, he or she retains ownership of all intellectual property which they create as a consequence of undertaking his or her studies, however the University is granted an irrevocable, royalty-free licence to use this intellectual property for its internal purposes including use in teaching, research and operational applications.

5. Ownership of intellectual property by University students

Unless it is University intellectual property, students own the intellectual property that they create in the course of their studies at the University, unless otherwise agreed in a specific instance.

6. Ownership of intellectual property by academic visitors

With the exception of University intellectual property which is comprised of computer programs, teaching or learning materials and material whose creation or performance has been specifically commissioned by the University, the University assigns the copyright in books (including novels and scripts), scholarly articles and other literary works and in creative works, films and recordings that have a dominant artistic, musical or dramatic character such as paintings, sculptures, drawings, engravings, musical compositions or works involving a performance to the authors, creators or performers of that subject matter, where those individuals are academic visitors at the time of creation, unless otherwise agreed in a specific instance.

7. Ownership of intellectual property by research participants

A person who is requested to participate in a research project by the University and who is not a staff member, student or academic visitor will have only those rights in the University intellectual property created as part of that research project which are granted by the University in an agreement which applies to that specific research project.

Part 3 - License of Certain University Property

8. License of higher education teaching materials

(1) Subject to sub regulation (2), the University grants to the creator of teaching and learning materials which do not relate to technical education, further education, or vocational education, who is a staff member at the time that these teaching and learning materials are created, a personal, non-assignable, non-sublicensable, fee-free licence to access and reproduce these teaching and learning materials for teaching higher education at another university or educational institution and for research.

(2) The teaching and learning materials cannot be used for any commercial purpose, whether by or on behalf of the creator of those materials, another university or educational institution, or any other person.

Part 4 - Moral Rights

9. Respect of moral rights

(1) The University respects the moral rights of authors, which are personal to the authors and cannot be assigned.

(2) Where the University is obliged by agreements with third parties to obtain authors' consents to acts which might

otherwise infringe any moral right, authors may only participate and create material covered by any such agreement on the basis that they will provide appropriate consents as and when required by the University.

Part 5 - Commercialisation

10. Potential commercialisation of University intellectual property

(1) A creator or any other person who has an interest in University intellectual property which may have potential commercial value must, in accordance with the University's relevant procedures, notify the University of-

a. the existence of that intellectual property;
b. the names of all of the creators of that intellectual property and their respective contributions to the creation of that intellectual property;
c. any intellectual property which is not owned by the University which is incorporated into that intellectual property, or which is necessary or would otherwise benefit the exploitation of that intellectual property; and
d. the details of any developments in respect of that intellectual property.

(2) After receiving a notification, the University must, within four months, decide whether the University wishes to commercialise the intellectual property.

(3) If the University requires additional information, it may-

a. request the person to provide additional information; and
b. by notice to the person, extend the period for decision to enable the additional information to be considered.

11. Obligations of creators of University intellectual property

(1) From the date of the creation of the intellectual property (and during any assessment period), the creators must keep the University intellectual property confidential, unless the University has provided its written consent to the disclosure of that intellectual property (or information concerning that intellectual property).

(2) If there are more than one creator of University intellectual property and the creators cannot agree in writing to their respective contributions to the creation of that intellectual property, then the University will make a final and binding determination of their respective contributions.

(3) On an ongoing basis, each creator must declare in writing to the University any actual or potential conflict of interest relating to the creation, protection, or commercialisation of any University intellectual property and adhere to any direction which the University gives to the creator in relation to dealing with or resolving such conflict of interest.

12. Consideration by the University

(1) In considering a notification under regulation 10, the University must take into consideration-

a. the objects of the University;
b. the nature of the intellectual property and the extent of patent or other protection that is desirable;
c. whether the securing of patent or other protection is likely to assist in the development and commercialisation of an invention;
d. the likely commercial returns to the University; and
e. any other relevant matters.

(2) In considering a notification under regulation 10, the University -

a. must consult, in confidence, with the creator; and
b. may consult, in confidence, with other relevant parties.

13. The University's decision

After considering a notification under regulation 10, the University must decide either-

a. that the University wishes to commercialise or protect the intellectual property; or
b. that the University does not wish to commercialise or protect the intellectual property.

14. Decision to exploit the intellectual property

If the University decides that it wishes to commercialise or protect the intellectual property, then the creators must provide a written and signed confirmation of assignment of the intellectual property to the University and provide the University with all assistance that the University reasonably requires.

15. Decision not to exploit the intellectual property

(1) If the University decides that:

a. it does not wish to commercialise certain University intellectual property (which may occur immediately following the University's consideration of the notification pursuant to regulation 10, or subsequently after the University's attempts to commercialise the intellectual property have ended); and
b. retention of ownership of ownership of such University intellectual property is not in the best interests of the University;

then the University must, if requested by the creators, provide a written assignment of the intellectual property to the creators in proportion to their respective creative contributions (or as otherwise agreed by the creators).

Example

The University may elect to retain ownership of a specific item of University intellectual property which relates to an area of the University's strategic research (although this technology is not commercialisable in its present form) to ensure that researchers have freedom to operate in this field in the future or where subsequent developments involving this technology may reasonably be anticipated to have commercial potential.

(2) Only persons who are specifically authorised by the University can consent (on behalf of the University) to the release of the University's confidential information or apply for registration or other protection of any of University intellectual property.

16. Distribution of revenue attributable to commercialisation by licence, option or assignment

(1) If the University derives a financial return from the commercialisation of University intellectual property (including licence fees, sale receipts, royalties, milestone payments, dividends and proceeds from the sale of shares), then it must attribute the applicable net revenue generated by each item of University intellectual property.

(2) In calculating the net revenue attributable to the commercialisation of each specific item of University intellectual property, the University must take the financial return applicable to it-

a. excluding taxes, research and development funds, grant income, consultancy revenue, returns from direct investment by the University or a third party, or any encumbered revenue (until such an encumbrance is lifted); and
b. less any amount expended by the University, including its internal costs (such as those involved in the provision of specific infrastructure, equipment, administration and personnel) and external costs (such as the provision of commercial development, protection or marketing services or the payment of fees and charges provided by service providers such as patent attorneys or lawyers).

(3) The University must distribute the percentage of the net revenue attributable to the commercialisation of each specific item of University intellectual property to the creators of that University intellectual property (where such

creators were University staff members, students or academic visitors at the time that the University intellectual property was created), and allocate the remaining percentages to the appropriate unit within the University and the general fund of the University in accordance with the table at the foot of this sub regulation, subject to-

a. sub regulation (4) and regulation 17; and
b. the terms of any agreement between the University and relevant creators.

Net revenue	Creators	Appropriate unit	University
$1+	40%	30%	30%

(4) If there is any dispute regarding the identity of the appropriate budgetary organisational unit within the University which is to receive a distribution of the net revenue of commercialisation of specific University intellectual property (which has been created within that unit), then the University will make a final and binding determination as to which unit is appropriate.

Note

Employees of organisations who have created University intellectual property, whether through collaborations or as independent contractors, are not entitled to receive any distribution of net revenue from the University.

17. Commercialisation by the formation of a company

(1) If the University decides to acquire shares in a company in exchange for the assignment of University intellectual property (which company may be new or existing), then the creators (who were University staff members, students or academic visitors at the time that the University intellectual property was created) are entitled to that percentage of those shares acquired by the University which equates to the amount of money which the University would have distributed to the creator pursuant to regulation 16, had the value of the shares at the time of acquisition by the University been in cash.

(2) The University shall hold the shares to which the creators are entitled on trust for the creators until the first to occur of-

a. a management buy-out of the company;
b. a trade sale;
c. an initial public offering of shares in the company;
d. liquidation of the company; or
e. an agreement between the creator and the University.

(3) Any dilution of the shareholding (attributable to the company's receipt of the assignment of University intellectual property) as a result of investment in the company or increase in the shareholding (attributable to the company's receipt of the assignment of University intellectual property) as a result of new shares being issued by the company, will be applied to this shareholding equally as between the creators and the University.

(4) On the occurrence of an event specified in sub regulation (2), the University will distribute the proceeds of those shares (or the shares themselves) which are held on trust to the creators. This is the only entitlement to a distribution that arises for creators in respect of such University intellectual property.

(5) The creators are solely responsible for their own taxation matters.

(6) Whilst held on trust, the University may exercise all rights attached to the creators' shares (which it holds on trust for the creators) in the best interests of the University and in an identical manner to its own shares.

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Part 6 - Students

18. Assistance to student

The University must not, other than in exceptional circumstances, provide assistance to a student to patent an invention or commercialise intellectual property unless the student assigns the intellectual property rights to the University in accordance with these Regulations.

19. Assessment and granting of awards

If the University owns intellectual property created by a student, the University must ensure that the ownership does not affect the assessment of the student's academic performance or the granting of an award.

20. Confidentiality

A student, assessor or examiner must not disclose confidential information about University intellectual property, whether such intellectual property is wholly or partly owned by the University, without permission in writing of the University.

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Status and Details

Status	Current
Effective Date	10th September 2014
Review Date	9th September 2029
Approval Authority	University Council
Approval Date	10th September 2014
Expiry Date	Not Applicable
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