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District Court Trial in Rare 146 Action Results in Victory for Rothwell Figg Client Roche

Chief Judge Leonard P. Stark of the United States District Court for the District of Delaware granted Rothwell Figg client, 454 Life Sciences ("454," which is now part of Roche Molecular Diagnostics) a complete and total victory over Johns Hopkins University ("JHU"), in JHU's appeal of an Interference decision that awarded priority to 454. Rothwell Figg also successfully represented 454 in the underlying interference.

The District Court held a three day bench trial and on *de novo* review of the PTAB's decision, Judge Stark awarded priority of invention to 454, finding that 454 was first to conceive and first to reduce to practice the invention in dispute. He also found in favor of 454 on several issues of patentability, holding that JHU had failed to prove that any claims of 454's patent application (the '240 application) were unpatentable for lack of enablement, written description or anticipation.

This case began when JHU filed the action pursuant to 35 U.S.C. § 146, seeking district court review of the Decision and Final Judgment of the Board of Patent Appeals and Interferences (now the PTAB) in Interference No. 105,857. The interfering applications are 454's U.S. Patent Application No. 13/033,240 (454's "'240 application") and JHU's U.S. Patent Application No. 12/361,690 (JHU's "'690 application"). The Interference involved a single Count and the interfering subject matter is directed to methods for analyzing nucleic acid sequences comprising the use of aqueous microreactors in a water-in-oil emulsion, where a plurality of microreactors each contain a single DNA fragment molecule, a single bead capable of hybridizing to the DNA fragment, and reagents to perform DNA amplification. The invention of bead emulsion PCR was an important technological advance at the time.

JHU had asserted it was entitled to priority of invention, and that regardless of whether JHU was entitled to a patent on the interfering subject matter, 454's claims should be declared unpatentable on several different grounds. In the decision issued late last week, Judge Stark determined that 454 had proven by a preponderance of the evidence that it had completely conceived of the invention and had actually reduced the invention to practice

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months before JHU proved entitlement to a priority date. Judge Stark further determined that, despite JHU's assertions to the contrary, all of 454's applications, including the '071 provisional application and the '592 provisional application, demonstrate a constructive reduction to practice of the full scope of the invention of the Count. Because 454 was the first to conceive of the invention and the first to reduce to practice, the Court awarded priority of invention to 454. The Court further denied JHU's assertions regarding the unpatentability of 454's claims. As a result of this decision, the Court has effectively confirmed that the claims of 454's Patent No. 8,748,102, which issued from the '240 patent, are valid, and JHU is not entitled to a patent on the competing claims of the '690 application.

Roche/454 was represented in this case by Rothwell Figg attorneys R. Danny Huntington and Sharon Crane, as well as by Kelly Farnan of Richards, Layton & Finger.