

# Friday Seminar Series

May 13, 2010

35 U.S.C. § 112

The Patent Specification

## 35 U.S.C. 112 Specification.

- The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.
- Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.
- A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.
- An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

## **35 U.S.C. 112, first paragraph:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

## U.S. Constitution, Article 1, section 8, clause 8:

The Congress shall have Power ...

To **promote the Progress of Science and useful Arts**, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries

"A country without a patent office and good patent laws is just a crab and can't travel any way but sideways and backwards."

Samuel Clemens (aka Mark Twain) *A Connecticut Yankee in King Arthur's Court* (1889)



## 35 U.S.C. 112, first paragraph:

The specification shall contain a **written description of the invention, and of the manner and process of making and using it,** in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

*Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*,  
598 F.3d 1336 (Fed. Cir. March 22, 2010) (en banc)

(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?

*Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*,  
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(1) Whether 35 U.S.C. § 112, paragraph 1, contains a written description requirement separate from an enablement requirement?

“We ... hold 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.”

# So what?

Ariad	Eli Lilly
<p>Written description:</p> <ul style="list-style-type: none"><li>■ identifying the invention;</li><li>■ enabling the invention.</li></ul>	<ul style="list-style-type: none"><li>■ Written description of the invention;</li><li>■ Written description enabling the invention.</li></ul>

# Original Claims

## Ariad

Written description:

- identifying the invention
- enabling the invention.

If Ariad prevailed, then the written description requirement may have been limited to situations involving new matter.

Why?

Because Ariad argued that an original claim by definition is a written description that identifies “the invention” and the only question is whether that invention is adequately enabled.

*Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*,  
598 F.3d 1336 (Fed. Cir. March 22, 2010) (en banc)

(2) If a separate written description requirement is set forth in the statute, what is the scope and purpose of that requirement?

“[T]he test for sufficiency 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.”

*Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*,  
598 F.3d 1336 (Fed. Cir. March 22, 2010) (en banc)

“The term “possession,” however, has never been very enlightening.”

A few broad principles:

- actual possession is not itself enough (must be described)
- actual possession is not necessary
- possession must be adequately described to POSITA
- a description that renders an invention obvious is not an adequate written description of the invention

# Written description issues arise in different contexts, including in original claims

- New matter (see also 35 U.S.C. § 132)
- Priority claims (written description analysis occurs “as of the filing date sought.”)
- Interferences
- Original claims (genus, functional claims, ranges ...)

X





Tell the crab where to go.

## 35 U.S.C. 112, first paragraph:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Courts and the USPTO have interpreted the enablement provision to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without "undue" experimentation.

## MPEP 2164.01(a) Undue Experimentation Factors

These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

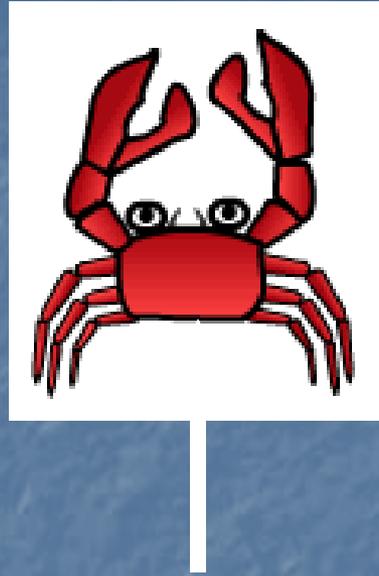
In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)

## Compare the two written description requirements

description of the invention	enablement of the invention
<ul style="list-style-type: none"><li>■ person skilled in the art</li><li>■ commensurate with claim scope</li><li>■ claim by claim analysis</li><li>■ at time of filing</li><li>■ show inventor's possession</li><li>■ obviousness insufficient</li><li>■ adequately described but not enabled?</li></ul>	<ul style="list-style-type: none"><li>■ person skilled in the art</li><li>■ commensurate with claim scope</li><li>■ claim by claim analysis</li><li>■ at time of filing? issuance?</li><li>■ provide public's possession</li><li>■ obviousness likely sufficient</li><li>■ adequately enabled but not described?</li></ul>

X





Tell the crab how to get there.

## 35 U.S.C. 112, first paragraph:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall **set forth the best mode contemplated by the inventor of carrying out his invention.**

The purpose of the best mode requirement is to "restrain inventors from applying for patents while at the same time concealing from the public the preferred embodiments of their inventions which they have in fact conceived." *In re Gay*, 309 F.2d 769, 772, 135 USPQ 311, 315 (CCPA 1962).

Two factual inquiries in a "best mode" analysis:

1. Did the inventor contemplate a best mode?  
(subjective test).
2. If yes, did the specification as filed enable one of ordinary skill to practice that best mode?  
(objective test).

# Best Mode Considerations

- Concealment may be intentional or accidental.
- Not required to designate as best mode.
- Not required to update relative to priority apps.
- Claim by claim analysis – best mode of practicing "the invention."
- Possible pitfalls:
  - new matter
  - Rule 131 affidavit of prior, undisclosed invention

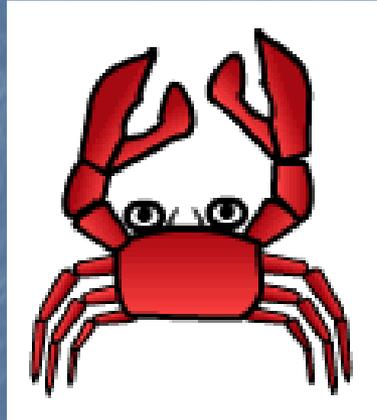
# Comparison of best mode with written description and enablement

Courts and the USPTO consider whether the specification *enables* a person of ordinary skill in the art to practice the best mode. If a mode of practicing the invention would have been obvious in light of the specification, then it is enabled.

(Compare, written description may not depend upon obviousness. It pertains to possession by the inventor.).

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Tell the crab how to be the best crab he can be.

Thank you.

