IP Toolkit – ANSTO Submission

27 February 2015

Thank you for the opportunity to provide comments to the draft IP Toolkit. ANSTO’s comments are contained below, as well as in the suggested changes to Parts 1 and 2 of the Toolkit which are attached to this submission.

1. Useful guidance and tools to simplify and improve discussions on IP in research collaborations

(a) Most useful parts

- **IP education** - The information on what IP is and how it can be used is easy to understand. It forms a good starting point for SMEs and researchers who may not have a lot of experience in this area.

- **Agreement template** - ANSTO supports the inclusion of a template agreement which can be adapted for use and therefore lower legal costs. This can sometimes be a barrier to entry and also delay negotiations.

- **Checklist** - The checklist is also a useful document to aid discussions of parties who may not have experience in collaboration, and the types of issues which need to be considered.

- **Case studies** – great use of real life examples to show how successful collaborations can work and produce good outcomes.

(b) Least useful parts

- **Term Sheet** – while the term sheet is very thorough, it may be too laborious for collaborators to work through. It also replicates much of the information to be populated in the Agreement Details. Perhaps they could be merged so that only one document is required. In ANSTO’s experience, term sheets for research collaborations are rarely used on their own. Instead, the parties have initial discussions (much like the ideas presented in the Checklist) and then agree on specifics when preparing the contract. While the term sheet is a good preparation tool for the parties to consider their collaboration in more detail, it may duplicate areas already covered by the Checklist and the Agreement Details.

- **Liability & warranty focus** – it is not very common for the parties to address liability and warranties in collaborations, and indemnities are often not included at all. Given the exploratory nature of the collaboration, it becomes difficult to envisage what loss the parties are expected to cover each other for. Contract provisions for confidentiality and IP should adequately cover any breaches and provide appropriate remedies. Including indemnities in the template makes it too legalistic, and parties may get lost in the legal detail rather than concentrate on the substance of the project. If they are to remain, ANSTO would suggest that the warranties and
indemnities sections be merged and limited only to IP infringement i.e. that IP being provided for the project, and IP being created out of the project, will not, so far as the party is aware, infringe a third party’s rights.

2. Gaps in information
The Toolkit may benefit from including more information on:

- **Know-how** – In many cases, the IP to be protected will not meet the requirements for novelty of a patented invention nor design. Often the most valuable IP created from a project will be know-how. This may be particularly true of engineering and scientific industries. There may currently be too much focus on registrable and legislative IP whereas, in many cases, registration of IP will not be in the interests of the SME. It may therefore be useful to include a discussion on know-how and its protection.

- **Legal form should be driven by commercial objectives, not the reverse** - Models for commercial outcomes should be included. It should contain commentary regarding options for the preferred manner of sharing revenue; obtaining commercial or other reward for the respective partners should drive legal form, not the reverse. There could also be additional examples about different models for sharing revenue (e.g. milestone payments, royalty structuring) based on the respective objectives of both parties. Also, models for risk-sharing between the partners to achieve their respective objectives may be included.

- **Provide structuring IP options** - IP structuring models could greatly help SMEs in addition to education about what IP comprises. For example, provision of licenses within a field as a way around broad exclusive licences, and providing the research organisation with ongoing licences. For organisations that may not be specialised in IP, a recommendation should be included that joint ownership may not be a best practice IP structure.

- **Students** - the use of students should be addressed, as these arrangements are often subject to their own agreements to ensure IP, confidentiality and publication obligations are addressed adequately with the student. Such arrangements often give the SME comfort that their commercial information is being taken seriously by the research organisation and will be adequately protected. ANSTO can provide a sample of its Student Agreement template.

- **Publication** – publication versus protection is often a fine line in research collaboration. More discussion on these tensions, and how they may be resolved, would be useful. For example, discussion on sample procedures for getting publication consent, whose consent may be required and when, the conditions for refusing consent and for how long, may all be included.

- **Project management options** – more discussion around how projects can be best managed and kept on track may be useful - for example, considerations on how IP is
noted and recorded, how results are communicated / shared and how IP decisions (including delay of publication) are made. Many collaborative projects benefit from having a management committee which contains personnel from each of the parties. Having such semi-formal mechanisms to address any issues and to make decisions adds structure to the project and allows the relationship to be built.

- **Value of contributions** – to truly reflect the collaborative nature of the arrangement, it may be good to provide some guidance on valuing in-kind (non-cash) contributions, which can often be made by both parties, though most likely to be provided by the research institution. Things like access to specialist equipment for analysis, laboratory space availability and staff time can all be valued but may not be otherwise captured. By focusing only on the cash contributed, the collaboration may risk being turned into a contract for services rather than a collaborative venture where each party is bring something valuable to the project.

3. **Improvements**

(a) **Checklist** – the checklist is a useful tool to start discussions. However there is some repetition in areas such as project structuring, milestones and deliverables. One way to simplify this would be to break the checklist up into smaller sections with easier-to-use headings. Sample headings may be “Before you begin”, “Initial Discussions”, “What is your project?”, “Undertaking your project”, “Managing Your Project Results & Outcomes” and “Finishing up”. If possible, it may also be useful to turn the Checklist into a living document/form where parties can populate the fields and have the form ready to print.

(b) **Chart of IP considerations** – this is a great tool visually; perhaps more consideration may be given to where it sits in the project preparation framework and when it should be used.

(c) **Case studies** – as the case studies are such a great way to showcase IP and collaboration, ANSTO suggests including more examples. The case studies may also benefit by reworking the end parts into “Tips” and “Traps” sections i.e. a ‘lessons learnt’. An identification of what was Background IP and Project IP in each case study may also help parties understand how IP works in practice.

(d) **Attachment 1** – would suggest that ‘What is IP’ and the related commentary in the Toolkit and Attachment 1 be merged so the information is all in the same place, allowing for ease of use.

(e) **Sample Agreement** – the agreement is currently very long and detailed, which may present a barrier to its uptake. The number of variables within it also presents the risk that if incorrectly completed, this could undermine the purposes of the option picked in another variable. Rather than trying to address every possible scenario, it may be best for the template to target the most common forms of collaboration. For example, there should be an option to separate R&D from commercialisation agreements, as it may be very difficult
to agree beforehand on such details before the value of the IP to be created is known. ANSTO’s suggestions have been included as a marked up document.

4. Other comments

ANSTO supports the IP Toolkit initiative. It is a great starting point for parties wishing to collaborate.
Responding on the draft IP Toolkit

The Department of Industry and Science and IP Australia invite interested parties to make written submissions on the draft version of the IP Toolkit by close of business on 20 February 2015. In particular, responses are sought to the questions posed below. Comments are welcome from any interested party.

1. Does the draft IP Toolkit offer useful guidance and tools to simplify and improve discussions on IP in research collaborations?
   a. What is the most useful part and why?
   b. What is the least useful part and why?

2. Are there any gaps in the information provided?

3. How could the draft IP Toolkit be improved for the target audiences of SMEs and researchers?

4. Any other comments or suggestions for improvement?

Note: This consultation draft includes a two party model contract only. A multi-party model contract structure will be developed using feedback. Another case study is also planned for the IP Toolkit.

The Department of Industry and Science and IP Australia will consider the submissions, and undertake further consultation as necessary.

Submissions should be sent to IPToolkit@industry.gov.au.

Please note that, unless specifically requested otherwise, submissions to the Department of Industry and Science and IP Australia will be made publicly available on the Department of Industry and Science website.

A request made under the Freedom of Information Act 1982 for access to a submission marked confidential will be determined in accordance with that Act.

This paper is also available at: http://www.industry.gov.au/IPToolkit.

Both the Department’s Privacy Policy and IP Australia’s Privacy Policy explain more fully our purposes for collection of, and how we handle personal information; how you may access and seek correction of your personal information; and how we receive and handle privacy-related complaints.
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A complete and current version of the draft IP Toolkit and model Agreement is available at www.industry.gov.au/IPToolkit.


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The IP Toolkit is only intended as a guide and is not legal advice: you should seek your own legal advice as required. Rather the IP Toolkit is a starting point to assist businesses, researchers and research organisations in their collaboration activities.

There is no one-size-fits-all solution to IP in collaboration. All collaborations are different. However, a framework for a standardised approach can simplify research collaborations by reducing costs and improving outcomes.

In general, the Toolkit does not address in detail the subsequent use of the output of collaboration.
Introduction

Structure of the IP Toolkit

1. The IP Toolkit consists of two parts:

   A. Tools
      - A1 Checklist – considerations to assist collaboration decisions
      - A2 Chart – IP considerations in research collaboration projects
      - A3 Sample term sheet – including for use in negotiations
      - A4 Model Contracts – for use as a starting point

   B. Information and context
      - B1 Collaboration tips and case studies
      - B2 IP-related issues in contracts

   The IP Toolkit also includes attachments containing more detailed information on intellectual property (IP) and useful resources for further information.

Who is it for?

2. The IP Toolkit is designed for business (in particular SMEs) and publicly-funded research organisations intending to undertake collaborative activities.

Why has the IP Toolkit been developed?

3. The Toolkit has been developed to provide a standard form of contract that, if widely adopted, will reduce costs and improve the outcome of research collaborations.

4. It does this by offering guidance and provides the tools necessary to simplify and improve discussions around IP in research collaborations. The Toolkit provides information and resources to help establish the terms for managing and using IP in collaborative activities.

5. It also aims to reduce unnecessary delays, costs and difficulties with research collaboration.

Collaboration

6. For the purposes of the IP Toolkit, collaboration is defined as the action of working with someone or an organisation to develop something.¹ Collaborations can involve many parties that usually work together on a project.

Research

7. For the purposes of the IP Toolkit, research is defined as experimental and/or theoretical work to acquire new knowledge, achieve an outlined objective,

address a constraint or problem or substantially improve, or produce new products, systems or services.2

8. The outcomes of research are never guaranteed and, despite the best efforts of all involved, the research purpose(s) may not be achieved.

What is IP?

9. IP rights – short for ‘intellectual property’ rights – refer to specific rights arising from law. This law mainly aims to provide specific protection for the results of creative and innovative endeavours.3 Examples of IP rights include copyright, patents, trade marks, designs, plant breeder’s rights and circuit layouts.4

10. There are two types of IP rights, registered or unregistered. Registered IP rights (patents, trade marks, designs and plant breeder’s rights) must meet certain requirements. Other IP rights (like copyright) are automatically assigned to you provided they meet legislative requirements and do not need registration (e.g. there is no register for copyright and circuit layout rights in Australia).

11. The difference is that registered IP rights can only be fully used after the owner has been granted a legal title after a registration procedure, whereas unregistered IP rights provide protection automatically and can be used immediately. ‘Consequently, choosing an IP protection right includes considering the benefits and disadvantages of choosing registered or unregistered rights5.’

12. IP rights often support investment and business and research collaboration. They can also greatly influence commercial and academic outcomes from collaboration (such as through rights to make, copy, exploit or publish material).

13. There are limitations to IP rights, such as other parties being able to use them under certain circumstances.

14. Each type of IP has different legal rights and exceptions. Moral rights are different to other IP rights in that they are personal rights of the author of copyright material. Further background on IP is at Attachment 1 – Intellectual Property.

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3 However, trade marks typically relate to business, product or service reputation and are not necessarily innovative.

4 IP law is dominated by Commonwealth Legislation, but caselaw can also be relevant such as the tort of passing off for business reputation.

**What’s the role of IP in collaboration?**

15. For the majority of businesses to remain competitive, the development of, access to, and treatment of, valuable information (including IP) is becoming increasingly important.\(^6\)

16. For example, there are lots of businesses that make pizza. The pizza business with the best processes and software for managing orders and delivery may utilise these to obtain a competitive advantage, potentially attracting more customers and therefore making more money than other pizza businesses.

17. It’s this valuable information (e.g. software, product or service specifications and/or branding) that is becoming more important than traditional infrastructure (e.g. pizza ovens) in providing a competitive advantage.

18. The software and branding that you use in your business can be protected as IP.

19. Collaboration can result in the creation of IP in information, documents, products, services, processes, software and other material as this IP is a result of the project (as opposed to being in existence before the project commenced) and is often referred to as (i.e. ‘project IP’\(^7\)). Parties also bring IP inputs to collaborations (e.g. ‘background IP’\(^8\)).

20. Collaborations can involve complexity in managing the interrelationships between confidentiality, publication of information, commercialisation and IP decision-making. It is important for parties entering collaborative arrangements to have regard to the IP outputs and set out the terms of any agreement in writing.

21. Collaboration agreements usually set out the terms and conditions that determine who how the IP will benefit from any IP outputs from a collaborative project can be used. These arrangements can determine what can be sold, published, used or improved upon and how this can be done. It is important for parties entering collaborative arrangements to have regard to the IP outputs and set out the terms of any agreement in writing.

22. The IP position may affect the extent to which a business can use the collaboration output in their business.

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\(^7\) For more information on project IP, see paragraph 18. Incorrect paragraph reference, please update.

\(^8\) For more information on background IP, see paragraph 15.
23. Likewise, for researchers, IP arrangements in collaborations may affect their ability to meet their objectives of advancing and disseminating knowledge⁹. A way to deal with such complexity in collaboration outputs is to:
   - use the general approaches set out in this guide as a starting point (e.g. who can use or sell a product); and
   - obtain specialist assistance when needed.

Ways to manage valuable collaboration inputs and outputs

24. There are different ways of managing valuable collaboration inputs and outputs. Two possible ways include:
   - using processes to manage IP rights; and/or
   - using processes to manage confidential information (including know-how and trade secrets).

25. Often both methods are used. For example, collaboration outputs may be agreed to be protected by patents. In addition, collaborators may use secure processes to limit access to, and publication of, valuable material. This can include using mandatory data access restrictions, confidentiality agreements and visitor policies.

Overall approach

26. The overall approach of the IP Toolkit is to provide a framework to assist the collaborators in agreeing coming to an agreement on the IP that parties are bringing to the collaboration as inputs and what can be done will happen with the finished product or outcome of the collaboration.

27. This ‘IP position’ in a collaboration should be guided by the project goals of those involved. This should be agreed by all collaborators before a contract is entered into, to increase the chances of a successful collaboration.

28. For instance, if the main goal of collaboration is to commercialise material and this does not happen (say within three years of the collaboration), a common IP position is that the IP arrangement allows those who want to commercialise the output to try other avenues outside the collaboration after a set period.

29. The IP position is important as it can protect much of the input and output material in collaboration.

30. A carefully defined process is likely to help decision-making and can assist in successful collaborations and maximising the value of the outcome(s). But keep

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⁹ For ease of reading, a reference to researcher in the IP Toolkit is taken to include research organisations where applicable throughout.
in mind that a simple collaboration may only require a simple IP position e.g. publication provisions.

31. There is no one-size-fits-all solution to IP in collaboration. All collaborations are different. However, a framework for a standardised approach can simplify research collaborations by reducing costs and improving outcomes.

32. The IP Toolkit is only intended as a guide and is not legal advice: you should seek your own legal advice as required. Rather the IP Toolkit is a starting point to assist businesses, researchers and research organisations in their collaboration activities. In general, it does not address in detail the subsequent use of the output of collaboration.

33. The IP position is important as it can protect much of the input and output material in collaboration.
A. Tools

A1. Decision assistance checklist – Have you considered:

The following questions draw on the material from the Toolkit. They are intended to prompt potential collaborators to consider important issues in designing and structuring the collaboration project design.

Project purpose and Scope

1. Is the collaborative project mainly to solve an industry constraint or problem, to commercialise or improve existing material, develop knowledge in an area or develop new material for commercialisation?

2. Which party is driving the project and who should be the project parties?

3. What are the project aim, scope and budget?

4. What is the key reason for each party’s decision-maker to agree to participate?

5. Who controls the project? Will it be controlled via a joint committee?

6. What are key project deliverables (distinguished from other investigator research)? What are the milestones? What should be the consequence of a milestone being met or not?

7. If there are any dates for project deliverables important to a party, what are they?

8. Are there key research outcomes or publications important to a party? If so, what are they?

8. Will the project results be able to be published or will parts need to be kept confidential, and if so, for how long?

9. How should project deliverables be reflected in milestones?

10. What should be the consequence of a milestone being met or not?

11. What is a minor variation period for all or specific milestones that is agreeable to each party?

12. How is a milestone demonstrated to be met to the satisfaction of all parties?

13. When should the project start and finish, being mindful of realistic timeframes?

14. What is the agreed approach for collaboration (e.g. good faith, level of researcher documenting requirements)?

15. Is the appropriate starting point that the sponsor will meet the full cost of the project?

16. What are the key risks of the project, who is best placed to manage them and what issues will require expert advice?

17. What, if any, promises should be made and liability taken on by parties?
Project inputs

18.16. Who are the key project personnel who are key to contributing to the successful delivery of the project?

19.17. Which party contributes what, including money, staff time, staff funding, access to equipment and facilities? How will non-cash (in-kind) contributions be valued?

20.18. What background information and IP is needed for the collaborative project from each party? How will this need to be handled by the other party e.g., confidentiality?

21.19. Do the parties own the IP inputs needed for collaboration (e.g. researchers may own some IP and employment and third party agreements may be relevant) and are there any preconditions (such as approvals) for collaboration?

22.20. What is specified as confidential information from each party is confidential i.e. not publically available or widely known, and what should other collaborating parties do in relation to this information?

Project activity

23.21. How is the project to be managed (e.g. through a project plan, management committee, measures to ensure quality of project IP and other research results, conflict of interest and privacy requirements)?

24.22. How will the parties be able to monitor the project (e.g. regular meetings, updated project plans and/or reports) and how often should this occur?

25.23. Who should be able to participate in the project or have access to project material and facilities (e.g. students and IT access restrictions)?

26.24. How is project IP identified and recorded, and by whom and how often?

27.25. Does one or more parties decide to register, maintain and defend IP, on what basis, and which party or parties pays for these activities?

28.26. How do parties notify, resolve and deal with changes to the project and disputes quickly?

29.27. How can a collaboration be terminated and when? For example, non-achievement of key milestones. What happens on termination? How will the project be wrapped-up?

Project outputs

30.28. What does each party want to reasonably do with the project outputs and IP in domestic and international markets?

31.29. What should each party be able to do other than to use project inputs and outputs solely to fulfil the project, (e.g. publication and naming authors, further research, improvements and teaching)?

32.30. Who should own what outputs (including IP and other research results) or is another option such as a licence suitable?

33.31. How will these outputs/outcomes be managed and who is responsible for associated costs?
Post project needs and obligations

34.32. What will each party need after project completion (e.g. confidentiality obligations, reasonable requests for data, further research, teaching, and the ability to provide improvements)?
A2. Chart of IP considerations in research collaboration projects

1. PROJECT SCOPING (e.g. aim)

- Is the collaboration to develop new or improved material for the:
  - sponsor; or
  - research organisation?

- Is the collaboration to commercialise existing material for the:
  - sponsor; or
  - research organisation?

- Is the collaboration to:
  - remove a conflict or solve a problem; or
  - develop knowledge to publish or for research?

- Who will control the collaboration and what is the scale of the project budget?

- What are the key roles of the project and who will manage them?

2. INPUTS (e.g. resources & background IP)

- Was the creation of the background IP or securing ownership of it very resource intensive for the:
  - sponsor; or
  - research organisation?

- What kind of inputs is each party providing including:
  - monetary and in-kind resources (e.g. staff and facilities);
  - background IP, and equipment?

- Which party is accepting more risk and obligation (e.g. providing key confidential information)?

- Is the collaboration crucial for the party (e.g. impact of a milestone not being met on time, PhD awards relying on project)?

3. OUTPUTS (e.g. software, publications and patents)

- Identify the most important outcomes for the entire project and how they are reflected in milestones.

- Define the project milestones and performance and delivery criteria for payment.

- Decide what each party might reasonably want to do with the output.

- Determine the key project dates and deliverables.

4. CONSIDER CONTRACT ARRANGEMENTS THAT:

- Align IP ownership with the party best able to licence.

- Include more restrictions on publishing if it has a high risk of limiting commercialisation (e.g. mentioning details preventing patenting).

- Assign IP rights needed for commercialisation activity in each country market.

- Identify and manage IP and confidential information with agreed processes.

- Clarify collaboration project management, reporting, recording and deliverable requirements.

5. FORM OF CONTRACT

- Consider running the model two party model contract mirrors the collaboration:
  - less more than two parties;
  - has lots of IP that will change hands;
  - is dependent on internal funding or approvals; or
  - is for output mainly outside Australia in such cases considering the complex model contract.
A3. Sample Term sheet for the two party model contract

This sample term sheet is designed to be used in negotiations in the following order: initial agreement on the scope and purpose of 1) define the project, 2) engage appropriately with internal policies, processes and approval mechanisms, 3) and use it in negotiations, and 4) once it captures the agreed terms, it can be used as contract drafting instructions.

Parties to collaboration (Who is collaborating)

Research Organisation contracting name ______________ ACN/ABN _______________
- Research organisation representative and contact details (Principal Investigator) ____________
- Research organisation address and contact details for notices: ____________

Sponsor contracting name ____________ ACN/ABN _______________
- Sponsor representative and contact details ____________
- Sponsor address and contact details for notices ____________

Project purpose and scope

Name of the project ____________ Objectives of the project (optional) ____________

Project background (no obligations in this) ____________

Anticipated project outputs or results ____________

Project start date ____________ or project start date on last party signing

Project end date ____________ or date when all parties obligations performed or date to be agreed in writing by parties

Project deliverable(s) to be produced by research organisation (if applicable include who owns deliverable, IP Register and updates, project plans and reports) ____________

Project inputs

Project budget _________ [e.g. salaries, travel, operating, capital] Note this operates as the agreed financing for the project and payments from budget are made under project activity (milestones)

In-kind contribution(s) of the sponsor _________ (list each with due date and agreed value and roles)

In-kind contribution(s) of the research organisation _________ (list each with due date and agreed value and roles)

Key research organisation personnel to be provided ____________ Key sponsor personnel to be provided ____________

Numbers of full and part-time staff to be provided by each party ____________:
- If recruitment of staff is required for above, is approval of the other party required? Y/N

Names of student(s) and/or volunteer(s) participating in the project as research personnel ____________ or none

Project equipment is owned by the (circle): sponsor or research organisation

List of project equipment _________ and conditions for each _________

List of equipment loaned by the research organisation _________ on condition _________[e.g. maintenance and insurance] _________

List of equipment loaned by the sponsor _________ on condition _________[e.g. maintenance and insurance] _________

Any background IP (including third party IP) to be provided by the sponsor and by when

- Sponsor background IP list _________, third party IP _________
- Sponsor confidential information list _________
- Confidentiality of all background IP Yes/No (for period ________) and other materials Yes/No (for period ________)
- Mechanism(s) required by research organisation for protecting background IP and other listed materials _________
• Any grant relating to background IP or Third Party IP other than for use in the collaboration
• Any condition of use of background IP and Third Party IP to other party for internal purposes
• Any condition of use of background IP and Third Party IP to other party for other purposes

Any background IP (including third party IP) to be provided by the research organisation and by when
• Research organisation background IP list
• Third party IP
• Confidentiality of all background IP Yes/No and listed other materials Yes/No for period
• Mechanism(s) required by sponsor for protecting background IP and other listed materials
• Any grant relating to background IP or Third Party IP other than for use in the collaboration
• Any condition of use of background IP and Third Party IP to other party for internal purposes
• Any condition of use of background IP and Third Party IP to other party for other purposes

Project Manager responsibilities

Reporting content required by the principal investigator to every

Liability - indemnities, warranties and insurance to apply (circle below):
A - general legal principles to apply
B - each party indemnify the other or
C - research organisation to indemnify Sponsor and Sponsor’s personnel
D - any other warranties or indemnities to apply

• any liability cap
• any insurance arrangements, Sponsor Research organisation

Project activity

Reports from the research organisation will concern [e.g. updated project plan] and are due [e.g. monthly] to [e.g. email address]_

Location of project activity and governing jurisdiction of the agreement if different

Project schedule of work including tasks to be performed by each party, methodology, task location and task due date

IP register required Y/N

Project deliverables by research organisation (include who owns deliverable and IP register if applicable, project plans and reports and due dates)

Payment schedule for milestones (include due dates and criteria for meeting each milestone) (e.g. prototype complete and functioning as specified)

Obligations for record keeping and data management

Note that a party must notify the other party of a dispute

If parties cannot agree on an issue of a notified dispute within 20 business days then parties (circle one):
A - may refer the dispute for alternate dispute resolution
B - must appoint mediator and participate in mediation
C - must refer dispute for expert determination (parties must agree to be bound by the outcome) or
D - must refer dispute for arbitration (parties must agree to be bound by the outcome)

Project outputs

The ownership, use or exploitation of the project IP:

by the sponsor specified in the schedule is:
• This is to enable the sponsor to:

by the research organisation specified in the schedule is:
This is to enable the research organisation to:

Note that unless agreed otherwise the owning party of the project IP owns it on creation. They may choose whether to pursue registration or other protection in their name at their own expense but must first consult with the other party.

All non-specified project IP [and other research results] is to be owned on creation by (circle one):

A – the sponsor
B – the research organisation or
C – both parties jointly as tenants in common in the following proportions (e.g. 50% each) – if chosen see clause 9

Registration and payment for project IP (circle one):

A - the owning party decides whether to apply for registered IP at their own expense after consulting other party(s)
B - other mechanism to decide whether to apply for registered IP and all IP payments from collaboration output which is:________

The research organisation or its personnel may publish the following collaboration material:______________

• Conditions that must be met for publication of the above material:______________

Project IP commercialisation rights, conditions and period:

A – only the owning party can commercialise project IP
B – the owning party has the first right to commercialise project IP within ___ years from the end of the term then the other party may request a license on reasonable terms
C – (generally only for joint IP) Either party may commercialise the IP as agreed: __(e.g. 50% each of net income after costs)__
D – (risks no agreement) a party can only commercialise as agreed (e.g. using agreed commercialisation strategy) in writing

Conditions of above are: (e.g. notify other party, prior written consent, as agreed, for fee or fee on reasonable commercial terms) _________________________

Publication of the following material is permitted by the research organisation: e.g.

A – list particular outcomes or deliverables
B – all project outcomes and deliverables
C – all material comprising project IP owned by the research organisation

Subject to the following conditions: e.g.

A – nil
B – in a particular journal
C – with prior written consent of the sponsor on a case-by-case basis
D – only after the application for registration of the project IP
E – only after set a period (say 3 years) after the project term

Other

Special conditions: __________________________________ or other project details________________

Research organisation moral rights obligations required Y/N if so the conditions are__________________________

If the granting party decides on a reasonable basis that their ___[specified]_____ IP has not been used to achieve the following objectives _______ within ___[e.g. # of years] then __________________________

Sponsor publication restrictions_____________________

Conditions concerning background material that is not IP or confidential material______________

Post project needs and obligations

What activities/obligations are to continue after the collaboration (e.g. confidentiality obligations, reasonable requests for data, further research, ability to provide improvements, ability to use the research for teaching)?
A4. Model contracts

- Contract 1 – Two-party model contract attached separately (with user notes detailing options).
- Contract 2 – Multi-party model contract structure – with key items left for negotiation – is to be developed based on feedback on the two-party model contract.
B. Information and context

B1. Collaboration tips and case studies

Purpose

1. This section provides an overview of key collaboration concepts for businesses and researchers to consider before entering into a collaboration.

Key ideas for collaboration

2. Collaboration can involve activities such as cross-training and exchange of staff, inter-organisational working groups, common financial arrangements (e.g. cost-sharing of services), the sharing of administrative and research data, and joint project management.

3. A successful, long-term collaboration will usually start out as one or more short-term engagements. Through the experience gained in these engagements, parties are then able to develop the following typical features of a longer-term collaboration:

- a shared vision and commitment to common goals;
- deep organisational connections involving regular communication between the people involved at multiple levels, and the sharing of information in a strategic (as opposed to an ad hoc) way;
- pooled and/or collective resources or other material in order to show commitment to the collaboration and achieve the shared goals; and
- mutual trust.¹⁰


CASE STUDY: Laserlife Littlejohn

Laserlife Littlejohn is a small manufacturing company that has been producing rubber and anilox rollers for the printing and packaging industry for over 40 years. It employs around 30 people.

In 2010, Laserlife Littlejohn partnered with CSIRO. Together, they collaborated to research and develop a new way to manufacture an anilox roller utilising both new materials and technologies. The project was undertaken as part of the Victorian Direct Manufacturing Centre consortium. Managing Director of Laserlife Littlejohn, Alex Engel, says that whilst the company had ideas on how to improve the technology they were unsure how to realise them.

In return for a financial injection to the collaboration, Laserlife Littlejohn was provided with access to scientists, researchers, facilities and equipment. The parties worked together to research the new anilox roller, technology that allowed Laserlife Littlejohn to grow as a company by offering more services to more people, both domestically and overseas. Additionally, a long standing relationship between Laserlife Littlejohn and the research organisation CSIRO was established. This has permitted further collaborations between the parties to improve and develop technology.

Obtaining a patent was chosen as the means to protect the IP developed in the collaboration. The parties considered that the technology could easily be reverse-engineered and therefore keeping the IP in commercial confidence would not prevent third parties replicating the product without authorisation.

The patent was registered and owned by CSIRO and a licence granted to Laserlife Littlejohn. Mr Engel stated that whilst the company does not own the IP from the project, the outcome was beneficial given the IP ownership responsibilities fell to CSIRO, with financial contributions provided by Laserlife Littlejohn. CSIRO’s reputation and the resources they have to prosecute and defend the patent mean they are in a better position to undertake these tasks.

Mr Engel attributes much of the success of the collaboration to planning. He stresses the importance of making sure the scope of the collaboration is clear at the outset. Forward planning, such as allocation of costs and strict budgeting documented in a written agreement, helped minimise potential disputes arising later in the project. He also emphasises the importance of understanding risks and that not all research results in a profitable or successful outcome. The involvement of Laserlife Littlejohn as not only a financial contributor but in a more hands on manner in the collaboration proved beneficial in producing successful outcomes and maintaining the relationships with the organisation.
A useful way to think of a collaborative project

4. In order to assist in managing a collaboration, it can be useful to think of a collaboration project as having five parts:

1. **purpose and scope** – what is the aim and intended outcome of collaboration?

2. **inputs** – e.g. what expertise, confidential information, background IP, resources and equipment/facilities does each party bring to the collaboration?

3. **activity** – how is the collaboration to be managed and each stage assessed by the parties?

4. **outputs** – what is the result of the project?

5. **post-project needs and obligations** – e.g. what are the continuing confidentiality obligations, licensing arrangements and ongoing IP protection responsibilities?

5. It is important to undertake collaboration with an understanding of what each party might reasonably want to do with the output(s) of the collaboration. Often the more IP is involved in the collaboration, the more complex the issues.

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CASE STUDY: Riancorp Pty Ltd

Ann Angel is the CEO of Riancorp Pty Ltd, a small company that manufactures laser devices for the treatment of post-mastectomy lymphedema. This is a potentially debilitating condition that can affect patients following breast cancer surgery, causing massive swelling and discomfort due to the retention of lymphatic fluid.

Ann’s company collaborated with researchers at Flinders University in Adelaide to carry out clinical trials to establish the safety and efficacy of their device. These clinical trials are necessary to obtain the regulatory approvals needed to market a medical device.

Riancorp retained full ownership of the patent covering the device and of the subsequent patents that have come from its collaboration with the university. Riancorp received a Commonwealth Government grant and it used this to fund the clinical trials, which were carried out by a graduate student at the university.

The benefits of the collaboration went both ways – Riancorp received high quality research to enable it to gain regulatory approval in many countries, while the university further developed its expertise in this area and gained recognition. The graduate student who conducted the trials won a prize for the research and presented the findings at a conference in Italy.

Ann’s relationship with the university has been an ongoing and mutually beneficial one. They continue to share knowledge to maintain their expertise in this field.

Industry collaboration is becoming increasingly important for universities and is commonly one of the performance criteria for promotion of academic staff. Ann has been able to provide letters of support for the academic staff she has collaborated with, which has assisted them in gaining promotions.

Riancorp exports its medical device all over the world. The Professor who led the research attended her meetings with the US Federal Drug Administration to support the application for regulatory approval in that country and has also presented the research results in Japan, Korea and New Zealand.

Ann’s advice to potential collaborators is to ensure that you focus on developing a good relationship first, then work through the legal matters that need to be handled. A good relationship with the researchers who will carry out the work can be instrumental in getting the project smoothly through the contract development stage.
**Start with the goals in mind**

6. Copyright, and patents and know-how are the most common forms of IP used and created in industry and research collaboration projects.

7. Any output from the project (e.g. products, services or documents) may have a potential value that a project party may wish to use or exploit. Unnecessary problems can arise, especially in relation to IP rights, if issues are not dealt with initially. For example, a non-disclosure agreement should be considered for initial discussions.

8. The IP position in each collaboration should follow from the parties collaboration project goals and be agreed before a contract is in place. This is important as otherwise the project may not be able to achieve its goals and can lead to disagreements about IP ownership rather than achieving project goals.

9. Some examples of IP approaches that may need to be considered are:
   - whether software, writing or images setting out details of a new product or service can be distributed shown (and if so, who by);
   - which project details results can be used in an article by a researcher;
   - the extent of a party’s ability to commercialise and/or benefit from an invention, such as a new component used in a product or service; and
   - which party owns and benefits from project improvements to an existing invention (whether patented or not).

10. By discussing and understanding how these and other inputs and outputs (e.g. third party IP and confidential material) could be used by all parties at the start, and agreeing on how to handle them, the IP approach can be settled.

**If possible, start small.**

11. If little is risked in testing the waters, potential collaborating parties can be more likely to interact at an early stage. They may also have a better understanding of the value of a particular collaboration. Taking a small step to explore the potential for collaboration can be useful in building trust for a successful collaboration. For example, a meeting with potential collaborators focussing on an industry constraint or problem. For example, a non-disclosure agreement should be considered for initial discussions.

**Different drivers for collaboration**

12. It is also important to consider the reasons why participants are collaborating, as in many cases people and organisations have different reasons for being involved.

13. Understanding these drivers means you can identify key issues that need to be agreed before commencing the collaboration.
13.14. It is important to note that for example, many publicly funded research organisations have distinct objectives and these will also influence the objectives of the project. For example, the Commonwealth Scientific and Industrial Research Organisation (CSIRO) has as an objective of carrying out scientific research for the purpose of ‘assisting Australian industry’\(^\text{11}\). These drivers will influence their perspective and so may not reflect the research drivers above.

14.15. The table below outlines general drivers for research and business.

### Table 1 – General drivers for research\(^{12}\)

<table>
<thead>
<tr>
<th>General drivers for research organisations</th>
<th>General drivers for business</th>
</tr>
</thead>
<tbody>
<tr>
<td>Publication and learning opportunities</td>
<td>Competitive advantage, including first to market</td>
</tr>
<tr>
<td>Income stream from licensing</td>
<td>Speed of commercialisation</td>
</tr>
<tr>
<td>Sponsored funding for current and future research</td>
<td>Increasing enterprise value</td>
</tr>
<tr>
<td>Challenging research problems to solve</td>
<td>Access to expert knowledge and highly skilled researchers</td>
</tr>
<tr>
<td>Research work-integrated learning opportunities for post-doctorates and students</td>
<td>Productive use of resources</td>
</tr>
<tr>
<td>Employment opportunities for graduates</td>
<td>Patent rights for market exploitation</td>
</tr>
<tr>
<td>Access to company data for more market-relevant research</td>
<td>Funding access or funding business case</td>
</tr>
<tr>
<td>Commercialisation expertise in research (e.g. prototyping)</td>
<td>Access to cutting edge equipment and facilities</td>
</tr>
<tr>
<td>Upskill of researchers</td>
<td>Market image and reputation</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>General research organisation focus</th>
<th>General business focus</th>
</tr>
</thead>
<tbody>
<tr>
<td>Advancement of knowledge</td>
<td>Market-driven</td>
</tr>
<tr>
<td>Academic freedom</td>
<td>Return on investment</td>
</tr>
<tr>
<td>Publication of results</td>
<td>Very cost conscious</td>
</tr>
<tr>
<td>Education of students</td>
<td>Profit-based</td>
</tr>
<tr>
<td>Relaxed approach to time frame and milestones</td>
<td>Particularly sensitive to timing and milestones</td>
</tr>
<tr>
<td>Competing demands on research resources</td>
<td>Time and research constraints</td>
</tr>
</tbody>
</table>

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It is important to note that many publicly funded research organisations have distinct objectives and these will also influence the objectives of the project. For example, the Commonwealth Scientific and Industrial Research Organisation (CSIRO) have as an objective of carrying out scientific research for the purpose of "assisting Australian industry." These drivers will influence their perspective and so may not reflect the research drivers above.

B2. IP related issues in contracts

Background IP

16.17. ‘Background IP’ (also called existing IP) is IP arising from work created prior to, or independently of, the collaboration which may be used to assist collaboration work. The definition of background IP may need to be tailored in the agreement to reflect the parties’ agreed meaning.

17.18. It is important to have a clear understanding about whether any background IP will need to be used, and by who, during and after the collaboration. It is also important for parties to try and specify all the background IP for use in the written contract (often there is a list in a schedule or IP register). How parties are able to use background IP should also be specified to minimise any disputes.

18.19. Commonly, a licence to access or use background IP may be required. The scope of the licence will need to be broad enough to enable the collaboration work to be carried out and the outcomes of the collaboration to be used for the intended purpose. For example, if the researchers need to access or use industry background IP to carry out the collaboration work and also need to use collaboration outputs for teaching purposes later, then a licence to use the background IP in these ways should be sought in negotiations.

Approach to project IP (or foreground IP)

19.20. The type of work produced during the collaboration will determine what, if any, IP will be created.

20.21. ‘Project IP’ (sometimes referred to as foreground IP or contract IP) is the new IP created as a result of the collaboration project. The most common types of IP rights developed in such projects are copyright, know-how and patentable material.

21.22. Copyright often applies to a report or an article. However, often more than one type of IP can apply to the same material. For instance, a prototype, set of test results, process enhancement or elements of an invention can to varying extents be covered by copyright and patents.

22.23. Careful consideration should be given to how the parties will need to use output from the collaboration and what type of rights are needed in relation to the IP created under the project (e.g. how the copyright in a research conference presentation is managed in the contract).

23.24. Other considerations include whether IP ownership, licensing or other mechanisms are necessary to allow a research organisation or researcher to
publish, disseminate and use material from the project for research, teaching or contributing improvements after collaboration.

24-25. The involvement of students in the collaboration may also need to be specifically considered. For example, the terms of the contract should not restrict a PhD student from publishing their thesis in accordance with university requirements (though sometimes it may be able to be submitted confidentially).

25-26. An alternative approach to the vesting of ownership of the IP on creation might be to transfer ownership of the IP at a specified time such as when the collaboration is complete. Consideration should also be given to whether the research organisation or researcher needs to retain any rights to the work so they can use it for future research, teaching or work they might undertake.

26-27. It may be that IP ownership is not required (a precondition) to commercialise the material covered by IP protection or other arrangements. A license may be sufficient.

27-28. An option agreement (where a party has an option to purchase IP or buy IP component(s) that allow commercialisation within a time period) means that the business does not have to pay the full cost of commercialisation (they often pay an option fee) until it has assessed the market potential. During the option period, the business may have an exclusive opportunity to understand the technology and its market potential as well as work with the research organisation to create a product.

29. A formal licence agreement can be signed at any time during the option period. Also, option agreements are often time-limited so that if the option is not taken up, it can be exploited by another party in a timely manner.

28-30. Similarly, a right of first refusal may also offer benefit where the IP is still being further developed and an option period may therefore be inappropriate. With this right, the party has the benefit of being the first to be consulted in commercialising the IP, before any other parties are approached.

29-31. In collaborations likely to generate sufficiently valuable IP, e.g. invention(s), an IP register that lists potentially valuable material for IP may be useful. A person could be nominated to update the register regularly (e.g. fortnightly).

Proving the origin of project IP (ensuring the ‘chain of title’)

30-32. Accurate recording of authors and potential inventors of IP (including planned material for patent applications) for the entire period of collaboration can ensure that the source of collaboration outputs can be proven. Often this is managed using a register of authors (including all software developers) and/or potential inventors.
31. Clear evidence of the origin of project IP assists in its commercialisation and in any potential litigation, including patent litigation. In cases of very valuable potential project IP that may arise from a project, researchers’ notebooks may be registered and secured in safes (including nightly deposit of notebooks).

32. Where an patentable invention may result from a collaboration, all publications and communications (including preliminary findings emailed by researchers to others and conference presentations) could be monitored through internal processes to ensure that a potential invention remains patentable and is not prevented by prior-disclosure.

Confidential information (including trade secrets and know-how)

33. Confidential information is generally considered to be information provided by one party to another where the information is:
   - designated as confidential by the Party by or for whom the information is provided;
   - imparted in circumstances of confidence; or
   - such that the recipient of the information knows, or ought to know, is confidential;

   but does not include information which is already known by the receiving party at the time it is disclosed, or which is or becomes public knowledge.

34. For the purposes of the IP Toolkit, trade secrets and know-how are categories of confidential information and can include valuable information such as a product formulation.

35. There are two main circumstances where confidentiality processes or mechanisms are used in a collaboration:
   - to allow the sharing of information; and
   - as a pre-condition to accessing or participating in collaborative research (including access to background IP).

36. Ways to manage confidential information include confidentiality and employment agreements, an assessment of whether the information is required for the research collaboration, security measures for confidential information (e.g. secure cabinets) and participation and access policies (e.g. computer, student and visitor access restrictions). Care should be taken that the designation of information as confidential does not prevent appropriate publication of the project outcomes.

37. As with background IP, it is important for parties to specify what is confidential information in contracts and what other parties have to do in relation to it to avoid later problems.

38. The definition of confidential information may need to be tailored to reflect an agreed meaning.
39. Businesses and researchers typically have different views and interests in relation to disclosing and sharing information. For example, industry often seeks a commercial advantage by restricting third party access to valuable information.

40. It may be in the interests of business collaborators (and be an obligation to shareholders in maximising business value) to allow researchers access to detailed confidential information that gives the business collaborators a competitive advantage (as long as the information remains confidential).

41. On the other hand research organisations and researchers typically wish to publish information about the collaboration. Also research organisations may have legislative obligations to disclose information (e.g. freedom of information in relation to public sector agencies).

42. These different views, interests and obligations can result in collaboration parties having differing approaches to aspects of confidentiality in collaboration projects and associated agreements.

43. It is best to discuss expectations and requirements upfront so that the parties can agree to appropriate time periods of restriction.

Publication

44. Similarly, there can be different party views on publishing.

45. It is worth considering the approach to publication that the UK Government has recommended in its Lambert Toolkit for universities and businesses wishing to undertake collaborative research projects:

“The ‘middle ground’ [on publication] is represented by the academic researchers being able to publish under a protocol that allows the commercial ‘partner’ an element of control over the content of, and the timescale for, publication (e.g. in order to give the sponsor an opportunity to secure patent protection).”

46. Parties most often agree to consult each other prior to publishing and to have input into the publication where it may contain confidential or otherwise commercially valuable information. In such instances, there is usually agreement on the publication being delayed for a set time to permit a party to seek IP protection, or alternatively, for the confidential information to be removed from the publication.

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14 For more information on different drivers including on publishing see paragraph 12.
Research results

45.49. Research data should be managed well to enable the research results to be relied upon. This can also be important for IP as good records (on when the IP was created and who created it) can facilitate commercialisation.

46.50. A key way to ensure the quality of raw research data is to generate and record research data in accordance with good scientific practices.

47.51. Similarly, a key method for ensuring the quality of research analysis is to analyse research data appropriately and without bias in accordance with good scientific practices.

48.52. It is worth considering the approach to research results recommended by the Lambert Toolkit:

“Data trails must be kept to allow people to demonstrate easily and to reconstruct key decisions made during the conduct of the research, presentations made about the research and conclusions reached in respect of the research.”

Other research results

49.53. Other research results are those results from a collaboration project that are not covered by IP arrangements (although they may be able to be covered by IP). Examples of other research results include undocumented findings, conclusions, methods, techniques and know-how. They can also include raw data, other information, samples or prototypes.

50.54. These other research results may be used in further research or for commercial purposes related to the commercialisation objective of the project, such as to support a proposed patent application or regulatory approval.

51.55. There are many reasons that IP protection may not be the immediate or primary method of protecting these types of research results. These include:

- that the collaborating parties are not the parties appropriate to apply to register IP and defend it if needed;
- parties may wish to apply for registered IP at a specific time for strategic reasons; or
- parties may decide to maintain confidentiality of methods, techniques or know-how for use in other contexts.


Liability (warranties and indemnities)

52. Warranties and indemnities are often used to manage risk in all transactions including collaborations.

53. A warranty is a contractual promise where one party provides an assurance to another party in relation to a certain subject or state of affairs.

54. Warranties can be included in collaboration agreements in relation to IP matters. For example, a party may ask a research organisation to warrant that, to their reasonable knowledge, they own or have the right to make background IP available, or that the work they produce under the collaboration contract will not infringe the IP rights of a third party.\(^\text{18}\)

55. An indemnity is a legally binding promise to accept the risk of loss or injury another party may suffer as a result of certain events.

56. In many cases, the issue of whether a party is willing to give a warranty or indemnity, such as for IP ownership, can prevent collaboration altogether. There is often uncertainty and therefore unquantifiable risk and liability associated with warranties and indemnities relating to IP ownership. For instance, patents are not searchable until published.

57. Requiring unreasonably broad warranties or indemnities can be viewed by potential collaborators as excessively onerous, given the risk, and act as a disincentive for research collaboration. Indemnity issues can also adversely affect the research organisation’s insurance arrangements for the collaboration activity.

Key issues highly likely to require legal advice

58-59. For the purposes of this IP Toolkit, legal advice is a specialised ability to advise on the law as it applies to a specific situation\(^\text{19}\).

59-60. While many of the issues referred to in the IP Toolkit may require legal advice from an expert, there are some issues that are more likely to require legal advice than others.

60. Legal advice is highly likely to be needed in situations that include where:

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\(^{18}\) Note that the Personal Property Securities Act 2009 creates a register that can significantly affect the ownership and value of personal property such as IP. Note that the register relates to security interests which have attached to property and lists securities on IP. Third parties may register such a securities on this register.

\(^{19}\) See Attachment 2 — Useful additional resources.
• the collaboration IP affects business viability or researcher career prospects;
• the collaboration involves overseas collaborators or contributions;
• the collaboration requires extensive use of existing IP owned by non-collaborating parties;
• a planned collaboration output is for an overseas application for registrable IP, such the project IP may end up being protected via as a patent, including internationally;
• an IP collaboration output is very valuable and an organisation seeks to borrow against it or protect it;
• the collaboration is planning legal action or a collaborating party has been sent correspondence claiming infringement of another’s IP connected with the collaboration;
• there is to be joint ownership of the project IP (as this often leads to complex issues such as decision processes for registering IP and obligations that relate to payment for registration);
• a potential collaborating party has been asked to warrant or indemnify another party;
• a party is considering ending the collaboration early or the parties are in dispute about the conduct of the project or the IP strategy and ownership (including publication);
• the subject of collaboration relates to national security or defence (there may be legal restrictions);
• substantial legal risks have been identified in relation to undertaking the collaboration; or
• a party’s IP is being infringed and is considering how it addresses infringement of their IP (which can be costly to enforce).

International issues

If there is international collaboration between parties, the IP regimes of all collaborating party countries should be taken into account when drafting an agreement.

Attachments

Attachment 1 – Intellectual Property

Introduction
1. This attachment outlines the main types of collaboration material that can be regulated by IP law. Registered IP such as patents and trade marks can be complex to obtain and enforce, so the services of IP attorneys and lawyers are typically employed.

Patents
2. In Australia, patents are governed by the Patents Act 1990. Patents give a patent holder the exclusive rights, during the term life of a patent, to exploit an invention and to authorise another person to exploit (e.g. sell) an invention. Patents can protect how a technical innovation works. In Australia, standard patents are generally limited to granted for 20 years (the term can be more extended for an extra 5 years for pharmaceuticals).
3. The main types of collaboration material that can be governed by patents are:
   a) inventions for new or improved products (including components of products);
   b) inventions for new or improved processes (including for service delivery and manufacturing); and
   c) certain types of biological inventions.
4. These inventions can include isolated biological material, a new therapeutic technique, computer software and hardware, engineering, electrical and other types of technology.
5. A patent must satisfy a number of criteria before it can be granted by IP Australia. There are two types of patents that can be granted - standard patents and a lower level patent aimed at Australian SMEs, called innovation patents (referred to as utility or petty patents in some countries).
6. Patents can be necessary for the successful commercialisation of collaboration output as they grant the owner the right to exclusively use that output for a time period.
6.7. It should be noted that a patent may will not be able to be granted for an invention if someone publicly discloses the invention before patent protection has been sought. For example, discussing an invention with a third party, presenting it at a conference or publishing relevant details (such as in a conference presentation) without a non-disclosure or confidentiality agreement may constitute public disclosure. This could make the invention unpatentable.
because it is now in the public domain and is no longer novel (novelty being a requirement of patent registration).

- Patent applications need to disclose the full details of the invention as these are made publicly available. Fees must be paid to apply for, and maintain, a patent in each relevant country. The validity or scope of a patent may be disputed and can be costly to defend in court.

6. In Australia, there is a research exemption for patents which permits researchers to use the disclosed patent. This means that work done for experimental purposes (such as testing how it works) relating to the subject matter of the invention does not infringe the patent.

Know-how

7. Know-how can be a valuable source of IP. Know-how relates to the methods, procedures, techniques and skills applied to carry out certain tasks. Such know-how may not be patentable or may be kept non-patentable in order to maintain commercial advantage.

8. Often in collaboration endeavours, know-how is improved upon and added to, and can therefore form part of the Project IP. It is important for collaboration parties to discuss how new know-how and improvements to know-how will be documented and owned.

Designs

7. In Australia, designs are protected under the Designs Act 2003. Design registration is granted to protect the overall appearance of a product including the shape, configuration, pattern or ornamentation of a product. Design protection will be important for outputs which rely on the design of a product to differentiate it in the market. A registered design gives the owner exclusive commercial rights such as to use, sell or license it for 10 years.

8. Design registration is often used for protecting the design of packaging or clothing, but can also be used for a wide variety of goods such as electronics, engineering and mechanical, tools, cars and caravans, building materials, furnishings and sporting goods.

9. Designs can be a valuable result of industry and researcher collaboration as the new or unique appearance of a product can influence buyer and market behaviour and create commercial advantage.

Copyright

8. In Australia, copyright is governed by the Copyright Act 1968. Under that Act, ‘copyright’ is a bundle of rights in original literary, dramatic, musical and artistic works. Similar, but more limited, rights are
qualifying available for sound recordings, films, television and sound broadcasts and the typographical arrangements of published editions of works.

7.9. The duration of copyright in documents, software and images is generally the life of the author plus 70 years. Copyright ownership is often dependent on the type of employment of the author and whether the work is created while ‘in pursuance’ of the employment.

10.12. Copyright applies to the format of the material, not the ideas in the material (e.g. copyright applies to the wording, actual expression of words in a report, not the ideas within the report or ideas referred to by it).

11.13. Copyright is a bundle of rights to do certain acts with copyright material. These rights include the right to copy, publish, communicate (e.g. broadcast, make available online) and publicly perform the copyright material. Copyright rights can be important to commercialisation of collaboration output. Copyright also has exceptions to infringement, such as its use for research and study, which enable others to use the content in limited ways without infringing the copyright.

12.14. The main types of collaboration material that can be governed by copyright are:
   a) documents including drafts (e.g. project plans, research methods, reports and diagrams) and electronic text (e.g. emails, test results and presentations);
   b) photographs, sketches, plans and schematics;
   c) software, including source code and multimedia;
   d) film (such as demonstration videos or animations of processes);
   e) sculptures (which may include prototypes); and
   f) audio recordings (such as dictated research notes).

Moral rights

8.10. If copyright material is produced under a collaboration, then moral rights also need to be considered. Moral rights are personal rights of the author of a work and are a separate right to a copyright, but also protected under the Copyright Act 1968.

9.11. Moral rights are:
   • to be clearly and prominently identified as the author of the work;
   • not to have authorship falsely attributed to another person / entity; and
   • not to have anyone treat the work in a derogatory manner i.e. to maintain the integrity of the copyrighted work.
12. Moral rights cannot be bought, sold or licensed, unlike copyright material or other forms of IP rights. They are also non-economic and cannot be used for direct financial gain.

40.13. Where the author has genuinely consented, it will not be an infringement of an author's moral rights to do, or omit to do, something in relation to their work if the act or omission is within the scope of a written moral rights consent genuinely given by the author.

44.14. Many bodies automatically seek moral rights consents through their contracts with authors. This is rather than to assist the body in managing the risk of inadvertently infringing an author's moral right. It is up to each individual author if they agree to grant consent to waive their moral rights. It can be useful that collaboration partners assessing the risk of infringing an author's moral rights in a collaboration project agree how this could be managed through the intended use of relevant copyright material.

12.15. It should also be noted that sometimes requesting moral rights consents may place a research organisation in a difficult position, especially if one of their researchers refuses to sign a moral rights consent. A research organisation may also be obliged (due to employee agreements or policy) to insist on moral rights clauses and not be in a position to agree to moral rights consents.

13.16. However a research organisation may be able to seek agreement to the way an industry collaborator may use the copyrighted material and obtain a tailored moral rights consent. For example, some consents are given so that instead of each author being listed, the name of their institution is listed on the work instead.

Other IP law (trade marks, geographical indications, plant breeder’s rights, circuit layouts)

44.17. There are other types of IP rights that may be important to collaboration such as:

a) plant breeder’s rights for new plant varieties;

b) trade marks, which differentiate goods and services in a market, and are often used for the commercialisation of a technology (e.g. logos and brand identity);

c) circuit layout rights for computer chip design; and

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d) geographical indications, which are relevant to the distinctive properties of products associated with a geographic region and are often used for wine areas in Australia.

Registered trademarks do not have an expiry period, provided the registered trademark continues to be used in the course of trade and the trademark owner continues to pay the renewal fees for the registration.

Other IP issues

Limits to IP

16. Each type of IP is limited in different ways to cater for issues such as access and competition. Also there are different rules worldwide for the different types of IP, for instance the length of copyright and the criteria for granting patents varies globally. Some of the most relevant IP limitations for collaborations (such as the length of IP rights and criteria for IP ownership) are outlined below.

17. In Australia, standard patents are generally limited to 20 years (the term can be more for pharmaceuticals). Whereas copyright in documents, software and images is generally the life of the author plus 70 years.

18. Contract, employment and case law usually govern IP ownership. Copyright ownership is often dependent on the type of employment of the author and whether the work is ‘in pursuance’ of the employment.

19. A key determinant of any IP ownership (and also IP length) can be in employment agreements. Employment agreements and policies can vary, particularly for each research organisation.

20. Copyright is only available for certain types of original content in a material form (i.e. there is no copyright in ideas). It also has exceptions, such as those for research and study, which enable others to use the content in limited ways without infringing the copyright.

21. A patent may not be granted for an invention if someone publicly discloses it before patent protection has been sought. For example, discussing an invention with a third party or publishing relevant details (such as in a conference presentation) without a non-disclosure or confidentiality agreement may constitute public disclosure. This could make the invention unpatentable because it is now in the public domain.

Patent applications need to disclose the full details of the invention as these are made publicly available. Fees must be paid to apply for, and

maintain a patent in each relevant country. The validity or scope of a patent may be disputed and can be costly to defend in court.

In Australia, there is a research exemption for patents. This means that work done for experimental purposes relating to the subject matter of the invention does not infringe the patent.

### Realistic IP valuation for collaboration

If one party has an unrealistic view of the value of the IP that they bring to the collaboration (background IP), it can affect the degree of mutual trust and hence impact on the likelihood of collaboration. This is because of the common expectation that there will be proportional value of inputs and outputs.

### Why potentially commercially valuable IP can be offered for free

A party's goals may not be furthered by a commercial IP valuation.

While the IP may have been costly to create (in terms of research time and resources), it may also be costly to commercialise. As part of a research organisation’s valuation of the IP that it brings to a collaboration, the research organisation may take into account the benefits of increased sponsored research and student development arising from the collaboration.

A number of Australian universities are using the Easy Access IP scheme to offer free access to potentially valuable IP. The purpose of the scheme is to increase the up-take of university IP by industry, accelerate the translation of IP into commercial outcomes and encourage new opportunities for collaboration between universities and industry.

### Licensing IP

Licensing of IP gives a right to use the IP. This can be done on an options can include exclusive basis i.e. only the party holding the licence can use the IP, or on a non-exclusive use basis i.e. a number of parties can use the IP, often in defined jurisdictions and/or defined technical fields. Exclusive use enables the licence holder to preclude others from competing in a relevant market and is generally more commercially valuable to a party than non-exclusive use. Similarly, rights to sub-license IP to other parties can be commercially valuable as they allow flexibility in commercialisation. Full ownership of IP without any constraints effectively provides exclusive use and rights to sub-license.

---


26 Exclusive licensing may preclude an IP owner from using or commercialising the IP.
33. A licensing option is to limit the scope of the IP to a time period. This is often based on activity, e.g. if the sponsor does not commercialise the IP in the specified time period then IP rights revert back to the research organisation.

Creative commons licensing

34. Creative commons refers to standard copyright licences to facilitate the legal sharing and reuse of copyright material without infringing the work.  

Traditional knowledge and IP

35. There are also many issues surrounding traditional knowledge and IP where materials have an indigenous source.

---

27 See http://creativecommons.org.au accessed on 8 December 2014.
Attachment 2 – Useful additional resources

**Australia**

- For information on copyright see [Australian Copyright Council](http://www.copyright.org.au/) and [www.ag.gov.au](http://www.ag.gov.au).
- For information on patents, trade marks, designs and plant breeder’s rights see [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au).
- For geographical indications for wine see [www.wineaustralia.com](http://www.wineaustralia.com).
- For searching the trademarks register: [http://pericles.ipaustralia.gov.au/atmoss/falcon.application_start (enter as Guest)](http://pericles.ipaustralia.gov.au/atmoss/falcon.application_start (enter as Guest)).

**International**

- WIPO Collaboration Agreements.
Notes:

Purpose

This model Research Collaboration Agreement is intended to be used when a Sponsor (i.e. a sponsoring organisation such as a company) will be providing money or other assistance to a Research Organisation (such as a university or other research institution) to conduct research. The research may result in Intellectual Property outputs which can be commercialised (i.e. licensed or sold).

This model Agreement has not been designed for complex or high risk projects or projects involving more than two parties, and should not be used for these purposes.

Structure

This model Agreement comprises four Parts:

- Part 1 – the Agreement Terms (standard legal terms which apply to this Agreement);
- Part 2 – the Agreement Details (the variable legal terms which must be agreed and completed by the Parties); and
- Part 3 – the Project Details (the specific details of the Project which must be agreed and completed by the Parties).
- Part 4 – Attachment A – Template IP Register.

This model Agreement has been drafted so that the Parties need only complete Part 2 and Part 3 of this Agreement. Please complete all highlighted sections in Part 2 and Part 3 of this Agreement, ensuring that only one option is selected in each clause and that the other option(s) are deleted.

Attachment A must be completed and maintained by the Research Organisation after the...
Agreement has been signed, unless the Parties agree otherwise.

Please delete all highlighted notes, such as this note, prior to signing the completed Agreement.

Disclaimers and conditions of use

The law referred to in this model Agreement is current as at October 2014. Please exercise caution in using this model Agreement beyond that date as the law may have changed.

This model Agreement refers to Australian law and has not been designed for use outside Australia, including that it has not been designed for use by Parties located outside Australia.

This model Agreement does not constitute legal or financial advice. Please consider whether you require legal or financial advice to complete this Agreement.

This model Agreement is made available for use on the condition that the Commonwealth of Australia and its officers, employees, contractors and agents expressly disclaim all responsibility (including responsibility for negligence) for the content of this model Agreement to the extent permitted by law. By using this model Agreement, users are deemed to have consented to this condition and agree that this model Agreement is used entirely at their own risk.

Licence

This model Research Collaboration Agreement created by the Commonwealth of Australia is licensed under a Creative Commons Attribution 4.0 International License.

A complete and current version of the model Agreement is available at www.industry.gov.au/IPToolkit.

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1 Parties

1.1 This Agreement is made between the Sponsor and the Research Organisation.

2 Operative provisions

2.1 This Agreement comprises:

(a) Part 1 – the Agreement Terms;
(b) Part 2 – the Agreement Details;
(c) Part 3 – the Project Details; and
(d) any other documents incorporated by reference.

3 Definitions and interpretation

Definitions

3.1 In this Agreement:

<table>
<thead>
<tr>
<th>Term</th>
<th>Definition</th>
</tr>
</thead>
<tbody>
<tr>
<td>Agreement</td>
<td>means this Research Collaboration Agreement, including its Parts and Attachments and any other documents incorporated by express reference, as described in clause 2.1 of these Agreement Terms.</td>
</tr>
<tr>
<td>Agreement Details</td>
<td>means Part 2 – Agreement Details of this Agreement.</td>
</tr>
<tr>
<td>Background IP</td>
<td>means any Intellectual Property:</td>
</tr>
<tr>
<td></td>
<td>(a) existing prior to the execution of this Agreement; or</td>
</tr>
<tr>
<td></td>
<td>(b) obtained or created after the execution of this Agreement by a Party other than as a result of the performance of this Agreement.</td>
</tr>
<tr>
<td>Budget</td>
<td>means the agreed budget for the Project, as set out in clause-section 16 of the Project Details.</td>
</tr>
<tr>
<td>Business Day</td>
<td>means a day other than a Saturday, Sunday or public holiday in the Governing Jurisdiction.</td>
</tr>
<tr>
<td>Claims</td>
<td>means claims, losses, damages, costs and expenses including legal costs on a solicitor and own client basis.</td>
</tr>
<tr>
<td>Commencement Date</td>
<td>has the meaning given in clause-section 6 of the Agreement Details.</td>
</tr>
<tr>
<td><strong>Commercialise</strong></td>
<td>includes, without limitation:</td>
</tr>
<tr>
<td>-------------------</td>
<td>--------------------------------</td>
</tr>
<tr>
<td>(a)</td>
<td>to manufacture, sell, license, assign or hire for commercial benefit or otherwise exploit a product or process or other subject matter in which Intellectual Property rights subsist;</td>
</tr>
<tr>
<td>(b)</td>
<td>to provide a service for commercial benefit; or</td>
</tr>
<tr>
<td>(c)</td>
<td>to license or authorise any person to do any of the above for commercial benefit, or</td>
</tr>
<tr>
<td>(d)</td>
<td>any acts that are related to the acts set out in (a), (b) or (c), but excludes a Party licensing Intellectual Property to a person merely to have that person perform activities on behalf of that Party and for that Party’s own non-commercial purposes, and Commercialisation is similarly construed.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th><strong>Confidential Information</strong></th>
<th>means the following information provided by or for one Party to another in any way in relation to this Agreement:</th>
</tr>
</thead>
<tbody>
<tr>
<td>(a)</td>
<td>information designated as confidential by the Party which provides the information (including in clause section 13 of the Project Details);</td>
</tr>
<tr>
<td>(b)</td>
<td>information imparted in circumstances of confidence; or</td>
</tr>
<tr>
<td>(c)</td>
<td>information that the recipient of the information knows, or ought to know, is confidential;</td>
</tr>
<tr>
<td></td>
<td>but does not include information which is already known by the receiving Party at the time it is disclosed, or which is or becomes public knowledge other than by breach of this Agreement.</td>
</tr>
</tbody>
</table>

| **Conflict of Interest** | means an actual, potential or perceived conflict of interest. |

| **Contributing Party** | has the meaning given in clause 13 of these Agreement Terms. |

| **Deliverable** | means an item of Material which is or will be created or provided during the Project, including those Deliverables specified in clause section 3 of the Project Details. |

| **Force Majeure Event** | means an event beyond the reasonable control of a Party. |

| **Funds** | means the financial contributions payable by the Sponsor in accordance with, and subject to, this Agreement. |

<p>| <strong>Governing Jurisdiction</strong> | means the place specified in clause section 17 of the Agreement Details. If no place is specified in clause section 17 of the Agreement Details, the Governing Jurisdiction is New South Wales. |</p>
<table>
<thead>
<tr>
<th><strong>In-kind Contribution</strong></th>
<th>has the meaning given in clause section 72 of the Project Details.</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Intellectual Property or IP</strong></td>
<td>includes all copyright (including rights in relation to phonograms and broadcasts), all rights in relation to inventions, plant varieties, trademarks (including service marks), designs and circuit layouts, and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields recognised anywhere in the world, but does not include Moral Rights and the rights of performers.</td>
</tr>
<tr>
<td><strong>Insolvency Event</strong></td>
<td>means the happening of any of the following events in relation to a Party:</td>
</tr>
<tr>
<td></td>
<td>(a) an application is made to a court for an order, or an order is made, that the Party be wound up;</td>
</tr>
<tr>
<td></td>
<td>(b) a liquidator, receiver, receiver and manager, administrator or controller is appointed in respect of the Party;</td>
</tr>
<tr>
<td></td>
<td>(c) the Party enters into a deed of company arrangement, a scheme of arrangement or composition with, or assignment for the benefit of, its creditors;</td>
</tr>
<tr>
<td></td>
<td>(d) the Party resolves to wind itself up, or otherwise dissolve itself, or gives notice of intention to do so;</td>
</tr>
<tr>
<td></td>
<td>(e) the Party is insolvent or is presumed to be insolvent within the meaning of the Corporations Act 2001 (Cth); or</td>
</tr>
<tr>
<td></td>
<td>(f) anything having a substantially similar effect to any of the events specified above happens under any law or any applicable jurisdiction.</td>
</tr>
<tr>
<td><strong>Internal Purposes</strong></td>
<td>means internal and non-commercial research, record-keeping, reporting, auditing, teaching and training purposes.</td>
</tr>
<tr>
<td><strong>IP Register</strong></td>
<td>means a register of all Project IP, Background IP and Third Party IP created or Used in connection with the Project and which is substantively in the form of Attachment A.</td>
</tr>
<tr>
<td><strong>Key Person</strong></td>
<td>means a person specified in clause section 4 of the Project Details.</td>
</tr>
<tr>
<td><strong>Loaned Equipment</strong></td>
<td>has the meaning given in clause 19 of the Project Details.</td>
</tr>
<tr>
<td><strong>Material</strong></td>
<td>Includes:</td>
</tr>
<tr>
<td></td>
<td>(a) property including samples and prototypes;</td>
</tr>
<tr>
<td></td>
<td>(b) information including conclusions, techniques, know-how, methods, raw data and undocumented findings;</td>
</tr>
</tbody>
</table>

IP Toolkit Model Research Collaboration Agreement DRAFT
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Comment [JN4]: Suggest removal as it may not be a section that is used very often.
<table>
<thead>
<tr>
<th>Term</th>
<th>Definition</th>
</tr>
</thead>
<tbody>
<tr>
<td>Milestone</td>
<td>means a milestone specified in clause section 17 of the Project Details.</td>
</tr>
<tr>
<td>Moral Rights</td>
<td>has the meaning given in the Copyright Act 1968 (Cth), as amended or replaced from time to time.</td>
</tr>
<tr>
<td>Owning Party</td>
<td>means the Party which owns Project IP, as specified in this Agreement.</td>
</tr>
<tr>
<td>Part</td>
<td>means a part of this Agreement, as more fully described in clause 2.1 of these Agreement Terms.</td>
</tr>
<tr>
<td>Parties</td>
<td>means the parties to this Agreement and their respective successors and permitted assigns and Party means any one of them.</td>
</tr>
<tr>
<td>Personnel</td>
<td>means, in relation to a Party, any employee, officer, agent, contractor, sub-contractor, student or volunteer of that Party including any Key Person and any employee, officer, agent, contractor, sub-contractor, student or volunteer of a contractor or sub-contractor, but excludes the other Party and its respective Personnel.</td>
</tr>
<tr>
<td>Principal Investigator</td>
<td>means the principal researcher who directs the Project on behalf of the Research Organisation.</td>
</tr>
<tr>
<td>Project</td>
<td>means the project described in the Project Details.</td>
</tr>
<tr>
<td>Project Details</td>
<td>means Part 3 – Project Details of this Agreement.</td>
</tr>
<tr>
<td>Project IP</td>
<td>means any Intellectual Property created by or on behalf of a Party for the purposes of the Project or this Agreement.</td>
</tr>
<tr>
<td>Recipient Party</td>
<td>has the meaning given in clause 13 of these Agreement Terms.</td>
</tr>
<tr>
<td>Representative</td>
<td>means a person authorised to manage this Agreement on behalf of a Party.</td>
</tr>
<tr>
<td>Special Conditions</td>
<td>means the special conditions specified in clause section 18 of the Agreement Details and clause section 20 of the Project Details, if any.</td>
</tr>
<tr>
<td>Term</td>
<td>has the meaning given in clause section 7 of the Agreement Details.</td>
</tr>
<tr>
<td>------------</td>
<td>---------------------------------------------------------------------</td>
</tr>
<tr>
<td>Third Party IP</td>
<td>means IP which is owned by a person other than the Sponsor or the Research Organisation, and is Used, or proposed to be Used, for the Project.</td>
</tr>
<tr>
<td>Use</td>
<td>means to exercise any or all rights subsisting in Intellectual Property, including to license or sub-license those rights.</td>
</tr>
<tr>
<td>WHS Law</td>
<td>[Note: WHS laws vary between different States and Territories of Australia. The parties should seek legal advice if they are uncertain of their obligations.]means all of the work health and safety and occupational health and safety laws, including regulations and codes of practice, which are applicable to the Parties and the Project.</td>
</tr>
</tbody>
</table>

**Interpretation**

3.2 In this Agreement, unless the context otherwise requires:

(a) the singular includes the plural and vice versa;

(b) a reference to an individual or person includes a corporation;

(c) a reference to any gender includes all genders;

(d) a reference to either Party includes that Party’s executors, administrators, substitutes, successors and permitted assigns;

(e) a reference to any legislation includes any regulations or rules made under that legislation and any amendment, modification to or replacement of that legislation which may be made from time to time;

(f) a reference to a clause, Part or Attachment means, unless otherwise specified, a clause, Part or Attachment of this Agreement;

(g) a reference to an amount of money means a reference to Australian currency unless otherwise indicated; and

(h) words of inclusion will be interpreted as being without limitation.

**4 Commencement**

4.1 This Agreement will commence on the Commencement Date and will continue for the Term.

**5 Role of each Party**

5.1 Each Party must undertake the Project by performing the obligations which it is required to perform as set out in the Project Details and by meeting all its other obligations under this Agreement including without limitation:

---

Comment [JN7]: Suggest that use of third party IP is a complicated area fraught with danger and should be subject to specialist legal advice prior to use.

Comment [JN8]: Not relevant to conduct of project unless parties are visiting each other’s premises to conduct the project. In which case, provisions to simply comply with all lawful directions may suffice.
The Sponsor must:

(a) provide Funds and In-kind Contributions, including Loaned Equipment, in accordance with the Project Details; and

(d) comply with the Special Conditions;

(e) at all times act in good faith in relation to the other Party with respect to all matters relating to the Project;

(f) to the extent practicable, act consistently with the interests of the Project; and

(g) perform all its other obligations as specified in this Agreement.

The Research Organisation must:

(a) comply with all laws;

(b) in conducting research, comply with generally accepted professional, scientific and ethical principles and standards including, if the Project involves human beings or animals, the codes adopted for that purpose by the National Health and Medical Research Council;

(c) perform all work in connection with the Project in a safe manner and in a way that, so far as is practicable, is without risk to the health, safety and welfare of any person and assists the other Party to meet its own obligations and responsibilities under WHS Law;

(d) carry out the Project at the places specified in accordance with the Project Details, if any, or such other places agreed by the other Party in writing;

(e) meet each Milestone and other deadlines as set out in the Project Details;

(f) provide Funds and In-kind Contributions, including Loaned Equipment, in accordance with the Project Details;

(g) provide Deliverables, including reports, in accordance with the Project Details;

(h) comply with the Special Conditions;

(i) commence the Project on the Commencement Date;

(j) complete the Project as specified in the Project Details;

(k) at all times act in good faith in relation to the other Party with respect to all matters relating to the Project;

(l) to the extent practicable, act consistently with the interests of the Project; and

(m) perform all its other obligations as specified in this Agreement.
5.3 Except as otherwise provided in this Agreement or agreed in writing between the Parties, each Party will be fully responsible for all costs and expenses that it incurs in relation to the Project.

5.4 In respect of the phrases In-kind Contributions and Loaned Equipment, the parties acknowledge and agree:

(a) the phrases are used as a convenient reference to assets, resources or equipment which are owned by a Party and which have been set aside by that Party for use in connection with the Project; and

(b) the phrases are not a reference to any actual contribution or loan.

6 Representatives

6.1 Each Party must appoint one Representative.

6.2 The Representatives as at the Commencement Date are those persons specified in clauses section 8 and 9 of the Agreement Details.

6.3 Each Party may, at any time and from time to time, replace its Representative by giving written notice to the other Party.

7 Key Persons Personnel

7.1 Each Party must ensure that each of its Key Persons Personnel performs the duties specified for that person specified in clause section 4 of the Project Details.

7.2 If a Key Person is unable at any time during the Project to continue to perform his or her duties and functions as specified in the Project Details, the applicable Party must:

(a) notify the other Party of that inability within 10 Business Days; and

(b) ensure that a replacement person is appointed, with the consent of the other Party, to perform the relevant duties as soon as practicable, and in any event within a further 10 Business Days, unless agreed otherwise. Such consent must not be unreasonably withheld by the other Party.

8 Students and volunteers

8.1 The Research Organisation may only permit students or volunteers to be involved in the Project if:

(a) the students and volunteers are listed in the Project Details, or the Research Organisation has otherwise obtained the prior, written consent of the Sponsor to their involvement; and

(b) [Note: assignments of IP can give rise to legal and stamp duty issues. The Parties should obtain advice on the best way to assign IP if an assignment is required; the students and volunteers have signed a deed of confidentiality in a form acceptable]
to the Sponsor and have agreed in writing to assign their rights in Project IP (if any) to the Owning Party at no cost.

8.2 Any student thesis that is developed as part of the Project will not form part of the Project Deliverables and any Intellectual Property in that thesis will not form part of the Project IP.

9 Sub-contracting

9.1 A Party may only sub-contract its obligations under this Agreement with the prior, written consent of the other Party, which consent must not be unreasonably withheld, but may be given subject to conditions.

9.2 If a Party sub-contracts its obligations in accordance with clause 9.1 of the Agreement Terms, it must ensure that the sub-contract is in writing, and imposes on the sub-contractor obligations which are consistent with, and no less onerous than, the obligations of that Party under the provisions of this Agreement.

9.3 A Party is fully responsible for the performance of its obligations under this Agreement even if it has sub-contracted the performance of any or all of its obligations under this Agreement.

10 Obligations regarding Personnel

10.1 Each Party must ensure that its Personnel who are undertaking the Project:

(a) are properly trained and qualified to perform their roles;

(b) are appropriately supervised, having regard to their qualifications; and

(c) comply with all lawful directions when on the other Party’s premises.

11 Equipment

Provision of Loaned Equipment

11.1 Each Party must provide the Loaned Equipment it has agreed to provide as specified in clause 19 of the Project Details or as agreed by the Parties in writing from time to time.

11.2 The provision and use of the Loaned Equipment is subject to such conditions as are specified in clause 19 of the Project Details, and each Party must comply with those conditions.

11.3 Unless clause 19 of the Project Details provides for the return of Loaned Equipment at an earlier date, a Party which is in possession of Loaned Equipment provided by the other Party must return the Loaned Equipment to the other Party as soon as practicable after the end of the Term.
11.4 The Research Organisation may use the Funds to purchase Project Equipment if specified in clause 19 of the Project Details or otherwise with the prior, written consent of the Sponsor.

11.5 The Party specified in clause 19 of the Project Details as the owner of particular Project Equipment will own that Project Equipment.

Responsibility for Equipment

11.6 Unless specified otherwise in the Project Details, the Research Organisation must, at its own expense:

(a) insure and maintain in good condition (subject to fair wear and tear) all Project Equipment and Loaned Equipment for the Term, and effect all necessary repairs; and

(b) comply with the duties under WHS Law that apply to persons who control plant or equipment used at a workplace including, but not limited to, any duties that apply in relation to supplying, importing, registering, licensing, safeguarding, installing, examining, testing, altering, repairing, providing signage for, maintaining or dismantling Project Equipment or Loaned Equipment.

Equipment records

11.7 The Research Organisation must:

(a) keep accurate records of the Project Equipment and Loaned Equipment, including details of serial numbers, location, condition and maintenance records; and

(b) provide any such records to the Sponsor upon request.

12 Material

12.1 Each Party must promptly make available to the other Party all Material in its possession or control which is reasonably required by the other Party to exercise its rights, and particularly its Intellectual Property rights, under this Agreement.

12.2 The Deliverables created for the purposes of this Agreement will be owned as set out in the Project Details or as otherwise agreed by the Parties in writing.

13 Background IP and Third Party IP

Ownership

9.1 Nothing in this Agreement affects the ownership of Background IP or Third Party IP.

13.1 Unless otherwise agreed in writing, a Contributing Party provides its Background IP to the Recipient Party on a non-exclusive, royalty-free, fee-free licence to use to the purpose of conducting the Project only.
Process for offering Material containing Background IP or Third Party IP

13.2 The process described in clauses 13.3 – 13.8 of the Agreement Terms applies except if the Project Details provide otherwise.

13.3 A Party (Contributing Party) may offer any Material containing Background IP or Third Party IP to be Used for the performance of the Project or this Agreement, on terms which must be disclosed by the Contributing Party to the other Party (Recipient Party) in writing at the time that the Material is offered.

13.4 The terms which must be disclosed by the Contributing Party for the purposes of clause 13.3 of the Agreement Terms include:

(a) details of any restrictions, conditions or encumbrances, that apply, or may apply, to the Use of the Background IP or Third Party IP, including fees or royalties for Third Party IP, and

(b) any other information as is reasonably requested by the Recipient Party.

13.5 If no terms are disclosed as described in clause 13.4 of the Agreement Terms, the terms set out in clause 6 of the Project Details will apply.

13.6 After receiving an offer described in clause 13.3 of the Agreement Terms, the Recipient Party may, acting reasonably:

(a) consent to the Use of any Material containing Background IP or Third Party IP (which consent may be subject to conditions); or

(b) reject the Use of any of the Material containing Background IP or Third Party IP, giving reasons.

13.7 If a fee or royalty is payable in order to acquire a Third Party IP licence, then the Parties must agree in writing the proportion in which the Parties will pay the fee or royalty.

13.8 If the Recipient Party rejects the Use of Material containing Background IP or Third Party IP in accordance with clause 13.6(b) of the Agreement Terms, the Contributing Party must not Use that Background IP or Third Party IP in connection with the performance of the Project or this Agreement.

Risk issues regarding Background IP or Third Party IP

13.9 Each Party must take reasonable steps to ensure that it does not, without giving prior written notice, offer or provide to the other Party Material that:

(a) presents a substantive risk to persons or property; or

(b) breaches, or may cause the other Party to breach, any applicable laws or regulations.

13.10 A Party which becomes aware that either of the circumstances described in clauses 13.9(a) or 13.9(b) of the Agreement Terms apply in respect of any Material must give the other Party prompt written notice of those circumstances.
Use and protection of Background IP and Third Party IP

13.11 A Recipient Party must not, without the prior express written consent of the Contributing Party, Use the Contributing Party’s Background IP or Third Party IP other than in accordance with this Agreement or a separate agreement signed by both Parties, or as permitted by law.

13.12 Each Recipient Party represents and warrants to the other Party that it will not assign, encumber or otherwise deal with, dispose of or Commercialise the Contributing Party’s Background IP or Third Party IP, except in accordance with this Agreement or a separate agreement signed by both Parties.

13.13 Each Party must take all reasonable steps to protect the other Party’s Background IP and Third Party IP from misuse and must give the Contributing Party prompt written notice of any actual or potential claims concerning infringement of Background IP or Third Party IP which come to their attention.

13.14 The Recipient Party must give the Contributing Party all assistance which it reasonably requests in order to protect the Contributing Party’s Background IP or Third Party IP, at the Contributing Party’s expense.

1410 Ownership of Project IP

14.11 Project IP vests on its creation as set out in clause section 7 of the Project Details.

14.2 Neither Party may dispose of or encumber the whole or any part of its interest in any Project IP, except with the prior, written consent of the other Party, which must not be unreasonably withheld.

14.3 Each Party must co-operate and promptly do all acts and things and execute all documents which may be necessary or desirable for the purpose of vesting ownership of the Project IP as described in clause 14.1 of these Agreement Terms.

15 Use of Project IP

15.1 Unless clause section 8 of the Project Details provides otherwise, the Owning Party grants to the other Party a perpetual, irrevocable, world-wide, non-exclusive royalty free and fee-free licence to Use the Project IP for the purposes of the Project and for Internal Purposes. This licence excludes the right to Commercialise (however, such a licence may be provided elsewhere in this Agreement).

16 Commercialisation of Project IP

16.1 Commercialisation of Project IP is only permitted as specified in clause 10 of the Project Details.
17 IP Register

17.1 Unless specified otherwise in clause 11 of the Project Details, the Research Organisation must maintain an IP Register throughout the Term in respect of all Project IP, Background IP and Third Party IP, and must ensure that updated and complete copies of the IP Register are provided to the Sponsor in accordance with clause 3 of the Project Details.

18 Moral rights

Moral rights will be owned by the persons who create Material for the purposes of this Agreement, including reports, software, etc, which is subject to the provisions of copyright law. Moral Rights cannot be assigned or transferred. If a person has Moral Rights then they should be recognised as the author of their work by the Sponsor and Research Organisation, including by having their name appear on their work. They may also be able to prevent certain uses of their work (such as editing). If this may be problematic for one or both Parties, the Research Organisation may be required to obtain written consents from those personnel, by selecting the optional clause section 12 of the Project Details. For more information on Moral Rights, please refer to the Toolkit.

18.11 Subject to clause 18.2 of these Agreement Terms, and unless specified otherwise in clause section 12 of the Project Details, each Party must respect the Moral Rights of the Personnel of the other Party as required by law.

18.21 If clause section 12 of the Project Details requires the Research Organisation to provide obtain Moral Rights consents from its Personnel, then the Sponsor is not required to comply with clause 18.1 of these Agreement Terms.

18.31 When providing Material to the other party for the purposes of this Agreement, each Party must ensure that the Material contains, or is provided with, correct attribution of authorship, if applicable, so as to enable the other Party to comply with clause 18.1 of these Agreement Terms, to the extent the other Party is required by this Agreement to do so.

19 Confidentiality

19.11 Subject to clause 19.2 of these Agreement Terms, the Sponsor and the Research Organisation (Obtaining Party) must each keep strictly confidential all Confidential Information provided to it by the other Party (Disclosing Party) in connection with this Agreement.

19.21 Clause 19.1 of these Agreement Terms does not prevent:

(a) use or disclosure of information lawfully obtained from any third person or lawfully developed by the Obtaining Party, other than as a result of a breach of confidentiality obligations;

(b) disclosure of information required to be disclosed by the Obtaining Party by law or pursuant to the rules of any securities exchange;
(c) disclosure by the Obtaining Party to its legal or other advisers, subject to the relevant adviser being subject to confidentiality obligations or a confidentiality undertaking in a form reasonably satisfactory to the Disclosing Party;

(d) disclosure of information which is necessary to perform the Project, but only to the extent necessary to perform the Project; and

(e) disclosure of information for the purposes of, or in connection with, the registration, protection, exercise or Commercialisation of any Project IP, Background IP or Third Party IP, if such registration, protection, exercise or Commercialisation is permitted by this Agreement;

(f) disclosure of information to an auditor solely for the purposes of an audit; and

(g) use or disclosure of information by the Obtaining Party which the Parties have agreed in writing may be used or disclosed by the Obtaining Party, provided such use or disclosure is in accordance with the terms of that agreement.

If a Party becomes aware that it has or may have breached this clause 19 of these Agreement Terms, that Party must immediately notify the other Party and take all reasonable steps required to prevent or stop the breach.

20.1 Announcements and publication

Without limiting any other rights granted under this Agreement, the Parties may make or issue public statements concerning this Agreement:

(a) to the extent permitted by any other provision of this Agreement concerning Confidential Information; and

(b) with the prior, written consent of the other Party, such consent not to be unreasonably withheld.

The Research Organisation may publish Project research outcomes and other publishable Material in accordance with clause section 14 of the Project Details.

21.1 Payment

Subject to clause 21.2 of these Agreement Terms and the Research Organisation's proper performance of this Agreement, the Sponsor must pay the Research Organisation the Funds up to the amount of the Budget, and as specified in, and subject to, clause section 17 of the Project Details.

The Research Organisation must deliver to the Sponsor correctly-rendered invoices in accordance with the payment schedule in clause section 17 of the Project Details. The Sponsor is not obliged to make a payment of any amount to the Research Organisation until 30 days after it has received a correctly-rendered invoice in respect of that amount, or within such other time period agreed by the Parties in writing.
21.3 The Research Organisation must only spend the Funds in accordance with the Budget.

21.4 Unless agreed otherwise by the Parties in writing, the Sponsor is not responsible for the provision of additional money to meet any expenditure in excess of the Budget, even if additional money is required to complete the Project.

22 Insurance

22.1 Each Party must maintain, and ensure its sub-contractors maintain, for the duration of the Project, insurance:

(a) as set out in clause 10 of the Agreement Details; and

(b) as required by all relevant laws relating to worker's compensation, for its Personnel engaged in the conduct of the Project.

22.2 Each Party must promptly provide to the other Party evidence of the insurances it maintains and its sub-contractors maintain, for the purposes of clause 22.1 of the Agreement Terms, when requested.

23 Liability

Liability

[To ensure that costs and resources (such as the cost of insurance) are minimised, liability under an agreement should generally be borne by the party best placed to manage it. In this Agreement, this will generally be the Research Organisation, as it is responsible for undertaking the research activities, which are likely to give rise to the most risk. Each Party should complete a risk assessment prior to negotiating this clause to assist in assessing the risks of the Project. A risk assessment will help the Parties to determine if risk treatment strategies (such as additional insurance) may be appropriate.]

23.1 The liability of the Parties under this Agreement will be determined in accordance with one of the options set out in this clause 23 of the Agreement Terms. The applicable option is specified in clause 11 of the Agreement Details. If no option is specified in clause 11 of the Agreement Details, Option A applies.

23.2 All options in this clause 23 of the Agreement Terms are subject to clause 24 of the Agreement Terms.

Liability Option A

[This option means that general legal principles apply to this Agreement. If an issue arises, then liability may not be clear from this Agreement and the Parties may need to obtain legal advice.]

23.3 The Parties agree that common law principles of liability will apply to this Agreement.
Liability Option B

This option may be appropriate if both Parties will be engaged in the research activities and the Parties do not wish to leave liability issues to be determined by general legal principles.

23.4 Each Party (Indemnifier) must indemnify, and keep indemnified, the other Party and its Personnel (collectively, Indemnified Persons) from and against any and all Claims suffered or incurred by, or brought or made against, Indemnified Persons resulting from:

(a) any breach by the Indemnifier of this Agreement or any law;

(b) the infringement of any Intellectual Property rights arising from the use, as contemplated by this Agreement, of the Background IP or Third Party IP provided by the Indemnifier (whether owned by the Indemnifier or another person);

(c) any malicious, fraudulent, negligent, unlawful or wilful act or omission by the Indemnifier or its Personnel; or

(d) any damage to any property, or injury or death to any person, to the extent caused or contributed to by the Indemnifier or its Personnel.

Liability Option C

This option may be appropriate if the Research Organisation will be undertaking all activities, or almost all activities, with minimal or no activities being performed by the Sponsor.

23.5 The Research Organisation must indemnify, and keep indemnified, the Sponsor and its Personnel (collectively, Indemnified Persons) from and against any and all Claims suffered or incurred by, or brought or made against, an Indemnified Person resulting from:

(a) any breach by the Research Organisation of this Agreement or any law;

(b) the infringement of any Intellectual Property rights arising from the Use as contemplated by this Agreement of the Project IP or any Background IP or Third Party IP provided by the Research Organisation (whether owned by the Research Organisation or another person);

(c) any malicious, fraudulent, negligent, unlawful or wilful act or omission by the Research Organisation or its Personnel; or

(d) any damage to any property, or injury or death to any person, to the extent caused or contributed to by the Research Organisation or its Personnel.

24 Limitation of liability

24.1 The Parties' liability arising from or in connection with this Agreement is limited as specified in clause 12 of the Agreement Details.
25——Warranties

25.1 In addition to, and without limiting, the warranties provided in the Agreement Terms, the Parties provide the warranties specified in clause 13 of the Agreement Details.

26——Privacy

26.1 Each Party must comply with the Privacy Act 1988 (Cth) (Privacy Act) in respect of all personal information (as defined in the Privacy Act) that it collects, uses, holds or discloses, whether by itself directly or through another person, including the other Party.

26.2 Without limitation to clause 26.1 of the Agreement Terms, the Research Organisation must comply, in respect of all personal information provided to it by the Sponsor or other third parties on behalf of the Sponsor and all personal information collected, used, held or disclosed by the Research Organisation in the performance of its obligations under this Agreement (collectively Information), with the privacy policy of the Sponsor as notified to the Research Organisation by the Sponsor from time to time.

26.3 The Research Organisation must not use any of the Information for any purpose other than to perform its obligations under this Agreement and must comply with all of the Sponsor's reasonable directions in respect of that Information, provided such directions are not contrary to the Privacy Act or the Sponsor's privacy policy.

26.4 Each Party must notify the other Party immediately if it becomes aware that it has breached or may have breached any of its obligations under this clause 26 of the Agreement Terms.

27——Work health and safety

27.1 Each Party must fully comply, and ensure that its Personnel comply, with its obligations under the WHS Law when performing this Agreement, including by consulting, co-operating and co-ordinating activities with the other Party and any other person who, concurrently with the Parties, has a work health and safety duty under the WHS Law in relation to the same matter.

27.2 The Research Organisation represents and warrants that:

(a) it has given careful and prudent consideration to the work health and safety implications of the performance of the Project and its obligations under this Agreement; and

(b) the proposed method of performance of those obligations complies with, and includes, a system for proactively identifying and managing work health and safety risks in a documented fashion which complies with, WHS Law.

27.3 Without limiting the Research Organisation’s obligations under this Agreement or at law, the Research Organisation must:
(a) ensure, so far as is practicable, the health and safety of Sponsor Personnel and Research Organisation Personnel any other person who may be put at risk from work that the Research Organisation carries out under this Agreement;

(b) provide to the Sponsor within ten days of a request by the Sponsor (or such longer period agreed by the Parties) any information or copies of documentation held by the Research Organisation or its Personnel to enable the Sponsor to comply with its obligations under the WHS Law in relation to this Agreement;

(c) provide to the Sponsor within ten days of a request by the Sponsor (or such longer period agreed by the Parties) written assurances specifying, and the documents supporting, that:

(i) to the best of the Research Organisation’s knowledge it and its Personnel are compliant with WHS Law; and

(ii) the Research Organisation has made all reasonable enquiries before providing the assurances in clause 27.3(c)(i) of the Agreement Terms;

(d) promptly provide to the Sponsor copies of any formal notices or written communications issued to the Research Organisation by a regulator or agent of a regulator under or in compliance with the WHS Law relating to the Project or this Agreement, and any document prepared by the Research Organisation in response to any such notice or communication;

(e) immediately report to the Sponsor any notifiable or reportable incident under the WHS Law relating to the Project or this Agreement, and provide the Sponsor with a copy of the notice provided to the relevant regulator as a result of the notifiable or reportable incident; and

(f) provide to the Sponsor such other information as may be required by the Sponsor to satisfy its obligations under WHS Law.

27.4 If Research Organisation Personnel are required to be physically located at the Sponsor’s premises for the purposes of the Project or this Agreement (including Sponsor premises licensed to the Research Organisation, but excluding Sponsor premises managed by the Research Organisation) the Sponsor must manage the physical work environment and facilities in which those persons are required to work, in accordance with WHS Law.

28.15 Conflict of interest

28.15.1 Each Party warrants that at the Commencement Date, to the best of its knowledge and after making diligent inquiry, no Conflict of Interest exists or is likely to arise in the performance of its obligations under this Agreement.

28.15.2 If, during the Term, a Conflict of Interest arises or appears likely to arise in respect of a Research Organisation, the Research Organisation must:
(a) immediately notify the Sponsor in writing of all relevant information relating to the Conflict of Interest, and the steps that it proposes to take to resolve or otherwise deal with the Conflict of Interest; and

(b) promptly take any and all steps that the Sponsor reasonably requires to resolve or otherwise deal with the Conflict of Interest.

If the Research Organisation fails to notify the Sponsor that a Conflict of Interest has arisen or appears likely to arise in accordance with clause 28.2 of these Agreement Terms, or is unable or unwilling to resolve or deal with the Conflict of Interest as required in accordance with clause 28.2 of these Agreement Terms, the Sponsor may terminate this Agreement for breach of a material term in accordance with clause 35(b) of these Agreement Terms.

**2916 Notices**

**Obligation for notices**

Each notice under this Agreement must be:

(a) in writing;

(b) addressed to the recipient at the Representative's address; and

(c) left at, or sent by pre-paid post, facsimile or email to, that address.

**Deemed receipt**

Notices given in accordance with clause 29.1 of these Agreement Terms will be deemed to have been received:

(a) if delivered by hand, on the day of delivery (or the next Business Day if the day of delivery is not a Business Day);

(b) if sent by post, five Business Days after being sent;

(c) if sent by facsimile, on the day of transmission provided that no error report is received in respect of the transmission (or on the next Business Day if the day of transmission is not a Business Day); or

(d) if sent by email, when the sender receives a confirmation of receipt from the intended recipient's computer demonstrating that the email has been received.

**3017 Force Majeure Events**

Where, by reason of a Force Majeure Event, a Party is delayed in performing, or is unable, wholly or in part, to perform, any obligation under this Agreement, and that Party:

(a) gives the other Party prompt, written notice of that Force Majeure Event including reasonable particulars, and, in so far as known, the probable extent to which it will be unable to perform, or be delayed in performing that obligation; and
(b) uses reasonable endeavours to remove, or mitigate the effects of, that Force Majeure Event as quickly as possible,

that obligation is suspended so far as it is affected by the Force Majeure Event during the continuance of that Force Majeure Event and that Party will be allowed a reasonable extension of time to perform its obligations.

30.217.2 If, after 30 days, a Force Majeure Event has not ceased, the Parties must meet in good faith to discuss the situation and endeavour to achieve a mutually satisfactory resolution to the problem.

31 Withholding tax

31.1 [Note: The parties should seek their own advice on the tax implications of entering this Agreement and the appropriateness of the following clause to their particular circumstances.] If a Party is required by law to make a deduction or withholding from an amount payable to the other Party under or in connection with this Agreement, whether for tax or otherwise, it must do the following:

(a) notify the other Party as soon as reasonably practicable that it is required to make the deduction or withholding;

(b) promptly make the deduction or withholding and pay the amount in the manner required to the authority entitled to receive it; and

(c) if requested by the other Party, as soon as reasonably practicable, deliver evidence satisfactory to the other Party that the payment has been made.

32 Goods and services tax

32.18.1 For the purposes of this clause 32 of these Agreement Terms:

(a) unless otherwise stated, terms that have a defined meaning in the A New Tax System (Goods and Services Tax) Act 1999 (Cth) (GST Act) have the same meaning as in the GST Act;

(b) in addition to its meaning in the GST Act, the term GST includes any notional liability to pay GST;

(c) the term consideration takes its ordinary meaning, rather than its defined meaning in the GST Act; and

(d) if a supply is treated as a periodic or progressive supply under the GST Act, each periodic or progressive component of the supply will be treated as if it is a separate supply.

32.18.2 Unless otherwise stated, all consideration to be paid or provided under or in connection with this Agreement is expressed exclusive of GST.

32.18.3 If GST applies to a supply made under or in connection with this Agreement, for consideration that is not stated to include GST, the recipient must pay to the supplier an
additional amount equal to the GST payable on the supply (GST Amount). The GST Amount is payable at the same time that the first part of the consideration for the supply is to be provided. However, this clause 32.3 of these Agreement Terms will not apply if the GST on the supply is reverse charged and payable by the recipient.

32.418.4 Notwithstanding any other provision, the recipient need not pay the GST Amount until it has received from the supplier a tax invoice or adjustment note (as the case may be).

32.518.5 If an adjustment event arises in respect of a supply to which clause 32.3 of these Agreement Terms applies, the GST Amount must be adjusted to reflect the adjustment event and a payment must be made by the supplier to the recipient, or by the recipient to the supplier, as the case may be.

32.618.6 If a Party is entitled to be reimbursed or indemnified for a cost or expense under or in connection with this Agreement, the amount to be reimbursed must be reduced to the extent that the Party (or the representative member for a GST group of which that Party is a member) is entitled to an input tax credit for the cost or expense.

32.718.7 Unless otherwise stated, if an amount payable under or in connection with this Agreement is to be calculated by reference to:

(a) the consideration to be received for a supply; or

(b) the consideration to be provided for an acquisition;

then, for the purposes of that calculation, the consideration is to be reduced to the extent that it includes any amount on account of GST (regardless of whether the amount is separately identified or included as part of the consideration).

32.818.8 This clause 32 will survive the termination or expiry of this Agreement.

Variations

33.119.1 Neither Party may vary this Agreement, including the scope of the Project, without the prior, written agreement of the other Party.

33.2 The Sponsor is not liable to pay for work undertaken or expenditure incurred by the Research Organisation as a result of a variation to this Agreement or the Project, except if it has occurred in accordance with clause 33.1 of the Agreement Terms.

Dispute resolution

34.120.1 A Party claiming that a dispute has arisen must give the other Party a notice of the dispute, providing details.

34.220.2 The Sponsor and the Research Organisation, represented by their respective directors or chief executive officers or equivalent Personnel, must promptly and in good faith attempt to resolve any dispute referred to in clause 34.1 of these Agreement Terms.
34.20.3 If a dispute is not resolved by the respective directors or chief executive officers or equivalent Personnel of the Parties within 20 Business Days of the date of the notice referred to in clause 34.1 of the Agreement Terms, then the Parties must comply with clause section 16 of the Agreement Details before commencing proceedings in a court or tribunal.

34.20.4 This clause 34 of the Agreement Terms and clause section 16 of the Agreement Details do not preclude either the Sponsor or the Research Organisation from seeking urgent interlocutory relief in a court.

3521 Termination and expiry

35.21.1 Without limiting any other right of termination that the Parties may have under law or equity, this Agreement may be terminated:

(a) at any time by the mutual written agreement of the Parties;

(b) immediately by a Party giving notice in writing, if the other Party experiences an Insolvency Event or breaches a material term of this Agreement which breach cannot be remedied;

(c) by a Party if the other Party has reached a limit of liability described in clause 24 of these Agreement Terms; or

(d) by a Party (First Party) if a breach of this Agreement occurs by the other Party (Breaching Party) and the Breaching Party fails to remedy that breach within 20 Business Days after the date on which the First Party notified it of that breach.

35.21.2 Termination of this Agreement by a Party does not limit or affect any right of action or remedy which has accrued to that Party.

3622 General provisions

Survival of obligations

36.22.1 The termination or expiry of this Agreement for any reason will not extinguish the obligations of the Parties which, either expressly or by their nature, are intended to survive termination or expiry, including those clauses concerning perpetual rights in Intellectual Property and Confidential Information.

Governing law

36.22.2 This Agreement will be governed by and construed in accordance with the laws of the Governing Jurisdiction. Each Party submits to the non-exclusive jurisdiction of the courts of the Governing Jurisdiction in connection with matters concerning this Agreement.

Entire agreement

36.22.3 This Agreement constitutes the entire agreement between the Parties and supersedes all prior communications, negotiations, arrangements and agreements, whether oral or written, with respect to the subject matter of this Agreement.
Assignment

Neither Party may assign the benefit of, or its rights under, this Agreement, including rights to Project IP, without the prior written consent of the other Party, which consent must not be unreasonably withheld.

Clause 25 Severance

Any provision of this Agreement that is held void by a court, or is or becomes at any time unlawful or unenforceable, will, to the extent to which it is void, unlawful or unenforceable, be deemed to be excluded from this Agreement without affecting the validity or enforceability of the remaining provisions.

Waiver

No failure to exercise, or any delay in exercising, any right, power or remedy by a Party operates as a waiver of that right, power or remedy.

Relationship

The relationship between the parties is that of independent contractors. Unless expressly stated otherwise, the parties are not partners, joint venturers or principal and agent.

Neither the Sponsor nor the Research Organisation may make representations on behalf of the other Party.

Further assurances

Each Party agrees to do all things and sign all documents necessary or desirable to give full effect to the provisions of this Agreement and the transactions contemplated in this Agreement.

Costs

Each Party must bear its own costs arising out of the negotiation, preparation and execution of this Agreement.

Counterparts

This Agreement may be executed in any number of counterparts. All counterparts when exchanged will be taken to constitute one document.

Inconsistency

If there is any inconsistency in relation to the documents which comprise this Agreement, it will be resolved in the following descending order of precedence:

(a) Part 2 – the Agreement Details;

(b) Part 3 – the Project Details;

(c) Part 1 – the Agreement Terms; and
(d) any other documents incorporated by reference.
Part 2 – Agreement Details

1 Sponsor

[Insert the full legal name, ACN/ABN and registered address of the Sponsor.]

2 Research Organisation

[Insert the full legal name, ACN/ABN and registered address of the Research Organisation.]

3 Project

[Insert Project title.]

4 Background

[Insert any relevant background information on how / why the project is occurring. Do not include any obligations here.]

5 Objectives

[Insert the objectives of the Parties in undertaking the Project, if desired. Otherwise, state "Not applicable."]

6 Commencement Date (clause 4 of the Agreement Terms)

[Option A: If the parties have agreed that this Agreement will commence on a particular date, insert that date. Otherwise, if the commencement date is not known, choose Option B.]

OR

[Option B: insert "This Agreement commences on the date when the last Party to sign this Agreement signs this Agreement."]

7 Term (clause 4 of the Agreement Terms)

This Agreement commences on the Commencement Date and ends on:

[Option A: If the parties have agreed that this Agreement will end on a particular date, insert that date. Otherwise, if the end date is not known, choose Option B or Option C.]

OR

[Option B: insert "the first date on which all the parties' obligations set out in the Project Details have been performed under this Agreement."]
OR

[Option CB: insert 'a date to be agreed by the parties in writing.]

unless terminated earlier in accordance with the provisions of this Agreement.

8 Sponsor’s Representative (clause 6 of the Agreement Terms)

[Insert name, title and contact details of the Sponsor’s Representative i.e. the key person responsible for managing this Agreement for the Sponsor.]

9 Research Organisation's Representative (clause 6 of the Agreement Terms)

[Insert name, title and contact details of the Research Organisation's Representative i.e. the key person responsible for managing this Agreement for the Research Organisation]

10 Insurance (clause 22 of the Agreement Terms)

[Insert insurance requirements (including $ amounts) for each Party. Consider whether public liability, professional indemnity, products liability or other insurances are relevant. Ensure that the details include whether the amounts are per claim or in aggregate (i.e. total). If any insurance must be maintained after the Term, ensure this is specified.]

11 Liability option (clause 23 of the Agreement Terms)

[Insert whether Option A, B or C has been chosen. If no Option is selected, Option A applies.]

12 Limitation of liability (clause 24 of the Agreement Terms)

[If the Parties have agreed to cap their liability under this Agreement, insert the amount of the cap or caps here. For example, 'The maximum liability of each Party is capped at $20 million'. The amount of the cap should be based on the Parties’ risk assessments.]

13 Warranties (clause 25 of the Agreement Terms)

[Insert any additional warranties required by either Party.]

14 Sponsor’s address for notices (clause 29 of the Agreement Terms)

[Insert details of the Sponsor’s physical address, telephone number, fax number and email address for notices.]

15 Research Organisation's address for notices (clause 29 of the Agreement Terms)

[Insert details of the Research Organisation's physical address, telephone number, fax number and email address for notices.]
Dispute resolution (clause 34 of the Agreement Terms)

[Insert Option A, B, C OR D and delete the other options.] If the process described in clause 34.2 of the Agreement Terms does not result in the resolution of the dispute:

Dispute Resolution Option A - Non-specific
The Parties may, but are not required to, refer the dispute for alternative dispute resolution.

Dispute Resolution Option B - Mediation
The Parties must appoint a mediator to mediate in relation to the dispute and participate in mediation in accordance with The Institute of Arbitrators and Mediators Australia Mediation Rules.

Dispute Resolution Option C - Expert Determination
The Parties must refer the dispute to an expert for determination in accordance with The Institute of Arbitrators and Mediators Australia Expert Determination Rules.

Dispute Resolution Option D - Arbitration
The Parties must refer the dispute to arbitration in accordance with The Institute of Arbitrators and Mediators Australia Fast Track Arbitration Rules.

If the value of the dispute is less than $50,000, arbitration must take place using the submission of documents alone.

Governing Jurisdiction (clause 36.2 of the Agreement Terms)

This Agreement is governed by the laws of:

[Insert an Australian State or Territory (e.g. New South Wales). This should generally be the location in which the research will primarily be performed. If no State or Territory is specified, the laws of New South Wales will apply.]

Special Conditions

[Insert any additional terms agreed by the Parties (or these can be added to Part 3 – Project Details if more appropriate).]
Part 3 – Project Details

[Note: this Attachment can be substituted with a document in a different format and structure if preferred by the Parties.]

1 Project details

[Insert any the details of the Project not included elsewhere in this Agreement, such as a description of potential outcomes, definitions for any additional defined terms used in this Part, etc.]

2 Schedule of work and role of each Party

The Parties must complete the following activities:

[Insert details of work to be performed, including which Party will perform it, the methodology to be used, the location of the activity, etc.]

<table>
<thead>
<tr>
<th>No</th>
<th>Description</th>
<th>Responsible Party</th>
<th>Due date</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>2</td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

3 Deliverables (clauses 5.2(g) and 12.2 of the Agreement Terms)

The Research Organisation must create and deliver the following:

[Insert details of Deliverables, including which Party will own the Deliverable, if applicable. Examples of Deliverables that may be listed are property including samples and prototypes, information including conclusions, techniques, know-how, methods, raw data and undocumented findings, documentation of all kinds or other material in whatever form and the subject matter of any category of Intellectual Property rights. The IP Register, including updates, should be included in this list, unless it will not be applicable for the Project. Project Plans and reports are also Deliverables.]

<table>
<thead>
<tr>
<th>No</th>
<th>Description</th>
<th>Owner (if applicable)</th>
<th>Due date</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>The reports specified in clause section 15 of these Project Details.</td>
<td>[insert]</td>
<td>As specified in clause section 15 of these Project Details.</td>
</tr>
<tr>
<td>2</td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>
4 Key Persons (clause 7 of the Agreement Terms)

<table>
<thead>
<tr>
<th>No</th>
<th>Name of person</th>
<th>Position and Party</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>[insert]</td>
<td>Principal Investigator, Research Organisation</td>
</tr>
<tr>
<td>2</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

5 Student and volunteer involvement (clause 8 of the Agreement Terms)

The Parties have agreed that the following students/volunteers may assist the Research Organisation with the Project as part of the Research Organisation Personnel:

[Insert details of students/volunteer, including the work that they may perform.]

<table>
<thead>
<tr>
<th>No</th>
<th>Name</th>
<th>Work to be performed</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td></td>
<td></td>
</tr>
<tr>
<td>2</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

6 Background IP and Third Party IP (clause 13 of the Agreement Terms)

6.1 Unless the Parties have agreed otherwise in writing, the Recipient Party is granted by the Contributing Party a non-exclusive, perpetual, irrevocable, worldwide, royalty-free and licence fee free licence to Use the Contributing Party's Background IP and Third Party IP for:

(a) carrying out the Project;

(b) [Option: Internal Purposes]; and

(c) [Option: insert any other purposes];

and for all other purposes permitted by this Agreement.

7 Ownership of Project IP (clause 14 of the Agreement Terms)

Ownership

7.1 The owner of Project IP is:

(a) if the table below provides that a Party will own particular Project IP, then that Party in respect of that particular Project IP upon its creation; and
(b) for all other Project IP, upon its creation: [insert only one option from the options below and delete all other options. Option C should only be selected if the Parties are willing to manage the Project IP together for the long term and accept the risk that this may result in additional resourcing and expense and increase the potential for disputes to arise.]

[Option A] the Sponsor;

[Option B] the Research Organisation; OR

[Option C] both parties as tenants in common in the following proportions: [insert percentage proportions for the Parties (e.g. 50% Sponsor/50% Research Institution)]. [Note: The agreed percentage is often based on the respective financial and In-kind Contributions made by the Parties.]

<table>
<thead>
<tr>
<th>No</th>
<th>Details of Project IP/Material comprising Project IP</th>
<th>Owner</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>If applicable, insert details of particular Project IP that will be owned by one Party. For example, this could be IP in a particular Deliverable, such as a report, database, etc.</td>
<td>[Insert either 'Sponsor' OR 'Research Organisation']</td>
</tr>
<tr>
<td>2</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

8 Use of Project IP (clause 15 of the Agreement Terms)

[Note: If the Owning Party wishes to vary the licensed rights granted to the other Party from those set out in clause 15 of the Agreement Terms, it should specify those rights here. Otherwise this clause should be marked 'not used'.]

9 Protection of Project IP

Protection of Project IP (other than co-owned Project IP)

9.1 Clauses 9.2 – 9.6 of the Project Details apply only in respect of Project IP that is not co-owned by the Parties.

9.2 The Owning Party may choose whether or not to pursue registration or other protection in respect of its Project IP in its own name and at its own expense, [Note: The remainder of this clause provides an optional obligation which is appropriate if the other Party’s rights may be affected by the Owning Party registering or protecting Project IP] but must first consult with the other Party.

9.3 Each Party must take all reasonable steps to protect the Project IP and must give the other Party prompt written notice of any actual or potential claims concerning infringement of Project IP which comes to their attention.
9.4 The other Party must give the Owning Party all assistance which it reasonably requests in order to protect the Owning Party's Project IP, at the Owning Party's expense.

Protection of Co-owned Project IP

[Include the following clauses only if Option C has been selected in clause 7.1(b) of the Project Details above or the table in clause 7.1 of the Project Details provides for co-ownership (sometimes referred to as 'joint' ownership) of the Project IP by both Parties.]

9.5 [Note: The following clauses provide that the Parties must agree various obligations in writing. There is a risk that such agreement will not be able to be reached at the relevant time. To minimise this risk, the Parties may wish to enter into a separate Commercialisation agreement or Commercialisation strategy which addresses these issues prior to commencing any Commercialisation.]

In respect of all Project IP which is co-owned, the Parties must:

(a) agree in writing to obtain registration or protection for that Project IP;
(b) agree in writing any action required to defend or enforce their rights in that Project IP;
(c) agree in writing which of them will be responsible for implementing the chosen method of registration, protection, defence or enforcement; and
(d) unless agreed otherwise in writing, share the cost of registering, protecting, defending or enforcing that Project IP in proportion to their percentage of ownership of the Project IP.

9.6 If one Party does not wish to, or is unable to, pay its share of the costs of the registration, protection, defence or enforcement of the co-owned Project IP, the other Party may pay the costs of the registration, protection, defence or enforcement at its absolute discretion. The Party paying such costs will be entitled to recoup these costs from the proceeds of any Commercialisation of such Project IP prior to the proceeds being distributed.

10 Commercialisation of Project IP

Right to Commercialise

[Insert one of the following options and delete the other options. Note: Options A and B are only intended for use if the Project IP is not co-owned.]

Option A - Owning Party has exclusive right to Commercialise Project IP

10.1 The Owning Party is the only Party that may Commercialise Project IP and may Commercialise the Project IP in accordance with the terms of this Agreement.

Option B - Owning Party has first right to Commercialise Project IP

10.2 The Owning Party has the first right to Commercialise the Project IP and may Commercialise the Project IP in accordance with the terms of this Agreement.
10.3 If the Owning Party has not commenced Commercialising its Project IP within a period of [insert years - e.g. 5 years from the end of the Term], the other Party may request a licence to Commercialise that Project IP on reasonable commercial terms, and the Owning Party must negotiate the terms of that licence in good faith.

**Option C - Either Party may Commercialise Project IP**

[Note: this option is generally used for co-owned Project IP only.]

10.4 Either Party may Commercialise the Project IP in accordance with the terms of this Agreement.

**Option D - Commercialisation agreement/strategy**

[Note: this option is generally used only if the Parties choose to agree the Commercialisation details at a later date. This option results in a risk that the parties may not be able to agree the terms at a later date.]

10.5 A Party may only Commercialise Project IP in accordance with a Commercialisation agreement or Commercialisation strategy agreed by the Parties in writing.

**Commercialisation conditions**

10.6 The following conditions apply to any Party which Commercialises Project IP:

[Insert any conditions which apply if a Party wishes to Commercialise Project IP OR insert 'nil'. Examples of conditions include that:

(a) the Commercialising Party must notify the other party or consult with the other Party in relation to the proposed Commercialisation strategy; or

(b) the other Party must provide its prior, written consent to the terms and conditions of any agreements entered into by the Commercialising Party for the purposes of Commercialising Project IP;

(c) Commercialisation may only occur in accordance with a Commercialisation agreement or Commercialisation strategy agreed by the Parties in writing; and/or

(d) the Commercialising Party must pay to the other Party a fee - of a specified amount, or on reasonable commercial terms as agreed by the Parties in writing.]

**Commercialisation of co-owned Project IP**

[Note: If co-ownership of Project IP will occur (i.e. Option C has been selected in clause 7.1(b) of the Project Details above or the table in clause 7.1 of the Project Details provides for co-ownership of the Project IP by both Parties) then the Parties must agree how the income will be apportioned - e.g. will each party be entitled to keep its own income or will the Parties share the net income derived from the Commercialisation of co-owned Project IP in proportion to their percentage of ownership of the Project IP? If the income is shared, then generally each Party will be entitled to recoup costs of registration/protection/Commercialisation as a first charge from the proceeds of Commercialisation. If so, this should be stated.]
Commercialisation payment for Background IP

[Insert one of the following options and delete the other option.]

Option A - terms to be agreed

10.7 If a licence to Commercialise a Contributing Party's Background IP in conjunction with, or as part of, Commercialising Project IP, is requested by the other Party, both Parties must negotiate in good faith to agree the reasonable commercial terms of that licence.

Option B - terms agreed

10.8 If a Recipient Party is permitted by this Agreement to Commercialise Project IP it may Use the Contributing Party's Background IP for the purposes of Commercialising Project IP. [Note: if nil fees or royalties are payable, delete the remainder of this clause] but must pay the Contributing Party: [insert details of royalty or licence fee, including when and how it is payable.]

Reasonable commercial terms

10.9 Any reference in this clause 10 of the Project Details to reasonable commercial terms requires regard to be given both to the value of the applicable Intellectual Property and the respective contributions of the Parties to the Project.

11 IP Register (clause 17 of the Agreement Terms)

11.1 [An IP Register is likely to be required unless no Commercialisation will occur and the Project will not result in any substantial Project IP.] An IP Register [insert 'must be kept' OR 'may not be kept'] by the Research Organisation.

128 Moral Rights (clause 18 of the Agreement Terms)

[The following optional clause may be inserted if the Parties have agreed that Moral Rights consents are required.]

12.18.1 The Research Organisation must:

(a) use its best endeavours to obtain from its officers, employees, contractors, agents, students and volunteers, and

(b) require its sub-contractors to use their best endeavours to obtain from their officers, employees, contractors, agents, students and volunteers, who, in the performance of the Project, are or may be engaged in the creation of Material in which copyright subsists, a genuine consent in writing to the use of that Material for the purposes contemplated by this Agreement, even if such use would otherwise be an infringement of their Moral Rights.
12.28.2 If the Research Organisation or any of its sub-contractors are unable to obtain a consent described in clause section 12.1, the Research Organisation must promptly notify the Sponsor in writing.

13 Confidential Information (clause 19 of the Agreement Terms)

13.1 [Due to the operation of clause 19 of the Agreement Terms, Confidential Information can be disclosed in a number of circumstances, including if disclosure is necessary to exercise Intellectual Property rights, such as patenting or Commercialising Project IP. Therefore, including information in this table will not prevent all disclosures. Sometimes patenting may not be the best choice to protect Project IP as it necessitates the disclosure of Confidential Information.] The following is Confidential Information as at the Commencement Date:

<table>
<thead>
<tr>
<th>No</th>
<th>Description</th>
<th>Party</th>
<th>Period of confidentiality</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>[Insert description e.g. Budget amount, names of Personnel, etc.]</td>
<td>[Insert the name of the Party that has provided the information – either ‘Sponsor’ or ‘Research Organisation’]</td>
<td>[insert period of time]</td>
</tr>
<tr>
<td>2</td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

149 Publication (clause 20 of the Agreement Terms)

[Note: Research Organisations which are universities or similar institutions may have responsibilities to broadly disseminate teaching or research outcomes. The outcomes of publicly-funded research, in particular, should generally be made available to the public. However, the Parties must be mindful that disclosure of certain information may adversely affect the ability to patent Project IP or otherwise Commercialise Project IP and may result in the disclosure of Confidential Information. Publication may also be prevented by Third Party IP rights in Material. Therefore, publication must be considered and managed carefully by the Parties. The following optional clause may be included to permit publication of research outcomes.]

14.19.1 The Parties agree that the Research Organisation may publish the following Material:

[insert a description of the Material that the Research Organisation may publish (e.g. list particular Project research outcomes or Deliverables OR 'all Project research outcomes and Deliverables' OR 'all Material comprising Project IP owned by the Research Organisation', etc). The Parties must check that rights in Third Party IP will not prevent publication before completing this clause and exercising these rights.]

subject to the following conditions:

[insert conditions or insert 'nil'. Conditions may include, for example: that publication may only occur in a particular journal; that prior written approval by the Sponsor of the publication is required on a case-by-case basis; that publication may not occur until after an

Comment [JN15]: It is unlikely the parties will know this when signing the contract. Suggest instead inserting a procedure for obtaining consent.
application for registration of Project IP has been made; or that publication may not occur until after a particular date (e.g. 3 years after the end of the Term).

### 15 Reporting (clause 5.3(g) of the Agreement Terms)

<table>
<thead>
<tr>
<th>No</th>
<th>Report</th>
<th>Requirements</th>
<th>Due-date</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>[Insert title or description e.g. progress report, final report, etc]</td>
<td>[Insert any particular requirements regarding format, content, delivery address, etc]</td>
<td>[Insert]</td>
</tr>
<tr>
<td>2</td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

### 1610 Budget (clause 21.3 of the Agreement Terms)

<table>
<thead>
<tr>
<th>No</th>
<th>Expenditure</th>
<th>20--/20--</th>
<th>20--/20--</th>
<th>Total</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>Salaries</td>
<td>[Insert]</td>
<td>[Insert]</td>
<td>[Insert]</td>
</tr>
<tr>
<td>2</td>
<td>Travel</td>
<td>[Insert]</td>
<td>[Insert]</td>
<td>[Insert]</td>
</tr>
<tr>
<td>3</td>
<td>Operating</td>
<td>[Insert]</td>
<td>[Insert]</td>
<td>[Insert]</td>
</tr>
<tr>
<td>4</td>
<td>Capital</td>
<td>[Insert]</td>
<td>[Insert]</td>
<td>[Insert]</td>
</tr>
<tr>
<td>5</td>
<td>[Insert other]</td>
<td>[Insert]</td>
<td>[Insert]</td>
<td>[Insert]</td>
</tr>
<tr>
<td>TOTAL</td>
<td></td>
<td></td>
<td></td>
<td>[Insert]</td>
</tr>
</tbody>
</table>

Note: This table contains the total Budget for the Project and will only be varied in accordance with clause 33 of the Agreement Terms.

### 1711 Payments (clause 21 of the Agreement Terms)

The planned schedule for, and dates for making, payments are as set out in the following table.

<table>
<thead>
<tr>
<th>Milestone</th>
<th>Milestone Achievement Criteria</th>
<th>Milestone Payment Amount</th>
<th>Milestone Due Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>MS [#]</td>
<td>[Insert - e.g. Execution of this Agreement]</td>
<td>$[amount]</td>
<td>[insert]</td>
</tr>
<tr>
<td>MS [#]</td>
<td>[Insert - e.g. Acceptance by Sponsor of Project Plan]</td>
<td>$[amount]</td>
<td>[insert]</td>
</tr>
<tr>
<td>Total</td>
<td></td>
<td>$[amount]</td>
<td></td>
</tr>
</tbody>
</table>
18 In-kind Contributions (clauses 5.2(a) and 5.3(f) of the Agreement Terms)

The Parties must provide the following In-kind Contributions:

Sponsor:

<table>
<thead>
<tr>
<th>In-kind Contribution</th>
<th>Due date</th>
<th>Agreed value ($)</th>
</tr>
</thead>
<tbody>
<tr>
<td>[insert details e.g. description of facilities, equipment model numbers, etc.]</td>
<td>[insert]</td>
<td>[insert]</td>
</tr>
</tbody>
</table>

Total Sponsor In-kind Contribution

Research Organisation:

<table>
<thead>
<tr>
<th>In-kind Contribution</th>
<th>Due date</th>
<th>Agreed value ($)</th>
</tr>
</thead>
<tbody>
<tr>
<td>[insert details e.g. description of resources, description of facilities, Loaned Equipment model numbers, etc.]</td>
<td>[insert]</td>
<td>[insert]</td>
</tr>
</tbody>
</table>

Total Research Organisation In-kind Contribution

19 Equipment (clause 11 of the Agreement Terms)

The [insert either Sponsor OR Research Organisation] will own the Project Equipment.

The Loaned Equipment and Project Equipment are subject to the following conditions:

**Loaned Equipment:**

<table>
<thead>
<tr>
<th>Description</th>
<th>Conditions</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>[insert]</td>
</tr>
<tr>
<td>2</td>
<td>[insert]</td>
</tr>
</tbody>
</table>

**Project Equipment:**

<table>
<thead>
<tr>
<th>Description</th>
<th>Conditions</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>[insert]</td>
</tr>
<tr>
<td>2</td>
<td>[insert]</td>
</tr>
</tbody>
</table>

[Note: The Parties must specify in the table above if Project Equipment owned by the Sponsor will be purchased by the Research Organisation as an agent for the Sponsor. This can affect which Party claims the input tax credit.]
2013 Special Conditions

[Insert any Special Conditions that have not been included elsewhere in this Agreement. For example, these may include particular requirements concerning the maintenance of laboratory books and security, work health and safety or access requirements for facilities.]
EXECUTED AS AN AGREEMENT

[SIGNED] for and on behalf of [insert Sponsor name]

by:

................................................
(signature)

................................................
(name and position)

................................................
(signature)

................................................
(name and position)

[SIGNED] for and on behalf of [insert Research Organisation name]

by:

................................................
(signature)

................................................
(name and position)
**PART 4 – ATTACHMENT A – TEMPLATE IP REGISTER**

**NOTE:**

REFER TO CLAUSE 17 OF THE AGREEMENT TERMS.

BIP = BACKGROUND IP

PIP = PROJECT IP

TPIP = THIRD PARTY IP

---

<table>
<thead>
<tr>
<th>NO.</th>
<th>TITL E</th>
<th>DESCRIPTION</th>
<th>TYPE OF IP (E.G. BIP, PIP, TPIP)</th>
<th>OWN ER</th>
<th>IF BIP OR TPIP, HOW WILL IP BE USED IN PROJECT?</th>
<th>FOR BIP OR TPIP, DATE CONTRIBUTED</th>
<th>FOR FIP, DATE CREATED</th>
<th>IS IP REGISTERED? (IF YES, PROVIDE DETAILS)</th>
<th>RESTRICTIONS ON USE OF IP (E.G. LICENCE CONDITIONS, ENCUMBRANCES, FEES, ETC)</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td><strong>ABC DATABASE</strong></td>
<td><strong>DATABASE CONTAINING DETAILS OF […]</strong></td>
<td>BACK GROUND</td>
<td>SPON SOR</td>
<td>FOR RESEARCH ORGANISATION TO DEVELOP A</td>
<td><strong>01 OCT 2014</strong></td>
<td><strong>NO</strong></td>
<td><strong>NO</strong></td>
<td>LICENSED FOR THE TERM AND ONLY FOR THE</td>
</tr>
</tbody>
</table>
METHODOLOGY AS DESCRIBED IN MILESTONE 1 OF THE PROJECT DETAILS.

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