This Intellectual Property Management was developed with the assistance of the industry cooperative innovation program (iciip) administered by AusIndustry to create an intellectual property handbook focusing on the electrical and electronics industry in fulfillment of the aims of the 'Electronics Industry Action Agenda'.

AusIndustry is the Australian Government's business programme delivery division in the Department of Industry, Tourism and Resources offering a range of more than 35 programmes, including innovation grants, tax and duty concessions, small-business skills development, industry support and venture capital. The Australian Government is committed to supporting the innovations of Australian businesses to encourage more business investment and improve Australia's international competitiveness.

The Australian Electrical and Electronic Manufacturers' Association (AEEMA) is the peak industry association representing local and international companies in the electronics, information and communication technologies (ICT) and electrical manufacturing industries.

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INTELLECTUAL PROPERTY MANAGEMENT
A PRACTICAL GUIDE FOR ELECTRICAL AND ELECTRONICS RELATED INDUSTRIES
CONTENTS

FOREWORD.............................................................................................................x

ACKNOWLEDGEMENTS.........................................................................................xii

CHAPTER 1. WHY IS INTELLECTUAL PROPERTY IMPORTANT TO YOUR ORGANISATION?...........................................................................................................2
The Importance of Intellectual Property ..............................................................3
Management of Intellectual Property .................................................................4

CHAPTER 2. WHAT EVERYONE SHOULD KNOW...................................................7
What this Chapter covers .......................................................................................9
What is Intellectual Property?................................................................................9
Forms of intellectual property .........................................................................10
Patents .....................................................................................................................12
What is a patent?.................................................................................................12
What can be protected by a patent?......................................................................12
Required elements for patent grant ....................................................................12
Other application requirements ..........................................................................14
Do I need to apply for protection?.........................................................................15
Characteristics of a standard patent and an innovation patent.......................17
What rights will I receive for a patent?.................................................................17
When would I infringe a patent?...........................................................................18
Copyright ...............................................................................................................18
What is copyright?................................................................................................18
What can be protected by copyright?...................................................................18
Do I need to apply for protection?........................................................................19
What rights will I receive for copyright?.............................................................19
Economic rights ....................................................................................................19
Moral rights ............................................................................................................20
Performers' rights .................................................................................................21
When would I infringe copyright? .................................................................21
Exceptions to copyright infringement ..................................................................22
Registered Designs ................................................................................................23
What is a registered design?................................................................................23
What can be protected as a registered design?......................................................24
Do I need to apply for protection?........................................................................25
What rights will I receive for a registered design?.............................................25
When would I infringe a registered design?.......................................................26

**Circuit Layout Protection**..................................................................................26
What is a circuit layout?..........................................................................................26
What can be protected by circuit layout rights?....................................................26
Do I need to apply for protection?.........................................................................27
What rights will I receive for circuit layout protection?........................................27
When would I infringe circuit layout rights?..........................................................27
Exceptions to circuit layout infringement...............................................................27

**Confidential Information**................................................................................28
What is confidential information?.........................................................................28
What can be protected as confidential information?...........................................28
Do I need to apply for protection?.........................................................................28
What rights will I receive for confidential information?.......................................29
When will I breach confidentiality?......................................................................29

**Trade Marks**..................................................................................................29
What is a trade mark?.............................................................................................29
What can be protected as a trade mark?...............................................................30
Do I need to apply for protection?.........................................................................30
What rights will I receive for a trade mark?..........................................................31
When would I infringe a trade mark?...................................................................31
Trade marks on the internet..................................................................................31

**Domain Names**...............................................................................................32
What is a domain name?.......................................................................................32
What can be a domain name?...............................................................................32
Do I need to apply for protection?.........................................................................32
What rights will I receive for a domain name?.......................................................32

**CHAPTER 3. WHAT THE BOARD AND CEO MUST KNOW**..........................34

**What this Chapter covers**.............................................................................35

**Developing an IP Strategy for your Organisation**...........................................35
Step 1: Identify your organisation's commercial goals.................................35
Step 2: Identify your organisation's IP rights and the competitive IP landscape........................................................................................................36
Step 3: Align your organisation's IP rights with its goals...............................37
Step 4: Formulate an IP strategy for your organisation..................................37
Developing your IP strategy from a global perspective.....................................39

**Implementing an IP Strategy**..........................................................................41
Establishing an IP management framework.......................................................41
IP management framework..................................................................................41
Stimulating creativity...........................................................................................42
Capturing creativity..............................................................................................42
Example methods to stimulate and capture creativity.......................................42

**IP and Capital Raising**..................................................................................43
Capital raising ........................................................................................................................................... 43
IP due diligence in capital raising ........................................................................................................... 43
Different capital raising options ............................................................................................................. 44
Government grant schemes ...................................................................................................................... 44
Government grant agreements .................................................................................................................. 44
Private equity ........................................................................................................................................... 48
Business angels ....................................................................................................................................... 48
Venture capitalists ................................................................................................................................... 48
Business plans ............................................................................................................................................. 50
Initial public offerings ............................................................................................................................... 50

CHAPTER 4. WHAT RESEARCHERS AND DESIGN ENGINEERS MUST KNOW........................................ 53
What this Chapter covers .......................................................................................................................... 55
Design Process Planning .......................................................................................................................... 55
Design process planning generally ......................................................................................................... 55
Elements of the Design Flow Process ....................................................................................................... 56
Why consider IP in design process planning ............................................................................................ 57
Assessing the competitive landscape ....................................................................................................... 57
Online IP databases ................................................................................................................................... 57
Searching strategies ................................................................................................................................... 59
How to read a patent specification ......................................................................................................... 60
Planning for re-use of designs .................................................................................................................... 62
Experimental use ......................................................................................................................................... 62
Re-using software ......................................................................................................................................... 63
Re-using hardware design .......................................................................................................................... 65
Re-using traded intellectual property ....................................................................................................... 66
Reducing the Risk of Infringement in Design Re-use ................................................................................. 67
Performing freedom to operate searches .................................................................................................... 67
Considering IP in your design process ...................................................................................................... 67
Step 1: Listing design components ........................................................................................................... 68
Step 2: Identifying the holder of the IP rights ............................................................................................. 69
Step 3: Seeking appropriate authorisation ................................................................................................ 71
Obtaining rights to third party IP for design re-use ..................................................................................... 74
Payment structure ....................................................................................................................................... 74
Warranties, indemnities and other contractual rights .................................................................................. 74
Conducting due diligence ............................................................................................................................ 75
Identifying Inventive Subject Matter ......................................................................................................... 75
Factors determining inventive step ............................................................................................................ 76
Preparing an invention disclosure .............................................................................................................. 77
Identifying the Inventor ............................................................................................................................... 80
Who is the inventor? ................................................................................................................................... 80
Identifying joint inventors ........................................................................................................................... 80
Managing IP in Research and Design Practices ......................................................................................... 81
Keeping laboratory notebooks and design workbooks ............................................................................... 81
IP record storage practices ......................................................................................................................... 84
Personnel practices ........................................................................................................................................ 84
Be familiar with your IP policy ......................................................................................................................... 84
Observe your confidentiality obligations ............................................................................................................ 84
Ongoing IP obligations ....................................................................................................................................... 85
Identification and protection of confidential information .................................................................................... 85
Review of public disclosures ............................................................................................................................. 85

CHAPTER 5. WHAT MANAGERS MAKING IP PROTECTION DECISIONS MUST KNOW……87
What this Chapter covers ..................................................................................................................................... 91

General Issues in Making IP Protection Decisions .......................................................................................... 91
Step 1: Identify subject matter that may need IP protection ........................................................................... 91
Step 2: Identify what forms of IP protection is available .................................................................................. 92
Step 3: Determine how to implement IP protection for the subject matter ..................................................... 92

Patents ............................................................................................................................................................... 93
Should the invention be registered? .................................................................................................................... 93
Patents vs. confidential information .................................................................................................................. 94
When to file a patent application ..................................................................................................................... 95
How to obtain the grant of a patent .................................................................................................................. 95
Patent searches .................................................................................................................................................. 95
The patent application process ......................................................................................................................... 96
Filing a patent application ................................................................................................................................... 99
Application fees .................................................................................................................................................. 100
Publication .......................................................................................................................................................... 101
Examination of standard patent applications ................................................................................................. 101
Examination of innovation patent applications ............................................................................................... 101
Opposition ......................................................................................................................................................... 101
Re-examination .................................................................................................................................................. 103
Revocation .......................................................................................................................................................... 103
Maintaining patent rights .................................................................................................................................. 103
Renewal fees ...................................................................................................................................................... 103
Use a patent notice ............................................................................................................................................. 103
Obtaining foreign protection ........................................................................................................................... 104
Paris Convention .................................................................................................................................................. 104
Patent Cooperation Treaty (PCT) ....................................................................................................................... 104

Copyright .............................................................................................................................................................. 107
How to implement copyright protection .......................................................................................................... 107
Use a copyright notice & © symbol .................................................................................................................. 107
Restricting access to source code by placing it in escrow .............................................................................. 108
Digital Rights Management & metadata ........................................................................................................... 108
Technological Prevention Measures ................................................................................................................ 109
Open source licences .......................................................................................................................................... 109
Dealing with moral rights and performers’ rights .............................................................................................. 111

Registered Designs ........................................................................................................................................ 111
Should the design be registered? ....................................................................................................................... 111
How to register a design ..................................................................................................................................... 111
Design searches .................................................................................................................................................... 111
<table>
<thead>
<tr>
<th>Section</th>
<th>Page</th>
</tr>
</thead>
<tbody>
<tr>
<td>Intellectual Property Management</td>
<td></td>
</tr>
<tr>
<td>Confidential Information</td>
<td>117</td>
</tr>
<tr>
<td>Circuit layouts</td>
<td>116</td>
</tr>
<tr>
<td>Trade Marks</td>
<td>119</td>
</tr>
<tr>
<td>Domain Names</td>
<td>128</td>
</tr>
<tr>
<td>CHAPTER 6. WHAT SENIOR MANAGEMENT MUST KNOW</td>
<td>133</td>
</tr>
<tr>
<td>What this Chapter covers</td>
<td>135</td>
</tr>
<tr>
<td>The registered design application process</td>
<td>112</td>
</tr>
<tr>
<td>Filing a registered design application</td>
<td>113</td>
</tr>
<tr>
<td>Request for registration or publication</td>
<td>114</td>
</tr>
<tr>
<td>Examination</td>
<td>114</td>
</tr>
<tr>
<td>Revocation</td>
<td>114</td>
</tr>
<tr>
<td>Maintaining registered design</td>
<td>115</td>
</tr>
<tr>
<td>Renewal fees</td>
<td>115</td>
</tr>
<tr>
<td>Use a registered design notice</td>
<td>115</td>
</tr>
<tr>
<td>Obtaining foreign protection</td>
<td>115</td>
</tr>
<tr>
<td>How to implement circuit layout protection</td>
<td>116</td>
</tr>
<tr>
<td>Use a circuit layout notice</td>
<td>116</td>
</tr>
<tr>
<td>Keep plans and masks properly</td>
<td>116</td>
</tr>
<tr>
<td>Assignment of rights</td>
<td>117</td>
</tr>
<tr>
<td>Obtaining foreign protection</td>
<td>117</td>
</tr>
<tr>
<td>Identification and protection of confidential information</td>
<td>117</td>
</tr>
<tr>
<td>Practical management of confidential information</td>
<td>117</td>
</tr>
<tr>
<td>Confidentiality agreements</td>
<td>119</td>
</tr>
<tr>
<td>Should the trade mark be registered?</td>
<td>119</td>
</tr>
<tr>
<td>Trade mark registration vs. passing off</td>
<td>119</td>
</tr>
<tr>
<td>How to register a trade mark</td>
<td>120</td>
</tr>
<tr>
<td>Selecting a trade mark</td>
<td>120</td>
</tr>
<tr>
<td>Trade mark searches</td>
<td>123</td>
</tr>
<tr>
<td>The trade mark application process</td>
<td>123</td>
</tr>
<tr>
<td>Preparing the trade mark application</td>
<td>125</td>
</tr>
<tr>
<td>Examination of the trade mark application</td>
<td>126</td>
</tr>
<tr>
<td>Opposition</td>
<td>126</td>
</tr>
<tr>
<td>Registration of the trade mark</td>
<td>127</td>
</tr>
<tr>
<td>Maintaining trade mark registration</td>
<td>127</td>
</tr>
<tr>
<td>Maintenance fees</td>
<td>127</td>
</tr>
<tr>
<td>Use the trade mark</td>
<td>127</td>
</tr>
<tr>
<td>Use the ® and ™ symbol</td>
<td>127</td>
</tr>
<tr>
<td>Avoid generic use of the trade mark</td>
<td>128</td>
</tr>
<tr>
<td>Obtaining foreign protection</td>
<td>128</td>
</tr>
<tr>
<td>Should the domain name be registered?</td>
<td>128</td>
</tr>
<tr>
<td>How to register a domain name</td>
<td>129</td>
</tr>
<tr>
<td>Selecting a domain name</td>
<td>129</td>
</tr>
<tr>
<td>Selecting a domain name registrar</td>
<td>131</td>
</tr>
<tr>
<td>Maintaining domain name registration</td>
<td>131</td>
</tr>
<tr>
<td>CHAPTER 6. WHAT SENIOR MANAGEMENT MUST KNOW</td>
<td>133</td>
</tr>
<tr>
<td>What this Chapter covers</td>
<td>135</td>
</tr>
</tbody>
</table>
CHAPTER 7. WHAT MUST BE KNOWN ABOUT IP COMMERCIALISATION ..........168
What this Chapter covers ................................................................. 169
Issues to Consider Before Undertaking IP Commercialisation ..........169
Is the IP ready for commercialisation? ........................................ 169
IP Commercialisation Structures .................................................... 171
Internal product development ....................................................... 172
Licence .......................................................................................... 172
Direct licensing to end users ......................................................... 173
End user licence agreements ......................................................... 173
Software licences ........................................................... 174
Using a distributor .............................................................. 175
Licensing commercialisation rights to third parties ...................... 176
Assignment .................................................................................... 178
Assignments vs. licences ............................................................. 178
Spin-off companies ...................................................................... 179
Using spin-off companies ........................................................... 180
Joint ventures ............................................................................. 180
Checklist for joint venture agreements ........................................ 181
Choosing a Commercialisation Partner ........................................ 182
Issues to consider ....................................................................... 182
Risks of IP Commercialisation .................................................. 183
Identifying risks .......................................................................... 183
Types of risks ............................................................................. 183
How to manage risks ................................................................... 185
Step 1: What is the likelihood of the risk event happening? ........... 185
Step 2: What will be the consequences? ....................................... 185
Risk management mechanisms ................................................... 186
IP insurance .................................................................................. 187

CHAPTER 8. WHAT MUST BE KNOWN ABOUT ENFORCING AND DEFENDING YOUR IP RIGHTS ..........190
What this Chapter covers ................................................................. 191
Issues to Consider Before Enforcing IP Rights ............................... 191
Value of the IP ........................................................................... 191
Nature of IP ................................................................................ 192
Costs ....................................................................................... 192
Risks ......................................................................................... 193
Enforcing your IP rights .............................................................. 195
Letter of demand ......................................................................... 195
Breach of contract ....................................................................... 196
Customs notice ......................................................................... 196
Litigation ..................................................................................... 197
Identifying, protecting managing and exploiting valuable intellectual property is the core element of success of any technology-based organisations. Developing this practical handbook is just a small part of the Australian Government’s commitment to enhancing the performance of such high technology organisations.

The Electronics Industry Action Agenda has been particularly effective in identifying that the process of converting useful knowledge into realised products should be the focal point for improvement if we are to be more successful in creating technology-based goods and services that Australia and the world wants and needs. It is therefore appropriate that a consortium led by the Australian Electrical and Electronic Manufacturers’ Association and including the specialist patent attorneys and lawyers of Spruson & Ferguson has been able to take advantage of the Australian Government’s Industry Cooperative Innovation Program to undertake the handbook task.

The resulting handbook highlights the centrality of intellectual property management and its exploitation in commercial success and provides practical assistance to all levels in the company or organisation. It will find relevance and value well beyond the electronics and ICT industries, including amongst other Action Agendas such as those of the Science Industry and Medical Devices.

I have pleasure in providing support for this handbook and recommend its widespread dissemination, study and implementation.

The Hon Bob Baldwin, MP
Federal Member for Paterson
Parliamentary Secretary to the Minister for Industry Tourism and Resources
ACKNOWLEDGEMENTS

Consortium Members

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WHY IS INTELLECTUAL PROPERTY IMPORTANT TO YOUR ORGANISATION?

The Importance of Intellectual Property ................................................3
Management of Intellectual Property ..................................................4
Every organisation has a reason for being. It might be a unique ability to offer a particular product or service, or it might arise from having been in the right place at the right time with a certain set of capabilities. But at its core, your organisation probably relies on intellectual property (IP) far more than you imagine.

Intellectual property is just another way of describing valuable knowledge – knowledge about the way that you do business, knowledge about the way that you make your products, your business processes, even your customer lists.

How would it affect your business if your closest competitor knew precisely how you carry out your business and had access to your internal operating procedures and customer lists? The knowledge that you have – and your competitor does not – is a source of competitive advantage and is likely to be a key factor in your success.

That knowledge is frequently the difference between organisations that succeed and those that fail. Physical assets and traditional sources of competitive advantage such as manufacturing capability or location have far less relevance. The value of many of the world’s largest companies is increasingly vested in knowledge-based, intangible assets. An economy based on these assets is often known as the ‘weightless economy’.

Some organisations recognise that innovation plays a role not just in product development but in every part of the organisation and institute formal processes to think about the generation and capture of knowledge wherever work is performed. They address each part of the business in terms of what is best practice and make commercial buy versus build decisions based on their particular corporate needs.

Given the increasing economic relevance of knowledge, it is imperative to focus on the identification of that knowledge, its value and its management.

Most people have some concept of what an ‘invention’ is, but the management of knowledge or intellectual property is far more than the patenting of inventions. It is an understanding of what intellectual property is, when intellectual property has been created, the value of the created knowledge, and of how to protect intellectual property that has value. It is the use of systematic processes to understand the intellectual property of others and to generate your own.

This last point is a critical one. Many young organisations are surprised to find how much has been ‘done before’ – usually so much that it is difficult to make a product without relying on previous work. Much of that work is protected and may not be used legally without obtaining a licence from the owner. However, knowledge of what has been done before can also refine a view of where your competitive advantage may come from and what your competitors are doing. It can provide substantial commercial opportunities. By licensing the knowledge of others and collaborating with them you can focus on your core competencies and make your investments go much further. It is preferable to be aware of the IP landscape and your competitors before investing significant resources in the development of new products.

So, how do you identify and manage intellectual property? This manual is designed to help. It provides guidance for those that are seeking to implement best practice in
intellectual property management and capture value as a result. It provides reference material and information relevant to all types of organisation. It recognises that individuals in different parts of an organisation have different roles in the protection and management of knowledge – but that at the core it is a responsibility for everyone.

Management of Intellectual Property

IP is a valuable strategic and financial asset for every organisation. Like any other resource, IP should be carefully managed. Without appropriate management, the organisation may be unaware of its IP, its value or benefits, or may expose itself to unnecessary risks.

The management of IP is an ongoing task which lasts throughout the life of the IP, until expiry. The diagram below illustrates the lifecycle of an IP asset, and the decision points you may need to consider at each stage of its life for the effective management of your IP.

This Manual provides guidance in the following Chapters on the management of IP throughout this lifecycle and for each of these decisions points, including providing information on the nature of the different forms of IP.
### Identify Existing IP and the Need for New IP
Identify the organisation's need for an IP asset and how it may be obtained.

### Record Existing and New IP
Identify and record any new IP:
- researched & developed by the organisation
- acquired through inward licensing
- acquired & developed by re-using existing designs, and/or
- acquired from third parties.

### IP Protection Decision
Identify the available forms of protection for the IP asset, and decide on the most appropriate, which may be:
- registered protection, e.g. patents, trade marks, registered designs, and/or
- unregistered protection, e.g. copyright, circuit layout, confidential information, database rights.

### Use the IP Asset
Decide on whether the IP asset will be:
- commercialised by the organisation
- used internally on an operational basis
- licensed out to the public, and/or
- offered to the public for free.

### Evaluate the IP Asset
Periodically evaluate the IP asset, and decide whether to:
- maintain the present form of IP protection for the IP asset
- vary the form of IP protection
- allow the IP rights to lapse, and/or
- further modify and develop the IP asset to enhance its strength or create new IP.
WHAT EVERYONE SHOULD KNOW

What this Chapter Covers .......................................................... 9
What is Intellectual Property? .................................................. 9
  Forms of intellectual property .............................................. 10
Patents .................................................................................. 12
  What is a patent? ................................................................. 12
  What can be protected by a patent? ...................................... 12
  Required elements for patent grant .................................... 12
  Other application requirements ......................................... 14
  Do I need to apply for protection? ....................................... 15
  Characteristics of a standard patent and an innovation patent .. 17
  What rights will I receive for a patent? ................................. 17
  When would I infringe a patent? ......................................... 18
Copyright .............................................................................. 18
  What is copyright? ............................................................... 18
  What can be protected by copyright? ................................... 18
  Do I need to apply for protection? ...................................... 19
  What rights will I receive for copyright? .............................. 19
  Economic rights ................................................................. 19
  Moral rights ...................................................................... 20
  Performers’ rights ............................................................. 21
  When would I infringe copyright? ....................................... 21
  Exceptions to copyright infringement .................................. 22
Registered Designs ............................................................... 23
  What is a registered design? ................................................. 23
  What can be protected as a registered design? ..................... 24
  Do I need to apply for protection? ..................................... 25
  What rights will I receive for a registered design? .................. 25
  When would I infringe a registered design? ......................... 26
What this Chapter Covers

In an industry where technology advances rapidly, such as the electrical and electronics industry, intellectual property (IP) plays an important role in driving innovation by providing a basis for return on investment in research and development. Everyone involved in a technology-based industry should have a basic understanding of the different types of IP and the rights granted by them.

This Chapter explains the concept of IP in the legal context and gives a brief introduction to the different types of IP, including:

- what can be protected
- how long the IP lasts, and
- what rights the IP provides.

A general understanding of the different types of IP will aid your understanding of the later chapters of this Manual.

What is Intellectual Property?

IP is an umbrella term used to describe the results of creative efforts from the mind or intellect. The Convention Establishing the World Intellectual Property Organisation 1967 (WIPO) defines IP as “rights relating to:

- literary, artistic and scientific works
- performances of performing artists, phonograms and broadcasts
- inventions in all fields of human endeavour
- scientific discoveries
- industrial designs
- trade marks, services marks and commercial names and designations
- protection against unfair competition, and

all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.”

IP in the Electrical and Electronics Industry

There is terminology used in the electrical and electronics industry that incorporates the word ‘IP’, such as ‘IP Cores’, ‘Star IP’ and ‘Commodity IP’. These are portions of integrated circuits or the ‘building blocks’ of a product that are sold to customers as commodity parts for the new designs. These are, in essence, only a subset of IP which may be capable of IP protection.

For more information on ‘IP Cores’, see Chapter 4 ‘What Researchers and Design Engineers Should Know’.
IP law protects creators of IP by granting to them legal rights to control the use of their IP for a certain time. These rights are not given for the physical creation of the objects but for the intellectual efforts applied to such creation. IP law and enforcement is generally similar in nature from country to country but will vary in points of detail.

IP takes a number of different forms, each with its own specific manner of protection. Different forms of IP arise in different subject matter; however, the same subject matter may attract more than one form of protection.

The diagram below illustrates eight different forms of IP and gives examples of subject matter that may be protected by them. All forms of IP, with the exception of plant breeders’ rights (which will not be discussed in detail in this Manual), will be of relevance to the electrical and electronics and other technology-based industries.
FORMS OF INTELLECTUAL PROPERTY

- **PATENTS**
  - Electrical and electronic products, (e.g. mobile phones, smart home products, medical devices)
  - Hardware
  - Interfacing products
  - Computer programs or software

- **COPYRIGHT**
  - Computer programs or software (as source code or object code)
  - Computer icons
  - Clip art
  - Graphical designs
  - Multimedia elements
  - Interfacing products
  - Databases, manuals & datasheets

- **REGISTERED DESIGNS**
  - Electrical and electronic products
  - Computer icons

- **CIRCUIT LAYOUT PROTECTION**
  - Mask works for integrated circuits and the resultant integrated circuit

- **CONFIDENTIAL INFORMATION**
  - Laboratory notebooks, design workbooks, customer information, documented internal processes

- **TRADE MARKS**
  - Computer icons, graphical designs, multimedia elements, words/names

- **DOMAIN NAMES**
  - Web addresses

- **PLANT BREEDERS’ RIGHTS**
A patent is the right granted by the government of a country to the patent owner allowing the patent owner to exclude others from commercially exploiting the invention within that country.

A patent may be granted for any invention (which may be a device, substance, method or process) which satisfies various requirements. The invention does not need to be ‘pioneering’ – an improvement or variation over what already exists may be patentable. It is sometimes said that only a ‘scintilla’ of inventiveness is required.

In Australia, the Patents Act 1990 (Cth) (‘Patents Act’) is the primary source of patent law.

However, some subject matter cannot be patented. This includes subject matter such as:
- a human being and biological processes for their creation
- inventions that are contrary to law
- inventions that are generally ‘inconvenient to the public’, and
- artistic creations.

The diagram below illustrates the requirements for patent grant in Australia. You should always remember that patents are granted country by country. Although patent requirements in different countries are similar, differences do exist. This Manual refers primarily to patent requirements in Australia.
To be patentable, an invention must be a ‘manner of manufacture’. Patent law largely leaves the determination of patentable subject matter to the Courts. As a general rule, an invention resulting from human activity (i.e. not naturally occurring) and which has commercial potential will typically be considered to be a manner of manufacture. On the other hand, discovery of a natural phenomenon (e.g. the law of gravity) will not satisfy this requirement of patentability.

Similarly, a mathematical formula describing a natural phenomenon is not a manner of manufacture, but a device utilising the mathematical formula, or an algorithm encoding the phenomenon, that produce a useful result is likely to be considered a manner of manufacture.

To be patentable, an invention must be ‘novel’ or new: that is, the invention must not have been publicly disclosed in any form, anywhere in the world as at the date of first filed patent application (referred to as the ‘priority date’).

Disclosure includes any form of public release of the invention (e.g. uploading a description of the invention on the internet, or selling or using the invention) and any statements made about the invention in a public forum (e.g. presenting the invention at a trade fair or academic conference).

In Australia, the Patents Act provides specific ‘grace periods’ for certain types of disclosures (i.e. the invention may still be considered novel if the patent application is filed within a certain period notwithstanding its disclosure). However, it is recommended that you always consult with a patent attorney before publicly disclosing your invention or entering into commercial dealings with respect to it.

Remember that most other countries do not have equivalent grace periods. You should therefore file a patent application before any disclosure or sale of the invention.

To be granted a **standard patent**, an invention must involve an ‘inventive step’.

This means that the invention must be more than an ‘obvious’ extension, variation or combination of prior inventions which could be brought about by an unimaginative person skilled in the field of the invention.

An ‘obvious’ invention is one which could have been arrived at by the inventor as a matter of course (e.g. thought to be worth a try with a prospect of success) in light of the common general knowledge in the relevant field.

Inventive step (and novelty) is evaluated against existing technical information publicly available before the priority date, known as ‘prior art information’. For more information on inventive subject matter, see Chapter 6 ‘What Researchers and Design Engineers Should Know’.

Similarly, an **innovative patent** must involve an ‘innovative step’. This means any variation between the invention and what is currently known about that technology.
must make a ‘substantial contribution’ to the working of the invention. This generally is believed to be a lower threshold than inventive step.

For more information on standard patents and innovative patents, see the Section ‘Characteristics of a Standard Patent and Innovation Patent’ in this Chapter.

**Utility**
A patentable invention must be useful, i.e. the invention should achieve what you say it will. This ‘utility’ requirement is analogous to an invention being industrially applicable. Lack of utility arises rarely.

**No prior secret use**
To be patentable, the invention must not have been secretly used in Australia before the date of the application. There are exceptions to prior secret use. These include:

- use for the purpose of reasonable experiment or trial
- use by a person under obligations of confidence
- use by the inventor (or authorised person) for a purpose other than for trade or commerce, or
- use by a Commonwealth, State or Territory government to which the inventor (or authorised person) has disclosed the invention.

**Other application requirements**
There are other important application requirements of which you must be aware when applying for grant of a patent. Failure to comply with these requirements may result in the patent being held invalid by the Patent Office or a Court.

These include:

<table>
<thead>
<tr>
<th>Sufficiency of Description</th>
<th>Fair Basis</th>
</tr>
</thead>
<tbody>
<tr>
<td>The description of the invention in the patent specification must be sufficiently detailed for a person skilled in the field to be able to make and use the invention.</td>
<td>The invention as claimed must be supported by or consistent with the detailed description. The claims must not be too broad in scope compared with the ‘promise’ of the detailed description.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Clarity of Claims</th>
<th>Inventorship</th>
</tr>
</thead>
<tbody>
<tr>
<td>A claim must be clear and unambiguous so that its scope can be ascertained. This requirement is one of language.</td>
<td>The correct inventors must be named in the application.</td>
</tr>
</tbody>
</table>
Do I need to apply for protection?

Yes. You need apply to IP Australia (i.e. the Federal Government Patent Office) to obtain the grant of patent. The different types of patent application that may be filed with IP Australia are described below. To obtain patent protection in other countries, the application processes for those countries will need to be followed, which may include PCT applications and/or Convention applications described below.

For more information on the application process for standard and innovation patents, see Chapter 5 ‘What Managers Making IP Protection Decisions Must Know’.

<table>
<thead>
<tr>
<th>Type of Application</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>Provisional application</td>
<td>A provisional application, strictly speaking, does not need to include claims defining the invention but usually will do so. A provisional application generally is used to secure a priority date for the invention, and affords up to 12 months to decide whether to continue with the patenting process in Australia and elsewhere. A provisional application will lapse after 12 months, so if patent protection is to be pursued, then a complete application must be filed within this period. Importantly, in Australia, a provisional application can serve as the basis for foreign patent protection (see PCT applications and Convention applications below). For this reason provisional specifications should be written to satisfy all requirements for grant in other countries. In other words, the idea that a provisional specification need only include sketchy details of how to put the invention into practice is dangerous.</td>
</tr>
<tr>
<td>Type of Application</td>
<td>Explanation</td>
</tr>
<tr>
<td>---------------------</td>
<td>-------------</td>
</tr>
<tr>
<td>Complete application</td>
<td>A complete application can be for either a standard or innovation patent and must be accompanied by a complete specification containing at least one claim defining the invention. A complete application is examined by the Patent Office to determine if it satisfies the requirements for a grant, and if so, usually leads to the grant of patent rights. For more information on standard patents and innovation patents, see the Section “Characteristics of a Standard Patent and Innovation Patent” in this Chapter.</td>
</tr>
<tr>
<td>PCT application</td>
<td>A PCT application (also known as an ‘international application’) allows you to apply for patent protection in a number of different countries through one international agency, provided that the countries are signatories to the Patent Cooperation Treaty. However, the PCT application will need to be ‘nationalised’ to the different countries of interest before a relevant deadline for local examination and grant to occur. Separate applications are necessary in those countries of interest not signatories to the Patent Cooperation Treaty.</td>
</tr>
<tr>
<td>Patent of addition</td>
<td>A patent of addition may be filed to protect an improvement or modification that you have made to the ‘main invention’ of an earlier patent or patent application. The improvement or modification must be novel - by not necessarily inventive - over the earlier main invention.</td>
</tr>
<tr>
<td>Divisional application</td>
<td>If the earlier patent application described more than one invention, then one or more divisional applications may be used to separately protect the other inventions without loss of priority date.</td>
</tr>
<tr>
<td>Convention application</td>
<td>The Paris Convention provides a right of priority of up to 12 months in the member countries. This means an application can be filed in other countries within 12 months of the first Australian filing, and the priority date is retained for these other countries for the purposes of the assessment of novelty and inventive step. The first application need not be filed in Australia. For example, there may be reasons to file the application in the United States first, then in other countries (including Australia) within 12 months.</td>
</tr>
</tbody>
</table>
## Characteristics of a standard patent and an innovation patent

Set out below are the characteristics and application requirements of a standard patent and innovation patent:

<table>
<thead>
<tr>
<th>Standard Patent</th>
<th>Innovation Patent</th>
</tr>
</thead>
<tbody>
<tr>
<td>Maximum term of protection is 20 years (with a possible extension of up to 5 years for certain patents), provided official renewal fees are paid.</td>
<td>Maximum term of protection is 8 years, provided renewal fees are paid.</td>
</tr>
<tr>
<td>An unlimited number of claims may be included in the application, although significant additional official fees are incurred where there are more than 20 claims.</td>
<td>Up to 5 claims may be included in the application.</td>
</tr>
<tr>
<td>Examination of the substantive validity of the application is compulsory.</td>
<td>Only an administrative formalities check is compulsory. Examination of the substantive validity of the innovation patent is optional.</td>
</tr>
<tr>
<td>Need to pass the ‘higher’ inventive step threshold.</td>
<td>Need to pass the ‘lower’ innovative step threshold.</td>
</tr>
<tr>
<td>Third parties may initiate pre-grant opposition.</td>
<td>Third parties may only initiate post-certification opposition.</td>
</tr>
<tr>
<td>No further examination is required before enforcing the patent.</td>
<td>The substantive validity of the patent must be examined (i.e. certified) before it can be enforced.</td>
</tr>
<tr>
<td>Very similar types of patent may be obtained in other countries.</td>
<td>Applications can only be pursued in Australia, although broadly equivalent utility model protection is available in Japan, Germany and Spain, for example.</td>
</tr>
</tbody>
</table>

## What rights will I receive for a patent?

Once registered, the Patents Act grants exclusive rights to the patent owner to prevent others from possessing, using, selling, manufacturing and importing the patented invention or offering to do any of these things.

Only with authorisation from the patent owner will anyone else be able to commercially exploit the patent.

It is incumbent on the patent owner to enforce these rights.
Whether a patent has been infringed is a question of fact. It must be proved that the alleged infringer has done an act which takes up each and every feature of at least one claim of the patent. The infringing act must have occurred after the date of publication of the patent application and enforcement proceedings must commence within 5 years from the date of an infringing act.

A patent may also be indirectly infringed. This may occur where a product has knowingly been supplied to a third party who will use it in a way that will infringe the patent. In this scenario, the supply of the product would constitute indirect or ‘contributory’ infringement.

Foreign Patents

Patent rights are territorial in nature. For example, where there is no enforceable Australian counterpart of a US patent, exploiting an invention claimed in the US patent in Australia will not constitute infringement of the US patent.

Copyright

What is copyright?

Copyright protects against unauthorised reproductions and public disseminations of an original work.

Copyright protects the particular expression of an idea – not the idea itself. Consequently, copyright does not prevent the use of the same idea, as long as the ‘expression’ of the idea is original.

‘Original’ does not mean the work needs to be particularly creative or ingenious. A work is ‘original’ where the work is created independently and skill, labour and judgment is applied to it.

In Australia, the Copyright Act 1968 (Cth) (‘Copyright Act’) governs the operation of copyright law.

What can be protected by copyright?

Copyright may exist in a range of creative, intellectual or artistic subject matter. There are eight primary categories of protected forms of expression:
## Intellectual Property Management

### Category of work

<table>
<thead>
<tr>
<th>Category of work</th>
<th>Examples</th>
</tr>
</thead>
<tbody>
<tr>
<td>Literary works</td>
<td>All written works, including reports, lyrics, poems, books, software, database</td>
</tr>
<tr>
<td>Artistic works</td>
<td>Photographs, drawings, paintings, sculptures, architecture, graphs, computer icons</td>
</tr>
<tr>
<td>Dramatic works</td>
<td>Plays, screenplays, choreographic works</td>
</tr>
<tr>
<td>Musical works</td>
<td>All works with written musical notation, including sheet music, operas</td>
</tr>
<tr>
<td>Cinematographic works</td>
<td>All works generating moving images, including films, computer games</td>
</tr>
<tr>
<td>Sound recordings</td>
<td>All works with recorded sound, including CDs, DVDs, mp3, podcasts</td>
</tr>
<tr>
<td>Broadcasts</td>
<td>Television and radio broadcasts</td>
</tr>
<tr>
<td>Published editions</td>
<td>Publisher’s typeface and layout of a published work</td>
</tr>
</tbody>
</table>

### Do I need to apply for protection?

No. Copyright protection arises automatically on creation of the work, provided it is original. Through an international agreement, this protection extends to most countries in the world.

The term of copyright depends on the type of work that is protected, when it was made and whether it was published. Generally, protection lasts for 70 years after the death of the creator.

### What rights will I receive for copyright?

In a very broad sense, copyright protects the ‘right to copy’ an original work.

There are three bundles of rights granted to a copyright owner: economic rights, moral rights and performers’ rights.

### Economic rights

These are exclusive rights granted to the copyright owner to prevent others from commercially exploiting the copyright protected work without authorisation. These rights may be transferred by assignment or licensed.

Economic rights vary between each type of copyright protected work and are described in the following table.
Intellectual Property Management

<table>
<thead>
<tr>
<th>Category of work</th>
<th>Economic rights granted</th>
</tr>
</thead>
<tbody>
<tr>
<td>Literary, dramatic and musical works</td>
<td>• Reproduction&lt;br&gt;• Communication to the public&lt;br&gt;• Publication&lt;br&gt;• Performance in public&lt;br&gt;• Making adaptations&lt;br&gt;• Entering into commercial rental agreements</td>
</tr>
<tr>
<td>Artistic works</td>
<td>• Reproduction&lt;br&gt;• Communication to the public&lt;br&gt;• Publication</td>
</tr>
<tr>
<td>Sound recordings and cinematographic works</td>
<td>• Copy&lt;br&gt;• Communication to the public&lt;br&gt;• Cause to be seen or heard in public&lt;br&gt;• Enter into commercial rental agreements (sound recordings only)</td>
</tr>
<tr>
<td>Broadcasts</td>
<td>• Make a film or television copy&lt;br&gt;• Make a copy of the sound recording of the broadcast&lt;br&gt;• Rebroadcast or communicate to the public</td>
</tr>
<tr>
<td>Published editions</td>
<td>• Make a facsimile copy of the published edition</td>
</tr>
</tbody>
</table>

**Moral Rights**

These are personal rights protecting the integrity and attribution of the creator which are summarised in the following table.

<table>
<thead>
<tr>
<th>Moral Right</th>
<th>Definition</th>
</tr>
</thead>
<tbody>
<tr>
<td>Right of integrity</td>
<td>The right to not have the work subjected to derogatory treatment</td>
</tr>
<tr>
<td>Right of attribution</td>
<td>The right to be identified with the work</td>
</tr>
<tr>
<td>Right against false attribution</td>
<td>The right to not have the work falsely credited to another person</td>
</tr>
</tbody>
</table>
Moral rights cannot be transferred by assignment or be licensed. However, they may be waived by written consent from the creator.

The consent must be genuinely given by the owner in writing and must specify the work(s) to which the consent relates, and the acts or omissions covered by the consent.

Moral rights may also be deemed to be waived if considered ‘reasonable’ in the circumstances. Factors deciding what is ‘reasonable’ include the nature and purpose of the work, industry practice in relation to the work, and whether the author made the work as an employee.

Remedies for breach of moral rights include injunction, damages, a declaration that moral rights have been infringed, an order for a public apology, or an order that any false attribution or derogatory treatment be removed or reversed.

Performers’ rights

These are personal rights preventing unauthorised recordings, broadcasting and other uses of the performance, including copying, selling, hiring, distributing, importing and possessing.

Performers’ rights, like moral rights, cannot be transferred by assignment or be licensed. However, they may be waived and this is a common occurrence in commercial transactions.

Copyright is infringed when a person deals with a ‘substantial part’ of a copyright protected work without the copyright owner’s authorisation, and such dealing is not covered by an exception.

Dealing with a ‘substantial part’ of a copyright protected work does not necessarily refer to using a large amount of the work. Often, whether a ‘substantial part’ of a work has been dealt with is assessed qualitatively (i.e. having regard to the essence of the work). For example, the use of only 127 bytes from a 32 kilobyte program was held by the High Court to be copyright infringement because it was dealing with a substantial part of the work (Autodesk Inc v Dyason [No 1] (1992) 173 CLR 330).

Substantial dealing with copyright protected work extends to downloading material from the internet. It should not be assumed that everything accessible from the internet may be downloaded and used without infringing copyright.

Copyright may also be infringed indirectly, i.e. subsequent dealings with unauthorised reproductions of the work. The main forms of indirect copyright infringement involve unauthorised copies of copyright protected work being imported, sold, hired or otherwise supplied for the purpose of trade.
As the advancement of digital technology poses an increasing challenge to enforcement of IP rights, there has also been an increasing use of technological measures to prevent and restrict violations of copyright in the digital realm:

**Technological Protection Measures (TPMs)**

These are software locks or encodings, or password protection measures on copyright works. It is an infringement to manufacture, import or deal commercially with devices or services designed to avoid TPMs.

**Electronic Rights Management Information (RMI)**

This is a set of electronic systems for identifying contents of copyright work, protecting copyright and tracking the usage of electronic information. It is an infringement to remove or alter electronic RMI attached to copyright works. This is also known as Digital Rights Management (DRM).

**Broadcasting Decoding Devices**

These provide encoded protection for copyright-protected broadcasts. It is an infringement to manufacture or deal with broadcast decoding devices which permit unauthorised access.

Civil and criminal sanctions may apply to using anti-circumvention devices to ‘unlock’ copyright protected digital content. Criminal sanctions are imposed where the person must have known or reasonably suspected that the device or service would be used to circumvent a technological prevention measure, and the person may be liable up to 5 years imprisonment.

### Exceptions to copyright infringement

**Fair dealing exceptions**

There is no copyright infringement if you deal fairly with copyright protected work for any of the following purposes:

- reporting news
- research or study
- criticism or review
- professional advice given by a lawyer, patent attorney or trade mark attorney.

Factors deciding what use is ‘fair’ include the purpose and character of use, the nature of the work, the amount and substantiality of the portion copied, and whether the material is used for commercial purposes.

For example, making a single copy of a journal article, one chapter or 10% of a book (equivalent to 10 or more pages long), or 10% of the number of words in a work in electronic form for research or study purposes will be considered fair dealing.
Other exceptions:

**Computer programs**

The incidental and automatic copying of software resulting from the process of normal use of the program or for back-up purposes will not infringe copyright.

To decompile, reverse-engineer, reproduce or adapt a computer program to make an interoperable product, to test its security, or to correct an error (if the required information or error-free copy is not otherwise available) will not infringe copyright.

**Home copying**

As long as it is strictly for private and domestic use, your copying of a sound recording which you own or the recording of broadcasted material will not infringe copyright.

**Judicial proceedings & judicial reporting**

Copyright will not be infringed where it is used for judicial proceedings and its reporting.

**Public recitation and performance**

If the public performance of copyright protected work takes place at premises where people reside or sleep (e.g. at home or in an institution) copyright in the work will not be infringed.

**Libraries and archives**

Libraries, museums, galleries and archives are allowed to reproduce material in their collections for students for fair dealing purposes, Members of Parliament and the Government without infringing copyright.

**Foreign copyright**

Use of a foreign copyright protected work in Australia will usually require permission. Subject to any applicable exception, use of foreign copyright protected work without permission in Australia will be an infringement of copyright.

**Registered Designs**

What is a registered design?

A registered design is the exclusive right(s) granted by the government to the design registration owner allowing the owner to exclude others from commercially exploiting the overall appearance of a particular design.
This Manual deals primarily with the 2003 Act.

A registered design protects the overall appearance of a product resulting from one or more visual features of the product.

| The following visual features of a product may be protected by designs registration: |
|---------------------------------|-------------------------------|
| Shape                           | Ornamentation                 |
| Pattern                         | Configuration                 |

But the feel of a product and the materials used in a product are excluded.

The diagram below illustrates the requirements for obtaining design registration in Australia.

- 'New' means the design has not been publicly used in Australia and has not been published within or outside Australia.
- 'Distinctive' means the design is substantially different in overall appearance to other designs already in the public domain.

Some designs are not able to be registered. Examples include those featuring:
- medals
- the layout for an integrated circuit
- the Olympic rings symbol, motto or torch and flames design
- the word ‘Anzac’
A protectable design may be two-dimensional (e.g. pattern) or three-dimensional (e.g. a shape), and either manufactured or homemade. The design does not have to be aesthetically pleasing. Although a design registration does not protect the functionality of an article, a visual feature which happens to have a functional purpose will not preclude it from obtaining a design registration.

Examples of well-known articles that have been protected by registered designs include Ken Done bed linen, the tread of a Dunlop pneumatic tyre, Speedo swimwear, a Malleys portable cooler and a Breville electric hot water jug.

It is important to understand that the term ‘registered designs’ has a different meaning to a ‘design process’ commonly referred to by engineers in the electrical and electronics industry. Whilst a ‘design process’ typically describes the process of generating a product, a ‘registered design’ is an IP right which protects the overall impression of a product only.

Yes. You must apply to IP Australia to register your design for protection in Australia. The term of protection lasts for a maximum of 10 years, provided official renewal fees are paid. However, you will only have the right to enforce your registered design once it is certified. For more information on the registered design application process, see Chapter 5 ‘What Managers Making IP Protection Decisions Must Know’.

If a design is not registered, copyright may still provide some protection – but this is very minimal. That is, copyright may provide protection where a design is based upon or consists of an artistic work. However, as a guideline, it is only registered designs that are available for the protection of products that are industrially applied, and copyright protection for such items is expressly excluded, even if it might otherwise exist.

Designs registration grants to the owner a number of exclusive rights, which include to be able to:

• licence and assign the use of the design, and
• prevent others from manufacturing copies or obvious imitations of the design without authorisation.
When would I infringe a registered design?

A registered design will be infringed where there is an unauthorised application to a product of an identical design or one that is substantially similar in overall impression.

‘Unauthorised application’ includes the importation, sale or hire of a registered design.

Certain acts of repair or replacement of parts of a product that is protected by a registered design may be excluded from being an infringing act.

Foreign Registered Designs

Registered designs are territorial in nature. Where there is no Australian counter-part of a foreign registered design, exploiting such a design in Australia will not constitute infringement. However, foreign registered designs may nevertheless be subject to copyright protection in Australia.

Circuit Layout Protection

What is a circuit layout?

Circuit layouts are representations (masks) describing the layout of designs of integrated circuits.

In Australia, the Circuit Layout Rights Act 1989 (Cth) (‘CLR Act’) governs the operation of circuit layout protection.

The CLR Act refers to original circuit layouts as ‘eligible layouts’.

What can be protected by circuit layout rights?

The circuit layout will be protected as long as it is ‘original’, i.e. it resulted from the designer’s own skill and labour. A circuit layout will not be considered ‘original’ where it is generic or there was no creative contribution by the creator.

There are further eligibility requirements to satisfy before protection is received:

• the creator must be an Australia citizen or an Australian corporation
• the circuit layout must first be commercially exploited in Australia or originate from a country where like protection exists, and
• the circuit layout must be created after 1 October 1990.
Examples of where circuit layouts are employed include digital watches, calculators, CD/MP3 audio players, DVD players, whitegoods, motor vehicles and computers.

Do I need to apply for protection?

No. Protection arises automatically on creation of the original circuit layout. The term of protection lasts for a maximum of 20 years. However, protection will only last for 10 years if the layout is not commercially exploited within that period.

What rights will I receive for circuit layout protection?

The exclusive rights granted to owners of protected circuit layouts allow them to:

- copy the circuit layout in material form
- manufacture integrated circuits in accordance with the layout, and
- exploit the plans of circuit layouts in Australia commercially.

Note the expression ‘material form’ clearly covers masks (stencils or plans that mark out the shape of each layer of semiconductor material), but may not cover computer code that may be used to fabricate an integrated circuit by direct laser techniques.

When would I infringe circuit layout rights?

An infringement of a circuit layout occurs when a person acting without authorisation from the circuit layout owner deals with the exclusive rights granted to the circuit layout owner, including:

- copying the circuit layout in material form
- making the circuit layout
- commercially exploiting the circuit layout, or
- authorising any of the above.

Exceptions to circuit layout infringement

There is no infringement of a circuit layout right if:

- the commercial exploitation is ‘innocent’: where the unauthorised person did not know or could not reasonably have known that exclusive rights existed in the circuit layout at the time of commercial exploitation, but upon becoming aware provided equitable remuneration for its use to the circuit layout owner
- the copying is for private use
- the copying is for research or teaching purposes
- there is reverse engineering of a circuit layout for the purposes of evaluation and analysis, and where the results of the reverse engineering is used and/or commercially exploited, or
- the use of the circuit layout is for defence or security purposes.
Confidential information is information that must be kept confidential by the recipient. When the confidential information is kept secret and used properly, this form of protection may be very effective. The most famous well-kept and valuable confidential information is the Coca Cola recipe, said to be kept secret since 1885.

The terms ‘confidential information’ and ‘trade secrets’ are often used interchangeably but strictly speaking, trade secrets are a subset of confidential information in the context of business, commerce or trade. Other forms of confidential information include personal information (e.g. diaries, photographs) or professional information (e.g. information supplied to a lawyer or accountant in the course of his/her professional duties).

Any sort of information may be the subject of confidence. Common examples of confidential information include manufacturing processes, recipes, engineering and technical designs and drawings, product specifications, customer lists, business strategies and sales and marketing information.

Confidentiality obligations under equity arise automatically provided the following conditions are satisfied:

Foreign Circuit Layout Rights

Foreign circuit layouts from ‘eligible foreign countries’ (such as the US, UK and Canada) are granted the same level and kind of protection as layouts made in Australia. Therefore, use of circuit layouts from eligible foreign country in Australia without permission from the owner will be infringement of the circuit layout rights.

Where the foreign circuit layouts are not from an eligible foreign country they will be not protected in Australia. However, more than 100 countries are prescribed as being eligible, in which case the likelihood of foreign layouts being protected in Australia is high.
the information has a necessary quality of confidence about it
it has been imparted in circumstances involving an obligation of confidence, and
an unauthorised use is made of the information to the detriment of the party communicating it.

However, to reinforce an organisation’s position and provide certainty as to the existence of the confidential information, it is prudent practice for an organisation to enter into a written confidentiality agreement with the recipient of the information.

The term of protection for confidential information may potentially be perpetual, provided the information remains secret.

Confidential Information is not “property” like other forms of IP. There are no proprietary rights granted to the owner of the confidential information, and consequently there is no action for ‘theft’ of confidential information. Unlike other IP rights, owners of the confidential information have limited avenues to prevent use of the information by unrelated third parties once the information is leaked.

However, you may be entitled to remedies if there is unauthorised disclosure. Remedies arising from breach of confidentiality and breach of contract may include:

- an injunction restraining the use and disclosure of the information
- an order allowing the search of premises and seizure of documents and products if there is a risk that evidence may be destroyed
- an account of profits, or
- damages for compensation.

A trade mark is a sign used in trade by a business to identify and distinguish its goods or services from those of another business.

In marketing terms, a trade mark is the ‘face’ of a business used to advertise a product, and may be the most valuable asset held by a business. For example, the world’s most valuable trade mark, Google, is valued at over US$66 billion (‘Top 100 Brand Ranking 2007’, Milward Brown Optimor).
In Australia, the Trade Marks Act 1995 (Cth) (‘Trade Marks Act’) governs the operation of trade mark law.

A trade mark may consist of any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent, or a combination of any of those things.

However, the Trade Marks Act prohibits the registration of particular marks as set out in the table below.

### Marks Ineligible for Trade Mark Registration

- Marks that are identical or deceptively similar to an existing trade mark, e.g. ‘Kolgate’ may be deceptively similar to ‘Colgate’.
- Marks that mislead the nature of the goods and services that it is applied to, e.g. ‘Soft pillows’ for firm pillows.
- Marks that are generic or descriptive of quality or the nature of the goods or services, e.g. ‘Sticky Sellotape’.
- Marks consisting of a geographical location or a common surname, e.g. ‘Sydney Pies’ or ‘Smith’s Hair Salon’.
- Marks that consist of a representation of the arms, flag or seal of the Commonwealth, State or Territory.
- Marks that are scandalous or against the law, e.g. racist marks, marks that promote an illegal substance, or marks that are protected by legislation, such as the Olympic rings or ‘Medicare’.

Generally, yes. You must apply to IP Australia to obtain a registered trade mark. However, the common law right of ‘passing off’ and the Trade Practices Act 1974 (Cth) may provide some protection against inappropriate use of an unregistered trade mark. For more information on the advantages and disadvantages of trade mark registration, see Chapter 5 ‘What Managers Making IP Protection Decisions Must Know’.

Registration establishes your legal rights and makes enforcement easier. The protection term for registered trade marks may be perpetual, provided renewal fees are paid every 10 years.

For more information on the trade mark application process, see Chapter 5 ‘What Managers Making IP Protection Decisions Must Know’.
What rights will I receive for a trade mark?
An owner of a registered trade mark is granted exclusive rights to:
• use the mark in relation to the good or services with respect to which it is registered, and
• prevent others from using a substantially identical or deceptively similar mark in relation to the goods or services registered by the mark.

When would I infringe a trade mark?
A registered trade mark is infringed where there is unauthorised use of the registered trade mark or use of a substantially identical or deceptively similar mark:
• in relation to the goods or services for which the trade mark is registered
• in relation to similar goods or services for which the trade mark is registered or
• where the trade mark is so well-known that the use of the infringing mark (even on unrelated goods or services) indicates a connection with the registered trade mark.

Unregistered marks may be protected by the common law right of passing off, or the prohibition on misleading or deceptive conduct under the Trade Practices Act, provided reputation in the trade mark is established.

Foreign Trade Marks
Trade marks rights are territorial in nature. Where the foreign trade mark is neither registered nor used in Australia, use of the trade mark in Australia may not constitute infringement. However, if a foreign trade mark is well-known in Australia, the law of passing off or the Trade Practices Act may apply.

Trade marks on the Internet
When using a trade mark on the Internet to offer goods or services, you should be aware of the risks of trade mark infringement in other countries as you are entering a global marketplace.


If you receive a notice from an overseas trade mark owner alleging that your organisation is infringing their trade mark via the internet, you should seek legal advice from a lawyer or trade mark attorney before taking any action.
Domain Names

What is a domain name? A domain name is an address on the internet. It is the unique name that identifies a website, e.g. www.aeema.asn.au. This is the ‘human readable’ version of a website’s internet numeric address, e.g. 123.45.678.910

What can be a domain name? Almost anything can be registered as a domain name, subject to the rules and policies of the various domain name Registrars. Domain names are registered on a first come, first served basis.

You can check the availability of a domain name by using the public WHOIS service located at www.whois.com.au.

Many domain names consist of a business’s registered business name or company name. Recently, the domain names allocation rules have broadened, and a business’s registered trade mark or trade mark application (even if it is not its registered business name) may now form the basis of a domain name.

Do I need to apply for protection? Yes. You must apply to any of the many domain name Registrars who will issue a licence for use of the domain name. Registrars decide whether your domain name meets the policy rules, and have direct access to the Registry so that new registrations, renewals and updates of registrant details can be processed in the database.

A list of the registrars in the .au domain as accredited and licensed by .au Domain Administration Ltd (.auDA) can be found at www.auda.org.au. .auDA is the government-endorsed policy authority and industry self-regulatory body for the .au domain space. Its responsibilities include developing and implementing domain name policy, accrediting and licensing registrars, implementing consumer safeguards and facilitating the .au Dispute Resolution Policy (.auDRP).

The licence term for a domain name may potentially be perpetual, provided renewal fees are paid.

What rights will I receive for a domain name? No proprietary rights are granted for domain names. You do not own the domain name. The only ‘right’ granted is the licence to use the domain name for a specified period of time.

Further, you cannot prevent others from holding the same or similar domain name in another domain, e.g. www.aeema.com, www.aeema.net.au, www.a-ee-ma.com, www.a_e_e_m_a.co.uk.

Having a business name, company name or registered trade mark does not necessarily give you a ‘better’ right than anyone else to a matching domain name. You may, however, bring a complaint under .auDRP if you think you have a better entitlement.
WHAT THE BOARD AND CEO MUST KNOW

What this Chapter covers............................................................35

Developing an IP Strategy for your Organisation.....................35

   Step 1: Identify your organisation’s commercial goals...............35
   Step 2: Identify your organisation’s IP rights and the competitive IP landscape......................................................36
   Step 3: Align your organisation’s IP rights with its goals..........37
   Step 4: Formulate an IP strategy for your organisation............37
   Developing your IP strategy from a global perspective............39

Implementing an IP Strategy ......................................................41

   Establishing an IP management framework .........................41
   IP Management Framework..................................................41
   Stimulating creativity ...........................................................42
   Capturing creativity .............................................................42
   Example methods to stimulate and capture creativity............42

IP and Capital Raising ..............................................................43

   Capital raising ......................................................................43
   IP due diligence in capital raising.........................................43
   Different capital raising options.........................................44
   Government grant schemes .................................................44
   Government grant agreements............................................44
   Private equity ......................................................................48
   Business angels ....................................................................48
   Venture capitalists ................................................................48
   Business Plans .....................................................................50
   Initial public offerings .........................................................50
The electrical and electronics industry along with most technology-based industries are innovative and creative. The industry survives on continuous innovation – developing new products, systems and services, re-designing work processes and improving existing products.

A sound IP strategy will assist your organisation in capturing and protecting the outcomes of its investment in innovation. In addition, an organisation will ideally have systems in place to stimulate and capture the creativity and innovations of its employees.

This Chapter provides guidance to the Board and CEO on how to:

• develop an IP strategy
• manage IP strategically and effectively
• stimulate and capture the results of creativity within your organisation, and
• deal with IP issues in various capital raising scenarios.

An IP strategy cannot be developed in a vacuum. In order for your IP strategy to be relevant to your organisation it needs to address your organisation’s needs. A sound IP strategy will assist your organisation to achieve its commercial goals effectively. Your IP strategy should drive your new product development and should minimise the risks involved in investing in the development of new products.

Before formulating an IP strategy, you will need to be aware of the competitive environment in which your organisation operates, and the competitive advantage that might be gained from your organisation’s IP. Set out below are some steps to assist in the development of an effective IP strategy for your organisation:

**What this Chapter covers**

**Developing an IP Strategy for your Organisation**

**Step 1:** Identify your organisation’s commercial goals

It is likely that your organisation will have well-developed and explicit commercial objectives. In order to develop an IP strategy that works for your organisation, you may wish to assess how you can achieve those objectives from the perspective of IP. For instance, IP may be used as a tool to:

• block competing products
• generate income from commercialisation
• deter potential infringers
• defend an infringement action
• attract investment
• raise your organisation’s profile, or
• increase the sale price of your organisation’s shares or business.

A list of some of the factors to be taken into account when assessing how and what form of IP may be used to accomplish your commercial goals is set out below:

<table>
<thead>
<tr>
<th>Considerations for using IP to accomplish your commercial goals:</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Product Cycle</strong></td>
</tr>
<tr>
<td>What is the lead-time for your products to reach the market?</td>
</tr>
<tr>
<td>What is the typical product life?</td>
</tr>
<tr>
<td><strong>Exploitation Strategy</strong></td>
</tr>
<tr>
<td>How will your products be exploited?</td>
</tr>
<tr>
<td>Will they be manufactured locally or overseas?</td>
</tr>
<tr>
<td>Will they be manufactured by your organisation directly, under a licence, or by a joint venture?</td>
</tr>
<tr>
<td><strong>Markets</strong></td>
</tr>
<tr>
<td>What are the key markets for your products and what is the size and value of those markets?</td>
</tr>
<tr>
<td>Are the markets short-term markets or long-term markets?</td>
</tr>
<tr>
<td><strong>Competitors</strong></td>
</tr>
<tr>
<td>Will your competitors respect IP rights?</td>
</tr>
<tr>
<td>Where do your competitors manufacture and sell their products?</td>
</tr>
<tr>
<td><strong>Infringement</strong></td>
</tr>
<tr>
<td>Who are the potential infringers of your IP rights? Are they large entities or small entities?.</td>
</tr>
<tr>
<td>Is there a grey market for your products?</td>
</tr>
<tr>
<td>What is the ‘value proposition’ of your IP to potential infringers (i.e. the licensing costs as opposed to the litigation costs of infringement proceedings and the likelihood of success in such proceedings)?</td>
</tr>
</tbody>
</table>

As a next step you will need to identify the IP rights held by your organisation and the strengths of each of those IP rights, e.g. its life span, coverage, validity and strength. If this information is not readily available, you may wish to conduct an IP audit to gather such information. For more information on conducting an IP audit, see Chapter 6 ‘What Senior Management Must Know’.

You will also need to develop an understanding of the IP landscape surrounding your IP (i.e. the type and degree of IP protection held by your company and others). Awareness of the competitive IP landscape will enable you to identify potential IP barriers. Once these obstacles are known, you will be able to develop an IP strategy designed to avoid and/or minimise these obstacles. A ‘freedom to operate’ search will assist you in understanding the IP landscape.

Step 2: Identify your organisation’s IP rights and the competitive IP landscape
For more information on freedom to operate searches, see Chapter 4 ‘What Researchers and Design Engineers Must Know’.

Assessing the competitive IP landscape will also assist you to:

- identify and pursue future trends and gaps in the market strategically, and
- monitor your competitors’ activities, identify their strengths and weaknesses, and predict their next move.

Once you have identified your organisation’s goals and IP assets, you will be able to consider how IP may assist a particular strategy or evaluate how valuable a particular IP asset is for your organisation. Some examples of the issues which you may take into account are set out below.

### Considerations for assessing the value of an IP asset:

<table>
<thead>
<tr>
<th>Revenue Contribution</th>
<th>• What IP supports products making up the bulk of your revenue?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>• What IP supports your most profitable products?</td>
</tr>
<tr>
<td></td>
<td>• Does any IP bring in revenue independently (e.g. from licences) and if so, how much?</td>
</tr>
<tr>
<td>Margin Contribution</td>
<td>• To what extent does the IP give your products an advantage over those of your competitors?</td>
</tr>
<tr>
<td></td>
<td>• How much more can you charge for your products because of that advantage?</td>
</tr>
<tr>
<td>Marketing Benefits</td>
<td>• Does the IP give you a marketing advantage over your competitors?</td>
</tr>
<tr>
<td></td>
<td>• Will consumers perceive your products as being of better quality because of the IP?</td>
</tr>
<tr>
<td>Organisational Value</td>
<td>• Is the IP necessary to raise funding for expansion?</td>
</tr>
<tr>
<td></td>
<td>• How do potential sources of finance view the IP?</td>
</tr>
</tbody>
</table>

Once the process of aligning the IP portfolio and your organisation’s goals is completed, you will be able to identify:

<table>
<thead>
<tr>
<th>Core IP</th>
<th>Surplus IP</th>
<th>IP Gaps</th>
</tr>
</thead>
<tbody>
<tr>
<td>IP which is core to your organisation’s business</td>
<td>IP which is no longer aligned with your organisation’s strategies</td>
<td>IP needed to better support your organisation’s current strategies</td>
</tr>
</tbody>
</table>

---

**Step 3:** Align your organisation’s IP rights with its goals

**Step 4:** Formulate an IP strategy for your organisation
IP in each of these categories may also be rated in accordance with its technical and legal strength. Once classified, the information will assist the development of an IP strategy that is tailored to the needs of your organisation.

It is important to remember that an IP strategy must be constantly reviewed against your organisation’s goals to ensure it supports and is integrated into your organisation’s business strategy.

An IP strategy may be offensive and aim to develop IP that an organisation can use to take action against an infringing party, or be defensive and intend to obtain IP to minimise the risk of being sued by others for infringement. Ideally, an IP strategy will address both fronts. Striking the correct balance between being offensive and defensive is a complex problem, and requires a thorough understanding of the information gathered from the previous steps. As the size of your organisation grows, it will generally be increasingly monitored by competitors who may own IP rights that your organisation may infringe. The need to address defensive IP issues will increase with the success of your organisation.

**Developing an offensive IP strategy**

An offensive IP strategy focuses on acquiring and protecting proprietary IP that gives your organisation an advantage over its competitors. In general, an offensive IP strategy requires high-quality rights and the resources to enforce those rights. Ideally, the IP rights should be able to block likely ‘design around’ alternatives, so far as this is possible having regard to the existing prior art.

In order to develop an offensive IP strategy, you will need to have a sound knowledge of your organisation’s products and services and the extent to which these can be protected and the relevant IP rights enforced. A comprehensive and up-to-date IP register will help to identify relevant IP rights.

For more information on establishing and maintaining an IP register, see Chapter 6 ‘What Senior Management Must Know’.
Developing a defensive IP strategy

In order to develop a defensive IP strategy, you will need to have a thorough understanding of the competitive IP landscape, your organisation’s goals and planned strategies and potential obstacles in your path. A defensive strategy aims to steer clear of or at least reduce the impact of any obstacles and the associated risks.

Some possible elements of a defensive IP strategy include:

- obtaining a licence to exploit any blocking IP
- designing around the blocking IP
- altering the specifications of your products/services
- releasing your products/services in stages
- developing or acquiring an IP portfolio as a ‘bargaining chip’ for cross-licensing purposes
- opposing the rights of the blocking IP
- forming an alliance within your industry
- establishing appropriate company structures
- transferring or reducing the consequences of potential risk by contractual terms (e.g. contractually limiting the type/quantum of liability)
- developing contingency plans, and
- arranging for IP insurance.

For more information on IP insurance, see Chapter 8 ‘What Must be Known About Enforcing and Defending your IP Rights.’

Developing your IP strategy from a global perspective

Although a detailed discussion of the issues involved in developing an IP strategy from a global perspective is beyond the scope of this Manual, set out below are some general IP issues you will need to consider, especially if you plan to manufacture, import or export products outside of Australia.
### Issues to consider when developing a global IP strategy:

| IP Protection | Consider obtaining IP protection for your innovation in countries where your products are to be manufactured, marketed or sold, or which are otherwise strategically important to your organisation. Each country will have its own legislation governing the requirements for protection of different forms of IP. You should consult a legal professional who may have associates in the relevant countries in which you are considering obtaining protection for your IP. |
| Branding | When importing or manufacturing goods in a foreign country, you will need to consider whether the organisation’s existing trade mark or branding for the goods will conflict with any existing trade marks or brands within each of those markets in that country. Consider also whether you need to protect your trade mark in that country to prevent local competitors from taking advantage of the goodwill in your brand. |
| Freedom to Operate | Before manufacturing or importing goods into a country, you should first ensure that your organisation has the freedom to operate in that country. Seek the assistance of an IP professional to conduct a freedom to operate search in that country with respect to the goods to be manufactured or imported. |
| Parallel Importation | Parallel importation is the importation and distribution of goods by someone other than the authorised dealer in a ‘grey’ market. Parallel importers ordinarily purchase products in one country at a cheaper price and import and sell the products in another country at a price lower than the ordinary selling price of the same type of products in the other country. The issue of parallel importation is particularly important when licensing IP rights to a third party for exploitation in a particular territory, or when manufacturing products in another country. |
| Industry Standards | If your organisation is exporting goods to foreign countries, you will need to consider any applicable industry standards in those countries. On the other hand, if you are manufacturing your products in another country for sale domestically, you need to ensure all products are manufactured in accordance with your specifications and all applicable domestic industry standards and requirements. |
Implementing an IP Strategy

Establishing an IP management framework

The global arena of the ICT industry provides great opportunities to manufacture and export products overseas, but it is also very competitive as some countries are able to offer competitive advantages in the form of low-cost labour or advanced technological expertise, such as China, India, Korea or the United States. The Board and CEO will need to assess the risks and opportunities these countries present when developing a global IP strategy.

The IP strategy of your organisation needs to be translated into an appropriate IP management framework to provide guidance to your employees on effective IP management.

Typically, an IP management framework consists of two components:

<table>
<thead>
<tr>
<th>IP Policy</th>
<th>IP Implementation Plan</th>
</tr>
</thead>
<tbody>
<tr>
<td>A document setting out your organisation’s IP management principles</td>
<td>A plan setting out the optimal systems and the allocation of resources within your organisation to implement the IP policy</td>
</tr>
</tbody>
</table>

Establishment of an IP management framework requires detailed knowledge of the organisation’s objectives, practices and resources, and an understanding of where IP-related issues need to be addressed. These issues may change over time as the organisation’s objectives expand or change direction, and accordingly the IP management framework should be regularly reviewed and updated to reflect such changes. It is likely that the preparation of the IP policy and IP implementation plan will be supervised by one of your organisation’s senior managers.

For more information on preparing an IP policy and an IP implementation plan, see Chapter 6 ‘What Senior Management Must Know’.

Once prepared, the IP management framework needs to be endorsed by the CEO and the Board.
Engineering is a creative profession and innovation within your organisation should be encouraged rather than stifled. Creativity within your organisation may be stimulated by a strong culture of support for creative thinking and recognition of creative efforts.

**Stimulating creativity**

Some example methods to stimulate and capture creativity in an organisation are to:

- establish a strong culture of support for creative thinking
- provide mechanisms to recognise efforts by employees
- allow freedom to explore new concepts
- facilitate regular discussions of IP issues, and
- ensure invention disclosure forms are used diligently.

**Recognition of creative efforts by employees**

Innovation amongst employees can often be promoted by recognising their contributions appropriately. Rewards for talented employees for their innovation may take the form of:

- financial rewards
- public announcement of results
- certificates
- gifts, and
- staff development opportunities.

Your organisation may decide to use one or more forms of the above mechanisms to encourage and reward innovation and retain talented employees.

**Capturing creativity**

Not every new idea generated by your employees will be implemented. However, in the electrical and electronics industry technological innovation moves at a fast pace. Your organisation therefore needs to take immediate steps to preserve, develop and implement potentially significant innovations, as failure to take immediate action may effectively mean that your organisation will lose the potential benefits of the innovation.

Your IP management framework should have effective mechanisms to:

- encourage your employees to report innovations
- facilitate invention disclosures, and
- preserve and protect any IP disclosed by making informed and effective IP protection decisions.
IP and Capital Raising

Capital raising

The IP owned or controlled by an organisation usually represents a significant proportion of its value. Particularly for small or start-up organisations, realising the value of its IP is critical in the monetisation of that value.

There are a number of capital raising options open to organisations involved in the development of technological innovations. Some of these are summarised in the diagram below:

- Government Grant Schemes
- Private Equity
- Initial Public Offerings

IP due diligence in capital raising

Any capital raising scenario will invariably involve a due diligence exercise to allow potential investors to gather information on the status of the company before investing in the organisation.

Due diligence is an information gathering and analytical process to:
- investigate an organisation’s assets and liabilities
- assess the organisation’s legal rights to utilise those assets, and
- evaluate the risks associated with the identified assets and liabilities.

A comprehensive discussion of the due diligence process is beyond the scope of this Manual. However, the basic elements of an IP due diligence exercise are set out below.

<table>
<thead>
<tr>
<th>Issue</th>
<th>Documents to be examined</th>
</tr>
</thead>
<tbody>
<tr>
<td>IP Ownership</td>
<td>• Relevant IP assignments (including documents showing the correct chain of title from the original owner to the organisation)</td>
</tr>
<tr>
<td></td>
<td>• Evidence showing that the relevant assignments have been lodged or recorded with the relevant authorities</td>
</tr>
<tr>
<td></td>
<td>• Consultancy agreements</td>
</tr>
<tr>
<td></td>
<td>• Employment agreements</td>
</tr>
</tbody>
</table>
**IP Validity**

- Official filing receipts for all registrable forms of IP
- Evidence showing payment of all official fees
- Freedom to operate reports
- Evidence showing the date and source of the inventions (including laboratory notebooks, invention disclosure statements and other records documenting the creation of the IP), and
- Documents showing any claims and disputes that may affect the grant or validity of the IP (such as opposition and revocation proceedings).

**Any other rights/obligations attached to IP**

All agreements in relation to IP, including:

- licence agreements
- confidentiality agreements
- collaborative research agreements
- government grant agreements
- other funding agreements, and
- manufacturing and distribution agreements

**Different capital raising options**

General capital raising issues are beyond the scope of this Manual and this Manual will only give a brief overview of the different capital raising options in the context of IP.

You should always seek appropriate expert advice when considering any capital or finance raising.

**Government grant schemes**

Government grants are offered at a Federal and State level to organisations to facilitate research, development and commercialisation of innovations. These grants are usually competitive in nature, which means that your organisation will need to apply for the funding and your application will be assessed against applications from other organisations under the required published criteria.

**Government grant agreements**

If your organisation is successful in the grant application, your organisation will usually be required to enter into a grant agreement with the relevant funding body. The grant agreement will govern the administration of the grant which is frequently linked to the achievement of certain deliverables or milestones set out in the agreement. Other conditions imposed by the funding body in relation to the grant will generally depend on the objective of the grant programme.

Government grant agreements raise many of the same general considerations in relation to IP that arise in contractual arrangements with non-government entities relating to research.
**Provisions typically found in government grant agreements include:**

| Identification and ownership of background IP to be used in the funded project. |
| Clear allocation of ownership of the IP resulting from activities undertaken in the course of the project (Project IP). |
| Where the organisation owns the Project IP, a royalty-free licence back to the government agency to use the Project IP. In some cases, this may be limited to internal and/or non-commercial use. |
| Requirement for the organisation to acknowledge the relevant government agency’s contribution to the Project IP. |
| Obligations on the organisation to manage and protect the Project IP diligently. |
| Obligations on the organisation to achieve certain milestones in the development of the Project IP. |
| Obligations on the organisation to provide regular reports on the progress of the project. |
| Obligations on the organisation to account for expenditure of funds. |
| Rights for the government agency to inspect and audit the organisation’s records. |
| Right for the government agency to terminate the agreement if the structure or shareholding of the organisation changes, or if the organisation breaches any conditions of the agreement. |

A government grant agreement may also include government policy provisions requiring the organisation to use and commercialise the Project IP for the benefit of the Australian public, or to ensure that ownership of the Project IP remains in Australia. For example, the relevant Co-operative Research Centre agreement provides that:

‘Any Commercialisation or utilisation of the Intellectual Property in Contract Material must:

a) maximise the national benefits accruing to Australia, including Australian industry, and the Australian economy generally; and

b) be consistent with the Objective of the CRC Programme.’

It is recommended that your organisation seek legal advice before entering into a government grant agreement. For more information on government grant agreements, see Chapter 6 ‘What Senior Management Must Know’.
The two main Federal government departments that offer funding are:

<table>
<thead>
<tr>
<th>Department of Industry, Tourism and Resources (DITR)</th>
<th>Department of Education, Science and Training (DEST)</th>
</tr>
</thead>
<tbody>
<tr>
<td>DITR offers funding through its business programme division, AusIndustry.</td>
<td>DEST offers funding through its Cooperative Research Centre (CRC) and Australian Research Council (ARC) programmes.</td>
</tr>
</tbody>
</table>

**AusIndustry**

AusIndustry offers a range of programmes designed to assist with:

- research and development
- manufacturing and production, and
- commercialisation

Below is a list of some of the Federal government grant schemes offered by AusIndustry available at the time of publication of this Manual.

<table>
<thead>
<tr>
<th>Grant</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Commercial Ready</strong></td>
<td>The Commercial Ready programme offers grants for the commercialisation of innovations to small and medium sized companies. A wide range of project activities can be supported, extending from initial research and development, through proof of concept, to early stage commercialisation activities.</td>
</tr>
<tr>
<td><strong>Commercialising Emerging Technologies (COMET)</strong></td>
<td>COMET focuses on the commercialisation of innovations by early growth stage and spin off companies.</td>
</tr>
<tr>
<td><strong>Innovation and Investment Fund (IIF)</strong></td>
<td>IIF is a venture capital programme that invests venture capital funds to assist small companies in the early stages of commercialisation.</td>
</tr>
<tr>
<td><strong>National Australian Technology Showcase (ATS)</strong></td>
<td>ATS is a national and international campaign designed to promote leading Australian technology and the skills of the companies that produce it.</td>
</tr>
</tbody>
</table>

**CRC programmes**

The CRC programme funds collaborations between researchers and industry to improve the effectiveness of Australia’s research and development effort.
Successful applicants in the CRC programme are required to establish and register a CRC company of which all the core participants are members. The company will enter into an agreement with the Commonwealth for up to seven years. Under the agreement, the Commonwealth agrees to provide funding to the CRC company each year and the CRC will undertake certain activities assisted by the contributions (cash and in-kind) of the CRC participants.

Typically, a CRC must include at least one Australian university and one private sector participant.

The CRC programme currently operates in six different sectors, including the information and communication technology sector. CRCs in the information and communication technology sector that are in operation at the time of publication of this Manual are included in the table below.

<table>
<thead>
<tr>
<th>CRCs in the Information and Communication Sector</th>
</tr>
</thead>
<tbody>
<tr>
<td>CRC for Spatial Information</td>
</tr>
<tr>
<td>CRC for Integrated Engineering Asset Management</td>
</tr>
<tr>
<td>Smart Internet Technology CRC</td>
</tr>
</tbody>
</table>

For more information on the CRC program, visit: http://www.crc.gov.au.

**ARC programmes**

The ARC funds a range of programmes under the National Competitive Grants Program (NCGP) to support researchers at different stages of their careers, build Australia’s research capability, expand and enhance research networks and collaborations, and develop centres of research excellence.

There are three types of programmes offered by the ARC:

<table>
<thead>
<tr>
<th>Programme</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>Discovery Programme</td>
<td>Funds individual researchers and projects.</td>
</tr>
<tr>
<td>Linkage Programme</td>
<td>Helps to promote partnerships between researchers and industry, government and community organisations and the international community.</td>
</tr>
<tr>
<td>Centres Programme</td>
<td>Supports large teams to undertake focused and sustained research activities, as well as strengthen major research partnerships and networks.</td>
</tr>
</tbody>
</table>
Successful applicants enter into a funding agreement with the Commonwealth (as represented by the ARC), whereby the ARC provides funding to the organisation until the obligations as set out in the agreement is fulfilled.

For more information on ARC programmes, visit: http://www.arc.gov.au.

**Private equity**

The two major sources of private equity are private investors (also known as ‘business angels’) and venture capitalists.

**Business angels**

Business angels are typically high net worth, non-institutional investors looking to invest part of their wealth in organisations offering high risk-high return investment opportunities. In return, they usually look for ownership of equity and voting rights in the organisation, and ultimately capital gain through an appropriate exit strategy. Business angels may be found through industry bodies that provide a central business angel register or through referrals from professional advisers.

In order to be confident about obtaining a desired return from their investment, business angels will usually seek assurances from the organisation regarding the quality and experience of its management and its market strategy. They will also want to see a well-thought out business plan before making an investment.

Before approaching business angels, you will need to ensure that your organisation has a sound IP strategy. Business angels will want to know as much as possible about your organisation’s IP assets and its IP management strategies. This is particularly so for organisations in the electronics and electrical industry whose growth and existence is mainly driven by the creation of technology. You will therefore need to review your organisation’s IP portfolio, and confirm the IP position and the value of each IP asset before approaching business angels.

When receiving an equity investment from business angels, it is important that the mutual expectations of the investor and the organisation are clearly set out in the investment documentation since each investor will have its own needs and expectations. Disputes concerning the needs and expectations of an investor may jeopardise the chances of your organisation in future capital raising opportunities.

**Venture capitalists**

Venture capitalists are companies that invest in relatively new organisations that may have little performance history but have a significant potential to grow. They usually participate in the management of the organisation, and the investment is generally taken on the understanding that further funding may be required before return on the investment can be made.

Investment from venture capitalists may be made in one or more stages of a company (see below) over a specified period.
As a venture capitalist company is likely to be closely involved in the strategic management of the organisation, the process of selecting a venture capitalist is much more important than simply finding someone with money to invest. A suitable venture capitalist should take the role of a trusted business partner who will add value to your organisation above and beyond the provision of investment funds by providing suitable mentoring and guidance. The process for obtaining venture capital investment will vary depending on the interests of the parties, the nature of the transaction and time constraints. Usually, a business plan will initially be submitted to the prospective investor, who will review it against its own investment criteria.

When selecting a venture capitalist, you should consider:
- the reputation and the character of the venture capitalist
- other investments by the venture capitalist in similar organisations
- the desired exit strategy of the venture capitalist
- the time frame of the various stages of investment
- whether the venture capitalist has experience in the industry
- willingness of the venture capitalist to participate in future rounds of financing, and
- any previous disputes between the venture capitalist and other organisations.

<table>
<thead>
<tr>
<th>Stage</th>
<th>Purpose of funding</th>
</tr>
</thead>
<tbody>
<tr>
<td>Pre-seed</td>
<td>Proof-of-concept for technology or initial stages of IP protection.</td>
</tr>
<tr>
<td>Seed</td>
<td>Development of business concept.</td>
</tr>
<tr>
<td>Start-up</td>
<td>Product development and initial stages of marketing.</td>
</tr>
<tr>
<td>Expansion/Development</td>
<td>Expansion of enterprise.</td>
</tr>
</tbody>
</table>
The general factors venture capitalists take into consideration when deciding to invest in an organisation, in addition to the quality of the management team and the market potential of the opportunity, include:

- the IP portfolio
- potential risks
- the expected rate of return
- the offered level of equity in the organisation, and
- the degree of control or involvement in the strategic direction of the organisation (such as the power to appoint a chair person and a place on the board of directors).

Like business angels, venture capitalists will want to be assured that the organisation has a sound business plan which not only demonstrates the market opportunities and potential for the organisation’s growth, but also the organisation’s IP strategy outlining the management practices of its IP assets. This is again particularly important for organisations in the electronics and electrical industry whose growth and existence is to a large extent driven by the creation of technology.

A business plan may include the following:

- a detailed description of the organisation and its management team
- a description of the products and services to be offered
- an outline of the market opportunities for those products or services
- a summary of the strength and value of each IP asset
- an assessment of the competitive IP landscape and the IP position for each asset
- summaries of financial reports (historical and projected)
- an overview of key contracts, and
- proposed use of funds provided by the venture capitalist.

After the initial review of the organisation’s business plan, meetings may be conducted to negotiate the terms and conditions of the investment.

Initial public offerings (IPO) are the first offering of shares in a company to the public for the purpose of raising capital to finance the company’s business. Once listed, the shares will compete against other shares being traded on the relevant stock exchange.

In Australia, only a public company can make an IPO. The company must also satisfy certain financial parameters regarding the company’s profits and assets set forth in the Australian Stock Exchange listing rules.
An IPO may be conducted by a company to:
- raise capital from public investors
- enhance the corporate image of the company
- provide liquidity for the founders, and
- attract debt financing.

Although a successful IPO will generally increase the wealth of the original owners of the company, the IPO will usually lead to a dilution of their control over the company. In addition, increased public disclosure requirements will require a greater disclosure of information regarding the company’s affairs and impose higher governance obligations.

An IPO is not a trivial exercise and will often consume a tremendous amount of time and resources, which may in some instances be better spent on improving the operations of the company.

The process of an IPO is highly complex and technical. When choosing advisers to assist with the IPO of your organisation, it is essential to engage professionals which have substantial experience in this area and have developed systems for the various steps in the process leading to the IPO. Generally, involvement of well-known firms of advisers is likely to increase investor confidence by enhancing the overall public perception of the IPO.
WHAT RESEARCHERS AND DESIGN ENGINEERS MUST KNOW

What this Chapter covers ............................................................. 55

Design Process Planning .......................................................... 55
  Design process planning generally ............................................. 55
  Elements of the design flow process ......................................... 56
  Why consider IP in design process planning .............................. 57

Assessing the competitive landscape ......................................... 57
  Online IP databases ................................................................... 57
  Searching strategies .................................................................... 59
  How to read a patent specification .............................................. 60

Planning for re-use of designs .................................................... 62
  Experimental use ......................................................................... 62
  Re-using software ....................................................................... 63
  Re-using hardware design .......................................................... 65
  Re-using traded intellectual property ........................................... 66

Reducing the Risk of Infringement in Design Re-Use ............... 67
  Performing freedom to operate searches .................................... 67

Considering IP in your design process ....................................... 67
  Step 1: Listing design components ............................................ 68
  Step 2: Identifying the holder of the IP rights ......................... 69
  Step 3: Seeking appropriate authorisation ................................ 71

Obtaining rights to third party IP for design re-use ...................... 74
  Payment structure ....................................................................... 74
  Warranties, indemnities and other contractual rights ................ 74
  Conducting due diligence .......................................................... 75

Identifying Inventive Subject Matter .......................................... 75
  Factors determining inventive step .............................................. 76
  Preparing an invention disclosure .............................................. 77

Identifying the Inventor .............................................................. 80
  Who is the inventor? ................................................................. 80
  Identifying joint inventors ......................................................... 80

Managing IP in Research and Design Practices .......................... 81
  Keeping laboratory notebooks and design workbooks .............. 81
IP record storage practices ................................................................................................................... 84
Personnel practices .......................................................................................................................... 84
Be familiar with your IP policy........................................................................................................ 84
Observe your confidentiality obligations....................................................................................... 84
Ongoing IP obligations .................................................................................................................. 85
Identification and protection of confidential information............................................................. 85
Review of public disclosures........................................................................................................... 85
What this Chapter covers

During the design process for electrical or electronics products and software systems, researchers and design engineers may:

- generate new IP
- re-use IP previously generated by themselves or their organisation, or
- incorporate third party IP into their products.

It is therefore essential to consider IP when planning the design process as well as to manage the generated and utilised IP appropriately. This Chapter provides guidance to researchers and design engineers on how to:

- consider IP when planning a design process
- identify IP generated and utilised in a design process, and
- capture and manage IP appropriately and effectively.

Design Process Planning

Researchers and design engineers need to ensure that each product, system or service they generate as a result of research, development and design results in the deliverable that they or their customers expect. This can be achieved by planning the design process carefully.

A design process ideally should map out all the technical and managerial processes necessary to deliver the project requirements. The diagram on the following page outlines the elements of a design flow process for a tangible product adapted from Australian Microelectronics Network, A Managers Guide to the Electronics Design Process.

The ‘Conception Definition’ stage and ‘Analysis’ stage are where all existing IP assets are reviewed. The ‘Design, Implementation and VVT’ stage is where new IP assets are first generated.

For more information on the electronics design process, see Australian Microelectronics Network, A Managers Guide to the Electronics Design Process.
Elements of the Design Flow Process

CONCEPT DEFINITION
- Need
- Timescale market research
- Existing solution
- Proposed improvement
- Requirements specification

ANALYSIS
- Evaluation
- Requirements, goals and references
- Feasibility
- Behavioural simulation
- System specification

Modify in light of analysis?

DESIGN, IMPLEMENTATION AND VVT
- Standards
- Hardware/software
- Structured design
- Detailed design
- Implementation
- VVT

Modify in light of design?

INITIAL MANUFACTURING
- BOM
- Drawings, CAD data etc
- Pre-production build
- Field trials

Modify in light of field trials?

VOLUME MANUFACTURING
- Volume build
- Release to customers
- Test data
IP generated in the course of executing a design project can add significant value beyond the ‘sale price’ of the products system or service involved. This value arises in being able to charge customers a premium price due to the limited monopoly enjoyed by an IP owner, and the opportunity to grant others licences to exploit the IP. Accordingly, failure to consider IP during design process planning effectively ‘throws away’ potential value.

The products, system or service resulting from a design product may also potentially infringe the IP rights of others. As a result, it is prudent to consider ‘freedom to operate’ issues before resources are committed to a design project, to minimise the likelihood others’ IP rights may be enforced against you or any resulting losses. It cannot be assumed that the utilisation of others’ IP in the design project can be done without permission or without cost.

For all these reasons it is extremely important to consider IP in the design process planning.

Assessing the competitive landscape

Before developing the design process plan, competitive intelligence is essential to assist with the decision of what actual product to develop and what components are suitable to be included in your product. Carefully analysing the competitive landscape will enable you to:

- find out what products or components of the product have already been created by your organisation, your competitors or other companies
- avoid wasting resources in re-developing existing products
- monitor your competitor’s activities
- identify future trends and gaps in the market
- make informed decisions on what product should be developed and will likely be a commercial success, and
- reduce risks of IP infringement.

Analysing the competitive landscape involves having a thorough knowledge of the relevant market, the demands of that market, and knowledge of the competitors’ existing products and direction. In addition to keeping up-to-date in the market developments of your field by regularly reviewing trade journals, IP information is a resource that you cannot ignore. For example, more than 70% of the world’s technical information is published only in patent specifications.

Online IP databases

There are many IP databases available online providing access to documents on registered IP, including pending patent applications and registered patents.

**Australian IP databases and registers**

The government agency, IP Australia, maintains the Australian patent, trade mark, design and plant breeder’s rights databases which are available for free viewing by the
There are no registers for copyright or circuit layout rights as these rights are granted automatically on creation of the ‘work’. Other Australian IP-related databases that may be useful include the business names register, company names register and domain names register.

<table>
<thead>
<tr>
<th>Australian IP-related Databases</th>
<th>Web Address</th>
<th>Types of IP or Business Assets</th>
</tr>
</thead>
<tbody>
<tr>
<td>IP Australia</td>
<td><a href="http://www.ipaustralia.gov.au">http://www.ipaustralia.gov.au</a></td>
<td>Patents, Trade Marks, Designs, Plant Breeders’ Rights</td>
</tr>
<tr>
<td>Business Names Register</td>
<td><a href="http://www.asic.gov.au">http://www.asic.gov.au</a></td>
<td>Business names</td>
</tr>
<tr>
<td>Company Name Register</td>
<td><a href="http://www.asic.gov.au">http://www.asic.gov.au</a>.</td>
<td>Company names</td>
</tr>
<tr>
<td>Domain Name Register</td>
<td><a href="http://www.auda.gov.au">http://www.auda.gov.au</a></td>
<td>Domain names</td>
</tr>
</tbody>
</table>

Most IP offices around the world publish pending applications and granted patents, trade marks, designs and other registrable IP online for free viewing by the public. The United States also provides a copyright register, however, you should note that the register is not comprehensive since entering copyright works on the register is only optional.

The World Intellectual Property Organisation (WIPO) provides free access to its international IP databases, including links to national IP Offices’ websites.

<table>
<thead>
<tr>
<th>IP Offices</th>
<th>Web Address</th>
<th>Types of IP</th>
</tr>
</thead>
<tbody>
<tr>
<td>IP Office of New Zealand</td>
<td><a href="http://www.iponz.govt.nz">http://www.iponz.govt.nz</a></td>
<td>New Zealand patents, trade marks, and designs</td>
</tr>
<tr>
<td>Canadian IP Office</td>
<td><a href="http://patents1.ic.gc.ca/intro-e.html">http://patents1.ic.gc.ca/intro-e.html</a></td>
<td>Canadian patents</td>
</tr>
<tr>
<td>Esp@cenet (hosted by European Patent Office)</td>
<td><a href="http://ep.espacenet.com">http://ep.espacenet.com</a></td>
<td>Patents worldwide</td>
</tr>
<tr>
<td>US Copyright Office</td>
<td><a href="http://www.copyright.gov">http://www.copyright.gov</a></td>
<td>US copyright</td>
</tr>
</tbody>
</table>
**Commercial databases**

Commercial databases provide access to online viewing of registered IP documents at a membership cost. These databases provide a more comprehensive search capability, offer more tools and features, usually have IP documents from several jurisdictions (i.e. cross-referencing) and can sometimes be industry-specific. Generally speaking, subscription databases are more information rich.

<table>
<thead>
<tr>
<th>Commercial Databases</th>
<th>Web Address</th>
<th>Types of IP</th>
</tr>
</thead>
<tbody>
<tr>
<td>Delphion</td>
<td><a href="http://www.delphion.com">http://www.delphion.com</a></td>
<td>Patents</td>
</tr>
<tr>
<td>DialogWeb</td>
<td><a href="http://www.dialogweb.com">http://www.dialogweb.com</a></td>
<td>Patents, Trade Marks, Copyrights</td>
</tr>
<tr>
<td>Derwent &amp; Dialog IP</td>
<td><a href="http://www.dialogselect.com/ip/index.html">http://www.dialogselect.com/ip/index.html</a></td>
<td>Patents, Trade Marks, Copyrights</td>
</tr>
<tr>
<td>Get the Patent</td>
<td><a href="http://www.getthepatent.com">http://www.getthepatent.com</a></td>
<td>Patents</td>
</tr>
<tr>
<td>Nerac</td>
<td><a href="http://www.nerac.com">http://www.nerac.com</a></td>
<td>Patents</td>
</tr>
<tr>
<td>Software Patents Institute</td>
<td><a href="http://www.spi.org">http://www.spi.org</a></td>
<td>Patents</td>
</tr>
<tr>
<td>Trade Mark Bots</td>
<td><a href="http://www.trademarkbots.com">http://www.trademarkbots.com</a></td>
<td>Trade Marks</td>
</tr>
</tbody>
</table>

**Searching strategies**

Most of the databases mentioned allow multiple searching criteria to be employed. Where patent records are concerned, this includes:

- applicant name and country of origin
- title
- application number
- patent number
• inventors name(s) and country of origin
• priority date, filing date and country of filing
• publication date
• grant date
• international Patent Classification (IPC)
• whole of text (keyword)
• combinations of these criteria


The IPC divides all subject matter into a particular class, with five levels of granularity. At the top level, the classification is:

A. Human Necessities
B. Performing Operations; Transporting
C. Chemistry; Metallurgy
D. Textiles; Paper
E. Fixed Constructions
F. Mechanical Engineering; Lighting; Heating; Weapons; Blasting
G. Physics
H. Electricity

At the lowest level, an IPC Class is represented as, for example, 'H01S 3/14 Lasers characterised by the material as the active medium'.

It is possible to search patent databases for broad classifications, for example: ‘H01S 3/00 Lasers’, or ‘H01S Devices using stimulated emission’.

As a word of caution, each patent record can be ascribed more than one IPC class, and sometimes a misallocation can occur.

Additionally, there is a separate US Patent Classification (USPC) system, which adopts a subject matter different to taxonomy than the IPC. The USPC is used only by the US Patent and Trademark Office. USPTO patent records are searchable by both USPC and IPC. A concordance exists between the two systems.

More information regarding the USPC system can be found at: http://www.uspto.gov/go/classification/uspcindex/uspcindex.htm.

How to read a patent specification

Each patent application provides information about the inventor(s) and the owner(s), and includes a patent specification. A patent specification is a detailed technical description of the invention, usually accompanied with drawings, and with ‘claims’ defining its scope of protection. The specification will not, however, usually include
manufacturing specifications (i.e. exact dimensions or operating parameters), unless they are critical to the way the invention operates.

Reading a patent specification is not a difficult skill to develop. All patent specifications have the same format. To locate the relevant information you require, you will need to understand what each heading in the patent specification signifies, as outlined in the following table.

<table>
<thead>
<tr>
<th>Heading</th>
<th>Content</th>
</tr>
</thead>
<tbody>
<tr>
<td>Abstract</td>
<td>Brief summary of the key features of the invention.</td>
</tr>
<tr>
<td></td>
<td>However, do not rely on the Abstract as accurately representing the whole information content of the specification.</td>
</tr>
<tr>
<td>Title</td>
<td>The name of the invention.</td>
</tr>
<tr>
<td>Technical field</td>
<td>The technical field at which the invention is directed.</td>
</tr>
<tr>
<td>Description of background art</td>
<td>Description of the relevant background technological development within the field, including a description of the problems or needs of that art which are addressed by the invention.</td>
</tr>
<tr>
<td>Object(s) of the invention</td>
<td>The aims of the invention.</td>
</tr>
<tr>
<td>Disclosure/Summary of the invention</td>
<td>This section may include advantages of the embodiments of the invention. This section is usually consistent with the broadest claims.</td>
</tr>
<tr>
<td>Brief description of the drawings</td>
<td>Description of any accompanied drawings of the preferred embodiment(s) of the invention.</td>
</tr>
<tr>
<td>Detailed description</td>
<td>Description of the best method and other methods of performing the invention enabling a person skilled in the field of the invention to make and operate the invention. Where a specification is being read as a source of information this section will contain the most useful information.</td>
</tr>
<tr>
<td>Industrial application</td>
<td>Description of how the invention can be applied industrially.</td>
</tr>
</tbody>
</table>
These are single sentence statements that define the invention in broad terms, and thus the scope of protection. The claims are used to determine whether there is an infringement of the patent.

The first claim is usually of the broadest scope.

Drawings of the preferred embodiment(s) of the invention, and any examples, to be read in conjunction with the detailed description.

Planning for re-use of designs

When creating a product, it is common for researchers or design engineers to re-use existing design components. For more information on design re-use see Australian Microelectronics Network, Design Re-use and Intellectual Property.

Re-use of existing designs may:
• reduce costs and time to complete the product
• improve reliability
• ensure better compliance with existing standards
• increase inter-operability with other products, and
• increase confidence of commercial success.

However, it must be remembered that the whole or parts of each electrical or electronic product made in the course of research, development and design may contain valuable IP. Whenever you are re-using a component of a product, you are likely to be re-using IP. Unless you own the IP rights in the component, you may be infringing a third party’s IP rights.

Below are some examples of re-use that may lead to infringement of third party IP rights.

<table>
<thead>
<tr>
<th>Subject Matter for Re-Use</th>
<th>Type(s) of Third Party IP Rights that may be infringed</th>
</tr>
</thead>
<tbody>
<tr>
<td>Hardware</td>
<td>Patent, Registered Design, Circuit Layout.</td>
</tr>
</tbody>
</table>

Experimental use

Experimental use of a patented apparatus or method for conducting research and development has not been considered judicially in Australia, and so there is uncertainty as to the scope of this exception to patent infringement.
In a report by the Australian Government Advisory Council on Intellectual Property (ACIP)’s ‘Patents and Experimental Use’ (2005), it was advised that ‘in some circumstances, use of a patented invention for experimental or research purposes would not constitute an infringement of a patent registered under the Act’.

However, not all commentary would agree with this position and the status of the law on experimental use does not necessarily follow this report. The position is unpredictable, and it is recommended that use of a patented apparatus or method with a view to leverage an improved apparatus or method should only be used with a research licence from the patent owner.

Seek advice from patent attorney or lawyer before using any patented apparatus or method for experimental use, research and development.

**Re-using software**  
Software is also commonly the subject of re-use within the electrical and electronics industry. This is because software is flexible and may be copied, modified and tested readily.

**Breach of copyright**  
Software is protected by copyright. Breach of copyright will occur if, without permission from the copyright owner, you (or if you authorise someone to) copy the entire or even a small, significant part of the following items which belongs to a third party:

- source or object code
- expression of an idea in a program, or
- flow chart of modules or functions used to develop the software.

Practically, there may be infringement of copyright if you:

- develop or distribute another version of existing software
- reverse engineer software, or
- develop interoperative programs (subject to certain exceptions).

There is a risk even if the software you use is ‘open source’ (where the source code is available publicly); ‘freeware’ (where the software is freely accessible, but the source code is retained by the developer); or ‘shareware’ (‘try before you buy’ software). Although these types of software may be accessible for free (at least for a limited period), often they are subject to conditions of use.

For more information on infringement of copyright, see Chapter 2 ‘What Everyone Should Know’.

**Breach of moral rights**  
If you are potentially infringing copyright of a third party, you also risk infringing moral
rights. Moral rights are personal rights protecting the integrity and right of attribution of the creator/author granted under the Copyright Act.

Subject to conditions where consent may be deemed, infringement of moral rights may occur if you (or if you authorise someone to):

- deal with the software without identifying the creator
- represent or imply that the software is created by a person other than the creator
- falsely attribute the software, or
- deal with falsely attributed software.

For more information on infringement of moral rights, see Chapter 2 ‘What Everyone Should Know’.

**Breach of contract or confidence**

Often software is made available as confidential information under contractual relationships. Software may also be supplied with other contractual restrictions, e.g. for a specific use only. If software (subject to contractual or confidential obligations) is re-used, there may potentially be breach of contract or breach of confidence. Common scenarios where breach of contract may occur include researchers or designers reverse engineering software (if it is prohibited to do so). Breach of confidence may occur where researchers or designers re-use software which is subject to confidentiality obligations, such as software developed:

- whilst they were employed by their former employers, or
- for a collaboration for a particular use, and the project did not proceed.

For more information on breach of confidentiality obligations, see Chapter 2 ‘What Everyone Should Know’.

**Infringement of patent**

Patents are increasingly being used to protect a wide range of software. It is possible in some countries to protect the source code as an electrical signal (i.e. at run-time), or the source code carried on a storage medium. An algorithm (e.g. Lempel-Ziv-Welch lossless data compression algorithm - see US Patent No. 4,558,302) embodied in software can be protected as a method. In some countries patent protection for software is more problematic, and it is necessary to show that the software solves a technical problem by a technical solution.

Infringement of a patent is a question of fact and depends on whether the activity conducted falls within a patent claim. Importantly, infringement of patents may be direct or contributory (e.g. supplying software that would infringe a patent at run-time).

For more information on infringement of patents, see Chapter 2 ‘What Everyone Should Know’.
It has become easier to re-use hardware designs or sections of hardware designs with the advance of hardware description languages (HDLs). In addition, researchers or design engineers may wish to re-use certain modules that are fully laid out and characterised.

Hardware is often protected by registered IP rights, such as patent and designs. Infringement of patents is discussed earlier in this Chapter under ‘Infringement of Patent’.

Infringement of design rights will occur if, without permission from the rights owner, you (or if you authorise someone to):

- copy the outward appearance of a hardware product, or
- create a hardware the appearance of which is substantially similar in overall impression to a product protected by a registered design.

For more information on infringement of registered design rights, see Chapter 2 ‘What Everyone Should Know’.

If the hardware components you are trying to re-use consist of semiconductors and integrated circuits, you may breach ‘eligible layout’ rights conferred by the Circuit Layout Act 1989 (Cth) if, without permission from the rights owner, you (or if you authorise someone to):

- copy the circuit layout in material form
- manufacture the integrated circuits according to the layout, or
- commercially exploit plans of the layout.

The circuit layout is in effect each mask used in the fabrication of an integrated circuit (i.e. a two-dimensional representation of the three-dimensional location of the active and passive elements and interconnections making up an integrated circuit).

However, eligible layout rights are not infringed if a circuit layout is copied or when an integrated circuit is made according to a layout for the purpose of:

- private use
- research or teaching, or
- evaluation or analysis.

Reverse engineering a circuit layout may be permissible if your new circuit layout is not a mere copy but is created utilising information gathered from the analysis of a third party’s layout. For more information on infringement of eligible layout rights, see Chapter 2 ‘What Everyone Should Know’.
The electrical and electronics industry incorporates the word ‘IP’ in their terminology when referring to different types of traded IP, sometimes known as ‘IP Cores’. IP Cores, very generally, refers to particular portions of a chip or blocks of functional and re-usable components that may be:

- used within a company’s internal operation (‘Star IP’)
- offered to others as part of a design service, or
- sold as separate functional components for new designs (‘Commodity IP’).

These are in essence a subset of IP which may be subject to IP protection.

Companies that supply Commodity IP are known as Electronic Design Automation (EDA) vendors, Field-Programmable Gate Array (FPGA) or Silicon IP vendors. They offer a range of re-useable Commodity IP, including:

- hard and soft re-useable IP cores
- design blocks, and
- ‘integration platforms’ for a broad range of digital applications, (such as DSP processors, encoders/decoders, bus interfaces, micro-processors, memories, micro-controllers, and related data communication cores).

Star IP is characteristically core to a company’s business and is unlikely to be generally available and traded.

Listed below are some of the major EDA vendors that trade Commodity IP:

<table>
<thead>
<tr>
<th>EDA vendor</th>
<th>Website</th>
</tr>
</thead>
<tbody>
<tr>
<td>ARM Holdings</td>
<td><a href="http://www.arm.com">http://www.arm.com</a></td>
</tr>
<tr>
<td>Cadence</td>
<td><a href="http://www.cadence.com">http://www.cadence.com</a></td>
</tr>
<tr>
<td>Ceva</td>
<td><a href="http://www.ceva-dsp.com">http://www.ceva-dsp.com</a></td>
</tr>
<tr>
<td>LogicVision</td>
<td><a href="http://www.logicvision.com">http://www.logicvision.com</a></td>
</tr>
<tr>
<td>Mentor Graphics</td>
<td><a href="http://www.mentor.com">http://www.mentor.com</a></td>
</tr>
<tr>
<td>MIPS Technologies</td>
<td><a href="http://www.mips.com">http://www.mips.com</a></td>
</tr>
<tr>
<td>Monolithic System Technology</td>
<td><a href="http://www.mosys.com">http://www.mosys.com</a></td>
</tr>
<tr>
<td>Rambus</td>
<td><a href="http://www.rambus.com">http://www.rambus.com</a></td>
</tr>
</tbody>
</table>
### Reducing the Risk of Infringement in Design Re-use

Failure to consider IP early in the design process may delay, or entirely prevent, the completion of the project, as your organisation may be unable to use your final product due to IP infringement issues. In some instances, the cost of completing the project may drastically increase if you are required to seek a licence to a particular piece of third party IP, which you have already incorporated into your product. Risks of IP infringement may be reduced by a number of measures. These are outlined below.

### Performing freedom to operate searches

If you know the IP landscape (the type and degree of IP protection held by your organisation and others) of your project at an early stage, you can plot a course around the IP barriers or negotiate for permission to use the IP. Freedom to operate searches may assist you in ascertaining whether the design components or software you plan to use in your design process will infringe IP rights of another party.

A freedom to operate search is an infringement search conducted on registered or published pending IP rights (such as patents or designs) to determine whether use or commercialisation of a component, a product or a method will infringe the registered or pending IP rights. Since IP rights are territorial by nature, you will need to conduct a freedom to operate search in each relevant country for the component, product or method you wish to use.

Freedom to operate searches are often performed by IP professionals who will provide a legal opinion on whether there is any infringement of existing IP rights. However, you should be aware that freedom to operate searches are often subject to time and resource constraints and the search may not locate key documents that were unpublished at the time of the search. It is for this reason infringement searches should be conducted periodically to avoid missing patents or designs unpublished at the time of the earlier search.

### Considering IP in your design process

Before re-using any existing IP it is imperative that you check who owns the IP rights in the design component you would like to incorporate in your product. If you do not own the IP rights to the design component, seek authorisation to use the component (e.g. by licence) from the IP owner before using it.

<table>
<thead>
<tr>
<th>EDA vendor</th>
<th>Website</th>
</tr>
</thead>
<tbody>
<tr>
<td>Synopsys</td>
<td><a href="http://www.synopsys.com">http://www.synopsys.com</a></td>
</tr>
<tr>
<td>Virage Logic Corp</td>
<td><a href="http://www.viragelogic.com">http://www.viragelogic.com</a></td>
</tr>
</tbody>
</table>

For further listings of EDA vendors, see the Silicon IP Catalogue at Design & Reuse’s website: http://www.us.design-reuse.com/sip/
Set out below are some steps to assist you to plan your design process from an IP perspective:

**Step 1: Listing design components**

While planning your design process, list all design components which you would like to include and their anticipated use in a ‘Design Process IP Checklist’. It will be best practice to identify all the possible components required for the project (even if you believe some components may have been generated in-house) and include it in the Design Process IP Checklist. The type of IP rights and other possible legal rights attached to each component should also be identified.

For more information on what type of IP rights may apply to different design components, see Chapter 2 ‘What Everyone Should Know’.

An example Design Process IP Checklist is set out below:

<p>| Project Name: Real-Time Operating System (RTOS) XYZ for computers in Client Pty Ltd |</p>
<table>
<thead>
<tr>
<th>Design Component</th>
<th>Anticipated Use in Project</th>
<th>Possible IP Type or Legal Rights Attached</th>
</tr>
</thead>
<tbody>
<tr>
<td>Software module: RTOS No.123-4</td>
<td>To be used as the core basis for the creation of the new RTOS.</td>
<td>Patent, copyright, moral rights, confidential information and other contractual restrictions</td>
</tr>
<tr>
<td>Software module: Calculator 123-4</td>
<td>To be used as a functional component in the new RTOS.</td>
<td>As above</td>
</tr>
<tr>
<td>Software module: ABC</td>
<td>To be used as a functional component in the new RTOS.</td>
<td>As above</td>
</tr>
<tr>
<td>Software module: XYZ</td>
<td>To be used as a functional component in the new RTOS.</td>
<td>As above</td>
</tr>
</tbody>
</table>
Design Component | Anticipated Use in Project | Types of IP
--- | --- | ---
Graphic design: Graphic design for the interface of RTOS No. 123-4 | To be adapted and used in the new RTOS. | Copyright, moral rights, and other contractual restrictions.

Clip art: Clip art 123-4 | To be used as an icon the new RTOS. | Registered design rights, copyright, moral rights, and other contractual restrictions.

Step 2: Identifying the holder of the IP rights

Once you have identified the IP rights and other legal rights attached to the required design component, you will need to determine who owns the relevant IP and legal rights.

If the design component is generated in-house by employees, it is likely that the IP rights are owned by your organisation. If the design component is generated by a contractor, the default position (in Australia) is that the contractor will own the IP unless otherwise stated in the terms of the contract between the contractor and your organisation. For more information on ownership of IP, see Chapter 6 ‘What Senior Management Must Know’.

If your organisation does not own the IP rights in the component, you will need to seek authorisation from the relevant IP owner before any use is made of it. It is an infringement of IP rights if you use the component before authorisation is obtained.

If a product is protected by registered IP rights, it is common that markings or notifications are found on the packaging materials. For instance, a copyright notice will usually include the name of the owner. Patent numbers (or other IP registration numbers) included in the packaging materials will often assist you in your search on the relevant IP registers to identify the owner of the relevant IP rights. For more information on IP registers and databases, see section ‘Online IP databases’ of this Chapter.

Owners of Commodity IP should be readily identifiable from the source of the Commodity IP. In some instances, owners of the IP rights may not be readily identifiable and further investigation may be required. You may wish to consult your legal adviser on such occasions.

List the relevant IP right holders in the Design Process IP Checklist you generated in Step 1.
<table>
<thead>
<tr>
<th>Design Component</th>
<th>Anticipated Use in Project</th>
<th>Possible IP Type or Legal Rights Attached</th>
<th>IP/ Legal Rights Holder</th>
</tr>
</thead>
<tbody>
<tr>
<td>Software module: RTOS No.123-4</td>
<td>To be used as the core basis for the creation of the new RTOS.</td>
<td>Patent, copyright, moral rights, confidential information and other contractual restrictions.</td>
<td>Patent and copyright is owned by Real Time Pty Ltd.</td>
</tr>
<tr>
<td>Software module: Calculator 123-4</td>
<td>To be used as a functional component in the new RTOS.</td>
<td>As above.</td>
<td>Open Source, conditions attached to Open Source licence. For more information on Open Source licensing, see Chapter 5 ‘What Managers Making IP Protection Decisions Must Know’.</td>
</tr>
<tr>
<td>Software module: ABC</td>
<td>To be used as a functional component in the new RTOS.</td>
<td>As above.</td>
<td>Commodity IP owned by MacroSoft, Inc.</td>
</tr>
<tr>
<td>Software module: XYZ</td>
<td>To be used as a functional component in the new RTOS.</td>
<td>As above.</td>
<td>Software generated by in-house employees.</td>
</tr>
<tr>
<td>Graphic design: Graphic design for the interface of RTOS No. 123-4</td>
<td>To be adapted and used in the new RTOS.</td>
<td>Copyright, moral rights, and other contractual restrictions.</td>
<td>Copyright is owned by Real Time Pty Ltd.</td>
</tr>
<tr>
<td>Clip art: Clip art 123-4</td>
<td>To be used as an icon the new RTOS.</td>
<td>Registered design rights, copyright, moral rights, and other contractual restrictions.</td>
<td>Registered design rights and copyright are owned by Iconic Ltd.</td>
</tr>
</tbody>
</table>
Once the identity of the IP owner has been ascertained, you will need to seek appropriate authorisation from the owner for your proposed use of the IP. Remember that not all use of another’s IP will require permission. For example, some use of a circuit layout may be authorised under the Circuit Layout Act, such as those activities outlined in section ‘Re-using Hardware Design’ of this Chapter.

In some instances, where you acquire a component and incorporate it in your design process in accordance with the terms under which you acquire the component, permission will not be required.

However, you should be aware that ‘purchasing’ a design component (e.g. to buy software off the shelf) does not mean you are able to deal with that design component in any manner. The IP right in that design component may not ‘exhaust’ or become lost entirely following a sale of that component. If you wish to deal with a design component in any other way than initially agreed (e.g. under the sales terms and conditions), you will need authorisation from the IP owner to do so, otherwise you will be infringing their IP rights.

In general, if your use of the IP amounts to an infringement of the IP rights, permission or consent from the IP rights holder will be required. For more information on when an activity constitutes an infringement for different types of IP (including foreign IP rights), see Chapter 2 ‘What Everyone Should Know’.

The process of seeking appropriate authorisation may be relatively straight-forward, or may require more time than expected. Therefore obtain the permission as early as possible and always before any use is made of the component.

A licence is the usual mode of authorisation. A licence agreement will define the terms and conditions of use, payment structure for the use, and preferably set out the IP ownership rights the final product. For more information on acquiring IP components, see the section ‘Obtaining Rights to Third Party IP for Design Re-Use’ of this Chapter.

It will be good practice to include applicable comments in the Design Process IP Checklist as to whether any required authorisation has been obtained and the conditions of that authorisation.
<table>
<thead>
<tr>
<th>Design Component</th>
<th>Anticipated Use in Project</th>
<th>Possible IP Type or Legal Rights Attached</th>
<th>IP/ Legal Rights Holder</th>
<th>Permission obtained?</th>
<th>Conditions for Anticipated Use</th>
</tr>
</thead>
<tbody>
<tr>
<td>Software module: RTOS No.123-4</td>
<td>To be used as the core basis for the creation of the new RTOS.</td>
<td>Patent, copyright, moral rights, confidential information and other contractual restrictions.</td>
<td>Patent and copyright is owned by Real Time Pty Ltd.</td>
<td>Licence owned by Client Pty Ltd does not authorise anticipated use.</td>
<td>Fresh licence under negotiation.</td>
</tr>
<tr>
<td>Software module: Calculator 123-4</td>
<td>To be used as a functional component in the new RTOS.</td>
<td>As above.</td>
<td>Open Source, conditions attached to Open Source licence.</td>
<td>Not required for anticipated use provided licence conditions are observed.</td>
<td>MIT licence condition. Need to check with Client Pty Ltd whether the conditions are acceptable.</td>
</tr>
<tr>
<td>Software module: ABC</td>
<td>To be used as a functional component in the new RTOS.</td>
<td>As above.</td>
<td>Commodity IP owned by Macro-Soft, Inc.</td>
<td>Commodity IP acquired through standard licence offered by Macro-Soft.</td>
<td>Subscription based licence.</td>
</tr>
<tr>
<td>Software module: XYZ</td>
<td>To be used as a functional component in the new RTOS.</td>
<td>As above.</td>
<td>Software generated by in-house employees.</td>
<td>Not required.</td>
<td>N/A</td>
</tr>
<tr>
<td>Graphic design: Graphic design for the interface of RTOS No. 123-4</td>
<td>To be adapted and used in the new RTOS.</td>
<td>Copyright, moral rights, and other contractual restrictions.</td>
<td>Copyright is owned by Real Time Pty Ltd.</td>
<td>Licence under negotiation.</td>
<td>To be advised.</td>
</tr>
<tr>
<td>Clip art: Clip art 123-4</td>
<td>To be used as an icon the new RTOS.</td>
<td>Registered design rights, copyright, moral rights, and other contractual restrictions.</td>
<td>Registered design rights and copyright is owned by Iconic Ltd.</td>
<td>Clip art acquired through standard licence offered by Iconic.</td>
<td>Unlimited use for one off fee.</td>
</tr>
</tbody>
</table>
Below is a general checklist of activities which may reduce risks of IP infringement when designing products.

<table>
<thead>
<tr>
<th><strong>Checklist for Avoiding IP Infringement</strong></th>
</tr>
</thead>
<tbody>
<tr>
<td>Before using any IP components, ensure your organisation owns it, or has the authorisation to use it for the purpose required for your design process (including to reverse-engineer or decompile).</td>
</tr>
<tr>
<td>Ensure partners working on joint-projects have the necessary rights and permissions to use the IP they are contributing to the project.</td>
</tr>
<tr>
<td>Read and comply with the terms and conditions of use for all IP used, including those available as open source or available ‘free’.</td>
</tr>
<tr>
<td>Avoid using the same development tools to generate a program with similar functions to another’s program. Instead analyse the function by observing the operation of the program, or studying the manual and (subject to contractual obligations) before developing the program.</td>
</tr>
<tr>
<td>Require written confirmation of originality from anyone who creates IP for the organisation.</td>
</tr>
<tr>
<td>Consider using material available in the public domain. However, check whether there are applicable conditions attached to the material.</td>
</tr>
<tr>
<td>Write the application’s manual yourself. Avoid copying unless there is permission in writing to use the material copied.</td>
</tr>
<tr>
<td>Always document all stages of research and development in a laboratory notebook or design workbook.</td>
</tr>
<tr>
<td>Check whether new employees are subject to any confidentiality restrictions imposed by their former employer or any other persons. Keep a record of such restrictions.</td>
</tr>
<tr>
<td>Ensure employees under confidentiality restrictions do not work on projects where the work is potentially covered by those obligations.</td>
</tr>
<tr>
<td>Where an idea or information that is disclosed to the organisation was already known or is later disclosed by another source, notify the other party at the time. Record this notification and the basis for it.</td>
</tr>
<tr>
<td>Monitor the market for new patents or other IP in trade press or through industry forums.</td>
</tr>
<tr>
<td>Conduct periodic ‘freedom to operate’ searches on the Patent Register.</td>
</tr>
</tbody>
</table>
Checklist for Avoiding IP Infringement

Ensure that the chain of title for licensed material has been properly linked from all IP owners.

Seek assistance from a lawyer to ensure that the scope of any licence negotiated is broad enough to include both present and anticipated uses of the material licensed (e.g. new technology). Ensure the agreement covers issues concerning ownership, who have commercialisation rights, and how commercialisation proceeds are shared.

Ensure confidentiality agreements are in place before discussing any ideas with partners with whom the organisation may be collaborating.

Obtain moral rights consents from creators of works permitting the organisation to use the work in any way.

Where practicable, identify the creator before using their work. Check and confirm the identity of the creator before acknowledging him/her. Crediting another person who is not the creator is an infringement of moral rights.

Obtaining rights to third party IP for design re-use

When obtaining rights to third party IP (including Commodity IP) for design re-use, there are several things which require your consideration. Importantly, the terms and conditions under which the third party IP is bought or licensed need to be carefully reviewed. At a minimum, you should examine the following:

- payment structure
- restrictions on use of the IP in question
- product warranties
- maintenance and support, and
- general warranty (e.g. on IP ownership and non-infringement).

Payment structure

Typical payment structures may include any one or a combination of the following:

- lump sum (one-off upfront fee)
- per use based (fee for each use of the IP on defined use scope)
- time based (multiple uses of the IP over a period of time)
- royalty based (fee charged when the IP is exploited), or
- subscription based (fee for accessing the IP over a period of time).

Warranties, indemnities and other contractual rights

A warranty is a statement in a contract asserting a factual position. Examples of warranties include warranties confirming:
the third party owns the IP or has adequate rights to grant the licence
registrable IP rights are being maintained
the IP does not knowingly infringe the IP right of another party.

You may further require the third party to indemnify your organisation against any claims by another person (e.g. a claim that the relevant IP infringes his/her rights).

The inclusion of a warranty or indemnity in a licence agreement (and the extent of the warranty and indemnity) is technical and will depend on the particular circumstances of a transaction. It is recommended that you consult your legal adviser for such matters (especially when the transaction is complex).

**Conducting due diligence**

Due diligence is an information gathering and analytical process to ensure (to the extent possible) that the third party actually owns the IP or is able to grant the purported IP rights under the proposed terms and conditions.

In the context of acquiring third party IP, the due diligence process typically involves requesting the third party to, at a minimum, furnish evidence that:

- the IP rights exist
- it owns the IP or has adequate rights to grant the IP rights in the purported licence, and
- the IP rights are valid.

For example, the third party may produce evidence of a granted patent for the IP concerned which shows that it is the owner and that all maintenance fees have been paid.

The scope (and cost) of a due diligence process will depend on the nature of the transaction. For more complex transactions (e.g. seeking an IP licence on an exclusive basis), or where the contract amount is substantial, a more extensive due diligence process may be justified.

**Identifying Inventive Subject Matter**

Researchers and design engineers in the electrical, electronics and software fields generate IP regularly. However, not all IP generated is sufficiently ‘inventive’ to gain patent protection. Among all the requirements for patent registration, the requirement of inventiveness (or non-obviousness) is generally considered to be the most difficult to achieve. With the rapid advancement of technology in the electrical and electronics industry, what is inventive today may well be obvious tomorrow.

This section discusses some of the criteria for assessing the patent requirement of inventiveness to assist researchers and designers to identify inventive subject
matter generated in a research or design process. For more information on other requirements for patent registration, see section ‘Patents’ in Chapter 2 ‘What Everyone Should Know’.

In Australia, the test for assessing inventiveness for a standard patent is, generally speaking:

‘Would the invention be obvious to an ordinarily skilled worker in the field in Australia at the priority date when considered against the closest prior art in light of the common general knowledge at the time?’

This is not necessarily a straight-forward question, and so the courts look to a number of factors to assist them with such an assessment:

<table>
<thead>
<tr>
<th>Factors</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>Imitations by rivals</td>
<td>Evidence of copying by rivals is a strong indication of inventiveness.</td>
</tr>
<tr>
<td>Unexpected results</td>
<td>Evidence of comparative testing with the closest prior art that results in unexpected or surprising results is a strong indication of inventiveness.</td>
</tr>
<tr>
<td>Solutions to unsolved problems</td>
<td>Providing a solution to an unsolved problem may indicate that the new invention is non-obvious.</td>
</tr>
<tr>
<td>Unrecognised problem</td>
<td>Providing a solution to a previously unrecognised problem is a strong indicator of non-obviousness.</td>
</tr>
<tr>
<td>Omission of an element</td>
<td>Omission of a part, ingredient or step in a process may indicate inventiveness.</td>
</tr>
<tr>
<td>Long felt need</td>
<td>Satisfaction of market demands may indicate inventiveness.</td>
</tr>
<tr>
<td>Congested art</td>
<td>A seemingly small inventive leap is non-obvious if the invention lies within a crowded art.</td>
</tr>
<tr>
<td>Assumed unworkability</td>
<td>Making something previously considered unworkable workable is an indication of inventiveness.</td>
</tr>
<tr>
<td>Unappreciated advantage</td>
<td>A previous unrecognised inherent advantage can be an indicator of non-obviousness.</td>
</tr>
<tr>
<td>Weak prior art</td>
<td>Proving that the prior art is inoperative, vague, conflicting, misunderstood or never implemented may strengthen the indication of inventiveness.</td>
</tr>
</tbody>
</table>
Factors | Explanation
---|---
Acceptance by industry | Evidence of trade articles, industry statements, requests for licences and industry restraint from infringing or challenging the invention can indicate inventiveness.
Commercial success | This does not demonstrate inventiveness but can be a strong indicator that the invention was needed by the market, which may help in borderline cases for registration.

Below are some examples of patentable inventions demonstrating inventive step:

- where a new combination of existing features results in an improved result (a new combination of existing features without an improved result is not an invention)
- where solutions are developed to resolve technological problems or limitations of the field
- where there is an omission of a stage in the process or unnecessary ingredient or a part of technology, and
- where there is a new and useful selection among members of a class of substances from which selection the inventor is able to produce new and useful results or old results in a cheaper or better manner.

Whenever you believe (taking into account the above criteria) there are good grounds that inventive subject matter is created, it is important that you capture the inventive subject matter in an invention disclosure document.

The invention disclosure document will be evaluated by management to determine the best form of IP protection to apply to the invention. Management may seek the advice of a patent attorney who will assist your organisation to determine whether formal protection of a patent registration is appropriate, or whether treating the invention as confidential information is more suitable.

A properly completed invention disclosure document (signed, dated and witnessed) is critical when trying to establish the date of invention. The date of invention is particularly important to filing patent applications in the United States, where patents are granted on a ‘first-to-invent’ basis.

A standard invention disclosure form may already exist within your organisation. All invention disclosure forms vary in format and style, but they should all essentially ask the same questions. Below is an example of an invention disclosure form:
CONFIDENTIAL

INVENTION DISCLOSURE FORM

Submitted by:

Date:

Please complete the following items and return a copy to:

[Insert Management contact details]

1. Individuals who contribute to the invention:

<table>
<thead>
<tr>
<th>Full name</th>
<th>Contact information</th>
<th>Department</th>
<th>Employee or Contractor?</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

2. Title of invention:

3. Abstract:

4. Was any part of the project externally funded and by whom (e.g. third-party or a government contract)? Provide contact details.

5. Date of first conception (dd/mm/yyyy):

   Identify any written evidence of this date (e.g. drawings, sketches, project notebooks, files) and/or names of any corroborating witnesses.

6. Has the invention been described in specific detail or in a general way in a publication? Has the invention been disclosed, sold or offered for sale to anyone? If so, please describe to whom and under what conditions (e.g. confidentiality agreement, beta test agreement) and provide relevant dates. **This is extremely important.**

<table>
<thead>
<tr>
<th>Type of disclosure</th>
<th>To whom</th>
<th>Conditions</th>
<th>Date (dd/mm/yyyy)</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

7. Are there any plans to publish or orally disclose a description of the invention in the next 12 months? Provide dates (dd/mm/yyyy).

8. List any websites, publications, patents, products, services, etc (i.e. prior art) that you are aware of that are similar to or discusses the subject matter of the invention.

9. Why do you think this invention is strategically important to the organisation?

10. Are there any organisation products/services/projects that utilise or may utilise the invention?
11. State the problem(s) you were trying to solve:
   
   a. Have others tried to solve the same problem? If so, describe how:
   
   b. Describe how your invention solves the problem and any other advantages of the invention. Provide a description as detailed as possible, in order for another person to 'build' the invention without any inventive effort of their own.
   
   c. Please attach or identify any drawings, sketches, project notes, documents, etc that describe the details of the invention.

12. Additional information:

**WITNESS: I have read and understood this Invention Disclosure Form:**  
[The witness should be a manager, rather than a co-worker or collaborator]

Printed name: 

Signature: 

Date:
Identifying the Inventor

Who is the inventor?

A patent for an invention may only be granted to the inventor or persons claiming ownership through the inventor. Correctly naming the inventors can be crucial to a patent application. There will often be more than one inventor.

If a mistake or omission is made in naming an inventor, there may be serious consequences. In the extreme case, this can include the patent being wholly invalidated. An ‘inventor’ is not defined in the Patents Act 1990.

There is little judicial guidance on determining inventorship, however the Australian Patent Office has provided two tests that are of assistance.

‘But For’ Test

A person is the inventor of an invention where the invention would not have occurred but for the involvement of that person, *Harris v CSIRO* (1993) 26 IPR 469.

‘Material Effect’ Test

A person is the inventor of an invention where his/her contribution had a material effect on the final concept of the invention, *Row Weeder v Nielsen* (1997) 39 IPR 400.

The issue of ‘inventorship’ should not be confused with ‘ownership’ or ‘authorship’ in the context of publications. ‘Inventorship’ is identifying the inventor of the invention, ‘ownership’ is identifying who is entitled to possess the patent rights in the invention and ‘authorship’ is identifying who has authored a particular publication. The inventor and the owner of an invention may not necessarily be the same entity. An author of a publication may not necessarily be an inventor.

Identifying joint inventors

It is common in the electrical and electronics industry for a team of researchers and design engineers to work together to produce an invention. As a result, doubt may arise as to who has contributed to the invention and should be regarded as a joint inventor. Two or more persons will be a joint inventor of an invention where the invention only came about because of the involvement of both of those persons.

The ‘but for’ test and ‘material effect’ test (above) may help to determine and identify joint inventors; however there are some indicators of joint inventorship that may also assist:
Is a Joint Inventor | Not a Joint Inventor
---|---
Materially contributes to the ultimate development of the invention | Merely following instructions
Solves a problem not recognised by initial inventors | Merely performing routine work
Solves a recognised problem that initial inventors could not solve | Merely engaged to construct an article to another’s design
Produced an advantage not contemplated by initial inventors | Merely puts forward a hypothesis

For more information on research collaborations, see section ‘Research Collaborations’ in Chapter 6 ‘What Senior Management Must Know’.

Managing IP in Research and Design Practices

Keeping laboratory notebooks and design workbooks

Laboratory notebooks and design workbooks should ideally record all your research and development activities. Information set out in the notebooks must be clear, dated and sufficiently record all relevant activities undertaken to develop a product.

Where an invention is generated in the course of product development, properly kept laboratory notebooks and design workbooks (i.e. in addition to properly prepared Invention Disclosures) may be critical substantive evidence in establishing the date of invention in the event of a patentability contest in a jurisdiction where patents are awarded on a ‘first to-invent’ basis, such as the United States. These workbooks also provide objective evidence of who is/are the inventor(s).

You should ensure and encourage those under your supervision to keep laboratory notebooks and design workbooks up-to-date. Avoid letting days go by without making an entry. Meticulous recordkeeping will ensure that each stage of development of the project is protected. Below is a general checklist for good laboratory notebooks and design workbooks keeping practices:

**General Checklist of Laboratory Notebooks and Design Workbooks**

- Entries written up in a consecutively numbered notebook.
- The notebook must be properly bound so that pages cannot be removed or inserted.
- Permanent ink used.
<table>
<thead>
<tr>
<th>General Checklist of Laboratory Notebooks and Design Workbooks</th>
</tr>
</thead>
<tbody>
<tr>
<td>No blank spaces on a finished page, no skipped pages and no removed pages.</td>
</tr>
<tr>
<td>Each entry written consecutively, signed, dated, verified by a witness and ruled off.</td>
</tr>
<tr>
<td>Entries are legible, thorough and complete.</td>
</tr>
<tr>
<td>Entries include description of initial ideas, experiments conducted and work completed.</td>
</tr>
<tr>
<td>Details of all persons involved in the project should be included with each entry.</td>
</tr>
<tr>
<td>Any corrections made should be dated, initialled and witnessed.</td>
</tr>
<tr>
<td>All non-standard terms, processes and abbreviations defined.</td>
</tr>
<tr>
<td>Annexed material should be permanently attached (i.e. glued, not stapled or sticky taped) and sealed, signed and dated. If it is not practical to annex it, store it separately, sign, date, witness and cross reference it to the relevant entry.</td>
</tr>
<tr>
<td>All laboratory notebooks and design workbooks, and their attachments, should be stored properly and appropriately.</td>
</tr>
<tr>
<td>All laboratory notebooks and design workbooks should be kept for as long as is needed to verify the legitimacy of the work.</td>
</tr>
</tbody>
</table>

Below is an example page of a laboratory notebook:
### Project No:
The reference number identifying the project.

### Title:
The name of the experiment or design you are conducting.

### Concept:
Statement and description of the idea you are testing and experimenting.

### Tests and Experiments:
A complete record describing the methodology, observations, results and conclusions of the test and experiments performed relating to the idea, including drawings and graphs.

Cross-reference any annexed materials here.

Record names of others who assisted with the experiment.

<table>
<thead>
<tr>
<th><strong>DESIGN ENGINEER</strong></th>
<th><strong>WITNESSED and UNDERSTOOD BY:</strong></th>
</tr>
</thead>
<tbody>
<tr>
<td>Signature:</td>
<td>Signature:</td>
</tr>
<tr>
<td>Printed name:</td>
<td>Printed name:</td>
</tr>
<tr>
<td>Date:</td>
<td>Date:</td>
</tr>
</tbody>
</table>
**IP record storage practices**

IP records are assets with great value, and it can only be realised if the IP records are stored safely and information is handled in an appropriate manner.

Disclosure of IP records at the ‘wrong’ time can limit or destroy its potential commercial value. In particular, premature or inappropriate disclosure, exploitation or commercial use of information forming the basis of some IP types may prevent your organisation from obtaining IP protection or diminish the scope of protection.

<table>
<thead>
<tr>
<th>Tips for Storing Intellectual Property Records</th>
</tr>
</thead>
<tbody>
<tr>
<td>Adopt appropriate security measures, e.g. under lock and key, encryption, password-protection.</td>
</tr>
<tr>
<td>Use up-to-date operating systems, anti-virus and anti-spyware software. Be wary of suspicious emails which may contain viruses.</td>
</tr>
<tr>
<td>Regularly back-up information stored on your hard-drive and store the back-up disks in locked facilities.</td>
</tr>
<tr>
<td>If necessary, seal the information in protective covering or wrapping to prevent deterioration, and store it away from known hazards.</td>
</tr>
<tr>
<td>Avoid storing the information on storage devices, such as USB drives, and CD-ROMs – unless kept locked up when not in use, and the information is deleted when no longer required.</td>
</tr>
</tbody>
</table>

**Personnel practices**

**Be familiar with your IP policy**

Your organisation is likely to have an IP policy in place which sets out your organisation’s objectives for managing IP. The IP policy will set out what you should do when you have created or acquired IP and provide guidance on ongoing practices in managing IP. You should be familiar with and adhere to your organisation’s IP policy.

**Observe your confidentiality obligations**

Since researchers and design engineers are key IP generators within an organisation, it is likely that you and those under your supervision would have signed confidentiality agreements with your organisation. Typically, these confidentiality agreements require employees to:

- maintain the secrecy of confidential information of the organisation during and after their employment
- only use the confidential information within the scope of their employment, and
- return all confidential information in their possession to the organisation at termination of their employment.

You should keep and ensure those who work under your supervision comply with those confidentiality obligations.
Ongoing IP obligations

The registration process for some forms of IP may take a few years. Therefore, you may have an obligation under your employment agreement to assist your organisation to register the IP you created (e.g. execution of relevant documents, including assignment documents) even after your employment with your organisation finishes.

Identification and protection of confidential information

Confidential information is information not readily available to the public and gives your organisation its competitive edge. Publication of confidential information may prevent patent protection being obtained. You are likely to generate confidential information every time you record information in your laboratory notebooks and design workbooks. Unauthorised disclosure of confidential information may undermine the value of your organisation. Precaution must be exercised to ensure confidentiality of the information is kept.

The IP Policy of your organisation would have outlined practices for the identification and protection of confidential information. For more information on measures to protect confidential information, see Chapter 5 ‘What Managers Making IP Protection Decisions Must Know’.

Review of public disclosures

Publication of work by researchers or public announcements in most instances destroys the patentability of otherwise patentable subject matters. All drafts of public disclosures (such as technical publications) and communications (such as correspondences, press announcements and internal memoranda), should be reviewed by responsible personnel to ensure any patentable subject matter is not inadvertently disclosed.
WHAT MANAGERS MAKING IP PROTECTION DECISIONS MUST KNOW

What this Chapter covers ............................................................91

General Issues in Making IP Protection Decisions......................91
  Step 1: Identify subject matter that may need IP protection ........91
  Step 2: Identify what forms of IP protection is available ...........92
  Step 3: Determine how to implement IP protection for the subject
          matter ................................................................................................... 92

Patents ..................................................................................93
  Should the invention be registered? ...........................................93
  Patents vs. confidential information .........................................94
  When to file a patent application .............................................95
  How to obtain the grant of a patent .......................................95
    Patent searches .................................................................................. 95
    The patent application process ...................................................96
    Filing a patent application ............................................................99
    Application fees ...........................................................................100
    Publication .......................................................................................101
    Examination of standard patent applications .......................101
    Examination of innovation patent applications ....................101
    Opposition ......................................................................................101
    Re-examination ............................................................................103
    Revocation ......................................................................................103
    Maintaining patent rights .........................................................103
      Renewal fees ...............................................................................103
      Use a patent notice .................................................................103
    Obtaining foreign protection ...................................................104
      Paris Convention .........................................................................104
      Patent Cooperation Treaty (PCT) .............................................104

Copyright .................................................................................107
  How to implement copyright protection ...................................107
    Use a copyright notice & © symbol ...........................................107
Restricting access to source code by placing it in escrow.........................................................108
Digital Rights Management & metadata................................................................................108
Technological Prevention Measures........................................................................................109
Open source licences.................................................................................................................109
Dealing with moral rights and performers’ rights......................................................................111

**Registered Designs** ............................................................................................................. 111

Should the design be registered?...............................................................................................111
How to register a design..............................................................................................................111
Design searches..........................................................................................................................111
The registered design application process................................................................................112
Filing a registered design application........................................................................................113
Request for registration or publication ....................................................................................114
Examination...............................................................................................................................114
Revocation................................................................................................................................114
Maintaining registered design....................................................................................................115
Renewal fees...............................................................................................................................115
Use a registered design notice...................................................................................................115
Obtaining foreign protection........................................................................................................115

**Circuit layouts** ...................................................................................................................... 116

How to implement circuit layout protection.............................................................................116
Use a circuit layout notice..........................................................................................................116
Keep plans and masks properly..............................................................................................116
Assignment of rights...............................................................................................................117
Obtaining foreign protection......................................................................................................117

**Confidential Information** .................................................................................................... 117

Identification and protection of confidential information........................................................117
Practical management of confidential information.....................................................................117
Confidentiality agreements.......................................................................................................119

**Trade Marks** ....................................................................................................................... 119

Should the trade mark be registered?......................................................................................119
<table>
<thead>
<tr>
<th>Topic</th>
<th>Page</th>
</tr>
</thead>
<tbody>
<tr>
<td>Trade mark registration vs. passing off</td>
<td>119</td>
</tr>
<tr>
<td>How to register a trade mark</td>
<td>120</td>
</tr>
<tr>
<td>Selecting a trade mark</td>
<td>120</td>
</tr>
<tr>
<td>Trade mark searches</td>
<td>123</td>
</tr>
<tr>
<td>The trade mark application process</td>
<td>123</td>
</tr>
<tr>
<td>Preparing the trade mark application</td>
<td>125</td>
</tr>
<tr>
<td>Examination of the trade mark application</td>
<td>126</td>
</tr>
<tr>
<td>Opposition</td>
<td>126</td>
</tr>
<tr>
<td>Registration of the trade mark</td>
<td>127</td>
</tr>
<tr>
<td>Maintaining trade mark registration</td>
<td>127</td>
</tr>
<tr>
<td>Maintenance fees</td>
<td>127</td>
</tr>
<tr>
<td>Use the trade mark</td>
<td>127</td>
</tr>
<tr>
<td>Use the ® and ™ symbol</td>
<td>127</td>
</tr>
<tr>
<td>Avoid generic use of the trade mark</td>
<td>128</td>
</tr>
<tr>
<td>Obtaining foreign protection</td>
<td>128</td>
</tr>
<tr>
<td><strong>Domain Names</strong></td>
<td>128</td>
</tr>
<tr>
<td>Should the domain name be registered?</td>
<td>128</td>
</tr>
<tr>
<td>How to register a domain name</td>
<td>129</td>
</tr>
<tr>
<td>Selecting a domain name</td>
<td>129</td>
</tr>
<tr>
<td>Selecting a domain name registrar</td>
<td>131</td>
</tr>
<tr>
<td>Maintaining domain name registration</td>
<td>131</td>
</tr>
</tbody>
</table>
What this Chapter covers

IP is often a valuable asset of an organisation. An organisation may risk losing its IP rights and significant opportunities to commercialise its IP if it neglects to implement proper protection measures.

This Chapter will:
• discuss the general issues arising in making IP protection decisions
• outline how to obtain and maintain protection for the different forms of IP, and
• discuss the specific issues relating to IP protection decisions for the different forms of IP.

General Issues in Making IP Protection Decisions

Protection of IP does not happen automatically. You need to take active measures to preserve, defend and enforce IP rights. Some forms of IP rights (e.g. patents, designs, and trade marks) require formal protection and you will need to apply to the relevant government authorities (e.g. IP Australia). Other forms of non-registrable IP rights (e.g. copyright, circuit layout and confidential information) will also benefit from and may require careful planning and implementation for their protection and enforcement.

The following steps will assist you when considering IP protection issues for your organisation:

Step 1: Identify subject matter that may need IP protection

The decision to implement IP protection for particular subject matter may occur before, during or after its creation. You may have already identified subject matter that requires IP protection as early as the planning stage of a project. Alternatively, an organisation may be unaware of the existence of an IP asset until after it has conducted an IP audit.

Not all subject matters generated or acquired by an organisation will require IP protection. The decision as to whether to implement IP protection measures for particular subject matter generated or acquired by an organisation usually depends on the nature, purpose and value of the subject matter and the role it plays to achieve the organisation’s objectives and business goals.

The questions below will assist you in formulating a view as to whether particular subject matter requires IP protection:
What role does the subject matter play to achieve the objectives or business goals of the organisation?

What is the intended use and purpose for the subject matter?

Does the subject matter have sufficient commercial value?

Is the subject matter prone to rapid change and development?

Does it have a short commercial life span?

Is protection required to preserve the value of the subject matter?

Can the subject matter be easily reverse-engineered or reproduced?

Can the subject matter be kept secret indefinitely?

Very often, more than one form of IP protection is available for a subject matter and you may not require all forms of protection to be implemented. For more information on the different forms of IP that may apply to a subject matter, see Chapter 2 ‘What Everyone Should Know’.

At this stage it is best practice to list all forms of IP that may apply to the subject matter and consider the advantages and disadvantages of the various forms of protection available.

Having identified the different types of IP protection available, and their respective advantages and disadvantages, you will need to form an opinion as to what form(s) of IP protection is/are appropriate. Use the following questions to assist you to determine the appropriate form(s) of IP protection for the subject matter.

Does the protection require formal registration?

Does formal registration provide any additional useful protection?

Does the benefit of registration outweigh the costs of registration?

Is registration necessary to preserve the value of the work?

You will also need to take into account the IP policy of the organisation. In particular, the IP policy may specify a particular procedure that you should follow to obtain approval for your recommendations.
Consider the following questions when making recommendations for the forms of IP protection to be pursued for the subject matter:

<table>
<thead>
<tr>
<th>Organisation’s IP Policy and Implementation Plan</th>
</tr>
</thead>
<tbody>
<tr>
<td>Does the IP policy provide guidance on the protection of IP?</td>
</tr>
<tr>
<td>What authorisation is necessary to implement IP protection?</td>
</tr>
<tr>
<td>Does the organisation have the resources to maintain the protection of IP?</td>
</tr>
<tr>
<td>Does the organisation have the resources to enforce IP rights if infringed?</td>
</tr>
</tbody>
</table>

Other sections of this Chapter will give you a general overview of how to obtain and maintain different forms of IP protection. However, implementation of IP protection, particularly registrable forms of IP, can be complex and technically difficult. If you wish to obtain formal registration of your IP asset, it is vital that you seek the assistance of an appropriate IP or legal professional.

**Patents**

**Should the invention be registered?**

<table>
<thead>
<tr>
<th>Patents</th>
<th>Confidential Information</th>
</tr>
</thead>
<tbody>
<tr>
<td>To be formally registered as a patent.</td>
<td>To be kept secret as confidential information.</td>
</tr>
</tbody>
</table>

Generally, an invention may be protected by one of the following ways:

Determining the form of protection that is appropriate for the invention depends largely on the nature of the invention. For example, there are certain criteria that need to be met before a patent is granted for an invention. Not all inventions may meet these criteria to be eligible for protection as a patent, and it may be appropriate for some inventions simply to be kept confidential. In addition, where it is highly unlikely that an invention could be reverse engineered it may be more appropriate to be kept as confidential information.

Of course, the alternative to protecting an invention is to intentionally publish details of the invention as a defensive strategy to prevent others gaining a monopoly position.

For more information on the patentability requirements in Australia, see Chapter 2 ‘What Everyone Should Know’.
Patents vs confidential information

The features of patent registration and confidential information are summarised below and you will need to assess the most appropriate way to protect the invention in light of the following:

<table>
<thead>
<tr>
<th>Features of Protection</th>
<th>Patents</th>
<th>Confidential Information</th>
</tr>
</thead>
<tbody>
<tr>
<td>Scope</td>
<td>• Exclusive rights to prevent others from exploiting the invention.</td>
<td>• No enforceable rights against others from exploiting the invention if it is discovered by reverse engineering or other legal means.</td>
</tr>
<tr>
<td></td>
<td>• Patent protection needs to be sought on a country-by-country basis.</td>
<td>• No need to pursue protection on a country-by-country basis.</td>
</tr>
<tr>
<td>Term</td>
<td>Provided renewal fees are paid, the term of protection is:</td>
<td>Protection will exist as long as the invention is kept secret.</td>
</tr>
<tr>
<td></td>
<td>• 20 years from filing of the complete application for standard patents.</td>
<td></td>
</tr>
<tr>
<td></td>
<td>• 8 years from filing of the complete application for innovation patents.</td>
<td></td>
</tr>
<tr>
<td>Costs</td>
<td>Costs of registration can be relatively expensive, especially if foreign protection is also sought.</td>
<td>Costs associated with keeping the invention confidential will generally be internal administrative costs and costs for maintaining physical security of the confidential information.</td>
</tr>
<tr>
<td>Risks</td>
<td>• The patent application may not be successful.</td>
<td>• The invention may be inadvertently disclosed.</td>
</tr>
<tr>
<td></td>
<td>• The patent application may be opposed or the granted patent invalidated.</td>
<td>• The invention may be reverse engineered or discovered by other means.</td>
</tr>
<tr>
<td></td>
<td>• The invention must be disclosed in the patent application which may increase the risk of others copying, working around or improving the invention.</td>
<td>• If discovered independently, it may be patented by someone else, which may limit your opportunity to exploit the invention.</td>
</tr>
<tr>
<td>Enforcement &amp; Remedies</td>
<td>• Court action must be taken to enforce any patent rights that are infringed, unless a licence can be negotiated.</td>
<td>• Court action may be taken for breach of contract, breach of confidence or breach of fiduciary duty.</td>
</tr>
<tr>
<td></td>
<td>• A range of remedies may be sought, namely injunctions, account of profits and damages.</td>
<td>• The only likely remedy after disclosure is damages.</td>
</tr>
</tbody>
</table>
When to file a patent application

Generally, a patent application should be filed as soon as it can be sufficiently described in a patent specification and the inventors can predict the scope of the invention.

A patent application also should be filed before any publication of the invention takes place. Publication or disclosure of the invention may destroy the possibility of being granted a patent.

Should a provisional application be filed?

Filing a provisional patent application (rather than a complete application in the first instance) is optional. However, a provisional application can be a cost-effective way to establish a priority date for your invention. The priority date is the date against which novelty and inventive ship of the invention will be assessed.

When a provisional application is filed, it allows you up to 12 months to:

- decide whether to continue with the patenting process
- do further research and development on the invention, and
- explore commercialisation opportunities of the invention by seeking potential commercialisation partners.

It is sometimes thought that a provisional specification need only describe an invention in general terms, and that the full detail can follow in the subsequent complete application. This is a very dangerous approach since the priority date established by the provisional application may not be sustainable – particularly in other countries – for lack of adequate description.

How to obtain the grant of a patent

Patent searches

Before submitting a patent application, it is advisable to conduct patent searches to find out whether the invention:

- is anticipated by any ‘prior art’, or
- infringes existing patent rights of others.

Limited patent searches may be conducted on IP Australia’s patent database ‘Patsearch’ located at: http://www.ipaustralia.gov.au.

It is recommended you seek the assistance of a patent attorney to ensure a comprehensive search is undertaken. A patent attorney will able to assist with conducting the following types of search:

- **Patentability searches:** Locates any prior art closely related to your invention, i.e.
already published publications, patents and other documentation or information.

- **Infringement searches:** Locates any existing patent or pending application having claims closely related to your invention.
- **State of the art searches:** Provides an overview of a particular market or field.
- **Bibliographic searches:** Locates pending patent applications or granted patents by a particular inventor or applicant.

For more information on patent search strategies, see Chapter 4 ‘What Researchers and Design Engineers Must Know’.

**The patent application process**

Set out in the diagrams below are the indicative overviews of the patent application process for standard and innovation patents.
Filing a provisional patent application is optional. The filing date of the provisional application will establish a priority date.

A PCT patent application may be filed within 12 months. See the 'Indicative PCT Process' diagram in this Chapter.

A complete patent application for a standard patent is filed (within 12 months from the filing date of the provisional application, assuming there is one).

The application will be published in the Official Journals of Patents after 18 months from the priority date (in this case lodgement of the provisional application).

The Patent Office determines whether the standard patent application meets the validity requirements.

Re-examination may be initiated by the Patent Office between acceptance and grant. If the applicant is unable to overcome an adverse re examination report, the accepted patent may be refused.

Opposition may be initiated by others within 3 months from the date of the Notice of Acceptance. If opposition is successful, the accepted patent may be refused, or problems rectified by amendment.

Notice of acceptance is published in the Official Journal of Patents.

This report summarises any patentability requirements that need to be met.

The term of a standard patent is generally 20 years from the filing of the complete application, provided renewal fees are paid.

IF the application is refused, the accepted patent may be revoked or its validity rectified by amendment.

Re-examination may be initiated by the patentee or others. The patent may be revoked or its validity rectified by amendment.

Patent application refused.

Submission of response by applicant.

Possible Re-examination.

Grant patent.
Innovation Patent Application Process

Provisional Patent Application
Filing a provisional patent application is optional. The filing date of the provisional application will establish a priority date.

Complete Patent Application
A complete patent application for a standard patent is filed (within 12 months from the filing date of the provisional application, assuming there is one).

Formalities Check of Innovation Patent
Does the innovation patent application pass the formalities check?

YES
Grant and Publication
The application will be granted and published in the Official Journals of Patents.

NO
Notice of Deficiency

Request for Examination of Innovation Patent
Does the innovation patent’s claims meet the validity requirements? This step is optional, but only a certified innovation can be enforced.

YES
Innovation Patent Certified
The term of an innovation patent is 8 years from the filing of the complete application, subject to payment of renewal fees.

NO
Examination Report
This report summarises any patentability requirements that need to be met.

Patent application may be revoked
Submission of response by applicant

Re-examination
Re-examination may be initiated any time during the term of a certified innovation patent.

If the patentee is unable to overcome an adverse report, the certified patent may be revoked.

Opposition
Opposition may be initiated (typically by others) any time after the innovation patent is certified.

If opposition is successful, the certified patent may be revoked, or problems rectified by amendment.

Patent application may lapse
Submission of response by applicant
Filing a patent application

A patent specification is a complex legal document that is best prepared by an experienced patent attorney. Once the patent application is lodged, the specification as filed will be assessed against patentability criteria by the Patent Office. It is generally not possible to amend the specification at a later stage to add further subject matter.

Aside from the fact that an invention as claimed needs to comply with the patentability requirements as set forth in Chapter 2 ‘What Everyone Should Know’, there are several specific requirements with which a patent application must comply. Failure to satisfy these requirements may lead to the subsequent granted patent being invalidated. These requirements are summarised in the diagram below.

Inventorship

All inventors who contribute to the development of an invention should be listed on the patent application.

An inventor is a person who has made a contribution to the conception of the invention which is defined in at least one of the claims of the patent application.

It is vital that the correct inventors be named on a patent application to avoid any risk of the subsequent granted patent being held invalid for false suggestion or misrepresentation.

You should provide your patent attorney with information outlining the contribution each individual made towards the invention to enable your patent attorney to identify the inventors.

For more information on inventorship, see the section ‘Identifying the inventor’ in Chapter 4 ‘What Researchers and Design Engineers Must Know’.

Sufficiency of Description

A patent specification must fully describe the invention and disclose the best method of implementing the invention known to the inventors at the time of filing so that a skilled person is able to carry out the invention. (Although this does not preclude the retention of some aspects of the invention’s implementation as confidential know-how).
You should provide your patent attorney with adequate details of the invention, including the different methods of performing the invention and details of all experiments or trials conducted and results obtained.

**Fair Basis**  
Fair basis essentially is a requirement that the claims of a patent (or a patent application) be supported by the subject matter described in:
- the patent specification, and
- any earlier applications from which priority is being claimed.

In simple terms, there must be a real and reasonably clear basis for the features themselves, and the specific combination of features of each claim in the described subject matter.

Fair basis is an issue with which a patent attorney will be concerned when writing a patent specification.

A lack of fair basis, in some circumstances, may be rectified by amending the claims of a patent application. However, a lack of fair basis cannot be rectified after a patent is granted.

**Clarity of Claims**  
A patent specification requires that the boundaries of the invention be stated and claimed clearly. In addition, a claim must be clear and unambiguous so that its scope can be ascertained. This requirement is one of language. The claims of a patent application should be sufficiently narrow to be novel, but be sufficiently broad as to adequately protect the invention from infringement by others.

You should provide your patent attorney with the results of any patent searches conducted and details of any public disclosures of the invention to assist in determining the appropriate scope of the claims. Often a patent attorney will provide your organisation with a questionnaire for the inventors to complete to assist with the preparation of a patent application.

For more information on a description of the different types of patent applications, see Chapter 2 'What Everyone Should Know'.

**Application fees**  
An application fee will be required to be paid at the time of filing a patent application. Additional fees will be required to be paid depending on the action taken during the application process, such as requesting examination and on acceptance.
These fees and their associated time-frames are subject to change and care should be taken to meet deadlines. Failure to do so may result in your patent application lapsing.

A full list of patent fees is available on the IP Australia website located at: http://www.ipaustralia.gov.au/patents/fees_index.shtml.

Publication

A patent application is published officially by the Patent Office approximately 18 months after the priority date. Once a patent application has been published, the organisation may disclose the invention without risk, provided that the technical publication discloses no more than what is set out in the specification.

It is recommended that there is no publication of the invention in the 18 months after filing the first patent application, especially if it is likely there will be further developments to the invention. Publication of the invention should be restricted until official publication occurs in case a follow-up patent application is to be filed for the new developments. This ensures that the new developments are not considered as obvious when assessed against the original invention.

Examination of standard patent applications

A standard patent application is subject to examination by the Patent Office. The applicant must lodge a request for examination within 5 years of filing the complete specification, or within 6 months of a direction issued by the Patent Office to request examination – whichever occurs earlier. Of course, you may request examination immediately, if early grant of a patent is sought.

Examination of standard patent applications consists of assessing the invention’s patentability against the required criteria set out in the Patents Act. The criteria is summarised in the section ‘Requirements of patent grant’ in Chapter 2 ‘What Everyone Should Know.’

The Patent Office will issue an examination report which summarises the particular patentability issues of the invention. The applicant has 21 months from the date of the examiner’s first report to overcome the issues raised by the Patent Office.

Examination of innovation patent applications

Examination of an innovation patent application is optional. An innovation patent application will be accepted when it meets all requirements of an initial formalities check regarding administrative issues.

However, to enforce the rights afforded by an innovation patent, an innovation patent must be examined and certified. At examination, the Patent Office will conduct a substantive assessment of the validity of the innovation patent. The Patent Office will either certify or revoke the innovation patent after the substantive examination.

Only a certified innovation patent may be enforced against an infringement.

Opposition

Both standard patent and innovation patent applications may be opposed on any of the following grounds set out in the Patents Act 1990 (Cth):
The applicant/patentee is not entitled to a grant of a patent for the invention.

The applicant/patentee is entitled to the grant of a patent but only in conjunction with some other person.

The specification of the patent does not describe the invention fully.

The specification of the patent is not clear, succinct or fairly based on the matter described in the specification.

The patent is not a manner of manufacture.

The patent is not novel.

The invention as claimed in the standard application/innovation patent has no inventive or innovative step respectively.

The invention as claimed in the standard application/innovation patent is not useful.

The invention as claimed in the standard application/innovation patent was secretly used before the priority date by or on behalf of, or with the authority of, the patentee or nominated person, or his/her predecessor in title to the invention.

The claims of the standard application/innovation patent are directed to a human being or involves the biological processes for the generation of human beings.

Additionally, and only for innovation patents, the claims are directed to a plant or animal or the biological process for the generation of a plant or animal.

A standard patent may only be opposed within 3 months of the date of a notice of acceptance being published in the Official Journal of Patents, with a possible one month extension. An innovation patent may be opposed any time after it has been certified by the Patent Office.

An opposition will be heard at the Patents Office where the Commissioner of Patents will decide the matter based on the evidence (including expert evidence) filed by the parties.

A successful opposition by the opponent may result in an accepted standard patent application being refused, and may result in revocation of a certified innovation patent.

You should be aware that even if an opposition is withdrawn by the opponent, the Commissioner of Patents may still consider any evidence already on file and voluntarily re-examine the patent application. See below for further information on re-examination.
**Re-examination**

A standard patent application may be re-examined by the Commissioner of Patents between the date of acceptance and grant.

A standard patent may be re-examined by the Commissioner of Patents, at the Commissioner’s discretion or at the request of the patentee or any other party, at any time after grant. Similarly, an innovation patent may be re-examined at any time after it has been certified.

Re-examination of a patent application, a standard patent, or a certified innovation patent is limited to assessing the novelty and inventive step or innovative step, respectively, of the invention.

The results of a re-examination can be that the applicant/patentee may amend the claims to achieve validity, although in some instances the result can be a refusal to grant the standard patent or revocation of the granted patent or the certified innovation patent. However, this decision may be appealed to the Federal Court of Australia.

**Revocation**

Both standard patents and innovation patents may be revoked by a Court on any of the grounds set out in section 138 the Patents Act 1990 (Cth), which are broader than the grounds for opposition. Anyone can apply to the Court to revoke the patent, or a Court may act on a counterclaim for revocation by a party accused of infringing the patentee’s rights.

For more information on the grounds of revocation, see Chapter 8 ‘What Must Be Known About Enforcing and Defending Your IP Rights’.

**Maintaining patent rights**

**Renewal fees**

The applicant/patentee for a standard patent must pay patent renewal fees to the Patent Office starting five years from the complete application filing date on an annual basis. These fees are required to maintain a pending standard application and to keep a granted standard patent in force. See section ‘Application fees’ in this Chapter.

The same generally applies for innovation patents. An annual fee must be paid at beginning on the first anniversary of the filing date after the grant occurs.

**Use a patent notice**

It is best practice to attach a patent notice to products or packaging of products. There is no required form of notice or specific words that need to be on the notice, but it may state: ‘Patent pending’ or ‘Australian Patent No. [xxxx]. All rights reserved.’
Patent rights are territorial and active steps will need to be taken to implement foreign patent protection of an invention.

Foreign patent protection may be implemented by:

- filing a patent application (Convention application) in a country which is signatory to the Paris Convention for the Protection of Industrial Property of 1883 (Paris Convention) within 12 months of the first filing of an Australian patent application
- filing an international patent application (PCT application) under the Patent Cooperation Treaty 1978 (PCT) for protection in countries which are signatories to the PCT within 12 months of first filing of an Australian patent application, or
- filing a foreign patent application in a country at the same time as filing an Australian patent application, or at least before using or publishing your invention.

Australia is signatory to both the Paris Convention and the PCT.

Where a country is not signatory to the Paris Convention or the PCT, it will be necessary to file a patent application in that country at the time of filing an Australian provisional patent application, or at least before using or publishing your invention.

The Paris Convention allows a patent application in a signatory country to claim the priority date of an earlier patent application in another signatory country.

Most, but not all countries are signatories to the Paris Convention. At the time of publication of this Manual, a list of contracting countries to the Paris Convention may be accessed at: http://www.wipo.int/treaties/en/SearchForm.jsp?search_what=C.

The PCT allows the filing of a centrally filed patent application which can be subsequently ‘nationalised’ in countries which are contracting parties of the PCT. You should be aware that not all countries are signatories of the PCT, including most of South America, Taiwan, Thailand and Pakistan. A list of signatory countries to the PCT at the publication of this Manual may be accessed at: http://www.wipo.int/treaties/en/SearchForm.jsp?search_what=C.

It is important to understand that a PCT patent application does not lead to grant of an ‘international patent’. A PCT patent application will need to be ‘nationalised’ in countries where patent protection is desired. Once nationalised, the application is examined according to the relevant patent laws and regulations of the relevant country. Therefore a PCT application ultimately results in separate national or regional patent applications in the same way as does the Paris Convention route.

Set out in the table below are the advantages and disadvantages of a PCT application compared with Convention applications:
### Advantages

<p>| | |</p>
<table>
<thead>
<tr>
<th></th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>Major costs of filing, such as filing fees and translation costs, are deferred.</td>
<td>Additional costs of filing (but these may be recovered by efficient national phase processing).</td>
</tr>
<tr>
<td>An international search report and written opinion are given to the applicant which provides an informed view of the likelihood of securing patent protection, and allows the opportunity to amend claims and/or description.</td>
<td>Grant of patent in the countries of interest may be delayed by at least 18 months. This would delay the ability to enforce or license such patent rights.</td>
</tr>
<tr>
<td>The applicant can defer its decision on the countries in which to seek patent protection in for up to 18 months (or 30 months if no priority claim is made).</td>
<td>Any limitations introduced to the claims during the PCT process may be more than would be required under the national laws of some countries, resulting in a lesser scope of protection.</td>
</tr>
</tbody>
</table>

The PCT process is split into two parts referred to as ‘Chapters’:

- Chapter I relates to International Searching, Publication and an International preliminary Report on Patentability, and
- Chapter II (optional) relates to International Preliminary Examination (IPE), which results in a non-binding International Preliminary Examination Report.

The PCT process is complex. It is recommended you seek assistance from a patent attorney if you wish to apply for patent protection through the PCT.

Below is an indicative simplified flowchart of the PCT process.
## Indicative Simplified PCT Process

<table>
<thead>
<tr>
<th>First Filing of National Patent Application</th>
</tr>
</thead>
<tbody>
<tr>
<td>The first filing of one (or more) national patent application (provisional or standard application) starts the timeline and establishes one or more priority dates.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>File PCT application</th>
</tr>
</thead>
<tbody>
<tr>
<td>A PCT application must be filed within 12 months of the earliest priority date. (In some instances, an earlier priority date may not be invoked.)</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Chapter I Action: International Search Report</th>
</tr>
</thead>
<tbody>
<tr>
<td>An International Search Report and Written Opinion on novelty and inventive step is issued by a Patent Office acting as an International Searching Authority, usually by 16 months from the earliest priority date. The claims may then be amended by the applicant.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Publication</th>
</tr>
</thead>
<tbody>
<tr>
<td>The PCT application is published by WIPO at around 18 months from the earliest priority date.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Demand for IPE</th>
</tr>
</thead>
<tbody>
<tr>
<td>A demand for an International Preliminary Examination (under Chapter II) is optional.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Chapter I IPRP</th>
</tr>
</thead>
<tbody>
<tr>
<td>If IPE is not demanded, then an International Preliminary Report (Chapter I IPRP) on patentability is issued based on the earlier Written Opinion.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Chapter II International Preliminary Examination</th>
</tr>
</thead>
<tbody>
<tr>
<td>Arguments and/or amendments in the claims address the issues of novelty and inventive step, raised in the existing Written Opinion.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Chapter II IPRP</th>
</tr>
</thead>
<tbody>
<tr>
<td>The Chapter II IPRP is issued.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>National Phase Entry</th>
</tr>
</thead>
<tbody>
<tr>
<td>The National Phase must be entered for all desired countries within 30 months (31 months in some countries) of the priority date.</td>
</tr>
</tbody>
</table>
Copyright protection arises automatically on creation of an original work. There is no formal process of registration required for copyright protection of a work.

However, there are steps you may implement to make others aware that your work is copyright protected. This may assist to reduce potential copyright infringement of your work.

The diagram below illustrates some of the different mechanisms of implementing copyright protection.

Use a copyright notice & © symbol

It is not a legal requirement to use a copyright notice or to attach the © symbol to your work. However, by attaching a copyright notice, you are informing users that copyright exists and identifying the owner of the copyright. The ‘reserving all rights’ notice in a copyright notice is an indication that no licence is implied by the publication of the work.

There is no particular set of words required in a copyright notice. Below are some examples of copyright notices for different forms of publication.

Print publications

© [Name of organisation] [Year of creation] All rights reserved.

This work is copyright. Except as permitted under the Copyright Act 1968 (Cth), no part of this publication may be reproduced by any process, electronic or otherwise, without the specific written permission of the copyright owner. Neither may information be stored electronically in any form whatsoever without such permission.
Restricting access to source code by placing it in escrow

Software is typically encoded into two forms: source code (human-readable code) and object code (machine-readable code). Although copyright may exist in both forms, the source code may be easily modified by a user, which means that any user who has access to the source code may alter the software. Therefore it is usual to restrict a user's access to the source code either by not releasing a copy or by placing the source code ‘in escrow’.

An escrow arrangement is an arrangement where a party is restricted from accessing the source code of a software program until special circumstances take place, such as where the service provider is unable to support the software any longer. See the section ‘Software Licences’ in Chapter 7 ‘What Must Be Known About IP Commercialisation’ for more information on placing the source code in escrow.

Digital Rights Management & metadata

Digital Rights Management (DRM) systems refer to the management and protection of copyright material in a digital environment by a variety of technological tools of protection. The Copyright Act 1968 (Cth) refers to this as ‘Electronic Rights Management Information’ (RMI).

DRM systems allow owners of the material to determine and control how a user can access and use copyright materials by implementing security features to restrict access and copying of the copyright materials.
DRM systems can be a simple spreadsheet or database with password protection, or a more complex system with strong encryption features.

Before implementing a DRM system, you may wish to consider:

- whether the nature of the copyright requires DRM protection
- the level of restriction to be placed on the copyright work, and
- whether the organisation should set up its own system or purchase an established DRM system.

The copyright information that is held within the DRM system is described by ‘metadata’. Metadata provides a meaningful name to data, which, if standing alone appears meaningless. This allows easy identification of the rights information. For example, if a piece of data held within the DRM system is an invention disclosure form, then the metadata attached to this data may be the title of the project and the name of the inventor, ‘ABC Project, John Smith’.

It is recommended that you seek advice and assistance from an IT specialist when considering implementation of a DRM system for the organisation.

### Technological Prevention Measures

Technological Prevention Measures (TPMs) are technological measures which restrict the use and access of digital content on electronic devices. TPMs protect copyright works in digital form by preventing any unauthorised use or copying of copyright materials. Examples of TPMs that may be attached to copyright works are summarised in the table below.

<table>
<thead>
<tr>
<th>Examples of TPMs</th>
</tr>
</thead>
<tbody>
<tr>
<td>Encryption</td>
</tr>
<tr>
<td>Registration keys</td>
</tr>
<tr>
<td>Read-only access</td>
</tr>
<tr>
<td>Serial numbers</td>
</tr>
<tr>
<td>Password protection</td>
</tr>
<tr>
<td>Low resolution images</td>
</tr>
</tbody>
</table>

In Australia, the Copyright Act 1968 (Cth) provides civil and criminal sanctions if any person manufactures, supplies or distributes devices that avoids or disables TPMs. Criminal liability may be up to 5 years imprisonment.

You may wish to seek advice and assistance from an IT specialist when considering implementation of TPMs for the organisation.

### Open source licences

Open source refers to any software program whose source code is made available for use, modification and redistribution to any user. Such software programs are usually developed as a public collaboration and are made freely available through open source licences. The table below includes some examples of open source software programs.
Examples of open source programs

<table>
<thead>
<tr>
<th>Apache</th>
<th>PHP</th>
</tr>
</thead>
<tbody>
<tr>
<td>Mozilla Firebird</td>
<td>Linux Kernel</td>
</tr>
</tbody>
</table>

Open source licences are ready-made licences that can be attached to software programs. Such licences usually grant users rights to use the software, (usually for free), but retain the ownership of the copyright for the owner.

To attach an open source licence to a software program, you will need to contact open source licence organisations which offer the ready-made licences. These organisations will record the transactions, collection and distribution of the software on your behalf.

There are two main categories of open source licences. Their general characteristics are summarised in the table below.

<table>
<thead>
<tr>
<th>Copyleft licences</th>
<th>Attribution-style licences</th>
</tr>
</thead>
<tbody>
<tr>
<td>• Confer rights to users to make exact or modified copies of the software</td>
<td>• Confer rights to users to use the source code within other software (which may be proprietary software)</td>
</tr>
<tr>
<td>• A copy of licence must be distributed with the software</td>
<td>• Copyright and licences must be kept intact</td>
</tr>
<tr>
<td>• A copy of the source code must be distributed with the software</td>
<td>• A statement must be added to acknowledge the software from which the work was derived</td>
</tr>
<tr>
<td>• Any modifications made must be identified and made openly available under the same terms which the original licence was granted</td>
<td></td>
</tr>
</tbody>
</table>

Example: GNU General Public licence (GPL).  
Example: Berkeley Software Distribution (BSD) Licence, MIT Licence.

For a copy of the GPL licence, visit: http://www.gnu.org/licenses/gpl.html.  
For a copy of the BSD licence, visit: http://www.opensource.org/licenses/bsd-license.php.

When choosing an open source licence, it is important to choose a licence that suits the needs of the organisation and the purpose for which the software program is to be used by the public. You should be aware that in some instances once the licence is attached to the software program it becomes a permanent grant of rights that cannot be revoked.

Open source licensing is a complex and evolving area. It is recommended that you seek the advice and assistance of a legal professional before attaching any open source licence to your organisation’s software program.
Dealing with moral rights and performers’ rights

Moral rights and performers’ rights are personal rights granted to the creator, author or performer. These rights can only be exercised by this individual and cannot be transferred by assignment or licensed.

Failure to obtain moral rights consent and/or performers’ rights consent means the organisation must not act or use the work in a way that would infringe these rights. You should consider whether such consents are required for the organisation to exploit the copyright materials in a manner reasonably anticipated by the organisation.

For more information on moral rights and performers’ rights, see Chapter 2 ‘What Everyone Should Know’.

Registered Designs

Should the design be registered?

Industrial designs need to be registered in order to receive exclusive rights and protection. If the industrial design is not registered (under the Designs Act 2003), only very minimal protection is provided by copyright and only if the design is considered to be an artistic work.

Various factors will affect whether a design should be registered, such as the organisation’s objectives, its proposed use for the design, and the nature of the design itself.

To be registrable, a design needs to comply with registration requirements. For more information on design registration requirements, see Chapter 2 ‘What Everyone Should Know’.

How to register a design

Design searches

Before submitting a design application, it is advisable to conduct design searches to ensure that:

- there are no existing registered designs that are similar or identical to the proposed design to be registered, which would prevent protection being obtained and
- the design does not infringe existing registered design rights of others.

Design searches may be conducted on IP Australia’s Australian Designs Data Searching (ADDS) system which has images of all registered designs from 1985 which is accessed at: http://www.ipaustralia.gov.au. Information and images on designs prior to 1985 are available at IP Australia’s office in each State capital.

However, it is recommended you seek the assistance of patent attorney to ensure a comprehensive search is undertaken.
The registered design application process

Set out in the diagram below is an overview of the registered design application process.

Indicative Registered Design Application Process

**Design Application**
The design application must be in approved form. If filing requirements are met, a filing date is established. This will be the priority date if the application is the first filing for the design.

**Request for Registration**
Request for registration made within 6 months of the priority date.

- **YES**
  - Design Registered
    - Registration of the design is advertised in the Official Journal of Designs.
    - The term of protection of a registered design is a maximum of 10 years, provided a renewal fee is paid after the initial 5 years. Registered designs cannot be enforced until Certified.

- **NO**
  - Notice of Deficiency
    - Submission of response by applicant
      - Registration may be refused

**Application Lapses**
If there is no request for registration or publication within 6 months of the priority date, the application will lapse.

- **YES**
  - Design Published
    - Publication does not grant any enforceable rights, but does prevent others from gaining any rights to the design.

- **NO**
  - Notice of Deficiency
    - Submission of response by applicant
    - Registration may be refused

**Request for Publication**
Request for publication made within 6 months of the priority date.

- **YES**
  - Design Published

- **NO**
  - Notice of Deficiency
    - Submission of response by applicant
    - Registration may be refused

**Request for Examination**
Examination can be requested by the owner or anyone else. Does the registered design meet validity requirements?

- **NO**
  - Adverse Examination Report

- **YES**
  - Registered Design is Certified
    - Possible Revocation
      - A person may make an application to a Court for revocation of a Certified registered design.
Registering a design involves completing and submitting a design application form and drawings of the product to which the designs relates. A design application must include the following information:

<table>
<thead>
<tr>
<th>Information required for the design application</th>
</tr>
</thead>
<tbody>
<tr>
<td>Details of the design applicant</td>
</tr>
<tr>
<td>Product(s) to which the design relates</td>
</tr>
<tr>
<td>Representations of the design</td>
</tr>
</tbody>
</table>

Representations are illustrations of the product to which the design(s) relates, which may be in the form of drawings, photographs or digital images. In some circumstances, a sample of the design may be submitted if it can be easily mounted on a flat surface and if it can be stored with other documents. In particular, you should ensure that:

- there are five identical copies showing each view of the product
- each representation must show an accurate and complete picture of the product
- one sheet should be used for each representation, and
- each sheet the representation is printed on should be numbered on the bottom right hand corner showing the total number of sheets lodged, e.g. 1 of 5, 2 of 5, etc.

You may also provide a Statement of Newness and Distinctiveness in the application, but this is optional. The statement identifies the particular features of the design considered to be new and distinctive, and special regard will be taken to those features identified when assessing newness and distinctiveness. If providing a Statement of Newness and Distinctiveness, ensure all features of the design which are new and distinctive are identified in the application.

Once the application is filed, it may be difficult to amend the representations set out in the application. The application will be assessed against set criteria by the Designs Office.

It is recommended that you consult a patent attorney to assist with any registered design applications.

**Application fees**

An application fee will be required to be paid at the time of filing a design application. Additional fees may be required to be paid depending on the action taken during the application process, such as requesting registration or publication.

These fees and their associated time-frames are subject to change and care should be taken to meet deadlines. Failure to do so may affect the success of your design application.
A full list of registered design fees is available on the IP Australia website located at: http://www.ipaustralia.gov.au/designs/fees_index.shtml.

**Request for registration or publication**

Within 6 months from the priority date of a design application, you must request registration or publication of the design. The priority date will usually be the filing date of the design application if the application is the first filing for the design. Failure to request registration or publication within the required time will result in the application lapsing.

**Registration**

If a request for registration is made, the Designs Office will conduct a formalities check to ensure that all the required details are disclosed, including the representations of the design. If the design meets the requirements, the design will be registered and advertised in the Australian Official Journal of Designs and in the Designs search databases (ADDS).

**Publication**

If a request for publication is made, and the publication requirements are met, the design will be published in the Australia Official Journal of Designs. Publication of the design does not grant any enforceable rights, but it does prevent others from gaining any rights to the design.

**Examination**

Examination of a registered design is optional. However, you will not be able to enforce your registered design rights if the registered design has not been examined and certified by the Designs Office.

Examination may be requested by the registered owner or any third party. When a third party requests examination of the design, that party may provide information to the Design Office regarding whether the registered design meets the registration requirements. The Design Office will either certify or revoke the registered design after examination.

**Revocation**

A registered design may be revoked upon application by a third party to a Court on any of the following grounds set out in the Designs Act 2003 (Cth):

- the design is not a registrable design
- that the registration of the design was obtained by fraud, false suggestion or misrepresentation
- that the design is a corresponding design to an artistic work, and copyright in the artists work has ceased
- one or more of the persons registered as the design’s owner was not entitled to be a registered designs owner, or
- where the third party was entitled to be the registered design’s owner at the time of registration.
Maintaining registered design

Renewal fees

Registered design protection lasts for a maximum of 10 years, provided a renewal fee is paid after the initial 5 years.

A full list of registered design fees is available on the IP Australia website located at: http://www.ipaustralia.gov.au/designs/fees_index.shtml.

Use a registered design notice

It is not compulsory to attach a registered design notice to a product embodying the registered design or the packaging of the product; however it is best practice to do so. The notice not only provides an indication that the design is registered, but also puts any infringer on notice of the existence of the IP right and therefore possibly increase the damages awarded by a court if there is an infringement action.

There are no particular set of words required to be used in a registered design notice, but it may state: ‘Australian Registered Design No. [xxxx]’. All rights reserved.

Obtaining foreign protection

Registered design rights are territorial and active steps will need to be taken to seek foreign registered design protection. Foreign protection of a design may be implemented by:

• filing a national application for registered design in the countries in which you wish to register the design, or
• filing a design application (Convention application) in the country which is signatory to the Paris Convention within 6 months of filing of an Australian registered design application.

At the time of publication of this Manual, a list of the countries that are members of the Paris Convention may be accessed at: http://www.wipo.int/treaties/en/SearchForm.jsp?search_what=C.

The main advantage of filing a Convention application is that the priority date of the Australian application can be retained and costs deferred for six months.

Foreign registered design applications need to be prepared, and will be examined and assessed in accordance with the country's relevant design laws and regulations. You should seek the assistance of a patent attorney to co-ordinate the various foreign registered designs protection.

A single European-wide (EU) design registration also is available, obviating the need to file in separate European countries.

Additionally, in the United Kingdom and a few other countries, a limited unregistered design right exists. Australian organisations may be able to take advantage of such rights if they choose a non-registration approach for their design products.
Circuit layouts

How to implement circuit layout protection

Circuit layout protection arises automatically on creation of an original circuit layout for an integrated circuit. No formal process of registration is required for exclusive rights to be granted to the creator/owner of the circuit layout.

However, there are steps you may implement to protect your circuit layout rights and put others on notice that rights exist in your circuit layout. These are summarised in the diagram below.

This may assist to reduce potential infringement of your circuit layout rights.

Use a circuit layout notice

It is not a requirement to attach a circuit layout notice to any packaging relating to an integrated circuit; however the Circuit Layouts Act 1989 (Cth) does suggest attaching a label or mark to the integrated circuit and its packaging, stating:

- that circuit layout rights subsist in the layout
- the country and year in which the layout was first commercially exploited, and
- the creator of the layout.

This will put the user on notice that circuit layout rights exist in the integrated circuit, and that any infringement of the rights may result in litigation.

There is no particular set of words required to be used in a circuit layout notice, but it may state: ‘Protected in Australia under the Circuit Layouts Act and in other countries under equivalent legislation. Australia 2007. [Name of organisation]. All rights reserved.’

Keep plans and masks properly

Proper recording and storing of plans and masks will assist in establishing originality of the circuit layout, especially if a third party claims that your circuit layout infringes its rights.

You should ensure that original plans and masks before, during and after development of integrated circuits are dated, properly stored and kept in a safe location. Any copies of the plans and masks, including where they are attached to communications, should be recorded and kept appropriately.
Assignment of rights

Ownership of the circuit layout rights (and other IP rights) in research and development agreements and service agreements should be clearly defined. This will avoid future disputes over ownership of the rights and protect your position in third party infringement claims. In addition, when dealing with independent contractors, you should obtain written assignments of the circuit layout rights from them.

Obtaining foreign protection

Under the Circuit Layouts Act 1989 (Cth) integrated circuits are protected in countries which are members of the World Trade Organisation (WTO) Trade-related Aspects of Intellectual Property Rights Agreement (TRIPS), and have equivalent national legislation.

A list of eligible foreign countries is given in the Circuit Layouts Regulations 1990 (Cth), and includes all industrialised countries. However, you should be aware that the equivalent circuit layout legislation is not uniform throughout all signatory countries, and the extent of protection may vary from that of Australia.

Confidential Information

Identification and protection of confidential information

Confidential information is information of significant importance to an organisation that is not readily available to the public. However, not all information generated by an organisation is, or needs to be, confidential. You will need to have a system in place to assess if the information should be classified as ‘confidential’, and the level of security required to be implemented against that information.

Practical management of confidential information

Any unauthorised or inadvertent disclosure of confidential information may result in a ‘loss’ of its confidential status and may potentially lead to serious consequences, e.g. publication of new inventions developed by researchers before filing a patent application may destroy its patentability. Practical procedures to protect confidential information should be implemented and followed.

The IP policy of your organisation may outline practices for the identification and protection of confidential information.

Standard Practices for Identifying and Protecting Confidential Information

<table>
<thead>
<tr>
<th>Keeping confidential information secure</th>
</tr>
</thead>
<tbody>
<tr>
<td>Prominently mark in red all sensitive, confidential documents as ‘CONFIDENTIAL’.</td>
</tr>
<tr>
<td>Restrict the number of copies of confidential information. If there are copies made, keep a record of the number of copies, and number them accordingly.</td>
</tr>
<tr>
<td>Limit the access and circulation of confidential information on a need-to-know basis. Authorisation may be required to access the information depending on its sensitivity.</td>
</tr>
</tbody>
</table>
Electronically stored confidential information should be technologically protected, such as password-protection and encryption. For more information on Digital Rights Management & Technological Prevention Measures, see section ‘Copyright’ in Chapter 4 ‘What Researchers and Design Engineers Must Know’.

All documents identified as confidential should be recorded and its confidential status should be periodically reassessed.

The location of the confidential information should be recorded. Adopt appropriate security measures, e.g. under lock and key, encryption and password protection.

Use log books or electronic audit trails to monitor access to confidential information.

Ensure documents classified as confidential are kept separately from non-confidential information.

Periodically review the confidentiality status of the document and ensure proper destruction procedures are followed, such as shredding and locked disposal bins.

Keep confidential information on the organisation’s premises and store it securely.

Enter into confidentiality agreements with all employees, contractors and anyone else that may come in contact with confidential information.

Conduct exit interviews with employees, reminding them of their post-employment confidentiality obligations.

Ensure all employees are aware of their confidentiality obligations and the procedures that are in place relating to dealings with confidential information.

**Disclosing Confidential Information**

Review all drafts of communications, press releases and technical publications prior to disclosure to ensure confidential information is not inadvertently disclosed.

Use generic descriptions or internal reference codes where possible.

Ensure that there is a confidentiality agreement in place between your organisation and the recipient of the confidential information.

Mark all communications of confidential information ‘CONFIDENTIAL’.

Ensure that the recipient of confidential information is aware of the confidential nature of the information.

When speaking about confidential information, ensure your conversation will not be overheard by unauthorised persons.

Before communicating confidential information, verify the email-address, fax number or the identity of the person you are speaking to on the phone. Attach a confidentiality notice to the communication.
Confidentiality agreements

When communicating confidential information to a third party, simply attaching a confidentiality notice to the communication will not necessarily create an obligation of confidence on the recipient. You will need to ensure the recipient has agreed in advance that the information received will remain secret. It is standard practice to obtain from the proposed recipient a signed confidentiality agreement defining the confidential information before revealing the sensitive information.

It is recommended that you consult a patent attorney to assist with any registered design applications.

Trade Marks

Should the trade mark be registered?

A trade mark does not need to be registered to receive protection. Unregistered trade marks may be protected by the common law of passing off, and/or misleading and deceptive conduct under the Trade Practices Act 1974 (Cth). However, registration of a trade mark will grant you exclusive rights to use the mark in relation to particular goods or services.

The following table summarises the advantages and disadvantages of registering a trade mark or leaving it unregistered.

<table>
<thead>
<tr>
<th>Trade Mark Registration</th>
<th>No registration: Passing off</th>
</tr>
</thead>
<tbody>
<tr>
<td>Trade mark is protected from the date of application for registration, without the necessity of proving reputation.</td>
<td>Reputation needs to be proved to protect the trade mark.</td>
</tr>
<tr>
<td>Protection is limited to the trade mark.</td>
<td>Protection may be provided for a wider variety of material indicative of reputation.</td>
</tr>
<tr>
<td>Protection term may be perpetual provided renewal fees are paid every 10 years.</td>
<td>Protection term may be perpetual, provided there is maintenance of good-will and reputation.</td>
</tr>
<tr>
<td>Expense required to apply for and maintain trade mark registration.</td>
<td>No expense required to apply for and maintain a trade mark.</td>
</tr>
<tr>
<td>Proof of infringement is easier to achieve.</td>
<td>Proof of infringement requires proof of reputation in the trade mark.</td>
</tr>
<tr>
<td>Protection of the trade mark is throughout Australia.</td>
<td>Protection of the trade mark may be limited geographically to areas where the trade mark is used.</td>
</tr>
</tbody>
</table>
**How to register a trade mark**

**Selecting a trade mark**

Almost anything can be registered as a trade mark, provided that it is distinctive and meets the eligibility criteria. For more information, see Chapter 2 ‘What Everyone Should Know’.

A trade mark may take a number of forms as illustrated below.

<table>
<thead>
<tr>
<th>Forms of trade marks</th>
</tr>
</thead>
<tbody>
<tr>
<td>Word</td>
</tr>
<tr>
<td>Phrase</td>
</tr>
<tr>
<td>Letter</td>
</tr>
<tr>
<td>Numeral</td>
</tr>
<tr>
<td>Shape</td>
</tr>
<tr>
<td>Colour</td>
</tr>
<tr>
<td>Sound</td>
</tr>
<tr>
<td>Smell</td>
</tr>
<tr>
<td>Logo</td>
</tr>
<tr>
<td>Graphic</td>
</tr>
<tr>
<td>Aspect of packaging</td>
</tr>
<tr>
<td>Combination of some or all forms</td>
</tr>
</tbody>
</table>

Apart from registration requirements, when selecting a trade mark, you should also consider marketing issues to ensure the chosen trade mark stands out and attracts consumer attention. Below is a checklist of issues to consider when selecting a trade mark:

**Issues to Consider when Selecting a Trade Mark**

- What is the nature of the mark? e.g. inventive word, graphics only, stylised
- Is the mark distinctive?
- Is the mark legible and easy to pronounce?
- Will the mark be used in colour?
- Is the nature of the mark appropriate for the goods and/or services it is applied?
- Are there identical or similar existing marks for similar goods and/or services?
- Have trade mark clearances been conducted so the organisation is free to use the mark?
- Is the mark already in use?
- Does the organisation own the copyright in the artwork of the mark?
- Does the mark achieve other marketing objectives?
- Is the mark offensive or misleading?
- Is the mark adopted from a foreign trade mark?
It is important to consider what goods or services you want to protect by your trade mark, because once the application is filed, the list of goods or services may not be expanded. Currently, there are 34 classes of goods and 11 classes of services. You may conduct a search of the different goods and services classes on IP Australia’s Classification Database: http://www.ipaustralia.gov.au.

Consider the issues below when selecting the goods and services to be protected by the trade mark registration:

<table>
<thead>
<tr>
<th>Issues to Consider when Selecting the Goods and Services to be Protected</th>
</tr>
</thead>
<tbody>
<tr>
<td>What is the nature of your business?</td>
</tr>
<tr>
<td>Where do you derive your business income?</td>
</tr>
<tr>
<td>What goods or services will your organisation provide?</td>
</tr>
<tr>
<td>What is your organisation known for doing by your customers?</td>
</tr>
</tbody>
</table>

Below are examples of different forms of trade marks and the issues regarding their registration:

<table>
<thead>
<tr>
<th>Form of trade mark</th>
<th>Example</th>
<th>Issues</th>
</tr>
</thead>
<tbody>
<tr>
<td>Inventive words</td>
<td>Trade Mark Number 359104 KODAK FILM K, CHEVRON PENTAGON STRIPES</td>
<td>Inventive words are generally distinctive because there is no known meaning or connotation arising from it. Plain words (i.e. not stylised) provide the broadest protection, and avoid the need to update the registration to reflect the particular style in use.</td>
</tr>
<tr>
<td>Stylised words</td>
<td>Trade Mark Number 93487 COCA-COLA</td>
<td>Stylised words may be distinctive; however, they will need to be updated when the style of the word changes.</td>
</tr>
</tbody>
</table>
### Form of trade mark

<table>
<thead>
<tr>
<th>Form of trade mark</th>
<th>Example</th>
<th>Issues</th>
</tr>
</thead>
<tbody>
<tr>
<td>Inventive words</td>
<td>Trade Mark Number 489050 NIKE, STRIPE, CURVED &amp; TAPERED FORMS SYMBOL, CORRECT OR SUNVISOR</td>
<td>Incorporation of a logo with a word can make a mark distinctive.</td>
</tr>
<tr>
<td>Graphics only</td>
<td>Trade Mark Number 497026 APPLE, SILHOUETTE WITH BITE APPLE STRIPED WITH BITE</td>
<td>Any kind of graphic representation may be used as a trade mark provided it is distinctive.</td>
</tr>
<tr>
<td>Colour</td>
<td>Trade Mark Number 1100096 SKYY VODKA, COLOUR BLUE BOTTLE</td>
<td>Colour marks are difficult to register because colour marks do not inherently distinguish goods/services from each other. It may only be registered if the colour is distinctive of the goods/services it offers.</td>
</tr>
</tbody>
</table>
**Trade mark searches**

It is vital you conduct a clearance search on the trade mark register to confirm that there are no existing similar trade marks for similar goods and services that could prevent you from registering your proposed trade mark. Further, it will avoid any potential trade mark infringement that may occur if the trade mark is registered.

Preliminary clearance searches may be conducted in-house, on the internet and through discussions with the marketing department and/or other employees familiar with current brands available on the market, then followed up with formal comprehensive searches by trade mark attorneys.


When conducting clearance searches, review other trade marks that are identical or similar to your proposed mark, and which relate to similar classes of goods and services to your proposed goods and services to which the proposed mark is to be attached.

The Australian Trade Mark Office offers use of their Assisted Filing Service (AFS) which provides an assessment of whether your proposed mark can be used and identifies if there are barriers to the registration of your mark. Further information on AFS is available at: [http://www.ipaustralia.gov.au/trademarks/afsbenefits.shtml](http://www.ipaustralia.gov.au/trademarks/afsbenefits.shtml).

It is recommended you seek the assistance of a trade mark attorney to ensure a comprehensive search is undertaken.

**The trade mark application process**

Set out in the diagram below is the procedure for applying for a trade mark.
Indicative Trade Mark Application Process

Trade Mark Application
The trade mark application must be in approved form. If filing requirements are met, a filing date is established. This will be the priority date if the application is the first filing for the trade mark.

Examination of Trade Mark Application
Does the trade mark application meet registration requirements?

YES
Acceptance
Notice of acceptance will be sent to the applicant.

Publication
Accepted trade mark is published in the Official Journal of Trade Marks.

Trade Mark Registered
The term of a trade mark is for an initial period of 10 years from the filing date of the application. Registration may be renewed perpetually, provided renewal fees are paid every 10 years.

NO
Examination Report
This report summarises any registration requirements that need to be addressed.

Submission of response by applicant

Opposition
Opposition may be initiated within 3 months of the date of notice in the Official Journal of Trade Marks. If opposition is successful, the accepted trade mark may be revoked.

Hearing
The applicant may request a hearing regarding the objections.
Registering a trade mark involves completing a trade mark application obtained from IP Australia in hard copy format, or by completing the application form online. A trade mark application must include the following information:

<table>
<thead>
<tr>
<th>Information</th>
<th>Requirements</th>
</tr>
</thead>
<tbody>
<tr>
<td>Details of the trade mark applicant</td>
<td>The applicant must have a legal personality, e.g. individual, company, incorporated association, or combination of these.</td>
</tr>
<tr>
<td></td>
<td>If the applicant is a company, use the corporation name and provide the company number (ACN). A business name or trading name is not acceptable because these names cannot own property.</td>
</tr>
<tr>
<td>Representations of the trade mark</td>
<td>The mark must be clear and legible for publication in the Official Journal of Trade Marks.</td>
</tr>
<tr>
<td></td>
<td>The mark must be reduced to 8cm by 8cm to fit into the box provided in the application.</td>
</tr>
<tr>
<td>Description of the trade mark</td>
<td>The description of the mark must be clear and precise, especially if the mark is a shape, scent, sound or colour.</td>
</tr>
<tr>
<td>Classes of goods and services</td>
<td>Since some goods and services may fall into multiple classes, it is recommended that you consult with an IP professional to determine the necessary classes in which the application should be filed to meet the needs of your organisation.</td>
</tr>
<tr>
<td>Description of goods and services of each class</td>
<td>The description of the goods and services with which the mark is to be associated must be clear and succinct.</td>
</tr>
</tbody>
</table>

You should be aware that once the application has been filed and details are published you cannot alter the trade mark substantially or add classes of goods and/or services, and the application fee cannot be refunded.

It is recommended that you consult a trade mark attorney to assist with trade mark applications.
An application fee will be required to be paid at the time of filing a trade mark application. Additional fees may be required to be paid depending on the action taken during the application process, such as requesting for an extension of time, or filing a notice of opposition.

These fees and their associated time-frames are subject to change and care should be taken to meet deadlines. Failure to do so may affect the success of your trade mark application.

A full list of trade mark fees is available on the IP Australia website located at: http://www.ipaustralia.gov.au/trademarks/fees_index.shtml.

Generally, applications are examined within 4-6 months from filing of the application. It is possible to request accelerated examination if the examination and/or registration of a trade mark is urgent, such as where there is an infringement issue or need to commit to an expensive marketing plan. The examination period may then be reduced to 4-6 weeks.

If the application does not meet all of the registration requirements, a report will be sent outlining the deficiencies in the application. You will need to reply to the examiner in writing and address the matters which have been raised within 15 months from the date of the examiner’s first report. Extensions of time may be requested with the appropriate fee. Failure to respond to the examiner’s report or request for an extension of time may result in the lapse of the application.

Once an application has been approved, it is published in the Official Journal of Trade Marks.

A trade mark application may be opposed by any interested party within 3 months of the date of notice in the Official Journal of Trade Marks, with a possible further 3 months extension.

A trade mark application may be opposed on any of the following grounds set out in the Trade Marks Act 1995 (Cth):
Grounds for Opposition

| The applicant is not the owner of the trade mark. |
| The applicant is not intending to use the trade mark. |
| The trade mark is similar to trade marks that have already acquired reputation in Australia. |
| The trade mark contains or consists of a false geographical indication. |
| The application was made in bad faith. |

Registration of the trade mark

If no opposition has been filed against your application, or if the opposition is unsuccessful, your trade mark will be registered once the registration fee is paid. The fee should be paid within 6 months from the date of the acceptance is advertised.

A Certificate of Registration will be sent to you and IP Australia will record the details of your trade mark in the Register of Trade Marks. The trade mark is registered from the date you filed the application, not the date it was examined or accepted.

Maintaining trade mark registration

Maintenance fees

Trade mark registration may potentially be perpetual, provided renewal fees are paid every 10 years. Each renewal fee must be paid within 12 months prior to the renewal date.

A full list of trade mark fees is available on the IP Australia website located at: http://www.ipaustralia.gov.au/trademarks/fees_index.shtml.

Use the trade mark

A trade mark must be used as a trade mark (i.e. to indicate a connection in the course of trade between the organisation and the goods and services to which it is applied) to maintain registration; otherwise it may be revoked for non-use.

Use the ® and ™ symbol

It is not a legal requirement to use the ® and ™ symbol to identify your trade mark, however it is advisable to do so.

The symbol ™ may be used with any registered or unregistered trade marks.

The symbol ® may be used with any registered trade mark in the territory within which it is registered.
Avoid generic use of the trade mark

If a trade mark becomes a generic word, the organisation may lose its trade mark protection because it is no longer distinctive or indicative of the organisation. For example, aspirin, nylon and cellophane were initially registered as trade marks but are now used to indicate goods of the kind rather than the source.

When using a trade mark, always avoid using the trade mark as a generic description of the goods/services by:

- using a ® and ™ after the trade mark,
- distinguishing the trade mark by capitalising the first letter of the trade mark, and
- always using the trade mark as an adjective - not as a noun.

For example, Xerox® or Xerox™, Xerox photocopier, and copy a document on a Xerox brand copy machine.

Obtaining foreign protection

Registered trade marks are territorial in nature and active steps will need to be taken to secure foreign trade mark registration. You may file for trade mark registration in foreign countries by:

- filing a national trade mark application in each country in which you wish to seek registration
- filing a single Community Trade Mark application (CTM) for the European Union countries, or
- filing an international application through the Madrid system for countries signatory to the Madrid Protocol. Madrid applications may be filed through IP Australia.

At the time of publication of this Manual, a list of countries that are signatories to the Madrid Protocol may be accessed at: http://www.wipo.int/treaties/en/SearchForm.jsp?search_what=C.

A foreign trade mark application will be examined and assessed according to the relevant trade mark laws and regulations of that country. Once registered, the foreign registration may be perpetual provided renewal fees are paid and maintenance requirements are met.

It is recommended that you seek the assistance of a trade marks attorney to coordinate obtaining foreign trade mark protection.

Domain Names

Should the domain name be registered?

The only avenue of gaining access to a domain name on the internet is by registration.

You should be aware that registration of a domain name does not give you any proprietary rights. Registration of a domain name gives the organisation exclusive use of that domain name for an agreed period of time.
How to register a domain name

Domain names are obtained through domain name registrars which are private companies that offer domain names for a fee to the public. An organisation may register any name as their domain name; provided that it is not already registered by another entity, and it bears a valid domain suffix (see below on 'Selecting a domain name').

The registrar will request contact details and other information for the registration of the organisation's selected domain name, which will be submitted to a central directory, the 'Registry'. The Registry provides information to internet users on the organisation's domain name, such as its Internet Protocol number, its registrar, and its technical administration contact.

A domain name registration contract will be entered into with the registrar setting out the terms and conditions under which the domain name registration is accepted and the obligations which the organisation need to comply with.

Selecting a domain name

A domain name is a unique address that identifies a website. It is the human-readable version of a website's internet protocol number. An organisation may register any domain name provided that it is not already registered by another entity, and it bears a valid domain suffix.

A domain name must contain at least 2 characters and contain no more than 63 characters, (excluding 'http://www'), and may consist of:

- the letters A-Z of the English alphabet, and/or
- numerals 0-9, and/or
- hyphens.

Other special characters, such as ! # * $, are not permitted.

Many organisations use the name of their organisation or their trade mark as their domain name. You will need to conduct a search to ensure that the proposed domain name is not already registered by another entity or individual. Searches can be conducted as a general search on an internet search engine, or on search engines offered by some domain name registrars.

If the domain name is already registered by another entity or an individual, it may be possible to purchase the domain name from them. However, it is likely they will charge a higher fee than buying a brand new domain name.

In some instances, legal action may be taken against those individuals or entities that have registered your proposed domain name without any legitimate interest, registered it in 'bad faith', and intended to profit from selling it to your organisation. This is referred to as 'cyber-squatting'. Seek legal advice if you suspect cyber-squatting by the individual or entity before taking any action.
The suffix of a domain name identifies the domain as belonging to a specific top level domain (TLD). TLDs are released by the Internet Corporation for Assigned names and Numbers (ICANN) which is responsible for managing and coordinating the Domain Name System. There are different TLDs, some of which may be restricted for use only by those entities that meet eligibility requirements. Examples of TLDs include:

<table>
<thead>
<tr>
<th>TLD Suffix</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>.com</td>
<td>Commercial</td>
</tr>
<tr>
<td>.net</td>
<td>Network</td>
</tr>
<tr>
<td>.org</td>
<td>Non-profit organisation</td>
</tr>
<tr>
<td>.gov</td>
<td>Government department &amp; agencies</td>
</tr>
<tr>
<td>.edu</td>
<td>Educational institutions</td>
</tr>
<tr>
<td>.mil</td>
<td>Military organisations</td>
</tr>
<tr>
<td>.au</td>
<td>Australia</td>
</tr>
<tr>
<td>.biz</td>
<td>Business</td>
</tr>
<tr>
<td>.int</td>
<td>International treaty organisations</td>
</tr>
</tbody>
</table>

You should note that the .com suffix in reality includes almost everything and the .net suffix is used when the .com suffix is not available.

In Australia, there are also .au second level domain (SLD) suffixes available for registration by Australian organisations. SLDs are restricted and must meet certain requirements. Examples of SLDs include:

<table>
<thead>
<tr>
<th>SLD Suffix</th>
<th>Requirements</th>
</tr>
</thead>
<tbody>
<tr>
<td>.com.au</td>
<td>For use by commercial entities registered and trading in Australia, and Australian commercial products and services.</td>
</tr>
<tr>
<td>.net.au</td>
<td>For use by Australian entities involved with internet networking and communications.</td>
</tr>
<tr>
<td></td>
<td>In reality, commercial entities registered and trading in Australia, and Australian commercial products and services may use this suffix.</td>
</tr>
<tr>
<td>.org.au</td>
<td>For use by Australian not-for-profit organisations, such as churches and charities.</td>
</tr>
<tr>
<td>.asn.au</td>
<td>For use by Australian associations incorporated under state legislation, such as trade unions, sporting and special interest clubs.</td>
</tr>
<tr>
<td>.id.au</td>
<td>For use by individuals who are Australian citizens or residents.</td>
</tr>
</tbody>
</table>
Domain name registrars are companies that sell or licence domain names for a fee. There are many registrars available that offer different TLDs, and they compete with each other to provide the best support and services at the lowest price.

A simple search on domain name registrars in Australia will provide a list of Australian domain name registrars.

You may also refer to ICAAN’s list of accredited domain name registrars from around the world, including Australia. This is located at: http://www.icann.org/registrars/accredited-list.html.

Australian Domain Name Administrator (.auDA), the delegated authority by the Australian government to manage the .au domain and the representative of .au at ICANN, also provides a list of accredited domain name registrars: http://www.auuda.org.au/registrars/accredited-registrars/.

When selecting a domain name registrar, consider the following issues:

<table>
<thead>
<tr>
<th>Issues to Consider when Selecting a Domain Name Registrar</th>
</tr>
</thead>
<tbody>
<tr>
<td>Is the domain name registrar accredited by .auDA or ICANN?</td>
</tr>
<tr>
<td>How much will it cost to register the domain name?</td>
</tr>
<tr>
<td>How long is the initial period of registration?</td>
</tr>
<tr>
<td>How long will you have to wait before you can use the domain name?</td>
</tr>
<tr>
<td>Does the domain name registrar offer the appropriate TLD or SDL you are seeking?</td>
</tr>
<tr>
<td>Does the domain name registrar offer web hosting services?</td>
</tr>
<tr>
<td>What are the terms and conditions of the contract?</td>
</tr>
<tr>
<td>Does the domain name registrar reserve the right to revoke your domain name for specific reasons?</td>
</tr>
<tr>
<td>Does the registrar reserve the right to change the terms and conditions without informing the organisation?</td>
</tr>
<tr>
<td>Will the organisation be able to transfer the domain name to another registrar?</td>
</tr>
<tr>
<td>Does the domain name registrar inform the organisation of upcoming renewal of the domain name registration?</td>
</tr>
</tbody>
</table>

You should ensure that renewal fees for the domain name are paid on time. A delay in payment may result in a loss of the domain name because after a certain period of time the registrar will offer the domain name to the general public.
The initial protection term of a domain name may vary from 1 to 10 years depending on the domain name registrar with which you register and the type of domain name licensed.
WHAT SENIOR MANAGEMENT MUST KNOW

What this Chapter covers .......................................................... 135
Ownership of IP by the Organisation ........................................ 135
  IP created by employees.......................................................... 135
  Moral rights ............................................................................ 135
  IP created by contractors....................................................... 136
IP Issues in Employment Contracts ........................................ 136
  Confidentiality obligations ................................................... 136
  Other obligations of employees ............................................ 137
  Post employment .................................................................... 137
Establishing an IP Management Framework ...................... 138
  What is an IP management framework?................................. 138
  Developing an IP policy.......................................................... 139
    Step 1: Conducting research ................................................. 139
    Step 2: Formulating the IP policy ....................................... 140
    Step 3: Review & finalisation .............................................. 141
    Example extracts of an IP policy .......................................... 142
  Developing the IP implementation plan ................................ 143
    Step 1: Reviewing the organisation’s IP policy and identifying available resources ........................................... 143
    Step 2: Formulating the IP implementation plan ............... 145
    Step 3: Review & finalisation .............................................. 146
IP Audits .................................................................................. 146
  Purpose of IP audits .............................................................. 146
  How to conduct an IP audit .................................................. 146
    Step 1: Scoping the IP audit ............................................... 147
    Step 2: Identifying existing IP assets .................................. 147
    Step 3: Analysing the information ...................................... 149
    Step 4: Reporting results of the IP audit ......................... 149
IP Valuation .............................................................................. 149
  Importance of IP valuation ..................................................... 149
Qualitative valuation
How to qualitatively value IP
Quantitative valuation
How to quantitatively value IP

Accounting Practices for IP
IP assets in financial statements
Definition of intangible assets and under AASB 138
Financial statements

Dealing with IP Rights in Contracts
IP ownership positions in contracts
Sole ownership
Joint ownership
Licence rights
Sole and joint ownership and licence rights compared
IP due diligence when acquiring IP
Research collaborations
Research collaboration agreements
Checklist for research collaborations
Government grants
Senior managers are responsible for the management of all of the assets of an organisation and need to be aware of and familiar with the issues involved in managing the IP of the organisation.

This Chapter provides guidance to senior managers on how to:

- retain ownership of IP created by employees and contractors
- establish an IP management framework for the effective management of IP within an organisation
- conduct an IP audit
- assess and value IP assets
- account for IP in financial statements, and
- deal with IP rights in contracts, including an overview of the different ownership positions that may arise in contracts with an IP component.

An organisation will usually wish to ensure that IP generated by employees is owned by the organisation.

Generally, at law all IP created by employees of an organisation in the course of their employment belongs to the organisation. Nevertheless, it is good practice to ensure that employment contracts contain express provisions governing IP ownership. This may include clauses to the effect that:

- all IP generated, modified or improved by the employee in the course of his or her employment with the organisation will vest in the organisation, and
- the employee will sign all necessary documents to assign the IP to the employer.

Under some IP legislation in Australia (e.g. Patents Act 1990 (Cth) and Copyright Act 1968 (Cth)), assignment of IP from the owner to another entity must be in writing and signed by both the assignor and assignee before it will be recognised. Where such formal assignments are required it is good practice for the organisation also to ensure that the formal assignments are executed by the employee promptly upon the creation of the IP.

Moral rights are the rights of an author of a copyright work to be identified as the author of his or her work, not to have a work falsely attributed to him or her, and not to have the work subjected to derogatory treatment.

Unlike other IP rights, moral rights are personal in nature and cannot be assigned to the organisation. However, the organisation may wish to obtain consents from the employee to any act by the organisation which may otherwise infringe their
moral rights. Provision of such consents may again be included in the organisation’s employment contracts or relevant confidentiality/IP agreements.

**IP created by contractors**

Generally, unless there is a written agreement to the contrary, IP generated by an independent contractor will belong to the contractor, with the organisation which engaged the contractor being entitled to use the IP only for the purpose for which it was provided to the organisation under the contract.

All services, consultancy and other agreements with contractors will therefore need to deal with ownership of IP and may need to include (where otherwise appropriate) an assignment clause transferring to the organisation the rights in any IP created by the contractor in the course of carrying out the work. It is also usual, where ownership is transferred, to require the contractor to do all things necessary to give effect to the organisation’s right to ownership, including executing formal IP assignments.

All arrangements for work to be undertaken by contractors should be set out in a written agreement and such agreements should be subject to legal review to ensure all necessary rights are obtained by the organisation.

For more information on different ways of dealing with IP in contracts, see the section ‘IP Ownership Positions in Contracts’ in this Chapter.

**IP Issues in Employment Contracts**

**Confidentiality obligations**

Some of the other issues, apart from IP ownership, which the organisation will need to consider with respect to IP created by employees and contractors are set out below.

It is good practice to require employees to undertake specific obligations of confidentiality in relation to the organisation’s trade secrets, financial information, technical know how and other valuable information. Such obligations may be included in the employment contract or in separate confidentiality agreements which employees are asked to sign as a condition of their employment.

The confidentiality provisions need to state clearly

- the information to which the obligations apply
- the actual obligations and restrictions imposed on the employee
- the consequences of any unauthorised use or disclosure of the organisation’s confidential information, and
- that the obligations will continue to apply after termination of their employment with the organisation.
It is important that employees are aware of their other more general obligations relating to IP, both with respect to the organisation’s existing IP as well as any new IP they generate. The obligations need to be clearly defined and set out in the organisation’s employment contract, as well as in its IP policy and IP implementation plan.

For more information on the development of an organisation’s IP policy and IP implementation plan, see the section entitled ‘Establishment of an IP Management Framework’ in this Chapter.

Confidentiality obligations in employment contracts usually continue to apply after the employee has left the organisation. Upon termination of employment, employees should be required to return to the organisation all material in their possession which refers to or contains any of the organisation’s IP or confidential information.

Employment contracts may also include restraints which limit an employee’s right to act in competition with the organisation for a specific period after their employment with the organisation ends. The restraint on the employee may not be broader in terms of geographical area and duration than is reasonably necessary for the protection of the organisation’s legitimate interests. This type of clause therefore needs to be carefully worded as any unreasonable restraint of trade will be unenforceable. Inclusion of a restraint will usually be dependent upon the nature of the position, seniority and the role of the employee.

All employment contracts and confidentiality agreements should be the subject of legal review to ensure that they give all necessary rights to the organisation.

The checklist below summarises the key IP issues which should be addressed in the organisation’s employment agreements.

**Provisions in employment contracts relating to IP may include:**

<table>
<thead>
<tr>
<th>Provision</th>
</tr>
</thead>
<tbody>
<tr>
<td>Obligations to keep the organisation’s existing IP and confidential information secret.</td>
</tr>
<tr>
<td>Restrictions on the employee’s use of the organisation’s IP and confidential information.</td>
</tr>
<tr>
<td>Necessary consents from an employee regarding acts which may otherwise infringe any moral rights the employee may have in any work created in the course of employment.</td>
</tr>
<tr>
<td>Requirement to comply with the organisation’s policies, practices and procedures relating to IP, including record keeping procedures and security measures.</td>
</tr>
<tr>
<td>Agreement that all IP developed by the employee in the course of employment will be owned by the organisation.</td>
</tr>
</tbody>
</table>
Provisions in employment contracts relating to IP may include:

- Obligation to provide all necessary assistance to give effect to the organisation’s ownership rights, including signing additional documents to that effect.
- Conditions of use with respect to any IP the employee brings to the organisation.
- Obligation to return all materials in their possession which refers to or contains any of the organisation’s IP or confidential information.
- (Dependent on role and responsibilities) Restraint on employee acting in competition for a specific period after their employment with the organisation ends.

**Establishing an IP Management Framework**

What is an IP management framework?

Building a culture of IP awareness throughout the organisation, maintaining continued protection of IP rights and ensuring proper management of IP assets is ideally underpinned by the establishment of an IP management framework.

An example of IP management framework is represented in the following diagram.

![IP Management Framework Diagram](image)

The IP management framework assists the organisation to manage its IP by:

- aligning policies on IP management with the organisation’s core functions and objectives
- providing guidance on making a range of decisions regarding the management of IP assets
- increasing awareness of the importance of IP throughout the organisation, and
- encouraging better IP practices.

An IP management framework will be most effective when it becomes an integral part of the organisation’s existing management and operational structure.
Developing an IP policy

An IP policy is a statement of principles governing the organisation’s management and practices in relation to IP. It provides guidance to officers and employees on the importance an organisation places on its IP and the practices for protecting and managing IP assets.

The development of an IP policy generally involves three steps:

1. **Conducting research**
   - Locate and review all documentation that defines the organisation’s corporate mission.
   - Review all policies that may be relevant to IP management, such as privacy, software use, e-mail, security, record keeping and confidentiality policies.
   - Review all standard documents that deal with IP assets, such as IP ownership provisions in standard contracts used to engage contractors, IP reporting mechanisms and procedures on maintaining laboratory notebooks and design workbooks.
   - Consult with all relevant parties.
   - List all types of IP commonly developed, acquired or dealt with by the organisation, and the relative importance of each to the organisation.
   - Research current practices for managing IP by interviewing relevant employees.

2. **Formulate the IP policy based on the information obtained**

3. **Review and finalise IP policy**

An IP policy needs to be tailored to an organisation’s corporate objectives. Identifying the organisation’s mission, business objectives, core functions and relevant policies is essential for determining the organisation’s IP management needs.

Throughout Step 1, it is vital to involve and consult with all relevant officers and employees of the organisation who may be able to provide relevant information. The knowledge and experience of employees may provide valuable insight into the shortcomings of the organisation’s existing IP practices and potential for improvements.

**Recommended actions for Step 1**

- Locate and review all documentation that defines the organisation’s corporate mission.
- Review all policies that may be relevant to IP management, such as privacy, software use, e-mail, security, record keeping and confidentiality policies.
- Review all standard documents that deal with IP assets, such as IP ownership provisions in standard contracts used to engage contractors, IP reporting mechanisms and procedures on maintaining laboratory notebooks and design workbooks.
- Consult with all relevant parties.
- List all types of IP commonly developed, acquired or dealt with by the organisation, and the relative importance of each to the organisation.
- Research current practices for managing IP by interviewing relevant employees.
- Identify possible alternatives to the organisation’s current IP practices. For more information on what forms of IP protection that are available for different subject matter, see Chapter 2 ‘What Everyone Must Know’ and Chapter 5 ‘What Managers Making IP Protection Decisions Must Know’.
Step 2: Formulating the IP policy

When formulating and drafting the IP policy, it is important to use clear, concise language that can be easily read and understood by employees at all levels.

An IP policy will typically include principles dealing with the following issues:

<table>
<thead>
<tr>
<th>Principle</th>
<th>Content</th>
</tr>
</thead>
<tbody>
<tr>
<td>Policy objective</td>
<td>Summary of the organisation’s aims and business objectives, including an explanation of how the creation, protection, management and exploitation of IP are important for achieving those aims and objectives.</td>
</tr>
<tr>
<td>Scope</td>
<td>Overview of the persons to whom the IP policy will apply, such as employees and contractors, visitors and volunteers of the organisation and its related entities. The scope may also limit the application of the IP policy to certain types of IP.</td>
</tr>
<tr>
<td>Nature and forms of IP</td>
<td>Outline of the different forms of IP commonly created or acquired by the organisation, and the particular forms of IP that are of most value to the organisation.</td>
</tr>
<tr>
<td>Identification and reporting of IP</td>
<td>Guidance on how to recognise an IP asset that may have potential commercial value to the organisation, including an explanation of the need to report all newly developed IP for the organisation to determine how best to protect and exploit it. For more information on identifying IP, see the section entitled ‘IP Audits’ of this Chapter. For more information on reporting IP, see Chapter 4 ‘What Researchers and Design Engineers Must Know’.</td>
</tr>
<tr>
<td>Ownership of IP</td>
<td>Direction on the organisation’s policy regarding ownership of IP developed by employees, contractors, visitors, volunteers and other third parties. For more information on IP ownership, see the section entitled ‘Ownership of IP by the Organisation’ of this Chapter.</td>
</tr>
<tr>
<td>Protection of IP</td>
<td>Explanation of the importance of actively protecting IP and the consequences if protection is not maintained. This should include guidance on how to make IP protection decisions for each form of IP that is relevant to the organisation. For more information on making IP protection decisions, see Chapter 5 ‘What Managers Making IP Protection Decisions Must Know.’</td>
</tr>
</tbody>
</table>
### Principle | Content
--- | ---
**Ongoing management of IP** | Procedures for the proper management of IP including:
- the conduct of periodic reviews of existing IP assets
- the ongoing decision-making process regarding IP protection and commercialisation, and
- disposal of IP.

For more information on the ongoing management of IP, see Chapter 4 ‘What Researchers and Design Engineers Must Know’ and Chapter 5 ‘What Managers Making IP Protection Decisions Must Know’.

**IP valuation** | Guidance on the organisation’s approach to quantitative and qualitative valuations of IP.

For more information on IP valuation, see the section ‘IP Valuation’ in this Chapter.

**Commercial exploitation of IP** | Guidance on the instances when commercialisation of IP is appropriate and the issues to consider when making IP commercialisation decisions. This section should also provide information on what authorisations are necessary when making IP commercialisation decisions.

For more information on IP commercialisation, see Chapter 7 ‘What Must Be Known About IP Commercialisation’.

**Recognition of employee contribution** | Policy on how the organisation recognises employee contribution to the development of IP.

For more information on recognition of employee contributions, see the section entitled ‘Stimulating creativity’ in Chapter 3 ‘What the Board and CEO Must Know’.

**Potential conflicts of interest** | Explanation of potential conflicts of interest that may arise in relation to the ownership, management, protection or exploitation of IP, and guidance on how to avoid or deal with such conflicts.

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**Step 3: Review & finalisation**

The development of an IP policy will usually involve numerous reviews and revisions. It may also be necessary to re-examine and refine the organisation’s IP management needs in order to align them with the organisation’s overall objectives and operational needs.
The structure of an IP policy will vary from one organisation to another. Some organisations may not have the time or resources necessary to conduct a thorough and organisation-wide research and formulation exercise and will instead focus only on issues which present the greatest risk or are likely to have the greatest impact on achieving its business objectives. Other organisations may have sufficient time and resources to develop a more comprehensive IP policy dealing with all areas of IP management.

Below are several examples of IP principles which may be found in some IP policies.

**Policy Objective**

‘Our corporate mission is to provide innovative and creative solutions designed to exceed market expectations in every facet of the communications, science and electronics industries. The creation of each innovative solution is a valuable form of Intellectual Property (IP).

The objectives of this IP policy are to provide guidance on best practice and appropriate procedures for the protection, management and commercialisation of IP. We will develop and maintain appropriate processes for the management of IP through our IP implementation plan.’

**Identification and Reporting of IP – Patents**

‘The IP Officer should be immediately made aware of all new innovations when they occur by completion of an invention disclosure form. An evaluation will be made by the IP Committee as to whether the innovation warrants patent protection.

Further, the IP Officer should be immediately made aware of any new technology-based market opportunities that may arise which will be assessed for feasibility for new projects by the IP Committee.’
An IP implementation plan sets out the chosen processes and procedures for the implementation of the organisation’s IP policy. It provides guidance on a practical and operational level on the practices and procedures to be followed by the organisation’s employees in relation to the management of IP.

The process of developing an IP implementation plan is similar to the development of the IP policy, but with emphasis on integrating the policy into operations and dealing with the practicalities involved in managing IP.

The development of an IP implementation plan usually involves the following three steps:

**Step 1:** Reviewing the organisation’s IP policy and identifying available resources

**Step 2:** Formulating an IP implementation plan

**Step 3:** Reviewing and finalising the IP implementation plan

The IP implementation plan is a tool to implement an organisation’s IP policy. The organisation’s IP policy will need to be reviewed in order to ensure each IP principle is addressed in the IP implementation plan at an operational level.

An IP implementation plan will usually incorporate and build on systems which are already in place within the organisation. The need to create entirely new processes or systems should be avoided or minimised where possible. Relevant existing processes and systems may include:

---

**Protection of IP – Confidential Information**

‘Everyone should take all reasonable precautions and steps to preserve all of our confidential information. Before disclosing any confidential information, you need to consult and obtain approval from management. Appropriate confidentiality agreements must be entered into with the recipients of the confidential information before any disclosure is made.

Failure to observe these rules will result in unnecessary loss of protection of our confidential information which could negatively impact on our competitive advantage.’

**Commercialisation of IP**

‘The organisation aims to commercialise all IP that it develops for the advancement and profit of the organisation.

You should consult your manager on the prospects of commercialisation of a particular IP asset. A proposal for the commercialisation of the IP asset should be prepared for evaluation and approval by the Board who will make a decision as to whether it should be commercialised, and if so, when and how.’
<table>
<thead>
<tr>
<th>System</th>
<th>Relevant issues</th>
</tr>
</thead>
<tbody>
<tr>
<td>Asset Management</td>
<td>Are all IP assets included in the existing asset register?</td>
</tr>
<tr>
<td></td>
<td>Are all IP assets included in financial reports and annual reports?</td>
</tr>
<tr>
<td>Risk Management</td>
<td>Do the existing risk management systems take into account the risks relating to the protection, management, use and commercialisation of IP?</td>
</tr>
<tr>
<td></td>
<td>Does the organisation adequately protect its position with respect to IP when dealing with third parties by including appropriate provisions in agreements regarding warranties, indemnities, limitation of liability and insurance?</td>
</tr>
<tr>
<td></td>
<td>Has the organisation obtained any IP insurance?</td>
</tr>
<tr>
<td></td>
<td>Does the organisation obtain professional legal advice relating to IP where necessary?</td>
</tr>
<tr>
<td>Contract Management</td>
<td>Do all contracts dealing with the creation of IP (such as employment contracts, outsourcing and consulting contracts) address IP ownership issues?</td>
</tr>
<tr>
<td></td>
<td>Do the organisation’s standard form contracts contain appropriate IP clauses, including different alternatives depending on the type of transaction?</td>
</tr>
<tr>
<td></td>
<td>Does the organisation provide clear guidelines on its preferred position in relation to IP clauses?</td>
</tr>
<tr>
<td>Financial Approval and Budgeting</td>
<td>Does the annual budget provide for the costs of managing IP?</td>
</tr>
<tr>
<td></td>
<td>Are there processes in place for obtaining financial approval for the development of new IP?</td>
</tr>
<tr>
<td>Record Keeping</td>
<td>Are there procedures in place for documenting the creation and development of IP in laboratory notebooks and design workbooks?</td>
</tr>
<tr>
<td></td>
<td>Does the organisation have an IP register which is properly maintained and updated, including regular reviews and reassessments of the IP?</td>
</tr>
<tr>
<td>Employee Management</td>
<td>Are there any formal or informal programmes in place recognising and rewarding the contribution of employees to the creation of IP?</td>
</tr>
<tr>
<td></td>
<td>Does the organisation provide regular training sessions on IP management?</td>
</tr>
<tr>
<td></td>
<td>What are the incentives or motivational tools in place to stimulate creativity?</td>
</tr>
</tbody>
</table>
You will also need to consult with all relevant stakeholders within your organisation regarding practical measures to implement the organisation's IP policy.

Effective IP management requires all employees to be familiar with and adhere to the provisions set out in the IP implementation plan. Ideally, the IP implementation plan should be written in clear, concise language that can be easily read and understood by all employees, including the use of visual tools such as diagrams, checklists and tables where appropriate.

When formulating the IP implementation plan, list the systems or procedures that are required and compare them with the existing systems that may be utilised. Once you have performed the above analysis, you will be able to identify:

- existing systems into which IP management can integrate, and
- systems or procedures that need to be put in place.

An IP implementation plan will generally address the following issues:

<table>
<thead>
<tr>
<th>Issue</th>
<th>Content</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Objective</strong></td>
<td>Statement of the organisation’s aims for the IP implementation plan, e.g. to set out operational practices and procedures for implementing the organisation’s IP policy.</td>
</tr>
<tr>
<td><strong>Strategies for Implementation</strong></td>
<td>Outline of the organisation’s strategies for the management of IP which correspond with the IP principles contained in its IP policy. These strategies are ideally incorporated into existing processes and systems identified in Step 1.</td>
</tr>
<tr>
<td><strong>Resources</strong></td>
<td>Overview of the resources to be used for the management of IP, which will usually include the utilisation of existing systems, time spent by senior management, as well as adequate corporate support from relevant employees.</td>
</tr>
<tr>
<td><strong>Authority and Responsibility</strong></td>
<td>Explanation of the organisation’s IP management structure, including an overview of the persons responsible for making decisions at the different levels of IP management and the scope of authority for those dealing with IP.</td>
</tr>
<tr>
<td><strong>Increasing IP Awareness</strong></td>
<td>Statement of planned actions to promote knowledge and awareness of IP such as:</td>
</tr>
<tr>
<td></td>
<td>• including IP issues in staff inductions</td>
</tr>
<tr>
<td></td>
<td>• providing regular training on IP</td>
</tr>
<tr>
<td></td>
<td>• communicating the organisation’s IP policy and IP implementation plan to all employees, and</td>
</tr>
<tr>
<td></td>
<td>• developing standard contracts that address IP issues.</td>
</tr>
</tbody>
</table>
Guidance on sources of expert advice and assistance. These may include internal advice from in-house lawyers or senior management responsible for managing IP, or external advice from legal advisers, patent & trade mark attorneys or other consultants such as market researchers or business advisers.

For more information on obtaining expert advice, see Chapter 9 ‘Where Can I Find Out More About IP’.

Outline of a mechanism for the review of the IP implementation plan to evaluate the effectiveness of the organisation’s practices in light of its objectives set out in the IP policy.

The IP implementation plan is the organisation’s ‘instruction manual’ regarding its approach to the management of IP. It will be referred to frequently by employees at all levels within the organisation for guidance on the practices and procedures relating to IP. The IP implementation plan may therefore need to be reviewed and revised several times before it can be finalised. All relevant employees should be consulted in the process to ensure the most appropriate operational practices are adopted for the implementation of the IP policy.

The identification of an organisation’s IP assets provides the basis for good IP management. An IP audit may be conducted as part of an organisation’s IP management framework and will assist senior management to:

- shape the organisation’s product development strategy
- identify risks associated with the organisation’s IP assets
- make informed decisions regarding IP protection and enforcement
- develop an IP commercialisation strategy
- avoid duplication in the acquisition or development of IP, and
- minimise the risk of infringing third party IP rights.

Conducting an IP audit is a complex, detail-orientated exercise.

It is recommended that you seek the assistance of an IP professional to carry out a comprehensive IP audit.
Conducting an IP audit involves four steps, as illustrated by the diagram below:

**Step 1: Scoping the IP audit**

The first step in an IP audit is the identification of an organisation’s objectives for and the extent of the audit. An organisation may undertake an IP audit for such purposes as:

- complying with a requirement of the organisation’s IP management framework
- assessing the organisation’s IP portfolio
- reviewing existing product development strategies
- identifying new IP created or acquired by an organisation
- conducting a due diligence exercise, or
- pursuing the enforcement or defence of IP rights.

The scope of the audit may be affected by the availability of the organisation’s finances and other resources to conduct the IP audit. Depending on those factors and the objectives of the IP audit, an organisation may undertake an IP audit limited to specific types of IP or particular departments within the organisation.

**Step 2: Identifying existing IP assets**

Existing IP assets held within an organisation may be identified in a number of ways depending on the scope of the IP audit. This process will generally require a significant amount of time and resources. Examples of how IP assets may be identified include:

- review of documentation
- targeted requests for specific information directed at relevant employees
- an organisation-wide IP survey, and
- site visits and interviews.

It is important that the process for gathering information is effective, comprehensive and in line with the objectives of the audit. In some instances, introductory workshops for the relevant staff regarding the IP audit may assist. The auditor should ensure that each answer to a survey, request for information or interview is supported by relevant documentation.
### Supporting documentation may include:

- Laboratory notebooks and design workbooks
- Employment contracts
- Consultancy or service contracts
- Funding agreements
- Confidentiality agreements
- Licences, assignments or other agreements dealing with the relevant IP asset
- Official documents from IP Australia or overseas IP offices

A checklist of information that is ideally obtained for each IP asset may resemble the following:

### Information to be obtained:

- Description of the IP asset, including form, expression and format
- Date of creation
- Expected date of expiration of IP rights
- Details of creators, including inventors and other contributors to patentable inventions
- Status of all creators (such as employee or contractor)
- Where the IP asset was acquired from a third party, description of the relationship with the third party, including details of any contractual arrangements
- Details of any commercial dealings, e.g. licences, assignments
- Potential risks associated with the IP asset
- Details of any third party claims regarding the IP asset
- Details of any encumbrances, such as mortgages, charges or other third party interests in the IP asset
- Any other material or information relating to the IP asset or its development
Step 3: Analysing the information

The information and supporting documentation collected in Step 2 will need to be analysed carefully in light of the objectives of the IP audit. This analysis will require a detailed review and assessment of all the supporting documentation in order to confirm each detail obtained at Step 2, including:

- the validity and ownership of each IP asset
- the existence of any third party rights
- any restrictions on the organisation’s rights to use the IP asset, and
- the likely remaining life of the IP asset.

Step 4: Reporting results of the IP audit

The final step in the IP audit process is the preparation of a report of the results of Steps 2 and 3. The report needs to be tailored to the organisation’s objectives of the IP audit established in Step 1. In addition, the report may provide information on:

- the effectiveness of the organisation’s IP management framework
- the strengths and weaknesses of the organisation’s overall IP position
- appropriate ways to monitor IP development in the future
- possible improvements to the organisation’s IP protection strategy
- areas of potential overlap with third party activities where the organisation may be infringing third party rights, and
- IP assets for which management decisions are necessary.

IP Valuation

Importance of IP valuation

Understanding the value of the organisation’s various IP assets is essential for the effective management of IP. Valuation of IP is not just concerned with the quantifiable value of an IP asset, but also with its qualitative value to the organisation.

<table>
<thead>
<tr>
<th>Qualitative Valuation</th>
<th>Quantitative Valuation</th>
</tr>
</thead>
<tbody>
<tr>
<td>Assessment of the importance of an IP asset to the organisation</td>
<td>Assigning a dollar value to an IP asset</td>
</tr>
</tbody>
</table>

Assessing the worth of an organisation’s IP will assist an organisation to form a view about whether particular IP is essential, secondary or surplus to the operation of the organisation. You should however be aware that the value of an IP asset may change over time depending on the nature of the IP and its strategic importance to the organisation.
Qualitative valuation

A qualitative valuation of an IP asset involves assessing the importance of the IP to the organisation.

An organisation may wish to conduct a qualitative assessment of its IP portfolio in one or more of the following scenarios:

**When to Conduct Qualitative IP Valuation**

- When deciding whether to continue with a particular research project.
- When deciding whether to apply for formal protection of an IP asset (e.g. patents, trade marks, designs).
- When deciding whether to dispose of IP.
- When licensing-in third party technology.
- When granting access to the organisation’s IP to third parties.
- When deciding how best to commercialise an IP asset.

How to qualitatively value IP

The issues that need to be considered when undertaking a qualitative valuation of an IP asset may include the following:

<table>
<thead>
<tr>
<th>Area</th>
<th>Issues</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Strategic and operational significance</strong></td>
<td>Is the IP asset essential for carrying out the organisation’s functions or achieving its objectives?</td>
</tr>
<tr>
<td></td>
<td>Is the IP asset necessary for the performance of a particular key task?</td>
</tr>
<tr>
<td></td>
<td>Does the organisation require continued access to the IP?</td>
</tr>
<tr>
<td></td>
<td>How much has the organisation invested in the creation and development of the IP asset?</td>
</tr>
<tr>
<td></td>
<td>What are the future maintenance costs of the IP asset?</td>
</tr>
<tr>
<td></td>
<td>Could the IP asset be replaced, and if so, at what cost?</td>
</tr>
<tr>
<td></td>
<td>How does the performance of the IP compare with available alternatives?</td>
</tr>
</tbody>
</table>
### Commercial Potential

<table>
<thead>
<tr>
<th>Area</th>
<th>Issues</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>What is the nature of the IP asset?</td>
</tr>
<tr>
<td></td>
<td>At what stage of development is the IP asset?</td>
</tr>
<tr>
<td></td>
<td>Can the IP asset be commercialised without much further adaptation or development?</td>
</tr>
<tr>
<td></td>
<td>Is there a demand for products or services applying the IP? If so, what is the estimated market size?</td>
</tr>
<tr>
<td></td>
<td>Are other organisations likely to be interested in using, buying or licensing the IP asset?</td>
</tr>
<tr>
<td></td>
<td>Can the IP asset be formally registered and protected, e.g. as a patent, registered design or trade mark?</td>
</tr>
<tr>
<td></td>
<td>Does the organisation have the unrestricted right to commercialise the IP asset?</td>
</tr>
<tr>
<td></td>
<td>Does the IP support products making up a substantive part of the organisation’s revenue?</td>
</tr>
<tr>
<td></td>
<td>What IP supports your most profitable products?</td>
</tr>
<tr>
<td></td>
<td>Does your IP bring in revenue independently (e.g. from licences) and how much?</td>
</tr>
<tr>
<td></td>
<td>To what extent does your IP give your products an advantage over those of your competitors?</td>
</tr>
<tr>
<td></td>
<td>How much can you charge for your products above your competitors because of that advantage?</td>
</tr>
<tr>
<td></td>
<td>Does your IP confer a marketing advantage over your competitor?</td>
</tr>
<tr>
<td></td>
<td>Will consumers perceive your products as better quality because of the IP?</td>
</tr>
<tr>
<td></td>
<td>Is your IP necessary to raise funding for expansion?</td>
</tr>
<tr>
<td></td>
<td>How do potential sources of finance view your IP?</td>
</tr>
</tbody>
</table>

Below are some examples as to how the above criteria are applied in various scenarios of IP management. The relative importance of the IP in that criterion may be ranked ‘high’, ‘medium’, or ‘low’.
Example 1

An organisation has developed a software program for a particular project and has obtained a patent for the software in Australia and the United States. The software is highly specific to the project and does not have other general uses. The project was abandoned by the organisation five years ago. In addition, technology has advanced so that the purpose served by software is almost redundant.

Should the organisation let the patent lapse before its expiry date?

<table>
<thead>
<tr>
<th>Criteria</th>
<th>Rank</th>
<th>Rationale</th>
</tr>
</thead>
<tbody>
<tr>
<td>Strategic and operational</td>
<td>Low</td>
<td>While the custom-made software program was tailor-made for the organisation, the relevant project had been abandoned for five years.</td>
</tr>
<tr>
<td>significance</td>
<td></td>
<td></td>
</tr>
<tr>
<td>Commercial potential</td>
<td>Low</td>
<td>It is unlikely that other entities would be interested in acquiring software due to advancement of technology.</td>
</tr>
</tbody>
</table>
Quantitative valuation

In general, quantitative valuation of an IP asset focuses on assigning a dollar amount to the IP asset.

An organisation may wish to conduct a quantitative assessment of its IP portfolio in scenarios including one or more of the following:

- When preparing financial statements.
- When determining the sale or purchase price for a transaction involving IP (e.g. in an IP assignment or an IP licence).
- When raising finance.
- When facing a merger/acquisition of the organisation.
- When deciding how best to commercialise an IP asset.
- When determining potential damages in a legal action involving IP.

There are various methods for quantitatively valuing IP. Each method has its advantages and disadvantages and not all methods will be appropriate for valuing all types of IP assets. The method chosen will also depend on the purpose of the valuation and the information available.

In general, the following information will be assessed when valuing IP quantitatively:

- the strength of the IP rights
- the expected life of the IP asset
- the stage of development of the IP asset
- the size of the potential market, and
- the availability of alternative technologies.

The three common quantitative valuation methods for IP assets are:

<table>
<thead>
<tr>
<th>Cost Approach</th>
<th>Income Approach</th>
<th>Market Approach</th>
</tr>
</thead>
<tbody>
<tr>
<td>To determine the reproduction or replacement cost of the IP at the date of the valuation.</td>
<td>To determine the estimated future income to be generated by the IP asset over its effective life.</td>
<td>To determine the comparable price or royalty that could be achieved by similar IP in the market.</td>
</tr>
</tbody>
</table>
Quantitative valuation of IP typically involves the following steps:

**Step 1: Scoping the valuation**
When an organisation decides to undertake quantitative IP valuation, it should first determine the scope of the valuation.

<table>
<thead>
<tr>
<th>Issues to be Considered When Scoping the Quantitative IP Valuation</th>
</tr>
</thead>
<tbody>
<tr>
<td>What is the purpose of the valuation?</td>
</tr>
<tr>
<td>Which IP portfolio is to be valued?</td>
</tr>
<tr>
<td>What is the date at which the IP is to be valued?</td>
</tr>
<tr>
<td>Who will be relying on the outcome of the valuation?</td>
</tr>
<tr>
<td>What resources should be used for the valuation?</td>
</tr>
</tbody>
</table>

**Step 2: Gathering information**
The kind of information required for IP valuation will depend on the method for quantitative valuation.

- **Cost approach**
  It is recommended that you seek the assistance of a valuation expert when selecting the most appropriate valuation approach and undertaking the valuation process.

- **Replacement Costs**
The costs of replacing the IP asset with an asset of similar utility, but not necessarily the same IP asset.

- **Reproduction Costs**
The costs that will be incurred in order to reproduce exactly the same IP asset.

**Step 3: Valuing and reporting**
The following information is usually required for a quantitative valuation of IP using the cost approach:

<table>
<thead>
<tr>
<th>Area</th>
<th>Details</th>
</tr>
</thead>
<tbody>
<tr>
<td>Material costs</td>
<td>The costs of tangible materials necessary for the development of the IP, such as raw materials, computers, books and software licence fees.</td>
</tr>
<tr>
<td>Labour costs</td>
<td>The costs of staff and contractors required for the development of the IP, including wages, salaries, consultancy fees, workers compensation insurance costs and superannuation contributions.</td>
</tr>
<tr>
<td>Overhead costs</td>
<td>A proportion of the costs of utilities and administration.</td>
</tr>
<tr>
<td>Other information</td>
<td>Any other information required for the calculation of the costs of recreating or replacing the IP asset, including time and resources.</td>
</tr>
<tr>
<td>Profit/incentive component</td>
<td>The amount of profit that would be sufficient to motivate the organisation to enter into the development process.</td>
</tr>
</tbody>
</table>

The cost approach may be useful in determining the minimum value of an IP asset that the organisation intends to sell or purchase. However, this approach does not take into account a wide range of other factors that may increase or decrease the value of the IP asset, such as the strength of the IP rights or the length of time needed to create alternatives.

**Income approach**

The income based approach values an IP asset by establishing the anticipated future income to be generated by the IP asset over the course of its life.

The following information is generally needed for an income based valuation:

<table>
<thead>
<tr>
<th>Area</th>
<th>Details</th>
</tr>
</thead>
<tbody>
<tr>
<td>Projected profits</td>
<td>Current market information, including market opportunities, competition and selling prices.</td>
</tr>
<tr>
<td></td>
<td>Future sale prices.</td>
</tr>
<tr>
<td></td>
<td>Expected market share and volume of products expected to be sold.</td>
</tr>
<tr>
<td></td>
<td>Historical market information on the effective life of comparable IP assets.</td>
</tr>
<tr>
<td></td>
<td>Cost of goods sold.</td>
</tr>
<tr>
<td></td>
<td>Future capital expenditure, marketing and other expenses.</td>
</tr>
</tbody>
</table>
The income based approach is most useful where reliable data is available in relation to the estimated effective life and projected profits of an IP asset. The main weakness of the income approach is that the valuation is based on a significant number of estimates and assumptions. Relatively small variations of the estimated effective life or the projected profits can significantly reduce or increase the final value arrived at using this approach.

**Market approach**

The market approach values an IP asset based on comparisons with sales or licensing income of similar IP assets in the market place.

This approach requires accurate and complete data for commercial transactions involving comparable IP assets, such as licences and assignments.

The following information on comparable IP asset is generally needed for a valuation of an IP asset using the market approach:
### Step 3: Valuing and reporting

This approach can be very useful for confirming the value of an IP asset arrived at using other valuation methods. However, on its own, this approach can lead to uncertain or misleading results as it may be difficult or even impossible to find sufficiently detailed publicly available information on assignments or licences of truly comparable IP assets.

You should consult with a valuation expert as to what method of valuation is most appropriate for the purpose of the IP valuation of your organisation. At times a valuer may apply multiple techniques when conducting the quantitative IP valuation.

The valuation report should be in a format that meets the needs of your organisation. In particular, the valuation report should at a minimum:

- identify and describe the IP which is the subject of the valuation
- describe the purpose and intended use of the valuation
- state the method of valuation adopted
- identify all assumptions and basis for the valuation approach, and
- list all limiting and contingent conditions that may affect the valuation.

In addition, the valuation report should ideally be certified by the valuer that:

- statements of facts in the report are true and correct
- any assumptions and limiting conditions are unbiased

<table>
<thead>
<tr>
<th>Area</th>
<th>Information on comparable IP asset</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Similarity of IP Assets</strong></td>
<td>Type of IP asset</td>
</tr>
<tr>
<td></td>
<td>Expected life of the IP asset</td>
</tr>
<tr>
<td></td>
<td>Strength of IP rights</td>
</tr>
<tr>
<td></td>
<td>Relevant industry</td>
</tr>
<tr>
<td></td>
<td>Geographical constraints affecting the commercialisation of the IP asset</td>
</tr>
<tr>
<td><strong>Similarity of transactions</strong></td>
<td>Nature of transaction (e.g. exclusive or non-exclusive licence or sale)</td>
</tr>
<tr>
<td></td>
<td>Nature of the parties, including whether they were dealing on arms’ length terms</td>
</tr>
<tr>
<td></td>
<td>Other information affecting the price, such as the parties’ relative bargaining power and market conditions</td>
</tr>
<tr>
<td><strong>Payments</strong></td>
<td>For assignments, the sale price</td>
</tr>
<tr>
<td></td>
<td>For licences, the licence fees, including upfront and ongoing licence fees and royalties</td>
</tr>
<tr>
<td></td>
<td>Minimum payments</td>
</tr>
</tbody>
</table>
the valuer has no interest in the valued IP, and
any fee payable to the valuer will not influence the results of the valuation.

Accounting Practices for IP

All IP assets owned by an organisation need to be accounted for in the organisation’s financial statements. The current Australian Accounting Standard for IP is ‘AASB 138 Intangibles’. This Standard prescribes the procedure for identifying, recognising, measuring and disclosing intangible assets for accounting purposes.

An organisation may choose to undertake a comprehensive audit of its IP portfolio to identify relevant intangible assets to be included in its financial statements.

For more information on how to conduct an IP audit, see the section entitled ‘IP Audits’ of this Chapter.

Definition of intangible assets and under AASB 138

An intangible asset is defined in AASB 138 as an ‘identifiable non-monetary asset without physical substance’.

Under AASB 138:

<table>
<thead>
<tr>
<th>Intangible assets include:</th>
<th>Intangible assets DO NOT include:</th>
</tr>
</thead>
<tbody>
<tr>
<td>Patents and designs</td>
<td>Internally generated brands</td>
</tr>
<tr>
<td>Trade marks</td>
<td>Internally generated mastheads</td>
</tr>
<tr>
<td>Copyright</td>
<td>Internally generated publishing titles</td>
</tr>
<tr>
<td>Licences</td>
<td>Customer lists</td>
</tr>
</tbody>
</table>

AASB 138 prescribes that computer software which is an integral part of related hardware is to be treated as property, plant and equipment and accounted for under AASB 116 ‘Property, Plan and Equipment’. All other software is to be treated as an intangible asset under AASB 138.

Expenditures on the acquisition, development and enhancement of intangible resources (e.g. new systems, processes, IP assets and market knowledge) will only be recognised as intangible assets where:

- the asset is separately identifiable
- future economic benefits will be derived from the asset
- the cost of the asset can be reliably determined, such as by reference to its purchase price and any directly attributable costs of preparing the asset for use
the asset is under the organisation’s control (either by contractual agreement or other legal rights), and
the asset is capable of being sold, transferred, licensed, rented or exchanged.

Financial statements
When including intangible assets in an organisation’s financial statements, the intangible assets must be separated into the following two categories and each given a fair valuation:

- assets with limited useful life are to be valued based on a cost and amortisation model, and
- assets with indefinite useful life are to be valued based on a cost annual impairment model.

Accounting advice should always be sought when preparing financial statements which include intangible assets.

For more information on the various IP valuation methods, see the section entitled ‘IP Valuation’ of this Chapter.

Dealing with IP Rights in Contracts
Senior managers are responsible for making decisions as to whether or not an organisation should enter into a particular contract with a third party. Where a contract will lead to the creation, use or grant of IP rights, it is essential that IP issues are adequately addressed.

IP ownership interests and rights to use IP may be structured in a number of different ways in a contract. It is important to understand the different types of IP ownership interests and rights of use and their implications in order to determine which position is the most favourable to the organisation in a particular situation.

The diagram below illustrates a range of IP ownership interests that may be adopted by the parties to a contract that has an IP component.

Different IP Ownership Positions in a Contract
Sole ownership

Sole ownership of IP occurs where all rights in the IP asset are owned by a single entity.

Sole ownership is the simplest form of interest. The transfer of the entire right and title to an IP asset to another party means the original owner of the IP will be unable to re-use or re-sell all or part of the IP. In general, an obligation for a contractor to provide for a total transfer of ownership to the organisation may add a substantial cost of the contract as the contractor will have no right to reuse that IP.

Transfer of ownership usually takes the form of an assignment. When a contract stipulates the complete, permanent transfer of IP rights and ownership to another party, sometimes a licence is granted back to the assignor from the assignee to the assignor to use the IP asset on the terms of a licence (referred to as a ‘licence back’). This allows the original owner to access the assigned IP for an agreed purpose in the licence granted back to the original owner.

For more information on IP assignment, see Chapter 7 ‘What Must Be Known About IP Commercialisation’.

Joint ownership

Joint ownership of IP is where two or more individuals or organisations together own the rights in an IP asset.

In a project where the creation of IP is anticipated as a result of a collaborative effort, the parties to a contract may agree that any IP generated will be jointly owned. Unless otherwise agreed, each joint owner will usually own an undivided equal share of the rights in the IP asset.

However, you should be aware that management of jointly owned IP may be complex. Importantly, unless otherwise agreed in a contract between the joint owners, the respective rights of the joint owners to the IP are governed by applicable IP legislation, depending on the type of IP. In the case where the joint owners are from different jurisdictions, another level of complexity will be introduced since the rights conferred on joint owners of IP may vary from country to country.

It is important that the details of any joint ownership arrangement are recorded in a written agreement which clearly sets out the parties’ rights and obligations regarding the protection, enforcement, use and commercialisation of the relevant IP asset.

Set out below is a summary of the rights of joint owners of different types of IP assets under Australian law which will apply unless otherwise agreed:
<table>
<thead>
<tr>
<th>Type of IP</th>
<th>Example Subject Matter</th>
<th>Rights of Joint Owners when Dealing with the Example Subject Matter</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Patent</strong></td>
<td>Computer hardware</td>
<td>Each joint owner may separately use all the exclusive rights granted by the patent to make and sell the hardware without accounting to the other joint owners. However, no joint owner can license or assign the patent for the computer hardware to third parties without the consent of all other joint owners.</td>
</tr>
<tr>
<td><strong>Copyright</strong></td>
<td>Software program</td>
<td>Each joint owner may only use the software program for its own benefit without accounting to the other owners. However, each joint owner requires all other joint owners’ consent to exercise copyright in the software (e.g. altering the software for distribution to third parties).</td>
</tr>
<tr>
<td><strong>Registered Design</strong></td>
<td>Electric kettle</td>
<td>Each joint owner may separately use all the exclusive rights granted by the design registration to make and sell the electric kettle. However, a joint owner cannot license or assign the registered design for the electric kettle to a third party without the consent of all other joint owners.</td>
</tr>
<tr>
<td><strong>Trade Mark</strong></td>
<td>Brand</td>
<td>Joint owners may not use the trade mark other than on behalf of all joint owners and in relation to goods/services with which all of them are connected in the course of trade. (Note that it is rare for a trade mark to be jointly owned by two or more organisations.)</td>
</tr>
<tr>
<td><strong>Circuit Layout</strong></td>
<td>Microchip</td>
<td>Each joint owner may only use the exclusive rights in the microchip with the consent of all other joint owners.</td>
</tr>
</tbody>
</table>

**Licence rights**

An IP licence is the right to use IP for a specified period of time in accordance with agreed conditions. An IP licence provides great flexibility as to the scope of rights granted to the licensee whilst allowing the licensor to retain ownership and the desired degree of control over the IP asset.

Depending on the needs of the parties to the licence, various licensing approaches may be used to accommodate those needs. For example, a licence may be exclusive, sole or non-exclusive.
In addition, IP rights granted in a licence may be limited by multiple parameters, (including territory, field of use, purpose, term and sublicensing rights), as illustrated by the following example.

Example: IP licence granted to three different entities by licensor

<table>
<thead>
<tr>
<th>Parameter</th>
<th>Company ABC</th>
<th>Company XYZ</th>
<th>Government Authority X</th>
</tr>
</thead>
<tbody>
<tr>
<td>Exclusivity</td>
<td>Exclusive in territory</td>
<td>Non-exclusive</td>
<td>Non-exclusive</td>
</tr>
<tr>
<td>Territory</td>
<td>Australia</td>
<td>US</td>
<td>US</td>
</tr>
<tr>
<td>Purpose</td>
<td>To commercialise the IP</td>
<td>Licensed IP only be used internally by Company XYZ</td>
<td>Licensed IP only be used internally by government authority X</td>
</tr>
<tr>
<td>Term</td>
<td>10 years</td>
<td>1 year</td>
<td>2 years</td>
</tr>
<tr>
<td>Sublicensing rights</td>
<td>Yes</td>
<td>No</td>
<td>No</td>
</tr>
</tbody>
</table>

For more information on IP licences, see Chapter 7 ‘What Must be known about IP Commercialisation’.

Sole and joint ownership and licence rights compared

The table below sets out some of the advantages and disadvantages of sole and joint ownership and licence rights from the perspective of an IP acquirer.
When acquiring IP from a third party, it is vital that appropriate IP due diligence be conducted. At a minimum, you should consider the issues listed in the section entitled ‘IP due diligence in capital raising’ in Chapter 3 ‘What the Board and CEO Must Know’ to confirm that the IP your organisation is acquiring is consistent with its understanding of what the IP rights entail.

Collaborations within industry and between industry and public sector institutions are frequently undertaken by many organisations. The pooling of resources and experience in collaborations can reduce the time it takes to bring a product to market, lower R&D expenditure, and spread or reduce the risks involved.

Research collaborations can range from a relatively short and simple research programme between two organisations to a series of complex, interdependent projects between a number of industry organisations and public sector research institutions.

<table>
<thead>
<tr>
<th>Type of right</th>
<th>Advantages</th>
<th>Disadvantages</th>
</tr>
</thead>
<tbody>
<tr>
<td>Sole ownership</td>
<td>• Gives complete control over the IP asset to the organisation</td>
<td>• May be difficult to negotiate where the IP asset is (at least partly) created by a third party.</td>
</tr>
<tr>
<td></td>
<td></td>
<td>• May increase the price of the contract.</td>
</tr>
<tr>
<td></td>
<td></td>
<td>• Shifts all risks associated with the IP asset to the organisation.</td>
</tr>
<tr>
<td>Joint ownership</td>
<td>• May be easier to negotiate than sole ownership.</td>
<td>• Is likely to require the consent of all owners for the use or commercialisation of the IP asset.</td>
</tr>
<tr>
<td></td>
<td>• Spreads the risks associated with the IP asset between the joint owners.</td>
<td>• May render the decision-making process for the protection, enforcement and exploitation of the IP asset complex, costly and inefficient.</td>
</tr>
<tr>
<td></td>
<td></td>
<td>• May lead to potential disputes between the joint owners.</td>
</tr>
<tr>
<td>Licence Rights</td>
<td>• Allows the organisation to obtain access to an IP asset without having to take on all the associated risks.</td>
<td>• Provides the lowest degree of control over the IP asset.</td>
</tr>
<tr>
<td></td>
<td>• Provides flexibility in how access to the IP asset may be structured.</td>
<td>• Does not provide access to the IP asset after termination of the licence.</td>
</tr>
<tr>
<td></td>
<td>• Is likely to be cheaper than obtaining ownership.</td>
<td>• Requires careful drafting to ensure the organisation is granted all necessary rights.</td>
</tr>
</tbody>
</table>
The three most common types of agreements governing research collaborations between industry and universities or other external R&D sources are:

- collaborative research agreements
- sponsored research agreements,
- consortium agreements.

In some cases, a collaborative effort between different parties is structured as a licensing arrangement or a joint venture.

For more information on licence agreements and joint ventures, see Chapter 9 ‘What Must Be Known About IP Commercialisation.’

**Collaborative research agreements**

Collaborative research agreements usually provide for the participation of two parties in a project in order to achieve specific common goals and develop defined deliverables. Both parties will contribute to the project by way of knowledge, experience, financial and in-kind resources and technologies.

The collaborative research agreement will set out each party’s rights and responsibilities in relation to the project. Importantly, the agreement will also deal with the ownership, management and rights to use any new IP created in the course of the project.

**Sponsored research agreements**

Sponsored research is research which is financially funded and directed by an organisation in order to achieve a specific objective of the organisation. The research is generally aimed at solving a particular problem or fulfilling a particular need identified by the organisation.

Research sponsorships are usually formalised in a written agreement specifying the organisation’s requirements. Sponsored research agreements will commonly have a detailed project plan setting out the goals and expected deliverables for each project attached.

**Consortium agreements**

Consortium agreements are commonly used where a number of organisations participate in and contribute their resources towards a set of shared research goals.

A written agreement for this type of collaborative project can be fairly complex as it will need to take into account all the requirements and objectives of each party.

The agreement will also need to deal with the ownership and management of any newly generated IP and the parties’ rights to access and exploit it. Typically, all consortium members will have a non-exclusive licence for internal use and commercial exploitation of all IP generated in the course of the project.
An agreement governing collaborative research between two or more parties will need to deal with various issues regarding the project and its outcomes, which may include the following:

### Checklist of Issues in Collaborative Research Agreements

Ensure that all confidential information exchanged between the parties (both prior to and during the project) is kept confidential under confidentiality obligations.

Specify the resources (both financial and in-kind) which each party is required to contribute to the project.

Specify who will be responsible for the overall management of the project. The parties may wish to establish a project committee for this purpose.

Set out the objectives of the project including measurable criteria for determining if and when those objectives are met.

Provide for a regular review of the performance of the project, including the opportunity for a party to opt out of the project if agreed milestones are not met.

Set up a register of all background and third party IP which is used in the course of the project.

Set out the rights of access to all background and third party IP.

Specify ownership of any project IP.

State which party is responsible for the protection and enforcement of project IP including associated costs.

Provide for a review of each researcher’s manuscripts, abstracts, proposed publications and presentations so that any patentable project IP may be protected prior to publication.

Set out the parties’ rights of access to project IP, including any appropriate conditions such as the sharing of revenue arising out of the commercialisation of project IP.

It is strongly recommended you seek legal advice when entering into any type of research collaboration.

### Government grants

The Federal government and State governments offer different types of grants to organisations to encourage the development of IP, subject to certain eligibility criteria.

For more information on the different government grant schemes offered by AusIndustry, the CRC and other programmes, see Chapter 3 ‘What the Board and CEO Must Know’.
What this Chapter Covers .......................................................... 169

Issues to Consider Before Undertaking IP Commercialisation 169

Is the IP ready for commercialisation? ........................................... 169

IP Commercialisation Structures ................................................. 171

Internal product development ................................................. 172
Licence ....................................................................................... 172
Direct licensing to end users .................................................. 173
End user licence agreements ................................................... 173
Software licences ...................................................................... 174
Using a distributor .................................................................... 175
Licensing commercialisation rights to third parties ................. 176
Assignment ............................................................................... 178
Assignments vs. licences ....................................................... 178
Spin-off companies ................................................................... 179
Using spin-off companies ....................................................... 180
Joint ventures ........................................................................... 180
Checklist for joint venture agreements ................................ 181

Choosing a Commercialisation Partner .................................... 182

Issues to consider ...................................................................... 182

Risks of IP Commercialisation ................................................. 183

Identifying risks ......................................................................... 183
Types of risks ............................................................................. 183
How to manage risks .................................................................. 185
Step 1: What is the likelihood of the risk event happening? .... 185
Step 2: What will be the consequences? ................................ 185
Risk management mechanisms .............................................. 186
IP insurance ................................................................................. 187
IP commercialisation is the exploitation of IP in the marketplace for the purpose of generating income. Successful commercialisation of IP may be one of an organisation’s goals for undertaking research, design and development. IP commercialisation is a complicated process and requires consideration of a wide range of factors.

This Chapter provides guidance when undertaking the IP commercialisation process, including:

- the issues to be considered prior to conducting commercialisation activities
- the fundamental characteristics of common commercialisation structures and approaches that may be adopted, and
- the risks involved in commercialisation and how to manage those risks.

The most common form of commercialising IP is where an organisation undertakes commercialisation of its internally developed IP. Although the issues to consider outlined in this Chapter are relevant to this form of commercialisation, many other elements of running a successful business will also obviously apply which are beyond the scope of this Manual. The parts of this Chapter following the section ‘Issues to consider before undertaking IP commercialisation’ focus primarily on forms of commercialisation external to the organisation as the reader is less likely to be familiar with commercialisation in these forms.

Successful commercialisation of IP is often one of the primary goals of an organisation’s IP strategy. However, not all IP created will be ready for commercialisation immediately, nor should all IP created be exploited for profit – it may be used internally on an operational basis, or licensed out to the public for free use or for design re-use. There are a range of issues that need to be considered before commercialising an IP asset. You may consider referring to your organisation’s IP strategy for direction on dealing with the IP asset generated. For more information on IP strategies, see Chapter 3 ‘What the Board and CEO Must Know’.

Outlined below are some questions that may assist you to assess whether certain IP is ready or suitable for commercialisation. You are likely to make better informed decisions on whether and when to commercialise a particular IP asset once you have considered these questions. Further, these IP specific issues may be relevant when preparing your business plan for the commercialisation of IP.
## Ownership of IP

Does the organisation own the IP and, if so, are there any joint owners?

Does the organisation have the necessary rights to commercialise the IP?

Are there any contracts relating to the IP restricting the organisation’s rights to commercialise?

## Nature of IP

Are the IP rights valid?

What is the strength of the IP?

What is the remaining IP life?

Has the IP got broad claim coverage?

Is the IP formally protected?

Will the IP asset require further development?

What is the estimated commercial life of the IP (as opposed to its legal life)?

## Stage of Development

Is the IP at a stage in its development where it is ready or suitable for commercialisation?

(Note that commercialising IP at its early stage of development may require more effort, be less certain of success, and generate smaller returns.)

## Response to Potential Infringement Actions

How willing and ready is the organisation to defend or prosecute IP infringement actions?

Who are your competitors and are they respectful of IP rights?

Who will be the likely infringers?
When preparing a business plan, there will be other general business issues that you may need to consider for the commercialisation of your IP. Detailed discussion of preparing a business plan is outside the scope of this Manual, although examples of some general business issues are given outlined below.

**Potential Market**

- Who are the prospective licensees, buyers and other customers?
- What is the size of the potential market?
- What is the likelihood of the IP successfully entering and staying in the market?
- Are there any competing/substitute products?
- What are the estimated financial returns?
- Will commercialisation contribute to the organisation’s competitive edge?

**Resources Required**

- Does the organisation have the appropriate skills as well as sufficient human and other resources to commercialise the IP?
- What is the financial budget for commercialising the IP?
- What is the method of commercialisation?

Choosing and establishing the most appropriate commercial structure is critical to the success of IP commercialisation.

The commercialisation structure to be adopted will depend on:
- the organisation’s goals and expectations
- the nature of the IP and any issues identified, and
- the availability of funds and resources to commercialise the IP.

There are number of different ways to bring newly developed IP to the market place. The five most common structures for the commercialisation of IP are illustrated in the diagram below.
A brief description of each type of commercial structure is outlined below.

It is strongly recommended that you seek professional legal advice and assistance when deciding on and establishing the desired IP commercialisation structure.

**Internal product development**

The primary manner in which most businesses will commercialise their IP assets is by their own development and supply of goods or services based on the IP, rather than by leveraging the IP by provision to some external party as is outlined in the following sections of this Chapter. However, whether IP should be commercialised internally, as against some form of external commercialisation, should always be something which is considered as part of the business planning process.

Although internal commercialisation obviously involves numerous other elements of operating a successful business, the development and supply of products still relies on careful and appropriate management of the underlying IP. As has been outlined in other parts of this Manual, identifying, protecting and managing IP embodied in the organisation’s products provides, among other things, a basis for the investment in new products, a defence against others’ business strategies and a competitive advantage in the market place.

The general business elements of design, development, marketing and distribution of new and updated products are beyond the scope of this Manual, however, appropriate IP management should be an integral part of each of these stages. Refer to the other Chapters of this Manual for guidance on managing IP within the organisation which have application to IP to be commercialised internally.

**Licence**

An IP licence grants another entity the right to access and use the IP for a certain time period where such access or use would otherwise infringe the rights of the IP owner. A licence is one of the most common forms of IP commercialisation as it is a
very flexible option allowing the expectations of both parties to be accommodated. Importantly, a licence does not permanently transfer ownership of IP or the rights attached to it.

A licence may be exclusive or non-exclusive, and may be restricted to a particular territory or a field. A licence may also be granted for a specific activity or a set of activities, such as researching, developing, modifying, manufacturing or selling products or services incorporating the IP.

A licensor (the party allowing the use) may require the licensee (the party taking the licence) to comply with certain performance obligations in a licence agreement. Failure to meet those performance obligations may result in the licence being terminated.

The diagram below illustrates some different forms of licensing that may be utilised by your organisation. These include:

- direct licensing of IP to an end-user (such as ‘selling’ software to customers using a ‘click wrap’ licence)
- granting rights to a distributor (who may already have an established position in a market) to distribute the products to end users, and
- licensing of IP to a commercialising party who will further develop and commercialise the IP.

**Direct licensing to end users**

When you are providing a product or a service which includes substantive IP subject matter (such as software or other copyright materials) to your customers directly, you should ensure that IP incorporated in that product or service is provided under legally binding terms and conditions with your customers. Where appropriate, you may contemplate using the following agreements:

- an end user licence agreement, or
- a software licence.

**End user licence agreements**

End user licence agreements (EULAs) are a type of licence granting to the licensee (the end user) a limited right to use certain IP solely for its own purposes. The licensee will not have the right to grant sublicences of the IP or to distribute products made
EULAs are commonly used in relation to software and are often in a standard form which an organisation can use to license the same IP asset on a non-exclusive basis to a number of different end users. EULAs generally prohibit the licensee from modifying the IP.

Software licences

When preparing software licences, you should at a minimum consider and address the issues in the following checklist. It is recommended that you seek legal advice when preparing software licences.

<table>
<thead>
<tr>
<th>Checklist for software licences</th>
</tr>
</thead>
<tbody>
<tr>
<td>Consider whether to include a prohibition on reproduction of the software, except as permitted under the Copyright Act 1968 (Cth).</td>
</tr>
<tr>
<td>Reproductions permitted by the Copyright Act (subject to certain restrictions) include reproductions for:</td>
</tr>
<tr>
<td>• back-up purposes</td>
</tr>
<tr>
<td>• error correction</td>
</tr>
<tr>
<td>• security testing, and</td>
</tr>
<tr>
<td>• the purposes of decompiling or reverse-engineering to achieve inter-operability</td>
</tr>
<tr>
<td>Ensure the permitted uses of the software are clearly defined.</td>
</tr>
<tr>
<td>Consider confining the use of the software to specific locations and/or equipment.</td>
</tr>
<tr>
<td>Consider restricting the use of the software to a limited number of users.</td>
</tr>
<tr>
<td>Consider offering upgrades and new versions of the software in return for a fee.</td>
</tr>
<tr>
<td>Exclude liability for malfunctions arising from any unauthorised use of the software, unauthorised modifications made to the software, or incompatibility with any other software or hardware.</td>
</tr>
</tbody>
</table>
**Escrow arrangements**

Where source code is not provided under a licence, licensees of custom made software solutions may request that the source code and other related materials be held ‘in escrow’ by an independent third party (an ‘escrow agent’). An escrow agent will be given a physical copy of the source code and other materials for safekeeping and will be under instructions only to release those to the licensee under certain circumstances. Such circumstances commonly include a failure by the licensor to fulfil its obligations to maintain and update the software, such as where the licensor becomes insolvent or ceases carrying on business.

An escrow arrangement enables the licensor to retain confidentiality of the source code and materials but at the same time gives the licensee comfort that it will be able to access the source code and materials when necessary.

**Using a distributor**

You may want to appoint a distributor to promote, distribute and sell products to end users on your behalf. Distribution arrangements usually involve the distributor purchasing finished products from the licensor and on-selling these to end users at a margin. This differs from an agency arrangement, where an agent promotes products and solicits orders but end users acquire the finished products directly from the licensor. Distributors may also be responsible for after-sales support and handling product warranty claims on behalf of the licensor.

If a distributor is to be granted exclusive rights in a particular territory or for sales in a certain manner (e.g. via the internet), you will need to consider whether this may contravene the Trade Practices Act 1974 (Cth). This Act also prohibits licensors from prescribing minimum prices at which distributors must re-sell products.

Distributors are generally granted a limited licence of IP rights in order for them to fulfil their obligations under the distribution agreement. Where the product is software, the licensor will generally require the product to be sold on the condition that end users enter into an EULA directly with the licensor.

Distribution agreements typically include the following features:

<table>
<thead>
<tr>
<th>Common features of distribution agreements</th>
</tr>
</thead>
<tbody>
<tr>
<td>Restrictions on the territory and the manner in which, or customers to which, products can be promoted and sold, usually in return for exclusive rights in defined areas.</td>
</tr>
<tr>
<td>Conduct of promotional activities by the distributor, including minimum obligations, conditions on which the licensor’s trade marks may be used and provision of training or other assistance by the licensor.</td>
</tr>
<tr>
<td>Acquisition of products from the licensor or its approved manufacturers, with a mechanism for future price increases.</td>
</tr>
<tr>
<td>Provisions regarding the purchase of products, including forecasts, orders, freight, insurance, risk, title and payment terms.</td>
</tr>
</tbody>
</table>
**Common features of distribution agreements**

Distributor primarily responsible for customer service, warranty claims and the conduct of recalls.

Minimum performance requirements in order to maintain distribution rights.

Non-compete obligations during the term of the distribution arrangement and for a limited period afterwards.

Termination and its consequences e.g. an obligation on the licensor to repurchase the distributor’s unsold stock or the ability for it to do so.

When negotiating a licence, it is essential that you understand and are aware of the nature and extent of the rights you are negotiating.

A licence agreement typically includes terms dealing with the following issues:

<table>
<thead>
<tr>
<th>Issue</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>Parties</td>
<td>Include details of each party, including name, ABN/ACN, and address of registered office or principal place of business, as well as details of the appropriate contact person for each party.</td>
</tr>
<tr>
<td>Licensed Rights</td>
<td>Describe the subject matter of the licence, e.g. the IP asset, including any patent and trade mark registration particulars and detailed descriptions of any unregistered IP.</td>
</tr>
</tbody>
</table>
| Type of Licence  | State whether the licence is exclusive, sole or non-exclusive:  
|                  | • Exclusive licence: The licensee is the only person who has the right to deal with the licensed IP, even to the exclusion of the licensor.  
|                  | • Sole licence: The licensee is the only person who has the right to deal with the licensed IP in addition to the licensor.  
|                  | • Non-exclusive licence: The licensor may also grant licences to third parties. |
| Licensed Territory| State the country or region in which the licensee may use the licensed IP. |
| Field            | Nominate the field in which the licensee may use the licensed IP. This can be limited by technology field, market segment or distribution channel. |
| Term             | Consider the period for which the licensee may use the licensed IP. This may be the life of the IP asset or any other specified period of time, provided this is no longer than the life of the IP asset in the case of registered rights. |
### Issue | Explanation
--- | ---
Sublicence | Consider whether the licensee will have rights to grant sublicences to other people and on what terms.
Improvements | Consider whether improvements to the licensed IP are to be included in the licensed IP and which party will own them.
Royalties and Licence Fees | Describe the calculation and payment of financial consideration for the use of the licensed IP.
Termination | Consider when your organisation and the licensee may terminate the licence. Describe any post-termination obligations. These will usually include the licensee ceasing the exploitation of the licensed IP and returning any materials and confidential information provided by the licensor.
Obligations of Licensor | These may include:
• provision of technical assistance or know-how, and
• responsibility for prosecution and maintenance of formal intellectual property rights for the licensed IP (this will generally be the case if the licence is non-exclusive).
Obligations of Licensee | These may include:
• payment of royalties and licence fees
• manufacture of products using the licensed IP to certain quality standards
• efforts to promote and sell products made according to the licensed IP
• accounting and reporting, and
• preservation of confidentiality of licensed know-how.
Product Liability | Consider product liability issues, for example, who will bear responsibility for product liability claims by end users. Note that the licensee will usually be required to maintain a product liability insurance policy to a specified value.
Governing Law and Jurisdiction | State the governing law of the agreement and jurisdiction. This is usually where the principal office of the licensor or licensee is located.

You should be aware that certain contractual provisions may be unenforceable if they contravene the Trade Practices Act 1974 (Cth) or the Patents Act 1990 (Cth).
An IP assignment is the permanent transfer of the ownership of the IP asset to another entity. IP is usually assigned in return for financial consideration in the form of a lump sum payment. However, it is possible to assign an IP asset in return for royalties, or a combination of a lump sum payment and royalties.

**Financial consideration for the assignment may cover:**

- All direct costs of research and development incurred by the organisation up to the date of the assignment, including all out of pocket expenses such as costs of materials and equipment.
- All indirect costs of research and development such as salaries and rental of laboratory space.
- Any outsourcing costs.
- The costs of protecting and maintaining the IP.
- Any other costs that contributed to the costs of developing the IP to its current state.
- A profit component.

You should be aware that a lump sum payment may be treated differently to royalty payments for tax purposes. You should therefore obtain advice from a tax specialist before deciding on how to structure the financial aspects of an assignment.

It is important to understand that once an IP asset is assigned, the original owner of the IP asset no longer has the right to use the IP asset (unless the assignment includes a licence back clause). Ownership of the IP asset will not usually automatically revert back to the original owner at any time in the future.

Under most IP legislation in Australia, assignments of IP must be in writing. Written assignments of registered IP rights generally need to be recorded with the relevant authority.

**Assignments vs. licences**

The table below summarises some of the characteristics and potential advantages and disadvantages of assignments and licences of IP.
### Assignments vs. Licences

<table>
<thead>
<tr>
<th>Assignments</th>
<th>Licences</th>
</tr>
</thead>
<tbody>
<tr>
<td>All responsibility and risks are transferred to the assignee. However, the assignor will no longer have any control over the development and commercialisation of the IP asset.</td>
<td>Licensor usually retains a certain degree of control regarding the development and commercialisation of the IP asset. However, the licensor may be exposed to certain risks in relation to these activities (depending on the terms of the licence).</td>
</tr>
<tr>
<td>The assignor only has to deal with a one-off transaction. However, IP rights may be lost if the assignee decides to abandon the project.</td>
<td>Licensor will need to monitor the commercialisation activities of the licensee. However, there is greater control over the IP asset.</td>
</tr>
<tr>
<td>The assignor is likely to receive a larger upfront payment. However, it may be difficult to value the IP asset to establish an appropriate sale price (especially where the IP is in an early stage of development).</td>
<td>Usually, the upfront payment amount is less. However, the subsequent financial return may be greater if the IP turns out to be valuable.</td>
</tr>
<tr>
<td>There will be no opportunity to share additional profits if the IP generates more revenue than expected, unless revenue-based royalties are payable.</td>
<td>There is a risk of only minimum return if commercialisation is not successful.</td>
</tr>
</tbody>
</table>

### Spin-off companies

A spin-off company is a separate company established by an organisation for the purposes of undertaking a particular activity, such as the commercialisation of a specific IP asset. A spin-off company usually starts out as a wholly-owned subsidiary of the organisation, although this is likely to change over time if external investment is sought. Once the spin-off company has been established, the organisation will licence or assign the relevant IP asset to the spin-off company to enable it to commercialise the IP.

Undertaking commercialisation activities via a spin-off company will transfer the responsibilities and risks associated with the commercialisation out of the organisation and into the spin-off company. The organisation may also attract new sources of funding for further development of the IP asset by offering to issue shares to potential investors in the spin-off company.

A spin-off company is a separate legal entity distinct from the organisation, and as such it will have to comply separately with the various requirements of the Corporations Act 2001 (Cth).
Establishing a spin-off company is probably the most complex and expensive form of IP commercialisation. However, the transfer of the responsibility and risks out of the organisation, the focus achieved by formation of a separate business with dedicated management, the potential to raise funds, as well as a potentially larger long term return may justify the effort and time, in particular where the IP requires extensive additional development.

Before establishing a spin-off company, you should at a minimum consider the following:

<table>
<thead>
<tr>
<th>Issues</th>
</tr>
</thead>
<tbody>
<tr>
<td>Is the IP ‘essential’ to the primary organisation?</td>
</tr>
<tr>
<td>Is the spin-off company approach consistent with the organisation’s objectives and goals?</td>
</tr>
<tr>
<td>What are the objectives of the spin-off company?</td>
</tr>
<tr>
<td>What are the measures of success for the spin-off company?</td>
</tr>
<tr>
<td>What are the expected financial returns?</td>
</tr>
<tr>
<td>What are the tax implications for the organisation and the spin-off company?</td>
</tr>
<tr>
<td>Is there a business plan for the planned activities of the spin-off company?</td>
</tr>
<tr>
<td>Will there be competition or a potential conflict of interest between the organisation and the spin-off company?</td>
</tr>
<tr>
<td>How much control will the organisation have over the management and decision making of the spin-off company?</td>
</tr>
<tr>
<td>Has the organisation consulted the views of other stakeholders?</td>
</tr>
<tr>
<td>What are the exit options for the future?</td>
</tr>
</tbody>
</table>

A joint venture is a collaboration of two or more parties to undertake a common project or to pursue a specific objective, such as commercialising IP. All parties to the joint venture will contribute their efforts, personnel, financial resources and/or existing IP towards the joint venture project.

A joint venture can be set up simply by the parties entering into a contractual arrangement setting out their rights and obligations in relation to the project (‘unincorporated joint venture’). Alternatively, the parties may decide to set up a separate, jointly-owned company to carry out the planned activities (‘incorporated joint venture’).

It is important that for any joint venture, the rights, responsibilities and contributions of the parties as well as the ownership of IP created in the course of the joint venture activities are clearly defined and documented. Usually, in the case of an unincorporated joint venture, the new IP will be owned jointly by all parties, with rights
to the benefits of such IP shared in accordance with their contributions to the project. In the case of an incorporated joint venture, the new IP will usually be owned by the joint venture company.

**Checklist for joint venture agreements**

The nature, size and complexity of the project will determine the level of detail contained in the joint venture agreement, but the following issues should generally be considered. As joint venture arrangements can be very complex, it is recommended that you seek the advice of your legal adviser in relation to the preparation of a joint venture agreement.

<table>
<thead>
<tr>
<th>Issue</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Parties</strong></td>
<td>• Who are the parties to the joint venture?</td>
</tr>
<tr>
<td></td>
<td>• Can new parties join the project in the future? If so, how?</td>
</tr>
<tr>
<td></td>
<td>• How can existing parties to the joint venture leave the project?</td>
</tr>
<tr>
<td></td>
<td>• What happens to the joint venture if a party becomes insolvent?</td>
</tr>
<tr>
<td><strong>Nature of Joint Venture</strong></td>
<td>• Under which name will the joint venture do business?</td>
</tr>
<tr>
<td></td>
<td>• What is the objective of the joint venture?</td>
</tr>
<tr>
<td></td>
<td>• Does the agreement clearly specify that the relationship of the parties is a joint venture, not a partnership?</td>
</tr>
<tr>
<td><strong>Financials</strong></td>
<td>• Specify each party’s financial contribution. Consider setting up a fund to finance the joint venture activities.</td>
</tr>
<tr>
<td></td>
<td>• Will financial contributions be dependent on certain milestones being achieved?</td>
</tr>
<tr>
<td></td>
<td>• Is there an obligation on all parties to provide additional funding for the project?</td>
</tr>
<tr>
<td></td>
<td>• How are profits and losses shared among the parties?</td>
</tr>
<tr>
<td></td>
<td>• What is the financial reporting procedure?</td>
</tr>
<tr>
<td><strong>Management</strong></td>
<td>• What are the management responsibilities of each party? Consider establishing a management committee and nominating a project director.</td>
</tr>
<tr>
<td></td>
<td>• When, where and how often should meetings be held?</td>
</tr>
<tr>
<td></td>
<td>• What is the mechanism to resolve disputes and deadlocks?</td>
</tr>
</tbody>
</table>
Choosing the right partner for the commercialisation of an IP asset is just as critical as choosing the right commercialisation structure. In order for the commercialisation to be successful, it is essential that the commercialisation partner shares the same goals as your organisation.

### Issues to consider

Issues which an organisation should consider when deciding to partner with a particular entity include:

<table>
<thead>
<tr>
<th>Issue</th>
<th>Explanation</th>
</tr>
</thead>
</table>
| **Activities** | • Have the joint venture activities been clearly defined in a project plan?  
• Who decides on changes to the project plan?  
• Is any special equipment required? Who is providing it and who will own it?  
• Will licences of any third party rights be taken in the name of the joint venture or each party?  
• What kind of insurance will the joint venture need to obtain? |
| **IP** | • What background IP is made available by the parties?  
• Who will own any new IP created in the course of the project?  
• Who is responsible for obtaining formal protection for new IP?  
• Do all parties have the right to use new IP? If so, for what purposes?  
• If the parties have the right to use new IP, do they also have the right to use each other’s background IP for that purpose? |
| **Term and Termination** | • For how long will the joint venture operate?  
• What are the provisions dealing with termination of the agreement?  
• How will guarantees, defects and insurance be handled after termination? |
| **General** | • Are there any obligations on the parties to sign all necessary documents relating to the joint venture, such as bank loans, bonds, indemnity agreements, etc?  
• Will a chartered accountant and a lawyer be appointed? |
Issues

The resources (both financial and other) the entity is prepared to commit to the commercialisation project

The level of expertise the entity has in the relevant technology

The level of expertise the entity has generally in commercialising IP

The entity’s reputation and influence in the marketplace

The entity’s access to relevant networks

The equity position sought by the entity if the commercialisation is to be via a spin-off company or incorporated joint venture

Before entering into an agreement with a potential commercialisation partner, it is essential that the organisation carry out comprehensive due diligence on the relevant entity to investigate (and confirm) that the entity:

- has the necessary resources and expertise to undertake commercialisation activities, and
- is capable of meeting relevant performance requirements.

A comprehensive due diligence process should include a detailed assessment of the entity’s financial stability, legal risks, technical experience and infrastructure, as well as any existing contractual relationships with third parties.

An organisation should seek the advice and assistance of a legal professional when conducting due diligence on any prospective commercialisation partner.

Risks of IP Commercialisation

Identifying risks

Commercialising IP will invariably involve risks. The nature of the risks will differ depending on the organisation, the nature of the IP, the chosen commercialisation pathway, and what the organisation wants to achieve. Such risks need to be identified, assessed and appropriately managed so that the organisation is only exposed to an acceptable level of risks throughout the commercialisation process.

To identify potential risks, an organisation will need to conduct appropriate internal due diligence, which is essentially an exercise to gather information concerning the risks and liabilities associated with the commercialisation of a particular IP asset and assessment of the identified risks and liabilities.

Types of risks

The IP specific risks involved in the commercialisation of IP include:
Nature of IP

Does the organisation own the IP?

Does the organisation have the rights to commercialise the IP?

What is the strength of the IP protection?

Is the organisation managing IP properly?

Is the use of the IP likely to infringe any third party rights?

Confidentiality

Can the confidentiality of the IP be maintained?

For more information on the protection of confidential information, see Chapter 5 ‘What Managers Making IP Protection Decisions Must Know’.

Other general commercial risks in the commercialisation of IP include:

Nature of the Product

Is the product likely to deliver what it promises?

What is the potential liability for using the product?

If access to upgrades is to be provided, can the organisation deliver on this promise?

Business and Financial

What are the financial risks of the commercialisation project?

What are the chances of failing to recover the costs associated with commercialisation?

Will the organisation be appropriately rewarded by the commercialisation process? Are the market returns or the licence fees and royalty rates appropriate?

Legal

Do the planned commercialisation activities comply with all applicable laws, regulations, policies and contractual obligations or restrictions?

Do the marketing strategies comply with the Trade Practices Act, State Fair Trading Acts and/or other consumer protection laws?
How to manage risks

Once identified, the organisation may assess the risks using the method below:

**Step 1:**
What is the likelihood of the risk event happening?

The organisation will need to collect information to ascertain whether the risk event is likely to occur. In most cases, the organisation will already have some form of information to assess the likelihood of the risk happening. For example, information concerning whether a particular IP asset is the subject of an ownership dispute, or whether the product is likely to deliver what it promises. In the example risk assessment table below, the likelihood of each risk event is ranked on a numerical scale from 1 (very unlikely) to 5 (very likely).

**Step 2:**
What will be the consequences?

The organisation will need to consider the likely severity of the impact of each risk event on the organisation. In the simple example below of two identified risk events for the Project XYZ, the severity of the consequences is ranked on a scale from minor to moderate to significant.

<table>
<thead>
<tr>
<th>Risk Event</th>
<th>Likelihood of risk event happening</th>
<th>Severity of consequences</th>
<th>Recommended action</th>
</tr>
</thead>
<tbody>
<tr>
<td>Infringement of third party rights</td>
<td></td>
<td></td>
<td>Take out insurance to cover the risk and consequences of litigation.</td>
</tr>
<tr>
<td>Ownership dispute (creator of the IP is a disgruntled employee who was let go by the organisation)</td>
<td></td>
<td></td>
<td>Check employment agreement and seek advice from legal adviser regarding IP ownership.</td>
</tr>
</tbody>
</table>
Based on the results of Step 1 and Step 2, the organisation will be able to assess the risks involved in commercialising a particular IP asset and make an informed decision on which form of risk management mechanism to implement. The section below outlines a range of risk management mechanisms that could be used by your organisation.

Once the various risks have been assessed, the organisation needs to decide on the most appropriate risk management mechanism to adopt. There are a number of ways to manage the potential risks that may arise in commercialising IP, and the most appropriate risk management mechanisms will depend on the nature of the IP and the type of risk.

The risk management mechanisms that an organisation may implement to minimise risks include the following:

<table>
<thead>
<tr>
<th>Type of risk</th>
<th>Checklist of Risk Management Mechanisms</th>
</tr>
</thead>
<tbody>
<tr>
<td>Nature of IP</td>
<td>Keep proper IP records</td>
</tr>
<tr>
<td></td>
<td>Conduct appropriate IP due diligence</td>
</tr>
<tr>
<td></td>
<td>Ensure that the organisation owns the IP or has the necessary rights to commercialise the IP</td>
</tr>
<tr>
<td></td>
<td>Carry out validity and infringement searches</td>
</tr>
<tr>
<td></td>
<td>Take out IP insurance</td>
</tr>
<tr>
<td>Nature of Product</td>
<td>Avoid or minimise liability for ongoing maintenance, support or upgrade of the IP</td>
</tr>
<tr>
<td></td>
<td>Take out or require the relevant commercialisation partner to take out product liability insurance and other suitable insurance, (for more information on obtaining insurance, see the section 'IP Insurance' below)</td>
</tr>
<tr>
<td>Business and Financial</td>
<td>Limit the risk by capping liability in agreements</td>
</tr>
<tr>
<td></td>
<td>Include appropriate termination rights and post-termination requirements</td>
</tr>
<tr>
<td></td>
<td>Monitor commercialisation activities according to business plans and agreements</td>
</tr>
<tr>
<td>Legal</td>
<td>Obtain expert advice where necessary</td>
</tr>
<tr>
<td></td>
<td>Ensure agreements are reviewed by legal advisor</td>
</tr>
<tr>
<td>Resources</td>
<td>Ensure there are adequate resources and systems for the ongoing management of the commercialisation activities</td>
</tr>
<tr>
<td></td>
<td>Allocate sufficient resources to manage the business relationship with any commercialisation partner</td>
</tr>
<tr>
<td>Reputation</td>
<td>Retain control over further product development to protect the organisation’s reputation</td>
</tr>
</tbody>
</table>
The three most common types of insurance an organisation may take out to help transfer the risks involved in IP commercialisation are as follows:

<table>
<thead>
<tr>
<th>Type of Insurance</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>Offensive Insurance</td>
<td>This type of insurance provides funding where an organisation enforces its IP by taking action against a third party infringer.</td>
</tr>
<tr>
<td>Defensive Insurance</td>
<td>This type of insurance covers the costs of proceedings brought against an organisation for infringement of IP owned by a third party.</td>
</tr>
<tr>
<td>Product Liability Insurance</td>
<td>This provides cover for an organisation’s liability where a person has suffered damage as a result of a product manufactured, repaired, altered or imported by the organisation.</td>
</tr>
</tbody>
</table>

For more information on offensive and defensive IP insurance, see Chapter 8: ‘What Must be Known about Enforcing and Defending your IP Rights’.
What this Chapter covers .......................................................... 191

Issues to Consider Before Enforcing IP Rights .................. 191

Value of the IP ........................................................................ 191
Nature of IP ........................................................................... 192
Costs ...................................................................................... 192
Risks ...................................................................................... 193

Enforcing your IP rights .......................................................... 195

Letter of demand ...................................................................... 195
Breach of contract ..................................................................... 196
Customs notice ........................................................................ 196
Litigation .................................................................................. 197
Alternative Dispute Resolutions .............................................. 197
Mediation ................................................................................ 197
Arbitration ............................................................................... 198
IP enforcement overseas ......................................................... 198

Defence and Cross-Claims to IP Infringement Actions ........ 199

Revocation ............................................................................... 199
Defences .................................................................................. 200
Estoppel .................................................................................. 200
Acquiescence ......................................................................... 200
Laches ..................................................................................... 200

Remedies ................................................................................ 200

Insuring your IP Rights ............................................................ 201

Obtaining IP insurance ........................................................... 201
Offensive IP insurance ............................................................ 202
Defensive IP insurance ............................................................ 202
Exclusions in insurance policies ............................................. 203
Choosing your IP insurance ...................................................... 203
What this Chapter covers

The ability to enforce and defend your organisation’s IP against unauthorised users is an integral part of an effective IP strategy.

Enforcing IP rights is a major undertaking, and you should always consider the issues outlined in this Chapter and seek advice from legal advisers before making any decision regarding the enforcement of your organisation’s IP rights.

This Chapter provides guidance on:
• issues to consider before enforcing IP rights
• different avenues to enforce your organisation’s IP rights
• defending IP rights in revocation proceedings, and
• obtaining IP insurance.

Issues to Consider Before Enforcing IP Rights

When you believe that others are using or exploiting your organisation’s IP without permission, you should consider taking steps to enforce your organisation’s IP rights; however, there is no obligation to do so. You should always consult with senior managers of your organisation and your legal advisers whenever there is any suspected infringement.

It is up to you to monitor third party activities actively for any infringement of your organisation’s IP rights and to take steps to enforce and/or defend those rights. An action for infringement of IP is a private legal action, not a State action. For information on what constitutes IP infringement, see Chapter 2 ‘What Everyone Should Know’.

There are a number of issues which require careful consideration before deciding whether you should take measures to enforce your organisation’s IP rights and what those measures might be. These are summarised in the following diagram.

<table>
<thead>
<tr>
<th>ISSUES TO CONSIDER BEFORE ENFORCING YOUR ORGANISATION’S IP RIGHTS</th>
</tr>
</thead>
<tbody>
<tr>
<td>Value of the IP</td>
</tr>
<tr>
<td>Nature</td>
</tr>
<tr>
<td>Financial and other costs</td>
</tr>
<tr>
<td>Risks</td>
</tr>
</tbody>
</table>

Value of the IP

Before you take any steps to enforce your organisation’s IP, you should always assess the impact of the alleged infringement on your organisation. Enforcement of IP rights may be required to:
• retain your organisation’s competitive edge conferred by the relevant IP
• protect the value of the relevant IP
• protect your organisation’s reputation against damage that may be caused by an infringer placing infringing products of inferior quality on the market
• deter other potential infringers
• comply with a contractual obligation (e.g. where your organisation is an exclusive licensee and is required to institute enforcement proceedings against any infringers), or
• raise the profile of your organisation by positioning it as a technology innovator.

Nature of IP
The nature of IP that is being infringed is also an important factor to consider when deciding what action to take. You will need to take into account the following:

- the strength of the relevant IP (including in the case of a patent, its validity and claim coverage)
- the remaining life of the IP, and
- the product cycle of the technology protected by the IP.

Costs
The financial costs of enforcing IP rights are significant as litigation can be lengthy, complex, and require considerable sums of money - a large proportion of which may not be recovered, even if your action is successful. The lack of financial resources is generally the main obstacle for IP owners when enforcing their IP rights. Set out below is an overview of the financial costs involved in bringing IP enforcement proceedings.

<table>
<thead>
<tr>
<th>Costs involved in IP enforcement</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Costs of legal proceedings</strong></td>
</tr>
<tr>
<td></td>
</tr>
<tr>
<td><strong>Costs of gathering specialist evidence</strong></td>
</tr>
<tr>
<td></td>
</tr>
<tr>
<td></td>
</tr>
</tbody>
</table>
Costs involved in IP enforcement

| Costs of proving the validity and ownership of IP rights | In most IP infringement proceedings, infringers will make a cross-claim challenging the validity of the IP. Proving the validity of your IP involves the identification of creators and the establishment of ownership rights. This can add significant costs to the litigation. |

The Australian Law Reform Commission (ALRC) conducted research on litigation costs for IP matters in the Federal Court of Australia in 1999:

<table>
<thead>
<tr>
<th>Party</th>
<th>Professional Fees</th>
<th>Disbursement Costs</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Average</td>
<td>Range</td>
</tr>
<tr>
<td>Applicant (the party who brought the legal action)</td>
<td>$76,900</td>
<td>$8,000 - $400,000</td>
</tr>
<tr>
<td>Respondent (the party who is responding to the legal action)</td>
<td>$36,100</td>
<td>$2,100 - $280,000</td>
</tr>
</tbody>
</table>

The present day litigation costs are likely to be considerably higher.

Apart from significant financial costs, IP enforcement proceedings will also take up considerable time and resources of your organisation and cause substantial stress to your employees. It is therefore crucial to allocate sufficient resources and budget accordingly when pursuing IP enforcement proceedings. This factor is almost always underestimated and it is not possible to claim compensation from the infringer for such costs, even if your action is successful.

Risks

Any decision to pursue IP enforcement proceedings should be preceded by a risk assessment. As with any legal dispute, a number of risks may arise when bringing IP enforcement proceedings. These include:

- potential financial liability
- inability for the organisation to continue to use the relevant IP
- adverse effect on the organisation’s reputation, and
• risks that the enforcement action be classified as an unjustified (and therefore unlawful) threat.

<table>
<thead>
<tr>
<th>Risks</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>Financial Liability</td>
<td>As with all forms of litigation, success is not guaranteed. The unsuccessful party to legal proceedings is usually ordered by the court to pay the other party’s legal costs, in addition to its own costs.</td>
</tr>
<tr>
<td></td>
<td><strong>Solicitor-client costs</strong></td>
</tr>
<tr>
<td></td>
<td>Solicitor-client costs are costs paid to a solicitor for work done on the instructions of a client. You will be liable to pay these costs to your solicitor, even where there is a possibility of recovering those costs from the other party of the legal action.</td>
</tr>
<tr>
<td></td>
<td>It is compulsory for solicitors to provide a costs agreement to you for any legal work carried out on your behalf.</td>
</tr>
<tr>
<td></td>
<td>Other information the solicitor may provide in terms of costs are barrister’s fees, costs of carrying out searches, expert reports and other work that may be incurred depending on the nature of the legal action. You should be informed of any significant increase in the estimated costs.</td>
</tr>
<tr>
<td></td>
<td><strong>Party-party costs</strong></td>
</tr>
<tr>
<td></td>
<td>Party-party costs are cost orders generally made by the court ordering a party to pay the costs of the legal proceedings to the other party.</td>
</tr>
<tr>
<td></td>
<td>Party-party costs are intended to reimburse one party, usually the successful party, for the legal costs incurred as a result of the legal proceedings, provided these costs have been determined as fair and reasonable. The amount of party-party costs is usually significantly lower than the amount of solicitor-client costs actually incurred.</td>
</tr>
<tr>
<td>Continued Use of IP</td>
<td>In all IP enforcement proceedings, it is common for an infringer to submit cross-claims. This may be on the basis that you do not own the IP or that the IP is invalid. If the cross-claims are successful, not only will your infringement claim fail, but you also risk losing your rights in the IP.</td>
</tr>
<tr>
<td></td>
<td>For more information, see the section entitled ‘Defences and Cross-Claims to IP Infringement Actions’ of this Chapter.</td>
</tr>
</tbody>
</table>
An unfavourable outcome of a court action may affect your organisation’s image and reputation in the eyes of consumers and investors.

In an extreme situation, an unsuccessful action may effectively cause a loss of the market share once held by the organisation for the relevant product and even to a reduction of the market share of other products of the organisation. It may take significant time and effort to regain consumer and investor trust and loyalty.

Where there are no legitimate grounds to commence enforcement proceedings, a threat to bring an action may be found to be unjustified. In this case, the threatened party can commence its own legal proceedings against you, and if successful, your organisation may be liable to pay damages to the other party for loss resulting from the unjustified threat. It is therefore crucial to obtain expert advice regarding the basis of the claim and to ensure the claim is able to be supported by sufficient evidence.

<table>
<thead>
<tr>
<th>Risks</th>
<th>Explanation</th>
</tr>
</thead>
<tbody>
<tr>
<td>Reputation</td>
<td>An unfavourable outcome of a court action may affect your organisation’s image and reputation in the eyes of consumers and investors.</td>
</tr>
<tr>
<td>Unjustified Threats</td>
<td>Where there are no legitimate grounds to commence enforcement proceedings, a threat to bring an action may be found to be unjustified. In this case, the threatened party can commence its own legal proceedings against you, and if successful, your organisation may be liable to pay damages to the other party for loss resulting from the unjustified threat. It is therefore crucial to obtain expert advice regarding the basis of the claim and to ensure the claim is able to be supported by sufficient evidence.</td>
</tr>
</tbody>
</table>

There are a number of ways to enforce your organisation’s IP rights which range from relatively simple measures, such as sending a letter of demand, to complex litigation.

Before taking any action to enforce your organisation’s IP rights, it is imperative you seek legal advice and assistance from a lawyer or patent attorney.

A letter of demand is a letter sent to a person whom you believe is infringing your IP rights. The letter will advise the person of the specific rights it is believed to be infringing and that court action may be taken if the infringing activities do not stop within a certain period of time.

In some situations, issuing a letter of demand may be sufficient to put an immediate stop to infringing activities.

A letter of demand advises the alleged infringer of your rights and warns them of your intention to commence legal proceedings unless the infringing activities are stopped.

When sending a letter of demand:
It is important to consult with your legal advisers before sending any letter of demand, as threatening someone with infringement proceedings may incur legal liability if not done correctly.

### Breach of contract

Where there is a contract setting out the terms and conditions governing the use of the IP, and those terms and conditions are not observed, this may constitute a breach of contract for which the non-breaching party may be able to claim damages or another type of remedy. For more information on available remedies, see the section entitled ‘Remedies’ of this Chapter.

The terms of the contract may set out the preferred avenue to resolve a dispute, and this may involve using non-litigious measures, (such as an informal conference by senior managers, mediation or arbitration), before pursuing an action in court. For more information on non-litigious methods for resolving disputes, see the section entitled ‘Alternative Dispute Resolution’ of this Chapter.

### Customs notice

A customs notice (or ‘Notice of Objection’) may be lodged with Australian Customs to protect an organisation’s trade marks and copyright from counterfeit, pirated or unauthorised importation of goods. Once this notice is lodged with Australian Customs, Customs has the power to seize infringing goods that are imported into Australia.

**To lodge a customs notice, you will need to supply:**

| Details of IP owner or authorised user |
| Details of the trade marks or copyright |
| A written undertaking to the Australian Customs Service to cover any costs the Australian Customs Service may incur as a result of seizing infringing goods. |

Any goods seized by Customs are held for 10 working days. During this period, the organisation may either commence legal action or consent to the release of the goods. The importer may also voluntarily forfeit the goods, provided no civil action has yet commenced.
A customs notice is valid for two years. After this period it may be re-lodged for ongoing protection. It may also be withdrawn at any time when it is no longer required.

**Litigation**

Court proceedings for IP infringement may be instituted in the Federal Court of Australia, and in some cases also in the Federal Magistrate Courts and State Supreme Courts. IP infringement litigation is usually complex and legal representation is required.

**Issues to keep in mind when enforcing your organisation’s IP rights:**

**Keep records of correspondences and action taken**

A record should be kept of all correspondence sent and received (including letters, e-mails and faxes and notes of any telephone conversations), and all enforcement measures taken concerning the alleged infringement, especially those at an initial stage.

**Avoid delays in enforcement**

Do not wait long to take enforcement action against any suspected infringers as any delay in enforcing your IP may jeopardise your legal rights.

**Be prepared to pursue IP enforcement**

Once you have commenced action enforcing your IP rights, you should be prepared to pursue that enforcement so the alleged infringer knows that you are serious about protecting your IP. You will need to allocate sufficient time and resources for the enforcement proceedings.

**Alternative Dispute Resolutions**

Alternative dispute resolution (ADR) refers to non-litigious methods to resolve disputes. ADR may involve an informal settlement conference attended by the parties and their legal representatives, or a more formal process such as mediation or arbitration where a neutral independent third party is involved.

Parties may agree in advance to resolve any disputes by ADR before commencing any court action (for example when entering into a contract), or a court may order the parties to pursue a specific form of ADR.

**Mediation**

Mediation involves a neutral third party (the ‘mediator’) assisting in the negotiation of a settlement. The mediator will only act as a facilitator to assist the parties to reach settlement and has no formal power to force the parties to settle.
Arbitration involves a neutral third party (the ‘arbiter’) acting as a private judge in a closed and private court context where each party has the opportunity to present its evidence and testimony. The parties will need to agree in advance to be bound by the arbiter’s decision.

Key features of arbitration are:
- evidence and testimony are heard from both parties
- a decision by the arbiter is made based upon the points of law and the evidence heard, and
- the arbiter’s decision is usually final and legally binding; however, there may be a right of appeal to the relevant court of law depending on the rules governing the arbitration.

IP enforcement overseas

If your IP rights are being infringed in an overseas market you may consider enforcing your IP right in that particular territory.

As with litigation in Australia, litigation in a foreign jurisdiction will be time consuming and complex. The costs are likely to be higher than in Australia, and in the case of the United States, usually much higher. You may need to address the following when instituting proceedings in a foreign country:
- language barriers
- limited foreign IP knowledge
- need for local advice
- differences in foreign IP systems
- unfamiliar business climate, and
- weak IP enforcement regimes in some countries.

You should also be aware that the successful enforcement of your IP rights in one country does not guarantee a successful outcome in other countries.

Your local legal advisers may have access to foreign legal expertise to assist with the
enforcement of your IP rights overseas.

**Defence and Cross-Claims to IP Infringement Actions**

When an IP infringement claim proceeds to court, the alleged infringer will usually submit a defence and most likely make a cross-claim to challenge the relevant IP rights. If the cross-claim is successful, your organisation will lose the IP rights and your infringement claim will fail.

For example, an alleged infringer of a patent may:
- use a defence that its goods do not fall within the scope of any claim of your organisation’s patent, and
- cross-claim that your organisation’s patent is invalid and should be revoked based on one of the grounds set out in the Patents Act 1990 (Cth).

The grounds of revocation of a patent are set out below (these are not the same as the grounds for Patent Office opposition proceedings). For more information on opposition proceedings, see Chapter 5 ‘What Managers Making IP Protection Decisions Must Know’.

<table>
<thead>
<tr>
<th>Grounds for Revocation of Patents</th>
</tr>
</thead>
<tbody>
<tr>
<td>The patentee is not entitled to a grant of a patent for the invention.</td>
</tr>
<tr>
<td>The patentee is entitled to the grant of a patent but only in conjunction with some other person.</td>
</tr>
<tr>
<td>The invention is not a patentable invention.</td>
</tr>
<tr>
<td>The invention is not novel.</td>
</tr>
<tr>
<td>The invention does not involve an inventive/innovative step.</td>
</tr>
<tr>
<td>The invention lacks utility.</td>
</tr>
<tr>
<td>The invention has been subject to prior secret use.</td>
</tr>
<tr>
<td>The specification of the patent does not fully describe the invention (including the best method known to perform the invention).</td>
</tr>
<tr>
<td>The claims of the patent are not fully based on the matter described in the specification.</td>
</tr>
<tr>
<td>The standard patent was obtained by fraud, false suggestion or misrepresentation.</td>
</tr>
</tbody>
</table>

There is also an important exemption from infringement for prior use. If a person has been using an apparatus or method within the scope of protection of the patented
invention at a time before the priority date of the patent, and has continued that use to the present time, then the person is exempt from infringement.

There are also exemptions relating to ships and aircrafts that are only in Australia temporarily.

**Defences**

Defences available to an IP infringer include the common law doctrines of estoppel and acquiescence.

**Estoppel**

The alleged infringer may claim estoppel where the alleged infringer acted on the understanding that IP rights would not be enforced based upon words said or actions taken by the IP owner.

**Acquiescence**

Under the doctrine of acquiescence the alleged infringer may assert that the IP owner acquiesced to the infringement or delayed taking enforcement action despite having knowledge of the infringement and thereby effectively gave permission to the infringing activities.

Acquiescence will not prevent a court from ordering an injunction to stop the infringing activities, but it may substantially reduce the damages awarded by a court or even lead to no damages being awarded.

**Laches**

Laches refers to a delay in enforcing IP rights, where a subsequent enforcement would prejudice the rights of the other party.

Laches is distinct from acquiescence. For example, failing to object to the use of a label or the registration of that label as a trade mark may amount to acquiescence. Failing to sue an infringer for several years from the first time the label was used may amount to laches.

**Remedies**

An IP owner may seek a number of civil remedies (including temporary and permanent remedies) in a legal action for infringement of IP. These are summarised in the diagram below.

Interim remedies are temporary orders made against an infringing party before or during the trial which will be in effect until the court has had an opportunity to hear the full case and make a final order. Permanent remedies are ordered by the court in a judgment delivered by the trial judge after a full hearing. Judgments in IP cases are reserved at the end of the hearing and handed down later.
IP infringement proceedings are often effectively decided at the interlocutory or ‘interim’ stage and only a small number of actions proceed to a full hearing.

**Insuring your IP Rights**

**Obtaining IP insurance**

Considering the significant amount of time, effort and resources spent in creating and protecting IP assets, it may be appropriate to insure your organisation against the financial costs of enforcement proceedings. Since bringing or defending an infringement claim is expensive, obtaining IP insurance will help to spread the risks and financial costs involved in IP litigation. It may also act as a deterrent to potential infringers.

An insurance policy may be cheaper if obtained at an early stage. Insurance underwriters may not be prepared to cover your IP if it has already been ‘exposed’ to risks.

IP insurance policies vary from insurer to insurer. Generally, the following types of insurance may be relevant in the context of IP enforcement litigation:
• offensive IP insurance, and
• defensive IP insurance.

Offensive IP insurance

‘Offensive insurance’, also known as IP enforcement litigation insurance, covers the costs of bringing legal action to prevent or stop IP infringement by unauthorised users.

Offensive IP insurance usually covers:
• costs of legal expenses to enforce the IP right (including legal fees, expert witnesses and investigators fees), and
• costs of defending cross-claims brought by the alleged infringer (including costs of any revocation proceedings of a patent cross-claim).

However, offensive insurance will usually not cover compensatory or consequential damages, fines, punitive damages and multiple damages.

If the infringement claim is successful, any amount awarded for legal costs and damages may have to be shared on a pro-rata basis between the insurer and the insured organisation up to the amount that the insurer has paid in supporting the litigation.

If the infringement claim is unsuccessful, the insurer will generally bear the costs of the court action, subject to any deductible amounts payable by the insured organisation.

Defensive IP insurance

‘Defensive insurance’, also known as IP infringement liability insurance, covers the costs of legal action in defending a third party claim alleging that the organisation is infringing the IP rights of the third party.

A defensive IP insurance policy usually covers:
• expenses incurred in defending third party claims brought against the organisation (including legal fees, declaratory injunctions and appeals), and
• damages payable by the organisation (including judgement and settlements, lost royalties and lost profits, interest and costs, and legal fees assessed by the court).
Exclusions in insurance policies

As with any insurance policy, there will be circumstances which are not covered. Typical exclusions include loss arising out of:

- the insured organisation’s own wrongful acts
- failure to notify the insurer of pre-existing claims
- breach of contract by the insured organisation’s licensees
- criminal acts by the organisation, and
- cross-claims for breach of trade practices law.

Choosing your IP insurance

Care must be taken when choosing an IP insurance policy. Policies vary between different insurance companies and a comparative analysis will assist in selecting the most appropriate cover for your organisation’s IP.

The product disclosure statement and the relevant insurance policy will need to be carefully reviewed and you should consult with an expert in the field before purchasing any type of insurance.

<table>
<thead>
<tr>
<th>Considerations for choosing your IP insurance</th>
</tr>
</thead>
<tbody>
<tr>
<td>The organisation’s needs and objectives</td>
</tr>
<tr>
<td>The value of the IP</td>
</tr>
<tr>
<td>The likelihood of the IP being infringed by others</td>
</tr>
<tr>
<td>The likelihood of your organisation infringing the rights of others</td>
</tr>
<tr>
<td>The organisation’s financial resources</td>
</tr>
<tr>
<td>The extent of cover required for the IP</td>
</tr>
<tr>
<td>Any existing insurance covering the IP, and if it is still sufficient</td>
</tr>
<tr>
<td>The premium of the policy</td>
</tr>
</tbody>
</table>

IP insurance is generally underwritten by a major insurer and is made available to insurance retail agents.
For IP insurance involving patents, an insurance underwriter may require the following details before issuing insurance:

- the organisation’s history of handling enforcement of patent rights
- the scope and strength of the patent claims
- actions taken to protect and monitor conflicting patents
- existing licences of relevant patents
- existing and potential competitors in related markets
- key patents in the field, and
- a validity and infringement opinion from a patent attorney.
WHERE CAN I FIND OUT MORE ABOUT IP?

Where Can I Find Out More About IP? ..................................................207

IP professionals ..................................................................................207
Patent and trade mark attorneys ......................................................207
IP lawyers ..........................................................................................207
Other IP professionals .......................................................................207
Internal resources .............................................................................207
Public resources ..................................................................................208
Australian IP law ...............................................................................208
IP laws in other countries .................................................................209
Further reading ..................................................................................210
The identification, protection, management and commercialisation of IP can be complex to understand, and you may require the advice and expertise of IP professionals when making IP-related decisions.

There are different types of IP professionals specialising in different areas of IP, and depending on the nature of your enquiry, you may require advice from a variety of IP professionals.

As IP is a very specialised field, you should ensure the IP professional you engage has the appropriate level of expertise and experience to assist with your enquiry.

Patent and trade mark attorneys

Patent and trade mark attorneys provide advice and assistance with the protection of registrable forms of IP, such as patents, trade marks and designs.

A list of registered patent and trade mark attorneys may be found at the following websites:


IP lawyers

IP lawyers are legal specialists in the field of IP, and they provide advice on IP management and enforcement, and assistance with IP-related commercial dealings.

A list of registered IP lawyers may be found at your local Law Society or business centre, and at the IP Australia website: [http://www.ipaustralia.gov.au/resources/professionals_lawyers.shtml](http://www.ipaustralia.gov.au/resources/professionals_lawyers.shtml)

Other IP professionals

Other IP professionals may assist with other IP related issues, such as IP development, accounting for IP and planning the IP business strategy.

These other IP professionals include industry specific advisors, management consultants, financial consultants and market researchers.

Internal resources

For assistance on your organisation’s IP management practices and procedures, refer to your organisation’s IP Management Framework (including the IP Policy and IP Implementation Plan). Relevant staff responsible for managing these may also provide advice and guidance.
**Public resources**

**Australian IP law**

Plenty of resources on IP management are provided to the public by the Australian Government and other organisations. Some examples are set out below:

<table>
<thead>
<tr>
<th>Organization</th>
<th>Description</th>
<th>Website</th>
</tr>
</thead>
<tbody>
<tr>
<td>Attorney-General’s Department</td>
<td>The Attorney-General’s Department provides information and fact sheets on copyright law, and offers free access to its publication ‘A Short Guide to Copyright in Australia’.</td>
<td><a href="http://www.ag.gov.au">http://www.ag.gov.au</a></td>
</tr>
<tr>
<td>Australian Copyright Council</td>
<td>The Australian Copyright Council provides information, advice and training about copyright in Australia.</td>
<td><a href="http://www.copyright.org.au">http://www.copyright.org.au</a></td>
</tr>
<tr>
<td>Australian Law Online</td>
<td>Australian Law Online provides information about the Australian legal system and the government organisations that are part of the Australian legal system.</td>
<td><a href="http://www.law.gov.au">http://www.law.gov.au</a></td>
</tr>
<tr>
<td>Australian Legal Information Institute (Austlii)</td>
<td>Austlii provides free online access to Australasian legal materials, including Australian legislation, cases and commentary.</td>
<td><a href="http://www.austlii.edu.au">http://www.austlii.edu.au</a></td>
</tr>
<tr>
<td></td>
<td></td>
<td><a href="http://www.dcita.gov.au">http://www.dcita.gov.au</a></td>
</tr>
</tbody>
</table>
### Department of Education, Science and Training (DEST)


http://www.dest.gov.au

### IP Australia

IP Australia provides information about patents, trade marks, designs and plant breeders’ rights. It offers online IP registration searches and lodgement tools, and free access to its publication ‘IP Toolbox’.

http://www.ipaustralia.gov.au

### IP laws in other countries

<table>
<thead>
<tr>
<th>Country</th>
<th>Sources</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>New Zealand</strong></td>
<td>Copyright Council of New Zealand: <a href="http://www.copyright.org.nz">http://www.copyright.org.nz</a></td>
</tr>
<tr>
<td></td>
<td>IP Office of New Zealand: <a href="http://www.iponz.govt.nz">http://www.iponz.govt.nz</a></td>
</tr>
<tr>
<td><strong>United Kingdom</strong></td>
<td>British and Irish Legal Information Institute <a href="http://www.bailii.org">http://www.bailii.org</a></td>
</tr>
<tr>
<td></td>
<td>United Kingdom Patent Office <a href="http://www.patent.gov.uk">http://www.patent.gov.uk</a></td>
</tr>
<tr>
<td><strong>United States</strong></td>
<td>Copyright Office of United States <a href="http://www.copyright.org">http://www.copyright.org</a></td>
</tr>
<tr>
<td><strong>European Union</strong></td>
<td>Europa: <a href="http://europa.eu/index_en.html">http://europa.eu/index_en.html</a></td>
</tr>
<tr>
<td><strong>International</strong></td>
<td>World Intellectual Property Organisation: <a href="http://www.wipo.int">http://www.wipo.int</a></td>
</tr>
</tbody>
</table>
Further reading

There is a wealth of information available on the subject of IP, available in textbooks, loose leaf services and articles. Examples of such are provided below.

**Textbooks**


**Loose leaf services**

- Australian *Industrial & Intellectual Property*, (edited by Liberman A) CCH Australia Ltd
- *Copyright & Designs*, (edited by Lahore J) Butterworths
BIBLIOGRAPHY

Legislation
Circuit Layouts Act 1989 (Cth)
Copyright Act 1968 (Cth)
Designs Act 2003 (Cth)
Freedom of Information Act 1982 (Cth)
Patents Act 1990 (Cth)
Plant Breeder’s Rights Act 1994 (Cth)
Privacy Act 1998 (Cth)
Trade Marks Act 1995 (Cth)
Trade Practices Act 1974 (Cth)

International Treaties and Agreements
World Trade Organisation, Trade-related aspects of intellectual property rights (TRIPS) agreement, 1994

Textbooks & Journal Articles
Anson W, Fundamentals of Intellectual Property Valuation: A Primer for identifying and Determining Value, American Bar Association, 2005
Australian Microelectronics Network, Best Practice in Electronics Design, 2004


Loose Leaf Services

Australian Industrial & Intellectual Property, edited by Liberman A, CCH Australia

Copyright and Designs, edited by Lahore J, Butterworths

Web-based Publications


World Intellectual Property Organisation, *States Party to PCT and the Paris Convention and Member of*


**Websites**

Arts Law Centre of Australia, *Arts Law Centre of Australia online*, <http://www.artslaw.com.au>

Australasian Legal Information Institute, *Australasian Legal Information Institute (AustLII)*, <http://www.austlii.edu.au>


Australian Copyright Council, *Australian Copyright Council’s Online Information Centre*, Australian Council for the Arts, <http://www.copyright.org>


Australian Electrical and Electronics Manufacturers’ Association, *AEEMA*, <http://www.aeema.asn.au>


Australian Society of Authors, *The Australian Society of Authors Online*, <http://www.asauthors.org>


Copyright Agency Limited, *Copyright Agency Limited: Licensed Copying and Communications*, <http://www.copyright.com.au>


Domain Names, *Domain name: domain name registration, domain name, web hosting*, <http://www.domainnames.com.au>

Film Australia, *Film Australia: Leaders in Australian Documentary*, <http://www.filmaust.com.au>


Media, Entertainment and Arts Alliance, *Alliance online*, <http://www.alliance.org.au>


Screenrights, *Screenrights*, <http://www.screenrights.org>


### ABBREVIATIONS

<table>
<thead>
<tr>
<th>Abbreviation</th>
<th>Full Form</th>
</tr>
</thead>
<tbody>
<tr>
<td>AASB</td>
<td>Australian Accounting Standards Board</td>
</tr>
<tr>
<td>ABN</td>
<td>Australian Business Number</td>
</tr>
<tr>
<td>ACN</td>
<td>Australian Company Number</td>
</tr>
<tr>
<td>ADR</td>
<td>Australian Dispute Resolution</td>
</tr>
<tr>
<td>ALRC</td>
<td>Australian Law Reform Commission</td>
</tr>
<tr>
<td>AMCOS</td>
<td>Australian Mechanical Copyright Owners' Society</td>
</tr>
<tr>
<td>APRA</td>
<td>Australian Performing Right Association</td>
</tr>
<tr>
<td>ARIA</td>
<td>Australian Recording Industry Association</td>
</tr>
<tr>
<td>ASIC</td>
<td>Australian Securities and Investment Commission</td>
</tr>
<tr>
<td>ATS</td>
<td>National Australian Technology Showcase</td>
</tr>
<tr>
<td>.auDA</td>
<td>.au Domain Administration Limited</td>
</tr>
<tr>
<td>.auDRP</td>
<td>.au Dispute Resolution Policy</td>
</tr>
<tr>
<td>CLR Act</td>
<td>Circuit Layout Rights Act 1989 (Cth)</td>
</tr>
<tr>
<td>COMET</td>
<td>Commercialising Emerging Technologies</td>
</tr>
<tr>
<td>Copyright Act</td>
<td>Copyright Act 1968 (Cth)</td>
</tr>
<tr>
<td>CRA</td>
<td>Collaborative Research Agreement</td>
</tr>
<tr>
<td>CRC</td>
<td>Cooperative Research Centre</td>
</tr>
<tr>
<td>Cth</td>
<td>Commonwealth of Australia</td>
</tr>
<tr>
<td>CTM</td>
<td>Community Trade Mark (European Union)</td>
</tr>
<tr>
<td>Designs Act</td>
<td>Designs Act 2003 (Cth)</td>
</tr>
<tr>
<td>DEST</td>
<td>Department of Education, Science and Training</td>
</tr>
<tr>
<td>DITR</td>
<td>Department of Industry, Tourism and Resources</td>
</tr>
<tr>
<td>DNS</td>
<td>Domain Name System</td>
</tr>
<tr>
<td>DRM</td>
<td>Digital Rights Management</td>
</tr>
<tr>
<td>EDA</td>
<td>Electronic Design Automation</td>
</tr>
<tr>
<td>EULAs</td>
<td>End User Licence Agreements</td>
</tr>
<tr>
<td>FPGA</td>
<td>Field-Programmable Gate Array</td>
</tr>
<tr>
<td>GPL</td>
<td>General Public Licence</td>
</tr>
<tr>
<td>HDLs</td>
<td>Hardware Description Languages</td>
</tr>
<tr>
<td>ICT</td>
<td>Information and Communications Technology</td>
</tr>
<tr>
<td>IIF</td>
<td>Innovation and Investment Fund</td>
</tr>
<tr>
<td>IP</td>
<td>Intellectual Property</td>
</tr>
<tr>
<td>IPE</td>
<td>International Preliminary Examination</td>
</tr>
<tr>
<td>ISR</td>
<td>International Search Report</td>
</tr>
<tr>
<td>IT</td>
<td>Information Technology</td>
</tr>
<tr>
<td>Paris Convention</td>
<td>Paris Convention for the Protection of Industrial Property 1883</td>
</tr>
</tbody>
</table>
Patents Act
PCT
PPCA
R&D
RMI
RTOS
Trade Marks Act
TRIPS
WIPO
WIPO Convention
WTO

Patents Act 1990 (Cth)
Phonographic Performance Company Australia
Research and Development
Electronic Rights Management Information
Real-Time Operating System
Trade Marks Act 1995 (Cth)
Trade-Related Aspects of Intellectual Property Rights Agreement
World Intellectual Property Organisation
Convention establishing the World Intellectual Property Organisation
World Trade Organisation
### GLOSSARY OF TERMS

<table>
<thead>
<tr>
<th>Term</th>
<th>Definition</th>
</tr>
</thead>
<tbody>
<tr>
<td>Account of profits</td>
<td>Account of profits is an order by a court requiring the infringing party to deliver profits made from unauthorised use of rights.</td>
</tr>
<tr>
<td>Acquiescence</td>
<td>Acquiescence is a legal doctrine where permission or acceptance is deemed to be given by silence or passiveness.</td>
</tr>
<tr>
<td>All rights reserved</td>
<td>All rights reserved is a notice usually found on copyright works. An ‘all rights reserved’ notice indicates that all rights granted under copyright law are retained (including the rights to take legal action if there is any infringement).</td>
</tr>
<tr>
<td>Alternative dispute resolution (ADR)</td>
<td>ADR techniques are non-litigious methods of resolving disputes, such as informal settlement conferences, mediation or arbitration.</td>
</tr>
<tr>
<td>Anton Pillar Order</td>
<td>Anton Pillar Order is an order by a court authorising the search of premises for the purpose of seizing infringing articles that are likely to be removed or destroyed by the infringer if notice of alleged infringement is given.</td>
</tr>
<tr>
<td>Arbitration</td>
<td>Arbitration is where a neutral third party (‘arbitrator’) acts as a private judge in a closed court to make a decision on the dispute to which the parties agree to be bound.</td>
</tr>
<tr>
<td>Artistic works</td>
<td>Artistic works is one of the categories of works that is protected by the Copyright Act 1968 (Cth). Artistic works include photographs, drawings, paintings, sculptures, architecture, graphs and computer icons.</td>
</tr>
<tr>
<td>Assignment</td>
<td>An assignment is the legal term for the permanent transfer of rights to another individual or entity.</td>
</tr>
<tr>
<td>Background IP</td>
<td>Background IP refers to any IP existing prior to the performance of a contract or acquired or independently created by a party to the contract.</td>
</tr>
<tr>
<td>Breach of contract</td>
<td>A breach of contract is where there is a failure by a party of the contract to comply with the terms and conditions set out in the contract.</td>
</tr>
<tr>
<td>Term</td>
<td>Description</td>
</tr>
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<td>-------------------------------------------</td>
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</tr>
<tr>
<td>Broadcasts</td>
<td>Broadcasts are one of the categories of works that is protected by the Copyright Act 1968 (Cth). This refers to a communication to the public via television and radio broadcasts.</td>
</tr>
<tr>
<td>Broadcasting decoding devices</td>
<td>Broadcasting decoding devices are devices which enable unauthorised access to an encoded broadcast.</td>
</tr>
<tr>
<td>Cinematographic works</td>
<td>Cinematographic works is one of the categories of works that is protected by the Copyright Act 1968 (Cth). Cinematographic works are works generating moving images, including films and computer games.</td>
</tr>
<tr>
<td>Circuit layouts</td>
<td>A circuit layout is a representation (i.e. a mask) describing the layout of the design of an integrated circuit. In Australia, the Circuit Layouts Act 1989 (Cth) grants an exclusive set of rights automatically upon creation of an original circuit layout for a limited period of time.</td>
</tr>
<tr>
<td>Collaborative Research Agreement (CRA)</td>
<td>CRA is a contract which defines the terms and conditions under which collaborative research will be undertaken.</td>
</tr>
<tr>
<td>Claims</td>
<td>The claims of a patent are written statements in the patent defining the boundaries of an invention as set out in a patent specification.</td>
</tr>
<tr>
<td>Community Trade Mark (CTM)</td>
<td>CTM refers to a trade mark registered with the European Communities Trade Mark Office and is enforceable throughout the European Union.</td>
</tr>
<tr>
<td>Complete application</td>
<td>A complete application is a patent application for a standard or innovation patent that includes a full and complete specification and claims for the invention.</td>
</tr>
<tr>
<td>Confidential information</td>
<td>Confidential information is information of a confidential nature (and may include information of a personal or commercial nature) that is not available to the public.</td>
</tr>
<tr>
<td>Copyright</td>
<td>Copyright is a form of intellectual property that protects the expression of an idea, but not the idea itself. In Australia, copyright is governed by the Copyright Act 1968 (Cth) where an exclusive set of rights are automatically granted upon creation of an original copyright work for a limited period of time.</td>
</tr>
<tr>
<td>Cost approach</td>
<td>The cost approach to IP valuation values IP by reference to the reproduction or replacement costs that would be incurred in creating the IP assets again.</td>
</tr>
<tr>
<td><strong>Cross claim</strong></td>
<td>A cross claim is a claim made in response to another claim, such as where a defendant brings a claim against the plaintiff in the same lawsuit.</td>
</tr>
<tr>
<td><strong>Customs notice</strong></td>
<td>A customs notice is a notice lodged with Australian Customs to seize imported goods that infringe an organisation’s trade mark or copyright.</td>
</tr>
<tr>
<td><strong>Damages</strong></td>
<td>Damages are monetary compensation that an infringer is required by a court to pay the owner for loss suffered as a result of the infringing act.</td>
</tr>
<tr>
<td><strong>Defensive insurance</strong></td>
<td>Defensive insurance is a type of insurance where funding is provided to cover the costs of legal proceedings brought against the insured for IP infringement owned by a third party.</td>
</tr>
<tr>
<td><strong>Designs</strong></td>
<td>See ‘Registered design’.</td>
</tr>
<tr>
<td><strong>Digital Rights Management (DRM)</strong></td>
<td>DRM refers to the management and protection of copyright material in the digital environment using technological protection tools.</td>
</tr>
<tr>
<td><strong>Divisional application</strong></td>
<td>A divisional application is a patent application filed to separate two inventions described in one earlier patent application, without losing its priority date.</td>
</tr>
<tr>
<td><strong>Domain names</strong></td>
<td>Domain names are sequences of letters which are translations of numeric internet protocol addresses.</td>
</tr>
<tr>
<td><strong>Dramatic works</strong></td>
<td>Dramatic works is one of the categories of works that is protected by the Copyright Act 1968 (Cth). Dramatic Works include plays, screenplays and choreographic works.</td>
</tr>
<tr>
<td><strong>Due diligence</strong></td>
<td>Due diligence is a comprehensive investigation and analysis of an organisation’s IP assets to confirm its ownership status over the assets and the organisation’s ability to authorise the proposed use of the IP assets.</td>
</tr>
<tr>
<td><strong>Economic rights</strong></td>
<td>Economic rights are a set of exclusive rights granted to a copyright owner by the Copyright Act 1968 (Cth), which may be assigned or licensed.</td>
</tr>
<tr>
<td><strong>Electronic Rights Management Information (RMI)</strong></td>
<td>RMI is a set of electronic systems for identifying, protecting and tracking copyright work in electronic form. The Copyright Act 1968 (Cth) prohibits the removal or alteration of RMI.</td>
</tr>
<tr>
<td><strong>End User Licence Agreement (EULA)</strong></td>
<td>EULA is a legal contract between the author or publisher of a software application and the user of that application. The user agrees to pay for the use of the software and to comply with all restrictions stated in the EULA.</td>
</tr>
<tr>
<td><strong>Estoppel</strong></td>
<td>Estoppel is a legal doctrine under which a person is prevented from asserting or denying a fact because of the person’s previous acts or words.</td>
</tr>
<tr>
<td><strong>Exclusive licence</strong></td>
<td>An exclusive licence is where the licensee is the only person who has the right to deal with the licensed rights to the exclusion of all others, including the licensor.</td>
</tr>
<tr>
<td><strong>Fair dealing</strong></td>
<td>Fair dealing refers to categories of acts that do not constitute copyright infringement under the Copyright Act 1968 (Cth). Fair dealing includes use of copyright protected works to report news, for research or study, for criticism and review, and for professional advice given by a lawyer, patent attorney or trade marks attorney.</td>
</tr>
<tr>
<td><strong>Freedom to operate</strong></td>
<td>Freedom to operate refers to being able to use a product freely without infringing registered or pending IP rights.</td>
</tr>
<tr>
<td><strong>Filing date</strong></td>
<td>Filing date refers to the date an application for registrable IP is lodged with the relevant IP office. A filing date may be the same or different to a priority date.</td>
</tr>
<tr>
<td><strong>Final injunction</strong></td>
<td>Final injunction is an order by a court requiring the infringing party to cease the infringing act permanently.</td>
</tr>
<tr>
<td><strong>Goodwill</strong></td>
<td>Goodwill is the reputation acquired from use of a particular registered or unregistered trade mark. A passing off action prevents others from trading on the goodwill acquired by a particular mark.</td>
</tr>
<tr>
<td><strong>Income approach</strong></td>
<td>The income approach to IP valuation values IP by calculating the expected future income stream (or cost savings) to be generated by an IP asset.</td>
</tr>
<tr>
<td><strong>In escrow</strong></td>
<td>In escrow refers to the holding of items by a neutral third party until certain conditions are met to release them.</td>
</tr>
<tr>
<td><strong>Innovation patent</strong></td>
<td>An innovation patent is a type of patent for an invention that involves an innovative step, in addition to other requirements of patentability. Protection generally lasts for 8 years from the first date of filing a complete application.</td>
</tr>
<tr>
<td><strong>Innovative step</strong></td>
<td>Innovative step is one of the requirements for innovation patent registration under the Patents Act 1990 (Cth).</td>
</tr>
</tbody>
</table>
**Intellectual Property (IP)**

IP is a form of intangible property resulting from creative efforts of the mind or intellect. IP are rights relating to:
- literary, artistic and scientific works
- performances of performing artists, phonograms and broadcasts
- inventions in all fields of human endeavour
- scientific discoveries
- industrial designs
- trade marks, services marks and commercial names and designations
- protection against unfair competition, and
- all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.

**Interim remedies**

Interim remedies are types of remedies granted temporarily until the court has heard the full case to grant permanent remedies.

**Interlocutory injunction**

An interlocutory injunction is an order by the court restraining an infringing party from continuing the infringing act until conclusion of the relevant trial.

**Invention disclosure form**

An invention disclosure form is a document for completion by the creators of particular IP setting out the details of its development, as well as details on how it is distinguished from existing IP.

**Inventive step**

Inventive step is one of the requirements for standard patent registration under the Patents Act 1990 (Cth).

**IP implementation plan**

An IP implementation plan is a document setting out a plan at an operational level to implement the IP Policy within an organisation.

**IP inventory audit**

An IP inventory audit is an exercise identifying all existing IP assets held by the organisation.

**IP policy**

An IP policy is a document setting out an organisation’s aims and objectives for the management of IP.

**IP valuation**

IP valuation is an assessment of the value of a particular IP asset. IP valuation may be quantitative or qualitative in nature. There are a range of methods to value IP.

**Joint ownership**

Joint ownership is where two or more individuals or organisations jointly own the IP. This may arise where they develop the IP together as a collaborative effort.

**Joint venture**

A joint venture is a legal construction where two parties join together to undertake a common project to reach a shared goal.
<table>
<thead>
<tr>
<th>Term</th>
<th>Definition</th>
</tr>
</thead>
<tbody>
<tr>
<td>Letter of demand</td>
<td>A letter of demand is a letter setting out certain demands to a person suspected of infringing IP rights issued by the owner of those IP rights.</td>
</tr>
<tr>
<td>Licence</td>
<td>A licence is the grant of particular rights to another individual or entity (‘licensee’) by the owner of those rights (‘licensor’) to use the rights for a period of time. The licensor of the rights retains the legal ownership of the IP and may exercise a varying degree of control.</td>
</tr>
<tr>
<td>Madrid System</td>
<td>The Madrid System refers to the Madrid System for the International Registration of Marks established under the Madrid Agreement 1891 and the Madrid Protocol 1989. It is administered by the World Intellectual Property Organisation granting trade mark protection in countries party to the Madrid Union by filing one application directly in their own national or regional trade mark office.</td>
</tr>
<tr>
<td>Manner of manufacture</td>
<td>Manner of manufacture is one of the requirements for patent registration under the Patents Act 1990 (Cth).</td>
</tr>
<tr>
<td>Mareva injunction</td>
<td>Mareva injunction is an order by the court freezing the infringing party’s assets so they cannot be consumed or transferred out of jurisdiction before the conclusion of a trial.</td>
</tr>
<tr>
<td>Market approach</td>
<td>The market approach to IP valuation values IP by assessing the comparable price or royalty that could be or has been achieved by similar technologies or IP in the market.</td>
</tr>
<tr>
<td>Mediation</td>
<td>Mediation is where a neutral third party (‘mediator’) assists and facilitates the negotiation between parties in dispute.</td>
</tr>
<tr>
<td>Metadata</td>
<td>Metadata is information that describes a particular piece of content being held digitally.</td>
</tr>
<tr>
<td>Moral rights</td>
<td>Moral rights are personal rights granted to the creator of a copyright work by the Copyright Act 1968 (Cth) protecting the integrity and right of attribution of their work. These rights cannot be assigned or licensed.</td>
</tr>
<tr>
<td>Musical works</td>
<td>Musical works is one of the categories of works that is protected by the Copyright Act 1968 (Cth). Musical works are works with written musical notation, including sheet music and operas.</td>
</tr>
<tr>
<td>Non-exclusive licence</td>
<td>A non-exclusive licence is where the licensor retains the right to grant an unlimited number of licences to third parties.</td>
</tr>
<tr>
<td>Notice of objection</td>
<td>See Customs notice.</td>
</tr>
<tr>
<td>Term</td>
<td>Definition</td>
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</tr>
<tr>
<td><strong>Novelty</strong></td>
<td>Novelty is one of the requirements for patent registration under the Patents Act 1990 (Cth).</td>
</tr>
<tr>
<td><strong>Object code</strong></td>
<td>This is the machine-readable code of a software program.</td>
</tr>
<tr>
<td><strong>Offensive insurance</strong></td>
<td>Offensive insurance is a type of insurance where funding is provided to cover the costs of legal proceedings where IP rights are being enforced by the insured against a third party infringer.</td>
</tr>
<tr>
<td><strong>Open source</strong></td>
<td>Open source refers to any software program whose source code is made available for use, modification and redistribution to any user.</td>
</tr>
<tr>
<td><strong>Paris Convention application</strong></td>
<td>A Paris Convention application allows an invention to be granted patent protection in other Paris Convention signatory countries whilst retaining the priority date of the first filing of a complete patent application in a Paris Convention signatory country.</td>
</tr>
<tr>
<td><strong>Passing off</strong></td>
<td>Passing off is a court tort action that protects the reputation or goodwill of unregistered marks.</td>
</tr>
<tr>
<td><strong>Patent</strong></td>
<td>A patent is a form of intellectual property that protects an invention. A patent grants a set of exclusive rights to the patent owner to exploit the invention commercially for a limited period of time. The grant of a patent in Australia is governed by the Patents Act 1990 (Cth) in Australia.</td>
</tr>
<tr>
<td><strong>Patent of addition</strong></td>
<td>A patent of addition is a patent application filed to protect an improvement or modification of an invention set out in an earlier patent application.</td>
</tr>
<tr>
<td><strong>Patent attorney</strong></td>
<td>A patent attorney is a professional qualified in a scientific discipline and qualified to act in the obtainment of patent and design registrations.</td>
</tr>
<tr>
<td><strong>Performers’ rights</strong></td>
<td>Performers’ rights are personal rights granted to the performer of a copyright work by the Copyright Act 1968 (Cth) protecting against unauthorised recordings and broadcasting of performances.</td>
</tr>
<tr>
<td><strong>Person skilled in the art</strong></td>
<td>A person skilled in the art is a legal term referring to a person who has the ordinary level of skills and knowledge in the relevant field of an invention.</td>
</tr>
<tr>
<td><strong>Permanent remedies</strong></td>
<td>Permanent remedies are remedies granted by the court at the conclusion of a trial.</td>
</tr>
<tr>
<td>Term</td>
<td>Definition</td>
</tr>
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</tr>
<tr>
<td>Plant breeders rights</td>
<td>A form of intellectual property that protects a registered plant variety. In Australia, plant breeders' rights are governed by the Plant Breeder’s Rights Act 1994 (Cth) where an exclusive set of rights are granted to the registered owner for limited period of time.</td>
</tr>
<tr>
<td>Prior art</td>
<td>A legal term referring to information previously disclosed to the public in any form relating to the invention before its priority date.</td>
</tr>
<tr>
<td>Priority date</td>
<td>The priority date is the date of filing of the first application for a registrable form of IP. This is the date against which the application is assessed in light of the relevant prior act.</td>
</tr>
<tr>
<td>Product liability insurance</td>
<td>A type of insurance where funding is provided to cover costs when a person has suffered damage as a result of a product manufactured, repaired or altered by the insured.</td>
</tr>
<tr>
<td>Published editions</td>
<td>One of the categories of works that is protected by the Copyright Act 1968 (Cth). These refer to publisher’s typeface and layout of a published work.</td>
</tr>
<tr>
<td>Registered design</td>
<td>A form of intellectual property that protects the overall appearance of a new and distinctive design. In Australia, the Designs Act 2003 (Cth) grants a set of exclusive rights to the registered designs owner to commercially exploit the design for a limited period of time.</td>
</tr>
<tr>
<td>Reverse-engineering</td>
<td>The process by which a finished product is examined in order to obtain information relating to its construction.</td>
</tr>
<tr>
<td>Right of attribution</td>
<td>A type of moral right granted to the creator of a copyright protected work. The Copyright Act 1968 (Cth) defines the right of attribution as the right to have the creator identified with his or her work.</td>
</tr>
<tr>
<td>Right of integrity</td>
<td>A type of moral right granted to the creator of a copyright protected work. The Copyright Act 1968 (Cth) defines the right of integrity as a right to not have the work subjected to derogatory treatment.</td>
</tr>
<tr>
<td>Royalty</td>
<td>A fee paid to the IP owner for the right to use their IP. Royalties may be calculated as a percentage of profit, as a fee per usage or as a lump sum payment.</td>
</tr>
<tr>
<td>Sole licence</td>
<td>A licence where the licensee has the right to deal with the licensed rights to the exclusion of everyone else except the licensor.</td>
</tr>
</tbody>
</table>

**Intellectual Property Management** 228
<table>
<thead>
<tr>
<th><strong>Sole ownership</strong></th>
<th>Sole ownership is where all rights in an IP asset are owned by one individual or organisation.</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Sound recordings</strong></td>
<td>Sound recordings are one of the categories of works that is protected by the Copyright Act 1968 (Cth). This refers to works with recorded sound, including CDs, DVDs, mp3s and podcasts.</td>
</tr>
<tr>
<td><strong>Source code</strong></td>
<td>This is the human-readable code of a software program.</td>
</tr>
<tr>
<td><strong>Specification</strong></td>
<td>A patent specification is a detailed technical description of an invention, usually accompanied by drawings, set out in a patent application.</td>
</tr>
<tr>
<td><strong>Spin off companies</strong></td>
<td>A spin off company is a separate company established by an organisation for the purposes of undertaking a particular activity, such as the commercialisation of a specific IP asset.</td>
</tr>
<tr>
<td><strong>Standard patent</strong></td>
<td>A standard patent is a type of patent for an invention that involves an inventive step, in addition to other requirements of patentability. Protection generally lasts for 20 years from the first date of filing the complete application.</td>
</tr>
<tr>
<td><strong>Substantial part</strong></td>
<td>A substantial part under the Copyright Act 1968 (Cth) refers to both the quantitative and qualitative taking of a copyright-protected work.</td>
</tr>
<tr>
<td><strong>Technological Protection Measures (TPMs)</strong></td>
<td>TPMs are technologies aiding the protection of IP works and restricting access to it, such as password-protection, encryption and read-only access.</td>
</tr>
<tr>
<td><strong>Trade mark</strong></td>
<td>A trade mark is a form of intellectual property that is a sign used in trade to identify and distinguish a business’s goods and services from other businesses.</td>
</tr>
<tr>
<td><strong>Trade mark attorney</strong></td>
<td>A trade mark attorney is a professional qualified to act in obtaining trade mark registrations.</td>
</tr>
<tr>
<td><strong>Trade secrets</strong></td>
<td>Trade secrets are confidential information in the context of business, commerce or trade.</td>
</tr>
<tr>
<td><strong>Utility</strong></td>
<td>Utility is one of the requirements for patent registration under the Patents Act 1990 (Cth).</td>
</tr>
<tr>
<td><strong>Warranty</strong></td>
<td>A warranty is an assurance that a provision in a contract is true.</td>
</tr>
</tbody>
</table>
**World Intellectual Property Organisation (WIPO)**

WIPO is a specialised agency of the United Nations dedicated to promoting the use and protection of IP works, such as administering various international treaties dealing with the harmonisation of different aspects of IP protection.

**World Trade Organisation (WTO)**

WTO is an international organisation that develops and enforces worldwide rules to promote international trade, including lowering tariffs and removing national trade barriers that restrict imports or exports of goods and services.
INDEX

A
Accounting practices 158-159
Alternative Dispute Resolutions (ADR) 197-198
Arbitration 198
Assignment 178
Audit 146-149

B

C
Capital raising
   Government grant schemes 44-48
   Government grant agreement 44-45
   Initial public offering 50-51
   Private equity 48
Circuit Layout
   Circuit layout notice 116
   Infringement 27
   Protection 26-27, 116-117
   Rights 28, 118
Collaborative research 164-165
Commercialisation
   Assignment 178
   Joint ventures 180-182
   Licence 172-173
   Partner 182-183
   Risks 183-186
   Spin-off companies 179-180
Confidential information
Breach of 29, 64
Employees 136-138
Identification of 28, 117
Management of 117-118
Protection of 29, 118
Public disclosures 117-118

Confidentiality (see Contracts)
Contracts
   Collaborative research agreements (CRA) 163-165
   Confidentiality agreements 119
   Escrow agreement 108, 175
   Indemnities 74-75
   Software 174
   Warranties 74-75
Copyright
   Artistic works 19
   Broadcasts 19
   Cinematographic works 19
   Copyright notice 107-108
   Digital Rights Management (DRM) 22, 108-109
   Dramatic works 19
   Economic rights 19-20
   Electronic Rights Management Information (RMI) 22
   Escrow 108
   Exceptions 22-23
   Infringement 21-22
   Literary works 19
   Metadata 108-109
   Moral rights 20-21, 63-64, 135-136
Musical works 19
Performers rights 21, 111
Protection of 107
Published editions 19
Software 23, 63, 108
Sound recordings 19
Source code 108, 109-110
Technological Prevention Measures (TPMs) 109

Cost approach (see Valuation)
Customs Notices 196-197

D
Databases 57-59
Defences
   Acquiescence 200
   Estoppel 200
   Laches 200
Designs (see Registered designs)
Design process planning
   Competitive landscape 57
   Design re-use 62
   Electronic Design Automation (EDA) vendors 66-67
   Generally 55
   Risks 67
   Re-using hardware design 65
   Re-using software 63
   Re-using traded intellectual property 66
Design work books 81-83
Digital Rights Management (DRM) 108-109
Divisional application 16
Domain names
   .auDA 33, 131
   ICANN 131
   Registers 32, 129
   Registrars 32, 129, 131
Due diligence 43-44, 75, 163

E
Electronic Rights Management 22
Employees (see Ownership)
End-user licence (see Licence)

Enforcement
   Alternative Dispute Resolution (ADR) 197
   Breach of contract 196
   Customs notice 196-197
   Letter of demand 195-196
   Litigation 197
   Overseas 198
Escrow agreement (See Contracts)
External IP advisers 207

F
Further assistance 206

G
Government grants 44-48

H

I
Income approach (see Valuation)
Indemnities (see Contracts)
Innovation patent (see Patents)
Innovation step (see Patents)
Insurance
   Defensive 202
   Exclusions 203
   Obtaining 201
   Offensive 202
   Policies 203-204

Intellectual property
   Circuit Layout 26-28
   Commercialisation 168-187
   Confidential information 28-29
   Copyright 18-23
   Databases 57-59
   Defending 199-200
   Designs 23-26
Domain names 32
Enforcement of 195-199
Forms of 9-11
Insurance 187, 201-204
Management of 4, 138
Ownership 135
Patents 12-18
Professionals 207
Protection of 91
Record storage practices 84
Trade marks 29-30
Invention disclosure forms (see Patents)
Inventive step (See Patents)
Inventor
Joint inventors 80-81
IP management framework 138
IP policy 139
IP strategy 35-41

J
Joint ownership (see Ownership)
Joint ventures 180-181

K

L
Laboratory notebooks 81-83
Letter of demand 195-196
Licence
End user licence 173
Exclusivity 162, 176
Open source 109-110
Purpose or field of use 176
Rights 161, 176-177
Term 176
Territory 176
Types 172-173

M
Market approach (see Valuation)
Mediation 197-198
Moral rights (see Copyright)

N
Novelty (see Patents)

O
Object code (see Software)
Open source (see Licence)
Ownership
Contractors 136
Employees 135
IP 135-136, 159-161
Joint 160-161
Sole 160

P
Paris Convention 104
Patents
Applications 15-16
Application process 96-98, 106
Characteristics 17
Claims 100
Costs 100-101
Examination 101
Filing 99
Foreign protection 104-106
Infringement 18
Innovation patent 17
Innovation step 13
Invention disclosure forms 77-79
Inventive step 13
Manner of manufacture 13
Novelty 13
Office 58
Opposition 102
Patent notice 103
PCT application 16, 104
Prior secret use 14
Protection of 15, 103
Provisional application 15
Publication 101
Rights 17
Registration 93
Requirements 12-15, 99-100
Searches 95-96
Specification 60-62
Standard patent 17
Term of protection 94
Usefulness 14
vs confidential information 94
Patent attorney 207
Patent Cooperation Treaty (PCT) 104
Protection
  Circuit Layouts 27, 116
  Copyright 18-19, 107
  Designs 24, 111
  Domain names 32, 128
  Patents 12-15, 93
  Trade marks 29-30, 119
Q
R
Record storage practices 84
Registered designs
  Applications 113
  Application process 112
  Costs 113-114
  Designs notice 115
  Foreign protection 115
  Infringement 26
  Maintenance fees 115
  Overlap with copyright 25
  Protection 24, 111
  Registration 112
  Searches 111
  Unregistered 25
Remedies 200-201
Risks
  Commercialisation 183-184
Management of 185-186
S
Software
  Licence 174
  Object code 108
  Open source licence 109-110
  Source code 108
  Spin-off companies 179-180
  Standard patent (see Patents)
T
  Technological Protection Measures (TPM) 22
  Third party IP 74
Trade mark attorney 207
Trade marks
  Application 125
  Application process 123-124
  Domain names 31
  Infringement 31
  Foreign protection 31
  Maintenance fees 127
  Protection of 30, 119
  Registration 119
  Rights 31
  Searches 123
  Selection of 120
  Symbol 127
  Term of protection 30
  Types of 30, 120
  Unregistered 119
  Use of 127
Trade secrets 28
U
  Unregistered design (see Registered designs)
  Unregistered trade mark (see Trade Marks)
V
Valuation
Cost approach  154-155
Income approach  155-156
Market approach  156-157
Qualitative  150-152
Quantitative  153-157
Valuation report  157
Valuer  157

W
Warranties (see Contracts)

X

Y

Z
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