- Invention Disclosure
  - Presumably from Hess's lab notebook
  - Original dated 3/18/89 but date redacted when submitted to PTO
    - Redacted to make it more difficult for an adverse litigant to determine Hess's DOC and, therefore, what constitutes prior art
    - Examiner doesn't need to know DOC; his only concern is whether it predates the presumptive DOI of potential 102 art
  - Used to persuade Examiner that Hess's DOC was prior to Fischell's presumptive DOI
  - Statement in 131 declaration was submitted to establish diligence from before Fischell's presumptive DOI to Hess's filing date
  - Recall that we spent considerable time looking at ways to invalidate the 168 patent by looking at ways to make potentially anticipatory art 102 prior art either by
    - Establishing the potentially anticipatory art had an earlier DOI and/or
    - Moving Hess's DOI to a later date
      - Showing that he was not diligent
        - Examine lab notebooks to see whether they evidence a continuous effort to reduce the claimed invention to practice
      - Showing that he lacked corroboration
        - Notice his invention disclosure lacks corroboration -- it wasn't witnessed
        - Query whether anyone else can confirm his claimed date of conception or whether there's any contemporaneous writing that confirms the date
      - Showing he didn't conceive as of the date of his invention disclosure
        - Remember complete conception requires a definite and firm idea of the complete and operative invention as it is to be applied in practice
          - *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F.2d 1367 (Fed. Cir. 1986)
        - Conception is complete only when the idea is so clearly defined in the inventor’s mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation. An idea is definite and permanent when the inventor has a specific, settled idea, a particular solution to the problem at hand, not just a general goal or research

plan he hopes to pursue. Because it is a mental act, courts require corroborating evidence of a contemporaneous disclosure that would enable one skilled in the art to make the invention.

  - *Burroughs Wellcome Co. v. Barr Laboratories Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994)

- "[P]art of the conception inquiry asks whether the inventor 'possess[ed] an operative method of making [the invention],'?" quoting I*nvitrogen Corp. v. Clontech Laboratories Inc.*, 429 F.3d 1052, 1063 (Fed. Cir. 2005). See also *Dawson v. Dawson*, 710 F.3d 1347 (Fed. Cir. 2013)

- A party cannot prove conception unless it shows possession of every feature recited in the claim; that is, every limitation of the claim must have been known to the inventor at the time of the alleged conception. *Davis v. Reddy*, 620 F.2d 885 (C.C.P.A. 1980); Johns Hopkins Univ. v. 454 Life Scis. Corp., 183 F. Supp. 3d 563 (D. Del. 2016). Naturally, the inventor must be able to describe the invention with particularity. *Hitzeman v. Rutter*, 243 F.3d 1345 (Fed. Cir. 2001). However, an inventor's testimony is insufficient by itself to show conception — the inventor must provide corroborating evidence. S*lip Track Sys. v. Metal-Lite, Inc.*, 304 F.3d 1256 (Fed. Cir. 2002).

▼ Does his invention disclosure evidence complete conception?

  ▼ Does it evidence possession of an operative method of making the invention?

    ▼ Turns on whether a POSA would be able to RTP the invention without extensive experimentation

      - Need testimony of POSA

      - Which, if any, embodiments did Hess try to make?

    ▼ There are some indications that Hess did not possess an operative method for practicing the claimed invention without extensive experimentation

      - E.g., not a single embodiment in the patent is found in the invention disclosure

      - His invention disclosure does not illustrate a structure designed to selectively shield radioactive material from the body yet deliver a desired dose

- Conclusion: attacking Hess's DOI is potentially fertile ground for Novoste