



INVENTIONS AND COMMERCIALIZATION AT U OF T

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This document addresses some frequently asked questions regarding inventions and commercialization at the University of Toronto. This document refers to U of T's [Inventions Policy](#) and nothing herein should be interpreted to override or supersede the Inventions Policy.

GENERAL

How is an "invention" defined for the purposes of the Inventions Policy?

For the purposes of U of T's Inventions Policy, an invention is defined as something which is more than an idea, theorem or algorithm. In patent terms, it should be new, useful and not obvious. Inventions may include processes, materials, research tools, software, data and improvements to existing inventions. In addition, the discovery should have a defined practical application and be shown to work in principle, or have been reduced to practice. Please refer to section 1.1 of the Inventions Policy for more information on the definition of an "invention".

How is a "copyright" defined for the purposes of the Copyright Policy?

Copyright works are defined as any architectural, artistic, choreographic, cinematographic, dramatic, literary, musical, scientific, technical or other work in which copyright may subsist under the Copyright Act and applicable law, and are governed by U of T's Copyright Policy. For more information, visit <http://www.governingcouncil.utoronto.ca/policies/copyright.htm>

Who owns inventions created at U of T?

U of T has a flexible policy that allows inventors to take personal ownership and commercialize their inventions on their own. Alternatively, U of T inventors may also offer ownership to the university and take advantage of the commercialization services provided by the university through the Innovations & Partnerships Office (IPO) and MaRS Innovation (MI). In either situation, U of T inventors have an obligation to disclose their inventions to the university. Inventions created at U of T may also be subject to obligations to the sponsor of the research (e.g. industry) which may need to be taken into consideration.

Who is covered by the U of T Inventions Policy?

The U of T's **Inventions Policy** is based on the use of U of T resources rather than an individual's status at U of T and applies to all members of the U of T community, without exception. This includes, but is not limited to, faculty members, staff, graduate and undergraduate students, post-doctorate fellows, research associates, technicians, librarians, and visiting scientists.

Is there support for entrepreneurship at U of T?

U of T is a vibrant entrepreneurial community with numerous initiatives and support programs that create, encourage, foster and grow new companies. Over 350 start-ups have been created in many disciplines to take cutting edge research from U of T to the marketplace. Information on these initiatives can be found at: <http://entrepreneurs.utoronto.ca/>

USE OF U OF T RESOURCES

What constitutes the “use of U of T resources” in the creation of an invention?

The Inventions Policy applies to all inventions that are made or developed “*using, in any way, facilities owned, operated or administered by the university and/or funds of, or funds administered by, the University*”. In practical terms, the use of U of T resources can be defined as, but is not limited to:

- All or part of the work was supported by research grants or sponsored research funds, including subgrants, administered by U of T
- All or part of the work was performed in a university-owned or operated facility, laboratory or other university infrastructure
- All or part of the work made use of proprietary software or other applications (e.g. MATLAB) provided by U of T
- All or part of the work made use of specialized or high performance computing facilities owned or administered by U of T

Are there any exceptions to the “use of U of T resources” aspect of the U of T Inventions Policy?

There are no exceptions, but for practical purposes the following U of T resources will not be considered significant towards the determination of whether an invention falls under the Inventions Policy:

- Use of a U of T email account or other common IT and/or communication services (i.e. telephony, fax, internet, WiFi)
- Use of common spaces or services provided freely to all by U of T (i.e. cafes, lounges, common meeting areas)
- Use of personal computers, laptops, tablets, mobile devices and other commonly used hardware and software applications, even if such assets are owned or provisioned by U of T

What if I invented something but didn't use U of T facilities?

Inventions created without the use of U of T facilities do not fall under the Inventions Policy and are not required to be disclosed. However, inventors may wish to register such inventions with U of T to ensure clarity over future ownership rights and obligations. Inventors may register inventions created without the use of U of T resources by submitting the **Declaration of Invention with No Significant Use Form** to the Innovations & Partnerships Office (IPO) for review and acknowledgement. It should be noted that filing a “No Significant Use Form” form at any stage does not preclude a future obligation to file an Invention Disclosure should the advancement of the invention involve the use of U of T resources. You can ask for advice and support from IPO at any time.

If the invention was created at an external institution, the inventors should contact the appropriate technology transfer office of that organization.

INVENTION DISCLOSURE

How are inventions disclosed to U of T?

The first step is to complete an **Invention Disclosure Form** and submit it to the Innovations & Partnerships Office (IPO). This form is used to record inventions created through the use of U of T resources and should be completed by the inventors to satisfy their obligation to disclose inventions to the university. Instructions and the form, including a downloadable step-by-step invention disclosure guide, are available at: <http://www.research.utoronto.ca/forms/invention-disclosure/>

When should an inventor disclose an invention to U of T?

Early disclosure to U of T is encouraged to allow time for ownership to be determined and patentability assessed. Disclosures should be filed as soon as the invention or work is clearly conceptualized or as soon as you can fully describe your new product or process so that someone else familiar with the field could use it immediately. You absolutely must disclose before you plan to sell, license, or otherwise assign your invention or encumbered copyright material.

What to expect after submitting an Invention Disclosure Form?

The inventor(s) will be contacted by the Innovations & Partnerships Office (IPO) to discuss the invention and potential options. An important part of the review undertaken by IPO will ensure that any third-party or sponsor (e.g. industry) obligations are fulfilled. If the inventor(s) wishes to own their invention, IPO will assist in executing such an assignment to the inventor(s) and ensure the inventor(s) are aware of their ongoing obligations to the university. If the inventors would like assistance in commercialization, IPO will conduct a joint review of the invention with MaRS Innovation towards a decision of acceptance. This review should be completed within 45 business days.

What is MaRS Innovation?

MaRS Innovation (MI) is a nationally funded Centre of Excellence Commercialization and Research and is U of T's partner in innovation and commercialization. MI commercializes the most promising research breakthroughs from 16 of Toronto's top universities, institutions and research institutes. Its portfolio, built through over 1,000 intellectual property disclosures from the member institutions, turns discoveries into businesses through industry partnerships, licensing arrangements and start-up companies.

MaRS Innovation is located within the MaRS Discovery District in the heart of Toronto and adjacent to U of T. The MaRS Discovery District provides resources — people, programs, physical facilities, funding and networks — to ensure that critical innovation happens. For more information, visit <http://marsinnovation.com> and <http://www.marsdd.com>

What to expect if IPO and/or MaRS Innovation accepts an invention into their portfolio?

IPO and MI will become a full-service commercialization manager that represents both the institutional and your interests as a U of T inventor. IPO will support the invention through the commercialization life cycle and strive to add value by developing a tailored business strategy and service offering that may include:

- Securing intellectual property rights to protect the invention from copying and unauthorized replication
- Securing financial support for further research and development or proof of concept work
- Networking with industry to improve market access and product development capabilities
- Managing and executing legal contracts related to confidentiality, material transfer, collaboration, sponsored research, commercial options and licenses, etc.
- Marketing and promoting the innovation to the broader marketplace while assuring your rights and interests are best represented
- Incorporating a company and participating as a shareholder (often done in partnership with Mars Innovation)

Why would an invention not be accepted for commercialization by IPO or MaRS Innovation?

This is not a reflection of the quality of the research or the invention, but may depend upon factors such as patentability, feasibility, timelines and estimated costs to market, competitive factors and other commercialization business considerations. Often suggestions for future developments are offered along with an invitation to re-disclose the invention in the future.

If the inventors take personal ownership of the invention, what are the obligations to U of T?

Inventors who opt for self-assignment of their inventions are responsible for their own commercialization activities, such as patenting, legal, investment, marketing and investment negotiation. In consideration of the use of U of T resources required

for the creation of the invention, the Inventions Policy describes the revenue sharing obligation with the university in addition to an annual report of activities. For more information, visit: <http://www.research.utoronto.ca/forms/inventor-owned-reports/>

Who receives revenues from a commercialized invention?

Revenues from commercialization activities typically arise from licensing (or royalties) arrangements or from the sale of company equity. All revenues are distributed by the Innovations & Partnerships Office (IPO) in accordance with the Inventions Policy. Proceeds are distributed by IPO between the inventors, their department(s), the faculty(ies), and potentially, the Connaught Fund. If IPO or MaRS Innovation is leading commercialization efforts on your behalf, a management fee is also included.

ADDITIONAL FAQs

What's the difference between an inventor and a contributor?

To be considered an inventor you must have made a creative contribution to the invention that makes it new, useful and non-obvious in light of what is already known in the field of study. People that assist in the data collection or testing an invention are not inventors, rather they are contributors.

Can students file an invention disclosure?

Yes, students, as well as any other person covered under the Inventions Policy, may file an invention disclosure form. However, all inventors must sign the disclosure form to complete the submission process. It is important to note that individuals that assist only in the data collection or testing the invention are not inventors, rather they are contributors.

I am collaborating with a researcher from another institution, where do we disclose?

You must disclose to both institutions. Each institution typically requires that a disclosure be filed with their respective technology transfer office. U of T inventors will complete the U of T invention disclosure form and submit it to the Innovations & Partnerships Office.

My invention was created with, or funded by, an industry partner – what now?

The inventors should complete an invention disclosure form and indicate the support or participation of the industry partners on the form. The Innovations & Partnerships Office will review the invention disclosure form and also any relevant contractual or agreement obligations with the partner that may need to be considered.

Do all inventions get patented?

No, not all inventions require intellectual property protection for commercialization. For inventions managed by the Innovations & Partnerships Office or MaRS Innovation, we will work with the inventors to develop the most suitable patenting strategy.

Should an inventor file a patent application before discussing with potential companies or partners?

Not necessarily, but it is advised that there be a confidentiality agreement in place between U of T and the company prior to sharing the details of an invention. The Innovations & Partnerships Office negotiates and executes all research and commercialization confidentiality agreements for U of T. For more information, visit

<http://www.research.utoronto.ca/forms/confidentiality-agreements/>

Who pays for the patenting of an invention?

If the inventors take personal ownership, they are responsible for patenting and all other commercialization expenses. If the invention is accepted into the Innovations & Partnerships Office and/or MaRS Innovation portfolio, the patenting, marketing and legal costs will be covered with an expectation towards their future recover from revenues.

Can I still publish my work if I report an invention?

Yes, but note that any public dissemination of the invention (i.e. conference, publication, presentation) may weaken the ability for future intellectual property protection. Please fill out an invention disclosure form as far in advance of publication as is reasonable so the Innovations & Partnerships Office has the time to evaluate and protect your intellectual property prior to a publication or other public presentation.

Is it too late to protect my invention if I have already disclosed it publically?

Not necessarily. If you believe that your invention has commercial value and you would like to commercialize it, please contact the Innovations & Partnerships Office.

LINKS

- [IPO and the VPRI](#)
- [U of T Inventions Policy](#)
- [U of T Disclosure Form & Guide](#)
- [U of T Banting & Best Centre for Innovation & Entrepreneurship](#)
- [MaRS Innovation](#)
- [MaRS Discovery District](#)

CONTACT

For more information about inventions and commercialization at U of T, contact the Intellectual Property Officer at ip.officer@utoronto.ca or 416-978-7833.