

SVHNS Intellectual Property Policy

Compliance with this Policy is Mandatory – if you are concerned that this policy is not being followed, it's OK to ask.

Applicable to:

SVHNS ☒

SVHS ☐

SJH ☐

SHH ☐

Policy

Context and Purpose:

Context

This policy applies to all intellectual property rights, including rights in confidential information, patent applications and patents, copyright and registered and unregistered trade mark rights.

SVHNS values the input into Health Research from it's Staff and Visitors and will share with them any rewards that arise from the protection and commercialisation of intellectual property rights in Health Research in accordance with this policy.

SVHNS has:

- (a) considered applicable law and policy, including New South Wales government policy applicable to affiliated health organisations and other public health organisations; and
- (b) adopted a governance framework to comply with applicable law and policy;
- (c) ensured the governance framework is consistent with the mission and values applicable to it as a service of the Sisters of Charity Health Service; and
- (d) met its obligations as St Vincent's Hospital Sydney Limited being a wholly owned subsidiary of St Vincent's Health Australia Limited.

Purpose

The purpose of the policy is:

- (a) all Staff and Visitors will have a clear understanding of protection and ownership of intellectual property rights created by Staff and Visitors, and will notify the IPC of all potential intellectual property rights in Health Research; and
- (b) the establishment of a framework for the fair distribution of the rewards of any commercialisation of intellectual property rights in Health Research is implemented.

To achieve the purpose, implementation by way of contract(s) and other documents may be required. Those affected are encouraged to obtain legal (including tax) advice.

Outcome:

Definitions

Staff	all officers, contractor, agents and employees of SVHNS
Visitor	any person providing services at SVHNS other than as Staff, in either a non-remunerated or honorary position, including honorary appointees, visiting practitioners, visiting medical officers and honorary medical officers, clinical academics, conjoint appointees, joint appointees, students; and any person (other than a student or Staff) who utilises the resources of SVHNS at any time, such as a visiting researcher.
Department	the part of SVHNS which is involved in the relevant Health Research, as determined by the CEO
Health Research	means laboratory, pro-clinical and clinical research and development in at its forms, including: <ul style="list-style-type: none"> • development of epidemiological and research methods • development of treatment procedures and methods • development of equipment or other goods for use in a clinical or public health setting • biomedical research • pharmaceutical research.
SVHNS	an affiliated health organisation under the Health Services Act 1997 (NSW) including its recognised establishments being St

Policy Statement/Policy Scope:

SVHNS, as the employer of Staff, owns all the intellectual property rights created or developed by Staff in the course of his or her employment.

Where SVHNS permits a Visitor to use any of SVHNS's resources for Health Research, SVHNS is to own all the intellectual property rights created or developed by the Visitor in the course of that Health Research. This is because such resources should be used only in the course of employment or otherwise with the agreement of SVHNS. Accordingly, SVHNS retains or obtains ownership of, and all benefits that arise from, such intellectual property rights. To ensure this policy is legally effective, SVHNS must ensure it obtains appropriate written assignments of intellectual property rights from Staff and Visitors.

However, SVHNS will:

- (a) transfer to Staff and Visitors who author journal articles, book chapters, or books, dealing with Health Research, within the course of their employment or using approved resources, the copyright in such works, in return for a licence back to SVHNS to use, copy and adapt the works; and
- (b) share with Staff and Visitors the rewards from commercialisation of intellectual property rights in Health Research in accordance with this policy.

Responsibilities and rights

It is the responsibility of SVHNS to:

- (a) educate Staff and Visitors about this policy; and
- (b) administer this policy and provide advice/information as to its implementation.

It is the responsibility of Staff and Visitors to:

- (a) ensure the commercial and other confidentiality of the creation and development of any intellectual property rights is preserved; and
- (b) notify the IPC, in accordance with the procedures applicable to the IPC from time to time, of all potential commercial opportunities in intellectual property rights in Health Research.

SVHNS maintains the right to determine the creation, development and commercial exploitation of its intellectual property rights, including branding and trade marks. The IPC will advise the CEO on any risks of any particular proposed commercialisation.

SVHNS will conduct the development of any approved intellectual property rights in Health Research for commercial purposes in conjunction with the inventors whilst they remain Staff of SVHNS and are willing to be involved.

Creation or development of intellectual property rights

There are three ways in which SVHNS may gain ownership of intellectual property rights:

Staff

(a) Intellectual property rights created or developed by Staff in the course of their employment or as a result of their use of SVHNS's resources, including funding.

Outside collaborators

(b) Staff are encouraged to cooperate with outside collaborators in the conduct of creative Health Research.

(c) If a research project is likely to result in the creation or development of a commercially viable process or product then, prior to the establishment of joint collaborative research project, the collaborators must reach agreement as to the distribution of the benefits of any intellectual property rights created in that project.

(d) The inventor(s) cannot negotiate any arrangement for the creation or development of a process or product without the consent of the CEO. In general, the financial rewards of these processes or products will be shared among the collaborators in proportion to their inputs into the project. Any agreement reached must be endorsed by the IPC before the project starts.

Visitors and researchers who are self-employed or employed by third parties

(e) SVHNS aims to reach arrangements or understandings with universities and other research organisations with which it may collaborate in Health Research. Where as a result of such collaboration SVHNS owns intellectual property rights in Health Research, any benefits arising from that ownership will be shared in accordance with this policy.

Confidentiality, publication and patent applications

The steps leading to commercialisation of potentially viable processes and products must be kept confidential. Publication of relevant data before a patent application is lodged is likely to invalidate part or all of any claimed patent.

Staff and Visitors, including any working with an outside collaborator, must not breach this confidence.

If an inventor(s) intends to publish the results of his/her research activity before an appropriate patent application is lodged, the inventor(s) must obtain the written approval of the CEO, by notifying the IPC. The IPC will consider the circumstances of the request, including whether students are involved, and make a recommendation to the CEO to approve or disapprove the publication of commercially sensitive material. The CEO will not unreasonably withhold or delay a decision.

No Staff or Visitor may lodge a patent application for an invention to which this policy applies without the written approval of the CEO, by notifying the IPC. The PC will make a recommendation to the CEO to approve or disapprove the patent application, after considering all options.

The CEO, with the advice of the IPC, has the delegated power to make a decision to lodge a patent application for an invention to which this policy applies. For urgent matters, the CEO will confer with the chair of the IPC and make the decision whether or not to lodge a patent application.

Where the CEO decides to lodge a patent application in the name of St Vincent's Hospital Sydney Limited, the costs of lodging and prosecuting the patent application will be borne by SVHNS.

Where the CEO decides not to lodge a patent application and gives permission for the inventor(s) to lodge the patent application:

- (a) SVHNS will assign the relevant intellectual property rights to the inventors(s);
- (b) the inventor(s) will bear the costs of lodging and prosecuting the patent application;
- (c) work on the invention will no longer form part of the inventor(s) work for SVHNS; and
- (d) profit sharing as described under the heading 'Sharing rewards from Health Research' applies.

Where the CEO decides not to lodge a patent application and gives permission for a person or persons other than the inventor(s) to lodge the patent application:

- (a) SVHNS will assign the relevant intellectual property rights accordingly;
- (b) the assignees will bear the costs of lodging and prosecuting the patent application;
- (c) work on the invention will no longer form part of SVHNS's work; and
- (d) profit sharing will occur as set out in the agreement between SVHNS and the persons or as described under the heading 'Sharing rewards from Health Research'.

After advice from the IPC, the CEO may decide, and may obtain approval in accordance with delegations, that SVHNS will disclaim all rights in an invention owned by SVHNS. If that decision is made, SVHNS will, and may obtain approval in accordance with delegations, assign all its rights in that invention to an appropriate person or persons.

Sharing rewards from Health Research

SVHNS recognises the need for specific agreements in specific cases. However, as a starting point, SVHNS will apply the following principles to intellectual property rights in Health Research owned by SVHNS that are the subject of a referral to the IPC. SVHNS will deduct all development, patenting and commercialisation costs, and calculate profit. Since these expenses are expected to be at least 10%, SVHNS will retain at least 10% to fund ongoing management of business and legal aspects of any commercialisation project. Any profit will be shared as follows:

- (a) One third will be allocated to the inventor(s). If there is more than one inventor, that one third will be allocated in proportion to their relative contributions to the creation of the intellectual property rights.
- (b) One third will be allocated to the department in which the inventor(s) works.
- (c) One third will be allocated to SVHNS.

Payment to the inventor(s) will continue after their employment with SVHNS ceases, and will also continue to their estates after their deaths.

SVHNS recognises that in specific cases it would be appropriate to share benefits with the contributors of funding, noting that:

- (a) intellectual property rights are not usually granted to such contributors of funding;
- (b) benefits can be shared, for example, giving contributors a first right of refusal to negotiate in relation to the commercialisation of intellectual property rights; and

(c) sharing in commercialisation will have regard to the contribution made to the total inputs of creating the intellectual property.

Mission and Strategic Fit:

SVHNS is a mission based organisation. SVHNS ensures that processes are provided in accordance with the Mission and Values of St Vincent's Health Australia (SVHA) as well as the frameworks of the Mary Aikenhead Ministries, Catholic teachings, the Code of Ethical Standards for Catholic Health and Aged Care Services in Australia and the NSW Ministry of Health.

Definitions:

Appendices:

Standard:

Compliance:

The IPC oversees the implementation of this policy, in accordance with the IPC Terms of Reference.

SVHNS Research Office provides:

- (a) advice/information to Staff, and where appropriate Visitors, on intellectual property right issues in consultation with the chair of the IPC;
- (b) assistance to Staff in preparing submissions to the IPC;
- (c) a secretariat for the IPC, and administers this policy day to day;
- (d) a regular report to the IPC of activities under this policy; and
- (e) records management of all patent applications lodged by SVHNS through St Vincent's Hospital Sydney Limited.

SVHNS may request additional support services from the SVHNS Research Office, and the SVHNS Research Office may supply them if appropriate financial arrangements are agreed before the services start.

If the inventor(s) in a particular case do not agree their relative share of rewards in accordance with this policy and the IPC is requested to advise the CEO, the CEO's decision on relative shares is final and binding.

Dealing with disputes about the policy

If Staff or a Visitor disputes any request or recommendation of the IPC in relation to this policy (Dispute), he or she must notify the CEO in writing.

Promptly after receipt of such a notice the CEO will appoint an appropriately experienced person, independent of the Dispute, to review the Dispute and make a recommendation to the CEO.

The CEO will consider the Dispute and make a decision binding on all affected Staff and the Visitor.

References:

Supporting Evidence:

National Standards:

Related SVH, SVHNS & SVHA Policies & Procedures:

Related Documentation:

NSW Health 'Intellectual Property arising from Health Research' PD/2005_370

Related risk register identification/incident number:

Linked P&P(s):

Revision History:

Dated Issued:	27/07/2016
Date of Last Review:	28/11/2016
Date of Next Review:	31/07/2019
Committees:	SVHN Executive Management Committee
Approved By:	Chief Executive
Responsible:	Executive Office
New Identifier:	D/2017/97499
Old Identifier:	10495