

Written Description and Enablement: Current Cases and Pending Decisions

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Nick Panno, DLA Piper LLP US - Reston, VA

Carla Ji-Eun Kim, Sterne Kessler Goldstein & Fox - Washington, DC

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35 U.S.C. § 112(a)

“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 or joint inventor of carrying out the invention.”

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Enablement

- ▶ “...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...”
- ▶ The disclosure teaches a POSITA how to make and use the invention without undue experimentation (routine experimentation is OK)
 - ▶ Consider breadth of claims, content of disclosure itself, level of ordinary skill, state and predictability of prior art
- ▶ The disclosure describes a practical utility for the invention

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Enablement Requirements

- ▶ Specification must enable full scope the claims
 - ▶ Not specification + knowledge of POSITA
- ▶ Combination of features / order of steps that provides enablement must be disclosed
- ▶ Enablement can fail if no utility disclosed
- ▶ No need to enable all possible or conceivable embodiments

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Written Description

- ▶ “...a written description of the invention, and of the manner and process of making and using it...”
- ▶ The specification must describe an invention understandable to a person of ordinary skill in the art (POSITA)
- ▶ A POSITA has enough detail to understand that the inventor had possession of the invention at the time of filing
 - ▶ Actual reduction to practice described
 - ▶ Sufficiently detailed description to show possession
 - ▶ Multiple species can support genus (sometimes)

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Written Description Requirements

- ▶ Express or inherent disclosure
 - ▶ Inherent: not disclosed but necessarily present in view of what is disclosed
- ▶ As broad as the claim scope
 - ▶ Claims that are literally broader than the disclosure can be narrowed by the disclosure

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