

Connecticut LawTribune

ALM

BORDER CROSSING

Foreign application provides patent priority

By MICHAEL A. CANTOR

In the realm of patent law, what happens overseas doesn't always stay overseas. *Frazer v. Schlegel*, a recent appeal from the decision in an interference action, demonstrates the interplay between U.S. and foreign patent law and its practical effects.



An interference action determines whether a pending patent application covers the same invention as another application or existing patent, and who was the first to invent the invention. It's heard by the Board of Patent Appeals and Interferences (BPAI) of the Patent and Trademark Office (PTO).

The interference action in *Frazer* arose between Dr. Ian Frazer's patent application for "Papilloma Virus Vaccine" and Dr. C. Richard Schlegel's U.S. patent application for "Papillomavirus Vaccine." Frazer

claimed priority of the invention under both Australian and Patent Cooperation Treaty (PCT) applications.

The invention at issue related to a vaccine for use against human papillomaviruses (HPVs), which can cause cervical cancer and other diseases. Frazer and a colleague conducted their work in Australia. They first reported it in a scientific article that was received by a California medical journal on May 21, 1991.

The text and experimental data from the article were included in their Australian patent application filed in Australia on July 19, 1991. The application described a process that required constructing recombinant DNA molecules that encode both L1 and L2 proteins.

Frazer and his colleague filed a PCT international application on July 20, 1992, claiming priority from the 1991 Australian application, and included additional text and experimental data. The application contained a summary that described a method that includes a step of constructing recombinant DNA molecules that each encode either papilloma virus L1 protein or a combination of papilloma virus L1 and papilloma virus L2 proteins.

Frazer then filed a U.S. patent application on Jan. 10, 1994, claiming priority from both the Australian and PCT applications. The defendants had filed their U.S. patent application on June 25, 1992. It wasn't disputed that the applications covered the same subject matter.

The Patent Act specifically addresses patent applications filed in the U.S. by any person, legal representative or assignee who has previously filed a patent application for the same invention in a foreign country. That country must afford similar patent privileges as the United States provides. If the U.S. filing

is within 12 months of the earliest foreign filing, the U.S. filing has the same effect as if it had been filed in the United States on the date the foreign application was first filed.

When a party in an interference action claims priority under a foreign patent application, the foreign application must disclose a "constructive reduction to practice." The question is whether the foreign application discloses its invention and meets the U.S. Patent Act's written description and enablement requirements.

The BPAI found that the Australian application didn't constitute a constructive reduction to practice because it didn't provide an enabling disclosure. At the time of its filing, Frazer believed both L1 and L2 proteins must be expressed together to produce the virus-like particle. His later work, however, revealed that only the L1 protein was necessary, as he then reported in the PCT application. The BPAI found that Frazer wasn't entitled to any date of disclosure until he accurately and fully understood the mechanism. Thus, neither the PCT application nor the U.S. application was entitled to the Australian application priority filing date.

On appeal, the Federal Circuit Court of Appeals ruled that the BPAI erred in denying Frazer's entitlement to the Australian application date. The court found the application contained the complete details of the method at issue in the interference count — even though Frazer subsequently discovered that *either* the L1 protein or the L1/L2 combination led to the vaccine.

The court held that Frazer's later discovery didn't negate or contradict his disclosure and constructive reduction to practice of the method. Where the claimed invention is the application of an unpredictable technology in the early stages of development, an

Michael A. Cantor is co-managing partner of Cantor Colburn LLP in Hartford. He practices in the areas of copyrights, trademarks, trade dress and unfair competition.

enabling description in the specification must provide those skilled in the art with a specific and useful teaching, recognizing the technology's development stage.

The Federal Circuit concluded that Frazer's Australian application described and enabled the formation of the virus-like particles shown in the Australian and the U.S. applications.

Based on the constructive reduction to practice of an invention whose disclosure complied with the written description and enablement requirements, Frazer was entitled to the Australian filing date's benefit. He therefore prevailed on the appeal of the

interference action, because the Australian application predated the defendants' earliest filing date.

Shortly before deciding *Frazer v. Schlegel*, the Federal Circuit confronted another issue related to foreign patent applications. In *Boston Scientific Scimed, Inc. v. Medtronic Vascular, Inc.*, the court considered whether the Patent Act allows an applicant for a U.S. patent to benefit from the priority of a foreign application filed by an entity not acting on the applicant's behalf at the time of filing.

The BPAI initially gave a U.S. inventor the benefit of the filing dates for two European applications filed by a French company. No

legal relationship existed between the French company and the U.S. inventor when those applications were filed. (The inventor subsequently assigned the rights in the European applications to the company.)

The court on appeal found that a U.S. patent applicant cannot benefit from the priority of a foreign application in the absence of a "nexus" between the inventor and the foreign applicant when the foreign application was filed. The foreign application must have been filed by either the U.S. applicant or someone acting on his or her behalf at the time the foreign application was filed. ■