

Student and Post-Doctoral Fellow Intellectual Property Guidelines

Preamble:

This draft was prepared by Acadia University's Office of Industry and Community Engagement (ICE) after studying the Intellectual Property Policies of the following Canadian Universities: University of British Columbia, University of Alberta, University of Calgary, McMaster University, Parteq of Queen's University, University of Toronto, Brock, York University, the University of PEI and the collective bargaining agreement of the Acadia University Faculty Association.

Members of Springboard, a network of Atlantic Canadian technology transfer professionals, were consulted in the preparation of this document. Input from Acadia student representatives was incorporated into the guidelines. Discussions of the guidelines with the Dean's Council at Acadia University provided general approval following incorporation of feedback from the Acadia Students Union and with the Acadia Graduate Students Association.

Introduction:

These guidelines have been developed to ensure that all students and post-doctoral fellows at Acadia are treated fairly and equally with respect to Intellectual Property (IP) ownership. The identification of the creators and owners of Intellectual Property is often a complex and difficult process. Acadia strongly recommends that consideration be given to IP ownership before work begins on any project. These guidelines should be useful to clarify ownership. Also, one of the purposes of the Office of Industry and Community Engagement (ICE) is to help students, staff and faculty to define IP ownership.

There are two ways that students may create Intellectual Property at Acadia:

1. while involved in a research project, either as a thesis project or as an employee during the summer or part-time during the school year
2. in carrying out their curriculum studies or course work

Post-doctoral fellows would primarily generate IP in the course of research projects.

Clear and fair identification of the owners of Intellectual Property allows all the benefits of research to be shared by the inventors as well as society as a whole. Acadia's objectives in supporting research include:

- generating new knowledge
- enhancing the student's learning experience
- attracting and retaining excellent faculty
- providing a return to the community and public for their investment in research

There are federal laws that cover patent ownership and copyrights. It is Acadia's intention that all student's and post-doctoral fellow's Intellectual Property rights comply with Canadian IP laws and are aligned with the rights of the Faculty and the staff.

The IP rights and obligations of the faculty at Acadia are covered, at the time of the drafting of these guidelines, by the 11th Collective Agreement of the Acadia University Faculty Association. Ownership of Intellectual Property generated by Acadia staff in the course of their normal employment duties is determined by Canadian common law. Prevailing law suggests that an employee's Intellectual Property is owned by his or her employer, unless other specific arrangements have been made. Students and fellows should be aware that they are encouraged to seek independent legal advice at any time, at their own expense, if they have any concerns about their Intellectual Property rights.

Definitions of Types of Intellectual Property:

The most common types of Intellectual Property that will be generated by students or post-doctoral fellows at Acadia are copyrighted materials and patents.

Copyright is the exclusive right of the author or creator to reproduce a work. As soon as any artistic, literary or musical work, or software is created, its author holds the copyright. Registration at the Copyright Office is purely voluntary, but may be useful for proving when a work was created or by whom. Copyright on a work can be assigned or licensed to another party by the creator.

A **Patent** is a right granted by a national government, upon application, and in exchange for a complete disclosure of an invention. A patent gives the patent holder the right to prevent others from selling his or her invention. By law, in order to be patentable, an invention must be novel, it must not be obvious to a person skilled in the field of the invention, and it must have utility (i.e. do something useful). Products, processes, machines, manufactures or composition of matter, or any new and useful improvement of any of these, such as new uses of known compounds, are patentable subject matter.

Other types of Intellectual Property include **know-how**, **trade secrets**, and **trademarks**. Acadia holds a number of trademarks on its names, programs and services. Acadia's trademarks cannot be used without permission from the administration.

Consideration should be made of the following, which are not directly related to IP but often confuse IP issues:

- **Confidential information** - In order to obtain a patent on an invention, it is necessary to keep the invention confidential until a patent application is filed. In many cases, the benefits to society can only be realized if an invention is patented, because the commercial development required for widespread

distribution of the invention will only occur if it is protected by a patent. Therefore, students and post-doctoral fellows should be sensitive to maintaining confidentiality about a research project, even if he or she does not personally own any IP in it. Another reason that students or post-doctoral fellows may need to maintain confidentiality about a research program is that an agreement to maintain confidentiality about that research project has been signed by Acadia. Any questions of dissemination should be discussed with the faculty member responsible for the project or with ICE. If a student is working on a project where confidential information is involved, it is the Office of Research and Graduate Studies responsibility to work with the student and ensure that the student's thesis can be defended and disseminated without breach of confidentiality. For the most part, this should be possible to achieve through discussions with the research sponsor, planned well in advance of the thesis defense.

- **Data** - the ownership of data collected during a research study should be considered separately from the IP. Data is not necessarily IP on its own. Generally, IP is created from studying the data and drawing conclusions from it. Data is generally jointly owned by the student, supervisor and the Institution. Joint owners of data each have the right use the data, but not to do anything with the data without the consent of their co-owners. Joint owners of data should make efforts to keep each other informed of up-to-date contact information, to facilitate joint decisions on the use of the data.
- **Inventors versus Stakeholders or Owners of IP** - Inventors of IP are those who participated in the intellectual process that led to the creation of the IP. Stakeholders or owners are those who claim an interest in the IP because they made some other kind of contribution, such as providing the funding for the research that led to the creation of the IP. Inventors may or may not be owners of the IP.

How to Determine who Owns Intellectual Property:

i) *Written works, including course assignments, theses, research papers, musical compositions and other material prepared to comply with curriculum requirements.*

Generally, these works are protected by copyright, which is owned by the author(s). Acadia retains ownership of the one copy of an assignment handed in to comply with course requirements, but the copyright remains with the author. Authors may find that they are requested to assign the copyright of a research paper to a publisher as a condition of publication. If this is the case, permission to reproduce the work in a thesis should be obtained from the publisher.

ii) *Research projects, including honours projects and Masters projects as well as research projects involving software development and other research programs.*

It is strongly recommended that all the students familiarize themselves with these guidelines and that they discuss them with their supervisor and/or a representative of ICE prior to beginning a research project of any sort. Discussion and investigation are frequently necessary to clearly identify the inventors of IP.

The most important questions to consider regarding the IP rights from research projects are discussed below.

- **Is the student enrolled in a scholastic program at Acadia or is he or she working as an employee of a faculty member or Acadia?**

If the student is enrolled in a degree program at Acadia, then he or she will own the Intellectual Property that he or she generates in the course of his or her studies, subject to the terms outlined below.

If the student is employed, then the Intellectual Property that he or she creates would generally belong to his or her employer. The employer might be Acadia, or it might be a faculty member at Acadia.

Students who are pursuing honours degrees would normally be considered to be employees if they are working and being paid to do research during a term when they were not enrolled in courses.

It is often the case that a simple distinction between being a student and an employee is impossible. If it is not clear if the student is employed or pursuing a course of study, clarification should be sought from the ICE and Dean of Research and Graduate Studies.

- **Is the post-doctoral fellow an employee or an academic trainee?**

The distinction should be made between research associates and post-doctoral fellows. Both may have a doctoral degree, neither is a faculty member. Fellows are those considered in training for a career as an academic and are generally paid through a scholarship or fellowship, while research associates are considered employees of Acadia. Acadia generally owns the IP generated by its employees. A fellow who is undertaking academic training owns the IP that he or she generates in the course of his or her studies, subject to the terms outlined below.

- **What is the source of funding for the student's or fellow's scholarship and the research project?**

Providers of scholarships and research grants sometimes place requirements on the Intellectual Property generated with the funds. Always consult the Intellectual Property policies of the source of funding before making a final

decision on the ownership of IP. Most not-for-profit granting agencies specify use of the institution's IP policies; however, there are expectations.

If a student or fellow is working on an industry sponsored research contract, there is a good chance that IP rights may be claimed by the funding partner.

Funds granted for 'Proof of Concept' or 'Intellectual Property Protection' programs may request assignment of the IP to the ICE.

Check to ensure which specific circumstances apply in each case.

Students and post doctoral fellows who are doing research may be supported by one or more sources of funds: the student's or fellow's scholarship or fellowship which provides them with personal support during their enrollment in full time studies and research grants that defray the costs of laboratory or other equipment and supplies with which research is performed. In cases where there is more than one supporter of research, there may be more than one co-owner of the IP.

Ensure all sources of funding are considered before deciding ownership of IP.

- **Where did the original ideas come from for the IP?**

The right of inventorship is related to the contribution to the intellectual creation of the invention. Although someone could put plenty of time and effort into developing an invention, if he or she was following the direction of another person, it is unlikely he or she is an inventor. (This is a different situation from authorship of research papers, where time and effort are more likely to be acknowledged with authorship.)

- **Who else worked on the project to generate the IP?**

It is unlikely that most students or fellows will be the sole inventor on a patent. Generally his or her supervisor will be a co-inventor, and there may be other students or post-doctoral fellows who contributed to the project that are co-inventors.

- **What facilities did the student or fellow use in generating the IP?**

Even if a student or post-doctoral fellow worked on his or her own ideas and time, if the facilities, (rooms, buildings, laboratories) or supplies used (equipment, reagents, supplies etc.) belong to Acadia or were purchased through a research grant to a faculty member at Acadia, then it may be appropriate to include Acadia or the faculty member as part owner of the IP. The degree of ownership should be determined by discussion with the faculty member, ICE or Dean of Research and Graduate Studies.

If clarification of IP rights is needed, discussion should begin between the student or fellow and his or her supervisor. If resolution is not achieved in this way, then the Director of ICE should be consulted. The Dean of Research and Graduate Studies will have the ultimate authority to resolve disputes.

Commercialization of IP

The owner(s) of any Intellectual Property generated at Acadia are free to decide the commercialization route of their IP. It is easier to develop IP if all of the owners of the IP give their decision making rights to a single party. Acadia's Office of Technology Transfer and Innovation was established to provide IP commercialization services, should the owners wish to assign their IP to Acadia for development.

Regardless of the route of IP development jointly chosen by the inventors and owners, the following should be observed:

1. All inventions should be disclosed to the Office of Technology Transfer and Innovation before any form of public presentation about the invention. This will entail completing an Invention Disclosure form. The information contained in this form remains confidential.
2. The identity and contribution of all co-inventors and funding sources that participated in the creation of the IP must be determined. Completion of item #1 above will facilitate this process.
3. The inventors and other stakeholders in the IP may decide how the IP will be commercialized. This includes deciding not to commercialize but to put the IP in the public domain by publication or other means.
4. If the inventors and other stakeholders choose to commercialize the IP themselves, the first \$10,000 in revenues are due to the inventors. After that, 25% of the revenues are due to Acadia, in return for provision of the facilities and other resources that supported the creation of the IP. The remaining 75% is due to the inventors.
5. The inventors and stakeholders may decide to assign the Intellectual Property to Acadia for commercialization. In this case, after the first \$10,000, which flows to the inventors, the inventors will share 50% of the net income generated by the sale of the invention. The remaining 50% flows to Acadia. If the inventors choose to have Acadia commercialize, a period of 90 days of non-disclosure of the invention will be required.
6. Regardless of the route of commercialization the inventors choose for the invention, the inventors will assign Acadia a royalty free, non-exclusive license to

the invention for use in internal academic, teaching, research and service purposes.

Student IP Ownership checklist (Answer the questions below, then go through the guidelines to determine IP ownership.)

1. Is the student's project for _____honours thesis
_____Master's thesis
_____other project

2. Is the student being paid to do the project _____yes
_____no

3. If the student is being paid a salary or scholarship what is the source?

4. What is the source of funds that support the project costs (other than salary of student)?

5. Do any of the funding sources require IP rights in exchange for program support?

5. Who is providing the intellectual creativity to the project?

6. Other than the student and faculty member, who else is contributing to the project, and how?

7. Can the inventors and owners of the IP that is likely to be generated from the project be identified? Is so, list them.

8. Has consideration been given to an assignment of IP ownership in return for future royalty consideration? _____yes
_____no
_____need more information

If you need assistance, contact the Office of Industry and Community Engagement, at 585-1425 or send an email to leigh.huestis@acadiu.ca