THE UNIVERSITY of ADELAIDE

Inventor's Guide

A guide to technology transfer

make history.

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Note: This booklet is based on the University of Michigan's "Inventor's Guide to Technology Transfer". We are grateful to the University of Michigan for the permission to use their guide

Overview

What is technology transfer?

Technology transfer is a process by which knowledge and discoveries are disseminated to the public. It can occur through publications, educated students entering the work force, exchanges at conferences, and relationships with industry or academic collaboration.

For the purposes of this guide, technology transfer refers to the formal licensing of technology to third parties.

What is the role of Innovation and Commercialisation Services?

The Innovation and Commercialisation Services (ICS) Branch is responsible for technology transfer at the University of Adelaide. Our team are composed of specialists in licensing, business development, and intellectual property matters. Our role is to manage and promote the intellectual capital of the University and seek impact through licensing the intellectual and tangible property to existing industry partners and newly formed spin-out companies.

We encourage you to contact us during your early research activities. Our team will work with you to make you aware and advise you of the options that will best leverage the commercial potential of your research.

How is technology transferred?

Technology is typically transferred through a licence agreement in which the University grants its rights in the defined technology to a third party (the licensee) for a period of years, which is sometimes limited to a particular field of use and/or region of the world.

The licensee may be an established company or a new business start-up. Licences include terms that require the licensee to meet certain performance requirements and to make financial payments to the University.

These payments are shared with the inventors and are distributed to the Schools, Faculty, and Division of Research and Innovation to provide support for further research, education, and participation in the tech transfer process.

How long does the technology transfer process take?

The process of protecting the technology and finding the right licensing partner may take months or even years to complete and is dependent on the:

- Development stage of the technology.
- Market for the technology.
- Competing technologies.
- Amount of work needed to bring a new concept to market-ready status.
- Resources and willingness of the licensees and the inventors.

What are the benefits of commercialising research?

The reasons are unique to each researcher and may include:

- Making a positive impact on society.
- Making research available for the public benefit.
- Feeling a sense of personal fulfilment.
- Achieving recognition and financial rewards.
- Generating additional laboratory/departmental funding.
- Meeting the obligations of a research contract.
- Attracting research sponsors.
- Creating educational opportunities for students.
- Linking students to future job opportunities.

Note: Throughout this guide, unless specifically described otherwise, the term inventor includes individuals listed on a patent, as well as contributors who have shared in creating the value of intellectual property that is not patented.

Commercialisation pathway

The process of technology transfer is summarised in the steps and diagram that follow. These steps can vary in sequence and often occur simultaneously.

Research

Observations and experiments during research activities often lead to discoveries and inventions.

An invention is any useful process, machine, composition of matter, or any new or useful improvement of the same.

Often, multiple researchers may have contributed to the invention. As staff members of the University, your invention will be owned by the University and the inventors will be entitled to receive a benefit.

Invention Disclosure

The written notice of invention which begins the formal technology transfer process. An Invention Disclosure remains a confidential document and should fully document your invention so that the options for commercialisation can be evaluated and pursued.

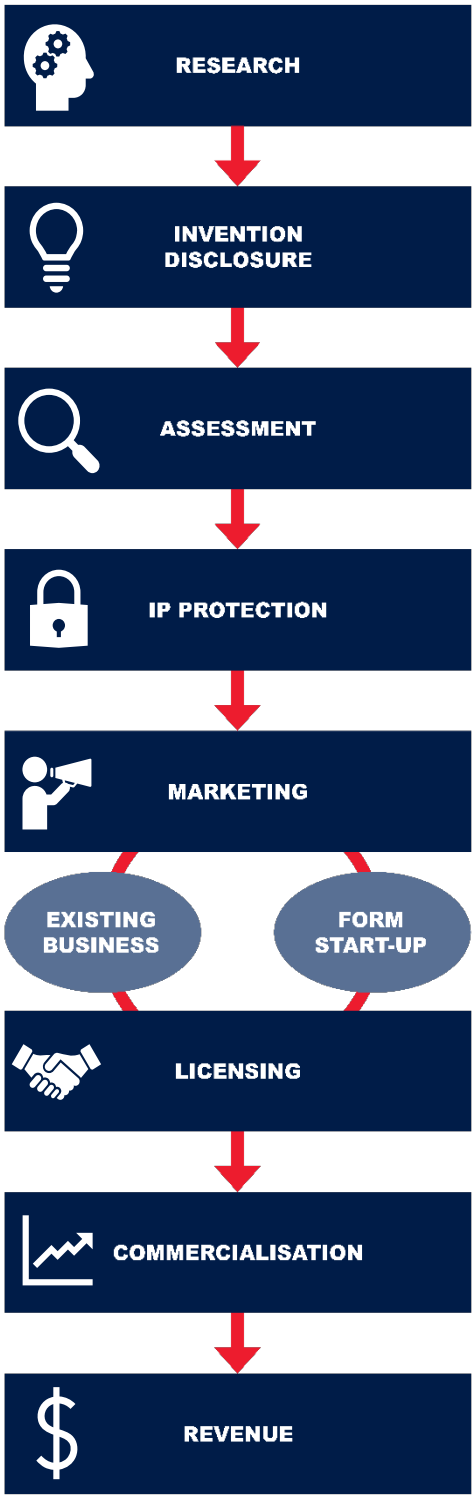
The University provides an Inventor Portal for online disclosure.

Assessment

Your IP Manager and Commercial Manager review the Invention Disclosure, conduct patentability review, and analyse the market and competitive technologies to determine the invention's commercialisation potential.

This evaluation process will guide the strategy on whether to focus on releasing the invention through publication for public good, or licensing to an existing company or a new business start-up.

Although an invention may fit the criteria for being patentable, novel and inventive, it may not have commercial justification to proceed, or it may be difficult to differentiate from or determine benefit compared to existing technologies. In cases where a decision is made not to patent, we recommend publishing the invention for public good in a high impact journal.



Intellectual Property protection

Safeguarding IP with protection through patents, plant breeder's rights, secret know-how and copyright is crucial to fostering an innovation because it creates a proprietary position during which others cannot use the invention. This provides time to invest in getting a technology to market.

Following agreement between ICS and the inventors, ICS oversees the patent application process in close collaboration with inventors and external patent attorneys.

Marketing

The Commercial Manager works with the inventors to identify companies that have the expertise, resources, and business networks to bring the technology to market.

This may involve marketing to an existing company or a start-up.

The inventors' active involvement is essential as the inventors are the experts and can dramatically help facilitate the marketing process.

We are committed to selecting licensees who have the greatest potential to commercialise the technology.

Licensing

Once a licensee is identified, ICS will negotiate and execute a Licence Agreement. A Licence Agreement is a contract between the University and a third party in which the University's rights to a technology are licensed, without relinquishing ownership, for fair consideration (e.g., upfront fee, milestone payments, royalties) and other benefits.

A Licence Agreement is used with both a new start-up business or with an established company. A fee-based option agreement is sometimes used to enable a third party to evaluate the technology and its market potential for a limited time, prior to deciding about licensing.

Commercialisation

The licensee continues the advancement of the technology and makes other business investments to develop the product or service. This step may entail further development, regulatory approvals, sales and marketing support, training, and other activities.

Revenue

Licence revenue is distributed according to the University's IP Policy. For a patented invention, typically:

- a third of net revenue is distributed to the originators of the invention;
- a third to the originator's School or administrative unit, as agreed by the Executive Dean of the relevant Faculty; and
- a third to the Division of Research and Innovation for strategic investment in research.

Research

Will I be able to publish the results of my research and still protect the commercial value of my intellectual property?

Yes, but since patent rights are affected by these activities, it is best to submit an Invention Disclosure (discussed in next section) well before communicating or disclosing your invention to people outside the University of Adelaide community.

There are significant differences between Australia and other countries as to how early publication affects a potential patent. Once publicly disclosed (published or presented in in any other form), an invention may have restricted or minimal potential for patent protection outside of Australia. Be sure to inform our IP Manager of any imminent or prior presentation, lecture, poster, abstract, website description, research proposal submission, dissertation/thesis, publication, or other public presentation including the invention.

May I use material or intellectual property from others in my research?

Yes, but it is important to document carefully the date and conditions of use so the University can determine if this use may influence the ownership and license rights of your subsequent research results. If you wish to obtain materials from outside collaborators, an incoming Material Transfer Agreement (MTA) is required. Contact our Contract Management team to execute an incoming MTA.

Will I be able to share materials, research tools or intellectual property with others to further their research?

Usually (see research limitations), however it is important to document items that are to be shared with others and the conditions of use. If you wish to send materials to an outside collaborator, an outgoing MTA is required for this purpose. It may also be necessary to have a Confidentiality Agreement completed to protect your research results or intellectual property.

We can assist you in completing outgoing MTAs where University IP may be shared or disclosed and arrange for Contract Management to execute any CDA.

What agreements could limit my future research?

Any agreement with an industry sponsor, or CAT2 or CAT3 grant, could restrict your use of what was created under those projects and assign a portion or all ownership to the sponsor. Work closely with the respective contracting group to understand:

- Who will own the project outcomes?
- Who will own the deliverables?
- Who can use the project outcomes or deliverables and for what purpose?

It is incredibly important to clearly articulate the research project, expected project outcomes and deliverables, as the sponsor may have rights to these and they can only be determined by the words in the agreement.

The University will always ask for use in further research, teaching and publication. Confidentiality obligations could prevent these activities without approval of the funding partner. Future research can also be limited to only other academic institutions.

If background IP, meaning technology, methods or other information that is confidential to the University researcher, is being used in a project, it should be disclosed and the rights to use it agreed up front. If it is patented IP, we will engage on appropriate licensing terms.

When receiving material to conduct your research, check what you are allowed to use the material for, who will own the results and what rights are provided to use the results. These can sometimes be very restrictive and give automatic rights or option over rights to the provider of anything created using the incoming material.

What about consulting?

When researchers enter into Consulting Agreements, they are performing an activity that is not anticipated to create new know-how or IP. Examples would be sample testing or product validation.

Researchers who enter in to Consulting Agreements should familiarise themselves with the University's Research, Grants, Contracts and Consultancies Policy.

The researcher is expected to ensure the terms of the consulting arrangement are consistent with University policies and guidelines, including those related to pricing, IP ownership, employment responsibilities and use of IP.

Invention Disclosures

What is an Invention Disclosure?

An Invention Disclosure is a written description of your invention or development that is submitted to ICS via our online Inventor Portal.

After we have received your Invention Disclosure, a Commercial Manager will contact you to discuss the invention and its potential commercial applications. Based on the disclosure, we may generate a non-confidential description of your invention to assist in marketing. Once a potential partner has been identified, and Confidentiality Agreements have been signed, more detailed exchanges of information can be made.

When should I complete an Invention Disclosure?

You should complete an Invention Disclosure whenever you feel you have discovered something unique with possible commercial value. This should be done well before presenting the discovery through publications, poster sessions, conferences, press releases, or other communications. Once publicly disclosed (i.e., published or presented in some form), an invention may have restricted or minimal potential for patent protection outside of Australia.

Why should I submit an Invention Disclosure?

When you disclose your invention to ICS, it starts the process that could lead to the commercialisation of your technology. This may involve beginning the legal protection process and working to identify outside development partners. If government or other third-party funding was used for your research, you may be required to file a prompt disclosure, which will be reported to the sponsoring agency. Similar requirements may exist for other sponsored projects.

How do I know if my discovery is an invention?

You are encouraged to submit an Invention Disclosure for all inventions and developments that you feel may solve a significant problem and/or have significant value. If you are in doubt, contact us to discuss the invention and strategies for commercialisation.

How do I submit an invention disclosure?

Invention disclosures can be submitted to ICS using our online Inventor Portal.

Please note: you must be connected to the University's network to access the Portal.

Step 1: Requesting an account for new users

If you already have an account go straight to **Step 2**.

1. Go to the Inventor Portal
2. Click on **Request account**
3. A **Request New Account** pop-up will appear asking you to enter your email address to receive a verification email. Enter your University of Adelaide email and click **Submit**.
4. Check your inbox for a verification email which contains a link to create your account.
5. Click on the link to access the **Create Account** page.
6. Complete the fields and click on **Create an Account**.
7. Your account request will be sent to our Commercialisation team for approval.
8. Once your account has been approved you will receive a confirmation email.

Step 2: Submitting Part A of the invention disclosure form

1. After being granted an account, go to the Inventor Portal
2. Follow the prompts to complete **Part A** of the form and submit.

Ownership of Intellectual Property

What is an Intellectual Property?

Intellectual Property (IP) includes inventions and/or material that may be protected under the patent, trademark and/or copyright laws, and sometimes by contract.

What is the University of Adelaide's policy on ownership of inventions?

Ownership is outlined in the University's Intellectual Property Policy.

As a rule, the University owns inventions made by its employees while acting in the course of their employment.

Can a student contribute to an invention?

As per the University of Adelaide's IP Policy

1. Students own IP created in the course of their studies, except when a student elects to participate in a project that:
    a. builds upon pre-existing University IP; or
    b. is being carried out for, or in conjunction with, an external third party (e.g. a company), whether under a separate formal agreement or not.
2. In cases where 1 (a) and/or (b) apply, the University is entitled to, and asserts ownership of, the IP (in order to protect interests relating to University IP or obligations to third parties) through a Student IP Deed Poll *(is there a link for students to view the Deed Poll?).* Once the Deed Poll is signed, the student will have the same rights and responsibilities as a University staff member in relation to that IP, including entitlement to a share in Net Revenue received by the University.

Supervisors and students can contact our IP Manager for further advice.

Should I list visiting scientists or scientists at other institutions on my Invention Disclosure?

Yes. All contributors to the ideas leading to a discovery should be mentioned in your disclosure, even if they are not University employees. ICS, along with legal counsel, will determine the rights of such persons and institutions. It is prudent to discuss all working relationships with us (preferably before they begin), to understand the implications for any subsequent inventions.

Should I list all funding sources that contributed to the Invention Disclosure?

Yes. Although the sponsor may have had nothing to do with the invention, the agreement may state that the sponsor will be a part owner of the invention. If that is the case, we will need to come to an agreement with the sponsor on how to progress the invention.

Assessment

How do you assess Invention Disclosures?

Our IP and Commercial Managers examine each Invention Disclosure to review:

- The novelty of the invention, protectability and marketability of potential products or services.
- Relationship to related intellectual property.
- Size and growth potential of the relevant market.
- Amount of time and money required for further development.
- Pre-existing rights associated with the intellectual property.
- Potential competition from other products or technologies.

How do you decide whether to commercialise with a traditional or an “open source” licence for software?

There may be situations where a funding body requires outcomes of the research to be made available for public good through open source licensing or publication. Where this has been agreed, we will work with Legal and Risk to develop a template licence fit for purpose.

Is an invention ever assigned to an Inventor?

If we decide not to pursue patent protection or we have pursued patent protection but there has not been commercial interest, the University may waive the invention back to the inventor(s) under commercial terms. Assigning the invention to the inventors is at the discretion of the University and has several considerations and more detail can be found in the University IP Policy, including whether it would be in the best interest to society to have the invention published and freely available to all.

Intellectual Property protection

What is a patent?

In Australia, a patent is a legally enforceable right for a device, substance, method or process. It provides you with the right to stop others from manufacturing, using and/or selling your invention in Australia without your permission. A patent also lets you license to someone else to exploit (e.g. manufacture, use and sell) your invention on agreed terms.

What type of subject matter can be patented?

Patent protection can be applied to a wide range of inventions. In addition to traditional inventions, the protection also covers computer-related inventions, business methods, biological inventions, microorganisms and other biological materials.

What cannot be patented?

You cannot patent human beings or the biological process for their generation, artistic creation, mathematical models, plans, schemes or other purely mental processes.

Generally, it is not the discovery that is patentable but the useful application of the discovery.

What is IP Australia?

IP Australia is the Australian Government agency that administers intellectual property rights relating to patents, trademarks, designs and plant breeder's rights.

What is the definition of an inventor on a patent and who determines this?

An inventor is a person who takes part in the conception of the ideas in the patent claims of a patent application. Not all authors on a publication may be inventors on a corresponding patent. Inventors are not the people who worked on the invention but those who had creative input in solving a problem that was not obvious to others in the field.

An employer or person who only provides money or equipment to build or practice an invention is not an inventor. Inventorship is a legal issue and may require an intricate legal determination by a patent attorney.

Who is responsible for patenting?

Our Commercialisation team contracts external patent firms for IP protection, assuring access to patent specialists in diverse technology areas. Inventors work with the patent attorneys in drafting the patent applications and responses to worldwide patent offices. Our IP Manager will help with the selection and over-sight of the external patent attorney.

Why does the University protect some intellectual property through patenting?

Patent protection is often a requirement of a potential commercialisation partner (licensee) because it can protect the commercial partner's often sizable investment required to bring the technology to market.

Due to the expense and the length of time required to obtain a patent, patent applications are not possible for all University intellectual property.

We carefully review the commercial potential for an invention before investing in the patent process.

However, because the need for commencing a patent filing usually precedes finding a licensee, we look for creative and cost-effective ways to seek early protection for as many promising inventions as possible.

Who decides what is protected?

ICS and the inventor(s) consider relevant factors in making recommendations about filing patent applications. Patents are primarily a tool to maximise the commercial value of an invention so the Commercial Manager makes the final decision whether to file a patent application or seek another form of protection.

Will the University initiate or continue patenting activity without an identified licensee?

Often the University accepts the risk of filing a patent application before a licensee has been identified. When the University rights have been licensed to a licensee, the licensee generally pays the back and future patenting expenses. At times we will decline further patent prosecution after a reasonable period (usually at 30 months) of attempting to identify a licensee, or if it's determined the University cannot obtain reasonable claims.

What if I created the invention with someone from another institution or company?

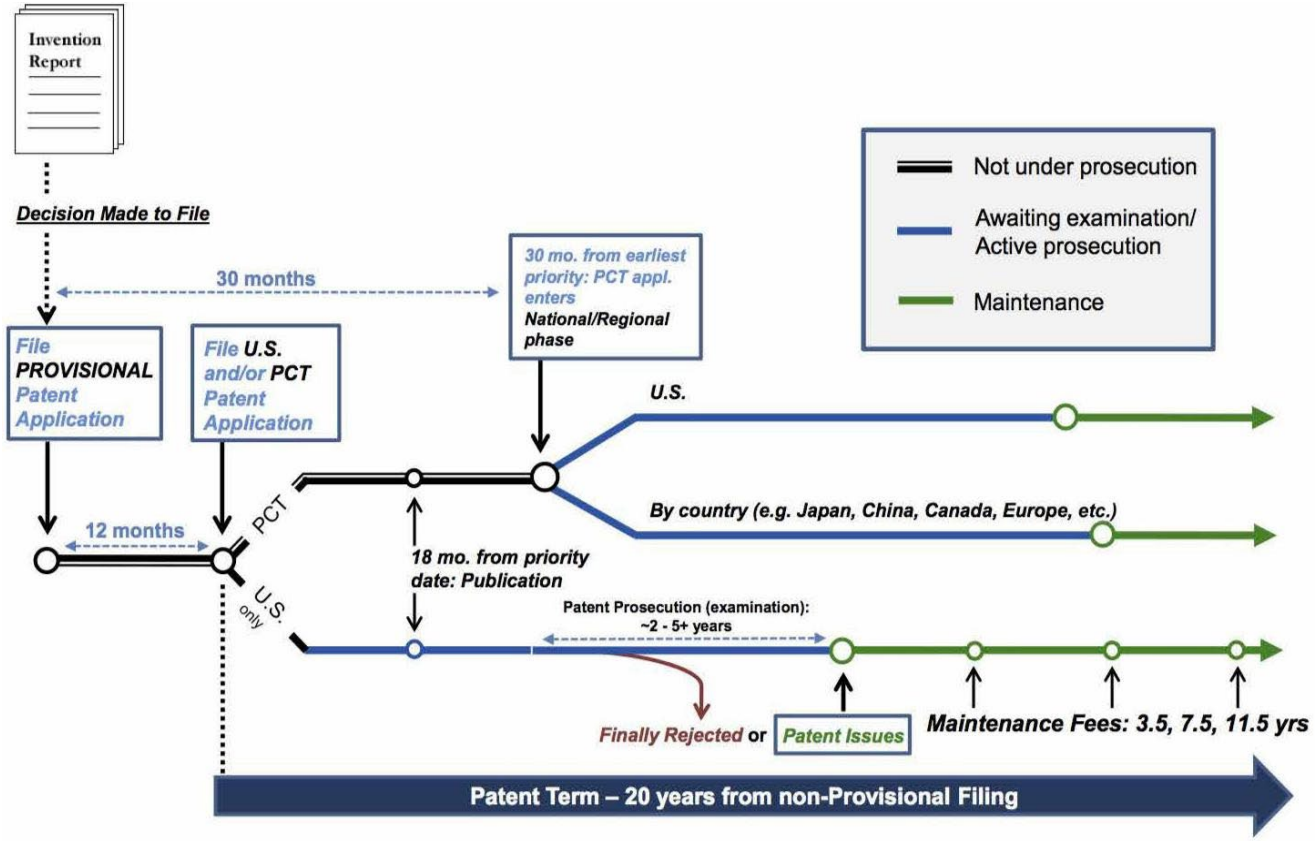
If you created the invention under a sponsored research agreement with a company, the Commercial Manager will need to review that agreement to determine ownership and other rights associated with the contract to determine the next steps.

Should the technology be jointly owned with another academic institution, the Commercial Manager will usually enter into an "inter-institutional" agreement that provides for one of the institutions to take the lead in protecting and licensing the invention, sharing of expenses associated with the patenting process and allocating any licensing revenue.

If the technology is jointly owned with another company, the Commercial Manager will work with the company to determine the appropriate patenting and licensing strategy.

What is the patenting process?

Patent applications are drafted by a patent attorney who understands the field. The patent attorney will generally ask the inventor to review an application before it's filed and will ask questions about inventorship of the application claims. At some stage of the application, the IP Manager may ask the inventor(s) to sign an Inventor's Declaration and/or Confirmatory Assignment, which evidences the inventor's duty to assign the patent to the University. The patent process is illustrated in the diagram below.



Adapted from UCLA's Office of Intellectual Property & Industry Sponsored Research

Is there such a thing as a provisional patent?

No. However, there is a provisional patent application, which is described below.

What is the difference between a provisional patent application and a standard patent application?

In Australia a provisional patent application can provide an inexpensive way to signal your intention to file full patent application later.

While it does not provide the protection of a full patent, it gives up to 12 months to consider all options before proceeding with a patent application. A priority date establishes who the first person to file a new invention is, so can be extremely valuable if there is much research happening in the same area.

Within that 12-month period, the provisional patent application can also be withdrawn, thus the information remains unpublished (noting that the information could have been published in a journal or presented).

What is different about foreign patent protection?

Foreign patent protection is subject to the laws of each individual country, although in a general sense the process works much the same as it does in the Australia.

In foreign countries, however, an inventor will lose any patent rights if he or she publicly discloses the invention prior to filing the patent application. Australia and the US have a one-year grace period after publication or public disclosure in any form during which a complete patent application (not a provisional patent application) may be filed.

ICS requires a very compelling case to take forward any Invention Disclosure that has been previously published.

Is there such a thing as an international patent?

Although an international patent does not exist, an international agreement known as the Patent Cooperation Treaty (PCT) provides a streamlined filing procedure for most industrialised nations. For Australian applicants, if you are wanting to base your PCT application on a provisional application you will need to submit your PCT application within 12 months of filing your provisional patent application.

The PCT application must later be filed in the national patent office of any country in which the applicant wishes to seek patent protection. Typically, 30 months after the initial priority date.

The PCT provides two advantages.

1. It delays the need to file costly foreign applications, which can range from $5-$10k per country) until the 30-month date, often after an applicant has the opportunity to further develop, evaluate and/or market the invention for licensing.
2. The international preliminary examination often allows an applicant to simplify the patent prosecution process by having a single examiner speak to the patentability of the claims, which can save significant costs in prosecuting foreign patent applications.

An important international treaty called the Paris Convention permits a patent application filed in a second country (or a PCT application) to claim the benefit of the filing date of an application filed in a first country. However, pursuant to this treaty, these so-called “convention applications” must be filed in foreign countries (or as a PCT) within one year of the first filing date of the Australian application.

What does it cost to file for and obtain a patent?

Filing an Australian provisional patent application typically costs anywhere from $5-$10k.

Filing a PCT patent application typically costs about $15k.

To obtain an issued patent may require an additional $5-$10k for filing and a further $5-$10k for patent prosecution per country.

In addition, most patents have renewal fees starting from the 3rd or 4th year, which average out to about $1k/year per patent.

What is the timeline of the patenting process and resulting protection?

Currently, the average patent application is pending for about five years, though inventors in the biotech and computer fields should plan on a longer waiting period.

Once a patent is granted, it is enforceable for 20 years from the complete filing of the application that resulted in the patent, assuming that renewal fees are paid.

Copyright

What is a copyright and how is it useful?

Copyright is a form of protection provided by the laws of Australia to the authors of "original works of authorship." This includes literary, dramatic, musical, artistic, and certain other intellectual works as well as computer software. This protection is available to both published and unpublished works.

The Copyright Act generally gives the owner of copyright the exclusive right to conduct and authorise various acts, including reproduction, public performance and making derivative works. Copyright protection is automatically secured when a work is fixed into a tangible medium such as a book, software code, video, etc.

The University's Copyright Compliance Policy describes the applicable rules for copyrightable works.

What is a derivative work?

A "derivative work" is a work based upon one or more pre-existing works, such as a translation, musical arrangement, dramatisation, fictionalisation, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a "derivative work."

The owner of a copyright generally has the exclusive right to create derivative works.

How can I learn more about University copyright policies?

We recommend that you begin by reviewing material on the University's Copyright Compliance Policy and visiting the University's Copyright Advice webpage.

If you have additional questions about a potentially copyrightable invention, please contact us.

If you have questions about other copyright policies, please contact the University's Copyright Coordinator at copyright@adelaide.edu.au.

Marketing

How does ICS market my inventions?

Commercial Managers use many sources and strategies to identify potential licensees and market inventions such as:

- Leveraging existing relationships of the inventors, staff, and other researchers with industry.
- Market research to assist in identifying prospective licensees.
- Promoting inventions on our website and technology matching platforms.
- Creation of technology flyers
- Publications
- Presentations.

How are most licensees found?

Research and consulting relationships of inventors are often a valuable resource for finding licensees. Licensees are also identified through existing relationships/networks of the Commercialisation team. Our licensees often license more than one technology from the University. We attempt to broaden these relationships through contacts resulting from website inquiries, market research, and the cultivation of existing licensing relationships.

How long does it take to find a potential licensee?

It can take months and sometimes years to locate a potential licensee, depending on the attractiveness of the invention, its stage of development, competing technologies, and the needs of the market. Most university inventions tend to be in the very early stage of the development cycle and thus require substantial commercialisation investment, making it difficult to attract a licensee.

How can I assist in marketing my invention?

Your active involvement can improve the chances of matching an invention to a company. Your research and consulting relationships are often helpful in both identifying potential licensees and technology champions within companies. Once interested companies are identified, the inventor is the best person to describe the details of the invention, its technical advantages, and how some of the risks in the development cycle might be reduced.

Can there be more than one licensee?

Yes, an invention can be licensed to multiple licensees, either non-exclusively to several companies; or exclusively to more than one company, each for a unique field-of-use (application) or geography.

Licensing

What is a licence?

A licence is a permission that the owner or controller of intellectual property grants to another party, usually under a Licence Agreement.

What is a Licence Agreement?

Licence Agreements describe the rights and responsibilities related to the use and exploitation of IP developed at the University. University Licence Agreements usually stipulate that the licensee should diligently seek to bring the IP into commercial use for the public good and provide a reasonable return to the University.

How is a company chosen to be a licensee?

A licensee is chosen based on its ability to commercialise the technology for the benefit of the general public. Sometimes an established company with experience in similar technologies and markets is the best choice. In other cases, a start-up company may be a better option. It is rare for the University to have multiple potential licensees bidding on an invention.

What can I expect to gain if my IP is licensed?

A share of any financial return from a licence is provided to the inventor(s). Under the Intellectual Property Policy, one-third of the net revenue generated from the licensing is distributed to the Originator.

Additionally, most inventors enjoy the satisfaction of knowing their inventions are being deployed for the benefit of the general public. New and enhanced relationships with businesses are another outcome that can augment one's teaching, research and consulting. In some cases, additional sponsored research may result from the licensee.

What is the relationship between an inventor and a licensee, and how much of my time will it require?

Many licensees require the active assistance of the inventor to facilitate their commercialisation efforts, at least in the early stages of development. This can range from infrequent, informal contacts, to a more formal consulting or collaborative research relationship. Working with a new business start-up can require substantially more time, depending on your role in or with the company, and your continuing role within the University. Your participation with a start-up is governed by University conflict of interest policies.

Commercialisation

What revenues are generated for the University if commercialisation is successful?

Most licences have licensing fees that can be modest (for spin-outs or situations in which the value of the licence is deemed to warrant a modest licence fee), or can reach hundreds of thousands of dollars. Royalties on the eventual sales of the licensed products can generate revenues, although this can take years to occur. Equity, if included in a licence, can yield returns, but only if a successful equity liquidation event (public equity offering or a sale of the company) occurs. Most licences do not yield substantial revenues.

A recent study of licences at U.S. universities demonstrated that only 1% of all licences yield over $1m. However, the rewards of an invention reaching the market are often more significant than the financial considerations alone.

What will happen to my invention if the spin-out company or licensee is unsuccessful in commercialising the technology? Can the invention be licensed to another entity?

Licences typically include performance milestones that, if unmet, can result in termination of the licence. This termination allows for subsequent licensing to another company.

What approvals are needed for the University to take equity in a spin-out?

If a researcher intends to start a company and license IP from the University, approvals from Head of School, Executive Dean and the Division of Research and Innovation are required as there may be impacts on inventor benefit as per the IP Policy, Conflict of Interest and Conflict of Commitment related to University duties. Approval is also required from the Vice Chancellor and President to take equity in a spin-out company.

What other types of agreements may be involved in commercialisation?

- **Non-Disclosure Agreements (NDAs)** or **Confidential Disclosure Agreements (CDAs)** are often used to protect the confidentiality of an invention during evaluation by potential licensees. NDAs also protect proprietary information of third parties that University researchers need to review in order to conduct research or evaluate research opportunities.
- **Material Transfer Agreements (MTAs),** used for incoming and outgoing materials at the University, are administered by the Commercialisation team where there is University IP attached to the material. Business Development can assist with all other MTAs. These agreements describe the terms under which University researchers and outside researchers may share materials, typically for research or evaluation purposes. Intellectual Property rights can be endangered if materials are used without a proper MTA.
- **Multi-Institutional Agreements** describe the terms under which two or more institutions (generally universities) will collaborate to assess, protect, market, license, and share in the revenues received from licensing jointly owned IP. These can also be called Inter-Institutional or Collaborative Research Agreements.
- **Letter Agreements**, including **Memorandum of Understanding**, are entered into with companies (and sometimes individuals) wishing to evaluate the technology. The agreement provides the company a time-limited period to negotiate a Licence or Option Agreement while conducting due diligence or speaking with investors and other potential partners.
- **Option Agreements** are entered into with companies wishing to evaluate the technology prior to entering into a full Licence Agreement. The option agreement provides the company with a time-limited right to obtain a full licence by “exercising” the option to obtain the licence.
- **Research Agreements** describe the terms under which sponsors provide research support to the University.

Revenue

How are licence revenues distributed?

The Commercialisation Unit is responsible for managing the expenses and revenues associated with technology agreements. Per the University IP Policy, revenues from licence fees, royalties and equity, minus expenses including patent costs, are shared with inventors.

What are the tax implications of any revenues I receive from the University?

Licence revenues may be taxed as income. You should consult a tax advisor for specific advice.

How are inventor revenues distributed if there are multiple inventors?

The inventors' share of royalties and other income under the licence is equally divided amongst all inventors, unless all inventors collectively agree to an uneven distribution, in writing. There is a Distribution of Benefits Agreement that the inventors can sign if they agree to an uneven distribution.

How is equity from a licence distributed?

When University equity is liquidated by the University's Finance Office, the resulting funds are distributed as per the IP Policy. Where an inventor takes shares in a spin-out Company or offered direct ownership in a Company, ICS and the inventor may separately agree that the inventor has been deemed to have taken this return in advance.

Contact us

To be connected with a Commercial Manager, contact us on:

E: commercialisation@adelaide.edu.au or **T:** +61 8 8313 1336