



Inventors News

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Inventors Association of Australia (SA) Inc Newsletter

April 2010 (NON-MEMBER)

NEXT MEETING

Function Room
Duke of Brunswick Hotel
207 Gilbert Street
Adelaide

Thursday 15th April

MEAL - Dining Room 6.00 pm
MEETING - DOORS OPEN at 7.00pm
For a 7.30pm start.

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General Meeting

Presentations

Question and Answer time

Tea Break

10.00pm CLOSE

QUOTE OF THE MONTH

Serious-minded people have few ideas.

People with ideas are never serious.

Paul Valery

Howard Says...

From the desk of a busy patent attorney.

Something a little different

The USA defines for most patent attorneys the requirements for writing a patent. The case below is the result of some efforts to reduce these but as will be seen it remains a challenge. What it means in practise is that you cannot safely simply rely on describing a single way of acheiving your "invention". If you do you may expect then to be held to have a scope that is very narrow and often then this is not much use in practise.

It does mean that one must spend more and more time and effort at the preparation side to explore alternatives.

Ariad v. Eli Lilly: An En Banc Federal Circuit Reaffirms a Separate Written Description Requirement

In a highly anticipated en banc opinion released yesterday, March 22, 2010, in Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co., the Federal Circuit reaffirmed that patents must satisfy **“two separate description requirements: a ‘written description’ [i] of the invention, and [ii] of the manner and process of making and using [the invention].”** The Federal Circuit’s decision is in line with existing recent precedent, but raises questions about the ability of some inventors, particularly universities and research entities, to obtain patents on early stage research.

Ariad dealt with the question: What fulfills the so-called “written description” requirement of 35 U.S.C. § 112, 1? The statute requires that:

The specification [of a patent] shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Ariad, the patent owner, argued Section 112, 1 could be met simply by showing that a patent enables one of skill in the art to make and use the invention. The majority of the en banc panel of the Federal Circuit disagreed, however. In analyzing Ariad’s patent for regulation of gene expression, and in particular the issue of obtaining protection for genus claims, the Federal Circuit emphasized that “merely drawing a fence around the outer limits of a purported genus is not an adequate substitute for describing a variety of materials constituting the genus.” Satisfying the written description for a genus “requires the disclosure of either a representative number of species falling within the scope of the genus or structural features common to the members of the genus.” Under the facts of this particular case, the Federal Circuit found that Ariad’s genus claims for all substances for reducing NF-kB activity did not fulfill the written description requirement because Ariad had failed to disclose specific molecules capable of reducing NF-kB activity.

The Federal Circuit’s decision to maintain separate written description and enablement requirements is not surprising given both the consistency of earlier decisions and what the majority saw as clear and unambiguous statutory language. Although Judge Gajarsa noted in his concurring opinion that Section 112 was the model of legislative ambiguity, the en banc Federal Circuit found that the statute’s language requires that the specification describe what the invention is and teach how to make and use the invention.

The Court gave special attention to Ariad’s arguments that the “written description requirement ‘has severe adverse consequences for research universities’ because it prevents the patenting of ‘the type of discoveries that universities make,’ that is, it prevents the patenting of basic scientific research.” (Newman, J., concurring). The en banc Federal Circuit was not swayed by those concerns. The Court stated that “patent law has always been directed to the ‘useful arts’” but “[m]uch university research relates to basic research, including research into scientific principles and mechanisms of action.” Patent protection is granted for practical application, not basic research, the Court stated.

In a dissenting opinion, Judge Rader wrote that the majority’s holding creates an irreconcilable conflict between its interpretation of the written description requirement and basic principles of claim construction. Judge Rader criticized the majority for giving itself and lower courts “unfettered power to err twice – both in construing the claims so broad as to exceed the scope of the rest of the specification and then to invalidate those claims because it

reads the specification as failing to support [the] court’s own broad conception of the claimed subject matter.”

Also in dissent, Judge Linn wrote that a separate written description requirement apart from the enablement requirement was “unnecessary and ill-advised.” He questioned how, if the patent specification was sufficiently detailed to enable a person of ordinary skill to make and use the invention, it could still “be in need of some undefined level of additional description.”

Fortunately for many patent prosecutors, the Court’s guidance here reiterates the Court’s previous precedent with respect to written description. Prosecutors must be careful to ensure that a patent complies with both the written description and enablement requirements of Section 112.

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NEW MEMBERS

We cordially welcome all our new members and trust that the Association can help you in your ‘journey’. If you have any special requests please talk to any member of the committee and we will endeavour to help you. Committee members have a red dot on their nametags.

NEWSLETTER CLASSIFICATIONS

There are basically 3 types:

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