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The Fraud-Tainted Cloning Patent: Scandalous in Theory, a Storm in a Teacup in Reality

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You may have heard that the United States Patent Office (USPTO) has recently issued a patent on cloning human stem cells to Korean researcher Hwang Woo-Suk[1]. About a decade ago, Dr. Hwang claimed to have cloned the world's first human embryos. Soon, however, his claim was unmasked as fraud, and Dr. Hwang was fired from his research position, and convicted of embezzling research funds.

On first blush this appears to be an embarrassing episode for the USPTO. But in reality, the USPTO has done its job, and the patent may prove to be both valid and enforceable after all.

Patents are routinely granted on inventions that have not yet been put into practice. One way to gauge what the inventors really did, as opposed to what they just think might work, is paying attention to the tenses in which the examples are written. If an example in a patent specification is written in the present tense, then it's a hypothetical scenario that has not been put into practice. On the flipside, if the example is written in the past tense, then it describes actual work done.

If this sounds odd, consider the even odder fact that many patents are asserted against technologies that were not even a glimmer in anyone's eye when the patent was granted. Yet, if the new technology practices all the steps of a patent claim, it infringes that patent, regardless of how remote the original patent's scope was from the new technology.

If Dr. Hwang described both his methodology and his experimental observations (or the lack thereof) truthfully,[2] and if it turns out that he was on the right path to cloning, and was the first to conceive of this invention, then he may well have the right to a valid and enforceable patent despite his famous fraud.

As reported in Law 360, the spokesman for the USPTO said that the office was aware of Dr. Hwang's history and "took steps to ensure that claimed invention complied with the patent statutes."[3] Moreover, the patent is to a specific cell line that has been deposited under the terms of an international treaty, and

[1] U.S. Patent No. 8,647,872 B2, issued on February 11, 2014.
[2] The prosecution history shows that the Examiner relied on an affidavit from Dr. Hwang in issuing the patent.
[3] Ryan Davis, USPTO Can't Be Blamed For Patent On 'Fraud' Stem Cells, Feb. 2, 2014 (available at www.law360.com/articles/511211).

this claimed cell line is now available to the public. Thus, scientists will be able to test it and verify Dr. Hwang's claims.

As many commenters have noted, the USPTO's only mandate is to evaluate whether a patent application complies with the conditions of patentability, such as whether the claimed invention is novel and nonobvious. It is not within the USPTO's mandate to conduct independent research and determine whether an application accurately describes the invention or whether the invention works.

The U.S. patent prosecution system operates on an honor system, with stiff penalties for perpetrating fraud on the USPTO. If any of Dr. Hwang's statements during prosecution are found to be false or misleading, this patent would be unenforceable.

Taken all together, the issuance of this patent is, really, a non-story. But if it helps educate the public about the rather opaque world of patent prosecution, then it has done society a service.

About the Author

Dr. Maria Granovsky is of counsel in the Intellectual Property & Technology group of Cohen & Gresser LLP and is an experienced pharmaceutical and biotechnology patent litigator. She has represented multinational generic and branded pharmaceutical companies, medical device companies, research instrumentation companies, universities, and individual entrepreneurs in a wide range of patent litigation and Hatch-Waxman litigation matters. Dr. Granovsky was previously an academic research scientist in molecular genetics.

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