Patently Strategic Musings

Inventorship Before the Seeming Irrelevance of the Prior Art

Daniel Wright

Aurora Consulting LLC

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Inventorship

Naming names and ruffling feathers

Inventorship 101 (uh, I mean 116)

- US patents issued to the INVENTORS
- Contributes to the CONCEPTION
  - Reduction to practice not necessarily required
- Joint Inventors need NOT:
  - Physically work together at the same time
  - Make the same type or amount of contribution
  - Contribute to EVERY claim

35 U.S.C. 101, 115, 116; 37 CFR 1.45; MPEP §2109

Claims Make the Invention

- Conception of the invention AS CLAIMED
- Inventorship can change as the claims change.
- WHY do claims change?
  - Restriction requirements
  - Formalities rejections (e.g., §101 and §112)
  - Prior art rejections (e.g., §102 and §103)
- Fundamentally, you must invent OVER the prior art

MPEP §602.09, §2109

Being an Inventor vs. Being an Inventor

- To be named on a patent application is a distinct standing from the status granted by an issued patent
- Details of a prior art analysis are irrelevant

Fictional Example: Whale Hunting

- Ishmael and Queequeg are collaborating to develop the ultimate whaling harpoon
- Ishmael develops a new grip; Queequeg develops a new spear tip
  - Claim includes both elements
- The USPTO determines the Ishmael's grip to be obvious over a product in a Bass Pro Shops® brochure
- Queequeg's spear tip is found novel and non-obvious
- The case issues with both Ishmael and Queequeg as inventors
  - i.e., no obligation to remove Ishmael from the patent
- What if claimed separately?

Case Law Example 1:

Pannu v. Iolab Corp., 155 F.3d 1344 (Fed. Cir. 1998)

- Pannu invents a new lens implant and files for a patent
- Pannu meets with Link to discuss a license to manufacture
- Link suggests an improvement to the lens
- Pannu files a CIP that includes the improvement but names only himself as inventor
- Iolab Corp. asserts patent invalid for improper inventorship
  - Link should be the only inventor on the CIP
  - Pannu's contribution already prior art due to the offer for sale

Case Law Example 1:

Pannu v. Iolab Corp., 155 F.3d 1344 (Fed. Cir. 1998)

- Sole inventor? No. Co-inventor? Yes
- "During the meeting with Link, Pannu was doing more than simply providing Link with well-known principles or explaining the state of the art"
- "Because it is undisputed that the invention was conceived while Link and Pannu were engaged in a collaborative enterprise and it is furthermore undisputed that Pannu conceived significant aspects of the invention, Pannu is certainly at least a co-inventor."
- Inventorship Correction
- CIP formalities

Case Law Example 2:

Dana-Farber Cancer Institute v. Ono Pharmaceutical Co., Ltd., No. 19-2050 (Fed. Cir. 2020)

- 2018 Nobel laureate Dr. Tasuku Honjo (Ono Pharmaceutical)
- Dr. Gordon Freeman and Dr. Clive Wood (Dana-Farber Cancer Inst.)
- Antibody-mediate cancer treatments – PD-1 receptor

Case Law Example 2:

Dana-Farber Cancer Institute v. Ono Pharmaceutical Co., Ltd., No. 19-2050 (Fed. Cir. 2020)

- Early 1990s – Honjo identifies PD-1 gene and receptor
- 1998 – Honjo meets with Ono and Wood; agree to collaborate
- 1998 – Freeman independently researching ligands; joins collab.
- 1999 – Freeman and Wood file a provisional without Honjo
  - These aren't the patents at issue
- 2000 –Group publishes journal article
- June 2000 – Honjo learns of 1999 provisional. Dana-Farber declines to add him.

Case Law Example 2:

Dana-Farber Cancer Institute v. Ono Pharmaceutical Co., Ltd., No. 19-2050 (Fed. Cir. 2020)

- Late 2000 – Honjo stops sharing results
- 2002 – Honjo files his own patents without naming Freeman or Wood on subject matter relying mostly on his own group's experiments.
- "It is not without interest that in [Honjo's] acceptance speech he credited Dr. Freeman as a major collaborator in his work."

Case Law Example 2:

Dana-Farber Cancer Institute v. Ono Pharmaceutical Co., Ltd., No. 19-2050 (Fed. Cir. 2020)

- Ono's Arguments:
  - Subject matter is removed from the original collab of Freeman and Wood
  - Patents were issued over the 1999 filing
  - The 2000 journal article disclosed Freeman and Wood's contributions
- "Ono urges us to adopt a legal rule that once a contribution is made public, it 'no longer qualifies as a significant contribution to conception.' Appellants Br. 39." (page 10)

Case Law Example 2:

Dana-Farber Cancer Institute v. Ono Pharmaceutical Co., Ltd., No. 19-2050 (Fed. Cir. 2020)

- Court sided with Dana-Farber
- Contribution to conception is key
- "Conception is complete when an idea is definite and permanent enough that a [PHOSITA] could understand the invention" (Page 11)
- "Joint inventorship does not depend on whether a claimed invention is novel or nonobvious over a particular researcher's contribution." (Page 12)

Case Law Example 2:

Dana-Farber Cancer Institute v. Ono Pharmaceutical Co., Ltd., No. 19-2050 (Fed. Cir. 2020)

- Ono has petitioned cert from the Supreme Court asking:

"Whether the Federal Circuit erred in adopting a bright-line rule that the novelty and non-obviousness of an invention over alleged contributions that were already in the prior art are 'not probative' of whether those alleged contributions were significant to conception"