

UW C4C recommends that the following paragraph be included in consulting agreements:

Company acknowledges that Consultant is employed by the University of Washington ("UW") and as a result has certain pre-existing obligations to UW, including obligations with respect to disclosure and ownership of intellectual property and obligations arising from sponsored research agreements between UW and third parties. Accordingly, Company and Consultant agree that to the extent this consulting agreement is inconsistent with any of Consultant's obligations to UW, including the reporting of all inventions developed during the period Consultant is employed by UW (regardless of where arising) and including contractual obligations arising under any sponsored research agreements between UW and third parties, then Consultant's obligations to UW shall prevail and to such extent any inconsistent provisions of this consulting agreement shall be deemed inapplicable and unenforceable. In performing this consulting agreement, Company and Consultant agree that Consultant shall not disclose or make any unauthorized use of any trade secrets or other confidential or proprietary information or in any way be authorized to convey any interest in any intellectual property developed or acquired as a result of consultant's employment by UW. Company and Consultant agree that this provision is being made for the benefit of and may be enforced by UW.

We in CSE find this way over the top in terms of phrasing. However, it is important to recognize two obligations that you *do* have as a UW employee:

1. You must avoid the leakage, through consulting, of intellectual property for which UW has ownership/responsibility under federal law. Every university that receives grants from the federal government subjects its employees to this restriction.
2. You must disclose to UW all inventions to which you contribute, even if these inventions occur in the context of consulting. This will allow UW to determine that no leakage has occurred.

The relevant text from the UW faculty code patent and copyright policy says:

University employees shall report all inventions and discoveries to the University's Office of Intellectual Property and Technology Transfer. As a condition of employment, and even if a specific patent agreement is not signed, University employees agree to assign all inventions in which the University has an interest to the University, to an invention management agency designated by the University, or to the sponsor if required under agreements governing the research. Employees shall execute documents of assignment and do everything reasonably required to assist the assignee(s) in obtaining, protecting, and maintaining patent or other proprietary rights. Students who are also employees, students working on a sponsored project, and students who have used University resources (other than for lecture-based coursework) shall also report all inventions

and discoveries to the University's Office of Intellectual Property and Technology Transfer and shall assign all such inventions and discoveries in the same manner as University employees. Inventions in which the University has an interest but which do not meet University criteria for patenting shall be managed in accordance with policies and procedures determined by the University Office of Intellectual Property and Technology Transfer. If and to the extent permitted by state law and other University policies, those procedures may include: (a) a mechanism by which the inventor(s) may personally pay patenting costs; (b) the formation of a commercial enterprise to pursue commercialization; and, under very rare circumstances, (c) the transfer, for appropriate consideration, of the patent rights to the inventor(s). These procedures shall be implemented at the discretion of the Vice Provost for Intellectual Property and Technology Transfer.

Although all inventions and discoveries must be reported to the Office of Intellectual Property and Technology Transfer, there are instances when the University may choose not to assert ownership. The University will not require assignment of interests for any invention for which no equipment, supplies, facilities, or trade secret information of the University was used and which was developed entirely on the employee's own time, unless (a) the inventions related (i) directly to the business of the University, or (ii) the University's actual or demonstrably anticipated research or development, or (b) the invention results from any work performed by the employee for the University.