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Patentable Intellectual Property

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Article

16

Intellectual property is at the heart of work in the academic community, from the development of

consumer products to the ways courses are taught. This issue focuses specifically on patentable intellectual property as defined in Article 16 of the new 2008-2011 Collective Agreement.

Generally, patentable intellectual property (better known as a patent) is an invention defined under the Patent Act as “new and useful art, process, machine, manufacture or composition of matter, or new and useful improvement in any art, process, machine, manufacture or composition of matter.” Research data, tools, material, proprietary information, and know-how could also fall under the definition of an invention.

With respect to patents and intellectual property, Queen's is considered to possess one of the more progressive policies among universities, especially in the early days of the policy change. The progressive nature of this policy centres on the automatic ownership of an invention by the Member(s) who created the invention. The typical

policy used by most other universities and workplaces is automatic ownership by the employer. By law, the creator(s) is still the inventor(s), but at those other universities, the ownership of the patent is automatically assumed by the university and not by the creator or inventor, as is the case at Queen's (for the purpose of simplicity, reference to a single Member or inventor or creator shall be used hereafter to represent an individual or a group).

The Queen's policy on patentable intellectual property has been successful in fostering development and commercialization activities through its partnership with PARTEQ Innovations, the at-arms-length organization established by Queen's in 1987. This approach has been adopted by other research-intensive universities, such as the recent adoption by the University of Toronto.

A number of changes were introduced in the new 2008-2011 Collective Agreement. The changes include new language, limitations to ownership of inventions created by a Member at work, definitions, more detailed disclosures of procedural matters, and a protocol for resolving disputes. Article 16 of the 2008-2011 Collective Agreement continues to build on the successful formula of intellectual property ownership by the Member. This formula also includes the right to publish in the public domain if a decision was made not to patent or not to commercialize an invention. Similar features can be found in the more recent intellectual

property policy documents of other universities, such as the University of Toronto.

Unlike the previous 2005-2008 Collective Agreement, the new Article 16 introduces the intent that this article applies *only to intellectual property created by a Member in the course of his or her employment by the University*. This wording should be interpreted as being an invention created as part of the Member's work and/or using University facilities and resources, as opposed to an invention created in one's basement or garage with no relationship to one's appointment at Queen's. Such an invention, derived in one's basement or garage and with no relationship to one's appointment at Queen's, remains outside the jurisdiction of the University.

The role of the University, through the Vice-Principal (Research), is outlined in greater detail in Article 16 and with new passages. As in the previous collective agreements, a decision to patent and commercialize shall be disclosed to the Vice-Principal (Research). Reporting is executed through a PARTEQ-based mechanism (usually the case) or any other form prescribed by the Vice-Principal (Research). In most cases, this disclosure requirement effectively forms a commitment to grant PARTEQ an exclusive opportunity for 90 calendar days to make a commercialization offer acceptable to the inventor (note that it was 60 undefined days in the previous Collective Agreement). If PARTEQ declines to make an offer, the

inventor is free to pursue any other opportunities with any other parties.

The previous 2005-2008 Collective Agreement only indicates reporting to the Vice-Principal (Research) for the above purpose with no discussion of other roles. The new Article 16 introduces details concerning additional roles for the Vice-Principal (Research) when considering such reports, roles focusing on due diligence with respect to issues of inventorship and consistency with the University's research policy and contractual constraints.

Also, for the first time, Article 16 contains a protocol for resolving disputes concerning decisions to commercialize, or for decisions to commercialize through PARTEQ or not. Unlike in the past, where there was no defined mechanism or body for a Member to approach for such disputes, the new article identifies the Vice-Principal (Research) as the person or office to engage for disputes of this nature.

As one can easily gather, the legal and liability issues surrounding patents are diverse and complex. Disputes could arise at all stages of commercialization. Disputes are often very taxing for all parties involved and hence should be prevented. Disputes could even prevent commercialization.

As a "quick" solution to prevent potential disputes, the University bargaining team tabled a proposal during the recent negotiations to become the automatic owner of intellectual property as defined in Article 16. Such a solution was also proposed in the prior round of negotiations. The most recent proposal included complex language and procedures that would have resulted in automatic ownership by the University. Such a proposal would have introduced a regressive change to Queen's patentable intellectual property policy, making it similar to

the patent regimes at most other universities and work places. Since this "dispute" issue ended up being far more complex than portrayed by the University's proposed solution, the bargaining teams agreed to form a Subcommittee of the JCAA (Joint Committee for Administering the Agreement) to study the matter further.

Another issue that should be considered in any discussion about patent commercialization at Queen's concerns the reality and the effectiveness of the procedures outlined in the new Article 16. Since the timeliness of patent protection is a major consideration in many cases, the effectiveness of the due diligence procedures outlined in Article 16 will need to be assessed in real-time.

There are likely other issues that ought to be discussed by the Joint Committee on Intellectual Property before it makes its recommendations. Please consider sending your concerns to QUFA if you wish them to be put on the table.

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