



## UNIVERSITY OF CALIFORNIA PATENT POLICY AND ACKNOWLEDGMENT

<b>Employee's Name (Last, First, Middle Initial)</b>		<b>Date Prepared</b>
<b>Employee ID</b>	<b>Department</b>	<b>Employment Date</b>

### PATENT ACKNOWLEDGMENT

This acknowledgment is made by me to The Regents of the University of California, a corporation, hereinafter called "University," in part consideration of my employment, and of wages and/or salary to be paid to me during any period of my employment, by University, and/or my utilization of University research facilities and/or my receipt of gift, grant, or contract research funds through the University.

By execution of this acknowledgment, I understand that I am not waiving any rights to a percentage of royalty payments received by University, as set forth in the University of California Patent Policy, hereinafter called "Policy."

I also understand and acknowledge that the University has the right to change the Policy from time to time, including the percentage of net royalties paid to inventors, and that the policy in effect at the time an invention is disclosed shall govern the University's disposition of royalties, if any, from that invention. Further, I acknowledge that the percentage of net royalties paid to inventors is derived only from consideration in the form of money or equity received under: 1) a license or bailment agreement for licensed rights, or 2) an option or letter agreement leading to a license or bailment agreement. I also acknowledge that the percentage of net royalties paid to inventors is not derived from research funds or from any other consideration of any kind received by the University. The Policy on Accepting Equity When Licensing University Technology governs the treatment of equity received in consideration for a license.

I acknowledge my obligation to assign, and do hereby assign, inventions and patents that I conceive or develop 1) within the course and scope of my University employment while employed by University, 2) during the course of my utilization of any University research facilities, or 3) through any connection with my use of gift, grant, or contract research funds received through the University. I further acknowledge my obligation to promptly report and fully disclose the conception and/or reduction to practice of potentially patentable inventions to the University authorized licensing office. Such inventions shall be examined by the University to determine rights and equities therein in accordance with the Policy. I shall promptly furnish University with complete information with respect to each.

In the event any such invention shall be deemed by University to be patentable or protectable by an analogous property right, and University desires, pursuant to determination by University as to its rights and equities therein, to seek patent or analogous protection thereon, I shall execute any documents and do all things necessary, at University's expense, to assign to University all rights, title, and interest therein and to assist University in securing patent or analogous protection thereon. The scope of this provision is limited by Calif. Labor Code Sec. 2870, to which notice is given below. In the event I protest the University's determination regarding any rights or interest in an invention, I acknowledge my obligation: (a) to proceed with any University requested assignment or assistance; (b) to give University notice of that protest no later than the execution date of any of the above-described documents or assignment; and (c) to reimburse University for all expenses and costs it encounters in its patent application attempts, if any such protest is subsequently sustained or agreed to.

I acknowledge that I am bound to do all things necessary to enable University to perform its obligations to grantors of funds for research or contracting agencies as said obligations have been undertaken by University.

University may relinquish to me all or a part of its right to any such invention, if, in its judgment, the criteria set forth in the Policy have been met.

I acknowledge that I am bound during any periods of employment by University or for any period during which I conceive or develop any invention during the course of my utilization of any University research facilities, or any gift, grant, or contract research funds received through the University.

In signing this acknowledgment, I understand that the law, of which notification is given below, applies to me, and that I am still required to disclose all my inventions to the University.

**NOTICE:** This acknowledgment does not apply to an invention which qualifies under the provision of Calif. Labor Code Sec.2870 which provides that (a) Any provision in an employment agreement which provides that an employee shall assign, or offer to assign, any of his or her rights in an invention to his or her employer shall not apply to an invention that the employee developed entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information except for those inventions that either:

- (1) Relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer; or
- (2) Result from any work performed by the employee for the employer. (b) To the extent a provision in an employment agreement purports to require an employee to assign an invention otherwise excluded from being required to be assigned under subdivision (a), the provision is against the public policy of this state and is unenforceable. In any suit or action arising under this law, the burden of proof shall be on the individual claiming the benefits of its provisions.

**RETENTION:** Accounting: 5 years after separation, except in cases of disability, retirement or disciplinary action, in which case retain until age 70. Other Copies: 0-5 years after separation.

Employee/Guest Name (Please print): \_\_\_\_\_

Employee/Guest Signature: \_\_\_\_\_ Date: \_\_\_\_\_

University Acceptance: \_\_\_\_\_ Date: \_\_\_\_\_

## UNIVERSITY OF CALIFORNIA PATENT POLICY—October 1, 1997

### I. PREAMBLE

It is the intent of the President of the University of California, in administering intellectual property rights for the public benefit, to encourage and assist members of the faculty, staff, and others associated with the University in the use of the patent system with respect to their discoveries and inventions in a manner that is equitable to all parties involved.

The University recognizes the need for and desirability of encouraging the broad utilization of the results of University research, not only by scholars but also in practical application for the general public benefit, and acknowledges the importance of the patent system in bringing innovative research findings to practical application.

Within the University, innovative research findings often give rise to patentable inventions as fortuitous by-products, even though the research was conducted for the primary purpose of gaining new knowledge. The following University of California Patent Policy is adopted to encourage the practical application of University research for the broad public benefit; to appraise and determine relative rights and equities of all parties concerned; to facilitate patent applications, licensing, and the equitable distribution of royalties, if any; to assist in obtaining funds for research; to provide for the use of invention-related income for the further support of research and education; and to provide a uniform procedure in patent matters when the University has a right or equity.

### II. STATEMENT OF POLICY

**A.** An agreement to assign inventions and patents to the University, except those resulting from permissible consulting activities without use of University facilities, shall be mandatory for all employees, for persons not employed by the University but who use University research facilities, and for those who receive gift, grant, or contract funds through the University. Such an agreement may be in the form of an acknowledgment of obligation to assign. Exemptions from such agreements to assign may be authorized in those circumstances when the mission of the University is better served by such action, provided that overriding obligations to

**B.** Those individuals who have so agreed to assign inventions and patents shall promptly report and fully disclose the conception and/or reduction to practice of potentially patentable inventions to the Office of Technology Transfer or authorized licensing office. They shall execute such declarations, assignments, or other documents as may be necessary in the course of invention evaluation, patent prosecution, or protection of patent or analogous property rights, to assure that title in such inventions shall be held by the University or by such other parties designated by the University as may be appropriate under the circumstances. Such circumstances would include, but not be limited to, those situations when there are overriding patent obligations of the University arising from gifts, grants, contracts, or other agreements with outside organizations.

In the absence of overriding obligations to outside sponsors of research, the University may release patent rights to the inventor in those circumstances when:

1. the University elects not to file a patent application and the inventor is prepared to do so, or
2. the equity of the situation clearly indicates such release should be given, provided in either case that no further research or development to develop that invention will be conducted involving University support or facilities, and provided further that a shop right is granted to the University.

**C.** Subject to restrictions arising from overriding obligations of the University pursuant to gifts, grants, contracts, or other agreements with outside organizations, the University agrees, following said assignment of inventions and patent rights, to pay annually to the named inventor(s), or to the inventor(s)' heirs, successors, or assigns, 35% of the net royalties and fees per invention received by the University. An additional 15% of net royalties and fees per invention shall be allocated for research-related purposes on the inventor's campus or Laboratory. Net royalties are defined as gross royalties and fees, less the costs of patenting, protecting, and preserving patent and related property rights, maintaining patents, the licensing of patent and related property rights, and such other costs, taxes, or reimbursements as may be necessary or required by law.

other parties are met and such exemptions are not inconsistent with other University policies.

Inventor shares paid to University employees pursuant to this paragraph represent an employee benefit. When there are two or more inventors, each inventor shall share equally in the inventor's share of royalties, unless all inventors previously have agreed in writing to a different distribution of such share.

Distribution of the inventor's share of royalties shall be made annually in November from the amount received during the previous fiscal year ending June 30th, except as provided for in Section II.D. below. In the event of any litigation, actual or imminent, or any other action to protect patent rights, the University may withhold distribution and impound royalties until resolution of the matter.

**D.** The DOE Laboratories may establish separate royalty distribution formulas, subject to approval by the President. Distribution of the inventor's share of DOE Laboratory royalties shall be made annually in February from the amount received during the previous fiscal year ending September 30th. All other elements of this policy shall continue to apply.

**E.** Equity received by the University in licensing transactions, whether in the form of stock or any other instrument conveying ownership interest in a corporation, shall be distributed in accordance with the Policy on Accepting Equity When Licensing University Technology.

**F.** In the disposition of any net income accruing to the University from patents, first consideration shall be given to the support of research.

### **III. PATENT RESPONSIBILITIES AND ADMINISTRATION**

**A.** Pursuant to Regents' Standing Order 100.4(mm), the President has responsibility for all matters relating to patents in which the University of California is in any way concerned. This policy is an exercise of that responsibility, and the President may make changes to any part of this policy from time to time, including the percentage of net royalties paid to inventors.

**B.** The President is advised on such matters by the Technology Transfer Advisory Committee (TTAC), which is chaired by the Senior Vice

President—Business and Finance. The membership of TTAC includes the Provost and Senior Vice President—Academic Affairs, the Director of the Office of Technology Transfer, and representatives from the campuses, DOE Laboratories, Academic Senate, the Division of Agriculture and Natural Resources and the Office of the General Counsel. TTAC is responsible for:

1. Reviewing and proposing University policy on intellectual property matters including patents, copyrights, trademarks, and tangible research products;
2. Reviewing the administration of intellectual property operations to ensure consistent application of policy and effective progress toward program objectives; and
3. Advising the President on related matters as requested.

**C.** The Senior Vice President—Business and Finance is responsible for implementation of this Policy, including the following:

1. Evaluating inventions and discoveries for patentability, as well as scientific merit and practical application, and requesting the filing and prosecution of patent applications.
2. Evaluating the patent or analogous property rights or equities held by the University in an invention, and negotiating agreements with cooperating organizations, if any, with respect to such rights or equities.
3. Negotiating licenses and license option agreements with other parties concerning patent and or analogous property rights held by the University.
4. Directing and arranging for the collection and appropriate distribution of royalties and fees.
5. Assisting University officers in negotiating agreements with cooperating organizations concerning prospective rights to patentable inventions or discoveries made as a result of research carried out under gifts, grants, contracts, or other agreements to be funded in whole or in part by such cooperating organizations, and negotiating with Federal agencies regarding the disposition of patent rights.
6. Approving exceptions from the agreement to assign inventions and patents to the University as required by Section II.A. above.
7. Approving exemptions to University policy on intellectual property matters including patents, copyrights, trademarks, and tangible research products.