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# Intellectual Property Manual of the NWU

The North-West University (NWU) has adopted an Intellectual Property Policy (the “IP Policy”) on 9 September 2021 to regulate the ownership, protection, enforcement, use and management of the Intellectual Property (IP) of the NWU. This manual (the “IP Manual”) is aligned, and must be read in conjunction, with the IP Policy.

## 1. INTERPRETATION AND APPLICATION OF MANUAL

This document (“the IP Manual” or “the Manual”) contains practical background information, context and guidelines to augment the IP Policy and to enable all employees, internal contractors and students to comply with the IP Policy. The information contained in this Manual should therefore not be interpreted in isolation, but with due regard for the IP Policy, as well as the legislation and other policies, procedures strategies and statutes of the NWU, referred to therein.

This Manual includes direct references to the following national legislation and associated regulations:

- Copyright Act, 98 of 1978 (“the Copyright Act”).
- Intellectual Property from Publicly Financed Research and Development Act 51 of 2008 (“the IPR Act”).
- Labour Relations Act, 66 of 1995 (“the Labour Relations Act”).
- Higher Education Act 101 of 1997 (“the HEA”); and
- Currency and Exchanges Act 9 of 1933.

## 2. DEFINITIONS

The terms defined in the IP Policy and used in this Manual have the same meaning defined in the IP Policy. In addition, the following terms used in this Manual have the meanings set out below, unless the context indicates otherwise:

**“conflict of commitment”** is a perceptible reduction of time and energy devoted, by an employee/internal contractor, to the activities of the University to which the employee/internal contractor is committed to participate in terms of the current task-performance agreement between the employee/internal contractor and the University.

**“conflict of interest”** is a private or personal interest sufficient to influence the objective exercise of the official duties of an employee/internal contractor, whereby the person is placed in a position to make or influence an official decision which may serve private or personal interests above those of the NWU.

**“copyright”** is an unregistered right subsisting in a copyright work, which entitles the proprietor thereof, for a limited period, to exclude unauthorised persons from performing certain acts in relation to that copyright work, such as reproducing or adapting the copyright work.

**“copyright work”** is a literary, musical or artistic work; cinematograph film; sound recording; broadcast; programme-carrying signal; published edition; or computer program, which is eligible for copyright in terms of the applicable legislation.

**“Council”** is the council of the NWU which governs the NWU in terms of chapter 4 of the HEA, including, the devising of strategic plans, determination of policy, making the NWU’s statute, rules and processes, the delegations of authority, the monitoring of operational performance and management, and establishing committees and which, together with the senate and joint committees, ensure that the NWU achieves its purpose and values.

**“employee”** is a person employed by the NWU, as contemplated by section 213 of the Labour Relations Act, including persons employed on a permanent, fixed-term or part-time basis.

**“free research”** is research resulting in significant R&I outputs that are made freely available for use and distribution by any person, at no cost.

**“full cost”** is the full cost of undertaking research as determined in accordance with international financial reporting standards, and includes all applicable direct and indirect cost as may be prescribed by NIPMO.

**“IP disclosure form”** is a document of the form prescribed by the TTIS office from time to time, an example of which is annexed in Appendix 1.

**“IP register”** is a register containing record of significant registered and unregistered IP of the NWU; of all binding agreements to which the NWU is party and which affect the NWU’s rights to own, enforce or use IP; and the NWU’s freedom to operate in relation to fields of technology of interest to the NWU.

**“open research”** is research resulting in significant R&I outputs that are made widely available for use and distribution by any person.

**“patent”** is a registered right granted in respect of an invention, provided that it is new, involves an inventive step and is capable of industrial application, which entitles the patentee, for a limited period, to exclude unauthorised persons from making, using, exercising, importing, disposing of or offering to dispose of the invention, or an application therefor.

**“plant breeders’ right”** is a registered right granted in respect of an eligible plant variety, which entitles the proprietor thereof, for a limited period, to exclude unauthorised persons from performing certain acts in relation to that variety, including producing, reproducing, selling conditioning, or exporting that variety, or an application therefor.

**“registered design”** is a registered right granted in respect of an independently created design that is new and/or original and/or not commonplace in the art in question, which entitles the proprietor thereof, for a limited period, to exclude unauthorised persons from making, selling, using and/or importing articles bearing or embodying the design, or an application therefor.

**“R&I”** is research and innovation.

**“significant IP”** is intellectual property associated with, embodied in, or pertaining to, a significant R&I output.

**“student”** is a natural person registered for study with the NWU, towards the award of any qualification from the NWU.

**“trade mark”** is a mark capable of being represented graphically, used in relation to goods or services for the purpose of distinguishing those goods or services from the same kind of goods or services of another person.

**“trade mark registration”** is a registered right granted to the proprietor of a trade mark which entitles the proprietor, for a limited period, to exclude unauthorised persons from using that trade mark in association with the same or similar goods/services.

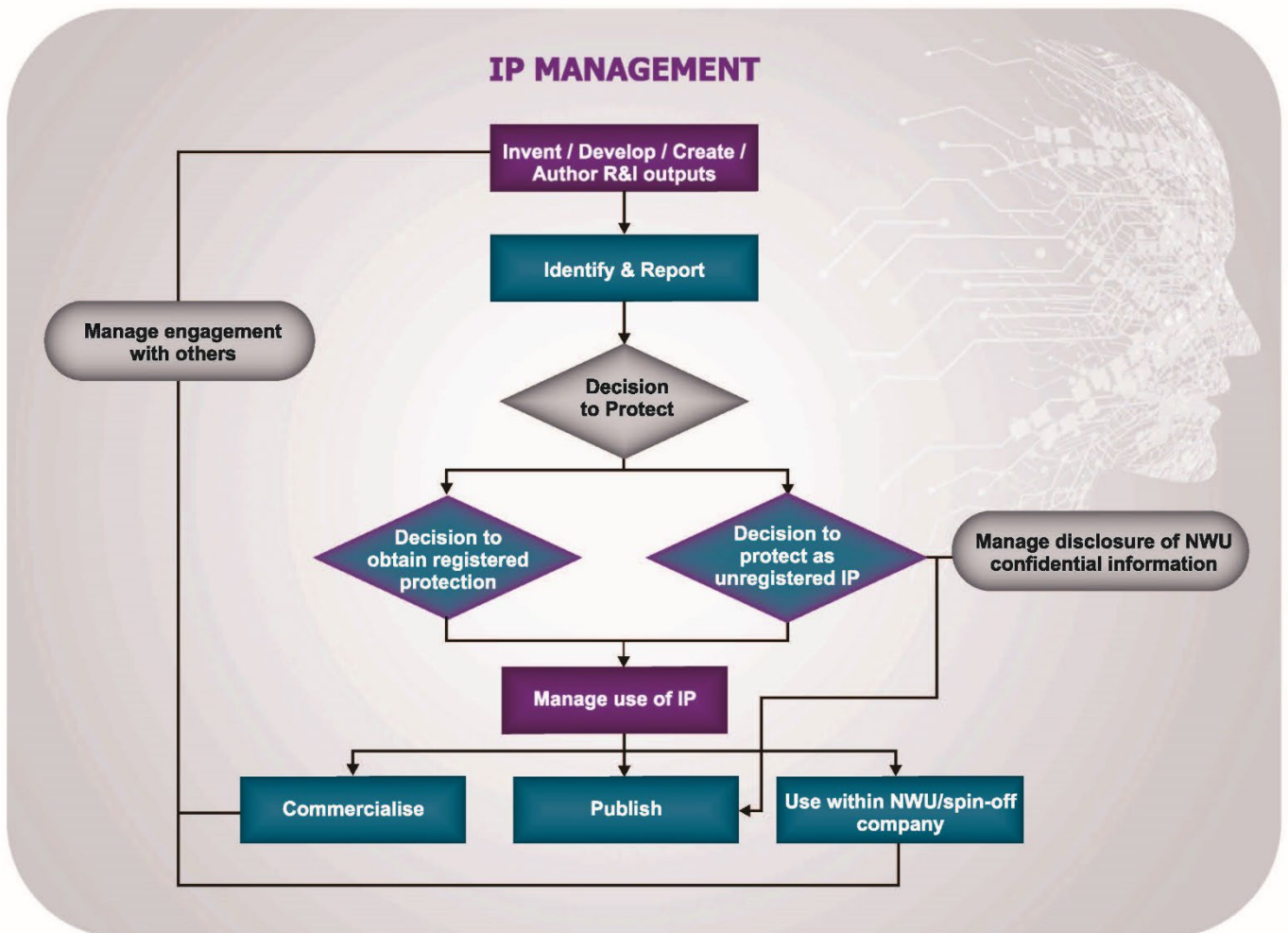
**“UMC”** is the University Management Committee of the NWU, which assist the Vice-Chancellor in the implementation of strategy and the planning and execution of management, administration and supervision of the NWU, in accordance with the NWU’s Statute.

### **3. MANUAL OBJECTIVES AND SCOPE**

The IP Policy contains policy statements stipulating the principles which apply to the management of intellectual property at NWU. In contrast, this IP Manual is intended to be a ‘hands-on’ management tool, providing context, background information, template documents and outlining processes, relevant to the implementation of the IP Policy principles.

Generally, IP management within NWU can be represented diagrammatically, as in Figure 1.

Figure 1



Using this IP Manual, employees, internal contractors and students should be able to:

- (i) In relation to the identification and reporting of IP, to:
  - identify significant IP;
  - understand how and when to report significant IP;
  - understand the consequences for the NWU, if significant IP is not properly identified and reported;
  - understand the NWU's obligations regarding the reporting to IP to NIPMO in terms of the IPR Act; and
  - understand how the ownership of certain IP associated with R&I outputs comes to be owned by the NWU;

- understand the effect of the IPR Act on the ownership of IP emanating from publicly-financed research;
  - understand how the NWU treats IP resulting from private contracting, bursaries, secondments, research conducted by visiting researchers and content created for short courses.
- (ii) In relation to the management of confidential information, to:
- identify confidential information of the NWU;
  - understand how to protect the confidential information of the NWU;
  - understand what information can be published and when it can be published;
  - understand the consequences of failing to properly protect confidential information;
  - determine whether or not a confidentiality agreement is required when receiving information from others; and
  - understand how to conduct free research within NWU.
- (iii) In relation to the management of research involving others, to:
- Understand the effect of the IPR Act on the ownership of IP emanating from publicly-financed research; and
  - Understand the principles upon which the NWU can contract with other parties, to conduct research.
- (iv) In relation to the use and commercialisation of the NWU's IP, to:
- Understand what is meant by 'commercialisation';
  - Understand the main mechanisms that the NWU could use to commercialise its IP;
  - Understand how the IPR Act entitles IP creators to benefit from their R&I outputs;
  - Understand how the IPR Act regulates the use and commercialisation of the NWU's IP;
  - Understand how trade marks and domain names could be used in the commercialisation of the NWU's IP and how they will be managed by the TTIS office;
- (v) In relation to the general management of NWU intellectual property:
- Understand the role, functions, duties and responsibilities of the TTIS office;

- Understand the role, functions, duties and responsibilities of the Advisory Panel (if one is appointed).

#### **4. IDENTIFYING SIGNIFICANT INTELLECTUAL PROPERTY**

- 4.1. Intellectual property describes a range of instruments that can be used to define, protect and exploit R&I outputs. The R&I outputs could take any of a range of forms such as an invention, a set of test results, a methodology or a software-implemented process and these outputs may qualify for intellectual property protection.
- 4.2. The law recognises various categories of rights to protect R&I outputs, including rights in patents, trade marks (both registered and unregistered), design registrations, plant breeders rights, copyright and know-how. The exclusive rights granted by intellectual property laws entitle the owner of the intellectual property to exclude others from infringing on the monopoly afforded by the intellectual property.
- 4.3. In some cases, intellectual property is registered, such as patents, plant breeders' rights, design registrations and trade mark registrations. In other cases, the owner of intellectual property is granted rights without having to register these rights, such as rights in know-how (which may include unpatented inventions and unregistered designs), copyright and unregistered trade marks.
- 4.4. Inventions and Patents
  - 4.4.1. A patent is an instrument used to protect an invention. It is issued by a Patent Office to prevent inventions being copied and reproduced. A patent right is restricted in a number of ways: Firstly, it is limited to the countries in which patents are granted for the invention. Secondly, it is limited to a maximum period of twenty years, subject to payment of renewal fees. Lastly, it is limited to the invention that has the features defined by the claims of the patent.
  - 4.4.2. Once a patent is secured in a particular country the patentee is entitled to a monopoly, which means that he can exclude unauthorised persons, for a limited period of 20 years, from making, using, exercising (in the case of an inventive method), disposing of (e.g. selling), offering to dispose of and importing, the invention in that country.
  - 4.4.3. An invention could be a process, method, machine, device, material, compound or composition. An invention is eligible for patent protection if it meets the requirements for patentability, which are: it must be novel, inventive and capable of a use in trade, industry or agriculture.



- 4.4.4. An invention is new if it is not previously known anywhere in the world. Searches are often conducted to determine if an invention is novel. The aim of the search is to identify “prior art”, which is technology or similar inventions that are already known. Identifying this prior art is a critical step in determining whether an invention is patentable and whether meaningful patent protection can be secured for the invention.
  - 4.4.5. An invention is inventive if it is not obvious to a person skilled in the particular field of the invention, in light of the prior art. An invention is inventive if it is not merely an arbitrary alternative to known solutions but rather alleviates disadvantages that are associated with known solutions.
- 4.5. Registered and Unregistered Designs
- 4.5.1. Many countries provide for the protection of the outward appearance of an article by way of a registered design. Registered designs protect the way an article looks - as opposed to patents that protect inventions, or the way in which an object is made or the manner in which it functions.
  - 4.5.2. In South Africa, a design can be protected only if it is applied to an article that is intended to be multiplied by an industrial process. In other words, once-off articles of craftsmanship are not protectable by way of design registration.
  - 4.5.3. Aesthetics designs relate purely to the aesthetic appearance of an article – what is commonly called the “eye appeal” of the article while functional designs are necessitated by the function of the article. In the case of a functional design, the article looks as it does so that it can function in a certain manner and not to be aesthetically appealing.
  - 4.5.4. To be registrable, a design must be new. In deciding whether a design is new it is not only compared with designs that are available in South Africa but with all known designs in the world. Functional designs have a further requirement that has to be met. In addition to being new the functional design must not be “commonplace”.
  - 4.5.5. In contrast with patentable inventions, designs are eligible for registration if they have been released to the public within the previous six month period. The release of the design could take a number of forms, including publishing the design or sale of articles to which the design has been applied. There are however disadvantages to filing a registration for a design after the release date and it is recommended that an application for registration be filed before any release.

4.5.6. As with patents, separate design applications must be filed in each country where design protection is sought. Final applications for design registration must be filed in each country within six months of the first application having been filed in South Africa.

4.5.7. Once a design registration is secured in a particular country the owner is entitled to a monopoly, which means that he/she can exclude unauthorised persons, for a limited period (in South Africa this is fifteen years for an aesthetic design and ten years for a functional design), from making, importing, using or disposing (e.g. sale) of an article included in the class in which the design is registered and to which the design has been applied, in that country.

#### 4.6. Plant Breeders' Rights

4.6.1. New varieties of plants produced by biological processes cannot be protected by a patent but may be eligible for protection by a plant breeders' right (PBR).

4.6.2. The variety could be produced by cross-breeding or could be discovered in nature.

4.6.3. To qualify for protection by a PBR, the variety must be new, distinct, uniform and stable.

4.6.4. To be "new", propagating or harvested material of the variety must not have been sold or otherwise disposed of by, or with the consent of, the breeder for purposes of exploitation of the variety:

- (i) in South Africa for more than one year;
- (ii) in certain other countries defined by PBR conventions/agreements, in the case of varieties of vines and trees, for more than six years; or
- (iii) in certain other countries defined by PBR conventions/agreements, in the case of other varieties for more than four years,

in each case, prior to the date of filing of the application for a PBR.

4.6.5. To be "distinct", the variety must be clearly distinguishable from any other variety of the same kind of plant of which the existence on the date is a matter of common knowledge.

4.6.1. To be "uniform", the variety must be sufficiently uniform with regard to the characteristics of the variety in question, subject to the variation that may be expected from the particular features of the propagation thereof.

4.6.2. To be “stable”, the characteristics of the variety must remain unchanged after repeated propagation or, in the case of a particular cycle of propagation, at the end of such cycle.

4.6.3. The owner of a PBR is entitled, during the term of the PBR and subject to certain exclusions, to exclude unauthorized persons from performing the following acts in relation to the protected variety:

- (i) production or reproduction (multiplication);
- (ii) conditioning for the purpose of propagation;
- (iii) sale or any other form of marketing;
- (iv) exporting;
- (v) importing;
- (vi) stocking for any of the purposes referred to in paragraphs (i) to (v), of propagating material of the relevant variety or of harvested material, including plants, which was obtained through the unauthorised use of propagating material of the protected variety.

4.6.4. The term of a PBR, calculated from the date of grant, is:

- (i) twenty-five years, in the case of vines and trees; and
- (ii) twenty years, in all other cases.

#### 4.7. Registered and Unregistered Trade Marks

4.7.1. Trademarks are words or other marks that are used to distinguish the goods or services of the trade mark owner from the goods and services of other vendors.

4.7.2. A mark is any sign capable of being represented graphically, i.e. capable of visual representation. A mark can be a device name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, slogan, musical jingle, colour or container for goods, or any combination of these.

4.7.1. Trade marks do not have to be registered (the owner of a trade mark may have common law (unregistered rights) in that trade mark. There are, however, advantages to registering a trade mark. The owner of a registered trade mark can, for as long as the registration is in force, exclude unauthorised persons using the trade mark in respect of the same or similar goods or services if that other trade mark so nearly resembles the registered trade mark as to be likely to deceive or cause confusion.

#### 4.8. Copyright

- 4.8.1. Copyright subsists automatically in any copyright work and does not need to be registered. A work must be in a material form in that a physical or tangible item exists. A work could be a literary, artistic or musical work, a computer program, a sound recording or a published edition (to name but a few).
- 4.8.2. To be eligible for copyright, a work must be original, meaning that it must not have been copied from another source, but must have resulted from the effort, skill, knowledge and endeavours of the author.
- 4.8.3. Copyright entitles the owner thereof to exclude, for the period of the copyright, unauthorised person from performing certain acts in relation to the copyright work, such as reproducing or adapting the work.
- 4.8.4. Rights of copyright do not, however, entitle the proprietor to exclude others from misappropriating methodologies or concepts which are embodied in the work (although this may constitute proprietary know-how which is protected under South African common law).
- 4.8.5. The exact term of copyright depends on the type of work concerned but can generally be considered as a period of at least fifty years from the moment of a certain event. In the case of literary, musical and artistic works copyright endures for a period of fifty years after the death of the author. In other cases, such as computer programs, copyright will expire fifty years from the end of the year in which the work was made available to the public with the consent of the copyright owner. If a work is not made available or published within fifty years from its creation, then the copyright in the work will expire fifty years after the creation of that work.
- 4.8.6. When the term of copyright in a work has expired, the work falls into the public domain and the former restrictions on its use and exploitation cease to have any effect.

#### 4.9. Know-How

- 4.9.1. Know-how is a category of intellectual property that is difficult to define because, at least in South Africa, there is no statute that determines the law pertaining to know-how and the prevention of misappropriation of know-how. Know-how is nevertheless protected in South Africa under the common law of unlawful competition.

- 4.9.2. Know-how can be described loosely as information that is not generally known or readily ascertainable, and which is of value to the creator thereof while it remains confidential, in that it provides a competitive advantage. For example, unpublished inventions and designs would qualify as know-how. Once rights are registered, the inventions/designs are published and will no longer qualify for protection as know-how.
- 4.9.3. It is important to protect know-how by keeping it confidential. This may mean limiting access to the know-how and restricting disclosure and use of the know-how through agreements with others.
- 4.10. From the remainder of this section 4, it should be apparent that IP (in the form of copyright, for example) is constantly created by students, employees and internal contractors of NWU. It is simply not possible to identify, report, protect and manage all IP created by NWU and efforts must therefore be focused on identifying significant R&I outputs and outputs that have the potential to result in significant IP and which align with the key focus areas for research and the strategic objectives of NWU.
- 4.11. When considering whether or not an R&I output is significant, the answers to the following questions should be considered:
  - 4.11.1. is it an invention that may be eligible for protection by registration of a patent because, on the face of it, it is novel, inventive and has use of application in trade, industry or agriculture?
  - 4.11.2. is it a design applied to an article that may be eligible for protection by a registered design because, on the face of it, it is new, original and/or not commonplace in the art?
  - 4.11.3. it is 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?
  - 4.11.4. it is an original work that has been reduced to material form which, on the face of it, it has the potential to be commercialised, and therefore be of commercial value to the NWU?
  - 4.11.5. it is information that is not generally known or readily ascertainable and it would be in the interests of the NWU for it to remain so?

If the answer is YES to any of these questions, then the R&I output should, at least initially, be deemed to be significant and therefore, reportable. That being said, R&I outputs resulting from undergraduate research conducted by students, will generally not be considered to be 'significant R&I outputs' for the purposes of IP management at NWU, although the NWU will retain the discretion to decide on this aspect as and when required. Any student, employee or internal contractor requiring a decision on whether an R&I output is deemed significant should contact the TTIS office for a determination thereon.

## 5. OWNERSHIP OF IP

### 5.1. Employment and Agreement

5.1.1. Generally speaking, the creator of an R&I output will, in the absence of any other factors, be the owner of the intellectual property associated with those outputs. However, where the IP creator is employed and the R&I outputs result from activities conducted in the course and scope of employment, then the associated intellectual property is owned by the employer.

5.1.2. An IP creator can, of course, assign his/her rights in the IP to another person. Where an internal contractor or a student (who are not employed by the NWU) create R&I outputs, the ownership of the associated IP will be determined by the agreement between the internal contractor/student and the NWU.

5.1.3. The IP Policy directs that the NWU will own all R&I outputs and associated IP which are created, made, discovered, invented or authored:-

- (i) by an employee, in the course and scope of the employee's employment; or
- (ii) by an internal contractor, in the course and scope of the contractor's arrangements with the NWU; or
- (iii) by a student, in the course and scope of the student's enrolment as a student

In other words, the IP Policy reflects the law on IP ownership in South Africa as it pertains to R&I outputs created by employees. The NWU owns IP associated with R&I outputs created by internal contractors and students, by virtue of their agreement to the NWU's IP Policy.

## 5.2. IPR Act

- 5.2.1. The IPR Act affects IP ownership with regard to the involvement of one or more other parties in the conduct of research. The IPR Act stipulates that intellectual property emanating from publicly-financed research will be owned by the NWU. In other words, where the NWU uses public funds (or publicly-financed resources, such as offices, laboratories, facilities and consumables) to conduct research, the NWU will own the associated intellectual property, by virtue of the IPR Act.
- 5.2.2. The IPR Act does provide for the co-ownership of jointly-created intellectual property in some circumstances and provided that certain conditions are met (please see paragraph 11.2, in this regard).
- 5.2.3. The IPR Act also directs that the NWU is not able to assign its rights in any intellectual property, without the prior approval of NIPMO (please see paragraph 12.3.1, in this regard).

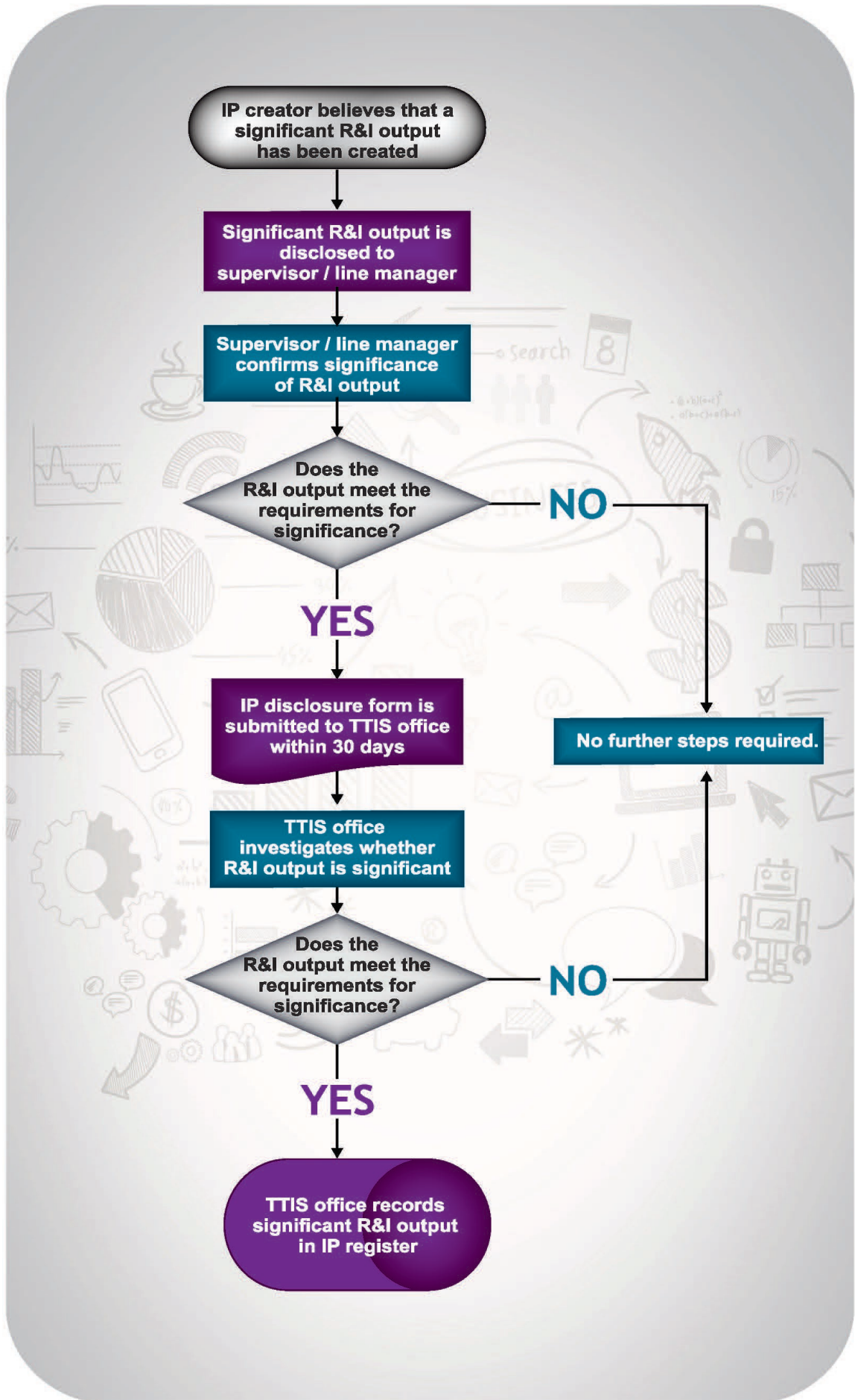
## 6. IDENTIFYING AND REPORTING IP

- 6.1. The South African Government contributes funding to the infrastructure and resources used to conduct research at the NWU. The NWU is therefore required to be compliant with the IPR Act.
- 6.2. The IPR Act requires the NWU to:
  - 6.2.1. put in place mechanisms for the identification, protection, development, management of intellectual property, intellectual property transactions and, where applicable, the commercialisation of intellectual property;
  - 6.2.2. provide effective and practical measures and procedures for the disclosure of intellectual property and ensure that intellectual property emanating from its research is appropriately protected before the results of such research are published or publicly disclosed;
  - 6.2.3. ensure that persons involved with the research make a disclosure to NIPMO within 90 days, of identification by such persons of possible intellectual property and before the intellectual property is made public;
  - 6.2.4. assess the intellectual property to determine whether it merits statutory protection and, where appropriate, apply for and use best efforts to obtain statutory protection in its name;
  - 6.2.5. refer disclosures for which it elects not to retain ownership or not to obtain statutory protection, to NIPMO within 30 days of it making such an election;

- 6.2.6. report to NIPMO twice a year on all matters pertaining to the intellectual property contemplated, including all intellectual property from which it elects to obtain statutory protection; and
- 6.3. Furthermore, NIPMO may, on behalf of the State, demand the assignment of rights to any intellectual property if the NWU fails to make a disclosure to NIPMO as provided for in the Act.
- 6.4. To fulfil the obligations placed on the NWU by the IPR Act, all significant R&I outputs resulting from research conducted at NWU must be identified, reported, protected, commercialised and managed. The NWU may also be obliged to report on such outputs to sponsors and funders who provide financial or other support for research at the NWU.
- 6.5. The IP Policy therefore requires employees, internal contractors and students to report significant R&I outputs created, made, discovered, invented or authored by them in the circumstances referred to in paragraph 7.1 of the IP Policy, to their immediate supervisor or line manager, while keeping these outputs confidential. If the supervisor or line manager agrees that the R&I output is significant, he/she will within 30 days and together with the student(s), employee(s) or internal contractor(s) involved, ensure that the R&I output is disclosed to the TTIS office.
- 6.6. Reporting R&I outputs to the TTIS office should be made using an IP disclosure form. The IP disclosure form, contains prompts for the information required in relation to the R&I output, including administrative details (e.g. identity and contact information of the creators) as well as information pertaining to the eligibility of the output for intellectual property protection (e.g. the way in which an invention can be distinguished from prior art and the advantages associated with that invention).
- 6.7. The TTIS office will keep an IP register, containing a record of all significant R&I outputs disclosed to it.
- 6.8. The procedure for reporting significant R&I outputs and recording these in the IP register is represented diagrammatically below:



Figure 2



The TTIS office will assess each significant R&I output disclosed to it, to determine whether or not steps should be taken to obtain registered intellectual property protection for the output. For example, the TTIS may elect not to obtain registered intellectual property protection for the R&I output, where:

- 6.8.1. The R&I output can be, and is best, protected by keeping it confidential;
  - 6.8.2. further research and development is required to be undertaken before registered protection can be applied for; or
  - 6.8.3. the intellectual property has no prospects of addressing the socio-economic needs of the country or of being commercialised.
- 6.9. If the NWU elects not to own the intellectual property or not to apply for statutory protection, it must refer this election and a disclosure of the relevant intellectual property to NIPMO within 30 days of it making this election and provide the reasons for its decision.
- 6.10. The TTIS office may request that the IP creator(s) provide additional information to inform its decision making in relation to the R&I output and IP creator(s) must cooperate in this regard. For example, the IP creator(s) must on request from the TTIS office, provide any information they have pertaining to:
- 6.10.1. The involvement of other parties in the creation of the R&I output;
  - 6.10.2. The circumstances and terms of any agreements relevant to the creation of the R&I output;
  - 6.10.3. The IP creator(s) intention to publish the R&I output and the timing thereof; and
  - 6.10.4. The commercial viability and prospects for commercialisation of the R&I output (such as the market size, competitive landscape, potential licensees and the like).

## **7. COPYRIGHT (INCLUDING IN SHORT COURSES AND TEXT BOOKS)**

- 7.1. Although the NWU will own copyright subsisting in copyright works created in the circumstances referred to in paragraph 7.1 of the IP Policy, the authors of those copyright works will retain their moral rights in the works. A moral right in a copyright work is the right which the author has to claim authorship of the work, and to object to any distortion, mutilation or other modification of the work where such action is or would be prejudicial to the honour or reputation of the author. The moral right of an author of a computer program (or a work associated with a computer program) may not, however, prevent or object to modifications that are absolutely necessary on technical grounds or for the purpose of commercial exploitation of the work.

- 7.2. Provided that the source of a copyright work is acknowledged, as well as the name of the author(s) of the work, the copyright will not be infringed by any 'fair dealing' in accordance with the provisions of the Copyright Act.
- 7.3. Where the NWU owns the copyright in a significant copyright work, that work will be marked with a copyright notice as determined by the TTIS office. For example, the notice could take the form "Copyright © [year] North-West University, All Rights Reserved" to notify others of the existence of copyright and of the NWU's ownership of such copyright.
- 7.4. Employees and internal contractors must, upon leaving NWU, ensure that they have fulfilled their obligations to report significant R&I outputs created before termination of their contract, in the manner prescribed herein, which may include providing to the TTIS office, all copies of significant copyright works authored or co-authored by them in the performance of their duties.
- 7.5. It is the responsibility of employees, internal contractors and students to ensure that any license conditions applicable to the use of third party open-source software (in which copyright subsists) is understood and is confirmed to not be in conflict with any provision of the IP Policy prior to using same. Where use of third party open-source software is contemplated, disclosure of same to the TTIS office is required prior to any use, and the TTIS office may prohibit, restrict or issue any conditions for such use as may be reasonably required to protect the interests of the NWU.
- 7.6. Notwithstanding the NWU's ownership of copyright in terms of the IP Policy, the NWU supports and promotes the creation of educational resources for learning and teaching through an open licensing framework such as creative commons and participation in such a framework.
- 7.7. Authors of copyright works in which the NWU owns copyright, are not entitled to use, reproduce or adapt such works, except (i) as is expressly provided for in the IP Policy; or (ii) for the purpose of education and tuition (whether at the NWU or at another educational institution and whether during the course of their employment/contract with the NWU or thereafter); or (iii) where the author has obtained prior written consent from the TTIS office for such use, reproduction or adaptation.

## **8. PRIVATE CONTRACTING, SECONDMENT, VISITING LECTURERS AND BURSARIES**

- 8.1. Lecturers or researchers visiting the NWU to conduct research (including adjunct faculty, visiting faculty, visiting researchers, post-doctoral fellows, and any other person making significant use of the NWU's resources) will be deemed to be internal contractors for the purpose of the IP Policy. Accordingly, the ownership of intellectual property associated with R&I outputs created in these circumstances will be governed by paragraph 7 of the IP Policy.

- 8.2. Where an employee or an internal contractor conducts research under a private contract, such research is deemed to fall outside of the course and scope of his/her employment or engagement with the NWU. Provided that no significant use of NWU resources is made in the conduct of such research, the NWU will not own the resulting IP.
- 8.3. Where an employee of the NWU visits or is seconded to another educational institution or research organisation to discuss research ideas or conduct research, the following will apply:
- 8.3.1. The employee must, prior to the visit/secondment, make appropriate arrangements regarding any intellectual property associated with R&I outputs created by him/her during that period and/or using the resources of that other institution/organization. Employees should contact the TTIS office for guidance or assistance in this regard.
- 8.3.2. All relevant facts will be considered when negotiating and agreeing to appropriate arrangements regarding such intellectual property, including the significance of the research to be conducted, the proposed contribution of the other institution/organisation to the research, the commercial feasibility of the R&I outputs, the ability of the other institution/organisation to commercialise the R&I outputs, and the provisions of the IPR Act.
- 8.3.3. Any obligation to assign the intellectual property associated with such R&I outputs to such other organisation/institution or agreement to co-ownership of such intellectual property with the outside organisation/institution, must be approved beforehand by the TTIS office, which will also obtain any NIPMO approvals that may be necessary.
- 8.3.4. In the absence of any agreement being concluded with such other organisation/institution, ownership of intellectual property created by the employee in these circumstances will vest with the NWU.
- 8.4. Where a student conducts research and creates R&I outputs using only funds allocated for a scholarship or bursary, the following will apply:
- 8.4.1. Intellectual property associated with such R&I outputs will fall outside of the scope of the IPR Act.
- 8.4.2. The student and the provider of the scholarship/bursary must, prior to the conduct of the research, make appropriate arrangements regarding any intellectual property associated with R&I outputs created by the student using the funding. Students should contact the TTIS office for guidance or assistance in this regard.

- 8.4.3. Any obligation to assign the intellectual property associated with such R&I outputs to the funder or agreement to co-ownership of such intellectual property with the funder, must be approved beforehand by the TTIS office.
- 8.4.4. In the absence of any agreement being concluded with such funder, ownership of intellectual property created by the student in these circumstances will vest with the NWU.
- 8.5. Where a student conducts research and creates R&I outputs using funds allocated for a scholarship or bursary, but there has also been significant use of NWU resources (for example, in the form of office space, libraries, equipment, consumables or the time/expertise of NWU employees/internal contractors), then the Intellectual property associated with such R&I outputs will fall within the scope of the IPR Act and will be subject to the NWU's IP Policy.

## **9. CONFIDENTIALITY AND PUBLICATION**

### **9.1. Disclosure of Confidential Information**

- 9.1.1. Employees, internal contractors and students of the NWU are expected to publish and present the results of their research in pursuit of research excellence. However, the NWU is required by the IPR Act to regulate the release of significant R&I outputs in instances where it is possible and appropriate for these R&I outputs to be commercialised or until such time as they can be protected from use by others, to facilitate/enhance the commercialisation thereof. The NWU may also have contractual obligations to others to retain the confidentiality of certain R&I outputs for a period of time. It is therefore important that the public disclosure of R&I outputs be closely controlled.
- 9.1.2. Employees, internal contractors and students must bring to the attention of their immediate supervisor or line manager, their intention to disclose the NWU's confidential information, either publicly or to another person under conditions of confidentiality. The supervisor/line manager will consider whether such information can and should be disclosed without restraint and if appropriate, authorise such disclosure. If the supervisor or line manager is of the view that the subject of the intended disclosure should not be disclosed (or should be disclosed under conditions of confidentiality), then the matter will be referred to the TTIS office.

9.1.3. The public disclosure of a significant R&I output will be held back until such time as the TTIS office has taken a decision regarding the possible registration of rights in relation to the output and/or the NWU's commercialisation strategy (e.g. to derive value from the output while retaining confidentiality for a period of time). The TTIS office will have due regard for the role of the NWU as a disseminator of knowledge, for the publication objectives of the IP creator(s) and for the obligations of the NWU in terms of the IPR Act.

9.1.4. If the TTIS office determines that a public disclosure can be made, it will obtain all necessary approvals from NIPMO and thereafter authorise the publication. If the TTIS office determines that the disclosure should be made subject to appropriate confidentiality obligations on the recipient, then it will authorize the disclosure and the legal office will assist the employee, internal contractor or student to conclude an appropriate agreement with the recipient.

## 9.2. Receipt of Confidential Information

9.2.1. Where an employee, internal contractor or student receives information from another person, and such other person requires that the NWU be bound by confidentiality obligations in respect of that information, consideration should be given to whether the execution of a confidentiality agreement could be avoided, having regard to:

- (i) whether or not the information to be disclosed is protected by registered intellectual property rights, such as patents or designs (the information may already be in the public domain); and
- (ii) whether or not the NWU is conducting research that has or is likely to give rise to the same information.

9.2.2. Only where the execution of a confidentiality agreement cannot be avoided and the information to be disclosed is of significant importance to the NWU should the execution of a confidentiality agreement be justified. In this case, the employee, internal contractor or student should approach the legal office for assistance in concluding an appropriate agreement for the receipt of information that is confidential to the other party.

## 9.3. Theses and Dissertations

9.3.1. Where a thesis or dissertation has been classified as confidential in accordance with the Rules for the Classification of Theses and Dissertations:

- (i) the confidentiality of the thesis/dissertation will, initially, be maintained for a period of 2 years from the date of classification unless otherwise specified by a contractual agreement with an interested person;
- (ii) after the initial 2-year period has expired or lapsed, the classification may be extended for a further period, if so requested by an interested person;
- (iii) after any 2-year extension of the confidentiality period, a further 1-year extension of the confidentiality period can be imposed on request thereto by an interested person.

9.3.2. The maximum period of confidentiality that can be imposed on a theses/dissertation is 5 years, unless otherwise agreed with the student.

#### 9.4. Material Transfer Agreements

9.4.1. In some circumstances, it may be necessary for the NWU to provide or receive tangible materials, to/from another person. For example, a sample of a particular variety of plant material may be provided by the NWU to a collaborator in a research project; a chemical composition may be provided by a customer to the NWU for testing/evaluation in a research project; or the NWU may provide a sample of material to a private laboratory for treatment/processing (standard services offered on a commercial basis by a service provider).

9.4.2. Where the material in question embodies or contains sensitive/proprietary information or where it is necessary to restrict what the recipient may do in relation to such material (e.g. the recipient may be restrained from conducting spectroscopic analysis on the material to determine its precise chemical composition), then the provision of such materials should be subject to a material transfer agreement.

9.4.3. Employees, internal contractors and students must bring to the attention of their immediate supervisor or line manager, their intention to provide such NWU materials to another person. The supervisor/line manager will consider whether such material can and should be provided without restraint and if appropriate, authorise the provision of the materials. If the supervisor or line manager is of the view that the materials should not be provided or should be provided under conditions of certain restraints aimed at preserving the NWU's confidential information, then the matter will be referred to the TTIS office.

9.4.4. Similarly, where employees, internal contractors or students wish to receive materials from another person under conditions of restraint, then they should bring this to the attention of their immediate supervisor or line manager. The supervisor/line manager will consider whether it is appropriate for the material to be provided to the NWU with/without restraints on the NWU's use of the material. If the supervisor or line manager is of the view that it is justified that the materials should be provided under restraints aimed at preserving the other party's confidential information, then the matter will be referred to the TTIS office.

## **10. OPEN RESEARCH**

- 10.1. Open research arrangements are aimed at increasing participation in research activities and make R&I outputs more widely accessible. The 'open' in this context, refers to the accessibility of R&I outputs, but does not imply that the outputs are unprotected by intellectual property rights or that their use is free of any charges or costs.
- 10.2. The NWU aims to balance the objectives of open research with any right it may have to prevent others from using its R&I outputs. Different types of R&I outputs will require different levels of openness/exclusiveness to ensure that such outputs are not exploited/misappropriated to the detriment of the NWU.
- 10.3. Where an employee, internal contractor or student wishes to conduct open research, they should make a request to the TTIS office providing all relevant details on the circumstances, either before the R&I outputs from the open research are published or before the employee/internal contractor or student acquires an obligation to do so later. For example, certain open source software licences and creative commons licences require the licensee to distribute adaptations of licensed works or make R&I outputs freely available to the public. In cases where an employee, internal contractor or student wish to use software under an open source licence, which will oblige him/her to publish any adapted software, they should first make a request to the TTIS office to do so.
- 10.4. Requests for the use of open source or creative commons licences in open research which is likely to result in the creation of significant R&I outputs, must be made in writing to the TTIS office.
- 10.5. Requests for the approval of open research, can be made on a case-by-case basis, on a project basis, or as 'blanket approval' for all research conducted by a particular department, for example. Whether or not the research should be approved as open research will be decided by the TTIS office having regard to the NWU's different objectives and obligations, its commitment to disseminate knowledge, promote innovation, improve the socio-economic circumstances of the people of South Africa and generate tangible benefits through the exploitation of its IP.



- 10.6. Before approving research as open research, the TTIS office will obtain any approvals required from NIPMO to ensure the NWU's compliance with the IPR Act, where required.

## 11. RESEARCH INVOLVING OTHERS

- 11.1. Research conducted at the NWU may involve another party, either as a collaborator, funder or client. Any such arrangement with another party should be entered into with a knowledge of all the facts and with an understanding of each party's rights and obligations regarding the ownership and use of the resulting IP. Furthermore, the IPR Act contains various provisions regulating the ownership and use of IP created in this matter, which provisions will need to be complied with by the NWU (please see paragraph 5.2 in this regard).

### 11.2. Collaborative Research

- 11.2.1. Where the NWU conducts collaborative research with another party (in other words, where that other party also makes an intellectual contribution to the research), the parties may agree that co-ownership of the resulting IP is the most equitable arrangement. The use and commercialisation of co-owned IP can present some challenges unless the parties have also agreed on how this IP will be used and commercialised by them and how they will both share in the benefits of any such commercialisation. In South Africa, a co-owner of IP is not entitled to use, commercialise, license or assign, their undivided share in the co-owned IP, without the consent of the other co-owner. In other words, a co-owner of jointly owned IP requires a licence from the other co-owner(s), to derive any benefit from the IP.

- 11.2.2. Furthermore, the IPR Act provides that the resulting IP can only be co-owned if:

- (i) there has been a contribution of resources, such as background intellectual property, by that other party;
- (ii) the other party is a co-creator of the intellectual property;
- (iii) appropriate benefit sharing arrangements are made for sharing benefits with IP creator(s); and
- (iv) the NWU and the other party conclude an agreement for the commercialisation of the intellectual property.

If all of these conditions are met, the parties are entitled to agree to co-ownership of the IP resulting from collaborative research. If the parties want the resulting intellectual property to be co-owned, the agreement between them should specify such co-ownership, subject to the fulfilment of the above-mentioned conditions.

### 11.3. **Contract Research**

11.3.1. Where the NWU conducts contract research for an external party which contributes financially to the cost of the research, the IPR Act provides that:

- (i) If that external party contributes the full cost of the research, the intellectual property will fall outside of the scope of the IPR Act and the parties are entitled to decide between them on the ownership and use of the resulting intellectual property; and
- (ii) If that external party contributes an amount that is less than the full cost of the research, the IP will fall within the scope of the IPR Act and the NWU (the 'recipient' in terms of the IPR Act) will be the owner of the resulting intellectual property.

### 11.4. **Funded Research**

11.4.1. Where the NWU conducts research using funds provided by another party, whether a private/public entity or a state funding agency, such as the Technology Innovation Agency or the National Research Foundation, the IPR Act provides that:

11.4.2. If that other party contributes the full cost of the research, the intellectual property will fall outside of the scope of the IPR Act and the parties will be entitled to agree between them on the ownership and use of the resulting intellectual property; and

11.4.3. If that party contributes an amount that is less than the full cost of the research, the intellectual property will fall within the scope of the IPR Act and the NWU (the 'recipient' in terms of the IPR Act) will be the owner of the resulting intellectual property.

11.5. Any written agreement between other parties involved in research, should be negotiated and concluded in accordance with the Policy for the Management of Research and Innovation Contracts and External Investment/Stakeholding, through cooperation between the Legal Office, the TTIS office and the employee(s) or internal contractor(s) and/or student(s) involved. The terms and conditions contained in the agreement will depend on the nature of the engagement, the extent to which the research is funded by the other party, each party's intellectual contribution to the creation of the resulting intellectual property and the negotiation between the parties.

## 12. **COMMERCIALISATION OF NWU IP**

The commercialisation of R&I outputs and the associated IP could take many forms. Although we refer to “commercialisation”, this term is defined to include any exploitation for commercial or social benefit. In other words, commercialisation is a process through which some benefit is derived from the R&I output. Gross revenues from commercialisation could take the form of purchase consideration, licence royalties, or shareholders’ dividends, for example.

## 12.1. Obligation to Commercialise in terms of the IPR Act

12.1.1. The NWU has obligations in terms of the IPR Act in relation to the commercialisation of its intellectual property. In particular, the NWU, through the TTIS office, is obliged to:

- (i) analyse disclosures of IP received, for any commercial potential and the likely success of such commercialisation;
- (ii) attend to all aspects of intellectual property transactions and the commercialisation of the intellectual property;
- (iii) manage revenues due to it from intellectual property transactions and the commercialisation thereof;
- (iv) negotiate and enter into intellectual property transactions with third parties on intellectual property belonging to the recipient;
- (v) report to NIPMO twice a year on all matters pertaining to the NWU’s intellectual property and the state of commercialisation thereof
- (vi) provide NIPMO with full reasons in respect of any intellectual property that is not commercialised; and
- (vii) put in place mechanisms to annually assess, record and report to NIPMO on the benefits for society of publicly financed research conducted in the NWU.

12.1.2. NIPMO will conduct reviews of non-commercialised intellectual property in consultation with the TTIS office. If such a review shows that the intellectual property in question can be commercialised but is not being commercialised by the NWU, then NIPMO will take steps to ensure that the intellectual property is commercialised. In this regard, NIPMO may require the NWU to grant a licence in any field of use to any person on reasonable terms or may demand assignment of such intellectual property (this is referred to as the State’s “walk-in rights”).

12.1.3. In any agreement governing an intellectual property transaction, the NWU must include the following statement:

*"The intellectual property under this transaction was created with support from the South African Government; (under the contract number, where applicable) awarded by (identify the Funding Agency or relevant government department, where applicable) and is subject to the requirements of the South African Intellectual Property Rights from Publicly Financed Research and Development Act, 2008 and its regulations ("Act 51 of 2008"). The South African Government has certain rights to the intellectual property in terms of sections 11(1)(e), 11(2) and 14 of Act 51 of 2008".*

12.1.4. Failure by the NWU to obtain from NIPMO, approval for an intellectual property transaction for which approval is required in terms of the IPR Act, will render such intellectual property transaction and relevant agreement void from its inception.

## 12.2. Commercialisation Mechanisms and Support

12.2.1. R&I outputs with potential for commercialisation may be brought to the attention of the TTIS office by employees, internal contractors or students. The TTIS office will:

- (i) independently assess the viability and commercial potential of the R&I output; and
- (ii) where appropriate, provide support to employees, internal contractors or students (which may take the form of training, assistance, advice, mentoring or incubation space), to develop an R&I output to a commercial product/service, to set up a commercial enterprise, and to commercialise the R&I output and/or associated intellectual property.

12.2.2. IP creators at the NWU re entitled to benefit from the commercialisation of R&I outputs. The three most common commercialisation mechanisms for public institutions and the manner in which the NWU and IP creator(s) would benefit, are set out below:

<b>MECHANISM</b>	<b>NWU BENEFITS</b>	<b>IP CREATOR(S) BENEFITS</b>
IP Assignment/Sale	The IP associated with R&I outputs is assigned to a purchaser in exchange for a purchase price or some other benefit, which is received by NWU.	For the 1 <sup>st</sup> R1m of the purchase price received by the NWU, the IP creator(s) receive 30%.  After the 1 <sup>st</sup> R1 million of purchase price received by the NWU, the IP creator(s) receive 30% of nett revenues.
Out Licensing	NWU grants a licence to a licensee, to perform certain acts in relation to the IP associated with the R&I output, which acts would otherwise constitute an infringement of the NWU's IP. The IP is licensed in exchange for a licence fee, which is received by NWU.	For the 1 <sup>st</sup> R1m of licence fees received by NWU, the IP creator(s) receive 30%.  After the 1 <sup>st</sup> R1 million of licence fees received by the NWU, the IP creator(s) receive 30% of nett revenues.
Spin-off Company	The NWU establishes a separate private entity in which the NWU has shareholding (a "spin-off company") to make, use, exercise, sell and/or market products/services which embody or result from, R&I outputs. Dividends are paid to shareholders of the spin-off company, including to NWU.	For the 1 <sup>st</sup> R1m of dividends received by NWU, the IP creator(s) receive 30%.  After the 1 <sup>st</sup> R1 million of dividends received by the NWU, the IP creator(s) receive 30% of nett revenues.  IP creator(s) may also own shares in the spin-off, in which case the IP creator(s) will benefit from dividends paid directly to it as shareholders.

### 12.3. IP Assignment/Sale

- 12.3.1. The NWU may not sell or otherwise assign its intellectual property to a third party without first referring the matter to NIPMO which shall have the opportunity to acquire ownership of the intellectual property if it believes that this is in the best interests of South Africa.
- 12.3.2. If the NWU wishes to assign intellectual property to a local assignee, the TTIS office must submit to NIPMO an application for approval of such assignment, and in the case of co-owned intellectual property the NWU must do so in consultation with the co-owner(s). In this application, the NWU must demonstrate that such assignment is in the public interest; or provide reasons as to why the intellectual property cannot be commercialised through other means such as an exclusive licence.
- 12.3.3. If the NWU wishes to assign intellectual property to a foreign assignee, the TTIS Office must submit to NIPMO an application for approval of such assignment, and in the case of co-owned intellectual property the NWU must do so in consultation with the co-owner(s). In this application, the NWU must clearly articulate the benefits of the commercialisation of the intellectual property to South Africa and demonstrate that:

- (i) there is insufficient capacity in South Africa to develop or commercialise the intellectual property locally; and
- (ii) South Africa will benefit from such an assignment;
- (iii) the benefits of the commercialisation of the intellectual property will be accessible to South Africans on reasonable terms;
- (iv) the irrevocable and royalty-free right of the State to use or have the intellectual property used on behalf of South Africa for the health, security and emergency needs of the Republic, has been provided for; and
- (v) the State's walk-in rights in terms of the IPR Act (and set out in paragraph 12.1.2) has been provided for.

12.3.4. Such an application for NIPMO approval must be lodged prior to initiating or concurrently with, where permitted, any application for final approval in terms of any other applicable regulatory approval, such as exchange control approval in respect of off-shore intellectual property transactions.

#### 12.4. Out Licensing

12.4.1. The NWU has the discretion to determine the terms and conditions for any non-exclusive licence granted on an arms' length basis, to a South African licensee, to intellectual property fully owned by the NWU. If the intellectual property is co-owned with one or more co-owners, its/their consent to these terms must be obtained.

12.4.2. The NWU is generally free to determine the terms upon which a non-exclusive licence is granted to a local or foreign licensee. However, the NWU will require NIPMO approval for **any licence** granted to **any licensee**, in which:

- the consideration payable by the licensee is not determined on an arms-length basis (for example, where a co-owner of the intellectual property also has an interest in the licensee entity); or
- there is no consideration payable by the licensee or the licence granted is royalty-free.

12.4.3. When granting an **exclusive** licence to a **South African licensee**, the NWU must:

- be satisfied that the prospective licensee is capable of developing the intellectual property further where required and of undertaking the commercialisation thereof;
- ensure that the licence agreement includes appropriate terms and conditions to:
  - the benefits of the commercialisation of the intellectual property will be accessible to South Africans on reasonable terms;
  - provide for the walk-in rights of the State to use or have the intellectual property used on its behalf, for the health, security and emergency needs of the Republic; and
  - provide for NIPMO's rights to demand that a licence be granted (referred to in more detail in paragraph 12.1.2, if the intellectual property is not commercialised within a reasonable period.

12.4.4. When granting an **exclusive licence** to a **foreign licensee**, the NWU must submit to NIPMO an application for approval of such license, and in the case of co-owned intellectual property the NWU must do so in consultation with the co-owner(s). In this application, the NWU demonstrate that:

- (i) there is insufficient capacity in the Republic to develop or commercialise the intellectual property locally; and
- (ii) South Africa will benefit from such a licence;
- (iii) the benefits of the commercialisation of the intellectual property will be accessible to South African on reasonable terms;
- (iv) the irrevocable and royalty-free right of the State to use of have the intellectual property used on behalf of the Republic for the health, security and emergency needs of the Republic, has been provided for; and
- (v) the State's walk-in rights (described in paragraph 12.1.2) been provided for.

## 12.5. Spin-off Companies

- 12.5.1. The merits of the establishment of a spin-off company either for commercialisation or for another purpose, will be investigated by the TTIS Office in response to a request from an employee or internal contractor. A strong factor in support of creating a spin-off company, is the interest and willingness of external investors to provide capital in exchange for equity in the spin-off company..
- 12.5.2. Where a spin-off company is provided with access to NWU resources, a written agreement containing the terms and conditions of the use or lease thereof will be concluded with the spin-off company.
- 12.5.3. All the principles pertaining to IP sale/assignment set out in paragraph 12.3 will apply equally to a transaction involving the assignment of NWU intellectual property to a spin-off company in return for shareholding. Any such transaction must also include a provision that in the event of the liquidation of that spin-off company, the intellectual property shall revert to the NWU.
- 12.5.4. Employees, internal contractors and students may have shares (often referred to as “founder shares” in a spin-off company, provided it is approved by the UMC, (and in appropriate circumstances, the Council). Such approval may be on such conditions as the UMC may impose, on recommendation from the TTIS. Such approval will always be conditional upon management approval of the line manager of any employee or internal contractor involved, in terms of the Conflict of Interest and Commitment Policy.
- 12.5.5. The NWU may approve IP creators having direct ownership of shareholding in a spin-off company, in lieu of their entitlement, in terms of the IP Policy, to receive a portion of revenues received by the NWU through the commercialisation of its IP. In this case, IP creators may exchange their entitlement to receive a portion of revenues generated by the NWU through commercialisation of its IP, for direct ownership of shares in a spin-off company (the IP creators’ equity in the spin-off company and the dividends received by virtue of such ownership may not be in addition to their entitlement to receive a portion of revenues received by the NWU).
- 12.5.6. The NWU is entitled, at its discretion, to determine the structure for the commercialisation of its IP. Each structure or investment made by the NWU to this end, may not be identical. For example, the NWU may opt to not take up shareholding in a spin-off company and receive benefits in the form of licence revenues.



- 12.5.7. Factors that may support an arrangement in which employees, internal contractors or students own shareholding in a spin-off company, include:
- 12.5.7.1. The need for operational involvement of the employee/internal contractor/student (i.e. he/she will spend dedicated time to further the business of the spin-off company);
  - 12.5.7.2. The financial risk carried by the employee/internal contractor/student (i.e. he/she is standing surety or investing funds/resources into the business); and
  - 12.5.7.3. the requirements of external investors.

12.6. Conflict of Interest/Commitment

- 12.6.1. Employees and Internal Contractors must perform the functions, duties and responsibilities specified in their contract with NWU, with all diligence and as a priority, and will not be permitted to compromise their efforts in doing so, in favour of themselves, or any other person, activity or pursuit.
- 12.6.2. Employees and internal contractors must not act in any way which would result in a conflict of interest or a conflict of commitment, which is a conflict between the interests/commitment of or to, that person or an entity through which he/she stands to benefit, on the one hand and the NWU on the other hand.
- 12.6.3. An employee or internal contractor may not act do any of the following for any collateral purpose or in advancement of their own financial interests:
  - (i) influence the activities of students or other employees or internal contractors, in the commercialisation of the NWU's IP;
  - (ii) withhold R&I outputs or provide R&I outputs on a preferential basis, thereby to prejudice the commercialisation of the NWU's IP; or
  - (iii) negotiate the terms of an arrangement or transaction between NWU and a company in which he/she owns shares, whether on behalf of NWU or the company.
- 12.6.4. Without having complied, in full, with the Conflict of Interest and Commitment Policy, employees and internal contractors will not be involved, as researcher, director, employee, financier, consultant, shareholder or in any other way, in any enterprise, or in his/her personal capacity:

- (i) which would result in a conflict between the interests of that person or that enterprise on the one hand and the interests of NWU or a spin-off company, on the other hand; or
- (ii) which sells, on a commercial basis, products or services which are not substantially different from the services offered by NWU or a spin-off company.

#### 12.7. Exchange Control Approval

12.7.1. Employees, internal contractors and students will request assistance from the TTIS office when considering a transaction in terms of which any right to ownership of IP is to be granted from the NWU to a foreign person. The grant of a 'right to ownership of IP' includes: an assignment of IP, the granting of an option to purchase IP; and the use of IP as security for an obligation in favour of that foreign person. The TTIS office will ensure that all exchange control approvals required in respect of the contemplated transaction have been obtained.

12.7.2. Employees, internal contractors and students will request assistance from the TTIS office when considering a transaction in terms of which the NWU will be required to make any payment to, or in favour, or on behalf of a foreign person, or place any sum to the credit of such person, such as in consideration of a license under intellectual property from a foreign licensor. The TTIS office will ensure that all exchange control approvals required in respect of this transaction are obtained.

### 13. DOMAIN NAMES AND TRADE MARKS

13.1. The NWU is the owner of various registered and unregistered trade marks and therefore reserves all its rights in respect of any marks that include its name, any logo, device, coat of arms, abbreviation or similar indication, or that otherwise suggest an association with the NWU. These include the names that identify the NWU and/or its various campuses, corporate identity, colours and logos. The NWU also has domain name registrations including these trade marks.

13.2. The NWU may license its trade marks to commercial partners, including licensing these trade marks to persons presenting short courses, in terms of the NWU's Policy on Continuing Education.

13.3. The TTIS Office is not responsible for the management of the trade marks and domain names associated with the NWU's name and corporate identity as described in paragraph 13.1, but is responsible for the management of trade marks associated with the commercialisation of R&I outputs.

- 13.4. Employees, internal contractors and students using the NWU's trade marks in the course of their duties or studies must comply with the guidelines and regulations laid down by the TTIS office from time to time. In particular:
- 13.4.1. NWU trade marks which are registered will be accompanied by registration notices (the symbol "®" following the mark, accompanied by a statement (usually at the bottom of the page) that the mark is a registered trade mark of the NWU.
  - 13.4.2. Where an NWU trade mark is not registered, it will be reproduced using "TM" or "SM" (for service marks) following the mark, to indicate that a trade mark interest in the word or symbol is being claimed.
- 13.5. Employees, internal contractors and students are not permitted to use the NWU's trade marks for private purposes or personal gain or any other activities that fall outside the course and scope of their employment, engagement or affiliation with the NWU, unless permission is expressly granted for such use.
- 13.6. Certain activities may constitute infringement or dilution of the NWU trade marks, and will not be permitted. In particular, others may not:
- 13.6.1. use a NWU trade mark or name in a manner that is likely to give the impression or otherwise imply an affiliation or association between it, its products or services, and the NWU or its spin-off companies, or any of their products, services, programs, materials, or other offerings.
  - 13.6.2. use a NWU trade mark or name in a manner that is likely to dilute, defame, disparage, or harm the reputation of the NWU or its spin-off companies.
  - 13.6.3. use any mark, name, or designation that is confusingly similar to the name of the NWU or a spin-off company or any NWU trade mark.
  - 13.6.4. register or use any domain name that incorporates any NWU trade mark.
- 13.7. Should an employee, internal contractor or student become aware of the unauthorised use of any of the NWU's trade marks, or use of its trade marks in any manner that does not comply with the IP Policy or the guidelines laid down by the TTIS office, it will notify the TTIS office thereof. The TTIS office will call on the relevant person immediately to cease such use and will take any additional steps that it deems necessary in order to protect and preserve the NWU's intellectual property rights.

## **14. IP MANAGEMENT ROLES AND RESPONSIBILITIES**

- 14.1. IP Custodian

The IP custodian refers to the deputy vice-chancellor: research and innovation of the NWU. He/she is responsible for the implementation of, and compliance with, the IP Policy.

14.2. Chief Director and TTIS Office

14.2.1. The chief director refers to the chief director: Technology Transfer and Innovation Support, who heads up the TTIS office of the NWU.

14.2.2. The TTIS office plays a pivotal role in the management of the NWU's IP. The duties, functions and responsibilities of the TTIS office are referred to throughout the IP Policy and this IP Manual and are summarised below:

- (i) putting in place mechanisms for the identification, protection, development, management of IP, IP transactions and, where applicable, the commercialisation of IP and appropriate capacity-building relating thereto;
- (ii) providing effective and practical measures and procedures for the disclosure of IP and ensure that IP emanating from any publicly financed research and development is appropriately protected before results of such research and development are published or publicly disclosed by other means;
- (iii) establishing and maintaining a database containing a record of significant R&I outputs emanating from the NWU and the associated IP and ensuring that it is current, up-to-date and contains all details required to ensure the effective management of the NWU IP;
- (iv) ensuring that IP creators make a disclosure to it of significant R&I outputs at least 90 days before they are made public;
- (v) assessing IP disclosure forms to determine whether R&I outputs are significant and whether they qualify for and merit statutory protection and, where appropriate, apply for and use best efforts to obtain statutory protection in the name of the NWU;
- (vi) referring disclosures of R&I outputs for which the NWU elects not to retain ownership or not to obtain statutory protection, to NIPMO within 30 days of it making such an election;
- (vii) managing revenues due to it from the commercialisation of the NWU R&I outputs and associated IP, including managing benefit-sharing arrangements with IP creators at the NWU;

- (viii) negotiating and entering into IP transactions with third parties in respect of NWU IP;
- (ix) reporting to NIPMO twice a year and as provided for in the IPR Act, on all matters pertaining to NWU IP, including all R&I outputs for which it elects to obtain statutory protection and the state of commercialisation thereof, in a manner stipulated by NIPMO;
- (x) providing NIPMO with full reasons in respect of any NWU IP that is not commercialised; and
- (xi) putting in place mechanisms to annually assess, record and report to NIPMO on the benefits for society of publicly financed research conducted by the NWU.
- (xii) Before the NWU relinquishes or abandons its rights in relation to any item of IP, or assigns its IP to another person, the TTIS office will: (a) consider all the factors prescribed in the IPR Act and any regulations and guidelines published by NIPMO, before taking the decision to do so; (b) notify NIPMO of its decision and the reasons therefor, within 30 days of taking the decision; and (c) when requested by NIPMO, assign the IP in question to NIPMO or as NIPMO may direct; and
- (xiii) refer any matter involving IP on which it requires broader input, discussion or recommendation, to the Advisory Panel for consideration.

### 14.3. Advisory Panel

14.3.1. The IP custodian may, but is not obliged to, appoint an advisory panel. Where an advisory panel is appointed, it will have the following duties and responsibilities:

- (i) considering all matters referred to it by the chief director or the IP custodian and making itself available for discussion and/or formulating recommendations to the appropriate handling of the matter, to the chief director or the IP custodian, as the case may be;
- (ii) considering and recommending an appropriate course of action for recourse where an employee, internal contactor or student fails to comply with the IP Policy; and

- (iii) where requested thereto by the chief director or the IP custodian, acting as a forum or adjudicating panel for the resolution of disputes arising from the interpretation of the IP Policy and/or the interpretation of this IP Manual.

## Technology Transfer & Innovation Support Office

### IP Disclosure Form

Date: \_\_\_\_\_

*The purpose of this form is to disclose new information to the North-West University relating to an innovation, project or business venture. This information will enable the University Technology Transfer & Innovation Support Office (TTIS) to provide support through ensuring that all intellectual property rights (including expertise) are sufficiently protected on behalf of the inventor and the University. Disclosure will also allow for the TTIS in partnership with the inventor(s)/entrepreneurs(s) to commercialise the ideas to its full potential and benefit of both parties. All information provided in this form shall be treated confidentially by the NWU.*

#### 1. CONTACT INFORMATION

<b>Name &amp; Surname</b>	
<b>School/Faculty</b>	
<b>Preferred e-mail address</b>	
<b>Office address</b>	
<b>Office phone</b>	
<b>Home address</b>	
<b>Cell phone</b>	

#### 2. INVENTION INFORMATION AND DESCRIPTION

**Title of the innovation**

*(The "Title of invention" is a brief, approximately two- to seven-word description of the invention. E.g. product/technology/service)*

Keywords

*List a number of keywords relevant to the innovation*

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**Non-confidential summary of the invention – abstract.** *The abstract/summary of the invention must give an overview of the invention’s concept and chief objective(s) or purpose(s), an introduction and background to provide context to the original developments that led to the invention and descriptions of the field(s) to which the invention pertains. The non-confidential summary of the invention should be one to two paragraphs in length and should not contain any proprietary information. The non-confidential summary should include its impact/commercial potential, which may be shared with companies who are interested in licensing the rights to the invention.*

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Type of innovation (please mark the relevant box)			
Invention		Business idea	
Procedural		Plant breeders right	
Registration		Intellectual property from research contract	
Diagnostic		Software	
New species		Therapeutic	
Multi-media		Written work	
Indigenous knowledge systems		Other: Please specify/describe below	



<b>Please indicate the relevant industry / field</b>			
<b><i>Life Sciences</i></b>		<b><i>Engineering</i></b>	
Biochemistry		Electrical Engineering	
Biotechnology		Electronic Engineering	
Food Science		Mechanical Engineering	
Microbiology		Process Engineering	
Physiology		Industrial Engineering	
<b><i>Energy and water</i></b>		<b><i>Software and Models</i></b>	
Biofuels		Educational	
Solar Energy		Geographical	
Wind Energy		Media	
Hydro/Ocean energy		Games	
<b><i>Natural Science</i></b>		Mobile Applications	
Chemistry and Polymer Science		Psychological tools	
Nanotechnology		<b><i>Health Sciences</i></b>	
Physics		Diagnostics	
Aquaculture		Medical Devices	
Integrated Pest Management		Services	
Cultivars		Methods	

Other industries not listed above:

<b>Indicate the type of support required from the NWU Technology Transfer Office</b>			
Techno-economic evaluation studies		Initial product, process (comprehensive technology package) and prototype development	
Sourcing of intellectual property opinions		Production of market samples and/or associated testing	
Refining and implementing designs		Conducting field studies to test the assumption made about the technology, market and/or customer need	
Support of certification activities and specification sheet development		Piloting and technology scale-up	
Market research		Business plan development	
Other (please specify below)			

Novel aspects or unique characteristics of the invention – features

*The “Novel aspects of the invention” should identify specifically those properties of the invention (or the processes by which it is made or used) that are novel and distinguish it from existing technologies.*

Which problems does this innovation solve?

Which additional benefits are offered by the innovation?

Please indicate the development stage of the innovation below:

TRL	Technology Readiness Level	Description	TRL Stage
1	Basic Technology research	Basic science. Not application focused. Principles are observed and reported on.	
2	Concept formulation	Some practical applications identified materials or processes required and confirmed. Technology and hypothesis formulated. Research plans and protocols are developed, peer reviewed and approved.	
3	Analytical and experimental critical function or research proof of concept established	Laboratory measurements validate analytical predictions of separate technology elements. Hypothesis tested.	
4	Validation in laboratory environment	Test results confirm design and meet technical performance.	
5	Laboratory scale validation in relevant environment	Test results confirm design and meet technical performance.	
6	Integrated prototype system verified in relevant environment.	Validation under relevant operational conditions, mimicked in the laboratory.	
7	Integrated pilot system demonstrated in operational environment	Integrated full-scale pilot systems demonstrated in an operational environment or site.	
8	Actual system completed and validated through test and demonstration	Actual product completed and qualified through certification, tests and demonstrations.	
9	Proven system and ready for full commercial deployment	Product proven ready through successful operations in operating environment.	

Does your team have the expertise or capacity to further develop the technology?

Does the project require additional funding? If yes, please provide detail of the amounts and a description of the activities to be funded?

Detailed technical description of the invention

*The “Detailed description of the invention” is a thorough description of the invention, as well as the way in which it is made/executed and used. The description should be detailed in such a way that a person who is skilled in the field would be able to make and use the invention as a result of reading it. Please be as clear, exact and thorough as possible in your description, and please be sure to identify clearly which element of your research “the invention” is. **Only details that are included in this section will be protected under any patent application that the NWU may file as a result of this invention disclosure.** If you wish to submit any figures, charts or other supporting materials, please include those materials with this document and define their descriptions/relevance here.*

### 3. BACKGROUND TO THE INNOVATION

Which publications or patents concerning the innovation are you aware of?

Please attach or provide URL links.

Which similar products/services/technologies (prior art) related to the innovation already exist? How does your innovation differ from these?

Has the idea been disclosed either in writing or verbally or published in any abstract, paper, presentation, thesis, speech, article or any other form of publication in full or in part? In addition, if so, where and to whom?

When do you plan to publish research results related to this specific technology?

Please list the most relevant published scientific works in the field of the technology.

Are you aware of any academic research groups or business enterprises conducting research in the field of the technology?

If yes, list them.

#### 4. MARKET ANALYSIS

Who would pay to have this problem solved?

Which companies are you aware of that provide a similar product/service/technology? Please, list any known enterprise engaged in the development and/or exploitation of comparable technologies in the field of this specific technology.

What are the possible markets for the concept (are there multiple user/clientgroups)?

What do you think is the Market Size?

Does the concept make economic sense? E.g. taking into account the cost of the technology and operational costs, would the concept be able to make a profit in the long run?

**5. RESEARCH FUNDING AND COLLABORATION**

Please, specify the financial resources used for the research and development of the technology.

Type of fund	Duration of the relating contract	Name of the organisation providing financial contribution

Please, list all third parties collaborating during the research work.

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Have any materials (reagent, cell line, antibody, plasmid, chemical compound, computer software, etc.) been transferred to a third party during the development of the technology? If yes, please give details of it.

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## 6. INVENTOR(S) AND NON-INVENTOR(S)

Who are the inventors of the technology? (Please, list all inventors, who made intellectual contribution to the creation of the technology).

Inventor	Name	Relationship between the Inventor and the NWU	Percentage of contribution (%)	Department	Email address
1					
2					
3					
4					

Please, list all researchers, who participated in the development of the technology as enabler only in addition to the inventors.

Name of the researcher	Type of legal relationship between the Researcher and the NWU	Department/organisation	Email address

*I, the undersigned inventor, hereby declare that I am aware of the provisions of the IP Policy of the NWU and I agree to provide my full support in all intellectual property protection and commercialisation activities.*

\_\_\_\_\_  
 Name of inventor                      Date                      Signature

\_\_\_\_\_  
 Name of inventor                      Date                      Signature

\_\_\_\_\_  
 Name of inventor                      Date                      Signature

\_\_\_\_\_  
 Name of inventor                      Date                      Signature

**7. MANAGEMENT CONSENT/APPROVAL**

I, the undersigned line manager, hereby declare that I am aware of this invention/project and I recommend that this business ideas or innovation be investigated for further commercialisation exploitation.

Completed by Director/Line Manager

<b>Name of Director/Line Manager:</b>	
<b>Faculty:</b>	
<b>Signature:</b>	
<b>Date:</b>	

Completed by Dean

<b>Name of Dean:</b>	
<b>Faculty:</b>	
<b>Signature:</b>	
<b>Date:</b>	

Original details: (12401307) K:\TTIS\TTIS RMS\10. Implementation of Expertise\10.0 Templates\10.0.2 Disclosure Templates\Invention Disclosure Template.docm  
11 June 2019

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