

THE AIA: WHAT'S ON THE LITIGATION HORIZON



The Written Description Requirement: When Narrow Teachings Meet Too Much Specificity (Post 2 of 3)

The previous post in this series introduced the potential litigation hurdle – or opportunity, depending on one’s perspective – involving the need for a “parent” patent application to satisfy the written description requirement with respect to claims of a later-filed child application. This requirement is well established under the cases interpreting 35 U.S.C. §112, paragraph 1. What is new, however, is the way the written description requirement interacts with transitional applications as defined by the America Invents Act (AIA).

Every patent application filed after March 16, 2013, which claims the effective filing date of a prior application filed on or before March 16, 2013, is deemed a “transitional application” under the AIA. If such a priority claim is justifiable, then the pre-AIA’s first-to-invent law applies to the claims of the transitional application, which is more favorable to the patent holder. Otherwise, the AIA’s more rigid first-to-file scheme applies to all claims in the transitional application.

This post identifies a few of the pre-AIA cases on written description which were decided against the patent holder. It then discusses, hypothetically, how similar cases would be decided if the later-filed application were a transitional application. The post concludes with practice pointers from the perspective of the patent drafter and the patent challenger in litigation.

In a case involving video game controllers, the Federal Circuit held that the disclosure found in a parent application was too narrow to support broader subject matter claimed in the later-filed application. *Anascape, Ltd. v. Nintendo of America, Inc.*, 601 F.3d 1333 (Fed. Cir. 2010). The subject claims were filed on November 16, 2000 and involved a video game controller comprising multiple input members. The patent holder asserted that these claims benefitted from the July 5, 1996 filing date of an earlier application with common inventorship that was pending on November 16, 2000. Importantly, intervening prior art surfaced in the form of Sony products that were marketed in 1998, making it important for the subject claims to be accorded the July 1996 effective filing date.

However, the court held that the specification including the drawings of the July 1996 application was specifically limited to controllers with a single input member rather than multiple ones. The defense succeeded by pointing to over twenty explicit statements in the 1996 application that the invention is directed to a single input member. The patent holder pointed to a few statements in the 1996 application about a controller with multiple input members, but the court observed that these were merely background statements to indicate the “significant disadvantages” of multiple input member controllers. *Id.* at 1337. Therefore, the claims at issue, as presented in the later-filed application, were not accorded the earlier filing date, rendering them

invalid. *Id.* at 1340; see also, *Gentry Gallery, Inc. v. Berkshire Corp.*, 134 F.3d 1473 (Fed. Cir. 1998) (the scope of the right to exclude was limited by a narrow disclosure, which only envisaged the controls for side-by-side recliners being located on a fixed console positioned between them); *LizardTech v. Earth Resource Mapping, Inc.*, 424 F.3d 1336 (Fed. Cir. 2005) (“a patentee cannot always satisfy the requirements of section 112, in supporting expansive claim language, merely by clearly describing one embodiment of the thing claimed”).

While many other litigation examples could be provided of a patent’s narrow teachings or use of very specific and limiting language – these illustrate the issue well. To illustrate the unique issues that AIA presents, take *Anascape* (but change the dates.) Suppose the first application was filed in 2012, and the later-filed application with the subject claims was filed on a certain date in 2014 – exactly one day after the Sony product was first disclosed. This is where the choice of law between pre-AIA first-to-invent versus the AIA’s more rigid first-to-file takes on importance. Given the one day difference presented in this hypothetical, the patent holder should be able to prove conception of the invention prior to the Sony reference. Under pre-AIA law, by showing reasonable diligence toward reduction to practice, the patent holder could then remove the Sony reference from consideration.

However, this would not even be a possibility under the AIA. The AIA is more rigid, and it is impossible to remove the reference – even one filed such a short time before – based on prior invention. The patent holder’s only chance to avoid the reference would be to justify the claim to priority of the original application. This hypotheti-

cal scenario illustrates two important aspects of the AIA. First, besides the issue of intervening prior art, transitional applications present the further issue of which law to apply based on whether the parent application meets the requirements of §112, paragraph 1. Second, the hypothetical shows that a virtual carbon copy of a case could be decided in exact opposite fashion under the AIA compared to pre-AIA law.

To avoid the rigidity of the AIA, patent drafters working on a transitional application might choose to include only those claims that are very likely to line up with the subject matter of the original application. Moreover, the claims in a transitional application must all be treated under either pre-AIA law or the AIA. Thus, suppose the transitional application contains 20 claims, 19 of which easily have written description support in the prior application. But if the twentieth claim has no support in the prior application, then the more rigid first-to-file scheme under AIA will apply to all the claims in the transitional application. Cost and risk-benefit factors will come into play for the patent drafter in these kinds of situations, because the twentieth claim might not be that important. If it is very important, the option exists to include the twentieth claim in a separate application from the other 19.

Such decision points for the patent drafter will also present a potential corollary opportunity for the patent challenger in litigation. Based on the hypothetical discussed above, when defending against patent infringement, it is advisable to consider all the claims in the transitional application – not just the ones being asserted – in light of the written description requirement.

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