

UNIVERSITY OF MANITOBA POLICY

Policy:	INTELLECTUAL PROPERTY
Effective Date:	March 16, 2010
Revised Date:	October 1, 2013
Review Date:	March 16, 2020
Approving Body:	Board of Governors
Authority:	<i>The University of Manitoba Act</i>
Responsible Executive Officers:	Vice-President (Research and International) and Vice-President (Administration) □
Delegate:	Vice-President (Research and International)
Contact:	Vice-President (Research and International)
Application:	Students; External Parties (Individuals with adjunct appointments, nil-salaried appointments, senior scholars, professor emeriti and/or retirees); Employees (all employment groups except UMFA members).

Part I Reason for Policy

- 1.1 To advance objectives that facilitate the creation, use, dissemination and Commercialization of Intellectual Property through a supportive framework that is reflective of the University culture and balances the interests of the University and University Members by establishing a framework to determine:
- (a) the ownership of and rights to use Intellectual Property written or created by a University Member in the course of University related activities and/or through the use of University Resources;
 - (b) the rights and obligations with respect to the Commercialization of Intellectual Property written or created by a University Member in the course of University related activities and/or through the use of University Resources; and
 - (c) the sharing of Net Revenues arising from Intellectual Property written or created by a University Member in the course of University related activities and/or through the use of University Resources.
- 1.2 The objectives of the Policy are:

- (a) To encourage creativity and innovation within the University community.
- (b) To set forth the respective rights and obligations of the University and University Members with respect to Intellectual Property;
- (c) To encourage the transfer of knowledge for the social and economic benefit of society, including by the publication of Works and Commercialization of Other Intellectual Property; and
- (d) To provide for the equitable sharing of revenues between the University and University Member arising from the dissemination, publication and Commercialization of Intellectual Property, recognizing the contributions of each.

Part II Policy Content

Introduction

- 2.1 The University's primary mission is to create, preserve and communicate knowledge.
- 2.2 Intellectual Property is the product of a cooperative relationship between the University and University Member(s) that is derived from the creative energies of University Member(s) fostered by the academic community and University environment, including resources provided by the University.
- 2.3 The University recognizes it has an important role in the creation, preservation, use and dissemination of Intellectual Property, and where appropriate, encouraging the application of Intellectual Property in tangible ways, including through Commercialization.

Definitions

- 2.4 The following terms have the following defined meanings for the purpose of this Policy and its Procedures:
 - (a) **Commercialization** or **Commercialize** means a complex of activities with the goal of financial return.
 - (b) **Copyright** means the rights described in the *Copyright Act* (Canada), as amended from time to time.
 - (c) **Direct Costs** means the reasonable costs and fees (including, but not limited to, legal fees and agents' fees) associated with the acquisition, management and Commercialization of Other Intellectual Property, including costs of evaluating it, obtaining and maintaining intellectual property protection, preventing unauthorized use or infringement,

prototype development funds, negotiating and implementing licences or other agreements with third parties.

- (d) **Intellectual Property** means Works or Other Intellectual Property.
- (e) **Moral Rights** means the rights described in the *Copyright Act* (Canada), as amended from time to time.
- (f) **Net Revenue** means the amount received with respect to the University Member's contribution to Other Intellectual Property from Commercialization of the Other Intellectual Property (by the University Member if Commercialized by the University Member or by the University if Commercialized by the University), less Direct Costs (which may be amortized to correspond with the recognition of gross revenue) incurred in Commercialization, and includes but is not limited to, proceeds from royalties, profit-sharing, lump sum payments and sale of equity shares in connection with Other Intellectual Property.
- (g) **Other Intellectual Property** means any result of intellectual activity that can be owned by a person (excluding Works) and includes, without limitation, inventions (whether or not patentable), industrial designs, trademarks and integrated circuit topographies, as those terms are defined by applicable legislation and includes Software.
- (h) **Software** means any set of instructions that is expressed, fixed, embodied or stored in any manner that can be used directly or indirectly in a computer to bring about a specific result.
- (i) University Member means:
 - (i) an individual who falls into one of the categories defined in the University's Employee Organizations and Employment Group Procedures), except an UMFA member;
 - (ii) a part-time or full-time, undergraduate or graduate student;
 - (iii) a post-doctoral fellow;
 - (iv) a nil salaried or adjunct appointee; and
 - (v) a professor emeritus(a), a senior scholar, or a retiree;
- (j) **University Resources** means the University's physical structures, research laboratories, capital equipment, technical facilities, services, funds and human resources. University services include the administration of funds and support received by the University in the form of grants, contracts or other support provided by the University or external sponsors.

- (k) **Works** means all original literary, dramatic, musical and artistic works, performances, communication signals and sound recordings capable of Copyright protection under the Copyright Act (Canada), with the exception of Software.

Scope

- 2.5 This Policy applies to all Intellectual Property written or created by a University Member in the course of University related activities and/or through the use of University Resources.

Ownership of Copyright in Works

- 2.6 Subject to 2.7 and 2.8, the University Member shall be the owner of Copyright in Works written or created by the University Member.

Exceptions – University Ownership

- 2.7 Notwithstanding 2.6, the University owns Copyright in Works written or created by a University Member:
- (a) in the course of employment. Works written or created "in the course of employment" include, without limitation, Works that are written or created by the University Member pursuant to:
 - (i) the direction of a supervisor;
 - (ii) the provisions incorporated within a job description or employment agreement; or
 - (iii) the performance of any administrative duty;
 - (b) resulting from the performance of a written agreement between the University and University Member in which the University and University Member have agreed to the University's ownership;
 - (c) resulting from an additional appointment beyond the University Member's normal workload for which the University Member receives compensation in addition to his/her base salary rate pursuant to a written agreement; or
 - (d) that the University Member has voluntarily assigned to the University.

Exceptions – General

- 2.8 Notwithstanding 2.6 and subject to 2.7, Works written or created by a University Member in the following situations are not owned solely by the University Member, and may be owned by the University, a third party, or jointly by two or more parties as the case may be:

- (a) the University may own or have a licence to use Works created as a result of an agreement between the University and University Member where the Work results from the University's contribution of special resources, such as a release of time from regular assigned duties, use of University funds, or substantial use of University Resources;
- (b) the University and/or a third party may own or have a licence to use Works written or created as a result of a written agreement with a third party, for example a research agreement or service agreement, wherein copyright ownership and use is determined by the specific terms of the agreement; or
- (c) ownership of Software shall be determined by the provisions of 2.16 (Other Intellectual Property).

Licence to the University

2.9 The University is automatically granted a royalty-free, indivisible, irrevocable and perpetual right to use Works written or created by a University Member in the course of University related activities and/or through the use of University Resources for non-commercial, archival, administrative, research and/or educational purposes. For the purposes of this section "educational purposes" includes research carried on at the University by University Members and teaching by University Members to students registered at the University.

Licence to the University Member

2.10 Where the University owns Copyright in a Work pursuant to 2.7 or 2.8, the University Member who wrote or created the Work shall have a royalty-free, perpetual right to use the Work for non-commercial, research and/or educational purposes. The University Member shall not give access to the Work to another party without the University's prior written consent.

Student and Theses

2.11 Notwithstanding any provision in this Policy, and subject to the rights of a student to assign any Work owned exclusively by him/her, any Work created exclusively by a student in the course of completing the requirements for an academic degree or certificate is owned by the student, to the extent that the Work comprises part of the requirements for the degree or certificate. Nothing in this Policy shall preclude a student from publishing his/her thesis in any form at any time. In this Policy, "Works" does not include raw data unless it is organized or expressed in an original format. Prior to commencing research required for an academic degree or certificate, students who are not employed by the University in connection with that research shall enter into an agreement, with their supervisor(s), in a form approved by the University, which will contemplate authorship and access to and use of raw data arising from the research.

Moral Rights

2.12 Where the University owns Copyright in a Work pursuant to 2.7, the University Member who wrote or created the Work automatically waives all Moral Rights in the Work.

Publication

2.13 The University Member is not required to disclose to the University his or her intention to publish or disseminate a Work owned by the University Member. Similarly, the University is not required to disclose to the University Member its intention to publish or disseminate a Work owned by the University.

Revenue Sharing

2.14 Subject to 2.15, the University Member shall be entitled to the revenue earned from Commercialization, publication or dissemination of a Work owned by the University Member. Similarly, the University shall be entitled to revenue earned from Commercialization, publication or dissemination of a Work owned by the University.

Agreement to Share Revenue and/or Costs

2.15 Notwithstanding 2.14, the University and University Member may enter into an agreement to allow for the sharing of revenue and/or recovery of costs incurred by the University arising from the provision of University funds, services, facilities, support and/or technical personnel to the University Member above and beyond the University Resources normally provided to University Members for the creation or Commercialization of a Work.

Other Intellectual Property

Joint Ownership of Other Intellectual Property

2.16 Subject to 2.17 and 2.18, the University and University Member shall jointly own Other Intellectual Property that is created by the University Member in the course of University related activities and/or through the use of University Resources.

Exceptions – University Ownership

2.17 Notwithstanding 2.16, the University owns Other Intellectual Property created by a University Member:

- (a) in the course of employment. Other Intellectual Property created "in the course of employment" includes, without limitation, Other Intellectual Property that is created by the University Member pursuant to:
 - (i) the direction of a supervisor;

- (ii) the provisions incorporated within a job description or employment agreement; or
- (iii) the performance of any administrative duty;
- (b) resulting from the performance of a written agreement between the University Member and the University in which the University Member and the University have agreed to the University's ownership;
- (c) resulting from an additional appointment beyond the University Member's normal workload for which the University Member receives compensation in addition to his/her base salary rate pursuant to a written agreement; or
- (d) that the University Member has voluntarily assigned to the University.\

Exceptions – General

2.18 Notwithstanding 2.16 and subject to 2.17, Other Intellectual Property created in the following situations are not owned jointly by the University Member and the University, and may be owned by the University, a third party, or jointly by two or more parties as the case may be:

- (a) the University may own or have a licence to use Other Intellectual Property created as a result of an agreement between the University and University Member;
- (b) the University and/or a third party may own or have a licence to use Other Intellectual Property created as a result of a written agreement with a third party, for example, a research agreement or service agreement, wherein ownership is determined by the specific terms of the agreement.

Nil Salaried or Adjunct Appointees with Appointments or Associations With Other Institutions or Organizations

2.19 Subject to section 2.18, if Other Intellectual Property is developed or created by a nil salaried or adjunct appointee, and that Other Intellectual Property can be attributed to the University Member's association with the University due to factors which may include, but are not limited to:

- (a) the involvement of a full or part time graduate or undergraduate student of the University;
- (b) a research agreement entered into or grant received by the University as a result of the University Member's association with the University; and/or
- (c) the use of University funds, University Resources and/or University services;

the provisions of this Policy will apply in all respects including Other Intellectual Property ownership and revenue sharing provisions.

Exception – Software

2.20 Notwithstanding 2.16 and subject to 2.17 and 2.18, the following categories of Software are owned by the University Member who created the Software:

- (a) where limited to the electronic form of a Work, or where it is ancillary to a Work; and
- (b) works of art, including works of art expressed in multimedia format.

No Obligation to Commercialize Other Intellectual Property

2.21 Neither the University Member nor the University shall have an obligation to Commercialize Other Intellectual Property. University Members have no obligation to modify research to enhance the potential for Commercialization.

Disclosure of Intent to Commercialize

2.22 University Members must disclose to the University their intention to Commercialize Other Intellectual Property, whether or not they choose to involve the University in the Commercialization process. The University agrees to keep all such information confidential and not to disclose such information externally, except with the prior written consent of the University Member. Disclosure is required for a number of reasons, including but not limited to the University's responsibility to be accountable to the government and the public; possible University obligations to third parties, for example with respect to Other Intellectual Property resulting from a research agreement or service agreement; the University's desire to exercise its right to share Net Revenue earned from Commercialization; and the University's desire to offer its Commercialization services.

Commercialization Independent of the University

2.23 University Members may Commercialize jointly owned Other Intellectual Property independent of the University, subject to any rights granted to a third party pursuant to a written agreement and/or the right of the University to revenue sharing pursuant to 2.25.

Commercialization by the University

2.24 Should the University Member request the services of the University to Commercialize jointly owned Other Intellectual Property, the University will advise the University Member within a reasonable time whether the University wishes to pursue Commercialization. If the University declines, the University Member may pursue Commercialization independent of the University, subject to the right of the University to revenue sharing pursuant to 2.25. If the University

decides to proceed with Commercialization, the University Member shall make an assignment to the University of all his/her rights in the Other Intellectual Property and the University shall commence Commercialization activities. If the University decides to no longer pursue Commercialization, it shall immediately notify the University Member and will assign its rights back to the University Member, if so requested by the University Member. In such event, the University Member is free to pursue Commercialization independent of the University, subject to the right of the University to revenue sharing and recovery of Direct Costs under 2.25.

Revenue Sharing

2.25 Net Revenue earned from Commercialization of Other Intellectual Property shall be shared between the University Member and University as follows:

- (a) fifty (50%) percent to the University Member(s) and/or other individuals who created the Other Intellectual Property; and
- (b) fifty (50%) percent to the University;

whether or not the University services are used to Commercialize the Other Intellectual Property. Direct Costs shall first be paid to the University and/or University Member, as the case may be, who incurred the Direct Costs in direct proportion to the amount of Direct Costs incurred. Where there is more than one University Member and/or other individual(s) who created the Other Intellectual Property, the University's share of the Net Revenue shall remain fifty (50%) percent and the other fifty (50%) percent shall be divided equally among the other contributing University Members and/or other individuals, or as otherwise determined by written agreement between all the contributing University Members and/or other individuals. Where there is a written agreement between the University Members and/or other individuals which provides for a different distribution of their share of Net Revenue, the University Members shall provide the University with a copy of said written agreement. The University's share of Net Revenue may be shared with other Institutions or Organizations pursuant to an agreement between them.

University Licence

2.26 The University is automatically granted a royalty-free, irrevocable, indivisible and non-transferable licence to any patented device, equipment, improvement, design, development or process arising from Other Intellectual Property created by the University Member solely for the University's internal, non-commercial use. This licence does not imply a right to transfer, licence or Commercialize such Other Intellectual Property, except as provided for in this Policy.

University and University Member Licence to Jointly Owned Other Intellectual Property

2.27 Each of the University and University Member shall have a royalty-free, perpetual right to use jointly owned Other Intellectual Property for internal, non-commercial and/or educational purposes, subject to any assignment, licence or abrogation of ownership. For the purpose of this section “educational purposes” includes research carried on at the University by University Members and teaching by University Members to students registered at the University.

Dispute Resolution

Disagreements Among University Members

2.28 If a dispute arises between or among University Members regarding their relative contributions to the creation of Works or Other Intellectual Property and this cannot be settled by the University Members involved, the advice and assistance of the individuals' Department Head or administrative equivalent shall be sought. If the dispute cannot be resolved at that level, it shall be referred to the Faculty Dean, or in the case of a dispute involving a graduate student, the Dean of the Faculty of Graduate Studies, for resolution. If the dispute cannot be resolved by these informal means, the University will assist in resolving the dispute through a mediator appointed by the Vice-President (Research).

Disagreements Between the University and University Member(s)

2.29 If a dispute arises between the University and a University Member with respect to the application of this Policy, formal procedures will be followed according to the provisions of the appropriate collective agreement. If the University Member is not covered by collective agreement, a form of arbitration agreement to both parties, or where they cannot agree, in accordance with The Arbitration Act of Manitoba.

Part III Accountability

3.1 The Office of Legal Counsel is responsible for advising the Responsible Executive Officers that a formal review of this Policy is required.

3.2 The Vice-President (Research and International) is responsible for the implementation, administration and review of this Policy.

3.3 Students, External Parties (Individuals with adjunct appointments, nil-salaried appointments, senior scholars, professor emeriti and/or retirees), and Employees (all employment groups except UMFA members) are responsible for complying with this Policy.

Part IV
Authority to Approve Procedures

- 4.1 The Approving Body may approve Procedures, if applicable, which are secondary to and comply with this Policy.

Part V
Review

- 5.1 Governing Document reviews shall be conducted every ten (10) years by the Responsible Executive Officers. The next scheduled review date for this Policy is March 16, 2020.
- 5.2 In the interim, this Policy may be revised or repealed if:
- (a) the Responsible Executive Officers or Approving Body deems it necessary or desirable to do so;
 - (b) the Policy is no longer legislatively or statutorily compliant; and/or
 - (c) the Policy is now in conflict with another Governing Document.
- 5.3 If this Policy is revised or repealed, all Secondary Documents will be reviewed as soon as reasonably possible in order to ensure that they:
- (a) comply with the revised Policy; or
 - (b) are in turn repealed.

Part VI
Effect on Previous Statements

- 6.1 This Policy supersedes all of the following:
- (a) Policy: Patents and Copyrights;
 - (b) all previous Board of Governors/Senate Governing Documents on the subject matter contained herein; and
 - (c) all previous Administration Governing Documents on the subject matter contained herein.

Part VII
Cross References

7.1 This Policy should be cross referenced to the following relevant Governing Documents, legislation and/or forms:

- (a) [Policy: Research Agreements](#)