

Intellectual Property as a Public Asset: Maximising Value & Impact

2021/02

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Webinar housekeeping

- All attendees will be on mute and their cameras turned off for the entire webinar.
- We have BD tech support live to assist with any technical issues.
- Use the chat function for any comments/technical issues.
- Use the Q&A function for specific questions related to the webinar content - Questions will be addressed at the end of the webinar.
- There will be a post webinar survey link sent at the end of the webinar, we value attendee feedback, presentation slides will also be sent to all attendees.
- We will also have a QR code linking to our feedback survey towards the end of the presentation so you can provide instant feedback.

Disclaimer

The information contained in this presentation is intended as general commentary and should not be regarded as legal advice. Should you require specific advice on the topics or areas discussed please contact the presenter directly.

Introduction



Contents

Intellectual Property Breakdown	5
Copyright	7
Trade Marks	8
Patents	9
Designs	10
Confidential Information / Trade Secrets	11
Whole of Victorian Government Intellectual Property Policy	12
IP Policy Intent	14
IP Policy Principles 1-6	15
Creative Commons	16
IP Policy Principles 7-12	19
Government-Specific Rights	24
Copyright	25
Patents and Designs	28
Case Studies	29



Intellectual Property Breakdown

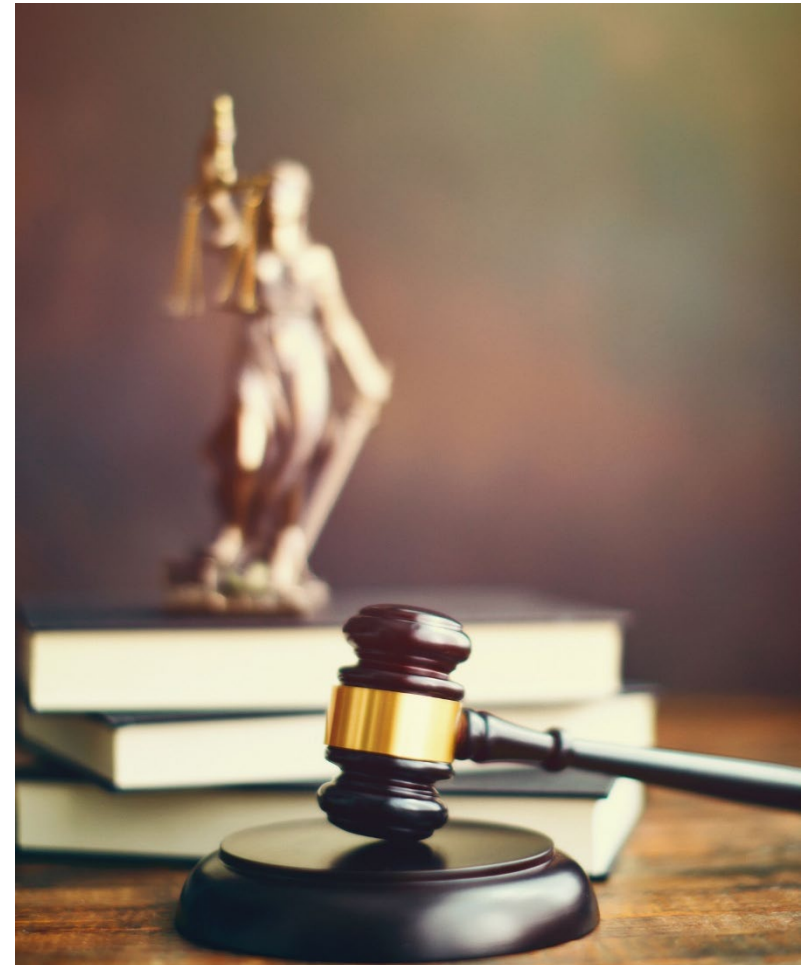


Intellectual Property Breakdown

What is Intellectual Property?

Exclusive rights to the results of creative and intellectual effort, protected by common law or statute, in areas such as:

- Trade Marks
- Copyright
- Design
- Patents
- Circuit layouts
- Plant varieties
- Domain Names
- Confidential Information
- Business reputation (passing off and trade practices)



Copyright

Copyright Act 1968 (Cth) (Copyright Act)

Protects the original expression of ideas (not the underlying concepts / information)

Key facts

- No registration system in Australia – rights arise as soon as the work is reduced to ‘material form’.
- Duration of protection is usually life of author plus 70 years or 70 years from date of first publication.
- Covers various works including: literary works, computer programs, compilations, artistic works, dramatic works, musical works, films, sound recordings, broadcasts, published editions.
- Infringed when you use important, essential or distinctive part of the original material.





Trade Marks

Trade Marks Act 1995 (Cth)

Trade marks are signs used in the course of trade to distinguish the goods or services of one trader from another:

Can be any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent, or any combination of these.

Key facts

- Statutory protection afforded by registration with IP Australia.
- Registration lasts for 10 years and can be renewed indefinitely.
- Scope of protection defined by goods and services specified by the registration, which are divided into 45 classes.
- Limited protection available for unregistered marks – passing off, breach of trade practices legislation.





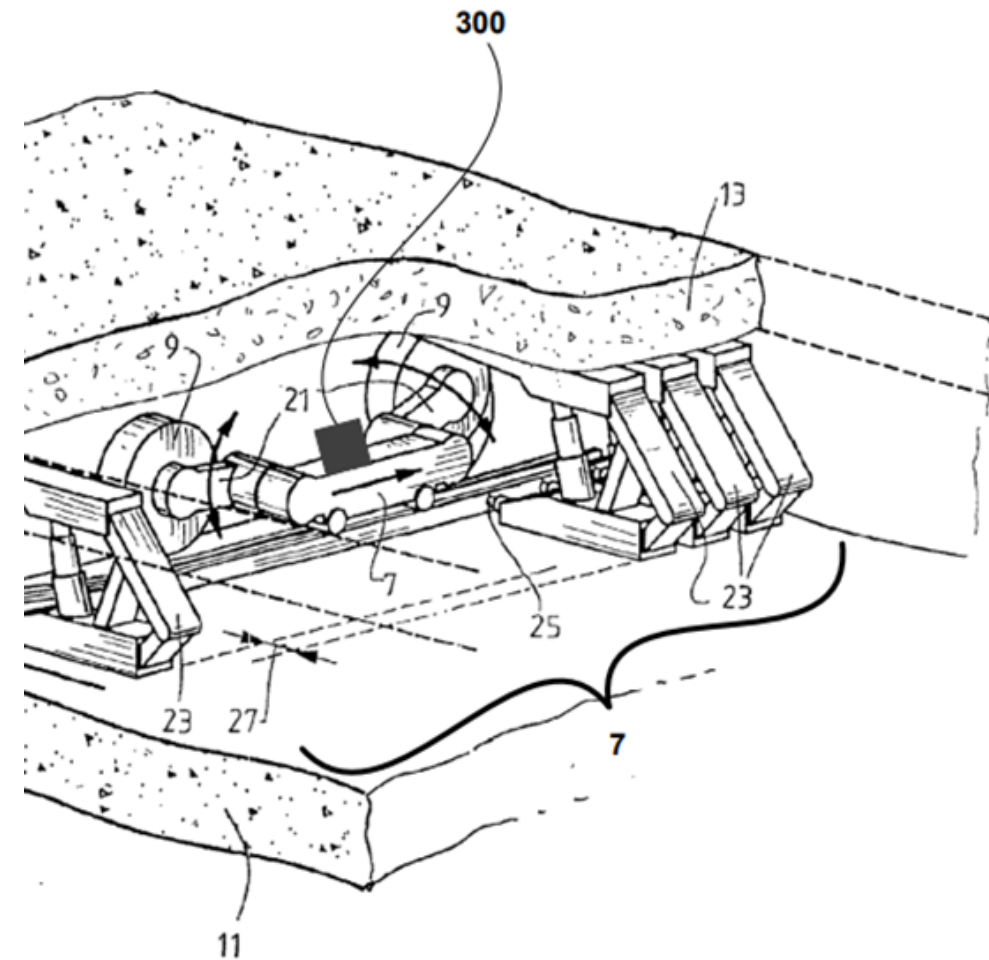
Patents

Patents Act 1990 (Cth)

Protects a device, substance, method or process that is new, inventive and useful.

Key facts

- Statutory protection afforded by registration with IP Australia.
- Three types:
 - Standard patents: 20 years
 - Innovation patents: 8 years (lower threshold but being phased out)
 - Pharmaceutical patents: 25 years.
- Must file application **before** disclosure.



CSIRO Patent No. 201600780: Mining Machine



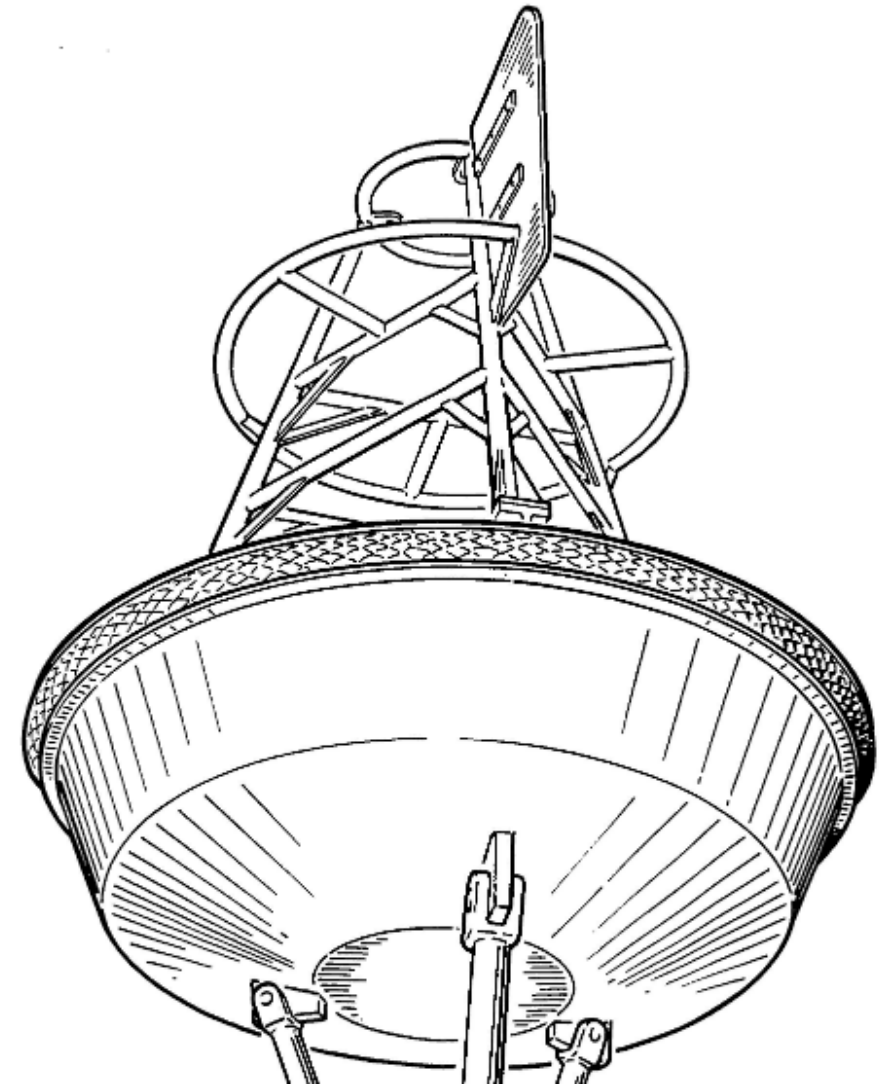
Designs

Designs Act 2003 (Cth)

Protects the features of shape, configuration, pattern or ornamentation which give a product a unique appearance.

Key facts

- Statutory protection afforded by registration with IP Australia.
- Protects the visual aspects of a design as applied to a product – not functionality.
- Designs must be new and distinctive.
- Protection lasts 5 + 5 years only.
- Must file application **before** disclosure.



CSIRO Design Registration No. 100143: Buoy



Confidential Information / Trade Secrets

Equitable or contractual right to enforce an obligation on a third party to keep information confidential

Key facts

- No system of registration.
- Information must be:
 - Secret;
 - Valuable; and
 - Imparted in circumstances importing an obligation of confidence.
- Protected by:
 - Contract: Confidentiality and Non-Disclosure Agreements;
 - Clearly specifying when information is confidential; and/or
 - Physical and technological barriers to access/disclosure.



Whole of Victorian Government Intellectual Property Policy



Whole of Victorian Government Intellectual Property Policy

Three components:

- **IP Policy Intent and Principles (IP Policy)** - the State's framework for the ownership and management of its IP, and for its use of IP belonging to other parties.
- **IP Policy Guidelines** – to assist the Victorian Public Service with the Policy's implementation.
- **IP Policy operational tools**

Department of Treasury and Finance - <https://www.dtf.vic.gov.au/funds-programs-and-policies/intellectual-property-policy>

For assistance, email : IPpolicy@dtf.vic.gov.au

What agencies are covered?

IP Policy Guidelines, Chapter 1.6:

“The IP Policy and these Guidelines apply to all agencies (that is, all departments and public bodies) of the State. ‘Department’ and ‘Public body’ are defined in the Financial Management Act 1994. Public bodies include State business corporations and statutory authorities.”



IP Policy Intent

“The State grants rights to its intellectual property, as a public asset, in a manner that maximises its impact, value, accessibility and benefit consistent with the public interest.

The State acquires or uses third party intellectual property in a transparent and efficient way, while upholding the law and managing risk appropriately.”



IP Policy Principles

Management of State owned Intellectual Property

1. The State manages its intellectual property in ways that are consistent, transparent and accountable.
2. The State grants rights to its intellectual property with the **fewest possible restrictions**.
3. The State may exercise its intellectual property rights restrictively for reasons of privacy, public safety, security and law enforcement, public health, commercialisation and compliance with the law.
4. The State owns intellectual property created by its employees in the course of their employment.
5. The State manages the moral rights of creators as required under the *Copyright Act 1968* (Cth).
6. The State responds to breaches of its intellectual property rights where appropriate in order to maintain its reputation or the value of its intellectual property.

(emphasis added)



Creative Commons

Public Access to Copyright Material

- According to the IP Guidelines, where appropriate, agencies should prioritise making their copyright material publicly accessible, for example, reports, policy papers, budget papers, information on Government websites, etc.
- Making material accessible should always be subject to relevant considerations such as privacy, public safety, security and law enforcement, public health and whether the material contains trade secrets or culturally sensitive information.
- Material should be released under terms allowing flexible public re-use without further permissions, the IP Guidelines recommend doing so under a **Creative Commons** licence.

What is Creative Commons

- Standard international copyright licences that have been developed for use by the owners of copyright material, including governments.
- Creative Commons licences are applied by the licensor when the work is published via automated online tools – see <https://creativecommons.org.au/>

Creative Commons

The CC licences available are as follows:

Image	Label	Acronym	Licence conditions
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Government IP Policy
Department of Treasury and Finance
Email: IPpolicy@dtf.vic.gov.au



IP Policy Principles

State Commercialisation of intellectual property

7. The State is not in the business of commercialising intellectual property, and does not create intellectual property in order to generate a financial return.
8. An agency may commercialise, or apply the Cost Recovery Guidelines to, intellectual property if:
 - a) it has an explicit statutory function to do so; or
 - b) it has been explicitly authorised by the Treasurer to do so because of a clear net benefit to the Victorian community.



IP Policy Principles

Procurement of Goods and Services

9. When State procurement may result in intellectual property being generated, the State:
- a) addresses in an agreement any rights to intellectual property (including pre-existing intellectual property) that may arise as a consequence of the procurement;
 - b) secures a licence to the intellectual property, only to the extent necessary to achieve the purposes of the procurement; and
 - c) only acquires ownership of the intellectual property if a licence is not adequate in the circumstances.

(emphasis added).



IP Policy Principles

Funding and grants towards the development of intellectual property

10. When the State provides a grant or similar funding for an identified purpose or project, the State:

- a) addresses in an agreement any rights to intellectual property (including pre-existing intellectual property) that may arise as a consequence of the grant or funding;
- b) does not secure a licence to the intellectual property unless there is a stated purpose for doing so, and then only to the minimum extent necessary to achieve that purpose;
- c) if a licence would not be adequate in the circumstances, acquires ownership of the resulting intellectual property; and
- d) ensures that ownership of the intellectual property is able to be assigned to or by the State if the intellectual property is not used by the recipient for the purpose of the grant or funding within a reasonable time.

(emphasis added).



IP Policy Principles

Use of intellectual property belonging to others

11. The State deals with third party intellectual property in a manner that:

- a) avoids infringing the intellectual property rights of others and complies with the law; and
- b) provides equitable remuneration to intellectual property owners (whether directly or through collecting societies) in a manner consistent with the responsible spending of public moneys.



IP Policy Principles

Identification and recording of intellectual property

12. Agencies of the State identify and record intellectual property in their possession, where that intellectual property:

- a) involves statutory registration and renewal processes;
- b) is critical to a deliverable or core function of the agency; or
- c) requires active risk management.



Government-specific rights





Copyright – Crown Ownership

Pursuant to sections 176 and 177 of the Copyright Act, the Commonwealth, a State or a Territory owns copyright in material if it is:

- created by, or under the direction or control of, the Commonwealth, State or Territory; or
- first published by, or under the direction or control of, the Commonwealth, State or Territory,

unless there is an agreement between the Commonwealth, State or Territory and another party, such as a contractor, which provides otherwise.

There is some uncertainty as to how far these sections apply to statutory corporations and authorities of the Commonwealth or States.

Best practice is to clearly stipulate who will own the IP in the relevant contracts.



Copyright – Third Party IP

Pursuant to section 183 of the Copyright Act, the State may make use of third party copyright material without first obtaining permission from the owner, and without infringing copyright, provided that:

- the use / exploitation is for the services of the State; and
- the copyright owner (or a collecting society if one has been declared by the Commonwealth) is remunerated for the use (either before or after the use is made).

The definition of the ‘State’ under this legislation includes:

- the executive and all departments;
- all statutory bodies whose constituting statute provides that the body ‘represents the Crown’.

Other bodies are not clear, but can gain protection of section 183 if they receive a written authorisation from the General Counsel of the Department of Treasury and Finance under section 183.



Collecting Societies

What are collecting societies?

Not-for-profit organisations that license or administer certain uses of copyright material on behalf of their members (who are copyright owners). The licence fees are collected and distributed to members.

Under Section 183A of the Copyright Act, the government has ‘declared’ certain companies to be ‘relevant collecting societies’. The States are required to reach agreement with those companies for equitable remuneration, which allows individual departments and many statutory bodies to make copies of third party copyright material as long as those copies are for the services of the State.

At present, the ‘declared’ collecting societies are:

- **Copyright Agency Limited** – for copies of works (i.e. newspaper articles, journal articles and books); and
- **Screenrights** – for copies of sound recordings, films and broadcasts.

However, the agreements only cover limited uses, such as photocopying, printing and electronic saving. For other rights such as publishing or uploading to a website, the agency must reach terms with the copyright owner.

According to the IP Guidelines, agencies are encouraged to make direct arrangements with copyright owners in any event, rather than relying on section 183A.



Patents and Designs

In certain circumstances, the State may use / exploit a third party patent or design without first obtaining permission from the owner, and without infringing the patent / design, provided that:

- the use / exploitation is for the services of the State; and
- the owner is informed and remunerated for the use (either before or after the use is made).

Ss 163-165 of the *Patents Act 1990* (Cth) and ss 96-98 of the *Designs Act 2003* (Cth).

The definition of the 'Commonwealth or a State' under this legislation is wider than under the Copyright Act and includes an 'authority'.

Agencies are required to inform and remunerate on a case by case basis.



Case Studies



Pink Lady Apple



Picture by Kerry Raymond, available at https://commons.wikimedia.org/wiki/File:Pink_lady_apples,_Thulimbah,_Granite_Belt,_Queensland,_2015_02.jpg under a Creative Commons Attribution 4.0 licence. No changes were made. Full terms at <https://creativecommons.org/licenses/by/4.0/legalcode>



Universal Catheter Holding Device



Photo by [Piron Guillaume](#) on [Unsplash](#)

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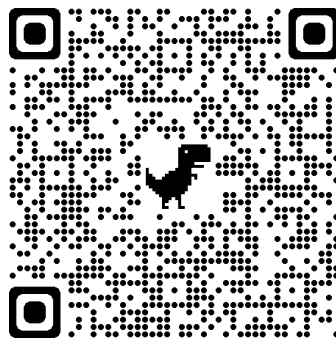
Feedback

Scan this QR code to provide instant feedback on the session.

Upcoming Victorian Government CPD Sessions

Session	Date	Presenter/s	CPD
Session 2: Investigating Corporate Entities,	<i>Friday 19 February</i>	Kylie Walsh & Danielle Nicholson – Russell Kennedy	1 Point <i>Substantive Law</i>
Session 3: The Coroners' Court – The 'Golden Rules' of The Jurisdiction	<i>Friday 26 February</i>	Ben Lloyd – Russel Kennedy	1 Point <i>Substantive Law</i>
Session 4: Divesting Leasehold Interests During the Lease Term & Social and Affordable Housing	<i>Friday 05 March</i>	Michael Dowling, Shaun Burmester, Emma Dunlevie, Samantha Taylor, Kate Bartlett & Melanie Young – Russell Kennedy	1 Point <i>Substantive Law</i>
Session 5: Ethics and Professional Development	<i>Friday 19 March</i>	Anna Hinder – Guest Speaker	1 Point in <i>Ethics</i>
Session 6: Making Defensible Administrative Decisions	<i>Friday 26 March</i>	Emma Turner – Russell Kennedy	1 Point <i>Substantive Law</i>

** All session will run from 11:00 am – 12:00 pm.



Register!

Scan this QR code to register and get more information on upcoming session.



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