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## Patenting Research or Preempting the Future Before It Has Arrived? Federal Circuit Reaffirms Written Description Requirement

The core intellectual property of many universities and advanced research centers may be significantly impacted by the Federal Circuit Court's recent *en banc* decision in *Ariad Pharmaceuticals Inc. v. MIT* (March 22, 2010). The question posed in *Ariad* was whether, in addition to explaining how to make and use the invention, the inventors were also required to set forth in the patent specification a written description sufficient to show that the inventors were in possession of the claimed subject matter as of the filing date of the patent application. The court's decision reaffirmed that an adequate written description is a separate requirement for patentability, and satisfying the enablement requirement does not necessarily satisfy the written description requirement.

Whether the written description is adequate in a particular case remains a question of fact, and thus is not susceptible to precise explication. Nonetheless, the hallmark of the written description requirement is disclosure sufficient to show "actual invention objectively demonstrated in the specification." The test is "an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art." Based on that inquiry, the specification must describe an invention **understandable** to a skilled artisan and show that the inventor **actually invented** the invention claimed.

Application of the "four corners" analysis in this case led

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the *en banc* court to find, as had a three-judge panel of the court, that the written description requirement had not been satisfied because the disclosure was insufficient to show that the inventors had possessed the invention claimed at the time of the effective filing date. At most, the written disclosure provided a place for others to start further research — it suggested that three classes of molecules might be used to achieve the end-result of the claimed method, but did not disclose any way of accomplishing the result.

The result in this case points out rather directly that even very important basic research, as much university research is, may not be patentable unless the patent application describes the invention in sufficient detail to establish that the inventor actually invented the claimed invention. The court recognized that universities may not have the resources or inclination to work out the practical implications of basic research and, hence, may not be able to obtain patents on the basic research itself. As the court noted:

"That is no failure of the law's interpretation, but its intention. Patents are not awarded for academic theories, no matter how groundbreaking or necessary to the later patentable inventions of others. . . . Requiring a written description of the invention limits patent protection to those who actually perform the difficult work of 'invention' — that is, conceive of the complete and final invention with all its claimed limitations — and disclose the fruits of that effort to the public."

The court recognized a few broad principles of general application. These include:

- The written description requirement does not demand examples or actual reduction to practice (the actual physical implementation of the invention);
- Even if the invention has actually been reduced to practice outside of the specification, that is not enough — the specification itself must demonstrate possession of the invention; and
- The description requirement does not require a particular form of disclosure, but the requirement will not be met if the specification merely renders the invention obvious.

In view of the court's decision, research entities, such as universities, and others that wish to have broad patent claims will need to rely increasingly on skilled patent attorneys to help them properly draft their patent applications to address the written description requirement. The *Ariad* litigation highlights the importance of disclosing multiple embodiments,

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particularly where the intended scope of the claims is quite large. When an invention is groundbreaking, inventors should take particular care to provide specific examples of concrete implementations of the invention.

If you have any questions regarding the *Ariad* decision and how it could affect your patent applications, please contact your principal Squire Sanders intellectual property lawyer or one of the lawyers listed in this Alert.



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