

INTELLECTUAL PROPERTY TOOLKIT

ABOUT THIS DOCUMENT

The purpose of this toolkit is provide some general information and resources regarding Intellectual Property (IP):

- I. This document is not meant to be exhaustive, but should provide a base knowledge on the subject
- II. This information is intended for AHS staff and any individual using AHS resources for their research and innovation
- III. This information reflects the [AHS IP Policy and Procedures](#), but is not meant to supersede such policies or procedures
- IV. This information has been prepared by the Innovation, Evidence & Impact team at AHS





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USAGE INSTRUCTIONS

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Quick Guide

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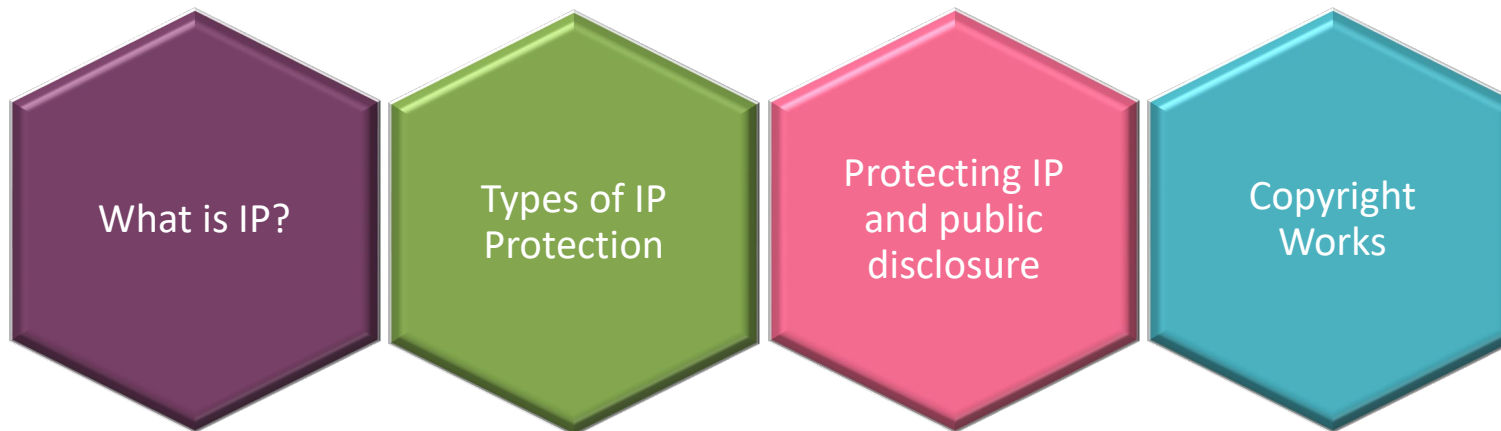
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About Intellectual Property





ABOUT INTELLECTUAL PROPERTY

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IP FAQs
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What is IP?





What is IP?

Intellectual property (IP) refers to a **creation of the mind**, including, but not limited to, inventions, literary and artistic works, designs, software, and trademarks.

IP rights such as copyright, trademark, and patents are protected by law making them an asset and allowing the owner of IP to earn financial benefit from what they create.

IP not only has economic value, but also the potential to contribute immense societal benefit.



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Types of IP Protection





IP INVENTORY CHECKLIST		Use this checklist to explore the types of intellectual property you could exploit. Do not include intangibles that are licensed from or owned by other companies!	
HOLDING	YES	NO	IP TO CONSIDER ACTIONS TO CONSIDER*
Advertising or signage			Trademark Copyright Include an indication of copyright and/or trademark rights
Algorithm			Trade secret Require NDAs ¹ or do not disclose!
Book, magazine, newsletter or manual			Copyright Include a copyright statement in a prominent location (year of first publication, owner, ©)
Business, product or service name			Trademark Include an indication of trademark rights
Customer list or data			Trade secret Copyright Require NDAs or do not disclose! Include a copyright statement if it is a compilation
Domain name			Trademark Search trademark databases to ensure your domain name is not someone else's trademark
Logo or symbol			Trademark Include an indication of trademark rights
Mobile app			Copyright Industrial design Include a copyright statement on your app or download site Maintain confidentiality until filing design registration for your graphical user interface; use NDAs
New or improved machine or device			Patent Maintain confidentiality until a patent application is filed; use NDAs
New or improved process or chemical compound			Patent Maintain confidentiality until a patent application is filed; use NDAs
Packaging			Industrial design Trademark Maintain confidentiality until filing design registration; use NDAs Include an indication of trademark rights
Photographs or illustrations			Copyright Industrial design Include a copyright statement in a prominent location (year of first publication, owner, ©) Maintain confidentiality until filing design registration if applied on a finished article; use NDAs
Secret recipe, process or formula			Trade secret Use NDAs; or if it can be easily reverse-engineered, seek patent protection!
Slogan			Trademark Include an indication of trademark rights
Software			Copyright Industrial design Patent (related concepts) Include a copyright statement in a prominent location (year of first publication, owner, ©) Maintain confidentiality until filing design registration for your graphical user interface; use NDAs Ask the Canadian Intellectual Property Office for information on software-related patents Establish ownership with suppliers or clients through written agreement
Training materials			Copyright Include a copyright statement in a prominent location (year of first publication, owner, ©)
Shape of a product			Industrial design Maintain confidentiality until filing for design registration; use NDAs
Website			Copyright Industrial design Include a copyright statement in a prominent location (year of first publication, owner, ©) Maintain confidentiality until filing design registration for graphical user interface; use NDAs






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Visit Canada.ca/intellectualproperty for more information on IP.
¹ NDA refers to non-disclosure agreements. Legal services should be sought to draft a proper NDA.
 *Securing formal protection is necessary to patent an invention and is recommended for trademarks, industrial designs and copyright.





Intellectual property in Canada

	Patent	Trade secret	Industrial design	Trademark	Copyright
COVERAGE	New, useful and non-obvious invention	Invention, business information	Visual features of a product	Source of goods or services	Original literary, artistic, musical or dramatic work
SCOPE (EXAMPLES)	Product, process, machine, chemical composition, use	Business method, invention, recipe, manufacturing process	Shape, configuration, pattern or ornament, or any combination of these features	Word, design, taste, texture, moving image, mode of packaging, hologram, sound, scent, 3-dimensional shape or colour, or a combination of these features	Software, sound recording, photograph, painting, web content, communication signal
RIGHTS	Exclude others from using, making or selling your invention	No formal rights (contractual obligations)	Exclude others from making, using, selling or importing something that uses your design	Prevent others from using your trademark	Prevent others from reproducing your original work
LOCATION*					
DURATION	Up to 20 years from date of filing	As long as confidentiality is maintained	Up to 15 years from date of filing	10 years (renewable)	Life of creator + 50 years (in general)
DISCLOSURE GRACE PERIOD	12 months	No disclosure	12 months	Not applicable	Not applicable (automatic rights)

*For patents, trademarks and industrial designs, consider securing your rights in other countries and regions.





Protecting IP and Public Disclosure

Legally protected IP is a valuable asset allowing the owner to gain financial benefit. However, if IP is publicly disclosed before it is protected, it can lose its value.

Protecting IP prevents others from taking advantage of the work and formal registration of IP rights creates legal documentation for evidentiary purposes in case of IP infringement.

Prior to public disclosure (publication or presentation):

AHS recommends protecting IP before it is published or publicly presented:

1. As per AHS policy, you should refrain from publicly disclosing IP until AHS has had a reasonable opportunity to evaluate the IP in the IP Disclosure Form.
2. If AHS identifies information in a publication or presentation that could compromise protecting the IP, you may proceed with public disclosure if you remove the identified information, or you can delay public disclosure for up to 90 days to enable the IP to be protected.
3. Seek advice from innovation@ahs.ca before you make any public disclosure of IP.



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Types of IP Protection



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Copyright Works





Copyright Works

What is the difference between copyright and IP?

Copyright is a type of IP. If you do not intend on commercializing the copyright work, then you do not need to submit an AHS IP Disclosure Form, but you should still mark the work with appropriate copyright notices and disclaimers.

For more specific information on copyright works developed by AHS staff or using AHS resources, please refer to the [AHS Copyright website on Insite](#) and contact copyright@ahs.ca if you have any questions.



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AHS IP Policy





AHS IP Policy

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Who does the AHS IP Policy apply to?





Who does the AHS Policy apply to?

The AHS IP Policy applies to all AHS employees, members of the medical and midwifery staffs, students, volunteers, and other persons acting on behalf of AHS (including contracted service providers as necessary).

The IP Policy also applies to any individuals using AHS resources for the purpose of innovation and research, including those with joint appointments.



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[AHS IP Disclosure Form](#)

Disclosing to AHS:

Under the AHS IP Policy, an IP creator shall report IP that is capable of being protected and of potential commercial value by completing an AHS IP Disclosure Form:

1. Completed IP Disclosure Forms should be submitted to innovation@ahs.ca.
2. Upon receipt of an IP Disclosure Form, our Innovation, Evidence & Impact team will work with you and stakeholders to evaluate the IP and propose a path forward.
3. In cases when there is an IP creator from another organization, AHS may enter into agreements with the other organization to establish ownership, a lead for commercialization, and revenue sharing.



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AHS IP Policy

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IP Ownership under the AHS IP Policy





IP Ownership under the AHS IP Policy

Unless otherwise indicated in the AHS IP Policy, AHS is the initial owner of any IP developed by AHS staff or anyone using AHS resources.

If there are IP creators from other organizations, the IP may be jointly owned.

Third-party sponsors and funders of research may also have rights through other agreements.

AHS may review requests to transfer ownership of the IP to the creators or another third party following review of the IP Disclosure Form, but is not obligated to transfer ownership.



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Who does the AHS IP Policy apply to?

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Joint Academic Appointments





Joint Academic Appointments

If you are jointly appointed with an academic institution and use AHS resources in your research, or you are paid a salary from AHS, then the AHS IP Policy applies to you too.

AHS has understandings with the University of Alberta (UA) and the University of Calgary (UC) with respect to managing IP disclosures. If you are jointly appointed with UA or UC, you can disclose to them and let them know that the AHS IP Policy may also apply to you.

Please feel free to forward your University report of invention. A separate AHS IP Disclosure Form is not required.

If you are unsure if the AHS IP Policy applies to you, you can contact innovation@ahs.ca to find out.



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IP Ownership under AHS IP Policy

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Transferring IP Rights





Transferring IP Rights

AHS will review requests to transfer IP either to the IP creator or to a third party, but is not obligated to transfer such IP.

AHS shall ensure that it obtains fair value for any IP transfer. AHS shall also retain a perpetual, royalty-free, non-exclusive, and irrevocable license to make, use, and modify any transferred IP solely for use by AHS, its affiliates and any third-party health care provider in the Province of Alberta for not-for-profit activities or the provision of health care services.

AHS and the IP creator will enter into an agreement regarding collecting, reporting, and sharing of net revenues and each party is responsible for its own legal costs in negotiating the terms of such agreement. The IP creator will report and obtain approval from AHS prior to any subsequent transaction whereby the rights to the IP are transferred to another party that is either directly or indirectly not at arm's length to the IP creator.

See considerations for transferring ownership on next slide.



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Joint Academic Appointments



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Considerations for Transferring IP Ownership





Considerations for Transferring IP Ownership

AHS will consider

Retention of IP ownership when...	Transferring ownership of IP when...
<ul style="list-style-type: none">• There is a request by an IP creator• There is strategic relevance to health care or end user• There is greater potential for successful adoption or commercialization with AHS as the owner• Retention decreases risk and conflict of interest• There is a contractual stipulation of a sponsor/funder• There is an overall net benefit to the parties• There is an increased likelihood for use in health care• Significant AHS resources were used	<ul style="list-style-type: none">• The IP is not relevant to AHS or is not a health system priority• The bulk of resources used in the development of the IP were not from AHS• The IP creator is willing and has the capability to undertake commercialization efforts• AHS is satisfied that its affiliation agreement partners will diligently pursue and report to AHS on their IP protection and commercialization activities





Commercialization

Commercialization is the transfer and/or commercial exploitation undertaken with respect to IP and includes licensing, sale, or further development through a spin-off company or joint venture.

AHS will consult with the IP creator with respect to the commercialization strategy for the IP, but the final IP commercialization strategy is determined by AHS.

Revenue from commercialization is split as per next slide.

If AHS no longer wishes to continue to commercialize the IP, AHS may discontinue such efforts provided there are no outstanding contractual commitments, and the IP creator has been offered a transfer of any existing rights relating to the IP in accordance with the [AHS Transfer of Ownership of the Intellectual Property Procedure](#).



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Considerations for Transferring IP Ownership

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Revenue Sharing





Revenue Sharing

Net revenue from commercialized IP is shared in accordance with the AHS IP Policy. In the event that there is more than one IP creator for any IP, the IP creators shall determine the division of the IP creator share between them.

Distribution of Revenue

When AHS owns and commercializes IP...	When AHS transfers ownership of IP...
<ul style="list-style-type: none">• 33.33% to the IP creator• 33.33% to AHS for innovation and research administration and other purposes• 33.33% to support ongoing innovation and research in the IP creator's department at AHS	<ul style="list-style-type: none">• 66.67% to the IP creator• 33.33% to AHS for innovation and research administration and other purposes• In exceptional circumstances, AHS reserves the right to enter into alternate arrangements





ADDITIONAL RESOURCES

Printable Resources



IP FAQs
(20220422)

[AHS IP Policy & Procedures](#)

[AHS IP Disclosure Form](#)

[Canadian Intellectual Property Office TOOLBOX](#)



[Author](#)
[Contact for further questions](#)



Case Studies

- [AHS retained IP ownership with License to Spin-off or third-party company](#)
- [AHS assigned IP ownership to Spin-off company](#)
- [AHS assigned IP ownership back to creators](#)
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Revenue Sharing



AHS retained IP ownership with License to Spin-off or third-party company

IP Disclosure

Staff completed an AHS IP Disclosure Form asking for AHS support in commercialization

Review

- No third party encumbrances/owners
- Significant AHS resources used in the creation of the IP
- High likelihood for use in health care
- Great potential for improving patient outcomes and providing alternative treatment plans not currently available
- Patent eligible subject matter, novel, useful, non-obvious

Assessment

- AHS to retain ownership, file patent applications for protection, and market to potential licensees

Outcome

AHS supported patent costs and development over years, but did not find an adequate 3rd party licensee to continue development of the technology. Creators later formed a spin-off company and AHS agreed to license the technology to their spin-off in exchange for future royalties on sales.



AHS assigned IP ownership to Spin-off company

IP Disclosure

Staff completed an AHS IP Disclosure Form asking for AHS to assign the technology to the creators' spin-off company created to commercialize the technology

Review

- No third party encumbrances/owners
- Significant AHS resources used in the creation of the IP
- Not a health system priority
- Creators willing and capable of undertaking commercialization

Assessment

- AHS owns the technology, but is willing to assign to the creators' spin-off company

Outcome

AHS assigned the technology to the creators' spin-off company in exchange for future royalties on sales. AHS also retained rights to use for healthcare purposes. The spin-off company is responsible for all aspects of commercialization, including IP protection as applicable.



AHS assigned IP ownership back to creators

IP Disclosure

Staff completed an AHS IP Disclosure Form asking for AHS support in commercialization

Review

- No third party encumbrances/owners
- Significant AHS resources used in the creation of the IP
- High likelihood for use in health care
- Potential for improving patient outcomes
- Patent eligible subject matter, novel, useful, non-obvious

Assessment

- AHS to retain ownership, file patent applications for protection, and market to potential licensees

Outcome

AHS supported patent costs, but after several interactions with the patent office, did not believe it would be successful in receiving an issued patent. Unprotected IP is difficult to license and AHS decided to no longer support commercialization efforts. The technology was offered back to the IP creators. In accordance with IP policy, AHS is still due 1/3 of revenue should the creators be successful in commercializing the technology.



AHS jointly owned IP with a University

IP Disclosure

Staff completed an AHS IP Disclosure Form noting joint appointment with a University

Review

- No third party encumbrances/owners
- AHS and University resources used in the creation of the IP
- Majority University creators
- Potential use in healthcare
- Patent eligible subject matter, novel, useful, non-obvious

Assessment

- AHS to share joint ownership with University, University to act as commercialization lead on behalf of both parties

Outcome

AHS entered into an Inter-Institutional Agreement with University to govern the management and commercialization of IP. University is responsible for all IP protection and commercialization. AHS and creators receive a share of revenue from the University after University has recouped patent expenses.



Copyright licensed under Creative Commons

IP Disclosure

Staff completed an AHS IP Disclosure Form with intent to commercialize copyright works with AHS support

Review

- No third party encumbrances/owners
- Significant AHS resources used in the creation of the IP
- High likelihood for use in health care
- Protected by copyright upon creation
- No third party licensed content

Assessment

- AHS to retain ownership and market to potential licensees

Outcome

Following further discussion, the creators decided not to commercialize the work, but to publish and offer it for free under a Creative Commons license with attribution to AHS, solely non-commercial use, and no permission for derivatives (CC-BY-NC-ND).



AHS policy does not apply

IP Disclosure

Staff completed an AHS IP Disclosure Form requesting assignment of the technology on basis that no AHS resources were used

Review

- No third party encumbrances/owners
- IP created in non-AHS facility (personal residence)
- IP created on own time (not as part of their AHS duties)
- IP created without use of AHS resources

Assessment

- AHS policy does not apply and AHS has no ownership in the technology

Outcome

AHS documented in a letter to the creators that AHS policy did not apply to the creation of the IP and disclaimed any ownership in the technology. The creators are free to proceed with commercialization as they see fit without any further obligation to AHS.



Novelty destroying prior art

IP Disclosure

Staff completed an AHS IP Disclosure Form asking for AHS support in commercialization

Review

- No third party encumbrances/owners
- Significant AHS resources used in the creation of the IP
- High likelihood for use in health care
- Potential for improving patient outcomes
- Patent eligible subject matter
- Previous publication by investigators found online from 2 years ago

Assessment

- Prior art (publication by creators) destroyed the novelty of the invention making it no longer patentable

Outcome

AHS could not file a patent application. Licensing unpatented technologies is difficult, unless the creators wish to for a spin-off and commercialize without IP protection. AHS did not pursue commercialization. If you plan on commercializing, hold-off on publishing until IP is protected.



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