

## **Questions to consider when drafting an IP Plan for inclusion in a grant application**

### **Who are the project participants and what intellectual property (IP) policy are they covered by?**

Are the participants undergraduate students, graduate students, post-docs, research assistants, technicians, etc.? Are any of the project leaders or participants affiliated with another university or an affiliated research centre (i.e. hospital)? If so, what is their IP policy? Knowing this will help to determine who owns the IP (i.e. the creators or the university/hospital or a combination). If participants don't fall under these criteria please contact Queen's Partnerships and Innovation (see below).

### **Are any project participants contributing Background IP (BIP) that will be used in this project?**

If yes, summarize the relevant BIP. Has this BIP been protected? Are there any obligations associated with the project team's use of this BIP that may impact the ability to exploit the project results? For example, have any of the participating institutions, project leaders or participants granted or assigned rights to BIP to a third party such as a funding agency or a collaborating company, or can the BIP be used in a project with plans for commercialization.

### **If using open-source software do you have the necessary rights to exploit and commercialize/license the project results and/or Foreground IP (FIP)?**

Ensure you carefully review the terms of use associated with open-source software. Some open-source providers do not allow users to commercialize inventions using their open-source software.

### **Do you plan to sub-contract a portion of the project work to third parties?**

If yes, indicate that you will engage Queen's to formally document such arrangements via collaboration agreements, fee-for-service contracts, or employment contracts, as may be appropriate, to ensure Queen's and the project team secure FIP rights, for the purposes of commercialization, associated with collaborations or fee-for-service/contract work such as software/app creation.

### **How will you determine who created the FIP?**

For patentable subject matter this can be based on an inventorship analysis to be led by Queen's Partnerships and Innovation; for copyright - authorship.

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## Will any new rights (option, license, ownership) associated with BIP or FIP be granted?

Do the project leaders or participants envision granting rights (exclusive or non-exclusive?) or assigning IP to a third party such as a funding agency or a collaborating company? If yes, note the expectation that the research team will have rights to use the IP for research and academic purposes.

## How will you ensure that the IP remains confidential and out of the public domain before it is protected?

Engage Queen's Partnerships and Innovation to establish non-disclosure agreements (NDA) with third parties that are not project collaborators in advance of project participants speaking to third parties about the IP; ensure IP is protected prior to submitting draft publications or presenting posters or giving oral presentations at conferences; work with collaborators to agree on a plan re: what/how/when project details can be shared and ensure mechanisms are in place to enable student participants to use the results to complete their studies.

## How will the IP be protected and exploited?

Consider the potential value of project-related IP. Will the IP be protected by patent, trade secret, copyright, design patent? Remember to disclose your inventions to Queen's Partnerships and Innovation prior to publication and for potential licensing to third party, startup formation, etc.

## How will you ensure all project participants are aware of, and in agreement with, the IP Plan?

Consider documenting such a plan in an internal or inter-institutional research agreement.

## Who will lead the initial commercialization process?

Will the process be led by Queen's, another collaborating institution or a collaborating company?

### Questions? Contact Queen's Partnerships and Innovation:

- [Michael.Wells@queensu.ca](mailto:Michael.Wells@queensu.ca)  
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### Information Related to Intellectual Property:

- [Intellectual Property Guidelines](#)
- [Queen's - QUFA Collective Agreement](#)
- [Postdoctoral Fellows Collective Agreement](#)
- [Queen's University Library Inventor Resources](#)