

In This Issue

- Effects of Grant Applications on Patents
- Education Update: Patient Billing

Quick Links

[University Hospitals Center For Clinical Research](#)
[Office of Research Compliance](#)
[UHCMC IRB](#)
[UHCMC Grants and Contracts](#)
[William T Dahms Clinical Research Unit](#)
[Clinical Trial Listing **NEW!**](#)



Questions, Comments, Suggestion?

If you have questions, comments or have a suggestion about how we can improve our human research protection program (HRPP) at UHCMC, send an email to: clinicalresearch@uhhs.com or contact Carol Fedor, Clinical Research Manager at (216) 844-5524

Education Updates!

[Click Here](#)

Contact Us

Office of Research Compliance
Lakeside 1400
11100 Euclid Avenue
Cleveland, Ohio 44106
216.844.5576

E-mail us!

Effects of Grant Applications on Patents

When filing a government grant proposal, researchers may be required to disclose their research plans and anticipated results. It is important to be aware that such proposals may prevent the researcher from obtaining a patent on an invention that is developed in the course of any subsequent research. For example, under U.S. patent law an inventor is not entitled to a patent if the invention was described in a printed publication, in public use, or on sale in this country more than one year prior to filing a patent application. In addition, many foreign patent rights are immediately lost upon publication if a patent application has not already been filed.

What if the grant proposal is not actually a “printed” publication?

A reference is a printed publication if it is accessible to the public. Therefore, even electronic publications, including an on-line database or Internet publication, may qualify as a printed publication.

DuPont v. Cetus, emphasizes the importance of understanding the impact a grant proposal can have on patent rights. In *DuPont v. Cetus*, an inventor had received several patents for a process of polymerase chain reaction (PCR) using an exponential process of replication. DuPont alleged that the patents were invalid because the inventor had disclosed the invention in a National Science Foundation (NSF) grant proposal more than one year before filing the patent applications.

The District Court determined that the grant proposal was indexed by title, author, institution and grant number in the NSF’s published indices of grants and awards and was available upon request from NSF under the Freedom of Information Act (FOIA). Therefore, the District Court held that the grant proposal was accessible to the public, and thus, a printed publication.

What is the proper procedure?

Ideally, researchers should file a patent application prior to submitting a grant proposal to prevent the loss of any patent rights. However, it is not always possible to file a patent application prior to filing a grant proposal. Therefore, other steps may be taken to prevent the grant proposals from becoming accessible to the public. For example, the FOIA exempts trade secrets, privileged and certain confidential information from public disclosure. Therefore, relevant portions of the proposal should be marked “Confidential” and a legend should be stamped on the front of the grant proposal stating that portions of the proposal are confidential and exempt from disclosure under the FOIA.

Other steps, such as changes in the proposal language, may also help protect a researcher’s patent rights. For additional information, contact Stephen Behm, Director Technology Management at (216) 844-1415 or Stephen.Behm@uhhospitals.org, or Bill Fisher, Sr. Research Business Specialist, at (216) 844-5577 or William.Fisher@uhhospitals.org.

Education Update: Patient Billing

Kumar Mukesh and Dave Ehlert from the Center for Clinical Research and Technology will be providing an overview of the new UHMG-Center for Clinical Research and Technology Patient Billing Process for UHMG Patient Bills Charged to CWRU Accounts on August 12, 2008. [Register here!](#)