

No. 2008-1248

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IN THE  
UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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ARIAD PHARMACEUTICALS, INC.,  
MASSACHUSETTS INSTITUTE OF TECHNOLOGY,  
THE WHITEHEAD INSTITUTE FOR BIOMEDICAL RESEARCH, AND  
THE PRESIDENTS AND FELLOWS OF HARVARD COLLEGE,

*Plaintiffs-Appellees,*

v.

ELI LILLY AND COMPANY,

*Defendant-Appellant.*

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**Appeal from the United States District Court  
for the District of Massachusetts in 02-CV-11280,  
Judge Rya W. Zobel**

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**BRIEF OF AMICUS CURIAE  
PROFESSOR CHRISTOPHER A. COTROPIA IN SUPPORT OF  
ELI LILLY'S ANSWERS TO THE EN BANC QUESTIONS**

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November 18, 2009

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## CERTIFICATE OF INTEREST

Counsel for amicus curiae Christopher A. Cotropia certifies the following:

1. The full name of every party of amicus represented by me is:

Christopher A. Cotropia

2. The name of the real party in interest represented by me is:

Christopher A. Cotropia

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are:

None

4. The names of all law firms and the partners or associates that appeared for the party of amicus now represented by me in the trial court or agency or are expected to appear in this court are:

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## STATEMENT OF INTEREST OF AMICUS CURIAE

Christopher A. Cotropia is a Professor of Law at the University of Richmond School of Law and a member of that School's Intellectual Property Institute. As a full-time academic, he concentrates his research and teaching on the legal and policy issues of the U.S. Patent Law.

Christopher A. Cotropia has no stake in any of the parties to this litigation or the result of this case, other than an interest in seeking correct and consistent development of patent law jurisprudence.

No part of this brief was authored by counsel for any party, person, or organization besides amicus. This brief is filed in response to the Court's invitation to file amicus briefs in this matter without leave of Court, as indicated in the Court's order in this matter dated August 21, 2009.

## SUMMARY OF ARGUMENT

This brief's primary goal is to demonstrate that, contrary to assertions by Ariad and others, the written description requirement is not a recent creation, but has been an explicit part of patent law for nearly two hundred years. The requirement is found in a long series of Supreme Court cases, appellate court decisions, United States Patent and Trademark Office ("USPTO") activity, and statutes—including current § 112, ¶ 1, as a proper grammatical interpretation shows. Therefore, the answer to the first en banc question is yes. The answer to the second en banc question is as well established, with the Supreme Court linking the requirement, from the beginning, to the patentee's need to actually invent the claimed subject matter—essentially a conception inquiry using the specification.

A fundamental tenant of patent law is that patents issue only to inventors. *See O'Reilly v. Morse*, 56 U.S. 62, 120-21 (1853). Likewise, a patent cannot grant exclusivity greater than what the inventor actually invented. *See Evans v. Eaton*, 20 U.S. 356, 430 (1822) (noting that a "party cannot entitle[] himself to a patent for more than his own invention"); *Ensten v. Simon, Ascher & Co.*, 282 U.S. 445, 452-453 (1931) (citing the "principle which forbids a patentee to assert a right to more than he has actually invented"). These restrictions on patents are expressed in the Patent and Copyright Clause of the United States Constitution. *See* U.S. Const., Art. I, § 8, cl. 8 (articulating rights for "Inventors"); *William C. Robinson*, 1 *The*

*Law of Patents* 91 (1890) ("The Constitution of the United States authorizes the grant of patents only to inventors."). Linking patent rights to the invention also finds its foundation in basic patent theory. See, e.g., *Kewanee Oil Co. v. Bicron Corp.* 416 U.S. 470, 480-81 (1974) (noting that patent exclusivity is meant to remunerate the inventor for *their* "enormous costs in terms of time, research, and development"); *Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc.*, 548 U.S. 124, 127 (2006) (Breyer, J., dissenting) ("Patent law seeks to avoid the dangers of overprotection just as surely as it seeks to avoid the diminished incentive to invent that underprotection can threaten.").

This truism—that you may claim only what you invent—has always found a place in the patentability requirements that govern the patent's disclosure. Specifically, the patent laws and the Supreme Court have always asked the patent specification to perform two functions: (a) establish that the patentee invented the claimed subject matter and (b) teach those skilled in the art how to make and use this described invention. The first of these requirements, which is identified by most as the written description requirement, is therefore far from a recent creation.

The Supreme Court articulated this requirement in *Evans*, 20 U.S. at 433-34, and continued to require written description support after the introduction of the modern patent claim in *Morse*, 56 U.S. at 113. The Court even recently reiterated the requirement in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535

U.S. 722, 736 (2002), noting that the "patent application must describe, enable, and set forth the best mode of carrying out the invention. § 112 (1994 ed.)."

The Courts of Appeals, including the Second, Fifth, Ninth, and D.C. Circuits, have followed this longstanding Supreme Court precedent and applied the written description requirement since at least the mid-1800s. The USPTO has also long been making written-description-based rejections, even describing this basis for rejection in its First Edition of the Manual of Patent Examining Procedure ("MPEP") in 1949. *See, e.g.*, MPEP § 706.03(n) (1st ed. 1949).

Such a requirement's early and continued existence is not surprising given that the plain language of 35 U.S.C. § 112, ¶ 1, and its predecessor statutes, contains three separate adjectival prepositional phrases that modify the noun phrase "a written description," one of which requires the description to be "of the invention." In light of the historical, universal, and consistent usage of the written description requirement by all three government branches since the early 1800s, the answer to the first en banc question is yes, there is a distinct written description requirement.

In response to the second en banc question, the statute and Supreme Court case law articulate the purpose behind the requirement—to ensure that the claimed invention was actually invented by the named inventor(s). And such an inquiry is nothing new in patent law. The requirement essentially operates like the initial

inquiry regarding conception—looking at the specification for evidence of "recognition and appreciation of the invention" by the patentee of the claimed invention. *Heard v. Burton*, 333 F.2d 239, 244 (C.C.P.A. 1964). In turn, just as a patentee must invent, and thus conceive, of every patent claim, the written description applies universally as well, applying to all claims, original and amended.

## ARGUMENT

### I. The Supreme Court Has Long Recognized a Distinct Written Description Requirement

#### A. *Evans v. Eaton, O'Reilly v. Morse, and Subsequent Case Law Articulates a Written Description Requirement*

Contrary to assertions by Ariad and others, a distinct written description has been part of U.S. patent law for almost 200 years. This requirement to patentability was articulated by the Supreme Court in *Evans*, 20 U.S. at 433-34, and then fully developed in the context of the modern patent claim in *Morse*, 56 U.S. at 112-20. The Court in *Morse*, looking at the 1836 version of what is now 35 U.S.C. § 112, ¶ 1,<sup>1</sup> found claim 8 of Morse's patent invalid because he claimed subject matter "he has *not described* and indeed had *not invented*, and therefore could *not describe* when he obtained his patent." *Id.* at 113 (emphasis added). The

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<sup>1</sup> The operative language is very similar. See note 11, *infra* (setting forth the relevant language).

Court was therefore "of opinion that the claim is too broad, and not warranted by law." *Id.*

Claim 8 described the "use of the motive power of the electric or galvanic current, which I call electromagnetism, however developed for marking or printing intelligible characters, signs, or letter, at any distances . . . ." *Id.* at 112. The Court specifically noted that claim 8, unlike other claims in the patent, did not restrict the invention to "any part of the process or combination set forth in [Morse's] specification." *Id.* at 113. The specification did describe one "method or process" for sending and printing information at a distance. *Id.* at 117. But nothing in the specification indicated that Morse had invented anything more. "[H]e has not discovered that the electro-magnetic current, used as a motive power, in any other method, and with any other combination, will do as well" as what was specifically described in the patent's specification. *Id.* The specification showed "Professor Morse has not discovered that the electric or galvanic current will always print at a distance, no matter what may be the form of the machinery or mechanical contrivances though which it passes." *Id.* Claim 8 "can derive no aid from the specification filed. It is outside of it, and the patentee claim beyond it." *Id.* at 119-120.

The Supreme Court found support for such a disclosure requirement—a

written description requirement—in § 6 of the 1836 Act.<sup>2</sup> *Id.* at 118-19 ("[T]he specification required by this law is a part of the patent; and the patent issues for the invention described in the specification."). The Court also found support in *Neilson v. Harford*, 151 Eng. Rep. 1266 (Ex. 1841). The patentee in *Neilson* claimed a general mechanical apparatus to produce a current of hot air—he claimed "no particular mode of constructing the receptacle, or of heating it." *Morse*, 56 U.S. at 115-16. The English court questioned whether the patent's specification provided enough detail to establish that Neilson was in fact the inventor of this broad claim. *Morse*, 56 U.S. at 116. The *Neilson* court answered yes because the specification showed that "the interposition of a heated receptacle, in any form, was the novelty he invented." *Morse*, 56 U.S. at 116.

As Eli Lilly identifies in its principal brief, the Supreme Court has consistently applied a written description requirement in its cases ever since *Morse*. See Eli Lilly Br. 9-15 (cataloging Supreme Court cases). The commonality amongst these cases is that the "description of the invention" in the specification limits the scope of patentable subject matter to prevent patent protection to "exten[d] the monopoly beyond the invention." See, e.g., *Holland Furniture Co. v. Perkins Glue Co.*, 277 U.S. 245, 258 (1928).

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<sup>2</sup> Again, the Court focused on language that is essentially the same as that found in § 112, ¶ 1. See note 11, *infra*.

As recently as 2002, the Supreme Court reaffirmed a distinct written description requirement. *Festo*, 535 U.S. at 736. A question at the core of the *Festo* decision was what patentability rejections could prompt claim amendments that establish prosecution history estoppel. *Id.* at 735-36. Specifically, the Court addressed whether amendments in response to § 112 rejections could create estoppel. *Id.* The Supreme Court answered in the affirmative, noting that such rejections are relevant to patentability—the "patent application must *describe*, enable, and set forth the best mode of carrying out the invention. § 112 (1994 ed.)." *Id.* (emphasis added). "What is claimed by the patent application must be the same as what is disclosed in the specification; otherwise the patent should not issue. The patent also should not issue if the other requirements of § 112 are not satisfied, and an applicant's failure to meet these requirements could lead to the issued patent being held invalid in later litigation." *Id.*

*B. The Written Description Requirement Is Articulated by the Supreme Court as Distinct From an Enablement Requirement*

Just as the written description requirement has long been articulated by the Supreme Court, the Court has also, for as long, distinguished it from enablement. The Supreme Court in *Festo*, in addition to recognizing the requirement, specifically distinguishes the "descri[ption]" requirement from an "enable[ment]" requirement. *Id.* This is not surprising, given that the Court's discussion in *Morse* clearly establishes two distinct disclosure requirements—the specification must (1)

communicate what Morse actually invented (written description) and (2) teach the manner to make and use this invention (enablement). *Morse*, 56 U.S. at 112-122, 119 ("The specification of this patentee describes his invention or discovery, and the manner and process of constructing and using it; and his patent, like inventions in the other arts above mentioned, covers nothing more.").

The parts of the *Morse* opinion that find no written description support for claim 8 do not rely upon whether someone skilled in the art *could* make and use that recited in claim 8. Instead, the Court's opinion focuses on what the specification tells us about what "Professor Morse . . . discovered." *Id.* at 117. The inquiry looks at what the specification tells about what Morse *himself* invented, not what it teaches some third party. *Id.* at 113 ("[Morse] claims an exclusive right to use a manner and process which he has not described and indeed had not invented, and therefore could not describe when he obtained his patent."). If *Morse* were solely an enablement inquiry, then there would be no discussion about what Morse actually recognized as his invention. Yet there was. *Id.* at 117.

The English decision upon which the Court relies, *Neilson*, further supports this distinction between written description and enablement. The court in *Neilson* is characterized as making two findings. First, the jury in *Neilson* "found that a man of ordinary skill and knowledge of the subject, looking at the specification along, could construct such an apparatus as would be productive of a beneficial

result . . . ," *Morse*, 56 U.S. at 115, a finding of what is traditionally considered enablement. The *Neilson* court goes on to responded to a "second ground of defence." *Morse*, 56 U.S. at 115. This second defense is written description—an allegation that Neilson's claim covered something Neilson had not invented and described, not something Neilson invented and described in the patent's specification. *Morse*, 56 U.S. at 116. The *Neilson* court found this objection baseless, concluding that "he had invented a mechanical apparatus" as claimed. *Morse*, 56 U.S. at 116. The Supreme Court in *Morse* then takes this discussion in *Neilson* of a distinct written description inquiry and applies it to Morse's claim 8, finding that Morse's specification lacked sufficient details where Neilson's did not. *Morse*, 56 U.S. at 116-21.

What makes cases like *Morse* and *Festo* so important is that they actually identify two disclosure requirements—written description and enablement. Supreme Court cases cited for the proposition that there is solely an enablement requirement, such as *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55 (1998); *The Telephone Cases*, 126 U.S. 1 (1888); and *Tilghman v. Proctor*, 102 U.S. 707 (1881), do no such thing. These cases do not overturn the rule set forth in cases like *Morse* that a patentee cannot claim that "which he has not described and indeed had not invented, and therefore could not describe when he obtained his patent." *Morse*, 56 U.S. at 113. The Supreme Court has never renounced the requirement's

existence, which is perfectly understandable, given the centrality the act of inventing plays in patent law and policy.

## **II. There Is a Historical Consensus Supporting the Existence of a Distinct Written Description Requirement**

### *A. Courts of Appeals Have Historically Applied the Requirement*

#### **1. There is No Conflict Among Circuit Courts**

There is no conflict among the courts of appeals as to the existence of a distinct written description requirement. For more than one hundred years, numerous circuits—including the D.C., Second, Fifth and Ninth Circuit—have applied a written description requirement, many citing *Morse* as the basis for the requirement.

Courts of Appeals' application of a written description requirement dates back to at least Justice Story's decision in *Wyeth v. Stone*, 30 F. Cas. 723 (C.C.D. Mass. 1840). In *Wyeth*, Justice Story opined on the validity of a patent claim reciting "an exclusive title to the art of cutting ice by means of any power, other than human power." *Id.* at 727. The specification described a "particular apparatus and machinery . . . to effect the purpose of cutting ice." *Id.* at 728. In Justice Story's opinion, this description did not support the general claim. The patentee was "not the inventor of any or all of such means, methods, or apparatus. A claim broader than the actual invention of the patentee is, for that very reason, upon the

principles of the common law, utterly void, and the patent is a nullity." *Id.* at 727 (citations omitted).

Other courts of appeals followed a similar line of reasoning—if the specification does not show the patent claim was actually invented, that claim is invalid. The D.C. Circuit applied this thinking to a Patent Office rejection in *In Re Gardner*, 32 App. D.C. 249 (1908). "Testing the appealed claims by the rules" set forth in *Morse*, the court concluded that if the claim at issue were allowed, it "would cover means substantially different from those described, which might be discovered by another for accomplishing the same results" as the claim. *Id.* at 251-52. In *Gen. Elec. Co. v. Brenner*, 407 F.2d 1258 (D.C. Cir. 1968), the D.C. Circuit came to a similar conclusion regarding the requirement's existence:

An analysis of this area of the law reveals:

a) The specification must contain a correct and adequate description of the invention claimed.

b) The description shall be in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains to make and use same.

*Id.* at 1261 (citations omitted).

The Second Circuit in *Steinfur Patents Corp. v. Beyer*, 62 F.2d 238 (2d Cir. 1932), also cited *Morse* for the proposition that the specification must show that the patentee invented the claimed process for the claim to be valid. *Id.* at 241 (finding the claims at issue are "an attempt to secure protection for the result itself

without reference to the rather limited contribution to the art made by the patentee's discovery. As a description of the invention, [the claims] are insufficient, and, if allowed broadly, would extend the patent monopoly beyond the invention."). The Fifth Circuit, in *Fruit Treating Corp. v. Food Machinery Corp.*, 112 F.2d 119, 121 (5th Cir. 1940), discussed two requirements for the specification, noting that "[w]hen a patent is claimed for discovery, the law requires the patentee to state its component parts with clearness and precision, and to give a practical statement of its ingredients." The Ninth Circuit, citing both *Morse* and *Wyeth*, has a similar view on this requirement for patentability. See *Otis Elevator Co. v. Pacific Finance Corp.*, 68 F.2d 664, 668-69 (9th Cir. 1934) (invalidating a claim for "failure to incorporate in the claim a sufficient description of the invention; the result, however, was not an indefinite claim, but a claim broader than the patent law permits").

2. The Federal Circuit Also Follows the Supreme Court's Precedent

The Federal Circuit, like these other regional circuits, has also recognized the historical Supreme Court roots of the written description requirement. In *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916 (Fed. Cir. 2004), the Federal Circuit cites both *Festo* and *Morse* to support its application of the requirement. *Rochester*, 358 F.3d at 921, 929 n.9. The Federal Circuit cited *Morse* again as foundation for the written description requirement in *LizardTech, Inc. v. Earth*

*Resources Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005). Similar reliance on *Morse* can be found in *Carnegie Mellon Univ. v. Hoffman-La Roche, Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (noting that "[i]t has long been the case that a patentee 'can lawfully claim only what he has invented and described, and if he claims more his patent is void'" (quoting *Morse*, 56 U.S. at 121)). Even the underlying opinion in this case cites *Morse* as the authority for the written description requirement. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 560 F.3d 1366, 1371 (Fed. Cir. 2009), vacated by 2009 WL 2573004 (Fed. Cir. Aug. 21, 2009).

*B. The USPTO Has Historically Applied the Requirement*

All available information indicates that the USPTO has also historically recognized the requirement, rejecting patent applications under the written description requirement.

Both of the D.C. Circuit decisions previously discussed, *Gardner* and *Gen. Elec.*, provide insight into the USPTO's early use of the requirement. *Gardner*, a 1908 case, affirmed a rejection of the claims at issue due to lack of written description support. *Gardner*, 32 App. D.C. at 252 (finding the "grounds assigned by the Primary Examiner and the Examiners-in-Chief in their decisions . . . sufficiently full and satisfactory"). In *Gen. Elec.*, the D.C. Circuit, when reviewing the actions of the USPTO, explicitly stated that there are two disclosure requirements set forth by § 112—a written description requirement and an

enablement requirement. *Gen. Elec.*, 407 F.2d at 1261 (noting "the requirements of [§ 112] under which the Commissioner must act with respect to the sufficiency of disclosures").

The original versions of the MPEP also enumerated a written-description-based rejection for patent examiners.<sup>3</sup> The first edition of the MPEP, issued in November 1949, describes a grounds for rejection—Section 706.03(n)—entitled "Correspondence of Claim and Disclosure." MPEP § 706.03(n) (1st ed. 1949). Section 706.03(n) recites "[a]nother category of rejections not based on the prior art," but "based upon the relation of the rejected claim to the disclosure. In chemical cases, a claim may be so broad as to not be supported by disclosure, in which case it is rejected as unwarranted by the disclosure." *Id.* Section 706.03(n) allows a rejection to stand where "averments in a claim do not correspond to the averments or disclosure in the specification . . . ." <sup>4</sup> *Id.*

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<sup>3</sup> The MPEP provides a window into the state of patent law at the time of its drafting. *See* MPEP *Forward* (1st ed. 1949). And while the MPEP is "not binding on this court," its contents have been given "judicial notice" by the Federal Circuit before. *Enzo Biochem v. Gen-Probe*, 323 F.3d 956, 964 (Fed. Cir. 2002).

<sup>4</sup> Notably, the section mentions that the "original claim is part of the disclosure and might adequately set forth subject matter which is completely absent from the specification." MPEP § 706.03(n) (1st ed. 1949). This statement first confirms that § 706.03(n) is talking about a written description-based rejection, not enablement, since it is looking at original claims as possibly providing description support. Second, the statement stands for the unsurprising proposition that the whole specification, including the claims, can provide written description support. Finally, the section says "may"—confirming that original claims do not

This is the written description requirement, not the enablement requirement, in use by the USPTO by 1949. Examiners are instructed to line up the specification with the patent claims to make sure the claimed invention is described in the specification, not whether the way to make and use it are explained. Section 706.03(n) says nothing about skill in the art or unreasonable experimentation. Nor does the section speak about what is taught to the skilled artisan. These inquiries are found elsewhere in another section of the MPEP—Chapter 600 describing the "Parts, Form and Content of Application." *See* MPEP § 608.01(g) (1st ed. 1949) (noting that the specification "must be in such particularity as to enable any person skilled in the pertinent art or science to construct, prepare and use the invention without involving extensive experimentation"). Instead, § 706.03(n) focuses on the likelihood of a rejection for the lack of correspondence in chemical cases, the very cases where written description problems are most likely.<sup>5</sup>

Section 706.03(n) is included, and not substantively changed, in all of the three revisions of the first edition of the MPEP and the four revisions of the second edition of the MPEP. *See, e.g.*, MPEP § 706.03(n) (2d. ed., Rev. 4 1958). Then,

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automatically provide written description support. Instead, the claims are examined, as well as the rest of the specification, to see if the inventor recognized the claimed invention at the time of filing.

<sup>5</sup> *See, e.g., Rochester*, 358 F.3d at 929 (invalidating a chemical composition claim for lack of written description in the specification).

in the third edition of the MPEP issued in November of 1961, the USPTO expanded its explanation of this type of rejection. Section 706.03(n) now included an additional sentence—a reference to "[s]ee 706.03(z) for rejections on undue breadth." *See* MPEP § 706.03(n) (3d. ed., 1961). This referenced section, § 706.03(z), entitled "Undue Breadth," further expounds on the written-description-like rejection. MPEP § 706.03(z) (3d. ed. 1961). Section 706.03(z) recites the typical written description invalidity scenario—"the disclosure of a single species does not provide an adequate basis to support generic claims." *Id.* (focusing on chemical cases) (citation omitted). The Section also notes that "[i]n mechanical cases, broad claims may properly be supported by a single form of an apparatus or structure." *Id.* (citation omitted). Again, the USPTO in the mid-1900s is discussing the same, typical application of the written description requirement as today—more likely to affect that validity of chemical patents than mechanical ones.<sup>6</sup> This examination by the USPTO—a written description inquiry—articulated in the first edition of the MPEP and expanded upon in the mid-1900s is not surprising given how established the requirement had become at the Supreme Court and the courts of appeals by this time. And the USPTO continues to instruct

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<sup>6</sup> Dan Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575, 1652-54 (2003) (noting that written description is "a highly technology-specific doctrine centered in the chemical arts").

examiners to make written description rejections today. *See* MPEP §§ 706.03(c); 2162 (8th ed., Rev. 7 2008).

### **III. Section 112, ¶ 1 Sets Forth a Distinct Written Description Requirement**

#### *A. The Plain Language of § 112, ¶ 1 Creates a Separate Written Description Requirement*

The first paragraph of § 112 establishes a distinct written description requirement. The paragraph begins by requiring a specification and that this specification must contain a "written description." There are then three adjectival prepositional phrases<sup>7</sup> that modify the noun phrase "a written description"—(i) "of the invention, " (ii) "of the manner and process of making and using it," and (iii) "in such full, clear, concise and exact terms as to enable any 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." This interpretation can be represented as follows:

(A) a written description

(i) of the invention, and

(ii) of the manner and process of making and using it,

(iii) in such full, clear, concise and exact terms as to enable any 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<sup>8</sup>

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<sup>7</sup> *See* Henry P. Emerson & Ida C. Bender, *Modern English* 86 (Book Two 1909) (defining an "adjective phrase").

<sup>8</sup> This diagramming differs from Ariad's in that it depicts all three prepositional phrases as modifying a single noun phrase—"a written description." Ariad

From this plain, grammatically correct reading, the written description must be these three things. And the first thing the written description must be is "of the invention." 35 U.S.C. § 112. ¶ 1. This is a separate component—a distinct phrase—of the first paragraph of § 112, as are the two later phrases. The statute's language therefore sets forth a distinct requirement—the patent must describe the invention.

Even if the final prepositional phrase—"in such full, clear, concise . . . use the same"—is read to inform one's understanding of the preceding phrases, the location of the term "and" in the statute links phrase (iii) to only phrase (ii), not phrase (i), "the invention". The conjunction "and" appears between phrase (i), "the invention," and phrases (ii) and (iii), which start with "manner and process of making . . . ". This separates the requirement that the specification describe the invention itself from the specification's task to set forth the "manner and process of making . . . in such full, clear, concise . . . " (the enablement requirement). The absence of an "and" between phrases (ii) and (iii), while there is one between (i) and the other two phrases, further supports such an interpretation. The conjunction, "and," links the later two phrases together, (ii) and (iii), in their modification of the

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signifies the last adjectival prepositional phrase as [B] (instead of (iii)), Ariad Br. 3, suggesting its positioned ahead in hierarchy of the proceeding prepositional phrases, which given the grammar is misleading.

noun phrase "a written specification" and separates them from the first (i), "the invention". Thus, even if phrase (iii) impacts the meaning of other adjectival prepositional phrases in the statute, it can only effect the second (ii), not the first (i).

The statute as written includes a necessary predicate before describing how to make and use the invention—a description of the invention.<sup>9</sup> Such a reading makes sense—how can someone skilled in the art be enabled "to make and use the same" when the specification does not first require a description of "the same"—the invention. Requiring the patentee to both describe the invention and then enable it is logical because the person having skill in the art must know what is being enabled. The invention itself sits between its creation and its use, and the statute explicitly asks the inventor to describe it. This is the very understanding reached by in one of the first U.S. patent law treatises: "According to the statutes, the Description must contain full explanations of three different subjects: *the invention itself*; the manner of making it; and the mode of putting it to practical use . . . ." *William Robinson, 2 The Law of Patents* 73 (1890) (emphasis added).

Any other reading renders the phrase "of the invention" meaningless. If the drafters wanted to require a description of only "the manner and process of using"

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<sup>9</sup> And the claims themselves do not automatically satisfy this requirement. The Supreme Court case law, discussed in Part I, *supra*, clearly contradicts this argument as well as the legislative history discussed in Part III.B, *infra*.

(enablement), there would be no phrase "of the invention," after "written description". Instead, the term "invention" would simply take the place of "it" at the end of the second prepositional phrase (ii).<sup>10</sup> Such drafting would have removed the need for the specification to describe the invention in addition to enabling it. The statute, however, does not do this and instead establishes a separate description requirement. In fact, it has kept this structure, with a separate requirement to describe the invention, since the 1790 act.<sup>11</sup>

*B. Legislative History Supports this Interpretation*

The legislative history of the 1952 Act supports this plain reading of 35 U.S.C. § 112, ¶ 1. As even Ariad notes, there is no legislative history that supports reading the written description requirement out of the statute. Ariad Br. 13-15. The only legislative history of relevance actually supports a distinct requirement.

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<sup>10</sup> The statute would read:

The specification shall contain a written description of the manner and process of making and using the invention, in such full, clear, concise, and exact terms . . . .

<sup>11</sup> See Act of Apr. 10, 1790, 1 Stat. 109, 110-11, ch. 7, § 2 (A patentee must "deliver . . . a specification in writing, containing a description. . . of the thing or things, by him or them invented or discovered . . . ."); Act of Feb. 27, 1793, 1 Stat. 318, 321-22, ch. 11, § 3 ("[E]very inventor, before he can receive a patent, shall . . . deliver a written description of his invention . . . ."); Act of July 4, 1836, 5 Stat. 117, 119, ch. 357, § 6 ("[B]efore any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery . . . ."); Act of July 8, 1870, 16 Stat. 198, 201, ch. 230, § 26 ("[B]efore any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefore, in writing, to the commissioner, and shall file in the patent office a written description of the same . . . .").

Congress noted that it was taking the claiming requirement out of the paragraph regarding the written description. *See* H.R. Rep. No. 82-1923, at 19 (1952); S. Rep. No. 82-1979, *reprinted in* 1952 U.S.C.C.A.N. 2394, 2412 ("The clause relating to the claim" from the pre-existing law was "made a separate paragraph to emphasize the distinction between the description and the claim or definition."). And, in contrast, Congress left in the required description "of the invention" in the first paragraph, meaning that there needed to be some description of the invention outside the patent claims. When moving the claiming of the invention to paragraph two of § 112, Congress could have deleted the "of the invention" phrase, but chose not to. The only reasonable inference is that it wanted to maintain the separate written description requirement for patentability.

Such a reading of the legislative history is not extraordinary given the Supreme Court's interpretation of the disclosure requirements prior to, and after, 1952. As discussed in Part I, *supra*, the Supreme Court, at least as early as *Evans* and *Morse* and as recently as *Festo*, interpreted U.S. patent law as articulating a written description requirement. This requirement was continually articulated by the Supreme Court, and even as the statutes changed, the particular written description language remained essentially the same.<sup>12</sup> And, as the Supreme Court mentioned in *Graham v. John Deere Co.*, 383 U.S. 1, 3-4, 13-15 (1966), the 1952

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<sup>12</sup> *See* note 11, *supra*.

Act simply codified the understanding of patent law at the time—an understanding that included a written description requirement.

#### **IV. The Written Description Requirement's Purpose and Scope is to Limit All Claims to what the Patentee Actually Invented**

The purpose behind the written description requirement is to ensure that the claimed invention was actually invented by patent's named inventor(s). The Supreme Court consistently repeats this purpose in its written description case law. *See, e.g., Morse* 56 U.S. at 113 ("[Morse] claims an exclusive right to use a manner and process which he has not described and indeed had not invented, and therefore could not describe when he obtained his patent."); *Evans*, 20 U.S. at 434 (noting that the requirement prevents a patentee from "pretending that his invention is more than what it really is").

Patent law is well equipped to engage in such an inquiry. It does so all the time when determining conception. "The primary meaning of 'invention' in the Patent Act unquestionably refers to the inventor's conception . . . ." *Pfaff*, 525 U.S. at 60. And while conception requires an enabled invention, it has a necessary predicate—"the formation, in the mind of the inventor, of a definite and permanent idea of the complete . . . invention, as it is thereafter to be applied in practice." *Mergenthaler v. Scudder*, 11 App. D.C. 264, 276 (1897). The inventor must "recogni[ze] and appreciat[e]" the claimed invention. *Heard*, 333 F.2d at 244. There must be evidence that the inventor had "possession of every feature" in the

claim. *Davis v. Reddy*, 620 F.2d 885, 889 (C.C.P.A. 1980). The written description inquiry asks the same questions, just limited to comparing the claims to the rest of the specification.<sup>13</sup> This inquiry is fairly certain, exemplified by a low, 17.5% reversal rate of district court written description determinations. See Patstats, Univ. of Houston Law Center, available at <http://www.patstats.org/Patstats2.html> (recording 33 affirmances and 7 reversals of written description determinations by the Federal Circuit from 2000-2007).

The requirement's connection to conception also explains how a claim can be enabled, but not described by the specification. Conception case law recognizes such situations where objectively, how to make and use the invention is taught, but there is not an underlying subjective appreciation. See, e.g., *Singh v. Brake*, 317 F.3d 1334, 1346 (Fed. Cir. 2003) ("Thus, whereas the test for determining whether or not Singh conceived the construct of the count depended on Singh's own personal knowledge of methods for making the construct and his formulation of a definite and permanent idea therefor, whether Brake 1 enables an invention within the count does not depend on what Brake knew, but rather on whether the application enables one skilled in the art to make and use the invention . . . .").

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<sup>13</sup> This is nothing new—patentees have relied on the specification before to establish conception. See, e.g., *Binstead v. Littman*, 242 F.2d 766, 846 (C.C.P.A. 1957) ("Binstead, therefore, has a right to rely upon the provisional specification for conception and reduction to practice of the invention defined in the count.").

There can be instances such as these of "inadvertent enablement." The specification can teach others how to make and use the invention, particularly when benefited by reasonable experimentation, and at the same time demonstrate that the inventor failed to recognize certain aspects of the claim. *See* Eli Lilly Br. 35-36 (cataloging exemplary cases).

Likewise, just as every claim must be conceived to be considered invented, *Pfaff*, 525 U.S. at 60, every claim must be described in the specification to meet the written description requirement. The requirement therefore applies to original and amended claims. And while claims themselves can be evidence of conception, just as any other part of the specification, they are not conclusive in their own right. *See, e.g., Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994) (holding that conception must be proven).

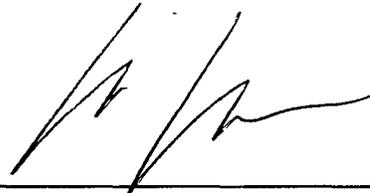
## CONCLUSION

For the reasons stated above, the answers to the en banc questions are:

1. There is a distinct, separate written description requirement established by longstanding Supreme Court precedent, appellate case law, prior statutes, and the plain language of 35 U.S.C. § 112, ¶ 1; and
2. This requirement applies to all patent claims for the purpose of ensuring that the patentee claims only what he or she actually invented.

Dated: November 18, 2009

Respectfully submitted,



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A handwritten signature in black ink, consisting of several fluid, connected strokes that form a stylized representation of the name Christopher A. Cotropia.

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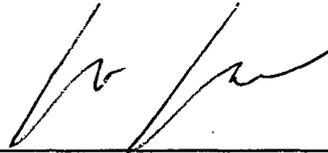
## CERTIFICATE OF COMPLIANCE

This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 29(d) and 32(a)(7)(B) and Fed. Cir. Rule 32(b). The brief contains 6,202 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii).

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