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IP CASE OF THE WEEK

Just Pick Up the Phone: Federal Circuit Chides Parties for Strategic Ignorance

***Trans Ova Genetics, L.C. v. XY, LLC*, No. 19-2312 (Fed. Cir. Sept. 8, 2020)**

By: Barry Irwin & Manon Burns | September 18, 2020

On September 8, 2020, the Federal Circuit affirmed the final written decision of the Patent Trial and Appeal Board (PTAB), finding that Trans Ova failed to show that XY's challenged patent was obvious. During oral argument on Trans Ova's appeal, the Panel took most of the time to grill the parties regarding the contribution of a particular scientist, Green, to one of Trans Ova's asserted prior art references.

The prior art reference at issue was an article written by the inventors of XY's patent. XY asserted that the article was the work of the patent inventors, and thus not prior art. However, in the text of the article, its authors thanked Green for allowing the citation of Green's unpublished work. The table attributed to Green's unpublished work was directly copied into the challenged patent. If Green had made an inventive contribution to the reference, then the reference would be considered prior art to XY's patent.

Both parties knew where to find the answer, and who to contact—the company where Green worked when the reference was published, Cogent. Both parties declined to do so. Trans Ova relied on the table's attribution to Green. XY relied on testimony from the attorney who filed the patent application for the challenged patent and was familiar with the ~~workings of XY~~roles of the credited authors at XY and Green's role at Cogent. According to the prosecuting attorney, he intentionally removed reference to Green from the patent application because he did not believe the table at issue was properly attributed to Green, whose role at Cogent was a subordinate one which required following instructions from one of the credited authors. The Petitioner carried the burden of proving that the reference was prior art. The PTAB weighed the evidence, comparing the table's attribution to Green to the fact that Green was not named as an inventor of the challenged patent and the prosecuting attorney with personal knowledge chose to remove him. Further, the Board deliberated, Green's lack of authorship and inventorship was consistent with his job description. The Board ultimately determined that the evidence weighed in XY's favor, and Trans Ova did not show otherwise.

On appeal, the Federal Circuit pointed out that under the standard of review, its hands were tied. Neither party sought out the truth, and the Board supported its decision with the evidence that was on the record. As such, Trans Ova's counsel would have to live with its decision not to investigate out of fear of what the answer would be.

It is an attorney's fundamental job to ask questions. Attorneys must make arguments grounded in fact, even if the facts are unfavorable. In this case, if Trans Ova's counsel had asked the question, then it would know whether it was pursuing the right strategy, or whether it should have the proceeding terminated to save its client a lot of attorney time and money. It might even have been able to show that its asserted prior art reference was indeed prior art. While attorneys may feel limited by their inability to contact party opponents, this should not extend to third parties who may be able to resolve significant issues. In other words—just pick up the phone and call.