

Archetype IPSM

Federal Circuit Friday

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In *D Three Enterprises v. Sunmodo Corp.* (May 21), the issue was whether a patent was entitled to the benefit of the filing date of a provisional application, which was necessary to avoid intervening prior art.

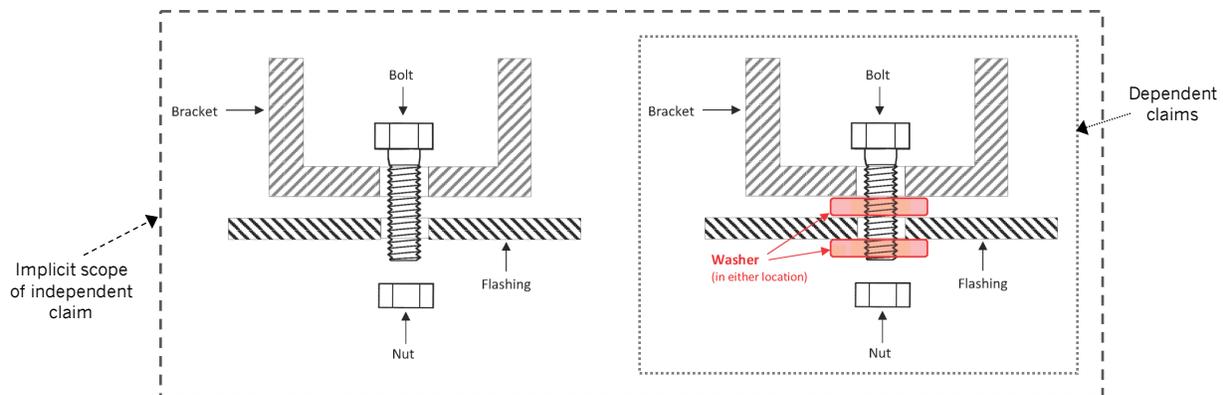
On summary judgment, the district court found that the patent was not entitled to the earlier date because the provisional application failed to provide adequate written description of the claimed subject matter. The district court then found the patent invalid over the intervening prior art. The Federal Circuit affirmed.

This case illustrates written description of a genus by disclosure of one or more species and the importance of claim construction in the written description analysis.¹

A. Claim Interpretation/Scope

Neither the district court nor the Federal Circuit provided detailed claim construction analysis, apparently because it was not materially disputed (other than a side issue regarding the transition word "comprising").

Each of the asserted claims related to apparatuses for mounting objects on a roof (e.g., solar panels). Cutting through the patent-ese of the relevant part of the claims, a bolt passes through a hole in each of two metal parts – a bracket and a raised area of flashing – to connect them. The *independent* claims are silent on the presence of a washer in or around the connection, but *dependent* claims include a washer. Because of the relationship between independent and dependent claims,² the independent claims implicitly cover assemblies both without a washer and with a washer:



¹ This case also illustrates the importance of burden of proof, an important but often-missed point relevant to all substantive patent law issues, not just written description. That aspect of the case will be addressed in an upcoming Food for Thought.

² See, e.g., *Intamin Ltd. v. Magnetar Techs., Corp.*, 483 F.3d 1328, 1335 (Fed. Cir. 2007) (independent claim that recited "intermediary" covered both magnetic and non-magnetic intermediaries because a dependent claim recited the "non-magnetic" variant; the Federal Circuit explained that "dependent claims can supply additional context for construing the scope of the independent claims associated with those dependent claims" and the "dependent claim shows both that the claim drafter perceived a distinction between magnetic and non-magnetic intermediaries and that independent claim 1 impliedly embraced magnetic intermediaries."); see also *Tronzo v. Biomet*, 156 F.3d 1154, 1156, 1158 (Fed. Cir. 1998) ("cup" structure recited in independent claims considered generic as to shape where dependent claims recited specific – i.e., conical – shape).

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In addition, the claims do not limit the kind of bracket that is used in any of the washer configurations, which means the claims cover all permutations of the various disclosed bracket types with both washered and washerless configurations.

The patent owner, D Three, argued at the district court "that it is unnecessary to recite a . . . washer (or its location) because the asserted claims are 'comprising' claims and thus do not exclude unidentified elements."³ The district court responded that the "comprising" nature of the claims was not relevant because, in light of the dependent claims, the independent claims necessarily cover both (i) assemblies that include a washer, and (ii) assemblies that omit a washer – and, therefore, the issue was whether the 2009 Provisional adequately describes the genus that includes both types of assemblies.⁴ The Federal Circuit agreed with the district court's claim construction and statement of the issue.⁵

B. Written Description

1. Legal Standards

At its core, the the written description requirement asks whether the disclosure "conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date."⁶ It is a limiting and protective doctrine that ensures that a patent covers no more than what the inventors actually invented – that which they actually "possessed" at the time of filing – and prevents a patent from extending to that which is merely obvious over, suggested by, or proposed by the disclosure. It ensures that inventors do not "attempt to preempt the future before it has arrived."⁷

Where claims cover a group of related embodiments (a genus) and the specification describes only a subset of the relevant individual embodiments (species within the genus), the written description issue is whether the description of the subset of individual species is sufficient to demonstrate that the inventors invented (had "possession" of) the full genus. As explained by the Federal Circuit here, "to claim a genus, a patentee must disclose a representative number of species falling within the scope of the genus or structural features common to the members of the genus so that [a PHOSITA] can visualize or recognize the members of the genus."⁸

³ March 15, 2017 Memorandum Opinion and Order, Case No. 15-cv-1148-CBS (D-Colo), p. 14.

⁴ *Id.*, p. 15.

⁵ The patent owner's argument nevertheless raises an interesting point. If the dependent claims had not recited a washer, then the basis for construing the independent claims as encompassing embodiments not including a washer would be weaker or non-existent. There might nevertheless be an issue whether the specification indicates that the invention is narrower than the claims -- *i.e.*, whether the specification mandates inclusion of a washer in all embodiments or omits a washer only in certain circumstances. See, e.g., *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1127 (Fed. Cir. 2008)(discussion of *Gentry Gallery*). In any event, by *dependently*-claiming certain washer embodiments (*i.e.*, a set of species), the patentee implicitly pulled all of the washer variants (*i.e.*, the corresponding genus) into the broader independent claims. See cases cited in note 2, above.

⁶ *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). See also *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) ("To satisfy the written description requirement, the disclosure of the earlier filed application must describe the later claimed invention 'in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.'").

⁷ *Billups-Rothenburg v. Associated Regional & University Pathologists*, 642 F.3d 1031, 1036 (Fed. Cir. 2011)(quoting *Fiers v. Revel*, 984 F.2d 1164, 1171 (Fed. Cir. 1993)).

⁸ Citing *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1373–74 (Fed. Cir. 2017). Note that the "representative number of species or common structural feature" is an analytic test for genus-species situations to determine the essential written description issue of whether the inventor invented (had possession) of the full genus (as opposed to the individual species or, perhaps, a subgenus). It is subservient to the established written description standard, not an alternative standard.

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2. Claims Covering Any Bracket in a Washerless Assembly Not Adequately Described.

The issue was whether the 2009 Provisional described either a representative number of species or a common structural feature of the genus of mounting apparatuses in which the washer is optional (washer can be included or omitted) and any of the various disclosed brackets are used. Everyone agreed that the 2009 Provisional discloses assemblies having various combinations of brackets and washers, so the dispute focused on whether the 2009 Provisional described species sufficient to adequately describe the other half of that genus: Washerless assemblies using any of the disclosed brackets.

The Federal Circuit accepted, for purposes of summary judgment, D Three's assertion that one of the embodiments of the 2009 Provisional omitted a washer.⁹ But that embodiment used only *one* of the various brackets and, per the Federal Circuit, the 2009 Provisional "in no way contemplates the use of other types of attachment brackets in a washerless assembly." The Federal Circuit found that the disclosure of that single species was not sufficient to demonstrate possession of the entire genus – "The 2009 Application never uses the term washerless, or describes any other types of attachment brackets that could be used in the claimed roof mount assemblies." Implicitly, the Federal Circuit determined that the single species disclosed was not a representative of the genus and that no structural feature was identified common to the members of the genus.¹⁰

D Three argued that nothing in the 2009 Provisional precluded the use of other brackets in washerless assemblies, but that actually hurt its case by inadvertently highlighting a key concept of written description law -- that it is not sufficient "that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to the modifications that the inventor might have envisioned, but failed to disclose."¹¹

D Three also pointed to a statement in the specification to the effect that various modifications, permutations, and combinations of the disclosed embodiments and components were within the scope of the invention. The Federal Circuit was not swayed: "This boilerplate language at the end of the 2009 Application's specification is not sufficient to show adequate disclosure of the actual combinations and attachments used in the Washerless Claims." Thus, the "permutations" boilerplate only invited speculation as to modifications that could be made but that were not actually disclosed.

3. Claims Reciting a Washer Under the Flashing Not Adequately Described.

There were two related issues here. First, whether the 2009 Provisional described a washered assembly in which the washer was under the flashing, which presents a straightforward written description analysis. Second, whether the 2009 Provisional described the genus of washered assemblies in which other washer was optionally either on top of or under the flashing, which implicates genus-species analysis. The dispute focused on whether the 2009 Provisional adequately

⁹ *Subtext*: The Federal Circuit seemed skeptical that the alleged washerless embodiment was really intended to be washerless, as opposed to the washer simply having been omitted from those figures in favor of focusing on another aspect of the invention.

¹⁰ The Federal Circuit did not discuss whether the single described species could support the genus, which can happen in certain circumstances depending on the predictability of the art. See, e.g., *Hologic v. Smith & Nephew* (Fed. Cir. No. 2017-1389 March 14, 2018)(genus supported by single species where the field of the invention was a predictable art and the parties did not dispute that the described species was known in the art as a member of the genus or that other species within the genus were well-known in the art).

¹¹ Citing *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

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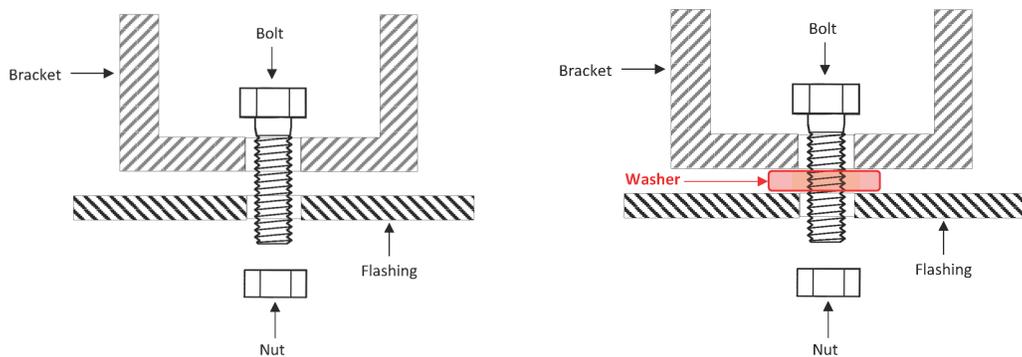
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described a washered embodiment having the washer under the flashing, which corresponds to the scope of one of the claims and represents half the genus of the other claim.

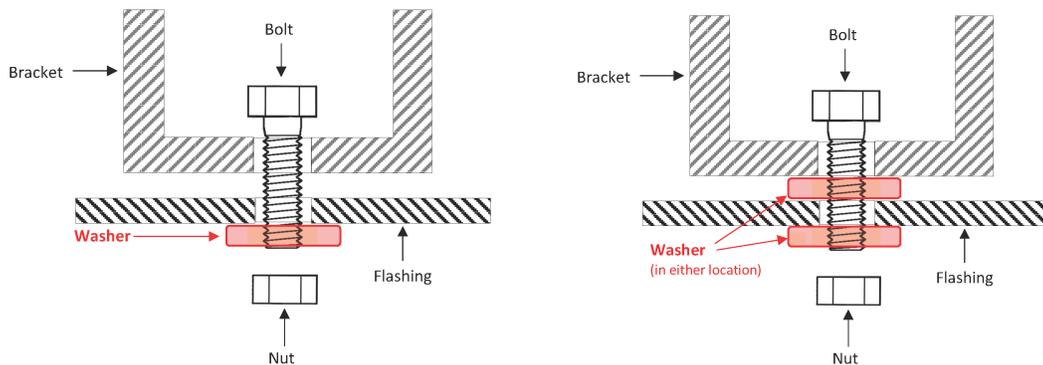
The 2009 Provisional described only the single washerless species (discussed above) and washered species in which the washer was on top of the flashing.

Thus, the issues can be represented visually as follows:

Disclosed configurations



Claimed configurations



D Three made an odd argument that the combination of the description of the washerless embodiment and the description of the washer above the flashing somehow provided adequate written description of a washered configuration having the washer under the flashing. The Federal Circuit dismissed that argument as baseless since the "disclosure of a washerless system does not support a finding of adequate written description because it does not show that the inventor 'invented what is claimed,' here, an assembly with a washer."

D Three also argued that nothing the 2009 Provisional *precluded* placing the washer under the flashing, but, as above, that hurt its case by inadvertently highlighting the point that "adequate written



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description does not ask what is permissible, rather, it asks what is disclosed."¹² In sum, the "lack of any disclosure of an assembly with a washer below the flashing, or statement on the flexibility of the position of the washer, is fatal to D Three's argument." Thus, the claims reciting a washer under the flashing or allowing the washer optionally to be under the flashing were invalid for lack of written description.

* * *

Key Takeaways:

- It is the actual disclosure that matters for written description, not what a person of skill would or might be able to do after-the-fact *based on* the disclosure. Thus, in a genus claim/species disclosure situation, the requisite representative species or common structural feature should be affirmatively described (and reliance on "permutations" boilerplate should be avoided).
- Claim construction is critical to written description and understanding the Federal Circuit's various rules and canons of claim construction, such as the way in which dependent claims can broaden independent claims in specific ways, can help avoid unintended written description problems.

¹² Citing *Ariad*, 598 F.3d at 1351.