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- Business
- Government & Policy
- Science/Technology
- Career & Employment
- ACS News



**February 21, 2005**  
**Vol. 83, Iss. 8**  
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2005

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**February 21, 2005**  
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p. 11

INTELLECTUAL PROPERTY

## Yale Recovers Lucrative Patent

Decision resolves dispute with Nobel Laureate over mass spec technique

[STU BORMAN](#)

[Yale University](#) has won a patent dispute with a former faculty member, chemistry professor [John B. Fenn](#), 87, now of Virginia Commonwealth University, Richmond. In a court decision dated Feb. 8, Yale was awarded damages of more than \$1 million and was assigned ownership of one of the basic patents on electrospray ionization mass spectrometry.

While at Yale in the late 1980s, Fenn developed ESI-MS for the analysis of large molecules, such as proteins. That work won him a share of the 2002 Nobel Prize in Chemistry. Unbeknownst to Yale administrators, Fenn applied for a patent, and it was approved in 1992, with Fenn as assignee.

Fenn licensed it to [Analytica of Branford](#), Conn., which he cofounded. Analytica then sublicensed rights to instrument makers. When Yale found out about the patent, it claimed rights to it and asked Fenn to reassign it to the university, but Fenn refused.

Fenn sued Yale, the university filed a counterclaim, and the U.S. District Court in Hartford decided the case in Yale's favor in a preliminary decision in 2003. The court found that Fenn "misrepresented the importance and commercial viability of the invention, ... actively discouraged Yale from preparing and filing a patent application," and wrongfully filed one himself without notifying Yale and the [National Institutes of Health](#), which helped fund the work.

In this month's final decision, the court ordered that Fenn pay Yale damages--\$545,000 in misdirected royalties and penalties and about \$500,000 in attorney fees--and that the patent be transferred to Yale. Fenn "is guilty of civil theft," it concluded.

[Timothy J. Oyer](#) of Wolf, Greenfield & Sacks, Boston, an intellectual property attorney with a doctorate in inorganic chemistry, comments that "the percentage of net patent royalties flowing to inventors under Yale's current policy is quite generous when compared with other universities, and certainly when compared with industry. If Dr. Fenn indeed induced Yale not to file a patent application on the invention by intentionally downplaying its significance, he made an improper and highly atypical decision as a professor."



**Fenn**  
ALLEN JONES/VCU  
CREATIVE  
SERVICES



**Yale**  
MICHAEL  
MARSLAND, YALE  
UNIVERSITY

"We are pleased by the court's vindication of the Yale patent policy," says Thomas Conroy, Yale deputy director of public affairs. "Yale has the greatest respect for Dr. Fenn as a scientist. We made repeated attempts to mediate with Dr. Fenn."

"I filed for a patent because Yale didn't," after the university decided there was insufficient commercial interest, Fenn tells C&EN. "Then Yale found out it was worth a substantial amount of money and said I stole it." Two earlier electrospray patents were assigned to Yale and were even more valuable, he notes. Fenn denies the theft charge and says he intends to appeal.

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