

Student inventor out of jail but patent dispute lives on

BY ANNETTE CODISPOTI

Assistant Editor, THE **INSTITUTE**

Taborsky is a free man today after serving time in a Florida prison in a bizarre patent case that questions university policies and guidelines for sponsor research.

Taborsky, a former student at the University of South Florida, Tampa, Fla., USA, was released 1 April after spending 18 months in jail and a work-release program. He first received probation after being convicted of theft of trade secrets, but his probation was revoked twice for applying for a patent and for refusing to sign over his patent to USF, which the judge did for him.

Dan Fisher, chair of the IEEE-USA Intellectual Property Rights Committee, said the committee is concerned about this sort of problem and urges universities to develop policies to avoid situations like this but emphasizes the Taborsky case is extreme.

UN POLICY. Fisher said universities have to be clear with student employees about whether they are hired to invent or not and should include notices in catalogs and other obvious places that tell students where they can view a copy of the university policies. 'Right now it's ambiguous, and it's ambiguous all over the country,' said Fisher.

But as long as the criminal court decided Taborsky stole trade secrets Fisher said, "the judge is within his rights to order him to sign it (patent) over."

Counsel Hank Lavandera agrees. He compared the judge's order to a judge forcing a spouse to sign over property in a divorce Taborsky's patent attorney Charles McClure disagrees with both men, saying the court had no right to prevent anyone from filing for a patent or to force someone to sign over a patent.

In 1986, as a student at US, Taborsky began working as a part-time assistant for Dr. Robert Carnahan in the civil engineering laboratory under a financial aid program.

SPONSOR RESEARCH. Progress Technologies Corporation, a subsidiary of 5 power utility company Florida Progress, awarded a US\$20,000 grant to US Division of Sponsor Research to perform part of a study on waste water treatment. Taborsky was assigned to the three-month project and performed laboratory testing. When the project ended Carnahan took Taborsky off the account.

But this is where the two sides disagree on what happened next. Taborsky said he continued to work part-time on other accounts while working on a master's thesis. According to Lavandera these other accounts were related to the first and Taborsky was never working on a master's thesis because he never completed courses for a bachelor's degree.

Then Taborsky claims in July 1988 while working on his master's thesis project on the various physical properties of day, he made a discovery which he believed would be valuable to PTC. Carnahan informed him that although potentially valuable he could not benefit from his discovery. When Taborsky discussed filing for a patent he claimed the professor threatened him with jail. "I thought he was crazy," said Taborsky.

CONTRACT. In a meeting with a representative from Progressive Water Technologies Corporation, another subsidiary of Florida Progress, in September 1988 to discuss his discovery and employment, Taborsky signed a confidentiality agreement. Carnahan signed the same agreement and backdated his to July 1988.

But the deal fell through and Taborsky applied for a patent. Criminal charges followed, and Carnahan and a Florida Progress representative filed a

competing patent.

'I didn't think it would reach this point,' said Taborsky. At first he and his wife consulted her family and the phone book for criminal and patent attorneys. Taborsky, who is not an U.S. citizen (he came to the U.S. from Czechoslovakia when he was six years old) also, had to fight the state's efforts to deport him.

CONVICTION. Taborsky was convicted in January 1990. Following his conviction and rejected appeal he filed two motions for post-conviction relief. His motions were rejected. Taborsky feels that evidence such as the campus police report detailing the investigation, which led to his arrest by Tampa police, would have helped his case. The jury did not see the police report at his trial. The university investigation also led the, Florida Board of Regents to believe Taborsky signed a confidentiality agreement before he started work on the project, therefore the board authorized the university to file suit against him.

INVENTORSHIP AND OWNERSHIP. The US. Patent and Trademark Office has determined Taborsky is the sole inventor. McClure said the record is quite clear. The university showed beyond a shadow of a doubt they didn't know what the invention was, said McClure of the application by Carnahan. He added, "They had the notebooks and still didn't get it." The university is still claiming ownership of the patents and is no longer disputing inventorship.

Lisa Zgorski, press secretary for the **US** Patent and Trademark Office, said the office will do the scientific evaluation but does not get involved with court matters. She added these criminal disputes over Patents are "rare but not unheard of."

Taborsky said he is seeking vindication, and the patent issue is secondary. Despite his ordeal, McClure said Taborsky is a gentle person with absolute integrity, but Lavandera believes Taborsky brought this on himself by ignoring judges' orders and decisions. "What, he is, is a convicted felon," said Lavandera.