

LA TROBE UNIVERSITY

**EXPLANATORY MEMORANDUM FOR THE INTELLECTUAL PROPERTY
STATUTE 2009**

Council is invited to make the attached **Intellectual Property Statute 2009** (the new Statute).

The new Statute is intended to replace Statute 32 – Intellectual Property and Regulation 32.1 – Inventions, Discoveries and other Intellectual Property.

The new Statute provides for the ownership, protection, use and commercial exploitation of Intellectual Property rights that subsist in things created within the University by academic and general staff as well as students.

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LA TROBE UNIVERSITY

INTELLECTUAL PROPERTY STATUTE 2009

The Council of La Trobe University makes this Statute under section 30 of the *La Trobe University Act 1964*.

PART 1—PRELIMINARY

1. Name and commencement

- (1) This Statute is the **Intellectual Property Statute 2009**.
- (2) This Statute comes into full force and effect on 1 July 2009.

2. Interpretation

In this Statute—

Commercial Exploitation means the application, publication, development, use, assignment, licensing, sub-licensing, franchising, exploitation, sale or other utilisation of Intellectual Property for the purpose of generating financial or other commercial gains;

Computer Program has the same meaning as in the Copyright Act;

Confidential Information means information of any kind which, because of its confidential character, is capable of protection by contractual or equitable means, and includes information of a valuable commercial or technical character;

Copyright Act means the *Copyright Act 1968* (Cth);

Copyright Work means any artistic work, literary work, dramatic work, musical work, sound recording, cinematograph film, television broadcast, sound broadcast or published edition of work within the meaning of the Copyright Act;

Creator means a person who creates or discovers whether in conjunction with other persons or persons or otherwise, any invention discovery or Intellectual Property;

Honorary Staff Member means any person who holds an honorary position or other equivalent position at the University;

Intellectual Property means any rights in relation to copyright, designs, inventions, plant varieties, trade marks (including service marks), Confidential Information, trade secrets, know-

how, circuit layouts and patent rights, whether registered or unregistered;

Intellectual Property Policy means the policy on Intellectual Property approved by Council for the purposes of this Statute and includes any procedures made under that policy;

Literary Work has the same meaning as in the Copyright Act;

Publishable Work means a Literary Work the subject matter of which is primarily concerned with scholarship, research or academic debate, or which is a creative work of fiction or poetry;

Specified Work means any literary, dramatic, musical or artistic work but does not include—

- (a) Teaching Materials;
- (b) Computer Programs; or
- (c) Copyright Works subject to an agreement under section 9;

Staff Member means a member of the full-time, part-time or casual academic or general staff, whether holding a permanent or other position;

Teaching Materials means any Copyright Works developed or used by a Staff Member for the purpose of teaching and education at the University and made available to a student including without limitation reading lists, subject plans, curriculum outlines, lecture notes, visual aids, exam scripts or websites in any format whatsoever including printed or electronic format, but does not include personal notes created by a Staff Member and not distributed to a student.

PART 2—OWNERSHIP, ASSIGNMENT AND PROTECTION

3. Ownership of Intellectual Property

Subject to this Statute and to any written agreement between the University and a Staff Member, the University owns all Intellectual Property created by a Staff Member which is created in the course of, or pursuant to, or under the terms of, the Staff Member's employment with the University.

4. Academic Staff Members to own copyright in Specified Works

- (1) Subject to subsection (2), an academic Staff Member owns copyright in a Specified Work created by that academic Staff Member.
- (2) Despite subsection (1)—
 - (a) if a Specified Work relates to an invention in respect of which a patent has not already been granted, an unregistered design or an unregistered plant variety, the academic Staff Member must not publish or otherwise disclose the Specified Work to any third party without the written authorisation of the University; and
 - (b) if a Specified Work is not a Publishable Work, the University shall have a non-exclusive, royalty-free, worldwide and irrevocable right, including a right to licence, to Commercially Exploit, use, perform, reproduce or communicate the Specified Work for the purposes of education, teaching or research.

5. Teaching Materials

- (1) Subject to subsection (2), if the University owns the copyright in any Teaching Materials developed or used by an academic Staff Member, then the academic Staff Member shall have, by virtue of this subsection, a non-exclusive, royalty-free, worldwide, non-transferable licence to use the Teaching Materials for teaching and research purposes, both during and after the term of the member's employment at the University.
- (2) An academic Staff Member's use of Teaching Materials under a licence under subsection (1) is subject to any relevant contractual arrangements entered into by the University with a third party, being contractual arrangements of which the academic staff member has notice or ought reasonably to have had knowledge.

6. Student Intellectual Property

Intellectual Property developed by a student in the course of his or her studies at the University is owned by that student.

7. Sharing the proceeds of Commercial Exploitation

- (1) Subject to subsection (2), proceeds accruing to the University from the Commercial Exploitation of Intellectual Property which the University owns or is licensed to use will be shared with the Creators of the Intellectual Property (including any Creators who are students) in accordance with the Intellectual Property Policy.
- (2) Subsection (1) does not apply in respect of any proceeds derived from the Commercial Exploitation of Teaching Materials developed for the purpose of delivering a degree, diploma, course or other unit of study to a student, regardless of where, by whom and in what mode such degree, diploma, course or unit of study is delivered.

8. Securing and protecting Intellectual Property

- (1) A Creator of Intellectual Property which the University owns or in which the University has an interest under this Statute—
 - (a) must, at the request of the University, execute any documents and do any acts or things required by the University, including without limitation execute a deed of assignment, to give effect to the provisions of this Statute including without limitation to secure or protect the University's title to or interest in the Intellectual Property; and
 - (b) must refrain from dealing with the Intellectual Property in any manner that is inconsistent with the University's rights in the Intellectual Property.
- (2) A Creator of Intellectual Property which the University owns under this Statute must not disclose or use that Intellectual Property without the written authorisation of the University if—
 - (a) the Intellectual Property comprises an invention, an unregistered design, an unregistered plant variety or a Copyright Work that relates in whole or in part to an invention, design or plant variety; or
 - (b) the disclosure or use is otherwise likely to prejudice the University's ability to protect, Commercially Exploit, prosecute or enforce the Intellectual Property or its rights in the Intellectual Property.
- (3) A Staff Member who creates an invention which the University owns in whole or in part under this Statute must, upon the invention being created, promptly notify the existence of the invention to the University in accordance with the Intellectual Property Policy.

- (4) An Honorary Staff Member who creates an invention in the course of performing his or her duties at the University must, upon the invention being created, promptly notify the existence of the invention to the University in accordance with the Intellectual Property Policy.
- (5) A student who creates an invention in the course of his or her studies at the University must, upon such invention being created, promptly notify the existence of the invention to the University in accordance with the Intellectual Property Policy.
- (6) A Staff Member commencing or leaving employment at the University must, in a form prescribed by the University—
 - (a) in the case of a commencing Staff Member, declare any interest in pre-existing Intellectual Property which could reasonably be expected to impact upon or limit his or her ability to perform research or related tasks under to his or her contract of employment with the University; and
 - (b) in the case of a departing Staff Member, notify the University of the existence of any invention he or she has created in accordance with his or her contract of employment with the University which he or she has not already notified the University of under subsection (3).

9. Agreements

- (1) The University may enter into an agreement with a Creator or any other person (including a Creator who is a student) regarding the ownership, licensing, use or Commercial Exploitation of Intellectual Property.
 - (2) An agreement made by the University under subsection (1) prevails over any provisions of this Statute to the extent of any inconsistency.
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PART 3—GENERAL

10. Regulations

- (1) The Council may make regulations—
 - (a) for or with respect to or providing for any matter or thing for the purposes of this Statute; and
 - (b) amending or revoking any regulations made under this Statute.
- (2) The Council must ensure that regulations made under this Statute are promulgated by having the regulations displayed on an official notice board of the University for a period of at least 14 days.
- (3) For the purposes of determining when regulations made under this Statute come into full force and effect within the meaning of section 30(4) of the Act, the regulations are taken to have been promulgated in accordance with sub-section (2) at the start of the first day on which they are displayed on an official notice board of the University.

11. Revocation of earlier University legislation

The following Statute and regulations are **revoked**—

- (a) Statute 32 – Intellectual Property;
- (b) Regulation 32.1 – Inventions, Discoveries and other Intellectual Property.

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Approved by the Council—

Approved by the Minister—