



SIMON FRASER UNIVERSITY
Policies and Procedures

Date
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Number
R 30.03

Revision Date

Revision No.

Intellectual Property Policy

1.0 Purpose

1.1 To provide an incentive for intellectu- in- TTct(i)6.4 (nn)-0.8 (ce)4.4 (0tu)-lecct8 (ce)4.1

expenses (which may be carried forward from year to year to offset gross revenue) incurred in the Commercialization, and includes, without limitation, proceeds from royalties, profit -sharing, lump sum payments, and sale of equity shares, but does not include the financing of research projects sponsored by a partner as part of a continuing program of colla

4.0 Applicability

4.1 This Policy applies to all University Members, including employees and other individuals, students, post-doctoral fellows and research grant employees, affiliated with the University who use facilities, resources or funds administered by the University in the course of University-related scholarly and creative activities.

4.2 This Policy does not apply to IP created in the course of non-University activities that do not make use of facilities, resources or funds administered by the University, for example outside employment or other activity in an area unrelated to University activities, or activity conducted wholly while on an unpaid leave of absence away from the University.

4.3 This Policy does not apply to IP created by individuals not affiliated with the University but whose IP is used by University Members.

4.4 Other University Policies that are relevant to this Policy are the Policy on External Research Grants and Contracts (R10.01), the Code of Ethics (A30.01), the Policy on Service Contracts (AD 313), the Policy on Outside Activities (A30.04) and the Policy on University Trade Marks (GP 28).

5.0 Ownership

5.1 Although the University has the right to require assignment of an interest in IP created by a University Member through the use of its resources, the full ownership of IP and all rights pertaining to ownership are vested in the Creator, unless the Creator has entered into an agreement with the University to the contrary. The following exceptions apply:

5.1.1 The University owns IP resulting from work specifically requested of a University Member by the University pursuant to a written contract of employment. This includes information brochures, commissioned studies or descriptive handbooks, whose production has been initiated at the request of the University.

5.1.2 The University owns IP resulting from the performance of a written contract for service, an agreement or commission in which the University and the Creator have agreed to the University's ownership. This may include products prepared for distance education and/or continuing education courses and purchased outright by the University; and other types of teaching or research-related materials, production of which is initiated at the request of the University. The Creator of products prepared for distance education and/or continuing education courses may request the consent of the University to use agreed extracts from the written or recorded materials for other purposes, including the preparation of textbooks. Ownership of the resultant products shall be determined by negotiation between the University and the Creator.

5.1.3 The University or a sponsoring agency owns the rights to IP developed in the course of sponsored research pursuant to a written contract.

5.2 The University specifically acknowledges that the substance of a lecture, whether delivered in the classroom or via other means, belongs to the Creator (in this case the lecturer) and that records of such lectures do not constitute IP under the terms of this Policy. The University will distribute records of such material to University Library cardholders only with the permission of their Creator.

5.3 The University specifically acknowledges that IP created in the form of a textbook, instructional website, or other instructional material developed as part of the normal course teaching activities of a faculty member is owned by the Creator.

5.4 The University specifically acknowledges that IP created exclusively by a student Creator in the course of completing the requirements for an academic degree or certificate is owned by the student Creator, to the extent that the IP comprises part of the requirements for the degree or certificate. In order to qualify under this paragraph, the student and the supervising faculty member

5.5 The Creator of IP may voluntarily assign or transfer any interest in the IP to the University. The

7.4 In accordance with the University Trade -mark Policy (GP -28), Creators must consult with and obtain the approval of the University (via the IE) before using the University's name , crest, facilities or resources in connection with any commercial arrangement.

8.0 Commercialization Procedures

8.1 Detailed Procedures will be found in Appendix B to this Policy.

8.2 A Creator who elects to Commercialize his/her IP must disclose such election in writing, as appropriate, to the Chair/Director of the Department/School (for faculty members – see the exception to this in the next S.6 ()0tt.225 0 h.8 (glA)6.4 (o)1 Td [(e0.8 (i)6.4 (s/4.4 () .9 (to)1.9 (S.6r6.4 (l)6.9 (o)-2.d [(ef.9 (S.6r6.44)-4

Creator will conclude a Revenue-sharing agreement. Appendix A will be used to determine equitable Revenue sharing between the University and the Creator.

9.5 For the purposes of determining Revenue, either the University or the Creator may require the other to provide an accounting of all funds received and expenses incurred with regard to IP covered by this Policy.

9.6 Speakers' honoraria, reimbursement of travel expenses or out-of-pocket expenses, and similar payments received by the Creator in the course of the normal dissemination of knowledge are not considered Revenue for the purposes of this Policy.

10.0 Use of University's Revenues

10.1 The University's share of Revenue from Commercialization of IP shall be administered under the authority of the Vice-President, Research and shall be used to further Commercialization of University IP.

11.0 Implementation

11.1 The Vice-President, Research has executive responsibility for implementing this Policy and will be the final decision authority on behalf of the University for any commercialization agreements entered into under this Policy.

11.2 IP that was created prior to the approval of this Policy will be subject to the Policies in place at the time of the creation of the IP ("Patent Policy" - R30.02 and "Copyright Policy" - R30.01).

12.0 Resolution of Disputes

12.1 If a dispute arises among Creators regarding their relative contributions to the creation of IP and this cannot be settled by the individuals involved, the advice and assistance of the Faculty Dean or administrative equivalent should be sought.

12.2 Disputes between the Creator(s) and the University regarding the provisions of this Policy which cannot be resolved through informal consultation will be decided with reference to the formal procedures outlined in the appropriate agreement between the relevant employee group and the University, or the appropriate set of University Policies or regulations governing the University

APPENDIX A

Intellectual Property Policy Revenue-Sharing Agreements

The following approaches to Revenue sharing with the University will be used to determine equitable distribution of Revenue, taking into consideration the normal use of University resources and any additional financial or other contributions by the University to the Commercialization endeavour. Dollar values below may be revised from time to time by the Office of the Vice President, Research to apply to subsequent Revenue-sharing agreements. Exceptions may be made, under the authority of the Vice President, Research, based on above-normal or below-normal use of University resources and additional financial or other contributions.

- A. If the Creator retains ownership of the IP and does not request the assistance of the University in Commercializing the IP, the University will normally receive 15% of additional annual Revenues received by each of the Creator(s), after \$25,000 in annual Revenue has been received by that Creator, based on the provision of general University resources and facilities including (possibly) minor IE staff assistance; assignment of the IP is not required.

OR

- B. If the Creator(s) requests assistance of the University in Commercializing the IP and the University agrees to assist, then - after the Direct Costs of Commercialization are repaid from Revenue shared on a 50:50 basis - the University will normally retain 30% of annual Revenue.

OR

- C. If the Creator requests assistance of the University in Commercializing the IP and the University declines to assist, or the University abandons the Commercialization of the IP and assigns the IP back to the Creator pursuant to Section 8.7, the University will normally receive 5% of additional annual Revenues after the first \$100,000 in annual Revenue has been received by each of the Creator(s), based on the provision of general University resources and facilities including (possibly) minor IE staff assistance; assignment of the IP is not required.

In the case of joint Creators, the above annual "threshold" amount before which Revenue is shared applies to each Creator separately.

APPENDIX B

Intellectual Property Policy Commercialization Procedures

1. A Creator who elects to Commercialize his/her IP must disclose such election in writing, as follows:
 - 1.1 Faculty members: to the Chair/Director of the Department/School
 - 1.2 Librarians: to the University Librarian
 - 1.3 Other employees: to the Director of the Unit
 - 1.4 Students: to the faculty Supervisor or Chair/Director of the Department/School
2. Disclosure will use the Intellectual Property Disclosure Form, Appendix C to this Policy. It is available online (see appendix C) or at the IE in Discovery 2, Room 230, MTF on the Burnaby campus, at the TIME Centre at the Harbour Centre campus, or at the IE on the Surrey campus. See Section 4 below for possible exception relevant to faculty members.
3. The recipient of the Disclosure Form (as above) will then forward the information to the IE for consideration by the Vice President, Research.
4. A faculty member who wishes to Commercialize his/her IP without the assistance of the University may make disclosure via the annual reporting that is required under Outside Activities Policy A 30.04. In this case, the information will be conveyed to the Vice President, Research by the office of the Vice President, Academic.

5. The Vice -President, Research, in consultation with the Office of Research Services and the IE, will determine whether the research or activity connected with the IP involves any specific obligations, patent or otherwise, to an external sponsor or to the University.
6. If the Vice -President, Research determines that the IP rights do not belong exclusively to any external agency or to the University, he/she will inform the Creator of this and of the University's services regarding Commercialization of IP. Services are provided primarily via the IE and include but are not limited to:
 - 6.1 Assessment of the potential for Commercialization of the IP;
 - 6.2 Assessment of opportunities, risk and responsibilities related to Commercialization;
 - 6.3 Advising on Commercialization partnerships and pathways;
 - 6.4 Partnering researchers with industry and government for collaborative research and development;
 - 6.5 Providing advice on and support for IP protection;
 - 6.6 Funding prototype development;
 - 6.7 Identifying funding partners to Commercialize university technologies;
 - 6.8 Assisting with the creation of new ventures through advice on business planning, legal matters and capital acquisition.
7. The Creator may then choose to pursue Commercialization alone, may request the University's assistance in Commercializing, or may decide not to proceed with Commercialization.
8. Should the Creator choose to request University assistance in Commercialization, the Vice President, Research will determine within two months of receiving such a request whether an investment of University resources such as those described above is warranted by the probabilities for successful Commercialization.
9. If the Vice -President, Research decides that the University should proceed, the Creator will be required to make an assignment to the University of all rights in and to the IP concomitant with concluding a Revenue -sharing agreement. Appendix A to this Policy will apply to the Revenue sharing agreement. Creators are encouraged to have their own lawyer review the written agreement prior to conclusion.
- 10.

In Part B of this form, there are detailed questions about the IP, prior art, and the potential commercial applications. It may be difficult to provide a full answer for each section at this point, but please do all you can. For many of the questions, it is appropriate to answer using point form format.

Please feel free to attach additional pages and/or expand the areas within this MSWord document to meet your needs. The IE staff will also be happy to clarify the information specifically required in each section. Alternatively, you may wish to meet with an IE Technology Manager prior to completing this document; in most cases, this is the route by which the IE prefers to receive disclosures from Creators – the IE and the Creator can work together to complete this Disclosure form.

Information provided on Part A of this form will be used for statistical purposes and will not be disclosed in any form that will identify the Creator(s) or any aspect of the IP without their written, prior permission. Information provided on Part B of this form will be used to assist with the commercialization of the IP and will not be disclosed in any form that will identify the Creator(s) or any aspect of the IP without their written, prior permission.

Any questions can be directed to the IE at our general office number 778- 782- 4292 (fax: 778- 782- 3477), via email to sfuie@sfu.ca, or by contacting an IE staff member directly.