

<b>Commercialization of Intellectual Property from Academic Research Activities Procedures</b>			
<b>Parent Policy</b>	Intellectual Property Policy		
<b>Policy Sponsor</b>	President	<b>Category</b>	Board
<b>Policy Contact</b>	Provost-Vice President, Academic	<b>Effective Date</b>	May 22, 2020
<b>Procedure Contact</b>	Associate Vice President, Research	<b>Review Date</b>	May 22, 2025

### 1. Purpose

Intellectual Property created in the course of Academic Research Activities is an essential output of a robust, creative and innovative university and public comprehensive research institution. Athabasca University is responsible for ensuring that where Intellectual Property is created, its commercial viability and contributions to larger society are maximized. To support this, processes must be established to ensure roles and responsibilities in maximizing the potential of Intellectual Property are clear for both creators and the University, including in the areas of ownership, disclosure, commercialization and revenue sharing, and dispute resolution.

### 2. Scope

These procedures apply to the Commercialization of Intellectual Property created in the course of Academic Research Activities by an Employee, or by a Creator using University Resources. These procedures do not apply to External Research Activities, or research that may be the subject of third-party rights or obligations under any funding agreement, sponsored research, or other applicable agreement.

### 3. Definitions

<b>Academic Research Activities</b>	The conduct of original research, scientific or scholarly inquiry, which advances knowledge in a discipline of study, or leads to publication in a peer-reviewed journal or other publication.
<b>Commercialization or Commercialize</b>	Any activity relating to the use, sale, transfer, license, marketing, or other disposition of IP for generation of profit. This is intended to cover any such activity, whether through business, industry or other organizations, such as a manufacturer, distributor, reseller, or licensee. However, publishing a scholarly article or chapter in a journal or textbook is not, by itself, considered "Commercialization" for the purposes of this definition.

<b>Creator</b>	An individual who produces Intellectual Property that is a candidate for Commercialization under these Procedures.
<b>Employee</b>	A full-time, part-time, casual, or seasonal staff member employed by the University.
<b>External Research Activities</b>	The conduct of research outside the University, independent of any relationship to or support from the University, apart from any duties and responsibilities to the University, and without the use of any University Resources.
<b>Intellectual Property</b>	Any invention, work, information or material, trade secret, data, or technological or industrial design or process, regardless of form, including anything protectable by patent, copyright, industrial design, trademark, or other intellectual property rights.
<b>Public Disclosure</b>	Any activity that results in making Intellectual Property publicly available through any public medium, including (but not limited to) speech, print, paper, and electronic communication, and disclosure to third parties outside the University.
<b>University</b>	Athabasca University.
<b>University Resources</b>	Resources that include but are not limited to the University's funds, finances, physical structures, research laboratories, capital equipment, technical facilities, services, and personnel. Intellectual Property is not considered to use University Resources merely due to the limited use of University email or telephone or internet access.

## 4. Guiding Principles

### 4.1. General

- a) These procedures support the rights and responsibilities of Creators and the University with respect to ownership, disclosure, commercialization, and management and protection of Intellectual Property.
- b) Where Intellectual Property is created through Academic Research Activities by an Employee or by a Creator using University Resources, and may be a candidate for Commercialization, Creators must follow the required processes under these Procedures with respect to Commercialization of the Intellectual Property.
  - i. Failure to follow these Procedures may result in the University taking action against the Creator, including under any applicable employment contract or collective agreement, or other legal action against the Creator and any subsequent third-party owner or licensee of the Intellectual Property, to enforce its rights.

- c) Where Intellectual Property is a candidate for Commercialization, the Creator and University will enter into an agreement to establish their respective rights and responsibilities, including but not limited to: support and management for the protection of Intellectual Property, ownership stake in any entity created for the purposes of Commercialization, revenue or other profit sharing, and dispute resolution.

#### **4.2. University's License**

In respect of any Intellectual Property covered by these Procedures, the University and Creator may enter into an agreement to record the University's license to use and modify the Intellectual Property under a perpetual, irrevocable, royalty-free non-exclusive, non-transferable license for teaching, educational and non-commercial purposes within the University. The absence of any written license agreement does not detract from any of the University's rights under the IP Policy.

#### **4.3. Disclosure**

- a) The Creator must disclose to the University any Intellectual Property they consider a candidate for Commercialization.
- b) The University has the first right to offer support and management for the protection of Intellectual Property that is or may be a candidate for Commercialization.
  - i. Determination of whether the University deems the Intellectual Property a candidate for Commercialization with the rights and responsibilities assigned to the University in these Procedures is at the sole discretion of the University and will be done in accordance with the processes established for that assessment.
- c) Disclosure of Intellectual Property under these Procedures will be to the Associate Vice President, Research.
- d) Disclosures made must set out all relevant circumstances of the creation of the Intellectual Property, a description of the Intellectual Property, and any other information that is required for the University to determine whether it is a candidate for Commercialization.
  - i. The Associate Vice President, Research may establish processes and forms with respect to the disclosure of Intellectual Property.
- e) Confidentiality must be maintained with respect to the Intellectual Property being disclosed by both the Creator and the University until such time as the Intellectual Property is protected.

- i. The University and Creator will refrain from any Public Disclosure of the Intellectual Property that may or would affect the ability to protect and Commercialize it.

#### **4.4. Commercialization Assessment**

- a) Determination of whether Intellectual Property created in the course of Academic Research Activities is a candidate for Commercialization will be done in a timely manner, and with regard to any applicable legislated timelines for ensuring the commercial viability of the Intellectual Property.
- b) The University may engage a third-party, subject matter expert or experts to assist in the determination of the commercial viability of the Intellectual Property.
  - i. The University will have the sole discretion to select the third-party, subject matter expert(s).
- c) The University's decision to support or not support the Commercialization of Intellectual Property under these Procedures will be final.
  - i. Where the University has determined the Intellectual Property is not a candidate for Commercialization under these Procedures, the Creator of the Intellectual Property retains all rights and responsibilities with respect to ownership, management, and protection of it. The University will relinquish any claim to any revenues or remuneration that may be realized as a result of Commercialization of the Intellectual Property by the Creator.
- d) Any determination as to the viability of Commercialization of Intellectual Property will be done in accordance with the University's values, the results of its assessment, and with a view to the protection of the reputation of the University and its members.
- e) Determination of Intellectual Property as a candidate for Commercialization will be done with regard to any applicable obligations set out in the Code of Conduct for Members of the University Community.

#### **4.5. Protection, Support and Management, and Revenue Sharing**

- a) Where Intellectual Property has been deemed a candidate for Commercialization, the University will undertake to support the necessary steps for the protection of the Intellectual Property and management of that protection to ensure Commercialization remains viable.
- b) The Creator and the University will enter into an agreement setting out the support that will be provided to protect and manage the Intellectual Property to Commercialization.

- i. The agreement may include provision for the creation of an entity to Commercialize the Intellectual Property and distribution of shares to the University.
  - ii. The agreement will include the amount of monetary and administrative support to be provided by the University, any management fee associated with such assistance, and the terms on which the University will recover its costs related to Commercialization.
- c) The Creator and the University will enter into an agreement setting out revenue sharing and/or royalties on the revenue realized as a result of Commercialization, or any ownership stake in the Commercialization entity.
  - i. Revenue sharing and/or royalties in the agreement will be negotiated, including the share distribution in any entity created for the purposes of Commercialization of the Intellectual Property. This may include the issuance of a reasonable percentage of non-dilutable shares to the University.
  - ii. Revenue sharing and/or royalties will be subject to the provisions for reimbursement of monetary amounts provided for the protection and management of the Intellectual Property prior to Commercialization as per clause 4.5 (b) of these Procedures.

#### **4.6. Dispute Resolution**

- a) All procedures for resolving disputes under the Intellectual Property Policy and Procedures will be in compliance with applicable laws, contractual obligations or collective agreements.
- b) The Creator and University will make good faith efforts to resolve any disputes under the Intellectual Property Policy and these Procedures, and will provide all relevant materials necessary to resolve thematters.
- c) The Creator and University may initially attempt to resolve any disputes amicably between themselves, in consultation, where appropriate with any legal, financial, or other representatives.
- d) Where disputes cannot be resolved amicably between the Creator and University, a third-party will be identified by the University to establish the process for resolving the dispute between the parties.

#### **5. Applicable Legislation and Regulations**

Intellectual Property Legislation as applicable

**6. Related Procedures/Documents**[Intellectual Property Policy](#)[Open Access to Research Outputs Policy](#)[Open Access to Research Outputs Procedures](#)**History**

<i>Date</i>	<i>Action</i>
May 22, 2020	Associated Policy Approved (The Governors of Athabasca University Motion #244-04)