

## **Clarifying the Muddy Metaphysics of Joint Inventorship: Part II**

*University of Pittsburgh v. Hedrick*, \_\_\_F.3d\_\_\_, 2009 WL 2183175, 91 U.S.P.Q.2d 1423 (Fed. Cir. July 23, 2009)

Earlier this year, in *Nartron Corp. v. Schukra U.S.A. Inc.*, 558 F.3d 1352 (Fed. Cir. 2009), the Federal Circuit clarified the contribution required for a person to be named as a joint or co-inventor. More recently, in *University of Pittsburgh v. Hedrick*, \_\_\_F.3d\_\_\_, 2009 WL 2183175, 91 U.S.P.Q.2d 1423 (Fed. Cir. July 23, 2009), the Federal Circuit has again attempted to clarify another aspect of joint inventorship. This time, the court considered the quanta of knowledge that inventors must have regarding the claimed invention before conception and, consequently, inventorship are established.

In 1996, two researchers, Katz and Llull, at the University of Pittsburgh discovered that under certain conditions fat cells called adipocytes would transform back and forth into more primitive cells having a fibroblast-like appearance. During experiments conducted in January and February 1997, Katz and Llull believed that they had observed these cells transforming into muscle, fat and nerve cells (i.e., the cells were "pluripotent"). Analytical testing later confirmed the researchers' belief. In July of 1997, another researcher, Hedrick, began a yearlong fellowship at the University of Pittsburgh laboratory. Near the end of his fellowship, Katz, Llull and Hedrick submitted an invention disclosure to the University of Pittsburgh for transforming cells into fat, bone, cartilage and muscle cells. The invention disclosure listed the date of conception as October 1996. Thereafter, Hedrick returned to UCLA where he formed the Regenerative Bioengineering and Research (REBAR) laboratory with three other researchers: Benhaim, Lorenz and Zhu. The REBAR researchers worked on the same cells as Katz and Llull. In March 2000, the University of Pittsburgh filed an international patent application that listed seven inventors, including Katz, Llull, Hedrick, Benhaim, Lorenz, and Zhu. The U.S. national stage of this international application would later issue as U.S. Patent No. 6,777,231.

In October of 2004, the University of Pittsburgh filed an action for removal of the REBAR researchers. Ruling for the University of Pittsburgh, the district court concluded that Katz and Llull must have conceived that their cells were pluripotent by February 1997, otherwise there would have been no reason for the researchers to perform confirmatory experiments. Further, the court found that Katz's laboratory notebooks contained sufficient detail to enable one skilled in the art to practice the claimed invention.

On appeal, the REBAR researchers argued that the research of Katz and Llull was inconclusive and remained highly speculative through at least June 1998. They also argued that Katz and Llull did not "know" every limitation of each claim until the REBAR researchers helped them confirm the claimed properties. However, the Federal Circuit disagreed with the REBAR researchers' understanding of what it means to "know" the limitations of the claims.

The court held that in this case, knowledge "does not mean proof to a scientific certainty." Instead the court proffered that "proof that the invention works to a scientific certainty is reduction to practice." The Federal Circuit found the district court's determination of inventorship proper since the facts supported that Katz and Lull formed a definite and permanent idea of the operative invention, even though it was not a scientific certainty.

Like the *Nartron* case, the decision in *Pittsburgh* shows that not all contributions to a collaboration rise to the level of inventorship, and in particular, those that contribute merely to the reduction to practice may not be deemed inventors. This case also confirms that conception, which is the "touchstone of inventorship," does not require the inventor to have knowledge of the invention to a scientific certainty.