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COMPETITION

March 4, 1967

Norman J. Latker, Esq.
Patent Counsel
National Institute of Health
Room 5B40, Building 31
Bethesda, Maryland 20 014

RE: "CRITIQUE OF BRENNER vs. MANSON"
By Lawrence R. Velvel
January 1967 JPOS - pp 5 - 14

Dear Norman:

In our 'phone conversation you appeared puzzled and inquisitive on Mr. Velvel's critique of Brenner v. Manson reported at 148 USPQ 689 and decided in March of 1966. The core of Velvel's argument is set out in paragraph 1, page 5, where he alleges that the Supreme Court has ruled out a process patent where the utility is "for scientific research" or otherwise lab utility. Additionally, Velvel states that the Court indicated "that a patent may not issue on a product whose sole utility is usefulness in research".

Starting from this bold assumption, Velvel tails off in the rest of his article. Note particularly paragraph 1 at page 12 and correlate this with note 17 at 148 USPQ 694. In concluding the opinion at p. 696, Mr. Justice Fortas came closer to the mark of what the Court actually meant where he states that potential utility is no good. In other words, a crystal ball utility is bad by the Court's present dicta.

Inquiry of Mr. Herbert I. Sherman on the brief before the Supreme Court and in Mr. Laurencess office specifically on the point of possible modification of the characteristic "Laurence type utility statement" used widely

in the 50's revealed that Herb suggested that no longer should a specific utility be tied down to standard pharmacological tests in animals but should be stated broadly. The danger in this is that clinical data may be required in a greater number of cases, but in weighing the end results, it is my opinion that with the wealth of potential for clinical data which exists at NIH, it would be wise to foresee any difficulties coming up. Although the Court has specifically not ruled on the validity of lab tested patents, it has indicated that such might come in the future. At present I would suggest that the above noted course be taken. In other words, for instance in the Manson case language like this might be used - this process produces products which have anti-tumor activity rather than saying that the process produces products which have been tested by standard pharmacological tests in laboratory animals and have been found to have anti-tumor activity.

Very truly yours,

cc: Herbert I. Sherman
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Warner Building
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