

BIO664

IP and Tech Transfer Case

Case Study: Author or Not

Joe was a starting graduate student in the laboratory of Professor Gout, a famous scientist that started the field of nano-sized self-assembling systems. He was learning to conduct experiments with the help of other post docs and visiting scientists. It was a lab with many members sprawled over two floors of different buildings.

Nothing Joe had touched had been working the way he expected. One of his main projects was making carbon nanotubes. One day, he was asking for input from visiting scientist Pat on an electron micrograph of some samples he had made. Pat exclaimed, "This is exactly what we need to prove Ann's theory! We haven't been able to make this configuration before!". Joe and Ann came from different backgrounds, so they often brainstormed together over coffee. Pat and Joe discussed the relevance of the nanotubes to actualize Ann's theory, and asked Joe if it was OK if he could show the images to Ann. "Yeah, sure." For Joe's application, the shape and size of the nanotubes made by nitrogen doping was useless, and he went home depressed.

Later in the week, Pat asked Joe if he wanted to work with the nanotubes Joe had shown him. As Joe was interested in focusing on his thesis project, he told Pat that he wasn't interested.

Joe's Ph.D. took much longer than expected. Three years later, he was still struggling when a junior graduate student who was interested in technology start-ups came by, excited. "Hey did you hear how much the start up of Professor Gout and Dr. Ann Parsons was sold for?". Joe didn't know that there was a start up company based on the nanotubes he had shown Pat, and the startup was bought out by a major company QBC for 5 million dollars. The patent that was licensed was based on Joe's accidental finding that nitrogen doping made the specific nanotube formulation was possible, although a team of people actually optimized the finding for the specific application that was of interest by QBC. Their names were on the patent, and as agreed by the University, they would be benefiting from the 30% royalties to inventors. It came as a shock to Joe.

Questions:

- Should Joe have been on the patent that is licensed to QBC? Why/ why not?
- If it is indeed his IP, what actions could he have taken to protect his intellectual property at the point when
 - o he first makes the discovery and has the conversations with Pat?
 - o he finds out that there was a sale of the start up company?
- Is there any legal consequence to not having Joe be an inventor on the patent?