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## FREQUENTLY ASKED QUESTIONS ABOUT INVENTIONS AND COMMERCIALIZATION AT THE UNIVERSITY OF ALBERTA

This document answers frequently asked questions regarding inventions and commercialization at the University of Alberta. While it refers to the [Patent Policy](#), [Copyright Regulations \(Appendix B\)](#) and other information, please remember it does not override or supersede any of these documents.

### Innovation Management at the U of A

[TEC Edmonton](#) is the U of A's vehicle for creating economic impact from discoveries through spin-off company creation, licensing arrangements and commercialization. A unique not-for-profit community endeavour, TEC Edmonton is a joint venture between the University of Alberta and the [Edmonton Economic Development Corporation](#) (EEDC).

In addition to managing the U of A's technologies, TEC Edmonton is also a business accelerator that captures the value of the innovation in the Greater Edmonton region for economic development in the region. TEC Edmonton is located at the U of A's downtown campus location, Enterprise Square, where it also manages space and programs for start-up companies and entrepreneurs. TEC Edmonton works closely with the U of A's Vice-President Research and the Research Services Office.

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## **INVENTIONS**

### **How is invention defined for the purposes of the U of A’s Patent Policy?**

The U of A uses the term “Patentable Intellectual Property” to refer to inventions. Patentable Intellectual Property (PIP) includes patents and patentable ideas that can be legally protected by patent in Canada or elsewhere. To be potentially patentable, PIP should be new, useful and not obvious. For more detail, please refer to the [Patent Policy](#).

### **Who is covered by the U of A Patent Policy?**

The Patent Policy covers all members of the U of A community, including faculty, researchers, staff and students.

### **Who owns PIP created by U of A personnel?**

PIP created by University personnel within their areas of research is owned by the person or persons who created it, unless there is a **specific** written agreement with the University or **research agreement** to the contrary. The [Patent Policy](#) also gives both the inventor and the U of A certain rights.

## **INVENTION DISCLOSURE**

### **I want to commercialize something I have invented. When do I disclose this to the U of A?**

If you decide that you want to commercialize, patent, sell, or license some of your PIP, the Patent Policy stipulates that you must disclose this decision to the University.

It is best to do this as soon as possible. Early disclosure allows time for ownership to be determined and patentability assessed. You should disclose as soon as the invention or work is clearly conceptualized, or as soon as the new product or process could be immediately used by someone else familiar with the field. You must disclose before you initiate any action to sell, license, or otherwise assign your PIP to someone else.

### **How do I disclose my invention to the U of A?**

You complete a [Report of Invention \(ROI\)](#) form and submit it to TEC Edmonton. This form is used to record inventions created at U of A.

The Report of Invention form also is where the inventor indicates his or her decision about whether to commercialize independently, or whether to assign the invention to the U of A.

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## COMMERCIALIZATION

### What does it mean to commercialize independently?

If an inventor decides to commercialize independently, he or she would take responsibility for the intellectual property filing process (patents, copyright, etc. as appropriate) for the invention, developing a commercialization strategy, negotiating legal agreements with potential partners, and paying the costs associated with these steps. The inventor would also be responsible for meeting any pre-existing obligations to the research sponsor.

### What does it mean to assign an invention to the U of A?

Simply put, assigning an invention to the U of A means the inventor wishes to undertake the commercialization process with the U of A, using the resources of TEC Edmonton. Using the ROI, TEC Edmonton will review the invention for patentability and commercial potential and will decide whether to add the invention to its commercialization portfolio. TEC Edmonton will usually complete this review within 30 business days of receiving the ROI, and it will share its review with the inventor.

### If TEC Edmonton accepts the invention into its portfolio, what can the inventor then expect?

For an invention accepted into its commercialization portfolio, TEC Edmonton initiates the intellectual property filing process (patents, copyright, etc. as appropriate) for the invention and pays the initial costs. Working with the inventor(s), TEC Edmonton develops a commercialization strategy, identifies possible business partners and negotiates legal agreements with those partners. For details on these services, please refer to the [Technology Management section of the TEC Edmonton website](#).

### Who receives the net revenues from an invention commercialized by TEC Edmonton?

Generally speaking, net revenues (as defined in the Patent Policy) are split three ways: one-third to the inventor, one third to the U of A, and one third to TEC Edmonton to help cover the costs of the commercialization process. Please refer to Section 9 of the University's [Patent Policy](#).

### If the inventor commercializes independently, are there still obligations to the University?

Yes. First, the invention must still be disclosed to the U of A by submitting a Report of Invention form. Second, an inventor who commercializes independently, either because of a decision to do so or because TEC Edmonton has declined to take the invention into its portfolio, is still required to ensure that any existing obligations to third parties are fulfilled (for example, rights granted through a research agreement). Third, there is an obligation to share one third of the net revenues with the University, in accordance with the Patent Policy. The inventor(s) must submit to the U of A (through TEC Edmonton) an annual "Report of Activities" along with the University's share of net revenue. Finally, in accordance with the University's conflict of interest rules, the inventor(s) must seek approval of the U of A for the first time the invention is sold, licensed, or assigned to another party and also for any subsequent sale, licensing or assignment of the invention to another party that is not arm's length to the inventor(s).

### How does the U of A support spin-off companies created by researchers?

TEC Edmonton assists U of A spin-offs in their early stages through a variety of programs. These include commitment of funds and expertise, and assistance with financing, third party negotiations, business planning and early stage operations.

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While no two spin-off company situations are the same, TEC Edmonton follows a set of [defined principles in structuring a spin-off company deal](#). These principles help ensure alignment between commercialization partners, and increase the likelihood of commercialization success. The U of A's Conflict of Interest and Patent Policies are also relevant to creating spin-off companies.

## **OTHER QUESTIONS**

### **Can students be inventors? Can they file an invention disclosure?**

Students are often inventors and as such are included on the Report of Invention form. Remember that once students are listed as inventors, they must also sign the disclosure form to complete the submission process. For a summary on who should be listed as inventors, please refer to the [Report of Invention form](#).

### **I am collaborating with a researcher from another institution. Where do we disclose?**

You will disclose to both institutions, as each will require disclosure forms be submitted to its own technology transfer office. U of A inventors complete the U of A Report of Invention disclosure form and submit it to TEC Edmonton.

### **My invention was created with, or funded by, an industry partner – what now?**

On the Report of Invention disclosure form, the inventor must indicate the support or participation of any industry partners. TEC Edmonton can then review the invention disclosure form in the context of relevant contractual or agreement obligations with other partners. Remember that some funding programs require that the intellectual property arising from a funded project has to be assigned to the industry partner (for example, the NSERC Engage program).

### **Do all inventions get patented?**

No, not all inventions require patent protection for commercialization. Further, some may not meet the criteria for patent protection. If TEC Edmonton accepts an invention into its commercialization portfolio, then it works with the inventor to develop the most suitable protection strategy.

### **Should an inventor file a patent application before approaching potential partners?**

Not necessarily, but a confidentiality agreement is recommended with the potential partner, prior to sharing any invention details. TEC Edmonton handles all confidentiality agreements regarding research and commercialization for the U of A.

### **Who pays for the patenting of an invention?**

If the inventor commercializes on his or her own, he or she is responsible for all patenting expenses.

If TEC Edmonton handles the commercialization, then it covers the initial patenting costs, with the expectation of cost recovery from future revenues (see "Revenue Sharing" question).

### **Can I still publish my work if I report an invention?**

Yes, but remember that any public disclosure, e.g., at a conference, a presentation or in a publication, may weaken the inventor's ability to properly protect future intellectual property. A Report of Invention disclosure form should be completed well in advance of any publication so TEC Edmonton has time to evaluate and protect your intellectual property prior to publication or any other public presentation.

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Is it too late to protect my invention if I have already disclosed it publicly?

Not necessarily. If you believe that your invention has commercial value and you would like to pursue it, please contact TEC Edmonton as soon as possible.

## **COPYRIGHT**

**How is copyright ownership determined at the University?**

Copyright protects the expression of an idea – i.e. a specific book, script, piece of art, or software program. Ownership of copyright in works created by faculty members is covered by the various academic staff agreements. The general rule is that the academic staff member owns the copyright in any work s/he produces, unless that staff member was engaged by the University to prepare such works or if it is a part of that staff member's normal responsibilities to prepare such works. If the works arise from research at the University, the copyright then lies with the creator/author.

For more information, see section 10 and Appendix B (the "Copyright Regulations") in the [academic staff agreements](#).

The University considers its students to be the sole possessors of their thesis copyrights. For more information, see [section 10.4 of the Graduate Program Manual](#).

**What about commercializing PIP associated with software development?**

U of A inventors routinely submit Reports of Invention for algorithms and software, and undertake commercialization of this type of intellectual property. Contact TEC Edmonton for more details about these cases.

### *Useful Links*

[TEC Edmonton](#)

[University of Alberta Research Services Office](#)

[Office of the Vice-President \(Research\)](#)

[Patent Policy and Commercialization Procedure](#)

[TEC Edmonton/University of Alberta Report of Invention](#)

[University of Alberta Copyright Regulations \(Appendix B\)](#)

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