

IN THE 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,

Defendants–Appellants.

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

BRIEF OF *AMICI CURIAE*
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CISCO SYSTEMS, INC.

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1. The full name of every party of amicus represented by me is:
Google Inc.; Verizon Communications Inc.
2. The name of the real party in interest represented by me is:
Google Inc.; Verizon Communications Inc.
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of a 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 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 *AMICI CURIAE*

Amici are innovative leaders in the high-technology and computer-related fields. Having obtained a number of patents based on their own extensive research and development efforts, and having also been improperly charged with infringing others' patented technology, *amici* have a strong interest in a fair and rational patent system. *Amici* have seen up close the important role that the written description requirement plays in reducing uncertainty and distinguishing legitimate from abusive patent applications. The Court has directed that *amicus* briefs may be filed in this case without leave of court.

INTRODUCTION AND SUMMARY OF ARGUMENT

As Chief Justice Marshall explained more than 175 years ago, “a correct specification and description of the thing discovered” is “the foundation of the power to issue the patent.” *Grant v. Raymond*, 31 U.S. (6 Pet.) 218, 247 (1832). A patent application must describe “in full, clear, and exact terms, the nature and extent of” the claimed invention, *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 435 (1822), so as to demonstrate that the applicant had actually possessed and invented it at the time the application was filed. *See O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 113 (1853). That is not a minor housekeeping matter. It is

the cornerstone of the *quid pro quo* underlying all patent rights: a patent holder is entitled to exclusivity for a period of years, but only for things the applicant actually invented and disclosed to the public.

Because the written description requirement serves the vital purpose of reducing uncertainty posed by ambiguous claims, its evisceration would stifle the very innovation the patent laws are designed to encourage. Such uncertainty creates opportunities for speculative patent litigation that plagues high-technology companies and diverts resources from research and development to legal budgets. This problem would get markedly worse if the written description requirement were eliminated. The written description requirement also provides a key statutory safeguard against abusive prosecution and continuation practices wherein patent applicants amend their claims over time to sweep in subsequent developments in the art.

The purposes of the written description requirement are not adequately served by the separate enablement requirement, in part because enablement takes account of not only the patent's specification, but also additional knowledge of a person skilled in the art. For that reason, an "invention" might be enabled by a specification even if the

patent applicant had not thought of it or intended to claim it at the time the patent application was filed.

Abolition of the foundational written description requirement would unquestionably harm innovation in the high-technology sector, and it is not necessary to protect the legitimate interests of the biotechnology sector. The requirement that inventors in any field describe what they claim to have invented is hardly unreasonable; indeed, it is fundamental to the patent bargain. In any event, even if there were a biotechnology-specific problem with the application of the written description requirement, the solution should be a case-specific one. There is no legal or policy justification for abandoning the requirement altogether for every invention in every sector.

ARGUMENT

I. Consistent With The Plain Statutory Text, The Supreme Court Has Confirmed That Section 112 Requires A Written Description Separate From Enablement.

At least as early as 1822, the Supreme Court held that a specification must include a separate written description sufficient to “put the public in possession of what the party claims as his own invention.” *Evans*, 20 U.S. (7 Wheat.) at 433-34. That description must “distinguish[] in full, clear, and exact terms, the nature and extent of [the invention].” *Id.* at 435. In the Supreme Court’s view, therefore, the written description requirement focuses on “the nature and extent” of the invention, in order to make the patent’s boundaries clear and thereby “tak[e] from the inventor the means of . . . pretending that his invention is more than what it really is.” *Id.* at 434, 435.

In *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47 (1938), the Supreme Court further explained that, because “the patent monopoly does not extend beyond the invention described . . . it cannot be enlarged by claims in the patent not supported by the description.” *Id.* at 57. In that case, where the original patent application described a combination including a *rigid* web, the Court held that an amendment claiming the combination with a *flexible* web was invalid for lack of

written description. *Id.* at 54-58. Even if the original specification enabled the use of the combination with a flexible web because a person skilled in the art would have known how to do so, the amendment was still invalid because “that was not the invention which [the patentee] described” in the specification. *Id.* at 58-59. The Court thereby made clear that the written description requirement mandates a description of the invention, separate and apart from the claims and the distinct enablement requirement.

Morse confirmed the existence of a separate written description requirement. The Court upheld most of Samuel Morse’s claims stemming from his invention of the telegraph, but held that Morse could not claim *all* uses of electric or galvanic current for marking or printing intelligible characters, signs, or letters at a distance. *Id.* at 112-113. Morse’s claim to *all* such uses, including as-yet unknown ones, covered “a manner and process which he ha[d] not described and indeed had not invented, and therefore could not describe when he obtained his patent.” *Id.* at 113. A patentee “can lawfully claim only what he has invented and described, and if he claims more his patent is void.” *Id.* at

As recently as *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002), the Supreme Court confirmed the continued existence of the separate written description requirement. The Court explained that under Section 112, Paragraph 1, “the patent application must describe, enable, and set forth the best mode of carrying out the invention.” *Id.* at 736. The Court’s use of the conjunctive to set forth three separate and distinct requirements was not accidental. It reinforces that description and enablement (and best mode) are separate statutory requirements. The Court further explained that “[w]hat is claimed by the patent application must be the same as what is disclosed in the specification; otherwise the patent should not issue.” *Id.* Importantly, the Court found this requirement to be distinct from “the other requirements”—enablement and best mode—“of § 112.” *Id.*

Ariad attempts to distinguish the first of the Supreme Court cases on point, *Evans*, as being unique to the Patent Act of 1793, under which patent claims were not required. “From 1836 onwards,” Ariad posits, “the function of defining the patented invention was assigned to claim(s), and the ‘written description’ henceforth served a single purpose: enablement.” Ariad Br. at 10. That argument fails for

numerous reasons. *First*, while *Evans* pre-dated the 1836 revision that specifically required claims, *Schriber-Schroth*, *Morse*, and *Festo* did not. *Second*, the patent at issue in *Evans* contained a written description *and* separate claims. *See* 20 U.S. (7 Wheat.) at 428. Nonetheless, the Court held, just as it later did in *Schriber-Schroth*, that the patent was invalid because the specification did not contain a separate written description that “put the public in possession of” his claimed invention. *Id.* at 433-34. *Third*, as the Supreme Court has explained, the “careful and elaborate” written description requirement of the Patent Act of 1793 was “substantially repeated in . . . the act of 1836.” *Miller v. Brass Co.*, 104 U.S. 350, 354 (1881).

Nor has there been any relevant change since that time. The current version of Section 112 provides:

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.

35 U.S.C. § 112, para. 1 (emphasis added). As Eli Lilly explains, that text breaks out written description “and” enablement (*i.e.*, how to make

and use the invention) as separate requirements, which means that the written description must contain more than enablement. *Eli Lilly Br.* 25-28. While *Ariad* complains that *Eli Lilly's* construction does not account for a comma, *see Ariad Br.* 6-7, *Ariad's* reading renders the entire italicized phrase above surplusage, contrary to settled interpretive principles. *In re Barker*, 559 F.2d 588, 591 (C.C.P.A. 1977). If the single purpose of the written description were enablement, there would be no need for the italicized phrase, because the remainder of the paragraph would require enablement without it. *Ariad's* effort to render an entire statutory phrase (including two commas) surplusage is far more significant than the grammatical nicety of where to place one comma.

It is hardly surprising that the Supreme Court and Congress have always recognized the importance of the separate written description requirement and Congress has never repealed it. The power to issue patents stems from the Constitution, U.S. Const. art. I, § 8, cl. 8, and “a correct specification and description of the thing discovered” is “the foundation of the power to issue the patent.” *Grant*, 31 U.S. (6 Pet.) at 247. Thus, the very First Congress required “a description,

accompanied with drafts or models, and explanations and models (if the nature of the invention or discovery will admit of a model) of the thing or things [claimed to be invented or discovered].” Act of Apr. 10, 1790, 1 Stat. 109-112, ch. 7, § 2. Given the foundational nature of the written description requirement, one would expect any repeal of that requirement to be clear. The requirement is too foundational to have simply atrophied *sub silentio*.

II. The Written Description Requirement Is Crucial To Preventing Patentees From Claiming What They Did Not Invent.

The Supreme Court’s longstanding precedents establish a common sense principle—patent holders’ exclusive rights should be limited to what was actually described in their patent applications. Abolishing the written description requirement would turn that principle on its head by creating perverse incentives for patent applicants to disclose narrowly and claim broadly. Freed from the constraints of a written description, savvy applicants might file applications setting forth only vague hints at an underlying invention. Then, the applicant could take advantage of the uncertainty in licensing negotiations or litigation, or could even wait to add detailed claims years later based on how the relevant market had developed over time.

Section 112 must be read in reference to the Constitution's and Congress's intent to foster innovation by rewarding disclosure, not secrecy or obfuscation. As the Supreme Court has emphasized, "[a] zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field." *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942).

While *Ariad* suggests that the written description requirement is unnecessary because patent claims themselves provide reasonable certainty, they do not. This Court has held that, while claims may not be "insolubly" ambiguous, they may permissibly give rise to "difficult issue[s] of claim construction." *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). In part because ambiguous claims are construed in light of the written description in a patent's specification, *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (*en banc*), the written description helps to put the public on notice of what a patent does and does not claim as well as what the patent holder did or did not actually invent. As the Supreme Court has noted, the "reason . . . the patent laws require inventors to describe

their work in ‘full, clear, concise, and exact terms,’ 35 U.S.C. § 112,” is that “clarity is essential to promote progress, because it enables efficient investment in innovation.” *Festo*, 535 U.S. at 730-31 (citation omitted). The written description requirement is thus an indispensable check against the uncertainty posed by ambiguous claims—uncertainty that prevents would-be innovators from determining the scope of others’ patent rights and leads to abuse of the continuation-and-amendment process.

A. The written description requirement protects against uncertainty from overbroad and ambiguous claims.

Amici have first hand experience with the problems stemming from overbroad and ambiguous patent grants. Claim ambiguity is particularly problematic in *amici’s* industry, where language is imprecise and inventors often act as their own lexicographer. *See* John R. Allison et al., *Valuable Patents*, 92 Geo. L.J. 435, 472 (2004) (noting that the boundaries of software patents can be particularly difficult to ascertain, and such patents are (unsurprisingly) “significantly more likely to be litigated than” the average patent). Software claims are often asserted broadly against products far afield from the actual invention, encompassing technologies unknown (or

unforeseen) by the inventor, and thus “preempt[ing] the future before it has arrived.” *Fiers v. Revel*, 984 F.2d 1164, 1171 (Fed Cir. 1993). In these circumstances, the Supreme Court has invoked the written description requirement to bar claims that exceeded what the inventor had actually invented and disclosed. *Morse*, 56 U.S. (15 How.) at 112-13.

Numerous ambiguous patent claims are asserted against *amici* and other high-tech companies each year. The possibility that claims would be read broadly in the absence of adequate disclosure artificially inflates the valuation of a patent. See Mark A. Lemley & Carl Shapiro, *Probabilistic Patents*, 19 J. Econ. Persp. 75, 95 (Spring 2005). Factor in the jaw-dropping number of patents confronting a would-be innovator and it becomes extraordinarily difficult to avoid patents. That impedes innovation. See Fed. Trade Comm’n, *To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy* 34, 39-40 (Government Printing Office 2003) (hereinafter “*FTC Report*”); Michael Heller, *The Gridlock Economy: How Too Much Ownership Wrecks Markets, Stops Innovation, and Costs Lives* (Basic Books 2008); Mark A. Lemley & Carl Shapiro, *Patent Holdup and Royalty Stacking*, 85

Tex. L. Rev. 1991, 1992 (2007) (citing Michael A. Heller & Rebecca S. Eisenberg, *Can Patents Deter Innovation? The Anti-Commons in Biomedical Research*, 280 Sci. 698 (1998); Carl Shapiro, *Navigating the Patent Thicket: Cross Licenses, Patent Pools, and Standard Setting*, in 1 Innovation Policy and the Economy 119, 119–23 (Adam B. Jaffe et al. eds., MIT Press 2001)). The patent clearance process is so inconclusive that, in stark contrast to matter-of-course land title insurance, the status of a product as not infringing is virtually uninsurable in any meaningful policy. *See* J. Rodrigo Fuentes, Note, *Patent Insurance: Towards A More Affordable, Mandatory Scheme?*, 10 Colum. Sci. & Tech. L. Rev. 267, 298 (2009).

Similarly, technology companies are regularly forced to defend against litigation involving patents with ambiguous claim scopes. The lack of a clear description of the claimed invention makes it difficult for parties to reach an agreement on the patent's value without litigation. Patent holders in these cases purport to own exclusive rights to concepts as generic as advertising on the Internet and processing online payments. *See* Mark Lemley, Doug Lichtman & Bhaven Sampat, *What To Do About Bad Patents?*, 28 Regulation 10, 12 (Winter, 2005-2006).

Defending litigation on ambiguous patents such as these can cost millions of dollars. *See FTC Report* ch. 3, at 2 (describing the “costly nature of litigation to invalidate these patents, both in terms of dollars and resources diverted from R&D”). The staggering costs of litigating unclear patents divert resources from innovation—the objective of the patent laws—to wasteful transaction costs.

The written description requirement is critical to mitigating those adverse consequences. To be sure, it may be difficult to map in words the boundaries of an invention. But that is a reason to require more description, not less, to support the claims. As the Supreme Court has explained, that is the very point of the written description requirement, to ensure that the patent grant does not exceed the inventor’s disclosed contribution. *See, e.g., Schriber-Schroth*, 305 U.S. at 57. There is already a serious problem with uncertainty in the scope of patent rights, and if the written description requirement were abolished, that problem would become much worse.

B. The written description requirement protects against applicants' use of amendments and continuations to claim more than they possessed when the application was filed.

The written description requirement plays an especially important role in “guard[ing] against the inventor’s overreaching by insisting that he recount his invention in such detail” in his original application that the Patent and Trademark Office (PTO), the courts, and the public can determine whether subsequently amended claims fall within the scope of the original invention. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991); *see also* Mark A. Lemley, & Kimberly A. Moore, *Ending Abuse of Patent Continuations* (George Mason Univ. Sch. of Law, Law & Econ. Research Paper No. 03-52, 2003), *available at* <http://ssrn.com/abstract=462404>.

As the Federal Trade Commission has cautioned, it has become a common practice for patent applicants to file not only an original application, but also one or more continuing applications and to argue that the filing date of the original application applies to each of the newly added or amended claims. *See, e.g., FTC Report at 40; Reiffin v. Microsoft Corp.*, No. C-98-0266, 1998 WL 397915, at *3 (N.D. Cal. July 10, 1998) (application amended 15 years later to add new claims). Some

patentees seek to secure seemingly endless continuations of applications in order to hold them open for future amendments. *See, e.g., Agilent Techs., Inc. v. Affymetrix, Inc.*, 567 F.3d 1366, 1368-69 (Fed. Cir. 2009) (claiming June 7, 1995 effective filing date for February 4, 2003 claim “through a long string of continuations”). Recent studies suggest that patents based on chains of such continuations are particularly likely to end up in litigation. *See, e.g., John R. Allison et al., Extreme Value or Trolls on Top? The Characteristics of the Most Litigated Patents* (Nov. 17, 2009), 158 U. Pa. L. Rev. 1 (forthcoming Dec. 2009) (Stanford Pub. Law Working Paper No. 1407796), *available at* <http://ssrn.com/abstract=1407796>, at 12 (noting, in a survey of heavily-litigated patents, that “the most-litigated patents made extraordinary use of patent continuations”).

Patent applicants may even argue that they are entitled to amend claims to cover competitors’ products that they learned about after filing their applications. *See Kingsdown Med. Consultants Ltd. v. Hollister, Inc.*, 863 F.2d 867, 874 (Fed. Cir. 1988). That has given rise to the increasingly serious problem of “submarine” applications, whereby applicants take advantage of the continuation and amendment process

to secure claims that were not set forth in the original application but that instead were set forth for the first time in amendments made *after* another company developed the relevant product or process. *See FTC Report* at 40; J. Thomas Rosch, Comm’r, Fed. Trade Comm’n, *Patent Trolls: Broad Brush Definitions and Law Enforcement Ideas*, Speech Before the Newport Summit on Antitrust and Economics, Newport, R.I. (May 31, 2008).

When used inappropriately, such amendments can, in effect, patent the prior art by claiming an earlier filing date that “antedat[es] patent-defeating prior art” developed between the filing of the original and amended applications. *Falko-Gunter Falkner v. Inglis*, 448 F.3d 1357, 1363 (Fed. Cir. 2006). Thus, the amendment and continuation practice, without the discipline of the written description requirement, engenders significant potential for abuse. *See* Mark A. Lemley & Kimberley A. Moore, *Ending Abuse of Patent Continuations* 13-16 (George Mason Univ. Sch. of Law, Law & Economics Research Paper No. 03-52, 2003), *available at* <http://ssrn.com/abstract=462404> (noting that “[p]ermitting patentees to change claims to track competitor’s

products invites abuse of the system” and emphasizing role of written description requirement as limitation on this practice).

As the Supreme Court confirmed in *Schreiber-Schroth*, the written description requirement is an essential check on such abuse because “the patent . . . cannot be enlarged by claims in the patent not supported by the description.” 305 U.S. at 57. The written description, in other words, is the measuring stick used to determine the legitimacy of an amended claim and to prevent “an applicant from later asserting that he invented that which he did not.” *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003). The written description requirement plays a similar role in policing priority when two parties dispute which of them is entitled to a patent on a single invention. *Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328, 1332 (Fed. Cir. 2000).

Significantly, Congress expressly relied on the written description requirement for this purpose. Claims are entitled to the filing date of a provisional application if, among other requirements, they were “disclosed in the manner provided by the first paragraph of section 112.” 35 U.S.C. § 119(e)(1). Similarly, an invention “disclosed in the manner

provided by the first paragraph of section 112” in an earlier application can be entitled to the benefit of the earlier filing date. 35 U.S.C. § 120. Congress thereby made clear that the Section 112 disclosure must be sufficient not only to enable, but also to demonstrate the scope of the patentee’s invention as of the filing of the patent application.

While some of Ariad’s *amici* argue that the written description requirement should be applied only to subsequent and not original claims, that contention only confirms the infirmity of Ariad’s position. *See, e.g.*, NYIPLA Br. 16-26. Section 112 sets forth a uniform written description requirement applicable in *all* situations. Sections 119 and 120 do not require an *additional* description; instead, they expressly cross-reference the description required by Section 112. Thus, if Section 112’s written description requirement applies to amended and other subsequent claims (which it surely does), it applies to original claims for the same textual reasons.

C. Other requirements in the Patent Act do not obviate the need for an adequate written description.

Ariad suggests that the written description requirement is not needed because the work now done by that requirement could be done by enablement or other requirements. Ariad Br. 43-49; NY Br. 19-21,

23-26. Even if Ariad were correct, that would not license the courts to ignore the clear import of the statutory text, as construed by the Supreme Court. But Ariad is not correct. The requirement that inventors describe what they claim to have invented, and thereby demonstrate that they did in fact invent it, has been “foundation[al]” ever since the First Congress. *Grant*, 31 U.S. (6 Pet.) at 247. The written description is not some dispensable collateral matter.

Indeed, enablement and written description are different concepts that do different work. If the written description requirement really added nothing to enablement, the questions presented here would not matter, and there would have been no reason for Ariad to file its en banc petition or for its *amici* to weigh in. One reason the distinction does matter is that enablement permits resort to some knowledge of persons skilled in the art that is not disclosed in the specification, whereas the written description requirement looks only to the invention disclosed in the specification. *See PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1564 (Fed. Cir. 1996). Thus, as *Schriber-Schroth* confirms, an “invention” may be enabled by a specification even if the patent applicant never thought of it and never meant to claim it,

especially in the more predictable arts such as engineering and computer programming. *See* 305 U.S. at 58-59.

Consider, for example, *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998), which held that claims to a sectional sofa were invalid under the written description requirement because the specification described a console control panel in a particular location on the sofa, whereas the amended claim moved the location of the control panel. Because there is little doubt that disclosure of the panel enabled those skilled in the art to place it in other locations, the amended claim was invalid for lack of written description, but not for lack of enablement. *See also Tronzo v. Biomet Inc.*, 156 F.3d 1154, 1158-59 (Fed. Cir. 1998) (holding that specification's disclosure of hip socket using a "conical" cup did not support amended claims that were generic as to the shape of the cup, even though a person skilled in the art would have known how to use other cup shapes).

The Patent Act, however, is not a foreseeability statute; rather, it requires that the inventor claim only what he actually invented and disclose the full scope of that invention to the public. As this Court has explained, "[a] disclosure . . . that merely renders the later-claimed

invention obvious is not sufficient to meet the written description requirement.” *Id.* at 1158.

Eliminating the written description requirement would not only place more weight on enablement than it can bear, it would also require increased reliance on Section 101’s overbreadth doctrine. Under that section, a patentee cannot patent every “substantial practical application” of a law of nature, because doing so would effectively preempt the natural law. *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972). If the written description requirement no longer protected against such overbroad claims (as in *Morse*), the *Benson* test would become far more important. That test has not always proven easy to apply, and there would be costs to overburdening that test. There is, moreover, no reason to turn to other doctrines to take the place of the foundational written description requirement. The Court should permit that requirement to continue to perform the same critical role it has for the past two centuries.

III. Any Concerns With This Court's Application Of The Written Description Requirement To Biotechnology Do Not Warrant Jettisoning The Longstanding Requirement Altogether.

While Ariad takes issue with this Court's application of the written description requirement to biotechnology, Ariad Br. 36-42, the written description requirement impacts all technology sectors, not only biotechnology. In just the last few years, this Court has held patent claims of all stripes invalid for failure to provide an adequate written description.¹

There is no justification for judicially abrogating a longstanding statutory requirement of general applicability because of the effect on a

¹ See, e.g., *In re Reiffin*, 199 F. App'x. 965, 2006 WL 2860589 (Fed. Cir. 2006) (multithreading computer application); *Adang v. Umbeck*, No. 2007-1120, 2007 WL 3120323 (Fed. Cir. Oct. 25, 2007) (transformed cotton plantlet); *Zenon Env'tl., Inc. v. U.S. Filter Corp.*, 506 F.3d 1370 (Fed. Cir. 2007) (ball bearings); *Ziarno v. Am. Nat'l. Red Cross*, 55 F. App'x. 553, 2003 WL 57060 (Fed. Cir. 2003) (internet-based fundraising system); *McMullin v. Carroll*, 153 F. App'x. 738, 2005 WL 2840281 (Fed. Cir. 2005) (golf shoe cleat); *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336 (Fed. Cir. 2005) (method for eliminating edge artifacts); *Energizer Holdings, Inc. v. ITC*, 275 F. App'x. 969, 2008 WL 1791980 (Fed. Cir. 2008) (mercury free alkaline batteries); *In re Curtis*, 354 F.3d 1347 (Fed. Cir. 2004) (dental floss); *McKechnie Vehicle Components USA, Inc. v. Lacks Indus., Inc.*, 122 F. App'x. 482, 2005 WL 121840 (Fed. Cir. 2005) (automobile wheel covering); *PIN/NIP, Inc. v. Platte Chem. Co.*, 304 F.3d 1235, 1248 (Fed. Cir. 2002) (tuber sprout growth inhibitor); *Williams v. Gen. Surgical Innovations, Inc.*, 60 F. App'x. 284, 2003 WL 932449 (Fed. Cir. 2003) (removal of tissue expander during surgery).

relatively new technology (here, biotechnology). Moreover, Ariad does not identify a single biotechnology case that it says was incorrectly decided (other than its own). Instead, Ariad acknowledges that the claims in the prior cases that it takes issue with may have been invalid, at least for lack of enablement. *E.g.*, Ariad Br. at 34-35. Judge Linn suggested that the claims at issue in this case may also be invalid for that reason. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 560 F.3d 1366, 1381 (Fed. Cir. 2009) (Linn, J., concurring). It would make little sense to abandon a longstanding and vitally important protection for the sake of the biotechnology field when that requirement has not been shown to have produced an incorrect result in *any* biotechnology case.

In any event, compliance with the written description requirement is a fact-based inquiry that will “necessarily vary depending on the nature of the invention claimed.” *Enzo Biochem Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 963 (Fed. Cir. 2002) (internal quotation omitted); *accord In re Wertheim*, 541 F.2d 257, 262 (C.C.P.A. 1976). Even if Ariad were correct that this Court’s written description jurisprudence had been too rigid for some biotechnology inventions, the solution would be to apply the requirement more contextually, on a case-by-case basis, to such

inventions—not to eviscerate completely this longstanding and foundational requirement for all inventions.

CONCLUSION

The Court should reaffirm the separate written description requirement.

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Dated: November 19, 2009

CERTIFICATE OF COMPLIANCE

I certify, pursuant to Fed. R. App. P. 32(a)(7) and the Rules of this Court, that the foregoing brief is proportionally spaced, has 14-point typeface, and contains 6,116 words.

November 19, 2009

Erin E. Morrow

CERTIFICATE OF SERVICE

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