



UNIVERSITY OF  
MARYLAND  
SCHOOL OF LAW

**PATENT LAW  
UPDATE**

***In re Jolley***

No. 01-1646  
Federal Circuit  
Oct. 29, 2002

***"[I]f there is no evidence in record that all of the elements of the count resided in the inventor's mind, a noninventor's testimony cannot supply the missing pieces."***

On October 29, 2002, the Federal Circuit affirmed the decision of the Board of Patent Appeals and Interferences that awarded priority of invention to McGraw based upon an earlier conception and diligence toward a later reduction to practice in a five-way interference proceeding relating to ester lubricant compositions compatible with chlorine-free HFC refrigerants. The Federal Circuit stated:

[The inquiry centers on] an e-mail sent by Ward to co-inventor McGraw [that] evidences a conception including esters both within and without the count. Conversely, the count encompasses some esters that were the subject of Ward's e-mail as well as others that were not. The disclosure of conception and the scope of the count have some overlap, but do not correspond neatly with each other.

[W]hen disclosure and count overlap, the question of whether an alleged conception discloses the subject matter of an interference count with sufficient particularity is a fact-intensive inquiry, based on whether the evidence of conception fairly suggests to one of ordinary skill the subject matter of the count, without the need for extensive experimentation to ascertain whether the matter encompassed by the disclosure suggests the desirable features of compositions belonging to the count. Although the fundamental inquiry in conception is whether the inventor held the complete invention in his or her own mind, proof of conception requires objective evidence of what the inventor has disclosed to others, and what that disclosure would fairly suggest to one of ordinary skill in the art. Thus, a preference for particular subject matter, highly relevant though not dispositive to this inquiry, must also be established on the basis of objective evidence. . . .

Jolley contends that because Ward's e-mail sets forth nothing more than a "research proposal" suggesting that a group of compounds be tested for the desired activity, it cannot evidence a complete, definite, and settled idea as the law of conception demands. Although we have stated that when the inventor has no more than "a general goal or research plan he hopes to pursue" conception has not occurred, the conception inquiry is fact-intensive and no per se rule excludes "research proposals" as evidence of conception. . . . The determinative inquiry is not whether McGraw's disclosure was phrased certainly or tentatively, but whether the idea expressed therein was sufficiently developed to support conception of the subject matter of the interference count. . . .

Because conception is a mental act, evidence of conception must ultimately address whether the inventor formed "the definite and permanent idea of the complete and operative invention" in his or her mind. Evidence of whether a noninventor envisioned the count limitations upon perusing the inventor's disclosure is relevant only insofar as it may address what the inventor's disclosure would mean to one of ordinary skill in the art. [I]f there is no evidence in record that all of the elements of the count resided in the inventor's mind, a noninventor's testimony cannot supply the missing pieces. But in the present case, there is no dispute that Ward's e-mail discloses a group of esters including esters of the count

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