



INTELLECTUAL PROPERTY POLICY

Blue = additions to proposal from current

PINK = Other changes from current to proposed

~~Strike out = deletions from current to proposed~~

University Policy No.:

Classification: Governance

Approval Authority: Board of Governors

Effective Date:

Supersedes:

Last Editorial Change:

Mandated Review:

Associated Procedures:

Commercialization of Intellectual Property and Revenue Sharing Procedure

1. POLICY PURPOSE

This policy is intended to regulate the process for Creator(s) to identify and Commercialize Intellectual Property (IP) and protect the rights of CUE.

2. DEFINITIONS

Within this Policy, the following capitalized terms will have the following meanings:

- **Commercialization or Commercialize** - means any activity relating to the legal protection, use, sale, transfer, license, marketing, duplication, or other disposition of IP for generation of profit, including any such activity through a third-party licensee or sublicensee.
- **Costs of Commercialization** - means all direct and indirect costs incurred during research and development, and Commercialization of the IP, and its related technologies, products, services or processes.
- **Creator** - means the author or inventor of IP who is a Member of CUE as described in section 5.1
- **CUE** - means Concordia University of Edmonton.
- **CUE License** - is defined in section 5.3(b) [Definition has changed considerably from current]
- **CUE Resources** - means resources that include but are not limited to (a) release time from regularly assigned duties where the primary purpose of the release time is the creation of IP, (b) direct discretionary investment by CUE of funds, or staff or the purchase of special equipment for the creation of IP, or (c) use of CUE's physical structures, research laboratories, capital equipment, technical facilities including computing resources, services, and personnel. A reference to "use of CUE Resources" in this Policy does not include:

- the payment of basic salary to CUE employees;
- the provision of a standard academic or administrative environment to CUE employees in which to perform their normal duties, including office space and furnishings, office computer equipment and software, and any other equipment that is necessary for the performance of

normal teaching or academic duties or for the production of Traditional Academic Work;

- the provision of overhead costs associated with the CUE's administration of external funds.
- **External Work** - means IP that is created by an employee, contractor, or consultant completely independent of, and separate and apart from, any relationship (whether employment-based, contractual or otherwise) with CUE, any duties and responsibilities to CUE, or any support from CUE, and without the use of any CUE Resources.
- **Gross Revenue** - means all royalty revenue and other income arising in whole or in part from Commercialization of the IP, and its related technologies, products, services or processes (which shall include profit sharing, upfront, lump-sum payments and monies from the sale of equity shares), ~~received by CUE or by the Creator, as the case may be.~~
- **Institutional Work** - means IP created at the request or direction of CUE where Special Circumstances apply, under written agreement with CUE, ~~and/or for CUE's use~~ for the primary purpose of CUE's use, exploitation or Commercialization, and/or through the use of CUE Resources, whether created by an employee, contractor, or consultant. Institutional Work includes, but is not limited to, non-academic research, policies, procedures, manuals, reports, software code or website design materials, guidelines, presentations, all materials created for new courses (including without limitation course architecture, course design and content, syllabi, presentation materials, lectures, manuals and digital production) at CUE's specific direction, administrative training awareness materials, including materials developed as part of professional development, and other content that is primarily for the administration and operations of CUE.
- **Intellectual Property** - (abbreviated in this document as "IP") means any form of knowledge or expression created with one's intellect that can be owned by a person and that can be protected by patent, copyright, trademark, integrated topography, industrial design laws, or other equivalent legislation or legal doctrine. Intellectual Property includes, but is not limited to, such things as inventions, computer software recorded in any format, works of art, databases, research data, research tools, audio-visual material, electronic circuitry, biotechnology and genetic engineering products, all other legally protectable products of research, and know-how.
- **Invention Intellectual Property Disclosure Form** - means the form to disclose IP, in the form attached to or linked within the Commercialization of Intellectual Property and Revenue Sharing Procedure.
- **Member of CUE** - includes all academic staff, staff, academic colleagues, administrators, students, visiting or adjunct scholars and professors, fellows and chairs, emeriti, holders of post- doctoral positions, paid and unpaid research associates and assistants, and any other persons in similar positions at CUE.

- **Moral Rights** – means moral rights as defined in the *Canada's Copyright Act*, R.S.C., 1985, c. C-42 as it may be amended.
- **Net Revenue** - means Gross Revenue minus Costs of Commercialization.
- **Policy** - means this IP Policy.
- **Public Disclosure** - includes any activity that results in making IP publicly available through any public medium, including (but not limited to) speech, print, paper, and electronic communication, public oral and poster presentations, submission of an abstract for presentation at conferences both within and outside CUE, submission of an abstract and/or manuscripts to journals, publication of an abstract and/or manuscript in journals and disclosure to third parties outside CUE.
- **Special Circumstances** – means a situation where IP is created by or contributed to an employee, contractor or consultant and: (i) that employee, contractor or consultant has a set number of working hours agreed upon with CUE, and CUE requests or directs that the employee, contractor or consultant spends some of those working hours in creation of or contribution to IP; (ii) that employee, contractor or consultant receives from CUE additional compensation (whether monetary or otherwise) for their creation of or contribution to IP; and/or (iii) that employee, contractor or consultant receives from CUE a reduction of, or relief from, other duties they were otherwise responsible for completing for CUE (including without limitation reduced teaching duties) in exchange for their creation of or contribution to IP.
- **Research** - means a process of purposeful inquiry that generates new insights or knowledge involving scholarly, scientific, or creative activities in a field of specialization. It typically results in quantifiable outcomes such as journal articles, books, conference presentations and creative performances that are communicated to a broader academic community, field of practitioners or the public.
- **Traditional Academic Work** - means IP ~~in any form~~ that is not Institutional Work and which is created by an employee, contractor or consultant of CUE to support teaching or that takes the form of one or more of the traditional kinds of academic output related to Research and publication (such as scholarly publications relating to research materials, inventions, scientific discoveries, and technological innovation) or relating to the teaching of courses (including without limitation course presentation materials, lectures or laboratory manuals) which are not created at CUE's specific direction where Special Circumstances apply. ~~academic reports, textbooks, journal articles, and monographs). This academic output includes, but is not limited to, educational, scholarly, artistic, or literary works in any medium. IP created for public service (such as speeches, reports, etc.) shall normally also be considered a Traditional Academic Work.~~

3. JURISDICTION/SCOPE OF THE POLICY

This Policy applies to all Members of CUE, and any IP created in the course of employment or a contract with CUE. This Policy is subject to the provisions of any

specific employment agreement or other contract for services. To the extent that there is any conflict or inconsistency between a provision of this Policy and a provision of any specific employment agreement or contract for services, the provision of such employment agreement or contract for services shall govern to the extent of the conflict or inconsistency. **Concept moved from 5.3(b) in current policy to here.**

4. ~~POLICY~~ Proposed Deletion

~~The objectives of this Policy are:~~

- ~~4.1 Promotion of IP Creation and Utilization: The intent of this Policy is to encourage creativity and innovation at CUE. This Policy seeks to facilitate the widespread use of IP created by Members of CUE.~~
- ~~4.2 IP Management: This Policy seeks to set the framework for IP to be useful as products, services and processes. It also establishes procedures to report creation of IP in a timely manner, govern the use and dissemination of IP, criteria for ownership of and commercial rights to IP and responsibility of Commercialization developed by Members of CUE.~~
- ~~4.3 Balance of Interests: This Policy seeks to ensure that revenue generated by Commercialization of IP is distributed in a manner consistent with the mission of CUE and advancement of research at CUE.~~

5. DISCLOSURE AND OWNERSHIP (NOW 4. In Employer proposal)

5.1 Creators:

- (a) To be considered a Creator for the purposes of this Policy, an individual must be considered to be a creator, author or inventor of IP pursuant to applicable Canadian intellectual property laws.
- (b) **Notwithstanding anything to the contrary in this Policy**, this Policy recognizes that collaborative or co-operative effort may involve several Creators, or may involve authors, inventors or joint-owners who are not subject to this Policy, and whose rights in the IP may prevent Public Disclosure or Commercialization if those authors, inventors or joint-owners have not given the required legal consent for use of their contributions to the IP. **The joint contribution by other creators, authors, inventors to IP who are not Members of CUE shall not impact the applicability of this Policy to all aspects of the contributions to IP by Members of CUE. Each Creator shall use their best efforts to promptly obtain such legal consents and agreements, in writing, as may be required to give effect to this Policy.**
- (c) Where there are two or more Creators of the same IP who are Members of CUE ~~(i) all references to the rights and obligations of “a Creator” in this Policy shall apply equally and simultaneously to all Creators of the IP in question; and (ii) the determination of the list of Creators will be determined under the Commercialization of Intellectual Property and Revenue Sharing Procedure.~~

5.2 Disclosure:

- (a) ~~Creator(s) of IP are free to publish the IP and acknowledge that Public Disclosure of IP may affect legal protection of the IP.~~ A Creator of IP may decide to publish Traditional Academic Work, and acknowledges that Public Disclosure of any Traditional Academic Work may affect legal protection of the IP related thereto. A Creator of Institutional Work may not publish or make any Public Disclosure of any aspect of same without first obtaining express written consent to same from CUE.
- (b) If CUE or the Creator(s) of IP expresses interest in or seeks to pursue any Commercialization of ~~the IP~~ any Institutional Work or any Traditional Academic Work, the Creator shall make full and complete disclosure of the IP to CUE, using the Intellectual Property Invention Disclosure Form, in accordance with the Commercialization of Intellectual Property and Revenue Sharing Procedure. Full and timely disclosure of the Institutional Work or the Traditional Academic Work to CUE must occur prior to the point that the Creator pursues Commercialization or pursues any Public Disclosure that may affect legal protection of such IP.
- (c) ~~Full and timely disclosure of IP to CUE must occur at, or prior to, the point that the Creator pursues Commercialization or pursues any Public Disclosure that may affect legal protection of the IP.~~ (moved to b)

5.3 Ownership:

- (a) Any and all Institutional Work and associated IP rights are owned by CUE. CUE controls all rights to this content and IP, including the rights to publish, share or Commercialize the Institutional Work. Any revenue generated from the Institutional Work belongs to CUE.
Concept previously found in 5.3(c)(ii) but expanded greatly.
- (b) For any Traditional Academic Work, the Creator is the first owner of the Traditional Academic Work and associated IP rights (unless such ownership and IP rights have been ceded in whole or in part to a third party or CUE) ~~concept previously found in 5.3(a) and (c)(i)~~, subject to the following: (1) CUE's right to share in any profits or an ownership stake in any entity created for the purposes of Commercialization, as may be set out in any applicable agreements or procedures, if such IP is Commercialized; and (2) CUE's absolute right to use and modify the Traditional Academic Work under an ~~perpetual~~ irrevocable, royalty-free, non-exclusive, non-transferable license for teaching, educational and non-commercial purposes (the "**CUE License**"). The CUE License shall expire two years following the cessation of any relationship (whether employment-based, contractual or otherwise) between CUE and the Creator. CUE may support the Creator's protection and management of such Traditional Academic Work in its sole discretion. For clarity, a Creator is at liberty to transfer any and all rights to any Traditional Academic Work that he or she may hold, including any and all IP rights, to CUE.
- (c) Any External Work is owned by the Creator, CUE has no claim to this type of IP, nor any responsibility to provide resources, or assist with IP protection or management.

- ~~(a) Subject to sections 5.3(b) and 5.3(c), all rights in IP shall be owned by the Creator at the time of creation of the IP, unless these rights have been ceded (in whole or in part) to:~~
- ~~(i) a third party, or~~
 - ~~(ii) CUE~~
- ~~(b) under a prior written agreement, that may include but is not limited to a funding agreement, non-disclosure agreement, material transfer agreement, development agreement, research agreement, consulting agreement or service contract. Where IP is developed in the course of any such funding agreement, non-disclosure agreement, material transfer agreement, development agreement, research agreement, consulting agreement, service contract or similar agreement between the Creator(s) and a third party, the ownership rights of the IP will be determined by the specific terms of that agreement. [Moved to Point 3. Scope of Policy]~~
- ~~(c) Exceptions and clarifications for section 5.3(a) and (b):~~
- ~~(i) Traditional Academic Work: The Creator of Traditional Academic Work is the owner of that IP, unless the Creator has entered into an agreement with CUE to the contrary.~~
 - ~~(ii) Institutional Work: CUE is the owner of Institutional Work, unless the Creator has entered into an agreement with CUE to the contrary;~~
 - ~~(iii) License in favour of CUE: CUE retains a non-exclusive, non-transferable, royalty free perpetual right to all IP that is created with the use of CUE Resources, for its use for educational, scholarly, administrative, research and other non-commercial purposes (the "CUE License"). Concept expanded in Employer proposal to include License to include Traditional Academic Work within the License.~~
- ~~License in favour of Creator: (d)-In cases where CUE is the owner of IP under this Policy with respect to copyright protected under Canada's the copyright act, Copyright Act, the Creator will of that IP is deemed to:~~
- ~~a. retain all Moral Rights in the copyrighted work; (i) irrevocably waive any and all Moral Rights in the copyrighted work unless otherwise agreed to by the Creator and CUE in writing; and~~
 - ~~b. have the right to revise the copyrighted work at reasonable intervals;~~
 - ~~c. (ii) subject to section 4.2(a) herein, have an perpetual, irrevocable, royalty-free, non-exclusive, non-transferable license to use, revise and modify the copyrighted work for non-commercial purposes only and upon reasonable advance written notice to CUE. The license provided for in this sub-paragraph 4.3(d)(ii) shall expire two years following the cessation of any relationship (whether employment-based, contractual or otherwise) between CUE and the Creator.~~
- ~~(iv) Presumption of use of CUE Resources: (e) There shall be a rebuttable presumption that, when IP has been created by Members of CUE~~

within their area of Research, the IP was created with the use of CUE Resources, even though some or all of the activity may have actually taken place elsewhere, ~~unless the Creator has entered into an agreement with CUE to the contrary.~~

- (f) Any Member of CUE asserting any rights in any IP that is, or is based on or copied from, work created, authored, or invented by a third party, must demonstrate, via documentary evidence, that such Member of CUE is entitled to such rights. Subject to the terms of this Policy, in the event a Member of CUE revises or otherwise alters work owned by a third party, such Member of CUE shall only have rights to that IP to the extent such revision or alteration can be identified as separate from the original work.

6. COMMERCIALIZATION

- 6.1 Commercialization Generally: ~~Although reporting of creation of all IP, as set out in section 5.1 of this Policy, is required when a Creator of the IP expresses interest in Commercialization, N~~neither the Creator nor CUE is required or obliged to Commercialize any IP. In keeping with CUE's scholarly/educational mission and its dedication to the pursuit and dissemination of knowledge, CUE does not encourage the development of IP solely for profit or personal gain.
- 6.2 Options for Commercialization: If a Creator wishes to Commercialize [Traditional Academic Work](#) IP ~~that has been created through the use of CUE Resources~~, the Creator has two options:
 - (a) The Creator may Commercialize independently of CUE under section ~~5~~ [6.3](#), or
 - (b) The Creator may Commercialize with the assistance of CUE under section ~~5.4~~ [6.4](#).

The Creator must make an election to proceed under one of these two options. That election is made in the [Intellectual Property ~~Invention~~](#) Disclosure Form, pursuant to the Commercialization of Intellectual Property and Revenue Sharing Procedure. ~~^paragraph space deleted here.~~

Decisions regarding Commercialization of IP shall be made with the consent of all of its Creators and CUE, in accordance with this Policy and the Commercialization of Intellectual Property and Revenue Sharing Procedure.

- 6.3 Commercialization by the Creator: The Creator may elect to undertake the Commercialization [of the Traditional Academic Work](#) independently of CUE, subject to:
 - (a) the provisions of the CUE License,
 - ~~(b)~~ any revenue-sharing obligations for [Traditional Academic Work \(section 6\);](#) ~~IP that was created with the use of CUE Resources (section 7);~~
 - (c) any [rights or](#) obligations granted to third-parties under any applicable funding

or other agreements, ~~(such as those listed in section 5.3(b));~~ and

(d) any rights that CUE may have under the Commercialization of Intellectual Property and Revenue Sharing Procedure.

~~See 7.4 (Commercialization by Creator), and Section 4 of the Commercialization of Intellectual Property and Revenue Sharing Procedure.~~

6.4 Commercialization by CUE: If the Creator elects to Commercialize [the Traditional Academic Work](#) with the assistance of CUE, CUE will have the final decision in [whether to proceed with](#) ~~proceeding with~~ Commercialization of the IP. The procedure for making this decision is set forth in more detail in the Commercialization of Intellectual Property and Revenue Sharing Procedure. If CUE decides to Commercialize the [Traditional Academic Work IP](#), the Creator will provide an assignment of ownership of the [Traditional Academic Work IP](#), to CUE and the parties will begin the Commercialization process in accordance with this Policy and the Commercialization of Intellectual Property and Revenue Sharing Procedure. Any Commercialization of the IP by CUE will be subject to:

- (a) the provisions of the CUE License,
- ~~(b) any revenue-sharing obligations for [Traditional Academic Work \(section 6\)](#) IP, that was created with the use of CUE Resources ~~(section 7)~~;~~
- (c) any [rights or](#) obligations granted to third-parties under any applicable funding or other agreements, ~~(such as those listed in section 5.3(b));~~ and
- (d) any [rights or](#) obligations that CUE may have under the Commercialization of Intellectual Property and Revenue Sharing Procedure.

~~See Section 5 of the Commercialization of Intellectual Property and Revenue Sharing Procedure.~~

7. REVENUE SHARING [\(6\)](#)

7.1 Revenue-Sharing: In the case of [Traditional Academic Work IP](#) ~~that was created with the use of CUE Resources~~, Revenue from Commercialization will be shared as per Sections [6.2](#) ~~7.2~~ (Commercialization by CUE), [7.3](#) (Inter-institutional Obligations), [and](#) [7.4](#) (Commercialization by Creator).

7.2 Commercialization by CUE: In the case of Commercialization of [Traditional Academic Work](#) through CUE [under section 5.4 herein](#), all Gross Revenue received by CUE from Commercialization of the [Traditional Academic Work IP](#), shall be [retained and/or](#) distributed as follows [\(or as otherwise determined and implemented following written approval of the President of CUE from time to time\)](#):

- (a) ~~50%~~ [100%](#) will be retained by CUE until all CUE Costs of Commercialization ~~to the date of the receipt of such Gross Revenue~~ have been recovered [by CUE](#); [and then](#)
- (b) of the remaining ~~Net~~ [Revenue](#):

- (i) CUE shall receive a 50% share of the Net Revenue, and
- (ii) the Creator, or the Creators collectively, shall receive a 50% share of the Net Revenue.

7.3 Inter-institutional Obligations: Where of **Traditional Academic Work** IP is developed jointly by a Creator who is a Member of CUE and a member of another institution and working at the other institution, rights to such IP and **Gross Revenue** shall be shared between the relevant parties in accordance with a definitive written agreement to be entered into by the relevant parties, CUE and the other institution, taking into account the policies of both institutions. and under a definitive written agreement. The sharing of **Gross Revenue** will normally take into account the relative contributions of the individuals Creator and their institutions. If the other institution is a CUE-affiliated institution, the sharing of ownership and **Gross Revenue** shall be governed by agreements in place between CUE and its affiliated institutions regarding the management of IP.

7.4 Commercialization by Creator: In the case of Commercialization of **Traditional Academic Work** through by the Creator(s), under section 5.3 herein, all Gross Revenue received by the Creator(s) from Commercialization of the of **Traditional Academic Work** IP shall be distributed as follows:

- (a) 50% will be paid to CUE until all CUE Costs of Commercialization to the date of the receipt of such **Gross Revenue** have been recovered by CUE, with the other 50% being retained by the Creator; and then
- (b) of the remaining **Net Revenue**,
 - (i) CUE shall receive a 25% share of the Net Revenue (such amount to be distributed under Section 7.5 6.5 herein (CUE's Share)) , and
 - (ii) the Creator, or the Creators collectively, shall receive a 75% share of the Net Revenue.

7.5 6.5 CUE's Share: In the case of Commercialization of **Traditional Academic Work** through the Creator under section 5.3 herein, CUE's share of Net Revenue will be distributed internally as follows for each individual **Traditional Academic Work** project:

For each individual IP project:

- (i) Income up to and including \$25,000 shall be kept in a research fund administered by the Vice President Academic and Provost of CUE. The fund will be applied to graduate scholarships, indirect costs of research and the development of IP; and
- (ii) Income over \$25,000 shall be distributed as follows:
 - 75% to CUE's general revenue;
 - 25% to a CUE fund for supporting Commercialization including costs related to legal protection of IP and other activities.

7.6 Modification with respect to implementation of revenue sharing schedule may be implemented on approval of the President. Implementation of these

revenue sharing provisions and modification to such implementation may occur on written approval of the President of CUE.

7. FURTHER ACTS AND DOCUMENTS

7.1 Should further acts be reasonably required to give full effect to the provisions and intention of this Policy, including without limitation the execution of further documents by CUE and/or by any Creators, CUE and/or any Creators shall take those acts.

8. CONSEQUENCES FOR NONCOMPLIANCE

- a. Failure to comply with this Policy shall be handled according to the applicable Collective Agreement, ~~but CUE or Creator(s) shall also have a right of action against the non-compliant party.~~ Employee agreement or other contract (if applicable).
- b. Non-compliance with this Policy may result in inability to protect IP, ~~Intellectual Property created at CUE~~, and consequential loss of revenue from Commercialization of such IP. Further, non-compliance may result in liability for Creators and/or CUE, and infringement of patent rights, copyright or other IP rights. CUE may establish other procedure(s) for determining any consequences for non-compliance with this Policy from time to time.

9. DISPUTE RESOLUTION

- a. Unless CUE otherwise establishes a procedure(s) for the resolution of disputes that arise under this Policy, if a dispute arises between a Creator(s) and CUE regarding the application of this Policy, the Commercialization of any IP, or any matter covered by this Policy, the dispute shall be resolved through binding arbitration in accordance with the *Arbitration Act* (Alberta) RSA 2000, as amended.

AUTHORITIES AND OFFICERS

A list of authorities and officers for the policy:

- a. Approving Authority: Board of Governors
- b. Designated Executive Officer: President & Vice-Chancellor
- c. Procedural Authority: Vice-President External and Internal Relations
- d. Procedural Officer: Associate Vice-President, Innovation

RELATED LEGISLATION

RELATED POLICIES AND DOCUMENTS

- Bylaws of the Board of Governors of Concordia University of Edmonton
- Collective Agreement between Concordia University of Edmonton and Concordia University College of Alberta Faculty Association

January 13, 2022

Appendix A4: MOU re: Intellectual Property (Article 17)

Memorandum of Understanding between

Concordia University of Edmonton and Concordia University

College of Alberta Faculty Association

Re: Intellectual Property

~~Notwithstanding any provision(s) of~~ **Subject to the terms of** the Intellectual Property policy, the University agrees that **a Faculty Member who is the Creator of any Traditional Academic Work** ~~all rights in the copyright to teaching materials originally created by a Faculty Member,~~ (including but not limited to written lecture material, laboratory manuals, computer programs, databases, multimedia instructional materials and distance education or online courses **that fall within the definition of Traditional Academic Work under the Intellectual Property Policy**) **is the first owner of the Traditional Academic Work.** ~~shall vest in the Faculty Member and may be used by the University only with the Faculty Member's permission.~~ **The University's use of the Creator's Traditional Academic Work shall be subject to the terms of the Intellectual Property Policy.**

~~Disputes that may arise with respect to the outcome of the application of the Intellectual Property policy related to this MOU will be resolved in accordance with Article 25 (Grievance and Arbitration).~~