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Patent Policy

Office of Administrative Responsibility:	Office of the Vice-President (Research)
Office of Accountability:	Office of the Vice-President (Research)
Approving Authority:	The Governors of the University of Alberta

Purpose

The broad mandate of the University of Alberta is to create, preserve and disseminate knowledge for the benefit of all Canadians. The creation of knowledge results from bringing together the intellectual and creative resources of the faculty, researchers, students, staff and other members of the University Community.

Those who are part of the University community are the beneficiaries of public resources and share in the commitment of the University to effectively disseminate this knowledge to society.

As such, the transfer and **Commercialization** of new **Patentable Intellectual Property (PIP)** is important. The efficient protection, commercialization and capitalization of PIP are important elements in maintaining the University's reputation as a leading centre of research and in the University's ability to attract the brightest and the best minds.

The successful commercialization of PIP must be the result of effective collaboration between the University and the **Inventors** or creators in a partnership that draws on and recognizes the unique contributions that each party makes to the process.

This policy is therefore intended to encourage, but not compel, Inventors to patent PIP and to provide a mechanism for the transfer and commercialization of the PIP that rewards the Inventor and protects the rights of the University.

The purpose of this policy is to:

- Identify the University of Alberta's commitment to ensuring that PIP that is intended to be exploited shall be disclosed to the University in a timely manner.

- Identify University of Alberta policy on the ownership, responsibility for Commercialization, and division of **Net Revenue** generated by the PIP.

Definitions

A definitions table as attached establishes the terms used in this policy and any unique rules of interpretation that apply.

Scope

This policy applies to all members of the University community.

Policy

1. APPLICATION

   This policy shall apply to all PIP created by all members of the University within their areas of research at the University, including faculty, researchers, staff and students whether registered for credit or not.

2. PIP CREATED AT THE UNIVERSITY

   There shall be a rebuttable presumption that when PIP has been created by members of the University community and within their area of research, it was created at the University even though some or all of the activity may have actually taken place elsewhere, unless there is a specific written agreement with the University to the contrary.

3. OWNERSHIP

   Ownership of PIP created at the University shall reside with the person or persons who created it, unless there is a specific written agreement with the University to the contrary.

4. TIMELY DISCLOSURE AND AVAILABILITY

   Full and timely disclosure of PIP to the University must occur at, or prior to, the point that the Inventor expresses an intent to explore Commercialization or pursues any activity to patent.

5. COMMERCIALIZATION

   a. Decisions regarding Commercialization of PIP shall be made with the consent of all its Inventors and the University. If any Inventor or the University does not consent, that decision shall be made through arbitration, with due regard to any ethical, moral, or religious objections of any Inventor and the University.

   b. The party that undertakes Commercialization, either the University or the Inventor, has a fiduciary obligation to all the interested parties.

6. COMMERCIALIZATION BY THE UNIVERSITY

   a. Where there is more than one Inventor the University will have the option to undertake Commercialization only in those cases where:

i. The Inventors unanimously agree that they wish the University to undertake Commercialization; or

ii. There is disagreement among the Inventors as to whether to pursue Commercialization, or as to how the Commercialization process is to proceed; or

iii. The University is not satisfied that all Inventors have been fully informed and are willing participants in the decision to pursue Commercialization or not.

b. In the case where the University undertakes Commercialization, ownership shall be assigned to the University to manage the process.

7. COMMERCIALIZATION BY THE INVENTOR

a. The Inventor, subject to the conditions in Clause 6, may elect to undertake the Commercialization process.

b. In the event that the Inventor elects to undertake the Commercialization process, the University will have the right to either approve or prevent the first transaction by which the rights to the PIP are affected.

c. The University will have the right to either approve or prevent any subsequent transactions by which the rights to the PIP are affected where any party directly or indirectly involved is not at arm's length to the Inventor.

d. University approval or prevention of transactions shall not be unreasonably withheld or exercised.

8. PRIORITY OF FUNDS TO SECURE LEGAL PROTECTION

Funds advanced by a party to secure legal protection of PIP shall have priority for return to the party who advanced the funds.

9. DIVISION OF NET REVENUE

a. One third (1/3) of Net Revenue generated by PIP shall go to the Inventor.

b. One third (1/3) of Net Revenue generated by PIP shall go to the University, one third (1/3) of which will be used to support research in the Faculty/Department where the research took place.

c. One third (1/3) of Net Revenue generated by PIP shall be committed to the Commercialization process.

10. VARIATION

Where the University believes that such agreements are in the best overall interests of the University and the Inventor, certain contracts, grants, sponsorships and research agreements which have been or will be entered into by the University, on its behalf or on behalf of certain of its members, with industrial companies, government agencies and other bodies, may contain provisions, whereby all PIP are licensed to such companies, agencies and other bodies or

assigned to the University and licensed to such companies, agencies or other bodies, and may contain provisions which are at variance with the provisions of this Policy.

The provisions of such contracts, grants, sponsorships and research agreements shall supersede the other provisions of this Policy. The University retains the right to enter into such agreements, and requires that University members comply with such provisions in contracts, grants, sponsorships, or research agreements.

11. EDUCATION AND RESEARCH USE

    The University has a non-transferable royalty-free license to use all PIP created at the University for non-commercial education and research purposes.

12. POLICY REVIEW

    Patent Policy and related Procedures shall be reviewed every five (5) years.

13. APPLICATION OF CONFLICTS AND ETHICS POLICY

    a. Conflicts of interest will be managed when they cannot be avoided. The University's *Conflict of Interest and Commitment and Institutional Conflict Policy (Conflict Policy)* will govern management of conflicts.

    b. Questions with respect to ethical issues will be resolved by reference to the Ethics Review process of the University.

14. DELEGATION

    The Vice-President (Research), or designates shall have the authority over the implementation and administration of this policy.

15. NON-COMPLIANCE

    Failure to comply with this policy shall be handled according to the respective Collective Agreements, but the University or Inventor shall also have a right of action against the non-compliant party.

16. ARBITRATION

    Any disputes shall be decided under the *Arbitration Act, R.S.A. 2000, c. A-43*, as updated from time to time. Issues that may be decided by Arbitration shall include, but shall not be limited to, the reasonableness or appropriateness of any judgment or exercise of discretion by the University, including the exercise of such judgment as it relates to nonmembers of the University community.

Definitions

Any definitions listed here apply to this policy document only with no implied or intended institution-wide use. For clarity, defined terms listed here include grammatical variations thereof.

Commercialization	The transfer or the commercialization or any combination of transfer and commercialization undertaken by a person with respect to Patentable Intellectual Property (PIP).
Inventor	The creator or creators of Patentable Intellectual Property.
Net Revenue	All consideration received by the Inventor or the University from third parties, from the sale or licensing of PIP, less the out-of-pocket costs paid by that party for obtaining the patent and granting, performing and enforcing any assignment or licensing of PIP. Any consideration not received in cash shall be valued by agreement between the University and the Inventor, failing which the value shall be determined by arbitration.
Patentable Intellectual Property	Includes patents; patentable ideas, including but not limited to plant cultivars, germ plasm, and computer software that is capable of being legally protected by patent, whether in Canada or elsewhere. This Policy does not apply to copyrights on work published or unpublished.

Parent Policy Suite

- Patent Policy
- Commercialization of Patentable Intellectual Property Procedure
- Declaring Best Interests of Inventor (Section 10 Variation of Patent Policy) Procedure

Related Links

- Arbitration Act R.S.A. 2000, c. A-43 (Government of Alberta)
- Canadian Intellectual Property Office (Government of Canada)
- Patent Act (R.S.C. 1985, c. P-4) (Department of Justice)

History

- June 22, 2007 Approved
- February 16, 2025 Editorial amendment. Formatting, office name and links.

For questions surrounding policy document interpretation or implementation, please contact the Office of Administrative Responsibility.

For the most recent version of this document, please visit https://www.ualberta.ca/policies-procedures/index.html