



# Intellectual Property policy

## Section 1 - Preamble

(1) This Policy is effective from 1 January 2021.

(2) This Policy is made under Part 4 of the Deakin University Vice-Chancellor Regulations, pursuant to powers granted in Part 5 of the [Deakin University Act 2009 \(Vic\)](#) and in accordance with Section 13 of the Deakin University Statute.

## Section 2 - Purpose

(3) This Policy governs the development, ownership and commercialisation of University Intellectual Property (IP).

## Section 3 - Scope

(4) This Policy applies to officers, staff, visitors, affiliates and students of Deakin University.

## Section 4 - Policy

### Ownership of works

(5) This Policy applies to the following categories of Works:

- a. Staff Works: an umbrella term encompassing all works created by an officer, staff member or affiliate, and irrespective of whether there was an express duty to create the Work:
  - i. in the course of or incidental to their employment at or engagement by Deakin University; or
  - ii. where Deakin University resources are utilised in the creation of the Works; or
  - iii. where Deakin University IP is incorporated in the Works.
- b. Scholarly Works: a subset of Staff Works which are based on the staff member's scholarship, learning or research and intended for academic publication (for example, an article, conference paper or book chapter/s) or peer review in any format (for example, by exhibition, display or performance) (but do not include Teaching Materials, which are dealt with in clause 5(c) below); and
- c. Teaching Materials: works, in any medium, created by a staff member (irrespective of whether or not this occurs under a specific direction to do so) for the primary purpose of teaching and learning, and as more fully defined in section 6 - Definitions of this Policy.
- d. Student Works: works created by a student in the course of their enrolment at Deakin University, usually for the purposes of assessment or fulfilling course requirements, but may also arise in other ways. Deakin University acknowledges that students own the Intellectual Property Rights subsisting in Student Works, while recognising that in some circumstances students may not be the sole owner of those Intellectual Property Rights or may be contractually obliged to assign ownership of those Intellectual Property Rights either to Deakin University or to a third party (as set out in clause 11).

## **Staff**

### **Staff works**

(6) All Intellectual Property Rights in Staff Works are owned by Deakin University. Officers and staff members hereby assign such Intellectual Property Rights to Deakin University immediately on their creation.

### **Scholarly works**

(7) Where the Staff Works referenced in clause 6 are Scholarly Works, Deakin University assigns ownership of the Intellectual Property Rights in the Scholarly Works to the originating staff member subject to the preservation for Deakin University of a perpetual worldwide, non-exclusive, royalty free licence to reproduce, publish, perform, communicate, disseminate, modify and adapt the Works for Deakin University's teaching, research and promotional purposes. The licence retained by Deakin University is subject to any overriding contractual obligations the originator owes to third parties (for example, a publisher of a textbook or a journal article).

### **Teaching Materials**

(8) Deakin University grants staff members a non-exclusive, non-transferable, royalty free licence to use Teaching Materials for the purposes of their own teaching, education and research at Deakin University. Unless agreed otherwise by the Intellectual Property Officer, staff members may not:

- a. sub-license or assign the rights to use the Teaching Materials;
- b. use the Teaching Materials to generate royalties or licence fees; or
- c. use the Teaching Materials for further academic research or teaching purposes other than at Deakin University.

(9) Any Works that may be considered to be both a Scholarly Work and Teaching Materials will be treated as Teaching Materials for the purposes of this Policy.

## **Students**

### **Student works**

(10) Intellectual Property Rights in Student Works are prima facie owned by the student, subject to clauses 10-19 and clause 11 in particular.

### **Assignment or commercialisation of Intellectual Property Rights**

(11) Students may be required by Deakin University or a third party to license or assign the Intellectual Property Rights in a student work to another party in circumstances where:

- a. the work was created jointly or subject to enforceable contractual obligations;
- b. it is a condition of a placement with an external host or agency undertaken as part of or ancillary to the course in which the student is enrolled, and that host or agency requires the licence or assignment;
- c. the student is participating in a collaborative team project where their work forms part of a planned research program and the Intellectual Property Rights developed as a result of the project forms part of the project outcomes (for example, in a Cooperative Research Centre, Deakin University Institute, or similar activity);
- d. there is collaboration with another researcher (other than the student's supervisor) or a research team within or outside Deakin University;
- e. the student's research requires the use of pre-existing University Intellectual Property (for example, work which is the subject of a provisional or complete patent application) or where Deakin University intends to file a patent application;
- f. the student receives funding (whether in part or full) for a research project or stipend from industry or other

- sources (not being a Commonwealth or Deakin University allocated competitive scholarship);
- g. the student is funded (whether in part or full) under research or other contractual agreements which require Deakin University (or other party) to own the relevant Intellectual Property Rights; or
  - h. the student is a co-originator of Exploitable IP with a Deakin staff member or under a project with a third party industry or other sponsor.

### **Deakin University Support**

(12) HDR supervisors must consider any relevant Intellectual Property Rights that the student may need to access and utilise as well as any Intellectual Property Rights that may be created in the course of the student's HDR project, and discuss the implications with the student at the outset of the project.

(13) Deakin Research Training is provided to assist HDR supervisors and students to understand the implications of any ownership or use rights in respect of Intellectual Property Rights used or created by the student, particularly for the purposes of thesis examination and publication.

(14) Where a third party (such as an industry partner) funds a student project, a written agreement entered into by Deakin University, the third party and the student will document the agreed terms and conditions on which the project is to be undertaken. Deakin Research provides assistance with standard agreements, placement agreements and negotiating tailored arrangements where required.

(15) Administration of undergraduate agreements post-signing will be managed by each faculty.

(16) Administration of HDR agreements post-signing will be managed by Deakin Research.

(17) Deakin University is unable to provide students with legal advice in respect of their individual Intellectual Property Rights creation, ownership or rights of use. It therefore recommends that students seek independent legal advice before signing an Intellectual Property Rights related agreement. Supervisors have discretion to provide up to \$400 from project funds to assist students to seek independent legal advice, or as otherwise agreed or determined by the Intellectual Property Officer from time to time.

### **Distribution of revenues from commercialisation of Intellectual Property Rights**

(18) Students who assign Intellectual Property Rights in a Student Work to the University are entitled to share in any net commercialisation revenue paid to Deakin University and arising from commercialisation of those Intellectual Property Rights as if they are designated as 'staff' in this Policy.

### **Alternative projects**

(19) A student who elects not to assign their Intellectual Property Rights pursuant to clause 11, must cease any involvement in the activity that triggered the request to assign. If this means that the student's project is no longer viable, Deakin University shall use best endeavours to ensure that an alternate project and supervision options are pursued so far as possible to avoid academic disadvantage caused by the student's decision not to participate in the project.

### **Affiliates**

(20) In the ordinary course, the terms of any written agreement in place between Deakin University and an affiliate shall prevail over the terms of this Policy.

(21) In the absence of a written agreement, this Policy shall apply as if an affiliate is a Deakin University staff member. However, an affiliate is not entitled to share in the proceeds of commercialisation unless specifically approved by the Intellectual Property Officer.

## Visitors

(22) In the ordinary course, the terms of any written agreement in place between Deakin University and a visitor shall prevail over the terms of this Policy.

(23) In the absence of a written agreement:

- a. Subject to sub-clause 23(b), this Policy shall apply as if a visitor is a Deakin University staff member for the period of the appointment as visitor.
- b. Deakin claims ownership to Intellectual Property Rights in the works of a visitor as an originator of University Intellectual Property where Deakin University makes a material contribution to the creation of works by the visitor, including but not limited to the provision of resources, access to facilities, or the provision of ideas or intellectual property (background intellectual property) used in the creation of the works. Where Deakin University makes a material contribution, Deakin University claims an ownership interest in the intellectual property rights proportionate to the material contribution made. The visitor is entitled to share in the proceeds of commercialisation of these intellectual property rights to the same extent as a staff member.

## Commercialisation of University Intellectual Property

(24) Deakin University is committed to the fair and transparent assessment, evaluation, development and management of Exploitable IP.

(25) Commercialisation of Exploitable IP is managed by Deputy Vice-Chancellor Research (or delegate) in accordance with this Policy.

(26) The aims of commercialisation are:

- a. to obtain financial and non-financial support for research activities;
- b. to obtain a fair return for the skill and effort of researchers and the investment of Deakin University; and
- c. to apply knowledge for public good.

(27) Staff must co-operate with all reasonable requests from Deputy Vice-Chancellor Research (or delegate) to support and assist Deakin University to commercialise University Intellectual Property, including staff members who invent or are the originator of the Exploitable IP.

(28) Deakin University:

- a. may exercise its discretion to commercialise any Exploitable IP (but is not required to do so);
- b. is responsible for determining and deploying the strategy to commercialise the Exploitable IP subject to (c) and (d);
- c. will take reasonable steps to inform and consult with Originators and to ensure that arrangements entered into and dealing with the commercial rights to Exploitable IP are fair and equitable; and
- d. is not bound to pursue a commercialisation strategy preferred by an originator.

(29) Staff are required to disclose to Deakin University any Exploitable IP in any Staff Works as soon as practicable after its creation by submitting an [Invention Disclosure form](#) (as set out below in Section 5 - Procedure).

(30) Staff who wish to use any works in the course of their employment at Deakin University that were created prior to their employment at Deakin University (or outside the scope of their employment at Deakin University) are required to disclose those works to their supervisor, together with any encumbrances or conditions or limitations on those works or on the Intellectual Property Rights in those works, prior to incorporating them in any works created at Deakin University.

(31) Subject to clause 7, a staff member who ceases employment with Deakin University is not entitled to use any Staff Works, give or provide any Staff Works (or access to those works), to any person, or to transfer any Intellectual Property Rights in any Staff Works, without the express permission of the Intellectual Property Officer.

### **Proceeds of commercialisation**

(32) Net commercialisation returns received by Deakin University from Exploitable IP will be distributed according to the following formula (unless otherwise agreed):

- a. Originators (collectively) are apportioned one third (33.3%) (and in equal shares unless the originators agree and document otherwise); and
- b. Deakin University is apportioned two thirds (66.66%), of which one half is apportioned to Deakin Research, and the other half is apportioned to the faculty, institute or business unit in which the Originator is based.

(33) Net commercialisation returns received by Deakin University from Exploitable IP will be remitted to the Originators (or their heirs or assigns) in accordance with clause 32, notwithstanding that the Originator's employment at Deakin University may have ceased.

(34) Any dispute between originators as to the identity of potential originators, their relative contributions or the valuation or distribution of their share of returns will be referred to the Intellectual Property Officer for resolution and the decision shall be final.

(35) For the avoidance of doubt, the following are not to be considered to form part of the commercialisation returns for the purposes of this Policy:

- a. monies received by Deakin University for further research, development, trials or demonstration of Staff Works; and
- b. any returns received by Deakin University referable to its investment where it has chosen to invest in Exploitable IP.

(36) An Originator may wholly assign their rights to net commercialisation revenue to:

- a. Deakin University in exchange for agreed consideration (for example, an equity stake or option in an entity established by Deakin University for the purposes of commercialisation of the Exploitable IP);
- b. Deakin University on agreed terms (for example, to relinquish their right to net commercialisation returns), or
- c. a third party only with the prior written consent of the Intellectual Property Officer and in alignment with other relevant Deakin University policies.

(37) Deakin University retains the right to license or assign the Exploitable IP to a third party and:

- a. originators may be offered equity or an option in a third party (non-controlled) entity on conditions which may include relinquishment of the right to net commercialisation returns from Deakin University; and
- b. the principles set out in clauses 24–38 will apply, and offers of equity, options or other proceeds will also take into account the costs of commercialisation and a net benefit may accrue.

(38) A staff member who, by deliberate act or omission, is found by the Intellectual Property Officer to have undermined the commercialisation of Exploitable IP and/or caused loss to Deakin University or any originator, may forfeit any entitlement to benefit under clauses 24-38 of this Policy.

### **Acknowledgement of Moral Rights**

(39) Deakin University will take reasonable steps to ensure that an originator is acknowledged in any relevant

documents in relation to Intellectual Property Rights (other than copyright) owned by Deakin University.

(40) For copyright material owned by Deakin University, Deakin University will use its best endeavours to respect the moral rights of each originator by:

- a. ensuring that the originator is acknowledged (in so far as this is reasonable);
- b. consulting with the originator before modifying or adapting, or authorising modification or adaption, of the originator's material;
- c. consulting with and obtaining the agreement of the originator and the adaptor as to the attribution provided in any adaption or modification;
- d. after consultation with the originator, ensuring that acknowledgement of the author or performer is a term of any assignment or licence of the material; and
- e. ensuring that any request by the originator not to be acknowledged is respected.

## **Intellectual Property Rights and Indigenous Peoples**

(41) Deakin University acknowledges the [United Nations Declaration on the Rights of Indigenous Peoples](#) and recognises and respects indigenous cultural heritage, traditional knowledge and traditional cultural expressions and will protect indigenous cultural and Intellectual Property Rights.

# **Section 5 - Procedure**

## **Notification of creation of Intellectual Property Rights**

(42) Any staff member or student who creates University Intellectual Property that they believe may be Exploitable IP (whether or not patentable), must as soon as possible after its creation notify:

- a. their supervisor, if they are a student,
- b. their Executive Dean, Head of School or Institute Director, and the Intellectual Property Officer (or delegate), if they are staff.

## **Originators must co-operate with Deputy Vice-Chancellor Research and provide assistance as required**

(43) An originator of Exploitable IP notified under clause 42 must provide all relevant information and must co-operate with Deputy Vice-Chancellor Research (or delegate) to provide further information (including new particulars, data, results, findings, commercial interactions and updates) as soon as such information becomes available.

(44) An originator must do and sign all such things and documents as may be necessary to protect University IP or to prove ownership of Intellectual Property Rights (including after the end of the originator's employment by, or studies or research with, Deakin University).

(45) An originator must not do anything to prevent the disclosure, evaluation or commercialisation of the Exploitable IP by Deakin University.

(46) Deakin University will normally only file and continue to prosecute patents where the originators are committed to the patenting, further research and development of the IP and commercialisation processes. It is therefore essential that the originators identified as inventors on a patent application remain involved in the prosecution of a patent, as their technical know-how is needed to ensure that patent examiners' queries can effectively be addressed.

(47) If an originator fails to do that which is required within a reasonable period (three months from date of original

request), or Deakin University is not able to contact the originator after Deakin University has made reasonable enquiry, the Intellectual Property Officer may execute all necessary documents relating to the ownership or transfer of Intellectual Property Rights and do such other acts as their attorney.

## **Evaluating commercial value of University Intellectual Property**

(48) The Intellectual Property Officer is responsible for the management, protection and exploitation of University IP and will consult with originators, Deakin Research and General Counsel as appropriate. Decisions will be communicated to originators in a reasonable timeframe.

(49) The Deputy Vice-Chancellor Research (or delegate) will establish the Intellectual Property Assessment Committee (IPAC) to consider and make recommendations to the Intellectual Property Officer in relation to:

- a. the initial assessment and valuation of University IP in accordance with its internal processes; and
- b. strategies for the protection and exploitation of University IP, and particularly whether a patent application should be considered.

(50) The Deputy Vice-Chancellor Research (or delegate) is responsible for working with originators to prepare information for the evaluation process and for communicating with originators at each stage of the evaluation and commercialisation process.

(51) The Intellectual Property Officer (or delegate) will determine whether to proceed with the protection of disclosed intellectual property.

(52) Legal protection and effective commercial exploitation of intellectual property may depend on maintaining the secrecy of the Exploitable IP as confidential information. During the period in which Deakin University receives, considers, evaluates and seeks to protect and/or commercialise the Exploitable IP, those Intellectual Property Rights are the University's strictly confidential information and the originator, staff, students and any other person aware of it must not disclose the creation or details of the Intellectual Property Rights without the prior permission of the Intellectual Property Officer.

## **Decisions regarding Intellectual Property Rights**

(53) The Intellectual Property Officer will establish the Commercialisation Committee (whose composition will include the Deputy Vice-Chancellor Research, Chief Financial Officer, Executive Director, Deakin Research Innovations and General Counsel) to consider, advise, endorse and approve commercialisation proposals initiated by Deputy Vice-Chancellor Research (or delegate) or elsewhere within the University (subject to the requirements of the [Deakin University Act 2009 \(Vic\)](#), the University statute, regulations, policies and procedures – most specifically the Ministerial Guidelines concerning commercial activities and [Commercial Activities and Entities policy](#) and [Commercial Activities and Entities procedure](#) which may require the further approval of the Vice-Chancellor and Council) including in relation to:

- a. Commencing or ceasing:
  - i. Licensing of University IP to a third party where the value of the licence exceeds \$100,000
  - ii. Assignment of University IP to a third party where the value of the licence exceeds \$100,000
  - iii. Establishing or participating in a commercial venture or enterprise including a partnership, joint venture, company or other entity
  - iv. Establishing or participating in a non-commercial venture or enterprise including a not for profit activity or company limited by guarantee
- b. Acquisition or disposal of shares, including shares received for no cost
- c. Other matters as reflected in the terms of reference approved by the Intellectual Property Officer.

## Reversion

(54) If a decision is made by Deakin University not to commercialise Exploitable IP or to cease to continue to commercialise it, Deakin University may offer to assign to the originators the Exploitable IP on reasonable terms and conditions. Any such assignment will also be subject to a perpetual worldwide, non-exclusive, royalty free licence for Deakin University to reproduce, publish, perform, communicate, disseminate, modify and adapt the work for Deakin University's teaching, research and promotional purposes, and where this is consistent with Deakin University policy, to provide open access to the work.

## Dispute resolution

(55) An originator who is dissatisfied with a decision of the Intellectual Property Officer other than a dispute arising under clause 34 of this Policy may, within 30 days of being informed of the decision, submit a written request to the Vice-Chancellor to review the decision. The Vice-Chancellor's decision is final.

## Delegations

(56) Delegations are as set out in the following table:

Delegator	Delegate	Scope
Deputy Vice-Chancellor Research	Executive Director, Deakin Research Innovations	Responsibility for management of commercialisation of Exploitable Intellectual Property in accordance with clause 25. Responsibility for establishing the Intellectual Property Assessment Committee in accordance with clause 49.
Intellectual Property Officer	Executive Director, Deakin Research Innovations	Responsibility for the management, protection and exploitation of University Intellectual Property in accordance with clause 43.

## Section 6 - Definitions

(57) For the purpose of this Policy:

- a. Act: means the [Deakin University Act 2009 \(Vic\)](#).
- b. affiliate: means
  - i. the holder of a clinical title appointed or recognised by Deakin;
  - ii. adjunct, conjoint and honorary appointee;
  - iii. consultants and contractors to Deakin University;
  - iv. any other person appointed or engaged by Deakin University who may perform research or teaching duties or functions on its behalf, not including a staff member or a visitor.
- c. commercialisation: means the application, publication, development, use, assignment, licensing, sub-licensing, franchising, exploitation, sale or other utilisation of Intellectual Property Rights for the purpose of generating financial or other commercial gains.
- d. copyright: means any rights protected under the [Copyright Act 1968 \(Cth\)](#).
- e. Deakin University means Deakin University as established under the [Act](#).
- f. Deakin University resources: means resources provided by Deakin University, including:
  - i. Deakin University IP;
  - ii. premises and facilities;



- iii. funds;
  - iv. services and equipment;
  - v. paid leave;
  - vi. staff assistance.
- g. Exploitable IP: means Intellectual Property Rights which may be the subject of commercialisation by Deakin University.
- h. HDR: means higher degree by research.
- i. Indigenous cultural and intellectual property rights: means Indigenous peoples' rights to their heritage, consisting of intangible and tangible aspects of the whole body of cultural practices, resources and knowledge systems developed, nurtured and refined by Indigenous people and passed on by them as part of expressing their cultural identity, including as reflected in article 31 of the United Nations Declaration of the Rights of Indigenous Peoples.
- j. Intellectual Property Rights: means all industrial and intellectual property rights of whatever nature throughout the world conferred under statute, common law or equity, whether existing now or at any time in the future, and includes rights in respect of or in connection with:
- i. copyright, neighboring rights, circuit layouts, and the protection of databases, semiconductors, circuit layouts, topographies;
  - ii. inventions (whether or not patentable), patents, formulae, databases, business processes and methods;
  - iii. plant varieties and scientific discoveries;
  - iv. trade marks, service marks, trading names (including both business and company names), domain names;
  - v. designs;
  - vi. confidential information, trade secrets and know-how,
  - vii. Indigenous cultural and intellectual property rights, and
  - viii. other industrial and intellectual property rights, whether or not registered or registrable, and includes the right to apply for or renew the registration of such rights.
- k. Intellectual Property Officer: means the principal officer appointed by the Vice-Chancellor from time to time to be responsible for the management of the University's Intellectual Property. As at the date of this Policy, the principal officer appointed by the Vice-Chancellor is the Deputy Vice-Chancellor Research.
- l. moral rights: has the meaning given to it in the [Copyright Act 1968 \(Cth\)](#) and includes, in relation to an author or performer:
- i. a right of attribution of authorship or performership;
  - ii. a right not to have authorship or performership falsely attributed; and
  - iii. a right of integrity of authorship or performership.
- m. net commercialisation returns: means the balance of monies or other forms of gain (such as shares, options etc) remaining after the costs of protection, commercialisation, marketing and other reasonable expenses incurred by Deakin University are deducted, all as determined by Deakin University.
- n. officer: means a person:
- i. who makes, or participates in making, decisions that affect the whole, or a substantial part, of Deakin University; or
  - ii. who has the capacity to affect significantly Deakin University's financial standing.
- o. originators means:
- i. for patentable inventions, Deakin University staff or students entitled to be named on the patent as inventors under the [Patents Act 1990 \(Cth\)](#); and
  - ii. for non-patentable Intellectual Property Rights, Deakin University staff and students who create

Intellectual Property Rights, whether alone or jointly with another person.

- p. scholarly work is defined in clause 5 of this Policy, and means a work which is based on the originator's scholarship, learning or research and is intended for academic publication, but not including teaching materials.
- q. staff or staff member: means a person employed by Deakin University.
- r. staff works: is defined in clause 5 of this Policy, and means works created by a staff member:
  - i. in the course of or incidental to their employment at Deakin University; or
  - ii. where Deakin University resources are utilised in the creation of the works; or
  - iii. where Deakin University IP is incorporated in the works.
- s. student: means, in addition to the meaning in the [Act](#), a person who is enrolled in a program of study (including, but not limited to, a course leading to an award or a unit within a course, or a HDR) offered by Deakin University.
- t. student works: means the works created by students of Deakin University in their capacity as a student.
- u. teaching materials: is defined in section 5 of this Policy, and means any materials, in any medium, created by staff (regardless of whether or not this occurs under a specific direction to do so) for the primary purpose of teaching and learning. Teaching materials include, but are not limited to:
  - i. lecture notes and materials;
  - ii. syllabes;
  - iii. handouts;
  - iv. study guides;
  - v. course software; and
  - vi. assessment materials.
- v. University Intellectual Property or University IP: means Intellectual Property Rights owned or developed by Deakin University (including Intellectual Property Rights owned by Deakin University pursuant to this Policy).
- w. visitor: means an individual, entity or corporation given access to Deakin University resources for the purposes of undertaking academic study, education, research or development, whether or not in collaboration with the University.
- x. works: means any and all:
  - i. artistic, dramatic, literary and musical works;
  - ii. documents, reports, designs, and drawings;
  - iii. teaching materials;
  - iv. articles, books, essays, and poems;
  - v. photographs, cinematograph films, sound recordings, broadcasts and live performances;
  - vi. field and laboratory notebooks;
  - vii. computer software and programs, databases and multimedia subject matter;
  - viii. prototypes; and
  - ix. any other item or thing in which Intellectual Property Rights are capable of subsisting.

## Status and Details

<b>Status</b>	Current
<b>Effective Date</b>	1st January 2021
<b>Review Date</b>	1st January 2026
<b>Approval Authority</b>	Vice-Chancellor
<b>Approval Date</b>	18th December 2020
<b>Expiry Date</b>	To Be Advised
<b>Responsible Executive</b>	Julie Owens Deputy Vice-Chancellor Research +61 3 522 73486
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