

PATENT ASSIGNMENT COVER SHEET

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CONVEYING PARTY DATA		
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	Property Type	Number
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29 August 2019

Dr Dean Moss
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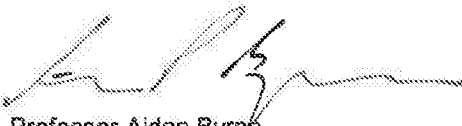
Dear Dean,

I am writing to provide a statement of service verification for Professor Mark Anthony Furnace Kendall in his capacity as a Professor at The University of Queensland.

I confirm that Professor Kendall was a full-time employee at The University of Queensland between 1 March 2006 and 18 March 2018.

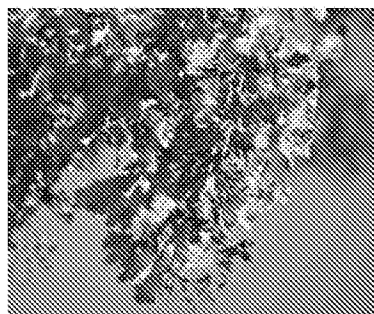
In accordance with the University's Intellectual Property Policy for Staff, Students and Visitors (PPL 4.10.13a) and the terms of his employment contract, I verify that the University owns all IP created by Professor Kendall during the course of his employment with the University.

Yours sincerely



Professor Aidan Byrne
Provost and Senior Vice-President

D19/1474980-1



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4.15.1 Intellectual Property Policy for Staff, Students and Visitors

 Print version

Policy Number: 4.15.1

Contact Officer: Director, Research and Research Training Division

Date Approved by Senate: 30/11/2009

Date last Amended: 30/11/2009

Date for Next Review: 30/11/2012

Related Policies: 1.50.2

Overview

1. Introduction

1.1 The University of Queensland (UQ) is dedicated to fostering a research culture in which commercialisation, technology transfer and entrepreneurial endeavour are critical aspects. Increasingly, the University recognises the importance of commercialising Intellectual Property (IP) in the creation of wealth and other benefits. The value is attested to by its role in attracting research funding, promoting linkages with industry, and in the financial rewards and social benefits resulting from its successful commercialisation.

1.2 The University is in the privileged position of being able to use its research expertise, not only to extend knowledge, but also to help to build knowledge-based industries. The result of this is employment growth and national wealth generation, and the delivery of new products and processes to the Australian community. Effective management of IP becomes, therefore, one of the most critical steps in the University's scholarly endeavours and in the translation of research into national wealth. In this regard, the University is committed to improving the understanding of intellectual property rights among its staff and students.

1.3 This Policy regulates the protection, management and commercialisation of University IP and provides specific guidance to University staff, students and visitors on IP-related matters. The University recognises the need for the underlying interests of staff, students and the wider community to be taken into account when dealing with its intellectual property.

1.4 This Policy ensures the University's compliance with the *National Principles of Intellectual Property Management for Publicly Funded Research*.

Description

2. Objectives

2.1 IP is of little economic value unless it is protected and developed. This Policy has as its primary objective the establishment of flexible mechanisms by which the University is able to identify, protect, manage and commercialise its IP. By successfully meeting this objective, the University and its staff and students will be in a stronger position to benefit from:

- a. attraction of industry and government research funding;
- b. establishment of an international reputation for research excellence;
- c. establishment of linkages with other universities, industry and government;
- d. generation of financial returns from commercialisation;
- e. growth of knowledge-based industries through research and its commercialisation; and
- f. generation of national wealth, through new products, services and employment.

2.2 The University recognises that its staff and students are its most valuable resource. This Policy aims to provide incentives for staff and students to create valuable IP, and, where they do so, to reward their innovation.

3. Types of Intellectual Property

3.1 Intellectual Property is a category of property rights recognised under the laws of Australia and can be defined as those rights arising from the output of the human intellect. Intellectual Property rights arise in relation to certain types of subject matter and those rights can be sold, purchased and licensed. Types of Intellectual Property include, but are not limited to:

- Patents – regulated by the *Patents Act 1990 (Cth)*;
- Copyright – regulated by the *Copyright Act 1968 (Cth)*;
- Trademarks – regulated by the *Trademarks Act 1995 (Cth)*. Unregistered trademarks are protected under Common Law.
- Design Rights – regulated by the *Designs Act 2003 (Cth)*;

- Circuit Layout Rights – regulated by the *Circuit Layouts Act 1989 (Cth)*;
- Plant Breeder's Rights – regulated by the *Plant Breeder's Rights Act 1994 (Cth)*;
- Confidential Information (consisting of trade secrets, know-how or other proprietary information and background knowledge that attracts an obligation of confidentiality) – protected by the Common Law.

3.2 "IP" means all types of Intellectual Property.

3.3 In the context of University-supported research and teaching, IP of most relevance would generally relate to patents, copyright and confidential information (through the exchange of valuable information and material). Of these, patents and on-line teaching materials have the greatest potential for generating commercial income. University know-how is important in terms of attracting research funding, and will often constitute the basis of patents and other forms of IP protection.

4. Moral Rights

4.1 A sub-category of rights under the *Copyright Act* are Moral Rights, which protect the right of a creator of original copyright works to be recognised as the creator of those works (Right of Attribution) and the right to object to the derogatory treatment of those works (Right of Integrity). These rights are personal rather than proprietary in nature and as such cannot be sold, licensed or assigned. Furthermore, moral rights vest in the creator irrespective of his/her employment status and the ownership of the copyright in the work. The *Copyright Amendment (Moral Rights) Act 2000 (Cth)* sets out these rights in detail.

5. Ownership of Intellectual Property - Staff

5.1 "Staff" means an employee of the University and includes academic staff (including those on Special Studies Programs) and general staff whether employed on a full-time, part-time or casual basis at the time he or she creates IP. "Staff" does not include employees of another institution or entity who are physically located at UQ.

5.2 Subject to any specific agreement to the contrary, the University owns all IP created by staff in the course of their employment. The University will make reasonable provision for the financial reward of staff who create IP that is successfully commercialised, as set out in Section 9 of this Policy. The University does not seek to claim ownership over any IP created by staff outside the course of their employment.

5.3 Scholarly Works: "Scholarly Works" includes any article, book, manual, musical composition, creative writing or like publication or any digital or electronic version of these that contains material written by staff based on that staff member's scholarship, learning or research, but does not include work that is a computer program, teaching material or administration material. In the absence of the scholarly publication arising as a part of a staff member's duties (for example, a school study guide) or an overriding contractual obligation with a third party, a staff member can presently assume, in line with past practice, that he/she will retain ownership of the copyright in scholarly works created in the course of his/her employment). The University gains an unrestricted licence to use the work free of charge.

5.4 Computer Programs: "Computer Program" means an expression in any language, code or notation of a set of instructions intended (either directly, or after conversion to another language, code or notation and/or reproduction in a different material form) to cause a device having digital information processing capabilities to perform a particular function.

If a staff member creates a computer program in the course of his/her employment at the University, the University will own the copyright and any other form of IP vesting in that work.

5.5 Teaching Materials: "Teaching Material" means all information, documents, materials or digital objects created or used for the purposes of teaching and education at the University and includes lecture notes that are made available to students, computer-generated presentations, course guides, overhead projector notes, examination scripts, examination marking guides, course data bases and websites. Teaching Material excludes personal lecture notes that are not made available to students. If a staff member creates any teaching material in any medium (including multi-media) in the course of his/her employment at the University, the University will own the copyright and any other form of IP vesting in that material. As such, the University has the right to use, reproduce, publish, communicate, perform, broadcast, adapt and disseminate that material for its education, research and academic purposes. However, the University will recognise the staff member's moral rights of attribution and integrity. Use of the material should involve consultation with the staff member concerned where this is practical. The University permits the staff member to utilise the teaching material he or she creates (excluding the contribution of others to collaboratively-produced materials) for education purposes at other educational institutions. The ownership of any third-party material will be governed by any contract between the University and the third-party.

5.6 Administration Materials: Administration materials created by a staff member in the course of his/her employment will be owned by the University.

6. Ownership of Intellectual Property – Students

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6.1 "Student" means a person enrolled as a student of the University, or in a course or program of study conducted by or on behalf of the University, at the time he or she creates IP.

6.2 Unless there is specific agreement to the contrary, a student will own the IP that he or she creates while studying at the University.

6.3 Where students are undertaking research as part of a project between the University and an external sponsor or on a commercially-oriented project, the University may request an assignment of the student's IP, in most cases before allowing the student to participate in that particular project. This permits the University to comply with the terms of any contract it may have with the sponsor, and to be able to commercialise all of the IP resulting from the project. The assignment of IP does not include assignment of the copyright in the student's thesis or in publications authored by them and arising out of their studies. The University recognises that students must retain the ability to control the reproduction of the text of their thesis to ensure that their careers benefit from publishing the results of their work.

6.4 Where IP with commercial potential has been created jointly by a student and the student's advisor or other University staff, the University may also request the student to assign their interest in that IP (except copyright in the student's thesis) to the University.

6.5 If a staff member is also enrolled as a student and the subject matter of his/her study is also the work for which the staff member is employed by the University, the University as employer will own any IP the staff member creates in his/her course of study.

6.6 Where students have assigned their IP to the University they are entitled to be treated in the same way as staff for the purpose of sharing in commercial benefits, including financial returns, from the commercialisation of the IP. In determining financial returns, the University will take the following into account:

- a. the degree of intellectual input from the advisor, other University staff and third-parties;
- b. the nature and extent of any University or third-party IP accessed or used by the student; and
- c. the nature and extent of any use a student makes of University facilities.

7. Ownership of Intellectual Property - Visitors

7.1 "Visitor" means any person other than a staff member or student of the University who takes part in any research project or scholarly activity that is conducted by any staff member or student of the University, or who visits any part of the University in which research or scholarship, or any related activity, is conducted at the time they create IP.

7.2 Visitors are required to disclose any IP with commercial potential that they create while at the University. The commercialisation of that IP and sharing of any net commercial benefits will be negotiated on a case-by-case basis, including with the visitor's employer. The University will recognise the publication rights of visitors subject to any overriding commercial imperative.

8. Indigenous Cultural and Intellectual Property Rights

8.1 "Indigenous Cultural and Intellectual Property Rights" refers to Indigenous Australians' rights to their heritage, and consists of the intangible and tangible aspects of the whole body of cultural practices, resources and knowledge systems developed, nurtured and refined by Indigenous people and passed on by them as part of expressing their cultural identity.

8.2 The heritage of Indigenous people is a living one and includes items that may be created in the future, based on that heritage. Indigenous Cultural and IP Rights are increasingly being recognised internationally through treaties and standard setting developments by the United Nations and its agencies. The University recognises and will protect Indigenous Cultural and IP Rights to the fullest extent permitted by Australian law.

9. Reward for Staff Contributors

9.1 The University wishes to encourage innovation by rewarding staff, students and visitors who create valuable IP ("contributors"), regardless of whether that IP vests in research or teaching materials. The University will ensure that the Net Proceeds of Commercialisation are distributed with one-third to the contributors, one-third to the relevant Faculty/Institute and one-third to central University funds. "Net Proceeds of Commercialisation" means the total of net cash revenues received from commercialising the IP (including royalties, license fees, milestone payments, dividends and proceeds from the sale of shares but excluding R&D funds, consulting funds, returns from direct investment by the University or a Commercial Company, and any encumbered revenues until the encumbrance is lifted). Net Proceeds of Commercialisation are less all expenses incurred by or on behalf of the University in respect of commercialising the technology that have not previously been recovered.

9.2 Commercialisation arrangements executed prior to the date of this policy will remain in accordance with the arrangements and policies in force at that time.

9.3 The individuals named as contributors and the sub-division of the Net Proceeds of Commercialisation distributed to them shall be based upon the written agreement of contributors. Any difficult negotiations on the ownership of IP and returns to contributors

may be referred to the Deputy Vice-Chancellor (Research) for advice and mediation.

9.4 Distributions of Net Proceeds of Commercialisation will be made to contributors regardless of whether they remain employed by the University. If a contributor is deceased, the distribution will be paid to the estate (or beneficiaries). The University will withhold payment when it believes the law requires it to do so.

9.5 The distribution of Net Proceeds of Commercialisation from projects managed by a "University company" operating as a subsidiary of UQ Holdings Pty Ltd is regulated by The Heads of Agreement between the University and UQ Holdings Pty Ltd.

10. Identifying Intellectual Property

10.1 The protection, management and commercial exploitation of University IP depend on its early identification and protection. Thus, it is essential that research projects are carefully monitored and their outcomes reviewed by staff and University officers with specific IP expertise. Staff, students and visitors should review their research activities regularly, keep detailed project and research records, and fully disclose in a timely fashion the creation of new IP with potential commercial value to the University or University company. Any unauthorised disclosure of IP must be reported.

10.2 It is recognised that where IP has little or no commercial value, staff have the substantial freedom to determine how to disseminate research outcomes and, in particular, the ability to control the publication process.

11. Protecting Intellectual Property

11.1 As stated above, staff, students and visitors have a continuing obligation to report the creation of IP with potential commercial value to the University or University company. That disclosure must include all particulars, data, results, findings and commercial interactions associated with the IP to enable fully-informed decision making by the University or University company. Any new data, results, findings and commercial interactions associated with the IP disclosed in the original report must also be disclosed to the University or University company on a continuous basis.

11.2 After a disclosure has been made, the University or University company will determine whether it wishes to protect and/or commercially exploit the IP. While this takes place, staff, students and visitors who have contributed to the creation of the IP must take all reasonable steps to protect that IP by avoiding public disclosure, for example through publication or academic conferences.

12. Commercialising Intellectual Property

12.1 Commercialisation is a complex and often lengthy process and requires commitment and diligence from those involved. There are a variety of pathways to commercialisation and numerous steps

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involved in the process, which will be unique in almost every case. Staff will use their best endeavours to assist in the commercialisation of IP.

12.2 The University or University company will decide whether to proceed with the protection or commercial exploitation of IP within 18 months of disclosure being made.

12.3 Where the decision is made to proceed with the protection or commercialisation of IP, contributors will have the opportunity to participate in processes associated with the protection and commercial exploitation of IP that they have helped create. Successful commercialisation of IP has in the past involved contributors participating as follows:

- fully disclosing new technologies at the earliest opportunity;
- working with the University company and patent attorneys to draft and lodge patents;
- undertaking further research in a timely manner to enable patents and provide the information necessary to facilitate final patent filing;
- answering promptly and professionally technical queries posed by the University company and the interested parties;
- assisting and writing appropriate parts of the documents required to proceed with the commercialisation strategy;
- developing and delivering presentations on the technology in association with the University company;
- assisting in negotiations with licencees and investors where appropriate in relation to the technology and future development;
- agreeing to undertake further research and support the commercial partner's activities, but only on a fully funded basis; and
- assisting with the management of the ongoing commercial arrangements.

12.4 Where the decision is made not to proceed with the protection or commercialisation of IP, or if a decision is made to cease commercialising at a later stage, the University may permit inventors themselves the opportunity to seek funding and commercial partners. This will not, however, affect the University's right to seek a share of commercial revenue from any such commercialisation by the contributor.

13. Dispute Resolution

13.1 If a dispute arises about how to interpret or apply this Policy, a grievance may be notified according to the procedures set out in

the University's *Staff Grievance Resolution Policy* or in the case of students, the University's *Student Charter*.

14. Conflict of Interest

14.1 A conflict of interest exists where the financial interest of, or the involvement that a staff member, student or visitor may have with another party, conflicts with the duties and obligations owed by them to the University. The University's *Code of Conduct* and *Personal Relationships in the Workplace Policies* outline the University's obligations in this regard. Full and prompt disclosure of any potential conflicts of interest to the relevant Executive Dean and University company is required to protect the University and to allow for an objective evaluation of the benefits of prospective commercial involvement with a third party.

15. Terms of Employment

15.1 Subject to any agreement to the contrary specifically approved by the Vice-Chancellor in writing, this Policy shall form part of the terms of employment of University staff.

16. Variations to Policy

16.1 This Policy may only be waived or modified in exceptional circumstances with the written approval of the Vice-Chancellor.

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Authorised by: Executive Director (Operations) and University Secretary

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