

INTELLECTUAL PROPERTY POLICY

FREQUENTLY ASKED QUESTIONS

The following have been developed to assist with interpretation of ECU's Intellectual Property Policy. As not all questions can be captured, if your query is not included here please contact Linda Penny, Manager Research Support at email research-grants@ecu.edu.au.

1. What is Intellectual Property (IP)?

Intellectual property is a term used to refer to different types of property rights over certain products of the human intellect. The Policy defines Intellectual Property with reference to the definition contained in Article 2 of the Convention Establishing the World Intellectual Property Organisation of July 1967 and lists examples of these rights in an Australian context. The most relevant forms of intellectual property to research at ECU are:

- **copyright**, which is a set of rights set out under the *Copyright Act 1968* (Cth) that relate to dealings with the expressive form (rather than the underlying ideas or concepts) of certain original material such as theses, journal articles, books, films, sound recordings, illustrations and computer code; and
- **patents**, which provide monopoly rights with respect to the manufacture and exploitation of inventions that are registered under the *Patents Act 1990* (Cth).

2. Why do I need to assign IP ownership to the University?

There are a number of reasons why you would need to assign your IP to the university the main ones being:

- a) Your project is funded by an external party. As the project agreement is between ECU and the third party, ECU requires ownership of your IP to comply with the agreement obligations;
- b) The university has an invested interest in your project e.g. by commitment of funds/Scholarship/salary and/or in kind resources;

3. Is it compulsory to assign IP ownership?

As a student, it is not compulsory for you to assign your IP. If you are uncomfortable assigning your IP, please speak to your Supervisor and ask about the possibility of being transferred to another project.

As a staff member, 1(b) above would apply where an external party is not involved.

4. When is the best time to assign IP ownership?

It is best for all involved in the research to be clear about the ownership decisions before the research begins. Supervisors should have this discussion with their students as part of their initial discussions.

Staff should discuss IP ownership with their funder early on in the discussions about the research project so that no surprises are in store for either ECU or the funder. ECU's preferred position is that ECU owns the IP, however depending on the funder's investment in the project they may seek to own the IP. In these instances, ECU will negotiate for a license to use the IP for further research, teaching and publication (at a minimum). Where commercialisation is an expected outcome, ECU will also discuss terms for a financial return to the university (and hence the researcher) with the funder.

ORI will provide the Supervisor/CI with the necessary forms.

5. Who can help me discuss any concerns I have in assigning IP ownership?

As a student it is best for you to seek independent legal advice. However, initial discussions may be held with your Supervisor.

6. Will assigning IP ownership affect any decisions I make about publishing my results or assigning copyright associated with publications?

In some circumstances assignment of IP (and most notably copyright) may affect publication. During the negotiation phase ECU will try to limit the effects of this, however it is useful to have the discussion with the funder as part of the project development to explore what is possible.

With respect of a student's PhD thesis, ECU will not accept any negotiated position in an agreement with a funder that would prevent it from being examined. In extreme cases e.g. where the results are commercially sensitive or in the national interest, this may require examiners to sign confidentiality agreements. In other instances the funder may require that the thesis be embargoed for a period of time such as 12-18 months. In these circumstances the student would be advised to consider if the funder's support was in the best interests of their career. In some fields such as defence this may be the norm e.g. in the interests of national security. This is a good reason for holding discussions with the funder as soon as possible.

7. If the University wishes to further develop something that has come from my work, what are my rights?

There are both rights and obligations that come from the further development of a Creator's work. As a first step if the Student should inform their Supervisor, who will in turn approach the Director ORI for advice on the ensuing commercialisation process. A staff member should approach the Director ORI.

If the university decides to proceed with commercialisation of the IP, it will pay the costs associated with IP protection. Sharing of proceeds of commercialisation is generally distributed as:

- a) One half to the Creators between them (Staff and/or Students)
- b) One half to the university, to be shared amongst the Creators' School or Centre at the time the Intellectual Property was developed, and the University's Strategic Initiatives Fund for strategic investment in research or commercialisation

If the university decides not to proceed, the Creator will be advised at which point the Creator may ask for the IP to be assigned to them to be protected and developed at the Creator's own cost.

8. In a case of ECU formerly declining to proceed, but later taking an interest to exploit, what would be the procedure of requesting the IP from the Creator, who now fully owns the IP?

Once the University has assigned the IP, it would be up to the University to approach the Creator for a license to use the IP. For example, the Creator may be asked to collaborate on a project and bring in the IP as background IP; to license their IP to a project without being physically involved in the project; or perhaps to be paid a license fee for use of their IP. The Creator is under no obligation to comply with any requested/suggested involvement in future research. Any collaboration would be covered by a separate agreement negotiated between the university and the Creator.

9. My PhD is self-funded. Do I have to assign IP?

Assignment of a Student's IP is usually only requested where an external funder requires ECU to assign or license the Project IP to them or where an ECU Scholarship is provided.

10. Does an invention as used in the policy cover any research finding?

The term invention is generally considered to apply items that can be manufactured or manufacturing processes. Inventions are protected through the patenting process. However research findings may be also protected as registered designs, by copyright or as a plant variety.