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Disclose narrowly and claim broadly at your own risk

Recent Federal Circuit decisions reveal divergent views of the written-description requirement among the judges.

David Beckwith and Paul Devinsky [All Articles](#)

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Recent Federal Circuit jurisprudence reflects a jigsaw puzzle of varied and divergent views of the written-description requirement of 35 U.S.C. 112, ¶ 1 and how written description affects claim construction. Should courts "rewrite" claims to limit their scope to what is disclosed in the specification? Should claim terms always be construed according to their plain meaning (absent a clear intent to the contrary by the inventor)? Should the plain meaning of claim language control, even if the resultant claim scope is broader than the accompanying disclosure, possibly rendering the claim invalid (under the "enablement" requirement)? Should courts even bother with the written-description requirement outside of the (soon to be eliminated) priority context, and instead focus on enablement?

In *Ariad Pharms. Inc. v. Eli Lilly & Co.*, 598 F.3d 1336 (Fed. Cir. 2010) (en banc), fuzzy battle lines were drawn between the proponents of a plain-meaning rule as applied to broad claim terms and the use of limited disclosures to narrowly construe claims. In *Ariad*, the majority of the U.S. Court of Appeals for the Federal Circuit ruled that written description is a separate and distinct requirement imposed by § 112, ¶ 1, independent from the enablement requirement, but conceded that in some predictable arts, the difference between the two may not be so easy to decipher. The majority in *Ariad* held that claims to a specific inhibitor of activity by NF-kB (a protein complex that controls the transcription of DNA) were invalid because the specification did not disclose any working or prophetic examples of the methods that achieve the specific claimed biologic activity — disclosure of a hypothetical class of compounds that might achieve the desired outcome was insufficient.

Chief Judge Randall Rader and Judge Richard Linn provided the core dissent in *Ariad*, questioning whether the written description has statutory legitimacy in the manner applied by the majority. As explained by the dissent, enablement of patents is governed by § 112, ¶ 1, while written description is a construct of flawed statutory interpretation (a positioned echoed in Judge Arthur Gajarsa's concurrence). Rader and Linn further argue that the use of a separate written-description requirement to "rewrite," or limit, broadly worded claims places

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the Federal Circuit in conflict with its own "plain meaning" precedent as articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). The dissent argued that the new written-description requirement only has meaning if the court ignores the primacy rules set down in *Phillips*.

The apparent tension within the Federal Circuit in terms of these issues arose again in the recent denial of Retractable Technologies Inc.'s petition for rehearing en banc, over the spirited dissent of Rader and judges Kimberly Moore and Kathleen O'Malley. The petition sought en banc review of the panel opinion in *Retractable Technologies Inc. v. Becton, Dickinson and Co.*, No. 10-1402 (Fed. Cir. July 8, 2011), a case that addressed the claim-construction tension between broadly drafted claims that are based on a written description having far narrower scope.

The Federal Circuit had affirmed in part, and reversed in part, the district court's determination that a claimed syringe "body" could include a multipart structure. The panel majority noted that the specification indicates what was invented is a unitary body, and the claim language should not be interpreted to extend the invention beyond what is presented by the inventor in the written description as the invention. Rader dissented from the panel decision, relying on the ordinary meaning of the term "body" as the basis for his disagreement. He argued that since there was no special meaning to supplant the ordinary construction of the term "body," it was error to limit the construction of that term to a one-piece structure.

Two separate dissenting opinions were filed from the refusal to grant rehearing en banc. In the first dissent, Moore and Rader viewed this case as a vehicle to address the role of the specification in construing claims, and specifically whether the specification could or should be used to rewrite the ordinary meaning of claim language to better capture what was invented. Rader and Moore explained that when claims are broadly drafted beyond what is disclosed in the specification, that raises a problem in terms of validity, not claim construction. As the dissenters explained, claims should not be rewritten to better conform to what the court discerns the "invention" of the patent to be. The plain and ordinary meaning of claim language should not be narrowed unless the inventor, in drafting her patent specification, acted as her own lexicographer or intentionally disclaimed claim scope — and changing the plain meaning of claim terms to tailor the scope of the claims to the disclosed invention is not supported by the en banc decision in *Phillips*.

CONFLICTING VIEWS

The views of Rader, Moore and Linn seem to reflect a minority position on the court, and appear to conflict with the views held by Judge Pauline Newman as illustrated in *Markem-Imaje Corp. v. Zipher*, No. 10-1305 (Fed Cir. Sept. 9, 2011). In *Markem*, Linn and Judge Raymond Clevenger reversed the district court's construction that claims directed to a tape drive require some method of deriving tension measurement, even though no such limitation was explicitly recited in the claims.

The majority in *Markem* found that the district court had improperly imported a limitation from the specification into the claim in connection with constructing claim terms, notwithstanding that the claimed device will only operate if the tension is measurable. The majority analogized the case to a claim to an engine providing motive power to an auto and explained that such a claim need not incorporate a limitation to an exhaust pipe, even though an engine clearly needs one to function. Newman dissented, arguing that the specification describes the invention as requiring some method of measuring-tape tension, and thus the claims must be construed to include this as a limitation. Newman argued that when a limitation is placed on the invention by the specification, the boundaries of the claims must also be so limited.

The unclear nature of the interplay between written description and claim construction is further demonstrated by the Federal Circuit ruling in *Crown Packaging Tech. Inc. v. Ball Metal*

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Beverage Container Corp., No. 10-1020 (Fed. Cir. April 1, 2011). In *Crown*, the claims at issue were directed to a metal-can design and seaming methods that allowed for seaming the can by driving either inside or outside the can's reinforcing bead. The district court ruled that the claims lacked written description because the specification only describes solving the prior-art problem by driving the seam outside the reinforcing bead.

Newman and Judge Ronald Whyte (of the Northern District of California, sitting by designation) reversed the district court's claim construction, holding that although the patent described two distinct problems with the prior-art can seaming, only one of the solutions described in the specification required driving the seam outside the reinforcing bead. Since the specification need only describe what is claimed, and only one of the identified solutions required limiting the driving to outside the bead, the majority concluded that the claim was so limited and consequently there was no failure of written description.

Judge Timothy Dyk dissented in part, arguing that the claims were actually broad enough to cover a combination of two different methods of can seaming, one of which is not disclosed in the specification. Because this claimed combination of sealing methods was not explicitly described anywhere in the specification, he would uphold the district court decision on the failure of written description. Given Newman's prior dissent in *Markem* (arguing that a narrow written description limited claim scope), one may conclude that either Dyk missed the mark in his analysis regarding the breadth of combination claims, or Newman has modified her views concerning those instances when a court can or should rely on limited disclosure to narrow the scope of claims.

Gajarsa (who took senior status last year) provides an altogether different viewpoint on § 112, ¶ 1; placing his emphasis on the enablement requirement. In *Ariad*, Gajarsa concurred with the outcome but disagreed that an independent written-description requirement is a necessity of patent law. He argued that enablement is the proper focus, and that the importance of written description as a separate requirement was overstated. Gajarsa would thus confine the use of written description to the context of establishing priority (an interference concept that has been obviated by the "first to file" provisions of the recently enacted America Invents Act). He encouraged Congress to "wield a machete" to clear the "thicket" of written-description jurisprudence and to provide clearer guidance and clarity.

In *Boston Scientific v. Johnson & Johnson*, No. 10-1230 (Fed. Cir. June 7, 2011), Moore and Judge William Bryson provide the majority view that claims to "analog compounds" lack written description because such a broad genus of compounds was not described. An example of one compound may not indicate possession of a genus of compounds having similar functionality. Gajarsa concurred in part, agreeing that the claims in issue, directed to drug-eluting stents, were invalid as drafted. However, he reached this result based on the failure of enablement rather than lack of written description.

FUNDAMENTAL DIVISION

There remains a fundamental division within the Federal Circuit on the importance of the specification of the patent as a limitation on claim scope, as compared to the view that the claim language itself should be of paramount importance in construction. At present, the outcome of contested constructions in such circumstances currently seems to hang, at least to some extent, on the panel hearing the appeal. Various judges, particularly Rader, Newman, Linn and Moore, place different emphasis on the primacy of claim language versus specification disclosure in construing claims.

In the Retractable Technologies case, a writ of certiorari is now pending at the U.S. Supreme Court. The various view of the members of the Federal Circuit may be resolved (or at least the legal principles clarified) if certiorari is granted. Perhaps Gajarsa has the most efficient approach, at least in terms of promoting certainty and predictability. Limiting the § 112, ¶ 1, analysis to enablement may resolve intracircuit differences in terms of the hierarchy of

importance between the plain meaning of claim language and scope of disclosure.

David Beckwith is a partner in the Irvine, Calif., office of McDermott Will & Emery. He focuses on complex litigation and trial of U.S. patent disputes, intellectual property due diligence and counseling. Paul Devinsky is a partner in the Washington office. He focuses on IP litigation and counseling, as well as on trade secrets litigation and counseling, and on licensing and transactional matters and post-issuance U.S. Patent and Trademark Office proceedings.

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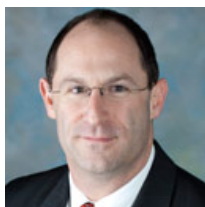
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