Introduction

On March 8, 2021, in *Ono Pharmaceutical Co., Ltd., et al. v. Dana-Faber Cancer Institute, Inc.*, appellant Ono filed a petition for writ of certiorari with the U.S. Supreme Court, asking whether the Federal Circuit should consider patentability (i.e., novelty and non-obviousness) in evaluating claims for inventorship. Specifically, Ono presented the following question:

> Whether the Federal Circuit erred in adopting a bright-line rule that the novelty and non-obviousness of an invention over alleged contributions that were already in the prior art are "not probative" of whether those alleged contributions were significant to conception.

The opposing party, Dana-Farber Cancer Institute, Inc., filed a brief in opposition only days ago. Though it remains to be seen whether the Supreme Court will grant the petition, the parties' respective briefings pose interesting questions on inventorship.

Factual Background and Procedural History

In the 1990s, Drs. Freeman and Wood worked with Dr. Honjo to explore interactions between ligands and receptors on T cells. For several years, these researchers collaborated with one another, exchanging discoveries and results of specific ligand-receptor interactions, holding numerous meetings and conferences, and providing comments and edits to their respective drafts for journal publications.

Drs. Freeman and Wood filed a U.S. provisional patent application, disclosing the use of antibodies in cancer therapy. A few years later, Dr. Honjo filed multiple U.S. non-provisional patent applications in the United States, disclosing similar subject matter. Importantly, Dr. Honjo's applications did not list Drs. Freeman and Wood as co-inventors.

Dana-Farber filed suit in district court, requesting to add Drs. Freeman and Wood to the patents-at-issue. The district court granted Dana-Farber's request, finding that Drs. Freeman and Wood made significant contributions to the subject matter in the patents.

Ono's appeal to the Federal Circuit argued that Drs. Freeman and Wood did not contribute to conception in a significant manner, because the patents claimed subject matter that was patentable over the Drs. Freeman and Wood's provisional applications. The Federal Circuit disagreed with the basis of Ono's argument. Specifically, the Federal Circuit declared:

> joint inventorship does **not** depend on whether a claimed invention is novel or nonobvious over a particular researcher's contribution. Collaboration and

> concerted effort are what result in joint inventorship…. The novelty and non[-]obviousness of the claimed inventions over the [prior art] are **not probative** of whether the collaborative research efforts of [the researchers] led to the inventions claimed here or whether each researcher's contributions were significant to their conception.

Dana-Farber Cancer Inst., Inc. v. Ono Pharm. Co., 964 F.3d 1365, 1372 (Fed. Cir. 2020) (emphasis added). Rather, the test is merely whether an inventor's contribution is not insignificant in quality, when measured against the dimension of the full invention. *See Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 (Fed. Cir. 1998).

Petition for Writ of Certiorari

In its petition, Ono argues that the Federal Circuit erred by not considering whether the researchers' contributions were **patentable**. Otherwise, one only need contribute known or obvious ideas to be considered an inventor. This undermines collaboration, creates windfalls for individuals who merely contributed ideas already in the prior art, and opens the door to fruitless post-hoc claims for joint inventorship.

Dana-Farber counters that the Federal Circuit's guidance does not contravene principles of patent law and should be affirmed for three reasons. First, evaluating patentability will lead to confusion among researchers when collaborating on subject matter that may be in the prior art at the time of collaboration. Second, sole considerations of novelty and non-obviousness disregard the exchange of ideas and information in a collaborative endeavor. Third, making novelty and non-obviousness the benchmark for inventorship will discourage future collaborative efforts, as researchers will fear that their contributions will be insignificant.

So, Ono desires an evaluation of patentability in inventorship determination, and Dana-Farber wishes to maintain the status quo, with attention directed to the parties' collaborative efforts.

Awaiting Guidance

Inventorship law remains a muddied water. It is fact-intensive and demands extensive corroborating evidence by the omitted inventors. While we await a decision on the petition, researchers should continue to document and record all ideas, subject matter, information, notes, materials, and drafts exchanged in collaborative endeavors. This could prove critical in showing that the researcher made a "significant" contribution to an issued patent or pending patent application.