

Center For Cellular Construction
National Science Foundation Science and Technology Center (STC): Integrative Partnerships
INTELLECTUAL PROPERTY MANAGEMENT PLAN

I. Preamble

1. This Intellectual Property Management Plan (the “Plan”) is established by The Regents of the University of California, through its San Francisco Campus (“UCSF”) with The Regents of the University of California, through its Berkeley Campus (“UCB”), with San Francisco State University (“SFSU”), Leland Stanford Junior University (“Stanford”), Exploratorium and IBM Research – Almaden Research Center (“IBM”), as Participants in the National Science Foundation – Science and Technology Center (STC): Integrative Partnerships grant program to address management of intellectual property that may be developed by Participants as a result of work performed under the Award (as defined below) for the formation of the Center for Cellular Construction.
2. The general purpose of the Plan is to address the protection and disposition of intellectual property developed by Participants under the Award within the framework of Federal laws, regulations, and policies.
3. The Plan objectives include:
 - a. Promoting the patenting, licensing, and rapid commercialization of intellectual property developed under the Award, and
 - b. Promoting the rapid dissemination of the research results developed under the Award for the public good.

II. Definitions

1. “**Award**” refers to a grant of monies from the National Science Foundation – Science and Technology Center (STC): Integrative Partnerships program, NSF 14-600 Competition, to an entity or entities by means of an award. For the purposes of this Plan, the Award is designated as NSF Proposal No. 1548297, entitled “Center For Cellular Construction”, submitted by Wallace Marshall, Zev J. Gartner and Wendell Lim, from UCSF.
2. “**Award Work**” means any work or activity performed by a Participant in performance of and funded by a National Science Foundation (STC): Integrative Partnerships Award.

3. **“Background Technical Data”** means technical information, developments, discoveries, drawings, designs, models, methods, techniques, formulae, algorithms, data, processes and other proprietary ideas (whether or not patentable or copyrightable) developed before or independent of performance under the Award that is necessary for the performance of Award Work.
4. **“Background Inventions”** means intellectual property and the legal right to that intellectual property developed before or independent of the Award including inventions, patent applications, patents, copyrights, trademarks, and any information embodying proprietary data such as technical data and computer software.
5. **“Invention”** means any discovery or a new device, method, or process developed from study and experimentation that is or may be patentable or otherwise protectable under Title 35 of the United States Code, or any work protectable under U.S. Copyright Laws.
6. **“Participant”** means an individual or entity who directly or as a subawardee, receives money from NSF pursuant to the terms of the Award for the purpose of performing Award Work and who contributes to the execution of Award Work. Each Party to this Intellectual Property Management Plan is a Participant.
7. **“Project Inventions”** means any Subject Invention of a Participant that has been conceived and reduced to practice in the performance of the Award.
8. **“Project Research Results”** means and includes technical information, developments, discoveries, drawings, designs, models, methods, techniques, formulae, algorithms, data, processes and other proprietary ideas (whether or not patentable or copyrightable) first conceived, discovered, developed, and reduced to practice or generated in the performance of the Award.
9. **“Project Team”** refers to a collective of Participants working in a collaborative manner in the performance of the Award.
10. **“Subject Invention”** means any Invention of a Participant that is conceived or reduced to practice in the performance of work under the Award.

III. Ownership of Subject Inventions, Background Technical Data, Background Inventions and Project Research Results

1. Each Participant shall retain ownership of its own Background Technical Data and Background Inventions. Nothing contained in this Plan shall be deemed to grant either directly or by implication, estoppel, or otherwise any license under any

patents, patent applications, or other proprietary interests to any other invention, discovery, or improvement of any Participant. The decision to make available any Background Technical Data or Background Invention for any use shall be at the sole discretion of each Participant and subject to a separate agreement. Each Participant shall also retain ownership of Subject Inventions, Project Inventions and Project Research Results developed solely by its employees and agents.

2. Unless agreed to otherwise in writing under Sections IV.1 and IV.2 below, the Participant filing a patent application on a Subject Invention or Project Invention may find a third party licensee or choose to pay all preparation and filing expenses, prosecution fees, issuance fees, post issuance fees, patent maintenance fees, annuities, interference expenses, and attorneys' fees for that patent application and any resulting patent(s). Such Participant may abandon any such prosecution but must notify the other Participants with an ownership interest in such Subject Invention or Project Invention at least sixty (60) days before the date that responses to any pending patent office actions need to be taken in order to preserve the rights in such Subject Invention(s) or Project Invention(s). No Participant may file a patent application on another Participant's sole Subject Invention or Project Invention.
3. Inventorship of Subject Inventions will be determined according to United States patent law. Ownership of such Subject Inventions shall vest in the party to whom the inventor has an obligation of assignment. In accordance with U.S. patent law, Participants who jointly own a Subject Invention shall have an undivided interest in such jointly owned Subject Invention(s), and may dispose of this interest at its discretion unless the co-owning Participants have otherwise agreed to in writing in accordance with Section IV.2 below.

IV. Licensing Project Inventions and Project Research Results

1. Participants with a sole ownership interest in a Project Invention(s) shall have the right, but not the obligation to file, prosecute or maintain patent rights on Project Inventions, and such Participants may grant exclusive and non-exclusive licenses for use of such Project Inventions. Notwithstanding the foregoing, for each Project Team, Participants of a Project Team agree to notify, in confidence, each Project Team Participant of any solely or jointly owned Project Inventions and, prior to any patent application filing or commercialization of such Project Inventions, all Participants of a Project Team agree to discuss in good faith possible strategies for promoting the patenting, licensing, and rapid commercialization of Project Inventions developed by the Project Team.
2. Prior to any patent application filing or commercialization of a Project Invention, Participants with a joint ownership interest in a Project Invention(s) agree to first discuss in good faith the management of such Project Invention and may enter

into a separate written agreement governing administration, commercialization, licensing and sharing of any expenses or revenue derived from such Subject Invention, such agreement to be negotiated in good faith by such Participants.

3. The Participants must fully and promptly notify UCSF upon the disclosure of any Subject Invention or any software developed in the performance of the Award Work. Any license to a Project Invention must include a reservation of certain rights to the Federal Government under the provisions of 35 U.S.C. § 200-212 et seq, which include march-in rights and a preference for U.S. industry.
4. Any license to a Project Invention will reserve the right of academic, educational, research institutions to use the Project Invention(s) on a royalty-free basis for research and education, subject to confidentiality requirements.
5. Any licensing of Project Research Results or Project Invention(s) shall be conducted pursuant to and in accordance with the terms of the Award under which the Project Research Results or Project Invention(s) was developed. Licensing of Project Research Results or Project Invention(s) shall not inhibit performance of Award Work.

V. Ownership of Technical Data

1. Each Participant shall own Project Research Results developed by its employees or agents. Any use by each Participant of another Participants' Project Research Results and related Background Technical Data shall be for the sole purpose of carrying out Award Work. Each Participant shall establish and implement specific measures and protocols to protect such data from disclosure in accordance with Section VI (Confidentiality).

2. In the event that sharing among Participants of Project Research Results is necessary for the performance of this Award Work, to the extent the Participant owning such Project Research Results is legally able to do so, the Participants shall grant non-exclusive, royalty-free licenses to their respective Project Research Results sufficient for, and limited to, internal research use towards completion of the Award.

VI. Confidentiality

"Confidential Information" shall mean proprietary and confidential information communicated by one Participant to the other in any format, whether orally, in writing, electronically, visually, or by any combination thereof. The receiving Participant shall use reasonable efforts not to disclose the disclosing Participant's Confidential Information to anyone except those working under the supervision of the Participant's lead investigator of the Award Work for the purposes of the Award Work. The receiving Participant will use the Confidential Information only in the conduct of the Award Work, evaluation of its results and to comply with its obligations under

the Award. The obligations of confidentiality set forth herein shall remain in effect for a period of five (5) years from the date of disclosure. The receiving Participant shall have no obligations under this paragraph with respect to information which:

- a. was known to it prior to receipt hereunder, as demonstrated by written records;
- b. at the time of disclosure was generally available to the public, or which after disclosure becomes generally available to the public through no fault attributable to receiving Participant;
- c. is hereafter made available to receiving Participant for use or disclosure by receiving Participant from any third party having a right to do so;
- d. is required to be disclosed by law, including but not limited to the California Public Records Acts, governmental rule or regulation or order of a court with competent jurisdiction; or
- e. is independently developed by receiving Participant without reference to the Confidential Information.

The terms of this confidentiality provision shall supersede any previous terms agreed upon by a Participant related to the Award.

This section is not intended to limit any publication rights of any Participant.

VII. Publication

Each Participant, consistent with academic standards, may publish or present the Project Research Results, provided such publication or presentation does not disclose the other Participant(s)' Confidential Information. The Participants agree that any publication or presentation of Project Research Results shall appropriately cite the contributions of any applicable Participant in a Project Team, using customary standards of scientific attribution. Each Participant shall provide the other Participants in a Project Team with such publication or presentation thirty (30) days prior to submission for presentation or publication to permit protection of any Confidential Information and/or patent rights, if desired and applicable.

VIII. Term and Termination

This Agreement shall remain in effect for five (5) years from the effective date of the Award. Any Participant may terminate this Agreement for any reason by providing thirty (30) days written notice of termination to UCSF. Notwithstanding termination of this Agreement, each Participant shall hold a disclosing Participant's Confidential Information in confidence for a period of five (5) years from the date of disclosure in accordance with the terms of this Plan.

Termination of this Plan shall not affect the rights and obligations of the Participants accrued prior to termination. In the event of termination by any of the Participants, each Participant shall be responsible for its share of the costs incurred after the effective date of termination, and which are related to the termination.

IX. Exchange of Materials

All materials, including progeny and unmodified derivatives, provided by or on behalf of any Participant in connection with this Plan shall remain the property of the providing Participant and shall be used solely for the purposes of the Award Work. Upon termination of the Award, the unused portions of such materials will be returned to the providing Participant or will be disposed of as directed by the providing Participant in writing.

This Plan may be executed in one or more counterparts, each of which together shall constitute one and the same Plan. For purposes of executing this Plan, a facsimile (including a PDF image delivered via email) copy of this Plan, including the signature pages, will be deemed an original. The parties agree that neither party will have any rights to challenge the use or authenticity of a counterpart of this Plan based solely on that its signature, or the signature of the other party, on such counterpart is not an original signature.

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