Research Intellectual Property

Speaker:
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What is it?

Intellectual Property means any confidential information (usually) or any rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields, including but not limited to the electronic media and any rights under the:

- Patents Act,
- Copyright Act,
- Design Act,
- Trade Marks Act,
- Plant Varieties Act,
- And rights under any convention to which Australia is a party and under the Common Law.
Why is it important?

• IP is of little economic value unless protected and exploited.

• (Patents provide exclusive right to exploit the invention)

• (Copyright is exclusive right to reproduce the work in a material form)

• ‘It protects the investment and resources of the creator of the IP and allows the commercial exploitation’
Registered Rights

• Patents

• Trade marks

• Industrial Designs

  *IP Australia administers rights with an examination and registration process*

• Plant Breeders Rights

  *Agriculture, Fisheries and Forestry Australia administers rights with an examination and registration process*
Unregistered Rights

- Copyright
- Circuit Layout rights

Commercial Strategies

- Trade secrets to keep processes/formulae secret
- Confidentiality agreements
- Rapid production processes
Intellectual Property Rights ……

………are worth $s? Only if:
– ownership can be protected
– they can be marketed or can produce a product
– they return a payment or revenue stream

• Don’t have to own IP Rights in order to make money from them

• The distribution of ownership of IP Rights can be quite different to the distribution of commercial returns
Ownership of Intellectual Property Rights - Staff

Any IP created in the course of their duties will be the property of the University, which may require a member of staff formally to assign to the University his or her interest in any such intellectual property.

(IP Statute 7.1, IP Policy No. 540)
Ownership of Intellectual Property Rights - Students

Any IP created by a student in the course of their studies will be the property of the student, provided that where a student is to be involved in a project or specific commission in respect of which the University has provided funds, equipment, facilities or supervision the University may require the student, before commencing the same, formally to assign to the University his or her interest in any IP which he or she may create.

(IP Statute 7.1, IP Policy No. 540)

IP Clauses may cover:

– the IP the parties bring to the project - “Background IP”.

– the IP produced in the project which is specific to the project aims - “Project IP”.

– the IP produced incidentally in the course of the project - “Improvements to Background IP” and “Serendipitous IP”.

IP Clauses may cover:

– the need to be able to use other party’s background IP in commercialising or using the product.

– the requirement/desire of the University to be able to use the Project IP in its academic endeavours.

– the desire of parties to publish project results (including student’s right to publish thesis).

– rights of party to purchase other’s share of IP Rights.

– the requirement/desire of the parties to patent Project IP.

• May document Background IP in contract - “includes but is not limited to…. ”.

• Carefully document Project Deliverables so Project IP can be identified.

• Confidentiality and Publication Clauses to support and reflect IP intentions.

• University contractual arrangements with its staff, casual/contracted staff, consultants.

Ownership
  – 100% to one party?
  – relationship to $s invested by parties
  – joint or tenants-in-common ownership with %s to be determined (can be difficult early in the project)

RMIT Student Participation Agreements
  – Often required for projects with external clients

Commercialisation Agreements
  – Licencing, royalties, single/periodic payment
Student Participation Agreements

- Can be required for every student.
- When essential?
- When recommended?
- When not needed? (The role of academic supervision)

Sometimes an outside organisation enters into its own agreement with students (CRCs) or there is a three-way agreement (student/organisation/RMIT)
Student Participation Agreements
When Essential? When Recommended?

• RMIT already has an agreement with an organisation with respect to IP and therefore has to own or control project IP to meet its contractual obligations. (eg. CRC, ARC Linkage)

• The student project is part of a larger project involving RMIT staff and perhaps students which may have been undertaken for previous years. It makes no sense for IP to be fragmented.

• RMIT decides that this particular project may have useful or valuable outcomes and chooses to require that the student assign the IP to RMIT in order to be permitted to undertake the project.
How do Inventors of IP benefit?

• Right to be recognised as a creator/inventor of the IP – “Moral Rights of Authors” upheld by RMIT

• Examples - will be listed as an inventor on any patent owned by RMIT or others and an author on publication

• Try to structure agreements to allow for fairly unfettered academic publication

• Can share in net benefits from commercialisation – negotiation start point is 50% to RMIT and 50% to the inventors

• (plus, for students, an excellent degree from a top-notch university?)
Who?

• Delegated Authority (RMIT’s Authorised Signatory):
  – PVC (R&I) or VC

• General Support:
  – Matthew Miller, Gretel Lamont, Mary Jakobenov & Diane Bates – SET
  – Eric Kingston, Nola Miles – R&I, BUS, general enquiries, records and issues for PVC(R&I)
Sources of IP Information

IP Australia – Australian Government Patent Office

http://www.ipaustralia.gov.au

Biotechnology Australia – Australian Government

http://www.biotechnology.gov.au

(and locate the “IP Management Training Manual”)