

Memorial University Intellectual Property (IP) Policy

Frequently Asked Questions (FAQ)

(1) *My position is in one of the bargaining units so how does this policy affect me?*

If the Collective Agreement includes terms and conditions related to IP, those terms and conditions in the Collective Agreement apply to you. In some cases, your Collective Agreement may reference the Memorial University IP Policy. To the extent that the IP Policy is not inconsistent with the language of the Collective Agreement to which you are subject, those features of the IP Policy will apply.

(2) *I have a letter of employment that includes terms and conditions related to intellectual property. How does this policy affect me?*

Any terms and conditions related to IP in your letter of employment apply to you. In some cases, your letter of employment may reference the Memorial University IP Policy. To the extent that the IP Policy is not inconsistent with the language of your letter of employment, those features of the IP Policy will apply.

(3) *I am a graduate student and have received an offer of admission that indicates that the University owns the intellectual property rights associated with my research. I thought that it was a creator-owned policy?*

If your offer of admission indicates that the University owns the IP rights in the IP that you develop as a graduate student, you will be undertaking your research on a project that is subject to an agreement between the University and a sponsor to transfer IP rights to the sponsor. You will be required, as a condition of your acceptance of the offer of admission, to undertake your research in a manner that is consistent with the terms and conditions of that agreement. While the University requires initial ownership of IP rights in order to be able to meet its contractual obligations to third-party sponsors of the research, the University is prepared to fully assign to you all of its IP rights in the IP that you create that the University does not require to be retained by the University to meet the contractual obligations to such third parties.

(4) *If I own intellectual property that I developed during the course of my employment at Memorial, is Memorial expecting that I will reimburse a portion of my salary associated with the time spent to develop the intellectual property if I wish to transfer or commercialize that intellectual property?*

No, the University has many of its Direct Costs covered through funding provided to the University from the Government of Newfoundland and Labrador through the annual grant from government. For example, this would generally include the salaries of faculty members and permanent staff at the University. In other cases, the direct costs, such as the salary of research staff and stipends for graduate students, are often covered from funding provided by a research sponsor, including the private sector, external organizations and governments. Where such costs have already been covered, there would be no expectation for these costs to be recovered as a result of the transfer or commercialization of IP.

(5) If my company sponsors research at the University and wishes to obtain a right to use the intellectual property for commercial purposes, is Memorial expecting that my company reimburses all of the Direct and Indirect Costs associated with the research that resulted in the intellectual property?

No, the Direct and Indirect Costs that your company has already covered or which have been covered by other sources of funding to the University in support of the project you are sponsoring would not be payable. For example, if the IP was developed through an NSERC partnership grant, some of the Direct and Indirect Costs would have been covered by the NSERC funding and the salary of the faculty members involved in the research would have been covered by the annual grant to the University by the Government of Newfoundland and Labrador. Normally, any amount payable to the University associated with the commercial license would depend on whether your company and any other funding agencies paid direct and indirect costs as part of their funding for the research.

(6) My company is interested in sponsoring research at the University but wishes to have exclusive rights for commercial exploitation of the intellectual property that is developed from that research. Is this possible?

Yes, this is possible so long as the University's direct and indirect costs associated with undertaking the research are covered. This may be through a combination of funding sources as discussed in Question (5) above. Furthermore, the University is committed to the principle that the creators of intellectual property have a right to benefit financially from the exploitation of the intellectual property that they create. Your company can negotiate with the University in advance of the research being undertaken an exclusivity payment that would be provided fully to the creators of intellectual property as payment for the exclusive right to use their intellectual property for commercial purposes. The Principal Investigator must be in agreement with the exclusivity payment and the University will ensure that all researchers who are subsequently engaged in the research provide their informed consent to participate under the terms and conditions of an agreement containing an exclusivity payment. If your company does not wish to make an exclusivity payment

as part of signing the research agreement, your company is free to negotiate exclusivity with the creators once the intellectual property has been created and your company has evaluated its commercial potential. Any direct negotiation must also ensure that the University is reimbursed for any Direct and Indirect Costs that have not been covered as discussed in Question (5). In all cases, the University retains a right to use all intellectual property for its future non-commercial research, teaching and educational purposes. There can be a moratorium for up to 6 months on publications, including thesis deposit in the library, and on the timeframe in which the University can begin to use the IP for its non-commercial academic purposes.

(7) I am a continuing employee of Memorial and I would like to start a spin-off company related to intellectual property that I have developed and which is not associated with any contractual obligations by Memorial to any third parties. Is this possible?

Yes, this is possible by following the Procedures for Transfer and Commercialization of Intellectual Property. If there is any prospect that your future work at the University will continue to support, directly or indirectly, the activities of your spin-off company, you must proactively disclose such potential conflicts in accordance with the Conflict of Interest Policy and abide by directions given following an evaluation of the conflict of interest by the Conflict of Interest Committee. The University has a number of mechanisms that can be used to effectively manage such conflicts to enable a continuing employee (faculty or staff) to be involved in a spin-off company that has an ongoing relationship with the University with respect to the transfer or commercialization of IP.