

IP rights must travel well



More and more universities are operating overseas, which puts a premium on navigating the often murky waters of protecting copyrights in foreign lands.

By Shehana Wijesena

Tertiary education is increasingly a global enterprise. International students roam the planet to find the best course, while universities establish international operations to forge stronger research links, differentiate themselves and burnish a global brand.

It's why Charles Sturt University has an Ontario, Canada campus, Monash has an outpost in Prato, Italy, and RMIT has a presence in Hanoi. Universities Australia's most recent review found there are 821 programs

offered by local universities offshore, lasting between six months and five years.

While there are clear benefits to this, there are challenges also, and many of them are associated with effective intellectual property rights protection.

Intellectual property rights – such as inventions, trademarks and copyright – are among the most prized assets of a university. Universities should ensure their internal policies for employees and students address intellectual property rights ownership and

usage. However, while there may be clear rules governing intellectual property rights protection in Australia, things can become a little hazier in some international markets, especially when a collaborative project spans several jurisdictions.

A key issue for any university abroad is to establish clearly, and upfront, who owns the intellectual property rights in any materials employees create.

In addition, universities should seek to register key trademarks ahead of entering an overseas market. A registered trade is the strongest right available in terms of enforcing a monopoly over a brand. However, the question arises: what steps should an Australian university take to protect its brands in China, Canada or even a post-Brexit UK?

OWNERSHIP AND USE

The decision in *University of Western Australia v Gray* established that in Australia academics do not have an intrinsic duty to invent. Further, it was found that in the absence of an agreement to the contrary, a university cannot automatically claim ownership of the inventions made by academic staff in the course of research, even if the inventions were made with the use of university's resources.

Universities planning international forays need to consider the equivalent legal position in the jurisdictions in which they plan to operate. Armed with that insight, they can then ensure their employment contracts are carefully drafted to address the ownership and use of any inventions (or other intellectual property rights) generated while the academic is employed by the university.

Universities establishing international campuses or forging global collaborative ventures should also ensure that any policies they use overseas correctly reflect their desired position on the ownership and use of such intellectual property rights.

Another consideration that universities should bear in mind that any licences granted to third parties to use their intellectual property rights must be documented and carefully address the rights and restrictions pertaining to that licence. These contracts should encompass issues such as who has standing to bring infringement actions, the retention of any rights by the university, ownership of improvements, and obligations to commercialise the intellectual property rights that are the subject of the licence.

TRADEMARK TERRORS

China remains one of the more challenging jurisdictions with regard to intellectual property rights protection, and universities would be wise to understand the risks. Unlike in Australia, it is possible for anyone to claim ownership of a trademark in China if they are the first to file an application to register that trademark. That's starkly different to Australia, where a university can claim to be the first user of a trademark (even if it was not first to file) and hence its rightful owner, even ahead of formal registration.

China also has a complex system featuring trademark subclasses, which can allow an entity to register a university's trademark in a subclass for goods or services similar to what the university offers. This can then prevent that university from being able to effectively control its use of its trademark and enforce its rights. Universities should seek advice on how best to prevent such a situation.

PROPER PROTECTION

Prior to commencing use of a trademark in an international market, universities should have searches carried out to ensure there are not any existing registrations that could give rise to a claim of trademark infringement.

To ensure that a university can protect and enforce its rights in its brands, it should seek to obtain registration of, at least, its core trademarks.

It is possible to achieve international trademark protection in a wide variety of overseas markets by filing a Madrid Protocol application. Most countries – with a few noticeable exceptions, such as Canada – are a party to the Madrid Union (the agreement and treaty that governs Madrid Protocol applications). This system enables the applicant to file one application designating the countries it is seeking protection in. It is a streamlined method of achieving international trademark protection and can be carried out from Australia. For countries such as Canada, which are not part of the Madrid Union, a separate trademark application can be filed directly through the national trademarks office.

While trademark ownership is relatively straightforward when the trademark is being used solely by one institution, universities that are seeking protection of a trademark being used in collaboration with other institutions should seek advice on how to structure ownership and usage

to avoid the validity of the trademark being challenged.

Universities also need to be mindful that there can be a lengthy wait to obtain registration in some countries. While in Australia the quickest a trademark can be registered is seven-and-a-half months from the date of filing, in other countries it can take far longer. For example, in August, the Indian trademarks office had been issuing certificates of registration for trademarks filed in 2009.

The UK's recent Brexit vote also raises questions for universities seeking protection across the current and future European Union, which may at some stage lack England, Scotland, Wales and Northern Ireland. While this position remains uncertain, it is possible to file a Madrid Protocol application across the EU plus these Brexit countries, though it does inject additional cost. Similarly, universities that already have EU trademark protection may need to assess the impact of Brexit on their registrations, and whether they will need to apply for separate trademarks specifically for the UK.

DOMAIN NAMES AND MOOCs

What can a university do if it discovers that another entity has set up a website using a domain name that encompasses one of its trademarks?

Fortunately, there are dispute resolution processes that can be carried out from Australia to address disputes over the ownership of .com and .au domain names. Universities should note that having a trademark registration will consolidate an argument that a domain name is infringing upon a brand over which the university has rights.

The content of course and other educational materials will be protected by copyright. In Australia a work is automatically protected by copyright once it is written down or recorded. There is no system of registration and there are no fees payable to be afforded copyright protection. However, this may differ across jurisdictions and universities should review the operation of copyright protection in the countries where they plan to operate.

Universities offering MOOC content should be aware that just because copyright materials are made available online for free does not mean the intellectual property rights in that material are relinquished. Rather, the material is being licensed for free and for a specific purpose.

The terms and conditions associated

on MOOC sites should set out restrictions on how and when the content can be reproduced, adapted or otherwise communicated.

It's also a good idea, though not strictly necessary, to have a copyright notice on any materials made available through MOOC sites, to alert users that these materials are protected by copyright that belongs to the university.

STUDENT RESPONSIBILITY

When setting up international campuses, Australian universities can learn the hard way that not all cultures have the same approach to intellectual property rights. The best way to ensure incoming students understand the university's rules is for each student to be provided with guidelines regarding plagiarism and use of copyright materials. These policies should also be available online.

Also, just as the internet has spawned the MOOC, it has allowed online sites such as Course Hero to emerge, which encourage students to share educational materials, such as course notes and presentations prepared by academics as part of their employment.

If a university finds that its copyright materials have been uploaded onto such a site, there are processes it can follow to request that the materials be taken down. This can be a swift and effective method of dealing with such infringements. However, it's important that universities continue to monitor such sites, as students regularly upload fresh material and until the complaints process is activated, it will stay online.

Once an infringement is identified, you should seek the advice of a lawyer based in the jurisdiction where the infringement has occurred. Generally, the first step is to send a letter demanding that the infringement cease. If that does not resolve the issue, universities may then need to consider initiating proceedings for infringement upon its intellectual property rights.

Disputes are inevitably costly and time consuming; having clearly documented policies, registrations, contracts and processes in place ahead of time can often reduce the incidence of infringement, or at the very least help resolve issues efficiently. ■

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