

POLICY 7.4 – Patents

Policy Category: Research
Effective Date: April 28, 1983
Supersedes: March 15, 1974

1. Research Objectives and Patenting

The University recognizes as a fundamental principle that it should maintain complete freedom of research and unrestricted dissemination of information. Research done solely in anticipation of profit is incompatible with the aims of the University.

Nevertheless, the University recognizes that in the course of its research activities, ideas or processes may be developed on which, in the public interest, patents should be sought. The University and the inventor have a responsibility to promote the effective development and utilization of such discoveries, and to ensure that they will not be restricted in their use in a way that is detrimental to the public interest.

The University recognizes that the payment to the inventor of revenue from an invention is a desirable incentive towards invention. It also recognizes that the effective development of inventions based on its research activities has occasionally provided revenues that have made possible the encouragement of further research, both in the field in which the invention was developed and in the University as a whole.

2. Applicability Within the University

This policy statement forms a broad, general basis for the conduct of all matters pertaining to patents within the University's activities and functions. As such, it applies to all of its organizational elements, faculty, staff and students.

3. Equity in Inventions

The University acknowledges that, with the possible exception of externally sponsored research, it has no direct equity in any invention developed by a member of its faculty, staff or student body (notwithstanding that the invention might be intellectually conceived and developed in the course of University supported research and utilizing University facilities and equipment).

4. Procedural Choice of the University Inventor

If a University member in the course of his normal University activities makes an invention or discovery which has patent possibilities, and that person wishes to apply for a patent, he may do so as an individual independent of the University, or he may proceed through the University's Patent Plan. In this regard, the University draws attention to the fact that it cannot accept responsibility for the exercise of discretion by one of its members in respect of retention or revelation of confidential information imparted to him by the inventor.

5. The University's Patent Plan

An invention submitted to the University and accepted for inclusion in the University Patent Plan will be subject to the provisions of an existing agreement between the University and a patenting agency or to the provisions of such other agreements as may be made from time to time between the University, the University inventor, and third parties who support research projects in the University.

From the date of such assignment to the University by the inventor, the University or outside agency (as the case may be) shall thereafter be responsible for the legal and other expenses and costs involved in the prosecution of patent proceedings, and possible subsequent further developments and promotion.

6. Sharing of Net Invention Profits by the University

The University affirms that it will provide recognition to inventors in order to encourage incentive, and that a portion of revenues from patentable inventions will normally be devoted to the further support of research.

Net monies shall mean the net profits derived from licensing or commercialization of the patented product, equipment or process after deduction of all expenses incurred for all patent matters (searches, obtaining and maintaining patent protection) and all licensing costs.

The apportionment of net revenues to the University from invention, received in a given University fiscal year, will be as follows:

- (a) For net revenue from a given invention up to \$1,000.00 all revenue shall go to the University inventor.
- (b) For net revenue from a given invention exceeding \$1,000.00, but not exceeding \$30,000.00, the amount in excess of \$1,000.00, but not exceeding \$30,000.00, the amount in excess of \$1,000.00 will be shared equally between the University inventor and the University.
- (c) For net revenue from a given invention exceeding \$30,000.00, the amount in excess of \$30,000.000 will be shared 30% to the University inventor and 70% to the University.

The share of net profits from invention as apportioned to the University by the above Plan will be placed in a university research fund. Allocation from this fund to University research projects will be by grant awards, with priority given to support of projects whose inventions provided the research fund. Unallocated balances in the fund shall be invested, and interest earned thereon shall accrue to the benefit of the fund. The fund may also be used at the discretion of the Assistant Vice-President (Research) or the Vice-President (Operations & Finance), to finance further patents or agreements on a recoverable basis.

EXAMPLE

Total Net Revenue from Invention to the University	Revenue to the Inventor	Revenue to the University Research Fund
\$	\$	\$
1,000	1,000	--
1,200	1,100	100
2,000	1,500	500
10,000	5,500	4,500
30,000	15,500	14,500
32,000	16,100	15,900
50,000	21,500	28,500
100,000	36,500	63,500
1,000,000	306,500	693,500
2,000,000	606,500	1,393,500

7. Disputes

If a dispute should arise between a University inventor and the University with regard to University patent matters, and this cannot be resolved through reference to the Assistant Vice-President (Research) then the question shall be referred for decision to a Board of Arbitration composed of one representative nominated by the University inventor, one by the University, and a third member selected by the two representatives thus chosen, who shall be Chair. The majority decision of such a Board shall be binding on both parties.

8. Administration of Patent Policy

The Assistant Vice-President (Research) is responsible for general surveillance of the University's Patent Policy.

The following procedures apply in all instances where a member of the University may have a potentially patentable invention or discovery.

- (a) The University member will complete a "Report of an Invention by a University Inventor" that is similar in scope and content to the one appended.
- (b) The Report will be forwarded to the Assistant Vice-President (Research). The University inventor should also notify his Department Chair of this action.
- (c) The Assistant Vice-President (Research) will review the Report and ascertain that the proprietary rights are as claimed in the Report. The Assistant Vice-President (Research) will then ascertain the wishes of the University inventor in proceeding with the patent application. If the inventor wishes to participate in the University Patents Plan, he will then enter into an agreement with the University whereby he assigns all rights on the discovery to the University.
- (d) Selection of the agency to assist in the further evaluation of the invention to determine its patentability and possible subsequent commercial development shall be the responsibility of the Assistant Vice-President (Research) after consultation with the inventor and the Vice-President (Operations & Finance). Licensing agreements stemming from patents or other know how will be submitted to the Vice-President (Operations & Finance) for approval.

- (e) Initial correspondence with the patent or development agency shall be through the office of the Assistant Vice-President (Research). Further correspondence may be directly between the inventor and the agency but copies of all correspondence shall be sent to the Assistant Vice-President (Research).

NOTE: See also the **Appendix - "Report on an Invention"** which follows.

1. Title of Invention (**Non-Confidential**):

2. Name(s), Citizenship(s), Department(s) and Social Insurance Number(s) of Inventor(s)

Principal Inventor: _____ Citizenship: _____
(Note: Person to whom inquiries for additional information should be made)

Permanent Address: _____ S.I.N.: _____
_____ **Phone Numbers:**

University Address: _____ Home: _____
Office: _____

e-mail/internet: _____ Fax: _____

Signature: _____

Co Inventor: _____ Citizenship: _____
(Note: Person to whom inquiries for additional information should be made)

Permanent Address: _____ S.I.N.: _____
_____ **Phone Numbers:**

University Address: _____ Home: _____
Office: _____

e-mail/internet: _____ Fax: _____

Signature: _____

Co Inventor: _____ Citizenship: _____
(Note: Person to whom inquiries for additional information should be made)

Permanent Address: _____ S.I.N.: _____
_____ **Phone Numbers:**

University Address: _____ Home: _____
Office: _____

e-mail/internet: _____ Fax: _____

Signature: _____

NOTE to Principal Inventor: If more Co-Inventors, please add separate sheet.

Dean _____ Chair _____

Please fill in names of your Dean and Chair.



3. **Detailed Description of Invention (Please use additional sheets if necessary.)**
Enclose sketches, drawings, photographs, screen prints and other materials that help illustrate the description. (Rough artwork, flow sheets, photographs and penciled graphs are satisfactory as long as they tell a clear and understandable story.)

4. **Advantages and Unique Features**
Please identify and expand on the **novel** and **unusual** features of the Invention. How does it differ from the existing technology? What problems does it solve, or what advantages does it possess?

Use additional sheets to elaborate, or attach descriptive materials

5. **Application of the Invention**
List the potential applications you envision resulting from this invention.

6. **If not covered in 4. above, please:**
(a) Describe alternate technologies/products which you are aware accomplish the same purpose as this invention, along with the companies that market, manufacture or make use of them.

7. Are written and dated laboratory records and data available? Give reference dates and physical location, **but do not enclose**.

8. **Invention History:**

	Date (approx.)	Location and Comments
Initial idea		
First description of complete invention, oral or written		
Proof of principle, reduction to practice; successful demo or prototype		
First publication (oral, written, e-mail) which describes the invention (may bar patent)		
Subsequent publications		

9. **Future Publications**

Are there any planned publications (theses, reports, preprints, reprints, abstracts etc.) pertaining to the invention? Please list **with expected publication dates**, and attach copies. Include manuscripts for publication (hardcopy and electronic disk) (submitted or not), news release, feature articles and items for internal publications.

- a. _____
- b. _____
- c. _____
- d. _____

10. Prior Art

- a) Has a recent literature search been performed. If so, with what result? Please include names of databases search strategy used.
- b) Has a recent patent search been performed, and if so, with what result? Please include names of databases search strategy used.

11. Funding

Was all work done at UWO? How was the work that led to the invention funded? Please provide name of funding agencies/ companies and year(s) of funding.

12. Future Research Plans

- a. Does the invention possess disadvantages or limitations? Can they be overcome? How? Is there further research planned or underway to address these issues?
- b. List any key competing research groups currently engaged in research and development in this area.

13. Commercial Interest

Has there been any commercial interest shown at this stage? Name companies and contact information if possible. Do you know of any others that might be interested.

14. Has the invention ever been available for sale?

15. Will you consider assigning this technology to UWO in exchange for a share of the revenue which might be generated by UWO's commercialization of this technology?

Acknowledgement of Receipt by THE UNIVERSITY OF WESTERN ONTARIO

_____ Date: _____

Doug Gill, Director – OFFICE of INDUSTRY LIAISON

OIL Representative handling this file.: _____

Phone: _____ E-mail: _____ Fax: _____

Note: To be completed by the Office of Industry Liaison.