

of the invention claimed.”” *Enzo*, 296 F.3d at 1324 (quoting *Vas-Cath*, 935 F.2d at 1563). In all of those cases, however, the description was found to contain enough information to lead a person skilled in the art to the claimed compound. *See Herschler*, 591 F.2d at 701 (finding that “the array of information supplied by appellant in the great-grandparent application [would] teach one having ordinary skill in this art that one of the class of steroids will operate in the claimed process”); *Edwards*, 568 F.2d at 1352, 1354 (application which described claimed compound by the process of making it contained adequate description, since “[i]t [wa]s undisputed that the ... reactions [set forth in the application] will inherently produce, as the predominant component, the claimed compound”; the “application, taken as a whole, reasonably leads persons skilled in the art ... to the claimed compound”). The ‘850 patent is completely lacking in that respect.



Plaintiff also argues that the requirements for written descriptions of claims to chemical compounds are irrelevant to this case because the ‘850 patent does not claim a compound, but a method of treatment by targeting PGHS-2 activity over PGHS-1 activity. Virtually any compound claim could be transformed into a method claim, however, simply by means of wording the claim in terms of a method of using the compound. With respect to the issue before the Court, then, this is little more than a semantic distinction without a difference. The claimed method depends upon finding a compound that selectively inhibits PGHS-2 activity. Without such a compound, it is impossible to practice the claimed method of treatment. It means little to “invent” a method if one does not have possession of a substance that is essential to practicing that method. Without that substance, the claimed invention is more theoretical than real; it is, as defendants argue, akin to “inventing” a cure for cancer by utilizing a substance that attacks and destroys cancer cells while

leaving healthy cells alone. Without possession of such a substance, such a “cure” is illusory, and there is no meaningful possession of the method.

I recognize that the inventors and the research teams of which they were a part did apparently make some significant discoveries in this field. They realized, in light of the discovery of PGHS-2, that it would be quite beneficial if one could find a compound that would specifically target the activity of PGHS-2, but not that of PGHS-1.

What the inventors did *not* do, however, is succeed in taking the last, critical step of actually isolating such a compound, or at least of developing a process through which one skilled in the art would be directly led to such a compound. Absent that step, their discoveries, valuable though they might have been, did not blossom into a full-fledged, complete invention. Scientific discoveries, and theories based on those discoveries, frequently lay the groundwork for later inventions, but that does not make the discoverer the inventor as well.

In reaching this conclusion, the Court has also reviewed the declarations of plaintiff’s two experts, Drs. Edward Dennis, who holds a Ph.D. in Chemistry, and John McGiff, M.D., a pharmacology professor at New York Medical College in Valhalla, New York. They both opine that the first application in the series of applications leading to issuance of the ‘850 patent (“the ‘780 application”) “reasonably conveys to the ordinary skilled team of workers that the University [of Rochester] inventors were in possession of the inventions claimed in the ‘850 patent as of September 22, 1992,” *i.e.* the date the application was filed. McGiff Decl. ¶ 10; Dennis Decl. ¶ 32.⁶

⁶Dennis and McGiff agree that “one” of ordinary skill in the art to which the ‘850 patent pertains is a team of scientists, with skills in medicinal chemistry, molecular biology, biochemistry, and pharmacology. Dennis Decl. ¶ 15; McGiff Decl. ¶ 7.

Dennis and McGiff agree that “[t]he ‘850 patent does not contain claims to any compounds, but rather claims their use in this novel method of treatment.” Dennis Decl. ¶ 12; McGiff Decl.

¶ 5. They state that “it would not be necessary for one of ordinary skill in the art to know the structure of a compound before screening it to determine whether it was suitable for use in the claimed method.” According to them, “one of ordinary skill in the art would expect that compounds suitable for use in the claimed methods could be identified using known non-steroid anti-inflammatory compounds as a starting point in the screening process.” Dennis Decl. ¶ 13; McGiff Decl. ¶ 6.

What this amounts to, though, is once again simply trial and error. Knowing the “starting point” is not enough; that is little more than a research plan. The patent describes how to test compounds to determine whether they work, but it does not set forth any procedure that will necessarily lead to discovery of such a compound, nor does it even identify any particular class of compounds that contains at least one suitable member. Cf. *Herschler*, 591 F.2d at 701 (finding that “the array of information supplied by appellant ... [would] teach one having ordinary skill in this art that one of the class of steroids *will operate* in the claimed process”) (emphasis added); *Edwards*, 568 F.2d at 1354 (description of process for making claimed compound was adequate, since described process “will inherently produce ... the claimed compound”).⁷

Tellingly, then, what plaintiff’s experts’ do *not* say is that one of skill in the art would, from reading the patent, understand what compound or compounds—which, as the patent makes clear, are

⁷I recognize that *Edwards* involved a claim to a compound, whereas the ‘850 patent claims a method. The point is that the process described in the ‘850 patent will not “inherently produce” or lead to performance of the claimed method, since the method cannot be performed without a suitable compound.