

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 PRESIDENT 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, Judge Rya W. Zobel

**BRIEF OF *AMICUS CURIAE* REALNETWORKS, INC.
IN SUPPORT OF ELI LILLY & COMPANY**

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November 18, 2009

CERTIFICATE OF INTEREST

Counsel for *amicus curiae* RealNetworks, Inc. certifies the following:

1. The full name(s) of every party or *amicus curiae* represented by us is:

RealNetworks, Inc.

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

RealNetworks, Inc.

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 us are:

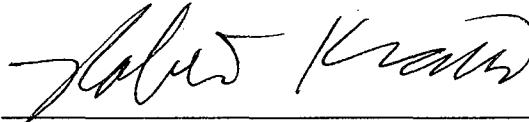
None

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

Robert F. Kramer, Howrey LLP
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Dated: November 18, 2009

Respectfully submitted,



Robert F. Kramer

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STATUTES

35 U.S.C. § 112 passim

INTEREST OF THE *AMICUS CURIAE*

RealNetworks, Inc. (“RealNetworks”) is a publicly traded technology company having offices located at 2601 Elliot Avenue, Seattle, Washington. RealNetworks provides digital music and entertainment services and products including media player software products, as well as proprietary software and servers for delivering digital media to wireless telecommunications carriers. RealNetworks is a developer of proprietary technologies and is engaged in continual innovation in audio and video streaming, download, copying, and management of digital entertainment products and services. RealNetworks owns numerous U.S. and foreign patents and pending patent applications.

RealNetworks files this *amicus* brief, in support of Defendant-Appellant Eli Lilly & Company, in response to this Court’s August 21, 2009 Order, inviting *amicus* briefs in this matter without first seeking leave of the Court.

RealNetworks has obtained consent of the parties to file this *amicus* brief, but takes no position as to the validity of Ariad’s claims.

RESPONSE TO EN BANC QUESTIONS

The Court's Order dated August 21, 2009 asked two questions, which RealNetworks answers as follows:

(1) Whether 35 U.S.C. § 112, paragraph 1, contains a written description requirement separate from an enablement requirement?

Answer: Yes, 35 U.S.C. § 112, paragraph 1, contains a written description requirement that is separate from enablement.

(2) If a separate written description requirement is set forth in the statute, what is the scope and purpose of the requirement?

Answer: The independent written description requirement protects legitimate inventions by ensuring that the inventor of patented technology was actually in possession of what he or she contends is the invention, as confirmed by a sufficient description of the invention in the specification demonstrating to a person skilled in the art that the inventor was in possession of the invention when the patent application was filed.

I. Summary Of The Argument

Long-standing precedent of the Supreme Court, Court of Customs and Patent Appeals, and Federal Circuit establishes that written description is a separate requirement from enablement under Section 112. As a general matter, enablement and written description may often rise and fall together, however, a claim may be enabled, yet the inventor may not have been in possession of what he or she later contends is the invention. A separate written description requirement balances the need to reward legitimate invention while preventing overreaching, and encouraging innovation.

II. Argument

A. Long-Standing Precedent Establishes That Written Description Is A Separate Requirement From Enablement Under Section 112

Beginning with Supreme Court cases in the early days of U.S. patent law jurisprudence, through the decisions of the Court of Customs and Patent Appeals (“C.C.P.A.”), and through this Court’s decisions, the patent laws have recognized and required an independent written description requirement. In the present case, this Court should continue the long line of precedential opinions, and clearly and finally establish that 35 U.S.C. § 112 contains a written description requirement separate from enablement.

1. The Supreme Court Has Consistently Recognized An Independent Written Description Requirement

The Supreme Court has consistently recognized the existence and importance of an independent written description requirement.¹ The Court's decision in *O'Reilly v. Morse*, 56 U.S. 62 (1854) illustrates that there has been a written description requirement apart from enablement since the mid-1800s. Indeed, the Supreme Court in *Morse* explained that many previous cases decided by our courts required patentees to fully describe their patented inventions, and that this was considered an established principle in American jurisprudence. *Id.* at 118

In *Morse*, Samuel Morse received a patent in 1840 on "Electro-Magnetic Telegraphs," which reissued in 1848.² *Id.* at 106. The Supreme Court stated that Morse's specification adequately described seven of the eight claims, but the eighth claim was overly broad and inadequately supported by or described in the patent specification. *Id.* at 112. As such, it was invalid. *Id.* Morse's eighth claim claimed "the exclusive right to every improvement where the motive power is the

¹ The Patent Act of 1793 "did require, in its 3d section, that the patent application 'deliver a written description of his invention, and of the manner of using, or process of compounding, the same, in such full, clear and exact terms, as to distinguish the same from all things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound and use the same....'" *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991) (quoting *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 430 (1822)).

² With respect to the reissue, too, the Supreme Court noted that "[t]he right to surrender the old patent, and receive another in its place, was given for the pur[p]ose of enabling the patentee to give a more perfect description of his invention, when any mistake or oversight was committed in his first." *Id.* at 112.

electric or galvanic current, and the result is the marking or printing intelligible characters, signs, or letters at a distance.” *Id.* As the Supreme Court stated, “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. The court is of the opinion that the claim is too broad, and not warranted by law.” *Id.* at 113.

The ground upon which the Supreme Court found claim 8 invalid was akin to the current 35 U.S.C. § 112 written description requirement (though based on the 1836 Patent Act), not an enablement requirement. In fact, the Supreme Court pointed out that the fifth section of the 1836 Act granted “the exclusive right of making, using, and vending to others to be used, his invention or discovery; referring to the specification for the particulars thereof.” *Id.* at 118. Moreover, the sixth section of the 1836 Act required a patentee, “before he receives a patent, he shall deliver a written description of his invention or discovery, ‘and of the manner and process of making, constructing, using, and compounding the same,’ in such exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same.” *Id.* The Supreme Court separated out the “written description” requirement from the “enablement” requirement, by its language.

The Supreme Court further explained that it was invalidating the eighth claim of Morse’s patent because he attempted to claim much more than he disclosed in the specification, to the point that it rendered the specification

unnecessary. *Id.* at 119-20 (“Yet this claim can derive no aid from the specification filed. It is outside of it, and the patentee claims beyond it. And if it stands, it must stand simply on the ground that the broad terms above-mentioned were a sufficient description, and entitled him to a patent in terms equally broad. In our judgment the act of Congress cannot be so construed.”); *see also id.* at 120 (“The words of the acts of Congress above quoted show that no patent can lawfully issue upon such a claim. For he claims what he has not described in the manner required by law.”). Thus, the Supreme Court has long recognized the existence of a requirement that the patent describe the claimed invention fully, separate from its ability to enable one skilled in the art to practice the invention.

2. The C.C.P.A., Building On Supreme Court Precedent, Has Recognized an Independent Written Description Requirement

The predecessor to the Federal Circuit, the C.C.P.A., built upon the Supreme Court’s long-standing precedent repeatedly recognizing a written description requirement separate from the enablement requirement of Section 112. The C.C.P.A.’s decision in *In re Ruschig*, 379 F.2d 990 (C.C.P.A. 1967), is a notable early C.C.P.A. enunciation of this principle.

In *Ruschig*, the C.C.P.A. addressed whether claim 13 of the patent-in-suit, directed to the chemical compound N-(p-chlorobenzenesulfonyl)-N’-propylurea, was supported by the patentee’s written disclosure. *Id.* at 991. The C.C.P.A. noted with approval the Board of Appeals’ statement that “The compound of claim 13 is not named or identified by formula and it can find support only as choices made

between the several variables involved. This is not regarded as adequate support for a specific compound never named or otherwise exemplified in the specification as filed.” *Id.* at 992; *see id.* at 993. In particular, “[s]pecific claims to single compounds require reasonably specific supporting disclosure.” *Id.* at 994. The fact that all of the compounds within the scope of the broadest claim, supported by the broad disclosure, could be listed did “not constitute support for each compound individually when separately claimed.” *Id.* Moreover, the court found it “equally easy to imagine that the compound of claim 13 might have been named in the specification,” indicating that it believed such a disclosure was necessary. *Id.* at 995.

Importantly, the court rejected the appellants’ argument that the language in 35 U.S.C. § 112 requiring enablement satisfied its duties, stating instead that “[w]hile we have no doubt a person so motivated would be enabled by the specification to make it, this is beside the point for the question is not whether he would be so enabled but whether the specification discloses the compound to him, specifically, as something appellants actually invented.” *Id.* The Court further noted that the text of Section 112 required the specification to “contain a written description of the invention.” *Id.* at 996. As the Court emphasized, the issue was whether claim 13 was described in the specification, such that those skilled in the art would understand by the information conveyed in the specification that the appellants had actually invented the compound claimed in claim 13. *Id.* Finding

no such disclosure, the Court found that claim 13 did not comply with the written description requirement of Section 112.

3. The Federal Circuit Has Consistently Recognized A Written Description Requirement Separate From Enablement

In re Ruschig is consistently cited by this Court for the proposition that Section 112 contains a separate written description requirement. In *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991), for example, this Court briefly traced the history of the independent written description requirement beginning with the early Supreme Court cases, with an eye towards clarifying the existence of the written description requirement. *See, e.g., id.* at 1560 (“before proceeding to the merits, we review the case law development of the ‘written description’ requirement with a view to improving the situation.”).

Vas-Cath involved two patents directed towards a “double lumen catheter” comprising a pair of tubes or lumens that allowed blood to be removed from an artery, processed to remove impurities, and returned close to the place of removal. *Id.* at 1557-58. The issue before the Court was whether the drawings of the design application leading to the patents-in-suit provided adequate written description under Section 112 to support the asserted claims. *See id.* at 1559. This Court accepted as a well-established principle that Section 112 contained a written description requirement, based on the statutory language, and discussed the development of the case law. *See id.* at 1560-63. The Court also discussed the policy and purpose behind the written description requirement. *See infra* at Section II.C.

This Court in *Vas-Cath* explicitly stated, based on the statutory language and underlying policies, that the written description requirement is separate and distinct from the enablement requirement. The Court also held that to the extent that a prior three-judge panel decision conflicted with this principle, the Federal Circuit in *Vas-Cath* disavowed such statements. *Id.* at 1563 (“we hereby reaffirm, that 35 U.S.C. § 112, first paragraph, requires a ‘written description of the invention’ which is separate and distinct from the enablement requirement.”). It explained that a patentee must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*,” where the invention is whatever the patentee now claims. *Id.* (emphasis in original).

B. Patent Claims May Be Enabled Without Being Adequately Described Or Ensuring Inventor Possessed What He Contends Is The Invention

Numerous Federal Circuit and C.C.P.A. decisions have recognized that it is possible for patent claims to be enabled, yet fail to meet the written description requirement. *See, e.g., University of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 921 (Fed. Cir. 2004) (“*Rochester I*”) (“Although there is often significant overlap between the three requirements, they are nonetheless independent of each other It is possible for a specification to *enable* the practice of an invention as broadly as it is claimed, and still not describe that invention.”) (internal citation omitted); *Vas-Cath*, 935 F.2d at 1561-62; *In re Barker*, 559 F.2d 588, 591 (C.C.P.A. 1977). Contrary to the dissenting opinion in *University of Rochester v. G.D. Searle & Co.*, 375 F.3d 1303 (Fed. Cir. 2004) (“*Rochester II*”) (Rader, J.,

dissenting), cases have indeed presented the situation where a claim was enabled, but not described under Section 112, and where the courts struck down the inadequately described claim as a result. In so doing, courts emphasized that the written description requirement of Section 112 ensures that inventors are in possession of what they contend is the invention, which the enablement requirement does not do. *See also, infra* at Section II.C.

In re Alonso, 545 F.3d 1015 (Fed. Cir. 2008), which was decided after *Rochester II*, is one such case where this Court affirmed the BPAI's decision that claim 92 of the patent-in-suit met the enablement requirement but was invalid for failing to meet the written description requirement. As the Court explained in *Alonso*, the "single antibody described in the Specification [was] insufficiently representative to provide adequate written descriptive support for the genus of antibodies required to practice the claimed invention." *Id.* at 1017 & 1020. Moreover, this Court affirmed the BPAI's reversal of the patent examiner's rejection of claim 92 for lack of enablement. *Id.* at 1021 n.6 ("It is true that the written description and enablement requirements usually rise and fall together. That is, a recitation of how to make and use the invention across the full breadth of the claim is ordinarily sufficient to demonstrate that the inventor possess the full scope of the invention, and vice versa. However, we have been clear that although the legal criteria of enablement and written description are related and are often met by the same disclosure, they serve discrete legal requirements. An invention

may be enabled even though it has not been described.”) (internal quotation and citations omitted).

In fact, cases decided by the Federal Circuit and the C.C.P.A. prior to *Rochester II* also have invalidated patent claims for not being adequately described in the specification, while being adequately enabled. *See, e.g., In re Curtis*, 354 F.3d 1347, 1350 (Fed. Cir. 2004) (although the examiner did not establish a prima facie case of lack of enablement, patentee was not entitled to the benefit of the earlier application filing date in any event because that application did not provide an adequate written description of the later-claimed genus of friction enhancing coatings); *In re Wertheim*, 541 F.2d 257, 263 (C.C.P.A. 1976) (“while we have no doubt a person so motivated would be enabled by the specification to make it, this is beside the point for the question is not whether he would be so enabled but whether the specification discloses the compound to him, specifically, as something appellants actually invented. We think it does not.”); *In re Ahlbrecht*, 435 F.2d 908, 911 (Fed. Cir. 1970) (finding that specification was enabled under § 112 but not properly described: “While appellant’s parent application may by reference to the copending application of Tiers contain enough to enable a person skilled in the art to make esters wherein m is 2, there is no explicit disclosure that m may be 2 or that certain starting materials from the Tiers disclosure may be used, which starting materials would ultimately lead to esters with two methylenes. That is, there is no description in full, clear, concise, and exact terms of esters wherein m is 2. The only esters described in such terms are those wherein m is 3-

12.”); *Ruschig*, 379 F.2d at 995 (“While we have no doubt a person so motivated would be enabled by the specification to make it, this is beside the point for the question is not whether he would be enabled but whether the specification discloses the compound to him, specifically, as something appellants actually invented. We think it does not.”). Thus, while enablement and written description often rise and fall together, a claim may be enabled albeit the specification may lack a description sufficiently demonstrating that the inventor was in possession of what he or she later contends is within the scope of the claimed invention.

C. A Separate Written Description Requirement Furthers The Policies and Objectives Of Our U.S. Patent System

The benefits of an independent written description requirement go to the heart of the U.S. patent system. Two such benefits are the protection of legitimate inventions by preventing overreaching by patentees, and encouraging further inventive activity by the patentee and others in the industry. The *quid pro quo* of the patent system is inextricably linked with both. See, e.g., *In re Alonso*, 545 F.3d at 1019 (“The requirement serves a teaching function, as a *quid pro quo* in which the public is given meaningful disclosure in exchange for being excluded from practicing the invention for a limited period of time.”) (quoting *Rochester I*, 358 F.3d at 922) (internal quotations omitted).

1. The Written Description Requirement Discourages Patentees From Overreaching And Protects Legitimate Invention

One purpose of an independent written description requirement is to prevent patentees from overreaching, which protects legitimate inventions. This has been

recognized repeatedly by courts. It is long-established that the U.S. patent system is meant to “‘promote the Progress of Science and useful Arts’ by rewarding innovation with a temporary monopoly.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 730-31 (2002) (citing U.S. Const., Art. I, § 8, cl. 8). If a patentee legitimately is in possession of a broad invention, then it is proper for that patentee to receive broad claims. *See In re Sus*, 306 F.2d 494, 497 (C.C.P.A. 1962) (claims must be commensurate in scope with the invention disclosed in the written description). However, he is not entitled to receive claims that are broader than the description of the invention set forth in the specification. *Id.*; *see also Morse*, 56 U.S. at 112-20 (claim 8 was invalid for overreaching).

“Adequate description of the invention guards against the inventor’s overreaching by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.” *Vas-Cath*, 935 F.2d at 1561. Moreover, a detailed written description requirement serves a broader purpose than simply how to make and use a claimed invention: it also conveys possession of the invention. *Id.* at 1563-64; *see Capon v. Eshhar*, 418 F.3d 1349, 1357-58 (Fed. Cir. 2005) (written description requirement satisfies inventor’s obligation to disclose knowledge upon which patent is based and also demonstrate possession of claimed invention); *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 972 (Fed. Cir. 2002) (Lourie, J., concurring) (“It is incorrect that the mere appearance of vague claim language in an original claim or as part of the specification necessarily satisfies the written description requirement or shows

possession of a generic invention.”); *Fiers v. Revel*, 984 F.2d 1164, 1171 (Fed. Cir. 1993) (prohibiting the patenting of merely a wish or plan as “an attempt to preempt the future before it has arrived”). By requiring a detailed description of the claimed invention, the written description requirement ensures that a patent is not viewed as “a hunting license. It is not a reward for the search, but compensation for its successful conclusion.” *Rochester I*, 358 F.3d at 930 n.10 (quoting *Brenner v. Manson*, 383 U.S. 519, 536 (1966)).

This policy is particularly germane to technology companies that are repeatedly subjected to patent infringement lawsuits in which patentees contend that they conceived and are entitled to broad patent coverage notwithstanding that a person skilled in the art can find no evidence in the specification demonstrating that the inventor was actually in possession of the “invention” when the patent application was filed. A vigorous and separate written description requirement discourages such behavior while still providing protection for those smaller inventors who legitimately possess an invention and claim what they are entitled to under the patent laws.

2. The Written Description Requirement Encourages Inventive Activity In The Field Of The Patent

A related purpose of the independent written description requirement is to encourage inventive activity by the patentee and others in the field. As the Supreme Court stated, a “monopoly is a property right; and like any property right, its boundaries should be clear. This clarity is essential to promote progress, because it enables efficient investment in innovation. A patent holder should know

what he owns, and the public should know what he does not. For this reason, the patent laws require inventors to describe their work in ‘full, clear, concise, and exact terms,’ 35 U.S.C. § 112, as part of the delicate balance the law attempts to maintain between inventors, who rely on the promise of the law to bring the invention forth, and the public, which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor's exclusive rights.” *Festo*, 535 U.S. at 730-31 (citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150 (1989)).

This policy behind requiring an adequate written description to encourage innovation has been recognized from the early days of the Supreme Court’s patent jurisprudence. In *Morse*, the Supreme Court explained that “the onward march of science” is impeded by lack of clarity and assurance that an inventor receives exclusivity only for that which he or she actually invented. *Morse*, 56 U.S. at 113. By providing clear boundaries of the patentee’s claimed invention and preventing unjustified overreaching, the patent system ensures that aspiring inventors in the same field know what they may use or manufacture without fear of suit for patent infringement. See *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 57 (1938); *Henry v. Providence Tool Co.*, 11 F. Cas. 1182, 1185 (D.R.I. 1878). Thus, others working in the field may freely pursue inventive activity in those areas not belonging to the patentee and are, in fact, encouraged to do so in the name of scientific progress.

III. Conclusion

Ariad Pharmaceuticals and the *amici* in support of Ariad have failed to

demonstrate any compelling reason to jettison long-standing precedent establishing that written description is a separate requirement from enablement under Section 112. A separate written description requirement balances the need to protect legitimate invention while preventing overreaching, and thus encouraging innovation.

Dated: November 18, 2009

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I am employed in the County of San Francisco, State of California. I am over the age of 18 and not a party to the within action. My business address is 525 Market Street, Suite 3600, San Francisco, California 94105.

On November 18, 2009, I served on the interested parties in said action the within:

BRIEF OF *AMICUS CURIAE* REALNETWORKS, INC. IN SUPPORT OF ELI LILLY & COMPANY

by placing two true copies thereof in sealed envelopes addressed as stated below and causing such envelopes to be delivered via overnight delivery by Federal Express at San Francisco, California.

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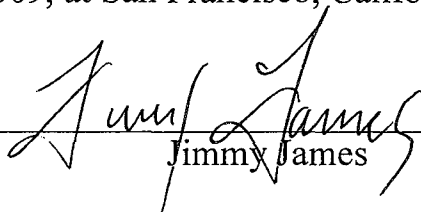
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I declare under penalty of perjury that I am employed in the office of a member of the bar of this Court at whose direction the service was made and that the foregoing is true and correct.

Executed this 18th day of November, 2009, at San Francisco, California.

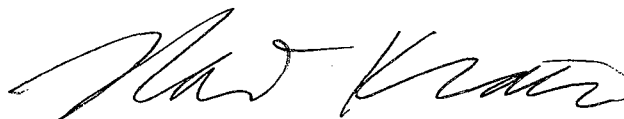

Jimmy James

CERTIFICATE OF COMPLIANCE

The undersigned counsel for *amicus curiae* RealNetworks, Inc. hereby certifies that the foregoing brief complies with the type-volume limitation set forth in Rule 32(a)(7)(B) of the Federal Rules of Appellate Procedure. Based on the word count tool in Microsoft Word 2003, the number of words in the foregoing brief, excluding the sections excludable under Rule 32(a)(7)(B)(iii) of the Federal Rules of Appellate Procedure and Federal Circuit Rule 32(b), is 3,834.

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Respectfully submitted,



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