

Federal Circuit Reinvigorates the Written Description Requirement

In last week's *en banc* decision in *Ariad v. Eli Lilly*, the Federal Circuit reaffirmed the existence of a written description requirement in section 112 separate from the enablement requirement. The ruling emphasizes the importance of describing one's actual invention and reflects the Court's willingness to invalidate claims in the all too many cases where there is a disconnect between the invention described in the four corners of the specification and that in the claims.

The Federal Circuit held that "a separate requirement to describe one's invention is basic to patent law." The Court relied on the "settled expectations of the inventing and investing communities," and PTO practice in addition to the statutory language, Supreme Court and its own precedent in affirming the written description doctrine. It stressed the importance of providing a meaningful disclosure to the public in exchange for the patent grant. The Court noted that "although written description and enablement often rise and fall together, requiring a written description of the invention plays a vital role in curtailing claims that do not require undue experimentation to make and use, and thus satisfy enablement" but are not what is actually invented and described in the specification.

The Federal Circuit also agreed with Eli Lilly that the written description requirement applies with equal force to original claims. As the Court pointed out, neither the statute nor Supreme Court precedent restricts the written description requirement to cases of priority or amended claims. The fact that original claims are part of the original specification does not mean that they disclose the subject matter that they claim. The Federal Circuit noted that the problem is particularly acute when the original claims simply describe a desired result without describing any species that achieve that result, i.e., the problem it found in *Ariad*. As the Court explained, "the claims [in *Ariad*'s patent] merely recite a description of the problem to be solved while claiming all solutions to it and... cover any compound later actually invented and determined to fall within the claim's functional boundaries — leaving it to the pharmaceutical industry to complete an unfinished invention."

The Federal Circuit emphasized that "[p]atents are not awarded for academic theories, no matter how groundbreaking or necessary to the later patentable inventions of others." It noted that the written description requirement is valuable in that it incentivizes "actual invention" and rewards those "who actually perform" the work of invention and disclose the fruits of that work to the public.

The Court also bolstered the written description requirement in its discussion of the test for a sufficient disclosure. It made clear that "the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art" and that the specification must show "that the inventor actually invented the invention claimed." The Federal Circuit also emphasized that the specification itself must show that the inventor invented the claimed invention. Possession of the invention outside of the specification does not satisfy the written description requirement. The Court reaffirmed that the specification must disclose rather than make obvious the invention to meet the written description requirement.

Following *Ariad*, three things are clear: (1) the written description requirement is a separate requirement from enablement; (2) patentees cannot avoid the written description requirement with original claims that do not comport with what was actually invented; and (3) the specification itself must show that the patentee invented what is claimed. Patentees should take note of the risks in describing a research plan without disclosing the results of carrying out the plan. Defendants should consider relying on the written description requirement in cases where the claims — whether original or amended — are not supported by a sufficient disclosure. ♦

If you would like more information about this alert, please contact one of the following attorneys:

Michael F. Buchanan	212.336.2350	mfbuchanan@pbwt.com
Gregory L. Diskant	212.336.2710	gldiskant@pbwt.com
Eugene M. Gelernter	212.336.2553	emgelernter@pbwt.com
Scott B. Howard	212.336.2451	sbhoward@pbwt.com
Robert W. Lehrburger	212.336.2996	rwlehrburger@pbwt.com
Jeffrey I.D. Lewis	212.336.2549	jidlewis@pbwt.com
Chad J. Peterman	212.336.2877	cjpeterman@pbwt.com
Irena Royzman	212.336.2081	iroyzman@pbwt.com
Karla G. Sanchez	212.336.2785	kgsanchez@pbwt.com
Steven A. Zalesin	212.336.2110	sazalesin@pbwt.com

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