



## **Intellectual Property Policy of the NWU**

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<b>Accountable executive manager</b>	DVC: Research and Innovation
<b>Policy Owner</b>	Chief Director: Technology Transfer and Innovation Support
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## INTELLECTUAL PROPERTY POLICY OF THE NWU

### Preamble

Against the background of the dream to be an internationally recognised university in Africa, distinguished for engaged scholarship, social responsiveness and an ethic of care, the council of the North-West University (NWU) has adopted this policy on XXXX to regulate the ownership, protection, enforcement, use and management of the Intellectual Property (IP) of the NWU in alignment with the key strategic objectives of both the NWU and the Department of Science and Innovation, and to ensure pursuit of the university's objectives by embedding risk and compliance management into all the processes of the NWU.

### 1 Interpretation and application

This policy must be interpreted and applied in a manner consistent with the –

- 1.1 Constitution of the Republic of South Africa, 1996;
- 1.2 higher Education Act, 101 of 1997;
- 1.3 Intellectual Property Rights from Publicly financed Research and Development Act, 51 of 2008 (“the IPR Act”);
- 1.4 Competition Act, 89 of 1998;
- 1.5 copyright Act, 98 of 1978;
- 1.6 counterfeit Goods Act, 37 of 1997;
- 1.7 Designs Act, 195 of 1993
- 1.8 National Environmental Management: Biodiversity Act, 10 of 2004 and the Bioprospecting, Access and Benefit-Sharing Amendments Regulations, 2015 promulgated in terms of section 97(1) of Act 10 of 2004;
- 1.9 Labour Relations Act, 66 of 1995;
- 1.10 Patents Act, 57 of 1978;
- 1.11 Plant Breeders’ Rights Act, 15 of 1976;
- 1.12 Trademarks Act, 194 of 1993;
- 1.13 Statue of the North-West University (“the Statute”);
- 1.14 all related policies, strategies and procedures of the NWU should be considered in the implementation of this policy.

### 2 Definitions

In this policy, unless the context indicates otherwise –

“**benefit**” means a monetary or non-monetary benefit received by the NWU through the commercialisation of NWU IP;

“**biological resources**” means microorganisms, genetic material, plant material, and other genetic information created, made, discovered, invented or bred, by an employee, student, internal contractor or a person making significant use of NWU resources;

“**chief director**” refers to the Chief Director: Technology Transfer and Innovation Support;

“**commercialisation**” means the process by which IP falling within the provisions of this policy may be exploited commercially or for social benefit, whether directly or indirectly, through IP transactions (including licencing or assignment), joint ventures, strategic alliances, integration or any other

commercial transaction or endeavour, including the sale of a product of service that embodies or utilises the IP;

**“commercialisation expenses”** refers to the following costs and expenses incurred by the NWU in commercialising its IP:

- (a) All out-of-pocket costs, fees and expenses that the NWU incurs and pays to independent third parties in connection with any of the following activities:
  - (i) filing, prosecution, development and maintenance of any statutory protection action for the commercialised IP, excluding any amounts recovered by the NWU from any third party, including the intellectual property fund established under the IPR Act;
  - (ii) auditing, recovery or collection of the gross revenues, including bank fees, charges and other expenses of any kind paid to collect, receive or account for, amounts payable to it for the commercialisation of the IP;
  - (iii) defence, validation and enforcement of commercialised IP in any intellectual property office, court or tribunal;
  - (iv) legal advice and services in respect of the above activities or issuance or conveyance of any securities or other consideration constituting gross revenues or in respect of any proposed, threatened or actual litigation involving commercialised IP; and
- (b) Costs directly incurred in respect of the conduct of market research, business development, marketing, advertising, promotion or sales activities or services, and administrative expenses associated with the commercialisation;

**“confidential information”** relating to R&I outputs means information which comes to the knowledge of –

- (a) an employee in the course and scope of employment with the NWU;
- (b) an internal contractor, in the course and scope of the contact with the NWU; or
- (c) a student, in the course and scope of enrolment at the NWU,

and which is not generally known among, all readily accessible to, persons within the field and which has commercial value which is the subject of a confidentiality obligation of the NWU in favour of another person;

**“conflict of commitment”** and **“conflict of interest”** have the meaning provided for in the NWU’s Policy and Rules on conflict of Interest and on Declarations of Interest and of Gifts;

**“contract research”** means research conducted by the NWU for another person in exchange for compensation;

**“dissertation”** means a dissertation authored by a student and submitted to the NWU in pursuit of the award of a postgraduate qualification at the NWU;

**“domain name”** means a network address that is registered or assigned in respect of an internet protocol number, electronic address or other resource on the internet;

**“domain name registration”** means a registered right in respect of a domain name, which defines a realm of administrative autonomy, authority, or control in favour of the registrant or authorised user on the internet;

**“facility”** means a campus, office, premises, building, plant or equipment which is owned or rented by the NWU or in which the NWU’s business or operations are carried out;

**“freedom to operate”** refers to the ability of the NWU to act without infringing the IP rights of any other person;

**“full cost”** means the full cost of publicly funded research and development as defined in section of the IPR Act;

**“gross revenues”** refers to all monetary and non-monetary benefits actually received by the NWU, and generated through the commercialisation of its IP, less any taxes;

**“intellectual property (IP)”** means, in accordance with section 1 of the IPR Act, any creation of the mind that is capable of being protected by law from use by any other person, whether in terms of South African law or foreign intellectual property law, and includes any rights in such creation, but excludes copyrighted works such as a thesis, dissertation, article, handbook or any other publication which, in the ordinary course of business, is associated with conventional academic work, and, subject to all other definitions provided for in legislation, includes for the purposes of this policy, rights in IP, whether registered, registrable, unregistered or the subject matter of an application for registration, including, but not limited to, inventions, patents, registered designs, know-how, copyright, domain name registrations, trademarks, plant breeders’ rights and rights in any information granted by any law,

further including all applications for and renewals or extensions of such rights, and all rights or forms of protection having an equivalent or similar effect to any of the aforementioned, which may subsist in any country in the world;

**“internal contractor”** means any natural person who is not an employee but who conducts research at or teaches for the NWU, whether or not such person is paid by the NWU for providing such services, including visiting researchers, professors, post-graduate research fellows, teachers and volunteers as well as adjunct professors and post-doctoral fellows not being employees, or any other person making use of NWU resources with the permission of the NWU;

**“IP enabler”** in relation to a particular item of IP, means an employee, an internal contractor or student who is not an IP creator but who is recognised by the IP creator(s) as having made a significant contribution to the creation of the IP, including testing, assessment, analysis, investigation or verification of the R&I outputs with which the IP is associated;

**“IP creator”** in relation to a particular item of IP, means an employee, internal contractor or student, involved in the conception of NWU IP and who is identifiable as such for the purposes of obtaining statutory or common law protection and enforcement of IP rights;

**“IP custodian”** means the deputy vice-chancellor: research and innovation of the NWU;

**“IP transaction”** means any transaction, agreement, arrangement or engagement between the NWU and another person involving the ownership, assignment, cession, transfer, licencing, access, development, or use of IP;

**“know-how”** means information that is not generally known or readily ascertainable and which is recognised or capable of being protected by law from used by an unauthorised third party, and which relates to the NWU or its business or operations go to a patent, registered design or copyright work or the exploitation of any of the aforesaid, including an invention and a design;

**“legal office”** refers to the legal office of the NWU, reporting to the registrar;

**“nett revenues”** means gross revenues less all commercialisation expenses;

**“NIPMO”** is the National Intellectual Property Management Office established in terms of the IPR Act;

**“NWU resource”** means any contribution made by the NWU to research, including the provision of financial or human resources, materials, infrastructure, relevant background IP, equipment and facilities, including funding, buildings, laboratories, consumables, access to 3rd party resources, labour, electricity and water, and the NWU’s reputation or goodwill;

**“personal entity”** means an employee, internal contractor or student, acting in the personal capacity, or a juristic entity by or through which an employee, student or internal contractor stands to benefit, whether directly or indirectly;

**“private contracting”** means contract ING for the conduct of research by employees or internal contractors in their personal capacity or for private entity in which they have an interest, where such research is conducted for another person in exchange for this compensation, without any significant use of NWU resources, and subject, where necessary, to approval by the NWU, and

**“private contract”** means an agreement on the terms and conditions of such research;

**“research”** means the systematic investigation into a study of materials and sources in order to establish facts and reach conclusions, and any other activity deemed by NIPMO to constitute research or development;

**“R&I outputs”** means research and innovation outputs, which are the learnings, outcomes or outputs resulting from the conduct of research, which may be tangible or intangible and which may include IP or new services and products that fulfil a previous unmet need or solve a problem that has not previously had a solution;

**“significant use of NWU resources”** means the use of NWU resources, not including the use of office, library, machine shop facilities and of personal computers, but including the use of any specialised facilities or consumables of the NWU including facilities or consumables designed or typically used for a specialised purpose related to the research in question;

**“significant R&I output”** means –

- an invention that may be eligible for protection by registration of a patent because, on the face of it, the invention is novel, inventive, and has use of application in trade, industry or agriculture;
- a design that may be eligible for protection as a registered design because, on the face of it, the design is new, original or not commonplace in the art;

- an original work that has been reduced to material form which, on the face of it, is eligible for copyright protection in terms of the Copyright Act 98 of 1978 or any equivalent thereof anywhere in the world'
- a new variety of plant that may be eligible for protection by registration of a plant breeders' right, and which on the face of it is new, distinct, uniform and stable;
- a distinctive mark arising from research which, on the face of it, constitutes or may constitute a trademark eligible for protection in terms of the common law, or registration and protection in terms of the Trademarks Act 194 of 1993 or any equivalent thereof anywhere in the world, and
- Information which is not generally known or readily ascertainable and it is in the interest of the NWU for it to remain so or which on the face of it, it has the potential to be commercialised, and may therefore be of commercial value to the NWU;

**“spin-off company”** means a company established by the NWU for the commercialization of NWU IP, in which the NWU has an interest as shareholder or in which an employee, internal contractor or student is appointed as an officer to drive the commercialisation with the consent of the NWU;

**“textbook”** means any book or literary work that is capable of being used as a standard work for the study of a particular subject;

**“thesis”** means a thesis authored by a student and submitted to the NWU in pursuit of the award of a doctoral degree by the NWU; and

**“the TTIS office”** means the Technology Transfer and Innovation Support office of the NWU established in compliance with section 6(1) of the IPR Act

### 3 Policy Statement

It is the policy of the NWU to –

- 3.1 Promote innovative research and innovation for economic development;
- 3.2 ensure, in collaboration with the university's employees, internal contractors and students, and in accordance with the policies of the Department of Science and Innovation and the applicable legislation, that intellectual property emanating from publicly financed research and development is identified, protected, utilised and commercialised;
- 3.3 support and promote the creation of educational resources for learning and teaching through an open licensing framework such as creative commons and participation in said framework notwithstanding the university's claim to ownership of copyrights works in terms of paragraph 8;
- 3.4 further the objectives of the IPR Act; and
- 3.5 give effect to the university's vision regarding entrepreneurship.

### 4 Policy objectives

The objectives of this policy are to –

- 4.1 Encourage the creation of IP as R&I outputs and to promote the commercialisation of IP for the public good;
- 4.2 set out the rights and obligations of employees, internal contractors and students regarding IP and the commercialisation of IP;
- 4.3 enable internal structures of the university to effectively manage IP of the NWU;
- 4.4 ensure the disclosure to the university of significant R&I outputs;
- 4.5 protect the university's R&I outputs that may have commercial value;
- 4.6 manage the dissemination of R&I outputs for scholarly purposes;
- 4.7 protect the NWU against prejudicial disclosure of confidential information;
- 4.8 ensure compliance by the NWU as a public research institution with all legislation concerning IP and R&I outputs; and
- 4.9 establish principles for the participation of IP creators in the commercialization of NWU IP and the share of benefits gained from such commercialisation.

## 5 Scope

- 5.1 This policy applies to the following persons, unless expressly exempted by, or excluded from, a written agreement with the NWU:
  - 5.1.1 all employees and students of the NWU, including:
    - 5.1.1.1 employees who are seconded to another entity for a purpose falling within the scope of their employment;
    - 5.1.1.2 employees whose appointment is subject to a probation period;
    - 5.1.1.3 interns, apprentices and secondees to the NWU; and
    - 5.1.1.4 employees conducting their research without making use of a facility of the NWU.
  - 5.1.2 all internal contractors, including but not limited to persons contracted by, paid by or engaged in any consultation or services agreement with the NWU, who are required to comply with the terms and conditions of this policy as a condition of their engagement with the NWU, including:
    - 5.1.2.1 adjunct faculty, visiting faculty and visiting researchers;
    - 5.1.2.2 post-doctoral fellows; and
    - 5.1.2.3 persons making significant use of the NWU's resources.
  - 5.1.3 all entities, including but not limited to spin off companies, which are designated by the IP custodian as being subject to the provisions of this Policy.
- 5.2 this policy regulates the management of NWU trademarks associated with the commercialization of R&I outputs.

## 6 Roles, responsibilities and accountability

- 6.1 The management of the NWU must ensure that the TTIS office has appropriately qualified personnel who collectively has interdisciplinary knowledge, qualifications and expertise in the identification, protection, enforcement, management and commercialisation of IP and in the negotiation and structuring of IP transactions.
- 6.2 The IP custodian is the custodian of this policy responsible to –
  - 6.2.1 ensure the implementation of this policy throughout the various divisions, units, faculties, departments and campuses of the NWU, assisted by the executive deans of all the faculties;
  - 6.2.2 monitor compliance with the policy and to implement disciplinary action in the event of non-compliance;
  - 6.2.3 ensure that the chief director develops and implements systems, processes and procedures for all activities affected by or related to this policy;
  - 6.2.4 ensure that the policy remains relevant and regularly updated and maintained so as to be effective in achieving the objectives set out in paragraph 4;
  - 6.2.5 ensure cooperation between the TTIS office and the legal office and any other offices and structures of the NWU, to enable them to perform their duties and responsibilities in terms of this policy; and
  - 6.2.6 to consider appointing an IP advisory panel, having the constitution and responsibilities set out in paragraph 6.3 and 6.4 in order to establish a broader university-wide participation and discussion of IP issues.
- 6.3 If an advisory panel is appointed by the IP custodian, it may comprise:
  - 6.3.1 the chief director;
  - 6.3.2 the director: Research Support office
  - 6.3.3 one representative of the legal office;
  - 6.3.4 one deputy Dean from each faculty; and
  - 6.3.5 if required, one further ad hoc member appointed from time to time to assist the panel in the performance of its duties and responsibilities.
- 6.4 If established, an advisory panel may perform an advisory role to the chief director and the IP custodian and may be requested to provide input or recommendations regarding disputes arising from this policy.

- 6.5 The executive Dean of each faculty and an employee appointed by the executive Dean for the purpose of this paragraph, must perform the following functions:
  - 6.5.1 create general awareness of the importance of the proper management of NWU IP and the universities obligations in terms of the IPR Act, and
  - 6.5.2 ensure that employees, internal contractors and students are made aware of the provisions of this policy.
- 6.6 Any disputes relating to the interpretation or implementation of a provision of this policy must be referred to the executive Dean of the faculty concerned for resolution, and if the dispute or issue remains unresolved, it must be referred to the chief director, and ultimately to the IP custodian.
- 6.7 non-compliance with this policy may result in cancellation of access rights to the NWU's facilities, denial of the use of NWU resources, who in the case of an internal contractor, application of remedies following breach of contract.
- 6.8 exceptions to, or exclusions from this policy may be authorised only by the IP custodian subject to approval being obtained from NIPMO where necessary.

## **7 Ownership and reporting of IP**

- 7.1 All R&I outputs and associated IP which are created, made, discovered, invented or authored –
  - 7.1.1 by an employee, in the course and scope of the employee's employment;
  - 7.1.2 by an internal contractor, in the course and scope of the contractor's arrangements with the NWU;
  - 7.1.3 by a student, in the course and scope of the student's enrolment as a student, and
  - 7.1.4 By any person making significant use of NWU resources –
 but excluding any such R&I outputs and associated IP resulting from private contracting, are owned by the NWU, and the IP creators are obliged to sign all documents necessary to ensure that ownership of such IP vests in or is transferred or assigned to the NWU.
- 7.2 Paragraph 7.1 applies whether or not to research resulting in the R&I outputs and associated IP is conducted on the premises of the NWU and whether or not such research is conducted during regular business or working hours.
- 7.3 When an employee, internal contractor student creates, makes, discovers, invent or authors a significant R&I output, they must as soon as is reasonably possible disclose the nature and details of such output to their immediate supervisor or line manager while keeping the R&I outputs confidential.
- 7.4 Within 30 days after receiving the information referred to in paragraph 7.3, the employee, internal contractor or student must disclose it in the prescribed manner to the TTIS office, which must keep a record of all such disclosures and of all significant IP owned by the NWU.
- 7.5 No employee, internal contractor or student may independently commercialise or use any R&I outputs in respect of which the NWU earns the IP rights without the express written consent of the chief director.
- 7.6 R&I outputs resulting from research conducted by an undergraduate student are not normal deemed to be "significant R&I outputs", but the chief director may, by submission by a student or employer, determine that a particular output of this nature be dealt with as an exception.
- 7.7 All disclosures made in terms of paragraphs 7.3 and 7.4 must be treated confidentially in order not to prejudice the ability of the to obtain appropriate protection of its IP.
- 7.8 IP creators must cooperate the TTIS office for the purposes of –
  - 7.8.1 disclosing the history of the creation of R&I outputs, the identification of IP enablers and the involvement of other persons or any agreements to which the NWU is a party and which may be relevant to the ownership of IP associated with R&I outputs;
  - 7.8.2 investigating the potential for R&I outputs to qualify for IP protection, where appropriate, including disclosing all prior art relevant to an invention or design which may affect its eligibility for registered protection and which is within the personal knowledge of the IP creator; and
  - 7.8.3 conducting any novelty or inventiveness searches to determine the eligibility of an invention or design for registered protection, where appropriate.
- 7.9 Where the NWU pursues the registration of any right in respect of a significant R&I output, the university must bear the associated costs.

- 7.10 Employees, internal contractors and students may not independently apply or attempt to apply for such statutory protection for any R&I outputs in respect of which the NWU owns rights or which may accrue to the NWU, whether in their own name or in the name of the NWU, without the consent of the chief director.
- 7.11 the NWU has the sole discretion to decide whether or not to claim and apply for any relevant IP right in respect of any R&I output falling within this policy and whether the NWU shall commercialise such R&I output.

## **8 Short courses and textbooks**

- 8.1 An employee or internal contractor who wishes to create content for a short course must consult the NWU's Policy on Continuing Education and Continuing Education Standard Operating Procedures and obtain the written permission of the executive dean of the faculty concerned, which may be granted subject to specified conditions or obligations.
- 8.2 Copyright works and textbooks authored by employees or internal contractors for short courses, are deemed to be created in the circumstances outlined in paragraph 7.1, and the copyright therein is owned by the NWU, but the author is entitled to share in the benefits contemplated in paragraph 19, unless –
- 8.2.1 the author signs a different written agreement with a duly authorised representative of the NWU; or
- 8.2.2 such works are authored in the course and scope of private contracting; or
- 8.2.3 the written permission granted in terms of paragraph 8.2 contain express provisions to the contrary.
- 8.3 Where the NWU owns copyright in textbooks authored by employees or internal contractors in terms of paragraph 8.3, such authors shall have a non-exclusive, non-transferable licence to reproduce and adapt such copyright works for research, private use and teaching purposes.
- 8.4 An employee or internal contractor may not prescribe a commercially available publication which contains content which was authored by the employee/internal contractor without the prior consent of the executive dean of the faculty concerned.
- 8.5 The NWU's trademarks may only be used in association with the marketing and promotion of short courses where the copyright associated with the short course is owned by the NWU and where written permission for the creation of content for such short course is provided in terms of the process outlined in paragraph 8.2.
- 8.6 Employees and internal contractors may share open educational resources freely and openly through online repositories within the guidelines set out by the NWU Open Educational Resources Declaration and Open Education Resources Subcommittee of the Senate Committee for Teaching and Learning.

## **9 Private contracting**

- 9.1 Employees and internal contractors are entitled to conduct research under private contracts, and such research is deemed to fall outside of the course and scope of their employment or engagement with the NWU.
- 9.2 For research to constitute private contracting, the employee or internal contractor in question must have complied with all the rules and procedures prescribed by the NWU for the approval of the research as private contracting.
- 9.3 Employees and internal contractors must ensure that private contracts with third parties are concluded in accordance with the NWU Policy and Rules on Conflict of Interest and on Declarations of Interest and of Gifts.
- 9.4 Employees and internal contractors entering into private contracting must explicitly disclose the nature and scope of their obligations to the NWU to the other contracting parties, and such contracts must clearly differentiate the research to be conducted under the contract from the research that the employees or internal contractors are obliged to conduct in terms of their employment or contracts with the NWU.

## **10 Exclusions from NWU IP ownership**

- 10.1 In the event of an employee or internal contractor creating, discovering, inventing or authoring R&I outputs in the course of private contracting, the outputs are not deemed to emanate from publicly financed research or development as envisaged by the IPR Act thereby excluding any claim by the



NWU to ownership of any IP associated with such outputs except if significant use of NWU resources was made in the creation of such outputs.

- 10.2 NWU does not claim ownership of IP related to outputs by employees, internal contractors and students that do not result from the conduct of research, including works of literary fiction, novels, poems, and musical compositions, except if significant use of NWU resources was made in the creation of the outputs
- 10.3 In cases where R&I outputs are made, discovered, invented or authored in circumstances falling outside of paragraph 7.1, and where no significant use of NWU resources has been made; and where the research is conducted on the personal, unpaid time of the employee, internal contractor or student, the NWU does not claim ownership of the resulting R&I outputs or the associated IP.
- 10.4 NWU does not claim to ownership of copyright in academic works, including theses, articles published in academic journals, scholarly books and similar publications.
- 10.5 Where an employee, internal contractor or student of the NWU conducts contract research for and on behalf of another person, or where research is conducted in collaboration with another person, the chief director may agree that the resulting IP in the R&I outputs is shared with or owned exclusively by, the other person.
- 10.6 Where an employee, internal contractor or student of the NWU conducts contract research for and on behalf of another person, or where research is conducted in collaboration with another person, the chief director may agree that the resulting IP in the R&I outputs is shared with or owned exclusively by, the other person.
- 10.7 Relinquishment, abandonment or waiver of IP rights owned by the NWU may be made only subject to ensuring the perpetual, royalty-free right and license for the NWU to use the IP for its own research, academic and teaching purposes.

## **11 Conflict of interest and commitment**

- 11.1 In generating R&I outputs and related IP, employees, internal contractors and students must have special regard to the NWU's Policy and Rules on Conflict of Interest and on Declarations of Interest and Gifts.
- 11.2 Under no circumstances may employees, internal contractors or students direct engagements to, subcontract, or solicit work in exchange for consideration, to or for a personal entity in conflict with the interests of the NWU
- 11.3 An employee, internal contractor or student may not compromise the NWU by doing any of the following for any collateral purpose or in advancement of their own interests:
  - 11.3.1 influence the R&I activities of students or other employees or internal contractors;
  - 11.3.2 withhold R&I outputs or provide R&I outputs on a preferential basis; or
  - 11.3.3 make significant use of NWU resources or NWU IP.
- 11.4 Employees and internal contractors are deemed to have a conflict of interest in the following circumstances:
  - 11.4.1 where they represent or act for the NWU in the negotiation of the terms and conditions upon which a personal entity conducts research for the NWU;
  - 11.4.2 where they engage a student in research conducted under a private contract involving a personal entity;
  - 11.4.3 where they facilitate the purchase or rental by the NWU of products or services sold by a personal entity;
  - 11.4.4 where they sell, through a personal entity, products or services which would be in competition with products or services that could be offered by the NWU or a spin-off company; or
  - 11.4.5 where they act in any other way that does not promote good faith or which is not in the interests of the NWU.
- 11.5 Where the NWU establishes a spin-off company and a personal entity or any of the university's employees or affiliates is engaged by the spin-off company, either as a director, technical champion, service provider or consultant, the NWU must ensure that there is no conflict of commitment in the form

of a reduction of the duties of the employee or internal contractor under their employment or other contract with the NWU, or of an adjustment of their remuneration.

## **12 Release of R&I Outputs into the public domain**

- 12.1 The conduct of research and the unrestricted disclosure and exchange of information among scholars are recognised as key functions of the university that must, as far as possible, be protected and upheld by the NWU.
- 12.2 Where an employee, internal contractor or student wishes to make a public disclosure of significant R&I outputs, they must submit a request to the TTIS office, providing all details required by the TTIS office to consider whether or not it is appropriate for the disclosure to be made, including:
  - 12.2.1 the prescribed form relating to the R&I output in question;
  - 12.2.2 a draft of any material containing the disclosure, such as an article, paper, presentation slides, which is proposed to be published;
  - 12.2.3 details of the manner in which the disclosure is proposed to be made, such as the name of the publication, conference or seminar in question, distribution under an open-source licence, and
  - 12.2.4 the date on which the disclosure is proposed to be made.
- 12.3 Following receipt of a request referred to in paragraph 12.2, the chief director must, within a reasonable period, communicate approval or disapproval of the requested disclosure in writing
- 12.4 No public disclosure of significant R&I outputs may be made without the express approval of the chief director.
- 12.5 Requests for the use of open source or creative commons licences in research which is likely to result in the creation of significant R&I outputs, must be made in writing to the TTIS office.

## **13 Confidentiality**

- 13.1 Employees, internal contractors and students may –
  - 13.1.1 not use confidential information for their own benefit or for the benefit of any person other than the NWU or the person owning rights in the confidential information, both during and after termination of their employment or contract, or their registration with the NWU;
  - 13.1.2 not disclose confidential information to any person unless such disclosure has specifically been approved by the TTIS office on the basis of the existence of a demonstrable need to know the information, and subject to the placing of appropriate obligations of confidentiality on the recipient
  - 13.1.3 take all reasonable steps to limit access to, and to prevent confidential information from falling into the hands of any unauthorised person; and
  - 13.1.4 seek guidance from the TTIS office or the legal office, in instances where the appropriate procedure and conditions for disclosing confidential information or for dealing with the confidential information of another person, are unclear.
- 13.2 Where an employee, internal contractor or student wishes to receive confidential information from another person, they must first consider, if necessary after obtaining advice from the TTIS office or the legal office, whether it is strictly necessary to enter into a confidentiality agreement with that other person having regard to the relevant factors, including the significance of any R&I outputs or other information that forms the subject of the proposed disclosure, and whether research is being conducted by the NWU in a field similar to that of the subject of the disclosure.
- 13.3 If the execution of a confidentiality agreement is necessary, whether for the disclosure of NWU confidential information or the receipt of the confidential information of another person, the employee, internal contractor or student involved must follow the guidelines and procedures regarding the drafting and conclusion of an appropriate agreement provided by the TTIS office and the legal office.
- 13.4 No employee, internal contractor or student may sign a confidentiality agreement on behalf of the NWU unless expressly authorised thereto in terms of the NWU's Policy on Delegations and Schedule of Authorisation Levels.
- 13.5 The employee, internal contractor or student concerned must provide an electronic copy of the signed confidentiality agreement to the TTIS office as soon as reasonably possible after signature by the

relevant parties, and the legal office will be provided with an original signed hard copy of the agreement for safekeeping.

- 13.6 Where an employee, internal contractor or student becomes aware or suspects that confidential information has been inappropriately disclosed, they must notify the TTIS office as soon as is reasonably possible.
- 13.7 Where the confidentiality of the contents of a thesis or dissertation is required to be maintained for a period of time in accordance with the Rules for the Classification of Theses and Dissertations –
  - 13.7.1 the student or candidate and the executive dean of the faculty concerned must be notified of the application for classification of confidentiality by the applying project leader, supervisor or promoter and of the reasons for the classification, and
  - 13.7.2 the student or candidate in question must provide the TTIS office with a draft of the thesis as soon as it becomes available.

## **14 Research involving others**

- 14.1 Where research conducted at the NWU involves another person as funder, financier, instructor, client, collaborator or sub-contractor, the NWU and that other person may enter into a written agreement beforehand which addresses the rights of the parties in relation to any IP resulting from such research
- 14.2 Any written agreement referred to in paragraph 14.1 must be negotiated and concluded in accordance with the Policy for the Management of Research and Innovation Contracts and External Investment/Stake holding in cooperation between the legal office, the TTIS office and the employees and internal contractors involved.
- 14.3 Employees and internal contractors must, where appropriate, identify and summarise in writing any pre-existing IP of the NWU that it will contribute to the research involving another person and also obtain from the other person a written summary of any pre-existing IP that such a person intends to contribute to the research, and the involvement of such pre-existing IP must be communicated to the legal office and TTIS office during the negotiation and preparation of an appropriate research agreement
- 14.4 Where research is conducted by employees, internal contractors or students of the NWU using public funds or NWU resources, the representatives of the NWU may not, without prior NIPMO approval agree to –
  - 14.4.1 any terms that would result in such other person owning the resulting IP, nor assign, nor undertake to assign such IP to such other person;
  - 14.4.2 co-ownership of the IP resulting from the research with such other person, unless –
    - 14.4.2.1 there has been, or will be, a contribution of resources by the other party
    - 14.4.2.2 there is, or will be, joint IP creatorship with the other party;
    - 14.4.2.3 appropriate arrangements have been, or will be, made for the sharing of benefit generated from the commercialisation of the IP with the NWU's IP creators; and
    - 14.4.2.4 an agreement is, or will be, concluded governing the commercialisation of the IP; or
    - 14.4.2.5 any terms that would result in the other person having a royalty-free licence under any IP of the NWU that is subject to the IPR Act or entitle that other person to grant a royalty-free sub-licence to another person for that IP.
- 14.5 Where contract research is funded by another party on a full cost basis, the NWU may (but is not obliged to) assign the resulting IP to the other person or agree to terms that may result in the IP being owned by such other person.
- 14.6 Where contract research is partially funded by another party, but such funding constitutes more than 70% of the full cost of the research, then the NWU may (but is not obliged to) grant the other party a royalty-free licence under the resultant IP, subject to NIPMO having granted its approval for such a royalty-free licence.
- 14.7 Where IP resulting from research is assigned to another person, the NWU must ensure that the university is granted an irrevocable, non-transferrable, and royalty-free licence by the assignee, to use the assigned IP for research, development and educational purposes.

## 15 Commercialisation of NWU IP

- 15.1 The chief director will make a determination regarding the possible commercialisation of NWU IP for a profit or otherwise for the benefit of the people of South Africa, with input from the IP creators and any other person whose input the chief director deems appropriate.
- 15.2 IP creators must cooperate with the TTIS office throughout the commercialisation process.
- 15.3 An employee, internal contractor or student who wishes to have a particular R&I output or IP portfolio commercialised, may submit a request to the TTIS office to facilitate commercialisation, providing all information reasonably required for the consideration of the commercial feasibility of the proposal.
- 15.4 In the event of a decision to facilitate commercialisation, the applicant referred to in paragraph 15.3 must cooperate in the performance of the following actions:
  - 15.4.1 the conduct of a technical investigation to establish whether or not an R&I output is protectable by means of the registration of rights;
  - 15.4.2 the assessment of the potential of the output to generate a commercial or non-commercial benefit;
  - 15.4.3 the investigation of licensing opportunities;
  - 15.4.4 the conduct of a market analysis, formulating a business plan, investigating routes to market and arrangements for commercialisation (whether through licensing, sale of rights, or the establishment of spin-off companies);
  - 15.4.5 the investigation of sources of financing, the opportunities for the formation of partnerships and identifying customers/clients;
  - 15.4.6 the investigation of the NWU's freedom to operate when commercialising the R&I outputs;
  - 15.4.7 the evaluation and management of a portfolio of IP pertaining to the R&I output; and
  - 15.4.8 the distribution of the proceeds of the commercialisation to IP creators in accordance with this policy.
- 15.5 A decision to commercialise any NWU IP and the means for commercialisation is taken at the discretion of the chief director, having regard to the strategic objectives of the NWU, the available resources and other relevant factors, but subject to the following:
  - 15.5.1 preference must be given to non-exclusive licensing;
  - 15.5.2 preference must be given to BBBEE entities and small enterprises;
  - 15.5.3 preference must be given to parties that seek to use the IP in ways that provide optimal benefits to the economy and quality of life of the people of South Africa;
  - 15.5.4 exclusive licence holders must, where feasible, be required to undertake to manufacture, process and otherwise commercialise within South Africa;
  - 15.5.5 provision must be made for the state to be licensed on an irrevocable and royalty-free basis to use or have the IP used throughout the world for the health, security and emergency needs of South Africa;
  - 15.5.6 if a holder of an exclusive licence is unable to continue with the commercialisation of the IP within South Africa during the term of the licence, the NWU may either –
    - 15.5.6.1 convert the exclusive licence to a non-exclusive licence; or
    - 15.5.6.2 retain the exclusive licence and furnish NIPMO with full reasons for retaining exclusivity within 30 days of it becoming aware that the holder of the licence is unable to do so.
- 15.6 Reference must be made in each IP transaction to the provisions of section 14 of the IPR Act in terms of which the state is entitled to exercise so-called "walk in rights" should a person who undertakes R&I using public funding fail to commercialise the NWU IP to the benefit of the people of South Africa.
- 15.7 An employee, internal contractor or student must immediately report the suspected incidence of the infringement of IP owned by another person through the actions of the NWU or a spin-off company to the TTIS office.
- 15.8 Following investigation of a suspected infringement referred to in paragraph 15.7, the chief director must advise the IP custodian on a possible course of action, including defending any legal claim and settlement of the dispute.
- 15.9 An employee, internal contractor or student must immediately report a suspected infringement of NWU IP or the IP of a spin-off company to the TTIS office.

- 15.10 Following investigation of the suspected infringement referred to in paragraph 15.9 the chief director must advise the IP custodian on a possible course of action, including instituting legal proceedings to enforce the IP of the NWU against the suspected infringer or settling the dispute through the grant of a licence.
- 15.11 Having had regard to the recommendations of the chief director contemplated in paragraph 15.8 and 15.10, the IP custodian may decide what actions to take in relation to the suspected infringement, if any, including defending any legal claim and settlement of the dispute.

## **16 Spin-off companies**

- 16.1 The merits of the establishment of a spin-off company either for commercialisation or for another purpose, must be investigated by the TTIS office in response to a request from an employee or internal contractor.
- 16.2 The chief director may make a determination to commercialise NWU IP through the establishment of a spin-off company, subject to agreement by the IP custodian and having obtained any other approvals that may be necessary.
- 16.3 An employee, internal contractor, student or any other person may own equity in a spin-off company, provided that all procedures, permissions and authorisations are complied with, and that such interest does not cause a conflict of interest or a conflict of commitment for that employee, internal contractor or student and that the interest is acquired in compliance with the procedures and with all permissions and authorisations, prescribed by the NWU for doing so.
- 16.4 The TTIS office may provide the following assistance to a spin-off company:
- 16.4.1 identifying suitable employees, directors and officers for the company;
  - 16.4.2 training of employees, directors and officers in business principles;
  - 16.4.3 formulating a business plan for the company;
  - 16.4.4 finding strategic partners for the company;
  - 16.4.5 incubating the spin-off company and making suitable facilities and NWU resources available to the company;
  - 16.4.6 identifying mentors and arranging for mentors to mentor employees, directors and officers of the company; and
  - 16.4.7 making legal and financial services available to the company.
- 16.4.8 In cases where a spin-off company operates as an extension of the NWU's core business or operations, including for academic or research programmes, or to facilitate the commercialisation of NWU IP, the NWU may hold a majority share of equity in the company.
- 16.4.9 The NWU may render support to spin-off companies in exchange for either equity or payment for services rendered, as agreed by the NWU and the spin-off company at the time.
- 16.4.10 Where a spin-off company is provided with access to NWU facilities or resources, a written agreement containing the terms and conditions of the use or lease thereof must be concluded with the company.
- 16.4.11 Any decision taken on behalf of the NWU to invest into a spin-off company must be taken by the IP custodian and any other person empowered thereto by the Policy on Delegations and Schedule of Authorisation Levels and must be based strictly on business principles, taking into account all relevant information, including the business plan of the company.

## **17 Plant breeders' rights, microorganisms, genetic material and material transfer provisions**

- 17.1 Where biological resources owned by the NWU have potential commercial value, the provisions of this policy applies.
- 17.2 The creators of biological resources are responsible to ensure compliance with all relevant legislation, including the provisions of the National Environmental Management: Biodiversity Act 10 of 2004, and no IP in biological resources may be transferred or commercialised before the conclusion, with the assistance of the TTIS office, of a material transfer agreement.
- 17.3 Legal protection of new plant varieties developed at the NWU may be facilitated at the discretion of the chief director.

## **18 Domain names and trademarks**

- 18.1 No domain name associated with research, R&I outputs or the commercialisation of R&I outputs or the associated trademarks may be registered without the express written permission of the chief director, such domain names being owned by NWU.
- 18.2 No trademarks associated with IP emanating from research or the commercialisation of R&I outputs and associated IP may be registered without the express written permission of the chief director and where appropriate, the chief director (is responsible for the registration and maintenance of such trademarks to be owned by NWU.

## **19 Benefit sharing from commercialisation**

- 19.1 Benefits from commercialisation may be shared according to a clear and equitable framework intended to encourage employees, internal contractors and students to develop new IP and to engage in commercialisation activities in a manner reflecting the values of the NWU, and which benefits the NWU, the community and partners of the NWU.
- 19.2 IP creators are entitled to share in the benefits received by the NWU through the commercialisation of the IP they created.
- 19.3 In cases where the NWU has not made contrary arrangements with IP creators in a written agreement with them, benefits will be shared in accordance with paragraph 19.6.
- 19.4 Where gross revenues generated through commercialisation received by the NWU are not in monetary form, the chief director must cause the value of such non-monetary benefits to be determined by an independent expert.
- 19.5 The TTIS office must keep a record of all gross revenues received from the commercialisation of NWU IP and all commercialisation expenses for the calculation of nett revenues.
- 19.6 Benefits must be shared between the NWU and IP creators (or their heirs) in the following manner:
  - 19.6.1 For the first R1,000,000 of gross revenues received by the NWU from the commercialisation of the IP:
    - 19.6.1.1 30% of such gross revenues to the IP creators of the commercialised IP;
    - 19.6.1.2 an amount equivalent to the commercialisation expenses must be recouped by the TTIS office;
    - 19.6.1.3 the remaining amount must be allocated as follows:
      - 19.6.1.3.1 25% to be distributed to the focus area or school to which the IP is linked (or divided equally if more than one focus area or school is involved);
      - 19.6.1.3.2 25% to be distributed to the faculty from which the IP in question emanated (or divided equally if more than one faculty is involved);
      - 19.6.1.3.3 50% to be distributed to the TTIS office for use towards achieving the objectives referred to in paragraph 4, including contribution to any incubation or seed funding programmes in place at the time.
  - 19.6.2 After the first R1,000,000 of gross revenues received by the NWU from the commercialisation of the IP –
    - 19.6.2.1 30% of nett revenues to be distributed to the IP creators of the commercialised IP;
    - 19.6.2.2 25% of nett revenues to be distributed to the focus area or school to which the IP is linked (or divided equally if more than one focus area or school is involved);
    - 19.6.2.3 25% of nett revenues to be distributed to the faculty from which the IP in question emanated (or divided equally if more than one faculty is involved);
    - 19.6.2.4 20% of nett revenues to be distributed to the TTIS office for use towards achieving it's the objectives referred to in paragraph 4, including contribution to any incubation or seed funding programmes in place at the time.
- 19.7 Benefits allocated to IP creators must be shared in equal proportion between the IP creators or their heirs unless otherwise agreed in writing between the IP creators (or their heirs) and the chief director.
- 19.8 The chief director is entitled to intercede on behalf of an IP creator (or heirs) if there is evidence that that the IP creator or heirs are being intimidated by another IP creator or if the proposed allocation is shown to be blatantly unfair.

- 19.9 IP creators may, by agreement among themselves, identify IP enablers for the IP in question, and share the portion of benefits received by them with such IP enablers, provided that all such agreements are in writing, specify the benefits to be shared with the IP enabler(s) and are signed by all the IP creators.
- 19.10 IP creators must provide a copy of any agreement contemplated in paragraph 19.9 to the TTIS office, but the TTIS office is not responsible for the distribution of benefits to IP enablers in terms of any agreement with the IP creators.
- 19.11 Benefits must be paid or distributed no later than 12 months after the date of receipt by the NWU of such revenues.
- 19.12 IP creators remain entitled to receive benefits after termination of their employment or contract with the NWU, after termination of a student's studies at the NWU and after the retirement of an employee or internal contractor.
- 19.13 On the death of an IP creator, the estate or the lawful heirs of the IP creator, as the case may be, are entitled to receive the benefits.