FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Stern v. Columbia Univ., 05-1291 (Fed. Cir. Jan. 17, 2006) (Mayer, J.)

The court affirmed that Stern was not a co-inventor of a patent for a method of treating glaucoma in primate subjects. Stern was a medical student who undertook a research elective in the inventor's lab. At the inventor's direction, Stern merely carried out an experiment on a new animal that had been previously performed by the inventor on other animals.

Columbia University owns U.S. Pat. No. 4,599,353, for a method of treating glaucoma in a primate subject's eyes by applying an "eicosanoid or an eicosanoid derivative." Bito, a longtime Columbia University faculty member, is the named inventor. Stern was a medical student who did a one semester ophthalmology research elective in Bito's laboratory.

> Because a patent carries a statutory presumption of validity, 35 U.S.C. § 282, Stern had the burden of showing by clear and convincing evidence, after all reasonable inferences were drawn in his favor, that he was an inventor of the '353 patent.

The court affirmed the summary judgment that Stern had no ownership in the claimed invention.

> Here, Stern did not have an understanding of the claimed invention, did not discover that prostaglandins have an effect on IOP, did not discover that repetitive application of prostaglandins to the eyes of primates can maintain reduced IOP, and did not conceive of the idea of the use of prostaglandins to reduce IOP in primates. Furthermore, there was no collaboration between Stern and Bito in developing a glaucoma treatment. Stern simply carried out an experiment previously done by Bito on different animals—animals that Bito had already determined would be good models for prostaglandins research. Stern's contribution is insufficient to support a claim of co-inventorship.

> Stern also argues that material in his laboratory notebooks would have proved his claim of co-inventorship, but that they were destroyed by Bito. However, regardless of the contents of the notebooks, unwitnessed laboratory notebooks on their own are insufficient to support his claim of co-inventorship. . . . Thus, the evidence Stern presented was insufficient to corroborate his claim of co-inventorship.

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