

*Robert Anderson*  
Telephone: (510) 987-9303  
Fax: (510) 763-0309  
Email: [Robert.Anderson@ucop.edu](mailto:Robert.Anderson@ucop.edu)

*Chair of the Assembly and the Academic Council  
Faculty Representative to the Board of Regents  
University of California  
1111 Franklin Street, 12th Floor  
Oakland, California 94607-5200*

November 1, 2011

**LAWRENCE PITTS  
PROVOST & EXECUTIVE VICE PRESIDENT FOR ACADEMIC AFFAIRS  
UNIVERSITY OF CALIFORNIA**

**Re: Revised patent agreement form**

Dear Larry:

In response to your request for advice on how to ensure that faculty sign the University's revised acknowledgement of the University's patent policy, Council discussed and agreed upon the following points that should be included in your communication to faculty:

- 1) Emphasize that the new language restores what the University intended, and what most faculty assumed, was the agreement between the University and faculty. The change is required because of a Supreme Court ruling, *Stanford v. Roche*, which found that similar language in Stanford's patent policy did not have the intended meaning.
- 2) Make clear that faculty are required to sign the new form.
- 3) Provide a concise explanation in the letter of why the court decision requires a new version of the agreement. Develop and provide a reference to an FAQ that addresses faculty members' rights and interests, as well as case studies illustrating why signing the agreement is important.
- 4) Letters from the deans of individual schools and colleges to members of their faculties would be more effective and ensure better compliance than one from you to all faculty. Moreover, deans will know which faculty members are at greatest risk of inadvertently signing away patent rights and could decide where to focus compliance efforts.
- 5) Do not refer to penalties for those who do not sign until the penalties have been determined. Any enforcement mechanism should be discussed with UCFW and UCORP.

I have enclosed Council's letter of December 3, 2009 to Vice President Beckwith and UCORP's letter of November 20, 2009 to Chair Powell emphasizing many of the points listed above, and suggesting that signatures be obtained in conjunction with a faculty member's next merit review or submission of his or her Outside Professional Activities form. Efforts to expedite the collection of

signatures should be focused on faculty whose work is most likely to produce patentable results; enforcement for low-risk faculty should be accomplished in conjunction with merit reviews or at another appropriate juncture.

We concur that how the letter is framed will be critical in securing faculty participation. UCFW Chair Bill Parker, UCORP Chair John Crawford, and I would be happy to assist you by reviewing the letter before it is sent.

Please do not hesitate to contact me if you have any questions.

Sincerely,

A handwritten signature in blue ink that reads "Bob".

Robert M. Anderson, Chair  
Academic Council

Copy: Steve Beckwith, Vice President, Research and Graduate Studies  
Academic Council  
Martha Winnacker, Academic Senate Executive Director

Encl. (2)



Henry C. Powell  
Telephone: (510) 987-0711  
Fax: (510) 763-0309  
Email: [henry.powell@ucop.edu](mailto:henry.powell@ucop.edu)

Chair of the Assembly and the Academic Council  
Faculty Representative to the Board of Regents  
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1111 Franklin Street, 12th Floor  
Oakland, California 94607-5200

December 3, 2009

**STEVEN BECKWITH, VICE PRESIDENT  
RESEARCH AND GRADUATE STUDIES  
UNIVERSITY OF CALIFORNIA**

**Re: Proposed Patent Policy Changes**

Dear Steve:

As you requested, at its November 23 meeting, the Academic Council discussed the proposed changes to the University's patent acknowledgement. Council unanimously concurred with UCORP's recommendation that the new acknowledgement form: 1) be signed at the time of a faculty member's next merit review or submission of the Outside Professional Activities form; and 2) be administered at the campus level, by the faculty member's dean's or chair's office. UCORP specifically recommended, and Council concurred, that the revised patent assignment not be promulgated in an impersonal mass notice and that case studies be provided to illustrate advantages to University employees of compliance with the patent policy.

These recommendations will promote compliance by the appropriate subset of faculty. The Academic Council felt strongly that not all faculty should be required to sign a new patent acknowledgement form, particularly in light of the increase in required compliance measures.

Please do not hesitate to contact me if you have any questions regarding this recommendation.

Sincerely,

A handwritten signature in black ink, appearing to read "Henry C. Powell".

Henry C. Powell, Chair  
Academic Council

Copy: Academic Council  
Larry Pitts, Interim Provost  
Marty Simpson, Managing Counsel  
Martha Winnacker, Academic Senate Executive Director



UNIVERSITY COMMITTEE ON RESEARCH POLICY (UCORP)  
Greg Miller, Chair  
[grgmiller@ucdavis.edu](mailto:grgmiller@ucdavis.edu)

Assembly of the Academic Senate  
1111 Franklin Street, 12<sup>th</sup> Floor  
Oakland, CA 94607-5200  
Phone: (510) 987-9466  
Fax: (510) 763-0309

November 10, 2009

**HARRY POWELL, CHAIR  
ACADEMIC COUNCIL**

**RE: Proposed Patent Policy Changes**

Dear Harry,

At its meeting of November 9, 2009, the University Committee on Research Policy (UCORP) discussed the proposed changes to UC's patent policy disclaimer, as suggested by the recent *Stanford v Roche* decision (encl). While UCORP is sympathetic to the need to protect the University from patent lawsuits, we urge caution in placing another compliance obligation on faculty during these difficult times.

It remains unclear if this change is one upon which employment can be based; that is, if a person who did not sign a revised statement could be fired or otherwise disciplined is unknown.

Regardless of the answer, however, a blanket requirement that all faculty sign a new form by X date seems overkill. Most faculty in fields where patent generation is unlikely could wait to sign a new form at their next merit review cycle without putting the University at risk. Faculty more likely to file patents could, at the time of their next OPA disclosure, be asked to sign the new language. Deans and chairs should know who needs to sign a new form, and the request should come from them, rather than the Office of the President or the Chancellor.

UCORP urges that if/when faculty are asked to sign a new patent agreement, care be taken in crafting the messaging surrounding the request, its justification, and its implications. We caution that impersonal dissemination is to be avoided. As part of the justification, we encourage presenting case studies: the *Stanford* decision is complex, and other examples of the utility of the new wording could prove very persuasive. An optional information session presented by General Counsel and/or offices of technology transfer would also be beneficial.

Finally, we encourage a proactive component. The new wording closes the recently revealed loophole, but there may be others. It could help to avoid future problems if faculty had access to, and/or were aware of, UC resources for legal advice to help vet any agreements they might be asked to sign in the course of OPA.

Thank you for your consideration.

Sincerely,

Greg Miller, Chair  
UCORP

cc: UCORP  
Martha Winnacker, Executive Director, Systemwide Academic Senate