



NEW SOUTH WALES GOVERNMENT
PREMIER'S DEPARTMENT

Intellectual Property Management Framework for the NSW Public Sector



Acknowledgements

The Intellectual Property Management Framework project was managed by Jennifer Perry from the NSW Premier's Department, and included contributions by Caireen Urquhart, Anita Westera, Cris Mauros, Ariel Ellis, Allison Manwaring, Sabine Mueller and Catriona Sparks. The Premier's Department gratefully acknowledges the assistance of other NSW and Australian government agencies, in particular:

- Members of the NSW Government working group - representing the NSW Cabinet Office, Treasury, TAFE, Attorney General's Department, and the former Department of Public Works and Services (now Department of Commerce) and the Department of Information Management and Technology (now Department of Lands)
- Audit Office of NSW
- Australian Copyright Council
- Commonwealth Department of Communications, Information Technology and the Arts
- Copyright Law Branch, Information Law and Human Rights Division, Commonwealth Attorney General's Department
- IP Australia
- Northern Territory Government
- NSW Crown Solicitor's Office
- Office of Trade Negotiations, Commonwealth Department of Foreign Affairs and Trade.
- Plant Breeder's Rights Office, IP Australia
- Queensland Government Department of State Development and Innovation
- Tasmanian Government, and
- Victorian Government Department of State and Regional Development
- Western Australian Government Intellectual Property Support Unit, Department of Industry and Resources

The Premier's Department also gratefully acknowledges the ongoing assistance of Lea Armstrong at the Crown Solicitor's Office in the development of the Framework.

This document is available on the NSW Premier's Department website at www.premiers.nsw.gov.au.

New South Wales Premier's Department
Cataloguing-in-Publication entry:

New South Wales. Premier's Department. Service Delivery Improvement.
Sydney: NSW Premier's Department, 2005.
ISBN 0 7313 3237 7

1. Intellectual property - Government Policy - New South Wales
 2. Intellectual property - Management
- I. Part 1. Principles and Better Practice Guide. II. Part 2. Resource Kit. III. Part 3. Summary Guide.

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Foreword by the Director-General

The intellectual property (IP) of the NSW Public Sector is a significant asset. It needs to be managed responsibly, in the same way NSW Public Sector agencies manage the State's tangible assets, such as its finances, buildings, infrastructure and the environment.

The *Intellectual Property Management Framework for the NSW Public Sector* has been developed to assist agencies to manage their IP effectively. It is the product of an extensive consultation process with NSW Public Sector agencies, and draws on the expertise of specialist practitioners from across Australia.

No one model can meet the variety of IP issues facing the diverse range of NSW government agencies where IP ranges from copyright in relation to a publication, a patented invention or a plant breeder's right arising from a new plant variety. Accordingly, the Framework has been developed to include Principles and a Better Practice Guide. The Principles are mandatory for all general Government Sector agencies and are the key elements of an effective IP management system, covering areas such as IP policy and strategy, creation and rights, identification and recording, publication, commercialisation and reporting. The Better Practice Guide is not mandatory. It provides further guidance in relation to each of the IP Principles and agencies can implement those aspects of the Better Practice Guide which support their core functions and service delivery outcomes.

There are many resources available to assist agencies manage their IP both at a State and Commonwealth level. The Framework also includes a Resource Kit which identifies these key resources in one place and includes detailed information about the different categories of IP, key contacts at a State and Commonwealth level, relevant legislation, policies and websites. The Resource Kit is a useful first point of reference when considering a particular IP issue.

Implementation of the Framework will ensure that the intellectual property of the NSW Government is effectively managed in order to optimise the economic, social and environmental benefits to the people of NSW.

I would like to thank the officers and agencies involved in the development of this Framework.

Col Gellatly
Director-General

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Part 1: Principles and Better Practice Guide



Intellectual Property Management Framework for the NSW Public Sector

Introduction

About the Framework

Aim

The Framework identifies and encourages better practice in relation to the creation, use, sharing, protection, and commercialisation of Intellectual Property (IP) in the NSW public sector to optimise the economic, social and environmental benefits to the people of NSW. It should also help agencies to determine when professional (for example, legal, financial, or commercial) advice about IP should be sought.

Structure

The Framework consists of:

Part 1 - a set of **mandatory Intellectual Property Principles, which all General Government Sector agencies must implement**, and a **non-mandatory Better Practice Guide** that identifies better practice in the management of IP and includes information and advice about the creation, use, protection, and commercialisation of IP. Agencies can implement those aspects of the Better Practice Guide which support their core functions and service delivery outcomes. Part 1 also includes a **Glossary** which provides explanations and definitions of terms used in the Framework.

Part 2 - an **IP Resource Kit** which provides more detailed information about the different categories of IP, the relevant legislation, legal definitions, references, key contacts at a State and Commonwealth level, and related policies and websites.

Part 3 – a **Summary Guide** which includes the IP Principles, Better Practice Checklist, and Advisory Signposts (where to go for more information).

Development

In October 2001, the NSW Audit Office released a Performance Report, *Management of Intellectual Property* (available at www.audit.nsw.gov.au). In response to this report, the Premier's Department established an inter-agency working group to develop an IP management framework based on a risk-management approach. It was clear from the consultation with agencies that a "one size fits all" approach to IP management in NSW would not work. Hence, while the principles in the Framework must be followed by all General Government Sector agencies, the Better Practice Guide identifies better practice in the management of IP and can be adapted as appropriate by all agencies.

Application

IP Principles

All General Government Sector agencies are required to implement the Principles. Although State Owned Corporations and Public Trading Enterprises are not required to apply the IP principles, they are encouraged to do so.

Better Practice Guide

The Better Practice Guide is not mandatory for agencies. However, all agencies, including State Owned Corporations and Public Trading Enterprises, are strongly encouraged to implement those aspects of the Better Practice Guide which support their core functions and service delivery outcomes.

Superseded Policies or Documents

About Intellectual Property

What is Intellectual Property?

Intellectual property (IP) is one of those concepts whose content is largely familiar (copyright, patents etc) but which is exceedingly difficult to define. Broadly speaking, IP is a generic term for the various rights or bundles of rights which the law accords for the protection of creative effort – or, more especially, for the protection of economic investment in creative effort. (McKeough J & Stewart A, *Intellectual Property in Australia* (Butterworths 2nd edition), p1)

IP is often referred to as an intangible asset.

Intellectual property covers:

- *copyright and related rights, including moral rights*, in relation, for example, to manuals, publications, educational resources, databases, digitised material (including CD ROM products), software, archives, and manuscripts
- *patents*, covering, for instance, the invention of new devices or processes
- *trade marks*, which protect brand names and business, company, or domain names
- *designs*, such as the design for a product (a chair, for example)
- *circuit layout rights*, relating to the three-dimensional configuration of electronic circuits, and layout designs for computer chips
- *plant breeder's rights*, in relation to a new plant variety, for example, and
- *trade secrets and confidential information*.

The Glossary and the Resource Kit provide definitions and further information.

How are IP rights created?

IP rights are created in different ways depending on the category. For example, copyright and circuit layout rights are automatic and do not require registration. On the other hand, patents, designs, and plant breeder's rights must be registered for the legal rights of ownership to apply.

In the case of trade marks, registration is not compulsory, but is advisable because it can be both expensive and time consuming to take legal action. Common law provides protection against the infringement of trade secrets, and for breach of confidentiality agreements.

IP rights can be owned by an individual or jointly. Similarly, an individual or entity can obtain a licence to use the IP. For example, a licence can be obtained from the copyright owner of a particular software program for home use only.

Managing IP—Framework guidelines

Why is IP management important?

IP is a major resource and a valuable asset. It is important that all assets belonging to the State of NSW, including IP assets, are managed effectively to maximise the economic, social, and environmental benefits to the people of NSW.

The obligations of agencies to manage assets effectively are set out in the:

- Results and Services Plan Agreement
- *Public Finance & Audit Act 1983*
- *Public Sector Employment & Management Act 2002*
- Total Asset Management (TAM) Policy (in relation to tangible assets)
- Annual Reports legislation.

Managing IP well can bring significant benefits, while failure can be costly.

Managing IP

Effective IP management involves the following four key areas:

1. Planning/risk management
2. Responsibility
3. Communication
4. Evaluation and reporting.

1. Planning/risk management

An agency's IP management should be consistent with the sector-wide policy contained in this Framework and, wherever possible, be incorporated into the agency's corporate planning, systems, policies, and objectives (see the flowchart below).

Agencies should adopt a risk management approach when implementing the Framework and allocate appropriate resources to manage the risk. For example, if the extent of an agency's IP is copyright in relation to its publications and website and the licences bought by the agency to use computer software, then minimal resources may need to be allocated to manage the risk and implement the Framework. (*The Risk Management and Internal Control Toolkit*, developed by NSW Treasury, is a useful guide — available at www.treasury.nsw.gov.au.)

When developing the IP policy and IP policy implementation strategy, the agency should take into account its core functions, service delivery obligations, and other relevant outcomes. For example:

- an agency does not need to incorporate plant varieties, designs, and patents into its policy if it does not own, control, or use these types of IP
- if a core function of an agency is to encourage economic development in NSW it may be agency policy, in certain circumstances, to transfer its IP to another party for a non-commercial (nominal or cost-recovery) fee, or free of charge
- if it is expected that people will make significant decisions based on an agency's publications or on information on the website, the agency's IP policy in relation to these publications should stipulate more stringent requirements for approval and have a specified review or withdrawal date.

An IP success story

An agency in NSW developed a business function thesaurus for the NSW public sector. The thesaurus can be built into other records management software packages used to store and retrieve information easily.

The thesaurus has attracted international attention. Over sixty licences have been sold beyond the sector nationally and internationally, including whole-of-government licences to the Commonwealth and governments in the Northern Territory and Alberta, Canada. These sales have generated significant revenue.

Under the terms of the licence agreement, licensees must provide the agency with any modifications they make to the thesaurus.

The dangers of not managing IP rights

A Victorian government department entered into a software licence and development contract which involved the outsourcing of a critical operational system. A subsequent review found that the department was exposed to significant risks:

- it did not own the software which drove critical systems, resulting in costs to the department of more than \$50million
- it had no right to profit from enhancements to the system made by the department
- it was prevented from reverse engineering and cloning the software for other applications, and
- it was restricted to one contractor for external support.¹

¹ Victorian Auditor-General's Office, 1996, *Special Report 46 Law Enforcement Assistance Program* cited in New South Wales Audit Office, 2001, *Performance Audit Report: Management of Intellectual Property*, p.44.

2. Responsibility

Management of IP should be a high priority within agencies. Responsibility for day-to-day IP management should be assigned to a senior officer or a team with appropriate skills and knowledge.

3. Communication

Everyone in the agency should be aware of the IP policy and IP policy implementation strategy. The agency's communication strategy in relation to IP will depend at least partly on the significance of IP to the agency and may include:

- incorporating key IP themes into staff inductions, in-house briefings, and forums for staff
- circulating booklets and pamphlets on IP within the agency
- developing standard contracts that address IP issues (State Procurement can help with this)
- providing relevant staff with training in contract management and related IP issues, and
- dedicating part of the agency's intranet to IP and providing links to websites which provide more information and updates on developments in IP.

4. Evaluation and Reporting

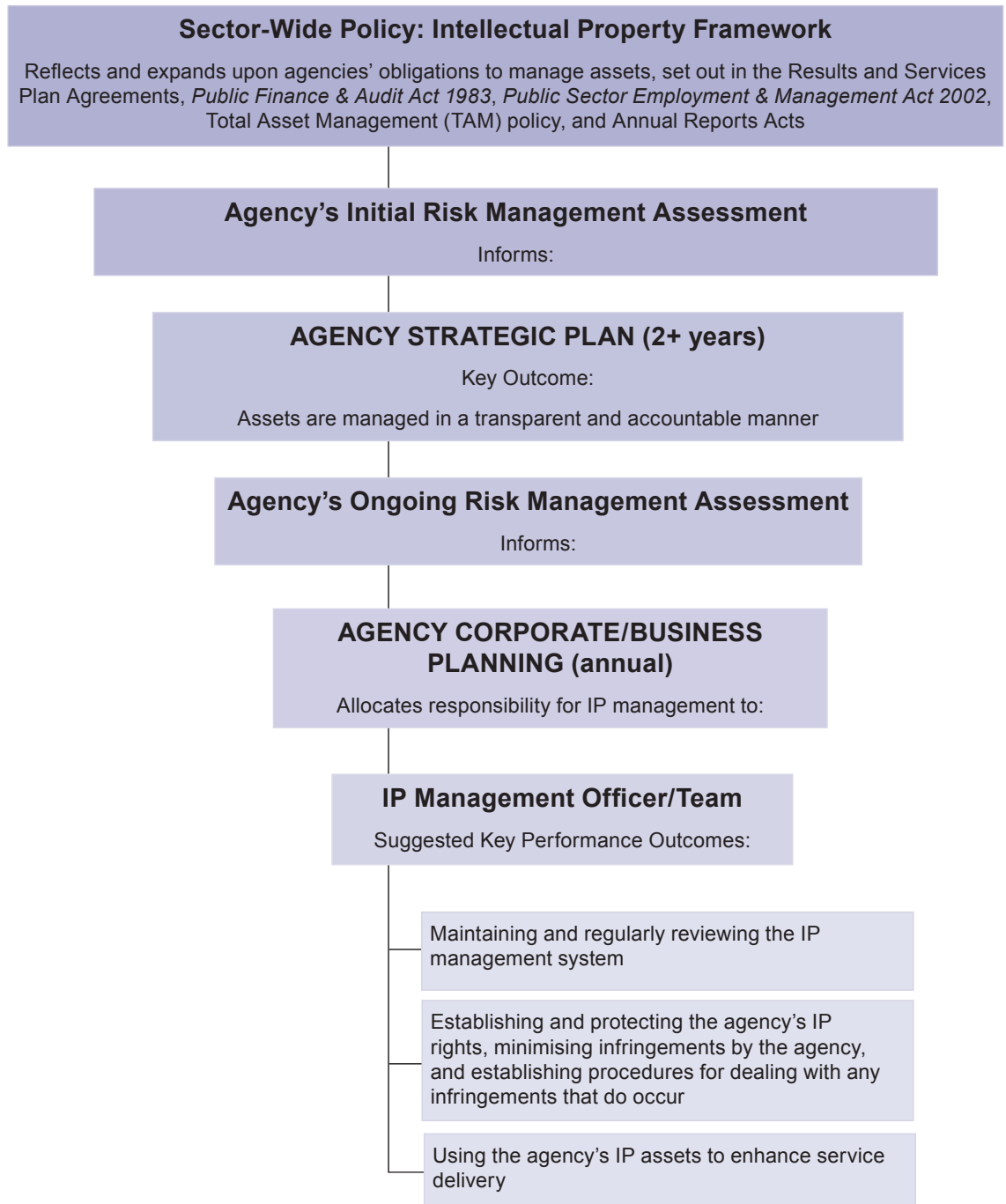
The agency should develop a system to record, report on, and evaluate IP, with aim of continuously improving the effectiveness of its IP management.

The outcomes from the system should be used to improve training programs and lead to an increased awareness and understanding of effective IP management.

Note:

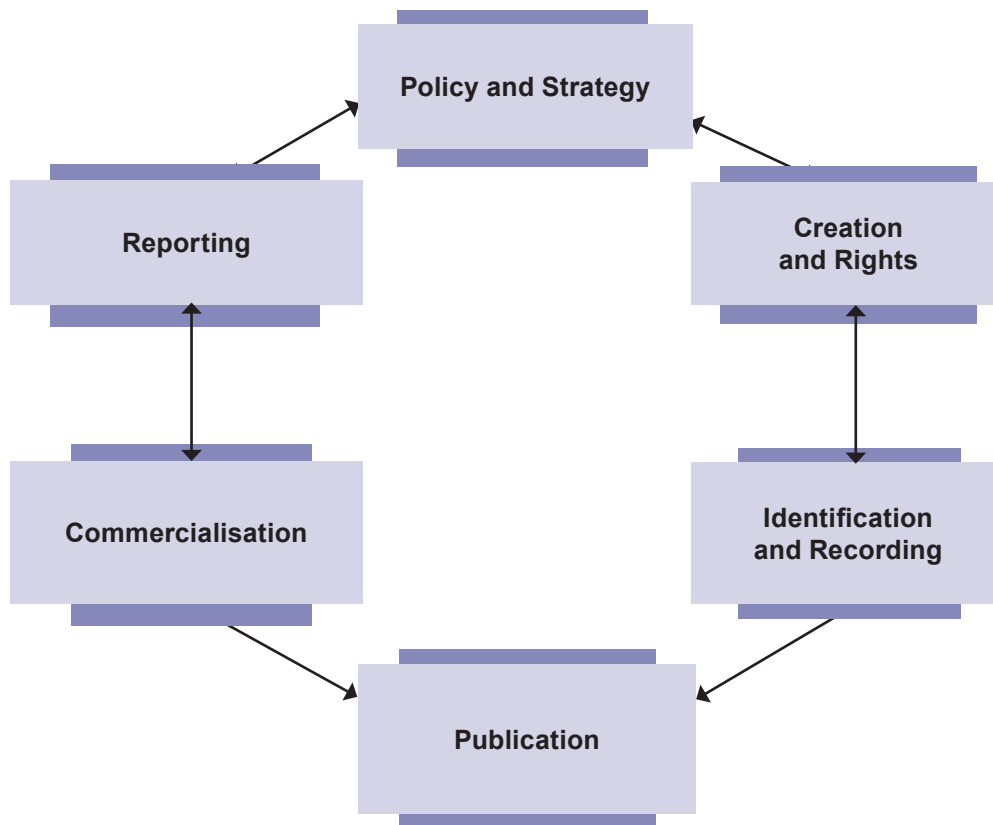
This Framework addresses the management of IP but not the related accounting requirements in an agency's general purpose financial report. For general purpose financial reporting, agencies should refer to the Australian Accounting Standards, in particular AASB 138 "Intangible Assets" (applicable for reporting periods beginning on or after 1 January 2005). For further information see the NSW Treasury website: www.treasury.nsw.gov.au.

Managing IP and implementing the Framework



Intellectual Property Principles

The IP Principles are mandatory for all General Government Sector agencies. The Principles are related to each other and cover the following areas:



IP Principles

Policy and Strategy

1. Agencies are to develop an IP policy based on this Framework which supports their core functions and service delivery outcomes.
2. Agencies are to develop an implementation strategy for their IP policy.

Creation and Rights

3. By law, the State of NSW owns any IP developed by its employees in the course of their employment unless it is specifically agreed otherwise. Moral rights are an exception; they automatically belong to the creator in the absence of an agreement to the contrary.
4. Agencies are to ensure that their employees are aware of their legal obligation to respect the IP rights of others, including their moral rights.
5. In all circumstances in which IP might be created or acquired (including employment, out-sourcing, grants, procurement, consulting, and contracting agreements) ownership of IP should be specifically addressed.
6. Agencies should take reasonable steps to ensure that the people of NSW have the best opportunity to benefit from the IP, whether the ownership of, or rights to, the IP are vested in the agency, a contracted developer, a collaborative developer, a grant recipient, or other party.

Identification and Recording

7. Agencies should introduce mechanisms to identify and record any significant IP they own, control, or use (refer to the Identification and Recording section below for guidance in determining significant IP). They must also address any issues which emerge in regard to the ownership of the IP. This applies whether the IP is created by staff in course of their duties, contractors, consultants, or others.

Publication

8. Agencies are to establish policies and procedures to manage their publications and websites.

Commercialisation

9. In making decisions about commercialising government IP, the agency must be satisfied that the people of NSW will obtain the maximum benefit. Note that in some cases it may be in the best interest of NSW for the agency to transfer the IP to another government agency, or private industry, either for a fee, a non-commercial fee, or free of charge.
10. Commercialisation decisions are to be made on the basis of appropriate legal, financial, and commercial IP advice.

Reporting

11. Information on the management of IP is to be provided in a timely manner by agencies to their Executive, Board of Management, and any other appropriate stakeholders.

Better Practice Guide

All NSW government agencies, including State Owned Corporations and Public Trading Enterprises, are **strongly encouraged** to implement the Better Practice Guide as far as possible.

Policy and strategy

Principles

1. Agencies are to develop an IP policy based on this Framework which supports their core functions and service delivery outcomes.
2. Agencies are to develop an implementation strategy for their IP policy.

Better Practice

1. An agency's IP policy and IP policy implementation strategy are to be based upon the IP Principles and follow the Better Practice Guide as appropriate.
2. In developing and implementing its IP policy, the agency should take into account the following:
 - its core functions and service delivery outcomes
 - what significant IP is likely to be created, owned, used, or controlled by the agency, including its publications (significant IP is described in the 'Identification and Recording' below)
 - the need to provide staff with appropriate training, such as a formal training course for staff directly responsible for IP management, or in-house training on general IP issues for other staff, and
 - allocating appropriate resources.
3. The IP policy and implementation strategy should be based on a risk management assessment by the agency, and the agency should be able to show how the IP policy reflects the identified level of risk. Agencies with more significant IP assets would be expected to have a more extensive strategy.
4. The IP policy and implementation strategy should:
 - be integrated with existing corporate systems, policies and objectives
 - be aligned with the agency's asset management obligations, set out in:
 - Results and Services Plan Agreement
 - Total Asset Management (TAM) Policy (in relation to tangible assets)
 - *Public Finance and Audit Act 1983* and the *Public Finance and Audit Regulation 2000*
 - *Public Sector Employment & Management Act 2002*, and
 - Annual Reports legislation
 - identify those responsible for implementing IP policy and for ongoing management
 - address third party IP rights and the legal obligation to respect those rights
 - provide appropriate guidance for staff
 - be communicated effectively throughout the agency, and
 - be subject to regular monitoring, review, and improvement as appropriate.

Creation and rights

Principles

3. By law, the State of NSW owns any IP developed by its employees in the course of their employment unless it is specifically agreed otherwise. Moral rights are an exception; they automatically belong to the creator in the absence of an agreement to the contrary.
4. Agencies are to ensure that their employees are aware of their legal obligation to respect the IP rights of others, including their moral rights.
5. In all circumstances in which IP might be created or acquired (including employment, outsourcing, grants, procurement, consulting, and contracting agreements) ownership of IP should be specifically addressed.
6. Agencies should take reasonable steps to ensure that the people of NSW have the best opportunity to benefit from the IP, whether the ownership of, or rights to, the IP are vested in the agency, a contracted developer, a collaborative developer, a grant recipient, or other party.

Scenario to avoid

An agency produces a detailed report on real estate in its area and holds the copyright. The agency's information manager engages a software developer to create a database program using the information in the report and gives the software developer an electronic copy of the report as part of the project.

The contract between the agency and the software developer does not address the issue of the right to use the information in the report. After a number of problems with the software developer, the agency terminates the contract and decides to do the work in-house. In the meantime, the software developer has produced a database using the agency's report and has sold it to real estate agents.

Conclusion: the contract did not protect the agency against the commercial exploitation of its information by the software developer. The contract should have specifically limited the purposes for which the information could be used.

Did you know?

Under the *Copyright Act 1968*, Commonwealth, Territory, and State government departments, agencies, and corporations may reproduce copyright material without the prior authorisation of the owners of the material. However, the government must pay owners for reproducing their copyright material. It does this by paying fees to societies that collect for copyright owners, such as the Copyright Agency Limited (CAL) (a collecting society for owners of works and published editions) and Screenrights (for owners of broadcasts). The rate of payment is calculated on the basis of an independent survey of copying in government agencies. The results of the survey are used to determine both the annual licence fee payable by the agency and the distribution of funds to copyright owners.

Better Practice

1. The agency should advise its employees that any IP they create is legally owned by the Government. Moral rights, however, are automatically attributed to the creator unless there is an agreement to the contrary.
2. Letters offering employment or contracts of employment should include a general moral rights consent clause where appropriate. The Resource Kit has further information about moral rights and consent clauses.
3. Key staff involved in the creation of significant IP should sign agreements to maintain the confidentiality of secret information both during and after employment with the agency. Confidentiality agreements reduce the risk of unauthorised disclosure of secret information about the IP. Unauthorised disclosure may, in some circumstances, breach the agency's statutory confidentiality provisions or privacy obligations, or it may destroy the commercial value of the IP asset (particularly where disclosure is made prior to publication or commercialisation).
4. The agency should assign responsibility for upholding IP rights and infringement management to a senior officer or team.

5. The agency should take a considered approach towards managing risk and opportunity in determining what IP rights to acquire during procurement, contracting, and engaging consultants, for example:

Licensing	Owning
(Agency decides to acquire a licence to use the IP)	(Agency decides to own the IP)
<ul style="list-style-type: none"> • one-off, isolated, or non-critical uses • alternative solutions available • low exit costs 	<ul style="list-style-type: none"> • on-going or critical uses • is likely to be further developed and the agency will need the enhancements • high exit costs

6. The agency should take active steps to avoid infringing third party IP rights. For example:

- if the agency is unsure about whether IP under development may lead to an infringement of third party rights, it should conduct appropriate searches for trademarks, business and domain names, patents, and designs (using, for example, the IP Australia website which has search databases: www.ipaustralia.gov.au)
- where the agency is aware that the IP it wishes to use belongs to a third party, it should obtain the requisite consent in writing and retain this consent in accordance with the agency's Records Management Program
- where it is unsure of matters regarding IP rights, the agency should seek appropriate legal advice, for example, from the Crown Solicitor's Office or other expert. In the case of unsolicited private proposals, however, the onus is on the private sector parties to identify and detail the IP implications of their proposals. (See: *Intellectual Property Guidelines for Unsolicited Private Sector Proposals submitted under Working with Government.*)

7. The agency identifies risks such as the potential infringement of third party IP rights, and provides strategies for dealing with incidents if they arise. The agency does this, for example, by making adequate insurance arrangements (the Treasury Managed Fund provides its member agencies with unlimited world wide cover) or setting aside funds to cover damages awarded by a court against the agency for breaching IP rights or other legal costs incurred in protecting the agency's IP rights.
8. IP issues must be considered before tenders and bids are called for and before contractors or consultants are engaged.
9. In all circumstances in which IP might be created or acquired (including employment, out-sourcing, grants, procurement, consulting, and contracting agreements) ownership of IP should be specifically addressed. (See: *Premier's Circular 2004-17 Guidelines for the engagement and use of consultants.*)
10. Non-disclosure or confidentiality agreements should be entered into when the agency is sharing IP with other parties.
11. Where joint ownership of IP is agreed to, the contracts should contain provisions relating to the use, management, commercialisation, and administration of IP assets.
12. If someone else infringes, or is likely to infringe, the agency's IP, the agency should follow its dispute resolution procedures as appropriate and decide whether to take further action, keeping in mind:
 - the core functions of the agency
 - the kind of IP to be protected and the reasons for the protection, for example, protecting the agency's trademark
 - the likely costs involved, based on expert legal and financial advice
 - the ability of the agency to protect the IP, that is, its available resources, and
 - the implications of not protecting the IP, for example that failure to protect it would damage the integrity or reputation of the State of NSW (or an individual agency) or would jeopardise its competitive advantage.

Identification and recording

Principle

7. Agencies should introduce mechanisms to identify and record significant IP they own, control, or use. They must also address any issues which emerge in regard to the ownership of the IP. This applies whether the IP is created by staff in the course of their duties, contractors, consultants, or others.

Better Practice

1. As part of developing its IP policy and strategy, each agency should identify the kinds of IP it creates.
2. Responsibility for managing the identification and recording of significant IP and related costs, risks, and revenue should be assigned to a senior officer or team.
3. A risk management approach is used when determining the need for registering IP owned, controlled, used, or generated by the agency, that is, the IP should be significant.
4. What is **significant IP**? The NSW Audit Office's suggestions are set out below, but some general considerations are:
 - IP which it is mandatory for the agency to record
 - IP which costs over a certain amount to generate (the amount to be agreed on by the agency according to its own particular circumstances)
 - IP worth over a certain amount to the agency
 - the cost to the agency of losing the IP and the cost of alternatives
 - IP which is valuable to the agency but not in monetary terms, for example the reputation of the agency could be at risk or there is a need to protect the integrity of the IP, and
 - IP which plays an important role in the operation of the agency or in the services it provides.
5. The agency's chief financial officer should be consulted when determining significant IP.
6. Significant IP should be recorded, using an existing system such as an asset management system, or using a separate IP system with an IP register.
7. The system for recording IP should include the following:
 - a description of the IP and its location
 - ownership details (if ownership is unclear, agencies should undertake research to determine who owns the significant IP they use)
 - whether contractors or consultants are involved in developing the IP, and, if so, details of the IP clauses in their contracts and the location of the contracts
 - the names of those responsible for the IP
 - any IP related rights issues, for example, whether the IP is protected, the status of the protection, and the expiry date
 - any potential or current risks associated with the IP
 - in cases where IP is licensed out: details of the licence (including the expiry date), licensee, and payments
 - where the agency has a licence to use someone else's IP: details of the licence, licensor, expiry date, and payments
 - the costs and revenue associated with IP, and
 - arrangements for the review of the IP.
8. The recording system should be linked with a system for reporting key IP issues to the Executive, Board of Management, and other appropriate stakeholders.

9. Agencies should take action to resolve any issues which come to light during the identification process, such as taking steps to protect any significant IP not currently protected, for example patents and trade marks or IP created under contract.
10. All employees should be made aware of their responsibility to notify the agency of work that may lead to the creation of IP.
11. Copies of relevant documentation for example, licence agreements should be retained, updated as appropriate, and captured in an appropriate corporate record-keeping system.

The Audit Office of NSW suggests that agencies consider recording the following IP:

- computer programs developed for the agency where the development cost (or replacement cost) exceeds \$10,000
- publications or promotional materials sold or provided free of charge
- databases maintained by the agency
- television and radio advertising material developed by or for the agency
- artworks and photographs commissioned by the agency and used in promotional material
- computer programs licensed by the agency
- training materials developed by the agency where the development cost (or replacement cost) exceeds \$10,000
- trademarks or logos used by the agency whether or not they are registered as trademarks or business names
- patented inventions, registered designs, and registered plant varieties created by the agency
- integrated circuit boards designed by or for the agency, and
- patented inventions, registered designs, plant varieties, and integrated circuit boards that are purchased by the agency, or for which the agency buys a licence.

Publication

Principle

8. Agencies are to establish policies and procedures to manage their publications and websites.

Scenario to avoid

Jack, the media officer, is responsible for updating the information sheets available on the agency website. A private company acts on the basis of information it found on the website. However, the information is out of date and has since been deleted from the website. The company loses \$5million and sues the agency for failing to make clear that the information was valid only for a particular period. Although the private company is ultimately unsuccessful in suing the agency, the agency's legal defence is costly and time-consuming.

Conclusion: this situation could have been avoided by the adoption of forward-thinking management procedures. For example, a disclaimer could have been included on the website saying: 'This online version is a controlled document. Any printed versions are considered uncontrolled and could be unreliable'. Other steps could include putting expiry dates on publications and triggering an automatic repeal from the website and revision of publications when the expiry date is reached.

Better Practice

1. The policy and procedures governing publications and websites should address, but are not limited to, the following:
 - the agency's core functions and corporate strategy and the principles which guide its decisions about the creation and content of publications and websites
 - access and pricing (guidelines for agencies on access to government information, and pricing, are currently being developed)
 - library deposits and records requirements, including recording details of versions and editions and retaining a copy of each version or edition
 - requirements to respect confidentiality and privacy
 - freedom of information obligations
 - any risks involved in publishing information over which the agency may wish to establish IP rights in the future
 - any approvals required for publication, including web publication, and
 - standard labelling and formatting of agency publications.
2. All publications, including websites, should display a copyright statement and, where appropriate, disclaimers.
3. The agency should take active steps to ensure that publications do not breach confidentiality, privacy rights, or other third party IP rights.
4. Publications involving higher risk should be subject to more stringent requirements for approval and have a specified review or withdrawal date.

Commercialisation

Principles

9. In making decisions about commercialising government IP, the agency must be satisfied that the people of NSW will obtain the maximum benefit. Note that in some cases it may be in the best interest of NSW for the agency to transfer the IP to another government agency or private industry, either for a fee, a non-commercial fee, or free of charge.
10. Commercialisation decisions are to be made on the basis of appropriate legal, financial, and commercial IP advice.

Scenario 1: Example of better practice

Lara, the principal projects manager, oversees the development of an urban traffic control system. The system is the first of its kind and would be very marketable internationally. In keeping with the agency's IP policy, Lara liaises with the IP officer, conducts a risk assessment of the proposed commercialisation, and obtains legal and financial advice from experts in the field. It is agreed that the proposal is viable and the system is distributed to authorities in a number of countries through a licensing agreement drawn up by legal experts.

Conclusion: the agency obtains long term financial benefits from developing and enhancing the system and continuing to market it overseas. The agency's IP policy assisted the smooth development of the commercialisation process by setting out the steps Lara needed to follow: conducting a risk assessment, and obtaining expert advice to guide decision making and the drawing up of contracts.

Better Practice

1. A decision about commercialising IP should be based on a consideration of the agency's core functions and the IP concerned. Commercialisation should not dominate or jeopardise the agency's core business.
2. Decisions regarding commercialisation should be made on the basis of appropriate legal, financial, and commercial IP advice obtained from the Crown Solicitor's Office, NSW Treasury, the Department of State and Regional Development, or other experts. Where an agency decides to obtain legal advice, note that in some cases it is a requirement that the Crown Solicitor be retained to provide the advice.
3. An agency should develop a commercialisation strategy if it decides, after obtaining appropriate advice, to commercialise IP. The strategy may include the following elements:
 - analysis of the product or technology (including such things as a description of the product or technology, an evaluation of its uniqueness, IP protection, an estimation of how much technical development remains to be done, and proof of technical concept)
 - market analysis (key customers and competitors, potential distribution channels, key success factors, and any impediments)
 - partners, collaborators, and strategic alliances (describe who they are, benefits to the project, relevance to the future technical and strategic support needed)
 - management team (technical and commercial experience of the team, skills to drive the project)
 - business opportunity (ownership issues, revenue potential by key markets, key risks and sensitivities, anticipated costs of development, production, and distribution), and
 - funding requirements (how much funding is required, how will funds be used, potential return on investment).

4. Systems for approving IP commercialisation through sale, licensing, or transfer and for facilitating the use of publicly owned information by people inside and outside of NSW (the 'uptake of IP') should be streamlined so that timely and informed decisions can be made.
5. The agency should have a policy on managing any IP that it does not wish to develop or exploit.
6. The disposal, sale, and licensing of IP should be conducted in an open, accountable, and competitive manner (consistent with ICAC guidelines).
7. Where a decision is made to transfer IP to another party for a fee, non-commercial fee, or free of charge, agencies should document the related public benefit case.
8. All commercialisation arrangements carry potential risks and an agency must take reasonable steps to manage the risks. These may include warranties and legal agreements that limit or indemnify against liability.
9. Where commercialisation is not financially viable (i.e. where revenue does not exceed commercialisation costs) or might expose the State to significant risk, it should not be undertaken unless it could be shown that it would, even so, be of benefit to the people of NSW.

Scenario 2: Another example of better practice

Michael, the research and development manager, has overseen the development of a new process which will revolutionise olive growing and which could be worth a lot of money to the agency if marketed properly. Michael obtains financial advice and realises that substantial fees would be involved in protecting the IP and marketing the process. However, the agency has little experience in the commercial sector and has a limited budget for costs not related directly to service delivery.

The legal, financial and commercial IP advice sought by Michael provides another option — to grant a licence to industry in NSW for a fee on condition that the agency maintains some control over the IP (the agency may use the IP and any future enhancements), and that the IP remain in NSW and be made available at a reasonable price. The agency endorses this proposal.

Conclusion: by considering the agency's circumstances — its core functions, expertise, and budget — and by obtaining appropriate legal, financial and commercial IP advice, the agency has maintained appropriate control over the IP, generated significant revenue, and provided economic benefits to the people of NSW.

10. The agency should consider transferring commercialisation rights to the NSW private sector in the first instance when this would be consistent with its core functions and likely to benefit the people of NSW, particularly when the agency does not have the resources to manage the IP asset effectively.
11. All arrangements transferring commercialisation rights should:
 - establish clear responsibilities, accountabilities, and agreed outcomes both within the agency and with the other parties to the arrangement
 - ensure that state records are protected as required by the receiving party (see the *State Records Act 1998*)
 - ensure that IP is managed consistently with the competitive neutrality principles agreed to by the government
 - set conditions aimed at ensuring that the IP is used for the benefit of NSW, and guarantee that if these conditions are not met, the agency may reclaim the IP
 - ensure that all rights which are required to meet the current and future operational requirements of the agency and the State of NSW are retained, for example:
 - the right to use the IP for non-commercial operations and internal research and development projects
 - the ongoing right to use any enhancements made to the IP, such as free software upgrades

- provide the best possible benefits for the agency and NSW through:
 - ensuring that royalties and licensing fees go the agency
 - ensuring that the IP can be used by everyone in a relevant industry rather than by a limited number of companies
 - establishing contract terms which guarantee that the IP will remain in NSW and be available at a reasonable price.

12. Agencies should discuss with Treasury the budgetary implications of additional banked income from the commercialisation of IP, particularly if large or consistent revenue streams are involved.

Note:

Access and pricing guidelines for government information are currently being developed. When the guidelines are approved, agencies will need to follow them in cases where they are seeking to commercialise IP or deciding to transfer IP on a non-commercial basis.

Reporting

Principle

11. Information on the management of IP is to be provided in a timely manner by agencies to their Executive, Board of Management, and any other appropriate stakeholders.

Better Practice

1. The identification and recording system should provide reports on the costs, risks, and revenue associated with significant IP owned or controlled by the agency, or arising from projects in which the agency is involved.
2. Staff should report relevant IP issues to the responsible IP officer including the following:
 - infringement of an agency's IP
 - infringement by the agency of others' IP
 - the proposed sale or disposal of IP, and
 - conflicts of interest.
3. The agency should ensure that it meets any obligations in relation to accounting for IP assets and reporting.
4. Reports on the costs, results, risks, and revenues related to IP should be provided to the agency's Executive, Board of Management, and appropriate stakeholders in a timely manner.

Better Practice Checklist

Management

- IP management incorporated into planning processes and directly linked to service delivery outcomes
- Risk management strategy underpins implementation
- Responsibilities assigned to a senior officer or team
- Communication strategy is developed and implemented
- System of evaluation established

Policy and Strategy

- Policy and procedures created and integrated with existing systems
- Significant IP identified and guidelines established for identifying remaining significant IP
- Policy and procedures communicated to employees
- Key staff trained
- Regular evaluation undertaken

Creation and Rights

- All contracts, including employment contracts, address IP rights, where appropriate
- Confidentiality and Non-Disclosure Agreements considered
- Active steps taken to avoid infringing IP rights
- Appropriate control maintained over the IP when rights transferred
- Dispute resolution strategy in place
- Expert financial and legal advice sought when protecting IP rights

Identification and Recording

- Significant IP is identified and recorded as it is created
- System for recording IP is linked to reporting system

Publication, including websites

- Publication policy issued
- Publication of IP does not breach confidentiality or infringe IP rights
- Risk assessment undertaken and steps taken for higher risk publications
- All publications, including websites, display a copyright statement and, where appropriate, a disclaimer

Commercialisation

- Risk assessment undertaken and steps taken to manage risk
- Commercialisation strategy developed
- Commercialisation arrangements ensure that IP is managed consistently with State Records and Competitive Neutrality obligations
- Rights to commercialise IP are transferred under certain circumstances provided appropriate conditions are met
- Expert financial, legal and commercial IP advice obtained as required or appropriate

Reporting

- IP reporting systems in place and line of reporting established
- Legal reporting obligations complied with
- Periodic reports made to appropriate stakeholders

Appendix

Glossary of terms

For the purposes of this Framework:

Agency	a NSW Government agency including those in the General Government and Non-General Government Sectors
Benefit	an economic, social, environmental or other advantage
Circuit layout rights	rights which automatically protect original layout designs for integrated circuits and computer chips
Collaborative developer	a person or organisation involved in the joint development of IP with a government agency
Commercialisation of IP	selling or trading the results of innovation and creativity including related IP rights, or licensing the sale of IP for profit
Competitive neutrality principles	<p>the Commonwealth, State and Territory Governments, under the National Competition Policy and Related Reforms Agreement, are committed to implementing the principle of competitive neutrality.</p> <p>This requires that Government businesses, whether Commonwealth, State, or local, operate without net competitive advantage over other businesses as a consequence of their public ownership. The principles are contained in the Competition Principles Agreement (April 1995). Clause 3 obliges all Australian governments to apply the competitive neutrality principles to the business activities of significant publicly owned entities where this is in the public interest. The NSW Government Policy Statement regarding Competitive Neutrality is at www.treasury.nsw.gov.au</p>
Confidentiality agreement	an agreement by an employee, contractor, consultant etc not to reveal secret or proprietary knowledge held within a business or agency during or after engagement with the body concerned
Consultant	a person or organisation engaged under contract on a temporary basis to provide recommendations or high level specialist or professional advice to assist decision-making. Generally it is its advisory nature that distinguishes the work of a consultant from other contractors. This definition does not include casual or temporary staff employed by the NSW government
Contractor or Contracted developer	a person engaged under contract on an independent basis to perform specified services. This definition does not include consultants (see above)
Copyright	'copyright' protection gives owners exclusive rights to license others to copy, perform in public, communicate, publish, or make an adaptation of their work. Exclusive rights apply also to sound recordings, cinematograph films, broadcasts and published editions of works
Copyright Agency Limited (CAL)	a not-for-profit company limited by guarantee, which centrally manages the copyright of authors, journalists, surveyors, photographers, visual artists, and publishers. More information can be found at www.copyright.com.au . Note: <i>Screenrights</i> undertakes a similar function in relation to radio and television (see www.screen.org). The Resource Kit contains further information
Crown copyright	the <i>Copyright Act 1968</i> provides that, subject to the Act, the State is the owner of the copyright in certain original works made by, or first published by, or under the direction or control of, the State. The Act also provides that the State is the owner of the copyright in a sound recording or cinematograph film made by, or under the direction or control of, the State
Design	visible features of shape, configuration, pattern, or ornamentation in a finished article
Domain name	the unique name which identifies an internet website

Employee	a person engaged under an employment contract, including casual or temporary staff members engaged by a NSW government organisation. Independent contractors and consultants are not employees
General Government Sector agency	an agency listed as such under the Total State Sector Accounts in the <i>NSW Report on State Finances</i> , produced annually by the NSW Treasury (available at www.treasury.nsw.gov.au)
Grant recipient	a non-government organisation or individual who receives funding from the NSW Government for a specific purpose, but not as a loan or a payment for services
Intellectual property	what can be legally owned as the product of intellectual activity in the industrial, scientific, literary, artistic, musical and dramatic fields
Intellectual property rights	all legal rights relating to intellectual property, including: (a) patents, copyright (including moral rights), rights in relation to circuit layouts, plant breeder's rights, registered designs, trade marks, trade, business or company names, or other proprietary rights and the right to have trade secrets kept confidential (b) any application for registration, or right to apply, in relation to these rights, and (c) any rights which may be introduced or come into existence through international and national laws
Moral Rights	rights relating to authors' or creators' reputations in relation to their work. See the Resource Kit for more information
Non-disclosure agreement	an agreement between two parties not to disclose information about IP to a third party
Outsourcing	procuring goods or services from an external provider
Patents	a right granted for a specific term for any device, substance, method, or process, which is new, inventive, and useful
Plant breeder's rights	rights to market a new variety of plant or its reproductive material
Public Trading Enterprises	agencies listed as such under the Total State Sector Accounts in the <i>NSW Report on State Finances</i> produced annually by the NSW Treasury (available at www.treasury.nsw.gov.au)
Risk management	assessing and taking steps to eliminate factors that could jeopardise the achievement of an organisation's objectives
State Owned Corporation	a company specified in Schedule 1 or a corporation specified in Schedule 5 of the <i>NSW State Owned Corporations Act 1989</i>
Trade marks	a letter, number, word, phrase, sound, smell, shape, logo, picture, aspect of packaging, or any combination of these distinguishing the goods or services of one trading entity from those of another
Trade secret	a special form of confidential information held within a trade or business (for example, a process, method, plan or formula), the disclosure of which to a competitor would be liable to cause significant harm to the owner
Transfer	to allocate the right to use IP belonging to the State of NSW to an external individual or body by selling, licensing, donating, or in some other way assigning it

Part 2: Resource Kit



Intellectual Property Management Framework for the NSW Public Sector

Detailed information about the different categories of Intellectual Property, relevant legislation, key contacts at a State and Commonwealth level, and related policies and websites

A. Intellectual Property (IP) definitions

a. Copyright and related rights

What is copyright?

Copyright is a type of legal protection for people who express ideas and information in certain forms. The most common forms are: writing, visual images, music, and film. Copyright protects the *form* or *way* an idea or information is expressed, not the idea or information itself.

How is copyright obtained?

There is no system of registration for copyright protection in Australia. Copyright protection is free and automatic. There are no forms to fill in, and there are no fees to be paid. Work does not have to be sent in to the Copyright Council or to anyone else.

A work is protected automatically from the time it is first written or recorded in some way, provided it has resulted from its creator's skill and effort and is not simply copied from another work. For example, as soon as a poem is written, or a song is recorded, it is protected.

From 1 January 2005, the duration of copyright for most works was extended to seventy years from the end of the year of the author's death (up from fifty). Copyright in films and sound recordings has also been extended to seventy years from the end of the year in which the film or recording was first published.

Australian copyright works are protected in most other countries, and copyright works from most other countries are protected in Australia.

The copyright owner's exclusive rights

Owners of copyright have a number of exclusive rights over their material. Anyone who wants to use someone else's copyright material in any of these ways generally needs permission. Different rights apply to different types of material. For example, owners of copyright in literary, dramatic, artistic and musical works have the exclusive right, amongst other things, to:

- reproduce the work (including by photocopying, copying by hand, filming, recording, and scanning)
- make the work public for the first time, or
- communicate the work to the public (for example, by fax, email, broadcasting, cable or the internet).

Copyright owners can "assign" (generally, sell) or license their rights. Assigning rights means someone else becomes the copyright owner; licensing means another person can use the copyright material.

The copyright notice

There is no need to put a "copyright notice" on a work for it to be protected in Australia, although one may be included as a reminder of the copyright protection. There is no formal procedure. The author or publisher may, for example, include a notice such as: © (or "Copyright") together with the copyright owner's name and the year of first publication—for example: © Gus O'Donnell 1968.

For copyright works belonging to the State of NSW, the notice takes the form: © State of New South Wales through [name of Department] or © Crown in right of NSW through [name of Department], plus year of creation or first publication. Agencies which are bodies corporate with the power to own property should use: © [Name of Agency] plus year of creation or first publication. The copyright notice should also make clear any automatic copyright permission the agency wishes to provide, any restrictions on use of the material, and how to obtain any further copyright permissions.

Assignment or licensing of Crown copyright material

The State owns the copyright in works, sound recordings and cinematograph films made by the State or under its direction or control. The NSW Attorney General is the principal agent of the Crown in NSW in regard to the assignment or licensing of Crown copyright.

It is government policy that approval of the Attorney General must be obtained in order to assign — give or sell — or license Crown copyright. When an application for an assignment or license of Crown copyright material is received by the Attorney General, the views of the Government agency responsible for the creation of the material will be sought and the terms of any licence or agreement will need to be settled by the applicant and the Government agency which created or controls the material.

Government entities that are not subject to the provisions of the *Public Sector Employment and Management Act 2002*, such as the Office of the NSW Ombudsman, may continue to exercise discretion in the dissemination of material they produce.

There is no requirement for an assignment or license to be obtained when one agent of the Crown wishes to reproduce material created by another agent of the Crown.

Note: The Attorney General's Department is currently reviewing its policy on the assignment and licensing of Crown copyright material. Until any changes are advised by the Department, agencies should continue to adhere to the current policy.

Source of copyright law

Copyright law is based on the *Copyright Act 1968* and decisions of the court.

Further Information

Further information about copyright in general can be found on the Copyright Council's website at www.copyright.org.au. Further information about Crown Copyright can be found on the website of the Community Relations Division in the Attorney General's Department: www.lawlink.nsw.gov.au/crd.nsf/pages/crown-copyright.

(Sources: the Australian Copyright Council Online Information Centre – www.copyright.org.au and the Community Relations Division in the Attorney General's Department – www.lawlink.nsw.gov.au/crd.nsf.pages.crown-copyright.)

b. Moral Rights

What are moral rights?

'Moral rights' belonging to authors or creators are rights which relate to a person's reputation as the author or creator of a work. These moral rights are granted only to individuals, generally last as long as the copyright in the work, and apply to a wide range of works including:

- literary works such as manuscripts, articles, other text materials, software, and databases
- artistic works such as photographs, paintings, drawings, maps, architecture, and sculpture, and
- dramatic and musical works and film.

The *Copyright Act 1968* recognises three moral rights:

1. the right to be named as the author or creator of the work, known as *the right of attribution of ownership*
2. the right not to have authorship of the work falsely attributed, known as the *right against false attribution*, and
3. the right not to have the work altered in a prejudicial way (for example, distorted, mutilated, or materially changed to the detriment of the creator's honour or reputation), known as *the right of integrity*.

Infringement of moral rights

Remedies available to creators of work in the event of an infringement of their moral rights include damages, injunctions to prevent or stop the particular activity, public apologies, and orders to undo or remove the derogatory material. A possible defence could be that the infringing act was reasonable having regard to all of the relevant circumstances. Section 195AR of the *Copyright Act 1968* lists various factors to consider—for example, the nature and purpose of the work, relevant industry practice, the difficulty or expense that would have been involved in identifying the creator, and so on.

Consent

Copyright creators can give consent to acts or omissions (whether past or future) which may otherwise infringe their moral rights. Generally, consent may only be given in relation to:

- (a) particular works in existence when the consent is given, or
- (b) specified works of a particular description, which are currently being made or are to be created.

However, blanket consents may be given by employees to their employers in relation to all works created by the employee in the course of employment (for example, as a term in the employment contract).

Where the creator is a contractor or consultant, consents must be specific, both in relation to the works and related acts or omissions. (See sections 195AW and 195AWA, *Copyright Act 1968*.)

Can moral rights be transferred?

Unlike economic rights (such as the right to reproduce a work), which creators can assign (sell, give away, or license), moral rights cannot be assigned. An author who assigned all economic rights in relation to a work would nevertheless retain the moral rights.

How long do moral rights last?

The rights of attribution and false attribution in relation to all works, and the right of integrity in relation to all works except films, last for the same period as copyright protection. Previously, in most cases this was the creator's lifetime plus fifty years. From 1 January 2005, this has been extended to the creator's lifetime plus seventy years. After a creator's death, these rights would be administered by the executor. The right of integrity in relation to films lasts only for the lifetime of the creator.

(Sources: the Copyright Council's Information Sheet G43 *Moral Rights* at www.copyright.org.au, and Premier's Circular 2004–17: *Guidelines For The Engagement And Use of Consultants*.)

Performers' moral rights

The *Copyright Act 1968* will also include comprehensive moral rights provisions for performers (expected to commence early-to-mid 2005 when the World Intellectual Property Organisation's *Performances and Phonograms Treaty* comes into force in Australia).

The moral rights provided for performers will be similar to the rights applying to authors of literary, dramatic, musical, and artistic works and authors of cinematograph films. That is, performers will have three moral rights: the right to be identified as the performer of a work (the right of attribution of performership); the right to take action against false attribution (the right not to have performership of a work falsely attributed); and the right to object to derogatory treatment of their performance which prejudicially affects their reputation (the right of integrity of performership of a work). Under the new provisions the moral rights of attribution and false attribution continue in force until the copyright ceases to subsist in the recorded performance. The right of integrity continues until the death of the performer of the recorded performance.

(Sources: the Copyright Council's Information Sheet G43 *Moral Rights* at www.copyright.org.au, and Premier's Circular 2004 17: *Guidelines For The Engagement And Use Of Consultants*.)

c. Patents

What is a patent?

A patent is a right granted for a specified period in relation to a device, substance, method, or process, which is new, inventive, and useful.

A patent is legally enforceable and gives the owner the exclusive right to exploit the invention commercially for the life of the patent. Patents are not granted automatically but must be applied for. All applications for patents are examined to ensure they meet the necessary legal requirements.

Patents give effective protection for new technologies that will lead to a product or process with significant long-term commercial gain.

The outcomes of primarily mental processes, such as artistic creations, mathematical models, plans, or schemes cannot be patented.

When to go public with inventions

Previously, patents would not be granted if the invention had been demonstrated, sold, or discussed in public before the application for a patent was filed. However, the patents legislation now provides for a grace period, so that under certain conditions an invention can be made public and this will not prevent a valid patent from being granted, provided that a complete application is filed within twelve months of the disclosure. This is to cover those circumstances where the inventor has disclosed the invention before applying for a patent, for example when the inventor has discussed it with a contractor without a confidentiality agreement. The grace period may help a patent application succeed in cases where disclosure of an invention has been made by mistake or is ill timed. However, a grace period should not be used as a general strategy for publicly disclosing an invention before filing a patent application.

Time limit

An Australian standard patent lasts for twenty years, subject to the payment of maintenance fees from the fifth year.

Who administers patents?

IP Australia is the Australian Government agency responsible for granting rights in patents, trade marks, designs, and plant breeder's rights. IP Australia takes applications for patents and assesses whether the invention is new, and whether it meets the legislative requirements.

International patents

Obtaining patents overseas can protect valuable export markets. Most countries have patent systems similar to the Australian system. In addition, Australia is party to a number of international agreements which can reduce the complexity of applying overseas. The IP Australia website — www.ipaustralia.gov.au — contains more information about the process.

(Source: IP Australia — www.ipaustralia.gov.au.)

d. Trade marks

What is a trade mark?

A trade mark can take the form of a letter, number, word, phrase, sound, smell, shape, logo, picture, aspect of packaging, or any combination of these.

It is used to distinguish the goods and services of one trader from those of another. A trade mark is not prima facie registrable if it is not capable of distinguishing the goods or services of a particular trader from those of others in the marketplace. Trade marks which conflict with an earlier trade mark, or comprise a geographic name or common surname, are also difficult to register. Some of these problems may be overcome however if the trade mark has been used extensively in the marketplace for a long time.

A trade mark should not mislead the public about the nature of the goods and services.

Registration is advisable

A trade mark can be used even though it is not registered. However, registration is advisable. Registration provides the owner with the exclusive and legally enforceable right to use the trade mark within Australia for the goods and services for which it has been registered, and to license or sell it. Action under common law to protect an unregistered trade mark is also possible, but it can be expensive and time consuming.

A search of existing registered trade marks should be made before using a mark or applying for registration. To infringe or use another's trade mark may result in legal action.

Time limit

Initial registration of a trade mark lasts for ten years. After that time renewal for further periods of ten years can be effected by payment of the appropriate fee.

A trade mark can therefore have a long life representing significant business value. However, the mark must be used in a bona fide way so that it does not become subject to removal on the grounds of non-use.

Who administers trade marks?

The Trade Marks Office of IP Australia administers trade marks and applications should be lodged there.

Protection against misrepresentation is also provided under trade practices and fair trading legislation, and it is also possible to take action under common law.

(Source: IP Australia – www.ipaustralia.gov.au.)

e. Designs

What is design registration?

A design comprises the visual features of shape, configuration, pattern, or ornamentation which give an article its unique appearance. To be registrable, a design must be new and distinctive.

Design registration is intended to stop others from copying the visual appearance of manufactured products. A registered design gives the owner the exclusive and legally enforceable right to use, license, or sell the design.

Note: Protection is only for the appearance of the article and not how it works.

Designs which are essentially artistic works are covered by copyright legislation and are not eligible for design registration.

Time limit

Initially, protection is for a period of five years, but this can be extended for a further period of five years.

Who administers design registration?

The designs section of IP Australia administers designs, and applications should be lodged there.

(Source: IP Australia – www.ipaustralia.gov.au.)

f. Circuit layout rights

What are circuit layout rights?

Circuit layout rights are granted automatically to protect original layout designs for integrated circuits and computer chips. The owner does not need to apply for registration. While these rights are based on copyright law principles, they are a separate form of protection.

Circuit layouts are usually highly complex and the intellectual effort in creating an original layout may be considerable and of great value. An integrated circuit or chip made from the layout plans is the key to the operation of all kinds of electronic devices, from heart pacemakers to personal computers.

The owner of an original circuit layout has the exclusive right to:

- copy the layout in a material form
- make integrated circuits from the layout, and
- exploit it commercially in Australia.

Commercial exploitation may take the form of importation, sale, hire, or distribution of a layout, or an integrated circuit made according to the layout.

Time limit

Rights relating to an original layout hold for ten years from its creation. If commercial exploitation begins within this period, the rights can apply, in addition, for the ten years from the date the commercial activity started. The maximum possible protection period therefore is twenty years.

Who administers circuit layout rights?

The Commonwealth Attorney General's Department administers the legislation for automatic rights to circuit layout rights and should be contacted for advice on matters relating to the *Circuit Layout Act 1989*.

(Sources: IP Australia – www.ipaustralia.gov.au and the Copyright Law Branch of the Commonwealth Attorney General's Department – www.law.gov.au.)

g. Plant breeder's rights

What are Plant Breeder's Rights?

Plant Breeder's Rights are exclusive commercial rights to a registered variety of plant. The rights are a form of intellectual property, like patents and copyright, and are administered under the *Plant Breeder's Rights Act 1994*.

The Act is based on Australia's membership of the International Convention for the Protection of New Varieties of Plants (UPOV) 1991, a United Nations multilateral agreement establishing an internationally harmonised regime for exclusive intellectual property grants relating to new plant varieties. The UPOV system, built on uniform, clearly defined principles, encourages investment, innovation, multiplication, and release of new plant varieties across member countries.

Extent of the coverage of Plant Breeder's Rights

Successful applicants for Plant Breeder's Rights have exclusive rights to produce, reproduce, and propagate the registered material, and to sell, import, and export it.

In certain circumstances, principally if the breeder has not had a reasonable opportunity to exercise the right to propagate the material, Plant Breeder's Rights extend to harvested material and, subject to a similar set of qualifications, to products obtained from harvested material.

Exceptions to the breeder's right are the use of the variety privately and for non-commercial purposes, for experimental purposes, and for breeding other plant varieties. A variety can be used for these purposes irrespective of the existence of Plant Breeder's Rights. Seed saved on a farm may be used, unless there is a regulation to the contrary. Currently no crops have been regulated in this way.

Time limit

The Plant Breeder's Right is available for a period of twenty five years for trees and vines, or twenty years for all other plants, provided maintenance fees are paid and any conditions applying to the variety are met. (Under the previous *Plant Variety Rights Act 1987*, all varieties were protected for twenty years.) Once Plant Breeder's Rights or Plant Variety Rights have expired, the variety is available to everyone.

Who administers Plant Breeder's Rights?

Following the 2004 federal election, IP Australia assumed responsibility for the administration of Plant Breeder's Rights.

(Sources: IP Australia. More information regarding applications, eligibility, legislation, FAQs etc is available from the IP Australia's website at www.ipaustralia.gov.au/pbr.)

h. Trade secrets

What is a trade secret?

A trade secret is a special form of confidential information held within a trade or business (for example, a process, method, plan, or formula), the disclosure of which to a competitor would be liable to cause significant harm to the owner.

Note: secrecy does not stop anyone else from inventing the same product or process independently and exploiting it commercially.

Confidentiality Agreements

A confidentiality agreement can be used to stop employees from revealing a trade secret or proprietary knowledge during and after their employment or association with a business.

Trade secrets are difficult to maintain over long periods or when a large number of people are made privy to the secret.

What if someone reveals my trade secret?

Common law provides protection for infringement of trade secrets, breach of confidentiality agreements and passing off trade marks. It should be noted, however, that proving a breach of confidentiality under common law can be complex and is potentially more costly than defending registered rights.

(Source: IP Australia – www.ipaustralia.gov.au. Legal advice should be obtained from the Crown Solicitor's Office, for example, in relation to issues surrounding trade secrets – www.cso.nsw.gov.au.)

i. IP and Traditional Knowledge/Indigenous IP

International

The term “traditional knowledge” (TK) is generally used to refer to tradition-based intellectual property. “Tradition-based” has been defined by the World Intellectual Property Organization (WIPO) as including knowledge systems, creations, innovations and cultural expressions which:

- have generally been transmitted from generation to generation,
- are generally regarded as pertaining to a particular people or its territory, and
- are constantly evolving in response to a changing environment.

Categories of TK could include agricultural, scientific, technical, ecological, medicinal (including related medicines and remedies) and biodiversity-related knowledge. It also includes “expressions of folklore.”

As a result, Indigenous IP or TK has the potential to traverse many forms of IP including copyright, patents, and designs.

The role of IP systems in relation to TK, and issues such as how to preserve, protect, and equitably use TK, have recently been under increasing attention in a range of international policy discussions about matters as diverse as food and agriculture, the environment (notably the conservation of biological diversity), health (including traditional medicines), human rights and Indigenous issues, cultural policy, and aspects of trade and economic development.

For further information see: www.wipo.int/tk/en/tk/background/index.html.

Australia is an active participant in these international discussions and will be guided by these discussions and international developments when developing the approach to these issues domestically.

Federal

The Government is proposing to amend the *Copyright Act 1968* to give Indigenous communities legal standing to safeguard the integrity of creative works that embody traditional community knowledge.

It is proposed that under the new legislation an Indigenous community will have the right to take legal action if there has been an infringement of that community’s right to be identified with a work or film, the right not to be falsely identified with a work/film, and the right not to have a work/film subjected to derogatory treatment.

For further information contact: Copyright Law Branch, Commonwealth Attorney-General’s Department on (02) 6250 6658 or www.ag.gov.au.

Agencies reproducing Indigenous material should refer to the relevant Indigenous Protocol Guides released by the Australia Council for the Arts which cover five areas of media material – New Media, Song, Performing, Visual, and Writing.

For further information see: www.ozco.gov.au.

B. Legislation

Subject	Commonwealth Statute/ Regulation	Administering Body (see 'Contacts' for further details)
Copyright and related rights	<i>Copyright Act 1968</i> <i>Copyright Regulations 1969</i>	Commonwealth Attorney General's Department
Circuit layout rights	<i>Circuit Layouts Act 1989</i> <i>Circuit Layouts Regulations 1990</i>	Commonwealth Attorney General's Department
Designs	<i>Designs Act 2003</i> <i>Designs Regulations 2004</i>	IP Australia
Patents	<i>Patents Act 1990</i> <i>Patents Regulations 1991</i>	IP Australia
Plant breeder's rights	<i>Plant Breeder's Rights Act 1994</i> <i>Plant Breeder's Regulations 1994</i>	IP Australia
Trade marks	<i>Trade Marks Act 1995</i> <i>Trade Marks Regulations 1995</i>	IP Australia (except for part 13, which is administered by the Australian Customs Service)
Confidential information and trade secrets	Common law	

C. Contacts

NSW Contacts

Legal Advice

NSW Crown Solicitor's Office—The legal services provided by the Crown Solicitor's Office include:

- legal advice
- representation in litigation
- property and commercial transactions
- drafting of documentation and agreements, including inter-governmental agreements and intellectual property agreements
- preparation of publications, and
- training and information for government agencies.

Government agencies are required to engage the Crown Solicitor's Office to perform *core legal work* in cases which:

- have implications for Government beyond an individual Minister's portfolio
- involve the constitutional powers and privileges of the State or Commonwealth
- raise issues which are fundamental to the responsibilities of Government, or
- arise from, or relate to, matters falling within the Attorney General's area of responsibility.

Note: Matters relating to Crown Copyright are an agreed example of core legal work².

The Crown Solicitor's Office competes with the private legal profession to perform non-core (general) legal work for government agencies and as part of that competition participates in tenders for legal work.

Contact Details:

State Crown Solicitor's Office
Level 5, 60-70 Elizabeth Street
SYDNEY NSW 2000

Ph: 9224 5000
Fax: 9224 5011
Website: www.cso.nsw.gov.au

Instructions are to be addressed to the Crown Solicitor, Mr I V Knight, at the above address.

Legal Management Service, Attorney General's Department—The Legal Management Service (LMS) provides a range of services aimed at improving the quality of legal management in the New South Wales public sector. LMS helps Government agencies review or restructure their legal service requirements. LMS services are provided for a fee and include:

- advice on reviewing an agency's legal services
- putting agencies in touch with a suitable legal management consultant
- conducting or assisting with reviews of agencies' legal service provision, and
- assisting when agencies decide to outsource their legal needs.

Contact Details:

Legal Management Service
Level 18, Goodsell Building
8-12 Chifley Square,
SYDNEY NSW 2000

Ph: 9228 8433
Fax: 9228 7889
Website: www.lawlink.nsw.gov.au/lms.nsf/pages/lmsfirst

² Refer Premier's Memorandum No.95-39 *Arrangements for seeking legal advice from the Crown Solicitor's Office.*

Copyright

NSW Attorney General's Department—The Legislation & Policy Division of the NSW Attorney General's Department can provide general advice about copyright issues.

Contact Details:

Legislation & Policy Division
Level 20, Goodsell Building
8-12 Chifley Square
Sydney NSW 2000

Ph: 9228 8061
Fax: 9228 8563
Website: www.lawlink.nsw.gov.au/lap.nsf/pages/index

Note: The State owns the copyright in works, sound recordings and cinematograph films made by the State or under its direction or control. The NSW Attorney General is the principal agent of the Crown in NSW in respect to the assignment or licensing of Crown copyright. For further information about Crown copyright refer to the Copyright section in Part a of the Resource Kit and the Community Relations Division webpage.

Contact Details:

Community Relations Division
Level 9, Goodsell Building
8-12 Chifley Square
Sydney NSW 2000

Ph: 9228 8104
Fax: 9228 8608
Website: www.lawlink.nsw.gov.au/crd.nsf/pages/crown-copyright

Government Chief Information Office, Department of Commerce—Guidelines on Information Management have been developed, including a Copyright Guideline.

Contact Details:

Government Chief Information Office
Level 21, McKell Building
2-24 Rawson Place
Sydney NSW 2000

Ph: 9372 8877
Fax: 9372 8299
Website: www.oict.nsw.gov.au

Standard contracts

State Procurement—develops and manages procurement contracts for a diverse range of goods and services to be used by government and community based not-for-profit organisations. In addition to establishing standard contracts, they can also assist, on a fee for service basis, in the development of one-off contracts for specific circumstances.

Contact Details:

State Procurement
McKell Building, 24 Rawson Place
Sydney NSW 2000
Email: smartbuy-infocentre@commerce.nsw.gov.au

General Enquiries Ph: 9372 7791
General One Off Contract : 9372 7594
IT One-Off Contract: 9372 7629
Website: www.stateprocurement.ogp.commerce.nsw.gov.au

Financial advice, including pricing

NSW Treasury—Treasury can provide assistance to agencies about the accounting and budgetary treatment of IP. An agency's financial analyst is, however, the first point of contact for all financial matters, including IP registers, the treatment of IP revenue, and the sharing of financial benefits with the property's creator.

Contact Details:

Office of Financial Management
Level 27 Governor Macquarie Tower
1 Farrer Place
Sydney NSW 2000

Ph: 9228 4567
Fax: 9221 7029
Website: www.treasury.nsw.gov.au

Commercialisation

NSW Department of State and Regional Development—The Department can provide advice to Government agencies who wish to commercialise their IP and products and take them to market. The Department works closely with key organisations such as the Australian Institute for Commercialisation, which offers commercialisation support services.

The Department can also offer Government agencies the links with research and development organisations, small business, industry, and service providers to help build the networks and partnerships, needed to drive commercial success.

Contact Details:

Innovation and Technology Unit
Level 44, Grosvenor Place
225 George Street
Sydney NSW 2000

Ph: 9338 6991
Fax: 9338 6890
Website: www.business.nsw.gov.au

Records management and archives

State Records—Is the NSW Government's archives and records management authority. The Authority can provide advice in relation to records management and archive issues, including systems and practices for effective IP recordkeeping.

Contact Details:

State Records
Sydney Records Centre
Globe Street
The Rocks
Sydney NSW 2000

Ph: 9673 1788 (switch)
Fax: 9833 4518
Website: www.records.nsw.gov.au

Science and medical research

NSW Ministry for Science and Medical Research (MSMR)—MSMR can provide agencies with access to information relevant to IP. MSMR also funds commercialisation services through BioLink and Biomed North.

BioLink is a member-owned service that has been established to assist government and not-for-profit life science research institutions in NSW with the identification, protection, and commercialisation of their IP. BioLink will also provide services in IP education, marketing of IP rights, and the negotiation of transactions on behalf of its members.

Biomed North provides IP protection and commercialisation services to the Northern Area Health Service and institutions undertaking biomedical research in the northern corridor of Sydney.

BioLink and BioMed North are planning to form a partnership. This will form the basis of a statewide IP service.

Contact Details:

Ministry for Science and Medical Research
Level 21
201 Elizabeth Street
Sydney NSW 2000

Ph: 9228 3629
Fax: 9228 5632
Website: www.msmr.nsw.gov.au

NSW Government domain names

Australian Government Information Management Office (AGIMO)— is the administrator of the gov.au namespace which includes nsw.gov.au. New NSW government domain names may be registered and existing entries modified by contacting the Government Chief Information Office, who will submit the request to AGIMO. Further information is available at <http://www.nsw.gov.au/dna/>.

Contact Details:

Government Chief Information Office
Level 21, McKell Building
2-24 Rawson Place
Sydney NSW 2000

Ph: 9372 8877 (switch)
Fax: 9372 8177
Website: www.nsw.gov.au/dna/

National Contacts

Copyright

Australian Copyright Council—The Australian Copyright Council is an independent non-profit organisation which provides a range of comprehensive on line information sheets, including an information sheet which specifically targets government and copyright (G62). The Australian Copyright Council may be contacted for advice about issues not covered in its information sheets.

Contact Details:

Australian Copyright Council	Ph: 9318 1788
245 Chalmers Street	Fax: 9698 3536
Redfern NSW 2016	Website: www.copyright.org.au
Postal address: PO Box 1986	
Strawberry Hills NSW 2012	

Copyright Law Branch, Information Law and Human Rights Division, Commonwealth Attorney General's Department—The Copyright Law Branch of the Information Law and Human Rights Division of the Attorney-General's Department is responsible for copyright policy and administration of the *Copyright Act 1968*. It also provides secretariat services for the Copyright Law Review Committee. The Copyright Law Branch publishes a booklet on Copyright Law in Australia as well as a copyright newsletter, AGD e-News on Copyright.

Under new administrative arrangements, the Commonwealth Copyright Administration (CCA) formerly located within the Department of Communications, Information Technology and the Arts, has moved to the Attorney-General's Department. The CCA is responsible for the administration and protection of copyright in Commonwealth publications.

Contact Details:

Copyright Law Branch	Tel: 6250 6313
Robert Garran Offices	Fax: 6250 5929
National Circuit	Website: www.ag.gov.au
Barton ACT 2600	

Circuit layout rights

Copyright Law Branch, Information Law and Human Rights Division, Commonwealth Attorney General's Department—Australian copyright law is administered by the Copyright Law Branch of the Information Law and Human Rights Division of the Attorney General's Department. The Copyright Law Branch (see above) also provides advice on matters relating to the *Circuit Layouts Act 1989*.

Contact Details:

Copyright Law Branch	Tel: 6250 6313
Robert Garran Offices	Fax: 6250 5929
National Circuit	Website: www.ag.gov.au
Barton ACT 2600	

Domain names

au Domain Administration Ltd (auDA)—auDA is an Australian not-for-profit company with responsibility for operating the .au domain for the benefit of all stakeholders. The company:

- develops and implements domain name policy
- licenses second level domain (2LD) for example, gov.au registry operators
- accredits and licenses domain name registrars
- implements consumer safeguards
- runs a centralised WHOIS service

- facilitates .au Dispute Resolution Policy, and
- represents .au at the Internet Corporation for Assigned Names and Numbers (ICANN) and other international forums.

Contact Details:

au Domain Registration Ltd
 107 Faraday Street
 Carlton VIC 3053
 Email: info@auda.org.au

Tel: 1300 732 929
 Fax: 03) 9349 5711
 Website: www.auda.org.au

Patents, designs and trade marks

IP Australia—IP Australia is the Australian Government agency that grants rights in patents, trade marks, and designs. Its mission is to ensure that Australians benefit from the effective use of IP, particularly through increased innovation, investment and trade. The IP Australia website provides useful information about patents, trade marks, and designs.

Contact Details:

IP Australia
 Head Office
 PO Box 200
 Woden ACT 2606

Tel: 6283 2999
 Fax: 6283 7999
 Website: www.ipaustralia.gov.au

Plant breeder’s rights

Plant Breeder’s Rights Office, IP Australia—The Plant Breeder’s Rights program, established under the *Plant Breeder’s Rights Act 1994*, promotes plant innovation by granting the owner of the registered new variety the opportunity to exercise limited commercial rights over propagating material, that is, the right to produce, reproduce, condition, sell, import, export, and stock the material. For information on the scheme see the website at www.ipaustralia.gov.au/pbr.

Contact Details:

Plant Breeder’s Rights Office
 PO Box 200
 Woden ACT 2602

Ph: 6283 2999
 Fax: 6283 7999
 Website: www.ipaustralia.gov.au/pbr

International trade

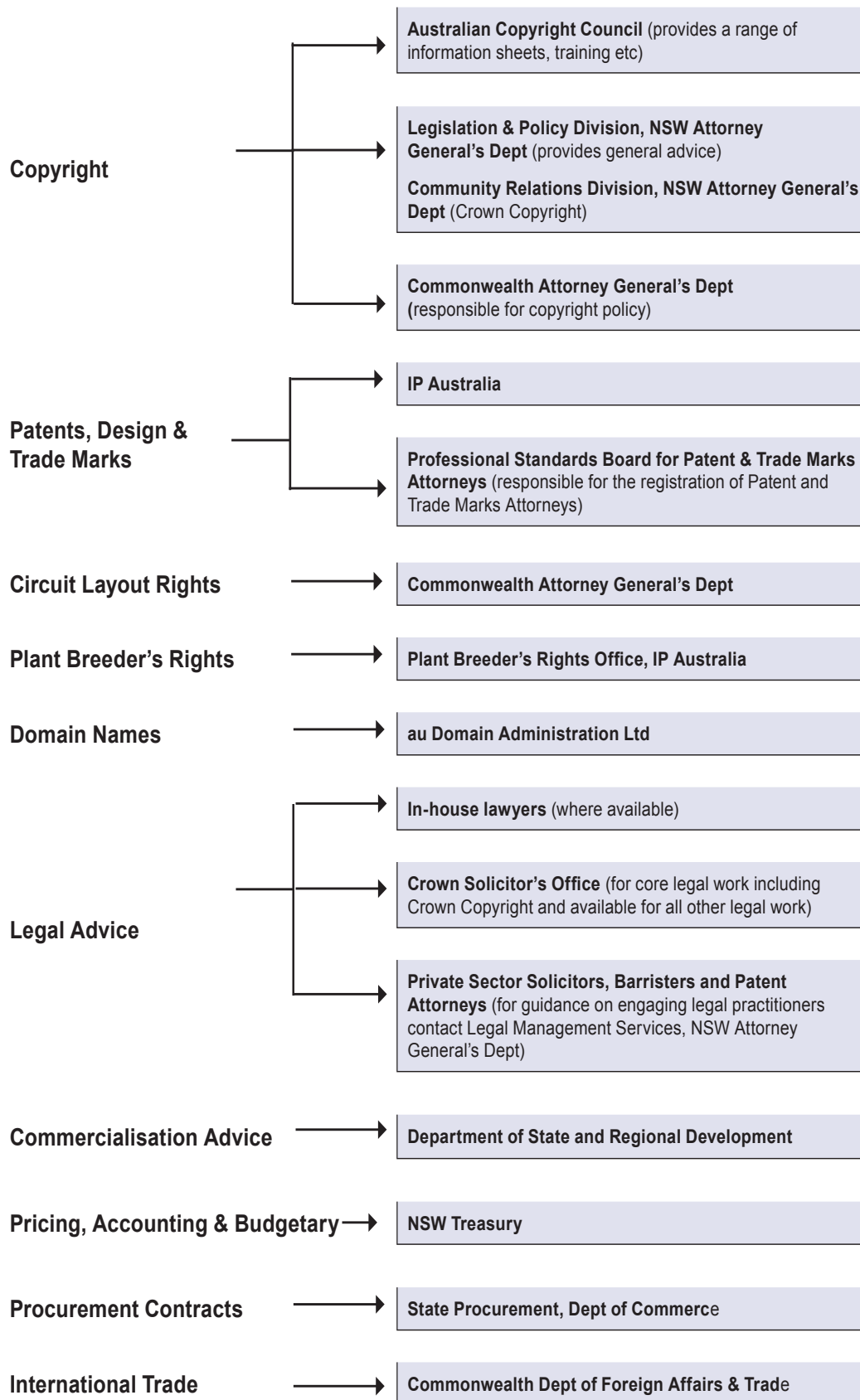
Department of Foreign Affairs and Trade—The Office of Trade Negotiations (OTN) in the Department of Foreign Affairs and Trade is responsible for the overall coordination of Australia’s engagement with the World Trade Organization. Within OTN, the International Intellectual Property Section has particular responsibility for IP issues.

Contact Details:


International Intellectual Property Section
 Services and Intellectual Property Branch
 Department of Foreign Affairs and Trade
 John McEwan Crescent
 Barton ACT 0221

Tel: 6261 2039
 Fax: 6261 3514
 E-mail: ip@dfat.gov.au
 Website: www.dfat.gov.au/ip/index.html

Intellectual Property Advisory Signposts



D. Websites

Web Address	Details
www.aesharenet.com.au	<p>AEShareNet connects people who are looking for learning materials with those who own them, and automates the negotiation and licensing process. The site also provides a range of useful information on IP, copyright, and licensing in relation to learning materials.</p> <p>AEShareNet is also responsible for administering the “Free for Education” Protocol. By attaching the  Licence Mark to particular material the website owner indicates that the material may be used by an individual or organisation for educational purposes. For further information go to www.aesharenet.com.au/Ffe/.</p>
www.ag.gov.au	The Copyright Law Branch of the Information Law and Human Rights Division, Commonwealth Attorney General’s Department, administers Australian copyright law (see National Contacts for more details).
www.artslaw.com.au	<p>The Arts Law Centre of Australia provides information sheets on a number of issues including:</p> <ul style="list-style-type: none"> • Confidential information • Designs • Trade marks • Business name protection • Copyright collecting societies.
www.austlii.edu.au	The Australasian Legal Information Institute (AustLII) provides online access to Australian legislation and case law.
www.copyright.org.au	The Australian Copyright Council provides a range of comprehensive on-line information sheets on copyright issues (see National Contacts for more details).
www.copyright.com.au	<p>Copyright Agency Limited (CAL) is an Australian copyright management company whose role is to provide a bridge between creators and users of copyright material.</p> <p>CAL represents authors, journalists, visual artists, photographers, and newspaper, magazine and book publishers as their non-exclusive agent to license the copying of their works to the general community.</p> <p>Screenrights undertakes a similar function in relation to radio and television (see www.screen.org). Websites relating to music and recording are: www.apra.com.au and www.aria.com.au.</p>
www.cso.nsw.gov.au	Crown Solicitor’s Office , NSW Attorney General’s Department (see NSW Contacts for more details).
gb.espacenet.com	esp@cenet is a free internet service provided by the European Patent Organisation (EPO) through the EPO and the national offices of its member states. Using esp@cenet it is possible to search all the patent applications published in the past two years (or more in some cases) by any national office in the EPO.

<p>www.findlaw.com.au (Technology & Media Law link under 'Legal Professionals')</p>	<p>FindLaw is a free legal information service and provides updates on legal developments. Topics on the site include:</p> <ul style="list-style-type: none"> • News • Precedents • Practical articles • Recent cases • Recent legislation • Events • Links & Resources.
<p>www.ipaccess.gov.au</p>	<p>IP Access is an Australian Government portal to information about IP and provides a comprehensive resource for anyone doing business in Australia.</p>
<p>www.ipaustralia.gov.au</p>	<p>IP Australia is the federal government agency that grants rights in patents, trade marks, and designs. IP Australia also administers the <i>Plant Breeder's Rights Act 1994</i>. The site provides useful information about patents, trade marks, designs, and plant breeder's rights (see National Contacts for more details).</p>
<p>www.ipmenu.com</p>	<p>IP Menu provides a global listing of IP resources on the internet.</p>
<p>www.lawlink.nsw.gov.au/lms</p>	<p>Legal Management Services (LMS), NSW Attorney General's Department, provides a range of services aimed at improving the quality of legal management in the New South Wales public sector. LMS helps Government agencies review, assess, or restructure their legal service requirements (see NSW Contacts for more details).</p>
<p>www.dfat.gov.au/ip</p>	<p>The Office of Trade Negotiations (OTN) of the Department of Foreign Affairs and Trade is responsible for the overall coordination of Australia's engagement with the World Trade Organisation. Within OTN, the International Intellectual Property Section has particular responsibility for IP issues (see National Contacts for more details).</p> <p>Users of the site can apply to receive a regular bulletin on recent developments in TRIPS (Agreement on Trade-Related Aspects of Intellectual Property Rights).</p>
<p>www.psb.gov.au</p>	<p>The Professional Standards Board for Patent and Trade Marks Attorneys is responsible for the registration of Patent and Trade Marks Attorneys. The website includes a database of registered Patent and Trade Marks Attorneys.</p>
<p>www.wipo.int</p>	<p>The World Intellectual Property Organisation (WIPO) is an international organisation dedicated to promoting the use and protection of IP.</p>

E. Policies and other documents

There is a range of policies and other documents to assist NSW Government agencies to manage intellectual property. These include Premier's Memoranda and Premier's Department Circulars, NSW Treasury Memoranda, guidelines and manuals, and Audit Office reports.

Subject/Document Title	Details	Location
Asset Management		
Total Asset Management (TAM) Manual	Total Asset Management (TAM) is a NSW Government policy introduced to achieve better planning and management of the State's assets. The Manual explains the five asset plans which comprise a Total Asset Management Strategy, and provides a series of guidelines on implementing various aspects of asset planning.	www.treasury.nsw.gov.au Contact: Asset Management and Procurement Branch, NSW Treasury Tel: 9228 4402
Total Asset Management(TAM) Policy Reconfirmation, Treasury Circular TC04/09	This Circular reconfirms the Government's commitment to the implementation of Total Asset Management (TAM) and advises of updated guidelines and closer integration into the Budget process.	www.treasury.nsw.gov.au Contact: Asset Management and Procurement Branch, NSW Treasury Tel: 9228 4402
Business Case		
Business Case Guidelines	These Guidelines provide practical advice on all aspects of producing a sound and compelling business case. They outline a rigorous methodology, describe the components of a business case and the processes for compiling one. The guidelines also provide additional tools and information including a template and key contacts.	www.premiers.nsw.gov.au Contact: Premier's Department Tel: 9228 4870
Business Case Guidelines, Premier's Department Circular 2000-79	This Circular announces the release of the Business Case Guidelines.	www.premiers.nsw.gov.au Contact: Premier's Department Tel: 9228 4870
Business Case Development Guideline	The Guideline ensures that business cases for investment in Information and Communications Technology (ICT) initiatives directly support agencies' business goals and plans.	www.oict.nsw.gov.au Contact: Government Chief Information Office, Department of Commerce Switch: 9372 8877
NSW Government—Guidelines for Economic Appraisal	The Guidelines are intended to extend economic appraisal methods (i.e. analysing all the costs and benefits associated with a particular project) to all public sector agencies to achieve a more consistent approach.	www.treasury.nsw.gov.au Contact: NSW Treasury Tel: 9228 4641

Subject/Document Title	Details	Location
Economic Appraisal – Principles and Procedure, Simplified Treasury Policy and Guideline Paper (TPP) 99-01	The Paper provides a simplified summary of the NSW Government Guidelines For Economic Appraisal.	www.treasury.nsw.gov.au Contact: NSW Treasury Tel: 9228 4641
NSW Government - Financial Appraisal Guidelines	The Guidelines provide assistance in the financial assessment of projects.	www.treasury.nsw.gov.au Contact: NSW Treasury Tel: 9228 3254

Competitive Neutrality Policy

Policy Statement on the Application of Competitive Neutrality Policy and Guidelines Paper	The Statement is an outcome of the 1995 agreement by the NSW Government, the Commonwealth, and other State and Territory Governments to implement competitive neutrality principles as part of its commitment to National Competition Policy (NCP). It offers a guideline for Government businesses and other parties.	www.treasury.nsw.gov.au Contact: NSW Treasury Tel: 9228 4240
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Consultants

Guidelines for the Engagement and Use of Consultants, Premier's Department Circular 2004-17	The Guidelines set out the key expectations of the Government in relation to agencies' engagement of consultants, and includes a consultancy agreement as a model for agencies preparing their own agreements with consultants.	www.premiers.nsw.gov.au Contact: Public Employment Office, Premier's Department Switch: 9228 5555
Engagement and Use of Consultants, Premier's Memorandum 2002-07	The Memorandum outlines reporting arrangements which describe more accurately the nature and purpose of consultancies.	www.premiers.nsw.gov.au Contact: Public Employment Office, Premier's Department Switch: 9228 5555

Contracts

Disclosure of Information on Government Contracts with the Private Sector, Premier's Memorandum 2000-11	The Memorandum introduces guidelines designed to clarify what information relating to Government-private sector contracts should, and should not, be made public.	www.premiers.nsw.gov.au Contact: Department of Commerce Head Office 9372 8877
Disclosure of Information on Government Contracts with the Private Sector, Premier's Department Circular 2002-47	This Circular refers to Premier's Memorandum No. 2000-11 (see above). It requires that Chief Executives ensure that this policy is being fully implemented in their agency.	www.premiers.nsw.gov.au Contact: Public Employment Office, Premier's Department Switch: 9228 5555

Ethics

Code of Conduct and Ethics for Public Sector Executives 1998	This Code provides a framework for ethical decision making by setting out the standards of behaviour expected of chief and senior executive officers.	www.premiers.nsw.gov.au Contact: Public Employment Office, Premier's Department Switch: 9228 5555
Model Code of Conduct for NSW Public Agencies	The Model Code provides agencies with guidance to develop or revise their own codes of conduct, to raise awareness of ethical issues in the workplace.	www.premiers.nsw.gov.au Contact: Public Employment Office, Premier's Department Switch: 9228 5555

Subject/Document Title	Details	Location
Financial Management		
Financial Management Framework	The Financial Management Framework is a key component in the reform of State financial management by the Office of Financial Management.	www.treasury.nsw.gov.au Contact: General Government Financial Management Framework, NSW Treasury Tel: 9228 3951
Information Management		
Meeting the Government's Information and Communications Technology Strategic Agenda, Premier's Memorandum 2000-12	This Memorandum sets out NSW government agencies' obligations to ensure that their electronic services are compatible with the whole of government electronic services delivery (ESD) platform developed and coordinated by the Department of Information Technology and Management.	www.premiers.nsw.gov.au Contact: Government Chief Information Office, Department of Commerce Switch: 9372 8877
Information Management & Technology Blueprint for NSW - A Well-connected Future, 1997	The Information Management & Technology Blueprint outlines ways to use information management and technology effectively to: <ul style="list-style-type: none"> • create accessible and responsive government services, and • deliver them to the community using a seamless communications network linking homes, workplaces, and public institutions. 	www.oict.nsw.gov.au Contact: Government Chief Information Office, Department of Commerce Switch: 9372 8877
Information Management - Audit Guideline	The Guideline aims to assist agencies to plan and perform information audits. It defines an information audit as the assessment of the information held by an agency and of its information management activities.	www.oict.nsw.gov.au Contact: Government Chief Information Office, Department of Commerce Switch: 9372 8877
Information Management - Australian Government Locator Service (AGLS) Metadata Guideline	The Guideline aims to promote consistent implementation of the AGLS metadata standard by NSW agencies across Internet and non-Internet environments.	www.oict.nsw.gov.au Contact: Government Chief Information Office, Department of Commerce Switch: 9372 8877
Information Management - Chief Information Officer Guideline	The Guideline describes the role, responsibilities and attributes of an agency's Chief Information Officer (CIO). The Guideline focuses on the need for each agency to implement policies on the effective collection, storage, access, use, and disposal of information which support the agency's business processes.	www.oict.nsw.gov.au Contact: Government Chief Information Office, Department of Commerce Switch: 9372 8877
Information Management - Classification Guideline	The Guideline aims to advise agencies on the design and practice of information classification. The Guideline defines the purpose of Information Classification as enabling information to be managed in a manner that is relevant to the agency's business goals and objectives.	www.oict.nsw.gov.au Contact: Government Chief Information Office, Department of Commerce Switch: 9372 8877
Information Management - Copyright Guideline	The objective of this Guideline is to examine the concept of copyright, and assist in its interpretation and application. It explains the background to intellectual property, the principles of best practice in dealing with copyright, the use of copyright in the protection of assets and provides guidance in the management of various copyright issues.	www.oict.nsw.gov.au Contact: Government Chief Information Office, Department of Commerce Switch: 9372 8877

Subject/Document Title	Details	Location
Information Management - Framework Guideline	The Guideline shows how a whole-of-government approach to information management can be achieved through better collection, storage, use, accessibility, and disposal of information. The Guideline deals with implementing the necessary strategies but not the specific technological measures underpinning this.	www.oict.nsw.gov.au Contact: Government Chief Information Office, Department of Commerce Switch: 9372 8877
Information Management - Inventory Guideline	The Guideline aims to assist agencies to understand the usefulness of having an information inventory.	www.oict.nsw.gov.au Contact: Government Chief Information Office, Department of Commerce Switch: 9372 8877
Information Management - Liability Guideline	The objective of this Guideline is to raise awareness of various liability issues and how they affect the government in relation to the information it holds and uses. It examines some key areas of liability that government agencies and individuals should be familiar with, in particular the legal implications of liability in relation to various agency activities and the risks.	www.oict.nsw.gov.au Contact: Government Chief Information Office, Department of Commerce Switch: 9372 8877
Information Management - Privacy and Personal Information Protection Guideline	This Guideline aims to assist agencies in developing policies and procedures for the effective management of personal information. The Guideline is primarily concerned with the responsibilities of agencies and individuals as set out in the <i>NSW Privacy and Personal Information Protection Act (1998)</i> .	www.oict.nsw.gov.au Contact: Government Chief Information Office, Department of Commerce Switch: 9372 8877

Overseas Projects

Overseas Projects, Premier's Memorandum 2002-03	This Memorandum sets out the policy and guidelines relating to the use of NSW public sector skills in overseas projects.	www.premiers.nsw.gov.au Contact: Ministerial and Parliamentary Services Division, Premier's Department Tel: 9228 4443
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Pricing

Guidelines for Pricing of User Charges TPP01-02 June 2001	This document has been developed to assist agencies to price goods and services in a competitively neutral way. It should be read in conjunction with the <i>Policy Statement on the Application of Competitive Neutrality Policy and Guidelines Paper</i> (see above).	www.treasury.nsw.gov.au Contact: NSW Treasury Tel: 9228 4240
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Procurement

Smarter Buying for Government	This document outlines strategies for a new accelerated phase in procurement reform and builds on the <i>Government's Procurement Implementation Strategy, Construct New South Wales, and Total Asset Management</i> .	www.commerce.nsw.gov.au Contact: Department of Commerce Head Office Tel: 9372 8877
Electronic Procurement Implementation Strategy	This document supports the strategies in the <i>NSW Government Procurement Policy and Construct New South Wales</i> on the take up of electronic commerce in procurement and information technology in construction.	www.commerce.nsw.gov.au Contact: Department of Commerce Head Office Tel: 9372 8877
NSW Government Procurement Policy, Treasury Policy and Guidelines Paper TPP 04-1:	The Policy establishes a whole-of-government framework for procurement. It includes the <i>NSW Government Code of Practice for Procurement</i> , which establishes obligations and standards of behaviour for Government agencies and those with whom they do business.	www.treasury.nsw.gov.au Contact: Asset Management and Procurement Branch, NSW Treasury Tel: 9228 4417

Subject/Document Title	Details	Location
Recording Keeping and Archives Management		
Government Recordkeeping Manual	The Manual brings together all the policies, standards, and practical guidance that NSW public offices need for the creation, management, protection, and retention or disposal of the records they generate in the course of their everyday business—whether that business is conducted wholly in the electronic environment or also relies on paper based processes.	www.records.nsw.gov.au Contact: State Records Switch: 9673 1788
Risk Management		
Risk Management and Internal Control Toolkit	The Toolkit is designed to help agencies assess how well their existing risk management and internal control framework is working and whether it could be improved. The Toolkit consists of: <ul style="list-style-type: none"> • Risk Management and Internal Control Guidelines • Risk Management and Internal Control Self-Assessment Matrix, and • Implementation Strategies. 	www.treasury.nsw.gov.au Contact: NSW Treasury Switch: 9228 4567
NSW Government - Guidelines for Economic Appraisal	The Guidelines are intended to extend economic appraisal methods (i.e. analysing all the costs and benefits associated with a particular project) to all public sector agencies to achieve a more consistent approach.	www.treasury.nsw.gov.au Contact: NSW Treasury Tel: 9228 4641
NSW Government - Financial Appraisal Guidelines	The Guidelines provide assistance in the financial assessment of projects.	www.treasury.nsw.gov.au Contact: NSW Treasury Tel: 9228 3254
Managing Risk in the NSW Public Sector (19 June 2002)	This Audit Report concentrates on risk management within the NSW public sector. It is based on a survey of twenty-six agencies.	www.audit.nsw.gov.au Audit Office of New South Wales Contact: See website for contact details for key personnel.
Working with the Private Sector		
Policy for Privately Financed Projects (2001)	This Policy sets out <i>Guidelines for Privately Financed Projects</i> (2001). These Guidelines update and broaden the scope of previous guidelines on the private financing of infrastructure.	www.nsw.gov.au/wwg Contact: Director, Privately Financed Projects Branch, NSW Treasury Tel: 9228 3213
Working with Government –Guidelines for Privately Financed Projects (2001)	The Guidelines are intended to assist in the establishment of a partnership between the public and private sectors. The aim is to deliver improved services and better value for money, primarily through appropriate risk transfer, encouraging innovation, greater asset utilisation, and integrated management throughout the life of the project. The guidelines specifically cover Privately Financed Projects (PFPs), which are part of the broader spectrum of Public Private Partnerships (PPPs). Other kinds of PPPs are covered by the NSW Government Procurement Guidelines.	www.nsw.gov.au/wwg Contact: Director, Privately Financed Projects Branch, NSW Treasury Tel: 9228 3213
Intellectual Property Guideline for Unsolicited Private Sector Proposals	This Guideline provides a checklist of intellectual property issues to be covered in unsolicited proposals submitted under the <i>Working with Government Guidelines for Privately Financed Projects</i> (see above). The aim is to assist proponents to describe the intellectual property aspects of their proposals effectively.	www.nsw.gov.au/wwg Contact: Director, Privately Financed Projects Branch, NSW Treasury Tel: 9228 3213

Part 3: Summary Guide



Intellectual Property Management Framework for the NSW Public Sector

IP Principles, Better Practice Checklist, and Advisory Signposts

IP Principles

Policy and Strategy

1. Agencies are to develop an IP policy based on this Framework which supports their core functions and service delivery outcomes.
2. Agencies are to develop an implementation strategy for their IP policy.

Creation and Rights

3. By law, the State of NSW owns any IP developed by its employees in the course of their employment unless it is specifically agreed otherwise. Moral rights are an exception; they automatically belong to the creator in the absence of an agreement to the contrary.
4. Agencies are to ensure that their employees are aware of their legal obligation to respect the IP rights of others, including their moral rights.
5. In all circumstances in which IP might be created or acquired (including employment, out-sourcing, grants, procurement, consulting, and contracting agreements) ownership of IP should be specifically addressed.
6. Agencies should take reasonable steps to ensure that the people of NSW have the best opportunity to benefit from the IP, whether the ownership of, or rights to, the IP are vested in the agency, a contracted developer, a collaborative developer, a grant recipient, or other party.

Identification and Recording

7. Agencies should introduce mechanisms to identify and record any significant IP they own, control, or use (refer to the Identification and Recording section below for guidance in determining significant IP). They must also address any issues which emerge in regard to the ownership of the IP. This applies whether the IP is created by staff in course of their duties, contractors, consultants, or others.

Publication

8. Agencies are to establish policies and procedures to manage their publications and websites.

Commercialisation

9. In making decisions about commercialising government IP, the agency must be satisfied that the people of NSW will obtain the maximum benefit. Note that in some cases it may be in the best interest of NSW for the agency to transfer the IP to another government agency, or private industry, either for a fee, a non-commercial fee, or free of charge.
10. Commercialisation decisions are to be made on the basis of appropriate legal, financial, and commercial IP advice.

Reporting

11. Information on the management of IP is to be provided in a timely manner by agencies to their Executive, Board of Management, and any other appropriate stakeholders.

Better Practice Checklist

Management

- IP management incorporated into planning processes and directly linked to service delivery outcomes
- Risk management strategy underpins implementation
- Responsibilities assigned to a senior officer or team
- Communication strategy is developed and implemented
- System of evaluation established

Policy and Strategy

- Policy and procedures created and integrated with existing systems
- Significant IP identified and guidelines established for identifying remaining significant IP
- Policy and procedures communicated to employees
- Key staff trained
- Regular evaluation undertaken

Creation and Rights

- All contracts, including employment contracts, address IP rights, where appropriate
- Confidentiality and Non-Disclosure Agreements considered
- Active steps taken to avoid infringing IP rights
- Appropriate control maintained over the IP when rights transferred
- Dispute resolution strategy in place
- Expert financial and legal advice sought when protecting IP rights

Identification and Recording

- Significant IP is identified and recorded as it is created
- System for recording IP is linked to reporting system

Publication, including websites

- Publication policy issued
- Publication of IP does not breach confidentiality or infringe IP rights
- Risk assessment undertaken and steps taken for higher risk publications
- All publications, including websites, display a copyright statement and, where appropriate, a disclaimer

Commercialisation

- Risk assessment undertaken and steps taken to manage risk
- Commercialisation strategy developed
- Commercialisation arrangements ensure that IP is managed consistently with State Records and Competitive Neutrality obligations
- Rights to commercialise IP are transferred under certain circumstances provided appropriate conditions are met
- Expert financial, legal and commercial IP advice obtained as required or appropriate

Reporting

- IP reporting systems in place and line of reporting established
- Legal reporting obligations complied with
- Periodic reports made to appropriate stakeholders

Intellectual Property Advisory Signposts

