UNIVERSITY OF CALIFORNIA, ACADEMIC SENATE

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Susan Cochran
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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

June 1, 2023

DOUGLAS HAYNES, VICE PROVOST
ACADEMIC PERSONNEL & PROGRAMS

Re: Systemwide Review of Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Vice Provost Haynes:

As requested, I distributed for systemwide Senate review the Presidential Policy on Inventions, Patents, and Innovation Transfer. All ten Academic Senate divisions and two systemwide committees (UCACC and UCORP) submitted comments. These comments were discussed at Academic Council's May 24 meeting and are attached for your reference.

We understand that the policy updates and renames the UC Patent Policy, expands the scope of the policy to address non-patentable innovations of interest to external sponsors and licensees, and transfers responsibility, authority, and accountability for innovation transfer and entrepreneurship from UCOP to the campuses.

The Senate is unable to fully support the policy in its current form due to significant concerns about how income distribution and royalties will be treated under the revised policy and other key policy elements affecting faculty that require additional clarification.

The Senate supports efforts to remove operational barriers to efficient patent development, technology transfer, and research commercialization by streamlining procedures and providing institutional support for faculty innovation and entrepreneurship. We also support elements of the revisions that remove outdated procedural details, modernize language, and expand the breadth of coverage for what faculty inventors want to commercialize.

Many Senate reviewers support shifting the administration of inventions and patents from UCOP to the campuses, to the extent that it promotes efficiencies, preserves exiting royalty distribution practices, and protects the research enterprise. However, reviewers are also concerned about how decentralization could affect campuses, and about the removal of several specific guarantees in the policy language. These include:

1. Allocating an additional 15% of patent net royalties to support research on the inventor's campus or in their laboratory;
2. Ensuring inheritance rights for patent income to the inventor's heirs;
3. Affirming inventor ownership of patents resulting from permissible outside consulting activities.

The removal of these incentives from the systemwide policy without an explanation raises concerns among faculty, who worry this may discourage patent pursuits, hamper innovation, and potentially impact faculty retention and recruitment. While individual campuses may choose to retain their current royalty practices, the systemwide policy could provide stronger assurances of such and could ensure that faculty are treated similarly on all campuses. It is crucial to reinstate these protections or provide further clarification to alleviate concerns.

During our meeting with Vice President Maldonado and other staff from the Office of Research and Innovation, it was revealed that important elements of the policy, such as the 35% royalty return to the inventor, have not been eliminated but are now incorporated into accompanying guidelines. While the intent to maintain current practices is reassuring, these changes remain problematic since guidelines, unlike a presidential policy, can be altered without undergoing a systemwide review. The relegation to guidelines and the absence of complementary local policies also raises concerns about granting campus chancellors excessive discretion over decisions about royalty distribution. The policy should incorporate better safeguards for faculty and outline clear circumstances and guidelines for when a chancellor may grant exceptions to the policy.

Faculty members are also worried that decentralization will increase the workloads of campus faculty and staff, necessitating additional resources and staff with specialized policy management expertise. It is neither fair nor efficient to expect faculty to independently advocate for fair treatment across ten different campuses. The University must establish a transparent systemwide policy with processes that safeguards and benefits faculty inventors. Presently, the policy is written to protect university interests but lacks sufficient provisions for inventor interests.

We recommend that the policy incorporate more explicit language affirming the faculty's ability to engage in outside activities and establish connections with California companies. It should explicitly state that patent assignment does not apply to inventions developed by employees during their personal time without utilizing University facilities. Furthermore, it should clarify whether the transfer of responsibility to campuses will alter the proportion of royalties and fees allocated to the UCOP budget. In addition, we recommend establishing a time limit on how long the University can hold a potential patent in limbo while it decides whether to go forth with obtaining a patent. It is critical that innovators can move forward with their work even if the University is not going to do so.

Finally, reviewers noted areas of the policy that include opaque language and definitions of terms that may be unfamiliar to a lay reader including "intellectual property," "unpatentable intellectual property," and "non-invention."

We appreciate the opportunity to comment and look forward to reviewing a revised version of the policy that addresses these concerns. We also recommend running the policy by patent

attorneys to ensure compliance with the law. Please do not hesitate to contact me if you have additional questions.

Sincerely,

Susan Cochran, Chair
Academic Council

Cc: Vice President Maldonado
Associate Vice Provost Brandt
Research Policy Manager Lu
Academic Council
Campus Senate Executive Directors
Executive Director Lin

Encl.

ACADEMIC SENATE
BERKELEY
320 STEPHENS HALL
UNIVERSITY OF CALIFORNIA

May 16, 2023

SUSAN COCHRAN
Chair, Academic Council

Subject: Systemwide Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Chair Cochran:

On May 8, 2023, the Council of the Berkeley Division (DIVCO) discussed the proposed Presidential *Policy on Inventions, Patents, and Innovation Transfer*. DIVCO members expressed appreciation for the attempt to develop a policy on this important issue.

There was general support for the shift of the administration of the intellectual property relating to inventions, patents, and innovation transfer from UC Office of the President to the campuses. It was noted that it will be a challenge for Berkeley that the campus doesn't have an efficient, well-managed patent management process and administration. We are concerned that there is a lack of language in the policy that explains the percentage that goes back to the department and that no date is specified on when allocations will be paid.

We also highlight that the proposed policy creates a broader scope of what is not patentable, and that the definition of "intellectual property" (IP) needs to be explicit and clearer.

At the Berkeley Division, the Committee on Research (COR) plans to explore this topic further next year.

Sincerely,

Mary Ann Smart

Mary Ann Smart
Professor of Music
Chair, Berkeley Division of the Academic Senate

cc: Maximilian Auffhammer, Vice Chair, Berkeley Division of the Academic Senate
Lia Fernald, Chair, Committee on Research
Jocelyn Surla Banaria, Executive Director
Patrick Allen, Senate Analyst, Committee on Research

UNIVERSITY OF CALIFORNIA, DAVIS

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May 17, 2023

Susan Cochran
Chair, Academic Council

RE: Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Susan,

The proposed revisions to the Presidential Policy on Inventions, Patents, and Innovation Transfer were forwarded to all standing committees of the Davis Division of the Academic Senate. Nine committees responded: Faculty Welfare (FWC), Research (COR), and the Faculty Executive Committees of the College of Agricultural and Environmental Sciences (CAES), the College of Biological Sciences (CBS), the College of Engineering (COE), the College of Letters and Science (L&S), the School of Education (SOE), the School of Law (LAW), and the School of Medicine (SOM).

Committees support the proposed responsibility shift from the Office of the President to the campuses. COR notes, however, that it is unclear whether the "conferral of responsibility from UCOP to the campus level also changes the proportion of royalties and fees that go to the UCOP budget. With less responsibility and work at the UCOP level, decreasing or eliminating the UCOP proportion of royalties and fees would be advantageous to campuses, as it would increase the local funding available for staffing intellectual property officers who are needed for supporting innovation efforts of faculty."

Committees staunchly oppose the proposed removal of several policy sections. While the agreement to pay 35% of patent royalties (which presumably fall under the new umbrella definition of "Net Commercialization Income") to inventors is retained, the agreement for payment to the inventors' "heirs, successors, or assigns" is eliminated. The rule that "15% of net royalties and fees per invention shall be allocated for research related purposes on the inventor's campus or Laboratory" is likewise eliminated, as is language that allows for inventor ownership of patents arising from permissible outside consulting activities. Committees also note that the vague "at least once per year" timeline for distributing Net Commercialization Income could cause tax issues for inventors.

Davis Division leadership concurs with committees that these revisions would disincentivize innovation and discourage patenting—negative outcomes for faculty and campuses alike. The Davis Division appreciates the opportunity to comment.

Sincerely,

Ahmet Palazoglu
Chair, Davis Division of the Academic Senate
Distinguished Professor of Chemical Engineering
University of California, Davis

Enclosed: Davis Division Committee Responses

c: Monica Lin, Executive Director, Systemwide Academic Senate
Michael LaBriola, Assistant Director, Systemwide Academic Senate
Edwin M. Arevalo, Executive Director, Davis Division of the Academic Senate

UC DAVIS: ACADEMIC SENATE
COMMITTEE ON FACULTY WELFARE

May 11, 2023

Ahmet Palazoglu
Chair, Davis Division of the Academic Senate

RE: Request for Consultation – Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Ahmet:

The Committee on Faculty Welfare has reviewed the RFC – Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer and showed overall support of the revised policy. The committee did express that it could be beneficial to more clearly establish where software, algorithms, etc. are addressed within the policy. There was also some concern around any potential implications for visiting scholars from outside institutions.

Sincerely,

Janet Foley
Chair, Committee on Faculty Welfare

c: Edwin M. Arevalo, Executive Director, Davis Division of the Academic Senate

UC DAVIS: ACADEMIC SENATE
COMMITTEE ON RESEARCH

May 12, 2023

Ahmet Palazoglu
Chair, Davis Division of the Academic Senate

RE: Request for Consultation on the Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Ahmet:

The Committee on Research (COR) has reviewed the proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer, and has the following suggestions:

Some Committee on Research members noted that several AS members have signed a letter expressing concern about the proposed changes (see https://forms.gle/LPXqPpBQQ1xMuU4e7). Perhaps most notably, the removal of explicit language regarding the percentages of royalties and fees that would be disbursed to faculty may disincentivize faculty from pursuing innovation. The absence of specific guidelines may undermine faculty rights to benefit from intellectual property, and/or may contribute to system-wide inequities if different local policies are implemented on different campuses. More specific guidelines may be needed, at least ensuring the 35% to faculty as a minimum. Additionally, the removal of language explicitly conferring inheritance rights of royalties to the heirs of inventors is concerning.

The changes ensuring disbursements of funds annually and conferring revenue flow to campus authorities rather than UCOP appear to be positive.

It is unclear whether the conferral of responsibility from UCOP to the campus level also changes the proportion of royalties and fees that go to the UCOP budget. With less responsibility and work at the UCOP level, decreasing or eliminating the UCOP proportion of royalties and fees would be advantageous to campuses, as it would increase the local funding available for staffing intellectual property officers who are needed for supporting innovation efforts of faculty.

Sincerely,

Paul D. Hastings
Chair, Committee on Research

Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

FEC: College of Agricultural and Environmental Sciences Committee Response

May 12, 2023

The Faculty Executive Committee of the College of Agricultural and Environmental Sciences reviewed the proposed revisions to the Presidential Policy on Inventions, Patents, and Innovation Transfer and appreciates this opportunity to comment.

The FEC members provided concerns on the proposed revision with the specific comments below:

1. Elimination of the inventor(s)' heirs, successors, or assigns and deletion of Elimination of an additional 15% of net royalties and fees per invention shall be allocated for research-related purposes on the inventor's campus or Laboratory in the same Text C: Income Distribution. The proposed changes would thwart the retention and recruitment of the best and brightest faculty.
2. Deletion of “An agreement to assign inventions and patents to the University, except those resulting from permissible consulting activities without use of University facilities, shall be mandatory for all employees, for persons not employed by the University but who use University research facilities, and for those who receive gift, grant, or contract funds through the University.” The deletion could confuse inventors, increase bureaucracy, and frustrate, discourage, and impede faculty from seeking to engage in permissible outside activities.
3. Deletion of specific annual income distribution date with vague at least once per year, which could negatively affect faculty tax liability plans.
4. The patent acknowledgment section seems to be very broad and discourages consulting and other outside collaboration activities.

FACULTY EXECUTIVE COMMITTEE
COLLEGE OF BIOLOGICAL SCIENCES
UNIVERSITY OF CALIFORNIA, DAVIS

May 12, 2023

Ahmet Palazoglu
Chair, Davis Division of the Academic Senate

RE: Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Ahmet:
The College of Biological Sciences Faculty Executive Committee reviewed this report on the ASIS whiteboard and sought comments from individual faculty through our department representatives. The general consensus is that this proposed revision is a complete non-starter. A large number of faculty comments were received, all of which were strongly opposed to the revisions. The revisions appear to remove key incentives for faculty to innovate and seek patents, including 1) a guarantee of annual payments of the 35% of patent royalties assigned to the inventor, 2) language permitting ownership of patents arising from permissible outside consulting activities, 3) a guarantee of 15% of patent royalties for the inventor's unit, and 4) the ability for the inventor's heirs to receive patent royalties. There is widespread concern that this "modernization" of the policy will be a serious disincentive to further innovation by faculty. Given the current financial difficulties facing many campuses, patent income is more needed than ever, making it entirely unacceptable to impose changes that would discourage faculty from seeking patents on their work.

The CBS FEC feels that the Academic Senate should vigorously oppose this revised policy. Our disapproval of this policy is so strong that one of our members has already circulated a letter of opposition addressed to UCOP Vice President of Research & Innovation, Dr. Theresa A. Maldonado, which is appended below. We also include below various comments from our faculty detailing the individual reasons for their opposition.

The College of Biological Sciences faculty appreciate the opportunity to comment. We hope that the Executive Council will take our concerns into serious consideration.

John Albeck
Associate Professor
Department of Molecular and Cellular Biology
Chair, College of Biological Sciences Faculty Executive Committee
Davis, CA

Individual faculty comments:

In addition to the comments below I would like to add my voice that I am strongly opposed to the changes that remove the 15% of royalties going to the home campus or department, the loss of right to assign royalties to heirs or other assignees, and the removal of language defining permissible outside consulting activities.

These changes will disincentive inventiveness and also may well lead to loss of top faculty and difficulties in recruitment.

Moving on to faculty comments:

In the comments below,

"1" refers to the removal of the 15% royalties going to home campus / dept

"2" refers to the 25% no longer being assignable to heirs, etc

"3" refers to the removal of language regarding permissible consulting.

####

1) This is yet another way for taking money away from research efforts. Disincentivizes people.

2) This is again very disincentivizing inventors and seems like a money grab move by UC.

3) Terrible policy if it goes through. Maybe they should just take away those permissions for consulting activities if they will not recognize them as outside of University facilities? They want to showcase faculty prominence outside academia by allowing us to consult, but then take away the fruits of such efforts.

######

I am against the changes. The most unfair removal is the heir provision. The other two are also bad, but not as glaring as #2.

#######

I cannot see any positives – only negatives. I cannot understand how this “modernization” is supposed to be better, at least for the faculty. It might possibly be better for UC administration in the short run, by tapping into another revenue stream. In the long run it will discourage anyone with aspirations to commercialize research from coming / staying at UC.

One point that the official statement does not address is how these policies compare with other universities of similar status. Is UC an outlier with its present policies? I don’t think so, rather I think that adopting these new policies might make it an outlier. That is my guess based on what I have heard from colleagues elsewhere, but I have no direct information. Such a comparative analysis is critically important before any decisions are made.

####

This will have a major impact on the inventors (PIs).

Based on the proposed 1) and 2) changes, inventors will be less likely to aggressively push for obtaining patents through the university. Based on proposed 1) change, there will be no incentive for the faculty to seek patents; this will also have a major impact on the college and the departments.

Is 2) refers to when the inventor passes away - the royalties will not be transferred? This does not make sense given UCOP will be continuing to benefit from the royalties. I think as long as UCOP receives the royalties, it should be passed on.

3) - this will impact those who will be doing consulting work outside the university.

Overall, many of the proposed changes will discourage people from pushing for patents. CBS FEC should not support the proposed changes.

In May 2021, the Regents Working Group on Innovation Transfer and Entrepreneurship recommended "broad-based reforms, increased investment and/or systemic modernization in the following seven areas: governance, patent tracking system, funding, ***policy***, culture/reputation, enforcement, and performance metrics." Overall, the Report is uplifting and lays the foundation for strengthening "UC's reputation as one of America's premier centers of research and innovation."

By contrast, the proposed change in the Patent Policy is utterly disappointing. There is nothing in the proposed policy that promotes innovation. There could be multiple ways to catalyze innovation and motivate faculty, such as earmarking a percentage of the royalty revenues to the inventor(s) 's research program or their department(s). Instead, the proposed policy omits the following: "an additional 15% of net royalties and fees per invention shall be allocated for research purposes on the inventor's campus."

UC used to share 50% of the royalties with the inventor(s). Then, the university reduced to 35% to "inventors or the inventors' heirs, successors, or assigns." The difference (15%) was allocated "for research purposes on the inventor's campus." The proposed policy omits "the inventors' heirs, successors, or assigns," and does not mention anything about the 15% difference! When applicable, royalties should be an asset transferable to survivors. Instead of modernizing, the proposed policy creates more ambiguity. For example, the exception for assigning inventions "resulting from permissible consulting activities without use of University facilities" was omitted.

Lastly, the timeline for the distribution of royalties is unclear. The current Patent Policy states: "Distribution of the inventor's share of royalties shall be made annually in November from the amount received during the previous fiscal year ending June 30th." By contrast, the proposed policy states "Net Commercialization Income under this policy will be distributed at least once per year based on income and costs from the previous year." The lack of a defined time for sharing royalties may cause tax issues for inventors.

In summary, the Report from the Workgroup is uplifting, but the proposed patent policy is a setback. To a minimum, the university should keep the terms of the current patent policy if the goal is to incentivize innovation.

Letter to UCOP Vice President of Research & Innovation, Dr. Theresa A. Maldonado

https://forms.gle/TMN2mmBozJqQbV3U7

May 11, 2023

Dear Vice President Maldonado,

Thank you for your letter of Feb. 17, 2023. On behalf of past, present, and potentially future inventors, we UC faculty, seek amendments to your "Proposed Policy on Inventions, Patents, and Innovation Transfer."

The Regents Workgroup on Innovation Transfer and Entrepreneurship concluded that "Many of the nation's premier innovation transfer universities … celebrate, support, and often incentivize faculty…" (May 2021, page 8). Additionally, the report noted that policies "should not create disproportionate burden bureaucracy, nor should they have an overall chilling effect on the faculty pursuit of innovation and entrepreneurial activities."

The proposed changes to the UC Patent Policy would have both a crushing effect and disincentivize faculty in their pursuit of innovation. Specifically, the suggested policy curtails income distribution by deleting critical parts of the current policy, i.e., "The University agrees, following said assignment of inventions and patent rights, to pay annually to the named inventor(s), **or to the inventor(s)' heirs, successors, or assigns**, 35% of the net royalties and fees per invention received by the University. **An additional 15% of net royalties and fees per invention shall be allocated for research-related purposes on the inventor's campus or Laboratory**." In addition, these proposed changes would thwart the retention and recruitment of the best and brightest faculty.

Another key point: the proposed policy omits a crucial clarification regarding an exception to the Patent Policy. Specifically: "An agreement to assign inventions and patents to the University, **except those resulting from permissible consulting activities without use of University facilities**, shall be mandatory for all employees, for persons not employed by the University but who use University research facilities, and for those who receive gift, grant, or contract funds through the University." This would confuse inventors, increase bureaucracy, and frustrate, discourage, and impede faculty from seeking to engage in permissible outside activities.

Lastly, the proposed policy regarding income distribution (**at least once per year**) is vague, negatively affecting faculty tax liability plans.

In the spirit of the Workgroup recommendations and shared governance, we strongly suggest you amend the proposed policy to include the abovementioned crucial terms.

Thank you for your prompt attention to this matter.

Respectfully submitted,

Walter S. Leal, Distinguished Professor of Biochemistry, Fellow of the National Academy of Inventors, UC Davis

Bruce D. Hammock, Distinguished Professor of Entomology, Fellow of the National Academy of Inventors, Member of the National Academy of Sciences, UC Davis

Simon R. Cherry, Distinguished Professor, Departments of Biomedical Engineering and Radiology, Member, of the National Academy of Engineering, Fellow of the National Academy of Inventors, UC Davis

Stephen Kowalczykowski Distinguished Professor of Microbiology and Molecular Genetics, Member of the National Academy of Sciences, Member of American Academy of Arts & Sciences, UC Davis

Savithramma P Dinesh-Kumar, Professor and Chair of Department of Plant Biology; Professor, The Genome Center; UC Davis

Andrew Hargadon, Professor of Management, Soderquist Chair in Entrepreneurship, Graduate School of Management, UC Davis

Steven A. Nadler, Professor and Chair, Department of Entomology and Nematology, UC Davis

Jerry M Woodall, NMT Laureate, Member NAE, Fellow: NAI, AAAS, APS, ECS, AVS, UC Davis

Frederic Chedin, Professor and Chair, Department of Molecular and Cellular Biology, UC Davis

James A. Letts, Assistant Professor of Molecular and Cellular Biology, UC Davis

Sean Burgess, Professor, Department of Molecular and Cellular Biology, UC Davis

Bruce C. Gates, Distinguished Professor of Chemical Engineering Emeritus, member NAE, Fellow of NAI, UC Davis

Gerald Quon, Assistant Professor of Molecular and Cellular Biology, UC Davis

Wolf-Dietrich Heyer, Ph.D. Distinguished Professor and Chair Department of Microbiology and Molecular Genetics Co-leader Molecular Biology Program UC Davis Comprehensive Cancer Center

Emanual Maverakis, Professor of Dermatology, UC Davis

Christian Nansen, Professor of Entomology & Nematology, UC Davis

Carlito B. Lebrilla, Department of Chemistry and Biochemistry and Molecular Medicine, UC Davis

Mark Mascal, Professor, Department of Chemistry, UC Davis

Oliver Fiehn, Professor, Department of Molecular and Cellular Biology, UC Davis

Kassandra Ori-McKenney, Associate Professor, MCB, UC Davis

Heike Wulff, Professor, Department of Pharmacology, UC Davis

Richard J. McKenney, , Associate Professor, MCB, UC Davis

Gail Taylor, Distinguished Professor and Chair, Department of Plant Sciences, UC Davis

Jorge Dubcovsky, Distinguished Professor and Member of the National Academy of Sciences, UC Davis

David E. Olson, Director of the Institute for Psychedelics and Neurotherapeutics, Associate Professor, Department of Chemistry, Department of Biochemistry & Molecular Medicine, UC Davis

Allen Van Deynze, Director, Seed Biotechnology Center, Associate Director, Plant Breeding Center, Director, Scientific Director, African Orphan Crops Consortium, UC Davis

Elizabeth Mitcham, Director Postharvest Technology Center, Department of Plant Sciences, UC Davis

Claude Meares, Distinguished Professor Emeritus, Chemistry Department, UC Davis

Eduardo Blumwald, Distinguished Professor, Dept. of Plant Sciences, UC Davis

Abhaya M. Dandekar, Distinguished Professor, Plant Sciences Department, UC Davis

Pat J. Brown, Associate Professor, Plant Sciences, UC Davis

Gang Sun, Distinguished Professor, Biological and Agricultural Engineering, UC Davis

Richard Michelmore, Distinguished Professor and Director, The Genome Center, UC Davis

Justin Siegel, Associate Professor, Faculty Director of the Innovation Institute for Food and Health, Fellow of the National Academy of Inventors, UC Davis

Marina S. Leite, Associate Professor, Materials Science and Engineering, UC Davis

Tonya Kuhl, Professor and Chair, Department of Chemical Engineering, UC Davis

Anne Britt, Dept. of Plant Biology, College of Biological Sciences, U.C. Davis

Satoshi Namekawa, Professor, Department of Microbiology & Molecular Genetics, UC Davis

Nitzan Shabek, Assistant Professor, PLB, UC Davis

Julin Maloof, Professor, Department of Plant Biology

Steven M Theg, Distinguished Professor, Department of Plant Biology of Plant Biology

Frank G. Zalom. Distinguished Professor Emeritus, Department of Entomology & Nematology, UC Davis

María Maldonado, Assistant Professor, Department of Plant Biology, UC Davis

Jeremy Munday, Professor, Electrical and Computer Engineering, UC Davis

Christopher Simmons, Professor and Chair, Department of Food Science and Technology, UC Davis

Edward Spang, Associate Professor, FST, UC Davis

Ben Montpetit, Associate Professor and Vice Chair, Department of Viticulture and Enology, UC Davis

Samuel L. Díaz Muñoz, Assistant Professor, Department of Microbiology and Molecular Genetics, UC Davis

Pamela Ronald, Distinguished Professor of Plant Pathology, Member of the National Academy of Sciences and Recipient of the Wolf Prize in Agriculture, UC Davis

JoAnne Engebrecht, Professor, Department of Molecular and Cellular Biology, UC Davis

Andrew Fisher, Professor of Chemistry, UC Davis

John Albeck, Associate Professor of Molecular and Cellular Biology, Chair of the College of Biological Sciences Faculty Executive Committee, UC Davis

J. Clark Lagarias, Distinguished Professor Emeritus of Biochemistry, Department of Molecular and Cellular Biology, UC Davis

Nathan Kuppermann, MD, MPH; Distinguished Professor of Emergency Medicine and Pediatrics, Fellow of the National Academy of Medicine, UC Davis

Harris A. Lewin, Distinguished Professor Emeritus, Department of Evolution & Ecology, Member of the National Academy of Sciences, USA, UC Davis

R Holland Cheng, Professor, Department of MCB, UC Davis

E. Charles Brummer, Professor, Department of Plant Sciences and Director, Plant Breeding Center, UC Davis

Sean Collins, Associate Professor, Microbiology & Molecular Genetics, UC Davis

Neil Hunter PhD, Professor, Department of Microbiology & Molecular Genetics, Investigator, Howard Hughes Medical Institute, UC Davis

Luca Comai, Department of Plant Biology, Distinguished Professor, The Genome Center, Member of the National Academy of Sciences, USA, UC Davis

Aydogan Ozcan, Professor at UCLA School of Engineering, NAI Fellow, UCLA

Holger Schmidt, Distinguished Professor of Electrical and Computer Engineering, Narinder Kapany Chair of Optoelectronics, Fellow of the National Academy of Inventors, the Optical Society of America, and the IEEE, UC Santa Cruz

John Owens, Child Family Professor of Engineering and Entrepreneurship, Department of Electrical and Computer Engineering, UC Davis

Michael J. Sailor Distinguished Professor Director, UC San Diego Materials Research Science and Engineering Center (mrsec.ucsd.edu) Director, UC San Diego Institute for Materials Discovery & Design (imdd.ucsd.edu), UC San Diego

Yoram Cohen, Distinguished Professor, Chemical and Biomolecular Engineering, Rosalinde and Arthur Gilbert Foundation Chair, UCLA Luskin Scholar

Subramanian S. Iyer, Distinguished Professor, NAI Fellow, UCLA

Dino Di Carlo, Professor and Vice Chair of Bioengineering, UCLA

Steven P. Briggs, Distinguished Professor, Cell & Developmental Biology, UC San Diego

Kevin W Plaxco, Professor and Vice Chair, Department of Chemistry & Biochemistry, UC Santa Barbara

Song Li, Professor and Chair of Bioengineering, UCLA

Kyriacos A. Athanasiou, Biomedical Engineering, Distinguished Professor, Henry Samueli Chair, Elected National Academy of Medicine, Fellow of the National Academy of Inventors, UC Irvine

Aaron Meyer, Associate Professor of Bioengineering, UCLA

Paul S. Weiss, UC Presidential Chair and Distinguished Professor of Chemistry & Biochemistry, Bioengineering, and Materials Science & Engineering, UCLA

Irene Chen, Associate Professor of Chemical and Biomolecular Engineering, UCLA

Anthony A. James, Donald Bren and Distinguished Professor, Depts. Micro. Molec. Gen. and Molec. Biol. Biochem. Member of the National Academy of Sciences, UC Irvine

B. S. Manjunath, Distinguished Professor, Department of Electrical and Computer Engineering, NAI fellow, UCSB

Glenn H. Fredrickson, Distinguished Professor of Chemical Engineering and Materials, Member NAS and NAE, UCSB

Rebecca Heald, Department of Molecular and Cellular Biology, Professor, UC Berkeley

Michael C. Pirrung, Distinguished Professor of Chemistry, Fellow of the National Academy of Inventors, UC Riverside

Chris T. Amemiya, Department of Molecular & Cellular Biology, Professor, UC Merced

Abraham P. Lee, Biomedical Engineering, Chancellor's Professor, Fellow of the National Academy of Inventors, UC Irvine

Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

FEC: College of Engineering Committee Response

May 12, 2023

The Faculty Executive Committee of the College of Engineering discussed the proposed revisions to the Presidential Policy on Inventions, Patents, and Innovation Transfer at its regular meeting on May 12, 2023. The Committee is generally supportive of the proposal as presently constructed, with no members raising any objections or concerns.

The College of Engineering faculty appreciates the opportunity to comment.

Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

FEC: College of Letters and Science Committee Response

May 12, 2023

The committee supports the idea of delegating the authority to the campus. We hope that the staff resources will be provided to support this policy.

Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

FEC: School of Education Committee Response

May 12, 2023

The School of Education is supportive of the portion of the proposed revisions to the Presidential Policy on Inventions, Patents and Innovation Transfer that puts responsibility for these activities on individual campuses instead of centralizing activities through UCOP. We believe that this will increase efficiency in some of our research activities, especially the Materials Transfer process. We also concur with the Committee on Research that greater clarity is needed around the implications for what proportion of net royalties will be disbursed to faculty inventors and on the extent to which consulting activities might be curtailed.

Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

FEC: School of Law Committee Response

May 12, 2023

The broad definition of IP (specifically the following statement “Future advances in science and the arts may result in new structures for intellectual property protection and they also fall within this policy” may raise ambiguity concerns for faculty.

Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

FEC: School of Medicine Committee Response

May 12, 2023

The committee had these questions:

Which university counsel has reviewed this document? Are the legal rights of the faculty taken into consideration in this version?

University of California, Irvine

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Irvine, CA 92697-1325
(949) 824-7685
www.senate.uci.edu

May 17, 2023

Susan Cochran, Chair
Academic Council

Re: Systemwide Review of Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

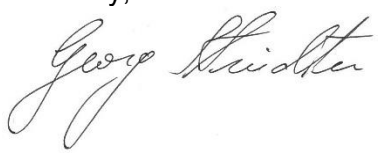
Dear Chair Cochran,

The Irvine Division discussed the proposed revisions to the Presidential Policy on Inventions, Patents, and Innovation Transfer at its Cabinet meeting on May 16, 2023. The Council on Planning and Budget (CPB) and Council on Research, Computing, and Libraries (CORCL) also reviewed the proposal. Their feedback is attached for your review.

Cabinet members concurred with the councils' feedback.

The Irvine Division appreciates the opportunity to comment.

Sincerely,



Georg Striedter, Chair
Academic Senate, Irvine Division

Enclosures: CPB, CORCL memos

Cc: Arvind Rajaraman, Chair Elect-Secretary
Jisoo Kim, Executive Director
Gina Anzivino, Associate Director

University of California, Irvine

Academic Senate
Council on Research, Computing & Libraries
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May 8, 2023

GEORG STRIEDTER, CHAIR
ACADEMIC SENATE, IRVINE DIVISION

RE: Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

At its meeting on April 20, 2023, the Council on Research, Computing, and Libraries (CORCL) discussed the proposed revisions to the Presidential Policy on Inventions, Patents, and Innovation Transfer.

The Council observed that the policy revisions are generally sensible. However, there were many areas in need of clarification. The Council offers the following specific comments:

II. Definitions

Intellectual Property. This term is defined to include "registered or unregistered trademarks" and "service marks." To the extent that the Policy itself only addresses "University IP," it is unclear how often a trademark or service mark would qualify as "University IP," which requires that the IP have been created within University employment, using University Research Facilities, or using grants, etc. received through the University. If, for example, Professor Smith creates a patentable medical device that constitutes University IP and calls the device the "Smith Device," does the University intend to claim ownership of the trademark "Smith Device" because the faculty member named the device "within the course . . . of University employment"? Further clarification on this point would be desirable.

Net Commercialization Income. The phrase "such other costs" in the last line of this paragraph is ambiguous and open-ended, particularly when coupled with the phrase "payments to third parties" that does not specify that those payments are related to the development of exploitation of the Intellectual Property rights. More specific language would be preferable to indicate what kinds of "other costs" are meant.

III. Policy Text

B. Ownership. Although the policy provides that "The University owns University IP," the policy offers no indication of what will happen if the University decides that it does not wish to pursue obtaining a patent on an Invention that qualifies as University IP, or decides not to attempt to commercialize such an Invention. It is not uncommon for technology transfer policies to provide that in such situations, the university would allow the faculty inventor to attempt to obtain an patent and/or commercialize the invention, often by licensing back any intellectual property rights to the faculty member. (The current policy that is being replaced includes a provision for the University to "release patent rights to the inventor" when the University decides not to seek to patent an invention.) If this Policy assumes that all inventions made by all faculty members on campus will always be commercialized through the University, that seems unrealistic. The Policy should make some provision for what will happen to an Invention that constitutes University IP when the University decides not to attempt to patent and/or commercialize that Invention.

C. Income Distribution. This paragraph requires the payment to Inventor(s) of 35% of the Net Commercialization Income from "Inventions." The policy defines an "Invention" as a device, method, composition, process, etc. that

"is or may be patentable." As an initial matter, this provision should only apply to "Inventions" that constitute "University IP," rather than any "Invention" (since it is unclear that the University has any right to commercialize any "Invention" that is not "University IP"). This would be parallel to the provision of III.B., discussed in the next section, that refers to "non-Invention University IP."

Note that the current policy provides, in addition to the 35% payment to the Inventor(s), for allocating 15% of the net royalties "for research related purposes on the inventor's campus or Laboratory." The removal of this provision would appear to leave the campus free to use the remaining 65% of the net commercialization income for whatever purposes it wishes. [The proposed policy also deletes the current policy's provision that "In the disposition of any net income accruing to the University from patents, first consideration shall be given to the support of research." That provision seems entirely hortatory and much less clear than the 15% requirement, so removing that provision may not have much practical impact.]

The current policy includes a provision that the University will pay the 35% share to the inventor(s) "or to the inventor(s)' heirs, successors, or assigns." Removing that provision raises the question of whether the University intends not to pay the 35% to anyone after the inventor dies.

The policy states that "the distribution of Net Commercialization Income from non-Invention University IP is determined at the campus or Laboratory level." The breadth of the policy's definitions means that "non-Invention University IP" can include, for example, course materials developed by faculty but owned by the University, trademarks associated with inventions (for example, a faculty member's name that is associated with a commercialized invention), as well as discoveries that are protected by trade secrecy rather than by patent. Leaving the determination of distribution of income from such non-Invention University IP to the campuses means that the systemwide policy can't specify the division (as it does for Inventions), but UC Irvine should be encouraged to establish percentages for such division or means for establishing the percentage rate applicable to in non-Invention situations, rather than simply handling this on an ad hoc case-by-case basis.

IV. Compliance/Responsibilities

This section states that "To support the University's research and education purposes, all licenses and grants of rights must include a retained right for the University and other non-profits to practice University IP." For the avoidance of doubt, it would be preferable to make clear that "all licenses of and grants of rights in any University IP must include a retained right for the University and other non-profits to practice that University IP."

In addition, the requirement to retain the right to "practice University IP" is probably only directly relevant to patent rights (and possibly trade secret rights). Copyright and trademark owners are not generally described as having rights to "practice" their copyrights or trademarks. Because "University IP" is defined very broadly to extend beyond patents and trade secrets, and is defined to include both copyrights and trademarks, it would be better to say that licenses and grants must include a retained right to "exercise the rights associated with University IP." (Alternatively, if this provision on retained rights is intended to apply only to inventions protected by patent or trade secret, then it would be better to specify that this applies only to grants or licenses of "Inventions that are University IP."

V. Procedures

B. Reporting.

The obligation to "promptly report and fully disclose all Inventions" to the licensing office should be publicized to faculty beyond simply promulgating this policy, which not all faculty will know about.

The definition of "Invention" as including those that "may be patentable" suggests that faculty should report broadly, even if they are unsure whether a particular invention is patentable.

General Comments

- It would have been helpful to know what prompted the changes outside of the organizational process that the review has undergone.
- There is concern that a broad interpretation of this may be overly burdening to faculty. Members expressed that the implications of the policy revisions are unclear. Clarity on practical applications of the revisions is needed.
- The review materials do not provide any indication that those that would be most interested in the changes (e.g. UCI's Beall Applied Innovation) were involved in its development. The Council suggested that the Senate consider more targeted outreach to faculty that are especially involved in tech commercialization for feedback.

The Council appreciates the opportunity to comment.

On behalf of the Council,

Matt Harding, Chair

c: Jisoo Kim, Executive Director
Gina Anzivino, Assistant Director
Michelle Chen, CORCL Analyst

University of California, Irvine

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May 8, 2023

GEORG STRIEDTER, CHAIR
ACADEMIC SENATE, IRVINE DIVISION

RE: Systemwide Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

At its April 26, 2023 meeting, the Council on Planning and Budget (CPB) discussed the proposed revisions to the Presidential Policy on Inventions, Patents, and Innovation Transfer.

The revisions include the following key changes:

- The responsibility for the implementation of the policy is transferred from UCOP to each individual campus.
- The new policy includes non-patentable innovations of interest to extramural sponsors and potential licensees.
- The policy is renamed to Policy on Inventions, Patents, and Innovation Transfer.

Overall, the Council found the revisions to be relatively straightforward. The renaming is appropriate and better reflects the policy content. The policy was rewritten to include detailed definitions and improve clarity. While the language may appear broader, there does not seem to be a significant change in policy.

The only question raised was that as responsibility for implementation now falls on individual campuses, it is unclear whether the change will result in an increased financial burden on each campus. In practice, UCI already has the Beall Applied Innovation where decisions are made concerning patents and innovation. Do the revisions align with existing practices at UCI? Most, if not all other campuses, seem to have an equivalent office. If there is a potential additional financial burden, it is unclear whether UCOP funds currently used for this will be reallocated to the campuses.

The Council appreciates the opportunity to comment.

On behalf of the Council,

Alyssa A. Brewer

Alyssa Brewer, Chair
Council on Planning and Budget

CC: Jisoo Kim, Executive Director, Academic Senate
Gina Anzivino, Associate Director, Academic Senate
Michelle Chen, CPB Analyst
Stephanie Makhlouf, Cabinet Analyst

UCLA Academic Senate
Executive Board

May 17, 2023

Susan Cochran
Chair, UC Academic Senate

Re: (Systemwide Senate Review) Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Chair Cochran,

The Executive Board (EB) of the Los Angeles Division appreciated the opportunity to review the Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer, which it reviewed at its meeting on May 11, 2023. Attached please find letters from divisional committees and councils.

EB members voted to approve a motion to decline to endorse the proposed revisions. Members were concerned about the lack of clarity that would accompany devolution of authority to campuses, including the distribution of royalties and the development of new positions (and necessary expertise) to manage on the campuses.

In addition, members expressed concerns, some of which reflected the feedback in committee and council letters, about the exception section and related protections for faculty in relation to Chancellorial discretion, changes in distribution of royalties (especially the portion of royalties no longer earmarked for research departments), and the exclusion of heirs. A committee also requested clarification of how the policy would apply to collaborators beyond the University of California.

The Los Angeles Division appreciated the opportunity to review this issue.

Sincerely,

Jessica Cattelino
Chair, UCLA Academic Senate

Encl.

Cc: April de Stefano, Executive Director, UCLA Academic Senate
Andrea Kasko, Vice Chair/Chair Elect, UCLA Academic Senate
Shane White, Immediate Past Chair, UCLA Academic Senate

UCLA Academic Senate
Council on Planning & Budget

May 1, 2023

Jessica Cattelino, Chair
Academic Senate

Re: Systemwide Review: Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Chair Cattelino,

At its meeting on April 3, 2023, the Council on Planning and Budget (CPB) reviewed the Proposed Revisions to the Presidential Policy on Inventions, Patents, and Innovation Transfer. Members offered the following comments.

Members were in unanimous support of the development of a more transparent process and adding a provision to request exceptions – and for these to be disclosed to the university community and include faculty consultation. A few members noted that the Chancellor has the power to make exceptions to the policy and noted that there were no clear guidelines for circumstances under which these would be granted, nor guidelines for granting them. Some members questioned whether exceptions would be liberally granted, in which case having such a policy might be unnecessary. Some members expressed concern over a process that grants exceptions to the policy without Academic Senate input. Other members observed that the policy was challenging to follow and understand.

If you have any questions for us, please do not hesitate to contact me at afl@ucla.edu or via the Council's analyst, Elizabeth Feller, at efeller@senate.ucla.edu.

Sincerely,

Andrew Leuchter, Chair
Council on Planning and Budget

cc: Andrea Kasko, Vice Chair/Chair Elect, Academic Senate
Shane White, Immediate Past Chair, Academic Senate
April de Stefano, Executive Director, Academic Senate
Elizabeth Feller, Associate Director, Academic Senate
Members of the Council on Planning and Budget

UCLA Academic Senate
Council on Research

May 1, 2023

Jessica Cattelino, Chair
Academic Senate

Re: Systemwide Review: Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Chair Cattelino,

At its meeting on April 5, 2023, the Council on Research (COR) reviewed the Proposed Revisions to the Presidential Policy on Inventions, Patents, and Innovation Transfer. Members offered the following comments.

Members noted that in previous versions of the policy there was 15% net royalties earmarked for investigators, but is now deleted (page 4, redline/tracked changes copy): "An additional 15% of net royalties and fees per invention shall be allocated for research-related purposes on the inventor's campus or Laboratory. Net royalties are defined as gross royalties and fees, less the costs of patenting, protecting, and preserving patent and related property rights, maintaining patents, the licensing of patent and related property rights, and such other costs, taxes, or reimbursements as may be necessary or required by law. Inventor shares paid to University employees pursuant to this paragraph represent an employee benefit." Members requested further clarification and explanation on the removal of this section and asked for the statement to be reinstated.

Additionally, members noted that the policy does not clearly state rules and responsibilities when peer investigators from other institutions are involved in a patent. There needs to be further clarification and guidance for when a UC faculty member is not the primary inventor.

If you have any questions for us, please do not hesitate to contact me at branting@ucla.edu or via the Council's analyst, Elizabeth Feller, at efeller@senate.ucla.edu.

Sincerely,

Jeff Brantingham, Chair
Council on Research

cc: Andrea Kasko, Vice Chair/Chair Elect, Academic Senate

UCLA Academic Senate

Committee on Data, Information Technology, and Privacy

April 26, 2023

Jessica Cattelino, Chair
Academic Senate

Re: (Systemwide Senate Review) Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Chair Cattelino,

At its meeting on April 11, 2023, the Committee on Data, Information Technology, and Privacy (CDITP) reviewed the Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer. The following comments were made by members of the committee:

Members with expertise having several UC patents and familiar with the process expressed that the policy as written is straightforward and agree with the revisions.

Thank you for the opportunity to comment on the proposed policy. If you have any questions for us, please do not hesitate to contact me at buia@mii.ucla.edu or via the Committee analyst, Renee Rouzan-Kay, at rrouzankay@senate.ucla.edu.

Sincerely,

Alex Bui, Chair
Committee on Data, Information Technology, and Privacy

cc: Andrea Kasko, Vice Chair/Chair-Elect, Academic Senate
Shane White, Immediate Past Chair, Academic Senate
April de Stefano, Executive Director, Academic Senate
Renee Rouzan-Kay, Senior Policy Analyst, Committee on Data, Information Technology, and Privacy
Members of the Committee on Data, Information Technology, and Privacy

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OFFICE OF THE ACADEMIC SENATE
PATTI LIWANG, CHAIR, ACADEMIC SENATE
senatechair@ucmerced.edu

UNIVERSITY OF CALIFORNIA, MERCED
5200 NORTH LAKE ROAD
MERCED, CA 95343

May 17, 2023

To: Susan Cochran, Chair, Academic Council

Re: Systemwide Review of Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer

The proposed Presidential Policy on Inventions, Patents, and Innovation Transfer was distributed for comment to the Merced Division Senate Committees and the School Executive Committees. The Committee on Research (CoR) offered comments for consideration. The committee's comments are summarized below and appended to this memo.

CoR viewed the proposed policy positively and believed it clarifies roles and responsibilities well. The committee's only concern pertains to section D Exceptions: "In special circumstances, it may be in the best interests of the University to enter into agreements that require exceptions to this policy. Campus Chancellors, the Vice President, Agriculture and Natural Resources, Laboratory Director and/or their delegates may authorize such exceptions in accordance with other University policies, applicable laws, and third-party obligations." CoR pointed out that campuses may not have set policies to deal with these exceptions.

Divisional Council reviewed CoR's comments via email and supports its various points and suggestions.

The Merced Division thanks you for the opportunity to comment on this proposed policy.

CC: Divisional Council
Monica Lin, Executive Director, Systemwide Academic Senate
Michael LaBriola, Assistant Director, Systemwide Academic Senate
Senate Office

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ACADEMIC SENATE, MERCED DIVISION
COMMITTEE ON RESEARCH (COR)
JASON SEXTON, CHAIR

UNIVERSITY OF CALIFORNIA, MERCED
5200 NORTH LAKE ROAD
MERCED, CA 95343

April 28, 2023

To: Patti LiWang, Senate Chair

From: Jason Sexton, Chair, Committee on Research (CoR)

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

---

CoR reviewed the proposed Presidential Policy on Inventions, Patents, and Innovation Transfer and offers the below comments.

CoR views the policy positively and believes it clarifies roles and responsibilities well.

The committee's only concern pertains to section D Exceptions: "In special circumstances, it may be in the best interests of the University to enter into agreements that require exceptions to this policy. Campus Chancellors, the Vice President, Agriculture and Natural Resources, Laboratory Director and/or their delegates may authorize such exceptions in accordance with other University policies, applicable laws, and third-party obligations." CoR points out that campuses may not have set policies to deal with these exceptions.

We appreciate the opportunity to opine.

cc: Senate Office

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CHAIR, ACADEMIC SENATE
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May 9, 2023

Susan Cochran, Chair, Academic Council
1111 Franklin Street, 12th Floor
Oakland, CA 94607-5200

RE: [Systemwide Review] Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Susan,

The Riverside Executive Council discussed the subject proposed policy during their May 8, 2023 meeting and had no additional comments to add to those attached from local committees that responded to the call for comments.

Sincerely yours,

Sang-Hee Lee
Professor of Anthropology and Chair of the Riverside Division

CC: Monica Lin, Executive Director of the Academic Senate
Cherysa Cortez, Executive Director of UCR Academic Senate Office

UC RIVERSIDE Academic Senate

COMMITTEE ON ACADEMIC FREEDOM

April 10, 2023

To: Sang-Hee Lee, Chair
Riverside Division Academic Senate

From: Ivy Zhang, Chair
Committee on Academic Freedom

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

The Committee on Academic Freedom reviewed the proposed Presidential Policy on Inventions, Patents, and Innovation Transfer at their April 3, 2023 meeting. The Committee did not have any concerns with the proposed policy based on their charge of academic freedom.

UC RIVERSIDE Academic Senate

COMMITTEE ON ACADEMIC PERSONNEL

April 3, 2023

To: Sang-Hee Lee, Chair
Riverside Division Academic Senate

From: Jang-Ting Guo, Chair
Committee on Academic Personnel

Re: **[Systemwide Review]** ***Proposed Revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer***

In its 3/20/2023 meeting, CAP discussed the proposed revisions to *Presidential Policy on Inventions, Patents, and Innovation Transfer*. The committee commended the effort toward modernizing the policy on innovation transfer and entrepreneurship, as well as expanding the policy's scope to many types of intellectual property that is important to innovation transfer. Below are our comments and suggestions.

- CAP supports the first major revision that explicitly gives campuses authority over innovation transfer and intellectual property related decisions.

- The second major revision is about expanding the policy's scope to address unpatentable innovations of interest to extramural sponsors/licensees and unpatentable intellectual property that can generate commercialization income. The latter part does not seem to be clearly laid out. The revised policy defines intellectual property most broadly, covering patents plus almost all types of outcomes of research activities. Among the intellectual property that is unpatentable, some may or may not generate commercialization income. As the intention of this revision is to expand the policy's coverage, a better definition of unpatentable intellectual property, which seems to be missing from the current version of the policy, should be added.

- Outside of the context of this revised policy but pertinent to CAP is how to evaluate the innovation transfer and entrepreneurship activities during the academic personnel review process. CAP agrees with the Academic Council's position that these contributions should be assessed with the current framework of the Academic Personnel Manual (APM) and may fall under teaching, research and creative activity, or service. APM provides useful flexibility while maintaining the high standards in the application of review criteria.

UC RIVERSIDE

Academic Senate

April 28, 2023

To: Sang-Hee Lee, Chair
Riverside Division

From: Susan Laxton, Chair
Committee on Library & Scholarly Communication

Re: 22-23. SR. Proposed revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

The committee wishes to know whether, now that the authority for control over Inventions, Patents and Innovation Transfer has been remanded to the individual campuses, whether the 65% of funds earned by the sale of inventions etc. that the University garnishes will be fully turned over to research and not used for administrative purposes, and whether those funds will be used only for the campuses that have generated them or spread among the 10 UCs.

UC RIVERSIDE | School of Medicine

April 21, 2023

TO: Sang-Hee Lee, Ph.D., Chair, Academic Senate, UCR Division

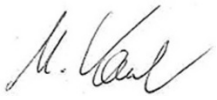
FROM: Marcus Kaul, Ph.D., Chair, Faculty Executive Committee, UCR School of Medicine

SUBJECT: Response to [Systemwide Review] Proposed Revisions to Policy: Proposed revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Sang-Hee,

The SOM Faculty Executive Committee has reviewed the proposed revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer, and agreed that an up-to-date policy is necessary. Some committee members noted during the review and discussion, that some clarity is needed on how contributions are defined and how royalty sharing is defined. While flexibility in the arrangements for sharing is useful, the policy should provide clarity with regard to the definitions that will be applied setting up those arrangements.

Yours sincerely,



Marcus Kaul, Ph.D.
Chair, Faculty Executive Committee School of Medicine

UC RIVERSIDE
School of Public Policy

School of Public Policy
University of California, Riverside
INTS 4133 | 900 University Ave
Riverside, CA 92521

TO: Sang-Hee Lee, Chair
Riverside Division

FR: Richard M. Carpiano, Chair
Executive Committee, School of Public Policy

RE: [Systemwide Review] Proposed Revisions to Policy: Proposed revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer

Date: April 24, 2023

The Executive Committee of the School of Public Policy reviewed the documentation for "[Systemwide Review] Proposed Revisions to Policy: Proposed revisions to Presidential Policy on Inventions, Patents, and Innovation Transfer."

The following comments arose in our review: The document should add some language about supporting research and evaluation of university innovation activities, which will help increase accountability and improvement of different programs, while encouraging and supporting UC campuses' innovation activities to be part of regional entrepreneurship ecosystem building.

We have no other comments.

Sincerely,

Richard M. Carpiano, Ph.D., M.P.H.
Professor of Public Policy

UNIVERSITY OF CALIFORNIA, SAN DIEGO UCSD

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May 12, 2023

Professor Susan Cochran
Chair, Academic Senate
University of California
VIA EMAIL

Re: Divisional Review of the Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Chair Cochran,

The Presidential Policy on Inventions, Patents, and Innovation Transfer was distributed to San Diego Divisional Senate standing committees and discussed at the May 8, 2023 Divisional Senate Council meeting. Senate Council reviewed the policy and provided the comments below. Council declined to take a position on the proposal (endorse or oppose) because the central concern that emerged during discussion is that it is difficult to support a systemwide policy when so many of the decisions surrounding patenting and commercialization are left to individual campuses' discretion to implement locally. Without knowing how the proposed changes to the Presidential Policy will be implemented in the complementary local policy (which has not been developed), Council did not feel comfortable agreeing with the proposed systemwide policy changes.

Council was concerned with the removal of the 15% of revenues that were previously earmarked specifically for campus or laboratory research. The new policy does not explicitly reserve funds for research, but instead uses broader language that allows campuses to allocate funds for other purposes. Members were concerned that this could negatively impact inventors if local campuses choose to allocate the funds elsewhere instead of back to the inventors' laboratories. The 15% royalty is an important incentive for innovation and commercialization, and reviewers felt it should be specifically designated in systemwide policy. This would likely provide a stronger assurance that the research mission will be prioritized across UC. There was also concern about the rights of inventors' heirs, successors, or assigns, since they were previously named explicitly as alternative beneficiaries of royalties, but now are not. This is another decision that may be determined locally, but explanation was not given as to why this was removed in the systemwide policy.

The responses from the Divisional Committee on Academic Information Technology, Committee on Faculty Welfare, and Committee on Research attached.

Sincerely,

Nancy Grey Postero

Nancy Postero
Chair
San Diego Divisional Academic Senate

ACADEMIC SENATE: SAN DIEGO DIVISION
UCSD, LA JOLLA, CA 92093-0002
(858) 534-3640
FAX (858) 534-4528

May 3, 2023

PROFESSOR NANCY POSTERO, Chair
Academic Senate, San Diego Division

SUBJECT: Review of Policy on Inventions, Patents, and Innovation Transfer

Dear Chair Postero,

The Committee on Academic Information Technology met April 12, 2023 and discussed the proposed revision to the Presidential Policy on Inventions, Patents, and Innovation Transfer. The committee was concerned about several aspects of the proposed policy. Most notably, the previous policy earmarked 15% of revenues specifically to campus or laboratory research, whereas the new policy does not explicitly reserve funds for research, but instead uses broader language that provide greater powers to each campus to allocate funds for purposes other than research (which could allow for either more or less than 15% allocated to research, depending on the decision of each campus). Specifically the language in A, below, is replaced with the language in B:

> A. An additional 15% of net royalties and fees per invention shall be allocated for research-related purposes on the inventor's campus or Laboratory.
>
> B. Bayh-Dole regulations require the University uses remaining Net Commercialization Income from Inventions for scientific research, development, and education.

The Committee felt that although individual campuses might create policies that preserve current distribution practices, the centralized policy provides stronger assurances that the research mission of the University will be prioritized.

Relatedly, the new policy will remove language regarding the rights of inventor(s)' heirs, successors, or assigns, who were previously named explicitly as alternative beneficiaries of royalties, but now are not. Again, we understand that now these rights will be determined by individual campuses. And again, the Committee felt that this was not a positive change, and that the previous language was preferable.

The Committee also had questions of clarification:

> 1. The Committee was uncertain how to interpret the expression, “Subject to previous versions of this policy and the University’s contractual obligations”, and wondered what influence previous versions of this policy would have on revenue distributions.
>
> 2. The Committee wondered whether there are any additional UC policies that govern how commercialization income is distributed, that might interact with this new policy. It also wondered which campus-level policies (e.g., at UC San Diego) currently exist that are relevant.

Sincerely,

Dave Barner, Chair
Committee on Academic Information Technology

April 26, 2023

NANCY POSTERO, CHAIR
Academic Senate, San Diego Division

SUBJECT: Systemwide Review of Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer

The Committee on Faculty Welfare (CFW) discussed the proposed changes to the Policy on Inventions, Patents, and Innovation Transfer. While we welcome a simplification in language, we are also concerned about changes that will adversely affect faculty at the University of California. Specifically, members of the committee shared a concern about ambiguity around income distribution (page 4). As proposed changes state that:

> Subject to previous versions of this policy and the University's contractual obligations, the University agrees to pay Inventor(s) 35% of the University's Net Commercialization Income from Inventions. Bayh-Dole regulations require the University uses **remaining Net Commercialization Income from Inventions for scientific research, development, and education**. When two or more Inventors are eligible to receive Net Commercialization Income for the same Invention, each Inventor shares equally, unless all Inventors agree in writing to a different sharing arrangement. The distribution of Net Commercialization Income from non-Invention University IP is determined at the campus or Laboratory level. The DOE Laboratory may establish separate royalty distribution formulas, subject to approval by the President.

As noted in the highlighted text, the new language in the policy gives greater discretion to "the University" in allocating invention-related income for scientific, development, and education. In this wording, it is unclear if income generated in campus A is controlled by campus A or by the Regents of the University of California (formally, "the University" in most policy documents). It is also unclear if this change, even with the proviso of the paragraph that this is "subject to previous versions of this policy", will affect the invention-related income that laboratories and units receive from the fruits of the work. Previous language made explicit the fact that income from royalties would be returned to the laboratories of the inventors ("An additional 15% of net royalties and fees per invention shall be allocated for research-related purposes on the inventor's campus or Laboratory"). That this is now largely unspecified in the current version is a cause of concern. This is an important incentive for innovation and commercialization, and it would be incorrect to create opacity around how such incentives work.

Sincerely,

Juan Pablo Pardo-Guerra, Chair
Committee on Faculty Welfare

cc: J. Hildebrand

ACADEMIC SENATE: SAN DIEGO DIVISION, 0002
UCSD, LA JOLLA, CA 92093-0002
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April 27, 2023

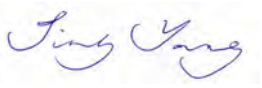
NANCY POSTERO, Chair
Academic Senate, San Diego Division

SUBJECT: Review of Presidential Policy on Inventions, Patents, and Innovation Transfer

The Committee on Research (COR) discussed the proposed revisions to the Presidential Policy on Inventions, Patents, and Innovation Transfer at their April 13, 2023 meeting. The Committee endorsed the proposed revisions, noting that the revisions appear benign, including updating language and decentralizing authority for some actions from UCOP to the individual campuses. The shift to campuses having approval authority was viewed as a positive revision that would allow the campuses to act swiftly on matters related to patents and inventions. COR members look forward to learning of any revisions to UC San Diego's policy and practices in the wake of the proposed UC policy.

We thank you for the opportunity to provide feedback on the proposed revisions to the Presidential Policy on Inventions, Patents, and Innovation Transfer.

Sincerely yours,



Jing Yang, Chair
Committee on Research

cc: G. Fuller
J. Hildebrand
L. Hullings
J. Lucius

UCSF Academic Senate

http://senate.ucsf.edu

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https://senate.ucsf.edu

Steven W. Cheung, MD, Chair
Steve Hetts, MD, Vice Chair
Thomas Chi, MD, Secretary
Kathy Yang, PharmD, Parliamentarian

May 16, 2023

Susan Cochran
Chair, Academic Council
Systemwide Academic Senate
University of California Office of the President
1111 Franklin St., 12th Floor
Oakland, CA 94607-5200

Re: Systemwide Review of Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Susan:

The San Francisco Division of the Academic Senate appreciates the opportunity to comment on the systemwide review of proposed Presidential Policy on Inventions, Patents, and Innovation Transfer, which was updated to improve innovation transfer and entrepreneurship to adapt to current business needs. UCSF's Committee on Research (COR) and the Committee on Faculty Welfare (CFW) provided comments.

First, COR recommends more precise definition of scope of University employment for University intellectual property (IP):

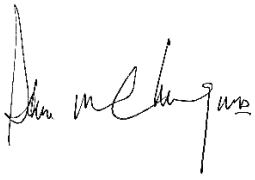
> *All Intellectual Property created: 1) within the course or scope of University employment, 2) using University Research Facilities, or 3) using gifts, grants, or contracts received by or through the University.*

When a UC professor creates an invention while on sabbatical at a different institution, it would be helpful to know whether the IP belongs to UC or another university, or both institutions.

Second, COR asks for clarification of *Net Commercialization Income,* which encompasses gross income received in consideration for a license or option. In certain transactions, UC takes an equity stake for a reduced up-front payment. It is unclear how proceeds from selling that equity is handled under the current definition.

Finally, CFW recommends referencing existing reports or resources that provide information on the value of the University's IP to the policy summary, i.e., the number of issued and licensed patents and UC costs and revenue.

Thank you for the opportunity to opine on the revisions to this important policy. If you have any questions, please let me know.



Steven W. Cheung, MD, 2021-23 Chair
UCSF Academic Senate

Enclosures (2)
Cc: Penny Brennan, Chair, UCSF Committee on Research
Jenny Liu, Chair, UCSF Committee on Faculty Welfare

UCSF Academic Senate

https://senate.ucsf.edu

Committee on Faculty Welfare
Jenny Liu, PhD, MPP, MA, Chair

May 11, 2023

Steven Cheung, MD
Division Chair
UCSF Academic Senate

Re: Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer Systemwide Review

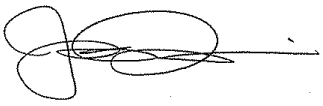
Dear Chair Cheung:

The Committee on Faculty Welfare (CFW) writes to comment on the Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer that is out for systemwide review.

CFW recommends the policy summary include a reference to any existing report or resource on the value of the University's intellectual property, such as the number of issued and licensed patents and UC costs and revenue related to intellectual property. If this information is available, CFW believes it would be helpful to reference that information. Not only would it provide context for the policy and a sense of the scope of the University's intellectual property, but CFW believes it would also be good for morale for faculty to see how much their innovation provides value to the University.

Thank you for the opportunity to comment on this review. Please contact me or our Senate analyst Kristie Tappan if you have questions about CFW's comments.

Sincerely,



Jenny Liu, PhD, MPP, MA
Committee on Faculty Welfare Chair

UCSF Academic Senate

http://senate.ucsf.edu

Communication from the Academic Senate Committee on Research

Penny Brennan, PhD, Chair

April 13, 2023

TO: Steven Cheung, Chair, UCSF Division of the Academic Senate

FROM: Penny Brennan, Chair, UCSF Committee on Research

CC: Todd Giedt, Executive Director, UCSF Academic Senate Office

RE: Second Systemwide Review of the Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Chair Cheung:

The Committee on Research (COR) writes to comment on the Systemwide Review of the Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer. COR is supportive of shifting UCOP's authority over intellectual property to campuses and expanding the policy's scope. The Committee also appreciates the efforts to remove outdated procedural details. Thus, COR primarily writes to express support for the new policy. However, COR members would like to suggest two changes to improve the policy's clarity.

(1) The policy defines University IP as "all Intellectual Property created: 1) within the course or scope of University employment, 2) using University Research Facilities, or 3) using gifts, grants, or contracts received by or through the University." COR thinks that it would be useful to define the scope of University employment more precisely, as employment can take several forms. For example, it is not clear whether this policy applies to faculty on sabbatical at another institution or entity. In other words, if a UC professor develops an invention while on sabbatical at the University of Oxford, for example, it is not immediately clear whether the intellectual property belongs to UC, the University of Oxford, or both institutions.

(2) The definition of Net Commercialization Income refers to gross income received in consideration for a license or option. UC often asks for equity in a company in exchange for a reduced up-front payment. Thus, it would be helpful to explain whether the gross income received in consideration for a license or option includes the proceeds from selling that equity.

Thank you for the opportunity to comment on this important issue. If you have any questions on the Academic Senate Committee on Research's comments, please contact me or Academic Senate Analyst Liz Greenwood (liz.greenwood@ucsf.edu).

UC SANTA BARBARA

Academic Senate
Susannah Scott, Chair
Shasta Delp, Executive Director

1233 Girvetz Hall
Santa Barbara, CA 93106-3050
http://www.senate.ucsb.edu

May 17, 2023

To: Susan Cochran, Chair
Academic Senate

From: Susannah Scott, Chair
Santa Barbara Division

Re: Systemwide Review of the Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer

The Santa Barbara Division distributed the Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer to the Council on Planning and Budget (CPB), Council on Faculty Welfare, Academic Freedom, and Awards (CFW), Graduate Council (GC), Committee on Research Policy and Procedures (CRPP), and the Faculty Executive Committees (FECs) of the College of Letters and Science, College of Engineering, Gevirtz Graduate School of Education (GGSE), Bren School of Environmental Science and Management (BREN) and the College of Creative Studies (CCS). CFW, CRPP, BREN, and CCS opted not to opine. All of the individual reviewing group responses are attached for your consideration.

The response to the proposed revisions was mixed. While CPB and GC support the proposed updates, the COE FEC does not, and the L&S FEC notes that it does not feel equipped to comment in a substantive way. The COE FEC finds the proposed revised policy to be too ambiguous for both students and project investigators. The committee makes a number of specific recommendations aimed at clarifying the policy. It also raises strong objections to several instances of struck language in the current iteration regarding income distribution and royalties, which it believes it is critical to restore.

Also, while several groups agree with the decision to shift authority and discretion for innovation transfer and entrepreneurship-related activities to the campuses, there is some concern about the associated resource implications, in particular, the potential impact on faculty and staff workload.

We thank you for the opportunity to comment.

UNIVERSITY OF CALIFORNIA
ACADEMIC SENATE
SANTA BARBARA DIVISION
Council on Planning & Budget

April 21, 2023

To: Susannah Scott, Divisional Chair
UCSB Academic Senate

From: James Rawlings, Chair
Council on Planning & Budget

Re: Policy on Inventions, Patents, & Innovation Transfer

The Council on Planning & Budget has reviewed the proposed revisions to the Policy on Inventions, Patents, & Innovation Transfer, an updated Systemwide policy which formerly focused exclusively on patents. In addition to expanding the scope of the document to cover many types of intellectual property, the revised version also removes outdated procedural details and delegates significant authority over intellectual property from UCOP to the individual campuses.

In the view of the Council on Planning & Budget, the new policy as drafted by the Research Policy Analysis and Coordination Unit succeeds in its goals. The new language is much more tailored to the modern context and the variety of forms that intellectual property can take outside of the patent system. And by shifting the authority to craft exceptions to the individual campuses, it creates a system that can be flexible and responsive to special circumstances. CPB views the proposed document as a welcome and sensible update to an outdated policy.

cc: Shasta Delp, Academic Senate Executive Director

Academic Senate
Santa Barbara Division

May 10, 2023

To: Susannah Scott, Divisional Chair
Academic Senate

From: Michelle O'Malley, Chair
Graduate Council

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

At its meeting on May 8, 2023, Graduate Council reviewed the proposed Presidential Policy on Inventions, Patents, and Innovation Transfer. The Council is in favor of the policy updates and has the following comments.

The Council agrees that the individual campuses should have sole authority and discretion to execute these matters as every UC campus differs greatly. Members of the Council would like to stress the importance of making sure graduate students receive the reasonable credit they deserve when it comes to inventions and patents involving their research projects.

CC: Shasta Delp, Executive Director, Academic Senate

UC SANTA BARBARA

Faculty Executive Committee
College of Letters and Science

April 11, 2023

To: Susannah Scott
Chair, Divisional Academic Senate

From: Jeffrey Stopple
Chair, L&S Faculty Executive Committee

Re: Proposed Systemwide Policy – Inventions, Patents, and Innovation Transfer

At its meeting on April 6, 2023, the Faculty Executive Committee of the College of Letters and Science (FEC) reviewed the proposed policy on Inventions, Patents, and Innovation Transfer. The policy constitutes updates to existing language, and includes a shift of intellectual property authority from UCOP to individual local campuses, an expansion of scope to include unpatentable innovations, and various adjustments removing outdated language.

The committee by and large did not feel equipped to comment on the proposed policy, feeling that critical analysis of these changes would best be left to Senate committees with more expertise in intellectual property and patent processes. However, one general concern raised that did not appear to be addressed in the policy was how campus resources would be impacted by this newly assigned responsibility over innovation transfer in intellectual property related decisions. It is not clear to the committee whether such responsibility could generate a significant burden on top of existing staff/faculty time.

Thank you for the opportunity to comment.

cc: Pierre Wiltzius, Executive Dean of the College and Dean of Science
Michael Miller, Interim AVC and Interim Dean of Undergraduate Education
Charlie Hale, Dean of Social Sciences
Daina Ramey Berry, Dean of Humanities and Fine Arts

May 12, 2023

TO: Susannah Scott
Divisional Chair, Academic Senate

FROM: Steven DenBaars, Chair
College of Engineering, Faculty Executive Committee

RE: Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer

The College of Engineering FEC met on Monday, April 10th and Monday, April 24th and reviewed the proposal. The committee has a number of concerns and does not support the proposal as currently written.

Committee members voiced the following concerns:

- Generally, the policy is too ambiguous, both for students and project investigators.
- Regarding section III. Policy Text, C. Income Distribution:
  - The policy does not define "non-invention". Non-invention could mean specialized knowledge, trade secrets, etc. It is important that this be specifically defined.
    - If "non-invention" is not specifically defined, the committee recommends that the following sentence be removed from the policy: "The distribution of Net Commercialization Income from non-Invention University IP is determined at the campus or Laboratory level."
  - The committee is strongly against omitting the old policy language regarding Income Distribution.
    - Omitting the clause providing an exception to inventions associated with consulting work would be detrimental to relationships with partnering companies who independently sponsor research and engage faculty as expert consultants.
- The policy should address who is responsible for paying patent costs and what the mechanism is for payment. The committee understands that patent funding experiences vary from campus to campus but some baseline procedures should be specified.
- The following sentence was removed in the proposed policy: "An additional 15% of net royalties and fees per invention shall be allocated for research-related purposes on the inventor's campus or Laboratory" (formerly section III. Policy Text, A.). The committee believes this statement should be restored and followed. Committee members noted they do not feel royalties have been returned to the appropriate laboratories in recent years.
- Regarding section V. Procedures, C. Income: The proposal states, "In the event of any significant future expense such as litigation, actual or imminent, or any other action to protect patent rights, the University may withhold distributions to cover costs until resolution of the matter." The committee does not believe it is right to withhold individual income based on *imminent* litigation as this leaves too much uncertainty. Instead, the committee recommends that a

common fund be established to protect the university from possible litigation. Removal of the words “or imminent” from the sentence is recommended.

UC SANTA BARBARA

Faculty Executive Committee
Gevirtz Graduate School of Education

May 12, 2023

To: Susannah Scott, Chair
Academic Senate

From: Ty Vernon, Chair
Faculty Executive Committee, GGSE

Re: Policy on Inventions, Patents, and Innovation Transfer

The Faculty Executive Committee of the Gevirtz Graduate School of Education has reviewed the proposed Policy on Inventions, Patents, and Innovation Transfer and is in support of transferring UCOP's authority over intellectual property to the individual UC campuses and updating the previous policies.

Ty Vernon, Ph.D.
Faculty Executive Committee Chair
Gevirtz Graduate School of Education
UC SANTA BARBARA

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1156 HIGH STREET
SANTA CRUZ, CALIFORNIA 95064

Office of the Academic Senate
SANTA CRUZ DIVISION
125 CLARK KERR HALL
(831) 459 - 2086

May 17, 2023

Susan D. Cochran, Chair
Academic Council

RE: Systemwide Review of Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Susan,

The Santa Cruz division of the Academic Senate has completed its review of the proposed Policy on Inventions, Patents, and Innovation Transfer with the Committees on Research (COR), and Privilege and Tenure (CPT) responding.

CPT noted a lack of clarity and precision in the definition of University Intellectual Property (IP). The first clause in the definition of University IP in the draft policy refers to the "course *or* scope of employment" (emphasis added). The Committee observed that this differs from the Patent Acknowledgement Form that all faculty sign as a condition of employment, where the wording is "course *and* scope of employment" (emphasis added). The first clause would appear to cover more ground since only "course" or 'scope" needs to be met for the proposed clause to be true. For consistency with the Patent Acknowledgement Form, CPT proposed that the conjunction should be "and."

CPT is also noted the absence of descriptive language for the term "scope." A faculty member's field, and therefore the scope of their employment, are not clearly defined. Nor are their working hours or course of employment. The University should either delineate the boundaries of this clause clearly in the policy, or cite a supplementary document with sufficient examples.

Both CPT and COR noted the removal of the following language from the proposed amended policy: "An additional 15% of net royalties and fees per invention shall be allocated for research-related purposes on the inventor's campus or Laboratory" (page 4). CPT wonders if this signifies that the campus is assigned the full 65% of net royalties and fees (not paid to the Inventor), and is free to use all these funds for non-research purposes? COR is curious to know if this 15% will remain at the inventor's campus, or does it go elsewhere? If it remains at the inventor's campus, is it still earmarked to support research?

Finally, COR would like to know how software Intellectual Property (IP) is treated under the new policy. The software IP landscape is very different from that of other forms of inventions, they observe, and may be worth treating separately if the University does not already do so.

On behalf of the Santa Cruz division, I thank you for the opportunity to comment on this proposed policy.

Sincerely,

P. Gallagher

Patty Gallagher, Chair
Academic Senate, Santa Cruz Division

encl: Senate Committee Responses (Bundled)

cc: Michael Hance, Chair, Committee on Research (COR)
Onuttom Narayan, Chair, Committee on Privilege and Tenure (CPT)
Matthew Mednick, Director, Academic Senate

April 14, 2023

PATTY GALLAGHER, Chair
Academic Senate, Santa Cruz Division

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

Dear Patty,

Thank you for the opportunity to provide input on the Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer. The Committee on Research has two questions about the proposed changes to the policy.

First, the new policy removes the 15% allocation to the campus or laboratory. Does this 15% still remain at the inventor's campus, or does it go elsewhere? Is it still earmarked to support research?

Second, we have a more general question about how software IP is treated under UC policy. The software IP landscape is very different from that of other forms of inventions, and may be worth treating separately (if it is not already).

Sincerely

Michael Hance

Michael Hance, Chair
Committee on Research

cc: Roger Schoenman, Chair, Committee on Academic Freedom (CAF)
Stefano Profumo, Chair, Committee on Academic Personnel (CAP)
Steven Ritz, Chair, Committee on Career Advising (CCA)
Alexander Sher, Chair, Committee on Faculty Welfare (CFW)
Abraham Stone, Chair, Committee on Library and Scholarly Communication (COLASC)
Onuttom Narayan, Chair, Committee on Privilege and Tenure (CPT)
Eleonora Pasotti, Chair, Committee on Rules, Jurisdiction, and Elections (CRJE)

March 21, 2023

PATTY GALLAGHER, Chair
Academic Senate, Santa Cruz Division

RE: Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer

Chair Gallagher,

Thank you for the opportunity to provide input on the Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer. The Committee on Privilege and Tenure (P&T) has two primary areas of concern it would like to recommend be clarified before the policy is finalized.

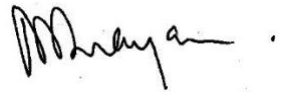
The first clause in the definition of University IP in the draft policy refers to the "course or scope of employment". This differs from the Patent Acknowledgement Form that all faculty sign as a condition of employment, where the wording is "course and scope of employment." Since "or" must cover more ground than "and", at a minimum, the wording of the policy should be changed to "and".

More broadly, we are unsure how expansively this provision in the policy — and in the Patent Acknowledgement Form — would apply to faculty. A faculty member's field, and therefore the scope of their employment, are not clearly defined. Nor are their working hours or course of employment. What situations does the University wish to capture with this clause that are not covered by the second and third clauses defining University IP? For instance, is IP that is created as a consultant at a company (consistent with APM 025), or when a faculty member is not being paid by the University (e.g. for a 9-month employee not earning a University salary during the summer), or is on sabbatical leave, included in University IP? How is one to interpret "scope"? The University should either delineate the boundaries of this clause clearly in the policy, or cite a supplementary document with sufficient examples. On the other hand, if this clause does not add anything significant to the other two clauses, the University should consider deleting it.

As a related point: does the obligation to promptly report and *fully* disclose (emphasis added) all inventions to the University include inventions that are clearly or probably not University IP?

P&T also notes that the line "An additional 15% of net royalties and fees per invention shall be allocated for research-related purposes on the inventor's campus or Laboratory" (page 4) has been deleted from the previous version. Essentially, 15% has disappeared in the policy, but it is not flagged in the policy that it was reallocated to some other purpose. Does this signify that the campus is assigned the full 65% of net royalties and fees (not paid to the Inventor), and is free to use all these funds for non-research purposes? If not, more detail is needed.

Sincerely,



Onuttom Narayan, Chair
Committee on Privilege and Tenure

cc: Roger Schoenman, Chair, Committee on Academic Freedom
Stefano Profumo, Chair, Committee on Academic Personnel

Steven Ritz, Chair, Committee on Career Advising
Alexander Sher, Chair, Committee on Faculty Welfare
Abraham Stone, Chair, Committee on Library and Scholarly Communication
Michael Hance, Chair, Committee on Research
Eleonora Pasotti, Chair, Rules, Jurisdiction and Elections
Matthew Mednick, Executive Director, Academic Senate

UNIVERSITY COMMITTEE ON RESEARCH POLICY (UCORP)
Cynthia Schumann, Chair
Email: cschumann@ucdavis.edu

University of California
Academic Senate
1111 Franklin Street, 12th Fl.
Oakland, California 94607

May 17, 2023

SUSAN COCHRAN
CHAIR, ACADEMIC COUNCIL

RE: Proposed Presidential Policy on Inventions, Patents, and Innovation Transfer

Dear Susan,

UCORP appreciates being involved in the drafting of the revision of the UC Patent Policy, which was last updated in 1997. The UCOP staff responsible for the new **Presidential Policy on Inventions, Patents, and Innovation Transfer** consulted with UCORP throughout the drafting process. I am writing to convey UCORP's overall support for the new policy, which is a clear and concise revision of the current policy.

Some specific comments, which will likely also be sent to you via campus channels, included questions about the definition of Intellectual Property (specifically, UC does not hold trade secrets), concerns around the elimination of specific percentages for royalty distribution, and a lack of clarity around situations of joint-ownership and partnerships with non-UC entities. Although the UC Patent Acknowledgement clearly states that patent assignment does not apply to inventions that employees develop on their own time without use of university facilities, it might alleviate some anxiety to include that statement in the Policy as well. Some UCORP members noted that the administration could do more to help faculty with royalty disbursements; delays and lack of information have become chronic problems on some campuses. UCORP thought that accompanying guidance in the form of an FAQ will be very useful.

We thank you for the opportunity to comment on this policy.

Sincerely,

Cynthia Schumann
Chair, University Committee on Research Policy

UNIVERSITY OF CALIFORNIA, ACADEMIC SENATE

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UNIVERSITY COMMITTEE ON ACADEMIC COMPUTING
AND COMMUNICATIONS (UCACC)
Matthew Bishop, Chair

ACADEMIC SENATE
University of California
1111 Franklin Street, 12th Floor
Oakland, California 94607

April 28, 2023

SUSAN COCHRAN
CHAIR, ACADEMIC SENATE

Dear Susan,

The University Committee on Academic Computing and Communications briefly discussed the proposed Presidential Policy on Inventions, Patents, and Innovation Transfer and find no substantive issues. The committee offers the following suggestion for clarifying the definition of Intellectual Property:

> **Intellectual Property:** ~~b~~Broadly defined to include inventions, discoveries, developments, improvements, systems, methods, processes, and materials, and copyrightable works retained by the University under the Copyright Ownership Policy or Ownership of Course Materials Policy. ~~For the avoidance of doubt, Intellectual Property excludes scholarly and aesthetic works transferred to academic authors under the Copyright Ownership Policy.~~
>
> Intellectual Property includes legally recognized rights in patents, registered or unregistered copyrights, registered or unregistered trademarks, service marks, trade secrets, and plant variety protection certificates. It also includes the physical embodiments of intellectual effort, for example, models, organisms, machines, devices, designs, apparatus, instrumentation, circuits, biological materials, chemicals, other compositions of matter, and plants. Future advances in science and the arts may result in new structures for intellectual property protection and they also fall within this policy.
>
> **This policy specifically excludes Intellectual Property rights in scholarly and aesthetic works that are transferred to academic authors under the Copyright Ownership Policy**.

Sincerely,

Matt Bishop, Chair
University Committee on Academic Computing and Communications