HIGHER DEGREE STUDENTS AND INTELLECTUAL PROPERTY

INTRODUCTION

The University’s policy on the commercial development of its intellectual property was approved by Council in December 1989, on the recommendation of the Vice-Chancellor’s Working Party on Intellectual Property (now disbanded). The policy includes sections on ownership and development of intellectual property, and the sharing of benefits from successful commercial development. It recognises that, in the absence of an employment relationship between the University and its students, students own their own intellectual property. This contrasts with the position of staff: the University owns all intellectual property produced by staff in the course of their employment, although the policy does provide for benefits to be shared with staff.

Nevertheless, there are research projects with commercial potential where it would be appropriate for a higher degree student to assign to the University his or her rights to the intellectual property arising from the research, on the condition that the student shared in the benefits arising from the research in the same manner as University staff.

DEFINITION

Intellectual property is mainly that property which is capable of being legally protected. In the present context this means mainly inventions or discoveries which are patented or patentable, and of processes which can be protected under the Plant Variety Rights Act. Copyright is a form of legal protection, but, with the possible exception of software, it is unlikely that the University would seek to have a student’s copyright assigned to the University. Results of experiments, conclusions from studies and collections of data do not of themselves attract legal protection. But where they are or may be of commercial value, they are also regarded as intellectual property. Mere ideas and suggestions are not usually regarded as intellectual property.

The situations where the University would seek to obtain the rights in a student’s intellectual property are those where the property is linked with other intellectual property being generated within the University; for example, where the student’s project is part of a larger research project involving staff of the University, other than the supervisor, and/or staff from an outside organisation which is wholly or partly funding the project.

In these situations, it is often difficult to separate the student’s contribution from those of the others engaged on the project. It is complicated by the fact that there is often an agreement between the University and the outside funding body about the ownership of the intellectual property arising from the research, or, at least, the use to which the research results may be put, the format in which they may be presented, and the extent to which they may be published.

If there are not to be quarrels, problems and, possibly, litigation between the various parties to research projects with commercial potential, mechanisms for addressing these issues must be found. The most straightforward and appropriate way to do this appears to be to treat the student’s contribution to projects with commercial potential in the same way as any University staff member’s contribution - subject to safeguards ensuring that the student’s candidature for the higher degree is not jeopardised in any way.

POLICY

The University’s policy on commercial development of intellectual property already provides that students can be required to enter confidentiality agreements in respect of their research. That this provision exists amounts to acknowledgment of the kinds of problems that have been referred to above, but it does not go far enough.

Where a University research project has commercial potential, it is University policy that Luminis Pty. Ltd. have the first option on its commercial development. If a project is successful commercially, the policy provides a formula for the sharing of benefits between Luminis, the researcher’s department and the researcher(s). This policy should apply also to the work of students where appropriate.

Recognising that the University cannot simply lay claim to a student’s contribution without the student’s agreement, it is required that an agreement for the assignment of a student’s intellectual property should be entered into with the student as a condition of the student’s research topic being accepted. (See Attachment F)

This agreement will include all conditions relating to the project, including conditions which might restrict disclosure or affect the extent to which communication with colleagues is possible during the course of the work and on its completion.

Sometimes there may be requirements or expressed preferences, particularly by funding bodies, about the format in which research results are to be presented, and whether and to whom they might be offered for publication or disclosed. These matters also need to be
addressed contractually, either in conjunction with an assignment of intellectual property, or, where assignment is not appropriate, separately. (Note: The policy on commercial development of the University's intellectual property provides certain safeguards to a student's candidacy in respect of confidentiality requirements which must be adhered to in any contracts.)

In some cases it may be necessary for an outside funding body also to be party to the agreement.

This strategy is endorsed in the University's Code of Practice for Maintaining and Monitoring Academic Quality and Standards in Higher Degrees.

If a student wishes to work in an area that his or her supervisor or Head of Department believes is commercially sensitive or has commercial potential, the student must agree to the arrangements described above. If the student does not wish to do so, the student would be free to choose another research topic in an area which is less commercially sensitive.

The University’s interest is in that intellectual property produced by students which is connected with other intellectual property being produced within the University itself by staff and other researchers. The University, in accordance with its policy on ownership of intellectual property produced by students (sub-section 10.13 of the University of Adelaide Handbook of Administrative Procedures), does not wish to make assignment of intellectual property compulsory for all higher degree students.

There are some grey areas where a student may disagree with a supervisor or Head of Department about the need for contractual arrangements. To this end, the Board of Research Education and Development will be the arbitrator in any disagreements.

OUTSIDE EMPLOYER

A further problem may exist with the higher degree student who is an employee of another organisation, which is not itself party to a joint research project with the University. In these situations it may be possible for the student’s employer to claim some rights over the intellectual property produced by the student, particularly if the research project is related to the student’s employment.

Consequently, it will be necessary to require potential higher degree students to indicate whether they are in such an employment relationship before their thesis topic is approved, so that suitable arrangements can be made with the students’ employer, if necessary. These arrangements might include obtaining a disclaimer from the employer of any interest in the research, or negotiating a sharing of rights to any intellectual property arising from the research.

PROCEDURES

5.1. General documentation for students

The University's Code states that the obligations of the University, its academic departments and staff, and the students, should be clearly set out in the documentation given to students at the time of admission.

This documentation will specifically draw students’ attention to the implications of their choosing a research project with commercial potential. It will set out the University’s policy, as described above, and as contained in the policy on commercial development of intellectual property. It should also ask students to discuss with their potential supervisor and Head of Department how these policies might affect their proposed research, and what agreements are likely to be necessary to ensure that the proposed research can proceed.

5.2. Acceptance of research proposal

It is essential that the commercial potential of a student’s proposed research project be identified, and all consequential intellectual property arrangements settled, before the student’s research topic is accepted. To this end, the form on which higher degree students are required to submit the outline of their proposed research contain the following provision, which must be endorsed by the student, the principal supervisor(s) and the Head of Department:

- Is this project likely to generate intellectual property which has potential for commercial development and in which the University itself or an outside funding body may have an interest?
- If yes, are the student and the University parties to a contract setting out the rights and liabilities of the student and the University in regard to the intellectual property which may be produced by the research? If third parties are involved, have the necessary contractual arrangements been made with them?
- Are you satisfied that all necessary matters relating to the intellectual property arising from this research, and consequential matters relating to confidentiality and disclosure, have been dealt with in the contract?
- Is the student in an employment relationship with an outside organisation? If yes, have the intellectual property implications of this relationship been appropriately dealt with?
It is also essential that some pro forma contracts be in existence, with room for adaptations as necessary, so that a student’s work is not held up while the necessary contractual arrangements are worked out.

5.3. Supervisors
The University’s guidelines on higher degrees by research state that “... a decision must be made before the commencement of the candidature on the general area of study and the supervisor(s) to be appointed to guide the student in the research. Since it is important that the supervisor is active in the general area of research which is chosen, it is clear that the choice of the field of study and supervisor are inter-related and therefore in practice decisions on both matters will often need to be made together”.

The question of the commercial potential of research in a particular field of study is likely to come up at the time that the field of study and the supervisor are being thought about. It is expected that, in general, potential supervisors of projects in potentially commercially sensitive areas would be aware of the sensitivities and be able to assist in the process of negotiating with the student on intellectual property matters. However, ensuring that intellectual property matters are addressed will need to be included in the responsibilities of supervisors (see Part I of the Code of Practice) and Heads of Departments.

5.4. Monitoring
Details of all contractual arrangements entered into by higher degree students will be kept in the Graduate Studies and Scholarships Branch. This will enable the number and type of such arrangements to be monitored, and provide the basis for reviewing the policy in the future.

FINANCIAL COMPENSATION

If a student is required to sign a Student Project Participation Agreement, the supervisor should have the responsibility of providing supplementary scholarship funding in consideration of the student’s willingness to sign this Agreement. This approach has the advantages of:

- bringing the issue to the attention of the student and the supervisor in each case;
- causing the supervisor to examine the consequences of specifying that a project involves consideration of intellectual property;
- encouraging negotiation at the level where it can actually be determined whether any additional funding is available and at which level such funding (if any) should be provided.
Accordingly, the University requires that

- if a student is required to sign a Student Project Participation Agreement the supervisor should endeavour to provide supplementary scholarship funding in consideration of the student’s willingness to sign the Agreement;

- the total amount of remuneration available to the student (from all sources) need not exceed the current value of an Australian Postgraduate Research Priority Award;

- the matter should be discussed and resolved with the student prior to signing of the Agreement. There should be written evidence of this.