



THE UNIVERSITY OF BRITISH COLUMBIA

Report to the Board of Governors

SUBJECT Amendments to Policy #88 – Patents and Licensing

MEETING DATE June 4, 2013

Forwarded to the Board of Governors on the
Recommendation of the President

**APPROVED FOR
SUBMISSION**

Stephen J. Toope, President and Vice-Chancellor

Presented By Hubert Lai, Q.C., University Counsel
John Hepburn, Vice-President, Research & International

Report Date May 10, 2013

DECISION REQUESTED **IT IS HEREBY REQUESTED that UBC Policy #88 be repealed and replaced by the proposed amendment of Policy #88 effective June 4, 2013.**

EXECUTIVE SUMMARY

The current Policy #88 (the “**Current Policy**”) has been in place, without amendment, since 1993.

The Office of the University Counsel initiated a process to substantially revise Policy #88 in order to create a Policy that is both reflective of and that furthers the University’s mandate to foster research and to see the product of that research implemented in practical applications of benefit to society. The intention was to create a Policy that aims to maximize the impact of University research in the broadest sense, whether through commercial or other means and a Policy that reflects the University’s latest thinking and practices with respect to research.

The proposed amendment of Policy #88 (the “**Proposed Policy**”) meets these stated aims.

Place and Promise Research Excellence
COMMITMENT

Place and Promise In contrast to the Current Policy, which is focused on the commercialization of inventions arising from University research, the Proposed Policy aims to maximize the impact of knowledge and understanding advanced through University research in the broadest sense, whether through commercialization or other means.
ACTION

Description & Rationale The Current Policy has been in place, without amendment, since 1993. Over the course of the two decades since that time, the technical, collaborative, and educational environments in which the University operates have changed significantly. Similarly, the University's practices in relation to the management of intellectual property arising from University research have evolved to such an extent that anyone reviewing the Current Policy would struggle to understand the University's practices.

The University has received numerous and increasing requests, from industry, government, and other stakeholders, to revise the Current Policy. Many of these requests call for changes that have already been adopted by the University at an operational level but that are not clearly reflected in the Current Policy. Other requests address matters which, if clarified, would assist the University both in its efforts to engage with industry and other community partners and in furthering its mandate to facilitate the creation of knowledge and to see that knowledge transferred from theoretical concept to practical application.

In response to these requests and in recognition of the inconsistency between the Current Policy and both the scope of the University's mandate and its existing operational practice, the Office of the University Counsel initiated a process to create a revised Policy that would achieve the following goals:

1. further the University's mandate to facilitate the dissemination of knowledge and maximize the impact that University research and inventions have on society;
2. encourage potential industry partners and other stakeholders to support research and learning at the University by empowering inventors to not only publish the results of their research, but to also utilize other non-commercial means to implement the products of their research into society without unnecessary restriction from the University; and
3. accurately reflect the University's current practices with respect to the treatment of University inventions.

The Proposed Policy satisfies these stated goals.

Additional Materials

The Current Policy, the Proposed Policy, a comparison of the Proposed Policy and the April 2012 Draft Policy, and a summary of the substantive comments received on the April 2012 Draft Policy.

SCHEDULE The Proposed Policy is submitted for the approval of the Board of Governors. It is
Implementation unanimously recommended by the Policy #88 Review Committee. The recommendation
Timeline has the support of the University Counsel and the Vice President, Research & International.

If the Proposed Policy is approved by the Board of Governors, the Office of the University Counsel will publish the revised version of Policy #88 on the University website and distribute the Proposed Policy to affected stakeholders.

CONSULTATION The revision process was initially informed by input from the University-Industry Liaison
Relevant Units, Office ("UILO") and a comprehensive review of comparable policies at the University's
Internal & External peer institutions in Canada and the United States, including the University of Waterloo,
Constituencies Stanford University, and MIT. The Office of the University Counsel then constituted a
Policy #88 Review Committee (the "**Committee**") comprised of the following members, to
consider and advise on the creation of proposed amendments to the Current Policy:

- Hubert Lai, Q.C., University Counsel (Chair)
- William Aiello, Professor, Computer Science
- Helen Burt, Associate Vice President, Research & International
- Jennifer Choi, Graduate Student, Biochemistry and Molecular Biology
- Alan Hu, Professor, Computer Science
- Mario Kasapi, Associate Director, UILO
- Chris Lennon, Associate, Richards Buell Sutton LLP
- Angus Livingstone, Managing Director, UILO
- Robert McMaster, Professor, Medical Genetics and Executive Director, VCHRI
- Mahmoud Pouladi, Graduate Student, Centre for Molecular Medicine and Therapeutics, (resigned from the Committee April 2012 due to placement abroad)
- Spiro Yannacopoulos, Associate Dean and Director, Engineering, UBC Okanagan

The Committee initially developed proposed amendments to Policy #88 (the "**April 2012 Draft Policy**") which were presented to the Board of Governors for information on April 3, 2012. Throughout the subsequent period from April to October 2012, the University widely solicited comments on the proposed amendments in the following manner:

- The April 2012 Draft Policy was published on the University's website under a call for comments on April 3, 2012. The comment period was set to run from April 3, 2012 until October 8, 2012.
- The Office of the University Counsel sent an email, and multiple reminder notices, highlighting key elements of the April 2012 Draft Policy and inviting responses to the call for comments via the "Heads Up" email list on both campuses to: the UBC executive team, associate vice presidents, all deans, principals, associate deans, directors and heads of units, department directors, student leaders and union leaders.
- shortly after the close of the comment period and prior to the Committee's review of the comments submitted, the Chair of the Committee:

- met with the President of the Faculty Association to provide an opportunity to discuss the Faculty Association’s comments and questions in person; and
- met with the head of Electrical and Computer Engineering (“ECE”) and later with the entire ECE department to discuss comments and questions raised by members of the department.
- A total of 83 responses were received during or shortly after the close of the comment period, all of which were considered by the Committee, including:
 - those submitted by Faculty Association members shortly after the close of the comment period in response to the Faculty Association’s appeal to its members to provide comments on the April 2012 Draft Policy ; and
 - those received from a number of industry groups shortly after the close of the comment period.

The responses to the call for comments raised a number of concerns and comments about the April 2012 Draft Policy. A summary of the substantive comments and the Committee’s responses is attached.

Previous Report Date	April 3, 2012	Decision	n/a
Discussion Points	Presented to the Board of Governors for information and comments		
Action / Follow Up	Published a call for comments		

 The University of British Columbia Board of Governors	Policy No.: 88	Approval Date: March 1993 Last Revision:
	Responsible Executive: Vice-President, Research	
Title: <p style="text-align: center;">Patents and Licensing</p>		
Background & Purposes: To encourage the public use and commercial application of inventions, and in so doing to protect the rights of the inventor and the University.		

1. Definitions

- 1.1. *Audiovisual and computer materials* include, but are not limited to, audio and video tapes, films, slides and photographs, computer programs and computer-stored information.
- 1.2. *Invention or discovery* includes data bases, audiovisual and computer material or equivalent circuitry, biotechnology and genetic engineering products and all other products of research which may be licensable.
- 1.3. *Literary Works* include, but are not limited to, books, lecture notes, laboratory manuals, artifacts, visual art and music.
- 1.4. *Publication* means putting the public in possession of an invention by way of speech, talk, paper, tape, video recording or other electronic means, drawing, photograph, printed work, or any other disclosure given or distributed, except on a confidential basis. Deposition of a thesis in the University Library constitutes publication in the above sense and may prejudice patent action unless an appropriate provision is made for limited accessibility to the thesis.

2. General

- 2.1. Members of faculty or staff, students and anyone connected with the University are encouraged to discuss and publish the results of research as soon and as fully as may be reasonable and possible. However, publication of the details of an invention may make it impossible to seek patent protection. Public use and commercial application are frequently facilitated by patenting and licensing arrangements.
- 2.2. *Discoveries, Inventions, Audiovisual and Computer Materials:* If any member of faculty or staff, any student, or anyone connected with the University proposes to protect or license an invention or discovery in which University facilities or funds administered by the University were used, a disclosure must be made to the University and the rights assigned to the University. The University may decide to protect or license the discovery or invention, in return for a share of any proceeds arising. If the University decides not to protect or license, the rights may be reassigned to the inventor, who may then develop commercial application of

the invention or discovery as he/she sees fit. Where it is anticipated that inventions or discoveries may ensue from a particular research enterprise, it may be necessary to undertake special agreements concerning patent or licensing rights before the research funds are accepted for administration by the University.

- 2.3. *Literary Works*: Ownership of and intellectual property rights to “literary works” produced by those connected with the University are vested in the individuals involved.

PROCEDURES

Approved: March 1993

Pursuant to Policy #1: Administration of Policies, "Procedures may be amended by the President, provided the new procedures conform to the approved policy. Such amendments are reported at the next meeting of the Board of Governors and are incorporated in the next publication of the UBC Policy and Procedure Handbook."

1. Administration

- 1.1. Responsibility for administration lies with the Director, University-Industry Liaison. On matters of policy, or in cases of dispute between inventors and the University, the Executive Committee for Research may make recommendations to the Vice President Research.

2. Patenting and Licensing Alternatives

- 2.1. Rights to inventions must be submitted and assigned to the University, unless there has been a prior arrangement to the contrary with a sponsor of research. The University may then develop the invention in various ways. By way of example, it may choose to:
 - 2.1.1. undertake patent and/or licensing arrangements through Office of University-Industry Liaison, using the services of patent agents, attorneys and other consultants;
 - 2.1.2. submit the proposal to a technology transfer or patenting corporation which has experience in evaluating inventions and obtaining patents on them, and which has the capability and facilities for introducing inventions and patents to public use;
 - 2.1.3. assign the University's rights in the inventions to the inventor(s), by an agreement which may make provision for the University to receive a royalty on gross sales or shares in a company or other considerations as may be negotiated.
- 2.2. The Director University-Industry Liaison will decide, after consultation with the inventor(s), which course of action will be taken. The University will normally prefer to retain patent rights and to grant non-exclusive licenses for limited periods, or make other such arrangements as may seem appropriate to facilitate technology transfer while protecting the rights of the inventor and the University. The University reserves the right to engage in litigation concerning patent and license infringements. The Vice President Research will report annually to the Executive Committee for Research regarding patents and licenses arising.

3. Assignment to and Development with the University

- 3.1. Any person associated with the University who has an invention capable of being patented or licensed must complete a disclosure form providing a full description of the invention and forward it to the Office of University-Industry Liaison. The Department Head, Director or Dean should be informed when a disclosure is made.
- 3.2. The Director of University-Industry Liaison normally decides within three months whether or not the invention is accepted by the University, and if so, whether it is to be retained by the University for patenting and/or licensing, or submitted to a patenting corporation. Acceptance of an invention or

discovery by the University does not mean that patenting, exploitation or commercialization will necessarily occur. Upon receipt of the invention questionnaire, the University-Industry Liaison Office will conduct a preliminary examination. If warranted, a market/commercial feasibility assessment will be conducted. The University-Industry Liaison Office will draw on the resources of an ad hoc committee with patenting/commercialization/business expertise as needed. If the invention does not appear to be viable to the Director of University-Industry Liaison, the rights to the invention will be returned to the inventor on a timely basis.

- 3.3. If the invention is accepted by the University, the Director, University-Industry Liaison consults with the inventor(s) on the proposed patenting and licensing arrangements. If the invention is to be submitted to an outside company, the Director, University Industry-Liaison or an appointed officer seeks the advice of the inventor(s) on the choice of an appropriate organization.
- 3.4. The Director, University-Industry Liaison, asks the inventor(s) to complete a standard invention disclosure and assignment form which describes the invention and assigns the inventor's interest in the invention to the University in return for a share of the revenue which may occur from commercialization.
- 3.5. After the completion of the invention disclosure between the University and the inventor(s), the cooperation of the inventor(s) in the development and marketing of an invention is critical. The inventor(s) assists in ensuring that written descriptions and patent filings are complete and accurate, and sign necessary legal instruments from time to time relating to the filing, carrying out and maintenance of patents and the commercialization of inventions.

4. Royalties to Inventor

- 4.1. Income derived from the sale or other disposal by the University of inventions or discoveries, including that derived under the terms of agreements with patenting corporations, are distributed such that the inventor receives 50% of the net income while the University retains 50% of the net income (25% as general University funds and 25% to the relevant Faculty). Net income is calculated as gross income less direct costs.
- 4.2. When several individuals collaborate on a patentable invention, the inventor's income share is divided among themselves (including co-developers who may not legally be inventors and who must be named to be eligible as recipients of portions of income).
- 4.3. Normally, an accounting is made from time to time, but not less frequently than annually.

5. Publication

- 5.1. Inventors should be aware that "publication" of the details of an invention may make it impossible to secure patent protection. In this sense "publication" means "putting the public in possession of an invention by way of speech, talk, paper, drawing, photograph, printed work, tape, video recording or other electronic means, or any other disclosure given or distributed, except on a confidential basis." Deposition of a thesis in the University Library constitutes "publication" in the above sense and may prejudice patent action unless an appropriate provision is made for limited accessibility to the thesis. Details are available from the Office of the Dean of Graduate Studies.

6. Record Keeping

- 6.1. If a patentable device or process might arise in the course of work on any project, laboratory records should be kept in a bound (not loose-leaf) notebook and be dated, signed and witnessed, as a routine procedure.

7. Other Employees

- 7.1. Members of faculty and staff responsible for work which might give rise to a patentable invention should ensure that no one associated or familiar with the material involved releases any unauthorized information. If appropriate, those associated with such a project may be asked to sign a brief agreement to this effect.

8. Dispute Resolution

- 8.1. In the event of a dispute between the Director of University-Industry Liaison and the inventor(s) as to his/her respective rights, an appeal may be made in writing to the President of the University, who will make a decision on behalf of the University after seeking the advice of the Executive Committee on Research and the Vice President Research. If the President's decision does not resolve the dispute, then final resolution is determined by arbitration under the provision of The Commercial Arbitration Act of the Province of British Columbia or any successor legislation.

9. Detailed Procedures

- 9.1. For further information, consult the Director of University-Industry Liaison.

 <p>The University of British Columbia Board of Governors</p>	<p>Policy No.: 88</p>	<p>Approval Date: <@> Last Revision: <@></p>
<p>Responsible Executive: Vice-President Research & International</p>		
<p>Title: Inventions and Discoveries</p>		
<p>Background & Purposes:</p> <p>The University is a community of scholars whose essential functions are the pursuit and dissemination of knowledge and understanding through research and teaching. Within that context, this Policy aims to: (i) promote the dissemination of knowledge and maximize the University's impact on society; (ii) facilitate the non-commercial use of inventions arising from University Research; (iii) establish the University as a hub of knowledge transfer and networking between researchers, industry and customers; (iv) maximize the University's impact on economic development and GDP growth; and (v) build constructive relationships with industry and entrepreneurs and cement the University's role as a leader in the Mobilization (as defined in Section 6.3 of the Procedures to this Policy) of research.</p> <p>In the Mobilization of discoveries, the University's primary objective is to maximize the impact on society, whether through commercial or non-commercial means. Earning revenue from a discovery is not a significant factor for the University.</p> <p>At the same time, the University recognizes that faculty members, students, staff members and other University Persons regularly participate in an array of projects and pursuits capable of producing inventions and discoveries. The University believes that certain categories of intellectual products should be distinguished from the inventions and discoveries arising from University Research.</p> <p>Accordingly, this Policy distinguishes University Research Products from other categories of intellectual products in order to define and clarify the treatment of inventions and discoveries, including University Research Products, which arise from the activities of University Persons or the University and to facilitate the public use and Mobilization of University Research Products while simultaneously enabling the mobilization of other discoveries.</p>		
<p>Related Policies, Materials and Notes</p> <p>Policy 85 - Scholarly Integrity Policy 87 - Research Policy 97 - Conflict of Interest and Conflict of Commitment Policy 105 - Acceptance, Management and Sale of Technology Licensing Equity</p>		

Defined terms are capitalized in this Policy. The definitions which are not found embedded within the Policy can be found at the end of the Procedures.

1. **General**

- 1.1 In accordance with the University's desire to foster research for the betterment of society, University Persons are encouraged to discuss and Publicly Disclose the results of their research, including University Research Products, as soon and as fully as may be reasonable and possible, provided that doing so will not violate any agreements that supported or are related to their research (University Persons are reminded that Publicly Disclosing the details of an invention or discovery may make it impossible to seek patent protection for such invention or discovery).
- 1.2 As used in this Policy and the related Procedures "**Publicly Disclose**" or "**Public Disclosure**" means disclosing to one or more other persons by any means, including through public presentation or publication in scholarly journals, theses or other academic publications, except on a confidential basis.
- 1.3 As used throughout this Policy "**Invention**" means any invention or discovery (whether or not patentable); software; and data, information, research tools, biological material and know-how which is proprietary in nature.

2. **Student Academic Product**

- 2.1 "**Student Academic Product**" means any Invention that is created, developed, discovered, conceived or invented in the course of or as part of a student's coursework (student includes any person enrolled in a course, whether credit or non-credit) provided that such coursework:
 - (a) is not a graduate student's thesis related coursework;
 - (b) does not involve activities for which such student is paid by the University;
 - (c) does not involve research that is the subject of an agreement (including a Sponsored Research Agreement) with a third party; and
 - (d) does not involve research where the Principal Investigator has made it a condition of participation that any Invention arising from such research shall be governed by this Policy as a University Research Product.
- 2.2 As the University wishes Student Academic Product to remain with its creators, the ownership and mobilization of Student Academic Product will be determined in accordance with applicable law and shall not be impacted by this Policy.

3. **Non-University Activity Product**

- 3.1 "**External Activity Product**" means any Invention, other than Work Product, that is created by University Persons but that is not created, developed, discovered, conceived or invented in the course of University Research.
- 3.2 As the University wishes External Activity Product to remain with its creators, the ownership and mobilization of External Activity Product will be determined in accordance with applicable law and shall not be impacted by this Policy.

4. **Sponsored Research Product**

- 4.1 In order to facilitate collaborative research, the University maintains a number of affiliation and research agreements with certain hospitals, governments, non-profit organizations, and industry partners under which University Research is conducted. In addition, to further foster research and dissemination of discoveries for the betterment of society, the University may, in consultation with the relevant Principal Investigator, enter into agreements (each a "**Sponsored Research Agreement**") with third parties from time to time with respect to University Research and the intellectual products arising from such University Research, which agreements may grant such third parties rights in such intellectual products.
- 4.2 "**Sponsored Research Product**" means any Invention that is created, developed, discovered, conceived or invented in the course of University Research that is the subject of a Sponsored Research Agreement.
- 4.3 Any agreements with third parties, including Sponsored Research Agreements, must be executed by the authorized signatories of the University in accordance with the signing resolutions approved by the Board of Governors. Since University Research involves the use of University facilities, equipment, or financial aid, or is conducted while acting within the scope of one's duties to the University, individual University Persons are not authorized to execute such agreements.

5. **University Research Product**

- 5.1 "**University Research**" means any research conducted by a University Person: (i) involving or utilizing the facilities, equipment or financial aid (including any grant funding) provided or administered by the University; or (ii) while acting within the scope of such University Person's duties or employment.
- 5.2 "**University Research Product**" means any Invention, other than Student Academic Product or Work Product, that is created, developed, discovered, conceived or invented in the course of University Research. For clarity University Research Product does not include teaching materials, lecture notes, textbooks, music, films, plays, and other dramatic works or writings that are scholarly in nature, developed or written by University Persons.
- 5.3 In furtherance of the University's desire to maximize the Mobilization of University Research Products, in addition to the ability to Publicly Disclose as described in Section 1.1 of this Policy, all University Inventors are granted a non-exclusive licence to undertake Non-Commercial Mobilization of any University Research Product that the University Inventor has created, developed, discovered or invented, unless:
- (a) the University Research Product is subject to a Sponsored Research Agreement or other form of agreement under which the University has agreed to convey a license, an option, or any other interest in the University Research Product to the other contracting party(ies);
 - (b) a University Inventor has disclosed the University Research Product to the University because the University Inventor wishes the University to undertake the Mobilization of such University Research Product or because of any other reason contemplated by the Procedures; or

- (c) the University Inventor is required to disclose the University Research Product to the University in accordance with the Procedures either because the University Inventor wishes the University to consider the Mobilization of such University Research Product or because the University Research Product is subject to a Sponsored Research Agreement or other form of agreement under which the University has agreed to convey a license, an option, or any other interest in the University Research Product to the other contracting party(ies).
- 5.4 Recognizing the University's mandate to facilitate teaching and research and to undertake the Mobilization of University Research Products for the greater good of society, the University, through its University - Industry Liaison Office, will, within the time frames specified in the Procedures:
- (a) review and consider University Research Products disclosed in accordance with the Procedures;
 - (b) assess the Mobilization potential of the disclosed University Research Products; and
 - (c) where appropriate, but always in consultation with University Inventors:
 - (i) engage third parties to carry-out or assist with such Mobilization; and
 - (ii) negotiate any business terms and other contractual arrangements with such third parties.
- 5.5 As University Research, by definition, involves the utilization of University facilities, equipment, or financial aid, or is conducted while acting within the scope of one's duties to the University, University Research Products are owned by the University. This consolidation of ownership with the University facilitates the Mobilization of University Research Products in a coordinated and efficient manner. Where documentation, including assignments, is required by law to vest ownership with the University, the University Inventors will execute such documents as are necessary to give effect to this Policy.
- 5.6 In the event the University undertakes Commercial Mobilization of a University Research Product, the University will be responsible for all costs that it incurs. The University will share any Net Revenue with University Inventors, subject to and in accordance with the Procedures. Furthermore, from its share the University will direct a portion of Net Revenue to the relevant Faculty in accordance with the Procedures.
- 5.7 Where the University concludes that it will not participate in, or continue with the Mobilization of a disclosed University Research Product, assignment of such University Research Product to the University Inventors will be addressed in accordance with the Procedures to this Policy.

6. **Work Product**

- 6.1 "**Work Product**" means any intellectual product (including all forms of intellectual property through which such intellectual product may be protected, including patents, copyrights, industrial designs, integrated circuit topographies, trade-marks, trade secrets and know-how) created in the course of a University Person's employment with the University if such University Person is required by the University to create the intellectual product. Examples of Work Product include web sites created for the University by its

web site designers, marketing materials created for the University by its communications staff, software created for the University by its programming staff, and administrative materials such as manuals and procedures created for the University by Department Heads and Deans. For the purposes of this Policy, Work Product does not include teaching materials, lecture notes, textbooks, music, films, plays, and other dramatic works or writings that are scholarly in nature, developed or written by University Persons in the course of their regular University employment.

- 6.2 The ownership of Work Product is vested with the University. Where documentation, including assignments, is required by law to vest ownership with the University, the University Person will execute such documents as are necessary to give effect to this Policy.
- 6.3 All Work Product must be the original creation of University Persons. Unless specific permission has been secured in accordance with Section 6.5 of this Policy, University Persons must not incorporate any third party intellectual property, including any open source software or other material, in any Work Product.
- 6.4 As Work Product, by definition, is not a University Research Product, a University Person may not discuss or Publicly Disclose any Work Product without the University's prior written approval. However, to aid in the advancement and dissemination of knowledge, the University may allow a University Person to undertake, through a new or an existing open source license, the Non-Commercial Mobilization of a particular Work Product.
- 6.5 If a University Person wishes the University to consider either: (i) the Non-Commercial Mobilization of a particular Work Product (e.g. through a new or an existing open source license such as Creative Commons, The GNU General Public License, etc.); or (ii) the incorporation of third party intellectual property into a particular Work Product (e.g. by utilizing open source software), such University Person must seek approval from the Administrative Head of Unit under whose management responsibility the Work Product was or will be created.

PROCEDURES

Approved: <@>
Revised: <@>

Pursuant to Policy #1: Administration of Policies, "Procedures may be amended by the President, provided the new procedures conform to the approved policy. Such amendments are reported at the next meeting of the Board of Governors." Note: the most recent procedures may be reviewed at <http://universitycounsel.ubc.ca/policies/index/>.

1. Administration

- 1.1 The responsibility for the administration of this Policy and these Procedures lies with the University – Industry Liaison Office. In cases where one or more University Inventors dispute a determination that has been made by the University – Industry Liaison Office pursuant to this Policy, the University Inventor(s) may, within 60 days after the date the disputed determination was made, refer the dispute to the Managing Director of the University – Industry Liaison Office and the Dean of the relevant Faculty, to facilitate a resolution to the dispute. In the event the matter cannot be resolved to the satisfaction of the parties within 60 days after the date of referral, the matter will be referred to the Vice President, Research & International, to facilitate a resolution or, if necessary, make a final determination. The Vice President, Research & International may convene an expert panel to assist and advise him or her in relation to the dispute and the making of any determination.

2. Disclosure and Assessment of University and Sponsored Research Products

- 2.1 Publicly Disclosing University Research Products may make it impossible to seek patent protection for such University Research Products. Accordingly, University Inventors are encouraged to disclose University Research Products to the University in accordance with these Procedures prior to Publicly Disclosing such University Research Products. University Inventors must assist the University in ensuring that all descriptions of University Research Products that are disclosed, including any patent filings, are complete and accurate, and must assist the University, as reasonably required, with the Mobilization of such disclosed University Research Products including by cooperating in obtaining patent or other protection for such University Research Product and in legal actions taken to protect such University Research Products.
- 2.2 A University Inventor must disclose a University Research Product to the University when the University Inventor wishes the University to consider the Mobilization of the University Research Product. A University Inventor must similarly comply with any disclosure mandated by a Sponsored Research Agreement.
- 2.3 Any University Inventor who discloses a University Research Product or a Sponsored Research Product to the University must:
 - (a) fully disclose the identity of all University Inventors in connection with such University Research Product or Sponsored Research Product, their relative contribution to the University Research Product or Sponsored Research Product, and any sources of funding for the University Research that resulted in the University Research Product or Sponsored Research Product, as the case may be;

- (b) fully disclose, to the University – Industry Liaison Office, the existence or the promise of any potentially conflicting interest (including equity, options, consulting fees, management position etc.) that such University Inventor may have in any licensee or Inventor Start-up (as defined in Section 4.1 of these Procedures); and
 - (c) sign, at the University's request, any documents, including assignments and waivers, that are necessary to confirm or give effect to the University's ownership of such University Research Product or Sponsored Research Product.
- 2.4 All disclosures to the University – Industry Liaison Office must be submitted and kept up to date in a timely manner using the disclosure forms prescribed by the University – Industry Liaison Office.
- 2.5 The University – Industry Liaison Office will make a determination about the appropriateness of undertaking the Mobilization of any University Research Product within 90 days of receiving a complete written disclosure of such University Research Product in accordance with these Procedures.

3. Mobilization of University Research Products

- 3.1 If the University determines that it is appropriate to undertake the Mobilization of a University Research Product that has been disclosed to the University under Section 2 of these Procedures, the University will consult with the primary University Inventors on the proposed Mobilization of the University Research Product.
- 3.2 The University is committed to working with the University Inventors to create an appropriate plan for the Mobilization of University Research Products. The University is also committed to aiding in the Mobilization of discoveries which may be of benefit to society. While the University maintains the discretion to make decisions regarding the Mobilization of University Research Products that have been disclosed to the University under Section 2 of these Procedures, provided the stated aims of this Policy are not frustrated by lack of consensus, the University prefers not to exercise such discretion.
- 3.3 After consulting with the University Inventors as contemplated in Sections 3.1 and 3.2, the University may, with or without expectation of realizing any positive Net Revenue:
- (a) enter into agreements with third parties that grant such third parties the right to undertake Mobilization of University Research Products, including agreements for the sale, Public Disclosure, assignment or license of University Research Products or the grant of an option to obtain certain rights regarding University Research Products;
 - (b) contract with third parties, to assist in the Mobilization of University Research Products, such as patent agents, lawyers, accountants and other professionals and consultants;
 - (c) establish a corporation, society or other legal entity for the purpose of the Mobilization of University Research Products;
 - (d) assign or license to any third party, on terms deemed reasonable to the University but always for the purpose of Mobilization, the University's rights in University Research Products; and

- (e) utilize alternative channels, such as Global Access Principles, open source licensing and science commons, to provide access to University Research Products for the benefit of society.
- 3.4 A University Inventor may request, from time to time, but not more frequently than once per fiscal year, a report on the Mobilization of University Research Products disclosed to the University by the University Inventor and upon such request the University will use reasonable efforts to respond to such request in a timely manner.
- 3.5 If a University Inventor discloses a University Research Product to the University in accordance with these Procedures and the University concludes that it will not proceed or continue with the Mobilization of such disclosed University Research Product, the University Inventor may request that the University assign such University Research Product to one or more University Inventors. Upon receipt of any such request, the University will assign such University Research Product to one or more of its University Inventors (subject to any existing third party rights in the University Research Product), provided that:
- (a) the University Inventor(s) have met their obligations under these Procedures to assist the University with the Mobilization of the disclosed University Research Product;
 - (b) all of the University Inventors have given their consent to such assignment; and
 - (c) the assignee(s) execute an agreement which, in the sole determination of the University, makes adequate provision for the University:
 - (i) to practice the University Research Product for research, clinical, educational or other non-commercial purposes;
 - (ii) to be protected and indemnified from any risks associated with the use or Mobilization of the University Research Product by such assignee; and
 - (iii) to address any other matters determined to be prudent in the circumstances.

4. Inventor Start-ups

- 4.1 The Mobilization of University Research Products may be undertaken by entering agreements with pre-funding or early stage ventures either founded by, having a close relationship with, or in which a financial interest is taken or will be taken by one or more University Inventors (collectively "**Inventor Start-ups**").
- 4.2 The University is supportive of efforts by University Inventors to participate in the Mobilization of University Research Products through Inventor Start-ups. However, such Inventor Start-ups may also create a conflict of commitment, an actual or potential conflict of interest, or a situation which creates a perception of a conflict of interest (collectively "**Conflicts**").
- 4.3 The University is committed to identifying and appropriately managing any such Conflicts while simultaneously supporting the appropriate entrepreneurial participation and external engagement of University Inventors. Accordingly, with respect to any negotiations or dealings with an Inventor Start-up:

- (a) in recognition of their role with the University, the University will not negotiate directly with any University Inventor(s) associated with the Inventor Start-up except in exceptional circumstances; and
- (b) in addition to any disclosure required of the relevant University Inventors, the University may require that any University Inventor provide assurances, to the University's satisfaction, with respect to any compensation received or to be received by a University Inventor, as further contemplated in Section 5.7 of these Procedures.

5. Distribution of Net Revenue

5.1 In order to create an incentive and to reward University Inventors, provided:

- (a) a University Inventor discloses a University Research Product to the University in accordance with these Procedures;
- (b) the University decides to undertake the Mobilization of such disclosed University Research Product, or any part thereof; and
- (c) the University Inventor assists the University with such Mobilization, as further set out in these Procedures,

the University will, unless otherwise provided for in these Procedures, distribute any Net Revenue received by the University from the Mobilization of the University Research Product as follows:

- (i) 50% of the Net Revenue will, subject to Sections 5.6 and 5.7 of these Procedures, be allocated among the University Inventors of the University Research Product in proportion to their relative contributions to the University Research Product which generated the Net Revenue, in accordance with Section 5.4 of these Procedures; and
 - (ii) 50% of the Net Revenue will be retained by the University, out of which 25% of the Net Revenue will be allocated as general University funds and 25% of the Net Revenue will be allocated to the relevant Faculty, as identified by the University Inventor. If more than one University Inventor is involved, the portion of the Net Revenue allocated to the Faculties will be allocated *pro rata* to the relative contributions of the University Inventors.
- 5.2 If the University receives, as a result of the Mobilization of the University Research Product, payment in the form of shares or other securities, the distribution percentages set out in Section 5.1 of these Procedures will be used in determining the allocation of such shares or other securities between the University and the University Inventors, after adequate provision for those expenses contemplated in Net Revenue.
- 5.3 The portion of Net Revenue allocated to the University Inventors under Section 5.1(c)(ii) of these Procedures will be due and payable to the University Inventors:
- (a) in the case of payments equal to or greater than \$5,000, within 60 days after the end of the fiscal quarter in which the payments were received; and
 - (b) in the case of payments less than \$5,000, within 60 days after the end of the fiscal year in which the payments were received,

provided, however, that the University may withhold such amounts as it deems to be necessary to meet anticipated expenses of Mobilization, and further provided that where the Net Revenue includes shares or securities, as contemplated in Policy #105 (Acceptance, Management and Sale of Technology Licensing Equity), the distribution of shares or securities will be subject to the expiry of any hold period or other restriction on the transfer of any shares or securities included in the Net Revenue, whether imposed by agreement, legislation or otherwise.

- 5.4 If there is more than one University Inventor for any University Research Product for which Mobilization has been undertaken as set out in Section 3 of these Procedures, the University will require the University Inventors to determine a list of University Inventors and the allocation of any Net Revenue among them. This allocation will be commensurate with the relative contribution made by each University Inventor to the creation, development, discovery or invention of the University Research Product. Subject to the agreement of all University Inventors, non-inventive University Persons who contributed to the University Research Product may be included in the list described in the foregoing sentence. Any dispute relating to the list of University Inventors, their relative contributions to the University Research Product or their entitlement to the Net Revenue will be determined by the University – Industry Liaison Office.
- 5.5 For each University Research Product that is generating Net Revenue to be allocated to one or more University Inventors, the University will prepare an accounting of Net Revenue from time to time, but not less frequently than once per fiscal year.
- 5.6 A University Inventor may waive his or her right to an allocation of Net Revenue under this Section 5 by filing a waiver in writing with the University-Industry Liaison Office, in the prescribed form, prior to being allocated any portion of the Net Revenue. For greater certainty, where a University Inventor has filed a waiver under this Section 5.6, the fair market value of the Net Revenue or shares or securities, as the case may be, otherwise allocable to that University Inventor shall be retained by the University to be used at its sole discretion, and shall not form part of the Net Revenue that is allocated to the University under Section 5.1 of these Procedures.
- 5.7 If a University Inventor chooses to be directly compensated by a company receiving any rights in relation to the Commercial Mobilization of a University Research Product, that University Inventor will not receive any portion of the Net Revenue from the Mobilization of the University Research Product. In such event, the portion of the Net Revenue that would otherwise have been allocated to that University Inventor pursuant to Section 5.1 of these Procedures will be allocated to the University and the other University Inventors on a *pro rata* basis.

6. **Additional Definitions**

- 6.1 **"Administrative Head of Unit"** means a Director of a service unit, a Head of an academic department, a Director of a centre, institute or school, a Principal of a college, a Dean, an Associate Vice-President, the Registrar, the University Librarian, a Vice-President or the President or the equivalent.
- 6.2 **"Commercial Mobilization"** means any Mobilization which is expected, or may reasonably be expected, to result in any payments or distributions from such Mobilization.

- 6.3 **"Mobilization"** means the development and implementation of a plan to maximize the impact that University Research Products or Work Products have on society and may occur by way of commercial licensing, sale, marketing, manufacturing, distribution, open source licensing, Public Disclosure, or other disposition of a University Research Product or Work Product and/or any works, products or services covered by, claimed by, and/or incorporating a University Research Product or Work Product, as well as securing patents or other forms of protection for such University Research Products or Work Products.
- 6.4 **"Non-Commercial Mobilization"** means Mobilization other than Commercial Mobilization.
- 6.5 **"Net Revenue"** means the gross payments and distributions, whether by way of cash, equity holdings or otherwise, received by the University from the Mobilization of a University Research Product, less all direct and indirect expenses incurred in pursuing such Mobilization including any legal fees, patent and prototype costs, ongoing development and operational expenses, payments under any inter-institutional revenue sharing agreement, and any other amounts reasonably paid in the sole discretion of the University for any relevant purpose in connection with the Mobilization of the University Research Product. For greater certainty, any funding or reimbursement of research costs received by the University shall not form part of the gross payments upon which Net Revenue shall be calculated.
- 6.6 **"Principal Investigator"** means the person who has primary responsibility for a research project. In the case of a project funded by an external or internal grant, this will normally be the holder of the grant. In the case of a project that is not funded, this will normally be the initiator of the project. The Principal Investigator is usually the supervisor of the research team (which may include other researchers) and is usually a faculty member.
- 6.7 **"University Inventor"** means the University Person(s) who individually or collectively created, developed, discovered or invented a University Research Product or Sponsored Research Product.
- 6.8 **"University Person"** means full-time and part-time faculty members and staff members of the University and any other person who teaches, conducts research, or works at or under the auspices of the University. For greater certainty, University Persons include but are not limited to students, adjunct and clinical faculty, librarians, lecturers, post doctoral fellows, faculty on study leave, honorary professors, research associates, and visiting professors.

 <p>The University of British Columbia Board of Governors</p>	<p>Policy No.: 88</p>	<p>Approval Date: <@> Last Revision: <@></p>
<p>Responsible Executive: Vice-President Research & International</p>		
<p>Title:</p> <p style="text-align: center;">Intellectual Products <u>Inventions and Discoveries</u></p>		
<p>Background & Purposes:</p> <p>The University is committed to the advancement<u>a community of scholars whose essential functions are the pursuit</u> and dissemination of knowledge. As such, the University wishes to encourage research which explores aspects of the world in which we live, and to aid in the mobilization of discoveries which may be of benefit to society, and understanding through research and teaching. Within that context, this Policy aims to: <u>(i) promote the dissemination of knowledge and maximize the University's impact on society; (ii) facilitate the non-commercial use of inventions arising from University Research; (iii) establish the University as a hub of knowledge transfer and networking between researchers, industry and customers; (iv) maximize the University's impact on economic development and GDP growth; and (v) build constructive relationships with industry and entrepreneurs and cement the University's role as a leader in the Mobilization (as defined in Section 6.3 of the Procedures to this Policy) of research.</u></p> <p>Recognizing that<u>In the Mobilization of</u> discoveries and inventions can be transmitted through various commercial and non-commercial means, the University aims to consider a range of avenues available to move a discovery into the world in a practical form. Accordingly, as used in this Policy or the related Procedures, mobilization (which is expressly defined below with respect to University Research Products and Work Products) is understood to mean the development and implementation of a plan to maximize, <u>the University's primary objective is to maximize the impact on society,</u> whether through commercial or non-commercial means, the impact that. <u>Earning revenue from</u> a discovery will have on society. <u>is not a significant factor for the University.</u></p> <p>In addition<u>At the same time,</u> the University recognizes that faculty members, students, staff members and other University Persons regularly participate in an array of projects and pursuits capable of producing inventions and discoveries. Moreover, the<u>The</u> University believes that certain categories of intellectual products should be distinguished from the intellectual products<u>inventions and discoveries</u> arising from University Research.</p> <p>Accordingly, this Policy distinguishes University Research Products from other categories of discoveries<u>intellectual products</u> in order to define and clarify the ownership of intellectual products<u>treatment of inventions and discoveries</u>, including University Research Products, which arise from the activities of University Persons or the University and to facilitate the public use and mobilization<u>Mobilization</u> of University Research Products while simultaneously enabling the mobilization of other intellectual products<u>discoveries</u>.</p>		

Related Policies, Materials and Notes

Policy 85 - Scholarly Integrity

Policy 87 - Research

Policy 97 - Conflict of Interest and Conflict of Commitment

Policy 105 - Acceptance, Management and Sale of Technology Licensing Equity

Defined terms are capitalized in this Policy. The definitions which are not found embedded within the Policy can be found at the end of the Procedures.

1. **General**

- 1.1 In accordance with the University's desire to foster research for the betterment of society, University Persons are encouraged to discuss and Publicly Disclose the results of their research, including University Research Products, as soon and as fully as may be reasonable and possible, provided that doing so will not violate any agreements that supported or are related to their research (University Persons are reminded that Publicly Disclosing the details of an invention or discovery may make it impossible to seek patent protection for such invention or discovery).
- 1.2 As used in this Policy and the related Procedures "**Publicly Disclose**" or "**Public Disclosure**" means disclosing to one or more other persons by any means, including through public presentation or publication in scholarly journals, theses or other academic publications, except on a confidential basis.
- 1.3 As used throughout this Policy "**Invention**" means any invention or discovery (whether or not patentable); software; and data, information, research tools, biological material and know-how which is proprietary in nature.

2. **Student Academic Product**

- 2.1 "**Student Academic Product**" means any ~~inventions, discoveries, know-how, compounds, biological materials, compilations of data, software, integrated circuit topographies, blue prints, drawings and designs, processes, and prototypes, and all intellectual property through which it may be protected~~ invention that is created, developed, discovered, conceived or invented in the course of or as part of ~~an undergraduate a~~ student's coursework, ~~or a graduate student's non-thesis related coursework,~~ (student includes any person enrolled in a course, whether credit or non-credit) provided that such coursework ~~does not involve:~~
- (a) is not a graduate student's thesis related coursework;
- (b) ~~does not involve~~ activities for which such student is paid by the University;
- (c) ~~does not involve~~ research that is the subject of an agreement (including a Sponsored Research Agreement) with a third party; ~~or~~ and
- (d) ~~does not involve~~ research ~~carried out by a research team~~ where the ~~principal investigator~~ Principal Investigator has made it a condition of participation that ~~all participating University Persons are participating in University Research or that any~~

~~intellectual product~~any Invention arising from such ~~University Research~~research shall be governed by this Policy as a University Research Product.

- 2.2 As the University wishes Student Academic Product to remain with its creators, the ownership and mobilization of Student Academic Product will be determined in accordance with applicable law and shall not be impacted by this Policy.

3. Non-University Activity Product

3.1 “**External Activity Product**” means any ~~inventions, discoveries, know-how, compounds, biological materials, compilations of data, software, integrated circuit topographies, blue prints, drawings and designs, processes, and prototypes, and all intellectual property through which it may be protected~~Invention, other than Work Product, that is created by University Persons but that is not created, developed, discovered, conceived or invented in the course of University Research.

- 3.2 As the University wishes External Activity Product to remain with its creators, the ownership and mobilization of External Activity Product will be determined in accordance with applicable law and shall not be impacted by this Policy.

4. Sponsored Research Product

4.1 In order to facilitate collaborative research, the University maintains a number of affiliation and research agreements with certain hospitals, governments, non-profit organizations, and industry partners under which University Research is conducted. In addition, to further foster research and dissemination of discoveries for the betterment of society, the University may in consultation with the relevant Principal Investigator, enter into agreements (each a “**Sponsored Research Agreement**”) with third parties from time to time with respect to University Research and the intellectual products arising from such University Research, which agreements may grant such third parties rights in such intellectual products.

4.2 “**Sponsored Research Product**” means any ~~inventions, discoveries, know-how, compounds, biological materials, compilations of data, software, integrated circuit topographies, blue prints, drawings and designs, processes, and prototypes, and all intellectual property through which it may be protected~~Invention that is created, developed, discovered, conceived or invented in the course of University Research that is the subject of a Sponsored Research Agreement.

4.3 Any agreements with third parties, including Sponsored Research Agreements, must be executed by the authorized signatories of the University in accordance with the signing resolutions approved by the Board of Governors. Since University Research involves the use of University ~~administered funds~~ facilities, equipment, or ~~other facilities~~ financial aid, or is conducted while acting within the scope of one’s duties to the University, individual University Persons are not authorized to execute such agreements.

5. University Research Product

5.1 “**University Research**” means any research conducted by a University Person: (i) involving or utilizing the facilities, equipment or financial aid (including any grant funding) provided or administered by the University, but excluding research conducted as part of an undergraduate student’s coursework, or a graduate student’s non-thesis related

~~coursework, provided that such coursework does not involve;~~ or (ii) while acting within the scope of such University Person's duties or employment.

- ~~(a) activities for which such student is paid by the University;~~
- ~~(b) research that is the subject of an agreement (including a Sponsored Research Agreement) with a third party; or~~
- ~~(c) research carried out by a research team where the principal investigator has made it a condition of participation that all participating University Persons are participating in University Research or that any intellectual product arising from such University Research shall be governed by this Policy.~~

5.2 "University Research Product" means any ~~inventions, discoveries, know-how, compounds, biological materials, compilations of data, software, integrated circuit topographies, blue prints, drawings and designs, processes, and prototypes, and all intellectual property through which it may be protected~~Invention, other than Student Academic Product or Work Product, that is created, developed, discovered, conceived or invented in the course of University Research ~~but excludes all Work Product.~~ For clarity University Research Product does not include teaching materials, lecture notes, textbooks, music, films, plays, and other dramatic works or writings that are scholarly in nature, developed or written by University Persons.

5.3 In furtherance of the University's desire to maximize the Mobilization of University Research Products, in addition to the ability to Publicly Disclose ~~University Research Products~~ as described in Section 1.1 of this Policy, all University Inventors are granted a non-exclusive licence to undertake Non-Commercial Mobilization of any University Research Product that the University Inventor has created, developed, discovered or invented, unless:

- (a) the University Research Product is subject to a Sponsored Research Agreement or other form of agreement under which the University has agreed to convey a license, an option, or any other interest in the University Research Product to the other contracting party(ies);
- (b) ~~the~~a University Inventor has disclosed the University Research Product to the University because the University Inventor wishes the University to undertake the Mobilization of such University Research Product or because of any other reason contemplated by the Procedures; or
- (c) the University Inventor is required to disclose the University Research Product to the University in accordance with the Procedures either because the University Inventor wishes the University to consider the Mobilization of such University Research Product or because the University Research Product is subject to a Sponsored Research Agreement or other form of agreement under which the University has agreed to convey a license, an option, or any other interest in the University Research Product to the other contracting party(ies).

5.4 Recognizing the University's mandate to facilitate teaching and research and to undertake the Mobilization of University Research Products for the greater good of society, the University, through its University - Industry Liaison Office, will, within the time frames specified in the Procedures:

- (a) review and consider University Research Products disclosed in accordance with the Procedures;
- (b) assess the Mobilization potential of the disclosed University Research ~~Product~~Products; and
- (c) where appropriate, but always in consultation with ~~the~~ University ~~Inventor~~Inventors:
 - (i) engage third parties to carry-out or assist with such Mobilization; and
 - (ii) ~~in consultation with the University Inventor~~, negotiate any business terms and other contractual arrangements with such third parties.

5.5 As University Research, by definition, involves the utilization of University facilities, equipment, or financial aid, or is conducted while acting within the scope of one's duties to the University. University Research Products are owned by the University. This consolidation of ownership with the University facilitates the Mobilization of University Research Products in a coordinated and efficient manner. Where documentation, including assignments, is required by law to vest ownership with the University, the University Inventors will execute such documents as are necessary to give effect to this Policy.

5.6 In the event ~~that~~ the University undertakes Commercial Mobilization of a University Research Product ~~and generates Net Revenue from such Commercial Mobilization~~, the University will be responsible for all costs that it incurs, ~~and~~ The University will share any Net Revenue ~~derived from such Commercial Mobilization with the~~with University Inventors, subject to and in accordance with the Procedures. Furthermore, from its share the University will direct a portion of Net Revenue to the relevant Faculty in accordance with the Procedures.

5.7 ~~If a University Inventor discloses a University Research Product to the University in accordance with the Procedures and~~Where the University concludes that it will not participate in, or continue with the Mobilization of ~~such a~~ disclosed University Research Product, ~~the University may assign~~assignment of such University Research Product to the University Inventors ~~subject to any existing third party rights in the University Research Product~~will be addressed in accordance with the Procedures to this Policy.

6. Work Product

6.1 "Work Product" means ~~anything created by University Persons whose employment duties include the creation or development of the~~any intellectual product, (including all forms of intellectual property through which ~~it~~such intellectual product may be protected, including patents, copyrights, industrial designs, integrated circuit topographies, trade-marks, trade secrets and know-how) created in the course of a University Person's employment with the University if such University Person is required by the University to create the intellectual product. Examples of Work Product include web sites created ~~by~~for the University's by its web site designers, marketing materials created ~~by~~for the University's by its communications staff, ~~and~~ software created ~~by the University's programming staff~~for the University by its programming staff, and administrative materials such as manuals and procedures created for the University by Department Heads and Deans. For the purposes of this Policy, Work Product does not include teaching materials, lecture notes, textbooks, music, films, plays, and other dramatic works or writings that are

scholarly in nature, developed or written by University Persons in the course of their regular University employment.

6.2 The ownership of Work Product is vested with the University. Where documentation, including assignments, is required by law to vest ownership with the University, the University Person will execute such documents as are necessary to give effect to this Policy.

6.3 All Work Product must be the original creation of University Persons. Unless specific permission has been secured in accordance with Section 6.5 of this Policy, University Persons must not incorporate any third party intellectual property, including any open source software or other material, in any Work Product.

6.4 ~~6.3~~ As Work Product, by definition, is not a University Research Product, a University Person may not discuss or Publicly Disclose any Work Product without the University's prior written approval. However, to aid in the advancement and dissemination of knowledge, the University may, ~~in certain circumstances,~~ allow a University Person to undertake, through a new or an existing open source license, the Non-Commercial Mobilization of a particular Work Product.

6.5 ~~6.4~~ If a University Person wishes the University to consider either: (i) the Non-Commercial Mobilization of a particular Work Product (e.g., through a new or an existing open source license such as Creative Commons, The GNU General Public License, etc.); or (ii) the incorporation of third party intellectual property into a particular Work Product (e.g. by utilizing open source software), such University Person must seek approval from the Administrative Head of Unit under whose management responsibility the Work Product was or will be created.

PROCEDURES

Approved: <@>

Revised: <@>

Pursuant to Policy #1: Administration of Policies, "Procedures may be amended by the President, provided the new procedures conform to the approved policy. Such amendments are reported at the next meeting of the Board of Governors." Note: the most recent procedures may be reviewed at <http://universitycounsel.ubc.ca/policies/index/>.

1. Administration

1.1 The responsibility for the administration of this Policy and these Procedures lies with the University – Industry Liaison Office. In cases where one or more University Inventors dispute a determination that has been made by the University – Industry Liaison Office pursuant to this Policy, the University Inventor(s) may, within 60 days after the date the disputed determination was made, refer the dispute to the Managing Director of the University – Industry Liaison Office and the Dean of the relevant Faculty ~~within 60 days after the date the disputed determination was made and, in,~~ to facilitate a resolution to the dispute. In the event the matter cannot be resolved to the satisfaction of the parties within 60 days after the date of referral, the matter will be referred to ~~and finally determined by~~ the Vice President, Research & International, to facilitate a resolution or, if necessary, make a final determination. The Vice President, Research & International may convene an expert panel to assist and advise him or her in relation to the dispute and the making of any determination.

2. Disclosure and Assessment of University and Sponsored Research Products

2.1 Publicly Disclosing University Research Products may make it impossible to seek patent protection for such University Research Products. Accordingly, University Inventors are encouraged to disclose University Research Products to the University in accordance with these Procedures prior to Publicly Disclosing such University Research Products. University Inventors must assist the University in ensuring that all descriptions of University Research Products that ~~they disclose~~ are disclosed, including any patent ~~filings~~ filings, are complete and accurate, and must assist the University, as reasonably required, with the Mobilization of such disclosed University Research Products including by cooperating in obtaining patent or other protection for such University Research Product and in legal actions taken to protect such University Research Products.

2.2 A University Inventor must disclose a University Research Product to the University when the University Inventor wishes the University to consider the Mobilization of the University Research Product. A University Inventor must similarly ~~disclose to the University any Sponsored Research Product and any other intellectual product arising from University Research which is subject to~~ comply with any disclosure mandated by a Sponsored Research Agreement ~~or other form of agreement under which the University has~~

~~agreed to convey a license, an option, or any other interest in the intellectual product to the other contracting party(ies).~~

- 2.3 Any University Inventor who discloses a University Research Product or a Sponsored Research Product to the University must:
- (a) fully disclose the identity of all University Inventors in connection with such University Research Product or Sponsored Research Product, their relative contribution to the University Research Product or Sponsored Research Product, and any sources of funding for the University Research Product or Sponsored Research Product, as the case may be;
 - (b) fully disclose, to the University – Industry Liaison Office, the existence or the promise of any potentially conflicting interest (including equity, options, consulting fees, management position etc.) that such University Inventor may have in any licensee or Inventor Start-up (as defined in Section 4.1 of these Procedures); and
 - (c) ~~(b)~~-sign, at the University's request, any documents, including assignments and waivers, that are necessary to confirm or give effect to the University's ownership of such University Research Product or Sponsored Research Product.
- 2.4 All disclosures to the University – Industry Liaison Office must be submitted and kept up to date in a timely manner using the disclosure forms prescribed by the University – Industry Liaison Office.
- 2.5 The University – Industry Liaison Office will make a determination about the appropriateness of undertaking the Mobilization of any University Research Product within 90 days of receiving a complete written disclosure of such University Research Product in accordance with these Procedures.

3. Mobilization of University Research Products

- 3.1 If the University determines that it is appropriate to undertake the Mobilization of a University Research Product that has been disclosed to the University under Section 2 of these Procedures, the University will consult with the primary University Inventors on the proposed Mobilization of the University Research Product.
- 3.2 The University is committed to working with the University Inventors to create an appropriate plan for the Mobilization of University Research Products. ~~Similarly, however, the~~The University is also committed to ~~fulfilling the stated aims of this Policy. In order to ensure that the intentions of this Policy are not frustrated by disagreement or lack of consensus, aiding in the Mobilization of discoveries which may be of benefit to society. While~~ the University maintains the discretion to make decisions regarding the Mobilization of University Research Products that have been disclosed to the University under Section 2 of these Procedures, provided the stated aims of this Policy are not frustrated by lack of consensus, the University prefers not to exercise such discretion.

- 3.3 After consulting with the University Inventors as contemplated in Sections 3.1 and 3.2, the University may, with or without expectation of realizing any positive Net Revenue:
- (a) enter into agreements with third parties that grant such third parties the right to undertake Mobilization of University Research Products, including agreements for the sale, Public Disclosure, assignment or license of University Research Products or the grant of an option to obtain certain rights regarding University Research Products;
 - (b) contract with third parties, to assist in the Mobilization of University Research Products, such as patent agents, lawyers, accountants and other professionals and consultants;
 - (c) establish a corporation, society or other legal entity for the purpose of the Mobilization of University Research Products;
 - (d) assign or license to any third party, on terms deemed reasonable to the University but always for the purpose of Mobilization, the University's rights in University Research Products ~~to any third party on terms deemed reasonable to the University;~~ and
 - (e) utilize alternative channels, such as Global Access Principles, open source licensing, ~~patent pools~~ and science commons, to provide access to University Research Products for the benefit of society.
- 3.4 A University Inventor may request, from time to time, but not more frequently than once per fiscal year, a report on the Mobilization of University Research Products disclosed to the University by the University Inventor and upon such request the University will use reasonable efforts to respond to such request in a timely manner.
- 3.5 If a University Inventor discloses a University Research Product to the University in accordance with these Procedures and the University concludes that it will not proceed or continue with the Mobilization of such disclosed University Research Product, the University ~~may~~Inventor may request that the University assign such University Research Product to one or more University Inventors. Upon receipt of any such request, the University will assign such University Research Product to one or more of its University Inventors ~~without charge, provided that all of the University Inventors have given their consent and further provided the assignee executes an agreement which, in the sole determination of the University, makes adequate provision for the University; (subject to any existing third party rights in the University Research Product), provided that:~~
- (a) the University Inventor(s) have met their obligations under these Procedures to assist the University with the Mobilization of the disclosed University Research Product;
 - (b) all of the University Inventors have given their consent to such assignment; and

(c) the assignee(s) execute an agreement which, in the sole determination of the University, makes adequate provision for the University;

- (i) to practice the University Research ~~Products~~Product for research, clinical, educational or other non-commercial purposes;
- (ii) to be ~~adequately~~ protected and indemnified from any risks associated with the use or Mobilization of the University Research ~~Products~~Product by such assignee; and
- (iii) to address any other matters ~~which the University determines~~determined to be prudent in the circumstances.

4. Inventor Start-ups

4.1 The Mobilization of University Research Products may be undertaken by entering agreements with pre-funding or early stage ventures either founded by, having a close relationship with, or in which a financial interest is taken or will be taken by one or more University Inventors (collectively "Inventor Start-ups").

4.2 The University is supportive of efforts by University Inventors to participate in the Mobilization of University Research Products through Inventor Start-ups. However, such Inventor Start-ups may also create a conflict of commitment, an actual or potential conflict of interest, or a situation which creates a perception of a conflict of interest (collectively "Conflicts").

4.3 The University is committed to identifying and appropriately managing any such Conflicts while simultaneously supporting the appropriate entrepreneurial participation and external engagement of University Inventors. Accordingly, with respect to any negotiations or dealings with an Inventor Start-up:

(a) in recognition of their role with the University, the University will not negotiate directly with any University Inventor(s) associated with the Inventor Start-up except in exceptional circumstances; and

(b) in addition to any disclosure required of the relevant University Inventors, the University may require that any University Inventor provide assurances, to the University's satisfaction, with respect to any compensation received or to be received by a University Inventor, as further contemplated in Section 5.7 of these Procedures.

5. ~~4.~~ Distribution of Net Revenue

5.1 ~~4.1 Provided:~~ In order to create an incentive and to reward University Inventors, provided:

- (a) a University Inventor discloses a University Research Product to the University in accordance with these Procedures;
- (b) the University decides to undertake the Mobilization of such disclosed University Research Product, or any part thereof; and

- (c) the University Inventor assists the University with such Mobilization, as further set out in these Procedures,

the University will, unless otherwise provided for in these Procedures, distribute any Net Revenue received by the University from the Mobilization of the University Research Product as follows:

- (i) 50% of the Net Revenue will, subject to Sections [4.65.6](#) and [4.75.7](#) of these Procedures, be allocated among the University Inventors of the University Research Product in proportion to their relative contributions to the University Research Product which generated the Net Revenue, in accordance with Section [4.45.4](#) of these Procedures; and
- (ii) 50% of the Net Revenue will be retained by the University, out of which 25% of the Net Revenue will be allocated as general University funds and 25% of the Net Revenue will be allocated to the relevant Faculty, as identified by the University Inventor. If more than one University Inventor is involved, the portion of the Net Revenue allocated to the Faculties will be allocated *pro rata* to the relative contributions of the University Inventors.

[5.2](#) ~~4.2~~—If the University receives, as a result of the Mobilization of the University Research Product, payment in the form of shares or other securities, the distribution percentages set out in Section [4.45.1](#) of these Procedures will be used in determining the allocation of such shares or other securities between the University and the University Inventors, after adequate provision for those expenses contemplated in Net Revenue.

[5.3](#) ~~4.3~~—The portion of Net Revenue allocated to the University Inventors under Section [4.45.1\(c\)\(iii\)](#) of these Procedures will be due and payable to the University Inventors:

- (a) in the case of payments equal to or greater than \$5,000, within 60 days after the end of the fiscal quarter in which the payments were received; and
- (b) in the case of payments less than \$5,000, within 60 days after the end of the fiscal year in which the payments were received,

provided, however, that the University may withhold such amounts as it deems to be necessary to meet anticipated expenses of Mobilization, and further provided that where the Net Revenue includes shares or securities, as contemplated in Policy #105 (Acceptance, Management and Sale of Technology Licensing Equity), the distribution of shares or securities will be subject to the expiry of any hold period or other restriction on the transfer of any shares or securities included in the Net Revenue, whether imposed by agreement, legislation or otherwise.

[5.4](#) ~~4.4~~—If there is more than one University Inventor for any University Research Product for which Mobilization has been undertaken as set out in Section 3 of these Procedures, the University will require the University Inventors to determine a list of University Inventors and the allocation of

any Net Revenue among them. This allocation will be commensurate with the relative contribution made by each University Inventor to the creation, development, discovery or invention of the University Research Product. Subject to the agreement of all University Inventors, non-inventive University Persons who contributed to the University Research Product may be included in the list described in the foregoing sentence. Any dispute relating to the list of University Inventors, their relative contributions to the University Research Product or their entitlement to the Net Revenue will be determined by the University – Industry Liaison Office.

5.5 ~~4.5~~ For each University Research Product that is generating Net Revenue to be allocated to one or more University Inventors, the University will prepare an accounting of Net Revenue from time to time, but not less frequently than once per fiscal year.

5.6 ~~4.6~~ A University Inventor may waive his or her right to an allocation of Net Revenue under this Section 4.5 by filing a waiver in writing with the University-Industry Liaison Office, in the prescribed form, prior to being allocated any portion of the Net Revenue. For greater certainty, where a University Inventor has filed a waiver under this Section ~~4.6~~, 5.6, the fair market value of the Net Revenue or shares or securities, as the case may be, otherwise allocable to that University Inventor shall be retained by the University to be used at its sole discretion, and shall not form part of the Net Revenue that is allocated to the University under Section ~~4.4~~ 5.1 of these Procedures.

5.7 ~~4.7~~ If a University Inventor chooses to be directly compensated by a company receiving any rights ~~with respect~~ in relation to the Commercial Mobilization of a University Research Product, that University Inventor will not receive any portion of the Net Revenue from the Mobilization of ~~at~~ the University Research Product. In such event, the portion of the Net Revenue that would otherwise have been allocated to that University Inventor pursuant to Section ~~4.1(e)~~ 5.1 of these Procedures will be allocated to the University and the other University Inventors on a *pro rata* basis.

6. ~~5.~~ **Additional Definitions**

6.1 ~~5.1~~ “**Administrative Head of Unit**” means a Director of a service unit, a Head of an academic department, a Director of a centre, institute or school, a Principal of a college, a Dean, an Associate Vice-President, the Registrar, the University Librarian, a Vice-President or the President or the equivalent.

6.2 ~~5.2~~ “**Commercial Mobilization**” means any Mobilization which is expected, or may reasonably be expected, to result in any payments or distributions from such Mobilization.

6.3 ~~5.3~~ “**Mobilization**” means the development and implementation of a plan to maximize the impact that University Research Products or Work Products have on society and may occur by way of commercial licensing, sale, marketing, manufacturing, distribution, open source licensing, Public Disclosure, or other disposition of a University Research Product or Work

Product and/or any works, products or services covered by, claimed by, and/or incorporating a University Research Product or Work Product, as well as securing patents or other forms of protection for such University Research Products or Work Products.

6.4 ~~5.4~~ "**Non-Commercial Mobilization**" means Mobilization other than Commercial Mobilization.

6.5 ~~5.5~~ "**Net Revenue**" means the gross payments and distributions, whether by way of cash, equity holdings or otherwise, received by the University from the Mobilization of a University Research Product, less all direct and indirect expenses incurred in pursuing such Mobilization including any legal fees, patent and prototype costs, ongoing development and operational expenses, payments under any inter-institutional revenue sharing agreement, and any other amounts reasonably paid in the sole discretion of the University for any relevant purpose in connection with the Mobilization of the University Research Product. For greater certainty, any funding or reimbursement of research costs received by the University shall not form part of the gross payments upon which Net Revenue shall be calculated.

6.6 "**Principal Investigator**" means the person who has primary responsibility for a research project. In the case of a project funded by an external or internal grant, this will normally be the holder of the grant. In the case of a project that is not funded, this will normally be the initiator of the project. The Principal Investigator is usually the supervisor of the research team (which may include other researchers) and is usually a faculty member.

6.7 ~~5.6~~ "**University Inventor**" means the University Person(s) who individually or collectively created, developed, discovered or invented a University Research Product or Sponsored Research Product.

6.8 ~~5.7~~ "**University Person**" means full-time and part-time faculty members and staff members of the University and any other person who teaches, conducts research, or works at or under the auspices of the University. For greater certainty, University Persons include but are not limited to students, adjunct and clinical faculty, librarians, lecturers, post doctoral fellows, faculty on ~~sabbatical~~study leave, honorary professors, research associates, and visiting professors.

Attachment 4 - Summary of Substantive Comments Received

Comment Category	Comment	Response
<i>Freedom to pursue non-commercial mobilization and elimination of arbitrarily distinct treatment of various forms of intellectual property (“IP”) both welcome changes</i>	One respondent commented that it is illogical to attempt to treat various forms of IP distinctly (as is done in the Current Policy) and applauded the April 2012 Draft Policy for removing such arbitrary distinctions. The respondent also applauded the inclusion of provisions allowing faculty to disseminate discoveries through non-commercial means like creative commons and open source licensing.	No Change
<i>Much needed clarity regarding the scope of University rights to IP provided</i>	One respondent made this comment in support of the April 2012 Draft Policy.	No Change
<i>Clarification of treatment of certain types of non-University Research Products a welcome change</i>	A number of respondents felt that the proposed distinctions made between student inventions, sponsored research products, non-university projects, and intellectual products arising from University Research were beneficial in a number of regards, including by making it easier to recruit external sponsors for capstone courses.	No Change
<i>Policy restricts academic freedom and undermines the University mission</i>	<p>The Faculty Association (the “FA”) and a number of its members asserted that the April 2012 Draft Policy offended academic freedom. Three points were provided to support the comment:</p> <p>-----</p> <p>They express comments that the Collective Agreement¹ states that the University’s primary function is instruction and the pursuit of knowledge, whereas the April 2012 Draft Policy states instead that the primary function of the University is the “Mobilization of University Research Products with an aim to creating an efficient relationship for industry partners.”</p>	<p>-----</p> <p>The Committee notes that the opening statement of the April 2012 Draft Policy already stated that “The University is committed to the advancement and dissemination of knowledge.” However, to strengthen this statement and to avoid any confusion, the Committee has amended the proposal and suggested some revisions to the first paragraph in</p>

¹ The preamble to the Collective Agreement states both that “... the University is a community of scholars whose essential functions are the pursuit and dissemination of knowledge and understanding through research and teaching and academic freedom is essential to carrying out these functions;” and “...the members of the University enjoy certain rights and privileges essential to the fulfilment of its primary functions: instruction and the pursuit of knowledge.”

Comment Category	Comment	Response
	<p>-----</p> <p>They express concerns that the April 2012 Draft Policy seeks to restrict the dissemination of knowledge through section 5.3(a).</p> <p>-----</p> <p>They express comments that by not granting outright ownership of all IP to the faculty members who create it, “the proposed policy presents a serious threat to academic freedom.”</p> <p>-----</p>	<p>the Background & Purposes portion of the Proposed Policy.</p> <p>-----</p> <p>Section 5.3(a) of the April 2012 Draft Policy stated that a University Inventor’s non-exclusive licence to undertake Non-Commercial Mobilization of a University Research Product (as otherwise granted in section 5.3) is not applicable when the University Research Product is subject to a Sponsored Research Agreement or other agreement granting a third party rights to the University Research Product. The Proposed Policy does restrict a University Inventor’s ability to disseminate knowledge in this very specific set of circumstances. However, the Committee believes that it is reasonable to confirm that a faculty member, who carries out research supported by a third party, will honour and abide by the terms of the agreement which supported his/her research. The Committee also notes that under the Current Policy, inventors are not granted any such right to undertake Non-Commercial Mobilization, restricted or otherwise. The Committee proposes that no change be made.</p> <p>-----</p> <p>The causal connection between ownership of IP and academic freedom was not further explained nor supported in the comments provided. The Committee does not agree that ownership of IP has anything to do with academic freedom and the Committee proposes that no change be made.</p>
<p><i>Policy is inconsistent with the Bryson decision</i></p>	<p>The FA asserts that the arbitration decision known as the <i>Bryson</i> decision establishes that the FA has the exclusive authority to negotiate matters about the IP ownership of faculty in works made in the course of their employment</p>	<p>The Committee acknowledges the exclusive bargaining power of the FA. However, the <i>Bryson</i> decision does not affect the University’s ability to address IP matters by way of University Policy. The Committee proposes that no change</p>

Comment Category	Comment	Response
	and that any instrument purporting to change such ownership must be negotiated with the FA.	be made.
<i>Policy is inconsistent with the normal treatment of IP in the Canadian academic context</i>	It was suggested that the definition of University Research is overly broad and not aligned with the more commonly adopted concept that University ownership of IP isn't triggered until extraordinary use of university facilities are involved.	There are a few Universities in Canada that make a distinction between normal and extraordinary use of university resources but it is not a commonly adopted concept. The concept appears to only have been adopted by Universities that have an inventor-owned IP Policy; for the reasons stated elsewhere, the Committee has determined that the Proposed Policy should not be an inventor-owned policy. Moreover, the definition in the Proposed Policy of University Research is tied directly to the language in the <i>University Act</i> which enables the Board of Governors to require, as a term of employment, that a person assign an interest in inventions made by that person while acting within the scope of their University related duties or employment, or while using the facilities, equipment or financial aid provided by the Board of Governors. The Committee has amended the proposal to include further language from section 27 of the <i>University Act</i> in the definition of University Research in order to clarify this.
<i>IP ownership should rest with the inventor</i>	<p>The FA asserted that the typical ownership structure in Canada is either joint or sole ownership of IP by faculty.</p> <p>A number of other faculty members suggested that IP ownership should rest with the inventor. The arguments provided for doing so included:</p> <ul style="list-style-type: none"> • Not doing so will inhibit commercialization prospects and make it difficult to pursue grant funding. • It would be preferable to leave decisions about commercialization entirely in the hands of the inventor. • Doing so would make it easier for faculty to start spin-offs. 	No single ownership structure is universal. The range of IP policies adopted by Canadian universities include inventor-owned policies, university owned policies, and a variety of policies that allocate ownership jointly to inventors and the institution. The Committee notes, in contrast however, that in both the United States and the broader international context, IP policies adopted by universities are predominantly university-owned policies. The Committee has already considered the broad policy structure of the Proposed Policy and determined that an inventor-owned model is not the appropriate model to adopt. The Committee also feels that there is no basis to suggest that students and faculty

Comment Category	Comment	Response
	<ul style="list-style-type: none"> • Doing so would increase the ability to attract talented faculty and graduate students. • Doing so is the best way to translate research into practice. • Not doing so will cripple the entrepreneurial spirit of inventors and thereby suppress innovation. • Faculty inventors should be given equal rights to students and own the IP in their inventions. • The Waterloo (i.e. inventor-owned) model is the most entrepreneurial and the one to be followed. • Inventors do not want to lose control of the creative process. 	<p>either are or should be treated equally. The Committee notes that students generally pay to attend the University and faculty are in contrast under the employ of the University. The Committee proposes that no change be made.</p>
<p><i>Policy grants University ownership of every thought a faculty member has while on campus</i></p>	<p>It was suggested that the definition of University Research Product was broad enough to capture every thought a faculty member has while on University grounds, and that the mere communication of ideas via a University resource, such as UBC's learning management system, would transfer ownership of those ideas to the University.</p>	<p>While this was not the intention, the definitions of both University Research Product and Work Product have been interpreted by some to be much broader in scope than was intended. The Committee has amended the proposal to revise and clarify both definitions.</p>
<p><i>Inappropriate to negotiate Sponsored Research Agreements without involving the FA</i></p>	<p>The FA asserted that the concept of the University entering Sponsored Research Agreements granting rights in resultant IP to external parties is contrary to the labour law principle that the FA is the sole bargaining representative for faculty and that such agreements cannot be negotiated directly with faculty members.</p>	<p>The Proposed Policy does not grant the University any new or revised right to enter Sponsored Research Agreements; the University has been entering these types of agreements for many years under the Current Policy. While these agreements are always entered with the support of the relevant faculty members, the agreement is between the University and relevant sponsor. As these agreements may grant a license or other rights to the research sponsor, the Proposed Policy merely states that the University will abide by any agreement it</p>

Comment Category	Comment	Response
		has entered. To clarify that the University always consults with and garners the support of relevant faculty members prior to entering a Sponsored Research Agreement, the Committee has amended the proposal to revise section 4.1 of the Proposed Policy.
<i>Definition of Work Product is too broad</i>	Concern was raised that the definition of Work Product would catch lecture notes, syllabi, textbooks and other teaching materials. Concern was also raised that the definition of Work Product could catch non-University work product.	The definition of Work Product in the Proposed Policy is not intended to catch teaching and other scholarly materials nor is Work Product intended to catch the product of non-University activities. The Committee has amended the proposal to suggest revised language at section 6.1 of the Proposed Policy and added specific carve-outs from the definitions of both University Research Product and Work Product.
<i>University should not have discretion to make decisions over the mobilization of University Research Products</i>	<p>The FA suggested that section 3.2 of the procedures accompanying the April 2012 Draft Policy (“April 2012 Procedures”), which gives the University the discretion to make decisions about the mobilization of University Research Products which have been disclosed to the University, amounts to bullying and violates UBC’s respectful environment statement.</p> <p>Another respondent suggested that as soon as an inventor discloses an invention, they lose all influence over the mobilization of such invention and as a result the invention may be mobilized in a manner that is disagreeable to the inventor.</p> <p>One respondent suggested that in the event there is a lack of consensus about mobilization, the University should assign all rights to the creator.</p>	The Committee notes that the language found in section 3.2 of the April 2012 Procedures is very similar to language in the procedures associated with the Current Policy. The Committee feels it is important to ensure that decisions can be made whilst emphasizing the importance of engagement from inventors. The Committee has revised the proposal to include language at section 3.2 of the procedures accompanying the Proposed Policy (the “ Proposed Procedures ”) which clarifies that only in exceptional circumstances will the University exercise its discretion to mobilize inventions without the support of inventors.
<i>Policy gives greater deference to needs of industry than faculty</i>	The FA alleged that the Proposed Policy justifies the University’s ownership of University Research Products by a need to appease the desire of industry to be assured that the University holds the rights to such products.	The Proposed Policy is not intended to appease industry; rather it is intended to increase the mobilization of discoveries which may be of benefit to society. The Proposed Policy states that University

Comment Category	Comment	Response
		<p>Research Products are owned by the University because they were either discovered with the use of University resources or in the course of University related duties or employment. The consolidation of ownership facilitates the coordinated and efficient mobilization of inventions. The Committee proposes that no change be made.</p>
<p><i>Policy constrains the ability of faculty members to disseminate their research</i></p>	<p>The FA suggested that the statements in the Proposed Policy affirming the right of faculty to disseminate their research are superficial and are further constrained by a loss of control over IP through section 5.3(a) of the Proposed Policy.</p>	<p>It is not correct to say that the right to disseminate is superficial. Inventors are not required to disclose and seek to mobilize their research through the University. They are in fact encouraged to publish and have the right to undertake non-commercial Mobilization on their own as they see fit without interference from the University. The only exception to this arises if the research leading to the invention was carried out pursuant to a third party agreement; in such case the inventor must comply with the terms of the agreement. The Committee proposes that no change be made.</p>
<p><i>Mechanism for dispute resolution is not appropriate</i></p>	<p>The FA asserted that any dispute over ownership, publication or commercialization of IP should be dealt with through the grievance arbitration provisions of the Collective Agreement.</p> <p>Other respondents suggested that a third-party mechanism should be utilized to settle disputes.</p>	<p>The Board of Governors has the authority to manage the business and affairs of the University, including any IP under its control, and the Board may delegate its decision making authority to the University – Industry Liaison Office (the “UILO”) and the Vice President, Research & International. The Committee believes it is important for the Proposed Policy to enable the UILO to make decisions affecting the mobilization of University Research Products in a timely fashion in order to maximize the impact that those University Research Products may have on society. However, the Committee also believes it is important to provide a process through which University Inventors may request a review of any</p>

Comment Category	Comment	Response
		<p>determination made by UILO staff members. In attempt to clarify the intended process, the Committee has amended the proposal to include the process provided in section 1.1 of the Proposed Procedures, namely in the event one or more University Inventors dispute a determination made by the UILO staff, they may refer the matter to the Dean of the relevant Faculty and the Managing Director of the UILO who together will attempt to facilitate a resolution to the dispute. In the event the matter still cannot be resolved to the satisfaction of the parties, the matter would be referred to the Vice President, Research & International to facilitate a resolution or make any necessary determination. The Proposed Policy also allows the Vice President, Research & International to convene an expert panel to assist him or her facilitate a resolution or make any determination.</p>
<p><i>Policy should address Conflict of Interest issues</i></p>	<p>One respondent commented that the Proposed Policy should deal with conflict of interest “head-on,” while asserting that: (i) the UILO is often in a conflict of interest when promoting products of University Research; and (ii) University Researchers supervising graduate students in research areas with the potential to produce patents are inevitably in a conflict of interest.</p>	<p>The Committee notes that the University has a policy in place to comprehensively address matters relating to conflicts of interest, namely Policy #97 - Conflict of Interest and Conflict of Commitment, and that the Proposed Policy highlights Policy #97 as a related Policy. The Committee recognizes, however, that conflicts of interest arising in situations where University Inventors take an interest in a start-up venture could be better managed if more clearly identified and addressed by the Proposed Policy. Accordingly, the Committee has amended the proposal to include a new section 4 (<i>Inventor Start-ups</i>) in the Proposed Procedures to avoid situations in which University Inventors are conflicted by negotiating against the University on behalf of start-up ventures</p>

Comment Category	Comment	Response
		<p>in which they hold an interest. The Committee has also expanded the disclosure requirements mandated by the Proposed Procedures to require that University Inventors disclose, to the UILO, any interest they hold or have been promised in relation to a start-up venture that is dealing with the University.</p>
<p><i>Should create a presumption in favour of contributing back to an existing open source project</i></p>	<p>Two respondents suggested that the process provided for open sourcing Work Product only contemplates new open source projects and that the Proposed Policy should also contemplate contributions made to existing open source projects. The same respondents also suggested that the Proposed Policy should create a presumption in favour of contributing back to open source projects and require that the University justify any decision not to allow such contributions to existing open source projects.</p>	<p>The Committee agrees that the Proposed Policy should not limit open source licensing to new open source projects. However, the Committee does not agree that it is appropriate to create a presumption in favour of making contributions to open source projects nor that justification should be provided for any decision not to make such a contribution in a particular circumstance. The Committee has amended the proposal and suggested revised language at sections 6.3, 6.4 and 6.5 of the Proposed Policy.</p>
<p><i>Conflicts with policies of NSERC and other Tri-agency policies</i></p>	<p>A number of respondents suggested that the aims of the Proposed Policy should match the aims of NSERC by prioritizing the realization of benefits to Canada.</p> <p>One of the respondents further contends that SSHRC's IP policy requires researchers to retain ownership of IP and as such it is in direct conflict with the Proposed Policy because the Proposed Policy contemplates that Sponsored Research Agreements might grant ownership of IP to sponsors.</p>	<p>As one of the world's leading universities, the University creates an exceptional learning environment that fosters global citizenship, advances a civil and sustainable society, and supports outstanding research to serve the people of British Columbia, Canada and the world. The University's vision is not restricted to Canada and thus the University aims to serve British Columbia, Canada and the world.</p> <p>The Committee notes that SSHRC's Policy on Intellectual Property and Copyright states as follows:</p> <p><i>Copyright and any rights to intellectual property developed under SSHRC funding are owned by the</i></p>

Comment Category	Comment	Response
		<p><i>applicant (principal investigators) and co-applicants (co-investigators) or by the postsecondary institution or organization, depending on intellectual property agreements as defined by the postsecondary institution or organization where the grant holder is employed. SSHRC does not retain or own any membership or exploration rights to any such intellectual property.</i></p> <p>There is an onus on researchers to ensure that any Sponsored Research Agreement entered is compatible with relevant funding agreements but the two are not necessarily in conflict and any conflict that does arise is not a result of the Proposed Policy.</p> <p>As noted above, the Committee has revised the proposal and recommended some revisions to the Background & Purposes section of the Proposed Policy, to clarify that the University wishes to maximize the benefit of discoveries on society and to further clarify that earning revenue from a discovery is not a significant factor for the University.</p>
<p><i>Student Academic Product definition should account for continuing education and non-credit students</i></p>	<p>One respondent suggested that academic product could also be generated by continuing education or non-credit students.</p>	<p>Agreed. The Committee has suggested revisions to the definition of Student Academic Product and corresponding revisions to the definition of University Research.</p>
<p><i>Policy allows transfer of patent rights to patent trolls</i></p>	<p>One respondent suggested the language in s.3.3(d) of the April 2012 Procedures enables the University to transfer University Research Products to any third-party including non-practicing entities which are commonly described as patent trolls.</p>	<p>Agreed. The Committee has amended section 3.3(d) of the Proposed Procedures to clarify that the transfer of rights permitted by such section will always be done for the purposes of mobilization.</p>

Comment Category	Comment	Response
<i>Policy does not set clear timeframes within which UILO must respond</i>	Two respondents suggested adding clear timeframes within which the University must assess and return the rights in any disclosed University Research Product to the inventor.	The Committee agrees that setting performance expectations are in principle a good idea and thus has revised the proposal at Section 2.5 of the Proposed Procedures to stipulate that the UILO will respond to University Inventors within ninety days.
<i>Students should own all IP they generate</i>	One respondent believes that students should always own the IP they develop whether such IP arises from course work or research.	The Proposed Policy already leaves the ownership of IP with students in most cases. Only in situations where it is impractical or inappropriate to do so does the Proposed Policy catch student contributions in University Research Product (e.g. in situations where a Sponsored Research Agreement requires that IP be licensed to a third party). The Committee proposes that no change be made.
<i>Policy contains poorly worded definition of IP</i>	One respondent took issue with the reference to know-how in the definition of University Research Product.	As noted elsewhere, the Committee has amended the proposal and suggested that the definition of University Research Product be amended. The definition of University Research Product now refers to the new definition of Invention which restricts know-how to proprietary know-how.
<i>Policy is not practical for film production</i>	One respondent explained that a filmmaker must control the IP in his/her works in order to raise the funding to make the films and ensure they reach a wider audience.	The Proposed Policy is not intended to transfer the ownership of IP in teaching and other scholarly materials to the University and accordingly the Committee has amended the proposal and suggested revisions to the definitions of both University Research Product and Work Product to exclude teaching materials, including other dramatic works or writings that are scholarly in nature.
<i>University Research Product should not include compilations of data</i>	One respondent saw this concept as particularly troubling for First Nations who work with University researchers to collect language data.	The Committee notes that University Policy does not purport to affect the rights of First Nations; rather it only

Comment Category	Comment	Response
		<p>addresses the allocation of rights between faculty, staff, students and other University Persons. The Committee also notes that the Proposed Policy encourages University Persons to disclose and publish the results of their research unless they are restricted from doing so by an agreement that supported their research. The Committee further notes that the University's ownership of University Research Products (as effected by the Proposed Policy) enables the University to make arrangements with third parties, such as First Nation groups, with respect to the use and treatment of certain University Research Products. The Committee proposes that no change be made.</p>
<p><i>Definition of Public Disclosure is too weak and ownership of theses or dissertations is not clear</i></p>	<p>One respondent noted that the definition will not drive all graduating masters and doctoral students to make their thesis/dissertation publicly available through the library repository. The same respondent also suggested the Proposed Policy state more clearly where theses and dissertations are captured.</p>	<p>The Committee notes that the Proposed Policy is not intended to compel graduating masters or doctoral students to deposit their theses or dissertations with the library repository. The Committee has, however, revised the proposal to clarify that the definition of Public Disclosure includes disclosure through public presentations such as the public examination of a thesis. As explained above, the Committee has also revised the proposal to clarify the definition of Student Academic Product and to specifically exclude scholarly writings from the definitions of University Research Product and Work Product. As a result, the Committee believes that the Proposed Policy is now clear that the text of a thesis would not be a University Research Product but that to the extent any thesis includes an Invention that is discovered through University Research, such Invention could be a University Research Product.</p>

Comment Category	Comment	Response
<i>While the proposed policy is a step in the right direction, the “entire ecosystem” must be brought into alignment</i>	One respondent suggested that compensation and incentive systems should be altered to support the Proposed Policy.	As this is not a comment on the Proposed Policy itself, the suggestion has been forwarded to the Office of the Vice President, Research & International for consideration.
<i>Potential for tension between non-commercial and commercial rights</i>	One respondent cited drug access as a potential field where such conflict could emerge and recommended that the statement in section 1.1 of the Proposed Policy, asserting an inventor’s right to publish, be prefaced with patentability considerations.	Agreed. The Committee has amended the proposal and suggested revised language at section 1.1 of the Proposed Policy. The Committee also notes that the Proposed Policy makes both a University Inventor’s right to publish or disclose the results of University Research and a University Inventor’s license to undertake Non-Commercial Mobilization of a University Research Product, subject to applicable Sponsored Research Agreements.
<i>Add notice requirements to s. 2.1(c) and 5.1(c) of policy</i>	One respondent suggested that both referenced sections of the April 2012 Draft Policy would benefit from the addition of a written notice requirement to ensure that students are aware when they are working on University Research and consequently that their work will not be treated as Student Academic Product.	The Committee notes that Policy #85 – Scholarly Integrity already requires that the research conditions for all involved in a research team be outlined in a letter from the Principal Investigator before team members become engaged. The Committee recommends that no revision be made.
<i>Non-Commercial Mobilization not defined</i>	One respondent commented that Non-Commercial Mobilization is referenced at section 5.3 of the April 2012 Draft Policy but not defined	The Committee notes that Non-Commercial Mobilization is defined at section 5.4 of the Proposed Procedures to mean “Mobilization other than Commercial Mobilization.” The Committee proposes that no revision be made.
<i>Strategic intent of the policy should be supplemented and fundamental IP management issues addressed</i>	The Premier’s Technology Council (“PTC”) suggested that some revisions be made to the stated aims of the Proposed Policy. The PTC also expressed a desire for the University to engage with the PTC to build an approach to IP management and commercialization incorporating new practices in relation to University inventions.	The Committee agrees with the recommendation to revise the stated aims of the Proposed Policy and has thus amended the proposal to include some revisions to the Background & Purposes section of the Proposed Policy. As the remaining comments provided by the PTC are not directed at the Proposed

Comment Category	Comment	Response
		Policy itself, the Committee has forwarded these additional comments to the Office of the Vice President, Research & International for consideration.