

Policy Name	Inventions and Technology Transfer		
Policy #	109	Category	Academic
Policy Sponsor	Associate Vice-President, Applied Research and Innovation	Previous Revision Date	Not Applicable
Policy Approved by	President & CEO	Revision Date	January 5, 2018
Procedures Approved by	Provost and Vice-President, Academic	Review Date	See Policy Review Date Or As Needed

See the related [POLICY](#).

DEFINITIONS

Commercialization: means realizing and/or attempting to realize monetary or other commercial value from Inventions and activities related thereto including, without limiting the generality of the foregoing, marketing, protecting rights, interests and entitlements by preparing, filing and prosecuting applications for statutory protection, issuing, causing to be issued and maintaining grants and registrations of intellectual property, funding reduction-to-practice and development of prototypes, Technology Transfer, advising interested parties, and otherwise protecting and/or exploiting interests in Inventions.

Invention: means any:

- (i) new and useful process, machine, manufacture or composition of matter, or any new and useful improvement in any process, machine, manufacture or composition of matter, whether or not patentable;
- (ii) software developed by an Inventor, including source code or object code, and software applications;
- (iii) Literary and/or artistic work;
- (iv) Industrial design;
- (v) Integrated circuit product; and/or
- (vi) Trade secret.

Invention Disclosure Form: means the form to be completed by the Inventor(s) to disclose an Invention or suspected Invention.

Inventor(s): means any Saskatchewan Polytechnic faculty or staff who makes or develops an Invention, alone or in combination with other individuals:

- (i) using, in any way, facilities or assets owned, operated or administered by Saskatchewan Polytechnic or using funds of, or funds administered by, Saskatchewan Polytechnic; or
- (ii) in the course of his or her employment as Polytechnic Personnel.

Net Revenue(s): means any royalty, licensing fee, sale proceed or other income received as a result of the development or Commercialization of the Invention, less all reasonable direct and indirect costs attributable to such development and Commercialization, including but not limited to:

- i) direct salary and benefit costs for personnel engaged in Commercialization activities;
- ii) direct costs of consumable materials;
- iii) development costs;
- iv) prototype costs;
- v) all out-of-pocket expenditures associated with evaluating the Invention, obtaining and maintaining appropriate intellectual property protection of the Invention;
- vi) costs of preventing unauthorized use or infringement of the Invention;
- vii) costs relating to negotiation and implementation of licenses or sale of the Invention; and
- viii) legal or other fees incurred by Saskatchewan Polytechnic, or by any agent or agency retained by Saskatchewan Polytechnic in relation to the Invention.

Polytechnic Resources: means and includes resources owned, administered, or controlled by Saskatchewan Polytechnic including premises, equipment, other facilities, Polytechnic-employee- (including faculty employee) and Polytechnic-student time, effort and assistance and funds, including gifts.

PSBU: means the Professional Services Bargaining Unit of the Saskatchewan Government and General Employees Union.

Research Data: means written and non-written material which is produced by a Polytechnic Personnel during the course of conducting research, including, but not limited to, data, records, computer software, program, database and other computer related materials, product of documentation, in any storage media.

Saskatchewan Polytechnic Personnel: includes all members of the faculty, employees, support staff, visiting researchers, and any other personnel registered and actively engaged in Saskatchewan Polytechnic's research or education programs, together with students as provided for in the Scope of this Policy, above.

SPFA: means the Saskatchewan Polytechnic Faculty Association.

Technology Transfer: means assigning, selling, licensing, or otherwise transferring from Saskatchewan Polytechnic to a third party:

- (i) rights, title, or interests in or to an Invention; and/or
- (ii) materials, wares, or services the making or delivery of which requires the exercise of rights in or to an Invention.

PROCEDURES

1. Disclosure, Ownership and Review of Invention(s)

- 1.1. Saskatchewan Polytechnic Personnel shall notify their immediate supervisor and the Office of Applied Research and Innovation ("OARI") of the development of an Invention. It is understood that such initial contact may be completed verbally, to the Director or Associate Vice-President within OARI. Saskatchewan Polytechnic Personnel will then complete an Invention Disclosure Form using the form to be provided by OARI. If Saskatchewan Polytechnic Personnel have any questions concerning the Invention Disclosure Form, they should contact OARI.
- 1.2. Upon receipt of the Invention Disclosure Form, the OARI will review the information in the form to determine whether the disclosed work of the Saskatchewan Polytechnic Personnel is patentable or can be commercialized. If the Saskatchewan Polytechnic Personnel is a member of the SPFA or the PSBU, then OARI will consult with the Commercialization Committee during the review period.

- 1.3. The Invention review process may include third party experts who will be utilized only under conditions of confidentiality.
- 1.4. The Office of Applied Research and Innovation (“OARI”) shall:
- (a) evaluate and review the ownership of the Invention and the names of the Inventor(s);
 - (b) review the patentability or potential for statutory protection of the Invention; and
 - (c) assess the potential for Commercialization of the Invention.
- 1.5 In determining whether work is an Invention and can be protected by legislative means, the following factors, without limitation, will be taken into consideration by OARI:
- (a) the novelty, utility and obviousness of the idea;
 - (b) existing/related patents or other intellectual property registrations;
 - (c) potential freedom to operate;
 - (d) cost of undertaking a patent or other registration; and
 - (e) availability of Polytechnic funds to complete a patent or other intellectual property registration, and access to external patent funds.
- 1.6 In determining whether an Invention can be commercialized, whether or not patentable, the following factors, without limitation, will be taken into consideration by OARI:
- (a) potential market for the Invention;
 - (b) commercial/business opportunity;
 - (c) development time and cost;
 - (d) availability of development funding;
 - (e) Commercialization strategy; and
 - (f) interest of Inventor(s) and/or potential partners in Commercialization.
- 1.7 Within a maximum of one hundred and eighty (180) days of the date of its receipt of the Invention Disclosure Form, OARI shall notify the Inventor(s) whether or not Saskatchewan Polytechnic wishes to patent the Invention and to recommend the Commercialization of the Invention.
- 1.8 Where Saskatchewan Polytechnic decides to apply for a patent or take steps to protect intellectual property rights in the Invention, the Inventor(s) shall assign all rights in and to the Invention to Saskatchewan Polytechnic, and shall sign any and all required documentation to give effect to such assignment.
- 1.9 Where Saskatchewan Polytechnic decides not to apply for a patent or takes steps to protect its interest in the Invention, Saskatchewan Polytechnic may agree to assign all or part of its rights in and to the Invention to the Inventor in accordance with procedures for such assignment as are established by Saskatchewan Polytechnic.

2. Rights in Invention(s) and Assignment

- 2.1. Saskatchewan Polytechnic shall only grant any rights in Invention(s) to partners on the basis that Saskatchewan Polytechnic receives, at a minimum, a fully paid-up, royalty-free, perpetual, non-exclusive right to use the Invention(s) internally for non-commercial research and educational purposes.
- 2.2. In the event that the Inventor is a member of the SPFA or PSBU, Saskatchewan Polytechnic will assign its rights in and to the Invention in accordance with the applicable Collective Agreement at the time of the assignment.

- 2.3. Where Saskatchewan Polytechnic decides not to patent the Invention(s), Saskatchewan Polytechnic will assign its rights in and to the Invention(s) to the Inventor(s) in return for an agreement in which Saskatchewan Polytechnic shall retain a fully-paid up, royalty-free, perpetual and non-exclusive right to use the Invention(s) for non-commercial research and educational purposes, together with the receipt of Net Revenue(s) as negotiated by Saskatchewan Polytechnic with the Inventor(s).
- 2.4. If the Invention(s) is made or developed under an agreement with a sponsor, the rights with respect to the Invention are subject to the applicable provisions of such agreement.

3. Commercialization of an Invention

- 3.1. Saskatchewan Polytechnic shall seek the most effective form of Commercialization of the Invention(s).
- 3.2. In the event that Commercialization is undertaken pursuant to a license agreement, Saskatchewan Polytechnic will endeavour to enter into an agreement that is competitive with industry norms whenever possible. Payment under the license agreement may be received in the form of licensing fees or royalties.
- 3.3. Any licensing or commercial exploitation agreement shall contain a provision that the licensee will indemnify and save harmless Saskatchewan Polytechnic and Inventor against any and all claims, demands, liabilities and costs of whatever nature or kind arising out of, in connection with, or resulting from these agreements.

4. Distribution of Net Revenue(s)

- 4.1. If Saskatchewan Polytechnic successfully commercializes the Invention, Saskatchewan Polytechnic will equally share (50:50) the Net Revenues from the Commercialization with the Inventor(s). Saskatchewan Polytechnic's portion of Net Revenues generated from the Commercialization will be used to foster and support research at Saskatchewan Polytechnic. Saskatchewan Polytechnic's portion (50%) will further be equally divided between OARI and the Saskatchewan Polytechnic Dean of the school or division where the invention was created. The portion attributed to the Dean will be held by OARI and will be utilized at the Dean's discretion for new applied research and/or for providing benefits to programs which support such research.
- 4.2. In the event that Saskatchewan Polytechnic receives Equity in a new venture created to commercialize the Invention(s), Saskatchewan Polytechnic as compensation for licensing or assigning such Invention to the new venture, will ensure that such Equity shall be shared with the Inventors in accordance the formulae set out above or as otherwise determined by Saskatchewan Polytechnic and the Inventor, based on the evaluation of that Equity at the time it is received by Saskatchewan Polytechnic.
- 4.3. All Net Revenue(s) shall be distributed within ninety (90) days of the end of each fiscal year of Saskatchewan Polytechnic.
- 4.4. An annual report on Commercialization activities involving an Invention shall be prepared by Saskatchewan Polytechnic, which shall include an accounting of revenues and expenses related to each Invention(s).

5. Role and Responsibilities of the OARI

- 5.1. The OARI shall be responsible for:

- (a) implementing these procedures;
- (b) reporting on the outcomes and impact of technology transfer and Commercialization activities;
- (c) recommending changes to these procedures to the Provost and Vice-President, Academic, as required; and
- (d) at the discretion of the Associate Vice-President, Research and Innovation, establishing and maintaining a Commercialization Committee in the format chosen by the Associate Vice-President. If formed, such Committee shall provide input and advice concerning:
 - (i) confirmation of the proper Inventors in relation to any Invention;
 - (ii) allocation of the interests of inventors in an Invention where there are multiple inventors;
 - (iii) decisions by Saskatchewan Polytechnic on whether to proceed with Commercialization of an Invention;
 - (iv) the choice of methods of Commercialization of an Invention: and
 - (v) whether to continue/renew intellectual property registrations which have been registered by Saskatchewan Polytechnic.

6. Appeals

6.1. In cases where Saskatchewan Polytechnic Personnel are subject to actions undertaken by Saskatchewan Polytechnic pursuant to the provisions provided herein, and where such Personnel feel those actions are inappropriate or unfair, the actions may be appealed by submitting a request in writing to the Provost and Vice-President, Academic (“VP Academic”).

6.2. The VP Academic will respond to the appeal by taking the following steps, to the extent required, until resolution is achieved:

- (a) Informal mediation, conducted by the VP Academic or their designate. Following consultation with the parties, the VP Academic will recommend a course of action. If the recommendation or the results of the VP Academic’s actions do not resolve the issue, the process shall move on to the step provided in 6.2(b) immediately below.
- (b) Formal mediation, using a mediator selected by Saskatchewan Polytechnic and the appellant, will be undertaken with the costs of engaging such a mediator being shared equally by Saskatchewan Polytechnic and the appellant. The mediator shall conduct discussions with the parties concerned and recommend a course of action to resolve the issues. If there is no mutual agreement on the selection of a mediator, or the mediator’s recommendations fail to resolve the issues, then the process will move to the step provided in 6.2(c) immediately below.
- (c) Confidential arbitration, using a single arbitrator selected by agreement between the parties, under the provisions of *The Arbitration Act, 1992* of the Province of Saskatchewan (the “Act”) as amended or substituted from time to time. If the parties cannot agree on an arbitrator within ten (10) days after referral of a matter to arbitration then the single arbitrator shall be appointed by the Court of Queen’s Bench under the provisions of the Act. The decision of the Arbitrator shall be final and binding upon all parties. The costs of the arbitration shall be apportioned between the parties as the arbitrator may decide.

7. Exceptions

7.1. No exception to these procedures shall be made without the prior written consent of the AVP-ARI.

RELATED POLICIES/DOCUMENTS

Inventions and Technology Transfer Policy