

Patent Law & Policy

Session 11

9/14/08

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Written Disclosure Requirements

- Basic Bargain
 - You tell us your invention, we protect you
- Tension ...
 - Overbroad protection shorts public knowledge
 - Underbroad protection shorts the inventor
- 35 U.S.C. § 112, ¶¶ 1, 2
 - enablement, written description, best mode
 - claim definiteness

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Enabling the claimed invention

- 35 U.S.C. § 112, ¶ 1
 - “... a written description ... [so] as to enable any person skilled in the art ... to make and use” it
- 1836 Act, § 6
 - “... a written description ... [so] as to enable any person skilled in the art ... to make, construct, compound, and use the same”

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Incandescent Lamp (S. Ct. 1895)

- Sawyer & Man patent is asserted against a licensee of an Edison patent
- Edison lamp has carbonized bamboo filament
- Sawyer & Man patent claims ...
 - Claim 1 – “carbonized fibrous or textile material”
 - Claim 3 – “carbonized paper”
 - Does Claim 3 cover the Edison lamp filament ?

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Incandescent Lamp cont'd

- Sawyer & Man's written description ...
 - "In the practice of our invention we have made use of carbonized paper, and also wood carbon."
 - "an incandescing conductor of carbon made from a vegetable fibrous material"
 - "advantages resulting from the manufacture of the carbon from vegetable fibrous or textile material"

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Incandescent Lamp cont'd

carbonized paper
↓
carbonized fibrous or textile material

- Logic of moving from paper to fibrous ?
- How many fibrous materials actually work ?
- Does the patent point us to fibers that work ?

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National Recovery (Fed Cir 1999)

“The scope of the claims must be less than or equal to the scope of the enablement. The scope of enablement, in turn, is that which is disclosed in the specification plus the scope of what would be known to one of ordinary skill in the art without undue experimentation.”

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Amgen v. Chugai (Fed Cir 1991)

- Claim 7 recites a DNA sequence functionally
 - “an amino acid sequence sufficiently duplicative of that of erythropoietin to” confer 2 properties
- Enablement rejection affirmed
- How many EPO analogs can be made ?
 - One amino acid change – 3,600
 - Three amino acid changes – more than 1 million
- How many DNA sequences are implicated ?

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Amgen cont'd

- Amgen doesn't give us a 'theory' that points to the right DNA sequences
- Mismatch between disclosure and claim
 - "Amgen has claimed every possible analog of a gene containing about 4,000 nucleotides, with a disclosure only of how to make EPO and a very few analogs."
 - Many possible changes to EPO structure, with unpredictable consequences for new item's utility

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