



Patent Rights (or Wrongs)

Dear Labby,
During my postdoctoral work I made a discovery that my lab head decided to try to patent. Our institution filed an application, which is pending. A month after the filing, I learned I was pregnant and sought a three-month leave during what will be my last month of pregnancy and the first two months after birth. This request, sought months in advance, was approved by both my department and our human resources department. (Such requests are routinely granted under my institution's maternity leave policy.) However, about six weeks before my delivery, my lab head asked me to initiate a large body of work for the purpose of adding more claims to the patent application. I told him I would do my best but that my leave was imminent. He got very angry and told me he would remove my name from the filed application if I did not generate the needed data for an amended application within the next month or two.

I was very upset but then recalled that Labby had addressed patent issues once or twice before in the column. So I am seeking your advice.

—Non-inventor to Be?

Dear Non-inventor to Be?,

This is a very egregious threat by your lab head. However, it is most improbable that you could be removed from the filed patent application, for several reasons. First, when the initial application was filed you and any other inventors signed a document affirming your beliefs that each of you made contributions that warrant inventor status. Second, the U.S. Patent and Trademark Office has a tradition of carefully scrutinizing requests for removal of an inventor from a pending patent application. Indeed, when such a request is found not to be valid the penalties can be significant. And third, the responsible party here is not your lab head but your institution, to which he, you, and the other inventors have assigned their rights. Thus it is your institution that would need to make the request to remove your name and would be liable should such a request be deemed inappropriate.

Many patent applications in biomedical science are in need, often sorely so, of further data to bolster the claims and make a plausible case for utility and enablement, while also making a strong case that the invention "would not have been obvious to those skilled in the art" (the latter a major principle of U.S. patent law). So, it is entirely proper for your lab head to push ahead, and it might turn out that someone other than you will make downstream findings that will enhance an amended patent application. The validity of that person's inventorship would be weighed by your institution's technology transfer office, which would be very mindful of the institution's liability in the event of a fraudulent claim of inventorship. Your institution may request that the new person's name be added, but that would not require removing your name. Be comforted that removal of an inventor from an initial patent application requires a high threshold of suasion.

That leaves us with the matter of your lab head's conduct. His threat is unseemly at the least and grotesque at the worst. Labby's advice is for you to take comfort in the protective doctrines in patent law and to watch your lab head's conduct for other manifestations of hostility or impropriety. Your institution probably has formal policies on scholarly behavior by faculty as well as the rights of nonfaculty lab members. Let us hope this incident will not have echoes in his subsequent behavior toward you. And all best wishes for you and your baby, and your continuing career. ■

—Labby

Direct your questions to labby@ascb.org. Authors of questions chosen for publication may indicate whether or not they wish to be identified. Submissions may be edited for space and style.