

Ethics In Research: Intellectual Property Issues in Academia



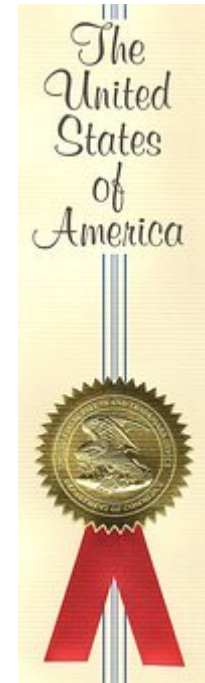
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Intellectual Property in Academia

Topics for Discussion:

- Patents
 - Public Disclosure
 - Duty of Candor and Good Faith
 - Inventorship
- Copyrights
 - Fair Use



DISCLAIMER: The following presentation is for educational purposes. Nothing in the presentation should be interpreted as legal advice.

Intellectual Property in Academia

Public Disclosure

1. Dissemination of knowledge is a cornerstone of academics.
2. But, disclosure of an invention may have adverse effects on your ability to procure IP protections under the law.
3. IP protection is not necessarily mutually exclusive with publication – timing is everything!!
4. ~\$3 Billion a year in University Licenses

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Public Disclosure and Patents

A person shall be entitled to a patent unless (a) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention

35 U.S.C. § 102(a)

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Public disclosures may include the following:

- Academic printed and online publications
- Abstracts
- Master's theses
- Ph.D. dissertations
- Open thesis defenses
- Presentations
- Poster sessions
- Department and campus seminars
- Non-confidential grant proposals (FOIA), and grant final reports

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The following are not typically Public Disclosure:

- Faculty Meetings – as long as they are attended only by KSU employees or covered under NDA
- Confidential Submissions for Publications – provided that the journal has confidentiality agreements with reviewers - prior to acceptance and publication
- Unfunded Government Grant Applications

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Mitigate Risk of Public Disclosure

- Consider filing a patent application prior to any public disclosure
- Protect through confidentiality and non-disclosure
- Where possible, present high-level, non-detailed summaries

- In the U.S., there is a 12 month grace period to file a patent application after public disclosure
 - Most countries outside the U.S. DO NOT have a grace period.

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Duty of Candor and Good Faith

Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section.

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Duty of Candor and Good Faith

On May 25, 2011, in *Therasense, Inc. v. Becton, Dickinson and Co.*, an en banc panel for the Court of Appeals for the Federal Circuit held... an accused infringer must show that the patentee knew of a reference, knew that the reference was material, and intentionally or deliberately failed to submit the reference.

Both materiality and intent must be proven by clear and convincing evidence.

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Prosecution History Estoppel

The Supreme Court of the United States held that a narrowing amendment made for reasons of patentability could give rise to an estoppel. And those “patentability reasons” include not just reasons relating to prior art, but also issues related to 35 U.S.C. §112 (e.g., written description, enablement, clarity, etc.). *Festo*, 122 S. Ct. at 1840, 62 U.S.P.Q.2d at 1712.

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Inventorship

The definition for inventorship can be simply stated: "The threshold question in determining inventorship is who conceived the invention. Unless a person contributes to the conception of the invention, he is not an inventor. ... Insofar as defining an inventor is concerned, reduction to practice, per se, is irrelevant [except for simultaneous conception and reduction to practice, *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993)].

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Inventorship

With regard to the inventorship of chemical compounds, an inventor must have a conception of the specific compounds being claimed.

"[G]eneral knowledge regarding the anticipated biological properties of groups of complex chemical compounds is insufficient to confer inventorship status with respect to specifically claimed compounds."); Ex parte Smernoff, 215 USPQ 545, 547 (Bd. App. 1982)

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Inventorship

One who suggests an idea of a result to be accomplished, rather than the means of accomplishing it, is not an coinventor.

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Copyright

The owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

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Copyright – Fair Use

...for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.