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Memo to all Members of the Faculty Association April 23, 2007

Negotiated settlement reached in Intellectual Property grievance.

A settlement was recently reached with the Employer regarding our Intellectual Property grievance. At the request of the parties, the start of the April 9-10 arbitration hearing was delayed to allow discussions to occur between the parties which led to a negotiated settlement late in the day on April 9. The arbitration hearing was convened at that point but only to register the *Minutes of Grievance Resolution* with the Arbitration Board and to ask that it retain jurisdiction over the matter for 60 days.

While it is the Association's position that the Collective Agreement provides for Members' ownership of all intellectual property which arises from their scholarly work, this grievance was not directly about the *ownership* of intellectual property. It was primarily about two issues:

1. The Employer's failure to recognize the Association as the *sole and exclusive* bargaining agent for its Members when it attempted to negotiate directly with Members to alter their intellectual property ownership rights, and
2. The Employer's actions to enter into a contract with a third party (ACOA) which named the University as the sole owner of intellectual property to the exclusion of Members; and to subsequently require those Members to enter into *sub-agreements* with the University for the purpose of assigning the ownership of their intellectual property to the University.

To address these points, the parties agreed to the following:

1. That a template agreement will be used for all Members who are currently involved in ACOA AIF contracts signed since March 12, 2004 and who have not signed any *sub-agreement* which assigns their ownership of intellectual property to the University. Among other items, this template agreement, which is to be signed by the University, the Member(s) and the Association, identifies the Association as the *sole and exclusive* bargaining agent for its Members and confirms that the title to any intellectual property developed in the project is to be vested in the Member and UPEI in accordance with their respective interests under the Collective Agreement. This same template agreement is to be used for all future ACOA AIF contracts. A copy of this agreement is included with this memo.
2. That all future (as of April 9, 2007) third-party research contracts and grants, excluding ACOA AIF contracts, which involve intellectual property will use a template agreement similar to that developed for the ACOA AIF contracts and will be signed by the University, the Member(s) and the Association.



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3. That the Employer provide the Association with a list of all third-party research contracts and grants, including all Members involved on each, for the time since the first Collective Agreement (March, 2004), where intellectual property was assigned by the University either entirely or partially to one or more third parties with any remaining portion held only by the University. The Association will then contact each identified Member to determine whether or not they agree with the continuation of the current intellectual property ownership arrangement. If not, the Employer must seek the consent of all third parties involved to amend the third-party agreements to recognize the intellectual property ownership interests of the Member. If a third party refuses to provide the necessary consent, the Association reserves the right to seek appropriate recourse under the Collective Agreement.

The Association is very pleased with the outcome of this settlement. First, it is an important acknowledgement that the Union is the *sole and exclusive* bargaining agent for its Members in all areas of the Collective Agreement, not just for intellectual property matters. Second, it allows the Union to address, on behalf of **all** Members, the concerns arising from the assignment of intellectual property ownership, both on a go-forward and retroactive basis. The Association can now ensure that Members' rights are protected in future situations and can exercise its *duty to fair representation* to all Members affected by intellectual property assignment agreements executed in the past.

The Association will be contacting those affected Members as soon as the Employer provides it with the necessary information. However, should you not be contacted by the Association within the next three weeks and you believe that you are affected by the terms of this settlement, please contact the Association immediately.

attachment: ACOA AIF intellectual property template agreement

THIS AGREEMENT MADE IN CHARLOTTETOWN, PEI, THIS _____ DAY OF _____, 20____.

BETWEEN:

The University of Prince Edward Island
(hereinafter called "UPEI")

AND:

The University of Prince Edward Island Faculty Association
(hereinafter called "the Faculty Association")

AND:

[NAME THE MEMBER OF THE FACULTY ASSOCIATION INVOLVED]

(hereinafter called the "Member")

(UPEI, Faculty Association and Member hereinafter called, collectively, the "Parties")

WHEREAS the Member is employed by UPEI and research is part of their scholarly duty, and has chosen to be involved in a project entitled _____ (the "Project");

AND WHEREAS the Project is partially funded by the Atlantic Canada Opportunities Agency ("ACOA") through the Atlantic Innovation Fund ("AIF");

AND WHEREAS the objectives of AIF funding are to strengthen the region's innovation capacity by supporting research, development and commercialization partnerships; to promote innovation and research and development that leads to technologies, products, processes or services that contribute to growth in Atlantic Canada; and to increase commercialization of these research and development outputs;

AND WHEREAS the acceptance of AIF funding requires that development of Intellectual Property and/or Proprietary Technology and/or Resulting Products arising from the Project (hereinafter "Intellectual Property") shall be subject to protection in order to further commercialization which may involve a patenting;

AND WHEREAS the commercialization of Intellectual Property developed in the Project is a mutual goal of the Parties;

AND WHEREAS the Faculty Association is the sole and exclusive bargaining agent for the Member;

AND WHEREAS the Parties acknowledge and confirm that they are governed by a Collective Agreement expiring on June 30, 2010, subject only to the provisions of this Agreement;

AND WHEREAS the Parties acknowledge that a requirement of ACOA's AIF funding program is the commercialization of arising Intellectual Property to the benefit of Atlantic Canada. And in consideration of the above and such other good and valuable consideration, the Parties agree that:

1. **“Background Intellectual Property”** means the intellectual property rights in the technology developed prior to the beginning of the Project and required for the carrying out of the Project or the exploitation of the Foreground Intellectual Property;

“Foreground Intellectual Property” means all technical data, including without limitation, all designs, specifications, software, data, drawings, plans, reports, patterns, models, prototypes, demonstration units, practices, inventions, methods, applicable special purpose equipment and related technology, processes or other information conceived, produced, developed or reduced to practice in carrying out the Project, and all rights therein, including without limitation, patents, copyrights, industrial designs, trade-marks, and any registrations or applications for the same and all other rights of intellectual property therein, including any rights which arise from the above items being treated by the Proponent as trade secrets or confidential information;

“Resulting Products” mean the Foreground Intellectual Property and/or any products resulting from the use of the Foreground Intellectual Property; and

“Day” means a day from Monday to Friday, excluding holidays, on which the offices of the Administration of UPEI are open, unless otherwise specified.

2. The Member or UPEI either owns the Background Intellectual Property or holds sufficient rights in the same to permit the Project to be carried out and the Foreground Intellectual Property to be exploited.
3. As between UPEI and the Member the title to the Foreground Intellectual Property is to be vested in the Member and UPEI in accordance with their respective interests under the provisions of the Parties’ Collective Agreement.
4. UPEI and the Member shall take the appropriate steps to protect the Foreground Intellectual Property as herein provided.
5. Pursuant to Article H4.1 and H4.7.6 of the Collective Agreement, the Member agrees that all commercial or marketing opportunities which may arise from the Project are considered worthy of Intellectual Property protection and agrees to offer a contract to UPEI in accordance with Article H4.7.6 of the Collective Agreement.
6. Subject to clause 8 herein, the Parties mutually agree to hold information and/or documentation in relation to the Intellectual Property arising from the Project in strict confidence. The Faculty Association will not be privy to technical or scientific details unless specifically requested by the Member in which event such information will be held in strict confidence, and the Faculty Association will execute a confidentiality agreement with UPEI.
7. Subject to clause 8 herein, the Parties will work co-operatively to prevent premature disclosure of the Intellectual Property arising from the Project, in order to protect the Member’s and UPEI’s rights in relation to the Intellectual Property.
8. Prior to publishing, presenting or submitting an abstract, manuscript, presentation or submission (the “Publication”) relating directly or indirectly to the Intellectual Property, a penultimate draft of the Publication will be provided to UPEI’s designated officer for review. The designated officer will determine with the Member authoring or responsible for the Publication, whether the Intellectual Property arising in the Project may be prematurely disclosed by the publication. UPEI will advise the

Member, within 30 days, of the results of the review. UPEI may be granted a further 30 days to review with the mutual consent of the Member. If UPEI has not advised the Member of its determination within 30 days, or if extended by consent 60 days, of the results of the review, UPEI will be considered to have authorized the release or disclosure of the Publication. In order to minimize delays in the review, UPEI will accept partially completed manuscripts or drafts-in-progress for review if these drafts are sufficiently detailed as to describe the research, the associated data, its conclusions and its implications.

- (a) If UPEI determines that the Intellectual Property may be prematurely disclosed in a Publication, the Member shall redraft the Publication to remove or modify the Publication, as appropriate, to prevent premature disclosure.
 - (b) If a Publication cannot be disclosed or released because it is not possible to amend or modify it adequately to avoid disclosing the Intellectual Property, UPEI may request that the Publication be withheld from disclosure or release for up to, but not exceeding, an additional 60 days so that UPEI may evaluate the Intellectual Property and take such steps as may be appropriate to protect the Intellectual Property arising from the Project, including patent applications, pursuant to Article H4.7.6 of the Collective Agreement.
 - (c) In all other respects UPEI and the Faculty Association agree that neither will infringe upon the academic freedom of the Member.
9. It is to the mutual advantage of the Parties for the Member to assist UPEI during the negotiations for commercialization of the Intellectual Property developed in the Project, and the Parties will co-operate to effect that goal.
10. Revenue from commercialization will be divided as per Article H4.7.6 of the Collective Agreement.
11. Except as herein expressly modified the Parties confirm the application of all terms and conditions of the Collective Agreement expiring on June 30, 2010.
12. In all matters involving Intellectual Property in which UPEI may have an interest under Article H4 of the Collective Agreement, all negotiations and agreements with third parties shall be negotiated by UPEI. All negotiations and agreements sought to be entered into by UPEI with any member of the Faculty Association shall be negotiated with the Faculty Association as the sole and exclusive bargaining agent of the Member.

DATED at Charlottetown, PEI, on the _____ day of _____, 20____.

University of Prince Edward Island

Per: _____

And: _____

University of Prince Edward Island Faculty Association

Per: _____

And: _____

Member
