


UW Patent Assignment Agreement (PAA)

The Faculty Senate's [Special Committee on Intellectual Property and Commercialization \(SCIPC\)](#) and the President's Intellectual Property Management Advisory Committee (IPMAC) have recommended improvements to the process of requesting and receiving prior approval for outside work for compensation. The resulting recommendations were accepted and incorporated into the [Form 1460](#) by the Office of Research, which has the responsibility and authority for administering the [Outside Professional Work process for Faculty, Librarians, and Academic Staff](#) on behalf of the Provost.

The Committees also recommended a separate assignment of intellectual property, limiting the scope of the present assignment. Only when the outside work is likely to involve inventive participation will the faculty member need a completed Patent Assignment Agreement. This agreement balances the faculty member's interests at the UW with the interests of the company providing the outside work engagement. This present assignment of patentable inventions is signed electronically via DocuSign, which is managed by CoMotion.

For each faculty member, a single completed Patent Assignment Agreement covers all inventive participation in outside work. This agreement only needs to be executed once.

Contact: PAA Help
uwassign@uw.edu
206-543-3970

 **Sign The Patent Assignment Agreement (In DocuSign)**

Key Points

- Affirmation of commitment to scholarly work and academic freedom. In the agreement, the UW acknowledges a faculty member's right to make potential inventions publicly available. This aspect of research, scholarship, and education has priority over any commercialization, and this agreement makes an explicit commitment to this priority.
- Limited Scope of Assignment of Patentable Inventions. In this agreement a faculty member makes a "present assignment" of patentable inventions that were developed within the scope of his or her employment. If an invention has been made public, then it is no longer patentable, so this preserves the priority of scholarly work.
- Executed electronically. This agreement is presented electronically through DocuSign. A faculty member who engages in outside work with inventive potential need only execute this agreement once.
- Dependence on request. If initially submitted as part of a request for outside work, then this Patent Assignment Agreement will be contingent on the approval of that request. This agreement will remain in effect only if the associated request for outside work is approved.
- Questions and Comments about the Patent Assignment Agreement or electronic signature using DocuSign should be addressed to uwassign@uw.edu.

Key Changes in Patent Assignment Process

Only when the outside work is likely to involve inventive participation (as evidenced by responses to the intellectual property questions on the Form 1460) will the faculty member need to complete the

Patent Assignment Agreement. This agreement includes a more limited scope of "present assignment" of patent rights than did the former Form 1460. However, it does not limit or change the faculty member's obligation to assign patent rights ("future assignment") under [Executive Order 36](#).

In general, the present assignment in the Patent Assignment Agreement has been narrowly drafted to balance the rights and interests of faculty members, the UW, and the organization providing the outside work engagement.

For each faculty member, a single completed Patent Assignment Agreement covers all inventive participation in outside work. This agreement only needs to be executed once, electronically, via DocuSign.

In the event that a faculty member is directed to execute the Patent Assignment Agreement by Form 1460, and the request for approval of outside work is denied, then the Patent Assignment Agreement will be null and void as if it had never been executed.


Questions and comments about the Patent Assignment Agreement or electronic signature using DocuSign may be addressed to uwassign@uw.edu.

Text of the Agreement as it appears in DocuSign

This Patent Assignment ("Agreement") ensures that the rights to inventions made at the UW are protected from being transferred to outside parties in ways that could: (1) deprive the Applicant and the UW of rights promised to each of them by the UW's Patent, Invention, and Copyright Policy; and (2) subject the Applicant to claims of breach of contract or violation of the [State's Public Ethics Law](#). On this basis, the undersigned Applicant and the UW hereby agree to the following:

- **Public Domain.** The UW agrees that the Applicant is free to place his or her inventions in the public domain by disclosing research results in publications, conferences, or other public fora; provided, however, that the Applicant has obtained the consent of the Principal Investigator and any co-creators on the research that led to the invention, and that such disclosure will not violate any other agreements, such as funding agreements or agreements within the UW.
- **Inventions.** The Applicant hereby assigns to the UW all rights, title, and interest in every Patentable Invention conceived or actually reduced to practice in the course of the Applicant's UW employment.
- **"Invention" and "Patentable Inventions" Defined.** The term "Invention" shall have the meaning given to it in the UW's Patent, Invention, and Copyright Policy. For purposes of this Agreement, the term "Patentable Invention" means only those Inventions that are patentable, i.e., meet the criteria for patentability under U.S. patent laws.

Failure of UW to Approve this Form. In the event that the UW does not approve this Request for Approval of Outside Professional Work for Compensation, this Agreement shall have no effect and be considered null and void as if it had never been signed by the Applicant.

 **Sign The Patent Assignment Agreement (In DocuSign)**