

392 (3d Cir. 1998). Thus, the court may grant summary judgment only if the moving party shows that there are no genuine issues of material fact that would permit a reasonable jury to find for the non-moving party. *See Boyle*, 139 F.3d at 392. A fact is material if it might affect the outcome of the suit. *Id.* (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-248 (1986)). An issue is genuine if a reasonable jury could possibly find in favor of the non-moving party with regard to that issue. *Id.* In deciding the motion, the court must construe all facts and inferences in the light most favorable to the non-moving party. *Id.*; *see also Assaf v. Fields*, 178 F.3d 170, 173-174 (3d Cir. 1999).

With these standards in mind, the court will describe the facts and procedural history that led to the motion presently before the court.

III. BACKGROUND

The patent-in-suit relates to a process for forming “an epitaxial film of group III-V semiconductor disposed on a single crystal substrate.” Dr. Harold Manasevit (“Manasevit”) developed the process described in the ‘098 patent. Rockwell filed an application for a process patent on April 7, 1978. This application issued as the ‘098 patent on January 11, 1983. It expired on January 11, 2000.

The alleged prior art in dispute is that of Dr. Robert Stearns (“Stearns”). Stearns worked for Monsanto Chemical Company from 1957-1968. In 1965, Dr. Robert Ruehrwein (“Ruehrwein”) assigned Stearns to investigate “the deposition of gallium arsenide using organometallics.” Steven Koban (“Koban”), a laboratory technician was also assigned to work on this project with him. Stearns and Koban intermittently worked on this project until early 1968, when Stearns left Monsanto to pursue unrelated business interests.

At his deposition, Stearns stated that he never used his organometallic process to make anything other than laboratory or test sample material, nor was he aware of anyone else having used it for another purpose. By way of a declaration, Stearns further testified that “the resulting films [from his experiments] were not of a quality sufficient for commercial production.” He continued by stating that his results were not reproducible. Indeed, he did not believe that his work merited the start of a patent review or publication of the results at that stage.

Although Stearns recalls having spoken of his organometallics work at a Monsanto Central Research Group dinner meeting, he does not remember exactly what he said at that meeting, nor who was in attendance. However, Harold Patton, a patent attorney at Monsanto during the mid-1960s, testified at his deposition that Monsanto dinner meetings were considered internal Monsanto meetings and were thus confidential.²

IV. DISCUSSION

Patents are presumptively valid. *See* 35 U.S.C. § 282. To overcome this presumption, the party asserting invalidity based on 35 U.S.C. §§ 102 and 103 must establish such invalidity by clear and convincing evidence. *See Price v. Symsek*, 988 F.2d 1187, 1191 (Fed. Cir. 1993); *see also Thomson, S.A. v. Quixote Corp.*, 166 F.3d 1172, 1175 (Fed. Cir. 1999), *cert. denied*, 527 U.S. 1036 (1999). “Clear and convincing” evidence is evidence that convinces the factfinder that the truth of a factual assertion is “highly probable.” *See Price*, 988 F.2d at 1191.

With Spectra’s and Opto’s burden in mind, the court will now turn to a discussion of Stearns’ work.

²Although consultants attended these dinner meetings, they were required to sign confidentiality agreements that forbade the disclosure of information obtained at the meetings.

A. 35 U.S.C. § 102(a)

Title 35 of the United States Code, Section 102(a) provides that “[a] person shall be entitled to a patent unless the invention was known or used by others in this country” 35 U.S.C. § 102(a). “[I]n order to invalidate a patent based on prior knowledge or use, that knowledge or use must have been available to the public.” *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1370 (Fed. Cir. 1998) (citing *Carella v. Starlight Archery*, 804 F.2d 135, 139 (Fed. Cir. 1986)). Private experimentation and in-house disclosures do not satisfy 35 U.S.C. § 102(a). *See Surgical Laser Tech., Inc. v. Laser Indus., Ltd.*, 29 U.S.P.Q.2d 1533, 1539 (E.D. Pa. 1993).

The court concludes that, on the present record, there is no evidence that anyone outside of Monsanto, with the exception perhaps of an outside consultant bound by a confidentiality agreement, had knowledge of, or used, Stearns’ work. Stearns did not commercialize his work, and indeed, he testified at his deposition that it was still in the private experimentation stage. Further, Koban’s knowledge is insufficient to show public knowledge. *See Rosemount Inc. v. Beckman Instru., Inc.*, 218 U.S.P.Q. 881 (C.D. Cal. 1983), *aff’d* 727 F.2d 1540 (Fed. Cir. 1984) (rejecting the contention that individuals who were employed by an inventor could meet the public knowledge requirement of Section 102(a)). Spectra and Opto have not argued to the contrary. Accordingly, Rockwell is entitled to judgment as a matter of law on this issue.³

B. 35 U.S.C. § 102(g)

A patent shall not issue if the invention that is the subject of the patent “was made in this country by another who had not abandoned, suppressed, or concealed it.” 35 U.S.C. § 102(g).

³This result is consistent with the District Court for the Northern District of California’s decision on Stearns’ work in a similar action. *See See Rockwell v. SDL, Inc.*, C95-1729 (N.D. Cal. Feb. 9, 2000).

Before this section becomes applicable, however, the invention must be complete. *See International Glass Co. v. United States*, 408 F.2d 395, 402 (Ct. Cl. 1969). Completion or reduction to practice and the date upon which that occurred is a pivotal issue. *See Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1444 (Fed. Cir. 1994). Thus, non-reproducibility constitutes a failure to reduce a conception to practice. *See Pharmacia, Inc. v. Frigitrionics, Inc.*, 727 F. Supp. 710, 714 (D. Mass. 1989) (noting that fortuitous, non-reproducible occurrences are insufficient to constitute reduction to practice).

Rockwell has provided Stearns' deposition testimony that he was not able to perfect the electrical properties and other impurities in order to make the invention reproducible. As Spectra and Opto have filed no opposition to this testimony, the court concludes that they have failed to show, by clear and convincing evidence, that Stearns reduced his work to practice.⁴ Furthermore, because prior art must satisfy the Section 102(g) requirements before it may be used as prior art under Section 103, the court holds that his work cannot be utilized as prior art to invalidate any of the '098 claims under either Section 102 or 103. *See E.I. DuPont De Nemours & Co. v. Phillips Petro. Co.*, 849 F.2d 1430, 1437 (Fed. Cir. 1988).

V. CONCLUSION

Based on the record before it, the court concludes that Spectra and Opto have failed to adduce clear and convincing evidence that Stearns' work was publicly known or used, or that it was reduced to practice.

⁴This result is likewise consistent with the District Court for the Northern District of California's decision on the issue of Stearns' work.

For these reasons, IT IS HEREBY ORDERED that:

1. Rockwell's motion for summary judgment that Dr. Robert Stearns' work is not prior art (D.I. 155) is GRANTED.

Date: March 28, 2002

Gregory M. Sleet
UNITED STATES DISTRICT JUDGE