



Federal Circuit Clarifies Requirement for Reference to Qualify as 'By Another' Under Pre-AIA Sections 102(a) and (e)

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The Federal Circuit recently clarified the requirement for work disclosed in a reference to qualify as “by another” under pre-AIA Sections 102(a) and (e), holding that there must be complete inventive identity between the information disclosed in the asserted reference and the inventors named on the relevant patent.

This appeal stemmed from two *inter partes* review proceedings (IPR) in which Hopewell Pharma Ventures challenged Merck Serono’s (Serono) patents, arguing that the prior art references disclosed the claimed dosing regimens. Serono argued that one of the asserted references did not qualify as prior art under pre-AIA Sections 102(a) and (e) because its relevant disclosure, a 6-line dosing regimen, was not “by another” as required by the statute. The PTAB rejected Serono’s defense and found all challenged claims unpatentable.

On appeal, the Federal Circuit considered the question of “whether and to what extent a disclosure invented by fewer than all named inventors of a patent may be deemed a disclosure ‘by another’ and thus included in the prior art.” Serono argued that so long as the relevant disclosure in the reference reflected the work of at least a subset of inventors on the challenged patent, it should not qualify as work “by another.” Rather, it reflected the work of the inventors of the challenged patent. Hopewell, on the other hand, argued that a prior disclosure may only be excluded from the prior art when there is complete identity between the inventors of the disclosure and the inventors named on the challenged patent.

In affirming the PTAB, the Federal Circuit largely adopted Hopewell’s argument. According to the court, for a reference **to not be** “by another,” and thus not qualify as prior art, the

disclosure in the reference must reflect the work of the entire inventive entity of the challenged patent claim. When the challenged claim is the work of joint inventors, the disclosure in the reference must reflect the work of the entire inventive entity of the challenged claim in order to avoid being considered a work “by another.” Overlap between those who contributed to the invention in the disclosure and the inventors on the challenged claim does not exclude a reference as prior art.

Based on the facts of this case the court held that Serono failed to show one of the named inventors on the challenged patent made a significant contribution to the information disclosed in the asserted reference. Thus, that inventor could not be considered a joint inventor of the disclosure, and as a result, the disclosure must be deemed to be part of the prior art as having been made “by another.”

Practice Tip: When preparing or defending patents, especially in collaborative research environments, it is important to carefully document the inventive contributions of each named inventor to be able to show that the inventors of a patent claim are identical to the inventors that disclosed the invention in related publications. This can be critical in later proceedings where the status of prior art may hinge on the degree of overlap between the named inventors and the authors or inventors of a related publication.

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