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Patent Acknowledgment FAQ's

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The Patent Amendment

Why is UC asking me to sign this Amendment?

Recent court rulings have changed the University's understanding of one of the provisions in UC's Patent Acknowledgment/Agreement (hereafter, both referred to as the Patent Acknowledgment) that is signed by all employees and others who use University research facilities, and those who receive gift, grant or contract funds through the University. That provision no longer guarantees the effective assignment of rights to the University of California as intended.

To protect the University and its employees and to meet legal obligations to sponsors of research and licensees of UC, all current employees and other relevant personnel who came to UC on or before October 31, 2011 must sign an Amendment to the Patent Acknowledgment.

What is the court case and what does it say?

In the recent court case *Stanford v. Roche*, the Court interpreted assignment language similar to UC's ("I acknowledge *my obligation to assign* inventions and patents that I conceive or develop...") as creating a "promise" to assign rights at some time in the future. As a result, the Court found a later assignment to a company took precedence over the earlier "promise" to assign to the university, and awarded patent rights to the company instead of to Stanford.

To address this ruling and to meet our legal obligations to sponsors of research and licensees of UC, UC has chosen to amend the existing Patent Acknowledgment by adopting the "hereby assign" language that the court acknowledged as creating an immediate assignment of rights to future inventions. Hence, the Amendment accomplishes the assignment of rights you agreed to at the time of your initial hire or start date.

For those interested in the legal development, the recent case is *Stanford v. Roche* ([Federal Circuit 2009](#) and [Supreme Court 2010](#))

How has the Patent Acknowledgment language changed?

The bold/italicized words and phrases have been added to the Patent Acknowledgment that employees and visitors sign when they join UC.

"I acknowledge my obligation to assign, **and do hereby assign**, inventions and patents that I conceive or develop **1) within the course and scope of my University employment** while employed by the University, 2) during the course of

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my utilization of any University research facilities or 3) **through** any connection with my use of gift, grant, or contract research funds received through the University. I further acknowledge my obligation to promptly report and fully disclose the conception and/or reduction to practice of potentially patentable inventions to the University authorized licensing office. Such inventions shall be examined by University to determine rights and equities therein in accordance with the Policy. I shall promptly furnish University with complete information with respect to each."

These changes also are reflected in the Amendment current employees and visitors will sign.

What are the changes in the Amendment to the Patent Acknowledgment?

There are four changes in the Amendment:

1. The words "and do hereby assign" are added. This addition provides a present assignment of invention and patent rights to UC, addressing the problem created by the Supreme Court decision.
2. The words "within the course and scope of my University employment" are added. This clarifies the scope of the present assignment, and is actually slightly narrower than the original version of the Patent Acknowledgment.
3. A grammatical correction with the addition of the word "through" in the following: "through any connection with my use of gift, grant or contract research funds received through the University."
4. "Office of Technology Transfer" is replaced with "University authorized licensing office" to reflect that fact that licensing is no longer done by a central office, but is conducted locally by campuses.

The Amendment does not alter or diminish any of your individual rights as inventors.

What is a present assignment of rights?

A present assignment of rights is an immediate assigning of rights to future inventions and patents, as opposed to a future assignment, which is the language of previous versions of the Patent Acknowledgment.

Is this a change in policy?

No. There is no change to the [University Patent Policy](#) or in employee rights regarding intellectual property with which they may be associated.

Does this broaden the scope of inventions to which the University is claiming rights?

No. In fact, the addition of "within the course and scope of my University employment" makes the scope of inventions narrower and better reflects actual University practice.

Why was "Office of Technology Transfer" deleted?

The technology transfer and licensing functions have been decentralized and the authority for these activities now resides with the campuses.

What is the relationship of the Patent Acknowledgment and the Amendment to copyrights?

The Patent Acknowledgment addresses only one form of intellectual property, namely inventions and the patents that protect them. The Patent Acknowledgement does not affect copyrights.

Signing the Amendment

Who does this Amendment apply to?

This Amendment applies to all University of California employees, including but not limited to faculty, staff, graduate students and postdoctoral fellows, others who use University research facilities, and those who receive gift, grant or contract funds through the University. It does not apply to people who joined the University on or after November 1, 2011.

I am just starting my job now. Do new employees, appointees or visitors have to sign the Amendment?

No. New employees and other relevant personnel whose initial hire or start date is after November 1, 2011, as part of the regular on-boarding process, will sign an updated 2011 Patent Acknowledgment that achieves the same objective.

I was hired before 1997, so I am entitled to the 1985 inventor's royalty share. Does this Amendment change that?

No. This Amendment does not alter any previous choice to remain under the 1985 UC Patent Policy or your eligibility to choose to remain under that policy.

⌘ [See details about royalty distributions and eligibility to elect a previous Patent Policy](#)

Do I have to sign the Amendment?

Yes. The Patent Acknowledgment that you signed as a new employee is a condition of your employment. If you are a visitor, you are also required to sign the Amendment as a condition of your access to University research facilities or contracts, grants or other funds through the University. As a condition of employment or visitor status, you are also required to sign additional documents requested by the University for the purpose of confirming the University's rights regarding intellectual property you create. This is true under both the Amendment and earlier Patent Acknowledgments.

What happens if I don't sign this Amendment?

As an employee of the University, you are required to sign this amendment. Researchers, in particular, should be aware that it is necessary to sign the amendment in order to participate in activities covered by agreements in which the University has made a legal commitment regarding inventions. Examples would include many sponsored research agreements, material transfer agreements, and even some purchases. Note that even federal contracts and grants impose invention obligations. In fact, the specific issue that went to the Supreme Court in the *Stanford v. Roche* case involved the treatment of inventions under federal funding. The University must be able to meet its legal obligations and under these sorts of agreements, in light of the Supreme Court decision, the only way this can be assured is if participants have signed the Amendment prior to participating.

My appointment is ending December 31, 2011; do I still have to sign the Amendment?

Yes. As a condition of employment or visitor status, you are required to sign the Amendment for the purpose of confirming the University's rights regarding inventions you create.

I'm not a researcher or faculty member; why do I have to sign the amendment?

All employees at the University, including staff and student employees, are required to sign the Patent Acknowledgment as a condition of employment. While most University inventions are made in the performance of research, some are not, including some that have been relatively successful. Furthermore, staff and student employees do occasionally undertake activities for which the University has obligations to a third party.

I work or am a guest (Affiliate) at Lawrence Berkeley National Lab and already signed an amendment. Do I have to sign this one too?

If you work full-time at LBNL, then you will not be part of this Patent Amendment process and do not need to sign. If, however, you have a dual appointment at a campus and LBNL or have any other employment at a campus, you will be required to sign the Patent Amendment.

If I sign this Patent Amendment, do I need to sign the Lawrence Berkeley Lab amendment?

Yes, if you became a guest (Affiliate) or were employed by LBNL prior to October 13, 2010, you must also sign the LBNL amendment.

I have dual appointments at two campuses and have received two emails asking me to sign the amendment. Do I need to sign twice?

It is highly recommended that you sign both copies of the amendment, as this will facilitate future reporting and compliance at both locations.

Will signing this Amendment affect my consulting agreements?

No. There is no change in our policies relating to approved compensated outside professional activity. The Amendment applies only to inventions and patents that arise within the course and scope of your University employment, during the course of your use of any University research facilities, or in connection with your use of any gift, grant, or contract research funds received through the University. In fact, the Amendment can actually help protect you from inadvertently signing away rights to inventions that are made outside the consulting arrangement. Note that your obligation to *disclose* all inventions so that UC may determine assignment and ownership, including those that arise from outside professional activity, continues and is unchanged.

How do I know what I signed before?

*: [View copies of the previous Patent Agreements and the 1997 Patent Acknowledgment](#)

You can determine the version that you signed based on your hire date. For example, if you were hired in 1995, you likely signed the 1991 Patent Agreement. Please note, however, that the 1990 Patent Policy that is included on the 1991 Patent Agreement was rescinded in 1997 and therefore, the 1985 Patent Policy would apply to individuals who signed this document. In addition, although the content is unrelated to this project, the Addendum to the 1980 Patent Agreement was included on this website for informational purposes.

Do I have to re-sign the State Oath of Allegiance, which is on the same form?

No. UC personnel only need to sign an Amendment to the Patent Agreement/Acknowledgment they signed when they came to the University. They are not being asked to re-sign the Oath.

In October 2011, I signed a Case-Specific Amendment for a research project. Do I still need to sign the Amendment?

Yes. The Amendment will cover all activities at the University. The Case-Specific Amendment addresses only that particular project.

I'm on sabbatical; do I need to sign the Amendment now or when I return?

Yes, you need to sign it now. As a faculty member on sabbatical, you are still employed and being paid salary by the University, and thus, the Patent Acknowledgment still applies to inventions you make.

Does having a non-disclosure agreement with a company conflict with any part of the Amendment?

If the non-disclosure agreement does not refer to invention or patent rights, then there is likely no conflict with the Amendment. Faculty and researchers should be careful, however, to avoid signing outside non-disclosure agreements covering information and inventions that are created within the scope of their University work. If the non-disclosure agreement contains provisions referring to invention or patent rights, you should consult with your campus department.

The electronic signing process**I've received email from VRES and am concerned it is phishing or spam. Can you confirm this email is legitimate?**

VRES is the outside vendor UC has hired to administer the electronic signature process for the Amendment. UC has authorized emails from this address:

UC_Patent_Amendment@vres.us

They are not phishing or spam.

What is my Employee ID and where can I find it?

Your Employee ID is the nine-digit number that uniquely identifies you as a UC employee. For security reasons, UC is asking for the last four digits of your employee ID rather than your Social Security number.

You can find your Employee ID on your Earnings Statement at the top under your name. To retrieve your Employee ID number, log in to [At Your Service Online](#).

I've entered my PIN and ID but the system is not letting me sign the amendment. What should I do?

First, make sure you are using your Employee ID and not your Social Security number. For security reasons, UC is asking for the last four digits of your employee ID rather than your Social Security number. You can find your Employee ID on your Earnings Statement at the top under your name. To retrieve your Employee ID number, log in to At Your Service Online.

If you are still not able to sign the amendment, contact VRES customer service for help at custserv@vres.us or 800-218-4026.

I neglected to print out the confirmation page; is there a way to get a copy?

No. There is not a separate mechanism to obtain a copy of the confirmation page. However, beginning in mid-March 2012, UC administrators will be able to confirm whether or not you have signed the Amendment.

Where can I get a paper version of the Amendment?

The Amendment signature process will be completely electronic for most employees. Paper versions of the Amendment will be mailed only to employees who do not have a work email address on file.

The language changes contained in the Amendment can be viewed and printed from the [Background Information Section](#).

Thanks for your participation and cooperation!

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Last Modified 12/23/2011 12:09:23