

**RESEARCH REGULATION: PATENT  
PLAN**

**University Policy No.:** RH8210  
**Classification:** Research  
**Approving Authority:** Board of Governors  
**Effective Date:** December/00  
**Supersedes:** April/83  
**Last Editorial Change:**  
**Mandated Review:**

**NOTE:** THIS POLICY APPLIES TO ALL PERSONS NOT COVERED BY THE POLICY ON INTELLECTUAL PROPERTY (POLICY #GV0215), APPROVED BY THE BOARD OF GOVERNORS IN NOVEMBER 2000.

1. GENERAL

This regulation is issued with the approval of the Board of Governors in accordance with the University Act, 27(s)(i) and (ii).

2. Membership of the Patent Committee

The Patent Plan Committee is composed of the following members:

- 2.1 Associate Vice-President for Research, or her or his nominee, who shall be Chair
- 2.2 Vice-President, Finance and Operations, or her or his nominee
- 2.3 two members of faculty

The two members of faculty shall be appointed by the President from nominations from the Committee on Faculty Research and Travel.

3. Terms of Reference

The Committee shall:

- 3.1 Advise the President on all matters pertaining to patents as they relate to the University
- 3.2 Carry out those duties specified in the University Patent Plan
- 3.3 Review periodically the University Patent Plan and make appropriate recommendations to the President
- 3.4 Undertake such other duties as may from time to time be referred to it by the President.

#### 4. Procedures

4.1 Where an invention is developed in the course of a person's activities for the University, or using University facilities or with the aid of funds administered by the University, the University has an interest in the invention, and the inventor, in accordance with Part 6, paragraph 27, sections (s) and (t) of the University Act of British Columbia, shall offer to assign the invention to the University. The inventor is entitled to share in the proceeds of the invention in accordance with paragraph 4.6 below.

4.2 Where an activity leading to an invention is supported by a sponsor outside the University, this Regulation applies subject to variations agreed to by the University. Such a sponsor may be entitled to share in the proceeds of the invention.

4.3 Any invention in which the University has an interest, as defined above, shall be referred through the Office of the Vice-President Research to the University Patent Committee. The Committee may recommend to the University officer responsible for the Office of the Vice-President Research that the University either:

4.3.1 waive its rights to the invention, or

4.3.2 take an assignment of the invention

The responsible officer shall consider the recommendation and inform the inventor of her or his decision. This decision should be made as soon as possible, and normally not longer than six months after initial referral of the Patent Committee.

4.4 If the University waives its rights to an invention, the inventor is free to seek patents and/or to license the invention on her or his own behalf.

4.5 If the University decides to take an assignment of an invention it shall, in consultation with the inventor:

4.5.1 Make reasonable efforts to evaluate the potential for commercial or other exploitation of the invention, and, as appropriate, seek licences and options for licences, have applications for patents filed and prosecuted, and otherwise manage the invention, or,

4.5.2 Arrange for their management by recognized patent management corporations such as Canadian Patents and Development Ltd., University Patents Inc., Chicago, Ill., or Research Corporation, New York.

4.6 Where an invention is assigned to the University, revenues arising from the invention shall be used to pay all direct costs associated with the patenting, licensing and trademarking of the invention, and to pay any royalties to a sponsor. If there are net revenues in excess of such costs, the inventor(s) is (are) entitled to share those net revenues equally with the University. Normally,

accounting under this paragraph shall be made annually. Revenue accruing to the University as a result of an invention shall be credited to University general revenue. In allocating such funds priority shall be given to the support of University research activities.

- 4.7 Any invention assigned to the University shall be offered for licensing and commercial exploitation, and the University shall not normally place restrictions on such exploitation.
- 4.8 Where feasible, the University will grant non-exclusive, qualified licences. However, the University recognizes that non-exclusive licensing may not be effective in bringing the invention to the commercial market in a satisfactory manner and thus will grant an exclusive licence if it determines that such is required in the public interest to encourage the marketing and eventual public use of the invention. In all cases, the University shall reserve to itself a right to make or have made and to use the invention within the University of Victoria for its own purposes.
- 4.9 Agreements and contracts with agencies for the licensing and commercial exploitation of inventions, developments and improvements assigned to the University shall be negotiated on behalf of the University by the Office of the Vice-President Research, and, after final review by the University solicitor, may be signed by the University officer responsible for the Office of the Vice-President Research. Information on such agreements and contracts shall be provided to the President for transmission to the Board of Governors.
- 4.10 If a dispute arises between the inventor(s) and the University with respect to the provisions of this Plan, it shall be referred for decision to a Board of Arbitration composed of one member nominated by the inventor(s) and acceptable to the University, one member nominated by the University and acceptable to the inventor(s), and a third member selected by the first two. In the absence of agreement about membership of the Board, the undecided position(s) shall be appointed jointly by the President of the University and the President of the Faculty Association. Until a decision is given by the Board, it is recommended that no action shall be brought by the inventor(s) against the University or by the University against the inventor(s) in any court of law on any matter arising out of this Plan.
- 4.11 Any use of the University's name in connection with the commercialization of an invention by an individual (i.e., an invention not assigned to the University) shall be approved in advance by the Office of the Vice-President Research. Such approval shall be reported to the President for transmission to the Board of Governors.

A sample inventions agreement is on the next page.

5. Sample Inventions Agreement

AGREEMENT

BETWEEN: (the Inventor)  
AND: UNIVERSITY OF VICTORIA (the University)  
AND: (the Sponsor)

WHEREAS:

- a. the Inventor has developed, as part of her or his activities as an employee of the University, or with the aid of University funds or facilities, the invention described as follows:
- b. the University maintains regulations relating to Inventions and Patents (the Regulations), and
- c. the sponsor contributed funds to development of the invention,

THIS AGREEMENT WITNESSES that, pursuant to the Regulations of the Patent Plan the Inventor hereby assigns to the University any and all proprietary rights she/he has or may hereafter acquire in the invention, including all rights to the patenting and commercial exploitation of the invention, on the following conditions:

1. The University shall, in consultation with the Inventor:
  - 1.1 proceed to seek patents and/or make licensing arrangements for the commercial exploitation of the invention, or
  - 1.2 seek an agreement with respect to the invention with one of the following agencies:
    - a. Canadian patents and Development Ltd.,
    - b. University Patents Incorporated, Chicago, Illinois,
    - c. Research Corporation, New York, or
    - d. any other appropriate agency which the University officer responsible for Research Administration, in consultation with the University Patent Committee, may determine.

2. Any revenues arising from the patenting or other exploitation of the invention will be used first to pay all direct costs associated with the patenting, licensing, trademarking and other exploitation of the invention.

The net revenues after payment of these direct costs will be divided as follows:

1. to the Inventor \_\_\_\_\_%,
2. to the University \_\_\_\_\_%,
3. to the Sponsor \_\_\_\_\_%.
4. The University shall cause an accounting under paragraph 3 to be performed annually, and shall pay the Inventor and Sponsor their portions after each such accounting.
5. Any dispute arising between the parties hereto will be referred to arbitration in accordance with the regulations. Until a decision of the Board of Arbitration has been obtained, no party will commence any proceeding in any Court of Law of a matter arising out of this agreement.

DATED this \_\_\_\_\_ day of \_\_\_\_\_, 2\_\_\_\_\_.

a. The Inventor:\_\_\_\_\_

b. The University of Victoria

Per:\_\_\_\_\_

c. The Sponsor:\_\_\_\_\_

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