FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Brown v. Barbacid, 05-1119 (Fed. Cir. Feb. 2, 2006) (Newman, J.)

In an interference proceeding, the court reversed the Board's decision not to credit evidence offered by Brown to corroborate Brown's diligence. The corroboration requirement for diligence allows for a variety of activities to serve as evidence. The Board was overly strict in not crediting the laboratory notebooks of a technician assisting Brown. It failed to view the evidence from the perspective of a person of ordinary skill in the art. Thus, the court found that the Board erred in law, remanding the interference.

This second appeal for a patent interference proceeding before the Board concerns the following invention common to Brown and Barbacid: "a method or assay for identifying compounds that inhibit farnesyl transferase ('FT'), an enzyme involved in the control of cell growth."

In the earlier appeal the court reversed the Board. One of Brown's co-inventors offered lab notebooks for proof of conception and reduction to practice. Testimony by another scientist could corroborate the notebooks for purposes of proving conception, but not for reduction to practice.

> On remand, the Board held that Brown had established conception no later than November 15, 1989, but had failed to provide corroborated evidence of diligence. . . . The Board again awarded priority to Barbacid, and Brown again appeals.

While normally Brown would need to show diligence from before Barbacid's date of conception, the original Board decision did not find such a date, thus Barbacid waived inquiry into that issue by not raising it thereafter until this appeal. This required Brown to merely show diligence from before Barbacid's date of reduction to practice.

> Brown provided evidence from inventor Dr. Reiss and laboratory technician Ms. Morgan concerning the exercise of reasonable diligence during the period from Barbacid's accorded date to Brown's filing date. . . .
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> Unlike the legal rigor of conception and reduction to practice, diligence and its corroboration may be shown by a variety of activities, as precedent illustrates. For example, in Lacotte v. Thomas, 758 F.2d 611, 613 (Fed. Cir. 1985), the testimony of the inventor and his notebook records were held adequately corroborated by his obtaining relevant supplies and the testimony of his associate. In Bey v. Kollonitsch, 806 F.2d 1024, 1030 (Fed. Cir. 1986), diligence was shown by an attorney's work in preparing the patent application. In Scott v. Koyama, 281 F.3d at 1248, diligence was shown by efforts to locate a construction company capable of building a manufacturing plant for practicing the process on a large scale. In Jolley, 308 F.3d at 1327, diligence was shown by activity to obtain necessary supplies and laboratory glassware and by testing of related materials. The basic inquiry is whether, on all of the evidence, there was reasonably continuing activity to reduce the invention to practice. There is no rule requiring a specific kind of activity in determining whether the applicant was reasonably diligent in proceeding toward an actual or constructive reduction to practice.
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> Brown provided evidence of laboratory work during this period performed by Debra Morgan, a scientist working in the Brown laboratory, as evidence of diligence and as corroboration of Dr. Reiss' testimony. . . . The Board found that Ms. Morgan's notebook records along with those of Dr. Reiss filled all but six days of the critical period, and that each of the six remaining days was a single-day gap; this was deemed sufficient to show substantially continuing activity. . . .
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> However, the Board refused to credit any of Ms. Morgan's evidence, criticizing what it described as the absence of explanation of the content and purpose of these experiments.

The Board discussed example pages from Ms. Morgan's lab notebook, commenting that they did not sufficiently explain her activity. The court found that the "Board erred in law, in failing to view the proffered evidence as it would be viewed by persons experienced in the field of the invention."

> It is undisputed that the subject matter recorded on the Morgan notebook pages and described in her declaration concerns the subject matter of the [interference] count.

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