RMIT University

Office of Pro Vice Chancellor (Research & Development)

Practices: Research and Development Intellectual Property

Distribution of economic benefits deriving from commercial applications of intellectual property

The University will offer members of staff and students a share of the net economic benefits which derive from successful commercialisation of the intellectual property they develop within the University.

Specific Practices pertaining to R&D Intellectual Property

Where preliminary assessment, which may be made by the RMIT Intellectual Property Evaluation Panel, indicates that the intellectual property has commercial potential and should be protected by patent, trade mark or other registration, the University through the Office of the Pro Vice-Chancellor (Research & Development) will underwrite the initial cost of such registration or, in the case of a patent, filing of the provisional specification by a patent attorney.

The Office of the Pro Vice-Chancellor (Research & Development) will manage the assessment of the commercial potential of the disclosed invention, through the RMIT Intellectual Property Evaluation Panel, and will require evidence of commercial interest before approving the preparation of a final specification, in the case of a patent. If approved, the University, Faculty, School or Department, as decided, will underwrite the costs of filing of the final specification. If a final specification is not filed, the University, not later than nine months after the inventor(s) disclosed the invention to the Office of the Pro Vice-Chancellor (Research & Development), will assign all rights of ownership of the intellectual property to the inventor(s) who may seek patent(s) independently. Legal and other costs incurred after the date of decision by the Office of the Pro Vice-Chancellor (Research & Development) not to proceed will be the responsibility of the inventor(s) and not of the University, its Faculties, Schools or Departments.

The Office of the Pro Vice-Chancellor (Research & Development) will maintain an accurate record of the cost of all services provided to the inventor(s) or their Departments including the professional services and the direct costs associated with filing of provisional and final specifications.

Patentable Inventions

The Office of the Pro Vice-Chancellor (Research & Development) acts for the University in the exploitation of intellectual property associated with patentable inventions and other invention related registration.

A staff member will be required to complete a disclosure of invention form in order for the Office of the Pro Vice-Chancellor (Research & Development) to determine whether the University will pursue the commercial development of that intellectual property. This provides a means of protecting the intellectual property against premature or inadvertent disclosure such as at conferences, seminars or through other publication.

The Office of the Pro Vice-Chancellor (Research & Development) and the staff member will negotiate the terms and conditions of any agreements.

Any dispute will be determined by the Research & Development Intellectual Property Committee.
A staff member or student may appeal against a decision of the Research & Development Intellectual Property Committee to the Vice-Chancellor.

**Patent Registration**

A provisional patent application is not published or otherwise made available by IP Australia. It serves to protect the priority date (the date of filing) for a period of 365 days only. A full specification must be filed in all countries in which protection is required within the 365 day period to preserve that priority.

Only a small proportion of patents repay the costs associated with obtaining patent protection and attempting commercialisation. Hence the University accepts a substantial risk when it invests in intellectual property developed by a member of the University. The successful patents are usually very successful and generate income which is many times the initial cost. However, the successful commercialisation of intellectual property requires the inventor to make a large, sustained and mostly unpaid investment of time and effort over and beyond the normal duties of a member of the University.

Recovery of investment by the University from the gross income of successful commercialisation will entail including direct initial costs such as:

(i) fee for filing of provisional patent specifications;
(ii) all patent attorney fees;
(iii) legal fees and other costs incurred;
(iv) fees for filing of final patent specifications; and
(v) annual maintenance fees for patents, trade marks, etc.

**Distribution of economic benefits deriving from commercial applications of Intellectual Property - (R&D)**

Except as provided under income related to copyright materials, any net income from intellectual property will be distributed in a way which recognizes the contributions of the involved parties and generally the following will be the initial position for negotiating:

(i) one half will be paid to the member of staff or student concerned. Where there is more than one member of staff or students, the Committee will in the absence of agreement by the staff or students, determine the proportions to be paid to the individual members of staff or students.

(ii) one half will be paid to the University. The proportions to be paid to the Centre, Department or other unit where the member of staff was employed or the student was enrolled at the time the intellectual property was created, and the proportion to the paid to RMIT or any other accounts, will be determined by the Research & Development Intellectual Property Committee.

**Staff income from copyright materials**

Where a staff member receives royalty income of an amount greater than $15,000 [1995 figure] in any calendar year, this must be reported in writing to the Pro Vice-Chancellor (Research & Development). It is not necessary for a staff member to report on any income less than this amount. The Intellectual Property Committee will determine any University interest in amounts above this threshold figure, taking into account the relevant circumstances.

**Agreements - ownership of IP**

Agreements between RMIT and external organizations concerning the ownership of intellectual property will be approved by the Pro Vice-Chancellor (Research & Development) subject to the delegations authority of the University.
Higher Degree Students

Pre-enrolment of higher degree student

- Relevant issues covered as per information prepared by Academic Administration or Faculties.

Enrolment

- Discussion between supervisor and student.
- A higher degree student is made aware of IP issues.

Questions which need to be asked:

- Is the student joining an established area of research in which IP is already shared between staff and students?
- Is the student being offered or using existing IP by a supervisor, beyond that of normal resources and supervision for the work?
- Is the student's research being funded by an external sponsor?
- Is the research being undertaken off-campus in the premises of another organization in which confidentiality of information and IP has been raised as an issue, or could in the course of the research project, become an issue?
- Is the student an employee of another organization which has an entitlement to claim the intellectual property created during the student's candidature?

<table>
<thead>
<tr>
<th>NO</th>
<th>No further action is required</th>
</tr>
</thead>
<tbody>
<tr>
<td>YES</td>
<td>Formal agreement may need to be prepared/signed.</td>
</tr>
</tbody>
</table>

Ownership of student intellectual property

Subject to Section 6.2 of the RMIT Intellectual Property Policy, RMIT will not make any claim to the intellectual property created by students. Policy paragraph 6.2 establishes two important principles:

i. contributors to the creation of any intellectual property are to be recognized; and

ii. where a student is involved in a project which involves the use of existing intellectual property or where the University has provided funds, equipment, facilities or supervision, it may be necessary for an intellectual property and/or confidentiality agreement to be negotiated before the work commences.

The supervisor of a postgraduate student must discuss with the student at the commencement of the research program any requirement to enter into an agreement concerning the student's ownership rights of any intellectual property created during that program.

Creation of IP by student in the course of the project where no existing agreement is in place

The University makes available the services of the Office of the Pro Vice-Chancellor(Research and Development) which can assist to assess, protect and prosecute the commercial application of any intellectual property created by a higher degree student.