



Federal Circuit Patent Watch

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Frazer v. Schlegel

No. 06-1154, Federal Circuit (*Newman, Friedman, Rader*)

When interference priority is at issue, constructive reduction to practice of a count may be established by disclosure of an embodiment within the count.

On August 20, 2007, the Federal Circuit reversed and remanded the decision of the Board of Patent Appeals and Interferences that awarded priority to Schlegel in an interference proceeding between U.S. patent applications Serial No. 08/185,928 (Frazer) and Serial No. 08/216,506 (Schlegel), which both related to papillomavirus vaccine. Frazer sought the benefit of the filing date of an Australian patent application. The Federal Circuit stated:

[W]hen the priority claim is based on subject matter disclosed in a foreign patent application whose filing date is properly claimed, the foreign application has the same effect as if filed in the United States. The invention must be “disclosed in the manner provided by the first paragraph of section 112.” Constructive reduction to practice does not invoke different standards whether the priority document is foreign or domestic. When interference priority is at issue, constructive reduction to practice of a count may be established by disclosure of an embodiment within the count. Although the Board analyzed the Australian application in terms of “conception,” when reliance is on a patent document already filed, the question is whether the document discloses the invention of the count by meeting the written description and enablement requirements of 35 U.S.C. § 112 ¶1, for a filed application serves as a constructive reduction to practice of its content.

The Board held that Frazer’s Australian application “did not provide a described and enabled anticipation under 35 U.S.C. § 102(g) of the subject matter of the count,” because at the time the Australian application was filed “Frazer believed that both the L1 and L2 genes had to be expressed together from the same plasmid,” whereas his “later work shows that only L1 protein was necessary.” . . . The Board stated that “[r]evising hypotheses in the face of evidence is a hallmark of well-conducted research,” and ruled that Frazer was not entitled to any date of disclosure until he accurately and fully understood the mechanism. The Board referred to Dr. Frazer’s “admission” that “it was impossible to determine, in 1991, whether the particles they produced had conformational epitopes of the native virions: ‘at that time, the

reagents that would be needed to do that work were not available.” The Board ruled that neither the PCT application nor the ensuing United States application was entitled to the priority date of the Australian application.

We conclude that the Board erred in denying Frazer’s entitlement to the date of the Australian patent application. The Australian application contained complete details of the method that is the subject of the interference count, and depicts the papillomavirus-like particle of the count with full disclosure of how to produce it. The specification also includes the DNA sequences encoding the papillomavirus L1 and L2 proteins. While Frazer in the Australian application reported the expression of both the papillomavirus L1 protein and the papillomavirus L2 protein, and he testified that at that time he believed both proteins were involved, his later discovery that either the L1 protein or both the L1 and L2 proteins led to capsid formation does not negate or contradict his disclosure and constructive reduction to practice of the method of the count that produced the papillomavirus-like particle of the count. Frazer correctly argues that the Australian application describes and enables the formation of the papilloma virus-like particles. The filing of a patent application is a constructive reduction to practice of the invention disclosed therein. [A]cknowledgment of the complexities of the science does not negate the disclosure of the production of these virus-like particles. . . . The Australian application was not “merely proposing an unproved hypothesis” or guess; it was an enabling disclosure.

On this appeal Frazer points out that “The Board never determined that Frazer failed to teach any essential step required to make VLPs of non-HPV-16 papillomavirus types. In fact, the Board acknowledged that ‘VLPs having the same shape and much more nearly the size of native virions could be made following the general procedure disclosed by the Australian application.’” There was no evidence contradicting Frazer’s production of the virus-like particles shown in the Australian application and the method shown therein of producing these particles. [T]he description of the procedures used, and the successful production of the virus-like particles there achieved and reported, disclose and enable a species within the count. The Board erred in ruling “that Frazer has failed to prove legal conception of an embodiment within the scope of the Count on the basis of the Australian application.”

Based on the constructive reduction to practice of an invention whose disclosure is in compliance with the requirements of § 112, Frazer is entitled to the priority benefit of the Australian filing date. That date predates Schlegel’s earliest date. The award of priority to Schlegel is reversed, and priority is awarded to Frazer.

For more information on these issues or other intellectual property law matters, please contact **Lawrence M. Sung, Ph.D.** at lsung@nixonpeabody.com or 202-585-8221.

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