I. Purpose

This section provides the policies and procedures for disclosing and managing potentially patentable inventions, and for arranging the transfer of research materials between UC Davis and other organizations.

II. Definitions

Additional definitions are provided in Business and Finance Bulletin (BFB) G-40.

A. Confidentiality Agreement—a written agreement which defines and limits rights to disclose certain information, which may include Intellectual Property. Also known as non-disclosure agreements or secrecy agreements.

B. Intellectual Property—products of the mind which include Patentable Inventions, copyright-protected materials, trade and service marks, and trade secrets. Use of Intellectual Property is controlled by individuals or entities as defined by federal law and University policies.

C. Material Transfer Agreement (MTA)—a written agreement to transfer research materials which may be related to a Patentable Invention, under conditions that maximize opportunities and promote collaborations and new research.

D. Patentable Invention—a new and useful process, device, or apparatus, article of manufacture, composition of matter, chemical compound, microorganism, plant or related improvement, or the new use for a known material or device, which may be protected by a patent.

III. Policy

A. The University retains all patent rights to Intellectual Property resulting from University research or employment.

B. University employees and those using University facilities or funds under the control of the University must promptly disclose the conception or development of potential Patentable Inventions.

C. Although the University seeks fair consideration from licensees, licensing of its Intellectual Property is done primarily to further University’s mission of public benefit through research and education over other considerations such as maximizing license fees and royalty rates, as described in the University Licensing Guidelines. (see V. References and Related Policies.)

D. A Material Transfer Agreement must be completed prior to transfer of research materials into or outside of the University, as research related to the materials can result in Intellectual Property of interest to both the transferor and the recipient.

E. To protect the University’s interests in Patentable Inventions, Technology Transfer Services negotiates and approves Confidentiality Agreements related to Intellectual Property.

IV. Procedures

A. Patent Acknowledgement
Section 250-15
9/15/11

1. At the time of hire, the department must have the employee sign the University’s Patent Acknowledgement.

2. For non-employees (e.g., visitors conducting research on campus, contractors), the department must have the individual sign the Patent Acknowledgement prior to commencing activities on campus.

3. The department chair can grant exemptions to individuals identified in BFB G-40. A form is available on the Technology Transfer website.

4. Requests for other exemptions or changes to the form must be approved by Technology Transfer Services before the individual arrives on campus.

B. Disclosing potential Patentable Inventions

1. Personnel must promptly report any potential Patentable Invention to Technology Transfer Services using the Record of Invention (ROI) form and process on the Technology Transfer website.
   a. The researcher should submit the ROI prior to any public disclosure (e.g., publication in a journal, presentation).
   b. If public disclosure is made prior to submitting the ROI, the researcher must notify Technology Transfer Services as soon as possible.

2. Technology Transfer Services will evaluate the disclosure’s patentability, inventorship, obligations to research sponsors, and distribution channels including commercial licensing potential. The disclosure will be assigned to an Intellectual Property Officer based on the subject discipline.
   a. The Intellectual Property Officer will consult with the inventor(s), research sponsors, legal counsel, and potential licensees to determine the best way to promote the University mission.
   b. Confidentiality Agreements and licensing agreements are negotiated on a case-by-case basis.
   c. All inquiries from individuals outside the University should be referred to the Intellectual Property Officer.

3. A licensing decision review may be necessary to ensure potential conflicts of interest relating to University inventors and licensing companies are managed appropriately.

C. Material Transfer Agreements

1. Submit the Material Transfer Agreement request as far in advance as possible using the process on the Technology Transfer website.

2. Software should not be transferred via MTA (see Section 250-03).

V. References and Related Policies

A. Office of the President


B. UCD Policy and Procedure Manual (http://manuals.ucdavis.edu/)

1. Section 250-03, Use of Copyright-Protected Materials in Teaching and Research.

2. Section 250-04, Distribution of Copyright-Protected Materials Produced under University Auspices.

3. Section 310-65, Use of the University's Name, Seal, and Other Trademarks.

4. Section 380-16, Conflict of Interest.


D. UC Davis Technology Transfer Services website (http://www.innovationaccess.ucdavis.edu/home.cfm?id=OVC,23,1729).

E. UC Davis Disclosure and Record of Invention (ROI) form and process (http://www.innovationaccess.ucdavis.edu/home.cfm?id=OVC,23,1729,1025).

F. UC Davis Material Transfer Request form (http://www.innovationaccess.ucdavis.edu/home.cfm?id=OVC,23,1729,1703,1705).

G. UC Davis copyright website (http://innovationaccess.ucdavis.edu/copyright).