



CALIFORNIA INSTITUTE OF TECHNOLOGY STAFF PERSONNEL MEMORANDA

SUBJECT PATENT POLICY	MEMO NO. <u>17</u>
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	DATE <u>3/13/2007</u>
Approved by: Julia M. McCallin, Associate Vice President for Human Resources	

(This supersedes Memo No. 17, dated 4/1/2003)

Inventions made by employees in the line of Institute duty or with the use of Institute facilities may be patented in order to protect and benefit the Institute and the public. Title to such patents is to be assigned to the Institute or, if appropriate, the sponsor. The cost of acquisition of such patents shall in no instance be borne by the employee.

It is the policy of the Institute that such patents be used for the public benefit. If there are innovations or discoveries that result in the filing of patent applications and the acquisition of patents, the Institute intends to serve the public interest by prudent and appropriate efforts to transfer the technology to those who will facilitate public use. When this result is achieved by the licensing of an invention or patent, income and/or equity may accrue to the Institute under terms negotiated at the Institute's discretion.

Where income is derived from such licensing, the inventor or inventors, collectively, will receive 25% of the income received by the Institute after the deduction of 1) unreimbursed external expenses associated with obtaining, maintaining, licensing and/or enforcing the patent or rights associated with the invention; and 2) the share of the income owed by Caltech to a third party pursuant to an income-sharing agreement between Caltech and the third party. In the event of multiple inventions in a license agreement, each inventor shall receive a proportion of that income according to Caltech internal procedures.

Where equity is derived from such licensing, the Institute will make no distribution of equity to inventors, but will make the distribution set forth in the previous sentence from the proceeds of the orderly sale of the securities at such times and in such amounts as determined in the sole discretion of the Institute in accordance with Institute policy, after the further deduction of brokerage and related expenses incident to the sale of the securities.

Inventors may opt, by means of a charitable donation to the Institute, to have all or any part of their share of the net income to be applied to support research of their choosing within the Institute. The Institute will then match the amount contributed by the inventor for the research, on a dollar-for-dollar basis, so as to provide total research support from such income up to 50% of the net income received by the Institute. Inventors who elect to contribute may subsequently elect instead to retain their share of the net income from future royalties.

The remainder of the income derived by the Institute from the licensing of patents, after payment of the inventor(s)' shares will be applied to the furtherance of instruction and research. The Institute retains the right not to pursue the filing of any patent application, and not to pursue commercialization of any invention. In that event, the Institute may choose to assign the patent rights to the inventor(s) if that is consistent with its legal obligations.

All Institute employees shall sign a Patent and Copyright Agreement assigning their rights to patents or inventions that they may make in the line of their duties, or with any use of Institute facilities, to the Institute or, if appropriate, its sponsor. A copy of the agreement may be obtained from Human Resources or the Faculty Records Office.

Individuals who work on governmental or industrial projects undertaken by the Institute are required to sign such supplemental agreements as are necessary to enable the Institute to fulfill its contractual obligations in regard to patents.

All employees shall report to the Institute immediately any innovation or discovery that might reasonably be considered to be of a patentable nature and that arises in the line of their duties, or as the result of any use of Institute facilities. This obligation is not intended to interfere with the prompt publication of research results.

Inventions made by employees or students outside the line of Institute duties on the inventor's own time without any use of Institute facilities are not the property of the Institute. Patents from such inventions should be administered so as not to involve the Institute name.

It is important that inventors disclose to the Institute any funding from an agency of the United States Government that may relate to inventions. The Federal Bayh-Dole Act and implementing regulations (37 C.F.R. 401) grants patent rights to the Institute for inventions made under most federally funded research. In return, the Institute has reporting obligations regarding such inventions to the funding agency, and must grant a license to the government for its own use.

Any dispute concerning this policy or the distribution of royalties shall be resolved by appeal to the Provost.

The Institute places no restrictions on the rights or activities of Postdoctoral Scholars and Research Faculty in their subsequent careers after they leave Caltech. If departing Research Faculty or Postdoctoral Scholars require access to research data, computer programs, material samples, biological specimens or other research materials that they helped develop while at Caltech, the Institute will negotiate with them to provide continuing reasonable access to such materials, appropriate to the circumstances and consistent with its legal requirement to maintain originals of data and other results arising from sponsored research.