

THE AIA: WHAT'S ON THE LITIGATION HORIZON



The Written Description Requirement: New Wrinkles on a Familiar Story (Post 1 of 3)

It happens regularly in patent litigation: a patentee asserts a patent that arose from a child application, which claims priority to some earlier-filed application. Whether the child application is a continuation, a nonprovisional from a provisional, or a national stage entry from a foreign application, the development of prior art in the intervening years can be important to the outcome of the litigation. In various cases, the outcomes (along with millions of dollars in damages) have hinged on the teachings of a parent application.

Tronzo v. Biomet, Inc., 156 F.3d 1154 (Fed. Cir. 1998), is such a case. The case involved the alleged infringement of a medical device patent involving implants for artificial hip sockets. The main claims at issue included an acetabular cup prosthesis that fits into the hip socket. The parent application that preceded the patent-in-suit was filed in 1984. The claims from the 1984 parent application were very specific in their geometry, and the patentee (Tronzo) could not prove that the defendant (Biomet) was infringing those claims. Rather, the infringement theory was based upon claims in a continuation-in-part application filed in 1987. Those claims were more generic and broader as they were not limited by the particular shape of the cup.

At trial, Tronzo won on infringement and validity, and Biomet appealed. Aside from any intervening prior art in the years between 1984 and 1987,

Tronzo seemed to have a solid case in support of patent validity. Thus, the result of the case on appeal depended on whether the claims at issue from the 1987 application could effectively lay claim to the 1984 filing date.

Even though this issue was decided in his favor at trial, Tronzo lost on appeal. One reason involved his own British application which was published in 1985 - more than a year before the child application. This publication would bar patentability unless the claims at issue from the 1987 application could rely upon the 1984 effective filing date. Crucially, the Federal Circuit determined the parent application did not contain adequate written description of a generic shaped acetabular cup, but was limited to "conical" and "trapezoid" for the shape. The court held that there was no substantial evidence to support the jury's finding of adequate written description in the 1984 application for the later-filed claims in the 1987 application. Accordingly, the generic claims of the later-filed application were not entitled to the earlier filing date, and the patent was invalidated.

Like many cases, Tronzo involved a parent application, a later-filed child application, and the development of some additional prior art during the intervening years. In Tronzo, it was the inventor's patent application published in 1985. Now, the America Invents Act (AIA) presents another type of development for patent attorneys to consider.

Specifically, any child application filed after March 16, 2013 is deemed a “transitional application” if it claims the effective filing date of a parent application on or before March 16, 2013. By definition, all transitional applications that straddle the March 16th date lay claim to an earlier-filed application. If that claim to an earlier-filed application is not justifiable, however, the AIA’s more rigid first-to-file scheme applies.

Litigators are accustomed to conflict-of-law issues that can drive the outcome of a case. In some cases, it is the conflict between laws of different states which is outcome-determinative, and the prevailing party will be the one who can persuade a court that its choice of law applies. Under the AIA, the key substantive difference involves first-to-invent versus first-to-file. For the patent holder, the first-to-invent law will always be more favorable because, for prior art that comes out shortly before the filing date, there is the chance to prove conception prior to the piece of art accompanied by the patentee’s diligent reduction to practice. In stark contrast, the AIA is rigid, and there is no such opportunity to disqualify prior art based on earlier invention.

We have yet to see a wave of cases presenting these issues, but we will. It has only been about 19 months since the AIA transition date. District court cases involving patent claims from a transitional application, if any, will still be in the very early stages of litigation and certainly will not have reached appellate review stages yet. However,

these issues will undoubtedly arise. Which law applies – the AIA or pre-AIA law? Is the later-filed application entitled to the effective filing date of the pre-AIA parent application? Is additional prior art from the intervening years available to challenge the patent? All who practice in our field will want to stay abreast of questions like these.

Courts in some cases will use the written description test to determine such issues. For a claim in a later-filed application to be entitled to the filing date of an earlier application, the disclosure of the earlier application must comply with the requirements of 35 U.S.C. § 112, paragraph 1, which includes an adequate written description. For the earlier disclosure to meet this requirement, it must reasonably convey to one of skill in the art that the inventor possessed the later-claimed subject matter at the time the parent application was filed. Future posts in this series will examine other written description cases and consider how pre-AIA written description cases will guide courts in determining whether the AIA applies. Such cases will generally fall into one of two categories: (1) those where the disclosure in the parent application was too narrow to support the broader claimed subject matter of the later-filed application; and (2) genus-species cases. The law under the AIA is still developing. But what is certain is that courts and litigators will have to address not only new art that is disclosed during intervening years between a parent and child application, but also the choice-of-law issues that depend on whether § 112, paragraph 1 is satisfied.

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