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Background on the UC Patent Acknowledgement

Background

The University of California, like other research universities, requires all employees and other personnel who use University research facilities or resources to sign a Patent Acknowledgment as a condition of employment or visitor status.

The Patent Acknowledgment—called a Patent Agreement prior to 1997—requires the individual to promptly report and fully disclose to UC licensing offices potentially patentable inventions. In addition, the individual acknowledges an obligation to assign to UC rights to inventions and patents that are conceived or developed while employed by the University or while using any University research facilities or any gift, grant, or contract research funds received through the University. UC typically evaluates each invention disclosure for development and commercialization potential and may require the inventor to formally assign rights to the University.

In the recent *Stanford v. Roche* case, the Court held that a company's agreement with a university faculty member with language containing a present assignment of future inventions can give the company patent title to inventions arising in that faculty member's later university research. In this particular case, even though the Stanford faculty member had previously signed Stanford's patent agreement in which the faculty member "agrees to assign" patents (i.e. a future assignment), the Stanford faculty member subsequently visited and signed an agreement with Cetus (later acquired by Roche) that assigned patent rights for future patents resulting from his work at Cetus to the company.

As a result of this case, it is important that UC now clarify the intent of the Patent Acknowledgment remains the assignment to the University of rights to inventions and patents that are made using University resources or facilities. The clarification will ensure that the University owns inventions that are made using University resources and facilities so that it can meet its legal obligations, properly manage these assets and meet its responsibilities as a public trust under the State Constitution.

UC's Response

In response to the *Stanford v. Roche* court decisions, the University has updated the language in the Patent Acknowledgment, which is part of the UPAY 585 form, for all employees hired on or after November 1, 2011 and is requiring all employees hired on or before October 31, 2011 to sign an amendment that clarifies the original intent of the language.

Starting November 28, 2011, employees hired on or before October 31, 2011 will be contacted through University email by an outside vendor, VR Election Services (VRES). The email will provide instructions on how the employee can electronically sign the Amendment. This electronic process will continue through February 29, 2012, and during this period, employees who have not yet signed will receive occasional reminders to complete the signature process prior to the end date. Those employees who do not have e-mail addresses will receive information and instructions by USPS mail.

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Employees who sign the 2011 Amendment will be able to see when they signed by logging in to their AYSO personal accounts beginning in mid-March, 2012.

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