



Policy Title:

# Innovation and Technology Transfer Policy

University Classification & Policy Number:

A-005-23

Approval Body:

Administration

Responsible Designate:

The Vice-President, Research & Innovation is responsible for the communication, administration, and interpretation of this Policy.

Established:

September 8,  
2023

Revised:

Editorial Revisions:

Scheduled Review:  
2028

## 1.0 Policy Purpose

**1.01** The University of Winnipeg (“University”) encourages research and scholarship that develops and advances knowledge. Additionally, the University supports technology transfer that includes patenting and/or commercialization activities in a manner consistent with the public interest and that of the University.

**1.02** This Policy aims to achieve the following:

- a) support and sustain a high-quality research environment that promotes research and innovation during all stages of discovery;
- b) encourage the disclosure, evaluation and, if appropriate, intellectual property protection of research discoveries and inventions made by faculty, staff and students of the University;
- c) foster an environment that encourages the advancement of research in a manner that is consistent with the policies and regulations of the University; and
- d) facilitate and encourage the transfer of technology to partners and, ultimately the commercialization of University research discoveries and inventions to the broader public.

## 2.0 Definitions

**2.01** The following definitions apply to terms as they are used in this Policy:

- a) **“UWFA”**: the University of Winnipeg Faculty Association;
- b) **“Invention”** includes 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; and
  - ii. software developed by University Personnel as an expected part of their employment at the University; For clarity, in the case of UWFA members the software must have been produced as a result of a specific written request of the employer, agreed to by the member;

- c) **“Invention Disclosure Form”**: the form to be completed by the Inventor(s) to disclose an Invention or suspected Invention;
- d) **“Inventor(s)”**: any University Personnel who makes or develops an Invention, alone or in combination with other individuals:
  - i. using, in any way, facilities owned, operated or administered by the University or using funds of, or funds administered by, the University, or
  - ii. in the course of their employment as University Personnel;
- e) **“Net Revenue(s)”**: any royalty, licensing and any other income received as a result of the development or commercialization of the Invention, less any legal or other fees incurred by the University, or by any agent or agency retained by the University, to register, develop, exploit or administer the intellectual property of the Invention; “
- f) **“Primary Appointment”**: the lead institution (University or affiliated research hospital) responsible for the appointment and personnel costs of the Inventor;
- g) **“Research Data”**: written and non-written material which is produced by a University 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; and
- h) **“University Personnel”**: all members of the faculty, support staff, postdoctoral fellows and graduate students, undergraduate students, visiting researchers, and any other personnel registered and actively engaged in the University’s research or education programs.

### 3.0 Scope

**3.01** This Policy applies to all members of the University community, including but not limited to, academic staff, support staff, graduate students, postdoctoral fellows, visiting researchers and trainees.

### 4.0 Policy Elements

#### 4.01 Ownership

4.01.01 Ownership of all Inventions and Research Data is subject to the University of Winnipeg UWFA collective agreement.

4.01.02 For the purposes of commercialization, the University shall retain ownership of all Inventions and Research Data except when:

- a) the Invention results from activities carried out in collaboration with Inventor(s) from other Institution(s), in which case ownership shall be negotiated by the University on a case-by-case basis;
- b) the Invention results from activities carried out under a sponsored research contract, the terms of which assigned the ownership of Inventions to the sponsor(s);
- c) the Invention results from private activities of the Inventor(s) carried out wholly on the Inventor(s)’ own time with no involvement of University facilities or resources; or
- d) the rights in and to the Invention have been returned to the Inventor(s) by the University.

## **4.02 Invention Disclosure and Review**

4.02.01 The Inventor(s) shall promptly disclose an Invention or a suspected Invention in writing to the Vice-President, Research and Innovation using the Invention Disclosure Form unless they are a UWFA member, in which case they shall only make such disclosure if they are interested in the commercial utilization of that Invention.

4.02.02 The Inventor(s) shall not take any steps to place the Invention in the public domain by a lecture or publication or otherwise until a decision has been rendered regarding the patentability or commercialization of the Invention.

4.02.03 The Office of the Vice-President, Research and Innovation shall:

- a) evaluate and review the ownership of the Invention and the names of the Inventor(s);
- b) review the patentability of the Invention;
- c) assess the potential for commercialization of the Invention. [Note: where the Inventor is a UWFA members, such review shall be in accordance with the Collective Agreement]; and
- d) assign the disclosure to the University of Manitoba Technology Transfer Office for further assessment.

4.02.04 Within a maximum of one hundred and eighty (180) days of the date of receipt of the Invention Disclosure Form by the University, the University shall notify the Inventor(s) as to whether or not the University wishes to patent the Invention and recommend commercialization of the Invention.

4.02.05 Where the University decides to apply for a patent for the Invention, the Inventor(s) shall assign all rights in and to the Invention to the University, including, but not limited to, signing all the required documentation to give effect to such assignment.

4.02.06 Where the University decides not to apply for a patent for the Invention, the University may agree to assign all or part of its rights in and to the Invention to the Inventor in accordance with procedures and conditions for such assignment established by the University; provided that in the case of Inventor(s) who are UWFA members, such assignment shall be in accordance with the guidelines established in the Collective Agreement for the UWFA at the time of the assignment.

## **4.03 Commercialization of an Invention**

4.03.01 When considering whether or not the commercialization of an Invention will be undertaken and, if so, the most effective form of commercialization, the University will consider the following factors:

- a) the amount of further development work required;
- b) the potential market for the invention; and
- c) whether commercialization of the Invention would be consistent with the strategic vision of the University.

4.03.02 Within the time period set out in section 4.02.04, the University will inform the Inventor(s) of the options open to the Inventor(s) regarding commercialization of the Invention, including, but not limited to, the granting of a license and the creation of a

new venture, and will establish the terms and conditions under which the University will proceed with the commercialization of the Invention. Where an Inventor is a UWFA member, such terms and conditions shall be in accordance with those set out in the Collective Agreement in effect at the date of the decision to commercialize the Invention.

#### **4.04 Distribution of Net Revenue**

4.04.01 Subject to section 4.03.02, the Net Revenue (s) shall be distributed as follows:

- a) in the case where the University assumes full responsibility for the commercialization of the Invention and the Inventor is a UWFA member: the Net Revenue(s) shall be paid in accordance with the guidelines established in the UWFA Collective Agreement in effect at the date of decision to commercialize the Invention; or
- b) in the case where the University assumes full responsibility for the commercialization of the Invention for a non-UWFA member: 80% of the first \$100,000 and 50% of the remainder of Net Revenue(s) received by University shall be paid to the Inventor(s).

4.04.02 In the event that there is more than one Inventor with respect to an Invention, the University (in consultation with the f UWFA member) shall determine the relative contribution of each Inventor to the Invention. This shall also determine the relative share of the Net Revenue(s) payable to each Inventor.

4.04.03 The University shall provide an annual reporting on the commercialization activities to the Inventor(s) receiving Net Revenues.

#### **4.05 Affiliated Hospitals and Research Institutes**

4.05.01 Notwithstanding anything contained in this Policy, University Personnel whose Primary Appointment is at an affiliated hospital or at one of the research institutes affiliated with the University shall be subject to the intellectual property and technology transfer policy of such hospital or institute. The University shall work with its affiliated hospitals and research institutes to endeavor to harmonize the intellectual property policies of such hospitals and institutes with the University's Policy.

#### **4.05 Confidentiality**

4.05.01 All University Personnel involved in the process of Invention disclosure, review, ownership determination, commercialization, patentability evaluation and commercial exploitation shall maintain the confidentiality of the Invention until such time that it receives adequate intellectual property protection.

4.05.02 Where appropriate, the Vice-President, Research and Innovation shall use non-disclosure agreements to ensure confidentiality when dealing with non-University Personnel.

#### **4.06 Procedures**

4.06.01 The Vice-President, Research and Innovation, shall establish procedures relating to the implementation of this Policy, including but not limited to, the patentability of an

Invention, assignment, the commercialization of an Invention and the distribution of Net Revenue(s). These procedures shall, in the case of UWFA members, be consistent with the Collective Agreement.

4.06.02 No exception can be made to this Policy without the written consent of the Office of the Vice-President, Research and Innovation.

## **5.0 Related Policies, Procedures and Institutional Documents**

- Collective Agreement between The University of Winnipeg and The University of Winnipeg Faculty Association (Regular Academic Staff)