

Federal Circuit Confirms that Both Written Description and Enablement are Required for Patentability

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Yesterday, March 22, 2010, the Federal Circuit "reaffirm[ed] that §112, first paragraph, contains a written description requirement separate from enablement." *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Company*. Nine of eleven participating judges joined in the *en banc* decision; Judges Rader and Linn filed separate decisions in which they dissented-in-part and concurred-in-part.

In its order granting rehearing *en banc*, the Court had directed the parties to brief two questions:

1. Whether 35 U.S.C. §112, paragraph 1 contains a written description requirement separate from an enablement requirement?
2. If a separate written description requirement is set forth in the statute, what is the scope and purpose of that requirement?

In its *en banc* decision, the nine-judge majority "agree[d] with Lilly and read the statute to give effect to its language that the specification 'shall contain a written description of the invention' and h[e]ld that §112, first paragraph, contains two separate description requirements: a 'written description [i] of the invention, and [ii] of the manner and process of making and using [the invention].'" (Slip Op., p. 10). The Court found this conclusion to be compelled by the statutory language of §112, Supreme Court precedent and *stare decisis*: "this has been the law for over forty years, ... and to change course now would disrupt the settled expectations of the inventing community...." (Slip Op., p. 16).

The *en banc* Court went on to say that:

[A] separate requirement to describe one's invention is basic to patent law. Every patent must describe an invention. ... A description of the claimed invention allows the United States Patent and Trademark Office ("PTO") to examine applications effectively; courts to understand the invention, determine compliance with the statute, and to construe the claims; and the public to understand and improve upon the invention and to avoid the claimed boundaries of the patentee's exclusive rights. (Slip Op., p. 12).

[T]he purpose of the written description requirement is to "ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor's contribution to the field of art as described in the patent specification." (Slip Op., pp. 28-29).

The Court reaffirmed that the test for written description is "whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." (Slip Op., p. 23, citations omitted). Acknowledging that the term "possession" "has never been very enlightening," the Court explained that "the specification must describe an invention understandable to th[e] skilled artisan and show that the inventor actually invented the invention claimed." (Slip Op., p. 24). The Court did not attempt to decide exactly what will or will not satisfy the "written description" requirement in every case. It "recognized that determining whether a patent complies with the written description requirement will necessarily vary depending on context," and was explicit that "we do not try here to predict and adjudicate all of the factual scenarios to which the written description requirement could be applied." (Slip Op., p. 24).

The Court did confirm that the written description doctrine is not limited to determining priority, and that "[a]lthough many original claims will satisfy the written description requirement, certain claims may not." (Slip Op., pp. 19-20). For example, a generic claim must be supported by disclosure of a sufficient number of species in the specification. Applying this doctrine to the case at hand, the *en banc* Court adopted the reasoning of the panel decision in reaffirming that the asserted claims were invalid for lack of written description. The claims were functional genus claims "far broader" than the disclosure in the specification relating to specific types of compounds. (Slip Op. pp. 37-38).

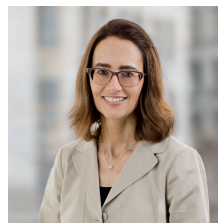
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