

THE BOARD OF REGENTS OF THE UNIVERSITY OF NEW MEXICO

v.

DR. GALEN KNIGHT and DR. TERENCE SCALLEN
(United States District Court for the District of New Mexico)
99-cv-577

Action for declaratory judgment of ownership and determination of inventorship brought by the University against an ex-professor and a technical researcher who were the inventors of a number of patents filed while the defendants were employed.

The invention relates to an immune modulator that has shown promising anti-cancer effects. The invention was developed in the late 1980's and early 1990's at the University medical center. Dr. Scallen is an M.D. and a Ph.D. and Dr. Knight has a PhD in biochemistry. The defendants left the University in 1992. Prior to that time the University licensed the patents to a start-up bio-technology company that carries the research forward.

Several years after the defendants left the University, the licensee's supplier found that the patented synthesis did not produce the compound claimed; the University, after obtaining independent expert confirmation of this fact, amended the patent applications to properly characterize the compound. The inventors disputed the results and the change to the claimed subject matter. Then, the University found that the continuation-in-part applications had not been assigned to the University. The licensee, claiming that it was precluded from raising venture capital because of a lack of title to the inventions, threatened suit against the University to quiet title.

The defendants represented themselves.

On September 10, 2001 a judgment was entered for the University after a one week trial to the Court. The Federal Circuit Court of Appeals affirmed the judgment. 321 F.3d 1111 (Fed. Cir. 2003).

On remand on the issue of whether the defendants' claims were precluded by the doctrine of sovereign immunity, the court again ruled against the defendants. The appeal by defendants was unsuccessful. 116 Fed Appx. 258 (Fed Cir. 2004)