



TECHNOLOGY LAW UPDATE

Invitrogen Corp.
v.
Clontech Labs., Inc.

Nos. 04-1039, -1040

Federal Circuit
Nov. 18, 2005

The priority determination requires evidence that the inventor actually first made the invention, and that he understood his creation to have the features that, comprise the inventive subject matter. [T]he court must identify when, during an emerging recognition that a particular invention includes something new, the inventor's understanding reaches the level needed for appreciation.

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On November 18, 2005, the Federal Circuit, inter alia, vacated and remanded the district court's summary judgment that U.S. Patents No. 5,244,797, No. 5,688,005, and No. 6,063,608, which relate to RNase H minus reverse transcriptase, are anticipated under 35 U.S.C. § 102(g)(2) because researchers at Columbia University conceived of a similar invention before, and were diligent in reducing it to practice after, Invitrogen's first reduction to practice in 1987. The Federal Circuit stated:

[W]ith regard to a claimed chemical compound, conception requires that the inventor "be able to define" the compound "so as to distinguish it from other materials, and to describe how to obtain it." This description, and the "definite and permanent idea of the complete and operative invention" for conception, require more than unrecognized accidental creation. "[A]n accidental and unappreciated duplication of an invention does not defeat the patent right of one who, though later in time, was the first to recognize that which constitutes the inventive subject matter." "The date of conception of a prior inventor's invention is the date the inventor first appreciated the fact of what he made." . . . Although such conscious problem solving suggests conception comes first, under some conditions conception is delayed until a reduction to practice. Such delayed conception is often described by the rule against nunc pro tunc conception. [A] reduction to practice at time A necessarily requires the inventor to possess the knowledge about the invention to show a conception. However, the law will not sanction the inference that reduction to practice at time A implies conception at earlier time B.

With unrecognized accidental duplication, the invention exists but remains unrecognized. The priority determination requires evidence that the inventor actually first made the invention, and that he understood his creation to have the features that, comprise the inventive subject matter at bar. Thus, the court must identify when, during an emerging recognition that a particular invention includes something new, the inventor's understanding reaches the level needed for appreciation. In the appreciation analysis, the relevant uncertainty relates to the emerging recognition of something new. That analysis requires objective corroboration of the inventor's subjective beliefs. [T]he junior party [must have] timely interpreted or evaluated the results, and understood them to show the existence the invention. [W]here there is an objective basis for identifying the novel features of an invention, there must be evidence that the inventor timely considered it. [A]n objective basis corroborating the inventor's belief [must] show, consistent with the appropriate burden at trial, that persons skilled in the art at the time of the recognition would have recognized the existence of the relevant inventive features.

[T]he record is inconsistent with the district court's notion that Goff set out to create RNase H minus RT, or that he recognized his invention in 1984. It shows, instead, that this action fits squarely within the unrecognized, accidental duplication cases. . . . Goff's research was general in nature [and] it was unknown at the time whether it was even possible to make an RNase H minus RT with DNA polymerase activity. [E]ven assuming the district court had assessed an objective basis for appreciation – which it did not – on these facts the partial summary judgment of conception for Clontech is unsustainable. [U]nsustained attorney argument regarding the meaning of technical evidence is no substitute for competent, substantiated expert testimony.