

## American University Patent Policies: A Brief History

- 1900-1924** Universities have no formal policy on patents, and follow defaults provided by law, addressing issues as they arise.
- 1912** University of California professor Frederick Cottrell forms non-profit Research Corporation to manage his inventions and others submitted by faculty nationwide. Faculty inventors receive royalties and their institution or research foundation may also receive a share. Research Corporation donates a portion of its share after expenses to the Smithsonian Institution for research, and as well supports research directly across the country.
- Cottrell describes Research Corporation in “The Research Corporation, an Experiment in Public Administration of Patent Rights.” *The Journal of Industrial and Engineering Chemistry*. December 1912, 864-67.
- 1924** Lehigh University adopts a formal patent policy.
- 1924-1950** By 1952, 73 universities have adopted a formal patent policy. By 1962, according to Archie Palmer this number doubles to 147 out of 359 universities that report conducting scientific or technological research. In 1962, 596 universities report they perform “little or no scientific or technological research” and have no formal patent policy.
- Of those universities that do adopt a patent policy, some abjure patenting, especially in biomedical fields. Harvard offers legal assistance to anyone challenging a biomedical patent. Others claim patents but only to prevent patenting and monopoly behaviors. Ownership of inventions follows extramural research contracting. Typically, the patent clause of such contracts is negotiated by the faculty investigator. Those that adopt a patent policy often direct faculty to use an affiliated foundation or Research Corporation.
- 1925** Formation of Wisconsin Alumni Research Foundation to manage inventions submitted by University of Wisconsin faculty, starting with Steenbock’s invention for UV irradiation of food.
- 1925-1950** Formation of dozens of WARF-style research foundations, 55 by 1962. Archie Palmer identifies Purdue Research Foundation (formed in 1930) as a model. Palmer advocates for formal research and patent policies, and publishes a succession of compendia of policy statements and analysis.
- 1950** Formation of the NSF, leading to formalized research policies. Vannevar Bush’s *Science the Endless Frontier* proposes a National Research Foundation that will support civilian research using strategies of teamwork demonstrated during the Second World War by university faculty, industry scientists and engineers, and “gadgeteers” were able to produce technology that the military establishment could not think to propose, such as the digital computer, advances in sonar and radar, and the atomic bomb.

- 1950-1981** Growth of university patent policies. A great deal of diversity. A number of universities claim ownership of inventions, but typically restrict that claim to “official duties” in which an employee is hired to invent, limit the claim to inventions that an invention management agent agrees to manage. Institutions consider whether they have “equity” in faculty inventions. Typically, a faculty-led committee reviews circumstances of institutional support and makes a recommendation. Invention equity might involve recognition, reimbursement, a shop right, a non-exclusive license, sharing of royalty income, or institutional ownership.
- In the 1970s, Research Corporation advocates that universities create “technology transfer” offices to assist in helping faculty identify inventions that might be “transferred” to Research Corporation for management. Faculty assign inventions that are federally supported to the sponsoring agency on request. In a few cases, agencies negotiate “Institutional Patent Agreements” that allow a university or an invention management agent to retain title to an invention assigned to them by faculty inventors.
- 1981** Bayh-Dole Act goes into effect. University patent administrators inaccurately represent Bayh-Dole as granting university administrators the right to take ownership of faculty inventions made with federal support simply by notifying the government.
- 1981-2011** Universities adopt and revise patent policies, replacing invention equity with ownership claims. Universities migrate the requirement to assign from research policy to invention policy and expand ownership claims to include use of resources and participation in extramural research. Some universities also expand definition of “invention” to include “inventions that are not patentable” while others conflate inventions, copyrights, and data under a general heading of “intellectual property” or claim by an arbitrary definition ownership of a broad range of assets, listing variously inventions, works, data, materials, scholarship, and expertise.
- 2011** US Supreme Court decides *Stanford v Roche*, rejecting claims made by many universities, AAU, APLU, and AUTM that Bayh-Dole vests ownership of inventions made with federal support with host university. IEEE and AAUP file an amicus brief that argues against the institutional taking of ownership to faculty inventions under the Stanford reading of Bayh-Dole.
- 2011-2013** Universities generally ignore *Stanford v Roche* decision in their policies and guidance documents. Some universities, notably Stanford, University of California, and University of Washington insert “present assignment” language into policy and employment documents, purporting to enact “automatic” assignment of any future inventions made by faculty. Advocates argue that such draconic ownership policies are necessary to preserve the institutional technology licensing industry that has been created around faculty inventions, and without this industry in place inventions will “sit on the shelf” and America will become a global technology backwater.