

SALK INSTITUTE FOR BIOLOGICAL STUDIES

PATENT AND INVENTION POLICY

Effective July 1, 2010

1. GENERAL POLICY AND OBJECTIVES

One of the primary objectives of the Salk Institute for Biological Studies (the "**Institute**") is to promote the wide dissemination to the general public of the results of scientific research carried out at the Institute. This objective is generally realized through prompt publication of research results through the usual academic channels. The Institute makes every effort to encourage such publication.

The Institute, of course, realizes that inventions or discoveries may result from the activities of Institute employees in the course of their research duties or through their use of Institute resources such as facilities, equipment, space, services, supplies, funds, etc. It is the Institute's policy that such inventions or discoveries will be administered in a manner so that they may be brought into practical use for the public benefit at the earliest possible time. To implement this policy, the Institute endeavors to encourage and facilitate technology transfer by all means appropriate to an institution supported by public and private funds, being cognizant of the respective interests of the Institute, the Institute's research sponsors, the inventors and the public. Such implementation generally involves the filing of worldwide patent applications on such inventions and the subsequent licensing of the resultant patent rights.

The Institute respects the proprietary nature of information and materials that are protected by intellectual property rights. The use or disclosure of such protected property of other organizations and individuals requires proper authorization from the rightful owner. Thus, it is the policy of the Institute that employees not use proprietary materials of others or disclose proprietary information of others for Institute activities and not maintain proprietary materials of others at Institute facilities without obtaining the required authorization.

The Institute will endeavor to implement its policy with respect to inventions or discoveries in a manner so as not to interfere with or delay the prompt publication of the results of the research involved.

2. DEFINITIONS

Throughout this policy, the terms listed in this section will have the following definitions:

- (a) **Invention.** For purposes of this policy, an invention includes every possible discovery, finding, method, formula, process, technique, procedure, system, product, device, apparatus, machine, design, article of manufacture, composition of

matter (including but not limited to chemical compounds, proteins, (e.g., antibodies), nucleic acids, vectors (e.g., plasmids or viral vectors), cells or cell lines, microorganisms, plants, animals, and the like), codes, computer programs, or a new use for, or improvement of, any of the above, whether patentable or not, which is conceived, developed, made, produced, or reduced to practice by an Institute employee (or a visiting scientist who carries out research work at the Institute), as a result of his (her) work at the Institute, or through the use of any Institute information, facilities or other resources.

- (b) **Inventors.** An invention may be made solely or jointly with others as co-inventors. However, to be recognized legally, a co-inventor must have conceived of or conceived and developed an essential element of an invention or contributed substantially to the inventive concept. However, for patent purposes, an inventor is determined by the claims and thus actual inventors named on a patent application must be determined by patent counsel based on legal criteria.
- (c) **Conception of Invention.** For purposes of this policy, conception of invention means the formation in the inventor's mind of the idea of the invention as it is thereafter to be applied in practice. For legal purposes, inventors must contribute to the conception of an invention.
- (d) **Reduction to Practice.** Reduction to practice of an invention occurs when the inventor's conception of the invention is actually tested in the laboratory or otherwise embodied in such a form as to render it capable of actual use. Individuals other than inventors can contribute to the reduction of practice of an invention.

3. RIGHTS TO INVENTIONS

Except as otherwise specified by the Institute in writing, inventions made by Institute employees or visiting scientists in the course of their research activities at the Institute or resulting from the use of Institute information, facilities or other resources, as well as any patent applications, patents or profit-yielding agreements resulting from such inventions, shall belong to the Institute.

An Institute employee will not be obligated to assign rights to the Institute when the invention qualifies fully under California Labor Code Section 2870 (copy attached as Exhibit A). Under this law, an employee is not obligated to assign any of his or her rights in an invention to his or her employer when the employee developed the invention entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information, except for those inventions that either: (1) relate, at the time of conception or reduction to practice of the invention, to the employer's business, or actual or demonstrably anticipated research or development of the employer; or (2) result from any work performed by the employee for the employer.

Each employee of the Institute, at the time of employment, and as a condition precedent to such employment, and each visiting scientist conducting scientific work at the Institute, as a

condition precedent to being permitted to conduct such work, unless provided an exception in writing by the Institute, shall agree to assign to the Institute, his or her rights to all inventions he or she may subsequently make while working at the Institute or with Institute information, facilities or other resources, as well as to all patent applications, patents and profit-yielding agreements which result from such inventions. Each such person shall further agree, upon the request of the Institute, whether during or after his or her employment at, or visit to, the Institute, to do whatever is required for the Institute to apply for and receive patents on such invention(s) in any and all countries.

The form of agreement which employees are required to execute at the time of employment is attached as Exhibit B to this policy.

The Institute, in consideration of the assignment by an employee or visiting scientist of inventions and resulting patent applications, patents and profit-yielding agreements, will distribute to the employee or visiting scientist, or his, her or their heirs, a percentage of net licensing income in the manner specified under Paragraph 7.

4. DISCLOSURE

As a condition of employment, Institute staff members shall disclose in writing to the Institute, at the time of employment by the Institute, all personally owned inventions previously conceived, reduced to practice, or developed by them as well as all active consulting agreements previously entered into.

Employees, and visitors conducting scientific work at the Institute (unless provided a written exception by the Institute), shall promptly and fully disclose each and every invention made during the period of employment by the Institute, or visit at the Institute, to the Institute's Executive Director, Office of Technology Development (OTD), and describe the circumstances under which the invention was conceived and/or reduced to practice, by properly preparing, executing and submitting the appropriate written Research Disclosure Form (provided by OTD). A sample Research Disclosure Form is attached to this policy as Exhibit C.

In the event of a disagreement between the Institute and any individual concerning rights of any kind in an invention, it shall be the responsibility of such person to demonstrate, to the satisfaction of the President of the Institute or his designee, including for example, an IP Committee, the rights, if any, of such person in such property. The President or his designee will then determine the rights to the invention in accordance with the Institute's current policy. The President or his designee may determine that the Institute has no property interest in the invention because its conception and reduction to practice was unrelated to the individual's work at the Institute or involved only insignificant use of Institute resources.

If an invention or patent has been wrongly assigned to a third party, action may be taken by the Institute, or the research sponsor, to claim rights in such invention.

The OTD shall reward each inventor on any original patent application filed, a pro rata share of \$1000 up to \$250 per inventor.

5. DISPOSITION

The Institute shall have the sole right to determine the disposition of Institute-owned inventions, subject to any prior contractual obligations of the Institute to external sponsors. Such disposition shall be in a manner which, in the judgment of the Institute, is in the best interests of the Institute, its inventors, its research sponsors and the public.

Under United States Government sponsored research, the Government normally grants to the Institute the rights throughout the world in and to any inventions made in the course of or under a grant or contract, but reserves to the Government a royalty-free license, as well as march-in rights if the Institute fails to reasonably pursue development of the invention.

While it is the general objective of the Institute to obtain patents on valuable inventions and discoveries which arise out of the activities of Institute employees or which are developed by the use of Institute resources, this objective must be pursued in a manner consistent with the obligations of the Institute to any sponsor involved subject to written agreements between sponsor and Institute which are reviewed, approved and monitored for compliance by OTD.

The evaluation of inventions, and the selection of those inventions that warrant the filing of patent applications, is a complex task which requires legal, business and scientific judgment. All such evaluations and selections at the Institute shall be made by OTD with advice and assistance from other sources as needed, including, without limitation, any patent committee of the Institute and any designated patent counsel, and when relevant, the sponsor. Any such decisions shall ultimately be made by the Executive Director OTD. If needed, additional review shall be made by the President or his designee.

The Institute will inform inventors, as promptly as practicable following the inventor's submission of a written Research Disclosure Form, as to its decision regarding whether or not it will file a patent application on the disclosed invention. The Institute shall have the absolute right to determine whether it would be in the best interests of the Institute, sponsors, the inventor and the public to file a patent application on the invention, dedicate the invention to the public or, with the approval of any research sponsor or sponsors, to license the patent rights in the invention to the inventor, the license fee being the reimbursement of Institute's patent costs. If a written release of patent rights by a license is granted to an inventor, the Institute shall not be obligated to bear any costs relating to patent prosecution, protection, licensing, or any other costs associated with the invention. Further, the Institute will normally retain a nonexclusive royalty-free license, with the right to sublicense and practice, both only for academic, non-commercial research purposes.

6. LICENSING

In some cases the dedication of an invention to the public or the granting of royalty-free nonexclusive licenses to an invention will best serve the interests of the Institute and the public.

However, in most instances, depending on the particular nature of the invention, the costs involved in transforming the invention into a commercial product or process, the economic potential of the invention and the desires and expectations of potential licensees, the Institute will license the invention on either a nonexclusive basis, a partial exclusive basis or an exclusive basis.

7. DISTRIBUTION OF INCOME

The Institute will distribute to the inventor(s), or his, her or their heirs, and to the laboratory(ies) of the inventor(s), a percentage of the Net Licensing Income (as defined below) received from licensing an invention in accordance with the following schedule:

To inventor(s): 33% of Net Licensing Income.

To laboratory(ies) of inventor(s): 7% of Net Licensing Income.

The remaining Net Licensing Income will be allocated for general Institute purposes including any specific allocations for research support or otherwise the President or his designee may make.

"Net Licensing Income," as used herein, shall mean gross licensing income received from royalties and/or fees with respect to an Institute invention other than consulting fees (which are normally paid to the person(s) providing the consulting without taking any deductions), less fifteen percent (15%) to assist in covering related internal costs, less external costs of patenting, maintaining, licensing, protecting and preserving the patent rights relating to the invention. Option payments are treated as licensing income.

Distribution of the "inventor's share" and the "laboratory's share" of the net licensing income shall be made on a regular basis, at the discretion of the Institute. Such distribution shall generally be made on a semi-annual basis, from the amount of net licensing income received during the fiscal year.

Payments to inventors and laboratories of inventors out of net licensing income are made on a patent by patent basis. In cases in which several inventions are licensed under a single license agreement, the Institute shall determine the share of net licensing income attributable to each invention.

Where there are two or more co-inventors of an invention with respect to which net licensing income is to be paid in accordance with this policy, each of the co-inventors and their laboratories shall share equally such net licensing income, unless all of the co-inventors have, prior to the first payment to them of net licensing income attributable to the invention, agreed, in writing presented to OTD Business Manager, to a different distribution. Where such an agreement has been entered into by the co-inventors, the agreement will govern the distribution of net licensing income among the co-inventors and their laboratories.

The inventor(s) designated on a patent application that is subject to this policy shall be determined by the Executive Director, OTD with advice of patent counsel in accordance with the law on inventorship under United States Patent Law.

The amount of net licensing income allocated to an inventor, as specified herein above, will not be reduced or terminated as a result of the inventor not being, or ceasing for any reason to be, an Institute employee.

8. SPECIAL CONSIDERATIONS REGARDING STOCK

In recent years it has become more common for the Institute to receive stock from licensees ("**Licensee Stock**") as part of the consideration for the license of technology developed by the Institute, particularly where the licensee is not a publicly traded company. A direct distribution of a portion of this Licensee Stock to inventors under the Institute's Patent and Invention Policy can raise a number of securities and tax law issues, including the following:

- (a) The Institute is generally required to give the licensee a so-called "investment letter, in which the Institute represents that it has acquired the Licensee Stock for investment and not with a view to distributing the stock to others;
- (b) Under existing tax laws, the Institute's distribution of non-traded Licensee Stock to inventors (or even the inventors' having an option to receive the stock) would cause the inventors to be immediately subject to taxation on the value of such stock even though there may be no market for the Licensee Stock and the inventors are therefore not able to sell the shares to generate cash to pay the resulting tax liability; and
- (c) If the Institute paid cash to the inventors in lieu of distributing their share of any non-traded Licensee Stock, the Institute would generally have little basis on which to place a value on such stock other than the representations of the licensee. Furthermore, since the Institute may determine to hold its share of any such Licensee Stock indefinitely, the Institute would be in a potential conflict-of-interest situation were it to value inventors' shares at a price not determined by a public market.

In order to address the foregoing issues and other related concerns, the Institute has implemented the following policy with respect to Licensee Stock received from licensees:

- a. Where the Licensee Stock is traded on an established securities market and the shares held by the Institute are freely transferable, inventors will receive the cash value of their share of such stock (based on the closing market price per share on the date such Licensee Stock was received by the Institute) in accordance with the normal procedures for distributing licensee payments (i.e., 3-4 months following the end of the semi-annual period in which the stock, if freely transferable, is received.
- b. Where the Licensee Stock received by the Institute is not traded on an established securities market at the time of receipt or is otherwise not freely transferable, inventors will normally receive a cash payment of their share of such stock 3-4

months following the end of the semi-annual period in which the first of the following occurs:

- (i) the Licensee Stock held by the Institute first becomes freely transferable on an established securities market as a result of an initial public offering or similar transaction by the licensee, at the closing market price per share on the date such Licensee Stock becomes freely transferable; or
- (ii) an actual cash sale of all or a substantial portion of the Licensee Stock held by the Institute, at the net price per share received by the Institute; or
- (iii) a sale for consideration other than cash, but not an exchange of stock, of all or a substantial portion of the Licensee Stock held by the Institute, at a per share price based upon the fair market value of such other consideration; or
- (iv) an exchange of stock where the Institute receives, for all or a substantial portion of its Licensee Stock, stock which is freely transferable on an established securities market, at a per share price based upon the closing market price of the stock received on the date of such exchange.

9. DISTRIBUTION OF INCOME FROM NON-PATENTED INVENTIONS

If a patent application is filed, net licensing income will be shared with the inventor(s) and laboratory(ies) of inventors in accordance with the terms of Section 7 above.

If the invention is not to be patented, but nevertheless generates money to the Institute the Institute will distribute to the developers and to the laboratory(ies) of the developers, a percentage of the Net Licensing Income (as defined in Section 7) received from licensing of the invention according to the following breakdown:

- 15.0% to Institute Administration Funds
- 42.5% to Institute's General Discretionary Funds
- 21.25% to an account of the laboratory of the developers ("lab share")
- 21.25% to the developers of the invention ("developers share")

10. PUBLICATION

Early drafts of manuscripts, posters, abstracts or other presentations (e.g., powerpoint presentations) shall be submitted to the Institute's OTD, and if relevant, to a sponsor, for review before publication, because such manuscripts frequently serve to identify patentable inventions and, further, such publication may have the effect of destroying patent rights in an invention described therein. However, the Institute will strive to avoid any interference with the prompt publication of research results, through the various academic channels, by inventors.

11. CONFLICTS OF INTEREST

It is the policy of the Institute not to interfere with the external activities of its staff, provided such activities do not conflict with their paramount obligations to the Institute. In this connection, staff members should be careful so as not to unwittingly create a conflict situation which is contrary to the best interests of the Institute. These concerns are addressed in the Disclosure and Conflicts of Interest Policies of the Institute. In order for the Institute to manage conflicts of interest, Institute staff members shall disclose to the President of the Institute, or such other person as the President may designate, existing relationships with outside organizations as well as contemplated or prospective arrangements with outside organizations, as required under the Disclosure and Conflicts of Interest Policies of the Institute. Any questions may be directed to the Office of the General Counsel.

12. EFFECTIVE DATE

This policy will become effective on July 1, 2010.

13. MODIFICATION/CANCELLATION

The Institute reserves the right to modify or cancel this Policy at any time in the future provided such modification or cancellation does not affect any rights accrued up to the date of such modification or cancellation.

14. VISITING RESEARCHERS AND SCIENTISTS

The Institute owns Intellectual Property created by visiting researchers and scientists as a result of their use of the Institute's facilities, equipment, confidential information or personnel. However, the Institute may make exceptions on a case-by-case basis consistent with this policy.

15. LABORATORY NOTEBOOKS AND RECORD KEEPING

Each scientist at the Institute is expected to keep and maintain laboratory notebooks. The notebooks are the property of the Institute and should not be removed at any time. When an employee leaves the Institute, the laboratory notebook shall remain in the laboratory at the Institute.

EXHIBIT A

CALIFORNIA LABOR CODE

ARTICLE 3.5 INVENTIONS MADE BY AN EMPLOYEE

(Article 3.5 was added by Stats. 1979, c. 1001, p. 3401, s.1
and amended by Stats. 1986, c. 346, s. 1)

Section 2870. Employment agreements; assignments of rights

- (a) Any provision in an employment agreement which provides that an employee shall assign, or offer to assign, any of his or her rights in an invention to his or her employer shall not apply to an invention that the employee developed entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information except for those inventions that either:
 - (1) Relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer; or
 - (2) Result from any work performed by the employee for the employer
- (b) To the extent a provision in an employment agreement purports to require an employee to assign an invention otherwise excluded from being required to be assigned under subdivision (a), the provision is against the public policy of this state and is unenforceable.

Section 2871. Conditions of employment or continued employment; disclosure of inventions

No employer shall require a provision made void and unenforceable by Section 2870 as a condition of employment or continued employment. Nothing in this article shall be construed to forbid or restrict the right of an employer to provide in contracts of employment for disclosure, provided that any such disclosures be received in confidence, of all of the employee's inventions made solely or jointly with others during the term of his or her employment, a review process by the employer to determine such issues as may arise, and for full title to certain patents and inventions to be in the United States, as required by contracts between the employer and the United States or any of its agencies.

Section 2872. Notice to employee: burden of proof

If an employment agreement entered into after January 1, 1980, contains a provision requiring the employee to assign or offer to assign any of his or her rights in any invention to his or her employer, the employer must also, at the time the agreement is made, provide a written notification to the employee that the agreement does not apply to an invention which qualifies fully under the provisions of Section 2870. In any suit or action arising thereunder, the burden of proof shall be on the employee claiming the benefits of its provisions.

EXHIBIT B
PATENT AND INVENTION AGREEMENT

This Patent and Invention Agreement (this “Agreement”) is made by me, _____, with the Salk Institute for Biological Studies, a California nonprofit public benefit corporation (“the Institute”), in partial satisfaction of my obligations under any Institute patent agreement I may have signed previously, and in partial consideration of my employment by or association with the Institute and activities undertaken thereby, which may change from time to time (my “Relationship”), any wages and/or salary to be paid to me by the Institute during any period of employment by the Institute, and/or my use of Institute information (information that is not publicly available and could not be obtained but for employment by or association with the Institute), facilities or other resources (my “Use of Resources”), the sufficiency and adequacy of which consideration I hereby acknowledge and accept.

I understand and agree that every possible invention (as defined in the Patent and Invention Policy of the Institute) that I conceive, develop, make, produce or reduce to practice, either solely or jointly with others, as a result of my Relationship and/or Use of Resources, are the properties of and are owned by the Institute. Consistent with this understanding and agreement, I agree to assign and hereby do assign to the Institute all of my rights, title, and interest in these Inventions and all intellectual property rights therein.

I acknowledge my obligation to promptly report and fully disclose to the Office of Technology Development (“OTD”) every Invention that I conceive, develop, make, produce or reduce to practice as a result of my Relationship and/or Use of Resources. Upon the request of the OTD, I shall promptly furnish complete information with respect to each invention.

I understand that each Invention will be reviewed by the Institute and appropriate action thereon will be taken in accordance with the Patent and Invention Policy of the Institute.

I further agree that, in the event the Institute deems any such Invention patentable and the Institute has the right and/or concurrence of the grantor or granting agency that provided funds for research to proceed with patent filing or granting of a license, I shall do all things necessary to assist the Institute in securing patent protection and licensing and/or enforcing such patents, including, without limitation:

- (i) not otherwise disclosing the Invention by oral or written communication until the filing of patent applications for the Invention, and
- (ii) executing and delivering any document reasonably requested by the Institute to apply for, obtain, perfect, and enforce such patents, at the Institute's expense, including any agreement to confirm my assignment to the Institute of all rights, title and interest therein.

I further agree that I will do all things necessary to enable the Institute to perform its obligations to grantors or granting agencies that provide funds for research that resulted in the

Invention, and to perform its obligations to licensees that have been granted rights in the Invention and the patents and patent applications based on the Invention.

I understand that my execution of this Agreement is not a waiver of any rights to a percentage of royalty payments received by the Institute as set forth in the Patent and Invention Policy of the Institute.

In the course of my Relationship and/or Use of Resources, I may generate data, notebooks, records, reports, and other writings, and I agree to assign and do hereby assign to the Institute all of my rights, title and interest in same and all intellectual property rights therein. However, I understand that this assignment does not apply to any copyrights in original works of authorship such as publications that are academic or scholarly in nature and authored by me in the course of customary research and educational activities, to the extent they are (i) not created at the request of the Institute and (ii) not owned by or obligated to be assigned to a third party.

In the course of my Relationship and/or Use of Resources, it may be necessary or helpful to obtain biological materials, reagents or information from other institutions or companies, the use or disclosure of which may be restricted as a condition of access to same. I hereby agree to abide by all such restrictions as the Institute may consent to for such purposes.

I agree to be bound to the terms of this Agreement as well as the Patent and Invention Policy of the Institute (as may be amended from time to time) for and during any and all periods of my Relationship and/or Use of Resources. I understand that my obligations to the Institute under this Agreement, unless specifically exempted, continue following the end of my Relationship and/or Use of Resources.

This Agreement supersedes and replaces any prior patent agreement with the Institute which may have been signed by me, and the terms and conditions provided herein apply to any Inventions, data, notebooks, records, reports, and other writings that I conceived, developed, made, produced or reduced to practice after the date of such prior patent agreement as well as to any Inventions, data, notebooks, records, reports and other writings that I conceive, develop, make, produce or reduce to practice in the future. In the event the Institute makes any amendment to the Patent and Invention Policy or there are any changes in the applicable laws or regulations, I agree to execute a revised Intellectual Property and Invention Agreement that is consistent with the amended Patent and Invention Policy and/or changes to such laws or regulations.

I agree to disclose to the OTD during the time of my employment or association with the Institute (i) any and all Inventions of mine that I believe belong to me personally or are assigned to or under obligation to be assigned to a party other than the Institute; (ii) any and all active consulting agreements I have with any third party; and (iii) any and all agreements I have to assign Inventions to a party other than the Institute. I agree not to use any Invention or other intellectual property that belongs to me personally or to a third party in the course of performing my work for the Institute, unless I have prior written consent from the Institute.

I understand that the assignment herein does not apply to any invention which qualifies fully under the provisions of Section 2870 of the California Labor Code:

(a) Any provision in an employment agreement which provides that an employee shall assign, or offer to assign, any of his or her rights in an invention to his or her employer shall not apply to an invention that the employee developed entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information except for those inventions that either:

- (1) Relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer; or
- (2) Result from any work performed by the employee for the employer.

(b) To the extent a provision in an employment agreement purports to require an employee to assign an invention otherwise excluded from being required to be assigned under subdivision (a), the provision is against the public policy of this state and is unenforceable.

This Agreement will be governed by and construed according to the laws of the state of California. This Agreement will be binding upon my heirs, executors, administrators and other legal representatives and will be for the benefit of the Institute and its successors and assigns. No waiver by the Institute of any breach of this Agreement shall be a waiver of any preceding or succeeding breach. This Agreement, along with the Patent and Invention Policy and any patent assignments required to be executed under this Agreement, constitute the final, complete, and exclusive agreement between the Institute and me with respect to the subject matter hereof. No modification or amendment to this Agreement, nor any waiver of any rights under this Agreement, will be effective unless in writing and signed by both parties. The provisions of this Agreement shall be deemed severable, and the invalidity or unenforceability of any one or more of the provisions hereof shall not affect the validity and enforceability of the other provisions hereof.

Questions concerning this agreement may be addressed to the Executive Director of the Office of Technology Development.

Date

Signature

Title
Printed Name

Date of Disclosure:
Docket No.:
Reviewed By:

EXHIBIT C
Invention Disclosure Form

1. Title of Invention ^a

- (a) Under U.S. patent law, a patent is available for any invention or discovery of a “new and useful process, machine, [article of] manufacture or composition of matter, or any new and useful improvement thereof...”(35 U.S.C. §101). The U.S. Supreme Court has held that this includes “anything under the sun that is made by man,” and various courts have ruled that this includes modified living organisms, methods of doing business, methods of treating disease, and purified forms of compounds found in nature, among many others. If you are not sure if you have an invention or discovery (both of which we’ll call an “invention” in this form), please contact the Office of Technology Development (OTD) for further information and advice.

2. General Description of the Invention ^{b,c}
Describe your invention generally, describe what you think it might be used for, how it might be used, and what you believe the benefits would be. Feel free to attach additional sheets if needed. If you have a draft manuscript describing the research surrounding the invention, please attach a copy, and we can get any detailed information from it directly.

- (b) This is not intended to be an exhaustive description, but only enough to allow the OTD to get a general idea of the invention. If you would like some help or advice on writing this section, please give us a call.
- (c) If we and you decide it is worthwhile to file a patent application, we will need to describe the invention, how to make it and how to use it in enough detail to allow one of ordinary skill in the field to make and use it, and also describe the best mode of carrying it out (...”(35 U.S.C. §112). Our staff and our patent attorney will work with you on this.

3. Plans for Continued Research and Development ^d
Describe your future basic research plans relating to the invention, and any plans you may have to further explore the practical utility of the invention, such as proof-of-principle experiments.

(d) We realize that basic research is the primary mission of most Salk laboratories, and we have no interest in changing or interfering with this. However, sometimes a very few experiments can substantially increase the scope of patent protection and the value of resulting patents. OTD would be glad to explain the scope of patent protection that may be available based on the information in this form, and may be able to provide some helpful suggestions on how the scope of patentability might be expanded.

4. Presentations and Publications of Research Related to the Invention ^e		
	Date	Details (presenter, meeting name, location, journal)
A. Talks given outside Salk, if any, formal or informal. If handouts were distributed, please attach copies to this form.		
B. Publications (<i>e.g.</i> , funding reports, papers, posters, abstracts, on-line, theses, etc.). Please attach copies to this form.		
C. List all scheduled talks and any publications that are being drafted or are in review.		

(e) In the U.S., a patent is available up to one year after a written publication ...”(35 U.S.C. §102(b)) In most foreign countries, however, an oral or written disclosure of an invention before filing a patent application can be a bar to patentability, depending on the extent of disclosure and local laws.

5. Funding of Research Related to the Invention ^f		
U.S. government grants (e.g., NIH, NSF).		
Agency	Grant No.	P.I.
Funding from companies, foundations, state governments, non-US government agencies or institutions		
Name of Provider	Award No.	Recipient

(f) Research funding agreements with federal and state agencies, companies, and an increasing number of foundations contain restrictions and requirements regarding the handling of inventions and the royalties they may produce. OTD will evaluate the agreements for the funding sources you identify, to make sure any such requirements are met.

6. Materials Used ^g		
List any companies, foundations or academic institutions that provided materials that may have been used in the above-described research (e.g., animals, cell lines, antibodies, genes, vectors, constructs, computer software and chemical compounds), and name or describe the materials. If any were provided under a material transfer agreement (MTA), provide the date and attach a copy if possible.		
Material	Provider	MTA

(g) Unique biological materials are often unpatented, but may be protected under trade secret laws if the owner controls their distribution and use. OTD will evaluate if materials used in your research raise any issues regarding your invention.

7. Commercial Potential ^h
A. Describe as many ways as you can think of that your invention might be used by a company in an internal process, in a product for sale, or by a customer who buys such a product. In each case, what benefits might your invention provide?
B. List any companies you may know of that might be interested in your invention, and if you have contacts in such companies, please identify the contact and their position in the company.

(h) One of the main goals of OTD will be to identify the commercial potential for your invention and contact companies that may be interested in licensing. We will supplement any information you may have with the results of our own investigation, analysis and market research, so don't be concerned if you don't have much information.

8. Inventors ^{i,j}				
Full Name	Home Address	Citizen-ship	Employer, Research location	Phone, e-mail

(i) An “inventor” is a person who “participates in a significant manner in the conception of the invention.” Under U.S. law, “conception” is defined as "the formation in the mind of the inventor of a *definite and permanent idea* of the *complete and operative* invention as it is thereafter to be applied in practice.." Please contact OTD if you need guidance in identifying the inventors.

(j) Please bear in mind that not all authors of a related publication may not be inventors. Inventorship is ultimately a question of law, and our patent attorney may advise

reconsideration or change of the named inventors once the scope of any patent application is known, or if certain aspects turn out not to be patentable.

9. Inventors’ Assignment and Designation of Relative Contributions^k

By our signatures below, each of us declare that we are inventors of the above-described invention.

Each of us that are employed by Salk or who carried out our our related research at Salk (“Salk Inventors) also (i) hereby assign or affirm our earlier assignment of all rights in same to the Salk Institute, subject to the royalty sharing and other provisions of the Salk Patent and Inventions Policy, and agree to sign any other documents Salk may request regarding such assignment; (ii) Unless “not agreed” appears in the box for our relative contribution, we each agree to the relative contributions of the Salk inventors as set forth below, and further agree that such percentages will be applied in dividing any inventors’ share of royalties among us; and (iv) if we have so agreed, we certify and attest that our agreement to the relative contributions set forth below was not the result of coercion by any other inventor or other person. In the absence of agreement by all Salk Inventors to the relative contributions shown, the Inventors’ share of royalties will be distributed evenly among all Salk Inventors. Please contact OTD if you wish us to assist in efforts to reach agreement.

Full Name	Signature	Date	Relative Contributions (%) ⁱ

(k) Percentages for Salk Inventors must add up to 100%, or it will be assumed there is no agreement by all Salk Inventors. Non-Salk Inventors should leave this space blank.