



Information Package “Higher Degree Student IP Assignment” for Supervisors

1. QUT’s Intellectual Property Policy - Why does QUT require a student to assign his or her Intellectual Property (IP) Rights?

- IP rights are a set of legal rights which protect the results of creative and inventive endeavours of the mind. The different types of IP include copyright, patents, trade marks, trade secrets, confidential information registered designs, circuit lay outs and plant breeders rights.
- Under QUT's IP Policy (http://www.mopp.qut.edu.au/D/D_03_01.jsp) a student normally owns the IP created during their course of study. However, QUT may in certain situations (see below) ask postgraduate students, as well as undergraduate students, to assign that IP by executing a [Student Intellectual Property and Confidentiality Deed](#).
- Please note that the Student Intellectual Property and Confidentiality Deed (found at www.ocs.qut.edu.au/resources/ipassign.doc) is the only current version and **should be used for all IP assignments from Higher Degree Students to QUT**.

This version may also be used in some circumstances for IP assignments from undergraduate students. However, with regard to undergraduate students it is recommended that you contact the Office of Commercial Services (OCS) for advice about the appropriate IP assignment contract.

- ask for an IP assignment in the following cases:
 - The project the student is involved in has clear commercialisation potential or objectives.
 - A funding agreement or other agreement with an industry partner entitles the industry partner to the IP and QUT is obliged to obtain an IP assignment from the student.
 - The conditions of a scholarship request an assignment of IP.

The copyright in the student’s thesis is generally exempt from the assignment. It is vested in the student.

- The assignment covers a range of research outcomes e.g. a contribution to a paper or other publication prepared by a group of people or a contribution to an invention.
- In consideration for assigning the IP the student is, together with the other creators and QUT, entitled to a share of any commercial benefits arising from the commercialisation of the results ([Chapter D/3.1.9 MoPP](#)) where there has been substantial contribution by the student to the IP being commercialised. Another benefit from this arrangement is that the student does not have to invest any costs with respect to the possibility of realising an income from the commercialisation of IP. QUT bears the costs of protection and commercialisation of the IP (e.g. cost of patent attorneys and other legal costs).

2. Elements of the Intellectual Property and Confidentiality Deed

- IP assignment (clause 2 of the deed)

The student signs over to QUT the rights in the IP he or she creates or acquires in the course of the individual project, described in the Schedule of the deed. In general, the copyright in the student's thesis is excluded from this assignment (clause 4).

QUT can restrict the publication of the thesis, e.g. where results of research have to be kept confidential to secure a patent application. The student needs the consent of QUT for any publication of the thesis.

In consideration for the assignment of the IP the student is entitled to a share of the commercialisation income that QUT might gain which is determined in accordance with QUT's IP Policy.

The effect of the assignment is that QUT owns the IP rights in the student's work together with the rights in the IP created by QUT staff working on the same project.

This enables QUT to protect the complete IP in a project and to commercialise IP produced by a research team or to assign these rights to an industry partner under a funding or collaborative research agreement.

- Moral rights clause (clause 9)

Moral rights are personal rights of a creator of a work, which is able to be protected by copyright. They include the right of attribution of authorship, the right not to have authorship falsely attributed and the right of integrity of authorship.

Moral rights can be infringed, e.g. if a creator is not identified or is falsely identified as the author or if the work is materially altered.

Moral rights stay with the creator even if the copyright has been assigned from the creator to another person. Moral rights are personal rights which cannot be assigned, but the creator can consent to infringements of moral rights. Clause 9 of the deed contains such consent. In the context of QUT's research activities such consent is often required by a funding body or industry partner.

The consent allows QUT (or an industry partner as the case may be) to use the contribution of the student to the project in the future without having to acknowledge the student as the author and to modify the IP created in the course of the project (like reports, articles or interpretation of research data) without having to seek the student's consent each time.

- Power of Attorney (clause 2)

In this clause the student appoints QUT as his or her attorney. This is to enable QUT to protect the project IP effectively, where the protection requires declarations or signatures of the original creators and the student might be overseas and cannot be reached. In some jurisdictions, like the US, for example, patent applications require the signature of the original inventors, even if the IP is assigned to QUT.

- Confidentiality clause (clause 8)

Whilst staff of QUT have confidentiality obligations resulting from the employment relationship with QUT, students are not bound to confidentiality only because of their status as students.

Where a research project deals with confidential information of QUT or an industry partner or with personal data of persons taking part in a survey, etc., QUT has to ensure that the students sign a confidentiality agreement with respect to the individual project before they start working on the project. Where the student also has to sign an IP assignment a confidentiality clause is contained in this deed. Where an IP assignment is not required the supervisor should arrange with OCS for the student to sign a separate confidentiality agreement.

3. What is the supervisor's role?

- It is the supervisor's responsibility to assess whether the student's project requires assignment of the IP. The supervisor is best positioned to make this decision as they know the circumstances under

which the project will be conducted. For example, whether the research has commercialisation potential or involves collaboration with or funding from an industry partner.

- The Office of Commercial Services can offer support for supervisors in deciding if IP assignments should be requested.
- If third parties (e.g. industry partners, agencies providing scholarships) are involved in the project and these parties request agreements relating to the students' IP, all negotiations with such third parties should be conducted through the Office of Commercial Services. The supervisor should contact the Office of Commercial Services if he or she is asked by a third party to negotiate IP agreements.
- The supervisor should also inform the student about the reasons why QUT needs an IP assignment and recommend that the student obtains independent legal advice.
- The supervisor should not give legal advice about the deed but instead explain to the student why he/she should seek independent legal advice. The reason for requesting independent advice is that a student who received only University advice about the deed could later claim that he or she had not received proper information and had been under undue influence to sign the agreement. A successful claim would render the deed invalid. QUT requires the student to sign an Acknowledgement Form indicating whether the student has obtained independent legal advice or not.

Please note that if the student has received independent legal advice in relation to the deed, an amount of up to \$300 will be reimbursed to the student upon presentation of an invoice issued from a practising solicitor and a letter from the solicitor advising that the student has been advised on the terms and effect of the assignment deed.

4. When should a supervisor talk to the student about the IP assignment?

- As early as possible and in any case before the student takes up work on the project for which an assignment might be necessary.
- A good time to talk to the student about IP issues is when the student contacts a supervisor in the process of application for a PhD, masters or professional doctorate place. There might also be an opportunity to consider if an IP assignment is needed when the application has been accepted and an offer is made to the student.

5. Is it possible to alter the terms of the IP assignment and how should such negotiations be conducted?

- The deed expresses QUT's position as to IP assignments. Nevertheless, depending on the circumstances of the individual case, QUT might have room to negotiate certain terms of the deed.
- The supervisor should advise the student to approach the OCS (Director of the OCS, Business Managers or Commercial Contracts Lawyer) in these cases.
- In the past most of these negotiations have concerned the moral rights consent in clause 9 of the deed. QUT might be able to remove this clause from the deed. This decision involves considerations as to the future commercialisation or the future use of the project IP and is made by the Director of the Office of Commercial Services.
- The supervisor can support this decision in answering two questions:
 - Is there no agreement with an Industry partner in place for the project under which QUT might be required to obtain consent to an infringement of moral rights from the student?
 - Is the supervisor aware and content that all future use of the student's input into the project is subject to moral rights legislation? This means inter alia that the student always has to be attributed as the author or one of the authors, that the student is not to be wrongly attributed as the author, and that alterations of his or her project input are restricted.

If OCS obtains a written confirmation of these two points from the supervisor, then in most cases a removal of the moral rights clause will be possible.

6. What are the procedural steps for an IP assignment?

The Student IP Assignment and Confidentiality Deed is available from the Office of Commercial Services website (www.ocs.qut.edu.au/resources/ipassign.doc). The deed is provided together with a cover letter, an excerpt from the MoPP and an Acknowledgement Form attached to it. An information package for students is also available.

The student may already have downloaded the IP assignment and the attached information or the supervisor may be asked to provide the student with the deed, in any event the supervisor should:

- make sure that the student has received the covering letter recommending the student seek independent legal advice and includes excerpts from QUT's IP Policy, two copies of the deed and an Acknowledgement Form;
- make sure that the student has completed the Schedule at the end of the deed detailing the student's name, address and student number, and a short detailed description of the project (including title of the project, title of the student's thesis, course of study e.g. masters or doctorate, name of school and supervisor),
- make sure that the student has signed both copies and that the student's signatures are witnessed;
- ask the student to send the signed Acknowledgement Form and both copies of the deed to the Office of Commercial Services (Commercial Contracts Lawyer, OCS, Level 4, O-Block Podium, Gardens Point Campus). OCS will arrange for signature on QUT's behalf and for storage of the deed. One original of the deed will be sent to the student and the Faculty will receive a copy;
- if the student has received independent legal advice in relation to the deed, an amount of up to \$300 will be reimbursed to the student if the following procedure is followed:
 1. The student must obtain an invoice issued from a practising solicitor and a letter from the solicitor advising that the student has been advised on the terms and effect of the assignment deed.
 2. The student should complete a Supplier Maintenance Form (a copy can be obtained from the Research Students Centre). This form allows QUT to transfer funds from any reimbursement of legal fees directly to your bank account.
 3. The student must present the invoice, solicitor's letter and the Supplier Maintenance Form to the Research Students Centre for payment.