

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."<sup>211</sup> 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.<sup>212</sup> In 1985 Cetus, a small California company, began to develop methods to quantify levels of the human immunodeficiency virus (HIV).<sup>213</sup> The situation involved three patents regarding AIDS monitoring.<sup>214</sup> 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.<sup>215</sup> However, in early 1989, Holodniy would visit Cetus to learn techniques related to his field.<sup>216</sup> 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.<sup>217</sup>

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.*