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 because they would be "obvious." "Obviousness" has a special meaning in patent law.

According to patent law, a patent claim must be "new, useful and non-obvious". "New" means you must be the first to invent. "Useful" means both a legal use and it does not violate the laws of nature. The "*nonobvious*" part is peculiar and more difficult to overcome.

Without the Joint Research Agreement the patent office could reject a patent application by declaring it "obvious" based on what other people doing similar work had written. Those who work in a group defined by a Joint Research Agreement can be exempt from such an obviousness rejection if it is based on the work of a group member. All the others, the non-collaborators, those not named in the group, could be prevented from patenting their invention by reason of obviousness. With a Joint Research Agreement, *only others, non-collaborators,* would be prevented from patenting the otherwise obvious claims.

Why bother with a Joint Research Agreement? In some fields, putting a big picture together is the key to making it all work. The pieces might all be there, but there are too many pieces and most pieces may contain false leads and contain errors. The inventors deserving the prize are the ones who successfully sift and sort the pieces.

The downside of such an agreement is that the other inventors in the group can more easily file an improvement based on your work. The downside of NOT having the agreement is that you can't file an improvement based on their work.

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.

A JRA does not fix all problems. 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 document anywhere in the world. The patent office can use it to declare the claimed invention obvious, and reject it.

The Patent Office also does not care that the published documents might be completely without publicity, not common knowledge, having no exposure or has no practical availability. A document in a public library in a mountain jungle with no internet access is fair game. The Patent office also does not care if most of the written work is non-credible, misleading, misguided, or filled with dead end conjectures.

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 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(l)(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.