



IP: The late claimed invention and the written description defense

KEEP AN EYE OUT FOR EACH OF THESE POTENTIALLY IMPORTANT FACTS WHEN REVIEWING A PATENT

You may be called upon to determine the strength of patent claims in many circumstances. Perhaps you have been accused of infringing a patent. You may be considering purchasing one. You might want to file a lawsuit asserting the claims of a patent against another and need to know if those claims are at risk of invalidity. When analyzing of the strength of patent claims, you will need to ask a number of questions, including what technology existed at the time the patent application was filed and whether one of skill in the art would understand how to make and use the invention. One key question will be the scope of the claims. If the claims are broad and cover a wide swath of technology, that may make the patent very valuable. However, broader claims also may open up a patent to a challenge that, among other things, its written description does not support the broader claims.

35 USC §112(a) states that a

patent specification shall contain a written description of the invention. This is the statutory basis for the written description invalidity defense that the patent claims asserted are not supported by the specification as it was originally filed. The disclosure can be made in the originally filed specification in any way that would be understood by one of ordinary skill in the art to indicate the inventor possessed the full scope of the invention. This disclosure can be made either through words or figures. The originally filed claims are considered part of the specification for purposes of the written description analysis. Because the focus is on what was originally filed, your written description analysis will need to include a thorough examination of the prosecution history of the patent.

When reviewing the patent and its prosecution history, you should keep an eye out for each of these

potentially important facts:

1. Late-added claims

Prosecution of a patent can be a lengthy process requiring multiple amendments to the claims originally filed and the addition of different claims in some circumstances. While the application is pending, technology can change and further advancements in the field may occur. If the description in the originally filed application is broad enough to encompass these advancements, then the patent applicant may incorporate them in the claims, even if these changes are deliberately made to cover a competitor's product. If the advancements or changes were not originally disclosed, however, they cannot be claimed. Amendments and particularly new claims added years into prosecution are worth a second look. The recent Federal Circuit case *Synthes USA v. Spinal Kinetics* ([Fed. Cir. 2013](#)) offers an example

of circumstance in which late-added claims were found to lack written descriptive support. The asserted Synthes patent asserted was directed to an intervertebral implant. The original application discussed grooves in the implant. Five years into prosecution, the claims were amended to add the words “opening” and “plurality of openings.” These changes were made after the accused infringer’s product had already been introduced into the market. The Federal Circuit affirmed the jury’s finding that the original disclosure did not encompass the more broadly worded openings and plurality of openings. Consequently, the patent claims were invalid.

2. Claim terms that do not appear anywhere in the specification

It is not a written description requirement that the exact language of the claims be used in the specification (this is usually referred to in cases by stating that there is no *in haec verba* requirement). However, when important terms do not appear anywhere outside of the late-added claims, this can serve as a heads-up that the scope of those claims may not have been originally disclosed. For example, a word search of the Synthes patent shows that the words “opening” and “plurality of openings” do not appear anywhere in the specification. To the contrary, the Court noted that the concept of

these openings was first added during prosecution and ultimately determined that this concept was broader than the grooves that were originally disclosed.

3. Extrinsic evidence

While extrinsic evidence may not always be available for your initial analysis, contemporaneous documents discussing what the inventor actually invented, information about the work put in by the accused infringer when developing the accused design, and expert testimony about how one of ordinary skill would understand the original disclosure may be important to a court’s written description analysis. For example, if the invention disclosure for a patent is explicit that what was invented did not include the expanded claim coverage, that would weigh against a finding that the broadened claims are supported. In *Synthes*, the accused infringer was able to submit evidence that the shape and size of the openings selected were important design considerations to prevent wear and tear on the implant. This supported the defendant’s argument that disclosure of grooves in the originally filed application would not be understood to disclose the openings of the broader claims. This type of extrinsic evidence can be particularly persuasive in a jury trial because the invention story can help transform the written description requirement from

feeling like a strict technicality to a rational limitation preventing an inventor from trying to claim things that she did not actually invent.

An early determination that a patent claim is likely unsupported can be important in setting negotiation and litigation strategy for both the patent owner and the potential purchaser or accused infringer. For the patent owner, knowing the strengths and weaknesses of your patent will be invaluable in your negotiations with third parties. For the potential purchaser or accused infringer, identifying these weaknesses can provide leverage.

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