



University of Western Australia v Gray [2009] FCAFC 116 (3 September 2009)

The Full Federal Court has dismissed the appeal of the University of Western Australia (UWA) against Professor Bruce Gray regarding **ownership of inventions** made by Dr Gray while employed by the university.

Notwithstanding express terms in Dr Gray's contract to undertake research and such research being undertaken in the course of employment by Dr Gray, the court held that there was **no "duty to invent"** imposed on Dr Gray and **no common law implication of employer ownership of employee inventions** in the circumstances that would give UWA proprietary rights in Dr Gray's inventions.

Further, the court held that in the absence of an implied term at common law, there was **no independent fiduciary obligation**

of a kind and scope that would hold Dr Gray accountable **to the university for his inventions, patents or patent applications**. Dr Gray did not hold his inventions and patents in trust for the University by virtue of his duties as an employee of the university. Relevant considerations included: Dr Gray's ability to determine and lead the direction of research, his need to act as an entrepreneur to attract funding to carry out the research and the freedom to publish his research findings and collaborate with researchers outside UWA.

The Court also looked at the significance of a term incorporating the university's patents regulations into Dr Gray's contract of employment. This term requires employees making

an invention during and in the course of employment to notify the Vice-Chancellor who was then to refer matter to the university's patents committee for recommendation whether university should assert rights in invention and apply for a patent. The university's failure to maintain its patents committee mechanism (on which its rights were dependent) resulted in Dr Gray being unable to fulfil this term of his contract. Therefore, the University's own failure excused Dr Gray from performance of his obligation to notify the university of his inventions.

See full decision at <http://www.austlii.edu.au/au/cases/cth/FCAFC/2009/116.html>