

## **FAQs for Signing the Revised Intellectual Property Agreement**

### ***What needs to be done?***

All employees and Associates need to sign the revised Intellectual Property Agreement. Please find the link to the form at <http://www.ameslab.gov/forms/intellectual-property-agreement>. Invention and reporting information can be found on the second page of the document. Please print out a copy of the revised Agreement, sign, and send the original copy to Ames Lab HR, 105 TASF.

### ***Why is this happening?***

A recent court ruling (Stanford v. Roche) has brought into question one of the provisions contained in the Intellectual Property Agreement (IPA) that Ames Laboratory employees and Associates signed upon accepting employment or participation as guests; that provision may no longer absolutely guarantee the timely assignment of rights to Iowa State University as intended. The new agreement also contains data rights protection and confidentiality clauses.

In order to meet our contractual obligations to the DOE, as well as those under sponsored research, all current employees and Associates will need to execute a revised IPA that will replace the IPA employees signed at time of initial hire or that Associates signed at the time of their initial start.

### ***How does this revision change the current IPA?***

The revision does not alter or diminish any of your individual rights as inventors; it merely completes the assignment of rights you agreed to at the time of your initial hire or start date. The original IPA stated that *I will assign* inventions that you conceive or develop to Iowa State University or to other recipients as specified in executed contracts or funding agreements. The revised form now states *I assign and hereby assign* such inventions to ISU or to other recipients as specified in executed contracts or funding agreements. A recent court case involving another institution interpreted similar language to that of the existing IPA as creating a "promise" to assign rights at some time in the future. As a result, the Supreme Court found a later assignment to a company took precedence over the earlier "promise" to assign, and awarded patent rights to the company instead. To address this, and avoid similar assertions in the future, we have chosen to revise the IPA by adopting the "hereby assign" language acknowledged by the court as creating an immediate assignment of future inventions.

### ***Who does this apply to?***

This applies to all Ames Laboratory employees and Associates - current and new.

***What is the court case and what does it say?***

For those interested in U.S. Supreme Court's ruling on *Stanford v. Roche*, please see <http://www.supremecourt.gov/opinions/10pdf/09-1159.pdf>.

***Is this a change in policy?***

No. There is no change in policy or in employee/Associate rights and entitlements in intellectual property they may be associated with.

***Do I have to sign the revised agreement?***

Yes. Under our Contract with the DOE, we are required to have employees assign their IP rights to the Contractor. The IPA that you signed as a new employee is a condition of your employment. If you are an Associate, you are also required to sign the IPA as a condition of your guest status with access to use Ames Laboratory facilities or contracts, grants or funds through the Lab. As a condition of employment or Associate status you are also required to sign documents requested by the Iowa State University Research Foundation (ISURF) and the Ames Laboratory for the purpose of confirming the University's rights in intellectual property you create.

***I'm an Associate. How does this revised agreement work with my obligations to my primary employer?***

Briefly, the IPA applies only to intellectual property that arises during the course of your utilization of any Ames Laboratory facilities or in connection with your use of any gift, grant, or contract research funds received through the Ames Laboratory. If you are an Associate working under an authorized agreement (e.g., a User Agreement, CRADA, Work for Others agreement or a Subcontract) between the Ames Laboratory and you or your current employer, and to the extent your activities fall within the scope of that Agreement, the provisions of that authorized Agreement take precedence over this revised IPA in the case of conflict.

Unless a particular Agreement you are working on states otherwise, all Ames Laboratory IP is assigned to the Iowa State University. If you are an Iowa State University employee and weren't affiliated with the Ames Laboratory, this would still be the case.

If you have any additional questions regarding how this IPA works along with any obligations you may have to your employer, please direct those questions to [joiner@ameslab.gov](mailto:joiner@ameslab.gov). In that email please let us know your Ames Laboratory host and if you are working here under a specific agreement such as a CRADA, Work for Others agreement or a Subcontract.

***Will signing this Amendment affect my consulting agreements?***

No. There is no change in our policies relating to approved compensated outside professional activity. The revised IPA applies only to intellectual property that arises within the course and scope of your University employment, during the course of your utilization of any University or

Ames Laboratory research facilities, or in connection with your use of any gift, grant, or contract research funds received through the University. Nevertheless, your obligation to disclose all inventions for ISURF to make a determination regarding assignment and ownership, including those that arise from outside professional activity, continues and is unchanged.

It is **strongly** suggested that if you are asked to sign a Consulting Agreement with a company, that you or your attorney review the IP clause, if any, of that agreement to make sure that it is not in conflict with the IPA that you have signed as an Ames Laboratory employee.

***What if I have other questions?***

Feel free to send any further questions to Stacy Joiner at [joiner@ameslab.gov](mailto:joiner@ameslab.gov) or call her at 4-5932.

Thanks for your participation and cooperation!