A Joint Research Pitfall – Soon to be Resolved?



Innovators in life sciences at companies and universities often collaborate and conduct research under a joint research agreement (JRA). The Cooperative Research and Technology Enhancement Act of 2004 (the "CREATE Act") was enacted to promote collaboration and cooperative research between different entities. The United States Patent and Trademark Office ("USPTO") recently proposed new rules for filing terminal disclaimers to address a particular issue in the case of JRAs.

Terminal disclaimers can be filed to overcome obviousness-type double patenting rejections. Under the current rules, parties to a JRA can only file a terminal disclaimer if certain circumstances are met. Under the CREATE Act, two patent applications of different ownership are considered commonly owned if an invention at issue was made pursuant to a joint research agreement, the invention is within the scope of the agreement, and the parties to the agreement are the applicants of the application. Even if these requirements are met, a terminal disclaimer can only be filed if the patent or patent application referenced in the double patenting rejection is prior art.

Under current practice, for example, if a company and a university collaborate under a JRA and file two patent applications of different ownership (e.g., one solely owned and the other co-owned) on the same day so that one is not prior art to the other, a terminal disclaimer cannot be filed. In that case, a petition must be filed and granted to waive the requirement.

The USPTO proposed changes to allow an applicant to file a terminal disclaimer even if the referenced patent or application is not prior art without the need to file the petition. These changes, if implemented, will facilitate the management of a patent portfolio subject to a JRA.