

**A Guide to**

# **Intellectual Property**

**for Graduate Students  
and Postdoctoral Scholars<sup>©</sup>**



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# I. Introduction

*“If you read only one part of this document, make it this one.”*

As a graduate or postdoctoral researcher, you are an active scholar: you express ideas in a valuable and original manner, conduct research that leads to novel and important findings, or invent new and different ways of building things. All of these endeavours have an intellectual property component that belongs to you, partly or wholly, and may be protected.

However, the conditions and circumstances in which this research is undertaken can vary widely. Research can be undertaken at different universities; it can be funded in a variety of ways from a variety of different sources. Your role as a researcher can depend on your working relationship with your supervisor and his or her research. All of these variables can influence the degree to which your stake in intellectual property can be protected.

The aim of the following document is to make you aware of the rules and regulations that surround intellectual property rights. It will become clear to you upon reading it that often these regulations depend on your personal circumstances: the policies of the institution you are attending, the conventions of your field, the way your research is being funded and the practices of your supervisor, among others.

It is beyond the scope of this document to enumerate all possible contingencies and their consequences. If it contains one message, it is that you have the responsibility to inform yourself in advance of how these circumstances will affect your intellectual property rights. Writ large, this may entail finding out about and/or negotiating protocol on three levels:

- with your university
- with your supervisor
- with your funding source (grants and others)

All three of these can play a role in determining the extent of your intellectual property rights. As graduate students, it is important for you to be clear at the outset of your studies about how the varied working arrangements out of which your research arises will affect the status of that research as intellectual property.

## What is intellectual property?

Intellectual property (or “IP”) simply defined is any form of knowledge or expression created partly or wholly with one's intellect and which can be legally protected. It is the product of the act of creation, such as an invention, a piece of writing, a painting, a design, a piece of music, etc. An invention is any product of the human intellect that is unique, novel, and unobvious to a person skilled in the field of invention. Individuals and/or institutions can own the products of their creativity and innovation in the same

way they can own physical property. An owner of IP can control and receive payment for its use, so IP has value in the marketplace. There are four main types of statutory IP protection:

1. patents for inventions – new and improved products and processes that are capable of industrial application;
2. trademarks for brand identity – of goods and services, allowing distinctions to be made between different traders;
3. designs for product appearance – of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture, or materials of the product itself or its ornamentation; and,
4. copyright for material – literary and artistic material, music, films, sound recordings, and broadcasts, including software and multimedia. In addition, moral rights are the author's right to integrity of the creation in its original form, to attribution, and to prevention of unfavorable associations with the author's creation.

### **Some examples of IP include:**

- Ideas that can be documented
- Inventions
- Artistic expression or literary creation
- Unique name
- Business methods
- Industrial processes
- Chemical formulas
- Electronic Circuits
- Some Software
- Drugs
- Genetically engineered organisms
- Presentations
- Publications

## **As a graduate student do I have intellectual property rights?**

The law grants intellectual property rights to all creators/inventors, irrespective of their status at a university or research institution (whether graduate or undergraduate student, postdoctoral scholar, professor or otherwise). Students have intellectual property rights and rights to protection under the copyright and patent regimes, provided they satisfy the requirements of the law.

In addition, all parties involved in research are governed by specific university policies. Unless they have signed an agreement stating otherwise, they have the right to own the copyright for their own written or artistic work or computer software, and to own the patent rights to any invention they might create, including computer software in some countries. Depending on the circumstances, these rights are often shared with others – their supervisor, their fellow students, and research staff. This will be determined by the requirements of the Law, by university policies, and by conventions of the discipline (see

[section II](#)). Policies can vary from institution to institution, so it is imperative to check with your university's Office of Technology Transfer or equivalent. In some Canadian Universities these offices are called the university Industry Liaison Office (UILO). Offices of Technology Transfer or Intellectual Property Management Offices, as they are also known, have been established at most research intensive universities. They provide advice and services to the university community in order to facilitate the protection and commercialization of intellectual property.

In addition to the laws related to intellectual property and university policies, conventions or local customs should be acknowledged and may apply. For example, customs may be followed regarding the recognition of individuals as co-authors in an article or paper presented at a conference. Different rules apply to patents since the Law requires that all inventors having contributed creatively to the claims of the patent be listed on it.

## **How are intellectual property rights determined?**

There are three main variables in the equation that determines the shape your intellectual property rights will take: conventions of your discipline, Canadian law that deals with forms of intellectual property and university regulations. In what follows, these three factors are explored in turn.

## II. Conventions of Disciplines

The conventions of your particular discipline can influence intellectual property rights to the extent that they may determine the degree of acknowledgment you are accorded for participation in a project or published article.

Conventions about what criteria define a joint author vary among disciplines. The narrowest definition comes from copyright law and applies to collaborations in literary and artistic works in some of the humanities. There, a "joint author" is technically someone who has collaborated on a work in which the contributions of the various authors are not distinct from one another. In this model, only contributors to the *form or expression* of the work qualify; those supplying ideas normally do not. If each person's contribution is distinct (e.g., contributors of entries to an encyclopedia), the work is a "collective work" and each author has copyright to his or her individual contribution.

However, in the physical and life sciences, collaboration and teamwork are common. Indeed, a student's research may be guided by a team or committee. Contributors to the original ideas in a project are typically given the right to joint authorship of publications that report on the results of the research. As a guideline, co-authorship should be recognized only where the individuals have participated in a significant way in at least two of the following aspects of the research:

- conception of idea and design of experiment,
- actual execution of experiment or hands-on lab work,
- analysis and interpretation of data, and/or
- actual writing of the manuscript.

Rights to senior or first authorship can be difficult to resolve. In the humanities and social sciences the student is often the only author of the published work that reports on his or her thesis research. In the physical and life sciences, students are frequently given first authorship on one or more of the publications arising from their thesis research. The conventions of your discipline provide you with a template for determining questions pertaining to accreditation and authorship.

It is important that you and your supervisor or the researcher with whom you are collaborating establish at the outset what the conventions of authorship are that will be applied in your working relationship. It is preferable to determine this before you enter into a working or research relationship with this person so that there are no surprises or disputes when it comes time to publish your research. Many universities publish guidelines on this topic. See also [section VI](#) of this document.

## III. Protection Governed by University Regulations

In most cases the initial ownership of intellectual property resides with the creator of that intellectual property, but often these rights are assigned under university policy. Policies with respect to IP vary at different institutions and all readers are encouraged to review the policy of their institution relating to ownership, obligation to disclose, sharing proceeds from commercialization and conflicts of interest.

Traditionally, universities in North America have allowed their faculty members to retain their copyright in literary, artistic and musical works. However, the regulations governing the university's involvement with and entitlement to other research can be specific to the institution you are attending. It is therefore advisable to consult university policy, the Intellectual Property Management Office, or other similar facility to clarify your institution's policies.

Regulations can vary from institution to institution and the details of these variable policies often govern the particulars of processes like patent assignation. These policy particularities can affect your portion of the proceeds accruing from a patented invention as well as your responsibilities for the patenting, marketing and licensing of this invention. If you are pursuing research that may have a patentable invention as its outcome, you should familiarize yourself with university policies on this matter as early as possible.

Some issues governed by university policy include:

### i. Shared ownership

You and a fellow student, researcher, post-graduate or supervisor may have joint property rights to a patentable invention or to works protected by copyright. Consult your university's policy concerning shared ownership of intellectual property through the Intellectual Property Management Offices or Offices of Technology Transfer. See also [section VI](#) of this document.

### ii. Access to data

In many universities, data collected under research projects funded by the federal or provincial governments is considered to belong to the university. Students cannot automatically expect exclusive ownership of data gathered for research projects performed under the auspices of a given institution. Students should inquire into university policy governing the rights to research data. This is also an issue that can be broached with one's supervisor: students should make an agreement with their supervisor that makes clear what data they can take with them or access once they leave the university.

### iii. Courseware

Be aware of university policy relative to courseware. As graduate students, you may have occasion to develop courseware (Powerpoint slides, overheads, handouts, and other instructional materials) for a professor in either a paid or an unpaid capacity. The university and/or the professor may claim the rights to these materials: you may not be able to use them for your own purposes later in your career. In addition to the university's intellectual property policy, the professorial union may have policies regarding this issue as well. For other information on intellectual property developed as a university employee see [section V, part ii](#) of this document.

University policies may also vary concerning software that you produce while associated with the university. When leaving your *alma mater*, make sure that all intellectual property that you developed while associated with it has been disclosed in order to avoid any issues of legitimacy at a later stage if such intellectual property is indeed commercially developed.



## IV. Protection Under the Law

There are two main forms of intellectual property protection that would apply to the research pursuits of graduate students: patents and copyright. Copyright protects the expression or embodiment of ideas, while patents protect inventions.

### i. Copyright

Copyright protects original literary, musical, dramatic, or artistic works in a variety of forms, including written materials and computer software. Copyright does not protect ideas, but rather the *expression* of such ideas. It prevents anyone from copying, publishing, translating, or broadcasting a work without the copyright owner's permission. Copyright exists as soon as an artistic, literary, scientific or musical work or software is created.

Currently in Canada, the usual term of copyright consists of the author's lifetime, the entire calendar year of his or her death, and an additional 50 years. In a number of countries (but not in Canada) copyright has been extended to life plus 70 years. The *Copyright Act* provides that the author of a work is the first and automatic owner of copyright unless it is work for hire.

Although copyright comes into existence automatically when the work is created, authors are advised to signal their claim by marking the work (© [author's name], [year of publication]). In addition, the author may register the copyright with the Copyright Office when warranted. Registration at the Copyright Office is purely voluntary; not doing so will not affect the validity of the copyright, but registration of a Copyright facilitates the Copyright holder's rights in the event of a legal dispute. Such disputes are generally triggered by commercial interests or plagiarism.

Copyright is the most common form of legal intellectual property protection that graduate students have. It covers any written materials produced by an individual: this can mean published articles and completed dissertations as well as writings that have been privately or unofficially circulated. Theses, published or not, are protected by copyright law. Because copyright comes into effect as soon as a work is produced it covers all manner of original written work. It is also the most common form of protection employed for protecting intellectual property rights to software which one has produced. Software may, in some circumstances, be protected by patents as discussed below.

### ii. Patents

A patent is a document issued by the government that describes an invention and provides a corresponding right to exclude others from using the invention for commercial or other purposes. It is a right granted by a national government, upon application and prosecution, in exchange for the complete disclosure of an invention. The disclosure is

initially a confidential disclosure to the Patent Office which, in Canada, becomes a non-confidential disclosure to the public 18 months later. A patent grants to the applicant the exclusive right to make, use or sell the claimed invention for a limited period of time. It is worth noting the distinction between inventor and owner: an inventor gets the patent issued in his or her name – once an inventor, always an inventor. The inventor may then assign ownership of the invention to someone else. Inventorship and ownership of an invention are not the same thing. Patents generally have a life, subject to the payment of the prescribed annual fees, of 17 to 20 years depending on the jurisdiction. In Canada, patents have a lifetime of 20 years from the date of initial filing.

## What is patentable?

To be eligible for a patent, an invention must fulfill three criteria:

- be novel or new (the same invention cannot already be in existence)
- have utility (i.e. it must be functional and operative)
- be non-obvious to a person skilled in the field of the invention

A patent is granted only for the physical embodiment of an idea or for a process that produces something saleable or tangible. Products, processes, machines, manufactures or composition of matter, or any new and useful improvement of any of these, such as new uses of known compounds, are patentable subject matter. Things not eligible for patenting include a scientific principle or theorems, ideas, or inventions that are illegal or have illicit purposes. As patent law evolves, business methods, software games and certain life forms are becoming eligible for protection under new patent laws in some countries.

## Disclosure and the Patent Process

An invention can be protected by patent only if it is **novel** (that is, if no prior publication of the invention has been made by the inventor or others). Most developed countries follow a policy of **absolute novelty** which means that no patent can be obtained if the invention has been publicly disclosed in any manner, anywhere in the world. Canada and the U.S.A., however, provide a grace period of one year from publication, during which the inventor can file a patent application, provided the disclosure was made by the inventor or someone who obtained the information from the inventor. In such cases, the patent will be limited to Canada and the U.S.A. You will not be able to obtain a valid patent if you disclose your invention more than one year prior to filing a patent application in Canada. Few other countries are as generous to inventors, and it is essential, therefore, not to disclose the invention to anyone until a patent application has been filed. Disclosure can however be made on a confidential or proprietary basis, and such disclosure will not affect the ability to patent.

The relationship between the parties determines whether the disclosure is public or made in confidence. The disclosure is legally confidential if, when receiving the information, the receiving party personally understands and accepts a duty to keep the information

strictly confidential. A disclosure to an academic colleague may or may not be considered confidential depending on the understanding between the parties. Such understandings should be made or confirmed in writing. Any printed publication in a newspaper, scientific journal or other written form available on an unrestricted basis is considered a public disclosure, as is an oral presentation at a public meeting. Please note that published pre-prints or abstracts of (a) papers for a scientific meeting or (b) degree theses are also considered public disclosures. Notably, a public thesis defense is considered a public disclosure. Any rights to subsequent patent protection, except in the United States and Canada, are lost under these circumstances if no precautions were taken.

A public disclosure, written or oral, can be used (as “prior art”) by an Examiner evaluating a patent application if enough of the invention is disclosed to enable a person skilled in the relevant field to put the invention into practice. Such disclosure can also be used in courts to invalidate an issued patent. In some countries, experimental use of the invention in public will count against patentability. It is important therefore that you discuss your invention with your university’s Intellectual Property Management Office (or Office of Technology Transfer) as early as possible and before any public oral presentation or publication, including abstracts, has taken place. While universities operate to foster the creation and dissemination of knowledge, in some cases such dissemination has legal consequences. Rather than neglecting its important function as a disseminator of knowledge, your university, through its Intellectual Property Management Office, can help you protect your IP rights, if necessary, by assisting you in the initiation of patent applications prior to public disclosure of your findings or by having those present at a thesis defense sign non-disclosure agreements.

It is advisable to disclose an invention to your institution's Intellectual Property Management Office *before the details of the invention are included in any grant application or disclosed to an industrial party*. Disclosure to the Intellectual Property Management Office does not invalidate the patentability of an invention and is held to be confidential. Although disclosure in a grant application does not represent public disclosure in Canada, reviewers will be exposed to the invention and potentially represent an unnecessary threat. In the United States, grant applications may be considered public documents under Federal Freedom of Information legislation. It is wise to label such information release as strictly confidential pending patent application.

If you have made an invention, contact your institution’s Intellectual Property Management Office. Most universities have established procedures, and usually forms, to assist you with your disclosure. Although each university may have a different policy or guidelines, the overall approach is very similar. Consult your university for a report of invention or invention disclosure form. The basic objective is to help you protect your invention and to explore with you any opportunities for commercialization.

An important factor to consider is that Canadian Patent Law follows the principle of the first applicant to file, as opposed to the U.S. Law which follows the first to invent principle. This is all the more critical when you deal with industry partners.

## Patent Protection and Foreign Countries

As has been noted above, other countries have significantly different criteria governing patent eligibility that have to be taken into account when making your research and inventions public. A Canadian patent guarantees patent protection throughout Canada only. At present, there are no universal patent laws. Patents need to be applied for in each country to ensure patent protection, although there are international agreements that harmonize this process.

Though this section may seem unnecessary, it is important to note that graduate students often travel to foreign institutions and countries as doctoral students, postdoctoral fellows or visiting research students. Inventions may be made abroad or inventions made in Canada may have international repercussions and commercial potential. In the spirit of having graduate students as informed as possible of their IP rights and responsibilities, the following provides a basic gloss of international patent agreements.

**The Paris Convention Treaty** of 1887 facilitates the filing of applications in all member nations. It states that if a patent is filed in one member nation, and other applications are filed in the other member nations within one year of the first application, all such applications will be accorded the filing date of the first application. This is very important when considering the effect of publication in a scientific or other journal on a foreign patent application. In other words, if you have filed for patent protection in Canada you are eligible for patent protection in other countries as long as you respect the time prescription to apply for patent protection in other member nations. Almost all industrialized countries are signatories to the Paris Convention.

The **European Patent Office** makes it possible to file a single application (in English, French or German) to protect one's rights simultaneously in European member countries (there are currently 30 member countries). A single regional patent is granted but is not effective until it is ratified in each of the National Patent Offices selected by the applicant, who also must pay the appropriate National Fees, translate into the national language, and meet specific national requirements as to form, among other matters.

The **Patent Cooperation Treaty**, to which Canada is a signatory, provides a standardized international filing procedure for many of our principal trading partners including the United States, Japan and most European countries. It offers a relatively inexpensive mechanism for initiating foreign patent protection rights by deferring some of the major patent expenses (such as foreign translation costs) for up to 30 months from the initial patent filing.

It is important to keep in mind that the patenting process is, overall, expensive. Your institution's Office of Technology Transfer will help in identifying both the most appropriate patent agent for your invention and the most suitable protection strategy.

## V. Variables

### i. Support by the means of a fellowship, scholarship or research grant

The relationship between funding and intellectual property rights depends on (a) who the funding body is, and (b) what the terms and conditions of funding are.

Not all funding bodies are the same. Some public funding bodies such as the federal granting councils –Natural Sciences and Engineering Research Council of Canada (NSERC), Canadian Institutes of Health Research (CIHR), and Social Sciences and Humanities Research Council of Canada (SSHRC) – attach no intellectual property claims to the research they fund. Other organizations, such as some charitable associations or foundations or provincial Centres of Excellence (e.g., the Heart and Stroke Foundation or Materials and Manufacturing Ontario) may claim either licensing rights or a share of royalties. Still other organizations, notably companies, do attach intellectual property claims to their support of university research or of fellowships or scholarships for students. Students must consult with their Intellectual Property Management Office or equivalent before signing any such agreements.

**To ascertain which of these conditions apply, you should be aware of which organization is funding the research you do and what ownership and license rights the organization has to the results of your work.**

If the research support is in the form of a contract, you may be asked to sign an agreement which indicates that you are aware of the intellectual property terms and conditions of the funding and that you agree to abide by them. If the research support is in the form of a grant, you should ask your supervisor about terms and conditions, particularly if you are engaged in doing research for a thesis.

### ii. Employee status

Under the applicable legislation, intellectual property created by an employee in the course of his or her employment is deemed to belong to the employer unless there is an agreement providing otherwise. University policies modify the application of this general principle, however, the degree to which they do and how can vary depending upon the institution you attend. It is therefore advisable that you contact your institution's Intellectual Property Management Office or equivalent body to determine how these regulations apply to your specific situation.

For instance, the intellectual property policies at certain universities dictate that intellectual property created by university employees in the course of their employment is the university's property only if the work or the invention was created at the *direction* of the employee's supervisor. Even if it was not created at the direction of the employee's

supervisor, the intellectual property may still be subject to the university's policy on patentable inventions; rights and any commercial revenues may have to be shared between the inventor and the university.

Sometimes it is unclear to students whether or not they are university employees. There are some important indications. First, do you have a university employee number? Second, are you contributing to university employee benefit plans? If the answer to either of these questions is "yes," then you are *probably* a university employee. However, the regulations that determine one's status as an employee of the university and what the repercussions of this status are for intellectual property rights can vary depending on your institutional affiliation. Certain categories of graduate employment such as research assistants and graduate assistants may or may not share in intellectual property rights and authorship. Because of the importance of one's characterization as an employee, it is essential that you clarify your status prior to undertaking any work that could lead to the creation of any kind of intellectual property.

## VI. Relationship to Supervisor and His/Her Research

The role of a supervisor varies in different fields of study. This may have an impact on the ownership of intellectual property.

### i. Co-authorship

Attribution of authorship is the most common problem area for graduate student intellectual property issues. Your university normally will have a policy that sheds light on this important issue.

In some fields, such as the humanities and social sciences, it is normally expected that students will receive guidance from their supervisors, but generate their own ideas, do their own research, and seek out their own financial support. The supervisor acts as a mentor, "resource person", and/or consultant, but less often as a full collaborator. Under these circumstances, the student will have the primary right to the intellectual property produced by his or her research.

In other fields, such as the physical and life sciences, the normal practice is that the student joins an established research group and works collaboratively with the supervisor, other students, postdoctoral fellows, technicians, and/or other employees. In this model, the supervisor has provided the general ideas that guide the research of the group, as well as the resources required to support or conduct the research activities. Protocol that governs attribution of authorship will reflect the model of collaboration within the relevant field. However, as was indicated above, this protocol or set of conventions, though it should be a universally recognized practice in the field, is not an absolute and binding procedure. In the case of such a collaborative research setup, the supervisor would normally make the decision on who shares co-authorship.

It is therefore advisable to come to an agreement with the professor or research supervisor about the protocol for attributing authorship (co-authorship as well as primary authorship) before embarking on a research project. This may depend on the professor's own practices, but it will also depend on the specification of your role in the research project.

The fact that a co-worker is not named as an investigator in a grant or contract under which the work was performed should not prevent him or her from being given credit as a co-author. However, a requisite of co-authorship is work that involves an original contribution as understood by that discipline. The right to co-authorship may be lost if a co-worker leaves the project or does not contribute substantially to the work. Although acknowledgement may be appropriate in such circumstances, co-authorship rights cannot be assumed.

Normally, the supervisor, in consultation with his or her co-authors, will make the decision as to when or whether a co-authored manuscript should be submitted for publication and to what journal. A student considering publication of his or her own paper also has a responsibility to consider the intellectual property and co-authorship rights of others who may have been involved in the research.

General criteria for attributing joint authorship are dealt with in the “Conventions of Discipline” category above ([section II](#)).

## ii. Co-inventorship

If you are working on a research project that involves a potentially valuable invention as its outcome, the resolution of intellectual property rights is very important. Though authorship status can be important in building one’s reputation as a scholar, status as an inventor can entitle one to proceeds accruing from an invention that one has played a role in creating.

An inventor is a person who has had an original idea or has contributed intellectual input which constitutes an inventive step to one of the claims of the patent. A patent application may be filed naming one or more inventors.

A person who works under the direction of another and does not contribute any original thought to the claimed invention or that has not creatively contributed to the proof of principle or concept **cannot and must not** be named as an inventor. For example, "works as a technician" is not an adequate justification to confirm one’s status as an inventor or co-inventor. *This type of relationship should be delineated clearly in writing before research or development work is undertaken relative to the project or activity.*

Professional collaborators may or may not contribute to the inventive concept being claimed and *great care should be taken in deciding who should be named as an inventor.* It is important to understand that inventorship is a legal matter, not a collegial matter — not all co-authors of a publication are necessarily co-inventors. Collaborators not deemed to be co-inventors can, however, be recognized through some sharing of the net proceeds of the invention. If in doubt as to inventorship, your Intellectual Property Management Office should be consulted and a professional opinion obtained. See also [section IV, part ii](#) for information on inventorship and details about the patent disclosure process.



## **VII. Dispute Resolution**

If a dispute or concern arises with respect to intellectual property and/or co-authorship rights, you and your supervisor should first try to resolve any differences amicably. If discussion with your supervisor does not resolve the problem, you have several avenues of help within your department that can be taken in the following order: your research supervisory committee, the graduate coordinator/director of your department and the chair of the department. You can also seek advice concerning intellectual property management from your university's Technology Transfer office. If the department is unable to find a satisfactory solution, you can seek help from the office of the Dean of Graduate Studies and from the office of the Vice-President or Principal of Research.

## VIII. List of Intellectual Property Resources

### Canadian Intellectual Property Office (CIPO)

Place du Portage, Phase I

50 Victoria Street

Hull, Quebec K1A 0C9

Tel: (819) 997-1936

Fax: (819) 953-7620

<http://cipo.gc.ca>

[cipo.contact@ic.gc.ca](mailto:cipo.contact@ic.gc.ca)

### The Canadian Intellectual Property Group

<http://www.research.utoronto.ca/utech/cuipg.html>