UCLA Procedure 955.1: Release of Patent Rights to Inventors

Issuing Officer: Vice Chancellor for Research

Responsible Department: Technology Development Group

Effective Date: July 9, 2018

Supersedes: New

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I.   PURPOSE & SCOPE

The purpose of this Procedure is to articulate the conditions in which the University of California ("University") will release patent rights to their Inventors. This Policy applies to all employees and others as specified in the University of California Patent Policy (the "Patent Policy").

II.   DEFINITIONS

For the purposes of this Procedure:

Inventor(s) refers to individuals who are identified as Inventors on the patent rights pursued on the invention and assigned their rights to the Regents or whose interests are owned by the Regents as a matter of policy, law, or contract.

Net Income means any and all consideration, including equity received by the Inventors from the commercialization of a Released Patent (as defined below), less the Inventor's documented unreimbursed out-of-pocket expenses in the prosecution of the Released Patent and its commercialization.

III.   STATEMENT

When the University elects not to file a patent application or to commercialize a patent, it may elect, at its absolute discretion, to release such patent rights to the Inventor(s) (the "Released Patent"). Such release will be made subject to the following conditions:

1. The Released Patent shall be subject to any rights that the sponsors of the research (that led to the invention relating to the Released Patent) may have. Patent rights related to an invention supported by a federal funding agency may not be released by the University directly to the Inventors and, as such, this Procedure will apply subject to the federal funding agency's release of such Released Patent.

2. The Inventor(s) must have disclosed to the University all material facts pertaining to the Released Patent and its commercial potential.

3. Each of the Inventors shall agree, in writing, to assignment of title in the Released Patent to her/his co-inventors and relinquish any rights they may have to income received by the University pursuant to Paragraph 6(b) below.

4. The Inventor(s) shall agree, in writing, that no further research or development of the invention related to the Released Patent may be conducted using any support, services, or facilities of the University.

5. The Regents expressly reserves the right to: (a) use the Released Patent and associated technology for educational and research purposes, to perform research sponsored by commercial entities, and

to perform clinical research and diagnostic and prognostic services; (b) publicly disclose research results; and (c) allow other non-profit and academic institutions to use the Released Patent and associated technology for the same purposes as all of the foregoing.

6. If the Released Patent is commercialized by the Inventor(s), the relevant Inventor(s) shall:

   a. Reimburse the University for its out-of-pocket expenses relating to the Released Patent on a pro rata basis in view of the amount the Inventor(s) spent in pursing patenting the Released Patent; and

   b. Pay to the University twenty percent (20%) of all Net Income received by the Inventor(s) from such commercialization, which the campus will redistribute per UCLA Procedure 955.2; provided however, in cases of equity UCLA shall not be entitled to receive more than five percent (5%) of the issued shared capital of the licensee.

IV. REFERENCES

1. University of California Patent Policy;
2. University of California Business & Finance Bulletin G-40 Patent Program;
3. UCLA Procedure 955.2, Distribution of the University's General Pool and Research Share Portions of Net Royalties.

Issuing Officer

/s/ Roger Wakimoto

Vice Chancellor for Research

Questions concerning this policy or procedure should be referred to
The Responsible Department listed at the top of this document.