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Immaculate Conception? It Is in the Eye, Re: Inventions

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Addressing the standard of conception of an invention, the U.S. Court of Appeals for the Federal Circuit affirmed a decision of the **U.S. Patent and Trademark Office** Board of Patent Appeals and Interferences (Board), finding that to show conception an inventor must demonstrate "conceiving a way to make an idea operative" although the inventor need not know "that a completed invention will work for its intended purpose." ***Dawson v. Dawson and Bowman***, Case Nos. 12-1214, -1215, -1216,; -1217 (Fed. Cir., Mar. 25, 2013) (Bryson, J.) (Reyna, J. dissenting).

The case stems from a patent interference instituted by the University of California, San Francisco (UCSF) with respect to two patents issued to Dr. Chandler Dawson and Dr. Lyle Bowman and assigned to InSite Vision (InSite). UCSF provoked the interference by filing a patent application naming Dr. Dawson as the sole inventor and generally copying the specification and claims of the two patents. Dr. Dawson had previously worked for UCSF before joining InSite. The Board ruled that UCSF had failed to prove sole conception by Dr. Dawson and the Federal Circuit affirmed.

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To prove sole conception by Dr. Dawson, UCSF proffered two documents relating to Dr. Dawson's presentation on the topical use of azithromycin, an azalide antibiotic, to control eye infection. Dr. Dawson had given that presentations at a World Health Organization (WHO) meeting in the summer of 1997 while still an employee of UCSF. In an unusual posture, UCSF chose not proffer any testimony from Dr. Dawson himself. UCSF also argued that a 0.5 percent azithromycin ointment prepared by Dr. Charles Leiter for Dr. Kenneth Chern, a colleague of Dr. Dawson, and Dr. Chern's testing of the ointment further corroborated Dr. Dawson's solo invention.

The Federal Circuit disagreed. The Court found that UCSF failed to provide evidence to suggest a complete conception of that specific formulation, *i.e.,* "0.01% to 1.0% of an azalide antibiotic," and other such requirements in the interference count. The Court concluded that Dr. Dawson's idea to develop a product that was 'like' another product did not establish that Dr. Dawson had a specific, settled idea or particular solution for his invention.

The Federal Circuit rejected UCSF's argument that an inventor did not need to know that his invention would work to satisfy conception but needed only to have conceived that his topical use of azithromycin would be effective. The Court explained that part of the conception inquiry asks whether the inventor possessed an operative method of making the invention. So while "an inventor need not know that his invention will work for conception to be complete, there is a critical difference between conceiving a way to make an idea operative and knowing that a completed invention will work for its intended purpose."

Judge Reyna dissented. "To demonstrate conception, the law does not require that Dr. Dawson develop a working physical embodiment of his innovative idea. . . . While conception [...] requires 'the formation, in the mind of the inventor, of a definite and permanent idea of the complete and operative invention,' it does not require reduction to practice." Judge Reyna described the work done at InSite as commercialization and cautioned against changing the law of inventorship.