



Assignments, Declarations & POA's, Oh My! Managing the Ownership of Your Institution's Patent Portfolio

Welcoming remarks will begin at
11:55 a.m. Eastern Time.

The formal presentation will begin at Noon Eastern

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Assignments, Declarations & POA's, Oh My! Managing the Ownership of Your Institution's Patent Portfolio

Speakers:

Daniel Goldberg, *Meagher Emanuel Laks Roehling & Goldberg, LLP*
Janis Elsner, *Vanderbilt University*

November 7, 2013

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Questions?

**We will be taking questions at the
conclusion of the presentation.**

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- AUTM Salary Survey
- AUTM Technology Transfer Practice Manual
- AUTM Licensing Activity Survey (currently for United States and Canada)
- AUTM Update

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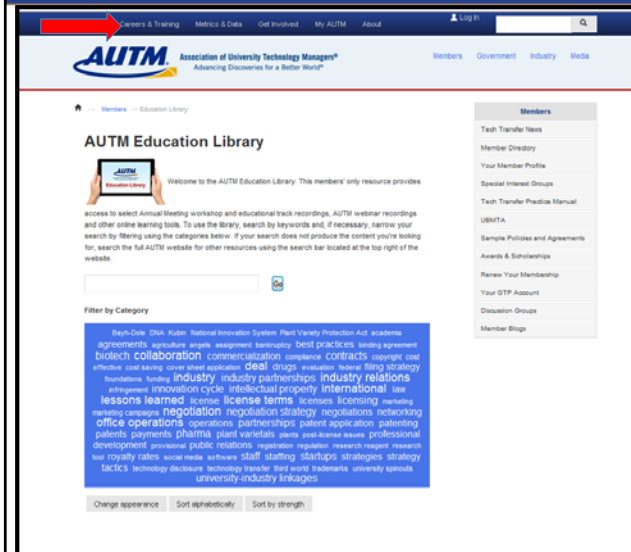
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- Special Interest Groups (SIGS)
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- Updates on legislative activity and how it affects you
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The screenshot shows the AUTM Education Library page. At the top, there is a navigation bar with links for 'Careers & Training', 'Media & Data', 'Get Involved', 'My AUTM', and 'About'. Below this is the AUTM logo and a search bar. The main heading is 'AUTM Education Library'. A welcome message states: 'Welcome to the AUTM Education Library. This members' only resource provides access to select Annual Meeting workshop and educational track recordings, AUTM webinar recordings and other online learning tools. To use the library, search by keywords and, if necessary, narrow your search by filtering using the categories below. If your search does not produce the content you're looking for, search the full AUTM website for other resources using the search bar located at the top right of the website.' Below the message is a search input field and a 'Filter by Category' section with a list of keywords including 'BioTech', 'collaboration', 'commercialization', 'contracts', 'copyright', 'cost saving', 'energy', 'innovation', 'industry', 'international', 'law', 'negotiation', 'operations', 'partnerships', 'patent', 'payments', 'pharma', 'plant', 'varieties', 'public', 'relations', 'regulation', 'research', 'royalty', 'software', 'staff', 'startups', 'strategies', 'strategy', 'technology', 'transfer', 'world', 'statements', 'university', 'spinoffs', and 'university-industry linkages'. At the bottom, there are options to 'Change appearance', 'Sort alphabetically', and 'Sort by strength'.

Introducing AUTM's newest member benefit

AUTM Education Library

Seeded content:

- 23 Annual Meeting workshop recordings
- 10 relevant links to the TTP Manual
- 5 educational webinar recordings
- Additional content added annually by committee

<http://www.autm.net/source/ed-library/index.cfm>

Member Benefits

The AUTM Global Technology Portal (GTP)



The screenshot shows the AUTM Global Technology Portal (GTP) website. At the top, there is a navigation bar with links for 'Home', 'Organizations', 'Technologies', 'Needs', 'Capabilities', 'Startups', 'Success stories', and 'People'. Below this is the AUTM logo and a search bar. The main heading is 'The AUTM Global Technology Portal (GTP)'. A welcome message states: 'Welcome to the AUTM Global Technology Portal, where you can easily find the latest university technologies available for licensing worldwide.' Below the message is a large image of a hand holding a blue folder. To the right of the image is a 'Technologies' section with two items: 'Low-Temperature, Corrosion-Resistant Integrated Heat Exchangers to Improve Efficiency of Coal Plants' and 'Controlling and Predicting the Stability of a Protein Against Degradation by Proteases'. At the bottom, there is a 'Get ready for the AUTM 2012 Annual Meeting by posting your technologies and capabilities' button.

AUTM Global Technology Portal



If you're an **AUTM member**, you're already signed up for the GTP. Simply login with your AUTM member login and password.

GTP.AUTM.NET



Daniel Goldberg,
Partner

*Meagher Emanuel Laks Roehling
& Goldberg, LLP*



Janis Elsner,
*Director of Commercial
Operations*

Vanderbilt University

**Assignments, Declarations & POAs, Oh My!
Managing the Ownership of your
Institution's Patent Portfolio**

The following presentation reflects the personal views and thoughts of Daniel Goldberg, and is not to be construed as representing in any way the corporate views or advice of the Meagher Emanuel Law Firm and their Affiliates, Subsidiaries or Divisions, nor the views or advice of the Association of University Technology Managers (AUTM). The content is solely for purposes of discussion and illustration, and is not to be considered legal advice.

Overview

- Stanford v. Roche
 - Key Points from Fed Cir Decision
 - The Bayh-Dole Act
 - Supreme Court's decision
 - Important Take Away Points
- Changes in Law – 1980
- Example University IP Policy
 - Annual Compliance Requirement
 - Invention Disclosure Form Assignment
 - Inventor's Oath or Declaration
 - Power of Attorney (POA)

Stanford v. Roche



- The US Supreme Court rendered the Stanford v. Roche decision in 2011.
- This decision had an immediate impact on the way research universities secure ownership of inventions.

Stanford v. Roche (Factual Background)

- The parties relevant to the dispute
 - **Cetus**: a research company with expertise in PCR (polymerase chain reaction)
 - **Roche**: acquired Cetus's PCR-related assets
 - **Dr. Holodniy**: an Inventor and Stanford University research fellow
 - **Stanford University**: research university conducting research on HIV measurement techniques

Stanford v. Roche (Factual Background)

- 1988 - Dr. Holodniy joined Stanford as a research fellow
 - Dr. H signed Stanford's Copyright and Patent Agreement ("CPA") and "agree[d] to assign" to Stanford his "right, title and interest in" inventions resulting from his employment
- 1988 - Dr. H's supervisor arranged for him to conduct research at Cetus to learn about PCR
 - Dr. H signed a 2nd agreement - Visitor's Confidentiality Agreement ("VCA") stating that he "will assign and do[es] hereby assign" to Cetus his "right, title and interest in . . . the ideas, inventions, and improvements" made "as a consequence of [his] access" to Cetus.
- Dr. H's research results in three patented methods (HIV quantification)
- 1991 - Roche purchases Cetus
- 1995 - Roche conducts clinical trials on the HIV quantification method and then began to commercialize - HIV detection kits
- 2000-2004 - Stanford attempts to negotiate an exclusive license of the patents to Roche

Stanford v. Roche (Procedural Background)

- 2005 - Stanford Files Patent Infringement Suit - alleges Roche's HIV detection kits infringe the 3 patents
- District court ruled:
 - a) patents invalid for obviousness; and
 - b) Roche ≠ co-owner (Bayh-Dole Act voided the 2nd assign)
- On appeal, the Federal Circuit
 - a) reversed the district court's ruling on Roche's co-ownership defense; and
 - b) remanded the case with instructions to dismiss it because Stanford lacked standing

Key Points from Fed Cir Decision

- Stanford's CPA agreement: "Agree to assign" means "a mere promise to assign rights in the future, not an immediate transfer of expectant interests." That is, a subsequent written instrument is required.
- Cetus' VCA: "Do hereby assign" means "a present assignment of ... future invention."

U.S. Supreme Court

- Question Presented
 - Whether a federal contractor university's statutory right under the Bayh-Dole Act, 35 USC 200-212, in inventions arising from federally-funded research can be terminated unilaterally by an individual inventor through a separate agreement purporting to assign the inventor's rights to a third party.

The Bayh-Dole Act

- University and Small Business Patent Procedures Act of 1980 (35 U.S.C § 200-212, 37 C.F.R. 401)
- Replaced a complex set of federal policies focused on the government owning any inventions made in whole or in part with government funding (resulting in almost no commercialization of such inventions)
- Includes a list of requirements including:
 - Report the invention to the sponsoring agency;
 - Elect in writing whether or not to retain title;
 - Assign rights in the invention to the organization;
 - File initial patent application within one year after election to retain title;
 - Notify the government if prosecution will not continue;
 - Grant to the government a nonexclusive, nontransferable, irrevocable, paid-up license ...

Supreme Court's decision

- The Bayh-Dole Act does not automatically vest title to inventions in federal contractors
- Title to the invention vests initially in the inventors
- Inventors must assign their patent rights to the contractor to trigger Bayh-Dole

Supreme Court's decision (cont.)

- Bayh-Dole Act - Statutory language does not support automatic vesting of title in the contractor
 - Each nonprofit organization or small business firm may ... ***elect to retain title*** to any subject invention..." § 202(a).
- Explicit language divesting inventors of their rights is missing from the Bayh-Dole Act

Important Take Away Points

- Watch your Assignment Language – use a present assignment of patent rights
- Make sure your researchers do not sign any agreements when conducting off-site research
- Review any visitor/confidentiality agreements for IP clauses
- If possible negotiate IP rights with any outside labs or facilities in advance

Assignments, Declarations & POAs, Oh My! Managing the Ownership of your Institution's Patent Portfolio

Janis Elsner, CLP
Director of Commercial Operations
Vanderbilt University

The following presentation reflects the personal views and thoughts of Janis Elsner and is not to be construed as representing in any way the corporate views or advice of Vanderbilt University or their Affiliates, Subsidiaries or Divisions, nor the views or advice of the Association of University Technology Managers (AUTM). The content is solely for purposes of discussion and illustration, and is not to be considered legal advice.

Invention Rights – Universities and Federal Labs

- What ownership rights does institution have
- Institutional policies and directives
- Ways and means to perfect property rights
- USPTO requirements and recommendations

Changes in Law - 1980

- Bayh-Dole Enacted; Public Law 96-517
 - 37 CFR 401.14(f)(2)
The contractor agrees to require, by written agreement, its employees, other than clerical and nontechnical employees, to disclose promptly in writing to personnel identified as responsible for the administration of patent matters and in a format suggested by the contractor each subject invention made under contract in order that the contractor can comply with the disclosure provisions of [paragraph \(c\)](#), above, and to execute all papers necessary to file patent applications on subject inventions and to establish the government's rights in the subject inventions.
- Stevenson-Wydler Technology Innovation; Public Law 96-480
- Federal Technology Transfer Act of 1986 (Public Law 99-502) - amended Stevenson-Wydler. Mandate for Federal labs to actively transfer technology and enter CRADAs

37 CFR Part 501 - UNIFORM PATENT POLICY FOR RIGHTS IN INVENTIONS MADE BY GOVERNMENT EMPLOYEES

§ 501.6 Criteria for the determination of rights in and to inventions.

(a) The following rules shall be applied in determining the respective rights of the Government and of the inventor in and to any invention that is subject to the provisions of this part:

(1) The Government shall obtain, except as herein otherwise provided, the entire right, title and interest in and to any invention made by any Government employee:

- (i) During working hours, or
- (ii) With a contribution by the Government of facilities, equipment, materials, funds or information, or of time or services of other Government employees on official duty, or
- (iii) Which bears a direct relation to or is made in consequence of the official duties of the inventor.

Know Your University IP Policy

- Identify property rights of your institution
 - Patents
 - Are all patentable inventions of its employees included?
 - Are there carve-outs?
 - Copyrights, if so, what type? (software, courseware, protocols, technical drawings, etc.)
 - Materials
- Are all creators (faculty, staff, graduate students, fellows, etc.) required to assign rights?

Perfecting the Institution's Rights

- Medium/mechanism for conveyance of rights
 - Employment contracts
 - Language for present assignment
- Timing for conveyance of rights
 - With patent application filing
 - Before out-licensing the invention/property rights
 - Representations and warranties
 - Make sure you know what property rights you actually have
 - Outliers
- Documentation

Vanderbilt Experience

- Intellectual Property Policy
- Invention disclosure form includes assignment
- Annual compliance reports - Required
 - Conflict of interest
 - Affirmation of assignment
- Explain the necessity to inventors

Annual Compliance Requirement - Snapshot

Check the box to indicate your agreement

- The Vanderbilt Policy on Technology and Literary and Artistic Works (the "Technology Policy") covers the ownership, protection and transfer of inventions, computer programs and software, and scholarly works made by Vanderbilt faculty, staff and students. It is necessary for such individuals to attest annually to issues related to compliance with the Technology Policy. As stated in the Technology Policy, subject to the exceptions set forth below, all rights in technology created by Vanderbilt faculty members, staff members, or students (i) with the use of University facilities or funds administered by the University, or (ii) which fall within the individual's scope of employment, are granted to the University, with income to be distributed in accordance with the terms of that policy. In accordance with the Technology Policy, I hereby assign to Vanderbilt all right, title and interest I now have or will have in the future in and to any patent, copyright and other intellectual property right covering any invention, software or other Technology created or authored by me while employed at Vanderbilt University.

Invention Disclosure Form Assignment - Snapshot

For good and valuable consideration, as described in the Policy on Technology and Literary and Artistic Works in the Vanderbilt University Faculty Manual, the sufficiency and adequacy of which are hereby acknowledged, **I agree to assign and hereby do assign**, sell, and transfer unto VANDERBILT UNIVERSITY, whose post-office address is 305 Kirkland Hall, 2201 West End Ave., Nashville, TN 37240, U.S.A., my entire right, title and interest in and to the inventions disclosed herein and related thereto, including but not limited to any associated intellectual property rights. I hereby agree to execute without further consideration any and all applications, petitions, oaths and assignments or other papers and instruments which may be necessary in order to carry into full force and effect, the sale, assignment, transfer and conveyance hereby made or intended to be made. I hereby agree that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment. I further represent that to the best of my knowledge, the information provided herein and in the body of the Invention Disclosure, is true and accurate, and I agree to promptly disclose to the Center for Technology Transfer and Commercialization any updated or new information relating to the disclosed technology hereunder.

- ***I have read and reviewed the information contained in the Disclosure Form and Assignment of Rights Form and agree that all information, including contributor information, is accurate to the best of my knowledge.***

AIA: Inventor's Oath or Declaration

Sec. 4. § 115

An Inventor must state in his/her oath/declaration that:

- (i) he/she is an original inventor of the claimed invention;
- (ii) he/she authorized the filing of the patent application for the claimed invention; and
- (iii) he/she hereby acknowledges that any willful false statement made in this declaration is punishable under 18 USC 1001 by fine or imprisonment of not more than five (5) years, or both.

An inventor is no longer required to:

- (i) state that he/she is the first inventor of the claimed invention;
- (ii) state that the application filing is made without deceptive intent; or
- (iii) provide his/her country of citizenship.

AIA Inventor Oath/Declaration - Options

- Maintain current practices (Oath and Declaration naming entire inventive entity)
- Use Application Data Sheet (ADS)
 - Non-provisional applications
 - To identify applicants who are NOT inventors (special section)
 - Must record assignment no later than payment of issue fee
 - Each inventor can execute separate declaration using form PTO/AIA/01 but ADS must identify the entire inventive entity
 - Declaration filing can be postponed until allowance
 - Submit new AIA fillable ADS form PTO/AIA/14 **with filing** (attorney completes)
 - Auto uploads info into USPTO (saves USPTO staff time of manual entry)
 - Claim benefit of priority
 - Include Declarations and avoid a surcharge (\$70 small entity)

PTO/AIA/14
Partial form

PTO/AIA/14 (03-13)
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 U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76		Attorney Docket Number	
		Application Number	
Title of Invention			

The application data sheet is part of the provisional or nonprovisional application for which it is being submitted. The following form contains the biographic data arranged in a format specified by the United States Patent and Trademark Office as outlined in 37 CFR 1.76. This document may be completed electronically and submitted to the Office in electronic format using the Electronic Filing System (EFS) or the document may be printed and included in a paper filed application.

Secrecy Order 37 CFR 5.2

Portions or all of the application associated with this Application Data Sheet may fall under a Secrecy Order pursuant to 37 CFR 5.2. (Paper filers only. Applications that fall under Secrecy Order may not be filed electronically.)

Inventor Information:

Inventor 1 Remove				
Legal Name				
Prefix	Given Name	Middle Name	Family Name	Suffix
Residence Information (Select One) <input checked="" type="radio"/> US Residency <input type="radio"/> Non US Residency <input type="radio"/> Active US Military Service				
City	State/Province	Country of Residence		

Mailing Address of Inventor:

Address 1	
Address 2	
City	State/Province
Postal Code	Country

All Inventors Must Be Listed - Additional Inventor Information blocks may be generated within this form by selecting the **Add** button. Add

PTO/AIA/14
Partial form

PTO/AIA/14 (03-13)
 Approved for use through 01/31/2014. OMB 0651-0032
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Application Data Sheet 37 CFR 1.76		Attorney Docket Number	
		Application Number	
Title of Invention			

Applicant 1 Remove

If the applicant is the inventor (or the remaining joint inventor or inventors under 37 CFR 1.45), this section should not be completed. The information to be provided in this section is the name and address of the legal representative who is the applicant under 37 CFR 1.43; or the name and address of the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter who is the applicant under 37 CFR 1.46. If the applicant is an applicant under 37 CFR 1.46 (assignee, person to whom the inventor is obligated to assign, or person who otherwise shows sufficient proprietary interest) together with one or more joint inventors, then the joint inventor or inventors who are also the applicant should be identified in this section. Clear

Assignee Legal Representative under 35 U.S.C. 117 Joint Inventor

Person to whom the inventor is obligated to assign. Person who shows sufficient proprietary interest

If applicant is the legal representative, indicate the authority to file the patent application, the inventor is:

Name of the Deceased or Legally Incapacitated Inventor:

If the Applicant is an Organization check here.



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DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN APPLICATION DATA SHEET (37 CFR 1.76)

Title of Invention	
---------------------------	--

As the below named inventor, I hereby declare that:

This declaration is directed to: The attached application, or
 United States application or PCT international application number _____
 filed on _____

The above-identified application was made or authorized to be made by me.

I believe that I am the original inventor or an original joint inventor of a claimed invention in the application.

I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.



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WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

LEGAL NAME OF INVENTOR

Inventor: _____ Date (Optional) : _____

Signature: _____

Note: An application data sheet (PTO/SB/14 or equivalent), including naming the entire inventive entity, must accompany this form or must have been previously filed. Use an additional PTO/AIA/01 form for each additional inventor.

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 minute to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
 If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Alternative: Assignment Containing Oath/Declaration

“Assignment-Statement”

- Must contain information and statements in an oath or declaration
- Must be recorded (recommend use of Electronic Patent Application System (EPAS))
- Check the box in EPAS to show use as combined assignment and oath/declaration
- Submit same day as filing patent application to avoid a surcharge

Sample: Combination Assignment Statement

Attorney Docket No.: _____
 VU Reference No.: _____

COMBINATION ASSIGNMENT-STATEMENT

DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN APPLICATION DATA SHEET (37 CFR 1.76) AND ASSIGNMENT FOR SINGLE ASSIGNEE	
Title of Invention:	
DECLARATION	
As a below named inventor I hereby declare that:	
<ul style="list-style-type: none"> - This declaration is directed to: <ul style="list-style-type: none"> <input type="checkbox"/> The attached application, or <input checked="" type="checkbox"/> United States application or PCT international application number _____ filed on _____ - The above-identified application was made or authorized to be made by me. - I believe that I am the original inventor or an original joint inventor of a claimed invention in the application. - I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 USC 1001 by fine or imprisonment of not more than five (5) years, or both. 	
ASSIGNMENT	
WHEREAS, <u>Vanderbilt University</u> having an office and place of business at <u>305 Kirkland Hall, 2201 West End Avenue, Nashville, Tennessee, 37240, USA</u> , is desirous of acquiring the entire interest in the same;	

AIA Combination Assignment Statement: Assignment

ASSIGNMENT

WHEREAS, Vanderbilt University having an office and place of business at 305 Kirkland Hall, 2201 West End Avenue, Nashville, Tennessee, 37240, USA, is desirous of acquiring the entire interest in the same:

NOW, THEREFORE, for good and valuable consideration, as described in the Policy on Technology and Literary and Artistic Works, published in the 1993-1994 Vanderbilt Faculty Manual, as such policy is amended from time to time, the sufficiency and adequacy and receipt of which are hereby acknowledged, I, the **INVENTOR**, agree to assign and hereby do sell, assign and transfer unto said **VANDERBILT UNIVERSITY** the entire right, title and interest in and to said invention and application throughout the world, including, without limitation, any Letters Patent which may issue thereon, and any subsequent application claiming priority to the above-identified application, reissue, reexamination, divisional, continuation-in-part, extension or continuation thereof and all rights of priority under the Paris Convention arising from said application, and all other rights in the **INVENTION** possessed by the **INVENTOR**, including the right to bring suit for damages due to past infringements; the same for **VANDERBILT UNIVERSITY'S** legal representatives and assigns, as fully and entirely as the same would have been held by us had this assignment and sale not been made:

AND, I hereby bind myself, my heirs, legal representatives, administrators and assign properly to execute without further consideration any and all applications, petitions, oaths and assignments or other papers and instruments which may be necessary in order to carry into full force and effect, the sale, assignment, transfer and conveyance hereby made or intended to be made and generally do everything possible to aid **VANDERBILT UNIVERSITY**, its legal representatives and assigns, to obtain and enforce proper protection for said invention in all countries throughout the world;

AND, I hereby covenant that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment.

LEGAL NAME OF INVENTOR

Inventor: _____ Date: _____

Signature: _____

Witness: _____ Date: _____

Signature: _____

- If not submitting an ADS or Oath/Declaration on filing:
 - Notice of Missing Parts
 - Surcharge

AIA: Power of Attorney (POA)

- USPTO recommends using PTO/AIA/82A&B
 - Individual inventors
 - Applicant (assignee)
- 82A is the transmittal signed by patent practitioner
- 82B is the POA signed by applicant
- Using PTO forms is not required

USPTO Forms

Link to Patent Forms: <http://www.uspto.gov/forms/index.jsp>

- Patent Forms for Applications Filed On or After September 16, 2012;
- Patent Forms for Applications Filed Before September 16, 2012.

Quick Reference Guide at USPTO

- http://www.uspto.gov/aia_implementation/inventors-oath-or-declaration-quick-reference-guide.pdf

Questions? Comments?



Discussion and Q&A

Click the raise hand button.

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Press * 6 to re-mute your phone.



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❖ Nov. 13

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AUTM 2014 Annual Meeting

Feb. 19 – 22
San Francisco Marriott Marquis
San Francisco, CA USA



Save the Date!
Registration is open

