

Procedure: IP protection and commercialisation

Purpose

To outline the rights and responsibilities of the University and University Staff, Students, Visitors and Visiting Fellows in respect of processes for protection, commercialisation and sharing of the benefits of the commercialisation of intellectual property (IP).

Procedure

Relevant Documents:

- * Intellectual Property Policy
- * Student intellectual property procedure

Definitions relevant to this Procedure can be found in the [Intellectual Property Policy](#).

Disclosure of IP

1. Acting promptly can be critical with regard to IP rights. Where a Creator believes they have created University IP that may have Commercial potential, they should contact the Office of Business Engagement and Commercialisation (BEC) as soon as possible. BEC will then require the Creator to complete and return a confidential [invention disclosure form](#).
2. The IP Disclosure must provide as complete and accurate information as possible, including listing all those involved in the development of such IP.
3. At the request of the University, University Staff, Students, Visitors and Visiting Fellows 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 principles set out in the IP Policy, including Background IP; and
 - b. provide other assistance as reasonably requested, such as providing evidence as to date of creation, assisting with IP protection, and assisting with enforcement of IP rights.

Confirmation of Ownership and Assignment of Student / Visitor and Visiting Fellow IP

4. For probity reasons the University may request that Staff sign a confirmatory assignment, the purpose of which is to have written confirmation that the University has clear ownership of the University IP that is to be the subject of any Commercialisation activity.
5. Where a Student and/or Visiting Fellow/Visitor is a joint Creator of the University IP that is to be the subject of any Commercialisation activity they will be requested to sign an IP assignment agreement that transfers ownership of the relevant University IP from the Student and/or Visiting Fellow/Visitor to the University.
6. The University cannot give personal legal advice to individuals regarding agreements between the University and individuals and individuals are encouraged seek independent advice (which may include legal advice) before entering into any such agreements, to ensure they enter into the agreement in full knowledge of its implications.

Background IP

7. University Staff, Students, Visitors and Visiting Fellows must declare any Background IP or confidential information they wish to use in any research activity prior to the commencement of that activity to their immediate supervisor, or to the Dean of the relevant ANU College, and to BEC. 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.
8. Where the Background IP is owned by University Staff, Student, Visitor or Visiting fellow, a written agreement between the individual and the University must be in place prior to commencement of the research activity to licence or assign the IP to the University. Whether a licence or assignment is required will depend on the nature of the research activity, including the presence of any funders or collaborators.
9. Where the Background IP is owned by a third party, the University Staff, Student, Visitor or Visiting Fellow must provide any documentation that gives them the right to use the IP to the University prior to the commencement of the research activity.

The University will review the documentation and determine the form of agreement necessary for the IP to be used in the research activity.

10. Agreements to govern Background IP must also grant a right to the University and any relevant third parties to use or disclose confidential information that the individual has the right to use or disclose.
11. The research activity must not commence until the appropriate written agreement/s as determined by the University are in place.

Evaluation of potential and pathway for commercialisation

12. The University will:
 - a. consult with the Creators the next steps with regard to whether IP protection is appropriate, the process for securing protection for such IP, and strategies for its Commercialisation, and.
 - b. undertake due diligence on University IP during the preliminary evaluation period. Such due diligence may include the investigation of the prior art, third party encumbrances and/or reliance on, or contribution of background IP, the potential market and potential competitors.
13. The University will decide, within six months from the receipt of an IP Disclosure, whether or not to proceed with Commercialisation and/ or the protection of University IP. The University will make decisions regarding protection of such IP in consultation with the relevant Creator/s, ANU Colleges and/or Schools.
14. Commercialisation of University IP relies on a close collaboration between the Creators and the University and the ongoing commitment of the Creators to support the Commercialisation activities is essential.

Protection of intellectual property and publication

15. The University acknowledges the interest of a Creator in publishing their research and seeks to facilitate academic publication, while preserving the potential value of any IP Disclosure.
16. 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 BEC.
17. Publishing your idea in any form may jeopardise your ability to claim a patent or design right before you even apply. This also means not tweeting your idea or putting on Facebook, not writing about it in trade journals and keeping your idea out

of the public domain. If you need to share sensitive information, use a non-disclosure agreement (NDA).

18. If the University has contractual obligations which restrict the publication and/or use of IP, the Creator must always abide by those restrictions regardless of whether the IP is the subject of an IP Disclosure.

19. 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 IP protection

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

	BEC	ANU College/School
Provisional-filing	100%	0%
PCT-filing (international patent protection)	75%	25%
National phase-filing	75%	25%
National phase – prosecution	75%	25%
Registered Trademark	75%	25%

21. 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, BEC with agreement from the relevant College or School.

Commercialisation of intellectual property (excluding Creator-led startups and assignment to Creators)

22. Commercialisation of University IP is managed by BEC. The University will make decisions regarding Commercialisation of such IP based on Commercial potential or strategic benefit in consultation with the relevant Creator/s, ANU College and/or School.
23. Only those identified in the ANU Delegations Framework are permitted to act on behalf of the University to assign, license, protect, enforce, Commercialise or otherwise deal with University IP.
24. Unless otherwise agreed between the University and Creators and subject to any third party obligations, 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 BEC)	0%	25%

25. 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 and trademark 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).
26. Revenue sharing of Net Income shall continue regardless of whether the Creator is still associated with the University. Payments will be made via the University finance system. For Creators who are Students, Visiting Fellows or Visitors, or who cease to be Staff, the Creator must notify the University of their current contact and account

details and provide any additional information required by the University to enable payment.

27. If a Creator does not comply with paragraph 26 and, as a result, the University cannot make contact with a Creator within three (3) years of initial notice of Net Income received, the University will have no further obligation to locate nor pay the Creator its share of Net Income.

Sharing of Net Income where there are joint creators of intellectual property

28. If there is more than one Creator of University IP, the pool of Creators (Joint Creators) must together agree in writing the proportion of Net Income to be allocated to each Joint Creator. Each Creator must agree to the proportional split in writing to BEC and confirm that, to the best of their knowledge, all Creators have been named.
29. If a dispute arises between the Joint Creators as to the proportions to be allocated or the individuals to be included, the dispute may be referred by any Creator to the Deputy Vice-Chancellor (Research & Innovation), whose decision shall be final.
30. In settling a dispute under paragraph 27, the DVC (Research & Innovation) may deal with the dispute in any manner the DVC (Research & 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.

Commercialisation via ANU Startup

31. Where Commercialisation of University IP occurs via an ANU Startup:
- a. the University will receive shares in the ANU Startup in consideration for licensing or assigning the University IP to the ANU Startup;
 - b. it is expected that all Creators of University IP to be licensed or assigned to the ANU Startup (ANU Startup Creators) will be given the opportunity to receive shares in the ANU Startup and as such will not be entitled to Net Income derived from equity or shares received by University from the ANU Startup;
 - c. the ANU Startup will be required to demonstrate that all ANU Startup Creators have had the opportunity to benefit from Commercialisation by the ANU Startup via an issue of shares or otherwise; and
 - d. as a condition to the licence or assignment of University IP to the ANU Startup, ANU Startup Creators (whether or not they elect to hold shares) will be required

to sign a waiver with the University to acknowledge they are not entitled to Net Income under this Procedure.

32. For the purposes of this procedure, ANU Startup means a startup company established by current or recent Staff for purpose of Commercialising University IP.
33. Net Income derived from the sale of shares in ANU Startups will be distributed as follows: 50% the relevant College(s) and 50% Central Administration (administered by BEC).
34. Where:
 - a. a Creator does not wish to personally hold its agreed distribution of shares in the ANU Startup; or
 - b. the ANU Startup does not wish to issue the shares to the Creator,
 - c. that Creator shall be known as a Non-Participating Creator.
35. Where the ANU Startup has made a request to the University that the University hold the Non-Participating Creator shares, the University will make a decision, in its sole discretion, as to whether to hold the shares.
36. If the University accepts to hold the Non-Participating Creator shares under paragraph 35, the University may, in its sole discretion, sell all or a portion of the Non-Participating Creator shares. Within 60 days of any sale of Non-Participating shares the University shall pay to the Non-Participating Creator the returns from the sale.

Assignment to creator/s

37. In the event that the University does not wish to lead Commercialisation and/or development of specific University IP then the University may agree to assign the rights to the Creators. As a condition of the grant of rights the assignees 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 those Creators to the conditions in paragraphs 38 and 39 below.
38. Such an assignment agreement will include provisions for the assignee(s) to:
 - a. take on liability for all ongoing costs associated with IP protection;
 - b. pay a royalty to the University from income already 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 Commercialisation by the assignee(s);
- 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.

39. Where University IP is assigned or licensed to the Creators:

- a. it is expected that all Creators will have been given the opportunity to receive benefits from any subsequent Commercialisation activity and as such will not be entitled to further Net Income derived from Commercialisation; and
- b. these Creators will be required to sign a waiver with the University to acknowledge they are not entitled to further Net Income

Dispute resolution

40. 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, BEC 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 DVC (Research & Innovation) for resolution. The decision of the DVC (Research & Innovation) shall be final.

Document information

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