Madey v. Duke University and Other Important Patent Issues Affecting University Research

Eric W. Guttag, JD, and Keith D. Fredlake, JD

Eric W. Guttag, JD, is a partner and Keith D. Fredlake, JD, is an associate with Jagtiani + Guttag in Fairfax, Virginia.

This section will explore several important patent issues that can uniquely impact university research, as well as how universities and their respective technology transfer offices can respond to these issues. This section discusses many cases where universities were involved in these issues, such as *Madey v. Duke University*.

Defenses to Infringement

The best defense to patent infringement is to avoid the issue entirely. However, that may not always be possible. Eventually, a university may have to confront a patent infringement problem. Rather than simply paying royalties or altering the research program, a university may be able to assert one of the following established defenses to patent infringement.

The Experimental Use Defense[1]

The best-known and possibly least useful defense to patent infringement is the experimental use defense.[2] The experimental use defense can be viewed as roughly the patent law equivalent of the fair use doctrine of copyright law,[3] and has been in existence since 1813.[4] The experimental use defense has two branches. The first branch is known as the *ascertain validity branch*,[5] and holds that one is entitled to practice the patented invention in order to check and test the validity of the patent.[6] While there is little case

law on the ascertain validity branch,[7] it remains as an extremely viable defense to patent infringement.[8]

The other, more commonly relied on branch, is known as the *philosophical experiment branch* and applies to those situations where the alleged infringement is "solely for amusement, to satisfy idle curiosity, or for strictly philosophical inquiry."[9]