

sions and group participation. We expect this year to be no exception. Lynn Astle, director at Brigham Young University and chair of the meeting committee, has assembled a strong group of volunteers to put the program together, but more help is always appreciated and is another way for you to participate in the meeting. Volunteers are always needed to help staff and coordinate activities at the meeting proper. Please contact Lynn or me if you would like to help, or fill out an online volunteer form on the AUTM Web site by clicking on the "Volunteer" link on the main menu.

Remember, if you are looking for the opportunity to network in a smaller group, the regional meeting is it!

As incoming vice president for the Western Region, my duties are to be a voice to the board on behalf of the AUTM membership in the region. I welcome the opportunity to be that relay and to hear from all the members of the region concerning your thoughts on issues affecting technology transfer and AUTM. If you are interested in sharing thoughts on an issue, getting involved in the Western Region or in general AUTM activities, contact me directly at pljones@ott.arizona.edu.

At this time, I also want to take the opportunity to thank Mary Watanabe, the outgoing vice president for the Western Region, for all of her work representing the region to the AUTM board over the past two years. She's been, and continues to be, a valuable resource for all of us, as well as a tremendous example of the people who make AUTM such a great organization. ■

***The Economist* Names Bayh-Dole Act Innovation's Golden Goose**

The Economist—one of the most influential business and political publications across the globe—recently ran the article entitled, "Innovation's Golden Goose."

The piece, which addresses issues affecting academic technology transfer, makes a rousing assertion: "The Bayh-Dole Act of 1980 is perhaps the most inspired piece of legislation to be enacted in America over the past half-century. Together with amendments in 1984 and augmentation in 1986, this unlocked all the inventions and discoveries that had been made in laboratories throughout the United States with the help of taxpayers' money. More than anything, this single policy measure helped to reverse America's precipitous slide into industrial irrelevance."

The full article is free to *Economist* subscribers at <http://www.economist.com>. For nonsubscribers, it is available on a pay-per-view basis. ■

The Siren Song: Misconceptions Concerning Provisional Patent Applications

By Todd L. Juneau, Nath & Associates

Obtaining patent protection for a university invention can be a very costly proposition; thus is it important to make efficient use of limited resources.

Many universities file patent applications based upon a draft manuscript of a scientific paper scheduled to be published to minimize their initial costs. This strategy is risky, however, as the resulting application probably will neither satisfy potential licensing partners nor provide a sufficient platform on which to build a patent portfolio. Accordingly, this paper attempts to dispel some of the common misconceptions about provisional applications to ensure the validity of university patents and maximize university resources.

A Scientific Manuscript Is Deficient as a Patent Application

A manuscript does not accomplish all the goals of a quality patent application, such as fulfilling statutory requirements and providing opportunities for licensing, and will probably jeopardize the organization's rights to the invention. For one thing, a manuscript usually does not provide sufficient guidance to teach a person of ordinary skill in the art how to make and use the invention as required by the patent statute.

The ways in which a manuscript is deficient as a working patent application are discussed below.

Authorship Does Not Necessarily Equal Inventorship

First of all, a manuscript typically lists numerous authors. All of these people are not usually actual inventors, however. For example, while a student working as an extra pair of hands in a professor's lab may be listed as a co-author of an article, he is usually not an actual inventor as defined by the patent statutes. He did not help to conceive the claimed subject matter, but was merely a tool taking specific instructions from his professor.

Accordingly, a manuscript's authors are not necessarily the true inventors properly listed on a patent application. This is important as it can affect the validity of the patent, royalty payments and licensing opportunities. If the inventorship is not accurate, it must be corrected before enforcement to avoid disastrous consequences. Additionally, any questions as to the proper inventorship of the patent may reduce the leverage you have in licensing, as licensing partners may discount the license terms.

Photographs Suitable for Publication May not Be Sufficient for Patent Applications

Second, there are no standards for photographs and/or drawings included in a manuscript. Accordingly, manuscripts commonly contain figures that do not have proper margins, font size, legends or are unclear and of shoddy quality. Conversely, some figures for manuscripts may have too much text associated with the figure. In contrast, there are very rigid guidelines for any figures appended to a patent application. A patent applicant who assumes photographs and drawings included in his or her manuscript are sufficient for a patent application may be in for a rude awakening.

Technical Achievements vs. Legal Requirements

Third, manuscripts typically focus on the technical achievements being reported. In contrast, a patent application must meet several legal requirements, in addition to providing a clear description of the technical achievements. The drafter of a manuscript may not appreciate the requirements and meanings of each section required in a patent application.

For example, any material included in the Background of the Invention section of a patent application is generally deemed by the U.S. Patent and Trademark Office to be admitted by the applicant to be a part of the prior art. The person who drafted a manuscript may not appreciate this aspect of the patent laws and may unknowingly accord prior-art status to an integral part of the invention without even realizing it. The result of this is, frequently, the receipt of narrow claim scope and less licensing royalties.

Similarly, a manuscript commonly refers to the objects and goals of the research described therein. However, the results of the research do not always meet the objects and goals set forth. In a patent application, this may have fatal consequences.

In particular, if the object of the invention as set forth in the patent specification is not supported by the experimental results, an examiner may validly claim that the application does not contain a true invention or, since the experimental data is incongruous with the stated object of the invention, the application does not contain an adequate written description sufficient to enable a person of ordinary skill in the art to make and/or use the claimed invention, as required by the patent statute.

Additionally, during a patent-infringement lawsuit, defense lawyers have been known to make good mileage by pointing out that the inventor failed to achieve the entire object of his or her invention by showing one or two examples that do not work.

Further, manuscripts are often very technical documents describing the objects to be achieved, the tests conducted

and the results of these tests. In contrast, a patent application must describe both how to make and use the claimed invention. Accordingly, manuscripts lacking a description of the synthetic processes for making the described subject matter, or embodiments of the subject matter which can be used in the real world, do not meet the requirements of the patent laws.

Known Facts vs. Future Extrapolations

Fourth, a manuscript in the pharmaceutical or biotechnology area may contain a recitation of various mechanisms of action by which it is believed the new discovery may work. While there is nothing wrong with including such information in a manuscript, this information is potentially damaging to a patent application as it can open the possibility that a greater number of prior-art references may be cited by the examiner in denying you a patent. Further, a greater problem arises when this mechanism becomes the sole basis for novelty over prior art and later turns out to be the wrong mechanism. Generally, this will result in an unenforceable patent, if a patent is granted at all.

Crediting Previous Work vs. the Patent Applicant's Duty of Disclosure

Finally, manuscripts typically include a list of references to ensure that proper credit is given to the author's resources. However, applicants and everyone involved in the patent process have an affirmative duty to provide the U.S. Patent and Trademark Office with every document they know of that is material to patentability. Failure to do so results in a charge of fraud on the patent office and an unenforceable patent. But, merely listing these references in a patent application as they are listed in a manuscript is insufficient to comply with and discharge an applicant's duty of disclosure. Instead, each relevant reference must be cited to the examiner in a specific form, an Information Disclosure Statement. Accordingly, a recitation of relevant references in the text of a manuscript is insufficient for a quality patent application.

Preparing Compliant Patent Applications on Budget

It is possible to avoid the siren song that lures patents to their doom by refusing to engage in the practice of slapping a provisional cover sheet on top of a draft manuscript, shipping it off to the U.S. Patent and Trademark Office and calling it a day's work.

But exactly how should a quality patent application, which complies with these critical requirements, be prepared on a university budget? The short answer is to conduct a brief search, formulate a strategy to obtain claims with commercial coverage and draft a proper application that meets the appropriate legal criteria.

Most law firms will happily provide a reasonable flat-fee quote for performing this service, especially since the law firm is receiving a head start in the form of a draft manuscript and a patent search.

Todd Juneau is a partner with the law firm of Nath & Associates in Washington, D.C. Copyright © 2002 Todd Juneau ■

Reminders, Deadlines and Contact Information

Dues Due

If you haven't already paid your membership dues for 2003, be on the lookout for the second notices that were mailed in mid-February.

And, don't forget to update your contact information. Contact AUTM headquarters at autm@autm.net with any changes, or update your membership listing online at www.autm.net.

AUTM Newsletter Deadlines

Articles for the *AUTM Newsletter* are always welcome. Deadlines for upcoming issues are:

May/June	April 4
July/August	June 9
September/October	August 8
November/December	October 8

If you would like to submit an article for the *AUTM Newsletter*, contact AUTM headquarters at autm@autm.net.

Contact Information

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Calendar of AUTM Events

Eastern Regional Meeting
Joint Meeting With the LES 2003 Spring Meeting
May 7–9, 2003
Loews Philadelphia Hotel
Philadelphia, Pa.

Western Regional Meeting
July 20–22, 2003
LaFonda on the Plaza
Sante Fe, NM

Central Regional Meeting
July 27–29, 2003
Fairmont Kansas City at the Plaza
Kansas City, Mo.
Hotel reservations deadline: July 5, 2003
For reservations, call 816/303-2934 or 816/756-1500

Basic Licensing, TOOLS and
Startup Business Development Courses
September 7–9, 2003
Baltimore Waterfront Marriott,
Baltimore, Md.

Advanced Topics Course
December 4–7, 2003
Hotel Del Coronado
Coronado (San Diego), Calif.

AUTM Annual Meeting
March 4–6, 2004
Marriott Rivercenter
San Antonio, Texas

For more information on AUTM events, visit the AUTM Web site at www.autm.net.

If you prefer to receive this newsletter electronically, send an e-mail to autm@autm.net, with your name, phone number and e-mail address.