



## PTAB Refuses to Ignore Reference Where Patent Owner Fails to Overcome Prima Facie Evidence of ‘Different Inventive Entity’

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The Patent Trial and Appeal Board determined that a reference could be used as prior art because patent owner failed to provide sufficient evidence that the prior art’s disclosure was invented by all four named inventors, and thus the same “inventive entity,” as the challenged claims.

Petitioner sought *inter partes* review of certain claims of a patent directed to the use of a drug for treatment of multiple sclerosis. The claims at issue were invented by four inventors, including patent owner’s chief IP attorney. Petitioner relied on a reference that named two authors, neither of whom were named inventors on the patent.

To qualify as prior art under pre-AIA 35 U.S.C. §§ 102(a) and 102(e), a reference must be “by another.” This analysis examines not merely the differences in the listed inventors/authors, but also whether the portions of the reference relied on as prior art, and the subject matter of the challenged claims, represent the work of a “common inventive entity.”

Patent owner argued that the reference must be excluded as prior art because it was not “by another.” Although the listed inventors were different between the reference and the patent, patent owner argued that, through a collaboration agreement, the patent inventors were responsible for the dosing regimen disclosed in the reference, which was the basis for petitioner’s obviousness challenge. Thus, according to patent owner, the same inventive entity had invented both disclosures. In support, patent owner submitted testimony from one of the patent inventors in which the inventor explained that the teams involved under the agreement included all the named inventors of the patent and the reference, among

others. It also provided draft meeting minutes and a draft briefing document which listed some—but not all—of the inventors, notably missing from both documents was patent owner’s chief IP attorney. The authors of the reference testified that they did not invent the described dosing regimen. Petitioner argued that there was insufficient corroborating evidence to determine that the dosing regimen was the work of the patent inventors, and, at a minimum, the two reference authors are co-inventors of the relevant disclosure and thus, the reference was still not invented by the same inventive entity.

The board concluded that petitioner met its initial burden in showing that the reference was prior art. Nothing on the face of the reference showed a common inventive entity, and neither the patent nor its file history mentioned a joint research agreement or tried to disqualify the reference as prior art. The burden thus shifted to patent owner to present evidence supporting that the reference was not prior art. But the evidence did not corroborate that patent owner’s chief IP attorney provided an inventive contribution to the relevant disclosure in the reference. None of the documents produced by patent owner mentioned its chief IP attorney’s name, and the named authors of the reference could not testify whether the attorney did anything in relation to the collaboration. Furthermore, the only testifying patent inventor could not recall any specific contribution by the attorney. The attorney’s presence as a named inventor on the patent did not sway the board as there was no evidence of his specific contribution to the claims. Although the claims had similarities to the reference’s disclosure, they also had key differences, which prevented a showing that the attorney would necessarily be a co-inventor of the disclosure.

**Practice Tip:** A party looking to survive a challenge that prior art is not “by another” should make sure to present evidence that there is a common inventive entity between the reference and the patent. This evidence should clearly substantiate that **all** inventors are the same as the individuals listed as authors or inventors of the prior art reference. Proof of some, or even most inventors matching, is not sufficient to disqualify the reference as prior art.

*Hopewell Pharma Ventures, Inc. v. Merck Seronos S.A., IPR2023-00481, Paper 62 (PTAB Sept. 18, 2024).*

## Categories

IPRs

Inter Partes Review

Prior Art

Infringement

35 U.S.C. § 102

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