

## Institute for Safety, Compensation and Recovery Research Ownership, rights and obligations in relation to intellectual property

### Introduction

This document is intended to provide a summary of who owns intellectual property (**IP**) used or developed in conducting the Institute for Safety, Compensation and Recovery Research (**ISCRR**) under the research institute collaboration agreement between the Transport Accident Commission (**TAC**), Victorian WorkCover Authority (**WorkSafe**) and Monash University (**Monash**) (**ISCRR Agreement**), and what the TAC's, WorkSafe's and Monash's rights and obligations are in relation to that IP.

This document is a summary only and for more detail you should refer to the ISCRR Agreement. References to the relevant clauses in the ISCRR Agreement are included within this document for ease of reference.

### Categories of IP

The two main categories of IP under the ISCRR Agreement are Background IP and Initiative IP. Initiative IP is further divided into four sub-categories that are dealt with differently under the ISCRR Agreement.

1. **Background IP** is IP that is made available or used by one or more of the parties to carry out an ISCRR research project, but was not developed in the course of any of the ISCRR activities.
2. **Initiative IP** is IP that is developed in the course of carrying out ISCRR research projects and other ISCRR activities. The sub-categories of Initiative IP are:
  - (a) **Funding Provider IP**, which is IP developed in the course of carrying out an ISCRR research project '*where all cash and ancillary assistance or resources towards that Project (other than contributions, assistance or resources that were incidental or not material to the Project) were provided by the TAC and/or WorkSafe*' (clause 24.3(a)(i));
  - (b) **Monash IP**, which is IP that is developed in the course of either carrying out a research project '*where all cash and ancillary assistance and resources towards that Project (other than any contributions that were incidental or not material to the Project) were provided by Monash*', or carrying out ISCRR activities other than research projects (clause 24.3(a)(iii));
  - (c) **Externally Funded IP**, which is IP developed in the course of carrying out a research project '*where that Project was funded, in whole or in part, by any funding provided by a third party (other than any funding that was incidental or not material to the Project)*' (clause 24.3(a)(ii)); and

- (d) **Joint IP**, which is Initiative IP that does not fall into one of the above three categories (clause 24.3(a)(iv)). This encompasses IP developed in a research project where funding and resources were provided by Monash and by either or both of the TAC and WorkSafe.

### **Ownership of IP**

In summary, Background IP remains owned by the party that makes it available for the purposes of ISCR, and Initiative IP is owned by the party who provided the funding towards the ISCR research project in the course of which that IP was developed (which may lead to joint ownership) or, where it was developed in the course of another ISCR activity, Monash. There is an exception for Externally Funded IP, in which case the parties must negotiate ownership taking into account the requirements of the third party funding provider.

The ownership of each category of IP is set out in more detail in the table annexed to this document.

### **Rights and obligations**

In general, the parties who do not own Background IP or Initiative IP have certain rights to use that IP. Most commonly, they may use the IP for the purposes of conducting ISCR projects and for their own internal non-commercial research, development and education purposes. These rights are subject to the user complying with its confidentiality obligations under the ISCR Agreement. This means that, unless the IP is public knowledge, the user must keep the IP confidential subject to the exceptions in clause 25.

The owner of the IP is generally free to do anything with the IP that they like, as long as the owner does not do anything that would prevent it from granting the required licence to the other parties. For example, the IP owner would generally not be entitled to grant an exclusive licence of the IP in an overlapping field, or assign away the IP.

The parties also have further rights, and are subject to further obligations in relation to the protection and enforcement of IP in the case of Background IP or where the IP is jointly owned.

The parties' respective rights and obligations in relation to each category of IP are set out in more detail in the table annexed to this document.

Date: 7 March 2011

## Annexure – detailed summary of ownership, rights and obligations

The ownership of the different categories of IP, and the parties' rights and obligations in relation to that IP, are summarised in more detail below.

Category of IP	Ownership of IP	Parties' rights and obligations in relation to IP	
Background IP	Ownership retained by the existing owner of the Background IP (clause 24.1(a)).	<p><b>Rights and obligations of IP owner</b></p> <p><u>Rights to use and license IP (clause 24.1(b))</u></p> <p>The Background IP owner retains all of its pre-existing rights, as long as it does not do anything that would prevent it from fulfilling its obligation to grant a licence to the other parties for the purposes of commercialising any Joint IP (see far right column). For example, the IP owner must not grant an exclusive licence of the Background IP in an overlapping field without an appropriate carve-out, or assign away the IP.</p> <p><u>Obligation to make materials available (clause 21.6(a)(i))</u></p> <p>The Background IP owner must make available to the other parties all materials comprising the Background IP which are '<i>reasonably necessary</i>' for the purpose of that party carrying out the project.</p> <p><u>Protection and enforcement of IP (clause 24.1(e))</u></p> <p>The owner must use '<i>reasonable endeavours</i>' to defend third party claims against its own Background IP or take other steps to ensure that ISCR projects can be completed and that Initiative IP can be used in accordance with the approved project plan and the ISCR Agreement.</p> <p><b>Rights and obligations of all parties (clause 24.1(e))</b></p> <p>A party must promptly notify each other party if it becomes aware of any claim by a third party that the Background IP</p>	<p><b>Rights and obligations of other parties</b></p> <p><u>Licence of IP (clauses 21.6(a)(ii) and 24.2)</u></p> <p>The other parties may use the Background IP for the following purposes:</p> <ul style="list-style-type: none"> <li>• carrying out the project (and Monash may grant sub-licences to any collaborator involved in the project);</li> <li>• commercialising any Joint IP; and</li> <li>• exercising their rights in relation to Initiative IP (see below for a description of those rights).</li> </ul> <p>These rights are subject to:</p> <ul style="list-style-type: none"> <li>• the user complying with its confidentiality obligations under the ISCR Agreement; and</li> <li>• any other restrictions specified by the IP owner. Such restrictions would be either (for Background IP specified in the plan) set out in the project plan or (for other IP) notified in writing to the other parties at the time the relevant Background IP is offered. <p><u>Infringement of IP (clause 24.1(d))</u></p> <p>Each user must promptly notify the IP owner of any infringement of the Background IP which comes to its attention, and provide certain details.</p> </li></ul>

Category of IP	Ownership of IP	Parties' rights and obligations in relation to IP	
infringes that third party's intellectual property rights, and provide certain details.			
Funding Provider IP	Owned by the TAC, WorkSafe, or both of them jointly, depending on which of them provided the resources for the project (clause 24.3(a)(i))	<p><b>Rights and obligations of IP owner(s)</b></p> <p><u>Where IP owned by either TAC or WorkSafe only</u></p> <p>There are no restrictions on the IP owner's use of the IP, as long as the owner does not do anything that would prevent it from granting the licence to the other parties (see far right column).</p> <p><u>Where IP owned by TAC or WorkSafe jointly (clause 2 of the side agreement)</u></p> <p>The following additional rights and obligations apply under the side agreement where the TAC and WorkSafe own Funding Provider IP jointly:</p> <ul style="list-style-type: none"> <li>• they may not assign, transfer or otherwise deal with their interests in the IP without the other's prior written consent;</li> <li>• they must each keep the IP confidential in accordance with the ISCR Agreement unless it becomes public knowledge, they seek IP protection, or they agree otherwise;</li> <li>• they must comply with the provisions of the side agreement relating to applying for statutory protection of the IP (for example, registered patent protection);</li> <li>• they must each notify the other if it becomes aware of any infringement or third party claim in relation to the IP, and comply with the relevant provisions of the side agreement; and</li> <li>• if the TAC and/or WorkSafe wishes to commercialise</li> </ul>	<p><b>Rights and obligations of Monash (and the TAC or WorkSafe, if not an IP owner) (clause 24.5(a))</b></p> <p>The other parties may use the IP for the usual purposes referred to in the body of this document, and subject to the usual limitation regarding confidentiality of the IP.</p>

Category of IP	Ownership of IP	Parties' rights and obligations in relation to IP	
		the IP, the other must not unreasonably withhold its consent and they must agree on which of them will be the commercialisation party and the commercialisation terms.	
Monash IP	Owned by Monash (clause 24.3(a)(iii))	<p><b>Rights and obligations of Monash</b></p> <p>There are no restrictions on Monash's use of the IP, provided that Monash does not do anything that would prevent it from granting the licence to the TAC and WorkSafe (see far right column).</p>	<p><b>Rights and obligations of the TAC and WorkSafe</b></p> <p><u>Licence of IP (clause 24.5(b))</u></p> <p>The TAC and WorkSafe may use the IP for the usual purposes referred to in the body of this document, and subject to the usual limitation regarding confidentiality of the IP.</p> <p><u>Licence of annual reports (clause 24.8)</u></p> <p>The TAC and WorkSafe have the right to use annual reports provided to them under clause 28.1 of the ISCR Agreement for any purpose, not just the usual limited purposes described above, subject to complying with the same confidentiality obligations.</p>
Externally Funded IP	As agreed between the parties and set out in the approved project plan. The ownership may be amended by the written agreement of the parties (clause 24.6(a)).	<p>The parties' rights to use the IP will be agreed between the parties and set out in the project plan approved for the relevant research project. The extent of the rights may be amended by the written agreement of the parties (clause 24.6(a)).</p> <p>In determining ownership of, and rights to use the IP, the parties:</p> <ul style="list-style-type: none"> <li>• must take into account: <ul style="list-style-type: none"> <li>○ the relative contributions of each of the parties to the development of the IP; and</li> <li>○ any requirements of the external funding provider; and</li> </ul> </li> <li>• subject to the requirements of the external funding provider, each of the parties must be granted rights to use the IP for research, development and education purposes (clause 24.6(b)).</li> </ul>	
Joint IP	Owned by the TAC,	<u>Licence of IP (item 3 of Schedule 6)</u>	

Category of IP	Ownership of IP	Parties' rights and obligations in relation to IP
	WorkSafe and Monash jointly (clause 24.3(a)(iv))	<p>The parties may use the IP for the usual purposes referred to in the body of this document, and subject to the usual limitation regarding confidentiality of the IP.</p> <p><u>Assignment of IP (items 1 and 2.2 of Schedule 6)</u></p> <p>A party must not assign, transfer or otherwise deal with any of its interest in the IP except with the prior written consent of the other parties. If either the TAC or WorkSafe did not provide funding towards the relevant project in which the Joint IP was developed, its consent is not required.</p> <p><u>Additional rights and obligations (items 1, 4, 5 and 6 of Schedule 6)</u></p> <p>The parties must comply with the provisions of Schedule 6 relating to applying for statutory protection of the IP (for example, registered patent protection).</p> <p>A party must notify the other parties if it becomes aware of any infringement or third party claim in relation to the IP, and comply with the provisions of Schedule 6 relating to infringement or claims.</p> <p>If a party wishes to commercialise the IP, the other parties must not unreasonably withhold their consent and the parties must agree on which of them will be the commercialisation party and on the commercialisation terms.</p> <p>If either the TAC or WorkSafe did not provide funding towards the relevant project in which the Joint IP was developed, these rights and obligations do not apply to it.</p>