Patent Policy

This policy has been superseded by R30.03 effective July 22, 2004. R30.01 and R30.02 will remain in effect for intellectual property created on or before July 21, 2004.

General

1. Objectives

   The objectives of the University patent policy are:
   
   a. to provide an incentive to research development and innovation,
   
   b. to provide a service to faculty and staff for effective development and utilization of discoveries, when such development would be in the public and University interest,
   
   c. to provide the possibility of extra funds to promote and aid independent research and development in the University, and
   
   d. to provide a check on possible University obligations that may be involved in patents relating to contract research carried out in the University.

2. Principles

   a. Research done solely in anticipation of profit is incompatible with University research activity. However, the University and the inventor have a responsibility in the course of University research, and ideas or processes may be developed, on which, in the public interest, patents should be sought.

   b. The University recognizes, under existing patent law, that the University inventor - be it a member of faculty, staff or the student body - has the first right of ownership to patents, even if the patentable process or development was produced solely using University time and facilities. This principle or guideline may not apply in the case of outside contract research that may have particular terms regarding patents.

   c. The University rejects the alternative and more restrictive principle of requiring faculty and staff to assign patent rights to the University in advance, i.e. as a condition of employment. Rather, the University desires to provide a service and incentive by helping faculty and staff in the complicated area of patenting on the basis that they have the first right to patents on their discoveries arising out of work in the University, and should be free to choose whether they wish to pursue a patent on their own or to avail themselves of the services of the University in this regard.

   d. The University has a strong interest in maintaining complete freedom of research and the unrestricted dissemination of information.

   The University wishes to encourage the publication by faculty members and others in the University of any of their findings from research and wishes to prevent any restrictions being placed in the way of such publication. The University therefore,
Policy

1. Simon Fraser University recognizes that in law, patent rights to any invention made by a faculty, staff or student inventor of the University on University time, belong to the inventor unless there is a written contract to the contrary, between the inventor and the University and/or a sponsoring agency, assigning such patent rights to the University or to the agency.

2. Before pursuing a course of action on patenting any discovery arising out of his/her University research, a faculty or staff inventor is required, as University policy, to report his/her intentions to the department chair or advisor. This policy is in no way intended to place any restriction by the University on the inventor regarding possible pursuit of a patent. Rather it is required because of possible University obligations regarding contract research and patents, because of the University’s legitimate interest in being informed of the University activities of its faculty, staff and students in this area, and because of its desire to communicate the existence of its services regarding patenting to the inventor.

3. If it is determined that no University or other obligations exist regarding the patents of a discovery which a faculty or staff member brings forth, and once the University services to aid in patenting have been made clear to the faculty or staff inventor, he/she shall be absolutely free to decide whether to proceed on his/her own or to ask the University for aid in patenting. University services in patenting, beyond the scope of advice, will only be provided if the University decides the patent is worth pursuing and on the condition that the inventor assigns the patent rights to the University. University services will involve pursuing the patenting by the University either on its own or through arrangements with a patent service.

4. The University must approve all contract research in the University. It is University policy, therefore, that in cases of contract research, in addition to the signature of the researcher(s), the University must sign the contract agreement regardless of whether such signature is required by the sponsoring agency in relation to University policies and obligations to provide facilities and services in support of the contract research. (Such signature does not make the University a party to possible patent or publication obligations). In cases of contract research where it is not possible to have the patent right vest with the researcher or the University, the University will take all essential steps to protect the researcher and the University and to avoid any legal misunderstandings should a patentable discovery arise from the research. Also in such cases of contract research, where the patent rights do not vest with the researcher(s) (i.e. vest either with the University or the sponsoring agency), any persons assisting the principal researcher in that contract research will be required to sign a waiver on all possible patent rights.

5. In the case of contract research where the patent rights do not vest with the sponsoring agency or with the University, and in cases of non-contract research, researchers should be aware of the fact that in order to maintain sole patent rights on inventions arising out of their research they should obtain a waiver on patent rights from anyone assisting them in that research.

6. Any funds accruing to the University from royalties, license fees, etc. over and above costs involved in obtaining and promoting a patent arising out of University research shall be disbursed for research in the University.

Procedure

1. When a faculty or staff member makes a discovery or invention in the course of his/her research at the University, and if he/she believes such discovery or invention to be patentable, the researcher is required to inform the chair of the department or supervisor and the Vice-President, Research in writing regarding the discovery or invention.

2. The Vice-President, Research will then determine whether the research connected with the discovery involves any patent obligations with an outside sponsor or with the University.
3. If it is ascertained by the Vice-President, Research that the patent rights do not belong to any agency or to the University, and once the inventor has been made cognizant of the University patent service and the conditions of utilizing this service, the inventor, if he/she wishes to proceed with an attempt to have the invention patented, will have the choice of:

   a. either proceeding for a patent on his/her own or dropping a patent attempt altogether, or

   b. requesting the University to proceed with patenting through its patent services.

4. If 3(b) is the choice of the inventor, the Vice-President, Research will, upon request from the inventor, decide whether such a patent attempt is warranted by the University. If the Vice-President, Research decides that the University does not wish to proceed with a patent attempt on the invention, then the inventor must proceed on his/her own if he/she still wishes to attempt to patent his invention. If the Vice-President, Research decides that the University should proceed, the inventor(s) will be requested to make an assignment to the University of all rights on the discovery. Following such assignment, the University will proceed with patenting within a reasonable time or will assign the patent rights back to the inventor.

5. The chief negotiating officer for this agreement for the University shall be the Vice-President, Research. The general guideline is that the University shall have the opportunity to recover its expenses by receiving 50% of all income until expenses are recovered. The term 'expenses' includes patent service expenses and also other University costs arising from the development and promotion of the invention. Once expenses have been recovered, the University shall be entitled to 20% of the remaining royalties or other income. Income to the University in respect to inventions shall be kept in a holding account under the authority of the Vice-President, Research.

**Interpretation**

Section 14.1 of the Faculty Association Framework Agreement deals with matters of interpretation of this policy.