



OFFICE OF INTELLECTUAL PROPERTY & INDUSTRY SPONSORED RESEARCH
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www.research.ucla.edu/oipa

[DATE]

[STAFF OR FAULTY MEMBER]

[DEPARTMENT]

[ADDRESS]

RE: Terms for Obtaining Release of an Invention during Permissible Consulting with [COMPANY]

Dear [STAFF OR FAULTY MEMBER]:

On [DATE] the UCLA Office of Intellectual Property and Industry Sponsored Research received your request to receive a tentative assurance that inventions conceived and reduced to practice during your consulting with [COMPANY] for a specified scope of work “[SCOPE OF WORK]” (Appendix A) be released to you. You, and Professor [DEPARTMENT CHAIR], Chair of [DEPARTMENT], state that the scope of work is distanced and separate from that of your teaching and research at UCLA (Appendix B). It is recognized that in the future you may choose to extend your University activities outside of the scope of work described in Appendix B.

Please remember that a consulting agreement is a personal agreement between you and the company and that UCLA is not a party to that agreement. Please also remember that, as an employee of the University of California, you have pre-existing obligations to disclose all inventions to UCLA’s Office of Intellectual Property. If and when an invention is developed under the consulting agreement, you must file an Invention Report (“Disclosure”) and attach a copy of this letter plus a letter asserting that the Disclosure was not:

- i) developed using gift, grant or contract research funds administered through the university;
- ii) developed using university research facilities (i.e. laboratory equipment, reagents, materials – a desk/computer is usually considered *de minimus* or insignificant for the purposes of triggering ownership);
- iii) created within the course and scope of university employment.

We will review your Disclosure and will forward a confirmatory “non-Assertion” letter if it meets the above-mentioned criteria.

We understand that [COMPANY] may desire rights to inventions made during your consulting. Provided that the Invention falls within the scope of work described in Appendix A and meets the criteria stated in i, ii, and iii above, including being outside of your scope of work for the University, which as of this date of this letter is described in Appendix B, The Regents will disclaim patent rights or rights in copyright to your contribution in the Disclosure.

This disclaimer will be limited to the data disclosed by you and contained in the Disclosure and cannot be interpreted to cover future and/or related developments. Any such development would require a separate disclosure and separate review. Further, the disclaimer relates only to rights the University of California may have had in the Disclosure and does not relate to intellectual property rights of any third parties, including those of the U.S. Government. If such rights exist, it is your responsibility to seek disclaimers/waivers from such third parties in addition to this disclaimer.

Please sign below to acknowledge your acceptance of the terms of this agreement, obtain the signature of your department chair, and return two sets of all original signatures to OIP. One set of original signatures will be returned for your records upon execution by The Regents.

[INSERT SIGNATURE BLOCKS]

-----ATTACHEMENTS-----

APPENDIX A

Scope of Work for the Consulting Agreement
“[SCOPE OF WORK]”

[Completely and fully describe the work to be completed under the consulting agreement. Provide background details as necessary]

APPENDIX B

Scope of Employment for UCLA

[Describe **all** teaching and research activity at UCLA. Provide details as necessary. A list of courses taught, previous and ongoing research projects, and relevant publications is required.]

SAMPLE