



James Steintrager
Telephone: (510) 987-9983
Email: james.steintrager@ucop.edu

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

November 1, 2023

**THERESA MALDONADO, VICE PRESIDENT
RESEARCH AND INNOVATION**

Re: Revised Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Vice President Maldonado,

I asked the University Committee on Research Policy (UCORP) to lead the Academic Council's consideration of new proposed revisions to the Presidential Policy on Inventions, Patents, and Innovation Transfer. The Senate reviewed an earlier version of this policy in spring 2023, and requested three main revisions in a June 1, 2023 letter¹:

1. Restore language ensuring inheritance rights for 35% of patent income to the inventor's heirs;
2. Restore language requiring the allocation of 15% of patent net royalties from the remaining 65% to support research on the inventor's campus or in the inventor's laboratory;
3. Affirm inventor ownership of patents resulting from permissible outside consulting activities.

The Council appreciates your efforts to address these concerns in a new draft and Frequently Asked Questions (FAQ) appendix. First, we appreciate the restoration of language concerning inheritance rights for 35% of net patent income. Second, we understand that UC policy has never required the return of 15% of net royalties to the inventor's laboratory. In the previous policy, "Laboratory" referred to the Department of Energy National Laboratories, not individual faculty laboratories. The policy will continue to provide 65% of income to chancellors, the vice president for agriculture and natural resources, or the Laboratory director to distribute according to local policies and practices, with 15% allocated for research-related purposes at the UC location. Finally, we appreciate the inclusion of a statement in FAQ 11 affirming inventor ownership of patents resulting from permissible outside consulting activities.

We also appreciate your efforts to address several additional comments and concerns from UCORP, including a request for clarification about what will happen to an invention that constitutes University Intellectual Property when the University declines intellectual property prosecution and/or commercialization of the invention. At its October 25 meeting, the Academic

¹ https://senate.universityofcalifornia.edu/_files/reports/sc-dh-inventions-patents-and-innovation-transfer-policy.pdf

Council endorsed the revised policy contingent on clarification of the circumstances and timeline for the release of intellectual property rights to the inventor in the above scenario.

Finally, we understand that the policy is still undergoing revision with input from a disciplinary expert from the faculty; as a courtesy, we request that you send the finalized version to Senate leadership so that we can confirm that any further changes are in the mode of clarification.

Thank you for the opportunity to opine. Please do not hesitate to contact me if you have additional questions.

Sincerely,

A handwritten signature in black ink, appearing to read 'J. Steintrager', with a stylized flourish at the end.

James Steintrager, Chair
Academic Council

Cc: Academic Council
Executive Director Motton
Research Policy Manager Lu
Senate Division Executive Directors
Senate Executive Director Lin