THE “EVOLVING WRITTEN DESCRIPTION DOCTRINE” AND THE SEARCH FOR SPECIFICITY (A.K.A. ADEQUACY IS THE MATTER OF INVENTION.)

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In 1996, the U.S. Supreme Court ruled in *Markman* that claim construction was a matter of law for the judge to decide.\(^1\) There was hope in the patent bar that *Markman* would bring uniformity to claim construction and a reduction to the lengthy process of patent litigation.\(^2\) Some authors report instead that the claim construction reversal rate is increasing.\(^3\) Other authors question the consistency of

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2 Id. at 390.
the rulings from the Court of Appeals for the Federal Circuit. Circuit Judge Rader of the Federal Circuit recently named this controversy the “Evolving Written Description Doctrine.”

Behind this controversy primarily lies judicial interpretation of the patent statute, 35 U.S.C. § 112, with other statutes invoked periodically to support or counter differing opinions. These opinions suggest that the Court of Appeals for the Federal Circuit is invoking the judicial doctrine of possession to modify what the statutory requirements of enablement, best mode and definiteness. A patentee writing a broad embodiment may suffer invalidity for failing to satisfy the definiteness requirement. Conversely, an application with distinctly expressed embodiments may suffer from element exclusion and forfeit an otherwise acceptably broad embodiment.

This article reviews the back-to-back cases of JVW Enterprises, Inc. v. Interact Accessories, Inc., and LizardTech, Inc. v. Earth Resource Mapping, Inc. The subsequent en banc denial in LizardTech evoked a declaration by Circuit Judge Rader that the Federal Circuit has created an “Evolving Written Description Doctrine,” in part over the court’s invocation of the possession test. Together with a discussion of the patent law and the judicial doctrines behind it, this article seeks to show that the Court of Appeals for the Federal Circuit is misapplying judicial doctrine (notably, the possession test) and lowering the standard for when this judicial doctrine applies.

Section I provides an overview of patent law and judicial doctrines that are

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6 35 U.S.C. § 112 (1) et. seq.

7 An early invocation of possession as relating to 35 U.S.C. § 112 (1) was Application of Smith, 481 F.2d 910 (C.C.P.A., 1973). (“[A]n important purpose of § 112, first paragraph … is the definition of the attributes which a patent specification must possess as of the filing date to be entitled to that filing date as a prima facie date of invention.”) Id. at 914 (emphasis added).


11 Id. at 1378.
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applicable to the written description and claim construction. Section II discusses the factual and legal issues of the JVW and LizardTech cases. Section III discusses Circuit Judge Rader’s rationale for the “Evolving Written Description Doctrine” and the role the judicial doctrine of possession has to the “Evolving Written Description Doctrine.” Section IV concludes with commentary from the viewpoint of a practitioner examining the roles that Congress and the Federal Circuit have in promulgating the statutory requirements of 35 U.S.C. § 112 and the interpretative judicial doctrines.

II. INTRODUCTION AND BACKGROUND

A. Introduction and Role of the Written Description

1. The Statutory Basis for a Written Description

A patent application is a written document crafted to meet the legal requirements of a specification and drawings for an invention. The United States Patent and Trademark Office (“Patent Office”) reviews patent applications according to Patent Law under 35 U.S.C. § 1, et. seq., the Patent Rules, 37 C.F.R. § 1, et. seq., and the Manual for Patent Examining Procedures, a detailed guide written for examiners by the Patent Office. A drawing is often helpful to describe an invention, but pictures can show only so much. Thus, patent law requires that the specification describe the invention in writing, rather than by pictures alone. The patent rules also require drawings that show every feature of the invention specified in the claims. Only on rare occasions is a drawing sufficient to support an otherwise imprecise patent application.

2. Describing the Invention

“A patentee has the right to be his own lexicographer.” This phrase dates

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15 37 C.F.R. § 1.83(a) (2000).
17 Esnault-Pelterie v. United States, 81 Ct.Cl. 785, * (1935) *Publication page references are not available for this document. The United States Court of Claims preceded the Court of Customs and
back several decades as a judicial doctrine allowing a patentee to use words of the patentee’s own choosing to describe the invention in the specification, even if the meaning contradicts the ordinary meaning.\textsuperscript{18} Even so, patent practice is not as flexible. The patent rules require the specification to include a brief and detailed written description with drawings.\textsuperscript{19} Patent law requires the specification conclude with the claims.\textsuperscript{20} Furthermore, the specification must describe the invention “in such full, clear, concise, and exact terms, to enable any person skilled in the art . . . to make and use [the invention,] . . . and shall set forth the best mode.”\textsuperscript{21} These clauses describe the definiteness requirement, the enablement requirement and the best mode requirement, respectively. Together they serve as notice to the public of the claimed invention.\textsuperscript{22} Additionally, these clauses as a whole must meet the adequacy requirement of the specification.\textsuperscript{23}

The Person Having Ordinary Skill In The Art, often abbreviated by the letters, PHOSITA, is someone with practical experience in the field of the invention. In some fields, such a person might have practical on-the-job training, while other fields may require many years of academic and technical training.\textsuperscript{24} Lastly, the claims must “particularly point . . . out and distinctly claim . . . the subject matter which the applicant regards as his invention.”\textsuperscript{25}

3. Preventing “New Matter” From Being Claimed

The patent laws and rules also include several express requirements regarding prosecution. For instance, a patentee can rely on information in prior inventions and filed documents for the enablement requirement.\textsuperscript{26} A patentee may also rely on “incorporation by reference” for information of previously filed applications.\textsuperscript{27} The “no new matter” requirement of 35 U.S.C. § 132 limits incorporation by reference to documents known before the initial filing.\textsuperscript{28} As such, the last sentence of 35 U.S.C. § 132 expressly restricts this requirement to
amendments, i.e., documents filed during prosecution.\textsuperscript{29} The no new matter requirement also applies to documents filed before or with the application where the application relies on a patent application that did not issue until after the filing date, and were therefore unknown to a person skilled in the art at the time of filing.\textsuperscript{30}

**B. Introduction to the Claim**

1. **A Brief History of Claims**

Patent law instruction, like most modern legal instruction programs, omits historical considerations as such information is usually not legally significant. In the context of patent doctrine, a brief history of the patent claim helps explain the policy behind the doctrine.

The . . . Patent Act of 1793 did not require claims, but did require, in its 3d section, that the patent applicant “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 . . .” [The] view of this language [was] that the specification of a patent had two objects. [F]irst . . . “to enable artizans to make and use [the invention] . . . [and] second . . . to put the public in possession of what the party claims as his own invention” [It] guard[s] against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented. It is, therefore, for the purpose of warning an innocent . . . person using a machine, of his infringement of the patent; and at the same time, of taking from the inventor the means of . . . pretending that his invention is more than what it really is. [That is] . . . the patentee is required to distinguish his invention in his specification.\textsuperscript{31}

In fact, “[c]laim practice did not achieve statutory recognition until the passage of the Act of July 4, 1836, and inclusion of a claim did not become a statutory requirement until 1870.”\textsuperscript{32} As the discussion below shows, even while discussing the meaning of the claims, the basis of much of the subsequent case law focused on the discussion of the invention rather than the claims. Thus, the next one hundred years did not bring about many seminal claim related cases. One outfall of this focus on the written description is that at least one influential patent law text shows about one-third of all seminal patent cases date from after 1970, and particularly since 1996.\textsuperscript{33}

\textsuperscript{29}\textit{Id.}
\textsuperscript{30}\textit{In re Glass}, 492 F.2d 1228, 1232 (C.C.P.A. 1974) (disallowing certain patent applications filed before the patent at issue, on grounds that the patents did not issue until after the filing date, and were therefore not known to a person skilled in the art at the time of filing).
\textsuperscript{31}\textit{Vas-Cath Inc.}, 935 F.2d at 1560-61 (citing Evans v. Eaton, 20 U.S. 356, 430-433 (1822)).
\textsuperscript{32}\textit{Markman}, 517 U.S. at 379 (citations omitted).
\textsuperscript{33} The reader is directed to the highlighted cases in the Table of Cases (pp. xxvii-xliii) of CRAIG ALAN NARD ET AL., PRINCIPLES OF PATENT LAW, (2d ed. 2001).
2. Markman: Claim Construction as a Matter of Law

One of the difficulties in a patent case is deciding what the inventor considered as the invention at the time of filing the application. The judicial process of determining the meaning of the claims is “claim construction.” The technology is at times difficult for the lawyers to understand and even more so for the court. Juries struggled for years with claim construction until the U.S. Supreme Court held in Markman that claim construction was a question of law rather than a factual question for the jury. Decided now by the court as a matter of law, the judicial process of claim construction is a Markman hearing. The importance of the Markman case is both its question of law ruling and its rationale. The Court stated in Markman that claim construction, as a matter of law, is important for uniformity in patent cases.

The Court’s premise was that, “treating interpretive issues as purely legal will promote . . . intrajurisdictional certainty through the application of stare decisis on those questions not yet subject to interjurisdictional uniformity under the authority of the single appeals court.”

As the Court noted, this was the same rationale used by Congress for creating the Court of Appeals for the Federal Circuit. To this goal, the Court’s rationale was to ensure a proposed definition fully comports with the specification and claims, and avoids leaving evidentiary questions of meaning wide open in every new court in which a patent might be litigated.

3. The Fine Art of Claim Construction

Claim construction must begin with the words of the claims themselves. The court will first view the claims in the ordinary and customary meaning of a person having skill in the art at the time of invention. Complicating claim construction is that the format of the claims usually prevents an explanation in the claims of their meaning. This format often requires reliance on the written description. Both claim construction and the adequacy requirement focus on the skill of an ordinary person in the art to understand the written description. Thus, claim construction depends on the field of art and the context of the patent.

34 Markman, 517 U.S. at 391.
35 Id. at 390.
36 Id. at 391.
37 Id. at 390.
38 Id. at 390-91.
40 Phillips v. AWH Corp., 415 F.3d 1303, 1313 (Fed. Cir. 2005).
41 Id.
43 Medrad, Inc. v. MRI Devices Corp., 401 F.3d 1313, 1318 (Fed. Cir. 2005).
4. Role of the Specification to Claim Construction

While claim construction is a question of law,\textsuperscript{44} patent “compliance with the written description requirement is a question of fact”\textsuperscript{45} that “depends on what is claimed and what is described.”\textsuperscript{46} To have valid claims to different forms of the invention, the patentee must expressly claim the invention with terms that provide the broadest interpretation of invention. This makes claim construction more art than science as the court often must infer what the patentee attempts to define as the invention. The Court of Appeals for the Federal Circuit has clearly stated that each claim construction case is particular to the patent at issue rather than to judicial decisions on claim construction as a whole.\textsuperscript{47} Thus, the Court of Appeals for the Federal Circuit cautions against reading too much into claim construction from one patent to another.\textsuperscript{48}

If the specification is not clear enough, other sources are available. On the intrinsic side, the court may use the prosecution history, if any.\textsuperscript{49} If the claims are still ambiguous the court may then use dictionaries and extrinsic evidence such as treatises, and finally, expert testimony.\textsuperscript{50} Expert testimony might be used to show equivalence at the time of invention, or the time of the alleged infringement.\textsuperscript{51} The basic rule being whether a person having skill in the art of amusement rides would know of the equivalence of the claimed and accused inventions.\textsuperscript{52}

C. Patent Claims at Modern Law

1. Enablement

a. The Statutory Role

As an express component of the patent statutes, enablement was not, by that term, a hotly debated issue until recently. During the first one hundred years of patent law after claims became a statutory requirement, courts created the lexicographer doctrine\textsuperscript{53} and the prohibition against undue experimentation, which led to the non-obviousness doctrine, which became a statutory requirement in

\begin{itemize}
  \item \textsuperscript{44} Markman, 517 U.S. at 391.
  \item \textsuperscript{45} Pandrol USA, LP v. Airboss Ry. Products, Inc., 424 F.3d 1161, 1164 (Fed. Cir. 2005).
  \item \textsuperscript{46} LizardTech, 433 F.3d at 1375.
  \item \textsuperscript{47} Cybor Corp. v. FAS Technologies, Inc., 138 F.3d 1448, 1462 (Fed. Cir. 1998) (Plager, J., concurring).
  \item \textsuperscript{48} Medrad, 401 F.3d at 1318.
  \item \textsuperscript{49} Vitronics, 90 F.3d at 1582.
  \item \textsuperscript{50} Amgen Inc. v. Hoechst Marion Roussel, Inc, 457 F.3d 1293, 1301 (Fed. Cir. 2006) (quoting Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111, 1116 (Fed. Cir. 2004)).
  \item \textsuperscript{53} Esnault-Pelterie v. United States, 81 Ct.Cl. 785 (1935).
\end{itemize}
1952. Interestingly, these two judicial doctrines laid the foundation for the present-day controversy.

Even without judicial interpretation, the enablement requirement seems plain enough.

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.

As the applicable role of the judiciary is statutory interpretation, the patent bar looks to the courts for useful clarification. In fact, the leading case on enablement stated enablement as a simple requirement. “The specification contains a written description of the invention[,] which must be clear and complete enough to enable those of ordinary skill in the art to make and use it.”

b. The Judicial Role

The history of the expressions, “full, clear, concise, and exact terms,” and “to enable any person skilled in the art” shows that the written description requirement of 35 U.S.C. § 112 has not been an easy interpretation. For example, “any person skilled in the art” in the statute becomes “those of ordinary skill in the art” in judicial doctrine. Furthermore, “to enable any person skilled in the art” means “without requiring undue experimentation.” In the most succinct of explanations available, the Court of Appeals for the Federal Circuit summarized the requirement by saying, “the first paragraph requires that the specification describe the invention set forth in the claims.”

2. Definiteness

Despite the focus on the written description, in infringement litigation, “the name of the game is the claim.” While paragraph one of 35 U.S.C. § 112 requires “full, clear, concise, and exact terms of the specification as a whole,” the second paragraph of 35 U.S.C. § 112 requires that the claim shall “particularly point[] out
and distinctly claim[] the subject matter which the applicant regards as his invention."64 Thus, the claims are what determine the scope of the patent, not the rest of the specification.

Unfortunately, the Patent Office requires that a claim shall be only a single sentence describing the invention.65 Consequently, a claim is often a long run-on sentence that is contrary to the proper rules of grammar and makes claim interpretation much like reading an engineering technical manual.66 Providentially, each patent is limited to describing a single invention, and each claim is limited to describing a single embodiment of the invention.67

3. Best Mode

The best mode requirement looks at three factors. First, the specification must disclose the most useful form of the invention.68 Second, the knowledge and belief of the inventor must be the basis for this form.69 The third factor looks at the first two factors as of the filing date.70

4. The Judicial Doctrine of Possession

a. Supporting the Written Description

Possession is not a statutory requirement, but a judicial doctrine.71 As noted above, an early patent case described possession from the viewpoint of the public. "[A] patent had two objects, . . . first. . . 'to enable artisans to make and use [the

64 An important distinction is that the statutory basis for the claims is 35 U.S.C. § 112(2) (2006).
66 Fressola v. Manbeck, 1995 WL 656874 (D.D.C., 1995) (Challenging Manual of Patent Examining Procedures § 608.01(m) on grounds that the "one-sentence requirement bears no reasonable relationship to the language of and policies behind 35 U.S.C. § 112." Id at 1. Denied on grounds, "the one-sentence rule fits much more comfortably into the "procedural" box than the "substantive" one." Id. at 4.)
68 Great N. Corp. v. Henry Molded Prods., Inc., 94 F.3d 1569 (Fed. Cir. l996) (holding that the inventor cannot disclose one embodiment of the invention and refrain from disclosing the best mode for commercialization).
69 Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1049-52 (Fed.Cir. 1995) (holding that the knowledge of the assignee is not imputed to the inventor).
70 W. L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1557 (Fed. Cir. 1983) (holding that the best mode requirement applies to the inventor's knowledge as of the filing date). See also Transco Products Inc. v. Performance Contracting, Inc., 38 F.3d 551, 556-559 (Fed. Cir. 1994) (holding the relevant date for evaluating a best mode disclosure in continuation practice is the date of the parent application and citing Dow Chemical Co. v. American Cyanamid Co., 615 F.Supp. 471, 482, 229 U.S.P.Q. 171, 179 (E.D. La. 1985), aff'd, 816 F.2d 617 (Fed. Cir. 1987), cert. denied, 484 U.S. 849 (1987) (holding the appropriate date for determining compliance with the best mode requirement for a reissue application is the filing date of the original application and not that of the reissue application)).
71 "The courts have described the essential question to be addressed in a description requirement issue in a variety of ways." Manual of Patent Examining Procedures §2163.02 (8th ed. rev 5 2006). 
72 "[T]o satisfy the written description requirement, an applicant 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, and that the invention, in that context, is whatever is now claimed." Id. (citing Vas-Cath, Inc. v. Mahurkar, 955 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991)).
invention]’ . . . [and] second . . . ‘to put the public in possession of what the party claims as his own invention.’”\(^\text{72}\)

Then, in 1991, possession took on another meaning. In Vas-Cath, the Court of Appeals for the Federal Circuit tried to argue a dichotomy in the court over the roles of enablement and the written description with this statement. “[T]he applicant 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.”\(^\text{73}\)

In doing so, the court seemingly created a new doctrine that required, as of the filing date, the applicant (i.e., the application) used “reasonable clarity,” to inform the person having ordinary “skill in the art,” of the invention.\(^\text{74}\) The problem here is that the enablement requirement requires that the written description is clear and complete enough to enable those of ordinary skill in the art to make and use it.\(^\text{75}\) By including the phrases, “with reasonable clarity,” and “skilled in the art” with the word possession, the Court of Appeals for the Federal Circuit created a new doctrine (test) of possession without answering the question of how enablement relates to the written description.\(^\text{76}\) Focused still on the confusion over enablement and the written description, the court sought to clarify the matter. “There appears to be some confusion in our decisions concerning the extent to which the ‘written description’ requirement is separate and distinct from the enablement requirement. The purpose of the written description requirement of section 112, first paragraph is to state what is needed to fulfill the enablement criteria.”\(^\text{77}\) While perceiving the confusion as between enablement and the written description, the court added a new doctrine of possession for supporting the written description requirement.

With uncertainty still reigning several years later, the court again attempted to make a distinction. “[T]here is no question that . . . written description and enablement are separate statutory requirements, and that written description is not simply a facet of enablement.”\(^\text{78}\) Not only did the court not clarify the requirements of written description and enablement, the court again failed to define what it meant by possession. Fortunately, a review of applicable case law shows that there are three facets to possession. These are the filing date, the scope of enablement, and predictably of the art.

b. The Filing Date

Patent applications often rely on earlier applications to take advantage of the earlier filing date to pre-date prior art.\(^\text{79}\) Such instances also occur in division or

\(^{72}\) Vas-Cath, 935 F.2d at 1560-61 (citing Evans, 20 U.S. at 430-33 (1822)).

\(^{73}\) Id. at 1563-64 (emphasis added).

\(^{74}\) Id.


\(^{76}\) Vas-Cath, 935 F.2d at 1563-64.

\(^{77}\) Vas-Cath, 935 F.2d at 1563 (emphasis added).


\(^{79}\) Application of John P. Glass, 492 F.2d 1228, 1233 (C.C.P.A. 1974) (possession applied to growth of crystals seeking earlier filed patent applications as enabling art). Tronzo v. Biomet, Inc., 156
c. Scope of Enablement

The scope of enablement facet of possession is likely what contributed to the confusion with the enablement requirement. The scope of enablement delineates whether what the inventor later claims as invented (i.e., in litigation) is a defined embodiment of the disclosure, claims and prosecution history.85 By scope of enablement, possession means a claim may not be vague or read as broader than the supporting disclosure.86

In Enzo Biochem, the court looked at whether the written description on the activity levels of the claimed nucleotides supported the claimed bacteria detection inventions.87 While the written description reported in an activity level of greater than five, some of the claims had much higher activity levels, and other claims referred to the inventions Enzo Biochem had deposited with a public organization.88 In a case of first impression, the court stated that “the mere appearance of vague claim language in an original claim or as part of the specification [does not] necessarily satisfy the written description requirement or show[] possession of a generic invention.”89 At least for the then new field of

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80 Division practice refers to the splitting of one application containing two or more inventions into multiple applications. 35 U.S.C. § 121 (2006). Continuation practice refers to the filing of an application to supplant an earlier application. 37 C.F.R. § 1.114 (2007).
81 Bilstad v. Wakalopulos, 386 F.3d 1116, 1123 (Fed. Cir. 2004) (citing Eiselstein v. Frank, 52 F.3d 1035, 1039 (Fed. Cir. 1995)).
84 Application of Edwards, 568 F.2d 1349, 1351 (C.C.P.A. 1978) (Reversing a rejection for inadequacy on grounds that an earlier application relied on as a reference did not provide an adequate descriptive for the make and use requirement of 25 U.S.C. § 112 para. 1). Said another way: “[T]hat requirement evidences appreciation of an important purpose of § 112, first paragraph, which is the definition of the attributes which a patent specification must possess as of the filing date to be entitled to that filing date as a prima facie date of invention.” Application of Smith, 481 F.2d 910, 914 (C.C.P.A. 1973) (holding that the how-to-use requirement was satisfied where there was no basis upon which to question use of all polymers within claimed genus, and where scope of genus was commensurate with specification disclosure).
85 Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1476 (Fed. Cir. 1998) (citing Markman, 52 F.3d at 979-81 (en banc), aff’d, 517 U.S. 370 (1996)).
86 Id. at 1473 (holding the location of controls as limited to the console as “[n]o similar variation beyond the console is even suggested”).
87 Enzo Biochem, 285 F.3d at 960-62.
88 Enzo Biochem, 285 F.3d at 962.
89 Enzo Biochem, 285 F.3d at 972 (holding that “reference in the specification to a deposit in a
genetic engineering, the court held that "[i]nventions that cannot reasonably be enabled by a description in written form in the specification, but that otherwise meet the requirements for patent protection, may be described in surrogate form by a deposit that is incorporated by reference into the specification."  

In Enzo Biochem, the Court of Appeals for the Federal Circuit effectively upheld the possession requirement in a case that did not involve priority. In a harbinger of the 2005-2006 cases discussed below, the Enzo Biochem dissent questioned the court’s decision not to hear the case en banc, as well as the court’s use of the possession test.

d. Predictability of the Art

The last facet of possession is whether the written description adequately discusses the claims for a person having skill in the art to understand all details of all embodiments in sufficient detail without undue experimentation, what the Court of Appeals for the Federal Circuit has called "predictability of the relevant art." In fact, the Court of Appeals for Federal Circuit has applied the possession doctrine almost exclusively to the complex, high-technology cases in the fields of material science, chemistry and biology, where the state of the art is rapidly changing. In these fields, a broadly-defined invention called the genus includes one or more narrowly-broadly defined inventions called the species. Such inventions are common in genetic engineering.

Predictability looks beyond the written description to the knowledge of the person having skill in the field of science. This allows a patentee to rely on the knowledge of peers to understand how to make and use the invention. In this respect, the patentee can focus on the invention while expending less effort and

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90 Enzo Biochem, 285 F.3d at 966.
91 Id. at 960.
92 Id. at 988 (Linn, J., dissenting).
93 Plant Genetic Systems, N.V. v. DeKalb Genetics Corp., 315 F.3d 1335, 1340 (Fed. Cir. 2003) (citing In re Vaeck, 947 F.2d 488, 495 (Fed. Cir.1991)).
96 Capon v. Eshhar, 418 F.3d 1349, 1357 (Fed. Cir. 2005) (possession applied to genetic engineering). See also In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991) (The application at issue was titled, "Hybrid Genes Incorporating a DNA Fragment Containing a Gene Coding for an Insecticidal Protein, Plasmids, Transformed Cyanobacteria Expressing Such Protein and Method for Use as a Biocontrol Agent").
97 Chiron Corp. v. Genentech, Inc., 363 F.3d 1247, 1253 (Fed. Cir. 2004) (citing AK Steel Corp. v. Sollac, 344 F.3d 1234, 1244 (Fed. Cir. 2003)).
funds documenting the knowledge of the person having ordinary skill in the art.\footnote{Whether billed by the hour or by the page, patent applications are time consuming and usually long. Applicants often file Information Disclosure Statements to separately provide that state of the art knowledge. On a related, but opposite side of the patenting coin is the Winslow test for obviousness. "[P]icture the inventor as working in his shop with the prior art references – which he is presumed to know – hanging on the walls around him." \textit{In re} Winslow, 365 F.2d 1017, 1021 (CCPA 1966) (Rich, J.)} For example, in \textit{Bilstad v. Wakalopulos}, Bilstein’s application related to an “apparatus for sterilizing three-dimensional objects using ionizing radiation without affecting the target objects in a deleterious manner.”\footnote{\textit{Bilstad}, 386 F.3d at 1118 .} At issue was whether the patent application had to “describe every embodiment within the range of two to infinity to support the count.”\footnote{\textit{Id.} at 1123.} The Court of Appeals for the Federal Circuit found that the Board of Patent Appeals and Interferences had not considered: “[W]hether [the] disclosure of manipulation in a small number of directions would reasonably convey to a person skilled in the relevant art that Bilstein had possession of manipulation in a plurality of directions as of his filing date.”\footnote{\textit{Id.} at 1126.}

The Court of Appeals for the Federal Circuit therefore vacated the judgment of the Board of Patent Appeals and Interferences and remanded for further proceedings.\footnote{\textit{Id.} at 1127.} The court’s rationale was that not every specification needs the complete detail of every embodiment in the specification.\footnote{\textit{Id.} at 1123-24 (citing \textit{In re Smythe}, 480 F.2d 1376, 1382 (C.C.P.A. 1973)).} This view does not apply to genetic engineering, where a description of a single species is insufficient for a claim to the genus, or for a description of the genus to claim the species, without a description of the species in the specification.\footnote{Regents of the Univ. of California v. Eli Lilly \& Co., 119 F.3d 1559, 1567 (Fed. Cir. 1997).}


The purpose of the written description analysis is to confirm that applicant had possession of what is claimed. The Guidelines . . . instruct the examiner to look for consistency between a claim and what provides adequate factual support for the claim as judged by one of ordinary skill in the art from reading the corresponding written description.

To assure the reader that the possession versus enablement confusion is still not yet corrected, the Patent Office provides this clarification: “The written description requirement, a question of fact, ensures that the inventor conveys to others that he or she had possession of the claimed invention; whereas, the enablement requirement, a question of law, ensures that the inventor conveys to
others how to make and use the claimed invention."106

In all, perhaps the best explanation this author found is still from the 2003 Amgen Court:

The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not: the applicant for a patent is therefore required to "recount his invention in such detail that his future claims can be determined to be encompassed within his original creation."107

While this is not the last word on the possession test in this article, the discussion of the evolution of the possession test is sufficient to introduce the Evolving Written Description Doctrine.

III. THE BACKGROUND CASES

A. Introduction to the Evolving Written Description Doctrine

In January 2006, Circuit Judge Rader dissented in the rehearing denial of LizardTech, Inc. v. Earth Resource Mapping, Inc., with an admonishment of the Court of Appeals for the Federal Circuit for making what were, in his view, two contradictory rulings.108 In October 2005, a panel of the court had held in JVW Enterprises, Inc. v. Interact Accessories, Inc.,109 that the claims can be broadly read to include an embodiment even if the embodiment is not expressly supported by the specification.110 The next day, a panel of different judges held in LizardTech that a claim is invalidated if all elements are not supported by the specification.111 On appeal by LizardTech for a re-hearing, the en banc court affirmed.112 In dissent to the en banc decision, Circuit Judge Rader called the court to task for allowing the JVW patentee to assert an embodiment the specification did not describe, while the court invalidated a claim that prevented the LizardTech patentee from doing the same thing.113 Circuit Judge Rader called this apparent inconsistency the "evolving written description doctrine."114 A minimally technical review is warranted as the art and facts of these cases are sufficiently different to affect the arguments.

107 Amgen Inc. v. Hoechst Marion Rousse, Inc., 1314 F.3d 1313, 1330 (Fed. Cir. 2003) (citing Vascath Inc. v. Mahurkar, 935 F.2d 1555, 1561 (Fed. Cir. 1991)).
108 LizardTech, 433 F.3d at 1376.
110 LizardTech, 433 F.3d at 1376.
111 LizardTech, 424 F.3d at 1336.
112 LizardTech, 433 F.3d at 1376.
113 Id. at 1377.
114 Id. at 1377.
B. JVW and the Imported Function Doctrine

1. The Patent at Issue: U.S. 4,494,754

JVW owns United States Patent No. 4,494,754\(^{115}\) for an I-beam shaped device used for holding a video game controller.\(^{116}\) The invention relieves the user from having to manually hold the game controller during play. The patent claims an upper horizontal platform to hold the game controller that includes a “means for lockably receiving a video game controller in fixed position” on a mounting member.\(^{117}\) The patent claims both the video game controller holder, and ways of using the video game controller holder.\(^{118}\) While there are several drawings in the patent, every drawing shows the invention holding the same Atari joystick controller with the embodiments differing by how the user sat with the invention.

2. Claim Construction and the District Court Ruling

a. Claim Construction

JVW sued Interact, a video game device manufacturer, for infringement by the Interact V3 and V4 steering wheel video game controllers.\(^{119}\) One point of contention in this case is that the patent shows an external holder for a video game controller, while the accused devices are video game controllers.\(^{120}\) In the patent, the “means” shown “for lockably receiving a video game controller in fixed position” are four flexible L-shaped clips outside the video game controller shown in the drawing.\(^{121}\) In its claim construction ruling, the district court considered this arrangement of the clips and the controller a necessary “interlacing,” but acknowledged that the game controller was not part of the invention.\(^{122}\)

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\(^{116}\) U.S. Patent No. 4,494,754, Fig. 1 and 2.

\(^{117}\) U.S. Patent No. 4,494,754, Col. 4, ll. 1-2 and ll. 33-35. “Mounting member” refers to the upper flat portion of the I-shaped invention. This is a classic “means-plus-function” claim under 35 U.S.C. § 112, para. 6 (2006). The claim must describe a function of the invention, and provide an element in the invention to perform that function.

\(^{118}\) Independent claims 1 and 5 provided different embodiments for the user to kneel or sit on the lower horizontal platform. U.S. Patent No. 4,494,754, Col. 3. ll. 47-48 (Claim 1), and Col. 4 ll. 27-29 (Claim 5), and Col. 3, ll. 17-27 (describing Figures 4, 5 and 6.) Any use of the patented invention without a license is an infringement of the invention, 35 U.S.C. § 271 (2006). One goal of a patent is to provide as many variations of the invention as possible to provide protection for different uses. Claims for making or using an invention are best suited where the invention is not patentable for some reason. The issue in JVW is ironic in that the patent provides fewer embodiments of the invention holding the game controller than how the user is positioned for holding the invention.

\(^{119}\) JVW Enters., 424 F.3d at 1327.

\(^{120}\) See Figure 1 below for a side by side comparison.

\(^{121}\) U.S. Patent No. 4,494,754, figs. 2 and 3, col. 2, ll. 39-45, col. 3. l. 50 col. 4. l. 2, and col. 4. ll. 33-35.

\(^{122}\) JVW Enters., 424 F.3d at 1328 (citing JVW Enters., Inc. v. Interact Accessories, Inc., No. 00-CV-1867 (D. Md. May 9, 2002) (“Supplemental Memorandum and Order Re Patent Claim Construction”). There is disagreement in the patent bar, and on the bench, whether the accused product has a role in claim construction. Some courts perform claim construction ‘blind’ to the features of the
In the Interact models, the allegedly infringing clips are inside the housing of the video game controller.\(^{123}\) For JVW to succeed in its infringement action, JVW would have to prove that the Interact models infringe the patent by using identical or similar clips and that whether the clips were inside or outside the housing is irrelevant.\(^{124}\)

Another claim construction issue was the district court’s interpretation of “in fixed position” and “means for lockably receiving” to require the invention to lock and unlock the controller in position.\(^{125}\) The specification lacked an express statement of how to remove the controller so the district court viewed the clips as immovable unless removed.\(^{126}\) In addition, the district court interpreted the pronounced horizontal portions of the L-clips as restraining the controller vertically as well as from side to side.\(^{127}\)

b. Holding by the District Court

One aspect that distinguishes the V3 and V4 video game controllers are the separable shells that move the clips away from the steering wheel to unlock and adjust the video game controller.\(^{128}\) Since this made the clips movable, the district court held there was no infringement as the V3 and V4 video game controllers lacked the interlace structure and the immovable function of the patented device.\(^{129}\)

3. Errors by the District Court

On appeal by JVW, the Court of Appeals for the Federal Circuit (2005) agreed that the “means for lockably receiving” claim was a valid means plus function claim.\(^{130}\) The court held though, that the district court’s claim construction violated two rules of means plus function interpretation.\(^{131}\) First, “a court may not construe a means-plus-function limitation ‘by adopting a function accused product.\(^{123}\) Id. at 1327 ("The V3 utilizes plastic clips mounted inside a shell that surrounds a steering wheel column.").

\(^{124}\) Markman, 517 U.S. at 374 ("Victory in an infringement suit requires a finding that the patent claim ‘covers the alleged infringer's product or process.’"); JVW Enters., 424 F.3d at 1333 ("The fact that the V3 adds a shell to allow the steering wheel height to be adjusted and a cam mechanism to provide a mechanical way to tighten and loosen the clips does not mean that the clips do not lock the steering wheel in a fixed position.").

\(^{125}\) JVW Enters., 424 F.3d at 1328 (citing JVW Enters., Inc. v. Interact Accessories, Inc., No. 00-CV-1867 (D, Md. Feb. 1, 2002) ("Memorandum and Order Re Patent Claim Construction").

\(^{126}\) JVW Enters., 424 F.3d at 1329.

\(^{127}\) Figures 1, 2 and 3 show controller holders 21-24 in the same L-shape pattern and same 4-side configuration. This is the only, and stated, preferred embodiment of the invention. U.S. Patent No. 4,494,754, col. 3, ll. 28-36.

\(^{128}\) JVW Enters., 424 F.3d at 1329.

\(^{129}\) Id. at 1329.

\(^{130}\) Id. at 1329 ("The parties agree, as do we, that "means for lockably receiving a video game controller in fixed position on said mounting member" is a means-plus-function limitation recognized by 35 U.S.C. § 112, ¶ 6."). A means plus function claim allows a patentee to claim multiple embodiments through a specific format. 35 U.S.C. § 112 para. 6 (2006).

\(^{131}\) "The first construction violated two tenets governing the determination of function in a means-plus-function limitation." Id. at 1331.
different from that explicitly recited in the claim." The court found that the district court had confused the separate functions of "fixed position" and "lockably receiving." The claims do not require the invention to both hold in place and unlock the video game controller. Thus, the district court erred in finding an interlacing of parts to lock and unlock the controller.

The second rule is that a court may not "import[,] the functions of a working device into the . . . specific claims," but must "read[] the claims for their meaning independent of any working embodiment." The court found that the district court had read into the claims a function for the L-shaped controller holders to "lock a controller into a fixed position by preventing linear, up and down movement of the [controller]." However, the claimed function is only to "lockably receiv[e] a video game controller in fixed position," without regard to the direction of how the clips kept the controller from moving. The limitations imbued by the district court were merely functions of the separate structural elements present in the preferred embodiment to facilitate the claimed function to "lockably receiv[e] a video game controller in fixed position." Since these were not claimed functions, the district court erred in requiring them. The invention merely has to lock the controller in place, irrespective of the direction of limited motion.

4. Infringement Analysis

With a crucial exception, the Interact V3 and V4 video game controllers are quite alike. The V3 has L-shaped clips that surround the steering wheel column while the V4 has a donut shaped plate. The Court of Appeals for the Federal Circuit (2005) found that the L-shaped clips on the accused V3 product performed the same function and were identical or equivalent to the L-shaped clips of the patent, and thus, the V3 model infringed the patent.

With its donut-shaped plates surrounding the metal shaft, the V4 locks the controller from rotational motion rather than locking the controller from horizontal and vertical motion. Thus, the V4 did not infringe the patent as "the structures clearly perform the claimed function in substantially different ways." Interact argued for non-infringement on grounds that the video game

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132 JVW Enters., 424 F.3d at 1331 (citing Micro Chem., Inc. v. Great Plains Chem. Co., 194 F.3d 1250, 1258 (Fed. Cir. 1999)).
133 JVW Enters., 424 F.3d at 1331 ("In its first construction the district court impermissibly added unclaimed functional limitations of "unlocking" and "releasing" the video game controller.").
134 Id. at 1330.
135 Id. at 1331 (citing Rodime PLC v. Seagate Tech., Inc., 174 F.3d 1294, 1303 (Fed. Cir. 1999)).
136 JVW Enters., 424 F.3d at 1335.
137 U.S. Patent No. 4,494,754 col. 3 l. 50-col. 4 l. 2, col. 4 ll. 33-35.
138 U.S. Patent No. 4,494,754 col. 3 ll. 28-36.
139 U.S. Patent No. 4,494,754 col. 3 l. 50, col. 4 l.2, col. 4 ll. 33-35.
140 JVW Enters., 424 F.3d at 1331.
141 JVW Enters., 424 F.3d at 1333.
142 Id. at 1335.
143 Id. at 1335 (citing Odetics, Inc. v. Storage Tech. Corp., 185 F.3d 1259, 1267 (Fed. Cir. 1999)).
controllers are not intended “for playing a video game without any additional accessory,” while the only embodiment shown in the patent is a holder of video game controllers. The court disagreed, saying it “would be improper” to “import limitations into claims from . . . embodiments appearing only in a patent’s written description . . . unless the specification makes clear that “the patentee . . . intends for the claims and the embodiments in the specification to be strictly coextensive.”

The court opined that “after reviewing the specification, we conclude that the patentee did not intend for the claims and the embodiments disclosed in the specification to be coextensive.” This meant the court was willing to accept a broad view of the claims even though the written description did not support such a view because the patent did not express the narrow view argued by Interact. The reader may note the court reversed the district court’s construction for interlacing and directionally applied locking for the same reason. While the opinion did not expressly state to what part of the specification the court was referring to, this author believes the court merely compared Figure 5 to the Interact video game controllers. This author prepared such a comparison, which is Figure 1 below this section. The reader will likely note the striking similarities.

5. Discussion and Summary on JVW

There are two problems with the court’s decision. For one, the holding of infringement by the V3 ignores that the court went inside the V3 to find the infringing L-clips. Logically, a video game controller cannot infringe a device intended to hold the video game controller. This is analogous to looking inside the Atari controller shown in the drawings and finding infringement. This is the prior art-infringement dichotomy of “that which infringes if later, would anticipate if earlier.” As such, the court could have affirmed the district court holding of non-infringement, and invalidated the patent as anticipated by the Atari controller.

The second problem is the court’s finding of the V3 as infringing, but the V4 as not infringing. The court described the patented invention as one which “the player may sit or kneel on the base of the accessory with his or her legs on either side of the riser,” [with] “the controller [] held in place by the controller holders and stabilized using the player’s weight.” As noted above, the court apparently saw the striking similarity of the V3 to the JVW patented invention. As a matter of law, the finding of infringement is consistent with the purpose of the means-plus-function limitation and the doctrine of equivalents to prevent such subversion of

144 Id. at 1335.
145 Id.; see also Phillips, 415 F.3d at 1323 (en banc).
146 Id. at 1335.
147 Id. at 1331 (citing Rodime PLC v. Seagate Tech., Inc., 174 F.3d 1294, 1303 (Fed. Cir. 1999)).
149 We can only speculate what might have happened had the same panel judges as LizardTech made the decision.
150 JVW Enters., 424 F.3d at 1327 (citing U.S. Patent No. 4,494,754 col.3 ll.13-28, col.1 ll.42-47).
patented ideas by insubstantial differences. A finding of non-infringement by the V3 would allow the wholesale copying of patented devices.

The finding of non-infringement for the V4 model is somewhat perplexing. The two models are identical except for the ability of the V4 to “lock a controller into a fixed position by preventing rotational movement of the steering wheel unit on the shaft.” The JVW patent does not claim a limitation to only “lock a controller into a fixed position by preventing linear, up and down movement of the steering wheel column.” This is the limitation of the preferred embodiment L-clips, shown for “lockably receiving [an Atari] video game controller in fixed position.” The court said that the district court erred by imputing a strict locking function of the L-clips to the patented invention. Yet, the court distinguished the linear locking function of the patented invention as justifying non-infringement by the V4. If the court can see through the distinction that Interact copied the whole of the JVW patented device for the V3, why did the court not see that the donut-shaped plates of the V4 were merely a means for “lockably receiving [the Interact V4] video game controller in fixed position?”

![Figure 1. Comparative Diagram of JVW and Interact V3](http://ec1.images-amazon.com/images/P/B00000JDDY.01._SS500_SCLZZZZZZZ_.gif)

U.S. Patent No. 4,494,754 figure 5 compared the Interact V3 (Image ©Amazon.com)

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151 Id. at 1333 (citing Odetics, 185 F.3d at 1267).
152 Id. at 1335.
153 Id. at 1335.
154 U.S. Patent No. 4,494,754 col. 4 ll. 1-2.
156 Id.
157 Id.
158 U.S. Patent No. 4,494,754 fig. 5.
C. LizardTech And The Possession Test


LizardTech, Inc. is the exclusive licensee of U.S. Patent No. 5,710,835 (issued January 20, 1998) for use of a set of mathematical formulas in software, called Digital Wavelet Transform algorithms, which compress digital images without creating fuzzy edges. If the reader were to look at the software code that makes a digital image, the reader would find many rows and columns of digital data, as if looking at a giant Sudoku puzzle. The LizardTech patented method mathematically divided the image into a mosaic of digital tiles before running the non-patented software algorithms. LizardTech alleged infringement by the competing Earth Resource Mapping (ERM) method (“ER Mapper”), which ran each individual row and column of digital data through the non-patented software algorithms.

2. Claim Construction Issues

The parties litigated the patent through two hearings and three appeals without going to trial. The first hearing related to claim construction of the term “tile” as used in the patent. The district court (in 2000) held that the LizardTech tile method did not include the single pixel row method used by ERM and granted summary judgment to ERM for non-infringement. On appeal by LizardTech (in 2002), the Court of Appeals for the Federal Circuit reversed this claim construction, and rejected alternative arguments by ERM that the terms “selected sequence” and “maintaining updated sums” excluded the ER Mapper method. Even so, the appeal ruling did not help LizardTech. On remand, the district
court (2004) construed “seamless” such that the ER Mapper method did not follow the same steps as the patented method. Additionally, the district court construed that the terms “overlapping” and “maintaining updated sums” excluded the ER Mapper method. Thus, “the district court held on summary judgment that ERM did not infringe claims 1 and 13 of the ‘835 patent.”

3. **Invalidation for Lacking Possession**

Claims 1 and 21 were very similar, and would have been identical, except that claim 21 lacked the terms, “maintaining updated sums,” “periodically compressing said sums” and “seamless.” This difference in the claims is acceptable as long as the claims can be read to refer to different inventions, i.e., claim 21 cannot be the same invention as claim 1.

Thus, the district court viewed claim 21 as referring to a non-seamless process. The district court also viewed the written description as explaining the workings of a seamless process, but not explaining a non-seamless process. The court held that a person having ordinary skill in the art would not understand how to make and use the non-seamless invention. For this reason, the district court held claim 21 and its dependent claims as indefinite and invalid.

On appeal (2005), LizardTech had a two-fold problem. One problem was that LizardTech could not argue that claim 21 impliedly included all three missing elements, as then claim 21 would be the same as claim 1 and still invalid. To avoid this interpretation, LizardTech argued that based on the entire specification, an ordinary person skilled in the art would understand that the seamless process applied also to claim 21.

Citing the prosecution history, the Court of Appeals for the Federal Circuit (2005) agreed with LizardTech.

There still remained the problem of claim 21 lacking the elements of “maintaining updated sums” and “periodically compressing said sums.” For claim 21 to be valid, LizardTech had to show the claim could be read to perform a seamless process without use of “maintaining updated sums,” and “periodically compressing said sums.” The next step is looking to the patent for such “full, clear, concise, and exact terms as to enable any person skilled in the art,” how to

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171 Id. at 1342-43. See also, Vitronics, 90 F.3d at 1582 (holding that a patentee cannot construe a term to have different meanings in different claims) (citing Hoescht Celanese Corp. v. BP Chem. Ltd., 78 F.3d 1575, 1578 (Fed. Cir.), cert. denied, 117 S.Ct. 275 (1996).
172 Id. at 1340-41.
173 Id. at 1343 (citing U.S. Patent No. 5,710,835).
174 Id.
175 Id.
176 LizardTech, 424 F.3d at 1343.
177 LizardTech, 424 F.3d at 1343.
178 Id. at 1343.
179 Id. See e.g., Phillips, 415 F.3d at 1315 (en banc).
180 LizardTech, 424 F.3d at 1343.
181 Id. at 1344.
make and use the invention.\textsuperscript{182} There, the court found a problem. The “specification provides only a single way of creating a seamless [process], which is by maintaining updated sums. There is no evidence that the specification contemplates a more generic way of creating a seamless [process].”\textsuperscript{183}

As this point, the court had clear precedent to invalidate claim 21 based on the §112(1) enablement clause.\textsuperscript{184} The court showed this understanding in two ways. For one, the court cited another enablement case that proved its point.\textsuperscript{185} Second, the court reiterated enablement as the reason for invalidation. “After reading the patent, a person of skill in the art would not understand how to make a seamless [process] generically and would not understand LizardTech to have invented a method for making a seamless [process], except by ‘maintaining updating sums.’”\textsuperscript{186}

Instead, the court oddly diverged into the best mode requirement, mixed in the enablement clause and invoked an old quid pro quo case.\textsuperscript{187} As though to justify this mix, the court then once again linked the enablement clause to the possession doctrine. “Those two requirements usually rise and fall together. [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 possesses the full scope of the invention, and vice versa.”\textsuperscript{188}

As noted above, the possession test has previously been held only to complex, high-technology subject matter in the material science, chemistry and biological arts.\textsuperscript{189} Here, the court held the possession test to a software patent, which has not before been subjected to the possession test. In addition, with apparent knowledge and disregard, the court resurrected the pre-Vas-Cath enablement-possession confusion.\textsuperscript{190}

Whether the flaw in the specification is regarded as a \textit{failure to demonstrate that the patentee possessed the full scope of the invention recited in claim 21} or a \textit{failure to enable the full breadth of that claim}, the specification provides inadequate support for the claim under section 112, paragraph one.

This statement suffers three problems. First, the court failed to keep written description and enablement separate as stated by the \textit{Moba} court.\textsuperscript{191} Second, the court failed to provide an interpretation of the judicial and statutory policies the

\begin{footnotesize}

\textsuperscript{182} Id (citing 35 U.S.C. § 112 (2006)).

\textsuperscript{183} \textit{LizardTech}, 424 F.3d at 1344.

\textsuperscript{184} The written description shall provide “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 make and use the same.” 35 U.S.C. § 112, para. 1 (2006).

\textsuperscript{185} \textit{LizardTech}, 424 F.3d at 1345 (citing AK Steel Corp. v. Sollac & Ugine, 344 F.3d 1234, 1244 (Fed. Cir. 2003)).

\textsuperscript{186} \textit{LizardTech}, 424 F.3d at 1345 (emphasis added).

\textsuperscript{187} \textit{LizardTech}, 424 F.3d at 1344.

\textsuperscript{188} \textit{LizardTech}, 424 F.3d at 1345 (emphasis added).

\textsuperscript{189} See supra \textit{Predictability of the Art}, Part I.C.A.

\textsuperscript{190} \textit{LizardTech}, 424 F.3d at 1345 (emphasis added).

\textsuperscript{191} \textit{Moba}, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1327 (Fed. Cir. 2003) (Bryson, J., concurring).
\end{footnotesize}
court was attempting to invoke with the possession doctrine. Lastly, in citing the missing claim element as the cause of invalidity, the court failed to recognize it was invoking the requirement that the claims shall “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.” 192 Presuming that what the court said is true, in prosecution, such a claim would fail the definiteness requirement of 35 U.S.C. § 112 paragraph 2 and the enablement requirement of 35 U.S.C. § 112 paragraph 1. Such unsupported claims are called omnibus claims because “it is indefinite in that it fails to point out what is included or excluded by the claim language.” 193

The seminal case for omnibus claims is O’Reilly v. Morse. 194 Morse had invented the telegraph and sued O’Reilly for infringement of Morse’s eighth claim, which stated:

I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims; the essence of my invention being the use of the motive power of the electric or galvanic current, which I call electro-magnetism, however developed, for making or printing intelligible characters, signs or letters, at any distances, being a new application of that power, of which I claim to be the first inventor or discoverer. 195

As here, omnibus claims attempt to provide patent coverage for related inventions that the inventor has not invented. As Morse claimed, “I do not propose to limit [my invention to the] specifications and claims.” 196 At that time though, claims were a relatively new addition to patents. Even so, Chief Justice Taney recognized that “this claim can derive no aid from the specification filed. It is outside of it, and the patentee claims beyond it.” 197 Thus, the U.S. Supreme Court invalidated the claim. 198 The LizardTech court recognized the similarity of the situation in citing Morse. 199

Adopting LizardTech’s argument “would lead to sweeping, overbroad claims because it would entitle an inventor to a claim scope far greater than what a person of skill in the art would understand the inventor to possess or what a person of skill in the art would be enabled to make and use.

So clearly, the court understood that claim 21 was invalid, either by failure of the enablement clause of 35 U.S.C. § 112 paragraph 1, or the definiteness clause of paragraph 2. Consequently, the court’s citing of the possession test here is perplexing. 200

194 O’Reilly v. Morse, 56 U.S. 62 (1853).
195 Id.
196 Id.
197 O’Reilly, 56 U.S. at 119-20.
198 Id. at 136-37.
199 LizardTech, 424 F.3d at 1346.
200 LizardTech, 424 F.3d at 1345.
4. *Per Curiam Denial of Rehearing*

LizardTech petitioned for a re-hearing by the court or an en banc appeal. Circuit Judge Lourie wrote a concurring opinion, while Circuit Judge Rader dissented. In the concurrence, Circuit Judge Lourie raised eight arguments in support of the petition denial. These were:

(a) Case law has been consistent upholding 35 U.S.C. § 112;
(b) That quid pro quo required a full disclosure;
(c) The disclosure failed to meet the full disclosure requirements;
(d) The facts here are different than in other cases;
(e) The disclosure failed the possession test (without calling it that);
(f) The preferred embodiment did not support the claim;
(g) 35 U.S.C. §132 bars new matter and that 35 U.S.C. §112 does not so apply, and
(h) The court has at least twice declined to hear a written description case en banc.

As discussed below, these arguments implicate that the Court of Appeals for the Federal Circuit is both improperly invoking the possession test, and raising the standard for showing possession. Due to the expansiveness of judicial doctrine in the opinion, this article will discuss each argument separately.

5. *Concurring Opinion and Counterarguments*

a. Does Judicial Doctrine Rule Over the Statute?

The concurrence purportedly supported the invalidation of claim 21. Instead, it served to show that the Court of Appeals for the Federal Circuit is divisive in the interpretation of 35 U.S.C. § 112. First, Circuit Judge Lourie opened his arguments with judicial doctrine. “Our case law has been quite consistent in holding that the patent law requires that a patent contain a written description of a claimed invention independent of the requirements to enable one skilled in the art to make and use the invention.”

Second, Circuit Judge Lourie argues that there is by “statute, policy, and practice,” “a written description [requirement] . . . independent of the requirement [to enable one skilled in the art to make and use the invention].” As support, Circuit Judge Lourie quotes the first paragraph of 35 U.S.C. § 112, with emphasis on the “and” between the written description requirement in the statute, and the enablement clause. Circuit Judge Lourie adds two instances of comporting case

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201 *LizardTech*, 433 F.3d at 1374 (denying en banc rehearing).
202 Id.
203 *LizardTech*, 433 F.3d at 1374-76 (Lourie, J., concurring).
204 *LizardTech*, 433 F.3d at 1374 (Lourie, J., concurring).
205 Id.
206 Id.
However, this first set of arguments suffers from two problems. The first problem is the choice of order in the arguments. First, rather than citing the statute, Circuit Judge Lourie cites judicial doctrine ("[o]ur case law has been quite consistent"), as though judicial doctrine on written description had overruled the statute, which as yet the court has not done. In *Marbury*, the U.S. Supreme Court said the role of the judiciary is interpretation, thus the first argument is the statute, not judicial doctrine. Second, these arguments are irrelevant. The statutory requirements for enablement, best mode and definiteness are not challenged here, nor have they been recently challenged. In this case, and the other cases cited here, the parties were not challenging the statutes, but rather the judicial interpretation of the statute.

b. Applying Quid Pro Quo to the Written Description

Circuit Judge Lourie then cited the quid pro quo doctrine, saying it is self-evident public policy applied to the entirety of the written description.

The whole purpose of a patent specification is to disclose one’s invention to the public. It is the *quid pro quo* for the grant of the period of exclusivity. The need to tell the public what the invention is, in addition to how to make and use it, is self-evident. One should not be able to obtain a patent on what one has not disclosed to the public.

This argument is subject to challenge on multiple fronts. The first challenge is that quid pro quo as applied to patent law does not involve 35 U.S.C. §112, but rather the legitimate use of the patent. The first use of quid pro quo arose from the 1836 patent law that “authorized the extension of a patent, on the application of the executor or administrator of a deceased patentee.” However, a licensee of the patent could not use the extension. While the law disappeared, the doctrine did not. The U.S. Supreme Court later cited the doctrine as justification for the “exclusive right” exception to monopoly and antitrust law giving a patentee a limited licensing right without violating the Sherman Antitrust Act (15 U.S.C. §1, et. seq.). These cases present the quid pro quo doctrine as a use doctrine, not a patentability doctrine.

This view is supported by a 1974 case in which the U.S. Supreme Court had to determine whether federal preemption applies to state laws that protect unpatentable trade secrets much as patent law would protect them, if they were

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207 *LizardTech*, 433 F.3d at 1374-75 (Lourie, J., concurring) (citing Invitrogen Corp. v. Clontech Labs., Inc., 429 F.3d 1052, 1071 n. 17 (Fed.Cir. 2005), and *Capon v. Eshhar*, 418 F.3d 1349, 1360 (Fed.Cir. 2005)).

208 *LizardTech*, 433 F.3d at 1374 (Lourie, J., concurring).


210 *LizardTech*, 433 F.3d at 1375 (Lourie, J., concurring).


212 *Woodworth v. Sherman*, 30 F. Cas. 586, 589 (Cir. Ct. Mass. 1844) (holding, *inter alia*, that an assignee could not get an extension since the patentee did not have the right to grant the extension).

213 *Simpson v. Union Oil Co. of Cal.*, 377 U.S. 13, 24 (1964) (holding that a consignment license coerced on lessees is illegal under anti-trust laws).
In Kewanee Oil Co. v. Bicron Corp., the U.S. Supreme Court recognized that the limited monopoly of patents, i.e., the open use of the patented invention, served as an incentive (the quid pro quo) to “full disclosure.” “The more difficult objective of the patent law to reconcile with trade secret law is that of disclosure, the quid pro quo of the right to exclude.”

In Kewanee, the U.S. Supreme Court recognized that allowing protection of trade secrets provides the same use incentive to businesses that did not need, qualify for, or could not afford patent protection. The problem before the Court was how to strike a proper balance between undisclosed, but state protected trade secrets, and disclosed, but federally protected ideas.

State rules which would grant such incentives seem to conflict with the economic quid pro quo underlying patent protection; i.e., a monopoly limited in time, in return for full disclosure of the invention. Thus[,] federal law has struck a balance between incentives for inventors and the public’s right to a competitive economy. In this sense, the patent law is an integral part of federal competitive policy.

The difficulty for businesses is that trade secrets can keep a business in business for decades, as with Coca-Cola, which has been a trade secret for some 120 years. A patent, on the other hand, provides only a limited monopoly for a fraction of that time. At expiration, everyone can legally make, sell and use the invention with impunity.

Thus, by ruling that federal patent law did not preempt the state trade secret law, the Kewanee Court affirmed the quid pro quo doctrine as a balancing factor in the competitive decisions made by businesses of whether to maintain a trade secret or seek patent protection, without regard to the disclosure of the application.

Other cases involving patents have also focused on the individual actions of the patentee/assignee in competition, rather than on the disclosure. In Rite-Hite

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215 Id. at 484 (citing Universal Oil Co. v. Globe Co., 322 U.S. 471, 484 (1944)).
216 Kewanee Oil, 416 U.S. at 474.
217 Kewanee Oil, 416 U.S. at 497, n.2 (holding that a state law granting monopoly protection to processes and manufacturing techniques by barring disclosure of unpatentable trade secrets does not violate federal patent law) (quoting Adelman, Secrecy and Patenting: Some Proposals for Resolving the Conflict, 1 APLA QUARTERLY JOURNAL 296, 298-99 (1973)).
219 A patent grants the patentee “the right to exclude others from [importing into,] making, using, offering for sale, or selling the invention throughout the United States” for a term of 20 years from the earlier of the filing or priority date. 35 U.S.C. § 154(a) (2006).
221 The federal trade secret protection statutes, i.e., 18 U.S.C. § 1831-1839, have been on the books since 1996. Just as with the patent statutes, these statutes do not, and cannot, address the competitive cost-benefit analysis necessary for whether a business should seek a patent or keep the information a trade secret. Kewanee Oil, 416 U.S. at 484-491.
222 See e.g. Image Technical Servs., Inc. v. Eastman Kodak Co., 125 F.3d 1195, 1997-02 (9th Cir. 1997) (holding that a monopolist's exclusion of others from its intellectual property by refusing to license or sell its intellectual property is a presumptively valid business justification to exclusionary
(1995), the Court of Appeals for the Federal Circuit placed emphasis of the quid pro quo doctrine on the marketplace, not patentability.\textsuperscript{223} Even the most recent U.S. Supreme Court case has not departed from that role.\textsuperscript{224}

The second difficulty is that cases that have tied quid pro quo to the written description doctrine have conditioned the link to public use of the invention. In the first case linking quid pro quo to the written description, a district court applied quid pro quo to the best mode requirement of 35 U.S.C. § 112.\textsuperscript{225} In Systematic Tool & Mach. Co., the district court said that "disclosure of the best method of performing the task the patent is intended to accomplish [is the] the quid pro quo for the grant of a legal monopoly over the subject matter, so that the public may obtain maximum benefits through complete revelation by the patentee."\textsuperscript{226} According to the Systematic court, the quid pro quo doctrine focuses on the best benefit of the invention, not the enablement (make and use) clauses of §112(1).\textsuperscript{227} Unlike Systematic Tool & Mach. Co., Lizardtech was not a question of validity under the best mode requirement—which also was not mentioned in the opinion other than in one short reference.\textsuperscript{228}

Not too long ago, the U.S. Supreme Court looked at the relationship of the quid pro quo doctrine to the written description.\textsuperscript{229} In \textit{J. E. M. Ag Supply, Inc. v. Pioneer Hi-Bred International}, the U.S. Supreme Court said that "to obtain a utility patent, a breeder must describe the plant with sufficient specificity to enable others to "make and use" the invention after the patent term expires. The disclosure required by the Patent Act is "the quid pro quo of the right to exclude."\textsuperscript{230}

There are, however, distinguishing factors between \textit{J. E. M. Ag Supply} and LizardTech. First, in \textit{J. E. M. Ag Supply}, the U.S. Supreme Court faced the question of whether newly developed plant breeds are patentable subject matter where Congress provides for utility patents under 35 U.S.C. § 101, plant patents under the Plant Protection Act (35 U.S.C. §§ 161-164) and Plant Variety Certificates under the Plant Variety Protection Act (84 Stat. 1542, as amended, 7 U.S.C. § 2321 et. seq.).\textsuperscript{231} The patentability question in LizardTech was limited conduct for any immediate harm to consumers).

\textsuperscript{223} Rite-Hite Corp. v. Kelley Co., Inc., 56 F.3d 1538, 1562 (Fed. Cir. 1995) (holding that "[t]he patent system was not designed merely to build up a library of information by disclosure, … but [is] to get new products into the marketplace during the period of exclusivity so that the public receives full benefits from the grant") (internal citation omitted) (emphasis added).

\textsuperscript{224} Ill. Tool Works Inc. v. Indep. Ink, Inc., 547 U.S. 28 (2006) (holding that a patent does not necessarily confer market power upon the patentee and requiring a plaintiff prove a patentee/defendant has market power in the tying product).

\textsuperscript{225} The specification shall . . . set forth the best mode contemplated by the inventor of carrying out his invention. 35 U.S.C. § 112(1) (2006).


\textsuperscript{227} \textit{Id.}

\textsuperscript{228} \textit{LizardTech}, 424 F.3d at 1344.


\textsuperscript{231} \textit{Id. at 127} (holding that newly developed plant breeds are patentable subject matter of § 101, and
strictly to the scope of the disclosure in support of the claims.\textsuperscript{232} Second, in most patent cases, the Court uses the broader, and more common term, patentee.\textsuperscript{233} Here, the Court does not refer to a patentee, but to the breeder.\textsuperscript{234} Thus, the focus in \textit{J. E. M. Ag Supply} is not on an inventor, but on a person working with live biological materials. In addition, plant inventions are subject to the biological deposit requirement of 37 C.F.R. §§ 1.801-1.809 because of “the practical difficulties of describing unique biological materials in a written description.”\textsuperscript{235} A deposit is not required, optional, or even allowed for a software invention.\textsuperscript{236}

In general, the quid pro quo doctrine is intended to entice a patentee to place the invention in the marketplace with the limited “right to exclude.”\textsuperscript{237} The distinguishing factors between \textit{J. E. M. Ag Supply} and \textit{LizardTech} make it clear that applying quid pro quo to the entirety of the written description must be limited to the cases where there are “practical difficulties of describing [the invention] in a written description.”\textsuperscript{238} Consequently, application of the quid pro quo doctrine to the possession test is limited to specific subject matter, just as courts in the past have done for genus-species patents.\textsuperscript{239}

c. Patent Practice

Circuit Judge Lourie then notes that patent applications provide for two parts in the specification describing the invention, a “substantive portion of a patent specification” and “a fuller written description of what the invention is.”\textsuperscript{240} By substantive portion, Circuit Judge Lourie was referring to the claims, as shown by the statement that “[a] patent specification always begins with a statement like ‘My invention consists of.’”\textsuperscript{241}

Circuit Judge Lourie argues, “[n]o one writes a patent application by beginning with statements like ‘I make my invention as follows’ or ‘I use my invention in the following manner.’”\textsuperscript{242} However, this argument ignores the patent laws and policy with which Circuit Judge Lourie seeks to support the denial of re-

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\textsuperscript{232} \textit{LizardTech}, 424 F.3d at 1344-1345.  
\textsuperscript{235} \textit{Enzo Biochem}, 323 F.3d at 965.  
\textsuperscript{237} \textit{Kewanee Oil}, 416 U.S. at 497.  
\textsuperscript{238} \textit{Enzo Biochem}, 323 F.3d at 965 (applying quid pro quo to requiring biological deposits when a written description would be inadequate disclosure).  
\textsuperscript{240} \textit{LizardTech}, 433 F.3d at 1375 (Lourie, J., concurring).  
\textsuperscript{241} Id. at 1375 (Lourie, J., concurring). See also 37 C.F.R. §1.75(e) (2006).  
\textsuperscript{242} Id. at 1375 (Lourie, J., concurring).
While the phrases alluded to by Circuit Judge Lourie are provided for by the enablement clause of 35 U.S.C. § 112, the rules clearly state such a discussion is part of the Brief Description, and the Detailed Description of the Invention parts of the application. In addition, no one could use such a phrase in a claim as described by Circuit Judge Lourie because the application would not pass examination. The patent rules expressly prescribe that the preamble use language such as “I claim,” or “we claim,” followed by “consisting of,” “comprising of,” or another comporting phrase. The Court of Appeals for the Federal Circuit has held that the patent rules are procedural in nature, and are not substantive for barring a patent for procedural non-compliance. While Circuit Judge Lourie is correct in saying that no one uses these phrases, the enablement clause is irrelevant to his argument.

d. Inconsistencies
Circuit Judge Lourie next seeks to justify the Court’s denial on re-hearing on grounds that the facts here are different from other cases. The argument fails as the facts here are just as sufficiently different to not justify the Court’s decision. If anything, applying the possession test to a case involving software is a case of first impression that requires an en banc review.

e. Passing the Opportunity
Circuit Judge Lourie next seemingly bypassed the opportunity to address the fundamental issues of the LizardTech (2005) opinion. Circuit Judge Lourie first states that the claims “must be interpreted, in light of the written description, but not beyond it, because otherwise they would be interpreted to cover inventions or aspects of an invention that have not been disclosed.” Though sounding as an anti-omnibus claim argument, the test is whether the “written description . . . reasonably convey[s] to a person skilled in the art that [the inventor] had possession of the claimed subject matter at the time of filing.” This is the same rule cited by the LizardTech (2005) court. The error by the LizardTech (2005) court and Circuit Judge Lourie is that “the [court] never truly discussed the

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244 LizardTech, 433 F.3d at 1375 (Lourie, J., concurring) (the patent rules, specifically 37 C.F.R. §1.77(b) (2006), prescribe the order of the descriptive sections in a patent application).
247 LizardTech, 433 F.3d at 1375 (Lourie, J., concurring).
248 Id.
249 Id.
250 Id.
251 Bilstad, 386 F.3d 1116, 1125 (holding that the Board of Patent Appeals and Interferences erred in requiring a patent application for an electronic sterilization apparatus to describe every embodiment within the range construction and not recognizing that a person skilled in the art would readily discern that other members of the genus would perform similarly to the disclosed members).
252 LizardTech, 424 F.3d at 1345–46 (citing In re GPAC Inc., 57 F.3d 1573, 1579 (Fed. Cir. 1995)).
understandings of persons skilled in the art.”

This case and the other cited cases here also raise the appropriateness of the possession test to the fields of software and the technology-related electronic arts. The Court of Appeals for the Federal Circuit has generally applied the possession test only to the fields of material science, chemistry and the biological arts. It is therefore odd that Circuit Judge Lourie alludes that the possession test is inapplicable here while expressly averting a discussion on the possession test on grounds “that [it] is a more complex topic having its own subtleties.”

This disclaimer creates a problem of precedent. The first cases of the possession test involved patents invoking earlier filed documents or reference material, or were matters such as genus-species claims. The LizardTech patent does not rely on earlier filed documents or reference material and the image compression algorithm does not involve a genus-species claim. Nor is this patent the type of subject matter the Court of Appeals for the Federal Circuit has said applies the possession test. Yet, the LizardTech (2005) court clearly stated it was relying on the possession test, providing additional grounds for a re-hearing. By denying a rehearing, the Court of Appeals for the Federal Circuit is doing just what Circuit Judge Lourie stated the court was not doing in Enzo Biochem, i.e., “elevat[ing] possession [as] a statutory test of patentability,” or in other words, “lowering the bar” for using the possession test.

f. Elucidated Embodiment Test

Circuit Judge Lourie next says that “[c]laims are not necessarily limited to preferred embodiments.” In this, Circuit Judge Lourie is correct. In Scimed, the Court of Appeals for the Federal Circuit said that a patentee may rely on, and does not have to disclose, the knowledge of a person having skill in the art for interpretation of the embodiments. In addition, the doctrine of equivalence allows a patentee to extend the scope of the embodiments to equivalents known in the art that perform substantially the same function in substantially the same way

253 Bilstad, 386 F.3d at 1125.
254 LizardTech, 424 F.3d at 1345-46.
256 See supra, Predictability of the Art, Part I.C.4.
257 LizardTech, 433 F.3d at 1375 (Lourie, J., concurring).
258 Enzo Biochem, 323 F.3d at 973 (restricting “the “possession” test for circumstances … in which the inventors showed possession of a species of the invention by reference to a deposit, but may not have described what else within the scope of the claims they had possession of.”) (Lourie, J., concurring).
260 LizardTech, 424 F.3d at 1345-46 (Rader, J., dissenting) (citing Capon v. Eshhar, 418 F.3d 1349, 1358 (Fed. Cir. 2005), see also Enzo Biochem, 323 F.3d at 969.
261 LizardTech, 424 F.3d at 1345-46.
262 Enzo Biochem, 323 F.3d at 973 (Lourie, J., concurring).
263 LizardTech, 433 F.3d at 1375 (Lourie, J., concurring).
264 Id. at 1345.
to obtain substantially the same result as the claimed device or process.\textsuperscript{265} In \textit{Capon}, the court stated, “[t]he ‘written description’ requirement must be applied in the context of the particular invention and the state of the knowledge” in the art.\textsuperscript{266} The \textit{LizardTech} (2005) court should have looked at both the specification and the state of the knowledge in the art.

The \textit{LizardTech} (2005) court had held that, “[t]here is no evidence that the specification contemplates a more generic way of creating a seamless [process].”\textsuperscript{267} Circuit Judge Lourie (2006) attempted to validate this decision by saying that “merely calling an embodiment ‘preferred,’ when there are no others, does not entitle one to claims broader than the disclosure.”\textsuperscript{268} However, neither the \textit{LizardTech} (2005) court nor Circuit Judge Lourie show that the required knowledge for making a seamless process without use of “maintaining updated sums,” and “periodically compressing said sums” was not within the knowledge of a person having skill in the art.\textsuperscript{269} The court is not allowing the patentee to act as his own lexicographer and draft the application to the scale of complexity in the art.\textsuperscript{270}

The requirement the court should have been looking for is whether “the specification makes clear that the invention does not include a particular feature.”\textsuperscript{271} As noted above, this is possible only by ascertaining the knowledge of the art. The difficulty here, as with \textit{Bilstad}, is that the court did not make clear that the “feature is . . . outside the reach of the claims.”\textsuperscript{272}

g. No New Matter

Circuit Judge Lourie also attempted to bolster the court’s reliance on the possession test by pointing out that patent law bars new information in a filed application, so 35 U.S.C. § 112 cannot have such a role.\textsuperscript{273} The law cited by Circuit Judge Lourie states that “[n]o amendment” shall introduce new matter.\textsuperscript{274} Here, however, Circuit Judge Lourie’s appears to add further to the confusion over the role of the possession test. For example, in \textit{Enzo Biochem}, Circuit Judge Lourie correctly noted that an amendment cannot add knowledge to the specification, so the possession test under § 112(1) is proper to assure that all embodiments are fully and properly disclosed as of the filing of the application.\textsuperscript{275} Priority disputes also involve the test of disclosure to the filing date, and would be another instance

\begin{itemize}
\item \textsuperscript{266} Capon v. Eshhar, 418 F.3d 1349, 1358 (Fed. Cir. 2005).
\item \textsuperscript{267} \textit{LizardTech}, 424 F.3d at 1344.
\item \textsuperscript{268} \textit{LizardTech}, 433 F.3d at 1375 (Lourie, J., concurring).
\item \textsuperscript{269} Id. at 1343.
\item \textsuperscript{270} Id. at 1345 (citing \textit{In re GPAC Inc.}, 57 F.3d 1573, 1579 (Fed. Cir. 1995)).
\item \textsuperscript{271} Scimed Life Sys. v. Advanced Cardiovascular Sys., 242 F.3d 1337, 1341 (Fed. Cir. 2001).
\item \textsuperscript{272} Id.
\item \textsuperscript{273} \textit{LizardTech}, 433 F.3d at 1375.
\item \textsuperscript{274} 35 U.S.C. § 132 (2006).
\item \textsuperscript{275} \textit{Enzo Biochem}, 323 F.3d 956, 973 (Fed. Cir. 2002) (Lourie, J, concurring) (”[T]he proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure . . . is § 112, first paragraph, not § 132.”) (citing \textit{In re Rasmussen}, 650 F.2d 1212, 1214-15, 211 USPQ 323, 326 (C.C.P.A.1981)).
\end{itemize}
where Circuit Judge Lourie’s reliance on the possession test would be proper. However, *LizardTech* was about claim construction and neither an amendment nor a priority date was before the court in this case. Consequently, Circuit Judge Lourie’s invocation of §132 here is inapposite.

h. A Non-Action is Not Precedent

Circuit Judge Lourie also argued that “this court has at least twice declined to hear a written description case en banc,” so “there is no reason for our court to hear this case en banc.” The purpose of the Court of Appeals for the Federal Circuit is to “strengthen the United States patent system in such a way as to foster technological growth and industrial innovation.” *Markman* made claim construction a matter of law for the court, while the Court of Appeals for the Federal Circuit has renounced *stare decisis* for claim construction. If the Court of Appeals for the Federal Circuit bars *stare decisis* for the fundamental action of claim construction, it is inapposite to use *stare decisis* as justification for inaction on claim construction.

IV. RISE OF THE EVOLVING WRITTEN DESCRIPTION DOCTRINE

A. Circuit Judge Rader Dissents

1. Circuit Judge Rader’s View on the JVW Opinion

At issue with Circuit Judge Rader in *JVW*, as argued in the *LizardTech* dissent, is how the Court of Appeals for the Federal Circuit handled the disparity between the specification and the disputed claim as compared to other holdings. In *JVW*, the court found infringement by the V3, a video game controller, even though the patent specification for the infringed invention was a *holder* for a video game controller.

Circuit Judge Rader was not troubled that the Court of Appeals for the Federal Circuit allowed this broad scope of patent coverage. In fact, Circuit Judge Rader cited several cases (discussed infra) allowing broad interpretation of claims. What Circuit Judge Rader found troubling with the *JVW* opinion was that the following day another panel of the Court of Appeals for the Federal Circuit issued the *LizardTech* ruling that invalidated, rather than finding infringement of, a

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276 *Enzo Biochem*, 323 F.3d 956, 969 (Fed. Cir. 2002).
278 *LizardTech*, 433 F.3d at 1375-76 (Lourie, J., concurring).
280 *Markman*, 517 U.S. at 372; *Medrad*, 401 F.3d at 1319.
281 *LizardTech*, 433 F.3d at 1376 (Rader, J., dissenting).
282 *JVW Enters.*, 424 F.3d at 1335.
283 *LizardTech*, 433 F.3d at 1377.
284 *Id.* at 1377 (citations omitted).
claim that the LizardTech patentee sought to have read broadly.285

2. Comparing the Opinions

The force of Circuit Judge Rader’s dissent is immediately apparent.286 “This court’s written description jurisprudence has become opaque to the point of obscuring other areas of this court’s law.”287 As was apparent to Circuit Judge Rader, the JVW court validated a claim for a video game controller holder to include within its scope a video game controller, even though the disclosure did not demonstrate such scope. Conversely, the LizardTech (2005) court invalidated a claim because the disclosure did not demonstrate such broad scope.288

In both cases, the claims encompass more than the specification expressly describes.” Yet, “[d]espite their similarities, the outcomes in LizardTech and JVW are strikingly different.” “In JVW, this court says that a claim scope in excess of the specification’s embodiments grants a broader range of infringement,” while “[i]n LizardTech, this court says that a claim scope in excess of the specification’s embodiments invalidates the claim.289

Quoting a trade article, Circuit Judge Rader remarks that these are “[t]wo cases whose juxtaposition presents a puzzle.”290 Circuit Judge Rader found particularly exasperating the rationale of the courts in each case: “[I]n JVW, this court determines that the claims are properly construed as broader than the disclosed embodiments because ‘the patentee did not intend for the claims and the embodiments disclosed in the specification to be coextensive.’”291 Meanwhile, “[i]n LizardTech, this court invalidates claims that are broader than the disclosed embodiments because ‘[t]here is no evidence that the specification contemplates a more generic way’ of performing the claimed invention.”292

Circuit Judge Rader correctly noted that this inconsistency is not lost as a source of confusion for the patent bar. “[T]hese next-door neighbors in West’s Federal Reporter must leave practitioners in a quandary.”293 Acknowledging the true difficulty, Circuit Judge Rader said that in the face of these opinions, the Court of Appeals for the Federal Circuit “provides little or no guidance about the standard it uses to decide” whether a disclosure is adequate under 35 U.S.C. § 112.294

285 LizardTech, 242 F.3d at 1346.
286 LizardTech, 433 F.3d at 1376-81 (Rader, J., dissenting).
287 Id.
288 LizardTech, 424 F.3d at 1347.
289 LizardTech, 433 F.3d at 1376 (Rader, J., dissenting).
291 LizardTech, 433 F.3d at 1376 (Rader, J., dissenting) (citing JVW Enters., 424 F.3d at 1335).
292 Id. (citing LizardTech, 424 F.3d at 1344).
293 Id.
294 Id. at 1380.
B. The Crooked Path to the Evolving Written Description Doctrine

At this point, the reader might want to step back and look at the claim construction routes taken by both cases. The claim construction in JVW was “in light of this court’s recent en banc clarification of claim construction [in Phillips],”295 LizardTech, on the other hand, was faced with “construct[ing] claim 21 as limited to seamless discrete wavelet transformation . . . despite the absence of the term seamless in that claim,”296 and without “maintaining updated sums,” or “periodically compressing said sums” in the process.297

It is also helpful to recognize that in JVW, the accused infringer asked that the court read the claim narrowly according to the specification where the patent did not express the disputed scope of claim.298 Instead, the court declined and held for infringement.299 According to Circuit Judge Rader, this is keeping with the Phillips viewpoint. “Phillips clarified claim construction, and in the process discussed the situation of specific embodiments coupled with broad claims: ‘[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments.”300

Circuit Judge Rader also cited other case law supporting a broader reading of the claim:

[C]laims may embrace ‘different subject matter than is illustrated in the specific embodiments in the specification.” In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.302 To avoid importing limitations from the specification into the claims, it is important to keep in mind that the purposes of the specification are to teach and enable those of skill in the art to make and use the invention and to provide a best mode for doing so.303 Indeed, in Phillips itself, this court gave the broad claim term ‘baffle’ a meaning beyond the narrower bullet-deflecting embodiments in the specification.304

In LizardTech, on the other hand, the court adopted a disputed claim construction at the argument of the patentee.305 Then, the patentee suggested that

295 LizardTech, 433 F.3d at 1377 (Rader, J., dissenting) (citing JVW Enters., 424 F.3d at 1335) (citing Phillips, 415 F.3d at 1323 (en banc)).
296 Id. at 1376-77 n.1.
297 LizardTech, 424 F.3d at 1343.
298 JVW Enters., 424 F.3d at 1335.
299 Id. at 1336.
300 LizardTech, 433 F.3d at 1377 (Rader, J., dissenting) (quoting Phillips, 415 F.3d at 1326-27).
301 Id. (quoting Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 906-08 (Fed. Cir. 2004); citing Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1327 (Fed. Cir. 2002); and SRI Int’l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1121 (Fed. Cir. 1985)).
303 Id. See also Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1533 (Fed. Cir. 1987).
304 LizardTech, 433 F.3d at 1377 (Rader, J. dissenting) (citing Phillips, 415 F.3d at 1326-27 (en banc)).
305 LizardTech, 424 F.3d at 1344.
the court should read the claim *broadly* with less regard to the specification.  

Instead, the court held the claim invalid.  

Thus, the outcome seems dependent on who does the asking. As bizarre as this observation seems to be, Circuit Judge Rader recognized an “unsatisfying solution” of logic to the cases.  

This is the “evolving written description doctrine.”

If the claims are construed as confined to the embodiments in the specification, written description invalidity does not come into play. If the claims, on the other hand, are construed to embrace more than the specification, this court (on only some occasions and without a clear standard to determine those occasions in advance) will invalidate.  

As Circuit Judge Rader commented, the *LizardTech* ruling must leave “[p]atent owners and practitioners . . . [struggling] to resolve the tension between *Phillips* and cases like *LizardTech*.”

Certainly, the patentee must have been shocked at the claim invalidation. On the other hand, although the phrase “evolving written description doctrine” is rather new, this author is of the opinion that the doctrine has been in place for some time.

C. The Link to Possession

In many patent litigation cases, we can assume the accused infringer will want the patent construed within the specification tightened, or invalidated, while the patentee is looking for the broadest scope of claim coverage. Thus, the first sentence of Circuit Judge Rader’s evolving written description doctrine applies to the accused infringer while the second phrase applies to the patentee. At the outset then, Circuit Judge Rader’s evolving written description doctrine seems to be a statement in which the outcome seems somewhat dependent on who does the asking.

The next question is that if this is truly a doctrine, what precedents define how the doctrine works? In discussing the dissent initially, Circuit Judge Rader did not mention the possession test by name, but there was no mistaking he was saying that neither patent qualified for such exacting treatment: “[B]oth *LizardTech* and *JVW* confront an issue common to many patent disputes: claims that are broader than the disclosed embodiments. (citations omitted.) Neither opinion involves biotechnology or chemistry, . . . [nor] discusses the issue of complexity or uncertainty in the art, a frequent characteristic of claims invalidated on written
description grounds.”

As noted above, Circuit Judge Lourie also bypassed an invocation of the term “possession,” even though the LizardTech (2005) court expressly invoked the term. With both Circuit Judge Lourie and Circuit Judge Rader talking around “possession,” it sounds like some kind of judicial mysticism—or an elephant in the courtroom.

D. An Evolving Mystical Expression

In 1991, Vas-Cath described the possession test and enablement as separate requirements. Sometime thereafter, confusion set in, even in the same case. In Enzo Biochem, the court struggled with defining the possession test by saying that “[e]nabling one of skill in the art to make and use the invention is a separate requirement.” One example the court provided was that “[a] description of [the invention] . . . in terms of . . . function . . . fails to distinguish [the invention] from others having the same activity or function.” This seems fairly clear until we see that in the same opinion, the court said that “possession . . . is only a criterion for satisfying the statutory written description requirement[, it] is not necessarily equivalent to providing a written description.”

Adding further to the confusion was the LizardTech (2005) court, which said that the written description “[1] must describe the manner and process of making and using the invention so as to enable a person of skill in the art to make and use the full scope of the invention without undue experimentation . . . , and, (2) describe the invention sufficiently to convey to a person of skill in the art that the patentee had possession of the claimed invention at the time of the application, i.e., that the patentee invented what is claimed.” As a two-part description, this discussion clarifies, as in Vas-Cath, that the written description is two parts, enablement (under the PHOSITA test), and possession (a full description of the invention at the time of filing).

Instead of continuing this distinction, the LizardTech (2005) court then tied enablement and possession together and made them interchangeable. “[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 possesses the full scope of the invention, and vice versa.”

As Circuit Judge Rader recognized, the LizardTech (2005) court had reverted back to the Enzo Biochem confusion by not “providing [a] neutral standard of application, [other than saying] . . . the specification must show ‘possession’ of the

315 Id. at 1376.
316 LizardTech, 424 F.3d at 1345.
317 Vas-Cath, 935 F.2d at 1563.
318 Enzo Biochem, 285 F.3d at 972 (Lourie, J., concurring).
319 Enzo Biochem, 285 F.3d at 968 (Lourie, J., concurring).
320 Enzo Biochem, 323 F.3d at 973 (Lourie, J., concurring).
321 LizardTech, 424 F.3d at 1344-45.
322 Vas-Cath, 935 F.2d at 1563.
323 LizardTech, 424 F.3d at 1345.
324 Id. at 1345 (emphasis added).
claim the invention.”

In doing so, the LizardTech court had once again tossed the enablement requirement and the possession test together without regard as to which they were applying. This lack of distinction is problematic in that rather than “explaining a neutral standard for applying written description, LizardTech seems to fall back on enablement, using the latter as a proxy for the former.”

The opinion of this author is that by focusing on the requirements of 35 U.S.C. § 112, paragraph 1, the Court of Appeals for the Federal Circuit has confused the written description requirement with the requirement of 35 U.S.C. § 112, paragraph 2 for claims that particularly point out and distinctly disclose the elements of the invention. Circuit Judge Rader well summarized this confusion. “LizardTech’s two clear statements of written description law, [the written description must establish] that the patentee invented what is claimed, and, an originally filed claim can provide the requisite written description, are relegated to bookends surrounding an enablement-based application of the new written description doctrine.” As Circuit Judge Rader noted above, the focus in LizardTech is on the claim in the specification (claim 21 specifically). Yet, the word “claim” does not appear in the first paragraph of 35 U.S.C. § 112. In focusing on the possession of enablement in the written description, the Court of Appeals for the Federal Circuit has overlooked the second paragraph of § 112 which requires a “specification [that] particularly point[s] out and distinctly claim[s] the subject matter which the applicant regards as his invention.” Consequently, the difficulty the Court of Appeals for the Federal Circuit has with possession does not lie with the enablement requirement of §112(1), but with the definiteness requirement of §112(2). As the U.S. Supreme Court said in Evans, the purpose of the specification of a patent is “to put the public in possession of what the party claims as his own invention.”

In focusing on enablement, the Court of Appeals for the Federal Circuit has misplaced the focus from “[t]he name of the game is the claim.”

E. Mystical Precedent

While bringing focus on the possession test, LizardTech (2006) did not answer any questions helpful to resolve the written description dichotomy of enablement and possession. One question might be the origin, but this author suspects the court would disagree even about that. Circuit Judge Rader cited Enzo Biochem (2002) as point of origin for the “court[’s] search[] for a proper standard

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325 LizardTech, 433 F.3d at 1378 (Rader, J., dissenting).
326 Id. at 1345.
327 LizardTech, 433 F.3d at 1380 (Rader, J., dissenting).
328 Id. at 1380 (citing LizardTech, 424 F.3d at 1345-46. (Fed. Cir. 2005)).
331 Id. at 1378 (Rader, J., dissenting) (citing LizardTech, 424 F.3d at 1345).
for its revised and evolving written description doctrine.”332 In Enzo Biochem, the Court of Appeals scuttled the “bright line” Lilly (1997) test for written description invalidity.333 This author, however, traces the written description muddle to at least Vas-Cath (1991) which, in the opinion of this author, “appl[ied the] “possession” test . . . in a way not contemplated by the original test.”334 Regardless of the starting point, the difficulty has been “the impossibility of finding a standard that measures the sufficiency of the disclosure in a specification by comparing two parts of that same specification.”335 This may be understandable where, “[t]he descriptive text needed to meet [the evolving written description requirement] . . . will vary with differences in the state of the knowledge in the field and differences in the predictability of the science.”336 However, it is doubtful that anyone wants a patent system that requires the patentee to “[b]ring [the] specifications to the Federal Circuit and we will tell you if they contain sufficient descriptions.”337

LizardTech (2006) at least showed that “it is apparent that a significant number of Federal Circuit judges agree that this court’s evolving written description doctrine needs clarification.”338 “My vote to deny en banc review, however, should not be taken as an endorsement of our existing written description jurisprudence.”339 “Perhaps the entire line of [written description] cases stemming from Ruschig is wrong, and perhaps we should at some point address that question en banc.”340

However, LizardTech also showed “the court is in no hurry to clarify the issue.”341 “Future panel opinions may provide the necessary clarity.”342 “I take no position on that issue at this juncture.”343 Thus, Circuit Judge Rader is undoubtedly correct that “as this court’s case law creation strays farther from the statute, its application only gets more strained.”344 While LizardTech is but one more case that makes perpetuates the confusion, it likely will not be the last.

332 Id. at 1378-79 (Rader, J., dissenting).
333 Id. at 1378-79 (Rader, J., dissenting) (citing Regents of the Univ. of Cal. v. Eli Lilly & Co., 119 F.3d 1559 (Fed. Cir. 1997)).
334 Id. at 1378 (Rader, J., dissenting) (citing LizardTech, 424 F.3d at 1345).
335 Id. at 1379 (Rader, J., dissenting).
336 Id. at 1379 (Rader, J., dissenting) (quoting Capon, 418 F.3d at 1357-59 (emphasis added)).
337 Id. at 1379 (Rader, J., dissenting).
338 Id. at 1381 (See Univ. of Rochester v. G.D. Searle Co., 375 F.3d 1303, 1304 (Fed. Cir. 2004) (Newman, J., dissenting from the denial of rehearing en banc); Id. at 1307 (Gajarsa and Linn, JJ., joining Rader, J., dissenting from the denial of rehearing en banc)).
339 Id. at 1381 (citing Rochester, 375 F.3d at 1304 (Fed. Cir. 2004) (Dyk, J., concurring in the denial of rehearing en banc).
340 Id. at 1381 (citing Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1328 (Fed. Cir. 2003) (Bryson, J., concurring)).
341 Id. at 1381 (See Rochester, 375 F.3d at 1304 (denying petition for rehearing en banc); Enzo Biochem, 323 F.3d at 970 (Fed. Cir. 2002) (denying petition for rehearing en banc)).
342 Id. at 1381 (citing Rochester, 375 F.3d at 1327 (Fed. Cir. 2004) (Dyk, J., concurring in denial of en banc review)).
343 Id. at 1381 (citing Moba, 325 F.3d at 1328 (Fed. Cir. 2003) (Bryson, J., concurring)).
344 Id. at 1381.
V. CONCLUSION

A. From the Judicial Point of View: Show Possession

Through this mud of judicial doctrine, Circuit Judge Rader provided two clear statements for practitioners and the judiciary. For practitioners, Circuit Judge Rader gave this gem: “The ostensible standard for an adequate written description is that the specification must show possession of the claimed invention.” As yet (2007) the court has not clarified the position of the possession doctrine to the written description. This author agrees with Circuit Judge Rader, who gave the judiciary this admonishment: “From my perspective, this court should not postpone further en banc reconsideration of its evolving written description doctrine.”

Until the Court of Appeals for the Federal Circuit does gives an en banc definition, or a retreat from possession, the patent bar will suffer from the lack of a definition of what the Court of Appeals for the Federal Circuit considers the requirements of possession.

B. From the Statutory Point of View: Enablement and Definiteness

While the JVW holding might seem inconsistent with LizardTech; the cases presented here, and the discussion in this article show that the Federal Circuit Court of Appeals is requiring patentees to show one thing. “An applicant complies with the written description requirement by describing the invention, with all its claimed limitations.”

The JVW patentee won against the Interact V3 because, as the comparative patent drawing and Interact V3 photograph show, the V3 mirrored the patented invention almost identically. On the other hand, the JVW patentee lost against the Interact V4 because the specification did not provide a discussion of any means for lockably receiving the video game controller other than the L-shaped clips.

Similarly, LizardTech lost claim 21 and its dependent claims because the claim omitted a necessary element and specification failed to demonstrate how someone could operate the patented method without “maintaining updated sums.” The cases discussed here show that the Court of Appeals for the Federal Circuit requires patentees to delineate every element and every embodiment in sufficient detail, so that of the filing date, the specification enables a person having skill in the field of art to understand how to make the invention, how to use the invention, and the inventor’s best mode. The problem with the possession doctrine

345 Id. at 1378.
346 Id. at 1381.
347 See generally JVW Enters., 424 F.3d at 1324.
349 JVW Enters., 424 F.3d at 1333.
350 LizardTech, 433 F.3d at 1377.
is, as Circuit Judge Rader said: “Bring your specifications to the Federal Circuit and we will tell you if they contain sufficient descriptions.” 351 Both 35 U.S.C. § 112 and judicial doctrine provide for broad claim construction through means plus function, the doctrine of equivalents and genus-species claims. 352 The possession doctrine restricts the ability of the patentee to use these statutes and doctrines.

C. From the Practitioner Point of View

The author reviewed many cases not cited here. This research leads the author to believe that the Court of Appeals for the Federal Circuit has created a two-headed monster for itself and the patent bar. One side wants more disclosure of enablement and definiteness to explain new technologies for which the courts and art are unprepared. The other side wants to keep the balance of technology and patent innovation moving forward.

Rather than clearly state the requirement, the Court of Appeals for the Federal Circuit once coined a buzzword named possession and is now reluctant to back away from precedent, even though it disclaims stare decisis—the elephant in the courtroom.

With this greater disclosure requirement in mind, this author supports Circuit Judge Rader’s admonition that the Court of Appeals for the Federal Circuit has an “evolving written description doctrine.” 353 While patent prosecution standards were due for tightening in the face of criticism over lax issue policies, the role of the judiciary is interpretation of statutes. By creating the possession doctrine and loosely applying this judicial requirement, the Court of Appeals for the Federal Circuit is expanding judicial doctrine beyond the statutory constraints of 35 U.S.C. § 112.

Regardless of whether in the greater scheme of patent practice and litigation the LizardTech court got it right, interpretations such as JVW will become rare if not extinct. As Circuit Judge Rader commented, patent practitioners are in a “quandary.” 354 The possession test is not a detailed requirement, but rather is a “requirement of detail” unlike any checklist within case law or the Manual of Patent Examining Procedure.

As a practitioner, this author agrees that the Court of Appeals for the Federal Circuit must abide by precedent and fully explain its rationale. The void of explanation creates unnecessary effort for practitioners in drafting applications and unnecessary expenses. Compounding matters is that a longer application is not necessarily more definitive. District courts will struggle with longer applications, and increasing reversal rates.

The judiciary will likely take a decade to resolve this newest doctrine. Patent practitioners need answers now for present and future claim construction issues to secure the widest permissible patent rights without invalidation or litigation.

351 Id. at 1379 (Rader, J. dissenting).
353 Id. at 1376-81.
354 Id. at 1376.
negating the purpose of the patent. While technology, biology and even language evolve, interpretation of the written description, concluding with the claims, must be sufficiently unchanging such that it does not frustrate the constitutional mandate that intellectual property serves which is “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries.”355