

INTELLECTUAL PROPERTY POLICY

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SECTION A: PURPOSE, PRINCIPLES AND INTERPRETATION: This section (clauses 1 to 3) sets out the definitions of words and phrases used in this policy. Words and phrases that are defined in this section appear in the body of the policy in italics. This section also sets out the purposes of this policy, how it applies to the Sax Institute and third parties, and the principles on which this policy is based.

1. Definitions and Interpretation

1.1 In this policy, the following words and phrases have the following meanings.

“Board” means the board of the Sax Institute and references to the Board may include a sub-committee of the Board, as described in clause 7.1;

“Collaborative Project” means a project or arrangement between the Sax Institute and one or more third parties, such as a joint research project. It does not include:

- a licence agreement to access *Research Asset Intellectual Property*;
- contracts, arrangements or understandings related to the funding of the Sax Institute or its *Research Assets*;
- other ongoing or recurrent contracts or agreements between the Sax Institute and third parties.

“Commissioned Research or Reviews” means any research reports, evidence reviews, literature reviews or like products that are commissioned by the Sax Institute on behalf of a third party agency;

“Creator” means an *Employee* or *Visitor* who creates *Intellectual Property* that is subject to this policy, whether or not the *Intellectual Property* was created solely by them, or jointly with another person;

“Employee” means any person in an employee/employer relationship with the Sax Institute;

“Intellectual Property” means:

- inventions;
- patents protected under the Patents Act 1900;
- trademarks protected under the Trade Marks Act 1995;
- designs protected under the Designs Act 1906;
- copyright works protected under the Copyright Act 1968;
- circuit layouts protected under the Circuit Layouts Act 1989;
- plant varieties protected under the Plant Breeder’s Rights Act 1994;
- intellectual property in biological materials, including molecules, compounds, reagents, cell lines, antibodies, viruses, proteins, peptides, enzymes, clones etc;
- confidential information, including trade secrets and know how, protected under common law; and
- all other forms of intellectual property recognised in Australia;

“Moral rights” has the meaning given by the Copyright Act 1968, including:

- an author’s right to be identified as the author of a work;
- the right of an author to take action against false attribution; and

- an author’s right to object to derogatory treatment of his or her work that prejudicially affects their honour or reputation.

“*Net Benefits of Commercialisation*” means the net returns from the commercialisation of *Intellectual Property* after deduction of all costs of the Sax Institute in relation to the creation, development, protection and commercialisation of the *Intellectual Property*;

“*Research Asset*” means any research asset developed by the Sax Institute which is accessible by third parties, and has the purpose of enhancing research capabilities. *Research Assets* include, but are not limited to, the 45 and Up Study, the Study of the Environment on Aboriginal Resilience and Child Health (SEARCH) and any other such studies developed under the auspices of the Sax Institute.

“*Research Asset Intellectual Property*” means *Intellectual Property* in:

- questionnaires, tools, brochures and like materials created in relation to the *Research Asset*;
- data and biological samples in the possession of the Sax Institute as part of a *Research Asset*,

and also includes any *Intellectual Property* over which the Sax Institute holds a licence in accordance with agreements described in paragraphs 10.2 and 10.3;

“*Scholarly Works*” means works in the nature of academic publications (including theses, essays etc), journal articles, conference presentations, papers, books or parts thereof;

“*Sub-study*” means a study undertaken by a person licensed to access *Research Asset Intellectual Property*, which involves the collection of new data, information or material not already included in the *Research Asset*;

“*Visitor*” means a person who is not an *Employee* of the Sax Institute but who has an arrangement with the Sax Institute whereby he or she undertakes work that is of benefit to the Sax Institute. *Visitors* include, but are not limited to, students, visiting fellows, postdoctoral and graduate researchers working at or for the Sax Institute but funded by third parties. *Visitors* do not include independent contractors.

- 1.2 In this policy, words in the singular include the plural, and words in the plural include the singular.

2. Purpose and application

2.1 This policy

- i) Outlines the requirements for the Sax Institute’s *Employees* and *Visitors* when dealing with *Intellectual Property*; and
- ii) Provides information to:
 - members of the Sax Institute;
 - funders of the Sax Institute, including *Research Asset* funding partners;

- organisations that engage in *Collaborative Projects* with the Sax Institute;
- agencies that commission work from the Sax Institute;
- researchers commissioned by the Sax Institute; and
- other third parties having dealings with the Sax Institute,

on the principles and practices of the Sax Institute with respect to *Intellectual Property*.

2.2 This policy will be used as the basis of arrangements negotiated in contracts and agreements entered into after the commencement of the policy. The policy does not affect any arrangements, contracts or agreements that are in force at the time the policy becomes effective. However, when renewing existing contracts and agreements, the Sax Institute will utilise this policy as the basis for reaching fair and equitable arrangements with other the parties regarding *Intellectual Property*.

3. Principles

3.1 The Sax Institute’s vision is that evidence from health research is considered fundamental to policy to improve the health of the community.

3.2 The Sax Institute’s mission is to improve health, health services and programs by increasing the use of research in policy making.

3.3 This policy is based on the following principles:

- The policy seeks to support the vision and mission of the Sax Institute, which is based on its constitution as a not for profit organisation that undertakes work for the public good. The Institute seeks rights over *Intellectual Property* in accordance with this policy in order to further its work for these purposes.
- The policy is drafted to be congruent with applicable laws and with the “National Principles of Intellectual Property Management for Publicly Funded Research”.
- The policy seeks to ensure transparency and accountability in the Sax Institute’s dealings with *Intellectual Property*.
- The policy seeks to encompass the objectives of members, funders and others who conduct business with the Sax Institute, but where these may conflict, the policy endeavours to identify a position that most enhances the public good and the Sax Institute’s vision and mission.
- Insofar as research using the Sax Institute’s *Research Assets* generates income for third parties, the Sax Institute seeks a reasonable and equitable share of that income commensurate with the contribution made by the Institute, for the purposes of reinvestment in the Institute’s continuing not for profit work in the public good.

SECTION B: INTELLECTUAL PROPERTY GENERATED WITHIN THE SAX

INSTITUTE: This section (clauses 4 to 9) sets out the Sax Institute's requirements in relation to *Intellectual Property* generated within the Institute itself, through *Employees* and *Visitors*. It does not apply to *Intellectual Property* generated by arrangements with third parties who use the Sax Institute's assets, or who work collaboratively with the Sax Institute, or who commission work from the Sax Institute. These issues are dealt with in Section C: Intellectual Property from the Sax Institute's Dealings with Third Parties.

4. Ownership of Intellectual Property

4.1 Except as detailed below or otherwise agreed in writing by the Chief Executive Officer, the Sax Institute asserts legal and beneficial ownership of *Intellectual Property* created by:

- *Employees* of the Sax Institute in the course of their employment; and
- *Visitors*, where:
 - generation of the *Intellectual Property* required the use of the Sax Institute's resources;
 - generation of the *Intellectual Property* resulted from the use of other *Intellectual Property* owned by the Sax Institute;
 - the *Intellectual Property* was created by a team or coalition of people under the auspices of the Sax Institute;
 - the *Intellectual Property* was created as a result of funding provided or obtained by the Sax Institute.

4.2 In determining whether *Intellectual Property* was created by an *Employee* in the course of their employment, the following factors will be relevant:

- the *Employee's* contract of employment, if any;
- whether the resources of the Sax Institute were used in the creation of the *Intellectual Property*;
- whether there was input from other *Employees* in the creation of the *Intellectual Property*;
- whether the *Employee* represented themselves as acting on behalf of the Sax Institute when creating the *Intellectual Property*; and
- whether the *Employee* claimed any additional expenses, overtime or other payment from the Sax Institute in the course of creating the *Intellectual Property*.

4.3 In general, *Intellectual Property* created by an *Employee* in the course of any secondary employment with a third party employer, will not be considered to be *Intellectual Property* generated within the course of their employment with the Sax Institute, unless the factors in clause 4.2 apply.

4.4 Subject to clause 4.5 the Sax Institute does not assert ownership over copyright in *Scholarly Works* created by *Visitors* or *Employees*, unless those *Scholarly Works* were commissioned by the Sax Institute under a separate agreement in which ownership of copyright is specified, in which case that separate agreement will apply.

4.5 The Sax Institute retains the right to be granted a non-exclusive, royalty-free, perpetual licence to develop the *Intellectual Property* in *Scholarly Works* of

Employees and Visitors where those *Scholarly Works* were produced in connection with their employment or engagement with the Institute.

- 4.6 *Employees and Visitors* will promptly execute any documents necessary to give effect to the ownership provisions of this policy.
- 4.7 *Employees and Visitors* will not apply for protection of any *Intellectual Property* over which the Sax Institute asserts ownership without first consulting with the Chief Operating Officer.

5. Notification of Intellectual Property

- 5.1 *Employees and Visitors* are required, as soon as possible, to report the development of any *Intellectual Property* that they reasonably consider may be of commercial value to their director or the Chief Operating Officer.
- 5.2 Although the Sax Institute does not assert ownership over copyright in *Scholarly Works*, *Employees and Visitors* are required to report publication of *Scholarly Works* to their director or the Chief Operating Officer, within 90 days of the work's publication.
- 5.3 The Chief Operating Officer will maintain the above notifications in an *Intellectual Property* register.

6. Reporting of Intellectual Property

- 6.1 The *Intellectual Property* register will be provided to the *Board* annually.

7. Management of Intellectual Property

- 7.1 The *Intellectual Property* of the Sax Institute will be managed in accordance with directions given by the *Board* from time to time. The *Board* may convene a sub-committee from time to time to give advice on, and make decisions regarding *Intellectual Property* matters. In this policy, references to the *Board* may also be read as references to such a sub-committee.

8. Functions of the Board

- 8.1 The functions of the *Board* in relation to *Intellectual Property* include:
- monitoring the *Intellectual Property* register;
 - giving directions regarding the management of *Intellectual Property*;
 - giving directions regarding the exploitation of any commercially valuable *Intellectual Property* in accordance with Section 9 of this policy; and
 - monitoring the operation of this policy and, where desirable, providing recommendations on its modification from time to time.
- 8.2 In making any decisions under this policy, the *Board* may seek such internal or external advice as it considers appropriate.

9. Exploitation of intellectual property

- 9.1 In cases of notification of *Intellectual Property* of potential commercial value pursuant to clause 5.1, the *Creator* will take reasonable steps to prevent early disclosure of that *Intellectual Property*.
- 9.2 After notification, the *Board* will
- (a) use its best endeavours to determine within 60 days whether the Sax Institute wishes to take steps to protect the *Intellectual Property* notified by the *Creator* or other person; and
 - (b) determine at the same time or any time thereafter whether it wishes to take steps to commercialise the *Intellectual Property*.
- 9.3 Where the *Creator* wishes to commercialise the *Intellectual Property* themselves, should the *Board* decide not to do so, they are required to notify the *Board* of this intention. The *Board* will then make a determination regarding *commercialisation* within 60 days of being so notified.
- 9.4 The *Board* may be convened and meet out of session in order to make such determinations. The *Board* may make a determination in relation to protection and commercialisation at the same time, or it may make a determination to proceed with protection and make a separate later determination as to commercialisation.
- 9.5 Where the Sax Institute determines to proceed with commercialisation of *Intellectual Property*, the *Board* will consult with the *Creator* regarding appropriate vehicles for commercialisation, but final decisions in relation to pathways of commercialisation are matters for the *Board*.
- 9.6 *Creators* will promptly execute any documents necessary to provide the Sax Institute with the necessary rights and entitlements to proceed with commercialisation.
- 9.7 Where the Sax Institute proceeds with commercialisation, the *Board* will determine the share of any *Net Benefits of Commercialisation* that will be distributed to the *Creator*. The share distributed to the *Creator* will not be less than one third of the *Net Benefits of Commercialisation*.
- 9.8 Where there is more than one *Creator*, the share to the *Creators* will be distributed amongst the *Creators* in a formula determined by them. Where no such agreement is reached between the *Creators*, the *Board* will distribute the share equally between all the *Creators*, and any disputes regarding the shares of individual *Creators* will be a matter for them.
- 9.9 Taxation obligations which flow to *Creators* as a result of sharing in the benefits of commercialisation are wholly a matter for them, and *Creators* must seek their own advice in this regard.
- 9.10 Where the *Board* determines that the *Intellectual Property* shall not be commercialised, the Sax Institute will notify the *Creator*, and inform them that they are free to commercialise that *Intellectual Property* for their own benefit at their own cost. The *Board* shall execute such assignments of the intellectual property back to the *Creator* as are required to allow the *Creator* to pursue commercialisation.

The Board may place terms and conditions upon such commercialisation by the *Creator*, including recovery of a share of profits commensurate with the Sax Institute's contribution to the development of the *Intellectual Property*.

- 9.11 The Sax Institute shall execute any necessary documentation in order to assign the *Intellectual Property* to the *Creator* for the purposes of commercialisation by them.

SECTION C: INTELLECTUAL PROPERTY FROM THE SAX INSTITUTE'S

DEALINGS WITH THIRD PARTIES: This section (clauses 10 to 12) sets out the basis upon which the Sax Institute will enter into contracts, agreements and arrangements with third parties regarding *Intellectual Property*. The section sets out the principles upon which the Sax Institute will seek a fair and equitable distribution of rights over *Intellectual Property*:

- developed by third parties using the Sax Institute's *Research Assets*, such as *Intellectual Property* developed by researchers who are provided with access to the 45 and Up Study;
- developed by the Sax Institute and a third party together in the course of a *Collaborative Project*, such as *Intellectual Property* developed by a research team of which a Sax Institute *Employee* is a member together with University employees and other third parties;
- developed as a result of third parties commissioning the Sax Institute to undertake work on their behalf, such as *Intellectual Property* in research reviews commissioned under the Evidence Check Program.

10. Intellectual Property and Research Assets

10.1 In order to maintain the integrity of the Sax Institute's *Research Assets* as consolidated resources, the Sax Institute asserts ownership over all *Research Asset Intellectual Property*.

10.2 The Sax Institute will have in place agreements that grant licences to use the *Research Asset Intellectual Property* for the purposes of research and projects approved by the Sax Institute in accordance with its policies and procedures from time to time. All persons seeking access to *Research Asset Intellectual Property* will be required to execute such an agreement.

10.3 The above agreements will generally seek the following:

- Where a person licensed to use the *Research Asset Intellectual Property* develops further *Intellectual Property* which may enhance the *Research Asset Intellectual Property*, the Sax Institute will seek a non-exclusive royalty-free perpetual licence of that *Intellectual Property* but only for the purpose of enhancing the *Research Asset* for the public good, and on such terms and conditions that do not derogate from the purposes for which the person was originally licensed to use the *Research Asset Intellectual Property*.
- Where a person is licensed to use the *Research Asset Intellectual Property* to conduct a *Sub-study*, the Sax Institute will seek a non-exclusive world-wide, royalty-free, perpetual licence over any *Intellectual Property* created as a result of the *Sub-study*, but only for the purposes of enhancing the use of the *Research Asset* for the public good and on such terms and conditions

that do not derogate from the purposes for which the person was originally licensed to use the *Research Asset Intellectual Property*.

- Where a person licensed to use the *Research Asset Intellectual Property* uses that *Intellectual Property* to create new *Intellectual Property* from which they derive a significant financial benefit, the person must notify the Sax Institute, and the Sax Institute will seek a share of that benefit, either through a financial contribution or appropriate licensing arrangements.

10.4 For clarification, the Sax Institute will not assert any ownership over copyright in *Scholarly Works* of persons licensed to use *Research Asset Intellectual Property*.

11. Intellectual Property and Collaborative Projects

11.1 Where the Sax Institute engages in *Collaborative Projects* with third parties, appropriate arrangements will be put in place for the equitable sharing of *Intellectual Property* with the collaborative partners.

11.2 Where *Employees* and *Visitors* engage in *Collaborative Projects* with third parties, they are required to notify their directors or the Chief Operating Officer prior to the commencement of the collaboration, in order to ensure that appropriate arrangements are in place.

12. Intellectual Property in *Commissioned Research and Reviews*

12.1 The Sax Institute brokers the commissioning of research and evidence reviews for use by policy agencies under its Evidence Check program and in other circumstances. It is recognised that the ownership and management of *Intellectual Property* created in the course of conducting *Commissioned Research and Reviews* may involve contentious issues.

12.2 The Sax Institute is currently developing a policy on publication and dissemination of *Commissioned Research and Reviews*. At present, the Sax Institute will negotiate *Intellectual Property* arrangements for *Commissioned Research and Reviews* on a case by case basis, in accordance with such Sax Institute Standard Operating Procedures that are in place from time to time.

SECTION H: MISCELLANEOUS: This section deals with the Sax Institute's position in respect of *Moral Rights*, the resolution of disputes that may arise from the application of this policy, and the preservation of its legal rights to deal with *Intellectual Property*.

13. Moral rights

13.1 The Sax Institute recognises the *Moral Rights* of authors in accordance with Australian law.

13.2 The Sax Institute will respect the *Moral Rights* of its *Employees* and *Visitors*.

13.3 The Sax Institute will preserve the *Moral Rights* of authors of *Commissioned Research and Reviews* but may seek an author's consent to the limited waiver of the moral right of attribution where this is reasonably necessary for the work to be used for the purposes for which it was commissioned.

14. Conflict resolution

14.1 Conflicts between *Employees* or *Visitors* and the Sax Institute over *Intellectual Property* issues will be dealt with in accordance with the Sax Institute's grievance procedures.

14.2 Disputes with funding agencies, partners and persons with whom the Sax Institute contracts will be dealt with in accordance with the relevant written agreement.

14.3 All disputes with third parties will be dealt with as far as possible through negotiation and conciliation, with legal proceedings being a process of last resort.

15. Preservation of legal rights

15.1 Despite any provisions in this policy, the Sax Institute asserts its rights to assign or licence its *Intellectual Property* in accordance with the law.

END OF POLICY

For more information about the Intellectual Property Policy please contact Deborah Frew, Director, Policy Impact Program on (02) 9514 5976 or Deborah.frew@saxinstitute.org.au.