

Case No. 2008-1248

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

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 & COMPANY,

Defendant-Appellant.

Appeal from the United States District Court for the District of Massachusetts
in Case No. 02-CV-11280, Honorable Rya W. Zobel

BRIEF OF *AMICUS CURIAE* MICROSOFT CORPORATION
IN SUPPORT OF DEFENDANT-APPELLANT ELI LILLY & COMPANY
ON REHEARING *EN BANC*

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CERTIFICATE OF INTEREST

Counsel for *Amicus Curiae* Microsoft Corporation certifies the following:

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

Microsoft Corporation.

2. The name of the real party in interest (if the parties named in the caption are not the real parties in interest) represented by me is:

Same as stated in paragraph 1.

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

None.

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

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Dated: November 19, 2009.

Respectfully submitted,



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STATEMENT OF INTEREST OF *AMICUS CURIAE*

Amicus Curiae Microsoft Corporation is a leading information technology and software company. Microsoft holds numerous patents and is a frequent defendant in suits alleging patent infringement and thus has a profound interest in both the standard and the process by which compliance of patents with 35 U.S.C. § 112 is determined.

As a patentee and as a defendant, Microsoft also has an interest in avoiding the harm done to the patent system by patents that, via the claims, stake out exclusive rights that do not correspond to what the written description discloses to be the inventor's actual contribution to the useful arts. This disconnect between claims and disclosure eviscerates the bargain, the *quid pro quo*, that justifies burdening the public with patent exclusivity. Moreover, as a participant in patent infringement litigation, Microsoft has an interest in how the adequacy of a patent's written description is adjudicated. This Court's current approach — treating that inquiry as purely a question of fact for the jury — is an inexplicable anomaly, flying in the face of centuries of precedent, patent and non-patent alike, which recognizes that the analysis and interpretation of written instruments is a legal question to be decided by judges, not juries. A predictable, consistent, and effective patent system requires that decisionmaking responsibility be properly allocated: factual questions to the jury, legal questions to the court.

INTRODUCTION

This *en banc* proceeding presents a question of statutory interpretation: what disclosure does 35 U.S.C. § 112 require a patentee to provide? To answer that question, the Court does not parse each word or clause in the statute or focus on “statutory phrases in isolation,” but rather must “read [the] statute[] as a whole.” *United States v. Morton*, 467 U.S. 822, 828 (1984). As this Court explained in *Warner-Lambert Co. v. Apotex Corp.*, 316 F.3d 1348 (Fed. Cir. 2003):

In expounding a statute, we must not be guided by a single sentence or member of a sentence, but look to the provisions of the whole law, and to its object and policy. When interpreting a statute, the court will not look merely to a particular clause in which general words may be used, but will take in connection with it the whole statute (or statutes on the same subject) and the objects and policy of the law, as indicated by its various provisions, and give it such a construction as will carry into execution the will of the Legislature.

Id. at 1355 (citations and internal quotation marks omitted).

In this analytical framework, statutory interpretation is not a search for hidden meanings or embedded requirements, which can, when unearthed, then be numbered and categorized and reduced to formulae and checklists. Rather, statutory interpretation discerns the intent of the legislature, as revealed, of course, in the words of particular provisions, but understood in the context of the purpose motivating the statute as a whole.

Although Microsoft has no doubt that this Court is well aware of and intends to apply these principles, the specific questions posed in the Court's August 21, 2009 Order granting *en banc* review, if viewed as defining the Court's actual task, could lead the parties, *amici*, and the Court into an irrelevant and distracting discussion. The questions as worded focus on a single sentence in section 112, a detailed and comprehensive statute entitled "Specification," and ask whether that single sentence contains separate written description and enablement requirements. As worded, the questions thus potentially invite analysis of the first sentence of section 112 in isolation from the remainder of that section, and from the Patent Code as a whole. Likewise, the questions posed may prompt interested parties to attempt to further parse this single sentence seeking discrete and separate disclosure requirements, with unique labels and standards assigned to each, as dictated by each party's particular interests. As the Supreme Court and this Court have made clear, however, that piecemeal approach will not "carry into execution the will of the Legislature." *Warner-Lambert*, 316 F.3d at 1355.

The "will of the Legislature" here is to set the terms of the patent bargain, the bargain by which an inventor receives a right to exclude the public from an area of the useful arts, but only in exchange for a disclosure that advances the useful arts by revealing fully to the public exactly what the inventor has contributed. The Patent Code effectuates this bargain by requiring an inventor to

provide a written description of his invention that puts that invention fully into the possession of the public and by then compensating the inventor for that contribution to the public store of knowledge by granting him the right to particularly point out and distinctly claim an area of exclusivity. Although the disclosure and the claims thus both address the invention, they serve distinct purposes in the structure adopted by Congress. The proper construction of section 112 must recognize and give effect to these distinct purposes.

Finally, this Court should recognize that whether a patent's specification complies with section 112 is a quintessential question of law, and as such should be decided by the court and not a jury. The analysis of a patent disclosure for compliance with the statute is, simply stated, the construction of a legal instrument, no different than the construction of a contract or a statute — and no different than the construction of a patent's claims or the determination whether the claims are sufficiently definite. All of these inquiries are legal questions decided by the court. There is no justification for treating the same inquiry, with a different label, as a question of fact to be decided by a jury. The assignment to the jury of questions that should be decided by the court is a fundamental contributor to the inconsistency and unpredictability that plague modern patent litigation, and is a fundamental reason for the persistent calls for legislative reform. This Court

can begin to address these concerns by rationalizing the current divergent approaches to analysis of the patent document.

ARGUMENT

I. SECTION 112 REQUIRES THAT THE INVENTOR PROVIDE A WRITTEN DESCRIPTION THAT FULLY DISCLOSES TO THE PUBLIC THE INVENTOR'S CONTRIBUTION TO THE USEFUL ARTS.

The policy that lies at the heart of the patent system in the United States is set out in unequivocal terms in the Constitution:

The Congress shall have power ... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

U.S. Const., Art. I, § 8, cl. 8. Congress adopted the Patent Code, including section 112, pursuant to, and to effectuate, this constitutional objective. *See, e.g., Diamond v. Chakrabarty*, 447 U.S. 303, 307 (1980). That legislative purpose, and constitutional objective, therefore must drive the interpretation and application of the statute.

The mechanism Congress chose to implement the objective “[t]o promote the Progress of Science and useful Arts” is to provide for a trade — to grant an inventor limited exclusivity in exchange for “precision of disclosure” of what he has invented. *Universal Oil Prods. Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484 (1944). For this trade to be effective — for it truly “[t]o promote the Progress of Science and useful Arts” — the inventor’s disclosure must contribute

sufficiently to the store of public knowledge to offset the public burden of the exclusive rights conferred by the patent. Such a disclosure must (a) place what the inventor perceives to be his contribution fully in the possession of the public and (b) thereby also make clear what is outside the area of exclusivity, both so that the public knows where it may continue to tread and so that the public can design around and improve upon the inventor's contribution.

To provide this *quid pro quo*, a disclosure must, of course, enable the invention, but it must do more, for a description of well-known and predictable techniques may enable one skilled in the art to make many things — including the invention — but with no correlation to what the inventor actually invented. Indeed, because much of the information necessary to enable an invention may already be in the public's possession, the most critical contribution of the patent disclosure is the description of the invention itself. Thus, to make a meaningful contribution to the public store of knowledge, the patent disclosure must describe the invention, not simply provide information that might enable one to make embodiments spanning the invention. Indeed, that is why even those who, like Ariad, argue that the statute requires only an enabling disclosure concede that the specification must “state *what* the invention is, for otherwise it fails to inform a person of skill in the art what to make and use.” (Ariad Rehearing Br. 30.)

A. A Full Disclosure of “The Invention” Is A Necessary Part of the Patent *Quid Pro Quo*.

An inventor who wants to be a party to the bargain Congress made available in the Patent Code must file an application for a patent. 35 U.S.C.

§ 111(a). That application has three parts: the specification, a drawing, and the inventor’s oath. *Id.* Section 112 explains what is required of the specification:

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 of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

* * *

35 U.S.C. § 112. Although the courts have, for ease of reference, attached numbers to the paragraphs of section 112 — *e.g.*, 112(1), 112(2), 112(6) — Congress did not adopt separate provisions or subsections, but rather a unified explanation of the specification which establishes that its written description and claims, although part of the same instrument, perform distinct functions.

The Supreme Court made this clear over 60 years ago, in *Schreiber-Schroth Co. v. Cleveland Trust Co.*:

The object of the statute is to require the patentee to describe his invention so that others may construct and use it after the expiration of the patent and to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not. *It follows that the patent monopoly does not extend beyond the invention described and explained as the statute requires; that it cannot be enlarged by claims in the patent not supported by the description; and that the application for a patent cannot be broadened by amendment so as to embrace an invention not described in the application as filed, at least when adverse rights of the public have intervened.*

305 U.S. 47, 57 (1938) (citations and internal quotation marks omitted) (emphasis added).

As *Schriber-Schroth* explains, the claims — which delineate the patentee’s zone of exclusivity — cannot “extend beyond the invention described and explained as the statute requires” and must be “supported by the description.” *Id.* And this requirement is not limited to claims added by amendment, as some have suggested. *See, e.g., Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 979-80 (Fed. Cir. 2002) (Rader, J., dissenting from denial of rehearing); *id.* at 988 (Linn, J., dissenting from denial of rehearing). Rather, *Schriber-Schroth* makes clear that while claims cannot be added where they would “embrace an invention not described in the application as filed,” the originally-claimed invention also must be “described and explained” and the originally-filed claims must be “supported by the description.” 305 U.S. at 57. That support might be found in an

originally-filed claim itself, which is, after all, part of the specification. *See In re Gardner*, 480 F.2d 879, 879-80 (CCPA 1973). But because of their different function, claims need only “particularly point[] out and distinctly claim[]” the subject matter of the invention, 35 U.S.C. § 112(2), a degree of disclosure which often will not be sufficient to place that subject matter in the public domain or make unquestionably clear what the public can do without infringing. In those instances, the requisite disclosure must be found in the written description. *See, e.g., LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1346 (Fed. Cir. 2005) (broad original claim held not to provide an adequate disclosure of the invention).

This Court, too, has explained that the written description is an essential aspect of the *quid pro quo*. *See, e.g., ICU Medical, Inc. v. Alaris Medical Systems, Inc.*, 558 F.3d 1368, 1376-77 (Fed. Cir. 2009) (“[T]he purpose of the written description requirement is to ‘ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor's contribution to the field of art as described in the patent specification.’ This requirement protects the *quid pro quo* between inventors and the public, whereby the public receives ‘meaningful disclosure in exchange for being excluded from practicing the invention for a limited period of time.’”) (internal citations omitted); *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir.

2008); *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 922 (Fed. Cir. 2004). That is why this Court has repeatedly held invalid claims that cannot be reconciled with the inventor's description of the invention in the specification. *See, e.g., ICU Medical*, 558 F.3d at 1376-78 (holding invalid claims that did not include a spike limitation where "the specification describes only medical valves with spikes"); *LizardTech*, 424 F.3d at 1344-46 (holding invalid claim for method for creating a seamless discrete wavelet transform that did not include limitation requiring "maintaining updated sums," where sole method for creating transform described in specification involved maintaining updated sums).

These holdings are fully consistent with this Court's instruction "to avoid the danger of reading limitations from the specification into the claim." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (*en banc*). The cases holding claims invalid for an inadequate written description rest on the maxim that a patentee may not claim an invention that he has not invented. This is true where, as in the written description cases, the description and drawings do not disclose what the patentee nonetheless asserts is his invention. *See, e.g., ICU Medical*, 558 F.3d at 1376-78; *LizardTech*, 424 F.3d at 1344-46. It is equally true where, notwithstanding broader claim language, the patentee limits the scope of the invention by explaining in the specification that a particular embodiment is "the invention." *See, e.g., Chimie v. PPG Indus. Inc.*, 402 F.3d 1371, 1379 (Fed. Cir.

2005) (“when the preferred embodiment is described in the specification as the invention itself, the claims are not necessarily entitled to a scope broader than that embodiment”) (quotation marks omitted); *Honeywell Int’l, Inc. v. ITT Indus., Inc.*, 452 F.3d 1312, 1318 (Fed. Cir. 2006); *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001).

B. Enablement Alone Does Not Satisfy Section 112’s Disclosure Requirement.

The patentee’s disclosure of the invention certainly must enable those of skill in the art to make and use it — that is an essential part of describing “the invention” so as to place it in the possession of the public. But it is not the entire description. The Supreme Court made that clear in *O’Reilly v. Morse*, 56 U.S. 62 (1853), which concerned Samuel Morse’s patent covering the telegraph. Morse’s patent contained eight claims — seven which set forth specific circuits, devices, and systems for communicating using electromagnetism, and an eighth which broadly claimed the generic use of electromagnetism to produce intelligible characters at great distance. *Id.* at 112-13. The patent included a “careful description” of Morse’s invention, which explained “fully the nice and delicate manner in which the different elements of power are arranged and combined together and act upon one another, in order to produce the effect described in the specification.” *Id.* at 112. The Supreme Court perceived “no well-founded

objection to the description” of the inventions set forth in Morse’s first seven claims, nor any other objection to the patentability of those claims. *Id.*

But the Court held Morse’s eighth claim invalid for an inadequate written description: “he 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.” *Id.* at 113. Although Morse’s written description disclosed specific modes of using electromagnetism to produce intelligible characters at great distance (and was, under current law, enabling, *see, e.g., Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 (Fed. Cir. 1987) (disclosure of a single embodiment is enabling)), the description was nevertheless inadequate to support Morse’s broad eighth claim because it did not set forth the precise nature of the invention of that claim, or the limits beyond which the public could not go without infringing it. *See also Snow v. Lake Shore & M. S. Ry. Co.*, 121 U.S. 617, 629-30 (1887) (“[T]he language of the specification limits the first claim to a combination in which the piston and piston-rod are detached from each other. ... There is nothing in the context to indicate that the patentee contemplated any alternative for the arrangement of the piston and piston-rod.”); *Evans v. Eaton*, 20 U.S. 356, 433-34 (1822) (“The specification, then, has two objects; one is to make known the manner of constructing the machine (if the invention is of a machine) so as to enable artizans to make and use it.... The other object of the

specification is, to put the public in possession of what the party claims as his own invention, so as to ascertain if he claim any thing that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented.”).

This Court’s enablement decisions only underscore the potential gap between a disclosure of “the invention” and a disclosure that enables one to “make and use” the invention. This Court has explained that “the enablement requirement is met if the description enables *any mode of making and using the invention.*” *Johns Hopkins Univ. v. CellPro, Inc.*, 152 F.3d 1342, 1361 (Fed. Cir. 1998); *see also Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1071 (Fed. Cir. 2005) (finding the “patent bargain” satisfied where the specification “fully teaches a mode of making the claimed invention”); *Spectra-Physics*, 827 F.2d at 1533 (“a broad claim can be enabled by disclosure of a single embodiment”). But the enablement of one mode or embodiment of making and using the invention does not establish the bounds of the invention as the statute requires.

This is particularly true in the case of software-related patents, an area of obvious concern for Microsoft and similarly-situated technology companies. These patents often claim their inventions in terms of the functionality provided by the software, rather than its precise structure. For example, claim 21 in *LizardTech* was directed to creating a seamless DWT (discrete wavelet transform), but

contained no limitation as to how that was to be accomplished. 424 F.3d at 1344. The written description disclosed but one particular way of creating the seamless DWT, thus enabling the claimed invention, but failed to disclose any “more generic way” of doing so. *Id.* If no further description of “the invention” were required, the patentee would have preempted all ways of creating a seamless DWT in the absence of any indication that his actual invention extended that far. *Id.* at 1344-45.

This situation is closely analogous to that of species and genus claims. One skilled in the art may be able to make and use all species within a genus based on a description of a single species together with information generally known in the field. But this fact alone should not entitle the inventor of a single species, in all instances, to a patent claiming a genus, for distinctions may exist among members of the genus which would make many of those species independently patentable. The PTO’s written description guidelines address this situation by providing that a claim to a genus can be granted only if the patent disclosure provides a description showing that the applicant has invented the genus. One way of doing so is to describe a “representative number of species,” which means

that the species which are adequately described are representative of the entire genus. Thus, when there is substantial variation within the genus, one must describe a sufficient variety of species to reflect the variation within the genus. The disclosure of only one species encompassed within a genus adequately describes a claim

directed to that genus only if the disclosure indicates that the patentee has invented species sufficient to constitute the genus. A patentee will not be deemed to have invented species sufficient to constitute the genus by virtue of having disclosed a single species when the evidence indicates ordinary artisans could not predict the operability in the invention of any species other than the one disclosed.

U.S. Patent & Trademark Office, *Manual of Patent Examining Procedure* § 2163 (rev. ed. July 2008) (citations and internal quotation marks omitted); *see also* U.S. Patent & Trademark Office, *Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, 1, "Written Description" Requirement*, 66 Fed. Reg. 1099, 1106 (Jan. 5, 2001).

Even Ariad recognizes this deficiency in treating enablement as the sole disclosure requirement. As Ariad explains, the specification must “describe (identify) what the invention is,” and “[i]dentifying the invention is necessary for enablement, since a specification that does not teach one of ordinary skill what to make and use does not enable the skilled artisan to make and use the unidentified subject matter.” (Ariad Rehearing Br. 43.) Ariad, however, does not go far enough: even if one mode of practicing the invention is identified sufficiently to be enabled, the full invention claimed by the inventor may not be sufficiently disclosed to make clear that he in fact invented what he has claimed and to convey to the public his invention.

Congress has made clear elsewhere in section 112 as well that the description of an invention includes, but must go beyond, enablement. Section 112(6) provides that a means-plus-function claim “shall be construed to cover the corresponding structure, material, or acts *described* in the specification and equivalents thereof.” 35 U.S.C. § 112(6) (emphasis added). This Court has held that this “description” requirement is both a necessary element of the *quid pro quo* between the patentee and the public, and distinct from enablement. Thus, “[i]f one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language.” *Default Proof Credit Card System, Inc. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 1298 (Fed. Cir. 2005); *see also Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1219 (Fed. Cir. 2003); *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1382 (Fed. Cir. 1999).

This description requirement cannot be satisfied by a merely enabling disclosure. As the Court explained in *Aristocrat Techs. Australia Pty Ltd. v. Int’l Game Tech.*: “Enablement of a device requires only the disclosure of sufficient information so that a person of ordinary skill in the art could make and use the device. A section 112 paragraph 6 disclosure, however, serves the very different purpose of *limiting the scope of the claim* to the particular structure disclosed, together with equivalents.” 521 F.3d 1328, 1336 (Fed. Cir. 2008) (emphasis

added). “The inquiry is whether one of skill in the art would understand the specification itself to disclose a structure, not simply whether that person would be capable of implementing a structure.” *Biomedino, LLC v. Waters Technologies Corp.*, 490 F.3d 946, 953 (Fed. Cir. 2007).

This principle necessarily applies with equal force beyond the specific case of means-plus-function claims. If, for example, a specification’s bare recital of a microprocessor or other programmable device is insufficient to support a “means for” limitation, as *Aristocrat Techs.* and other cases clearly hold, the same specification likewise cannot provide a disclosure of the invention adequate to support claims that use purely functional method language or directly recite a microprocessor or other programmable device without regard to its programming. A written description that does not provide a sufficient disclosure to place the claimed invention in the possession of the public or to notify competitors of what was actually invented (and thus what was not invented) fails to comply with section 112, regardless of the form of the claims. *See, e.g., Fiers v. Revel*, 984 F.2d 1164, 1170-71 (Fed. Cir. 1993) (“An adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a *description of the DNA itself*. ... A bare reference to a DNA with a statement that it can be obtained by

reverse transcription is not a description; it does not indicate that Revel was in possession of the DNA.”) (emphasis added).

To fulfill the constitutional mandate and create the incentives necessary “[t]o promote the Progress of Science and useful Arts,” Congress devised a system that compensates inventors for their contributions to that progress by granting them exclusivity commensurate in scope with their contributions — *i.e.*, the inventions they have actually made and disclosed to the public. Congress did not intend to bestow, and the Constitution does not authorize Congress to bestow, windfalls upon inventors because of the happenstance that their disclosure of well-known and predictable materials and techniques may enable others to make inventions that go far beyond the inventors’ own work. *Cf.*, *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 511 (1917) (“[T]he primary purpose of our patent laws is not the creation of private fortunes for the owners of patents, but is ‘to promote the progress of science and the useful arts.’”). Indeed, as the Supreme Court has cautioned in the section 101 context, a patent should not “confer power to block off whole areas of scientific development, without compensating benefit to the public.” *Brenner v. Manson*, 383 U.S. 519, 535 (1966). The requirement that an inventor provide a written description of “the invention” is essential to maintaining the proper balance between inventive contribution and inventor compensation.

II. SATISFACTION OF THE WRITTEN DESCRIPTION REQUIREMENT IS A QUESTION OF LAW TO BE DECIDED BY THE COURT.

Whether an inventor has provided an adequate disclosure of his invention in his specification is, by any measure, a question of law that should be decided by the court. That determination requires interpreting the written patent document and comparing the claims to the written description — in other words, construction of a legally operative instrument to determine its substance and scope, and the relationship among its various parts. Centuries of jurisprudence establish that this is a matter of legal analysis, not factual inquiry, and should be performed by the court, not the jury. *See Levy v. Gadsby*, 7 U.S. (3 Cranch) 180, 186 (1805) (Marshall, C.J.) (“[N]o principle is more clearly settled, than that the construction of a written evidence is exclusively with the court.”); *see also, e.g., Firestone Tire & Rubber Co. v. Bruch*, 489 U.S. 101, 112 (1989).

This jurisprudence has particular force in the patent arena. As the Supreme Court has explained, “The construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis. Patent construction in particular ‘is a special occupation, requiring, like all others, special training and practice. The judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury; and he is, therefore, more likely to be right, in performing such a duty,

than a jury can be expected to be.” *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388-89 (1996) (quoting *Parker v. Hulme*, 18 F. Cas. 1138, 1140 (No. 10,740) (C.C. E.D. Pa. 1849)); *see also Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978 (Fed. Cir. 1995) (*en banc*) (“It has long been and continues to be a fundamental principle of American law that ‘the construction of a written evidence is exclusively with the court.’”) (quoting *Levy*, 7 U.S. (3 Cranch) at 186).

For these reasons, it is well settled that claim construction is a question of law to be decided by the court. Claim construction involves interpreting claim language, as it would be understood by one of skill in the art, “in the context of the entire patent, including the specification.” *Phillips*, 415 F.3d at 1313; *see also id.* at 1315-17 (describing the necessity of interpreting the specification as part of claim construction). The same rationale applies to the determination of claim definiteness. That inquiry involves comparing the construed claims to the specification, and therefore is also a matter of law. *See, e.g., Default Proof*, 412 F.3d at 1298 (“The requirement that the claims ‘particularly point[] out and distinctly claim[]’ the invention is met when a person experienced in the field of the invention would understand the scope of the subject matter that is patented when reading the claim in conjunction with the rest of the specification.”) (citing *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1367 (Fed. Cir. 2001)); *Atmel*, 198 F.3d at 1378 (citing *Personalized Media Communications, LLC*

v. Int'l Trade Comm'n, 161 F.3d 696, 705 (Fed. Cir. 1998)) (“A determination of claim indefiniteness is a legal conclusion that is drawn from the court’s performance of its duty as the construer of patent claims.”).

Precisely the same analysis applies to assessment of a patent’s written description. The written description requirement is satisfied where “the patent specification set[s] forth enough detail to allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed.” *Univ. of Rochester*, 358 F.3d at 928. In other words, the inquiry requires a comparison of the construed claims with the disclosure of the invention in the specification. *Id.*; *see also LizardTech*, 424 F.3d at 1343-44 (construing claim 21 and then comparing it to the patent disclosure). Determining the adequacy of the written description involves discerning what one skilled in the art would understand a written instrument, the specification, to disclose as the invention. As this Court held in *Univ. of Rochester*, “it is in the patent specification where the written description requirement must be met.” 358 F.3d at 927. To rely on juries to review and construe this written instrument as a question of fact, *see, e.g., Enzo Biochem*, 323 F.3d at 962-63; *Fiers*, 984 F.2d at 1170; *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991), cannot be reconciled with the determination of claim meaning and definiteness as questions of law. *See* Jesse S. Keene, *Fact or Fiction: Reexamining the Written Description Doctrine’s*

Classification as a Question of Fact, 18 Fed. Cir. B.J. 25, 62 (2008) (finding no “sufficient answer” in this Court’s precedents for designation of written description as a question of fact and concluding, “[i]n the end, the classification of written description as a question of fact appears incorrect”). Just as those legal inquiries require the “special training and practice” that only a judge can bring to bear, *see Markman*, 517 U.S. at 388, so too does analysis of the written description.

And this is not a matter of purely academic or theoretical interest.

Although section 112 mandates that inventors provide adequate disclosure in order to fulfill their end of the patent bargain, the power of that mandate is sapped if it is not enforced consistently and predictably. Consistent and predictable enforcement of patent laws is of surpassing importance to a fair and efficient patent system. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 739 (2002) (warning against “disrupt[ion of] the settled expectations of the inventing community”). But consistency and predictability are nigh impossible to attain when legal questions are assigned to the wrong decisionmaker for resolution.

Indeed, the patent system’s over-reliance on juries has been the subject of substantial scholarly criticism.¹ *See, e.g.*, Kimberly A. Moore, *Judges*,

¹ This is not to suggest that juries have no role to play in patent litigation; indeed, the Seventh Amendment requires that they do. But the Seventh Amendment “tells us nothing about which issues must be decided by a jury upon demand of a litigant and which issues are for the judge to decide.” *In re Lockwood*, 50 F.3d 966, 981 (Fed. Cir. 1995) (emphasis omitted) (Nies, J.,

Juries, and Patent Cases—an Empirical Peek Inside the Black Box, 99 Mich. L. Rev. 365, 365 (2000) (citing “extensive scholarly debate and increasing skepticism regarding the role of juries in patent cases”); The Advisory Commission on Patent Law Reform, A Report to the Secretary of Commerce 107 (1992) (criticizing the role of juries in patent cases); *Lockwood*, 50 F.3d at 980-81 (Nies, J., dissenting) (“No more important nor contentious an issue arises in patent law jurisprudence than the appropriate role of juries in patent litigation.”) (citing authorities).

Moreover, these concerns with an undue role for juries manifest themselves in concrete, practical terms in how cases are actually decided. Empirical evidence demonstrates that the choice of decisionmaker — court vs. jury — may substantially affect outcomes in patent cases:

Recent statistics show that patentees are far more likely to prevail in a jury trial than a bench trial, and that the damages awarded by juries are markedly higher than damages awarded by judges. According to one recent study, patentees won 44% of bench trials compared to 79% of jury trials. The average jury award is more than ten times greater than the average bench award of damages. ... [O]f the sixty-five to seventy patent cases that go to trial every year, patentees win approximately 75% of the cases. While only a small percentage of cases go to trial, the results of those cases are significant in that they represent generally high success rates and large

dissenting from denial of rehearing *en banc*), *vacated sub nom. American Airlines, Inc. v. Lockwood*, 515 U.S. 1182 (1995).

awards of damages, the threat of which allows the patent owner to negotiate a more favorable settlement.

Gary M. Hnath & Timothy A. Molino, *The Roles of Judges and Juries in Patent Litigation*, 19 Fed. Cir. B.J. 15, 16-17 (2009); *see also* Moore, 99 Mich. L. Rev. at 387 (“the patent-holder win rates follow the pattern predicted by popular perception — namely, higher win rates for the patent holder in jury trials, but not in judge trials”); Adam Shartzter, *Patent Litigation 101: Empirical Support for the Patent Pilot Program’s Solution to Increase Judicial Experience in Patent Law*, 18 Fed. Cir. B.J. 191, 214 (2009) (noting that patentees win 90% of jury trials in particular district and that juries in that district “rarely invalidate a patent”).

The inappropriate allocation of responsibilities between judge and jury is not only a fundamental cause of perceived and actual unfairness in the system, but also a source of disharmony between the U.S. patent system and intellectual property regimes elsewhere in the developed world. *See, e.g., Voda v. Cordis Corp.*, 476 F.3d 887, 902 (Fed. Cir. 2007) (noting in case involving Canadian, British, European, French, and German patent claims, that “the foreign sovereigns at issue in this case have established specific judges, resources, and procedures to ‘help assure the integrity and consistency of the application of their patent laws’”; contrasting U.S. system); John B. Pegram, *Should the U.S. Court of International Trade Be Given Patent Jurisdiction Concurrent with That of the District Courts?*, 32 Houston L. Rev. 67, 103 (1995) (comparing U.S. patent

system to British and Japanese systems). *See also* Kimberly A. Moore, *Xenophobia in American Courts*, 97 *Northwestern Univ. L. Rev.* 1497, 1504-05 (2003) (“[t]he increase in jury demands in patent cases, coupled with the perception of jury prejudice against foreign parties, may also contribute to the low incidence of patent enforcement [in the U.S.] by foreign parties”).

Only by mandating that legal issues be decided by those best equipped to decide them correctly — *i.e.*, judges — can this Court ensure that the patent system produces fair and predictable results, and is perceived to produce fair and predictable results. Indeed, in *Markman*, this Court cited considerations of fairness and predictability in holding that the court rather than jury should construe claims:

[I]t is only fair (and statutorily required) that competitors be able to ascertain to a reasonable degree the scope of the patentee’s right to exclude. *Merrill v. Yeomans*, 94 U.S. at 573-74 (“It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent.”); *Hogg v. Emerson*, 47 U.S. (6 How.) at 484. They may understand what is the scope of the patent owner’s rights by obtaining the patent and prosecution history — “the undisputed public record,” *Senmed*, 888 F.2d at 819 n.8 — and applying established rules of construction to the language of the patent claim in the context of the patent. Moreover, competitors should be able to rest assured, if infringement litigation occurs, that a judge, trained in the law, will similarly analyze the text of the patent and its associated public record and apply the established rules of construction, and in that way

arrive at the true and consistent scope of the patent owner's rights to be given legal effect.

52 F.3d at 978-79.

Like claim construction, the question whether a patentee has provided an adequate written description turns on "the text of the patent" and calls for the application of "established rules of construction" to "arrive at the true and consistent scope" of the patent. That is a task that can only be performed by the court.

CONCLUSION

Amicus Curiae Microsoft Corporation respectfully submits that the Court should hold that section 112 requires a written description of the invention that goes beyond merely enabling those of ordinary skill to make and use the invention, and makes clear to the public the full scope of the inventor's claimed contribution to the useful arts. Microsoft also respectfully submits that the

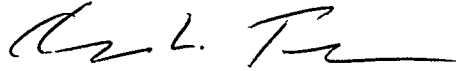
question whether a patent's written description complies with the statute is a question of law to be decided by the court.

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**CERTIFICATE OF COMPLIANCE WITH
FRAP 29(d) AND 32(a)(7)(B)**

Counsel for *Amicus* certifies that the body of this brief, beginning with the Statement of Interest of *Amicus Curiae* on page 1 and ending with the last line of the “Conclusion” on page 27, contains 6,456 words, as measured by the word-processing system used to prepare this brief, in compliance with Federal Rules of Appellate Procedure 29(d) and 32(a)(7)(B).



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