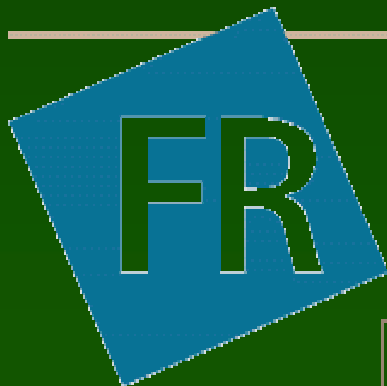


CREATE Act

NCURA, May 9, 2006

HEIDI E. HARVEY ESQ.

FISH & RICHARDSON P.C.



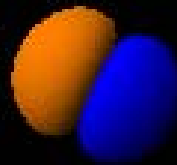
The Atomic Model-Hydrogen

Simple – 1 proton and 1 electron (1s¹)
(remember?)



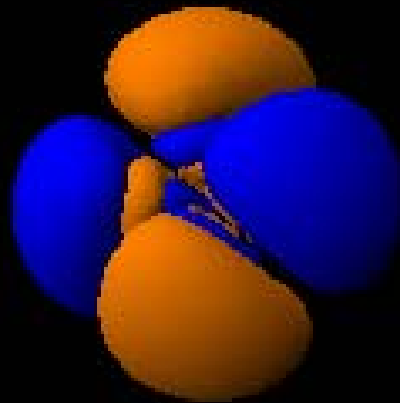
The Atomic Model - Helium

Understandable - Two protons/two electrons swirling around the center in separate but interacting orbits (1s²)



The Atomic Model--Nitrogen

Forget about it – 7 protons, a few neutrons
and a bunch of electrons ($1s^2, 2s^2, 2p^3$)



The Atomic Model--Nitrogen

Forget about it – 7 protons, a few neutrons
and a bunch of electrons ($1s^2, 2s^2, 2p^3$)



Some Basic Concepts: Inventor

An inventor is a human, not an institution

The inventor is the original owner of the invention

Ownership can only be transferred in writing

Some Basic Concepts: Patents

Each claim has separate inventorship

We cannot know who all the inventors are until the last patent issues

An inventor of a single claim owns the whole patent

Some Basic Concepts: Prior Art

The work of “another” collaborator could be prior art

BUT no prior art effect if

owned by the same person

OR

subject to common assignment obligation

CREATE Act¹

The CREATE Act:

“no prior art” effect for inventions made in scope of a pre-existing joint research agreement

Joint Research Agreement²

- Agreements that address ownership of inventions qualify
- Agreements that merely designate the work as joint research appear to qualify
- Agreements have to pre-date the invention

Joint Research Agreement: Questions

- If the agreement pre-dates the invention, does the writing have to? [Probably...]
- What does “person” mean? [Human]
- Do the inventions have to actually be commonly owned? [No]

Example 1³

2002: Joint Research Agreement between Company A and University B

2003: Professor BB from University B communicates invention X to Company A and files patent application on X.

2004: Company A files a patent application disclosing and claiming invention Improved X, which was made pursuant to JRA and is an obvious variant of invention X.

Result: 103 (c) applies and earlier patent application is not prior art as work of “another”*, even if University owns 100% of X and Company A owns 100% of Improved X

Example 2³

2003: Professor BB from University B communicates invention X to Company A and files patent application on X.

2004: Company A files a patent application disclosing and claiming invention Improved X, which was made pursuant to JRA and is an obvious variant of invention X.

2005: Joint Research Agreement between Company A and University B

Result: 103 (c) does not apply and earlier patent application may be prior art as work of “another” despite current Joint Research Agreement

Example 3: From the mind (desk) of Heidi

2003: Joint Research Agreement between Company A and University B is PROPOSED (written draft)_

December 9, 2004: Professor BB from University B communicates invention X to Company A and files patent application on X

December 10, 2004: Company A files a patent application disclosing and claiming invention Improved X, which was made pursuant to the PROPOSED JRA as a result of the efforts of Consultant to C to Company B and is an obvious variant of invention X.

January 2005: Consultant C has a falling out with Company B and leaves without signing any assignments or contracts

2005: Company A and University B sign Joint Research Agreement making it retroactive to the beginning of the collaboration (2003)

Result:

The Atomic Model--Nitrogen

Forget about it – 7 protons, a few neutrons
and a bunch of electrons ($1s^2, 2s^2, 2p^3$)



Contact Information

- Questions, or to receive slides and appendix of citations by e-mail:
- harvey@fr.com

Footnotes

1. 35 U.S.C. Section 103(c)(2) (effective December 10, 2004):

For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if -

- (A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;
- (B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and
- (C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

Footnotes (cont.)

2. 35 U.S.C. Section 103(c)(3):

For purposes of paragraph (2), the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

Footnotes (continued)

3. Manual of Patent Examining Procedure,
Section 706.02(I)(2)
www.uspto.gov/web/offices/pac/mpep/index.htm