

Frequently Asked Questions University of Chicago Patent Agreement and Assignment (PAA)

For Graduate Students:

To comply with the provisions of University of Chicago Statute 18.1, all graduate students are required to execute a “present assignment of future rights,” or Patent Agreement and Assignment (PAA). Because it is not possible to determine in advance which graduate students will create intellectual property covered by Statute 18.1, new graduate students are to execute the PAA by the end of their first academic quarter, and current graduate students are expected to execute the PAA upon request by the University through AIS but no later than the date of enrollment for the next academic quarter.

Statute 18 reads, in part, as follows (emphasis added):

18.1. The basic policies of The University of Chicago include complete freedom of research and the unrestricted dissemination of information. While the traditional method of dissemination of the results of academic work is through publication in scholarly or other public media, developments having commercial potential often arise in the course of University research or other activities. For the benefit of the University, the inventor or creator, and the public, the University endeavors to bring the products of research to practical implementation. Where research or other activities carried out at the University, or with substantial aid of its facilities or funds administered by it, result in inventions, discoveries, or device-like software, such intellectual property shall be disclosed to the University, and shall be the property of the University from inception. *The inventor or creator shall agree in writing to notify the University promptly of any such intellectual property and to assign to the University all of his or her rights, title and interests in such intellectual property, in the form of a present assignment of future rights.* The inventor or creator shall comply with the University’s request that he or she perfect the University’s ownership of the intellectual property by execution of a recordable assignment of the intellectual property to the University, or to an organization designated by the University. The University, acting directly or through its designee, shall endeavor to license or assign such intellectual property in a manner that benefits the University and the public, and provides a return to the inventor or creator. The inventor or creator shall be consulted and kept informed of the arrangements.

What is the PAA?

The University’s long-standing Patent Policy ([Statute 18](#)) gives the University rights in discoveries and inventions that are created by people working at or for the University. The PAA is an agreement between you and the University that confirms the rights that the University already has under Statute 18. Except in unusual circumstances, you will be asked to sign the PAA only once (not annually) during your association with the University.

Does the PAA change or enlarge the University’s policy regarding inventions?

No. The PAA does not create rights in inventions that the University does not already have under Statute 18. By enrolling at the University, all current students have already agreed to be bound by Statute 18 and to the University's ownership of inventions on the terms described in Statute 18. The PAA has no effect on or implications for the University's policies or practices with respect to copyrighted works in any medium.

If I am already bound by Statute 18, why is the University now requiring a signed PAA?

The PAA is being implemented at the University because patent law court decisions (in cases not involving the University), most notably the United States Supreme Court's decision in the case *Stanford v. Roche*, have highlighted the importance of obtaining a written assignment of inventions prior to the time an invention is made. As a result of these court decisions, research universities in the United States have implemented procedures for obtaining similar signed patent agreements. In addition, obtaining assignment agreements upfront will enhance our corporate engagement efforts, as our corporate sponsors typically expect such a process to be in place at the University with respect to faculty and students who participate in corporate sponsored research projects. The PAA process was vetted with the Faculty Committee on Individual Conflicts of Interest as part of its review of similar procedures for obtaining conflict of interest assurances under the University's conflict of interest policy.

I am not an inventor and never will be, so why do I have to do this?

There is no practical way of determining who may, in the future, create something that could be subject to the University's intellectual property policies. Inventions sometimes arise in unlikely settings and in unexpected ways. We have tried to make the process of signing and submitting the PAA as easy as possible to minimize your inconvenience.

What if I do not sign?

- Academic appointees: If you have not begun your appointment, your offer of appointment is contingent on your signature on the PAA; if you do not sign, your appointment will not become effective, your employment at the University may not commence, and you will not be paid. If you are a current appointee and do not sign, your term appointment may not be renewed unless you comply, or you may not receive raises or other discretionary compensation from the University (other than compensation to which you are now contractually entitled).
- Graduate students: If you are a graduate student and do not sign, your enrollment in classes for future quarters will be restricted.
- Undergraduate students: If you are an undergraduate student not employed by the University and do not sign when requested to do so to enable participation in a sponsored project, you will not be permitted to participate in the sponsored project. If you are an undergraduate student employed by the University, the requirements established for other University staff will apply.

What if I have questions before I sign?

If you have questions about the PAA, you should first contact your Dean of Students to seek clarification. They in turn can contact or refer you to the relevant administrative offices of the University, depending on the nature of the question.