COLUMBUS, OHIO, July 3, 1931.

HON. JOHN W. BOLIN, *Prosecuting Attorney, Athens, Ohio.*

DEAR SIR:—Your recent request for my opinion reads:

> "We have in our county and in Athens Township, a duly elected constable who has accepted an appointment under Civil Service as fire marshal for the city and he makes his residence in the building furnished for the Athens City jail, taking care of the prison and driving the fire truck.
>
> I feel that these positions of constable and fire marshal are inconsistent and that he is holding the constable job illegally or vice versa."

Section 486-23, General Code, relative to civil service employes, provides in part:

> " * * * Nor shall any officer or employe in the classified service of the state, the several counties, cities and city school districts thereof be an officer in any political organization or take part in politics other than to vote as he pleases and to express freely his political opinions."

This office has often held that one who is elected by the people is in politics.

> 1928 Opinions of the Attorney General, 1119.
> 1929 Opinions of the Attorney General, 837.
> 1929 Opinions of the Attorney General, 1904.

In an opinion found in the 1929 Opinions of the Attorney General, 1619, after reviewing the various authorities on the question, I stated:

> "These opinions clearly disclose that one may not hold a public office whether elective or appointive and at the same time be in the classified civil service of the state."

While the above quotation refers to the classified service of the state, it is also applicable to the classified service of a city.

Since the duly elected constable in the instant case is in politics, it follows that under the provisions of Section 486-23, supra, he may not concurrently hold a position in the classified service of a city.

In view of the foregoing, I am of the opinion that a duly elected township constable may not concurrently hold a position under the classified service of a city.

Respectfully,
GILBERT BETTMAN,
Attorney General.

3399.

CONTRACT—BETWEEN OHIO STATE UNIVERSITY TRUSTEES ACTING THROUGH ADVISORY COUNCIL OF ENGINEERING EXPERIMENT STATION AND CO-OPERATIVE AGENCY FOR ASSIGNMENT OF ANY PATENTS TO SAID AGENCY RESULTING FROM INVESTIGATION FINANCED BY SUCH AGENCY—PROPER CONSIDERATION NECESSARY—OPINION NO. 2619 CONSIDERED.

SYLLABUS:

An agreement made by the Trustees of the Ohio State University through

the advisory council of the University Engineering Experiment Station to assign to a co-operative agency any patent or patents obtained as a result of researches and investigations made at the instance of and in conjunction with the co-operative agency, must be based on a proper consideration, in order to foreclose the right of the advisory council to publish the results of the said investigation, as authorized by Section 7961-5 of the General Code of Ohio, and to justify the university authorities in not carrying out their duty to dedicate such patents to the public, and permit the assignment of the patent or patents to the co-operator.

COLUMBUS, OHIO, July 3, 1931.

DR. GEORGE W. RIGHTMIRE, *President, Ohio State University, Columbus, Ohio.*

MY DEAR DR. RIGHTMIRE:—I am in receipt of your recent communication, the pertinent part of which reads as follows:

> "In the first Opinion which you rendered on the subject of patents resulting from research in the Ohio State University Engineering Experiment Station, the last sentence is as follows:
>
> 'A contributor has no choice in the matter if the trustees choose to publish the results of their investigation unless the right of the contributor to patents growing out of such investigation is previously fixed by contract before the investigation starts.'
>
> * * * * * * * * * * * * *
>
> I beg to come back to you now with the following thoughts:
>
> When an agreement between a cooperator in an industry and the Engineering Experiment Station Council is drawn up nobody knows how important the research in pursuance of the project may be. It may result in something very valuable commercially or it may 'pinch out' and produce no results which are conclusive of anything. Most research comes out in the latter way. Therefore, the value of an item in the contract waiving the University's right to give publicity to and to disseminate information about the results of the research is entirely problematical and if included in a contract would be there merely as a part of a contract form which might be established for use. At the time of entering into the contract any particular value of such waiver would not be apparent and probably would not get the attention of either party.
>
> However, if as a result of the research certain important discoveries are made which are patentable, at that time the parties would receive the first impression of the importance of determining what should be done about patents. Patents result in so few research projects that it is scarcely worth thinking about what may be done in case valuable discoveries are made until they are coming over the horizon.
>
> In view of this particular situation I am led to inquire what force should be given in your opinion to the sentence above quoted. As I read the Opinion this element is introduced nowhere else therein and therefore the thought has occurred to me many times since first reading the Opinion, that the time when the waiver is made might not be important and since the situation in which a waiver would prove to be of any value would not arise except after research has been carried on and since the dissemination of the information about the research would not knowingly take place

until the time at which the research is showing an outcome, it has impressed me that possibly the waiver might with propriety take place only at the time when it becomes apparent that there is something worth while to waive. The question in my mind then is briefly this:—

Under the statute relating to the Engineering Experiment Station may not the waiver of the right to give publicity be made by the University any time after it appears that the cooperator will get something of value through the waiver. It should be kept in mind that even if it seems worth while to make an application for a patent on the discovery made in the research yet it will be a long time before it can be determined by the Patent Office whether there is patentable material and the cooperator can have assurance of value which might become its own property and interest only after the Patent Office procedure has been completed.

* * *"

The opinion to which you refer is Opinion No. 2619, addressed to you under date of December 3, 1930. It had to do with the ownership of patents which were the outgrowth of research work conducted by the Engineering Experiment Station affiliated with the College of Engineering at the Ohio State University when that research was conducted at the instance of, and partially or wholly at the expense of individuals, firms or corporations who had sought the assistance of the experiment station and cooperated with the station in rendering such assistance, by authority of Section 7961-5, of the General Code of Ohio.

In the act of the General Assembly establishing the Engineering Experiment Station at Ohio State University, which act was codified as Sections 7961-1 to 7961-5, inclusive of the General Code, of Ohio, it is provided that the station shall be under the control of the Board of Trustees of the University, through its regular administrative and fiscal officers. The board is directed to appoint a director for the station and an advisory council of seven members consisting of the director and six others

By the terms of Section 7961-5, General Code, power is granted to the station to extend its facilities in aid of any individual, firm or corporation who may seek its assistance. The advisory council, however, is empowered to decline to render such assistance, or to require that any expense incident to such assistance, if rendered, shall be borne either in whole or in part by the person or persons who seek the assistance. The advisory council is further authorized to publish the results of the investigations of the station at its option.

From the terms of the statute it seems clear that the option to publish the results of the investigations conducted by the station exists in any case whether the advisory council had previously required the cooperator or the individual, firm or corporation at whose instance the research had been conducted, to finance the investigation or not, unless that option be foreclosed by agreement of the parties.

In the course of researches conducted by the station, it occasionally happens that a new process or article of manufacture is developed which is patentable, and the question at once arises, to whom the benefits of the patent, if one is obtained, shall accrue. This question is of considerable moment in cases where a so-called cooperator had prompted and financed the research out of which the new process or article of manufacture upon which a patent is obtained had grown.

The purport of Opinion 2619, is to the effect that patents obtained under the circumstances mentioned, are not the property of cooperators in any case unless the board of trustees of the university through the advisory council of the station

determines, in its discretion, that the best interests of the station and of industry and trade will be served by agreeing with the cooperator to give to it the immediate benefits growing out of the assistance rendered to it, in consideration of its financing the investigation in whole or in part, and does so agree. It is held in the said opinion, as stated in the syllabus thereof as follows:

> "1. The Ohio State University, through its Board of Trustees, may lawfully contract with persons, firms or corporations, or associations of persons, firms or corporations who seek the assistance of the Engineering Experiment Station affiliated with and operated in connection with the College of Engineering, and who bear in whole or in part the expense incident to such assistance, that any patents granted on processes discovered or devised or on articles of manufacture developed in the course of rendering such assistance, shall be assigned in whole or in part to the cooperator.
>
> 2. In the absence of contract, contributing agencies are not entitled to an assignment of patents obtained as a result of experiments or research work conducted by the Engineering Experiment Station affiliated with the College of Engineering at the Ohio State University, even though such contributing agencies bear a part or the whole of the expense incident to such experiments and research."

An agreement, such as is spoken of, in order to be valid and binding must of course possess the elements necessary to make a binding contract in accordance with law. It must be based on a proper consideration, the same as any valid and binding contract must be. For that reason the agreement, in order to constitute a valid contract, should be made to operate prospectively while mutual promises may be made in consideration of each other. To foreclose the option reposed in the university authorities to publish the result of any investigation, the agreement not to publish it and to give to the cooperators the benefits of the invesigation, whether a patent or patents grow out of the investigation or not, should be made while yet there may be some consideration moving to the university in order to validate and bind the agreement. For that reason I was prompted to say in the opinion, after discussing questions relating to the ownership of patents obtained as a result of researches conducted by the station and after speaking of the optional right on the part of the university authorities to publish the results of investigations and researches made by the station: "The decision as to the publication lies wholly with the station. A contributor has no choice in the matter if the trustees choose to publish the results of their investigation unless the right of the contributor to patents growing out of such investigation is previously fixed by contract before the investigation starts."

The Trustees of the University are public officers. The Director and members of the advisory council of the Engineering Experiment Station, if not technically public officers, are at least public employes. They are charged with a public trust with reference to the conduct of the affairs of the Experiment Station and the use of the property of the station and the University. If, after an investigation is completed during which a patentable process or article has been developed and a patent obtained thereon, that patent belongs to the University to be dedicated to the public as stated in my Opinion No. 2929 issued under date of February 10, 1931, it is then beyond the power of the University authorities to agree to assign the patent or patents to anyone. Any agreement to do so made at that time would be entirely without consideration, or based on a past consideration, and would virtually amount to the giving away of property which belongs to the public. To

make such an agreement and carry it out would, in my opinion, be a violation of the trust reposed in the university authorities and would be beyond their power to make.

If, at any time during the progress of an investigation, it appears that funds are necessary to complete the investigation, and the advisory council requires a cooperator to furnish those funds, the funds so furnished, if reasonably commensurate in amount with the beneficial results of the investigation, may be a valid consideration for an agreement to forego the publishing of the results of the investigation and to assign to the cooperator who furnishes the funds any patents that may be obtained as a result of the work of the researches so conducted.

The statement of the former opinion that the right of the contributor to patents growing out of such investigation should previously be fixed by contract *"before the investigation starts"* is possibly too narrow. Such an agreement to assign the results of an investigation or patents obtained as a result thereof to a cooperator may no doubt be made at any time, so long as the consideration therefor is a valuable consideration and sufficiently adequate that it may not be said that the university authorities abused their powers by reason of its inadequacy.

Respectfully,
GILBERT BETTMAN,
Attorney General.

3400.

OMNIBUS BOND—COVERING OFFICERS AND EMPLOYES OF POLITICAL SUBDIVISION—SIGNATURES OF VARIOUS EMPLOYES UNNECESSARY—DESIGNATION BY POSITIONS RATHER THAN BY NAMES SUFFICIENT—INCORRECT HEADING OF SCHEDULE OF POSITIONS NOT BAR TO SURETY LIABILITY FOR ALL EMPLOYES OF A DEPARTMENT, WHEN.

SYLLABUS:

1. *The faithful performance of duty by any number or a group of the officers or employes of a municipality or other political subdivision may be guaranteed by the provisions of a single or omnibus bond purporting to cover each or all of said officers or employes.*

2. *It is not necessary that the officers or employes, the faithful performance of whose duties the bond purports to guarantee, be designated by name, in such instrument or in the schedule attached thereto. It is sufficient that the position or office be designated.*

3. *An official bond purporting to guarantee the faithful performance of duty of a public officer or employe is not necessarily rendered invalid by reason of the fact that the principal does not join in the execution of the instrument by affixing his signature thereto, where such bond is executed by a bonding company for a valuable consideration and the form of the instrument and the whole transaction discloses that it was never intended that the officer or employe covered by the bond was to join in its execution or its obligation.*

4. *The contractual obligation of the signer of such a bond is primary and not that of a surety. Maryland Casualty Company* v. *McDiarmid,* 116 *O. S.,* 576.

5. *Where an instrument of the kind described in syllabus No. 3 above, recites in the body thereof that the contract is made with a certain department of a*