



TECHNOLOGY LAW UPDATE

Invitrogen Corp.
v.
Biocrest Mfg.

Nos. 04-1273, -1274

Federal Circuit
Oct. 5, 2005

[T]he test for the public use prong includes the consideration of evidence relevant to experimentation, as well as the nature of the activity that occurred in public; public access to the use; confidentiality obligations imposed on members of the public who observed the use; and commercial exploitation.

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On October 5, 2005, the Federal Circuit affirmed-in-part, reversed-in-part and remanded the district court’s summary judgment that Biocrest infringed U.S. Patent No. 4,981,797, which related to improved DNA uptake competence of *E. coli*, and that the ‘797 patent was not invalid for indefiniteness, but was invalid for public use under 35 U.S.C. § 102(b). The Federal Circuit stated:

[B]oth the on sale and public use bars of § 102 stem from the same “reluctance to allow an inventor to remove existing knowledge from public use.” [T]he Supreme Court’s “ready for patenting test” applies to the public use bar under § 102(b). A bar under § 102(b) arises where, before the critical date, the invention is in public use and ready for patenting. [I]n applying the Pfaff two-part test in the context of a public use bar, evidence of experimental use may negate either the “ready for patenting” or “public use” prong.

The proper test for the public use prong of the § 102(b) statutory bar is whether the purported use: (1) was accessible to the public; or (2) was commercially exploited. Commercial exploitation is a clear indication of public use, but it likely requires more than, for example, a secret offer for sale. Thus, the test for the public use prong includes the consideration of evidence relevant to experimentation, as well as the nature of the activity that occurred in public; public access to the use; confidentiality obligations imposed on members of the public who observed the use; and commercial exploitation.

[T]he district court reasoned that Stratagene had used the claimed process in its own laboratories, more than one year before the ‘797 application was filed, to “further other projects” beyond development of the claimed process and to acquire a commercial advantage. Stratagene admits that it used the claimed process in its own laboratories before the critical date to grow cells to be used in other projects within the company. The district court determined that use of the invention in Stratagene’s general business of widespread research generated commercial benefits. The district court examined the totality of the circumstances and found that this use was “public.” Stratagene argues, however, that this secret internal use was not “public use” under the applicable test, because it neither sold nor offered for sale the claimed process or any product derived from the process, nor did it otherwise place into the public domain either the process or any product derived from it. Under the proper test for public use under § 102(b), these facts do not erect a bar.

[T]o qualify as “public,” a use must occur without any “limitation or restriction, or injunction of secrecy.” In some cases, [a] use before the critical period was not public even without an express agreement of confidentiality. [S]ecrecy of use alone is not sufficient to show that existing knowledge has not been withdrawn from public use: commercial exploitation is also forbidden. Invitrogen’s invention was not given or sold “to another,” or used to create a product given or sold to another, and was maintained under a strict obligation of secrecy. . . . While there are instances in which a secret or confidential use of an invention will nonetheless give rise to the public use bar, this is not such a case. [T]here is no evidence that Invitrogen received compensation for internally, and secretly, exploiting its cells. The fact that Invitrogen secretly used the cells internally to develop future products that were never sold, without more, is insufficient to create a public use bar to patentability.