



**The University of British Columbia
Board of Governors**

Policy No.:

88

Approval Date:

June 2013

Responsible Executive:

Vice-President Research & International

Title:

Inventions and Discoveries

Background & Purposes:

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.

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.

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.

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.

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 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: June 2013

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.