IP FAQ

What is intellectual property?
Intellectual property (IP) represents the property of the mind or intellect. Intellectual property rights (IPR) are rights that the owner and/or creator have over how their IP is used.

How can my intellectual property rights be protected?
Copyright, which protects the written expression of an idea or concept but not the actual idea or concept itself, and circuit layout rights are automatic and do not require a formal application for protection.

For all other forms, such as patents, legal rights of IP ownership must be applied for or formally registered.

Confidentiality/trade secrets, including know-how and other confidential or proprietary information, are most often protected through legal agreements.

Who do I ask about IP?
To discuss whether you may have valuable IP or the process in general, contact:

- Dr Samantha South (samantha.south@uwa.edu.au) will also be available on level 8 at Perkins every Thursday
- Dr Louis Pymar louis.pymar@uwa.edu will also be available on level 8 Perkins every Friday.
- Or you can send an invention disclosure form, which can be found at: http://www.rdi.uwa.edu.au/commercialisation#NA_InvDiclose

What is an innovation disclosure?
An innovation disclosure is a notification to UWA of the outcome of a research project or an idea that might lead to an IP position with commercial potential. UWA will review each disclosure for its commercial viability and where appropriate, work with you to identify and protect IP and package it for commercialisation.

Patentable ideas can only be protected if they are applied for before others know about them. So if you have an idea or research project which may have commercial potential, talk to us before you send out your article or conference paper abstract. UWA will keep the disclosure confidential.

Ownership of Intellectual Property created by UWA Staff
1. The University owns Intellectual Property created by a University Staff Member pursuant to a contract of service to the University excluding Teaching Materials and Scholarly Works.

2. Ownership of Intellectual Property in projects involving third parties will be determined by the third party agreement with those parties to the project.

More information concerning the ownership of IP can be found at the UWA IP Policy site: http://www.governance.uwa.edu.au/procedures/policies/policies-and-procedures?method=document&id=UP07%2F49

What benefits can I expect from the commercialisation of IP?
Recognising the significant contribution required for successful commercialisation, the University will share income generated as a result of commercialisation of its intellectual property 50:50 with originators, net of direct costs incurred (see below).

The structure of income sharing is:

Cumulative Net Revenue	Originator	Retained by UWA
Up to $100,000	85%	15%
Over $100,000	50%	50%*

*The 50% share retained by the University is further divided with the School or Centre where the intellectual property was developed receiving 68%.

What constitutes public disclosure?
As mentioned above, inventions can only be legally protected if that protection is applied for before they are disclosed to the public. A public disclosure is any non-confidential communication of an idea, results or an invention. Inventors need to be mindful of public disclosure, as it can lead to loss of patent rights, particularly if the disclosure is "enabling", i.e. the disclosure provides enough information for a person "of ordinary skill in the art" to practice the invention.

Sometimes it is necessary to talk about an invention with people before protection is applied for. In these cases, inventions can be discussed under a Confidential Disclosure Agreement (CDA). It is always best practice to determine whether a patent application should be filed before any public disclosure is made.

Disclosure	Not a Disclosure
Publication (printed and online)	Confidential submissions for publications prior to acceptance and publication.
Seminar presentation to student and public	Grant applications (except abstracts)
Conference presentation/poster session etc	Seminar presentations to UWA staff only
Abstracts	Ethics approval document for a research project
Theses	Presentations to students under confidentiality
Marketing information online (Perkins or UWA websites)	
Emails/letters /collaboration proposals	

Can I publish if I want to patent my research outcome?
UWA is dedicated to ensuring that material created throughout the course of commercial projects will not restrict your ability to publish. Generally, a patent application should be filed before your manuscript is published. UWA will work with you to optimise the impact of your publication.

The commercialisation pathway doesn't need to preclude you from publishing in an academic journal, presenting at a conference, displaying posters at a conference or otherwise benefiting from publishing your work. However, the commercialisation and translation of your research to public good may be jeopardised by public disclosure if it is not managed appropriately.

How can I commercialise my research if I don't have something that is patentable?
Translation can occur through many different types of partnerships such as collaborative R&D, licensing deals, start-ups, scholarships, internships, graduate employee programs and philanthropic foundations. If you believe you may have an idea or invention that is valuable, please contact us to discuss the best path for your work.

What is a provisional patent application?
A provisional patent application is a patent application that may be filed without some of the formalities required for other applications. It provides a priority date for "when" the invention was protected but allows for further information to be produced and included before filing a patent application where the claims need to be enabled (experimental proof shown). It is balancing act to determine the best time to file a provisional patent application. Usually at the time you are writing a journal article is the time to review whether the idea is patentable. This ensures that the patent review process does not hold up the publishing process. If filed too early there may be a risk that the provisional patent application does not effectively protect the invention.

What does commercialisation mean in relation to IP?
In broad terms it means taking an invention from the lab and bringing it to the wider market. Commercialisation is about giving University (staff and student) generated inventions the ability to create impact by developing a commercial product or service (Only IP considered to have commercial potential will be patented).

In addition to a valuable addition to your résumé, both staff and students may be granted a right to a share of the commercialisation profits generated by the invention, in accordance with the relevant University IP Policy (as discussed above). Commercialisation of inventions is generally more successful if the inventor is engaged in the ongoing process.

How is a decision made on whether to patent or seek some other form of IP registration?
We look at whether there is something that a) could and b) should be patented. Your work may be something that is better covered by a design registration or it may not need to be formally registered at all, such as with copyright. Sometimes what appears to be a great idea may not even be able to be protected.

The fundamental tenants of patentable inventions are; is the invention novel, useful and likely to have commercial potential? A quick search in the literature, in patent databases (e.g. in WIPO) and even on Google will give a good idea of how unique an invention is. As discussed above, disclosure of an invention outside of the University will severely limit patentability.

If an invention satisfies these criteria then it may be patentable. Consideration is required to balance the urgency of publication and potential public good of a speedy publication vs. achieving impact through commercialisation of the invention and capturing the commercial benefits for the University and yourself.

How is inventorship determined?
The University does not make the rules for who is an inventor. The definition of who is an inventor is set by patent law and is outside the remit of the University. The inventor(s) must have contributed an inventive step to the invention. Task setting or supervision in itself is not enough to be an inventor.

Well-kept notes of meetings and properly kept bound laboratory note books can be very useful in determining disputed inventorship.

What happens next?
As soon as IP has been disclosed to us we conduct a review of the literature, patent databases, market research data and discuss with industry contacts to determine which projects to take on.

What if UWA doesn't want to commercialise the IP?
Sometimes the IP is 'too early' for commercialisation and more research needs to be conducted; other times there might be issues with the IP having been disclosed, similar IP existing elsewhere or the market considered too small to be attractive to investors.
When UWA decides not to commercialise IP we can:

- Offer the Intellectual Property to the creator(s), gratis or on commercial terms;
- Release the Intellectual Property to the public domain with or without conditions.

Ownership of Intellectual Property created by a Student
UWA's IP policy states:

2.1 Unless the Student has agreed in writing to assign Intellectual Property to others, the Student owns Intellectual Property created by that Student.

2.2 A Student always owns copyright in a thesis.

2.3 A Student that participates in the creation of Teaching Materials in the course of study for the future use of the University does so under condition that the Student grants to the University an irrevocable, perpetual, non-exclusive, royalty-free licence to publish, reproduce and communicate those Teaching Materials for the purposes of teaching, learning and research.

What happens if a student has an invention or a good idea (which might be an invention)?
In the first instance, a student should talk with their supervisor and/or Head of School for advice. Students generally own copyright in new material which they create arising from their studies. Students may also be entitled to be an inventor on a patent for inventions they create whilst studying. Depending on the contribution of supervisors and other staff and students the student may/may not be the sole inventor.

If a student works on a commercially funded project, IP rights will usually be assigned to the University, in which case the student may be an inventor but does not own the IP. More information is found at the UWA IP Policy site: http://www.governance.uwa.edu.au/procedures/policies/policies-and-procedures?method=document&id=UP07%2F49

If there is a patentable invention in a PhD thesis, will submitting the thesis to the University change the opportunity to patent?
In order to protect valuable IP, access to a thesis may sometimes be restricted when submitted. In doing this, no public disclosure occurs when the thesis is submitted and the IP is not affected. It is important to talk to the PhD supervisor about who is examining the thesis and whether there are appropriate agreements in place with the examiners. Whether there may be additional inventors should also be discussed.

What is a confidential disclosure agreement (CDA) or non-disclosure agreement (NDA)?
A "confidentiality agreement" also called a confidential disclosure agreement (CDA) or non-disclosure agreement (NDA), is a legal contract between at least two parties (e.g. employees, business partners, business associates, research academics) that outlines confidential material, knowledge, trade secrets or non-public information that the parties wish to share with one another for certain purposes, but wish to restrict access to or by third parties. It is a contract through which the parties agree not to disclose information covered by the agreement.

CDAs can be mutual, meaning both parties are restricted in their use of the information provided, or they can restrict the use of the information by a single party (unilateral).

What is an MTA?
A Material Transfer Agreement (MTA) is a contract that governs the transfer of tangible research materials between two organizations, defining the rights of the provider and the recipient with respect to the materials and any derivatives created. MTAs are official legal contracts, and researchers, academic institutions and companies are obliged to abide by the provisions they contain. Breach of these agreements creates legal and financial risks for the institution and researchers involved.

Who can execute agreements?
Only certain people are authorised to execute agreements such as MTA's and CDA's; researchers should only sign the MTAs as acknowledgement of the conditions of the transfer. Please see John, Sam or Louis to execute these contracts.

What are moral rights?
Moral rights are personal legal rights that cannot be assigned and have been protected in the *Copyright Act 1968 (Cwth)* since 2000. They include:

- The right of attribution of authorship / performership,
- The right not to have authorship / performership of a work falsely attributed,
- The right of integrity of authorship of a work.

Moral rights and ownership rights are separate and distinct. Moral rights always belong to the creator even if the creator does not exercise other intellectual property rights (IPR) in relation to that work. Therefore, if you create something in the course of your employment, your employer may own the IPR but as the creator you will retain your moral rights.

While you cannot assign your moral rights to a third party, you can consent to allow your moral rights to be infringed. All IPR can be assigned or transferred with the exception of moral rights.

What happens to IP when a staff member leaves the University?
Any assigned IP remains under assignment to the University where the IP was created. Any royalties due will still be paid unless otherwise agreed.

To discuss whether you may have valuable IP or the process in general, contact:
Dr Samantha South (samantha.south@uwa.edu.au)
Dr Louis Pymar louis.pymar@uwa.edu
Or you can send an invention disclosure form, which can be found at: http://www.rdi.uwa.edu.au/commercialisation#NA_InvDiclose