

# ***Board of Trustees of the Leland Stanford Junior University v. Roche Molecular Systems, Inc.***

The Bayh-Dole Act Does Not Supersede  
Inventor Rights



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## ***The First Agreement***

- An inventor and Stanford Research Fellow, signed a “Copyright and Patent Agreement” where he ***“agree[d] to assign”*** all inventions resulting from his employment with Stanford



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## The Second Agreement

- To learn PCR at Cetus Corp, the inventor signed a “Visitor’s Confidentiality Agreement” - where he **“will assign and do[es] hereby assign”** all inventions as a consequence of [the] access” he was granted at Cetus



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## The Third Agreement

- Patent applications related to PCR assays for monitoring the effectiveness of antiviral therapy in the treatment of AIDS, were filed and assigned to Stanford
  - U.S. Pat. No. 5,968,730
  - U.S. Pat. No. 6,503,705
  - U.S. Pat. No. 7,129,041



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## The Bayh-Dole Act

- Inventions were made with grants from the NIH, which brought the inventions under the Bayh-Dole Act (35 U.S.C. 200-212).



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## *The Lawsuit*

- Roche obtained rights to Cetus' PCR business, including the agreements with Stanford and its researchers.
- Roche began marketing HIV detection kits.
- Stanford sued for infringement due to the assignments from the inventors.
- Roche – no suit because it had rights to the patents by virtue of the Cetus agreement.

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## Ownership Transfer

- Stanford Agreement – no transfer
- Cetus Agreement – transferred future rights to Cetus
- Inventors – rights vested in inventors – visiting inventor’s rights immediately transferred to Cetus
- Roche purchase of Cetus – transfer to Roche
- Stanford inventor’s assignment – no effect because rights already transferred first to Cetus, which transferred to Roche

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## The Bayh-Dole Act

- Stanford – the BD Act indicates that the grant recipient (institution) and not the inventor is the primary owner of inventions
- BD Act allows recipients the right to “**retain**” title to any subject invention” as long as certain conditions were met.



**Birch Bayh**



**Bob Dole**

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## Roberts and Majority



- Supremes disagreed with Stanford
- BD language too indirect, especially when viewed in comparison to other statutes that provide for government ownership.

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## *Breyer and Ginsberg Dissent*

- Sotomayer concurred with majority but agreed with the dissent's concern's regarding the Federal Circuit's *FilmTec Corp. v. Allied-Signal, Inc.*, 939 F.2d 1568 (Fed. Cir. 1991).
- The *FilmTec* decision changed the law and made a distinction between "agree" to assign and "do hereby assign." Prior to *FilmTec*, both agreements transferred equitable title.
- Disagreed with majority's interpretation of the Bayh-Dole Act.

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