Intellectual Property Procedure

Section 1 - Purpose and Scope

(1) The University of Queensland (UQ or the University) seeks to foster the translation of research for broad knowledge transfer and community benefit, a process that may be facilitated through the protection and/or commercialisation of UQ Intellectual Property (UQ IP or University IP).

(2) University IP may be commercialised or used in various ways that will benefit the University, originator/s and the community, depending on the nature of the IP and its potential application. In some cases, it may be desirable for the University to protect the IP to achieve the best commercial outcome from that IP or future research. In other cases, it may be that making the work available on a non-commercial basis to the public may result in the best outcome.

(3) Commercialisation at UQ relies on the close collaboration between researchers, who are the originators of UQ IP, and the University's commercialisation companies. Successful commercialisation events are heavily dependent on this close collaboration.

(4) This Procedure outlines the University processes for:

a. Commercialisable IP: potential commercial or artistic value; and
b. Other Public Value IP: not commercially valuable, but should be made available to benefit the public through its deployment, and benefit the University through engagement with the community.

(5) This Procedure is underpinned by The University of Queensland's Intellectual Property Policy and describes the processes for:

a. Notification of IP;
b. Protection, commercialisation, and publication of UQ IP;
c. Evaluation of IP;
d. Rewarding UQ IP originator/s;
e. UQ IP assignment to HDR candidates;
f. Resolution of UQ IP disputes among researchers; and
g. Commercialisation pathway review.

(6) This Procedure applies to all University staff, students, title holders and University commercialisation companies.

Section 2 - Process and Key Controls

(7) When researchers feel that they may have created potentially valuable IP, or if commercially valuable background IP is brought to the University, the researcher should discuss with the University commercialisation company a Notification of (background) IP.

(8) Prior to the dissemination of UQ IP with commercialisation potential, researchers should seek guidance from the relevant University commercialisation company where disclosure, or the timing of a disclosure, may affect the

potential for commercialisation.

(9) Research data and records must be maintained in accordance with the Research Data Management Policy.

(10) The commercialisation of UQ IP is managed by established University commercialisation companies: UniQuest and JKTech. These companies undertake the commercialisation process and manage commercial risks.

(11) Proceeds resulting from commercialisation will be distributed in accordance with this Procedure.

(12) Disputes relating to UQ IP or commercialisation will be resolved through discussion and mediation, with final determination made by the Deputy Vice-Chancellor (Research and Innovation).

Section 3 - Key Requirements

Notification of IP

Notification of new IP

(13) When potentially valuable IP is created, a researcher should enter into a discussion with the University commercialisation company to explore the nature and potential of the IP. Where the potential of the IP merits it, the University commercialisation company will work with the researcher to generate a notification of new UQ IP made using the IP Notification Form, or an equivalent supplied by the University commercialisation company.

(14) If more than one person was responsible for the development or creation of the UQ IP, a single notification to the University commercialisation company that lists all originators is preferred.

Notification of Background IP

(15) A researcher (excluding title holders) joining UQ should advise the University of the existence of background IP that the researcher brings to the University, where that IP is part of a commercial venture, or has the potential to be related to commercially valuable IP that may be generated while an employee of UQ. Notification should occur within 30 days of commencement of employment, engagement or enrolment by completing the Background IP Notification Form. On receipt of the Background IP Notification Form, the Deputy Vice-Chancellor (Research and Innovation) will consider whether a management plan is required. The University commercialisation company staff are available for a new UQ staff member to consult and assist in this process.

Protection, Commercialisation and Publication of IP

(16) Public disclosure of UQ IP that has potential commercial value before implementing IP protection strategies with the University commercialisation company may adversely affect commercialisation potential.

(17) The notification of new UQ IP of potential commercial value should not normally impact on publication or the ability to apply for research funding, providing an appropriate commercialisation plan is in place.

(18) If, after agreeing on the scope of any restrictions with the originators, the University or a University commercialisation company enters into agreements which restrict the publication and/or use of UQ IP, the originator/s must abide by those restrictions. In addition to being agreed with originators, such restrictions must not conflict with pre-existing contractual obligations that originators may be under from funding bodies to publish.

(19) The maintenance of research records must be handled in accordance with the Research Data Management Policy for all UQ IP that is the subject of a notification that underpins a commercialisation project.

Evaluation of IP

(20) Staff of the University commercialisation company are available to consult with researchers as their research projects progress to provide advice as to what commercial opportunities may exist for their research, and inform researchers about the commercialisation process.

(21) Upon submission of the IP Notification Form, the University commercialisation company will consult with the originator/s of the UQ IP as to potential commercialisation pathways, and what may be the most appropriate pathway leading to the commercialisation of the IP. Consultation often includes initial discussions on publication, protections that may be required, and further work that may be needed to progress the IP towards commercialisation.

(22) The University commercialisation company will undertake due diligence on the UQ IP during the preliminary evaluation period, a period of three months commencing from the date the complete IP Notification Form is received and accepted by the University commercialisation company. Refer to “Workflows” under section 7 for workflow of evaluation process. 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. An initial determination of the commercial potential of the UQ IP will be made by the University commercialisation company and communicated to the originator/s within the preliminary evaluation period, resulting in one of the following pathways:

a. Commercialisation project - A potential commercial opportunity is identified and activities initiated to identify and engage with potential partners and/or investors to progress the commercial potential of the UQ IP. The University commercialisation company will develop a commercialisation plan in consultation with the originator/s. Refer to clauses 38 to 42 (Commercialisation Pathway Review).
b. Other public value - The UQ IP is assessed as being of little or no commercial value. In this case, the UQ IP may be made available by UQ for free or on a cost-recovery basis to support impact and engagement in the community. In such circumstances, the UQ IP may be licensed by the University and any proceeds generated as a result of such licensing will be disbursed in accordance with clause 30.
c. Continuing development - No immediate commercial opportunity is identified. However, it is recognised that further research may lead to a commercial opportunity. The University commercialisation company provides ongoing advice on the development of the UQ IP for 15 months, at which point the originator may continue to work with the University commercialisation company, or may request assignment of the UQ IP.
d. Researcher-led start-ups – Under very specific circumstances where it can be demonstrated that standard UniQuest commercialisation models are not appropriate, a researcher-led start-up where researchers hold equity may be considered as an appropriate commercialisation vehicle into which UniQuest may licence University IP. The Researcher-Led Start-Up Pathway Guideline sets out the circumstances under which a researcher-led start-up may be considered.

(23) At any time, the University commercialisation company may re-evaluate the commercial potential of the UQ IP and decide to:

a. Develop a commercialisation plan in consultation with the originator/s (in the case where the UQ IP was initially designated pathway 2 or 3 but is subsequently reassessed to be pathway 1);
b. Suspend or cease supporting the protection and/or commercialisation of UQ IP in any market or jurisdiction; or
c. Offer the UQ IP to the originator/s to commercialise the IP at their own cost (subject to the approval of the Deputy Vice-Chancellor (Research and Innovation).

Rewarding UQ IP Originator/s

(24) University IP originator/s are financially rewarded through a share of any net proceeds that the University or University commercialisation company derives from its commercialisation of that IP.

(25) UQ's Annual Performance and Development explicitly recognises a researcher's efforts to move a project along the pathway to potential commercialisation.

Disbursement of Net Proceeds from Commercialisation

(26) Any net proceeds resulting from commercialisation through the University commercialisation company will be disbursed as follows:

a. One third to the IP originator/s (and contributors as agreed by the originator/s);
b. One third to University commercialisation company; and
c. One third to the relevant faculty or institute of the University.

(27) This right applies regardless of whether the originator is still associated with the University - but does not apply where originator/s hold direct equity in a researcher-led start-up. Any such net proceeds of commercialisation will be paid to the originator's estate if the originator is deceased.

(28) In some circumstances, the UQ IP originator/s may wish to recognise one or more colleagues who have made a significant contribution to the development of the UQ IP as Contributors. Contributors can share in the distribution of net proceeds of commercialisation by receiving a share of the one third to be allocated to the originator/s.

(29) The agreement of distribution of net proceeds between originator/s and contributors will be facilitated by and submitted to the University commercialisation company and will require the agreement of all originators. If an agreement cannot be reached among all originators then dispute resolution should be sought in accordance with clauses 35 to 46.

Disbursement of Net Proceeds of other Public Value UQ IP

(30) The net proceeds resulting from any licensing or other paid use of the other public value UQ IP will be transferred to the relevant faculty or institute of the University.

UQ IP assignment to HDR Candidates

(31) In the case of UQ IP created solely by an HDR candidate originator, if, following the preliminary evaluation period, the University commercialisation company determines that there is not a commercialisation project as outlined under clause 22(a), the originator may request an assignment of the UQ IP which is the subject of the IP Notification Form if the following conditions are met:

a. UQ IP assignment is in line with the overall commercialisation and UQ IP protection strategy of the University and the University commercialisation company;
b. UQ IP assignment would not negatively impact on the reputation of UQ; and
c. The originator/s has complied with the University Intellectual Property Policy and Intellectual Property Procedure and any ancillary agreements.

(32) The assignment of UQ IP to the HDR candidate will be negotiated between the University commercialisation company and the HDR candidate and formalised in a written agreement that shall include the following minimum terms:

a. Identifying the UQ IP to be assigned to the HDR candidate;
b. A nominal 10 per cent shareholding in any start-up company formed around the assigned UQ IP to be held by the University commercialisation company and subject to the disbursements described under clauses 26 to 29 on conversion to a cash return recognising the use of UQ facilities and resources in the development of the IP; and

c. The granting of a non-exclusive, perpetual, royalty-free licence to the University to use the IP for education and research purposes.

(33) An offer of UQ IP assignment to the HDR candidate is subject to the discretion and approval of the Dean, Graduate School.

(34) The provisions under above clauses 31 to 33 do not apply to UQ IP where the HDR candidate is a joint originator or contributor of UQ IP with a UQ staff member or affiliate.

IP Issues, Pathway Reviews and Dispute Resolution

UQ IP Issues among Researchers

(35) If an issue over UQ IP arises among researchers, all parties will make every reasonable effort to resolve the issue in accordance with the Responsible Research Management Framework Policy and this Procedure in a timely manner.

(36) UQ IP issues may include, but are not limited to:

a. IP ownership;
b. Identification of originators and/or contributors; or
c. Sharing of net proceeds of commercialisation amongst originator/s and/or contributors.

(37) The following steps should be followed when attempting to resolve an IP issue between researchers:

a. Individuals involved in the issue should first seek resolution through discussion among themselves.
b. Issues that cannot be resolved among the individual originator/s and/or contributors will be referred to the Executive Director, Research Partnerships, or other nominee, who will attempt resolution through mediation.
c. Where mediation is unsuccessful in resolving the issue, the matter will be referred to the Deputy Vice-Chancellor (Research and Innovation) as a dispute for determination under clauses 43 to 46.

Commercialisation Pathway Review

(38) The University commercialisation company shall, in consultation with the originator/s, be responsible for determining the pathway for commercialisation taking into consideration the perspectives of the originator/s. Successful commercialisation events are almost invariably dependent upon the combined skills, collaboration and commitment of the originator/s and the staff of the University commercialisation company.

(39) Should they so wish, originator/s may request a review by the Commercialisation Pathways Advisory Group of the pathway towards commercialisation for UQ IP. Such a review would not ordinarily initiated until 18 months after the submission and acceptance of the latest IP Notification Form related to the UQ IP.

(40) Commercialisation pathway reviews may include a request for an IP assignment to the originator(s).

(41) The following steps should be followed when requesting a review of the commercialisation pathway:

a. Originator to request a commercialisation pathway review through the appropriate Level 3 Authorised Officer in accordance with the Human Resources Sub-delegations Schedules.
b. The Authorised Officer will submit the review request for the consideration of the Commercialisation Pathways Advisory Group.
c. The advice by the Commercialisation Pathways Advisory Group will be reviewed by the Deputy Vice-Chancellor (Research and Innovation), before being provided to the Level 3 Authorised Officer for relaying to the originator.
d. Where the issue is not resolved following the review, the matter may be referred to the Deputy Vice-Chancellor

(Research and Innovation) as a dispute for determination under clauses 43 to 46.

(42) A commercialisation pathway review must be undertaken to assess the suitability of a researcher-led start-up as the commercialisation pathway. The Deputy Vice-Chancellor (Research and Innovation) will confer with the Provost on the potential access to this pathway before the advice is provided to the Level 3 Authorised Officer.

Resolution of Disputes

(43) All disputes arising under or as a result of this policy and procedure must be dealt with in accordance with this and the subsequent three clauses (i.e. clauses 43 to 46).

(44) The disputes may include, but are not limited to disputes relating to the following:

a. IP ownership issues;
b. Identification of originators and/or contributors;
c. Sharing of net proceeds of commercialisation amongst originator/s and/or contributors;
d. IP commercialisation pathway; and
e. Net proceeds of commercialisation.

(45) The following steps should be followed when attempting to resolve a dispute under this Procedure:

a. Any issues must be referred in the first instance to mediation under clauses 35 to 37 or the commercialisation pathway review process covered by clauses 38 to 42.
b. If the issue has not been resolved by mediation or through the commercialisation pathway review process, then it may be referred to the Deputy Vice-Chancellor (Research and Innovation) as a dispute for a final determination in their absolute discretion.
c. The Deputy Vice-Chancellor (Research and Innovation) may consider written representations from the parties and advice from within or outside the University, including advice from the Commercialisation Pathways Advisory Group. The decision of the Deputy Vice-Chancellor (Research and Innovation) will be final and binding. The decision of the Deputy Vice-Chancellor (Research and Innovation) may be made with or without conditions.

(46) Refer to “Workflows” under section 7 for workflow of IP dispute resolution.

Vice-Chancellor as Attorney

(47) An originator and/or contributor will, as required by the University, complete all documentation or any other action that the University or University commercialisation company deems necessary for the protection and commercialisation of IP owned by the University. If an originator and/or contributor fails to complete any documentation or any other action that the University or University commercialisation company deems necessary for the protection or commercialisation of IP owned by the University, the Vice-Chancellor has the right to execute all such documents and do all such acts as their attorney. The Vice-Chancellor may exercise such power of attorney even if the University benefits from this power. This power of attorney does not extend to instances where failure to complete documentation is a result of conflicts as to ownership of the IP, or where there is an ongoing dispute between the originators and/or contributors and the University or University commercialisation company.

Section 4 - Roles, Responsibilities and

Accountabilities

Vice-Chancellor

(48) The Vice-Chancellor acts as the attorney with the power to execute commercialisation documents in alignment with clause 47.

Deputy Vice-Chancellor (Research and Innovation) and Provost

(49) In the case of UQ IP disputes or commercialisation pathway reviews, the Deputy Vice-Chancellor (Research and Innovation) will make the final determination. The Deputy Vice-Chancellor (Research and Innovation) will confer with the Provost on the potential access to the researcher-led start-up pathway.

Executive Director, Research Partnerships

(50) The Executive Director, Research Partnerships will attempt to resolve UQ IP disputes through mediation with the disputing parties per clauses 35 to 46.

Dean, Graduate School

(51) The Dean, Graduate School is responsible for approving the offer of UQ IP assignment to HDR candidate where they are the sole originator.

Commercialisation Pathways Advisory Group

(52) The Commercialisation Pathways Advisory Group will provide the Deputy Vice-Chancellor (Research and Innovation) with advice and recommendations regarding UQ IP disputes and commercialisation pathway reviews.

University Commercialisation Company

(53) The University commercialisation company is responsible for:

a. Provision of advice to UQ researchers on IP matters, including when discoveries may provide benefit through promotion and open dissemination or when they may have potential commercial or other public value.
b. Working with UQ researchers to progress IP notifications, and receiving and managing IP Notifications.
c. In consultation with UQ researchers, deciding the pathway for commercialisation of that IP.
d. Keeping the originator/s informed of the commercialisation of UQ IP to the extent reasonably practicable and necessary to support the commercialisation.
e. Consideration of an offer to an HDR candidate and/or originator for UQ IP assignment according to clauses 22(a), 31 to 34, and 47.

UQ Staff Involved in the Management of Research Partnerships

(54) UQ staff with functional roles in the management of research partnerships under the Executive Director, Research Partnerships, and Executive Director, Research Office are responsible for referring IP matters to the University commercialisation company in accordance with this Procedure.

Originator/s of IP

(55) The originator/s of UQ IP:

a. Is/are responsible for notifying the University commercialisation company of the creation of potentially valuable

UQ IP, including any background IP, and any updates to the UQ IP as soon as possible.

b. Must retain sufficient records, materials and data to demonstrate the outcomes of any research, and to defend those outcomes if challenged.
c. Following an IP notification, researchers must keep the University commercialisation company informed of amendments to the particulars, data, results, findings, updates and commercial interactions associated with the IP.
d. Where commercialisation is contemplated or initiated, originators should work collaboratively with the University commercialisation company to support the commercialisation of the UQ IP and should not act in a manner which would result in:
    i. the loss of the opportunity to protect or commercialise UQ IP; or
    ii. the University breaching obligations to third parties concerning UQ IP.

Section 5 - Monitoring, Review and Assurance

(56) The Deputy Vice-Chancellor (Research and Innovation) is responsible for the development, compliance monitoring and review of this Procedure.

(57) The Deputy Vice-Chancellor (Research and Innovation) may take advice from the Commercialisation Pathways Advisory Group as required.

Section 6 - Recording and Reporting

(58) University commercialisation companies maintain records of UQ IP as disclosed to them. University commercialisation companies record and maintain information on intellectual property and commercialisation activities through their customer relationship management databases.

(59) The Deputy Vice-Chancellor (Research and Innovation), or other nominee, may request reports and other data on intellectual property and commercialisation activities.

(60) The Commercialisation Pathways Advisory Group maintains records of all items discussed and meetings are minuted.

(61) All University records shall be managed, retained and disposed of in accordance with the Information Management Policy and procedures and Research Data Management Policy.

Section 7 - Appendix

Workflows

a. Workflow for Intellectual Property Evaluation - Staff
b. Workflow for Intellectual Property Created Solely by a UQ HDR Candidate
c. Workflow for Intellectual Property Issues, Commercialisation Pathway Reviews and Dispute Resolution.

Related Forms

a. IP Notification Form.
b. Background IP Notification Form.
c. IP and Confidentiality Deed for Visiting Researchers agreement.

d. Student Intellectual Property and Confidentiality Deed agreement.

Definitions

Term	Definition
Authorised Officer	in accordance with the Human Resources Sub-delegations Schedules.
Background intellectual property	intellectual property that is created prior to, or independently of. the particular University IP, research project or course of study.
Commercialise	means to: a. develop, make, have made, use or market; b. in relation to the intellectual property, to exercise the rights exclusively granted to the holder of such intellectual property by the laws of the jurisdiction in which the intellectual property subsists; c. in relation to a product, kit, apparatus, substance, software, documentation or information resource (or any part of such materials), to develop, make, distribute, market, sell, hire out, lease, supply, or otherwise dispose of it; and d. in relation to a method or process, to use the method or process, to use the method or process to develop, make, distribute, market, sell, hire out, lease, supply, or otherwise dispose of a product, kit or apparatus the use of which is proposed or intended to involve the exercise of the method and process, or to use the method or process to provide a service, and "Commercialisation" is to be construed similarly.
Contributor	is a University staff member, student or title holder that contributed to the creation, development or invention of the relevant UQ IP.
Intellectual Property (IP)	all statutory and other proprietary rights (including rights to require information be kept confidential), anywhere in the world, whether registered or unregistered, in respect of inventions, copyright, trademarks, designs, patents, plant breeder's rights, circuit layouts, know-how, trade secrets and all other rights as defined by Article 2 of the Convention establishing the World Intellectual Property Organisation of July 1967.
Net proceeds of commercialisation	with respect to particular UQ IP, means the cash revenues actually received by the University (or a University Commercialisation Company) from commercialising that IP (including royalties, licence fees, milestone payments, dividends and proceeds from the sale of shares and any other items specified as revenue) but NOT including R&D funds, consulting fees or returns to the University from a University commercialisation company, LESS any expenses and costs relating to the protection, registering, management, marketing, commercialising or enforcing of that UQ IP (such as for example third party legal and consultants fees, patent attorney fees, financial and technical advice, insurance, marketing and travel, creation of prototypes, taxes, bank fees and transaction fees and any other items specified as expenses). Encumbered revenues are not considered received until the encumbrance is lifted. In the case of licences or assignments where the income received is concurrently invested in the company for shares as part of the transaction, such income is excluded from the net proceeds of commercialisation.
Originator (or originators)	University staff, students or title holder who: a. in the case of a patentable invention: is an inventor; b. in the case of a copyright work or similar: is an author; c. in the case of a word, colour, smell, slogan, image or similar to be used as a trademark: is a person who conceived, developed or first used the word, colour, smell, slogan, image or similar as a trademark; d. in the case of designs: is a designer; e. in the case of plant breeders rights: is a breeder; f. in the case of circuit layouts: is a designer; and g. in the case of trade secrets and know-how: is an originator of that body of knowledge.
Preliminary evaluation period	a period of three months commencing from the date the complete IP Notification Form is received and accepted by the University commercialisation company.
Other public value IP	IP that is created and deemed to be of use to an external organisation for non-commercial purposes. Where the primary purpose of licensing the IP to the external entity is for engagement and the public good.
Researcher	any University staff member, student or title holder who conducts, or assists with the conduct of, research at, or on behalf of, the University.

Term	Definition
Staff	continuing, fixed-term, research (contingent funded) and casual staff members.
Student	a person enrolled as a student at the University or undertaking courses or programs at the University.
Title holders	visiting academics, academic title holders, industry fellows, emeritus professors, adjunct and honorary title holders, and conjoint appointments.
University commercialisation company	a. JKTech Pty Ltd; or b. UniQuest Pty Ltd.
University resources	resources of the University, which includes, without limitation, premises, infrastructure, facilities, funds, services, equipment, paid leave, and staff, student or title holder's time.

Status and Details

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