

Patent Law & Policy

Session 10

9/11/08

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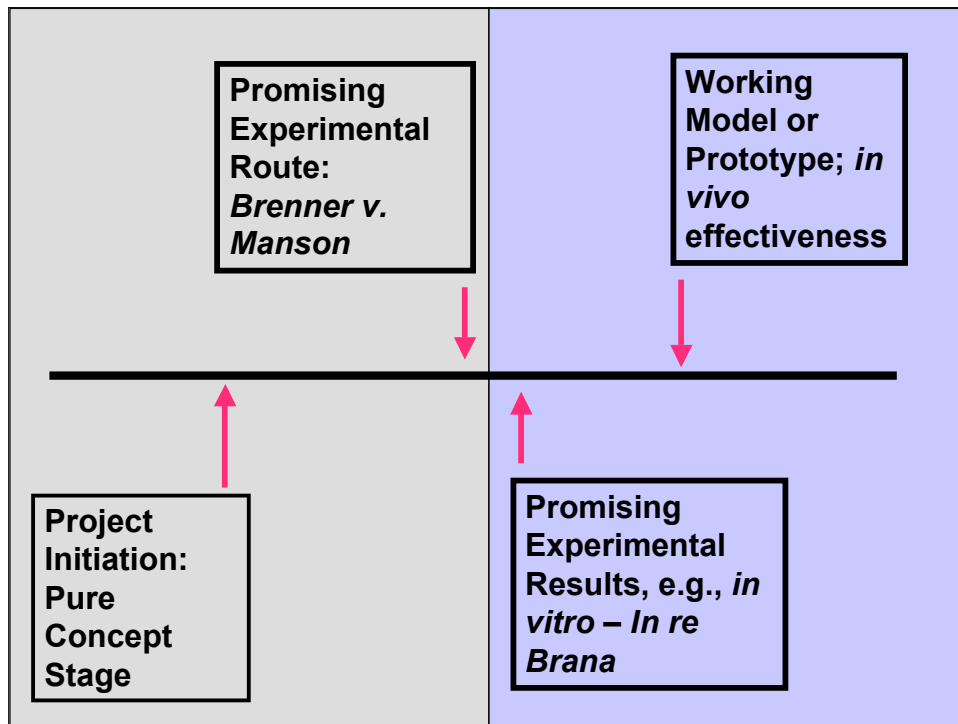
In re Brana (Fed. Cir. 1995)

- Invention – new antitumor compounds
- PTO - “no disclosure of specific disease against which compounds are useful”
 - Problem - Wrong on the facts
- PTO - “failed to prove usefulness”
 - Procedural problem? Substantive problem?
- [Unpredictability of bio activity, like Manson?]

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PTO Utility Guidelines

- 1995

- “useful for any particular purpose (i.e., a ‘specific utility’)”

- 2001

- “useful for any particular practical purpose (i.e., it has a “specific and substantial utility’)”
- “excludes ‘throw-away’ ... utilities” [“landfill”]

In re Fisher, 421 F.3d 1365

- Claim to 5 different maize ESTs
 - Real party in interest : Monsanto Co.
- “Fisher did not know the precise structure or function of either the genes or the proteins encoded for by those genes.”
- Recited 7 uses, including ...
 - identifying polymorphisms
 - as probes, primers

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Fisher cont'd

- PTO : “Fisher’s alleged uses are ...”
 - “merely starting points for further research”
 - “so general as to be meaningless”
- Nine amici, all favoring PTO’s position
 - Including Affymetrix, Eli Lilly, Genentech, NAS
- Fed Cir
 - Brenner v. Manson sets the standard
 - Use must be both substantial and specific

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Fisher cont'd

- Substantial
 - invention “has a significant and presently available benefit to the public”
- Specific
 - invention “can be used to provide a well-defined and particular benefit to the public”
- Fisher’s uses?
 - “the underlying genes have no known functions”
 - “Any EST ... has the potential to perform any one of the alleged uses.”

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Fisher cont'd

- Fisher : ‘An EST is like a microscope.’
- Majority
 - Microscope “has the specific benefit of optically magnifying an object to immediately reveal” it
 - An EST “is unable to provide any information about the overall structure let alone the function of the underlying gene”
- Dissent
 - “both take a researcher one step closer ... ”

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