

# The cream of the crop

Becoming an IP Hall of Fame inductee is no easy thing. That's why those who have made it this year are all acknowledged leaders in their respective fields

By Sara-Jayne Adams and Joff Wild

The five individuals to be inducted into the IP Hall of Fame for 2008 were announced at the end of September. They are Jane Ginsburg, Francis Gurry, Dolores Hanna, Michael Kirk, and Niels Reimers. They have all won plaudits throughout their careers and their induction to the IP Hall of Fame recognises the tremendous contribution each has made to the development of the global intellectual property system.

The five were chosen by the 40-plus members of the IP Hall of Fame Academy following a selection process that began on 1st May 2008. It was then that members of the global IP community were invited to nominate individuals who they felt had "made an outstanding contribution to the development of intellectual property law and practice", and to supply supporting paragraphs giving their reasons. All nominations were sent to Academy members. To give you an idea of the work that Academy members put into making their final decisions, the nomination document was 78 pages long, ran to over 24,000 words and contained more than 200 nominations. Such facts also demonstrate quite what an achievement it is to be voted into the IP Hall of Fame – a lot of very well-known names did not make it.

The IP Hall of Fame seeks to identify

individuals who have helped to establish intellectual property as one of the key business assets of the 21st century. The aim is not only to acknowledge the vital role played by these innovators in fostering today's vibrant IP environment and ensuring its continued health, but also to show how central IP is to the global economy and to the wellbeing of people across the world. In addition, it is a way for the global IP community to thank those who have helped create a thriving industry and one which, as is discussed elsewhere in this magazine, is set to become even more important over the coming years (see "A flight to quality", pages 41-53).

On 22nd June 2009, this year's inductees into the IP Hall of Fame will be honoured at a gala dinner that will take place in Chicago. This is being held as part of the IP Business Congress 2009 ([www.ipbusinesscongress.com](http://www.ipbusinesscongress.com)) and promises to be a memorable event. Soon afterwards, the process to find 2009's inductees will begin. The support the IP Hall of Fame receives from IP professionals across the world has been hugely gratifying. Long may it continue. *iam*

You can find the names of all previous inductees into the IP Hall of Fame, as well as photos and profiles, at the IP Hall of Fame website. There is also a list of the current members of the IP Hall of Fame Academy. [www.iphalloffame.com](http://www.iphalloffame.com)

## Jane Ginsburg – international copyright expertise

“I didn’t have any preconceptions about copyright law and was totally ignorant when I got to law school,” admits Jane Ginsburg, professor of literary and artistic property law at Columbia University School of Law in the US. “I opted for the course because the teacher offering it was the best I’d had in my first year of law school.” Finding the subject engaging, she pursued studies in intellectual property and received her JD from Harvard in 1980.

After law school, Ginsburg spent a year clerking for the Honourable John J Gibbons of the United States Court of Appeals for the Third Circuit before spending three years as an associate with New York law firm Cowan, Liebowitz & Latman PC. It was following this period in private practice that, in 1984, Ginsburg won a scholarship to study for a *diplôme d’études approfondies* (DEA) in intellectual property law at the University of Paris II. “The official reason for wanting to study in Paris was my anticipation that international intellectual property would become increasingly important and that as a common law-trained lawyer it would be desirable to learn a civil system’s copyright law,” Ginsburg recalls. The unofficial reason was somewhat different. “The study programme legitimised my aesthetic yearning to live in Paris,” she laughs.

Ginsburg has written extensively on French copyright law and believes that her time spent in France has been crucial as her career has progressed. “I think I owe my job to having studied in France,” she affirms. “My speculation that international IP would be important turned out to be correct. The year spent in a French law school proved very formative not just for learning IP, but for understanding other approaches to law in general.”

Ginsburg has taught French and US copyright law, as well as US legal methods and contracts law, at the University of Paris. She has also held the Arthur L Goodhart Visiting Chair of Legal Science at the law faculty of Cambridge University and she has returned there as a Herbert Smith Fellow during Michaelmas term 2008.

To date, Ginsburg has penned over 100 articles and numerous books on copyright and trademark law. She is widely regarded as one of the world’s foremost authorities on international copyright issues. One contribution of which she is most proud is

her co-authorship with Sam Ricketson of the highly regarded *International Copyright and Neighbouring Rights: The Berne Convention and Beyond*, published by Oxford University Press in 1996. Ricketson had written what many considered to be the definitive book on copyright law in 1987 and, when looking to publish this second volume, asked Ginsburg to collaborate. The book provides an analysis of major international conventions on copyright and also considers how international copyright laws apply to the digital age.

Since Ginsburg began her career in IP, rapid developments in technology, such as the advent of the internet, have created increased opportunities for infringement. Consequently, the laws that govern the protection of rights – and the rights themselves – have come under close scrutiny. Debate over whether consumers should pay for the use of a protected work and, if so, how much rages on. “It really is a case of greed on both sides,” Ginsburg sums up. “There is a perception that copyright owners are trying to squeeze every last dollar for every possible use of the work on the one hand; and on the other there is the propensity of ordinary people just to take stuff.”

Moves by large copyright owners and associations, such as the Recording Industry Association of America (RIAA), to take action against individual infringers have, according to Ginsburg, not helped to improve public perception of copyright law in the US. “The general public associates copyright with big corporations such as Disney and doesn’t really think about individual authors,” she



says. Not only have these cases brought negative attention to the copyright cause, Ginsburg claims, but it is questionable how effective they have been. “The rights holders hoped that the prospect of getting caught would deter file sharers and encourage them to subscribe to paying services,” she explains. “But it’s not clear that the lawsuits have proved a successful deterrent.”

Ginsburg suggests that alternative means of deriving revenue from copyrighted materials should be considered. “It’s pretty clear at this point that it’s very hard to prevent people making unauthorised copies,” she states. Various alternative revenue streams have been proposed, including the suggestion that copyrighted materials become free for internet users while internet providers pay a percentage of their fees into a pool to be divided among producers and

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## Francis Gurry – rebuilding WIPO’s shattered reputation

authors. But such an approach has one fatal flaw, suggests Ginsburg. “To turn all of copyright into one enormous compulsory licence is very controversial. Copyright is not only the right to get paid, but also the right to say no.”

The internet has opened the door to a new breed of amateur authors who, Ginsburg feels, often have little awareness of their rights and how best to make use of them. This inspired the creation of [www.keepyourcopyright.org](http://www.keepyourcopyright.org), launched by Columbia University last year. “The website is designed to provide individual creators with information on how to deal with publishers or others to whom they are asked to grant some or all of their rights,” Ginsburg explains. While the website does not offer legal advice, it translates the terms of a contract into plain English. “The website has a database of contracts indexed with a rating system,” Ginsburg says. “The ratings range from a green thumbs-up for author-friendly contracts to a large red claw for incredibly over-reaching contracts. Unfortunately the largest number of examples we have are in the latter category.”

The internet has undoubtedly changed the landscape in which copyright law must function. Ginsburg sums it up: “The difference between the new technology and what has come before is that end users are engaging in acts which previously were engaged in only by commercial intermediaries.” And it will require some creative thinking about how to make the law work better for both the consumer and the rights holder. “Figuring out how such a pervasive copyright system should work may require devising a more flexible copyright regime than the one designed for commercial intermediaries,” she says. She is under no illusion that reaching a solution will be easy and appreciates that theory does not always translate into practice. “In the utopian view, the internet makes it possible for all authors to find a public who will not only consume, but also – where the author so requests – pay for their works,” Ginsburg explains.

“At the moment, the technology enables authors to attain the first objective, but the second requires both the technological innovations to implement easy means of payment and a willingness on the part of the public to pay.” ■

With a career at the World Intellectual Property Organisation (WIPO) that has spanned more than 23 years to date, there is no doubting Francis Gurry’s qualification for the director-general job he formally assumed at the beginning of October 2008.

Born in Australia in 1951, Gurry graduated from the University of Melbourne with a master of laws in 1976. Before joining WIPO in 1985, Gurry spent time in private practice at Australian firms Arthur Robinson & Company and Freehills, and as a senior lecturer in law at the University of Melbourne. It was while studying for a doctorate in the legal and economic analysis of trade secrets that Gurry’s interest in IP was piqued. “This led me to consider whether, from the viewpoint of economic policy, we should have a law that protected secrecy and at the same time have a patent law that encourages disclosure,” Gurry recalls. “And also to consider what is the compatibility of these two things.”

Gurry’s career with WIPO began in the Development Cooperation and External Relations Bureau for Asia and the Pacific. He went on to head the Industrial Property Law Section before joining the Office of the Director-General. It was while there that Gurry was instrumental in establishing the WIPO Arbitration and Mediation Center. Created in 1994 to offer alternative dispute resolution (ADR) options for international commercial disputes between private parties, the centre launched WIPO’s Domain Name Dispute Resolution Policy (UDRP). The UDRP, which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) in August 1999, enables trademark holders who feel that a domain name infringes on their mark to file a case with a resolution service provider, such as the Arbitration and Mediation Center.

Despite the eventual success of both of these initiatives, they did not initially meet with a warm reception. “The biggest challenge we faced when setting up the arbitration centre was to establish trust and credibility for a new institution in the world of dispute resolution, because obviously enterprises do not want to put their disputes with an institution that is untried,” explains Gurry. As for the UDRP, there was initially much resistance from those that believed that it would conflict with the widespread culture of non-regulation on the internet.

“People were very frightened of regulation for several valid reasons,” says Gurry. “They feared a multiplicity of inconsistent international laws which was no good for a global medium, and that the growth of the internet as a social and technological phenomenon would be stifled by regulation.” With time, however, WIPO was able to demonstrate the benefits of these services – including their speed and relative low cost when compared to litigation – and ensure their success. Yet Gurry is under no illusion that ADR holds all the answers. “I don’t think that it is a complete substitute for litigation, but it’s a very useful complement,” he states. “ADR can provide a neutral forum in the context of international transactions and can involve less confrontational procedures for resolving business disputes where the two parties have to remain in contact.”

While climbing the WIPO ladder, Gurry was at one time responsible for traditional knowledge and cultural expressions, and the need for a balanced agenda at WIPO that addresses the intellectual property needs of both the developed and developing world is something he understands. That the position of director-general went to someone from a developed nation with a strong IP tradition, rather than a nominee from a developing country, raised a few eyebrows in the IP world. Yet Gurry insists that any fears or accusations that his background would mean he favours a developed world agenda are unfounded. “I think that it’s not possible in a multilateral organisation to make progress on one agenda alone, whether it’s



## Francis Gurry continued

developed or developing countries,” he suggests. However, while he is not naïve enough to dismiss the concerns of the developing world, he believes that the debate is more complex than many suggest. “Of course, I understand that there are vast, very real differences across the world,” says Gurry. “But as far as IP is concerned, it is too simplistic a view to say that all IP is held by the countries of the north (or the developed countries) and that they exploit the countries of the south.”

It was, he believes, because of his clear intentions to re-establish WIPO as an organisation that people could have faith in – and not because of his nationality – that he won the position of DG. “In general, people wanted to see WIPO progress and that desire overcame political allegiances narrowly construed,” maintains Gurry. “The overwhelming desire was to see the organisation back on its feet again and making progress, and that led people to look at candidacies without necessarily holding to fixed, preordained political positions.”

The need to reaffirm WIPO as a trustworthy, reliable institution comes after the controversy surrounding the premature departure of the immediate past director-general, Kamil Idris. This followed allegations that he misled WIPO about his age when applying for the post. There were also questions over the way in which Idris managed staffing and financial issues at the organisation’s offices in Geneva. As a result, WIPO’s reputation has been severely damaged both internally and externally.

Gurry is eager to get the office back on the right track with a three-point plan. “First of all, we need to have a greater external focus. We have been very introverted and inward-looking in the last couple of years and we need to focus on the programmes for the outside world that we’re meant to be delivering. Secondly, we have to focus on the organisation having a service orientation. We are there to serve – whether it’s member states, or the users of our registration systems, or the general public. Thirdly, we need to create dialogue and communication. We have been isolated and cut off and we need to restore lines of communication both within the organisation and with the outside world.” This plan, Gurry explains, will work alongside a process of strategic realignment within the organisation. This will cover:

- The corporate culture of the organisation, focusing on issues such as customer orientation.
- The efficiency of WIPO’s administration processes internally and efforts to re-engineer them.
- Restructuring the secretariat to make it more responsive to new strategic goals and the objectives that the organisation is supposed to be meeting.

Taking these steps, Gurry hopes, will help to remind the IP world why it needs WIPO. For his part, Gurry is clear about the reasons: “Global issues and multilateral solutions.” As international economic and trade barriers continue to break down, Gurry believes that WIPO’s role will become evermore vital to the continued success and development of intellectual property. “Because our consumption of technology is increasingly global, many of the issues we confront in the area of IP are global in nature. For those issues, any single country cannot provide an adequate solution,” he explains. “The solutions have to be increasingly multilateral to work.”

Gurry appreciates that the IP world is rapidly evolving and that many of the concerns

surrounding intellectual property rights have changed in recent years. “Many of the things we confront now concern the use of IP as opposed to the issue or the grant of a title,” he says. “We have all these issues out there now about how IP is used – whether they concern litigation, trolls, licensing, the intersection of the effect of patents on access to medicines, the effect of technology in areas of climate change and so on.” Going forward, Gurry recognises that WIPO must keep up. “We shall focus increasingly on how IP serves innovation and creativity, and on the underlying social purpose for which we have intellectual property,” he states.

It is as the rejuvenator of WIPO that Francis Gurry wants his stint as director-general to be remembered. “The objective is progress on all fronts: a balanced agenda where everybody will be able to identify themselves in part of the programme and as part of the solution.” It is an ambitious aim and one that will ask a lot of an organisation that has spent many years mired in controversy.

But with a pedigree of success and an in-depth knowledge of IP, Gurry could just pull it off. If he does, he will deserve all the plaudits that he will inevitably receive. ■

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## Dolores Hanna – a trademark pioneer

Dolores Hanna set the first of many precedents in her career directly after graduating from Chicago Kent College of Law. It was then that she became the first woman ever hired by IP boutique Fitch, Even, Tabin & Flannery. But it was not a passion for intellectual property that led her to take the position. “When I interviewed with the firm I really didn’t know that much about trademarks or IP,” she admits. “So it was a case that the firm was taking a chance on me as a woman, and I was taking a chance on them to see whether trademark law was an area I enjoyed.”

The gamble paid off and before long Hanna achieved partnership at the Chicago-based firm. It was while working for Fitch, Even, Tabin & Flannery that Hanna was head-hunted by one of its biggest clients, Kraft Inc, which was establishing its headquarters in the Windy City. “Kraft asked me to join them as trademark counsel but I resisted for about a year as I wasn’t sure I wanted to leave my firm,” Hanna explains. However, she was eventually persuaded and, having made the move, Hanna went on to work for Kraft until its acquisition in 1988 by The Philip Morris Company.

It was then that Hanna’s career turned back towards private practice. She was special trademark counsel at law firm Hill & Simpson for several years before its dissolution in 2000. Hanna then moved to Bell Boyd & Lloyd where she headed up its trademark group until, to their disappointment, she retired in 2006. “I thought about retiring for about a three-year period, but every time I would approach the matter with management they would talk me out of it,” she says.

Hanna’s contribution to the trademark community has meant that many have regretted her recent withdrawal from day-to-day involvement in it. In fact, after advising the Public Interest Law Initiative – a Chicago-based organisation that creates opportunities for law students and lawyers to provide public interest law and *pro bono* services to the disadvantaged – that she would be retiring, its members subsequently made her a life director. This ensured her continued, albeit reduced, input. But Hanna believes that it is time to enjoy her retirement and give others the opportunity to make their mark. “Since my retirement I have done my best to withdraw from most of the

organisations to which I belonged,” she says. “I want the younger generation to know they have the opportunity to move ahead and succeed without feeling they have to defer to me.”

But defer they should. Hanna served as the first female president of the International Trademark Association (INTA) from 1984 to 1985 and holds the distinction of receiving INTA’s first President’s Award. Furthermore, as president Hanna requested a new look at US trademark law and consequently set in motion the first significant review of the Lanham Act. “We wanted to see if significant changes were needed to make certain that businesses and the public were given all the necessary assistance to make trademarks work as they were designed to do,” she explains. The subsequent Trademark Review Commission was appointed by the succeeding INTA president, William Finkelstein, and Hanna was asked to chair it.

Having studied the 1946 Act in great detail, Hanna cites Fritz Lanham as a personal IP hero whose work in the development of trademark law she most admires. And she is proud of what the 1988 Trademark Law Revision Act achieved. “It strengthened trademark law and gave trademark owners great opportunities, and made sure that the interests of the consumer were well protected,” she states. According to Hanna, one of the greatest achievements of the Act was the adoption of the intent to use application system. This enables those who have not yet used a trademark commercially, but plan to do so in the future, to have their mark protected until they are ready to use it and apply for registration.

Hanna’s desire to see the rights of IP owners and consumers protected inspired her to become a leading force in the establishment of the Chicago Intellectual Property Alliance in 2004. “We thought it would be very useful to have an area of the country that could become recognised for promoting and protecting intellectual property,” she explains. “We wanted to be different from those organisations that simply explained the law: we wanted to work together with businesses and organisations to help them understand what IP is and how it could enhance our way of life.” And the Alliance intends to spread this message further than the business world by dedicating time to interaction with the wider community.



Through the work they do with the US public school system’s science fairs, members hope to help inspire a new generation to develop their interests and ideas.

The promotion of IP is a theme that has run through Hanna’s career. It is currently evident in her efforts to educate and mentor young lawyers and students. She has acted as a role model specifically for other women looking to enter and progress within the industry. As president of INTA, Hanna was intent on paving the way for more women to follow in her footsteps. “I made it a point that women were included in the important committees and in any work of real consequence,” she explains. Hanna’s promotion of women in law did not stop with INTA: during her career she also acted as president of the Women’s Bar Association of Illinois and of the Women’s Bar Foundation.

Hanna recognises that while progress has been made in the number of women entering and succeeding in law, continued vigilance is required. Her contribution in this area was recognised in the mid-1990s when she received an award from the Chicago Bar Association’s Alliance for Women Committee. “I feel I did make a difference in the organisations I joined, in that woman have been recognised and are able to pursue an interest in those organisations,” she says. And now that Hanna has laid the foundations, she is happy to stand back as a new generation of trademark professionals build on her achievements. ■

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## Mike Kirk – a lifetime of service

If Mike Kirk had not been a soldier, the chances are that he would never have got involved with intellectual property. But while he was serving in the US army, he took on a role that involved liaising between engineers and scientists at a research base in Maryland and patent attorneys working in Washington DC.

Kirk, who had trained as an engineer before joining up, enjoyed the work and decided to learn more when he returned to the civilian world. He found himself a job as a patent examiner at the USPTO and studied for a law degree in the evenings at Georgetown Law School. He then went to work in the general counsel's office at NASA, before being called back to Washington DC and the USPTO when ex-NASA colleague (and IP Hall of Fame inductee) Gerald Mossinghoff was appointed as head of the office by Ronald Reagan in 1981. It was then that Kirk's career really began to take off.

"I got involved in the early 80s in a number of bilateral discussions between the US and other countries – mostly in the Far East – about linking IP and trade issues," he explains. This was something that both the Reagan administration and American industry supported – especially as there was growing dissatisfaction with WIPO's failure to persuade countries to improve their enforcement regimes. Born from these frustrations was a desire to take a new look at IP on the international stage; and so the TRIPs negotiations as part of the Uruguay Round came into being.

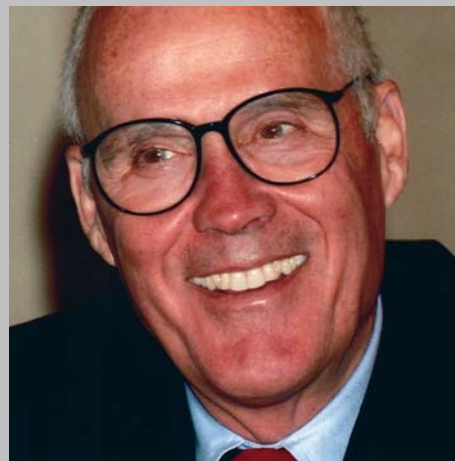
By the early 1990s, Kirk was heading up the international operation at the USPTO and he assumed the lead negotiating role as the TRIPs discussions entered their final, crucial year. What eventually emerged was the most comprehensive package of IP-related provisions ever seen in an international trade agreement. For the first time, minimum standards of enforcement and protection were to be obligatory for all those wishing to join the World Trade Organisation (established by the Uruguay Round) so as to obtain beneficial access to the markets of other member states. Post-TRIPs, countries would no longer be able to get away with words; instead, they would be judged on their actions. "That was the high point of my career up to then and a high point of global respect for and protection of IP," says Kirk. "I knew that something like that would not

happen again soon and so when I got a call from the then-president of the AIPLA to see whether I wanted to take up the executive director's position, it set me thinking."

Three weeks later, after being part of a USPTO delegation celebrating the 10th anniversary of the Chinese patent law in Beijing, Kirk got on a plane to Japan to represent the AIPLA at a meeting in Tokyo. And so began his 16 years at the head of what is probably the biggest national IP organisation in the world.

With 17,000 members, two-thirds of whom come from private practice and one third from industry, Kirk admits that it was always important to balance the interests of different sections of the AIPLA. But, he feels, by and large this was done successfully during his tenure. "We got the American Inventors Protection Act, which brought in things such as the publication of patent applications and *inter partes* re-examinations, and we worked with the Federal Trade Commission and National Academy of Science to build support for further changes in the law," he says. There was also a series of amicus briefs filed in a wide range of cases heard in US courts, including both patent and trademark cases that came before the Supreme Court. In the months before Kirk's retirement at the end of August 2008, the organisation filed a brief against the USPTO (in *Tafas v Dudas* on proposed new claims and continuation rules) for the first time in its history. "I am not saying the AIPLA could not have done a better job, but I think we acquitted ourselves rather well there," says Kirk, who points out that the organisation was the only bar association to have been involved in the *Tafas* case in that way.

Now that he has left the AIPLA, Kirk is doing part-time consultancy work for the Coalition for 21st Century Reform, a group that represents a number of companies that are opposed to the Patent Reform Act in its present incarnation. He has strong words for those businesses that have been pushing for the Act to be passed by Congress. "I do not think that wanting to do something about issues such as damages and permanent injunctions is the problem," he argues. "It's the way they have sought to make their point. When you say that the patent system is broken and needs fixing or that it puts innovation at risk, a lot of people are going



to believe you. I can even see their influence in the Supreme Court's decision in the *KSR* case, written by Justice Kennedy."

High-tech companies, he continues, are seeking to portray patent reform as a battle involving just themselves and the life sciences industries. "They want to make out that this is a struggle between companies that provide the technology products everyone enjoys and the big, bad pharma multinationals," Kirk explains. "But this is not the case. It is not pills versus chips; it is the high-tech industry and some in financial services against pretty much everyone else."

Although the legislation is stalled, Kirk expects it to be reintroduced early in 2009 by Patrick Leahy, its most prominent supporter in the Senate. "The real issue is what will then happen. It could be that should the same problems appear again, Leahy will decide he wants to forget patent reform and do something more productive instead."

Away from domestic US issues, Kirk is very excited by the appointment of Francis Gurry as the new WIPO director-general. "I am hopeful that he will return the organisation to its rightful position as a world opinion leader," he says. "I just hope that people understand he cannot do it overnight – after all, it took 11 years to get into today's situation. But Gurry is the best qualified man to sort it out." Kirk believes that with Gurry at the helm, there is a possibility that there may be positive moves towards greater harmonisation of the global patent system, especially if the new director of the USPTO – who will be appointed by Barack Obama – makes it a priority. "That could set something in motion. Quality patents internationally are in everyone's interests."

Kirk was at the recent meeting of the Trilateral Authorities in The Hague and was an active participant in the debates that took place there. International IP politics, it seems, remains a passion for the man who has given a lifetime of service to the US IP community. And you get the feeling that, retirement or not, if progress is to be made on international harmonisation, Mike Kirk will somehow be involved. The fact is, his experience is just too valuable. He will not be allowed to walk away, even if he wanted to. ■

## Niels Reimers – the man behind the RDNA licensing programme

Having earned degrees in mechanical engineering from both Stanford and Oregon State University, Niels Reimers served in the US navy before beginning his career in the aerospace industry.

It was in 1968, while working for Ford Aerospace as a division director of contract administration, that Reimers accepted the position of associate director of Stanford's Sponsored Projects Office. "I soon found out that contract management in the universities is less interesting than in industry as you're not at all involved in the research and its outcome," Reimers reveals. And the licensing and collaboration process was far more protracted. "When I first joined Stanford, the contract management office practice was to send an invention disclosure to Research Corporation in New York City" he explains. "In about six months we would hear back from them on whether or not they thought it was worth their filing a patent application for the purpose of licensing."

At that time, Research Corporation was managing licensing for several hundred universities, covering all patent and licensing expenses and sharing net royalty income with the client university. Reimers was interested to see whether there was a quicker, more lucrative method of commercialising the university's inventions. "I called around a few other universities with independent licensing programmes to see how they were being run," he says. Having seen that they were predominantly managed by patent attorneys and, on the whole, were not generating impressive revenues, he settled on a different approach. "I decided to focus my efforts in the direction of technology marketing so that we would be on the front end of tech transfers," Reimers explains. This meant that rather than waiting to secure a patent and then license an invention, marketing began on the technology promptly after its disclosure.

Having explained the merits of this approach to Stanford's management, Reimers was granted limited funding for a one-year pilot Office of Technology Licensing (OTL) programme to begin in 1969. "The pilot OTL was just me on a part-time basis," he recalls. But during this trial period Reimers brought in over US\$55,000 for the university: more than 10 times what Stanford had generated in total in the prior 15 years of working with an external licensing agent.

Subsequently, the OTL was approved as a university programme with one director and one secretary/office manager.

Despite Reimers' success in running the programme, the university's controller, Kenneth Creighton, wanted him to return to his position in research administration. He claimed that there was no career path in the OTL and that such a move could be detrimental to his career. Reimers response was that "if I could have five years of such fun, that would be the career of a lifetime". He was named director of the Stanford OTL and for the first few years of its existence continued to work as its only licensing associate.

While at the OTL, Reimers became involved in the creation of the Bayh-Dole Act. This pivotal piece of US legislation gave universities IP rights over inventions resulting from government-backed research and stipulated that inventors should receive a share of the income from the discovery. The effect was that almost immediately, universities saw the number of invention disclosures grow phenomenally.

To criticisms that the Bayh-Dole Act has incentivised universities to pursue only lucrative avenues of research Reimers acknowledges that "some universities have gone too far in the search for the dollar", but argues that this is not standard practice. "In my experience, the main objective of any faculty member is to publish their research findings promptly and contribute to the development of science and technology," he states. In fact, he continues, it is more often true that the most significant discoveries come from undirected basic research. "If a scientist begins to focus on more applied research in chase of commercially useful outcomes, any discoveries tend to be only incremental advances in the state of the art and less valuable from a licensing perspective; and, frankly, less likely to receive peer recognition and research funding."

The discovery which was to lead to perhaps Reimers' most celebrated achievement during his career in university technology transfer licensing, the recombinant DNA (RDNA) licensing programme, was made in 1974. Having read about a new technique called gene-splicing invented by professors Stanley Cohen of Stanford and Herbert Boyer of University of California, Reimers persuaded the scientists to let him patent their invention. Non-

exclusive licences with favourable terms were offered to industry with a deadline of December that year. Over 70 companies signed up and with the first year minimum payment two months later, Stanford had netted an impressive US\$1.4 million. In total, the number of RDNA licences granted reached 467. And by the licence expiration, OTL had 369 active licensees and had received cumulative royalty payments of over US\$250 million.

Throughout Reimers' career at the Stanford OTL, it was his practice to contact companies directly after a disclosure and without a confidential disclosure agreement (CDA). "I was not averse to signing CDAs – just to the time it would take (pre-email) going back and forth in the mail," he explains. Without a CDA or patent application on file, it was a pretty brave step, but one which Reimers believes paid off. "My focus in marketing a technology was collaboration between the company and the university in bringing a new product or process to public use and benefit, not a focus on the claims of a patent," he points out. "If our collaboration was successful, our mutual objective was achieved, regardless of whether a strong patent might issue or not."

According to Reimers, and perhaps contrary to the zeitgeist, strong and immediate IP protection is not always necessary. "There's no need to get hung up waiting for a patent application to be filed – or even necessarily decide whether to file for a patent – before contacting companies about possible collaboration or development," he insists. ■

