

## CREATE Act Helps Collaborating Researchers Avoid Obviousness Patent Rejections

By Colin S. Wright.<sup>1</sup>

On December 10, 2004, President Bush signed the Cooperative Research and Technology Enhancement (CREATE) Act, which significantly amended U.S. patent law as it pertains to the patentability of inventions. In 1984, Congress exempted “common owner” inventions from the application of certain types of obviousness rejections based on common ownership. The 1984 exemption was limited to inventions assigned or subject to assignment to a common owner at the time they were made. By passing the CREATE Act, Congress has extended this exemption to “joint research agreement” inventions. These are inventions that, at the time they are made, are owned by or are subject to assignment to parties who are part of a joint research agreement in effect when the invention was made. Such inventions are still subject to the double patenting principles that apply when inventions are commonly owned.

The CREATE Act maintains the safe harbor previously provided under U.S. patent law for inventions that are owned by a single company or entity. It prevents an obviousness rejection based on an earlier filed patent application having the same assignee. This safe harbor has now been extended to inventions from different entities, but who are working under a joint research agreement. Under the CREATE Act, the term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention. If an applicant receives an obviousness rejection based on a reference created under such an agreement, the applicant may be able to overcome the rejection by:

- 1) Providing a statement signed by the applicant or assignee asserting that:
  - a. The reference was made by or on behalf of the parties to a joint research agreement under 35 U.S.C. § 103(c);
  - b. The agreement was in effect on or before the date the claimed invention was made; and
  - c. The claimed invention was made as a result of activities undertaken pursuant to and within the scope of the agreement.

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- 2) Amending the specification to disclose names of parties to the agreement, and
- 3) Amending the specification to either:
  - a. Set the date the agreement was executed and a concise statement of the field of the claimed invention; or
  - b. Specify where (i.e., by reel and frame number) the information is recorded at the U.S. Patent & Trademark Office.

Researchers and patent applicants should take heed and ensure that any joint research projects between separate entities are protected by a written agreement that meets the requirements of 35 U.S.C. § 103(c). In addition, pending applications may require amendments which set forth the date of agreement and name the parties to the agreement. Broadening reissue applications should be considered if an issued patent includes collaboratively invented claims that were narrowed in response to prior art that the Act now exempts.