

UNIVERSITY OF JOHANNESBURG



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OF
JOHANNESBURG

POLICY ON INTELLECTUAL PROPERTY

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RELATED DOCUMENTS

UJ Documents (e.g. Policies, Regulations, Guidelines, Contracts)	Other (e.g. laws, DoE and HEQC, directives, external guidelines)
<ul style="list-style-type: none">• UJ Vision, Mission and Values• UJ Strategy for Diversifying Income Resources• Agreement between UJ and DALRO	<ul style="list-style-type: none">• Constitution of SA Act 108 of 1996• Labour Relations Act 66 of 1995 and other Labour legislation

<p>(2005)</p> <ul style="list-style-type: none"> • UJ Conditions of Service • UJ Financial Policy 	<ul style="list-style-type: none"> • Copyright Act 98 of 1978
<p>Divisions, Constituents and/or Individuals Affected by the Policy</p>	<ul style="list-style-type: none"> • Council • All employees of UJ • Former employees of UJ • Students • Former students of UJ • Members of the Executive Council • Head: Office for Intellectual Property • Executive Director Research and Innovation • DVC Research Innovation and Advancement • Bursary Donors and sponsors
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1. INTRODUCTION

This document outlines the University's policy on the entitlement, protection, transfer and exploitation of intellectual property. It is applicable to intellectual property developed or used in respect of or as a result of all knowledge-creating, knowledge-disseminating and knowledge-application activities at the University. It applies to all temporary and permanent employees, to visiting academics and to all registered students of the University. Employees and students confirm their acceptance of this policy as part of their conditions of employment and their conditions of registration respectively.

2. OBJECTIVES OF THIS POLICY

The objectives of this policy are to establish and protect the rights and duties of the University, of the initiators and generators of intellectual property and of the sponsors involved, in respect of such intellectual property.

3. GENERAL POLICY STATEMENT

3.1 The University wishes to promote an environment conducive to:

- (i) innovation and enterprise as necessary and logical extensions of its academic project;
- (ii) cost-effective transfer of intellectual property;
- (iii) the development of a vibrant and lucrative diversified-income portfolio, adding significantly to the financial well-being of the University.

3.2 The University therefore commits itself to the following:

- (i) ensuring that its primary obligation in the execution of teaching and learning is the transfer of knowledge to, and the education and training of, students registered with the University;
- (ii) ensuring that its primary obligation in the execution of research is the search for knowledge, where appropriate, for the benefit of and utilisation by the community it serves;
- (iii) stimulating and supporting diversified-income initiatives which may lead to inventions, products, services or business ideas that can be exploited commercially;
- (iv) optimal protection of the intellectual property of the University, its employees and its students;

- (v) undertaking such diversified-income activities, where necessary and useful, in collaboration with other organisations on a basis that is to the mutual benefit of the parties concerned.

4. PROTECTION OF INTELLECTUAL PROPERTY RIGHTS

4.1 Definition of intellectual property

“Intellectual property” is a collective term for immaterial property protected by law. It refers to registrable and non-registrable inventions, expertise, trade marks, trade secrets, copyright, designs and plant breeders’ rights which have come about through the mental efforts, insights, imagination, expertise and creativity of employees and students of the University and which are recognised and protected by law.

4.2 Entitlement to intellectual property rights

4.2.1 Intellectual property rights exist in respect of the following activities that put the intellectual capital of the University to work:

- (i) services rendered by employees or work undertaken by registered students of the University in the normal course and scope of their employment (in the case of employees) or of their University-assisted studies (in the case of registered students);
- (ii) non-subsidised academic programmes (as defined in paragraph 1.2.2 of the document, *Strategy for Diversifying Income Resources*);
- (iii) consultation work (as defined in paragraph 1.2.3 of the document, *Strategy for Diversifying Income Resources*) undertaken by employees or students on behalf of external parties.

4.2.2 Intellectual property rights vest in the University and in the following categories of persons in the manner described in 4.2.3-8:

4.2.2.1 *employees*, i.e. any person employed by Council on any of the following bases:

- (i) permanent employees, regardless of whether they work full-time or part-time,
- (ii) fixed-term contract employees, regardless of whether they work full-time or part-time, appointed for periods of longer than 12 months,;
- (iii) temporary employees, regardless of whether they work full-time or part-time, appointed for a period of not more than 11½ months;

4.2.2.2 *students* registered for a programme of study at the University, whether full-time or part-time;

4.2.2.3 bursary donors and sponsors of research at the University.

4.2.3 *Services rendered in the normal course and scope of employment*

4.2.3.1 All intellectual property that arises from services rendered by employees in the normal course and scope of their employment at the University belongs to the University, subject to the exceptions provided for in 4.2.3.4 below. The University retains the right to such intellectual property after termination of the employee's employment, unless the University waives such right in accordance with the procedures prescribed in 4.3 below.

4.2.3.2 "Normal course and scope of an employee's employment" refers to the activities that he/she is contractually bound to carry out in terms of his/her conditions of service and job specification. These include the teaching and assessment of students, as well as the promotion and expansion of knowledge in his/her field of expertise through research and publications as well as the planning and execution of academic and non-academic support services by employees.

4.2.3.3 There are no fixed office hours or a specified work environment within which academic and research employees fulfil their conditions of service.

4.2.3.4 The following exceptions to the provision contained in 4.2.3.1 apply:

- (i) Intellectual property that arises from *private work* (i.e., work undertaken by an employee on behalf of a third party for the sole financial benefit of the employee and not of the University), approved in accordance with the relevant policy of the University, does not belong to the University, but to the creator thereof.
- (ii) An agreement can be reached with a fixed-term contract employee and a temporary employee that the intellectual property arising from his/her employment at the University belongs to him/her in full or in part, or, in the case of a temporary employee in the permanent employment of an employer other than the University, that the intellectual property belongs to such employer in full or in part.
- (iii) Copyright of any publications of which the University ceded the copyright to an employee in terms of Part D29, paragraph (h) under the heading "Policy" of the *Conditions of Service for Employees of the University of Johannesburg*, belongs to the employee.

4.2.4 *Learning undertaken in the normal course and scope of University-assisted studies*

4.2.4.1 Intellectual property arising from the normal course and scope of a student's University-assisted studies belongs to the University. The University retains the right to such intellectual property after termination of

the student's University-assisted studies, unless the University waives its right in terms of the procedures prescribed in 4.3 below.

4.2.4.2 "University-assisted studies" includes studies arising from the teaching and study guidance that such a student receives from an employee, whether or not such student is registered for a formal qualification.

4.2.5 *Non-subsidised academic programmes*

4.2.5.1 Copyright in the design, curriculum, study material (where such study material is not already subject to copyright) and presentation of non-subsidised academic programmes, and the assessment of students registered for such programmes, belongs to the University. The University retains its copyright after termination of the programme, unless the University waives its right in terms of the procedures described in 4.3 below.

4.2.5.2 Written agreement can be reached between the University and a temporary or fixed-term employee, prior to the commencement of the programme, that copyright in respect of any aspect of the programme referred to in 4.2.5.1 above belongs to him/her in full or in part or, if the employee is in the permanent employ of an employer other than the University, that copyright in respect of any such aspect of the programmes belongs to the employer in full or in part.

4.2.6 Consultation work

4.2.6.1 Intellectual property that resides in the project design and procedure, as well as the project result of consultation work undertaken for external parties by employees or students of the University on behalf of the University in accordance with a written agreement between the University and such external party/parties belongs to the University. This is the case even if such external parties financially support the consultation work in whole or in part.

4.2.6.2 Written agreement can be reached by the University and the external party, prior to the commencement of the consultation work, that intellectual property rights in any aspect of the consultation work referred to in 4.2.6.1 above belongs to the external party, either in full or in part, or that the University and the external party are co-entitled to the intellectual property rights. Such prior written agreement can also provide for licensing of intellectual property rights or for the granting of preferential rights.

4.2.6.3 If the written agreement in terms of which consultation work is undertaken provides for work to be undertaken by an employee or a student in collaboration with an external party, a prior written agreement must be entered into by the University and such external party/parties to provide for entitlement to intellectual property rights that result from the

consultation work. Such agreement may provide for co-entitlement to the intellectual property rights.

4.2.7 Research undertaken with the financial assistance of donors or sponsors

4.2.7.1 Intellectual property is determined by the creative contribution thereof and not the financial support thereof. Therefore, intellectual property arising from the research of an employee or a student, supported financially by one or more bursary donors or sponsors, belongs to the University.

4.2.7.2 Under appropriate circumstances the University will negotiate an agreement with a bursary donor or a sponsor to provide for the entitlement to intellectual property rights before the student registers or before the employee undertakes the research. Such an agreement may also provide for co-entitlement to intellectual property or for the licensing thereof or for the granting of preferential rights.

4.2.8 Multiple individual contributions to the creation of intellectual property

4.2.8.1 If more than one individual contributes intellectually to the creation of intellectual property, irrespective of the nature and scope of the contribution, recognition is given to every contribution.

4.2.8.2 If more than one individual contributes to the creation of intellectual property, and all the individuals are employees and/or students of the University, they must agree mutually and in writing on the relative scope of every original intellectual contribution. Any dispute in this regard must be referred to the Executive Dean of the relevant faculty (or other appropriate Executive-level line manager as circumstances demand) as soon as possible for a resolution, and the Dean must provide his/her decision in writing within a further 30 days.

4.2.8.3 If any individual who contributes to the creation of intellectual property is not an employee or student, the decision on who is entitled to the intellectual property and what the relative contribution of every individual is must be referred to the Executive Dean of the relevant faculty (or other appropriate Executive-level line manager) as soon as possible, and the Dean must provide his/her decision within 30 days.

4.2.8.4 In determining each one's relative contribution for the purpose of paragraphs 4.2.8.2 and 4.2.8.3, the Dean may receive evidence from the parties involved and must seek advice on the relevant matter from the Head of the Office for Intellectual Property.

4.3 Waiver of intellectual property rights

4.3.1 An employee or a student, or a former employee or a former student may address a written request to the responsible University Executive (i.e., the most senior line manager of the employee concerned or the Executive Dean of the faculty in which the student was registered) to cede intellectual property developed by him/her to him/her.

4.3.2 In considering such an application the responsible University Executive seeks advice from the Head of the Office for Intellectual Property and takes the following factors into account:

- (i) the financial benefit to the University to pursue the commercialisation of the intellectual property;
- (ii) whether the University has the ability and/or inclination to pursue commercialisation of the intellectual property;
- (iii) whether the extent of the benefit (financial or otherwise) of the commercialisation of the intellectual property is greater for the creator than for the University;
- (iv) considerations of fairness and reasonableness, which will depend on special circumstances.

4.3.3 If the responsible University Executive finds that the request should be granted, the intellectual property is ceded to the creator through a contractual arrangement incorporating, but not limited to, an agreed valuation of the intellectual property concerned, as well as the amount and method of payment concerned.

4.3.4 If the responsible University Executive denies the request, the person(s) making the request may appeal such decision to the Vice-Chancellor within 14 days of the request having been denied. The decision of the Vice-Chancellor in this regard is final.

4.3.5 Employees and students who commercialise intellectual property that does not belong or no longer belongs to the University may not use the name of the University in such commercialisation without permission.

4.4 Manner of protection of certain types of intellectual property rights

4.4.1 *Patents, models and trademarks*

4.4.1.1 The decision on whether or not to protect inventions arising from the research activities of employees and students by means of patents and/or model registrations and/or trademarks rests with the University as the owner of the intellectual property. Care will be exercised to ensure that no

interested party will suffer harm in the execution of the decision or otherwise procedurally.

4.4.1.2 The decision is taken on behalf of the University by the Management Executive Committee, acting on the advice of the Head of the Office for Intellectual Property, the Executive Director: Research and Innovation and the Deputy Vice-Chancellor (Research, Innovation and Advancement).

4.4.1.3 No employee or student may take their own initiative to pursue the provisional or final registration of any patent, trademark, model or any other form of intellectual property on their own or through a representative without the knowledge and written permission of the responsible University Executive, acting on the advice of the Head of the Office for Intellectual Property.

4.4.1.4 Considerations taken into account by the University in deciding whether or not to obtain a *patent or model* registration include the following:

- (i) in the case of inventions, the nature thereof and the possibility of rather protecting them by way of secrecy than as patents (insofar as such secrecy can be reconciled with applicable legislation and the ethos of the University to disseminate information and knowledge to the community);
- (ii) the envisaged strategy for the significant protection of the invention, design or model;
- (iii) whether the invention, design or model will comply with the newness, self-evidence and other requirements of the relevant legislation of countries where patent or model applications are considered:
- (iv) the envisaged strategy for the technical development of the invention, design or model;
- (v) the financial attractiveness of the invention, design or model, taking the following into account:
 - 1. the estimated cost of the development work to date, the cost of the envisaged protection and further development,
 - 2. subsidies that the University would be able to receive from the patenting of the invention or the registration of the design or model,
 - 3. the income from royalties and/or dividends that the University would expect to receive from the use of the invention, design or model;
- (vi) the envisaged strategy for the commercialisation of the invention, design or model.

4.4.1.5 Considerations taken into account by the University in deciding whether or not to register a *trademark* include the following:

- (i) whether the trademark has already been used, and the extent to which it has achieved prominence and distinctiveness;
- (ii) the proposed strategy for the further presentation of the trademark;
- (iii) the proposed strategy for the further use of the trademark, which includes whether or not franchising and/or licensing will be used;
- (iv) the proposed strategy for the protection of the trademark;
- (v) whether the trademark complies with the registration requirements of the relevant legislation of the countries where trademark applications are considered;
- (vi) the goods and services with which the trademark is used and the classes in which applications for registration must be submitted.

4.4.1.6 It is University policy to exploit its patents, trademarks and models preferably by means of licenses, whether exclusive or non-exclusive.

4.4.2 *Copyright*

4.4.2.1 Copyright vested in an author – or if the author is an employee or student of the University, the University (subject to the provisions of 4.2.3.4 (iii) above) – confers the sole right to reproduce his/her original work and to exploit it for commercial profit or otherwise. Copyright in a work arises as soon as a work is in writing, or recorded, or represented in digital data or signals, or otherwise relayed in a concrete form. Works include literary or musical works, artistic works, artworks, performances, movies, sound recordings, digital recordings, broadcasts, computer programmes, programme-bearing signals and published editions as described in the *Copyright Act (Act 98 of 1978)*. Copyright in South Africa does not necessitate registration.

4.4.2.2 In order to confirm the University's claim to copyright arising from the normal course and scope of an employee's employment (subject to the provisions of 4.2.3.4 (iii) above) or a student's University-supported studies and to facilitate evidence, employees and students are expected to effect the following copyright entitlement on all works except those subject to the provisions of 4.2.3.4 (iii) above (unless there are good reasons not to do so and the relevant Executive Dean supports the reasons):

Copyright reserved: 20XY University of Johannesburg
(20XY represents the year in which the work was first published)

4.4.2.3 Photocopying, or other forms of copying, of copyright-protected works is permissible only in accordance with the provisions of the *Copyright Act (Act 98 of 1978)* and regulations framed thereunder, and in accordance with the terms of the agreement signed between the University of Johannesburg and DALRO in 2005 (lodged with the Registrar).

4.4.2.4 If an employee or student develops computer software in the normal course and scope of his/her service or University-supported studies, the University has copyright to such software, in terms of section 21(1)(d) of the *Copyright Act (Act 98 of 1978)*. The University has no copyright in computer software developed by independent contractors for the University. The University will, however, employ its best endeavours to negotiate agreement with such independent contractors to cede such copyright, or licences in respect of the copyright, to the University.

4.5 Confidentiality

4.5.1 Confidentiality is protected by agreement, whether verbal or written and whether explicit or implied.

4.5.2 It is University policy to disseminate information or knowledge that is the result of research conducted in the University without restriction. It is, however, acknowledged that the dissemination of such information or knowledge may be limited under certain circumstances and for good reason, by means of confidentiality undertakings on the part of the University or the imposition of confidentiality undertakings by the University on an employee or student. Such circumstances are the following:

- (i) if an invention is published before patent applications for its protection have been submitted, thereby causing the irrevocable destruction of the possibility of patenting;
- (ii) if the publication of the invention might lead to the destruction of the commercial value of the knowledge and information contained in the invention even in cases where the University has decided not to submit a patent application for the protection of an invention;
- (iii) if the commercial interests of specific expertise or secret information (including the franchising of a trademark and/or a style of conducting business) demand the imposition of confidentiality.

4.6 Resignation, retirement or death of an inventor or author

4.6.1 If an employee resigns or if a student's registration at the University terminates, he/she forgoes any claim that he/she has on income from the commercialisation of the University's intellectual property, unless a written agreement is entered into between the University and the employee or student providing for alternative arrangements.

- 4.6.2 The provisions of 4.6.1 are not applicable in the case of an employee who retires.
- 4.6.3 If an employee dies, the financial value of the legal claim that the employee would have had is calculated and the University's liability will be finalised by way of a once-off payment to the deceased estate.

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