



Department of
**Jobs, Tourism, Science
and Innovation**

Ownership of WA Government Intellectual Property

IP Policy: Agency Toolkit



About this document

This guide is part of the **Intellectual Property Toolkit for WA Government Agencies**.

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Contents

In summary.....	4
1 Introduction	5
1.1 Ownership of Western Australian Government IP	5
2 Principles for determining ownership	6
3 Options for ownership	6
4 Ownership arrangements in different settings	8
4.1 Employment arrangements	9
4.2 Collaborative projects and research partnerships.....	9
4.3 Contracts and agreements.....	10
4.3.1 <i>Procurement of contractors and suppliers including Information and Communication Technologies (ICT)</i>	11
4.3.2 <i>Funding and Grants</i>	13
4.3.3 <i>IP needs analysis</i>	13
4.4 Use of IP owned by other parties	14
5 Determining ongoing ownership arrangements	14
5.1 Factors for determining ongoing ownership.....	15
5.2 IP to be retained within WA Government.....	15
5.3 Reassignment of IP ownership	16
5.4 Licensing and third party access	17
6 Supporting resources	17
Flowchart 1: Assignment of ownership	18
Flowchart 2: Determining ongoing IP ownership.....	19



In summary...

OWNERSHIP OF WA GOVERNMENT IP

The State owns the IP created by its employees in the course of their employment.

In some circumstances, parties may agree to alternative ownership arrangements.

Options for IP ownership



Sole Ownership
IP owned by 1 entity



Licensing
Owner grants conditional rights for other parties to use IP



Joint Ownership
Ownership shared between 2 or more parties

COMMON OWNERSHIP SCENARIOS

The WA Government IP Policy provides guidance and suggested starting points for IP ownership in a number of settings.

Agencies may adopt an alternative approach if required as long as the arrangements meet operational requirements and maximise public benefits.

SUGGESTED STARTING POINTS:



Employment

State owns IP created by employees in course of employment duties.



Research partnerships

Ownership assigned to 1 party who grants licences to agreement partners.



Contracts & suppliers

Contractor/supplier owns IP created and grants State broad licensing rights.



Funding & Grants

Funding recipient owns IP created. State may seek licensing rights.

DETERMINING ONGOING OWNERSHIP

Agencies should periodically assess their ongoing IP ownership arrangements.

The transfer or assignment of IP should be considered when:

- The agency does not wish to further develop or commercialise the IP; or
- There is a party better placed to further develop or commercialise the IP.

Agencies should ask how the assignment, licence or transfer of its IP benefits the State



Facilitate IP development for the benefit of the community



Facilitate job creation



Attract investment



Build the innovation ecosystem



Provide economic, social or environmental benefits



1 Introduction

Like other forms of property, intellectual property (IP) assets also have a legal owner who may be an individual person, government department, company or not-for-profit organisation.

An IP owner has a number of rights, including the right to:

- make decisions about the development, use and commercialisation of the IP;
- register protections for the IP and take action where someone infringes their rights;
- make the IP available for other parties to use and develop, usually in exchange for a financial benefit; and
- dispose or transfer ownership of the IP asset to another party.

Given the potential commercial value of IP assets, determining who owns the IP is a critical step for its effective management.

1.1 Ownership of Western Australian Government IP

The requirements and guiding principles for ownership of WA government IP are set out in section 4 of the [Western Australian Government Intellectual Property Policy](#) (the IP Policy). The high level statements are set out in this guide.

WA Government IP Policy Position Statement: ¹

The State owns the IP rights created by its employees in the course of their employment.

Where the IP is created in the course of a WA public sector employee's duties, ownership will rest with the State unless the agency has entered into an agreement to vary this arrangement.

To mitigate confusion and the risk of dispute, it is important that ownership arrangements are specifically addressed in all contracts and agreements where IP is likely to be created, including with contractors, consultants and seconded public employees.

The IP Policy encourages agencies to assess appropriate arrangements for the ongoing ownership of IP, including consideration of the party best placed to further develop or commercialise the IP for maximum public benefit.

¹ WA Government Intellectual Property Policy (2023), p. 7.



2 Principles for determining ownership

The below principles illustrate how ownership of IP may be determined, including where there is an employment or contractual agreement. The starting point for determining IP ownership is based in the common law which provides that the person who created the work is the owner of the IP. The exception to this is where the IP was created under a contract of service, including employment. Where IP is developed in the course of employment, it is owned by the employer unless agreed to the contrary.

General principle provides that person who created the work is the owner of the IP.

EXCEPT, where the IP is created under a contract for service including employment.

When IP is developed in the course of employment it is owned by the employer.

UNLESS, there is an agreement to the contrary in place.

IP created by employees

Employees often create IP as part of their work. For example, a piece of software or a new product design. In Australia, employers own the IP their employees create in relation to the business. Exceptions to this rule must be in the employment contract to be legally binding.²

IP created by contractors

Contractors are often hired to create a wide variety of new materials, including valuable IP, under a contract of service. For example, websites, designs, drawings, databases and logos. In Australia, IP created by a contractor is the property of the contractor unless otherwise stated in the contract.³

3 Options for ownership

There are a number of options for ownership that may be considered, each with different risks and benefits, as outlined below:

- **Sole ownership:** IP is owned and managed by one entity.
- **Joint ownership:** Ownership rights are shared between two or more parties. These arrangements are more likely to arise where IP is developed or created as the result of a partnership.
- **Licensing:** Allows another entity to exercise IP rights subject to a set of agreed conditions. The IP owner(s) retain their right of ownership and some rights to use the IP depending on terms of licence agreement.






Refer to the [Guide for Commercialising WA Government IP](#) for more information about licensing arrangements.

² IP Australia, [Who Owns Intellectual Property?](#), retrieved February 2023

³ Ibid.

The table below outlines some of the key advantages and disadvantages from the perspective of the agency or entity for different types of IP ownership⁴.

Ownership type	Advantages	Disadvantages
<p>Sole ownership</p> 	<ul style="list-style-type: none"> Entity has full control of IP. Suitable for IP with strategic or whole-of-government importance. 	<ul style="list-style-type: none"> Time and costs to negotiate arrangements with contracting parties. May increase the contract price in procurements. May deter some contractors and collaborators. <p>Entity that retains ownership may not be in a position to further develop or commercialise the IP.</p>
<p>Joint ownership</p> 	<ul style="list-style-type: none"> Perceived as more flexible than sole ownership. May be easier to negotiate joint ownership rather than entity retaining sole ownership. 	<ul style="list-style-type: none"> Presents a higher risk to the State including through: <ul style="list-style-type: none"> Higher risk of dispute between joint owners. Can be complex to manage. Requires detailed agreements and contractual arrangements. May be perceived as less attractive by investors and limit future commercialisation opportunities.
<p>Licensing</p> 	<ul style="list-style-type: none"> Flexible. May reduce costs by avoiding unnecessary negotiation and related legal costs. Can encourage further innovation or growth within a particular industry. 	<ul style="list-style-type: none"> Entity may not have full control of IP. Contracts need to be worded carefully to ensure certainty and adequate rights. Licence conditions require appropriate management.

⁴ Table adapted from Commonwealth of Australia (2012) *Australian Government Intellectual Property Manual*, p.150.

4 Ownership arrangements in different settings

WA Government IP Policy Position Statements: ⁵

Relevant employment, secondment and consultancy contracts should expressly address any research, invention and innovation type duties of employees.

IP ownership should be addressed in contracts between agencies and third parties that involve pre-existing IP or new IP. This includes procurement, grant, funding, research and collaboration contracts.

Where the State will not own the IP, the State's right to use the IP (licence terms) must be specifically addressed in all relevant contracts. The right to use the IP should be broad enough to cover the State's operational needs.

The IP Policy provides guidance for agencies considering IP ownership in a number of settings including:



Employment



Collaborative projects and research partnerships



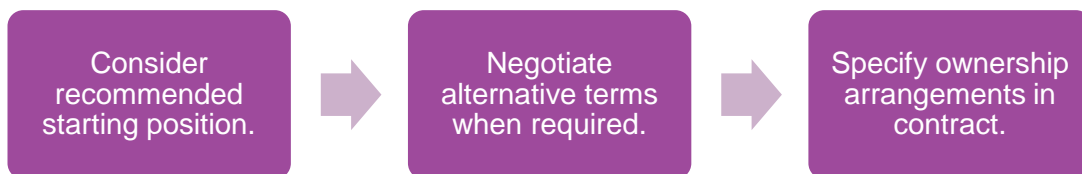
Engagement of consultants and suppliers



Grant and funding agreements.

The following sections include *suggested* approaches to the treatment of IP in contracts. These positions are recommended starting points only and an agency may adopt an alternative approach where required provided the arrangements meet operational requirements and maximise public benefits.

Figure 1: Suggested approach to addressing IP ownership in contracts and agreements



Supporting resources

The [flowchart for Assignment of Ownership](#) at the end of this guide may assist an agency when considering alternatives to the recommended IP ownership positions in relation to contractors and suppliers.

⁵ WA Government Intellectual Property Policy (2023), p.7.



4.1 Employment arrangements



Suggested starting position

State owns IP created by employees in course of employment duties.

The WA public sector is a diverse group of approximately 130 employing agencies working to deliver services to the community⁶. Some roles and positions within WA Government are likely to present more opportunities for research, innovation and invention than others. For example:



The Biodiscovery and Conservation Science section of the Department of Biodiversity, Conservation and Attractions employs staff with expertise in a wide range of fields including biology, ecology, taxonomy and genetics to support the functions of the Parks and Wildlife Services, Botanic Gardens and Parks Authority, Zoological Parks Authority and Rottneest Island Authority⁷.



The ChemCentre's research and innovation program focuses on areas including environment and mining, agriculture and food, water, and forensic science⁸.



The Department of Primary Industries and Regional Development undertakes targeted research and development in areas that will drive innovation and commercial outcomes for the State's grains, livestock, horticulture, fisheries, aquaculture and forestry industries⁹.

For business areas within WA government agencies that engage in research and innovation activities it is important that all employment contracts clearly and expressly:

- address the duties of employees related to research, innovation and invention; and
- state that any IP generated by an employee in the course of these duties will be owned by the State.

Where required, agencies should seek legal advice regarding the inclusion of terms related to IP rights, confidentiality and moral rights consents in employment contracts.¹⁰

4.2 Collaborative projects and research partnerships



Suggested starting position

Assign IP ownership to one party. This party may then grant a licence to the other relevant parties. These licences can include equivalent rights to ownership.

WA Government agencies may enter into research partnerships with universities and research institutes. Collaborative partnerships can provide opportunities to pool resources and experiences and will likely result in the development and creation of new IP.

To ensure effective management of IP, it is suggested that IP ownership is held by one party who provides rights for the other parties to use the IP via licence.

⁶ State of Western Australia (2021), [About WA Government](#), retrieved February 2023.

⁷ Department of Biodiversity, Conservation and Attractions, [Biodiversity and Conservation Science](#), retrieved February 2023.

⁸ ChemCentre, [Research Development and Innovation - A Centre of Excellence](#), retrieved February 2023.

⁹ Department of Primary Industries and Regional Development (2020), *Primary Industries Plan 2020-2024*, p37.

¹⁰ WA Government Intellectual Property Policy (2023), p.8.

Collaboration agreements with third parties should address ownership of pre-existing and new IP and the purposes for which the parties may use that IP.¹¹

Joint ownership may be appropriate in certain circumstances, but this can be high risk and needs to be well managed. It is recommended that agencies obtain legal advice prior to entering into any joint ownership agreements, particularly where the arrangement is novel or where it is likely that the IP is to be commercialised.¹²

Arrangements for ownership must be:

- clearly outlined in all contracts and agreements;
- actively managed; and
- regularly reviewed to ensure any changes in project scope or deliverables are addressed.

Agencies are encouraged to seek legal advice early in the development of research partnerships to ensure that ownership arrangements are sufficiently addressed.



Online resources

- [Australian IP Toolkit for Collaboration](#)
- [Higher Education Research Commercialisation Intellectual Property Framework](#)
- [Biotechnology Intellectual Property Manual](#)

4.3 Contracts and agreements

Many contracts and grant agreements result in the use, creation or assignment of IP in some form. The table below provides examples of IP that may be created for different types of contracts¹³.

Types of contract	Common examples of IP related deliverables
Procurement of goods	Designs, inventions, parts, specifications.
Procurement of services – including services to be provided on behalf of government.	Reports, written materials, inventions or innovations, design and management of websites, confidential information, brands.
Procurement of software / software services	Software code, user manuals, specifications, data, software modifications.
Procurement of Consultancy services	Design and delivery of training packages, discussion papers and reports of reviews carried out on behalf of government, IP/confidential material similar to that produced by employees of the entity.
Provision of a Grant (grant agreement)	Written or multimedia content, reports, research results, inventions, designs, information products, client data.
Research & development grants	Inventions, designs, data, reports, confidential information.

Most projects will require both the agency and the contractor to contribute existing IP (background IP) in order to create the new materials (IP output). In some cases the contractor may also leverage the IP of a third party as part of their work, for example purchasing off-the-shelf software.

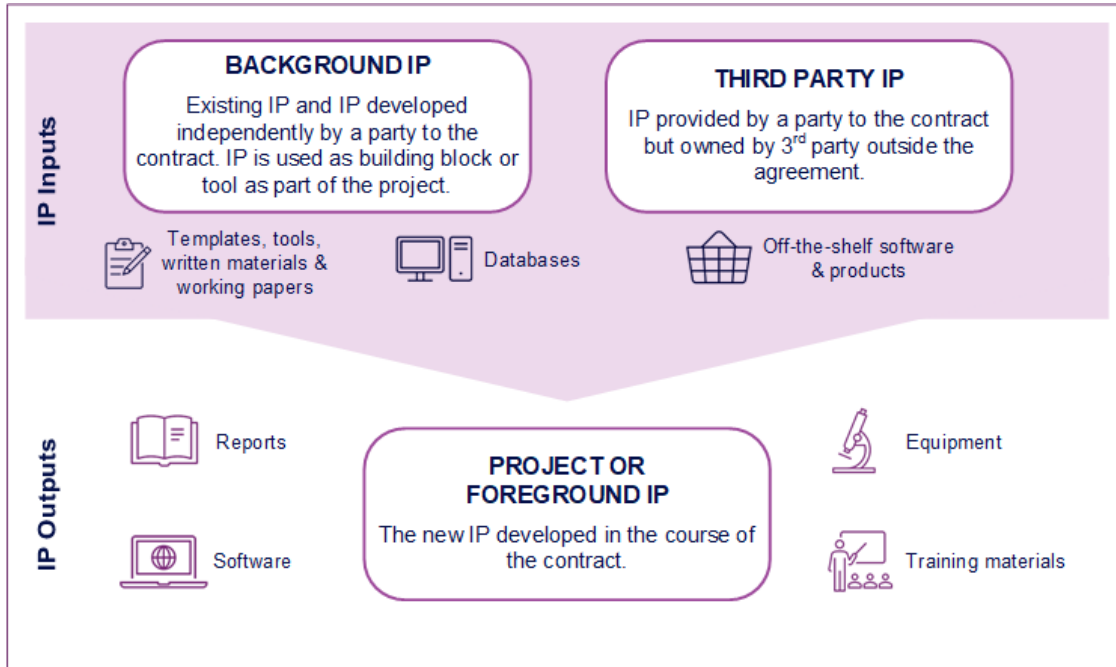
¹¹ WA Government Intellectual Property Policy (2023), p. 9.

¹² Ibid

¹³ Content and table reproduced from Commonwealth of Australia (2012) *Australian Government Intellectual Property Manual*, p.132.

It is important for agencies to consider the ownership arrangements for both the IP inputs and deliverables when developing contracts. Figure 2 below outlines the inputs contributing to the development of IP outputs, including where this is existing/background IP and IP owned by a third party outside of the contract¹⁴.

Figure 2: IP inputs contributing to the development of Project IP



4.3.1 Procurement of contractors and suppliers including Information and Communication Technologies (ICT)

Suggested starting position



For lower value goods or services: New Project IP should be vested with the Contractor or Supplier, unless the IP is considered essential to the agency. The State is granted a broad licence to use the IP.¹⁵

Each party retains ownership of any background IP they contributed to project.



For higher value goods or services: Ownership arrangements to be determined on a case-by-case base. In some situations, the State may wish to own the new IP and enter into a licencing arrangement with the supplier.

Each party retains ownership of any background or existing IP they contributed to project. The State should seek a broad licence to use the Contractors existing IP.¹⁶

This may be particularly relevant where a contractor has developed a program logic, or where a training provider develops a training program that is a 'tool of their trade' (i.e. pre-existing IP).

¹⁴ Information in figure adapted from Commonwealth of Australia (2012) *Australian Government Intellectual Property Manual*, p.138.

¹⁵ WA Government Intellectual Property Policy (2023), p. 14.

¹⁶ Request Conditions and General Conditions of Contract, clause 23.3 (November 2022): [Request Conditions and General Conditions of Contract \(www.wa.gov.au\)](http://www.wa.gov.au).



Where the engagement of suppliers or contractors is likely to involve the creation of new IP, agencies must take into consideration both the principles of the IP Policy and the procurement frameworks provided by the Department of Finance. Agencies should be aware that in some instances, low value procurement may result in IP that agencies may wish to own.

Guidance from the Department of Finance

The Department of Finance provides the following guidance for WA Government agencies when considering IP ownership in procurement¹⁷:

In most cases for purchases with low complexity the Customer (your State Agency) will not require the ownership of the IP. Unless you want to sell or commercialise the IP you probably don't need to own it.

When considering whether you require ownership of the IP or whether a licence will do in the circumstances, consider the extent to which your ownership could represent a cost to the Supplier, which they will build in to their offered pricing.

The [Western Australian Procurement Rules](#) state which form of contract agencies should use based on monetary thresholds, unless the risk, complexity and/or type of procurement requires a different form of contract.


The Department of Finance has developed standard contract terms for use by State agencies.

Contract terms	Description	Considerations
Very Simple Contract Terms	<ul style="list-style-type: none"> Allow the contractor to retain ownership of the IP rights in the materials created, but gives a broad licence to the State to use the Intellectual Property. 	Not appropriate: <ul style="list-style-type: none"> When the purchase has complex requirements including special IP ownership and/or licensing requirements. Where procuring ICT goods, ICT services or consultancy services.
Simple Contract Terms	<ul style="list-style-type: none"> The default position allows the contractor to retain ownership of the IP rights in the materials created, but gives a broad licence to the State to use the Intellectual Property. The agency can change the default position by including the Special Conditions that provide the Customer (Agency) will own the IP rights and grants a licence to the Supplier to use the IP for specific purposes. 	<ul style="list-style-type: none"> If any agency chooses to include the Special Conditions, the price offered by respondents is likely to be greater. In most cases the default position will be sufficient, and the Special Condition should not be included.
General Conditions of Contract Request templates for goods and services	<ul style="list-style-type: none"> Ownership arrangements are determined on a case-by-case basis, informed by what IP may be created. 	<ul style="list-style-type: none"> Do not contemplate joint ownership. Where this is the preferred position, legal advice will be required to reflect joint ownership and the request and

¹⁷ Department of Finance, (2022), *Guide to completing the written quote template suite (WQTS)*, p21. Retrieved February 2023 from www.wa.gov.au/government/document-collections/written-quote-template-suite.



Contract terms	Description	Considerations
General Provisions for the Purchase for Community Services Community Service templates	<ul style="list-style-type: none"> In the relevant Request document, the agency can select the applicable provisions to determine ownership of the IP between the State, Customer or Contractor. 	contract documents will require appropriate amendment.




Department of Finance: Procurement resources

- [Western Australian Procurement Rules](#)
- [Written Quotes Template Suite](#)
- [Goods and services templates](#)
- [Community services templates](#)
- [Buying for government](#)

Agencies may also seek advice from their Procurement Unit.

4.3.2 Funding and Grants



Suggested starting position

All agreements for funding and grants should address any rights to IP.

Where the grant or funding recipient retains ownership, the State may wish to secure a licensing arrangement, where appropriate.

Many WA Government agencies provide grants and funding to individuals and organisations to undertake specific activities or achieve particular goals. These activities often generate IP including written or multimedia content, reports, research results, inventions, designs, information products and client data¹⁸.

Like other contracts and agreements, agencies must consider arrangements for the ownership of these IP outputs, ensure these arrangements are clearly stated in the funding agreements and understood by all the parties involved.

The WA Government IP Policy also applies to activities utilising State resources, which can include those undertaken by contractors and grant and funding recipients, unless otherwise specified in contract.¹⁹ It is recommended that agencies include appropriate terms recognising the application of the IP Policy, where relevant.

¹⁸ Commonwealth of Australia (2012) *Australian Government Intellectual Property Manual*, p.132.

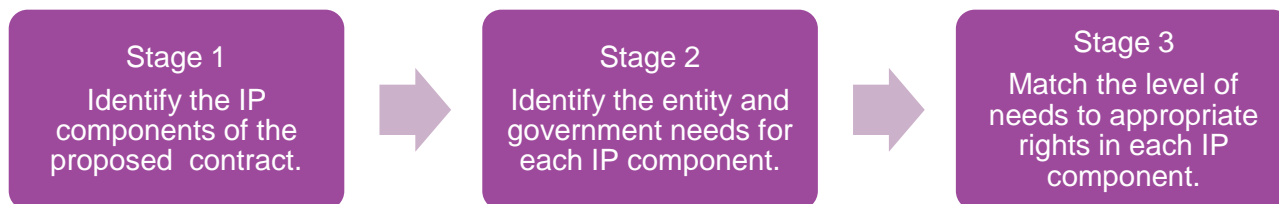
¹⁹ WA Government IP Policy, p.6.



IP needs analysis

The *Australian Government Intellectual Property Manual* sets out a basic framework for ascertaining an entity's preferred IP ownership position based on the needs of a contract²⁰. The key steps in this process are outlined below.

Figure 3: Australian Government IP needs analysis process²¹



Online resources

Chapter 7 of [The Australian Government Intellectual Property Manual](#) includes a structured process to conduct an IP Needs Analysis.

4.4 Use of IP owned by other parties

There may be times where an agency may seek to use IP owned by another party. The agency may:

- enter into a licensing arrangement with the party for the use of the IP; or
- be able to exercise special legislative rights to use the IP without express prior permission (Crown Use).



Further information

[Guide for Managing WA Government IP](#) – Section 5

5 Determining ongoing ownership arrangements

WA Government IP Policy Position Statement: ²²

Where possible, business critical or IP required for core functions owned by the State should be retained.

In determining appropriate arrangements for the ongoing ownership of IP, agencies are encouraged to consider who is best placed to further develop or commercialise the IP for maximum public benefit, and whether licensing, assignment or transfer arrangements will optimise these benefits.

Ownership of IP requires continual resourcing to ensure the assets are managed and used effectively. In some circumstances, agencies retaining ownership of IP by may not be the best approach and alternative arrangements should be considered. The reassignment or disposal of IP may result in greater benefits for the State by increasing the impact value and accessibility of the IP.

²⁰ Ibid, p139.

²¹ Figure adapted from Commonwealth of Australia (2012) *Australian Government Intellectual Property Manual*, p.139.

²² WA Government Intellectual Property Policy (2023), p.7.



5.1 Factors for determining ongoing ownership²³

The IP Policy requires agencies to periodically review and evaluate their IP holdings and the [Guide for Managing WA Government IP](#) provides further information about review processes.

When assessing whether to maintain ongoing ownership of an IP asset, an agency may consider:

1. The impact of the disposal of IP rights on its functions and operations.
2. Whether the disposal of IP rights will maximise public benefit and be in the public interest.
3. The benefits, risks and costs associated with disposal.
4. Whether the nature of the IP lends itself to wider public dissemination via open source licensing.



The [Whole of Government Open Data Policy](#) may assist agencies when assessing the benefits of providing wider access to IP.



WA Government IP Toolkit

The [flowchart for determining ongoing ownership](#) at the end of this guide may when considering whether to retain ownership of IP assets.

5.2 IP to be retained within WA Government²⁴

The IP Policy provides that the State should retain ownership of the following types of IP. Agencies may consider opportunities to provide third parties with access where appropriate.

Description	Considerations
Business critical IP	Where possible, the State should maintain ownership at all times.
Confidential, sensitive and 3rd party licenced IP	This IP should be retained by the State unless legal advice has been obtained and the relevant approvals received for its disposal.
Operational IP	IP required for operational purposes within an agency should not be assigned. The State may consider licencing for use of IP on a limited, non-exclusive basis.
IP with benefits within Government	Where IP may be of use to other WA Government bodies, the agency should consider opportunities to share access via licence, taking into account: <ul style="list-style-type: none"> • Any legislative restrictions; • Personal, sensitive or confidential information; • Any potential infringement of third party IP rights.

²³ Ibid, p.20.

²⁴ WA Government Intellectual Property Policy, p.7.

5.3 Reassignment of IP ownership ²⁵

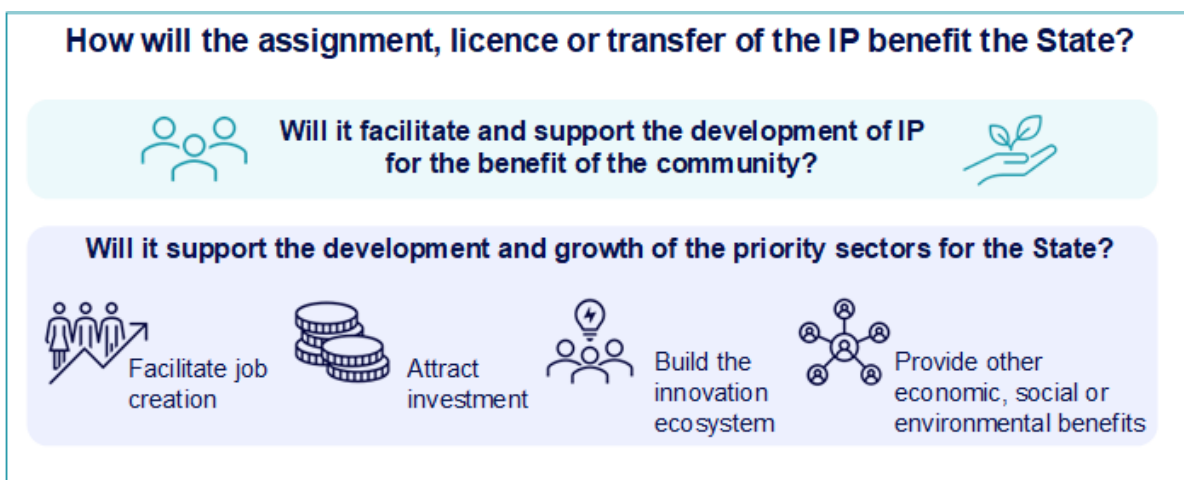
Agencies may transfer the IP to a current or former WA public sector employee or other third party subject to a number of factors and considerations outlined in section 7 of the WA Government IP Policy.²⁶

Where an IP assessment indicates that the agency is:

- not best placed to develop or commercialise the IP to achieve the maximum benefit;
- unlikely to pursue any further development or commercialisation of the IP; or

The IP Policy encourages agencies to consider the transfer or assignment of the IP to a suitable third party for development or commercial exploitation.

Figure 4: Factors to consider for the transfer, assignment or licence of WA Government IP



Conditions for transfer, licence or assignment of IP²⁷

1. Assignment will be for the benefit of the State including where it will maximise public value or increase innovation.
2. Assignment or transfer will provide an appropriate return for the State.
3. The disposal process is undertaken in a fair manner, is appropriately documented and complies with the requirements for the disposal of WA Government assets.
4. Conflicts of interest are managed where the IP is assigned or licenced to a current public sector employee.
5. Provides for the associated risks and costs to be borne by the third party to the fullest extent possible.
6. The recipient is able to make effective use of the IP and has the technical, business and financial capacity to progress the IP's development or commercialisation.

²⁵ Ibid, p.21, 22.

²⁶ Ibid, p.22.

²⁷ WA Government Intellectual Property Policy, p.22.



5.4 Licensing and third party access

Licensing arrangements can provide a way for WA Government agencies to offer access to IP for use and/or development by other parties without losing ownership rights or control of the IP.



Further information

[Guide for Commercialising WA Government IP](#) – Section 3

6 Supporting resources

Flowcharts

- [Assignment of ownership](#)
- [Determining ongoing IP ownership](#)

Agency guides

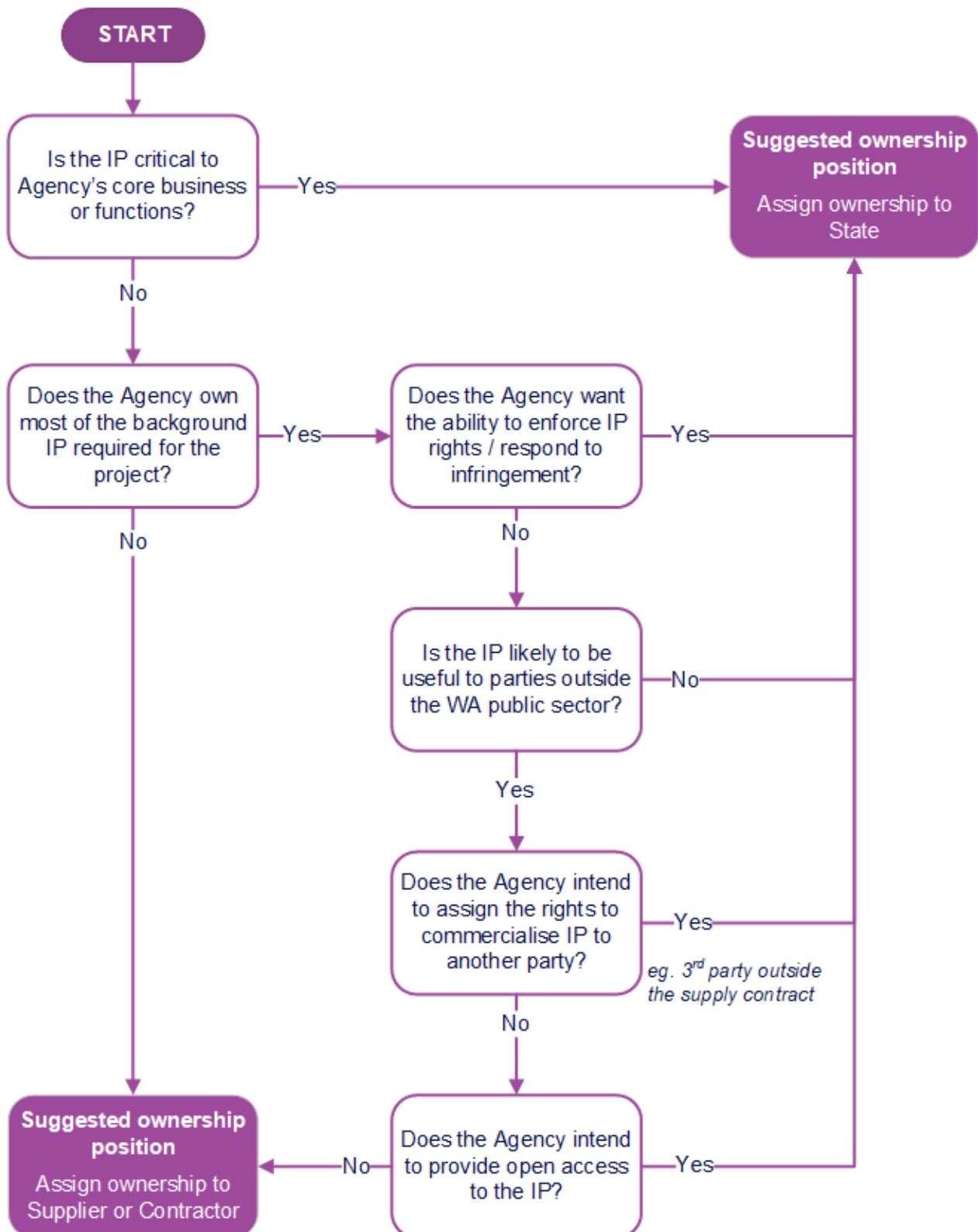
- [Managing WA Government IP](#)
- [Commercialising WA Government IP](#)
- [Rewarding innovative WA public sector employees](#)



Flowchart 1: Assignment of ownership

This flowchart outlines some of the factors that may be relevant where an agency is considering IP ownership in respect to suppliers and contractors.

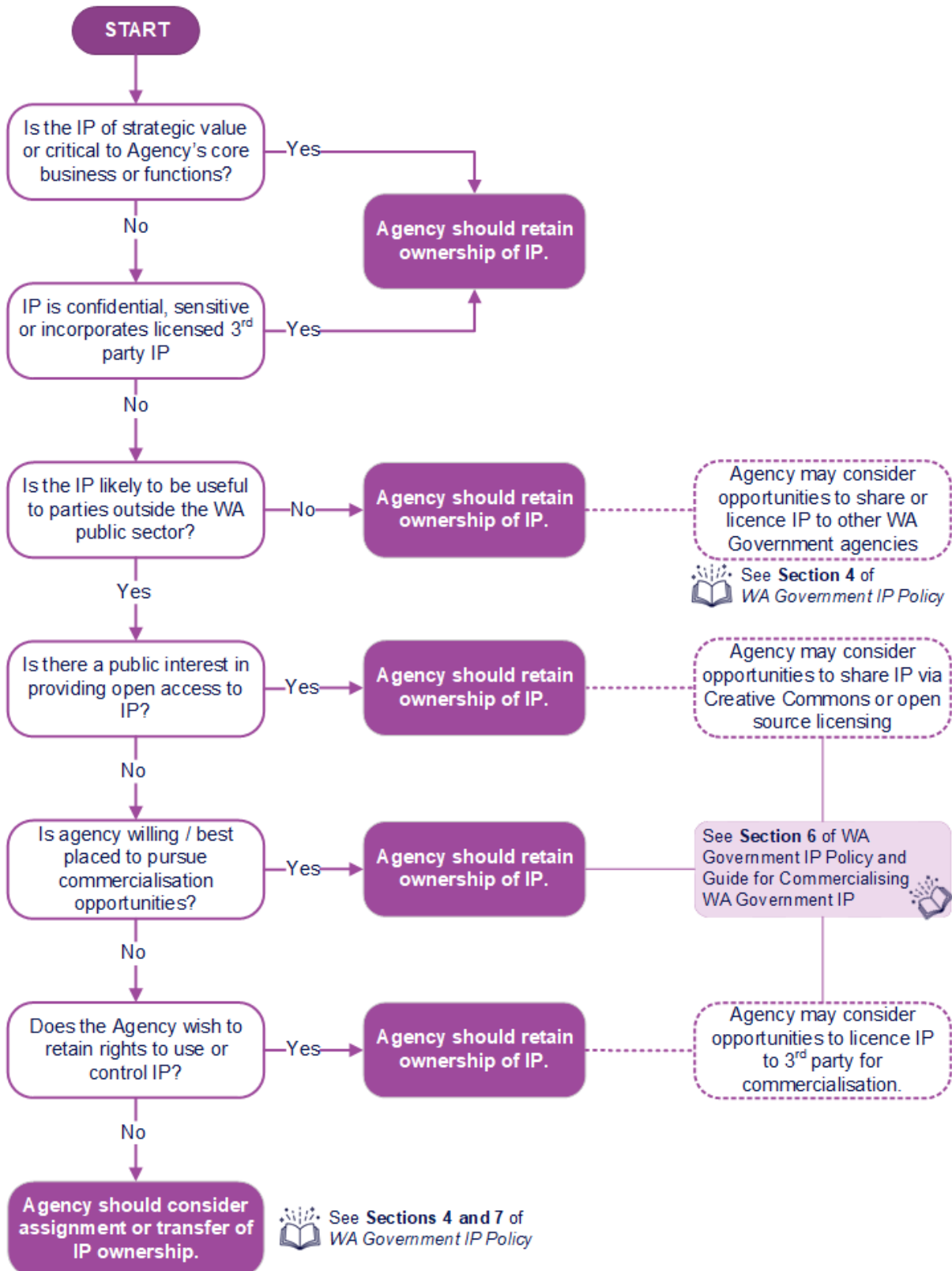
Note: In most instances, the agency is not recommended to require ownership of the IP. Agencies must consider the *Procurement Act 2020 (WA)* and Department of Finance guidance materials for procurement with an IP component.





Flowchart 2: Determining ongoing IP ownership

This flowchart outlines some of the factors that may assist an agency when assessing whether to retain ownership of IP or consider assignment to another party. For ownership of IP in procurement situations, agencies are encouraged to consider **Flowchart 1** above.





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