



UC San Diego

Policy & Procedure Manual

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CONTRACTS AND GRANTS (RESEARCH)

Section: 150-33

Rescinded: 08/16/2021

Effective: 07/02/1983

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Issuing Office: [Office of Contract and Grant Administration](#)

UCSD PATENT PROGRAM

I. REFERENCES

- A. Patent Policy Issuance Statement by President Saxon dated March 13, 1980.
- B. [University of California Regulation 23 "University Policy Regarding Patents" \(revised April 1, 1980\)](#).
- C. University Patent Agreement Requirements and Procedures, dated July 14, 1976.
- D. University of California Academic Personnel Manual, Section 200-99, a.(7).
- E. University of California Employment Certification form U1600.
- F. Patent Practices at the University of California (October, 1982).
- G. [University Regulation No. 4 \(Revised\)](#).

II. RELATED POLICIES AND PROCEDURES

UCSD Policy and Procedure Manual (PPM)

- 165-99 Payments to Postdoctoral Scholars
- 165-100 Visiting Scholar Program
- [230-20](#) Procedures for Appointment of Academic Personnel
- 250-6.1 Student Employment Work-Study
- 250-7 Personnel Transaction Forms
- [500-5](#) University Copyright Policy
- [523-10.1](#) Independent Consultants

III. BACKGROUND

The University of California has maintained an active patent and patent licensing program for over 35 years. The major objectives of the University patent program are: (1) to disseminate new and useful knowledge resulting from University research through the use of the patent system; (2) to license patents to industry in order to promote the development of inventions toward practical application for use by the general public; (3) to provide income for use in supporting further research and education, with a share of the income going to the inventor, and (4) to assure that patent-related obligations to sponsors of research are met.

IV. POLICY

It is an objective of the University to promote the wide dissemination of new ideas to the general public. Most new ideas, however, require considerable development before tangible results are

available for the public benefit. The patent system is an effective means for promoting such development. By granting the inventor a limited period (17 years) of exclusivity for the invention, the patent system of the United States encourages the investment of resources necessary for developing the invention to the point of practical application. In return for this limited right to exclude others, the inventor must disclose the details of the invention, thereby making new knowledge available to everyone and stimulating others to make still further inventions.

In order to encourage and assist the University inventor in the use of the patent system in a manner that is equitable to all parties involved, the Regents have adopted the *University Policy Regarding Patents*, [Exhibit A](#). The *Policy* requires all University employees, persons not employed by the University but who use University research facilities, and those who receive grant or contract funds through the University to agree to assign patents and inventions to the University. In return, the inventor receives 50% of net royalties and fees received by the University.

V. PROCEDURES

A. Acceptance of Award Involving Extramural Funds

1. Upon acceptance of a contract or grant award by the University, the Office of Contract and Grant Administration (OCGA) shall advise the Principal Investigator, in writing, of the patent provisions contained in the award document and of related University patent policies, regulations and procedures.
2. Prior to start of work involving extramural funds, the Principal Investigator shall apprise all individuals known to be involved in the work under the contract, including Graduate Students and visiting scientists and scholars, of the patent obligations to the sponsoring agency and the University.
3. If the Principal Investigator is working and/or receiving funds from more than one agency, care must be taken to segregate funds into specific projects and not to overlap their use, so that in the event an invention occurs, conflicting patent requirements will not impede development of the research.
4. The Principal Investigator should always maintain a permanent record of his/her research and related events which may lead to a patentable discovery. This record should be contained in bound notebooks properly witnessed and dated (see [Exhibit B](#)).

B. Disclosure by Inventor

1. All persons subject to the *University Patent Agreement* (see paragraph VI) are required by University regulation and/or by the research sponsor when extramural funds are involved, to report promptly all possibly patentable devices, ideas, processes, or improvements to the Patent Administrator, 2490 Channing Way, Systemwide Administration, Berkeley, California 94720. Disclosure should be made on the form entitled *University of California Record of Invention*, effective January 1, 1982, [Exhibit C](#). Copies of this form may be obtained from the University Patent Office or the OCGA. This information is CONFIDENTIAL and should be submitted promptly to the University Patent Office.
2. To protect United States and foreign patent rights, inventors should not, as a matter of University policy, disseminate copies of the disclosure to any other persons or offices. This policy serves to protect individual and University rights and to ensure that obligations to the research sponsors are met. It does not affect, however, the inventor's obligations to make specific technical reports as required under the contract or grant award.
3. Where a disclosure lists Federal Agency support, the University Patent Administrator will notify the UCSD Office of Contract and Grant Administration by

copy of the acknowledgment letter to the inventor identifying the contract or grant under which the disclosure has been made.

C. Publication of Research

A public "enabling" disclosure of an invention before the actual filing date of a United States patent application automatically destroys patent rights in nearly all foreign countries. An "enabling" disclosure or description is one which will enable others in the same or related field to practice the invention without undue experimentation. Public disclosure means disclosure in any manner, such as by oral or written description, exhibit, demonstration, use, or the like, to outside parties in a nonconfidential environment. United States patent law allows a one-year grace period after first enabling printed publication, public use or sale of the invention in which to file a patent application.

D. Action by the Office of the Board of Patents

Upon receipt of a disclosure statement, the Patent Administrator will review the patent provisions of the appropriate contract or grant award (if the discovery occurred in the course of sponsored research) to determine the equity of the parties in the invention.

1. The disclosure is reviewed as to its novelty, commercial potential in private industry, and patentability.
2. The Patent Administrator will formally report the invention to the sponsor of the research and will also report such findings to the inventor.

E. Determining Commercial Potential

When the Board of Patents has made a determination that an invention is patentable, has practical application, and the University retains patent rights (see [Exhibit A](#)), the invention's actual commercial potential is investigated. The Board may not authorize the filing of patent applications unless there is reasonable expectation of recovering patent prosecution costs.

F. Filing the Patent Application

When the Board of Patents decides that an invention has commercial potential, Patent counsel will be retained, in association with the General Counsel, to file an application for patent and resolve any matters, such as litigations, pertaining to the prosecution of the patent.

G. Negotiating Licenses

Licenses are negotiated with industry by the Patent Administrator on an individual basis, taking into consideration possible limitations which may have been imposed upon the University by the sponsor of research. Financial terms generally include: provision for a license issue fee payable to the University upon execution of the agreement, assurance that the licensee will exercise due diligence in developing the invention; a percentage of sales as royalty; and a minimum annual royalty requirement as a further due diligence measure to insure continued sales effort on the part of the licensee.

The purpose of licensing inventions to industry is twofold: (1) to provide a mechanism for transferring the results of University research to the public for the public benefit, and (2) to generate income for education and research. Net proceeds from licensing income are shared equally between the inventor and the University in accordance with the [University Policy Regarding Patents](#). The University's share is used to finance patent expenses and to support research generally in the University. Funds to support research are allocated annually to each Chancellor by the President. Since 1962, over \$3.5 million have been returned to the campuses for graduate student research, special research projects, and other academic needs.

H. Distributing Royalties to Inventors

Net royalties are shared with inventors pursuant to the schedule set forth in Paragraph 6 of the *University Policy Regarding Patents* (see [Exhibit A](#)). The Board of Patents Office is responsible for the collection and distribution of royalties.

VI. UNIVERSITY PATENT AGREEMENT

A. Purpose

The *University Patent Agreement*, [Exhibit D](#), restates the University policy regarding patents and when signed by the employee and appropriately witnessed, binds the individual and the University to the conditions therein.

B. Who Must Sign

1. All employees (academic and non-academic) hired by the University.
2. Any person using University research facilities, exclusive of libraries, whether in an employee, volunteer, consultant or visitor status.
3. Any person who uses contract or grant funds obtained through the University or who interacts with University personnel engaged in research.

C. Over-riding Patent Obligations

Students are sometimes employed in private industry and their education subsidized by their employers. Since inventions may occur as a result of research conducted in the University, under no circumstances should such students be permitted use of contract or grant funds or research facilities unless they have signed the University Patent Agreement and assured their respective deans/department chairs that they have no overriding patent obligations to an outside employer (see [Exhibit E](#)).

D. Exemption

The following exemptions are limited in each case to only those persons who are not covered under B.2 and B.3 immediately above.

1. A member of the military service who is non-University compensated;
2. A teacher and lecturer of the Extension Division and of regular University curricula;
3. A visiting scholar on special short-term assignment of one year or less (if reappointed, a *Patent Agreement* must be signed);
4. A lecturer making a one-time appearance or a series of appearances;
5. A non-University compensated clinical appointee.

Note: The Patent Administrator has discretionary authority to resolve like situations not specifically covered herein, all subject to approval by General Counsel.

E. Exemption Procedure

1. Exemptions to signing the University Patent Agreement within the limitations set forth above are the responsibilities of the department chair/head. In situations where the department chair/head feels an exemption might be permissible but

which is not specifically covered above, the matter should be referred to the Patent Administrator.

2. In all cases where an exemption is made by the department chair/head, the following statement must be completed, signed and dated by the department chair/head and filed in the individual's personnel file in lieu of a signed *Patent Agreement*.

TO: EMPLOYEE'S PERSONNEL FILE
RE: (Name of Individual Being Exempted)

This is to certify that the above-named individual is [insert pertinent type of exemption listed under VI.D., above]. This individual will not be using any University research facilities or contract or grant funds obtained by or through the University in the course of his/her appointment. He/she therefore qualifies for exemption from the University's patent agreement requirements.

Signed: Department Chair
Date:

VII. CONTRACT AND GRANT PATENT PROVISIONS

A. General Policy

It is the policy of the University to secure patent provisions in each contract or grant agreement which conserve the potential rights of both the inventor and The Regents, while recognizing the probable rights of the extramural sponsor when the sponsor has a desire to have such rights considered.

For information concerning the related area of copyrights, refer to PPM 500-4, University Copyright Policy. Agreements for ownership and other rights related to copyrighted material are administered by the Business Office.

B. Negotiation Guidelines for Classes of Sponsors

1. Federal Agencies

The University, through the Office of Contract and Grant Administration, negotiates with federal sponsors to obtain agreements on patent provisions which will apply to all grants and contracts to which the University and the sponsor are parties. Negotiation is usually conducted in such cases in conjunction with the Patent Administrator.

When no such prior agreement has been achieved, it is University policy that grants and contracts with the Federal sponsor are acceptable when the patent rights provide no more than a non-exclusive, royalty-free license to the Government. The negotiations of provisions giving more comprehensive rights to the sponsor are coordinated by the campus Contract and Grant Officer with the Patent Administrator.

This policy is supported by recent federal legislation as documented by [Public Law 96-517](#), effective July 1, 1981, and OMB Circular A-124, effective March 1, 1982, which provides for allocation of principal rights to small business and nonprofit grantees. Under this policy the Federal Government retains a non-exclusive, non-transferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States the subject invention throughout the world.

2. State, County, and Municipal Governments

Historically and traditionally, agreements with these agencies have not included any patent provisions, and this precedent should be continued. Requests for patent rights by such sponsors are forwarded by the Office of Contract and Grant Administration to the Patent Administrator for consideration and, if necessary, for presentation to the Board of Patents and/or The Regents. In no event may any exception to established policy be made without such submission.

3. Profit- Making Private Organizations

To protect the interests and the potential equities of both the University and its employees/inventors, it is University policy to secure patent provisions which grant patent rights to the University in awards from profit-making enterprises. This policy also applies to any improvements the University may make on an existing invention even though title to that invention vests in the sponsoring agency. However, a profit-making sponsor may obtain certain patent rights through negotiation of an appropriate licensing agreement with the Patent Administrator which provides for energetic exploitation.

In order for any sponsor to be granted a right of first refusal to an exclusive license for the life of any United States' patent with the right to sub-license (insofar as may be possible in light of existing University obligations to other sponsors), the sponsor has the obligation to pay royalties on the license. In addition, the sponsor must pay all of the direct costs associated with the project, including salary compensation commensurate with the effort expended by the Principal Investigator of the project. (See [Exhibit F, Summary of Sponsor Patent Rights Applicable to Funding Agreements with Industrial \[For Profit\] Sponsors of Research.](#)) Support for indirect costs must also be provided by the sponsor, computed by application of the approved University indirect cost rate to the modified total direct cost base (ref. [PPM 150-14](#)).

4. Non-Profit Private Foundations or Organizations

In contrast with the profit-making private organizations, most non-profit private foundations do not engage in commercial development of inventions. Therefore, patent rights in the form of negotiated licenses are neither requested by these agencies nor offered by the University. However, the University's patent policy is still applicable with major concentration of its efforts to the awarding of licenses to commercial organizations with the capability of implementing the invention in the marketplace.

As in the case of the sponsors discussed above, the patent policy of each non-profit sponsor must be reviewed for compliance with University policy. In situations where policies may conflict, acceptable patent language must be negotiated between the University and the sponsor prior to award acceptance.

VIII. RESPONSIBILITIES

A. Patent Administrator

1. Provide assistance to the Office of Contract and Grant Administration in the negotiation of patent matters with extramural sponsors, when the object is to secure a change in the proffered patent terms of the sponsor.
2. Review all inventions reported to the University by individuals subject to the University Patent Agreement, including the:

Determination of the equity of the parties in the invention;

Reporting of the invention to the sponsor of the research;

Referral of patentable and commercially potential inventions to Patent Counsel for patent prosecution.

3. Negotiate licenses with industry on an individual basis.

B. Office of Contract and Grant Administration

1. In consultation with the Systemwide Administration Patent Office, conduct negotiations with extramural sponsors relating to patent matters, when the object is to secure a change in the policy or proffered patent terms of the sponsor.
2. Advise Principal Investigators, in writing, of patent provisions set forth in the agreement supporting their project, and of related University patent policies, regulations and procedures.
3. At the time of the award and periodically thereafter remind all individuals associated with work under a contract or grant of both the University's and the sponsor's patent obligations, including the submission of any required interim and final patent reports.
4. Maintain patent reference files on all extramurally sponsored research contract and grant programs. Coordinate with the Principal Investigator and the campus subcontract administrator the preparation of the agency patent reporting forms.

C. Department Chair / Head

1. Ensure that all individuals, including graduate students, consultants, visiting scientists and scholars, involved in work under a research project, or using University facilities, other than students solely in pursuit of their University studies, have executed a *University Patent Agreement*, [Exhibit D](#), before participating in research.
2. Ensure that the exemption procedure is followed.

D. Principal Investigator

1. Upon receipt of an award from an extramural sponsor, apprise themselves and their assistants of the obligations imposed upon them by the agency and discharge the obligations within the time specified.
2. Ensure that all individuals, including graduate students, consultants, visiting scientists and scholars known to be involved in work under a research project, or using University facilities, other than students solely in pursuit of their University studies, have executed a *University Patent Agreement* before participating in the work.
3. Where work and/or funds from more than one agency are being obtained by the investigator, take care to segregate the funds into specific projects and not to overlap their use so that in the event an invention occurs, conflicting patent requirements will not impede development of the invention.
4. Maintain bound laboratory notebooks on information leading to a possibly patentable discovery duly witnessed and dated (see [Exhibit B](#)).
5. Report promptly all possibly patentable devices, ideas, processes or improvements to the Patent Administrator (see [Exhibit C](#)).
6. Submit via the campus Contract and Grant Office timely interim and final patent reports to the sponsoring agency.



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University of California

UNIVERSITY POLICY REGARDING PATENTS

PREAMBLE

The Regents of the University of California, in administering intellectual property rights for the public benefit, desire to encourage and assist members of the faculties, employees, 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 Regents recognize the need for and desirability of encouraging the broad utilization of the results of University research not only by scholars but in practical application for the general public benefit and acknowledge 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. Equity in such patentable inventions may involve parties other than the inventor and The Regents. The use of University facilities or services, particular assignment of duties or conditions of employment, possible claims of a cooperating agency where research is supported from extramural funds, and other situations may give rise to a complex of interrelated equities or rights, which must be appraised and appropriately disposed by agreement between the parties.

Therefore, 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, 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 where The Regents have a right or equity, the policy herein set down is adopted.

STATEMENT OF POLICY

1. All matters relating to patents in which the University of California is in any way concerned shall be administered by an agency known as the University of California Board of Patents.

2. a. The Board of Patents shall be appointed by The Regents. It shall have full power of organization, except as hereinafter provided, subject to the provision that it shall meet at least once a year. The members shall serve without extra compensation at the pleasure of The Regents. The normal term of appointment shall be for three years.

b. The Board of Patents shall consist of eleven persons selected from among the faculties and the administration of the University, and of such other groups as The Regents may determine, but of this number the Committee on Committees of the Academic Senate shall select from the Senate at large one person to serve as a member for the normal term. The Chairman of the Board of Patents and Patent Administrator shall be approved by The Regents upon the recommendation of the President of the University.

c. In its consideration of matters relating to each particular patent case or situation, the Board of Patents shall take into consideration the principles laid down in the patent laws, appropriate judicial decisions, and the laws of the State of California.

3. The Board of Patents shall have the following powers and duties, which may be delegated in whole or in part to the Patent Administrator:

a. To evaluate inventions and discoveries for patentability, as well as scientific merit and practical application and, where desirable, to appoint a committee of experts to examine the merits of each potentially patentable invention and to cause such committee to report its findings to the Board of Patents.

b. To authorize applications for patent and to retain patent counsel, in association with the General Counsel, for matters pertaining to the filing of patent applications, the prosecution thereof, and the litigation that may arise therefrom.

c. To determine the patent and related rights or equities held by The Regents in an invention, and to negotiate agreements with cooperating organizations, if any, with respect to such rights or equities.

d. In the absence of overriding obligations to outside sponsors of research, to release patent rights to the inventor in those circumstances, (i) where The Regents elect not to file a patent application and the inventor is prepared to do so, and where no further research or development to develop that invention will be conducted involving University support or facilities, subject to a shop right being granted to The Regents, or (ii) where the equity of the situation clearly indicates such release should be given.

e. To negotiate licenses and related agreements with other parties concerning patent and related property rights held by The Regents.

f. To arrange for and direct the collection of royalties and fees and the distribution thereof to those entitled thereto.

g. To assist 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 grants, contracts, or other agreements to be funded in whole or in part by such cooperating organizations, and to negotiate Institutional Patent Agreements or other agreements with Federal agencies regarding the disposition of patent rights.

h. To recommend to the President appropriate exemptions from the agreement to assign inventions and patents to The Regents as required by paragraph 4 of this policy.

i. To make such reports and recommendations to The Regents as The Regents or the President shall direct.

4. An agreement to assign inventions and patents to The Regents, 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 grant or contract funds through the University. Exemptions from such agreements to assign may be authorized in those circumstances where the mission of the University is better served by such action, provided that overriding obligations to other parties are met and such exemptions are not inconsistent with other University policies.

5. 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 Patent Administrator. 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 rights, to assure that title in such inventions shall be held by The Regents or by such other parties as may be appropriate under the circumstances. Such circumstances would include, but not be limited to, those situations where there are overriding patent obligations of The Regents arising from grants, contracts, or other agreements with outside organizations. Releases of patent rights may be authorized by the Board of Patents where the equities so indicate.

6. Subject to restrictions arising from overriding obligations of The Regents pursuant to grants, contracts, or other agreements with outside organizations, The Regents agree, for and in consideration of said assignment of patent rights, to pay annually to the named inventor(s), the inventor(s)' heirs, successors, or assigns 50 percent of the net royalties and fees received by The Regents. Net royalties are defined as gross royalties and fees, less 15 percent thereof for administrative costs, and less the costs of patenting, protecting and preserving patent 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. Where 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 differing distribution of such share. Distribution of the inventor's share shall be made annually in February from the amount received during the penultimate calendar year. In the event of any litigation, actual or imminent, or any other action to protect patent rights, The Regents may withhold distribution and impound royalties until resolution of the matter.

7. In the disposition of any net income accruing to The Regents from patents, first consideration shall be given to the support of research.

Revised effective April 1, 1980.

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SUGGESTIONS FOR INVENTION RECORD KEEPING*

It is not unusual for two or more inventors to independently develop similar inventions at about the same time. The question as to who will receive title to the patent may well depend on who has kept the most complete and authenticated records.

The procedure set forth below is recommended for recording data describing original research and development work.

- Record the data in a permanently bound ledger-type notebook with numbered pages.
- Make all entries in ink.
- Put the date and your signature at the top of each page and at the end of each experiment.
- Periodically, have your notes reviewed by two knowledgeable persons (not the inventor, co-inventors, or developers of the work being recorded) and authenticated by attaching the statement shown below. When especially significant data are being recorded, this should be done at least once a week.

AUTHENTICATION FORM

Disclosed to and understood by me
this _____ day of _____
Signed _____
Signed _____

- Make entries on consecutive pages; do not leave large blank spaces.
- Attach documentary materials - photographs, sketches and data sheets - to the appropriate notebook pages. Materials that must be handled separately should be clearly cited, giving all identifying information, in the notebook.
- Make no erasures and remove no pages. If you wish to correct an entry, cross out the erroneous words with a single line (do not obliterate the incorrect entry) and insert the correction directly above or following the deleted material. Initial and date the change.
- The description should be sufficiently clear and complete so that someone else with knowledge in the subject area can understand the device or method.
- The date of the first actual reduction to practice of an invention is especially important. Two witnesses to the first successful test or operation of a possible invention should record the event in their own notebooks and authenticate the inventor's notebook.
- Record new ideas in the notebook.

A sample of a properly maintained notebook page is reproduced in Figure 1.

*Adapted from Lawrence Berkeley Laboratory, Pub. 252, courtesy of Robert J. Morris

Date and sign at the top of the page	August 8, 1979	John D. Doe	31
Make description complete enough so that it is obvious what you have in mind	<p>While working on control circuits for the new X Y C magnet, it occurred to me that the magnetic field could be measured and ^{applied} negative feedback, ^{as in the} circuit sketched below, to reduce ripple and transients to a lower value than conventional circuits can provide.</p>		
Sign and date at the end of each entry	<p>Calculations show that ripple below 20 Hertz should be reduced by a factor of 10 less than that of the Jones circuit.</p>		
	<p>John D. Doe August 8, 1979</p>		
Witnesses should read all entries back to previous authentication	<p>Disclosed to and understood by me this <u>10th</u> day of <u>August</u>, 1979 Signed <u>[Signature]</u> Signed <u>[Signature]</u></p>		
Start next entry immediately below signatures of witnesses — do not leave large blank areas			

Figure 1. Sample notebook page.



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INSTRUCTIONS FOR COMPLETING UNIVERSITY OF CALIFORNIA RECORD OF INVENTION FORMS

The following instructions apply to the correspondingly numbered sections of the Form:

1. Use a short title, sufficiently descriptive for aiding in identifying the invention.
2. Provide a brief summary which addresses the nature and gist of the invention and particularly points out its novel features and advantages. Use additional sheets to provide an expanded description which should cover the following points:
 - a. General purpose or utility of the invention.
 - b. Brief description of the state of the art prior to your invention.
 - c. Technical description with reference to drawings, schematics, sketches, flow diagrams, etc., as appropriate, including a description of the best way you know of practicing the invention.
 - d. Possible modifications and variations.
 - e. Advantages and improvements of your invention over existing practice, and the features believed to be new.
3. Since funding often carries patent obligations, be sure to include all outside agencies, organizations, or companies that actually provided salary, research funds and/or facilities for the research which led to the conception or first actual reduction to practice of the invention. (Do not list anyone gratuitously; i.e., be factual, not nice!)

Identify all such sponsors by name and applicable grant or contract number.
- 4-8. This information is legally important from the standpoint of determining priority of invention and/or legal "bars" to patenting. (As a general rule, public disclosure, in any manner, before the date a patent application is actually filed automatically destroys patent rights in most foreign countries. United States patent law allows inventors up to one year to file a patent application after first printed publication, public use or sale.)
9. List any references of which you are aware which most closely describe the related state of the art prior to your invention. You are not required to make a search of the art.
10. Provide to the best of your knowledge the names and addresses (if available) of companies that are or may be interested in manufacturing, using, and/or further developing your invention. (Optional)
11. List as inventors those individuals who, individually or jointly, contributed an essential feature of the invention. In the event that a patent application is filed, inventorship will be verified by the patent attorney assigned to the case.

NOTE

*Original signatures are required. If a co-inventor is not available to sign, please so indicate.

*Arrange for signing by two technically qualified witnesses who have read and understood the invention disclosure.

If you would like assistance in completing the Form, please call the Patent Office at (415) 642-5000.

Please submit the completed Form, with original signatures, directly to Patent Administrator, Systemwide Administration, Berkeley, 94720. If you do not receive an acknowledgment within 30 days, please call the Patent Office at (415) 642-5000.

UNIVERSITY OF CALIFORNIA
RECORD OF INVENTION

Note: This Record of Invention is an important legal document and care should be taken in its preparation. Please refer to instructions accompanying this form. If you would like assistance, please call the Patent Office at (415) 642-5000.

1. Short descriptive title of the invention.
2. Give a brief summary of the invention, particularly including the novel features and advantages. (Use additional sheets for detailed description.)

3. (a) List the source(s) of funding of the project under which this invention evolved. Identify by contract or grant number, if applicable, and identify Principal Investigator/Supervisor.

<u>Funding Source/Sponsor</u>	<u>Contract or Grant Number</u>	<u>Principal Investigator/Supervisor</u>
_____	_____	_____
_____	_____	_____
_____	_____	_____

4. When did you first conceive this invention?
5. What is the date of the first written record (notebook, letter, proposal, drawing, etc.) of this invention?
Identify the document, page numbers involved, and location of the document.
6. When did you first successfully test this invention?
7. When, under what circumstances, and to whom have you disclosed this invention to persons not on the University staff, including research sponsor, if any?
 - (a) orally
 - (b) in writing
 - (c) by actual use, demonstration, or posters

(over)

8. Have you submitted or do you plan to submit a report, abstract, paper or thesis relating to this invention for publication, for presentation at a conference, or to a research sponsor? If yes, give details, including date of submission or planned submission and whether manuscript has been accepted. Append copy of document, if available.

9. Identify any references, patents, patent applications, or other publications of which you are aware which you believe to be pertinent to this invention. Please attach a copy of each of these references, if available.

10. What companies might be interested in marketing this technology?

11. INVENTORS:

a. _____ Signature Date	c. _____ Signature Date
_____ Print Name	_____ Print Name
_____ Campus Address & Phone Ext.	_____ Campus Address & Phone Ext.
b. _____ Signature Date	d. _____ Signature Date
_____ Print Name	_____ Print Name
_____ Campus Address & Phone Ext.	_____ Campus Address & Phone Ext.

12. For any "Inventors" named above who are not employed by UC on a 100% time basis, please identify other employers (e.g., V.A.) and % of salary time funded by such other employer.

TECHNICALLY QUALIFIED WITNESSES: (Two required)

Invention disclosed to and understood by:

a. _____ Signature Date	b. _____ Signature Date
_____ Print Name	_____ Print Name

SUBMIT WITH ORIGINAL SIGNATURES DIRECTLY TO PATENT ADMINISTRATOR, SYSTEMWIDE ADMINISTRATION, UNIVERSITY OF CALIFORNIA, BERKELEY, 94720. IF YOU DO NOT RECEIVE AN ACKNOWLEDGMENT WITHIN 30 DAYS, PLEASE CALL THE PATENT OFFICE AT (415) 642-5000.

DISTRIBUTION OF COPIES TO THIRD PARTIES IS EXPRESSLY PROHIBITED.

THIS RECORD MAY BE USED FOR INTERNAL UNIVERSITY CONFIDENTIAL PERSONNEL PROCEDURES AND ACTIONS.

Effective January 1, 1982



UC San Diego

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CONTRACTS AND GRANTS (RESEARCH)

Section: 150-33 EXHIBIT D

Rescinded: 08/16/2021

Effective: 07/01/1983

Supersedes: 04/01/1980

Review Date: TBD

Issuance Date: 07/01/1983

Issuing Office: [Office of Contract and Grant Administration](#)

UNIVERSITY OF CALIFORNIA PATENT AGREEMENT

This agreement is made by me with 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.

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

I agree that every possibly patentable device, process, plant, or product, hereinafter referred to as "invention," which I conceive or develop while employed by University, or during the course of my utilization of any University research facilities, shall be examined by University to determine rights and equities therein in accordance with the Policy, and 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, and University desires, pursuant to determination by University as to its rights and equities therein, to seek patent 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 protection thereon. The scope of this provision is limited by California Labor Code section 2870, to which notice is given below. In the event I protest the University's determination regarding any rights or interests in an invention, I agree: (a) to proceed with any University requested assignment or assistance; (b) to give the University notice of that protest no later than the execution date of any of the above-described documents or assignment; and (c) to reimburse the University for all expenses and costs it encounters in its patent application attempts, if any such protest is subsequently sustained or agreed to.

I shall 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 agree to be bound hereunder for and 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.

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

NOTICE

This agreement does not apply to an invention which qualifies fully under the provisions of Labor Code section 2870 of the State of California which provides that:

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 for which no equipment, supplies, facility, or trade secret information of the employer was used and which was developed entirely on the employee's own time, and (a) which does not relate (1) to the business of the employer, or (2) to the employer's actual or demonstrably anticipated research or development, or (b) which does not result from any work performed by the employee for the employer. Any provision which purports to apply to such an invention is to that extent against the public policy of this state and is to that extent void and 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.

Employee/Guest Name: _____
(Please Print)

Employee/Guest Signature: _____ Date: _____

Witness Signature: _____ Date: _____

Revised: April 1, 1980



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CONTRACTS AND GRANTS (RESEARCH)

Section: 150-33 EXHIBIT E

Rescinded: 08/16/2021

Effective: 07/01/1983

Supersedes: 04/01/1980

Review Date: TBD

Issuance Date: 07/01/1983

Issuing Office: [Office of Contract and Grant Administration](#)

Office of the President

January 14, 1976

Re: Patent Agreement Requirements--Graduate Students

The University does not impose patent obligations upon students who are not employed by the University or who are not involved with any research project funded by an outside agency or company. However, there are situations, described below, where signed Patent Agreements must be obtained from students in order to meet research sponsors' patent requirements.

Research conducted by graduate students is often funded by outside sources, such as the National Science Foundation, Office of Naval Research, Air Force, United States Public Health Service, nonprofit agencies, and private industry. Funds obtained from such sources carry with them, almost without exception, very definite patent obligations. The requirement to obtain signed Patent Agreements from all persons connected with the research project may be expressed or implied. In either event, it is imperative that graduate students, not otherwise employed by the University, sign the University's Patent Agreement, without qualification, and that they be fully apprised of their specific patent obligations to the University and to the sponsor of research. To not obtain signed Patent Agreements from persons connected with a research project is a breach of the research contract or grant. (Where the students happen to be employees, they presumably will have already signed the Patent Agreement in compliance with the University's employment regulations, as set forth in memorandum dated November 14, 1969, from Charles J. Hitch to all Chancellors, et al. and it is not necessary to obtain another signed agreement in those cases.)

There are certain situations where graduate students may be actually employed in private industry and their education subsidized by their employers. In these circumstances, the students often retain their employee status with their industrial employers and also remain bound by their employers' patent agreements. In no circumstances should such graduate students be permitted to participate in research projects funded by outside sources that carry patent obligations unless those students have signed the University's Patent Agreement and unless those students have assured their respective Deans or department heads that they have no overriding patent obligations to an outside employer that would preclude the student and the University from meeting their respective contractual requirements to a sponsor of research.

There can be no exceptions to these Patent Agreement requirements for graduate students since such obligations are imposed upon the University by its sponsors of research.



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CONTRACTS AND GRANTS (RESEARCH)

Section: 150-33 EXHIBIT F

Rescinded: 08/16/2021

Effective: 07/01/1983

Supersedes: 04/01/1980

Review Date: TBD

Issuance Date: 07/01/1983

Issuing Office: [Office of Contract and Grant Administration](#)

UNIVERSITY OF CALIFORNIA	
SUMMARY OF SPONSOR PATENT RIGHTS APPLICABLE TO FUNDING AGREEMENTS WITH INDUSTRIAL (FOR PROFIT) SPONSORS OF RESEARCH	
<p>This summary is to inform potential industrial Sponsors of research at the University of California of University policy on patent rights arising under sponsored research. A specific, written agreement must be executed between University and Sponsor as a condition precedent to the Sponsor having any rights to patentable inventions arising under its funding. The terms and conditions set forth in such agreement shall define the actual patent rights of Sponsor.</p> <p>Subject to the General Conditions stated below, research funding agreements may provide a time-limited right of first refusal to the Sponsor for commercial rights to patentable inventions (other than plant patents) conceived and reduced to practice under the sponsored research, based on the following funding schedule:</p>	
<p>When the Sponsor pays or provides:</p> <p>A. All direct and indirect costs (including an appropriate share of the Principal Investigator's salary) for the research to be undertaken.</p>	<p>The Sponsor may be granted a right of first refusal to:</p> <p>An exclusive or nonexclusive license for the life of any U.S. patent at Sponsor's option. Right to sublicense may be granted under exclusive license only.</p>
<p>B. All direct costs (including an appropriate share of the Principal Investigator's salary), but not full indirect costs. Indirect costs must be paid by Sponsor unless a waiver is approved by the Vice-President--Financial and Business Management in very exceptional cases.</p>	<p>An exclusive license not to exceed seven years years from the date of license and nonexclusive thereafter for life of U.S. patent; or, at Sponsor's option, a nonexclusive license for the life of U.S. patent. Right to sublicense during exclusive period of license may be granted.</p>
<p>C. Less than all direct costs, but a portion thereof, in the form of money, expendable materials or supplies, or other substantial assistance.</p>	<p>A nonexclusive license for life of U.S. patent, to the extent possible in view of University's obligations to other sponsors of the same project.</p>
<p>D. Salary or stipend moneys in support of a fellowship or research assistanceship only.</p>	<p>Right of refusal for commercial rights not applicable, but Sponsor will be considered as a potential licensee if the recipient is a named inventor, rights are assigned to University, and to the extent permissible under other funding agreements.</p>
<p>General Conditions:</p> <p>(1) All research support agreements, except for Category D., shall be based on a defined, specific-term research protocol and detailed budget.</p> <p>(2) All licenses will be royalty-bearing, rates negotiable and based on general industry practices for the type of invention involved.</p> <p>(3) All licenses must provide for diligent development, commercial marketing or use as one condition for retention of the license. Diligence provisions will normally require a license issue fee and appropriate minimum annual royalties.</p> <p>(4) Licenses under corresponding foreign patents may be granted where possible on terms and conditions similar to U.S. licenses, except that Sponsor must agree to reimburse University for its foreign patent prosecution costs.</p>	
<p>Authority: Actions of The Regents of the University of California of 16 Nov. 1956, 15 Feb. 1957 and 17 Feb. 1968.</p> <p>May 1982</p>	