



Procedure: IP protection and commercialisation

Purpose

To provide the procedure and processes for protection, commercialisation and sharing of the benefits of the commercialisation of intellectual property (IP).

Procedure

Implementation of Intellectual Property Policy

1. At the request of the University, Staff will:
 - a. execute, in a timely manner, all such confirmations of assignment and ownership, and other documentation reasonably necessary to give effect to the IP ownership and use provisions set out in the IP Policy; and
 - b. provide other assistance as reasonably requested, such as providing evidence as to date of creation, assisting with IP protection procedures, and assistance with enforcement of IP.
2. The University cannot give personal legal advice to students and honorary status holders regarding IP matters and they should seek independent advice (which may include legal advice) before entering any agreement, to ensure they enter the agreement in full knowledge of its implications.

Disclosure of intellectual property

3. Acting promptly can be critical with regard to intellectual property rights. Where a creator believes they have created intellectual property of value and seeks to commercialise this IP, they should contact the Technology Transfer Office as soon as possible. The Technology Transfer Office will then require the creator to complete and return a confidential invention disclosure form (IP Disclosure).
4. The IP Disclosure must provide as complete and accurate information as possible, including listing all those involved in the development of such intellectual property.
5. The Technology Transfer Office will agree with the Creators the next steps with regard to whether IP protection is appropriate, the process for securing protection for such intellectual property, and strategies for its Commercialisation.

Background intellectual property

6. Background intellectual property should be disclosed by the staff, student or honorary status holder to their immediate supervisor, or to the Dean of the relevant ANU College, and to the Technology Transfer Office, before making use of it in any University activity. The written background IP disclosure must include:

- a. a description of the background IP;
- b. any known restrictions on the use of the described IP; and
- c. the names of any other persons (including corporations or organisations) with a legal interest in the described IP.

Protection of intellectual property and publication

7. The University acknowledges the interest of a creator in publishing their research and seeks to facilitate the publication, while preserving the potential value of any IP Disclosure.

8. A creator must not disclose to third parties, or otherwise into the public domain, or submit for publication, University IP that is the subject of an IP Disclosure, before discussing protection strategies with the Technology Transfer Office.

9. If the University has contractual obligations which restrict the publication and/or use of IP Disclosure, the creator must abide by those restrictions.

10. The University will decide, within six months from the receipt of an IP Disclosure, whether or not to proceed with the protection of disclosed IP. The University will make decisions regarding protection of such IP in consultation with the relevant creator/s, ANU Colleges and/or Schools.

11. It is essential that individuals identified as inventors on a patent remain involved in the prosecution of a patent, as their technical knowhow is needed to ensure that patent examiners' queries can effectively be addressed. The University will normally only file and continue to prosecute patents where the creators are committed to the patenting, development and commercialisation processes.

Costs and management of patent filing

12. Patent filing costs will be covered in the following manner:

	Technology Transfer Office (TTO)	ANU College/School
Provisional-filing	100%	0%

PCT-filing	75%	25%
National phase-filing	75%	25%
National phase – prosecution	75%	25%

13. The cost of IP protection can be significant. Continued support for a patent beyond provisional filing will be dependent on a number of factors including: technical validation, market validation, commercial interest, research support for the commercialisation process and return on investment. The decision to proceed beyond provisional filing will be made by the Director, Technology Transfer Office with agreement from the relevant College or School.

Commercialisation of intellectual property

14. Commercialisation of University IP is managed by the Technology Transfer Office. The University will make decisions regarding commercialisation of such IP in consultation with the relevant creator/s, ANU College and/or School.

15. Only those identified in the ANU Delegations Framework are permitted to act on behalf of the University, or act in their own name, to assign, license, protect, enforce, Commercialise or otherwise deal with University IP.

16. Net Income will be shared in the following proportions:

	Up to \$50,000	Over \$50,000
Creator/s	100%	50%
University – ANU College	0%	25%
University - Central Administration (managed by TTO)	0%	25%

17. For the purposes of this procedure, Net Income means the cash revenues actually received by the University from commercialising University IP (including royalties, licence fees, milestone payments, dividends and proceeds from the sale of shares, but not including research and development funds or consulting fees) less any expenses and

costs relating to the protection, registering, management, marketing, commercialising or enforcing of that IP (for example, legal fees, patent attorney fees, financial and technical advice, insurance, marketing and travel, creation of prototypes, University derived proof-of-concept funding, taxes, bank fees and transaction fees). Net Income does not include consideration in the form of equity or shares.

18. In specific agreed instances, the Net Income proportions may be changed with the approval of the Vice-Chancellor.

19. Creators who are staff will be paid via the University payroll system and superannuation will be deducted from the amount paid. The University will be responsible for any associated costs or taxes incurred by the University as a result of the payment.

20. Revenue sharing of Net Income shall continue regardless of whether the creator is still associated with the University. For creators who are not staff, the creator must notify the University of their account details and provide any additional information required by the University to enable payment.

Sharing of benefits where there are joint creators of intellectual property

21. The PVC (Innovation), on recommendation of the appropriate College Dean/s and on advice from the Technology Transfer Office, will determine the individuals who are to be recognised as creators of the intellectual property and may seek any additional information to assist it in determining the pool of creators (joint creators).

22. The joint creators of University IP must together agree in writing the proportion of Net Income to be allocated to each joint creator under clause 16.

23. If a dispute arises between the joint creators as to the proportions to be allocated, the dispute may be referred by any creator to the PVC (Innovation), whose decision shall be final.

24. In settling a dispute under clause 23, the PVC (Innovation) may deal with the dispute in any manner the PVC (Innovation) considers will expedite the resolution of the dispute, including without limitation, withholding distribution of benefits to all creators until a decision has been reached on the proportion of benefit to be received by each individual creator.

Assignment to creator/s

25. In the event that the University does not wish to pursue Commercialisation and/or development of specific University IP then the University may agree to assign the ownership rights to the Creator/s or Joint Creators. In that event the Creators must agree to meet all costs and risks associated with the Commercialisation of the University IP personally (i.e. not from University resources), and any other conditions reasonably

required by the University. Such assignment will only be completed with the agreement of all Creators in compliance with this clause 25.

26. Such an assignment agreement will include provisions the assignee(s) to:
- a. take on liability for all ongoing costs associated with IP protection;
 - b. a royalty payable to the University from income received by the assignee(s) from the commercialisation of the IP once the revenue reaches a defined threshold;
 - c. provide appropriate indemnities for the University with respect to the assignee(s) commercialisation;
 - d. report regularly to the University in relation to progress made with the commercialisation of the University IP and the revenue entitlements of the University; and
 - e. grant the University a licence to use the University IP for education, academic and research purposes.

Dispute resolution

27. If a dispute arises with respect to the application of the Intellectual Property Policy or Procedure the matter should be brought to the attention of the Director, Technology Transfer Office in the first instance. The Director will attempt to resolve the dispute within a period of 2 months from the date of notification of the dispute. If a resolution is not reached the matter will be referred to the PVC (Innovation) for resolution. The decision of the PVC (Innovation) shall be final.

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