



Intellectual Property (IP)

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Intellectual Property

- “Property of your mind or intellect”
- Various rights for the protection of “creative effort”
- Includes
 - ✓ *Copyright, authorship & moral rights*
 - ✓ *Inventions & discoveries*
 - ✓ *Patents*
 - ✓ *Trademarks*
 - ✓ *Industrial Designs*
 - ✓ *Literary or artistic works*
 - ✓ *Performances & recordings*
 - ✓ *Broadcasts*
 - ✓ *Plant Breeders Rights*
 - ✓ *Circuit layouts*
 - ✓ *Trade secrets*
 - ✓ *Confidential information*
 - ✓ *Multimedia subject matter*



UNSW IP Policy

- Different Universities handle IP differently
- UNSW has an obligation and a responsibility to ensure that all IP developed is captured and protected
- UNSW's IP Policy binds all staff employed by this University and indicates how student IP is handled
- A copy of the IP Policy is on the UNSW Website
- NewSouth Innovations is geared to provide assistance at UNSW



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Ownership of Staff IP

- UNSW **asserts ownership** of all IP including
 - teaching/course material
 - but UNSW may give staff a license to use it
 - anything created at the express request or direction of the University
- The University **does not assert ownership** over scholarly books, journal articles, conference papers, musical, dramatic or other creative works
 - **UNLESS** specifically commissioned by UNSW
 - UNSW retains a license to use them
- The University (through NewSouth Innovations) will patent and commercialise IP and any commercial benefit is shared
 - 1/3rd Inventors – 1/3rd University – 1/3rd NSi



Ownership of Student IP

- In almost all cases, UNSW **asserts ownership** over any IP that is created by students where
 - generation of IP required use of UNSW resources
 - generation of IP relies on pre-existing IP owned by UNSW
 - the IP belongs to a team of which the student is a member
 - the IP is the result of funding to UNSW
- Students at UNSW are entitled to a share of any commercial benefits (equivalent to members of staff)
- A student may be required to assign his/her IP rights where he/she is involved in research activities that involve third party agreements e.g. Research Institutes, CRC's, Industry
 - **NOTE** - students may not have access to some areas of research if they are not willing to assign their IP



Staff Responsibilities

- Staff members have a responsibility to ensure that all IP is appropriately reported and adequately protected
- **BEFORE** any student commences his/her research activities
 - **UNSW STAFF MUST** ensure that students are made aware of any requirement to
 - assign or give consent in relation to intellectual property
 - work under specific confidentiality arrangements



Student Participation in Research

- Student participation in research which may result in IP
 - should be discussed openly with the supervisor
 - should not interfere with academic progress
 - should not compromise future career choices
 - should result in benefits equivalent to a member of staff if the IP is commercialised
 - may result in a delay in confidential sections of a thesis being publicly available in the library
 - maximum of 2 years

Commercialisation of IP



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- NewSouth Innovations Pty Ltd
 - UNSW Controlled Entity
 - primary role is to protect and commercialise UNSW IP
- Notify NSi and disclose IP – take their advice and help
- NSi will assess commercial potential of all projects
 - generally up to 8 weeks to make a decision on commercialisation
 - Yes
 - NSi proceeds with commercialisation - any benefits are shared
 - No
 - IP is assigned to the inventors



Student Responsibilities

- Ask your supervisor to think about IP issues
- Discuss future IP rights with your supervisor
- Discuss authorship and acknowledgement issues with your supervisor in general terms ***before specific examples arise***
- Take legal advice if necessary
- Talk to your family and friends
- Think about your options
- Don' t be “pressured“ into signing anything
- Use laboratory note books and other records effectively



Authorship

- UNSW's *Code of Conduct for the Responsible Practice of Research* sets out requirements for authorship
- Criteria for Authorship
 1. substantial contributions to conception and design, or acquisition of data, or analysis and interpretation of data
 2. drafting the article or reviewing it critically for important intellectual content
 3. final approval of the version to be published
- The acquisition of funding, collection of data or general supervision of the research group are not criteria for authorship in themselves



Authorship

- Where a person does not qualify as an author, but has contributed to the work
 - the person should be named and acknowledged
 - the person's contribution should be described
- Research students must be recognised as authors according to the same criteria as all other authors participating in the research
 - **a valid author cannot be excluded** without their permission in writing
 - someone cannot be included as an author who does not meet the authorship criteria



Authorship

- The order in which names appear on the list of authors differs between disciplines
 - the order should be discussed (and agreed) between researchers at an early stage in a research project
 - it is preferable that the agreement be recorded in a signed document
 - authors should be able to explain or rationalise the order in which authors are listed



Authorship

- Authors **MUST** complete a signed statement of authorship
 - a form for this purpose is available on the UNSW Research Services website
 - authorship forms must be held by the Head of School or Centre Director
- If a dispute about authorship arises it should initially be discussed with your Supervisor
 - if this is not possible
 - the Associate Dean (Research) and two Professors will act as mediators
 - if agreement still cannot be reached the Deputy Vice-Chancellor (Research) will make a decision

Ori Allon



- PhD Student in Computer Science (2006)
- Working on Search Engine improvements
 - Better than Google
- Worked with NSi to find commercial opportunities
 - Google, Yahoo, MSN
 - Travelled to the US to demonstrate his work
- Rights to his algorithm sold to Google
 - He now works for Google in California
 - Excellent public profile of good research at UNSW
- Everybody happy 😊 😊



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Hypotheticals - Negative

- Student's work partly involves research contract project with a third party
 - supervisor doesn't inform student about confidentiality requirements of the research
 - student not aware of any confidentiality requirements
- Student publishes "confidential" information in PhD thesis
- Contract breached – University, Faculty, School and supervisor exposed to legal action – reputational damage
- Thesis is OK - some parts restricted access
- Supervisor disciplined, future contracts gone
- Student happy 😊, Nobody else happy 😞

Hypotheticals - Negative

- Student works on project and supervisor decides to publish
- Student, supervisor and one other person (previous researcher) in the group to be authors
- Authors cannot agree on the interpretation of experimental data
 - all three are “real” and “valid” contributing authors
 - authors disagree and in “deadlock”
- **Stalemate** – not easy to break apart contributions
- Unable to publish
- Nobody happy 😞 😞

Hypotheticals - Negative

- Student involved in a simple vacation project
- Good ideas – good “hot” application
 - leads to patent and IP
 - multiple inventors including the student
- Escalating investor interest in IP
- Narrow window-of-opportunity – fast moving technology area
- Some inventors challenge IP agreement for greater share
- **Inventors in conflict** - ownership of IP clouded
- **Stalemate** - investors go away
- Nobody happy 😞 😞

Hypotheticals - Positive

- Student involved in PhD project funded by an industry sponsor
 - student receives a stipend/scholarship for her PhD studies
 - student assigns IP to industry sponsor as a prerequisite to working on the project
- Research progresses under “industry rules”
 - no disclosure, frequent reporting – somewhat painful
- Research develops a really useful product
- Full patent filed listing the student as co-inventor
- Student receives a \$ share of royalty flow
 - 10 years after the discovery and continuing
- Everybody happy 😊 😊