

FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Lizardtech v. Earth Res. Mapping, 05-10620 (Fed. Cir. Jan. 5, 2006) (revised order)

The court took a poll whether to hear this case en banc in order to review its law related to the written description requirement. The poll failed to generate en banc review, resulting in an opinion in support of that vote, and dissenting opinions against such an outcome.

Judge Lourie argued that en banc review was not necessary because the court has “been quite consistent in holding that the patent law requires that a patent contain a written description of a claimed invention independent of the requirements to enable one skilled in the art to make and use the invention.”

Both a written description and a disclosure of how to make and use the invention, as well as the best mode of carrying it out, are required by the statute. . . . It is said that the written description requirement is merely a means of “policing new matter violations.” However, there is a separate new matter provision in the statute (35 U.S.C. § 132), and that provision is subsidiary to the basic requirement set forth in Section 112 to disclose one’s invention.

Judge Rader dissented from the denial of en banc review.

This court’s written description jurisprudence has become opaque to the point of obscuring other areas of this court’s law. . . . On the one hand, according to [Lizardtech, Inc. v. Earth Resource Mapping, Inc., 424 F.3d 1336 (Fed. Cir. 2005)], claims should not be broader than the disclosed embodiments unless the specification suggests the invention is broader than those embodiments. Logically, that creates a presumption: claims must be commensurate in scope with the preferred embodiments absent language suggesting otherwise. On the other hand, according to [JVW Enterprises,

Inc. v. Interact Accessories, 424 F.3d 1324 (Fed. Cir. 2005).], claims should not be narrowed to the preferred embodiments unless the specification suggests the inventor intended such narrow coverage. Logically, that creates a different presumption: claims need not be commensurate in scope with the preferred embodiments absent language suggesting otherwise. Of course, the unsatisfying solution to the puzzle is simple: while JVW considered principles of claim construction in light of this court’s recent en banc clarification of claim construction, see JVW, 424 F.3d at 1335 (citing Phillips v. AWH Corp., 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc)), Lizardtech dealt with this court’s evolving written description doctrine . . . The illogic of the new written description test—measuring the sufficiency of a specification’s disclosure by weighing one part of the specification against another—may doom any hope of this court ever devising a neutral test or resolving the tension with Phillips. . . . Far from explaining a neutral standard for applying written description, Lizardtech seems to fall back on enablement, using the latter as a proxy for the former.

