

EXAMPLE APPLICATION FILED – RELEASE LETTER

DATE:

(INVENTOR(S))

RE: Terms of Release to Inventor(s)
“[INVENTION TITLE]”
UC Case No. _____

Dear Drs. _____, _____ & _____:

This letter agreement (“Agreement”), effective on the date of the latest in time of the signatures below (“Effective Date”), memorializes the terms of agreement between you and The Regents of the University of California (“UC”) for release of rights as further detailed below, subject to your acceptance of all of the terms and conditions below.

1. Background

1.1 Pursuant to the UC Patent Policy (“Patent Policy”), you submitted to UC Davis InnovationAccess a Record of Invention (“the ROI”) for an invention entitled, “[invention title],” identified as UC Case No. _____. The ROI is attached to this Agreement as Exhibit A.

1.2 The invention specifically described in the ROI, including the Patent Rights to the invention (as the term “Patent Rights” is defined in Paragraph 1.3 below), is referred to in this Agreement as “the Invention.”

1.3 “Patent Rights”, as referred to in this Agreement, means UC’s rights in the claims of U.S. Patent Applications, Serial Numbers _____, entitled " _____ " and " _____ " filed on _____ and _____, respectively, by Drs. _____ and assigned to UC; continuing applications thereof including divisions, substitutions, extensions and continuation-in-part applications (only to the extent, however, that claims in the continuation-in-part applications are entitled to the priority filing date of

the above-listed parent patent application); any patents issuing on said applications or continuing applications including reissues; and any corresponding foreign patents or applications.

- 1.4 You have signed the University Patent Acknowledgement or Patent Agreement (“the Patent Acknowledgement”).
- 1.5 Under the Patent Acknowledgment and the Patent Policy, UC owns the Invention and may, in its discretion, release the Invention to you.
- 1.6 You have requested that UC release the Invention to you.
- 1.7 UC is willing to release the Invention to you in accordance with the terms and conditions of this Agreement.

2 Terms.

2.1 Rights Released. To the extent legally able to do so, and subject to the terms and conditions below, UC hereby releases to you all right, title and interest in and to the Invention. The release of Patent Rights is solely to the extent that, under the U.S. Patent Laws, the Patent Rights are supported by the express content of the ROI. If the Invention is jointly owned by UC and a third party, the release of rights will apply only to UC’s undivided interest in the Invention. You understand your ongoing duty under the Patent Policy to disclose to UC any other inventions, including, without limitation, improvements to the Invention, that fall outside the express content of the ROI, and, that such other inventions or improvements will be managed in accordance with the Patent Policy. UC has no obligation, implied or otherwise, to release any such other inventions or improvements.

2.2 Reimbursement of Past Patent Costs.

2.2.1 Expenditures incurred by UC prior to the Effective Date for preparing, filing and maintaining Patent Rights in the U.S. are referred to below as “Patent Costs.” You agree to make a reimbursement payment (“Reimbursement Payment”) to UC for Patent Costs, in accordance with the following:

- (a) If Patent Costs do not exceed \$5,000, the Reimbursement Payment will be the full amount of Patent Costs.
- (b) If Patent Costs exceed \$5,000, the Reimbursement Payment will be according to the following formula:

$\$5,000 + 25\%$ of Patent Costs in excess of \$5,000 provided that the Reimbursement Payment will not exceed \$20,000.

2.2.2 Patent Costs are \$_____. In accordance with Paragraph 2.2.1 above, you agree to make Reimbursement Payment to UC in amount of \$_____. You understand and agree that any outstanding invoices for patent expenditures not yet received by UC as of the date at the top of page 1 of this Agreement will increase the Patent Costs and may increase the Reimbursement Payment. In the event of such increase in Reimbursement Payment, UC will provide you with subsequent notice in writing of the increased Reimbursement Payment.

2.2.3 The Reimbursement Payment will be due upon the date when gross sales by or under you of products, methods or services covered by the Patent Rights exceed five (5) times the Patent Costs.

2.2.4 You agree and acknowledge that no invoice for the Reimbursement Payment will be sent to you. The Reimbursement Payment will be made by check payable to "The Regents of the University of California," with reference to UC Case No. _____. The Reimbursement Payment will be sent to:

The Regents of the University of California
1111 Franklin Street, 5th Floor
Oakland, CA 94607-5200
Attention: Executive Director,
Research Administration and
Technology Transfer
Referring to: UC Case No. _____

2.3 No Federal Funding. You affirm that the Invention was not made with the use of any federal support or funds.

2.4 Third-Party Obligations. You affirm that you have disclosed to InnovationAccess, through the ROI or otherwise in writing, the following:

- (a) all third-party sources of funding (including, without limitation, government, private and non-profit sources) and all third-party sources of in-kind support, where such funding or support was used in the conception or reduction to practice of the Invention; and
- (b) all third-party sources of data or materials which were used in the conception or reduction to practice of the Invention, where such data or materials were transferred under a restrictive transfer agreement, including, without limitation, material transfer agreements (MTAs), purchase agreements, or collaboration agreements.

With respect to any obligations concerning the Invention owed by UC to third parties (sponsors or otherwise), you understand that you are responsible for such obligations as of the Effective Date and you agree to fulfill any such obligations, including without limitation obligations under MTAs, inter-institutional agreements, confidentiality agreements, research agreements, collaboration agreements and purchasing agreements.

2.5 Inventorship. You affirm that, to the best of your knowledge, the inventorship listed in the ROI is complete and correct. In the event that you determine an additional inventor of the Invention exists, you will immediately notify the Executive Director of UC Davis InnovationAccess in writing.

2.5.1 If the additional inventor has an assignment duty to UC for the Invention (“Additional UC Inventor”), UC will give the Additional UC Inventor the option of signing a letter agreement of release for the Invention. Should any Additional UC Inventor not execute a release letter with UC, then UC will retain an undivided interest in the Invention, in which case, you and UC will coordinate to jointly manage the Invention.

2.5.2 You understand and agree that if the additional inventor has no duty of assignment to UC for the Invention (“Additional Non-UC

Inventor”), then the Additional Non-UC Inventor may have an undivided interest in the Invention.

2.6 Shop Rights. You understand and agree that UC will retain a shop right and a fully paid-up, royalty-free license to do any one or more of the following activities:

2.6.1 publish any technical data resulting from research performed by UC relating to the Invention;

2.6.2 make, have made, use and import the Invention for educational and research purposes (including, but not limited to, clinical trials); and

2.6.3 allow other educational and non-profit institutions to do any of the activities above, for educational and research purposes.

2.7 Prohibition on Using UC Resources for Development of Personal Property.

You understand and agree that the Invention is being released to you for your own personal activities. You understand and agree that UC does not have any responsibility to further develop the Invention, and that UC will not be obligated to expend any additional funds, equipment, facilities or other resources to further develop the Invention. You understand and agree that, neither you, nor others at your direction, including, without limitation, technicians, visitors, students, postdoctoral researchers or other UC employees, will use UC support or facilities subsequent to the Effective Date to conduct further research or development of the Invention.

2.8 No Negative Impact to UC Students. You affirm that no UC student will be negatively impacted by this release of the Invention.

2.9 Indemnification, Hold Harmless, and Defense. You will indemnify, hold harmless, and defend UC and its officers, employees, and agents, and any sponsor(s) of the research that led to the Invention, from and against any and all claims, suits, losses, damages, costs, fees, and expenses resulting from the production, marketing, commercialization or other use of the Invention. This indemnification, hold harmless and defense will include, but not be limited to, any product liability.

2.10 Governing Law. This Agreement will be construed, interpreted, and applied in accordance with the laws of the State of California, excluding any choice of law rules that would direct the application of the laws of another jurisdiction, except that the scope and validity of any patent or patent application covered by this Agreement will be determined by the applicable law of the country of such patent or patent application. Any legal action brought by the parties relating to this Agreement will be conducted in San Francisco, California. The prevailing party in any legal action under this Agreement will be entitled to recover its reasonable attorneys' fees in addition to its costs and necessary disbursements.

2.11 No Representations or Warranties.

2.11.1 THIS RELEASE AND THE INVENTION ARE PROVIDED WITHOUT WARRANTY OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE OR ANY OTHER WARRANTY, EXPRESSED OR IMPLIED. UC MAKES NO REPRESENTATION OR WARRANTY THAT PRACTICE OF THE INVENTION WILL NOT INFRINGE ANY PATENT OR OTHER PROPRIETARY RIGHT.

2.11.2 IN NO EVENT WILL UC BE LIABLE FOR ANY INCIDENTAL, SPECIAL OR CONSEQUENTIAL DAMAGES RESULTING FROM EXERCISE OF THIS RELEASE OR THE USE OF THE INVENTION.

2.11.3 UC MAKES NO REPRESENTATION OR WARRANTY THAT THE INVENTION IS PATENTABLE IN THE UNITED STATES OR FOREIGN COUNTRIES OR THAT THE INVENTORSHIP AS DOCUMENTED ON THE ROI IS COMPLETE OR CORRECT.

2.12 No Ongoing UC Obligations. You understand and agree that patentability of the Invention is subject to all requirements of patent law, and that deadlines may exist with respect to avoidance of loss of patent rights for the Invention. You understand and agree that UC has no obligation to advise you

on patentability of the Invention. You understand and agree that UC has no obligation to inform you of future patent filing or prosecution deadlines, and that UC assumes no liability by failing to inform you of any such deadlines. You understand and agree that UC has no obligation, and does not intend, to further market or assist in your licensing or commercialization of the Invention. You understand and agree that further patent prosecution and marketing of the Invention will be at your own expense. You acknowledge UC's recommendation that you retain an outside patent professional or law firm to personally represent you and to ensure that patent rights to the Invention, if any, are not lost. You understand and agree that you may need to use a different patent professional or a different law firm than was used by UC for this Invention, due to conflict of interest considerations. You understand and agree that you will be responsible for the selection, if necessary, of a new patent professional or law firm and for any fees, including, but not limited to, fees for transfer of case materials.

Please sign below to confirm your acceptance of the terms of this Agreement, obtain the signature of your department chair and dean, and return two sets of fully signed originals of this Agreement to UC Davis InnovationAccess. One fully executed original will be returned to you for your records upon execution by UC.

This Agreement will not be effective until it is fully executed. This offer will automatically lapse if not accepted by signature(s) below and returned to UC Davis InnovationAccess within sixty (60) days from the date at the top of page 1 of this Agreement.

Sincerely,

[Licensing Officer]

[Signatures begin on following page.]

AGREED ON BEHALF OF THE INVENTOR(S):

[Inventor Name]

Date

[Inventor Name]

Date

**CONCURRED ON BEHALF OF THE UC DAVIS DEPARTMENT OF [XXXXXX]
AND THE UC DAVIS COLLEGE OF [XXXXXX]:**

I have reviewed the representations and terms contained herein, as well as the ROI description of the Invention attached as Exhibit A, and I concur with UC's decision to release the Invention to the inventors subject to the terms of this Agreement. Further, I attest that I have verified that no UC students' graduate or undergraduate work will be negatively impacted by this release.

[Department Chair]

Date

[Dean of College/School]

Date

AGREED ON BEHALF OF THE REGENTS OF THE UNIVERSITY OF CALIFORNIA:

David R. McGee
Executive Director, UC Davis InnovationAccess

Date

Exhibit A

ROI