



TITLE

**TRANSFER OF OWNERSHIP OF THE INTELLECTUAL PROPERTY**

SCOPE

Provincial

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Alberta Health Services Executive Leadership Team

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Intellectual Property Policy (#1137)

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**NOTE:** The first appearance of terms in bold in the body of this document (except titles) are defined terms – please refer to the Definitions section.

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## OBJECTIVES

- To outline the rights and obligations of Alberta Health Services (AHS) and **intellectual property creators (IP creator)** in the transfer of ownership of **intellectual property (IP)** to the IP creator or to a third party.

## APPLICABILITY

Compliance with this document is required by all Alberta Health Services employees, members of the medical and midwifery staffs, students, volunteers, and other persons acting on behalf of Alberta Health Services (including contracted service providers as necessary).

## ELEMENTS

### 1. Initial Ownership of Intellectual Property

- 1.1 Ownership of rights in IP developed by an IP creator is governed by the *Intellectual Property Policy*.

### 2. Transfer of Intellectual Property owned by AHS

- 2.1 AHS may receive requests to transfer IP either to the IP creator or to a third party under an **Affiliation Agreement** or other joint IP sharing agreement. Such a request may only be made with respect to IP for which an *Intellectual Property Disclosure Form (IP Disclosure Form)* has been filed in accordance with the *Intellectual Property Disclosure Procedure* and the *Intellectual Property Disclosure Form Procedure*.

- 2.2 Upon such request, the Vice President, Provincial Clinical Excellence (VP, PCE) shall consult with the other parties with an interest in the IP, before a decision regarding the transfer is made. The VP, PCE shall review the IP creator's or the third party's plans for the **commercialization** of the IP, and such other matters with respect to the IP as the VP, PCE considers relevant in the circumstances, including the considerations for ownership contained in the *Intellectual Property Assessment* Procedure. The VP, PCE may involve additional AHS staff and consultants to assist and review the request for transfer. AHS is not obligated to transfer IP to any requestor.
- 2.3 The terms and conditions of the transfer shall take into account the provisions for the sharing of revenues.
- 2.4 Before ownership of IP is transferred to the IP creator or the third party, the parties shall enter into an agreement setting out the terms and conditions of such transfer. All such agreements shall include a provision granting AHS 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 for the provision of health care services. AHS shall not sell or sublicense IP that has been assigned to the IP creator or a third party.
- 2.5 When AHS has transferred IP to the IP creator, the IP creator shall report and obtain approval from AHS prior to any subsequent transaction whereby the rights to the IP are transferred to a party that is either directly or indirectly not at arm's length to the IP creator.
- 2.6 AHS is not obligated to provide any support after the transfer has occurred. The transferee is solely responsible for all obligations and costs for the IP, unless otherwise agreed to between AHS and the transferee.

## DEFINITIONS

**Affiliation agreement** means a formal legal contract, including a master IP agreement and any sub-agreements, between AHS and another organization, usually an academic institution, which defines the terms of their relationship. These terms may include, but are not limited to, shared and/or overlapping responsibilities for IP, staff, and students.

**Commercialization** or **commercialize** means the transfer or commercial exploitation or any combination thereof undertaken with respect to IP and includes, without limitation, licensing, sale, or further development through a spin-off company or joint venture.

**Intellectual property (IP)** means:

- the intangible nature of works or creations that is unique and original;
- any tangible expression thereof;
- the rights arising from the legal protection of IP, including copyright, trademarks, patents, industrial designs, and integrated circuit topographies; and
- know-how and other trade secrets.

IP includes, but is not limited to, technology, technical information, data, databases, formulae, computer software, computer code, drawings, graphics, designs, concepts, ideas, apparatus, processes, research tools, prototypes, methods, techniques, and all original literary, dramatic, musical, and artistic works, all print, multimedia electronic and audiovisual materials, manuals, program packages, and educational materials.

**Intellectual property creator (IP creator)** means the originator of IP who is an AHS employee, an individual working in association with an AHS employee, an individual using AHS resources, or a partnership of one or more individuals or organizations.

## REFERENCES

- Alberta Health Services Governance Documents:
  - *Intellectual Property Policy* (#1137)
  - *Intellectual Property Assessment Procedure* (#1137-01)
  - *Intellectual Property Disclosure Procedure* (#1137-04)
  - *Intellectual Property Disclosure Form Procedure* (#1137-07)
- Alberta Health Services Forms:
  - *Intellectual Property Disclosure Form*

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