

Absent Full Scope Of Enablement, Broad Claims Fail

Friday, Mar 21, 2008 --- Following two recent cases applying the doctrine requiring that broad claims be fully enabled by the specification, the U.S. Court of Appeals for the Federal Circuit again applied the doctrine, invalidating patent claims that had been broadly construed but not sufficiently enabled by the patent specification under 35 U.S.C. 112, ¶ 1. *Sitrick v. Dreamworks LLC*, Case No. 07-1174 (Fed. Cir. Feb. 1, 2008) (Moore J.)

Inventor David Sitrick's two patents involve substituting or integrating a user's audio signal or visual image into a pre-existing audiovisual presentation.

Sitrick sued the defendant movie producers and distributors for releasing DVDs that included the allegedly infringing product called "ReVoice Studio."

The district court granted the defendants' summary judgment motion that all the asserted claims were invalid for lack of enablement. Sitrick appealed.

The Federal Circuit rebuffed Sitrick's challenge to the broad claim construction because he had earlier convinced the district court to deny the defendants' request to limit the claims to video games.

Next, because of the broad construction, the Federal Circuit agreed with the district court that the asserted claims required that the technology be enabled for both video games and movies.

Finally, assuming the application of the disclosed technology to video games was enabled, the Federal Circuit reviewed the district court's analysis of the disclosure in regards to movies.

The "enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation."

Rather than assessing only whether the patent disclosure enables the accused device, this Federal Circuit reminded us that the analysis must consider the "full scope" of the invention for each of the asserted claims. Therefore, "a patentee who chooses broad claim language must make sure the broad claims are fully enabled."

Here, Sitrick disclosed a "controller" system that receives, modifies and processes audiovisual signals in order to substitute or integrate a "user image" into the presentation.

According to the defendants' experts, identifying and extracting a particular

character's audio signal or visual image from a series of movie frames in order to substitute and integrate a "user image" requires different techniques than doing so in a video game, which instead contains programmatically rendered characters.

Citing Sitrick's lack of contradicting evidence, the Federal Circuit agreed with the district court's conclusion that the scope of the claimed invention was not enabled (for movies) despite the written description of video game implementation.

As this case illustrates, a broadly construed claim coupled with a narrow disclosure creates a high risk of invalidation.

As other recent Federal Circuit decisions have also demonstrated, the ramifications of the full scope of enablement doctrine must be considered during both patent prosecution and during claim construction litigation strategy. See, e.g., *Auto. Techs. Int'l, Inc. v. BMW of N. Am., Inc.*, (IP Update, Vol. 10, No. 9) (claim covering both mechanical and electrical sensors was not enabled by disclosure of only mechanical sensor); *Liebel-Flarsheim v. Medrad*, (IP Update, Vol. 10, No. 4) (claim covering two types of needle holders was not enabled by description of only one of the needle holders).

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