



FOR INFORMATION

PUBLIC

OPEN SESSION

TO: Committee on Academic Policy & Programs

SPONSOR: Vivek Goel, Vice-President, Research & Innovation
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PRESENTER: As above
CONTACT INFO:

DATE: December 4, 2017 for January 11, 2018

AGENDA ITEM: 2

ITEM IDENTIFICATION:

Vice-President, Research & Innovation: *New Guideline on Recognition of Postdoctoral Fellows* as part of the *Inventions Policy*

JURISDICTIONAL INFORMATION:

Policy on research is considered by the Committee on Academic Policy and Programs. Research policies deal with such matters as intellectual property, publication of research results, inventions and innovations. The Vice-President, Research & Innovation is responsible for the administration of the *Inventions Policy*, and is authorized to approve guidelines, regulations and procedures pursuant to the *Policy*. Modifications are reported annually to the Committee on Academic Policy and Programs of the Governing Council.

GOVERNANCE PATH:

1. Committee on Academic Policy & Programs [for Information] (January 11, 2018)

PREVIOUS ACTION TAKEN:

N/A

HIGHLIGHTS:

The *Guideline on Recognition of Postdoctoral Fellows* clarifies the inventor status of postdoctoral fellows from trainees to unionized administrative staff as reflected in the [Memorandum of Agreement](#) signed on May 18, 2017. The Division of the Vice-President, Research & Innovations developed the *Guideline* so that the inclusion of postdoctoral fellows is consistent with the University's established practice of including both unionized and non-unionized postdoctoral fellows as potential inventors.

The new *Guideline on the Recognition of Postdoctoral Fellows* has been developed consultation with the Research Advisory Board and the University of Toronto Faculty Association (UTFA). All bodies' comments and suggestions have been addressed in the current version.

FINANCIAL IMPLICATIONS:

N/A

RECOMMENDATION:

This item is *for information only*.

DOCUMENTATION PROVIDED:

Guideline on Recognition of Postdoctoral Fellows

Inventions Policy

Inventions Policy Guideline on Recognition of Postdoctoral Fellows

This Guideline is issued by the Vice-President, Research and Innovation under the University of Toronto [Inventions Policy](#) (the “Policy”).

Under paragraph 3.3(b) of the Policy, the University owns all rights in inventions made by members of the University’s administrative and support staff as a result of activities covered by their contract of employment. Postdoctoral fellows employed by the University are administrative and support staff of the University.

However, postdoctoral fellows have typically been included in the sharing of rights and net revenues arising from their inventions, proportional to their contribution to the invention as determined by the inventors amongst themselves. The University currently does not intend to change this approach with respect to postdoctoral fellows.

Therefore, for the purposes of paragraph 3.3(b) of the Policy, postdoctoral fellows shall not be considered “administrative and support staff” unless otherwise agreed in writing.

Issued December 4, 2017



UNIVERSITY OF TORONTO

University of Toronto
Governing Council

Inventions Policy

October 30, 2013

To request an official copy of this policy, contact:

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INVENTIONS POLICY

Preamble

The University of Toronto Inventions Policy has three basic objectives:

- to encourage creativity and innovation within the University community;
- to facilitate the translation of knowledge for the greatest possible public benefit, including by commercialization through development of Inventions into commercial products or processes; and,
- to ensure that revenue generated by these Inventions is distributed in a manner consistent with the first two objectives and the advancement of research at the University.

1. Definitions

1.1 **“Invention”** or **“Inventions”** means any:

- (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” [Patent Act, R.S. 1985, c. P-4, s. 2], whether or not patentable;
- (b) computer software under section 2.6 of the University’s *Copyright Policy*;
- (c) research data or research tool, including, without limitation, biological material and other tangible research material; and,
- (d) proprietary information, know how, trademark related to any of the foregoing items;

and includes all legal and equitable rights relating to such property.

1.2 **“Inventor”** or **“Inventors”** means any person, including any member of the academic staff, librarian, administrative staff, postdoctoral fellow, visitor, student, or person holding an academic appointment at the University, who makes or develops an Invention using, in any way, facilities owned, operated or administered by the University and/or funds of, or funds administered by, the University.

1.3 **“Management Fee”** means a fee for services provided by the University in connection with the commercialization of an Invention by the University.

1.4 **“Net Revenue”** means the royalty, licensing and other income or equivalent financial return, including the proceeds of disposition of share capital or other financial instruments, received from the assignment or licensing of the rights in an Invention, less legal and other fees incurred directly in the process of establishing and maintaining the legal protection of those rights.

1.5 **“University”** means The Governing Council of the University of Toronto, as represented by its duly appointed officers and officials and their designates.

2. Application of Policy

- 2.1 **General.** This Policy applies to all Inventions disclosed to the University after the date fixed for implementation of this Policy by the University. 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.
- 2.2 **Agreements.** Notwithstanding any other provision of this Policy:
- (a) all agreements between the University and third parties that relate to Inventions and/or Inventors shall remain in full force; and,
 - (b) the determination of rights in, and the allocation of revenue from, an Invention made by an Inventor who also holds an appointment in an affiliated teaching hospital, centre of excellence, network of centres of excellence or other external institution shall be subject to the terms and conditions of agreements between the University and the hospital, centre, network or institution in force at the time of the disclosure of the Invention, or, in the absence of such an agreement, to negotiation between the institutions involved.

3. Disclosure and Ownership

- 3.1 **Disclosure.** When an Inventor makes an Invention, the Inventor shall make full and complete disclosure of the Invention to the University by submitting an invention disclosure form to the office of the Vice-President, Research and Innovation without unreasonable delay.
- 3.2 **Ownership.** All rights in Inventions shall be owned jointly by the University and the Inventor at the time of their creation, unless these rights have been ceded (in whole or in part) to a third party under a prior written agreement.
- 3.3 **Exception.** Notwithstanding any other provision of this Policy, the University shall solely own all rights in Inventions which are:
- (a) made in the course of activities performed pursuant to direction given by a faculty or staff member of the University specifically with the object of making such an Invention;
 - (b) made by an Inventor who is a member of the administrative and support staff of the University as a result of activities covered by the Inventor's contract of employment; or,
 - (c) specifically commissioned by the University under a written agreement in which the Inventor assigns ownership of the Invention to the University;

and the disposition of all rights in, and the allocation of revenue from, such Inventions shall be at the University's sole discretion.

4. Commercialization

- 4.1 **By University.** An Inventor may offer an Invention to the University if the Inventor wishes the University to take full responsibility for the legal protection and/or commercialization the Invention. The University may undertake a commercial and/or technical assessment or other evaluation of the Invention before accepting the Inventor's offer.

Upon acceptance of the Inventor's offer:

INVENTIONS POLICY

- (a) the Inventor shall assign sole ownership of the Invention to the University; and,
- (b) if the University has not made reasonable efforts to enter into an agreement with a third party to commercialize the Invention within two years of entering into the assignment with the Inventor, the Inventor may request to assume responsibility for legal protection and/or commercialization of the Invention. If so, the University shall assign sole ownership of the Invention to the Inventor, subject to the obligations set out in section 4.2.

4.2 **By Inventor.** If an Inventor wishes to take full responsibility for the legal protection and/or commercialization of an Invention, the Inventor shall inform the University and the University shall assign sole ownership of the Invention to the Inventor subject to certain obligations, including without limitation:

- (a) the University's right to use the Invention for research, teaching and administrative purposes, without cost and in perpetuity;
- (b) any obligations granted to third parties under any applicable funding or other agreements;
- (c) all agreements with respect to the license or assignment of the Inventor's rights in the Invention shall include indemnification of the University; and,
- (d) the Inventor shall provide to the University, on an annual basis, a copy of each such agreement entered into by the Inventor together with a report of all patent activity and business transactions undertaken and revenues received in respect of the Invention.

4.3 **Net Revenue.** Net Revenue shall be shared and distributed in accordance with Appendix A, on an annual basis.

5. Dispute Resolution

5.1 **Process.** If a dispute arises between an Inventor and the University with respect to the application of this Policy, the Inventor and the University shall attempt to resolve the dispute through mediation, failing which the dispute shall be referred for decision to a panel composed of one member nominated by the Inventor, one member nominated by the University and one member selected by the first two or, in the absence of an agreement between them, by the Dean of the Faculty of Law of the University. The third member so selected by the nominees or the Dean of the Faculty of Law will be a person with training as a neutral adjudicator. Each of the Inventor and the University will be permitted to have a representative act on their behalf before the panel. Normally, the parties shall share the costs of the panel's adjudication equally, except for those costs incurred by the Inventor in the use of a designated representative which shall be borne by the Inventor.

5.2 **Standstill.** Until a decision is given by the panel, no action shall be brought by an Inventor against the University, or by the University against the Inventor, in any court of law on any matter arising out of this Policy.

6. Administration of the Policy

6.1 **General.** The Vice-President, Research and Innovation is responsible for the administration of this Policy and is authorized to approve guidelines, regulations and procedures pursuant to this Policy. The Vice-President, Research and Innovation (or designate) is also authorized to execute such assignments, agreements, consents, and other documents as may be necessary or desirable to implement this Policy, and the disposition of rights in Inventions thereunder, on behalf of the University.

INVENTIONS POLICY

Approved June 25, 2007, replacing the Policy approved on March 6, 1990 (as amended on June 3, 2002).
Amended [DRAFT- January 22, 2012]
Revisions approved by the Governing Council on October 30, 2013

Appendix A

In this Appendix:

“**Connaught Fund**” means the fund administered by the University’s Connaught Committee, or any similar fund established by the University to support research.

“**Management Fee**” and “**Net Revenue**” have the meanings prescribed by the Policy.

The tables below show the distribution of Net Revenue to all participants:

Commercialization by the University:

Cumulative Net Revenue	\$0 - \$500,000	\$500,001 - \$5,000,000	More than \$5,000,000
Inventor	60%	60%	60%
Management Fee	20%	20%	20%
Inventor’s Academic Division	10%	3%	0%*
Inventor Academic Department	10%	3%	0%*
Connaught Fund	0%	14%	20%*

Commercialization by the Inventor:

Cumulative Net Revenue	\$0 - \$500,000	\$500,001 - \$5,000,000	More than \$5,000,000
Inventor	75%	75%	75%
Management Fee	0%	0%	0%
Inventor’s Academic Division	12.5%	3.75%	0%*
Inventor’s Academic Department	12.5%	3.75%	0%*
Connaught Fund	0%	17.5%	25%*

* unless otherwise determined by the Vice-President, Research and Innovation in consultation with relevant stakeholders and communicated to the Business Board of Governing Council