Five Things Every Academic Researcher Should Know About Patents

Mark D. Janis
Robert A. Lucas Chair of Law
Director, Center for Intellectual Property Research
Indiana University Maurer School of Law (Bloomington)
mdjanis@indiana.edu

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- inventorship is a legal determination – e.g., *Vanderbilt Univ. v. ICOS Corp.* (Fed. Cir. 2010)
- no presumption that co-authors are co-inventors
inventor is NOT one who merely
-identifies general problem/objective
-explains the state of the art
-creates a prototype of the invention based on instructions from others
-supervises the inventor

-e.g., Bd. of Trustees of Florida State Univ. v. American Bioscience, Inc. (Fed. Cir. 2003)
inventor is one who
-contributes to “conception” of subject matter of at least one “claim”

-e.g., *Falana v. Kent State Univ.* (Fed. Cir. 2012) (post-doc researcher contributed to conception of class of compounds and so should have been listed as a co-inventor)
Why this matters. . .
> in collaborations with non-IU personnel
  - ownership

> in collaborations with IU personnel
  - revenue distribution under IU IP policy
2. “I need to get a U.S. patent. Send me the online form to file.”
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3. “On second thought, make it a global patent. Send me the form for filing at the World Patent Office.”
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• Regular application
  • specification
  • claims

• Provisional application
  • specification only. . .but must be converted to a regular (with claims) within a year
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3. “On second thought, make it a global patent. Send me the form for filing at the World Patent Office.”

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- patents available only to a person who “invents or discovers” something – 35 U.S.C. § 101
- if a non-inventor files, the true inventor can institute a “derivation” proceeding at the PTO – 35 U.S.C. § 135
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- no doctrine of patent “fair use” comparable to copyright fair use
- unauthorized use of a patented invention in an academic lab for “experimental” purposes is likely to be deemed infringement – *Madey v. Duke University* (Fed. Cir. 2002)
Resources – Center for Intellectual Property Research

- pro-bono IP Clinic for start-ups
- research symposia on IP
- programs on IP for IU faculty/students

ip.indiana.edu