

the university, or whether it initially remains with the inventor absent an assignment.

B. *The Stanford v. Roche Case*

1. The Legal Issue

§ 202 of the BDA states that "each nonprofit organization or small business firm may, within a reasonable time after disclosure as required by paragraph (c) (1) of this section, elect to retain title to any subject invention."²¹¹ In *Stanford*, the question arose as to whether or not this provision implied that title in an invention automatically vested in the nonprofit or small business, and not in the inventor himself.

2. The Facts

The facts behind the *Stanford* case reinforce the claim that complicated fact sequences often give rise to major legal conundrums.²¹² In 1985 Cetus, a small California company, began to develop methods to quantify levels of the human immunodeficiency virus (HIV).²¹³ The situation involved three patents regarding AIDS monitoring.²¹⁴ One of the named inventors, Mark Holodniy, was a researcher at Stanford in 1988.

In 1988, Holodniy became a research fellow at Stanford and signed a "Copyright and Patent Agreement" that obligated him to assign his inventions to the university.²¹⁵ However, in early 1989, Holodniy would visit Cetus to learn techniques related to his field.²¹⁶ In exchange for the education received, Holodniy signed a contract that stated he "will assign and do[es] hereby assign to CETUS, my right, title, and interest in each of the ideas, inventions and improvements... as a consequence of" his work at Cetus.²¹⁷

211 35 U.S.C. § 202 (a) (2009).

212 See Sanjesh Sharma, *The Bayh-Dole Act and Allocation of Ownership Rights in Inventions Arising out of Federally Funded Research*, 8 INTELL. PROP. & TECH. L.J. 23, 23 (August, 2011).

213 See *Stanford*, *supra* note 10, at 1-2.

214 See *Board of Trustees of the Leland Stanford Junior University v. Roche Molecular Systems, Inc.* 583 F.3d 832, 837 (Fed. Cir, 2008), *aff'd* 563 U.S. ____ (2011) (*hereinafter* *Stanford*(CAFC)).

215 *Stanford*(CAFC), *supra* note 214, at 837.

216 *Id.*

217 *Id.*