University of California

University Policy Regarding Patents

PREAMBLE

The Regents of the University of California is disposed, as hereinafter stated, to assist members of the faculties and employees of the University in all matters related to patents based on discoveries and inventions developed in situations where the invention has been conceived or developed by them.

It is recognized that such inventions may, and frequently do, involve equities beyond those of the inventor himself. The use of University facilities or services, the particular assignment of duties, or conditions of employment, the possible claims of a cooperating agency, as in research supported from extramural funds; these and other situations may give rise to a complex of interrelated equities or rights involving the inventor, the University, and a cooperating agency. Such rights or equities must be appraised and an agreement reached on the proper disposition of them. It is further recognized that the 15th All-University Faculty Conference of 1960 adopted a resolution urging further use of inventions as a source of intramural funds for research within the University. Therefore, to appraise and determine relative rights and equities of all parties concerned, to facilitate patent applications, licensing, equitable distribution of royalties, if any, to obtain funds for research, and to provide a uniform procedure in patent matters where such originate within the University, 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 meet at least once a year; and the members shall serve without extra compensation at the pleasure of The Regents. The normal term of appointment shall be for three (3) years.

b. The Board shall consist of eleven (11) 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 (1) person to serve as ex officio member for a period of three (3) years. The Chairman of the Board and Administrator of Patents shall be approved by The Regents upon the recommendation of the President of the University.

3. The following powers and duties shall be exercised by the Board of Patents:

a. 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.

b. To determine the relative equities or rights held by the inventor and The Regents or by a cooperating agency, if any, and to reach an agreement among all parties concerned with respect to such equities.

c. 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.

d. To release patent rights to the inventor in unusual circumstances where the equities so indicate, subject to his granting a shop right to The Regents.

e. To negotiate licenses and other agreements covering the manufacture, use and sale or lease of patented articles, or processes resulting from patents or inventions.

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

g. To assist in negotiation with appropriate University officers to obtain from cooperating agencies agreements concerning patent rights to inventions or discoveries made as a result of research carried on under grants or contracts.

h. 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 and in the court decisions of the United States.

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

4. Members of the faculties and employees shall make appropriate reports of any inventions they have conceived or developed to the Board of Patents.

5. An agreement to assign inventions and patents to The Regents of the University of California, except those resulting from permissible consulting activities without use of University facilities, shall be mandatory for all employees, academic and nonacademic. Releases shall be executed, where the equities so indicate, as determined by the University of California Board of Patents. Subject to overriding obligations assumed by The Regents, University faculty and staff members who are employed under research contracts, grants in aid or service to industry agreements or special State appropriations covering specific activites shall make such assignment of inventions and patents as is necessary in each specific case in order that the University may discharge its obligations, expressed or implied, under the particular agreement.

6. The Regents is averse to seeking protective patents and will not seek such patents unless the discoverer or inventor can demonstrate that the securing of the patent is important to the University.

7. The Regents agrees, for and in consideration of said assignment of patent rights, to pay annually to the inventor, his heirs, successors, and assigns, fifty (50) percent of the royalties and fees received by The Regents after a deduction of fifteen (15) percent thereof for overhead costs plus a deduction for cost of patenting and protection of patent rights. Distribution shall be made annually in February from the amount received during the penultimate 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.

8. In the disposition of any net income accruing to The Regents from patents first consideration will be given to promotion of research.

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