



OFFICE OF THE ASSISTANT VICE CHANCELLOR
OFFICE OF INNOVATION AND COMMERCIALIZATION
(858) 534-5815
(858) 534-7345 FAX
<http://invent.ucsd.edu>

9500 GILMAN DRIVE
LA JOLLA, CALIFORNIA 92093-0910

DATE

NAME

ADDRESS

CITY, STATE ZIP

COUNTRY

Re: Invention Disclosure Title – “_____”, SD_Case # _____ (“Invention”)
Release of Invention

Dear _____:

The University of California, San Diego (“UCSD”) Office of Innovation and Commercialization (“OIC”), is informing you of its decision not to [continue to] pursue a patent application for the above captioned Invention. As the inventor [co-inventors] of the Invention, you are being offered the opportunity to have the Regents of the University of California (“University”) release to you the University’s right, title and interest to the Invention arising from your assignment of rights to the University. You had earlier represented to this office that the Invention was made with no funding from any federal agency. You should retain personal counsel to secure an assessment as to whether ownership of this invention would create risk for you under federal or state law. This agreement is effective on the date of the last signature (“Effective Date”).

Based on your above representations and request, the University agrees to release to you its right, title, and interest to the Invention arising from your assignment of rights to the University subject to the following conditions:

1. You affirm that you have disclosed to OIC in writing the following:
 - (a) all third-party sources of funding (including, without limitation, government, private and non-profit sources, and consulting agreements) and all third-party sources of in-kind support, where such funding or support was used in the conception or reduction to practice of the Invention;
 - (b) all third-party sources of data or materials which were used in the conception or reduction to practice of the Invention, where such data or materials were transferred under a restrictive

transfer agreement, including, without limitation, material transfer agreements (MTAs), purchase agreements, or collaboration agreements;
(c) a full and complete description of the Invention and the potential commercial applications or uses of the Invention of which you are aware; and
(d) all data or other information related to the Invention which would be material to a fair and full assessment of the Invention's value.

2. You are being offered this release, but are still subject to compliance with state statutes and regulations governing conflicts of interest, specifically the Political Reform Act of 1974 (the Act). The Act requires public officials to "perform their duties in an impartial manner, free from bias caused by their own financial interests or the financial interests of persons who have supported them." (Gov. Code, § 81001, subd. (b).) You and UCSD affirm that the activities of the respective parties under this agreement have been and will be conducted in the public interest.
3. You agree that making any false, fictitious, or fraudulent statement may, in addition to other remedies available to the government, be subject to civil penalties under the Program Fraud Civil Remedies Act of 1986 (45 CFR Part 79).
4. You agree that no further research or development of the Invention will be conducted, now or in the future, by you or by others at your request using University resources.
5. You agree that the Invention is being released to you "AS IS" as determined by the information and data you disclosed to this office on record, and that the University has not relinquished its right, title and interest to any information or data that you have not previously disclosed to the University under the Invention disclosure.
6. You agree that this release applies only to the Invention and does not relieve you from obligations to the University with respect to other inventions, including improvements and variations of the Invention, now existing or that may arise in the future.

7. You agree to reimburse, via a check made out to "The Regents of the University of California" with Case Number XXXX-XXX in the memo and delivered to OIC, the patent costs incurred and unreimbursed up until the date of this letter. The amount of the reimbursement is \$XXXXXXXX. **[USE IF PAST COSTS ARE OVER \$2,000]**

8. You agree that you have disclosed to OIC any and all (i) companies that you are aware of which now have or previously had an interest in licensing or otherwise acquiring any of the patent rights in Invention; (ii) start-up companies that you have founded, are in the process of founding, or plan to found; and (iii) companies in which you and/or your immediate relatives own or have the right to acquire equity (other than via an individual retirement account or pooled funds such as mutual funds) that exceeds 3 percent of the company's total equity or exceeds a value of \$10,000.
9. You hereby agree not to license or assign any of the rights in the Invention to any company falling within categories 8(i), 8(ii) or 8(iii) above which was not disclosed to the OIC on or before the Effective Date, as required above, unless OIC has first consented to such license or assignment in writing. In the event that such consent is necessary, or in the event of a breach of any warranty herein by you, UCSD may require you, as a condition of such

consent, to make payments to the University, as represented by the OIC, in the same manner as such company would have reasonably made to the University if this assignment had not been made, and such license or assignment to such company had been made by UCSD.

10. You agree to file a [regular, non-provisional patent application that claims priority to the provisional patent application referenced above][provisional patent application], or, if said application has already been filed, you agree to prosecute and maintain such patent application and all continuing applications thereof; any patents issuing on said applications including reissues, reexaminations and extensions; and any corresponding foreign applications or patents. You must not abandon any such patent rights except when maintaining appropriate continuing applications, unless either the OIC has first consented to such abandonment or you have offered to transfer title to the invention and prosecution of the application to the University.
11. You agree to provide OIC a copy of each of the patents that may issue on the Invention within one hundred and twenty (120) days of issuance.
12. You understand and agree that UC will retain a shop right and a fully paid-up, royalty-free license to do any one or more of the following activities:
 - a. publish or otherwise disseminate any technical data resulting from research performed by University relating to the Invention;
 - b. make, have made, use and import the Invention for educational and research purposes (including, but not limited to, clinical trials); and
 - c. allow other educational and non-profit institutions to do any of the activities above, for educational and research purposes.
13. With respect to any obligations concerning the Invention owed by the University to third parties (sponsors or otherwise), you agree that you are responsible for such obligations as of the Effective Date and you agree to fulfill any such obligations, including without limitation obligations under MTAs, inter-institutional agreements, confidentiality agreements, research agreements, collaboration agreements and purchasing agreements.
14. You will indemnify the University for any costs or liability related to or resulting from the patenting or marketing of the Invention after the date of this agreement, and for all activities under this agreement.
15. Inventor hereby agrees to pay to the University fifteen percent (15%) of Financial Benefit, where "Financial Benefit" means any and all forms of value and consideration which inventor may realize, directly or indirectly through others, (i) from the commercial exploitation of patent rights; (ii) possession, use, sale, manufacture or import of Invention; or (iii) grant of or forbearance to grant sublicenses. For any Non-Cash Consideration (as defined below) the fair market cash value of such Non-Cash Consideration, calculated at the time of the transaction shall be paid. "Non-Cash Consideration" shall mean any consideration other than cash, including but not limited to stock, LLC membership interests, or interest in a partnership, for transactions related to the Invention or this Agreement.

Please acknowledge the above conditions by your signature(s) below and return this letter to my attention. This offer shall automatically lapse if not accepted by signature(s) below, including

concurrences by your Department Chair and Dean, and returned to this office within thirty (30) days from the date of this letter.

Good luck with your endeavor.

Sincerely,

Jane C. Moores, Ph.D.
Assistant Vice Chancellor

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Accepted by: _____
(Signature)

Name: _____

Date: _____

[REPEAT AS NECESSARY FOR ALL INVENTORS]

Concurrence: _____
(Dept. Chair Signature)

Name: _____

Date: _____

Concurrence: _____
(Dean Signature)

Name: _____

Date: _____

Concurrence: _____

(Vice Chancellor Signature)

Name: _____

Date: _____