

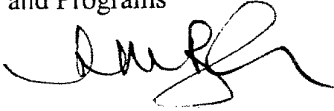


University of Toronto

OFFICE OF THE VICE-PRESIDENT - RESEARCH AND INTERNATIONAL RELATIONS

April 10, 2002

MEMORANDUM

TO: Committee on Academic Policy and Programs
FROM: Heather Munroe-Blum 
RE: Amendment to the Inventions Policy

Background

In 1990, the Governing Council passed a new *Inventions Policy*. Included in that Policy was a definition of "Invention" that referred to several categories of software described in the *Policy on Computer Software* (1988). If the Governing Council replaces the *Policy on Computer Software* with a new *Copyright Policy*, the definition of "Invention" will need to be amended in order to reflect that change.

In addition, if the Governing Council repeals the *Policy on Copyright and Other Proprietary Rights*, it would be prudent to ensure that some of the "other proprietary rights" covered by that document continue to be subject to University policy. These "other proprietary rights" include research data and research "tools," such as cell lines. While they are not, generally speaking, commercially valuable by themselves, they may be valuable in combination with inventions. Even if they are not, it is important that the University have the ability to ensure that they are preserved and made available for research purposes.

New Definition of Invention

The proposed amended definition of "Invention" is presented on the attached sheet, along side the current definition. There are two main changes:

- Reference to software that "falls within Category 1(a) and Category 3 of the University's *Computer Software Policy*" is replaced with a reference to software "excluded from the application of the University's *Copyright Policy*." Under the latter Policy, software that is non-instructional in purpose is excluded and directed to be under the *Inventions Policy*.

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- Specific mention of “research data or research tool” is included in the definition. These items were previously covered by the *Policy on Copyright and Other Proprietary Rights*, under which the University could claim ownership. The practical effect of putting them under the *Inventions Policy* would be to make them jointly owned by the University and their creators. If commercialization was envisaged, they would be disclosed and assigned under the *Inventions Policy*. If not assigned, the University, as co-owner, would have the right to ensure that they were preserved and made available for research purposes.

The overall effect of the amended definition is to make clearer what is, and what is not, an Invention under the University’s policy.

Recommendation

That the Committee recommends to the Academic Board that the definition of “Invention” in the *Inventions Policy* be amended as set out of the attached sheet, and that all other provisions of the *Inventions Policy* remain in force.

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Existing Definition	Proposed Definition
<p>Invention – means "any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter" (s. 2, <i>Patent Act</i>, R.S.C. 1985, c. P-4) and includes related computer software, know-how and now life forms. For the purposes of this policy, the term Invention applies to Inventions, whether or not they are patentable, to computer software that falls within Category 1(b) and Category 3 of the University's <i>Computer Software Policy</i>, to trademarks relating to those Inventions and computer software and to any like proprietary right not covered by the University's <i>Copyright Policy</i>. This policy does not apply to Inventions and computer software (and related trademarks) created in the course of demonstrably private research unrelated to the Inventor's University functions or in the course of consulting activities to outside bodies, when such activities do not involve any substantial use of University facilities.</p>	<p>Invention – means any:</p> <ul style="list-style-type: none"> (a) "new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter" [<i>Patent Act</i>, R.S.C. 1985, c. P-4, s. 2], whether or not patentable; (b) computer software pursuant to section 2.6 of the University's <i>Copyright Policy</i>; (c) research data or research tool, including, without limitation, biological material and other tangible research material; and, (d) proprietary information, know-how or trademark related to any of the foregoing items; <p>and includes all legal and equitable rights relating to such property. This policy does not apply to Inventions created in the course of demonstrably private research unrelated to the Inventor's University functions or in the course of private consulting activities to outside bodies, when such activities do not involve any substantial use of University facilities.</p>