INTELLECTUAL PROPERTY MANAGEMENT
Professor Karl F. Jorda
Spring '03

Class Problem I
Forty Points

Due Date: Monday, March 17, 2003 - 5:00 pm

PROBLEM 1

The University of Wisteria applied for and was granted a patent on methods for diagnosing whether a cat was infected with a feline immunodeficiency virus (FIV). FIV is analogous to the human immunodeficiency virus (HIV) relating to the human acquired immune deficiency syndrome (AIDS) disease.

The University sued Acme Corporation for infringing its patent by selling test kits used to determine the presence of FIV in cats. Acme counterclaimed, in part, that no infringement was possible because it was a co-owner of the patent. Acme claimed that the University failed to include a co-inventor named Black on the patent, and that including Black as an inventor would make Acme co-owner of the patent by virtue of an assignment of invention rights therein. According to Acme, Black brought her sick cats, along with her written observations of the cats' symptoms, to the University with a suggestion that the cats might have a virus similar to the human AIDS virus.

The district court was unpersuaded by this argument, emphasizing that Black only suggested that her cats showed symptoms of an immunosuppressive disease and provided the University with the infected cats. However, the University inventors identified the method for isolating the new virus, actually isolated the new virus, and developed a method for diagnosing cats that are infected with the FIV virus. Accordingly, the district court held that Black could not be considered a co-inventor. Acme appealed.

What should the decision on appeal be and why? In your answer also discuss the salient principles governing joint inventorship.**[10 points]**

PROBLEM 2

What are the various reasons (legal and otherwise) behind the common and requisite Invention Disclosure policy and procedure in patent law and practice? **[10 points]**

-OVER-

PROBLEM 3

Jet Engine Inc. (JE) needed an improved design for jet turbine blades and approached Gas Turbine Corp. (GT) to take on the project. John Smith, general manager at GT, then assigned Brad Brainy as the chief engineer on the project of coming up with a different design. The specific goal of Brainy's project was to develop a one-piece leading edge. Brainy spent 70% of his time on that project and after attempting several solutions he developed the invention. Brainy reduced the invention to practice using GT's resources, GT's other employees, GT 's shop tools and materials, and GT's time. GT also has paid and continues to pay for the prosecution of a patent application on the invention. And Brainy has repeatedly acknowledged GT's roles in the development of the invention, although he had no written employment contract. GT and Brainy now dispute ownership.

Who owns the patent rights for this invention and why? **[10 Points]**

PROBLEM 4

What considerations in terms of scope (geography, subject matter), duration, timing, consideration (quid pro quo), employee type would govern your crafting an enforceable (even in states which have Freedom-to-Create legislation) employment or invention agreement that is fair and balanced as betwen employer and employee? **[10 points]**

KFJ/Ruh/3.5.03