

# Innovation Disclosure Form - Supporting Information

This document accompanies the [Innovation Disclosure Form](https://www.health.qld.gov.au/__data/assets/word_doc/0025/719008/invention-disclosure-form.docx) through which Queensland Health researchers/innovators submit information to enable their inventions and other innovations to be assessed for commercial potential. Intellectual property (IP) protection (e.g., patent) may be necessary to attract investment to develop and make the innovation widely available, to deter infringement and to facilitate licensing of the IP to other parties.

## Can my invention be patented?

A new device, substance, method or process may be protected by patent if it meets the requirements of the *Patent Act 1990* (Cwth), under which an invention must:

* be a **manner of manufacture** i.e., a tangible invention, rather than a theory, idea, mathematical model, purely mental process or artistic creation.
* be **novel** i.e., the invention has not been disclosed before by the inventor or anyone else. A search of [patent databases](https://www.ipaustralia.gov.au/patents/understanding-patents/searching-patents), the internet, journals, textbooks and other resources will help to ascertain whether the invention is novel. Due to the novelty requirement, inventors should seek advice and/or file a patent before disclosing an invention in publications, at conferences, by email or by other means. Confidentiality agreements should be used if you need to disclose inventions to potential business partners or research collaborators.
* involve an **inventive step.** It must not be obvious to somebody with knowledge and experience in the technological field i.e., somebody “skilled in the art”.
* be **useful** i.e., do what you say it will do.
* not have secretly been used in a commercial manner by the person/entity applying for the patent or with their consent.

## Can I patent software?

It may be possible to patent software if it meets the strict criteria of the *Patent Act 1990* set out above. This may be the case for software that improves the technical functionality of a computer in a new and innovative way. However, it can be very difficult meet the requirements of the legislation for software, and it may be necessary to consider other forms of protection (See below). Also, the inclusion of open-source software may prevent you from being able to patent new software, due to restrictions imposed by the open-source licence terms.

## What other IP protection may be available?

Other forms of intellectual property protection may also be relevant to your project, including **copyright** (e.g., for literary material/publications, photographs, drawings, software code), **trade marks** to protect branding such as names and logos, **circuit layout** rights, and **registered designs** to protect the appearance of a product. IP can also be protected by keeping it confidential.

## Why is freedom to operate important?

It is important to consider “freedom to operate” early in the commercialisation process, to ensure that the planned use of your invention will not infringe IP rights held by other parties. As part of a due diligence process, the inventor should conduct a [patent search](https://www.ipaustralia.gov.au/patents/understanding-patents/searching-patents) to help to identify protected IP in the relevant field of technology. IP professionals such as patent attorneys will be able to assist with freedom to operate searches and advise in relation to the scope of the rights held by others.

There may be options available if freedom to operate is impacted, such as negotiating licences with the owners of existing technology.

## Why is it important to review existing agreements?

IP provisions in contracts with funding bodies and research collaborators should be reviewed to determine who owns the IP arising from a research project, and any restrictions on how it may be used and commercialised.

You may have entered into a licence agreement to use another party’s pre-existing (also known as “background”) IP in connection with the development of your new IP. The terms of that agreement should be reviewed, particularly provisions relating to ownership, use, protection, and enforcement of IP rights. These provisions may impact how you can use your new IP that incorporates or has been developed from the pre-existing IP. Examples include materials transfer agreements for biological materials and open-source software licences.

## Planning the next steps

Commercialisation of IP involves significant investment of time and resources and is by its nature high risk. Therefore, it is important to plan a commercialisation strategy.

The expertise of the researchers/innovators who created IP will be instrumental in planning for commercialisation, including analysing the market need and competitive landscape for the technology.

The development and commercialisation of IP requires funding. Consider potential external funding sources such as [government grants](https://business.gov.au/grants-and-programs?resultsNum=10), loans and incentives and venture capital companies.

You will also need to consider partnerships that could make your project successful. Who would be logical partners to further develop the technology to a market-ready stage? Are there companies that manufacture similar technologies, or entities whose core business fits well with your IP and commercialisation objectives?