



# Intellectual Property Policy

**Category:** Research;

**Jurisdiction:** Vice President, Research and Innovation;

**Approval Authority:** Executive Team;

**Established on:** November 27, 2007;

**Amendments:** None.

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## 1. GENERAL

- **1.1 Purpose:** The purpose of this policy is to clarify the relationship between:
  - a) University Faculty Personnel, Students, Staff, and other University Persons (as defined below),
  - b) the University (including its various Faculties and Departments), and
  - c) to the extent possible, Third Parties,  
in the context of intellectual property.
- **1.2 Intention of Policy:** It is the intention of this policy to:
  - a) apprise students, staff, faculty, and the University of the forms of intellectual property and intellectual property protection;
  - b) set out the procedures to be followed and clarify the respective rights of interested parties who wish to commercialize Intellectual Property;
  - c) provide guidelines to assist in the determination of ownership of Intellectual Property created or developed in whole or in part by Lakehead University researchers, or partners of Lakehead University;
  - d) establish guidelines for the use of Lakehead University resources, including the Innovation Management Office, for the commercialization of intellectual property in various ways, including licensing and start-up company development;

- e) provide a guideline for expense and revenue sharing related to the commercialization of intellectual property between interested parties; and
  - f) provide a dispute resolution method for the above noted areas.
- 1.3 It is not the intent of this policy to make new law, but instead to interpret and clarify existing laws related to intellectual property. Any conflict between Canadian intellectual property laws and this policy shall be resolved in favour of the applicable Canadian law.
  - 1.4 It is not the intent of this policy to change, modify, supersede, or terminate any rights and/or obligations set out in other legal agreements between University Persons, the University, and/or Third Parties, including without limitation the LUFA Collective Agreement and other employment contracts.

## **2. APPLICATION OF POLICY**

- 2.1 This policy applies to any and all University Persons, the University, and Third Parties, in respect of any type of Intellectual Property created and/or developed, or believed to be created and/or developed in whole or in part by any University Person in the course of that University Person's duties or activities at the University or through any use of University Facilities.
- 2.2 This policy does NOT apply to Undergraduate Students of Lakehead University, including students of the Northern Ontario School of Medicine.
- 2.3 In the event that this policy conflicts with any agreement (including without limitation the LUFA Collective Agreement) between the University and any University Person, the terms of the agreement shall prevail to the extent of the conflict.

## **3. DEFINITIONS**

- 3.1 In this policy, including any of its schedules or appendices, the following terms have the following meanings, respectively:
  - a) "Copyright IP" shall have the meaning set out in paragraph 5.1 of this policy;
  - b) "Distributed Learning" refers to classes and courses provided through the Office of Continuing Education and Distributed Learning, and includes distance education courses as that term has been used traditionally;

- c) "Extraordinary Support of the University" shall be any funding or support provided by the University that is not Ordinary Support.
- d) "Faculty Personnel" means:
  - i. LUFA Personnel;
  - ii. a Non-LUFA Contract Lecturer; and
  - iii. Adjunct Professors and Professor Emeriti
- e) "Graduate Student" means any person registered at the University as a graduate student, including those on either a full-time or part-time basis;
- f) "Intellectual Property" and "IP" have the meaning ascribed by the common law and any statute law, both in Canada and internationally, and include without limiting the generality of the foregoing, patents, copyright and Copyright IP, trademarks, industrial designs, plant breeder rights, integrated circuit topographies, computer programs, trade secrets, data sets;
- g) "IP Statutes" includes the Patent Act, Copyright Act, Trade-Marks Act, Integrated Circuit Topography Act, Industrial Design Act, Plant Breeders' Rights Act, and other Canadian or other legislation dealing with intellectual property;
- h) "LUFA Collective Agreement" means the agreement between the Board of Governors of Lakehead University and the Lakehead University Faculty Association for the period between July 1, 2003 and June 30, 2006, and any amendments, renewals, or subsequent collective agreements reached between the same parties;
- i) "LUFA Personnel" means anyone who is a member of the Lakehead University Faculty Association bargaining unit, as that term is defined in the LUFA Collective Agreement;
- j) "Net Proceeds" means the net profits derived from the sale, leasing, licensing, or commercial exploitation of the invention, improvement, design or development after deduction of all expenses incurred in the protection of the invention, improvement, design, or development including patent searches, patent applications, patent application prosecution, and maintenance of patent protection in Canada and in other countries.

- k) "Non-LUFA Contract Lecturer" means any person engaged by Lakehead University who may carry out teaching and/or research, but does not include LUFA Personnel, Adjunct Professors, and Professor Emeriti;
- l) "Ordinary Support of the University" includes a University Person's regular salary and benefits; the personnel, equipment, supplies, and facilities funded by regular departmental operating budgets; ordinary use of the library and centralized computing facilities; and research equipment and supplies obtained through grants in aid of a University Person's work.
- m) "Public Disclosure" refers to any book, thesis, journal article, technical or other report, research paper, whether in print, typescript or manuscript form, or recorded and/or stored in electronic or other form. For greater certainty, examples include internet postings, CD ROMs, literature, and DVDs;
- n) "Publish" in this Policy includes any non-confidential distribution of Public Disclosures and other information such as a literary work, and includes activities such as publishing in a journal, posting on the internet, distribution of copies of information in a public setting, and disclosure through media such as television and radio. The term "publishing" in this Policy has the corresponding meaning;
- o) "Research" means work undertaken to expand the frontiers of knowledge, to apply existing knowledge to new applications or study of a particular question.
- p) "Research Contract" has that meaning set out in section 3.1 of the University policy entitled "Policy for the Application and Administration of External Research Grants and Contracts";
- q) "Research Grant" has that meaning set out in section 3.2 of the University policy entitled "Policy for the Application and Administration of External Research Grants and Contracts";
- r) "Research Guidelines" means the University policy entitled "Guidelines and Policy for the Ethical Conduct of Research and Procedures for Investigating Misconduct";
- s) "Research Project" means any Research performed by a University Person, whether or not pursuant to a Research Grant or Research Contract, using any University Facilities;

- t) "Staff" means any employee of the University who is not a Faculty Personnel or Student;
  - u) "Student" means Graduate Students, Undergraduate Students, and any other person enrolled in or auditing one or more courses, workshops, or seminars at the University;
  - v) "Third Party" means a person who is not the University or a University Person;
  - w) "Undergraduate Student" means any person registered at the University as an undergraduate student, including those on either a full-time or part-time basis;
  - x) "University" means the corporation generally known as the Board of Governors of Lakehead University, organized pursuant to the laws of the Province of Ontario;
  - y) "University Established Faculty" refers to a faculty within the University, and includes the Faculty of Business Administration, Faculty of Education, Faculty of Graduate Studies, Faculty of Engineering, Faculty of Forestry and the Forestry Environment, Faculty of Professional Schools, Faculty of Science and Environmental Studies, Faculty of Social Science and Humanities, and any other faculty created by the University;
  - z) "University Facilities" means any facilities, resources, equipment, or human resources of the University, including any services, assistance, or guidance provided by University Persons; and
  - aa) "University Person" means a Faculty Personnel, Staff, Graduate Student, a member of the Board of Governors of the University, or any other employee of the University or independent contractor engaged by the University and includes post-doctoral fellows.
- 3.2 For greater certainty, and in reference to the terms "Faculty Personnel", "LUFA Personnel", "Staff", "Undergraduate Student", "Graduate Student", "Student", and "Third Party", a person may have more than one status and fall under more than one of the said terms. For example, a Staff who also teaches a course would be a Faculty Personnel for the purposes of activities undertaken while acting as a lecturer, and a Staff for all other purposes. Similarly, an Adjunct Professor who engages in an unrelated private business would likely be a Faculty Personnel for the purpose of

activities undertaken while acting as an Adjunct Professor, and a Third Party for all other purposes.

#### 4. INVENTORSHIP

- **4.1 Inventor vs. Author:** It is important to note that the "inventors" or "creators" of IP are not necessarily the same people who are entitled to be listed as "authors" on a publication. The University discusses authorship in the Research Guidelines, specifically paragraph 3.3 therein. The Research Guidelines do not deal creation or inventorship of IP. Conversely, this Policy does not deal with authorship in any way. Who is and is not an "inventor" or "creator" of IP is determined by the laws applicable to the particular IP in issue.
- **4.2 Inventor vs. Owner:** It is also important to note the difference between an "inventor" and "creator" of IP and the owner of that IP. The fact that one creates IP does not necessarily mean that one owns the IP that was created. Pursuant to Canadian law, the inventor or creator of IP is not necessarily the owner of that IP. Ownership of various forms of IP is addressed in the IP Statutes, and also through the common law. The statutory ownership provisions may also be modified by agreements, including employment contracts, Research Contracts, or even the terms and conditions of Research Grants. It is therefore crucial to refer to the applicable IP Statute, contract, or other terms and conditions when attempting to determine ownership of IP in general. Please do not hesitate to seek the advice of the Manager, Technology Transfer or your lawyer if you are at all in doubt.

For example, pursuant to the Copyright Act, the owner of a literary work that was created by an employee in the course of employment is the employer and NOT the employee in the absence of any agreement to the contrary.

- **4.3 Determining Inventorship:** Generally, the individuals who participated or assisted in the creation or development of IP should determine among themselves which of the participants are "inventors". It is crucial that inventorship be correctly determined at the outset, and in accordance with the relevant Intellectual Property laws, as incorrect

determination could have significant legal consequences in the event that the IP is successfully commercialized. University Persons who have difficulty in determining inventorship may seek assistance from the Innovation Management Office, and may use the dispute resolution process set out below in Article 12. Ultimately, any uncertainties in inventorship should be referred to a patent agent or a lawyer.

## 5. OWNERSHIP (COPYRIGHT)

- 5.1 This Article 5 shall apply to any intellectual property which is or may be protected by Canadian copyright laws (called "Copyright IP"), such as:
  - a) books, articles, and similar printed material;
  - b) course notes, course outlines, examinations, and assignments;
  - c) painting, sculpture, music, and similar works of art;
  - d) lectures delivered;
  - e) audio and video recordings or digitally encoded representations;
  - f) photographs, film, and other similar recordings; and
  - g) computer programs.
- 5.2 Where this Article 5 conflicts with Article 6 of this policy, this Article 5 shall prevail.
- 5.3 The University shall own copyright in any Copyright IP produced by University Persons employed by the University (excluding LUFA Personnel) in the course of employment of that University Person, pursuant to subsection 13(3) of the Copyright Act.
- 5.4 Except as set out in this paragraph and paragraph 5.5 of this Policy, the University shall not claim any interest in Copyright IP produced by LUFA Personnel (See LUFA Collective Agreement s. 38.02.01):
  - a) The University shall own copyright in any written information produced by LUFA Personnel concerning course requirements, assignments, evaluation procedures, components and percentage weighting of the final mark, penalties for late filing of assignments, office hours for academic counselling, and other material provided to the LUFA Personnel's supervisor, and any changes thereto, related to that LUFA Personnel's assigned teaching load. (See LUFA Collective Agreement s. 38.02.02)

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- b) The University shall own copyright in any assessment, grading, report, or correspondence produced in his/her normal administrative duties pursuant to 16.04, which includes such Copyright IP produced in relation to participation on University administrative bodies such as Department and Faculty Councils, University Established Faculty and University committees, and Senate. (See LUFA Collective Agreement s. 38.02.02)
  - c) The University shall own copyright in any Copyright IP assigned to the University by LUFA Personnel.
  - d) Any LUFA Personnel that participated in the production and/or creation of Copyright IP may grant license(s) to the University regarding such Copyright IP, and in that event the University shall have a license to such Copyright IP, on the terms and conditions set out in the said license.
  - e) Upon reasonable request from the University, LUFA Personnel must grant the University an irrevocable, worldwide, royalty free license to use the following Copyright IP owned by that LUFA Personnel (See LUFA Collective Agreement s. 38.02.01):
    - i. any Copyright IP that the LUFA Personnel produced in the course of his/her teaching assignment pursuant to 16.02.01;
    - ii. any intellectual property that the member produced in the course of his/her teaching assignment pursuant to 16.02.12, which includes examination material; and
    - iii. any intellectual property that the member produced in the course of his/her teaching assignment pursuant to 13.03, which includes any Copyright IP that the LUFA Personnel produced that is related to instructional work of a Non-LUFA Contract Lecturer.
  - f) The University shall own copyright in any journal or magazine published by Lakehead University, even in the case when any LUFA Personnel edits the said journal or magazine. This subparagraph does not apply to those articles, reviews, or literary pieces written by LUFA Personnel (See LUFA Collective Agreement s. 38.02.04).



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- g) The University shall have an interest in any Copyright IP produced by LUFA Personnel more particularly described in other approved agreements with LUFA Personnel (i.e. implied limited license to material posted to University website by LUFA Personnel).
    - h) The University shall own an interest in any Copyright IP produced by LUFA Personnel for a Distributed Learning course, in accordance with section 38.02.05 of the LUFA Collective Agreement, and paragraph 5.5 of this Policy.
  - **5.5 Distributed Learning Materials:** In this paragraph 5.5, the term "Course Developer" refers to any person engaged to develop distributed learning material, and includes LUFA Personnel engaged to develop distance education courses, as that term is used in paragraph 38.02.05 of the LUFA Collective Agreement. This paragraph 5.5 applies to any Copyright IP created by a Course Developer for a distance education course ("Distributed Learning IP"). (See LUFA Collective Agreement s. 38.02.05)
    - a) The University and the Course Developer shall enter into a contract ("Distributed Learning Developer Contract") that, among other things, shall cause each to own a 50% interest in Distributed Learning IP.
    - b) Copies of all Distributed Learning IP shall contain a statement or marking identifying the joint ownership of copyright and appropriate credit to the contributors.
    - c) The University shall exercise reasonable care and caution to ensure that no Distributed Learning IP in its possession is erased, copied, amended, or edited in any way without the written consent of all copyright holders, or as otherwise allowed in a Distributed Learning Developer Contract or the LUFA Collective Agreement.
    - d) No one shall loan, transfer or distribute a copy of Distributed Learning IP to a Third Party without the written consent of all copyright holders, except in accordance with this Policy, section 38.02.05 of the LUFA Collective Agreement, or a Distributed Learning Developer Contract, as the case may be.
    - e) At the time Distributed Learning IP is developed, the Course Developer shall warrant to the University in writing that the Course Developer is the sole creator, producer, and original copyright holder of all material contained therein, unless

- written approval had been received by the Course Developer to include materials not created or produced by the Course Developer.
- f) In the event that the University consents to the inclusion in materials developed for a Distributed Learning course of Copyright IP created or developed by someone other than the Course Developer contracted to develop that Distributed Learning course,
- i. the Course Developer shall prior to completion of the development of the Distributed Learning course:
    - 1) provide the University with a written list of any other copyright material contained therein and the names of the relevant copyright holders;
    - 2) indemnify the University against any loss resulting from a failure by the Course Developer to list the registered owner of any such copyright material;
  - ii. The University shall pay any reasonable cost related to securing all copyright permissions and for the use of such approved copyright material.
  - iii. For greater certainty, no such copyright material may be included by the Course Developer without the written approval of the University.
- g) Course Developers who hold any copyright interest in Distributed Learning IP shall grant to the University an exclusive licence to distribute copies of such Distributed Learning IP for use by other educational agencies. The University, in distributing such material to any other educational agency, shall ensure that the other agency shall not loan, transfer, or distribute a copy of such material to any other party without the written consent of the University. Notwithstanding the above, where funding has been provided by contractual agreement with the Province of Ontario or other granting agency for Distributed Learning initiatives, the University may grant to the Province or such granting agency an exclusive royalty-free licence to distribute copies of Distributed Learning material. This exemption applies only to that material for which such a licence is a condition of receipt of funding and, if the Course Developer is LUFA Personnel, only where

- the University has submitted a statement to the Lakehead University Faculty Association from the granting agency that such a condition exists.
- h) Net Proceeds of any fees or royalties that the University receives for the use by a Third Party of Distributed Learning IP developed by LUFA Personnel shall be distributed in proportion to the ownership interest of the University, any LUFA Personnel, and any others having an interest in such Distributed Learning IP. For greater certainty and as an example, in the event that the University and LUFA Personnel each own a 50% interest in Distributed Learning IP, Net Proceeds shall be split with 50% going to the University and 50% to the LUFA Personnel. In the event that any LUFA Personnel has assigned his/her entire interest in Distributed Learning IP to the University, the University shall retain 100% of the Net Proceeds
- i) In this paragraph 5.5, "Net Proceeds" shall mean the fees and royalties received less the cost of reproduction, distribution and production costs (which include charges to produce the materials including licensing costs of other copyright materials contained therein).
- j) Revisions to Distributed Learning IP:
- i. Five years after the creation of Distributed Learning IP, and every three years thereafter, LUFA Personnel owning a copyright interest in the said IP may notify the University of the need to revise such material or have it withdrawn from use by the University. The said LUFA Personnel shall give twelve months' written notice to the University in each instance.
  - ii. The University may request revisions in Distributed Learning IP in order to ensure that proper and current academic standards are met. The Course Developer who holds copyright in such material shall be responsible for its revision pursuant to paragraph 38.02.05.01 of the LUFA Collective Agreement. At the time the development of Distributed Learning IP is assigned, the Course Developer shall agree that for five academic years following completion of its development, he/she shall accept the University's request for revisions or allow the appropriate department or school to make the revisions. The Course Developer shall remain bound

by this agreement regardless of his/her employment status with respect to the University.

- iii. In the event that the University and Course Developer cannot agree on the nature or extent of the revisions:
  - 1) the University may purchase the Course Developer's ownership of the Distributed Learning IP. In this case, the Course Developer shall be paid 50% of the original stipend for development paid to the Course Developer; and
  - 2) if the University still wishes to modify the Distributed Learning IP, the University shall engage the services of someone recommended by the appropriate academic unit to make any revisions to the Distributed Learning IP. In all cases where someone other than the Course Developer who originally produced the Distributed Learning IP makes revisions to the materials, if the Course Developer objects to the extent or the propriety of the revisions, the Course Developer may require that his/her name be withdrawn as a contributor to the work and any visible indications that he/she was a contributor to the work shall be withdrawn.

## 6. OWNERSHIP (NON-COPYRIGHT)

- 6.1 This Article 6 applies to any intellectual property that is not Copyright IP (See Schedule A for more information on different types of IP).
- 6.2 The University makes no claim to any rights to any invention, improvement, design, or development made by University Persons, subject to the following:
  - a) the law of the nation for which the ownership is in issue;
  - b) this Policy;
  - c) any Research Contract;
  - d) the terms and conditions of any Research Grant; and
  - e) any other properly authorized written agreement between any University Person and the University.

- 6.3 Actual legal ownership of intellectual property shall be in accordance with the law of the nation for which the ownership is in issue. For example, the owner of IP for the purposes of Canadian law shall be determined in accordance with the statute and common law of Canada applicable at the time. Ownership of IP for the purposes of the law of another country shall be determined by the law of that nation, applicable at the time.
- 6.4 Subject to any written agreement, initial ownership of IP shall be shared by all University Persons and Third Parties who participated in the creation of the IP (called "Inventors" in this Article). If only one person created the IP, that person shall be the initial sole owner of the IP.
- 6.5 Unless otherwise agreed upon between the Inventors, and provided that no agreement is already in place, if none of the Inventors expresses a position with respect to their share of ownership of the IP, the IP shall be owned equally by all Inventors. Any express written agreement to the contrary, or objection by any Inventor or purported Inventor, shall supersede this default provision.
- 6.6 Where one or more University Persons and/or Third Parties participated or purportedly participated in the creation and/or development of IP, the said individuals should endeavour to agree on the percentage ownership interest each has in the IP. It is recommended that such agreement also include provisions for sharing of any Inventor portion of moneys obtained from the commercialization of the IP. Sample wording which the individuals may wish to use to set out their agreement is included in Schedule B to this policy.
- 6.7 If any party is unsatisfied with a decision reached pursuant to paragraph 6.7 herein, the dispute may, at the option of the parties involved in the dispute, be decided in accordance with the Dispute Resolution Procedure set out below in Article 12.

## 7. GRADUATE STUDENT WORK

- 7.1 This Article 7 sets out specific terms and conditions that apply when a Graduate Student is involved in research or teaching leading to the creation of IP. In situations where this Article 7 conflicts with any term or condition set out in this Policy, this Article 7 shall prevail.

### Copyright of Student Work

- 7.2 When Copyright IP is submitted to meet a requirement of a course, the University acknowledges the Graduate Student's ownership of the copyright, but places the following conditions on the submission of the work to meet course requirements.
  - a) The original physical document becomes the property of the University (i.e. the document itself, but not the intellectual property expressed in the document).  
This applies particularly to examination answer scripts, and may also be applied to term papers and other course work.
  - b) If creative input into student-produced work is provided by the University or University Persons, then the University or the University Persons (as the case may be) may have a claim to partial ownership.
  - c) The Graduate Student shall grant to the University a royalty free, non-exclusive licence to make copies of the work for academic purposes within the University, to circulate the work as part of the University collection, and to use academic tools as to allow Faculty Personnel to assess compliance with University policies and procedures, such as the "Code of Student Behaviour and Disciplinary Procedures".
- 7.3 Graduate Student Theses, Projects, and Portfolios are subject to the following:
  - a) A Graduate Student shall own the copyright in that Graduate Student's finished thesis, project or portfolio.
  - b) Copies of the thesis shall have on them in a prominent place on the title page the international copyright notice.
  - c) The Graduate Student is required to sign licences to the University and the National Library of Canada, granting non-exclusive permission to reproduce the thesis, project or portfolio and to circulate it.
  - d) The University and Graduate Student must recognize that the ideas in the thesis, project or portfolio will often arise from interaction with others. In some cases, this interaction will have been solely with the thesis, project or portfolio supervisor; in other cases, a larger research team will have been involved. For this reason, it is understood that the copyright refers only to the written document of the thesis, project or portfolio. The ideas themselves -- including any advances

in theory, data, patentable ideas, or commercial exploitation of the work -- may or may not be the exclusive property of the Graduate Student. Whether or not they are is discussed above in Article 6: "Ownership (Non-Copyright)".

- e) In cases in which a Graduate Student's thesis, project or portfolio has been supported in part by Research Grants or Research Contracts, there may be other conditions affecting any patent or commercial exploitation. The Graduate Student's thesis, project or portfolio supervisor must ensure that the Graduate Student is made aware of any such conditions before work begins.

### **Ownership of Other Graduate Student IP**

- 7.4 Regarding any IP interests other than copyright interest, a Graduate Student shall not claim ownership of such IP, in whole or in part, in the following circumstances:
  - a) Where any specific written agreement between the Graduate Student and the University (meaning also any designated representative of the University) specifically waives any claim to ownership.
  - b) Where the IP was created or developed pursuant to an agreement between a University Person and a Third Party, and that agreement contains provisions regarding the ownership of IP that conflict with this policy. For greater certainty, and without limiting the generality of the foregoing, where Research is carried out pursuant to a Research Contract, and that Research Contract indicates that a Third Party shall own, in whole or in part, the IP developed pursuant to that Research Contract, the Graduate Student's claim to ownership shall be subject to that Research Contract. The Graduate Student's supervisor must ensure that the Graduate Student is made aware of any such conditions before work begins.
  - c) Any IP resulting from unauthorized use of University facilities.
- 7.5 Upon receipt of an Invention Disclosure Form from a Graduate Student, and in addition to any responsibilities indicated elsewhere in this policy, the Innovation Management Office shall ensure that the Dean of Graduate Studies and the Graduate Student's supervisor are aware of the IDF, subject to requirements that information contained in the IDF may be confidential.
- 7.6 In addition to any other reporting obligations of a Graduate Student, a Graduate Student shall give notice to the Dean of Graduate Studies and the Graduate Student's

faculty supervisor of any IP or any information that may be commercially valuable IP or give rise to commercially valuable IP.

## 8. DISCLOSURE OF IP

- 8.1 A University Person shall give notice to the University through the Innovation Management Office in writing of any application to protect IP (including without limitation an application for patent, copyright, trademark, or integrated circuit topography registration) made by the University Person or involving the University Person within three months of the date of the application. The notice shall be in the form attached hereto as the "Invention Disclosure Form" ("IDF"), and shall include all the information set out on that Form. (See LUFA Collective Agreement s. 38.01.03)
- 8.2 A University Person (except LUFA Personnel) shall give timely notice to University through the Innovation Management Office of any IP or any information that may be commercially valuable IP or give rise to commercially valuable IP, using the IDF.
- 8.3 LUFA Personnel are encouraged, but not required, to give timely notice to University through the Innovation Management Office of any IP or any information that may be commercially valuable IP or give rise to commercially valuable IP, using the IDF.
- 8.4 The Innovation Management Office shall ensure that any co-inventors identified in an IDF are aware of the IDF, subject to requirements that information contained in the IDF may be confidential.
- 8.5 The Innovation Management Office shall evaluate the IDF and respond to the University Person within a reasonable time, in accordance with University approved policies governing the operation of the Innovation Management Office.
- 8.6 Any person who receives an Invention Disclosure Form shall keep the IDF and any information included therein confidential and not disclose it to any other person unless:
  - a) authorized to disclose to that person by express authorization from the Inventor(s), purported Inventor(s), or arising from a written agreement; or
  - b) that other person is under a duty to keep the information confidential.



## 9. PUBLIC DISCLOSURE

- 9.1 This policy shall in no way hinder or restrict a University Person's right to publish the results of the University Person's research, if such right exists from a source other than this policy. Specifically, and without limiting the generality of the foregoing, LUFA Personnel have the unqualified right to publish the results of his/her research, unless such LUFA Personnel has agreed to limit such right in some other agreement.
- 9.2 Any University Person (except LUFA Personnel) who is considering publishing IP shall undertake the necessary due diligence to delay release of IP which may be the subject of joint ownership in whole or in part with another University Person. Such delay shall be for the purposes of allowing the owners of the IP, including any owners who are University Persons, to determine whether or not the IP should be protected using appropriate mechanisms such as patent applications, prior to publishing. Such delay shall be for such time as is necessary to allow that determination to be made, but in no event shall the delay be longer than sixty (60) days unless otherwise agreed to in writing between the University Person wishing to publish and other joint owners.
- 9.3 Any LUFA Personnel who is considering publishing IP is encouraged, but not required, to undertake the necessary due diligence to delay release of IP which may be the subject of joint ownership in whole or in part with another University Person. Such delay shall be for the purposes of allowing the owners of the IP, including any owners who are University Persons, to determine whether or not the IP should be protected using appropriate mechanisms such as patent applications, prior to publishing. Such delay is encouraged to be for such time as is necessary to allow that determination to be made, but in no event shall the delay be longer than sixty (60) days unless otherwise agreed to in writing between the University Person wishing to publish and other joint owners.

## 10. DECISION TO COMMERCIALIZE

- 10.1 The owners of IP shall determine whether or not IP will be protected, assigned, licensed, or otherwise commercialized. Any disputes may be resolved using the Dispute Resolution Process set out in Article 12 herein.

- 10.2 The name of the University, any trademarks, trade names, or goodwill of the University, and the University letterhead shall not be used in connection with any invention, improvement, design or development in which the University has no interest unless agreed to in advance in writing by the University, although nothing shall prevent a University Person from stating the nature and place of employment, rank, and title in connection with activities associated with the invention, improvement, design or development, provided that the University Person shall not purport to represent the University or to speak for it, or to have its approval, unless such approval has been given in advance in writing from the University. (See LUFA Collective Agreement s. 38.01.07)
- 10.3 Involvement of the University in the IP commercialization process shall be in accordance with applicable University policies governing the operation of the Innovation Management Office.

## **11. PROFIT SHARING BETWEEN UNIVERSITY AND OTHER OWNERS/INVENTORS**

- 11.1 Where IP was invented, created or developed in whole or in part by a University Person (except LUFA Personnel) with:
  - a) Ordinary Support of the University, the University shall receive 25% of that University Person's share of the Net Proceeds; and
  - b) Extraordinary Support of the University, the University shall receive 50% of that University Person's share of the Net Proceeds.
- 11.2 Where IP that is a protected invention, improvement, design, or development was invented, created or developed in whole or in part by a LUFA Personnel, with:
  - a) Ordinary Support of the University, the University shall receive 25% of that LUFA Personnel's share of the Net Proceeds; and
  - b) Extraordinary Support of the University, the University shall receive 50% of that LUFA Personnel's share of the Net Proceeds.
- 11.3 For greater certainty, the University shall not be entitled to any percentage of a LUFA Personnel's share of Net Proceeds from IP that is not a protected invention,

improvement, design, or development, except as specifically set out in the LUFA Collective Agreement.

- 11.4 In the event that the University agrees to be the commercialization agent for IP, the University may receive an additional portion of the Net Proceeds as negotiated with the inventors and mutually agreed upon amongst the inventors and the University.
- 11.5 Any revenue that the University receives pursuant to paragraph 11.1 herein shall be used at the University's discretion (subject to the requirement in paragraph 38.01.08 of the LUFA Collective Agreement that certain revenue be dedicated to research), except that in each case 25% of such income shall be allocated between the Departments or the Schools with which owners of IP who are University Persons are affiliated, prorated in accordance with the percentage interests of the said University Persons, as determined in accordance with this Policy or as otherwise agreed. (See LUFA Collective Agreement s. 38.01.08)
- 11.6 In addition to any other provision of this Policy, where IP has been created, invented or developed with the Ordinary Support or Extraordinary Support of the University:
  - a) the owners of the IP who are not LUFA Personnel shall grant to the University a nonexclusive, royalty-free, irrevocable, indivisible, and non-transferable right to use the IP solely within the University. Such right shall not by virtue of this paragraph 11.6 include the right to exploit the IP in any way; and
  - b) the owners of the IP who are LUFA Personnel shall grant to the University a nonexclusive, royalty-free, irrevocable, indivisible, and non-transferable right to use such IP that is an invention, improvement, design or development solely within the University. Such right shall not by virtue of this paragraph 11.6 include the right to exploit the invention, improvement, design or development in any way. (See LUFA Collective Agreement s. 38.01.04)

## 12. OPTIONAL DISPUTE RESOLUTION

Sometimes disputes arise between inventors and alleged inventors, owners and alleged owners of intellectual property, members of research teams and the University. Often, parties to such a dispute lack financial resources, time, resources or incentive to resolve the dispute,

and instead merely walk away from it or ignore it. As a service to the University community, and to encourage fast and inexpensive access to assistance in resolving disputes involving intellectual property, the following OPTIONAL dispute resolution process is provided by the University. This process in no way removes a party's right to seek other legal remedies, but is instead offered as an option to help encourage and facilitate dispute resolution.

- 12.1 Any allegation, dispute, disagreement, or conflict between University Persons and another University Persons or the University regarding anything set out in this Policy or the ownership, inventorship, or sharing of proceeds of commercialization of intellectual property (collectively referred to as the "Dispute"), may be addressed and resolved pursuant to this Article, at the option of the University Persons and the University.
- 12.2 The University Persons shall initially attempt to resolve the Dispute themselves.
- 12.3 Any University Person involved with the Dispute may consult with their immediate supervisor, it being understood that this consultation will remain confidential. The immediate supervisor shall maintain confidentiality in dealing with the Dispute so as to protect the reputation and careers of all involved, as well as the reputation of the University. If the allegations are against a University Person's immediate supervisor, the party or parties may consult with the supervisor of their immediate supervisor. In these instances, the consulted individual shall follow the same process as outlined herein for the University Person's immediate supervisor.
- 12.4 If the University Persons are unable to resolve the Dispute themselves, a written appeal (the "Notice of Appeal") may be made to the Vice President Research and must contain:
  - a) the nature of the Dispute;
  - b) reasons for making the appeal;
  - c) the names of all parties involved; and
  - d) the form of retribution, compensation, action or other relief sought.
- 12.5 Upon receipt of a Notice of Appeal, the Vice-President Research shall promptly establish an IP Committee, consisting of three (3) individuals suitable to the parties to the dispute, which individuals may but need not be drawn from the following:
  - a) Vice President Research;

- b) Dean of the University Person's University Established Faculty (if the University Persons is a Faculty Personnel), Dean of Graduate Studies (if the University Persons is a Graduate Student), or Vice President Administration and Finance;
  - c) Union representatives;
  - d) Faculty Personnel knowledgeable in commercialization activities; and
  - e) Manager, Technology Transfer.
- 12.6 The IP Committee shall, as promptly and prudently as possible (which should if reasonably possible not be more than twenty (20) working days) determine whether or not the Dispute has merit.
  - a) If through this consultation it is determined that the Dispute has no merit, all practical steps should immediately be taken by the IP Committee to redress any harm that may have been done by the Dispute.
  - b) If through this consultation the IP Committee determines that the Dispute may or does have merit, the IP Committee shall attempt to resolve the Dispute. If the IP Committee is unable to resolve the Dispute to the satisfaction of all parties within forty (40) working days after receipt thereof, the IP Committee shall notify the parties in writing, after which the parties may choose to seek other legal remedies such as arbitration or other litigation.
- 12.7 It is the responsibility of the Vice-President Research to take whatever actions may be necessary to protect the party or parties making the Dispute from possible acts of coercion or retribution by the other individual(s) involved. This is especially important if any person involved in the Dispute is a Graduate Student supervised by another individual alleged to be involved in the Dispute, or is a research employee whose employment in the University is directly dependent upon grant or contract funds for which the individual alleged to be involved in the Dispute is the signing authority.
- 12.8 In all proceedings and subsequent to a final decision, the University will undertake to assure that those making an allegation in good faith and without demonstrably malicious intent will be protected from reprisals or harassment.

### 13. GENERAL PROVISIONS

- 13.1 Legal Counsel: University Persons are advised to seek independent legal counsel, including those practised in protection of intellectual property, at any time. Costs for this are borne wholly by the University Persons, unless an express written agreement with the University states otherwise.

#### REFERENCES:

Patent Act, R.S.C. 1985, c. P-4, as amended from time to time.

Copyright Act, R.S.C. 1985, c. C-42, as amended from time to time.

Ramsay, John T., Technology Transfers and Licensing, (Toronto: Butterworths, 1996)

Sarna, Lazar, Guide to Commercializing R&D (Montreal: Jewel Publications Ltd., 2000)

Various intellectual property guides from the Canadian Intellectual Property Office.

AUTM Technology Transfer Practice Manual

Policies of the following Institutions:

McMaster University

University of Guelph

Mount Sinai Hospital and the Samuel Lunenfeld Research Institute

University of Western Ontario

University of Waterloo

University of Toronto

Ohio State University

Ryerson University

Careton University

Wilfrid Laurier University

#### SCHEDULE A

Abridged Intellectual Property Primer

NOTE: The text of this Schedule is an excerpt from the "Intellectual Property Primer", published by the Innovation Management Office, available online at [innovations.lakeheadu.ca](http://innovations.lakeheadu.ca). For more details, please see the website.

## Types, Protection, and Transfer of IP

Forms of IP: Generally, Intellectual Property consists of the expression of ideas, and can exist in many forms, including without limitation artistic works, literary works, inventions, discoveries, processes, knowledge, data sets, data bases, audio visual and computer material or equivalent circuitry, biotechnology and genetic engineering products (including plant cultivars and germ plasma), computer software, circuit board schematics, and any other item, knowledge, thought, or product of research.

Protection of IP: Intellectual Property can be protected in several different ways, depending upon the type or form in which the IP exists. For example, a traditional invention may be protected by a patent application; an artistic work by a copyright registration, trademark, or industrial design registration; an idea for a new circuit by integrated circuit topography legislation, and plant varieties by the plant breeder's legislation. To illustrate the difference between Intellectual Property and the protection thereof, consider that a "patent" is not Intellectual Property, it is merely the means used to protect certain Intellectual Property. The following methods can be used, when appropriate, to protect IP, each of which is discussed in more detail in the "Intellectual Property Primer", a copy of which is attached hereto as Schedule A: patents, copyright, trademark registration, integrated circuit topography registration, industrial design registration, plant breeder's registration, trade secret agreements, and other methods.

An example of the use of different forms of IP protection can assist the reader in understanding the differences between them. Consider a bottle of Coca-cola® pop. The written material on the label is protected by copyright, the shape of the bottle by industrial design, the name by a trademark, and the method of capping the bottle by a patent. The recipe for the beverage would most likely be a trade secret.

Transfer of IP: The owner of IP may grant rights in the IP to others, either through a transfer of part or all of their ownership interest in the IP (called an "assignment"), or by giving permission

to others to use or otherwise deal with the IP (called a "license"). Assignments and Licenses may be granted in consideration for some sort of return from the person receiving the rights, including money, shares in a corporation, or some other form of payment.

For further information contact the Manager, Technology Transfer, or a lawyer or patent agent.

## SCHEDULE B

### Sample IP Ownership Sharing Wording

The following wording may be used by Inventors to set and clarify their respective interests in Intellectual Property:

"Ownership of any Intellectual Property developed pursuant to the Research Project or related thereto shall be divided between the Researchers, in accordance with the following shares:

Replace the following with the names of each inventor and his or her respective percentage share of ownership and/or profits:

1. Student 1 - X%;
2. Student 2 - Y%; and
3. Faculty Personnel - Z%,

provided that if any other persons have a legal right to claim ownership in any Intellectual Property, the above named individuals will enter into negotiations regarding the above noted percentages. The above named individuals further agree that any profits they are collectively entitled to arising from the Intellectual Property shall be divided amongst themselves in accordance with the above noted shares."



**Review Period:** 7 years;

**Date for Next Review:** 2020-2021;

**Related Policies and Procedures:** To be determined;

**Policy Superseded by this Policy:** None.

The University Secretariat manages the development of policies through an impartial, fair governance process, and in accordance with the Policy Governance Framework. Please contact the University Secretariat for additional information on University policies and procedures and/or if you require this information in another format:

Open: Monday through Friday from 8:30am to 4:30pm;

Location: University Centre, Thunder Bay Campus, Room UC2002;

Phone: 807-346-7929 or Email: [univsec@lakeheadu.ca](mailto:univsec@lakeheadu.ca).