



MEETING RECAP
THE PAULINE NEWMAN
IP AMERICAN INN OF COURT
WEDNESDAY, OCTOBER 10, 2012

The second monthly meeting in the second year of the Pauline Newman IP American Inn of Court took place in the U.S. Court of Appeals for the Federal Circuit, across the street from the White House. It was a joint reception with the Giles S. Rich American Inn of Court. An initial reception in the historic Tayloe House with drinks only began at 5:30 p.m.

The meeting convened in Courtroom 201 at 6:24 p.m. by Kevin McCabe, the Vice President of the Giles Rich Inn. President Al Tramposch of the Pauline Newman Inn made introductory remarks. Judge Pauline Newman then spoke briefly, saying that some people in the room would be



unemployed but for Dr.

Chakrabarty. Joshua Goldberg from the Pauline Newman Inn explained the background under Section 101 of the patent statute. Chakrabarty's case established that organisms could be protected as compositions of matter, rather than merely as processes. What is patent eligible remains a contentious issue in the courts. Joan Ellis from the Giles Rich Inn summarized Dr. Chakrabarty's career. He has worked on cures for various diseases.

Dr. Ananda Chakrabarty (who was the inventor of the microorganism in the U.S. Supreme Court case that held that patents could be granted on life forms) was the featured speaker. Dr. Chakrabarty said that both Giles Rich and Pauline Newman were major influences on him. He was asked if private ownership of advanced medical technology becomes common, will new policies be necessary? He said that the company that brings the technology to market must be responsible.

Dr. Chakrabarty was asked if the *Myriad* and *Prometheus* cases were decided correctly. He thought that the court could have done better. He discussed genetic markers for cancer. Bacteria may keep cancer in check. A peptide from the bacteria is being tested as an anti-cancer

drug, and it may also prevent cancer. Bacteria were first discovered to repress cancer more than one hundred years ago. But deliberately giving the bacteria to patients may make them sick. Hence, the peptide is being used, rather than the bacteria. He thought that tests for mutations had utility, and thus should be patentable.

Dr. Chakrabarty was asked if there should be at least one technically trained judge on each Federal Circuit panel deciding a patent case. He said yes, it is important that judges be able to understand what they are ruling on. He discussed a program to teach science to judges.

He was asked if academics who say that patents impede innovation were correct. He has a different opinion. There is a diversity of views among academics. He teaches medical students about patents.

He was asked what mouse models were. Drugs are given to mice before they are tested on humans. For comparison, control groups of mice are not given the drugs.

He was asked if court decisions restricting what can be patented will encourage companies to keep inventions as trade secrets. He said that you can always keep an invention as a trade secret. The reason for patenting is that a trade secret may be discovered by other labs. There will not be an incentive to keep secret if inventions can be patented.



Dr. Chakrabarty was asked about patent protection for drugs in developing countries. He believes that strong patent protection encourages innovation in countries that provide it.

Judge Pauline Newman gave the concluding remarks. Where there are flaws in our patent system, it should be fixed, but it encourages visionary innovation, such as that by Dr. Chakrabarty.

The meeting adjourned at 7:29 p.m. It was followed by the main reception in the Tayloe House, with drinks and hors d'oeuvres, until about 8:15 p.m.

Photographs were taken by Charles Rones, Bill Stoffel and Michael Lew.

Respectfully submitted,

Stephen Christopher Swift
Secretary-Treasurer

