DANA-FARBER CANCER INSTITUTE, INC. v. ONO PHARMACEUTICAL CO., LTD., Appeal No. 2019-2050 (Fed. Cir. July 14, 2020). Before Newman, Lourie, and Stoll. Appealed from D. Mass. (Judge Saris).

Background:

Ono owns patents directed to groundbreaking cancer treatments developed by Dr. Tasuku Honjo − winner of the 2018 Nobel Prize in Physiology or Medicine. Dr. Honjo began collaborating with two researchers, Drs. Freeman and Wood, from Dana-Farber in 1998. The collaboration resulted in a journal article published in October 2000. In 2002, Dr. Honjo filed a patent application in Japan from which each of the Ono patents claimed priority. None of these patents included Drs. Freeman or Wood as co-inventors. Dana-Farber sued alleging that its doctors should be added as inventors based on several grounds related to the doctors' contributions to the subject matter recited in the claims of the patents. The district court agreed and found in favor of Dana-Farber.

Issue/Holding:

Did the district court err in holding that the Dana-Farber doctors contributed to the Ono patents? No, affirmed.

Discussion:

Ono argued that the district court erred by relying on contributions of Drs. Freeman and Wood that were too far removed from the claimed subject matter. The Federal Circuit found this argument misguided. It held that conception is the touchstone of the joint inventorship inquiry, and conception is complete when an idea is definite and permanent enough that one of ordinary skill in the art could understand the invention.

Ono argued that Dr. Honjo arrived at the relevant findings (*i.e.*, specific methods of treating cancer using blocking antibodies) independent of Drs. Freeman and Wood. But the Federal Circuit found that the fact that Drs. Freeman and Wood were not present or participants in all the experiments that led to the conception of the claimed subject matter does not negate their overall contributions throughout their collaboration with Dr. Honjo.

Ono argued that the fact that the patents were issued over a 1999 provisional application filed by Drs. Freeman and Wood was evidence that the patents claimed treatments that were novel and nonobvious over Drs. Freeman's and Wood's contributions. The Federal Circuit dismissed this point explaining that novelty and nonobviousness of the claimed subject matter over the provisional application are not probative of whether the collaborative research efforts led to the claimed subject matter or whether each researcher's contributions were significant to their conception.

Ono also argued that the contributions of Drs. Freeman and Wood were made public in the October 2000 journal article and were thus in the prior art before the alleged conception. However, the Federal Circuit held that such a rule would ignore the realities of collaboration, which generally spans a period of time and may involve multiple contributions. And that while it is true that simply informing another about the state of the prior art does not make one a joint inventor, a collaborative enterprise is not negated by a joint inventor disclosing ideas that are less than the total invention to others, particularly when the collaborators had worked together for around one year prior to the disclosure, and the disclosure occurred just a few weeks prior to conception, as was found to be the case here.