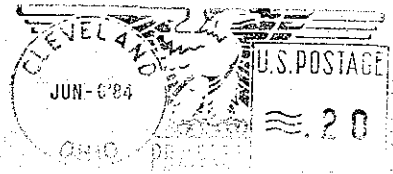


SUPA Newsletter

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SOCIETY OF UNIVERSITY PATENT ADMINISTRATORS

Fundamentals of Patent Law and Licensing

St. Louis, MO

June 11, 12, 13, 1984

Registration Form

NAME: _____

TITLE: _____

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Please check the selected registration category and enclose registration fees (U.S. currency) with this registration form.

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SUPA Member _____ \$ 90.00

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Non-member registrants wishing to join SUPA may fill out the membership application available at the registration desk. Upon approval of the application by the Membership Committee, such applicants will be deemed to have paid their dues as part of the course registration fee.

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(215-898-7293)

SUPA Newsletter

Quarterly Publication of the Society of University Patent Administrators

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PRESIDENT'S MESSAGE

BY SPENCER L. BLAYLOCK

As newly elected President for SUPA, and as one of my first orders of business, I would like to thank Todd Eachus for doing an outstanding job in arranging the program for the annual meeting last February in Washington, D.C. I would also like to thank Al Broseghini for arranging and moderating the Elements of Licensing course.

The mock negotiating session devoted itself to negotiating a limited partnership R&D agreement between a research university and a biotechnology firm. The two negotiating teams were presenting a negotiation they had already participated in with each other. They are to be congratulated for an excellent job.

Our Society continues to grow. There were 249

registered for the annual meeting, and we now have over 300 members for 1984.

In another article in this Newsletter, Al Broseghini describes an educational course arranged for June in St. Louis.

Our next annual meeting will be held at the Capitol Holiday Inn in Washington, D.C., on February 3-5, 1985. We look forward to an even larger registration.

Bob Custard and Ralph Pinto, having completed their terms as trustees, Jim Brown as Treasurer, Phil Dufour as Vice-President-East, and Cynthis, Vice President-West, were thanked by the membership for their contributions and efforts on behalf of the Society. I look forward to serving as your President for the years 1984 and 1985.

SUPA Offers Course

The SUPA Education Committee has scheduled a two-and-one-half-day course on patent law and administration at the Sheraton-St. Louis on June 11, 12 and 13. Staff for this course represent both university and industry.

See registration form on page 4 of this newsletter.

On Monday, June 11, the program will consist of a comprehensive

review of patent law directed toward the needs of university patent administrators. Following lunch, attendees will have an opportunity to discuss material covered in the morning sessions.

On Tuesday, June 12, the licensing function of university patent administrators will be discussed. Specific licensing problems will be examined.

On Wednesday, June 13, the staff

will discuss the role of a university technology transfer office in identifying patentable technology, evaluating disclosures, working with patent attorneys and establishing a licensing program. This third session is scheduled to conclude no later than 12 noon.

SUPA NOTES

Members are encouraged to send in items for the Newsletter that would be of interest to other SUPA members. Notices of positions relating to patent and licensing administration will be accepted.

Do you have questions about technology transfer? We encourage you to submit questions and we will do our best to provide answers.

Publication of the question and answer will depend on the general interest and availability of space. Send your questions to the Editor.

Any member wishing to serve on a SUPA Committee, should write to the Committee Chairperson. The names of Chairpersons and their committees will be announced in later issues of the SUPA Newsletter.

The Society of Research Administrators upcoming meetings:
June 10-13, 1984 — "ADMINISTRATION IN THE RESEARCH ENVIRONMENT: COMPLEMENT OR IMPEDIMENT?" Western Section Regional Meeting, Sahara Tahoe, Lake Tahoe, Nevada

Sept. 23-26, 1984 — 18th Annual Meeting, Hotel Del Coronado, Coronado, California.

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1984-1985

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Legislation Notes

HOWARD W. BREMER, Chairman, Legislative Affairs Committee S.1538, which authorizes the Commissioner of Patents and Trademarks to publish a "statutory invention recording" for which the inventor merely seeks "defensive rights" was reported out of the Judiciary Committee with an amendment by Senator De Concini. The amendment would ordinarily require use of statutory invention recording procedure for any inventions where the government has right of ownership that do not have commercial potential.

S.1535—Hearings were held on

April 3. This bill addresses a variety of patent issues. The reforms of S.1535 are included in House Bills H.R.4524 to H.R.4529 (Legislative Committee Report, January 1984—distributed at Annual Meeting).

Of particular interest to the university sector are the equivalents of H.R.4526, which would make the importation, sale or use in the United States of a product made in another country (H.R.3577 would apply to products wherever made) by a process patented in the United States an infringement of the patented process, and that a product patent could not be avoided by manufacturing components in this country and shipping abroad for assembly. From a patent licensor's standpoint, H.R.4529 which would permit a patent licensor to receive royalty payments during the time

the licensee is challenging the patent's validity.

(H.R.4814 is essentially the same as H.R.4526, except it omits the requirement that the infringer know the product was made by a process patented in the United States before damages could be awarded.)

H.R.3462 would exempt independent inventors, small businesses, and nonprofit organizations from paying maintenance fees.

H.R.5003 (Fuqua, Fla.) would, except in exceptional circumstances, permit government contractors to elect to retain title to federally funded inventions. (Parallels H.R.4964 but drafted so it would be referred to Science and Technology Committee.)

NEWSLETTER COMMITTEE

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The SUPA Newsletter is published quarterly in Cleveland, Ohio. Copy for publication should be sent to the Editor by the 15th of the month previous to publication dates, March 15, June 15, September 15, December 15.

A reminder to members that corporations are invited to join SUPA as non-voting associate members. Associate memberships give corporate and university personnel more opportunities to discuss items of value to both.

* * *

PREJUDICE TO PATENT RIGHTS AS A RESULT OF NEWS RELEASES

One of the basic principles of patenting inventions is that inventors should proceed diligently with the filing and prosecution of the patent application, if they intend ever to do so. Otherwise, damage to the public results because the time when the valuable invention is disclosed to the public through a published patent is delayed, and the time when the invention is free of the seventeen-year right to exclude conveyed by the patent grant is prolonged.

In furtherance of this general purpose, under U.S. law an inventor has a one-year grace period in which to file a patent application following the occurrence of any one of several triggering events, discussed in turn below. (Nevertheless, it is highly preferable to file a patent application before any of the triggering events have occurred in order to preserve foreign patent rights, as also discussed below.)

Four of these triggering events are set forth in 35 U.S.C. § 102(b), which is known as the "statutory bar" provision in the U.S. patent laws. Specifically, the following are the triggering events:

- 1) Patenting the invention in any country.
- 2) Describing the invention in a printed publication in any country.
- 3) "Public use" in the United States.
- 4) "On sale" in the United States.

Although the above listing seems simple enough, there are a great many decided cases interpreting exactly what these terms mean in light of various circumstances. Additionally, although not specifically mentioned in the patent statutes, the "public use" and "on sale" bars both have an exception known as the "experimental use doctrine."

In the U.S. we are relatively fortunate to have the one-year grace period. In most foreign countries, particularly the major European industrial countries, there is no such exception. Rather, they have what is known as an "absolute novelty" requirement as of the day the patent application is filed.

In the usual circumstance, the three triggering events to be most wary of are (2) described in a printed publication anywhere, (3) public use in the United States, and (4) on sale in the United States.

Considering first a printed publication, the damaging effect is potentially two-fold: what the publication itself says, and where it may lead a person who requests further information after having read the publication.

Analysis of the first potentially damaging effect can be relatively straight-forward. Simply put, in order to trigger the statutory bar provision of 35 USC §102(b), a printed publication must describe the invention in a manner which is adequate to a person with ordinary skill in the art to

which the invention pertains.

Moreover, by the weight of authority, the description must enable such a person not only to comprehend the invention, but also to make it.

On this basis, very often a press release intended for the public in general and containing only sketchy information will likely not trigger the statutory bar provision. On the other hand, in most cases articles published in technical journals, or even well-written abstracts, will constitute a triggering event.

The second way in which a published article is potentially damaging arises in situations where a member of the public in general reads the publication, and then requests additional information. Depending upon the policies of the particular organization, additional, more detailed, information may or may not be forthcoming. While the disclosure of such additional information may not itself fall neatly within any of the defined triggering events, it may well constitute a disclosure of a public nature and of a type which shortly leads to one of the specific triggering events. Once in the hands of third parties, anything might happen, such as the information being incorporated in detail in another article, or a device being made and put on public use, or a device being made and put on public sale.

As a related aside, inventors should be aware that what is thought to be the substance of even a "private" conversation may eventually find its way into print.

General interest articles on a particular subject are one form of publication which can result from a press release. Another form of publication is a listing or identification of research proposals which have been granted funding. In many cases, the underlying proposals may be quite detailed. Depending upon the institution, a member of the public reading of the funding of a particular project may be able to readily receive a copy of the entire proposal.

Finally, inventors should be aware that acts of "public use" or placing an invention "on sale", even in the absence of any printed publication, can trigger the beginning of the one-year grace period. Therefore, premature public demonstrations of any invention are certainly to be avoided.

In summary, all inventors should be well aware of these basic patent law principles concerning ways in which rights to patent an invention, either in the U.S. or in foreign countries, can be lost through premature description in a publication, public use, placing on sale, or being made publicly available in a manner which might lead to one of these statutory triggering events.—by Steven C. Schnedler, member of the firm of Kerkam, Stowell, Kondracki and Clarke, Washington, D.C.