

MODULE 3- STUDENT CREATED INTELLECTUAL PROPERTY ARISING FROM PARTNERSHIP-BASED CURRICULAR ACTIVITIES (For Students)



STUDENT CREATED INTELLECTUAL PROPERTY ARISING FROM PARTNERSHIP-BASED CURRICULAR ACTIVITIES

LEARNING OBJECTIVES

This training is for students creating intellectual property (IP) in courses and related curricular activities.

After completing this module, you will be able to:

- ✓ Define Ownership and explain basic principles of why it is important to understand IP and Ownership in relation to the third-parties
- ✓ Identify five scenarios where students and faculty work with third-party IP, and what agreements and procedures are needed for each scenario
- ✓ Explain the process and protocols for when a student, instructor, and/or department encounters a Non-Disclosure Agreement



MODULE CONTENTS

1. OWNERSHIP OF INTELLECTUAL PROPERTY DURING CURRICULAR ACTIVITIES
2. UNIVERSITY POLICIES
 - Inventions
 - Copyright
3. TYPES OF AGREEMENTS WITH THIRD PARTIES
4. APPLICATION – *WHO OWNS THE IP?* SCENARIOS
5. LESSONS LEARNED
6. UNIVERSITY RESOURCES AND SUPPORTS

REVIEW: WHAT IS INTELLECTUAL PROPERTY?

Intellectual property or IP refers to the creations of the mind. IP is called “property” because rights are acquired with ownership but considered an intangible asset (e.g., product design, raw data and code, designing a new process) as opposed to a physical asset (e.g., building, equipment, cash).

Under intellectual property law, owners enjoy certain rights to a variety of intangible assets.

For a detailed explanation of Intellectual Property, you should review [Module 1: Introduction to Intellectual Property and Intellectual Property Rights](#).



REVIEW: OWNERSHIP AND THE UNIVERSITY'S INVENTIONS POLICY

When you create an invention using university-administered funds and/or resources it brings into effect the University Inventions Policy.

THE INVENTION POLICY ESTABLISHES:

- Definitions for “Inventor” and “Inventions”.
- How ownership and rights to use inventions developed at U of T is determined and managed.
- The process for identifying, evaluating, protecting and managing inventions developed at U of T.
- The framework for commercialization of U of T inventions, engaging with commercial partners and sharing and distribution of any economic benefits.

IMPORTANT REMINDERS

U of T resources or funds means:

- Use of facilities owned, operated or administered by U of T (unless leased by a company) or
- Use of funds from, or administered by, U of T

The University's Inventors Guide provides additional detail about when the University's Inventions Policy applies.

WHEN I CREATE IP DURING A CURRICULAR ACTIVITY, WHO OWNS IT?

You own the IP you develop during an academic course. You own your papers, your projects and your theses.

However, there are situations when you will engage with third parties (organizations, employers and peoples external to the University) during a curricular activity.

Sometimes, third parties will present an agreement that includes a condition that requires you to assign your IP created during the course to the third party. They may also request that a Non-Disclosure Agreement (NDA) be signed to protect their confidential information. This module will provide you with a better understanding of what to do in these circumstances.

WHEN I CREATE IP DURING A CURRICULAR ACTIVITY, WHO OWNS IT?

When IP is created through curricular activities, there are three possible owners:

1. You
2. The Employer / Organization (the third party)
3. The University

IP created as part of extra-curricular entrepreneurial activities (e.g., campus accelerator), sponsored research, thesis work, or the Mitacs Accelerate and Elevate Internships are out of scope of this module.



WHEN STUDENTS CREATE IP DURING A PARTNERSHIP-BASED CURRICULAR ACTIVITY, WHO OWNS IT?

STUDENTS

When you create IP as part of academic course work at the University, you will generally own the IP.

This includes IP created as part of your course where a third party (e.g., an organization external to the University) has collaborated with your instructor to provide a real-world problem for the students in the course to solve (e.g., capstone/ organization-partnered project). However, third parties may request a student grant limited non-exclusive rights to IP developed by the student to the third party.

THIRD PARTY

When you create IP during a professional work term (e.g., co-op term), the third party (your employer) will own any IP that is created.

When you are on a professional work term (e.g., co-op term), you are employed by a third party and you will be asked to sign an employment agreement. Employment agreements typically cover details of IP ownership and confidentiality.

UNIVERSITY

Only in certain cases does the University have rights to IP developed by students.

If you are being paid by the University, are accessing University resources and / or if you have an employment contract with the University, then the Inventions and Copyright policies of the University apply. This should be addressed in your employment contract or discussed with your supervisor.

NOTE: Where there may be new and novel IP created through curricular partnership-based experiences, including academic internships, it is important for you to understand that you may not own the IP. Always ensure you have clarity prior to engaging in a partnership-based activity where new and novel IP may be created.

UNIVERSITY POLICIES: INVENTIONS

IF I CREATED IP AS PART OF A CURRICULAR ACTIVITY, DOES THE INVENTIONS POLICY APPLY TO ME?

Generally, **no**.

- The Inventions Policy defines “Inventor” as having created an invention using, in any way, facilities owned, operated or administered by the University and/or funds of, or funds administered by, the University.
- IP created by you during classwork tends to be created using U of T resources that are usually and generally available (e.g., classroom, dorm library). The use of these generally available resources have not been interpreted by U of T as bringing into effect the Invention Policy’s application to IP.
- Therefore, when you develop IP as part of your classwork it would not generally meet the definition of “Inventor” for the purposes of the Inventions Policy.
- If you create IP as part of a professional work term (e.g., co-op), it would also not fall under the Inventions Policy because neither University facilities nor funds would be generally used to create the IP.
- **However**, the Inventions Policy would likely apply if the University is providing you with funds to conduct a project (e.g., a graduate student conducts research in a faculty lab) or if you enter into an employment contract with the University.



UNIVERSITY POLICIES: COPYRIGHT

IF I CREATED IP AS PART OF A CURRICULAR ACTIVITY, DOES THE COPYRIGHT POLICY APPLY TO ME?

Yes. However, under [U of T's Copyright Policy](#) as a student author you generally own your own copyright work including your theses, papers, reports and analysis.

The University rarely owns copyright and only does if:

- a) work is created during your employment with the University. For example, you accept a summer job at the University to produce content on human rights caselaw for the Faculty of Law website. In this instance, the University owns the copyright because you are classified as an employee.
- b) work is commissioned by written agreement between you and the University. Note that in this instance, ownership of the work would still reside with the creator of the work.

Neither of these scenarios generally applies to curricular activities.

CHECK FOR UNDERSTANDING

Given the following scenarios, please select which party (the University, Student, or Third Party) most likely owns the IP you created:

1. You are participating in an unpaid academic internship offsite at an architecture firm. The project you are contributing to is being led by a professional architect and a faculty member.
2. You are on a paid professional work term (e.g., co-op term) and on your lunch hour, you use the placement-issued laptop in a U of T library, have a coffee and develop an application.
3. You undertake an organization-partnered project as part of a course and the outcome of your project is a new volunteer sign-up process to support the organization with which you were working.

CHECK FOR UNDERSTANDING

Given the following scenarios, please select which party (the University, Student, or Third Party) most likely owns the IP you created:

1. You are participating in an unpaid academic internship offsite at an architecture firm. The project you are contributing to is being led by a professional architect. **ANSWER: While participating in an academic internship, you generally would not own the IP you create because you are generally required to agree to the terms / policies of the placement site itself. Therefore, unless there is an agreement in place that states otherwise, the IP developed is owned by the architecture firm where you were placed for your academic internship.**
2. You are on a paid placement and on your lunch hour term (e.g., co-op term), you use the placement-issued laptop in a U of T library, have a coffee and develop an application. **ANSWER: The third party would own the application, since the student was acting as an employee of the third party.**
3. You undertake an organization-partnered project as part of a course and the outcome of your project is a new volunteer sign-up process to support the organization with which you were working. **ANSWER: The student. However, you are free to grant non-exclusive rights to the organization on their request.**



WHAT TYPES OF AGREEMENTS WILL I ENCOUNTER?

TYPE OF CURRICULAR LEARNING EXPERIENCE	TYPES OF AGREEMENTS YOU MIGHT ENCOUNTER
<p>THIRD PARTY CONFIDENTIAL INFORMATION: you receive information in a curricular activity from a third-party that cannot be further shared or distributed due to its confidential nature (e.g., a data set). In this case, you do not interact directly with the third party.</p> <p>ORGANIZATION-PARTNERED PROJECTS: a project-based research, design, consultancy, creative or artistic work experience undertaken in partnership with a third party.</p>	<p>A Non-Disclosure Agreement (NDA) will only be signed in specific circumstances as outlined on the Experiential Learning Hub. The NDA will not be signed by you, but rather by the head of the affiliated academic unit and the third party.</p> <p>When IP is created during an organization-partnered project, an IP Agreement may be requested by the third party granting limited non-exclusive rights to IP developed by students to the third-party. If this is the case, your course instructor should inform you of this in advance of you undertaking the project. The IP agreement will not be signed by you, but rather by the head of the affiliated academic unit and the third party.</p>

WHAT TYPES OF AGREEMENTS WILL I ENCOUNTER?

TYPE OF CURRICULAR LEARNING EXPERIENCE	TYPES OF AGREEMENTS YOU MIGHT ENCOUNTER
<p>ACADEMIC INTERNSHIP: you engage in an unpaid work experience as part of a course, the experience integrates academic learning with its application in a workplace..</p> <p>PROFESSIONAL PRACTICUM: an unpaid, practice-based experience where students observe or assist a licensed or registered professional through the hands-on application of disciplinary concepts in a professional setting.</p>	<p>If you are going on a curricular unpaid placement (e.g., academic internship or professional practicum), the University enters into an agreement with the placement site. Your course instructor who is organizing the placement may request that you sign an agreement outlining confidentiality and other items pertinent to your placement. This agreement would be between you and the instructor, not the third-party.</p>
<p>PROFESSIONAL WORK TERM: you complete a full-time work experience, on or off-campus, for a minimum of one term as a component of an academic program (e.g., co-op work term). These experiences are typically paid.</p>	<p>If you are engaging in a professional work term (e.g., co-op), you will be entering into an employee-employer relationship with the third party and will sign an employment contract. If you want to adjust your employment contract, you need to negotiate directly with your employer. The University is not involved in the development of signing of these contracts.</p>

CHECK FOR UNDERSTANDING

THIRD-PARTY CONFIDENTIAL INFORMATION

SCENARIO: In a course, you are asked to undertake a project where a non-profit organization shares a confidential data set. The project is bound by a non-disclosure agreement that has been signed by the academic unit head and the third party: the data provided by the non-profit to you and your classmates cannot be disclosed to anyone outside the class.

Q: You decide that you require a resource from a lab technologist in order to move the project along. However, you are concerned that you are bound by the NDA and can't describe what you need without sharing confidential information. **Can you talk to people outside of class without violating the NDA?**

A: You can't. As a student, be sure to design your project with NDAs in mind before you begin.

Q: After finishing the project, you and your team would like to write a report that will be published in your undergraduate student journal. **Are you allowed to do this without violating the NDA?**

A: It is possible, but you would need to redact the confidential information or get consent from the non-profit organization to include certain data.

CHECK FOR UNDERSTANDING

ORGANIZATION-PARTNERED PROJECT

SCENARIO: You are in a course and your instructor assigns an organization-partnered project with a software company. For the project, the software company shares some of its valuable original software code and asks you to design a method to improve on the data processes.

In order to complete the assigned project, you develop some intellectual property including outlining a novel design process in the report you submit to your instructor and the company.

Q: Who owns the new designs? Does the University own the IP for the design the students made?

A: Subject to an agreement with the software company and/or University policies, whoever developed the IP owns the IP. The University did not develop the IP so would not own it, unless University funds or resources were used to design or test the method. For example, if you used servers or supercomputers at the University to test the method or new code the University would have joint rights to the IP. Likewise, if you and the software company jointly created IP, the IP would be jointly owned between you and the software company.

CHECK FOR UNDERSTANDING

ACADEMIC INTERNSHIPS

SCENARIO: You are participating in an unpaid academic internship at an architecture firm. A project you are contributing to is being led by a professional architect. As part of the project team, you develop an app that allows the architecture firm to share design images with their clients via mobile devices.

Q: You believe this app is marketable and want to share it with other architecture firms who might be interested in paying you to implement it for their business. Do you own the invention, and can you market it to other organizations?

A: While participating in an academic internship, you generally would not own the IP you create because you are generally required to agree to the terms / policies of the placement site itself. Therefore, unless there is an agreement in place that states otherwise, the IP developed is owned by the architecture firm where you were placed for your academic internship. This being the case, you are not able to claim the invention as your own and would not be able to market it to other organizations.

CHECK FOR UNDERSTANDING

PROFESSIONAL PRACTICUMS

SCENARIO: You are participating in professional practicum at a physiotherapy clinic. As part of the practicum, you are engaging with clients while supervised by a licensed physiotherapist.

Q: You want to discuss a client's case as part of your upcoming class project. Are you allowed to do so without agreement from the third-party?

A: No. Your knowledge of the client's case would be considered confidential information and, therefore, you would not be able to discuss the details of the case.

CHECK FOR UNDERSTANDING

PROFESSIONAL WORK TERM

SCENARIO: You are on a professional work term (e.g., co-op term) at a software company and you develop a new method for processing using the company's codes.

Your supervisor at the software company advises you that they will be using your new method of analysis and does not need your permission to do so.

Q: Can the organization use your work without your permission?

A: Probably, yes. While you are on a professional work term, you are bound by the rules and policies of the software company's employment contract. This usually means that the company owns any intellectual property created. For example, if you created the new method while using the software company's computer, the company's policy likely states that they own the IP.

WHEN ELSE MIGHT I ENCOUNTER IP CONSIDERATIONS RELATED TO THIRD PARTIES?

IP considerations also arise in situations that are not curricular in nature. While these are beyond the scope of this module, we wanted to ensure you knew where to go to learn more:

- IP created as part of extra-curricular entrepreneurial activities (e.g., campus accelerators) is covered in more detail in [U of T Entrepreneurship's IP Education Program](#).
- IP created in the course of research is covered on the [Division of the Vice-President, Research & Innovation's website](#) where you will find information about ownership rights in intellectual property created during research.
- IP created during a [Mitacs Elevate or Accelerate Internship](#) while on the University's premises or from the use of the University's background IP is subject to the University's policies and inventions should be [disclosed to the University](#). IP created during a [Mitacs Elevate or Accelerate Internship](#) while on the third party's premises or using the third party's background IP, the third party's IP policies will apply. If the third party has concerns about the University's policies, [contact the Innovations & Partnerships Office](#) who can negotiate an agreement with the third party to ensure a clear understanding of each party's rights and obligations. In the absence of such an agreement, the University's policies apply.

LESSONS LEARNED: YOU AND THIRD PARTY AGREEMENTS

It is important to keep these things in mind when you are working with a third party:

- **Know the University policy:** The [Innovations and Partnership Office](#) is a great place for you to start if you are thinking about commercializing IP.
- There are benefits to collaborating with third parties as part of a curricular experience. But remember **intellectual property rights differ depending on the circumstances** and it is important that you understand your rights when embarking on a partnership.
- **You should talk to your course instructor or faculty supervisor** about what agreements are in place if you are developing new IP with a third party or are given confidential information by a third party.
- **It is very important that you understand your obligations to keep confidential information confidential** (e.g., do not share on social media or other platforms like Github).

UNIVERSITY RESOURCES AND SUPPORTS

Where do I go for additional support and information?

- For information on the University's Inventions Policy and assigning IP, visit the [Innovations and Partnership Office](#).
- For information on curricular unpaid student placements (e.g., Academic Internships), visit the [Student Placements](#) page facilitated by the Office of the Vice-Provost, Students.
- For information on non-disclosure agreements, visit the [Experiential Learning Hub](#).
- For information related to extra-curricular entrepreneurial activities (e.g., campus accelerators), check out the [U of T Entrepreneurship's IP Education Program](#).
- For information related to sponsored research, visit the [VPRI site](#).
- For information related to the Mitacs Elevate or Accelerate internships, visit the [Mitacs website](#).



END OF PRESENTATION



UNIVERSITY OF
TORONTO

Entrepreneurship