

Frequently Asked Questions

University of Chicago Intellectual Property Agreement and Assignment (“IP Agreement”)

For Staff:

To comply with the provisions of the University’s intellectual property policies, all University staff are required to execute a “present assignment of future rights,” or Intellectual Property Agreement and Assignment (“IP Agreement”). Because it is not possible to determine in advance which staff members will create intellectual property covered by our policies, University staff are to execute the IP Agreement either at the time of accepting employment with the University or, if already employed, as soon as prompted through Workday but no later than the next date of compensation change.

Why is the University doing this now?

As stated in the University’s Statutes, “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.” For many of these developments to be effectively disseminated, the University must work with commercial entities who are willing to make large investments, for example, by running clinical trials. Increasingly, research sponsors are requiring grantees to develop structured practices relating to intellectual property, such as the signature of an intellectual property assignment by employees, to enable this to occur.

What is the IP Agreement?

The IP Agreement is an agreement between you and the University that confirms the rights that the University has in certain intellectual property by documenting the assignment of these rights to the University and specifying the related obligations of University staff. Except in unusual circumstances, you will be asked to sign the IP Agreement only once during your employment with the University.

Does the IP Agreement change or broaden the University’s policies regarding intellectual property?

The IP Agreement is consistent with the University’s existing intellectual property policies. By being employed by the University, all current staff employees are expected to comply with the University’s intellectual property policies. The IP Agreement does not change the scope of the University’s ownership of intellectual property created by staff. For example, under the University’s copyright policies, the ownership of copyrighted works created by staff employees are governed by the Copyright Act and other applicable law. Under the Copyright Act, a copyrightable work is a “work made for hire” when it is created by an employee within the scope of the employee’s employment, and the employer is considered the copyright owner of such work. The University is not seeking to obtain ownership of intellectual property that is clearly created outside the scope of staff members’ employment and the agreement does not apply to such intellectual property.

If I am already bound by the University’s intellectual property policies, why is the University now requiring a signed IP Agreement?

The IP Agreement is being implemented at the University to better affirm and evidence the rights to which it is entitled under its intellectual property policies. Recent court decisions (in cases not involving the University), 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 agreements.

I am not creating intellectual property and never will be, so why do I have to do this?

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

What if I do not sign?

If you are an incoming employee, your employment at the University is contingent on you signing your IP Agreement; if you do not sign, your employment will not become effective. If you are a current employee and do not sign, you may be subject to disciplinary action

based on your employment status, such as ineligibility for merit increases. Staff employees represented by a union will be subject to progressive discipline.

What if I have questions before I sign?

If you have questions about the IP Agreement, you should first contact your supervisor 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.

Examples

A staff member in a University communications department is given the assignment to take artistic photos of campus architecture for a University brochure. This work is within the scope of her employment and the resulting photos would be considered "works made for hire" and would be owned by the University along with the copyrights. If the photos were taken by a contractor instead of a staff member, the ownership would be governed by the agreement between the University and the photographer.

A Facilities Services staff member uses a University laptop to write fiction during nights and weekends. As fiction writing is not within the scope of his employment, and the use of the laptop is not considered a substantial use of University resources, the University does not own his fiction.

A technician in a University lab who is characterizing new semiconductor materials as part of the lab's research conceives of a method and device that dramatically increase the rate at which samples can be analyzed. They fabricate the device and test it using University resources. The invention is within the scope of their employment and substantial University resources have been used. The invention would be owned by the University.

A University accountant creates new accounting software using a University laptop outside of work hours. The software is not tested or deployed at the University and does not incorporate any confidential information of the University. Her University work responsibilities do not include writing software. The software was not written within the scope of her employment and substantial University resources were not used. The software would not be owned by the University.

A staff programmer works part-time at the University as part of a research team using AI to interpret the speech of dolphins. He also works part-time at a software company using AI to interpret

physicians' dictated recordings. **While writing code for the University, he develops an algorithm that he realizes would also be useful for the work at the company.** The algorithm was written within the scope of his University employment. Any intellectual property in the algorithm would be owned by the University. The software company would not own the intellectual property but could request a license from the University to access and use the algorithm. If the University does not obtain a patent covering the algorithm, the programmer would be free to recreate the algorithm for the company in newly written code using his general knowledge without the use of any University confidential information or other substantial resources of the University.

A staff programmer working in a University Computer Science research group writes software as part of a research project directed by a faculty member. The faculty member and staff programmer wish to release the code under an open source license. This work is within the scope of her employment and the resulting software would be considered a "work made for hire" and would be owned by the University. Subject to any constraints that may exist from any funding agreements under which the research was conducted, the code may be released under an open source license. (The Polsky Center can advise on the implications of the use of specific open source licenses.)