

## Nipissing University Policy on Intellectual Property

<b>Office of Accountability:</b>	Vice-President, Academic and Research
<b>Office of Administrative Responsibility:</b>	Office of Research Services – Associate Vice-President, Academic and Research
<b>Approver:</b>	Senate
<b>Scope:</b>	Compliance with University policy extends to all members of the University community that generate Intellectual Property
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### Introduction

The fundamental mission of the University is to increase and communicate knowledge. These endeavours commonly result in the creation of Intellectual Property, which may benefit society. The rights to Intellectual Property normally reside with the creator of the Intellectual Property when the creators are academic personnel. Intellectual Property created by non-academic personnel normally resides with the University because it is typically created as a result of the individual's employment with the University, or was commissioned by the University. The primary mission of a publically funded institution is to create and disseminate public knowledge. The goal of this policy is to encourage the creation of intellectual property, and to facilitate the development and commercialization of intellectual property, while safeguarding the academic freedom and interest of the University, its faculty, staff and students.

## Definition of Intellectual Property

Intellectual property (IP) has the unique characteristic of being of the mind, with no physical existence; hence, *intellectual property*. Intellectual property is any form of original knowledge or expression created in part or whole with one's intellect and may include but is not limited to: technical information, know-how, copyrights, models, patterns, drawings, specifications, prototypes, inventions, and so forth.

What matters to the law are legal rights and on that score, IP ownership or monopoly rights are recognized in law in an original expression of an idea or concept, be it an invention (patent), a web page (copyright) or device (industrial design). The three traditional intellectual property rights are patents, copyrights and trademarks. They are all creations of statute, where, to encourage creativity and scientific spirit, the government recognizes and will enforce the public expression of an original idea for a limited period of time. Designs for product appearance and computer chips (integrated circuit topographies) have been added to this traditional list. The common law has contributed in a unique form: trade secrets, which have no statutory parent but which, through contractual and tort remedies, can protect intellectual property.

Although the theory behind IP is that the inventor owns the monopoly, IP created pursuant to employment is presumed to belong to the employer subject to an agreement, common law, custom or practice to the contrary.

In addition, moral rights are the author's right to integrity of the creation in its original form, to attribution, and to prevention of unfavorable associations with the author's creation.

## Applicability

This policy applies to all university personnel and students who create or develop intellectual property. This policy governs all external contractors (with the necessary changes) if the terms of their contracts with the University do not specify intellectual property ownership.

This policy does not apply to intellectual property created by independent effort in the course of demonstrably private research or private consulting to external organizations/businesses, provided that these activities do not involve use of University infrastructure or support, and where these activities have been approved by the University.

Nothing in this policy will override any rights or responsibilities accorded university personnel in any collective agreements to which they are obligated.

## **Definitions**

Appendix A contains the definitions of terms used in this policy.

## **1. Ownership of Intellectual Property**

### **i. Ownership**

Academic personnel/students own the intellectual property that they create in the course of their teaching, research and academic work, except as otherwise specifically provided herein.

Exceptions to the above are listed below:

- a.** The University will negotiate a contract that specifies the terms of ownership of intellectual property resulting from initiatives that are specifically commissioned by the University that is outside the scope of the assigned duties of the academic member.
- b.** Ownership of Intellectual Property in externally sponsored research or in contracted research activities may be determined in whole or in part by the regulations of the sponsor or the terms of the contract. University personnel must be aware of any such regulations or contract terms by the principle investigator (i.e. leader of the research project) before participating in these research activities.
- c.** When an academic member/student dies, the estate will retain all rights, responsibilities and obligations under this policy, unless the estate transfers the rights, responsibilities and obligations in writing to the University or to another party.

The University owns intellectual Property that is created by non-academic personnel in the course of their employment.

### **ii. License**

An academic member/student who creates Intellectual Property in the course of normal duties and responsibilities will grant the University a non-exclusive, perpetual, royalty-free, and non-

transferrable license to use the work for non-commercial educational and research purposes. This license does not include copyrightable material intended for use solely by students registered in the course taught by the member.

### **iii. Responsibilities**

Individual researchers have an obligation to ensure that their work is published or publicly disseminated. All contributors to a work share this responsibility. All creators must examine and accept responsibility for the contents and research results reported in a scholarly work. All members of the research team must ensure that appropriate credit is given for the contributions of all individuals that contributed to the work.

### **iv. Recognition**

Those individuals who have made a significant intellectual or scholarly contribution to the work being reported, and without whose contribution the work would not be complete must receive appropriate recognition for their contributions. The listing of contributors should be consistent with the traditions of the specific discipline. Decisions concerning publication require unanimous agreement of all contributors. Recognition may include recognition as a creator, recognition through citation or through an acknowledgement.

### **v. Acknowledgement of the University**

University personnel shall acknowledge Nipissing University for the support provided by the University when reporting their scholarly work. Creators of intellectual property will recognize the university's support through a financial contribution as identified in this document.

### **vi. Use of the University's Name, Trademarks, Service Marks and Logos**

To protect the reputation of the University, it must control the use of its name, trademarks, service marks and logos. This is particularly true for non-university sponsored commercialization of Intellectual Property. Under no circumstances may the University be presented, directly or indirectly, as endorsing or warranting a particular

product. The use of the University's name, trademark, service marks and/or logo may not be used in commercial advertising, product or product promotions, service, research project or work (apart from indication of the institutional affiliation of the creator(s)) without the prior approval of the Vice-President, Academic and Research.

Additional information on the use of the University's marks is contained in the Visual Standards Guidelines on the University's website.

**vii. Third-Party Rights**

University personnel and students are expected to respect third-party Intellectual Property rights. This obligation precludes for example but is not limited to the infringing use, reproduction, modification, translation or adaptation of software or photocopied textbooks unless the permission has been obtained from the copyright holder.

**viii. Collaborative Research**

Collaborative research for the advancement and creation of knowledge is encouraged and supported by the University. The process by which the rights of Intellectual Property that arise from the collaboration will be determined prior to the commencement of the collaboration and must be specified in a written Collaboration Agreement. This is particularly critical in collaborations that involve academic personnel, students and outside agencies/companies. The rights of ownership shall be based on the extent and nature of the contribution and not on differences in power or rank. It is imperative that rights of students involved in research projects, including recognition and grades, be protected. If University resources (physical, financial or human) are used the University must also be party to the Collaboration Agreement. Any modification or waiver of rights in the Collaboration Agreement requires informed consent.

**2. Copyright and Patents**

**i. Copyright**

Policy 1 (i) states the general principles governing copyright in works created by University personnel.

In addition to the provision contained in Policy 1 (i) the University recognizes copyright ownership of scholarly works created by academic personnel/students in the course of teaching, research and assigned duties provided the creator(s) grant the University a perpetual, non-exclusive, royalty-free, irrevocable license to copy, and use such works (including distance and continuing education), research, and academic not-for-profit activities within the University. The exception to this is where copyright ownership rests with the publisher and not the creator.

After seven years the creator(s) may discontinue the University's license to the works if the content of the works is becoming out-of-date or in the judgment of the creator(s) the University using the material inappropriately. The creator(s) must provide evidence to the Vice-President, Academic and Research to support the reason for the discontinuance. If the request for discontinuance is denied the creator(s) have the right to appeal the decision under the provisions of Article 8 of this policy.

Creator(s) have the right to request exemption to some or all of the above under special circumstances. These requests must be made in writing to the Vice-President, Academic and Research providing details of the special circumstances necessitating the exemption. If this request for exemption is denied the creator(s) have the right to appeal the decision under the provisions of Article 8 of this policy.

## **ii. Patents**

Policy 1 (i) states the general principles governing patents in works created by University personnel.

In addition the ownership by university personnel/students of Patent rights in Inventions is subject to the following conditions.

- a. The creator(s) grant the University a perpetual, non-exclusive, royalty-free, irrevocable license to copy, use and modify such works (including distance and continuing education), research, and academic activities within the University.
- b. The creator(s) will give notification in writing to the Vice-President, Academic and Research of any patent application

in Canada or other countries at least 1 month prior to the to the date of making the patent application.

### **3. Teaching Materials, Computer Software, and Databases**

#### **i. Teaching Materials**

The ownership of teaching materials is more difficult to define particularly when the course content and materials used are derived from the academic staff member's research and is therefore owned by the academic staff member. That being said, non-academic members from the Centre for Flexible Learning (CFL) and other areas may contribute significantly to the presentation of the material and in that context said material is owned by the University.

The grant of ownership of copyright of teaching materials to academic personnel/students who create this material is limited when non-academic staff assistance has substantially transformed the work and as such the creation/copyright is shared equally by the academic staff member and the University. It is the responsibility of the Director of the CFL to inform the academic staff member in writing that collaboration is about to substantially transform the work and obtain written agreement to proceed further. Article 6 of this policy will govern any commercial benefits derived from such teaching materials.

In addition the creator(s) grant the University a perpetual, non-exclusive, royalty-free, irrevocable license to copy, use and make minor modifications to such teaching materials in teaching (including distance and continuing education), research, and academic activities within the University.

After seven years the creator(s) may discontinue the University's license in the works if the content of the teaching materials is becoming out-of-date or if in the judgment of the creator(s) the University is using the teaching material inappropriately. The creator(s) must provide evidence to the Vice-President, Academic and Research to support the reason for the discontinuance. If the

request for discontinuance is denied the creator(s) have the right to appeal the decision under the provisions of Article 8 of this policy.

Creator(s) have the right to request exemption to some or all of the above under special circumstances. These requests must be made in writing to the Vice-President, Academic and Research providing details of the special circumstances necessitating the exemption. If this request for exemption is denied the creator(s) have the right to appeal the decision under the provisions of Article 8 of this policy.

## **ii. Computer Software**

The ownership of computer software and applications for the internet (social networking sites) is more difficult to define particularly when the computer software is derived from the academic staff member's research and is therefore owned by the academic staff member. That being said, non-academic members from the Centre for Flexible Learning and other areas, may contribute significantly to the presentation of the material and in that context said material is owned by the University.

The grant of ownership of copyright of computer software and applications for the internet (social networking sites) to academic personnel/students who create this material is limited when non-academic staff assistance has substantially contributed to its creation and as such its creation/copyright is shared equally by the academic staff member and the University. It is the responsibility of the Vice-President, Operations to inform the academic staff member in writing that collaboration is about to substantially transform the work and obtain written agreement to proceed further. Article 6 of this policy will govern any commercial benefits derived from such teaching materials.

In addition the creator(s) grant the University a perpetual, non-exclusive, royalty-free, irrevocable license to copy, use and make minor modifications to such computer software and applications for the internet (social networking sites) in teaching (including distance and continuing education), research, and academic activities within the University.

The creator(s) will provide the University with the source code, object code and relevant documentation with all updates in



respect of the computer software and applications for the internet (social networking sites) for the purposes of the license rights granted above.

Creator(s) have the right to request exemption to some or all of the above under special circumstances. These requests must be made in writing to the Vice President, Academic and Research providing details of the special circumstances necessitating the exemption. If this request for exemption is denied the creator(s) have the right to appeal the decision under the provisions of Article 8 of this policy.

### **iii. Databases**

Databases developed as part of a research program are copyrightable and are subject to the copyright policy.

This policy is not concerned with data from external sources that may be used in teaching or research at the University except to state the obligation that publications or theses using these Databases must recognize and fully document their sources.

Original data collected and measured in the course of teaching and research by academic personnel/students must be protected and preserved for a reasonable period of time (defined by the norms of the discipline). This data must be made available to other scholars and non-commercial users.

The ownership of data collected by academic personnel/students in the course of their research are subject to the norms of academic scholarship and must be considered open, subject to review, and where possible accessible via the widest means possible. All university personnel have a collegial obligation to allow the creator(s) of such data a first opportunity to exploit that data for published work.

In addition to the extent that the creator(s) have rights in the data, the creator(s) grant the University a perpetual, non-exclusive, royalty-free, irrevocable license to copy and use such data in teaching (including distance and continuing education), research, and academic activities within the University.

The creator(s) shall make available the resulting data sets after completion and publication of the thesis or paper on which the data is based to other university personnel for royalty free, non-commercial use in teaching, research and academic activities in the University.

When the research is subject to confidentiality requirements because of contractual agreements with a sponsoring agency, to publication delays associated with patent applications or to University ethics constraints on research involving human or animal subjects as defined in the University Research Ethics Policy exceptions to this policy will be permitted. All collaborators must be aware of and agree to in writing in advance to such contractual limitations.

#### **4. Contract Research**

##### **i. Ownership of Intellectual Property in Contract Research**

Ownership of intellectual property may be determined in whole or in part by the regulations of the sponsor, or by the terms of the contract. In accordance with the University's policy on Research, academic personnel/students must retain the right to publish their work within a reasonable period of time and to use the results of this research in subsequent projects. Academic personnel/students must recognize the limitations that derive from using proprietary data and adhere to academic and professional standards of their discipline. All academic personnel/students must be aware of any ownership stipulations of the contract made by the principal investigator or by any other designated leader of the project.

Exceptions to this policy are governed by the following:

- a. University personnel/students entering into an agreement that will limit their normal academic scope for research must enter the contract with informed consent.
- b. Externally sponsored or contract research that limits the scope of academic research must be negotiated with the Vice-President, Academic and Research in consultation with the academic personnel/student that are proposing to enter into these research activities.
- c. When a company or agency funds a research program and retains the ownership of the intellectual property generated by

that research, some other academic benefit must be provided (eg., funding for students in a research lab). The research must support the generation and dissemination of knowledge in some other meaningful way as decided by the academic staff member, Vice-President, Academic and Research and the relevant Dean.

- d. Academic personnel must make known to any third party for whom they expect to consult, their obligations to the University. It is the responsibility of the academic staff member to ensure that the terms of the contract with a third party has the approval of the Vice-President, Academic and Research, and that the terms of the contract does not conflict with their commitment to the University.

## **ii. Non-Disclosure Agreements**

When one party wishes to disclose confidential information to a second party and to bind that party to confidentiality, a Confidential Disclosure Agreement is signed. These agreements can stand alone as a separate agreement or be part of a larger agreement.

If one party wishes to disclose confidential information to another party and to bind the confidentiality of the second party a Confidential Disclosure Agreement must be signed to protect both parties. The Vice-President, Academic and Research must review all Confidential Disclosure Agreements. It is the responsibility of the principle investigator to inform all participants of their obligations as defined in the terms of the confidential disclosure agreement.

## **iii. Material Transfer Agreements**

Academic personnel/students commonly transfer materials to their colleagues for a variety of purposes. This material is an important factor in attracting research funding. For this reason, the University requires that a Material Transfer Agreement or other agreements be signed ensuring that these materials will be used for research and not for commercial applications. If the material is being used for commercial application it will be governed by a license agreement. The Vice-President, Academic and Research must approve all such material transfer and license agreements.

## **5. Other Types of Intellectual Property**

There are other types of intellectual property including domain names, trademarks, breeders' rights and trade secret rights. These types of intellectual property have different rules and regulations governing their protection, but follow the same philosophy outlined in Article 1.

Any questions concerning other types of Intellectual Property and the universities policies should be directed to the Vice-President, Academic and Research.

## **6. Commercialization of Intellectual Property**

### **i. Timely Disclosure**

Academic personnel/students who have developed intellectual property that they intend to commercialize must inform the Vice-President, Academic and Research in advance, in writing and in a timely manner of their intent to do so. This disclosure must include the nature of the Intellectual Property, the names of the creator(s), the source of funding from which the Intellectual Property evolved and any other relevant information. The University will inform the creator(s) that they may commercialize the Intellectual Property themselves or the University may offer to assist with the commercialization and will provide information about those options.

### **ii. Commercialization by Creator(s)**

If the creator(s) elect to commercialize the Intellectual Property, they assume responsibility for legally protecting and marketing it, finding a licensee, negotiating a license agreement, and administering that agreement. Any such license agreement must contain full and complete releases and indemnification of the University with respect to commercialized Intellectual Property. The University will receive 10% of Net Revenues arising from the Intellectual Property annually. The Intellectual Property shall remain subject to the license and other rights of the University under these policies.

Where non-academic personnel are co-creator(s) of the Intellectual Property and the where the University has not waived its ownership rights as the employer of such non-academic personnel, the Vice-President, Academic and Research shall represent the University's interest in all matters related to this Intellectual Property.

The University is not responsible for any legal, development, marketing and other costs that may be incurred, including patent prosecutions if the creator(s) pursue commercialization on their own.

### **iii. Commercialization by the University**

Creator(s) may offer to the University the Intellectual Property for commercialization. The University retains the absolute and sole right to determine whether to accept such Intellectual Property for commercialization.

The University may seek a commercial and/or technical assessment of the Intellectual Property before accepting any assignment. Prior to conducting the assessment the University will enter into an agreement with the creator(s) with the following terms and conditions:

- a. If the University accepts the offer the University thereafter shall deal with such rights, including any further assignment to some specialized external agency. The University shall assume sole responsibility and authority for legally protecting and marketing the Intellectual Property, finding a license or sale agreement, and administering the agreement. The University shall retain 50% of Net Revenue arising from the Intellectual Property and the creator(s) shall receive 50% payable on an annual basis, unless the University and the creator(s) agree to a fixed percentage of Gross Revenue that is of equal or greater value for the University.
- b. If as a result of the assessment the University decides not to act to protect and/or commercialize the rights to the Intellectual Property, these rights shall be returned to the creator(s).
- c. If after three years from the date of the assignment (or the date of the issuance of the Patent) the rights to the Intellectual Property have not been assigned or licensed, at the creator(s) request they may be assigned back to the creator(s) provided the creator(s) reimburse the University for all Development Expenses prior to any disbursement of revenues and remit to the University 10% of the Net Revenue arising from the Intellectual Property on an annual basis.

University academic staff/students are not required to use the University's services, nor is the University obligated to take any Intellectual Property brought to it.

## **7. Administration and Amendments**

The Vice-President, Academic and Research is responsible for the administration of this Policy and is responsible for making determinations on various matters referred to in this Policy, including determining time periods, limitations on ownership rights, what constitutes private research and ownership rights of academic personnel/students.

It is the responsibility of the Vice-President, Academic and Research to review and evaluate these policies on an annual basis. Any changes to these policies recommended by the Vice-President, Academic and Research shall be provided to Senate, the Board of Governors of the University for consideration.

## **8. Dispute Resolution**

Disputes may arise between the University and academic staff/students or non-academic staff with respect to the ownership of intellectual property and the implementation of these policies.

When an agreement cannot be reached between the Vice-President, Academic and Research and the creator, the dispute will be referred to the Joint Committee on the Administration of the Agreement. The role of JCAA will be to attempt to resolve the dispute through mediation. If mediation fails the matter may be submitted to arbitration.

### **Acknowledgements:**

This document has been informed by the following documents governing intellectual property;

The University of Ontario Institute of Technology, Intellectual Property document ([http://www.uoit.ca/EN/main2/about/14057/14152/Academic\\_Policies\\_and\\_Procedures/intellectual\\_property.html](http://www.uoit.ca/EN/main2/about/14057/14152/Academic_Policies_and_Procedures/intellectual_property.html)).

The Intellectual Property policies governing the TriCouncil (NSERC, SSHRC and CIHR) granting agencies (<http://www.nserc-crsng.gc.ca/>).

The Intellectual Property documents governing University of New Brunswick, Guidelines on Intellectual Property Interests for Students involved in Research at the University of New Brunswick (<http://www.unb.ca/hr/services/Article38.html>)

The University of Western Ontario, Procedures: Intellectual Property Policy ([http://www.uwo.ca/research/services/intellectual\\_property\\_summary.html](http://www.uwo.ca/research/services/intellectual_property_summary.html)).

The definition of Intellectual Property is based on Duhaime Org, Intellectual Property Definition (<http://www.duhaime.org/LegalDictionary/I/IntellectualProperty.aspx>).

## **Definitions**

**Gross Revenue:** All income generated before expenses as defined below are accounted for.

**Net Revenue (gross income less all expenses):** For the purposes of calculating net income, expenses include all direct costs incurred by the University or the Member and paid or owed to an arms-length third party for obtaining and maintaining the statutory protection for the intellectual property, developing a prototype for the intellectual property, and exploiting the intellectual property for commercial gain. Expenses will not include any costs for time spent by the Member or by University employees in activities involving the commercial exploitation of intellectual property.

**Copyright:** shall mean the sole rights granted for specified periods pursuant to the *Copyright Act* (Canada), as amended or re-enacted from time to time, or any successor legislation, including the sole right to produce or reproduce an original literary, dramatic, musical and artistic work in any form. Literary works within the meaning of the *Copyright Act* include works consisting of text as well as computer programs. Copyright also includes the sole right to perform a work in public, to publish an unpublished work, to produce, reproduce, perform or publish any translation of a work, to convert a dramatic work into a novel or other non-dramatic work, to convert a novel, non-dramatic work or artistic work into a

dramatic work, to make a sound recording, cinematographic film or other mechanical contrivance of a literary, dramatic or musical work, to reproduce, adapt or publicly present a work as a cinematographic work, to communicate a work to the public by telecommunication, to present an artistic work at a public exhibition, and to rent out a computer program or a sound recording of a musical work. Similar rights are included with respect to performers' performances, sound recordings and broadcast communication signals. All of these rights extend both to the work and a substantial part of it, and include the right to authorize any of these actions.

### **Definitions - Continued**

**License:** A special permission to do something on, or with, somebody else's property which, were it not for the license, could be legally prevented or give rise to legal action in tort or trespass. A license, even though exclusive, does not give the **licensee** all the rights of the **patentee**. A license does not set up rights as between the **licensee** and the public, but only permits him/her to do acts that he/she would otherwise be prohibited from doing. He/She obtains merely a right of user. But a license is a grant of a right and does not merely confer upon the **licensee** a mere interest in equity. A license is the transfer of a beneficial interest to a limited extent, whereby the transferee acquires an equitable right in the **patent**. A license prevents that from being unlawful which, but for the license, would be unlawful; it is a consent by an owner of a right that another person should commit an act which, but for that license, would be an infringement of the right of the person who gives the license. A license gives no more than the right to do the thing actually licensed to be done."

**Patent:** shall mean the grant of exclusive rights, pursuant to the *Patent Act* (Canada), as amended or re-enacted from time to time, or any successor legislation, for a period of 20 years from the patent



application filing date, to make, construct and use an invention, and sell it to others to be used. In exchange, the patent application is made public by the Patent Office 18 months from the earlier of the filing date in Canada, or the filing date abroad under an international treaty. For an invention to be patentable it must be new, useful, and not obvious to someone skilled in the area.

APPROVED