

Joint Research Agreement

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Summary Of Joint Research Agreement Topic

A "Joint Research Agreement" (JRA) permits collaborating inventors with differing affiliations to patent improvements that would otherwise be rejected as obvious. Without the agreement, the claims of one patent application to one inventor could be rejected as "*obvious*" on the basis of one or more elements or concepts written by other collaborators. With a Joint Research Agreement, *only others, non-collaborators*, would be prevented from patenting the otherwise obvious claims.

A patent claim must be "new, useful and non-obvious" by law, or the claim of the patent application will be rejected. "New" means you must be the first to invent. "Useful" means a legal use not violating the laws of nature. The "*non-obvious*" part is peculiar and more difficult to overcome.

One way the U.S. Patent Office (USPTO) holds a claim to be obvious occurs when a "Person Having Ordinary Skill in The Art" (often called a PHOSITA) can invent the same invention using common knowledge and skills. More obtusely, the USPTO can impose an obviousness rejection if a PHOSITA can simply put together concepts from publicly available documents to make the claimed invention. The USPTO assumes that there is at least one PHOSITA who would be aware of any publicly available documents anywhere if those publications would make the claimed invention obvious. Collaborating inventors from different universities or companies might be barred simply by various publications of the authors.

As a result, joint, collaborative research can face serious obviousness barriers against separate patents.

The patent law was recently changed to promote joint research and expressly allow collaborating inventors to be immune from "obviousness" rejections. The **CREATE Act**, effective 10 December 2004 (just a little over 3 years ago), defines a "joint research agreement" as:

... a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention, that was in effect on or before the date the claimed invention (under examination or reexamination) was made.

...

MPEP 706.02(1)(2) III

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The actual law 35 U.S.C. 103(c)(3) reads:

35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.

35 U.S.C. 103(c) ...

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term “**joint research agreement**” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.