

## ASSIGNMENTS

“Assignment”, in general, is the act of transferring the title, ownership, and rights of one’s property to another. Intellectual property (such as inventions and patents), is an intangible type of personal property, and under patent law, patent applications have the attributes of personal property.

By signing the **Intellectual Property Agreement (IPA)** an employee assigns to the University the entire title, ownership and rights to all inventions resulting from research conducted at the University, with significant use of University resources. The IPA also establishes an obligation to execute all documents required to secure the protection of the invention.

In order to secure the protection of the invention, the UR may file a patent application or applications. While the IPA documents University ownership, best practice in patent law requires an **assignment** from the inventor(s) that identifies the patent application specifically by application number, inventor name, and invention title be filed with each patent application and recorded.

There is no specific language required to create an assignment. Our outside counsel will prepare and propose assignment documents to the inventor(s). While wording and formats may vary, these assignment documents will commonly:

- i. Be in writing
- ii. Identify the parties
- iii. Describe the subject matter
- iv. Identify the rights to be transferred
- v. Indicate clear intention to transfer rights
- vi. Be signed

The following are common examples. Some require a witness to the signature; some require notarization. One combines another patent office-required form (Inventor Declaration) with the assignment. “Consideration” is customarily described as good and valuable, or a nominal monetary amount, and represents the benefit gained from what is given. i.e. in exchange for the benefits of employment at the University, the inventor gives the rights to his/her invention to the University.

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### *Example no. 1*

#### **ASSIGNMENT**

**WHEREAS**, I, \_\_\_\_\_, a citizen of the United States of America, having a mailing address of \_\_\_\_\_, hereinafter generally referred to as "ASSIGNOR," have invented a certain new and useful \_\_\_\_\_ (title) for which I have executed U.S. Provisional Patent Application No. \_\_\_\_\_, filed \_\_\_\_\_ (Date).

**WHEREAS University of Rochester**, having a place of business at 601 Elmwood Avenue, Box URV, Rochester, NY 14642, hereinafter generally referred to as “ASSIGNEE”, is desirous of acquiring said invention and said patent application.

**NOW, THEREFORE**, in consideration of good and valuable executed consideration, the full receipt and sufficiency of all of which are hereby acknowledged and intending to be legally bound hereby, I, the undersigned ASSIGNOR, hereby agree to sell, assign, transfer and convey and by these presents does sell, assign, transfer and convey unto the above-named ASSIGNEE, the whole and entire right, title and interest

in and to said invention as described in the above patent application, for the territory of the United States and its possessions and territories and all foreign countries;

in and to the above patent application and any and all related United States and foreign patent applications disclosing said invention, including provisionals, non-provisionals, divisions and continuations thereof, along with all rights of priority created by said patent application under any treaty relating thereto; and

in and to all United States and foreign patents which may be granted on any and all of said patent applications, including extensions, reissues and reexamination certificates thereof;

said invention, application(s) and patent(s) to be held and enjoyed by the above-named ASSIGNEE, for ASSIGNEE's own use and benefit, and for ASSIGNEE's legal representatives and assigns to the full end of the term or terms for which said patent(s) may be granted, as fully and entirely as the same would have been held by the undersigned ASSIGNOR had this assignment and sale not been made; and for the aforesaid consideration ASSIGNOR hereby covenant, agree and undertake to execute, whenever requested by the above-named ASSIGNEE, all patent applications, assignments, lawful oaths and any other papers which ASSIGNEE may deem necessary or desirable for securing to ASSIGNEE or for maintaining for ASSIGNEE all the patent(s) hereby assigned or agreed to be assigned; all without further compensation to the undersigned ASSIGNOR.

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Date

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(Name)

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*Example no. 2*  
**ASSIGNMENT**

**WHEREAS I**, \_\_\_\_\_, of \_\_\_\_\_, hereinafter referred to as "ASSIGNOR", am an inventor of the invention described and set forth in the below identified U.S. Provisional Patent Application:

**Title:**

**U.S. Provisional Application No.**

**Filed:**

(the "Application"); and

**WHEREAS**, the **UNIVERSITY OF ROCHESTER**, located at 601 Elmwood Avenue, Box OTT, Rochester, N.Y. 14642, (hereinafter referred to as "ASSIGNEE"), wishes to acquire all of the rights, title and interest of ASSIGNOR therein to thereby become sole owner of said Application and invention and any Letters Patent to be issued thereupon;

**NOW, THEREFORE**, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged by ASSIGNOR, ASSIGNOR hereby assigns to ASSIGNEE, its lawful successors and assigns, all right, title, and interest of ASSIGNOR in and to the Application and to all foreign counterparts (including applications for patents, utility models and industrial designs), and in and to any Letters Patent and Registrations which may thereafter be granted on the same in the United States and in any and all countries throughout the world, and to claim priority from the application as provided by the Paris Convention. The right, title and interest is to be held and enjoyed by ASSIGNEE and ASSIGNEE's successors and assigns as fully as it would have been held by and enjoyed by ASSIGNOR and ASSIGNOR's successors and assigns had this assignment not been made, for the full

term of any Letters Patent, Registration, or other government grant which may be granted thereon, or of any divisional, continuation in whole or in part, substitution, conversion, reissue, prolongation or extension thereof.

ASSIGNOR further agrees that ASSIGNOR will, without charge to ASSIGNEE, but at ASSIGNEE's expense, (a) cooperate with ASSIGNEE in the prosecution of U.S. patent applications and foreign counterparts on the invention and any improvements, (b) execute, verify, acknowledge and deliver all such further papers, including patent applications and instruments of transfer, and (c) perform such other acts as ASSIGNEE may lawfully request to obtain or maintain Letters Patent, Registrations or other government grants for the invention and improvements in any and all countries, and to vest title therein in ASSIGNEE or ASSIGNEE's successors and assigns.

**IN WITNESS WHEREOF**, ASSIGNOR has signed this Assignment on the date indicated.

Dated: \_\_\_\_\_

Signed: \_\_\_\_\_  
[typed name]

Assignor's Assignment accepted on behalf of the University of Rochester by the undersigned authorized official:

Dated: \_\_\_\_\_

Signed: \_\_\_\_\_  
[typed name and title]

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*Example no. 3*  
**ASSIGNMENT**

Dkt.: \_\_\_\_\_

In consideration of One Dollar (\$1.00), and other good and valuable considerations, the receipt of which is hereby acknowledged, I/we, the undersigned,

Hereby sell, assign and transfer to **University of Rochester.**, a University of the State of NEW YORK, having a place of business at **601 Elmwood Ave., P.O. Box URV, Rochester, New York 14642**, its successors, assigns and legal representatives, the entire right, title and interest for all countries, in and to any and all inventions which are disclosed and claimed, and as possessed by the undersigned, any and all inventions which are disclosed but not claimed, in the application for United States Patent, which was executed by the undersigned on the date set forth below and is entitled

(TITLE)  
**(U.S. Application S.N. \_\_\_\_\_, filed \_\_\_\_\_)**

and in and to said application and all divisional, continuing, substitute, renewal, reissue, and all other applications for U.S. Letters Patent or other related property rights in any and all foreign countries which have been or shall be filed on any of said inventions disclosed in said application; and in and to all original and reissued patents or related foreign documents which have been or shall be issued on said inventions;

Authorize and request the Commissioner of Patents of the United States to issue to said Assignee, the corporation above named, its successors, assigns and legal representatives, in accordance with this assignment, any and all United States Letters Patent on said inventions or any of them disclosed in said application;

Agree that said Assignee may apply for and receive foreign Letters Patent or rights of any other kind for said inventions, or any of them; and may claim, in applications for said foreign Letters Patent or other rights, the priority of the aforesaid United States patent application under the provisions of the International Convention of 1883 and later modifications thereof, under the Patent Cooperation Treaty, under the European Patent Convention or under any other available international agreement; and that, when requested, without charge to, but at the expense of, said Assignee, its successors, assigns and legal representatives, to carry out in good faith the intent and purpose of this assignment, the undersigned or the undersigned's executors or administrators will, for the United States and all foreign countries, execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications or other documents on any and all said inventions; execute all rightful oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its successors, assigns and representatives, all facts known and documents available to the undersigned relating to said inventions and the history thereof; testify in all legal proceedings; and generally do everything possible which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing, maintaining and enforcing proper patent protection for said inventions and for vesting title to said inventions and all applications for patents or related foreign rights and all patents on said inventions, in said Assignee, its successors, assigns and legal representatives; and

COVENANT with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

Date: \_\_\_\_\_ [L.S.]  
 \_\_\_\_\_  
 (Inventor)

Witness: \_\_\_\_\_ [signature]  
 \_\_\_\_\_ [print name]  
 \_\_\_\_\_ [address]  
 \_\_\_\_\_

*Example no. 4*

ASSIGNMENT and DECLARATION OF INVENTORSHIP

Applicant:	
First Named Inventor:	
Attorney Docket No.:	
Application No.:	
Filed:	

TITLE: \_\_\_\_\_

FOR GOOD AND VALUABLE CONSIDERATION, I/we, the **JOINT INVENTOR(S)** and **ASSIGNOR(S)**: \_\_\_\_\_, residing at: \_\_\_\_\_

HEREBY ASSIGN(s) to the ASSIGNEE: \_\_\_\_\_, a \_\_\_\_\_ corporation existing under the laws of the State of \_\_\_\_\_, with a business mailing address at \_\_\_\_\_

ALL RIGHT, TITLE, AND INTEREST WORLDWIDE in and to the invention described in the above-identified US (provisional/nonprovisional) application entitled \_\_\_\_\_, [claiming priority to \_\_\_\_\_, filed \_\_\_\_]; and in and to said US patent application and all applications that may be filed on said invention anywhere in the world, including any and all divisions, reissues, continuations, and extensions thereof and in and to any Letters Patents, Inventors' Certificates, Design Registrations, Industrial Models, Utility Models, and all other forms of protection that may be granted thereon, including the right to file applications and the right to claim priority from the US application worldwide, and including the right to pursue and obtain any damages, recoveries, or remedies for past infringements of these protections.

**ASSIGNOR(S)** covenant(s) that no assignment, license, or encumbrance has been or will be made that would conflict with this Assignment.

**ASSIGNOR(S)** request(s) that all Letters Patents, Inventors' Certificates, Design Registrations, Industrial Models, Utility Models and all other forms of protection on said invention be issued to the ASSIGNEE, and **ASSIGNOR(S)** agree(s) to cooperate fully in obtaining and enforcing patent protection for said invention, including communicating any facts relating to said invention, signing lawful papers, and, at the request and expense of the ASSIGNEE, but without compensation, testifying in legal proceedings.

**INVENTOR(S EACH) HEREBY DECLARE(S):**

The Declaration is directed to the above-identified application \_\_\_\_\_.  
The referenced application was made or authorized to be made by me.

I believe I am (an original inventor) (an original joint inventor) of a claimed invention in the application.

I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

**My** mailing address is the same as my residence and is listed above below my name.

Dated: \_\_\_\_\_  
\_\_\_\_\_  
**(INVENTOR NAME)**

STATE OF \_\_\_\_\_ )  
COUNTY OF \_\_\_\_\_ ) <sup>ss</sup>

*On the \_\_\_\_ day of \_\_\_\_\_ in the year 2020, before me, the undersigned, a Notary Public in and for said State, personally appeared (INVENTOR NAME), personally known to me or proved to me on the basis of satisfactory evidence to be the individual whose name is subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their capacity, and that by his/her/their signature on the instrument, the individual, or the person upon behalf of which the individual acted, executed the instrument.*

\_\_\_\_\_  
Notary Public

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