FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Invitrogen Corp. v. Biocrest Mfg., L.P., 04-1273 (Fed. Cir. Oct. 5, 2005) (Rader, J.)

The district court misunderstood the § 102(b) public use bar and thus on summary judgment incorrectly invalidated Invitrogen's patent for a method to improve bacteria cells' competence to incorporate foreign DNA and replicate that DNA upon multiplication. The court affirmed the summary judgment of infringement for various claims, and non-validity for indefiniteness of claim 1, but applied Pfaff v. Wells Elecs., Inc., 525 U.S. 55 (1998) to the public use question.

Invitrogen owns U.S. Pat. No. 4,981,797, which "involves the introduction of recombinant DNA molecules into receptive E. coli cells to improve the cells' 'competence,' i.e., their ability to take up and establish exogenous DNA and replicate this DNA as they multiply."

The court reversed the § 102(b) public use invalidation of the patent, basing the analysis on the Supreme Court's "ready for patenting test" from Pfaff v. Wells Elecs., Inc., 525 U.S. 55 (1998).

> The parties do not dispute that Invitrogen used the claimed process before the critical date, in its own laboratories, to produce competent cells. Invitrogen did not sell the claimed process or any products made with it. The record also shows that Invitrogen kept its use of the claimed process confidential. The process was known only within the company. Stratagene does not dispute that the claimed process was maintained as a secret within Invitrogen until some time after the critical date. . . . Following the Court's guidance in Pfaff, this court rejected the totality of the circumstances test in the context of statutory bar disputes. . . . [T]he Court's analysis of the statutory term "invention," or the ready for patenting prong, applies to both of the other parts of section 102(b), "on sale" and "public use." Thus, the 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. This court notes that in 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, inter alia, 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. . . . As the Supreme Court pointed out in Pfaff, . . . secrecy 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. Without more, these circumstances are insufficient to create a public use bar to patentability. . . . [Invitrogen] did not sell its invention or any products made with it, and kept the invention entirely confidential within the company,

The court also affirmed the infringement determination. Tests conducted to establish the increased competence of E. coli cells in the Biocrest process did not raise any genuine issues of material fact. The court also turned back the indefiniteness challenge to claim 1. The claim term "improved competence" was not "insolubly ambiguous" in light of the claim construction.

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