

MASS HIGH TECH

MT

THE JOURNAL OF NEW ENGLAND TECHNOLOGY

INSIDE IP LAW

Research collaborations: Avoiding possible traps

Research collaborations offer institutions the opportunity to achieve goals they might not accomplish on their own: breakthrough discoveries with manageable costs. Such collaborations permit the sharing of resources and ideas, but they can also bring with them risks concerning the intellectual property that grows out of the collaborative work. These risks are rooted in patent law governing inventorship and ownership of jointly created inventions.

Under U.S. patent law, scientists and engineers from separate institutions may be joint inventors of an invention even though they have not made the same type or amount of contribution to the patented subject matter. A person who contributes to the subject matter of a single claim of a patent is considered an inventor of the entire patent, and his or her employer may thereby become a co-owner of the patent. Joint inventors do not need to have physically worked together in the same laboratory or facility or even at the same time. An individual who participated in one phase of the research may be a joint inventor of patents arising out of a multiphase project, so long as he or she has made an inventive contribution to any feature ultimately claimed in the patent.

The rights to a patent are vested in the inventors or their assignees, and it is for this reason that joint inventorship results in co-ownership of a patent. The law further provides that unless there is an agreement to the contrary, each of the co-owners may practice the patented invention without the consent of and without paying the others.

Collaborating institutions can minimize the incentives for one institution to claim sole credit and ownership of patentable discoveries by entering into a joint development agreement at the beginning of the collaboration. Such agreements should do the following:

Define the collaboration. In order to protect the collaborative research results, enter into a written joint development agreement that defines the field of the collaboration. In the absence of such agreement, certain nonpublic information shared by researchers from separate institutions could be considered "prior art" to their joint work, rendering the results obvious and unpatentable.

Identify patent responsibilities. The agreement should set forth clearly which party is responsible for filing and prosecuting joint patent applications, and it should require the cooperation of all collaborators in those activities.

Require notice and disclosure of patent filings. To the extent that any collaborator retains the right to file patent applications within the field of collaboration, the agreement should require advance notice of the collaborator's intention to do so as well as disclosure of the proposed patent application.

Use a license to confirm shared rights. To avoid future disputes over inventorship, include cross licenses to patentable inventions in the defined field of collaboration, regardless of who is named as inventor on any given patent arising from the collaboration. This way, the collaborating institutions can agree in advance on who has the right to commercialize inventions on what terms, without risk that one of them will obtain and assert a blocking patent.

Negotiate royalty rates early. Negotiation of royalty terms in advance, including either

a specific rate or a range or cap, ensures that the parties share the same expectations and minimizes disputes.

Create a mechanism for dispute resolution. To avoid costly litigation, include provisions for resolving disputes over inventorship of joint research, such as private arbitration.

In addition to entering into a joint development agreement concerning the collaboration, each collaborating institution should do the following to protect its inventorship and ownership interests:

Obtain assignments from employees. All employees should be required to sign invention assignment agreements, transferring their rights to any inventions made during their employment. These agreements should also require cooperation in patent prosecution and litigation even after the employee leaves the institution. This eliminates an employee's incentive to stake a personal claim to an invention after it achieves commercial success and ensures cooperation in the event of later proceedings to enforce a patent.

Create and maintain good records. One institution should not rely on another to record the inventive contributions of its researchers. Each member of a research team should maintain his or her own laboratory notebook and should keep detailed notes of team meetings and discussions. Laboratory notebooks should be detailed and complete. Each entry should be dated and witnessed by another member of the team; if not, the laboratory notebook may lack corroborative value.

BARBARA FIACCO is a partner within the patent litigation practice group of Boston-based Foley Hoag LLP. She focuses on intellectual property disputes and has litigated and advised corporations on trademark, copyright and patent matters. She can be reached at bfiacco@foleyhoag.com.

GUEST COLUMN



Barbara Fiacco