



## TECHNOLOGY LAW UPDATE

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### *In re Crish*

No. 04-1075  
Federal Circuit  
Dec. 21, 2004

*[O]ne cannot establish novelty by claiming a known material by its properties. [J]ust as the discovery of properties of a known material does not make it novel, the identification and characterization of a prior art material also does not make it novel.*

On December 21, 2004, the Federal Circuit affirmed the decision of the Board of Patent Appeals and Interferences upholding the rejection under 35 U.S.C. § 102(b) of the claims of application Serial No. 08/822,509, which related to DNA having promoter activity for the human involucrin gene (hINV). The Federal Circuit stated:

A determination that a claim is anticipated under 35 U.S.C. § 102(b) involves two analytical steps. First, the Board must interpret the claim language, where necessary. Because the PTO is entitled to give claims their broadest reasonable interpretation, our review of the Board's claim construction is limited to determining whether it was reasonable. Secondly, the Board must compare the construed claim to a prior art reference and make factual findings that "each and every limitation is found either expressly or inherently in [that] single prior art reference." . . .

First, Crish argues that the Crish and Welter publications cannot anticipate his claims because the prior art does not provide any information regarding nucleotide sequences. According to Crish, the fact that Crish's application references a prior art plasmid is irrelevant; the pending claims cover a specified novel DNA sequence, not the starting materials. Secondly, Crish asserts that even if the Crish and Welter publications are relevant, a person of ordinary skill in the art starting with the plasmid disclosed in the Crish and Welter publications would not necessarily obtain SEQ ID NO:1. Crish explains that different DNA sequencing techniques, for example, using different restriction enzymes, may result in workers obtaining different DNA sequences. Specifically, Crish relies upon the Lopez-Bayghen publication where workers purportedly used the same plasmid disclosed in Crish's application, but obtained a DNA sequence different from SEQ ID NO:1. Finally, Crish argues that there is no evidence that the plasmid disclosed in the Crish publication is the same plasmid used to obtain SEQ ID NO:1. Crish raises the possibility that the plasmid referenced in Crish's application may have become contaminated or mutated, thus having a DNA sequence different from the plasmid disclosed in the Crish publication.

We reject Crish's argument that the claims are not anticipated because the Crish publication did not sequence the promoter region of hINV. While the PTO's position that the discovery of new properties of a known material does not make claims reciting those properties novel is correct, and we agree with the PTO as to its conclusion, we differ with its characterization of the nucleotide sequence of the gene as a property of that gene. The sequence is the identity of the structure of the gene, not merely one of its properties. The gene may have functional, biological properties, and it may have physical properties, but its structure is its identity, not merely one of its properties.

A long line of cases confirms that one cannot establish novelty by claiming a known material by its properties. . . . The promoter region of hINV was not new. As explained above, hINV was known and used years before. Moreover, the promoter region of hINV was specifically identified by size and location in the Crish and Eckert publications. The only arguable contribution to the art that Crish's application makes is the identification of the nucleotide sequence of the promoter region of hINV. However, just as the discovery of properties of a known material does not make it novel, the identification and characterization of a prior art material also does not make it novel.