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HYATT V. BOONE

By Salima Merani

"Unfortunately, it is not so easy to tell what the law of the Federal Circuit is," lamented Judge Easterbrook in his analysis of the written description requirement.[1] The written description requirement, codified in section 112 of the Patent Act, provides that a patent application must contain "a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains ... to make and use the same."[2]

The precise standard used by the courts in determining the sufficiency of the written description requirement has been the subject of much controversy. Some courts have used the apparently lenient standard that an adequate disclosure need only "reasonably convey to the artisan" that the applicant has possession of the invention.[3] In contrast, other courts have adopted a seemingly more stringent "necessary and only reasonable construction" measure.[4] In *Hyatt v. Boone*,[5] Judge Pauline Newman attempted to reconcile the apparently divergent written description standards.[6] She concluded that the various expressions used to define a sufficient written description in prior cases did not set divergent standards for compliance with section 112.[7] Judge Newman emphasized that, in all cases, the purpose of the written description was to ensure that the inventor had possession of the specific subject matter claimed by him.[8] As such, any debate

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1. Vas-Cath Inc. v. Mahurkar, 745 F. Supp. 517, 522 (N.D. Ill. 1990), *rev'd* 935 F.2d 1555, 19 U.S.P.Q.2d (BNA) 1111 (Fed. Cir. 1991).
2. 35 U.S.C. § 112 (1998).
3. *See* Fujikawa v. Wattanasin, 93 F.3d 1559, 1570, 39 U.S.P.Q.2d (BNA) 1895, 1904 (Fed. Cir. 1996) ("[T]he disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question."). *See also* Fiers v. Revel, 984 F.2d 1164, 1170, 25 U.S.P.Q.2d (BNA) 1601, 1606 (Fed. Cir. 1993); *In re* Ruschig, 379 F.2d 990, 996, 154 U.S.P.Q. (BNA) 118, 123 (C.C.P.A. 1967) ("Does the specification convey clearly to those skilled in the art, to whom it is addressed, in any way, the information that appellants invented that specific compound.").
4. *In re* Wertheim, 646 F.2d 527, 538-539, 209 U.S.P.Q. (BNA) 554, 565 (C.C.P.A. 1981).
5. 146 F.3d 1348, 47 U.S.P.Q.2d (BNA) 1128 (Fed. Cir. 1998).
6. *See id.* at 1354, 47 U.S.P.Q.2d at 1132.
7. *See id.*
8. *See id.*

over the precise standard of the written description requirement is misguided; the only issue is whether or not the inventor had possession of the claimed subject matter at the time of filing. Although Judge Newman's approach to the written description requirement may not eliminate the debate over the written description requirement, it will certainly help provide some clarity to an otherwise amorphous standard.

I. BACKGROUND

Gilbert P. Hyatt, holder of United States Patent No. 4,942,516 entitled "Single Chip Integrated Circuit Computer Architecture" ("the '516 patent")[9] and Gary W. Boone, holder of patent application Serial No. 07/473,541 entitled "Variable Function Programmed Systems" ("the '541 application")[10] were the opposing parties in *Hyatt*. Boone initiated an interference contest after Hyatt's '516 patent was issued.[11] A patent interference is a proceeding in the Patent and Trademark Office ("PTO") that is instituted when two or more applications claim the same subject matter.[12] An interference can relate to some portion or all of the claims in an application or a patent.[13]

According to procedure,[14] Boone copied some of Hyatt's pending claims into his pending application and requested a declaration of interference.[15] The patent examiner then declared the interference.[16]

The contested invention in *Hyatt* consisted of a computer on a chip formed on a single integrated circuit chip, with specified circuits and functions.[17] The interference count[18] was as follows:

> A computer on a chip comprising:
>
> an integrated circuit chip having a computer implemented thereon;

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9. *See id.* at 1350-1351, 47 U.S.P.Q.2d at 1129.

10. *See id.* at 1351, 47 U.S.P.Q.2d at 1129.

11. *See* Hyatt v. Boone, 146 F.3d 1348, 1351, 47 U.S.P.Q.2d (BNA) 1128, 1129 (Fed. Cir. 1998).

12. *See* 37 C.F.R. § 1.601(i) (1998).

13. *See* 37 C.F.R. § 1.606 (1998).

14. *See* 37 C.F.R. § 1.607(a) (1998).

15. *See Hyatt*, 146 F.3d 1348 at 1351, 47 U.S.P.Q.2d at 1129.

16. *See id.*

17. *See* Hyatt v. Boone, 146 F.3d 1348, 1351, 47 U.S.P.Q.2d (BNA) 1128, 1129 (Fed. Cir. 1998).

18. A count, for the purposes of an interference proceeding, "defines the interfering subject matter between two or more applications or between one or more applications and one or more patents." 37 C.F.R. § 1.601(f) (1998).

> an integrated circuit main memory storing computer instructions, wherein said integrated circuit main memory is included on said integrated circuit chip;
>
> an integrated circuit operand memory storing operands, wherein said integrated circuit operand memory is included on said integrated circuit chip; and
>
> an integrated circuit processing the operands stored by said integrated circuit operand memory in response to the instructions stored in said integrated circuit main memory, wherein said processing circuit is included on said integrated circuit chip.[19]

In accordance with 35 U.S.C. § 135(a), the Board of Patent Appeals and Interferences ("Board") is the first administrative body to determine questions of priority.[20] The primary purpose of an interference proceeding is to determine which party was the first to invent the subject matter.[21] In the United States, the right to a patent derives from priority of invention, not priority of patent application filing.[22] Invention, for this purpose, encompasses two concepts: conception and reduction to practice.[23] Reduction to practice may be actual or constructive.[24] Actual reduction to practice involves the embodiment of the invention in an actual working version,[25] whereas the filing of the patent application serves as constructive reduction to practice.[26]

The filing of a patent application has the legal effect of constructively serving as both conception and reduction to practice of the subject matter described in the application.[27] Therefore, the inventor does not have to provide proof of either conception or actual reduction to practice when relying on the content of the patent application, unless a date earlier than the filing date is sought to be established.[28] When a party to an interference seeks the benefit of an earlier-filed United States patent application, the earlier application must comply with the legal requirements for support

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19. *See Hyatt* at 1351, 47 U.S.P.Q.2d at 1129.
20. *See* 35 U.S.C § 135(a) (1998).
21. *See* DONALD S. CHISUM, CHISUM ON PATENTS § 10.09[1][a] (1998).
22. *See id.* § 10.03[1].
23. *See id.*
24. *See id.*
25. *See id.* § 10.06.
26. *See id.* § 10.05[1].
27. *See* Kawai v. Metlestics, 480 F.2d 880, 885, 178 U.S.P.Q. (BNA) 158, 162 (C.C.P.A. 1973).
28. *See* Hyatt v. Boone, 146 F.3d 1348, 1352, 47 U.S.P.Q.2d (BNA) 1128, 1130 (Fed. Cir. 1998).

of the interference count.[29] Accordingly, the earlier application must contain a written description of the subject matter of the interference count, and must meet the enablement requirement.[30] The sufficiency of the requisite written description in Hyatt's '881 application was at issue in *Hyatt*.[31]

In the present case, both Hyatt and Boone claimed the benefit of earlier-filed patent applications and relied on those applications as constructive reduction to practice.[32] Through a chain of nine prior applications, Boone was granted an effective filing date of July 19, 1971.[33] The Board granted Hyatt an effective filing date, through a chain of four prior applications, of December 14, 1977.[34] Hyatt claimed the benefit of a December 28, 1970 filing date based upon his application No. 05/101,881 ("the '881 application").[35]

II. PROCEDURAL HISTORY

In Hyatt's original '881 application, claim 40 described a data processing system implemented on a single integrated circuit chip.[36] Although other electronic data systems were described in detail, the '881 specification did not include any other mention of a single integrated circuit chip.[37] Hyatt argued that the text of claim 40 did indeed describe the subject matter of the interference count. Hyatt contended that: 1) the "read only memory means" of claim 40 was the same as the "integrated circuit main memory storing computer instructions" of the count, 2) the "alterable memory means" of claim 40 was the same as the "integrated circuit operand memory storing operands" of the count, and 3) the "program means" of claim 40 was the same as the "integrated circuit processing circuit" of

29. *See id.*

30. Section 120 states that for a benefit of an earlier filing date in the United States, "an application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States ... shall have the same effect, as to such invention, as though filed on the date of the prior application...." 35 U.S.C. § 120 (1998).

31. *See Hyatt*, 146 F.3d at 1352, 47 U.S.P.Q.2d at 1130.

32. *See id.* at 1351, 47 U.S.P.Q.2d at 1129.

33. *See id.* at 1351-1352, 47 U.S.P.Q.2d at 1129.

34. *See* Hyatt v. Boone, 146 F.3d 1348, 1352, 47 U.S.P.Q.2d (BNA) 1128, 1129 (Fed. Cir. 1998).

35. *See id.*

36. *See id.* at 1352, 47 U.S.P.Q.2d at 1130. Claim 40 reads, "An electronic data processing system including read only memory means, alterable memory means and program means, said system being implemented on a single integrated circuit chip." *Id.*

37. *See id.* at 1353, 47 U.S.P.Q.2d at 1130.

the count.[38] Hyatt asserted that his '881 specification contained extensive descriptions of various computer circuits, which supplemented the text of claim 40 by describing a computer consisting of various "integrated circuits mounted on multiple printed circuit boards and comprising a physically distributed, operatively dispersed system."[39]

The Board defined a sufficient written description under section 112 as "the 'necessary and only reasonable construction' that would be given it by a person skilled in the art is one that clearly supports each positive limitation in the count."[40] The Board determined that claim 40 "could be read as describing subject matter other than that of the count"[41] and, as such, "did not establish that Hyatt was in possession of the invention of the count."[42] Further, the Board found that the relevant descriptions that were absent from claim 40 were not provided elsewhere in the '881 specification, and that the "systems and circuitry neither describe nor suggest a computer on a single chip."[43] The Board concluded that "while two memories and a computer program may generally constitute a data processing system of some sort, they do not describe the invention set forth by the count."[44]

Hyatt and Boone submitted opposing views of the knowledge of one of ordinary skill in the field at the time the '881 patent application was filed.[45] Hyatt's witnesses testified that "a person of skill in this field would have known that the program means processed the operands in accordance with the read-only memory instructions, and would have easily understood that the program means, read only memory means, and alterable memory means cooperate in the way stated in the count."[46] The Board determined that although Hyatt's witnesses testified that the concept that a data processing system must include some sort of processing circuit was well-known, they did not establish "whether a data processing system must necessarily include the specific processing circuit required by the count."[47]

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38. *See id.*

39. *Id.*

40. Hyatt v. Boone, 146 F.3d 1348, 1353, 47 U.S.P.Q.2d (BNA) 1128, 1130-31 (Fed. Cir. 1998).

41. *Id.* at 1353, 47 U.S.P.Q.2d at 1131.

42. *Id.*

43. *Id.*

44. *Id.*

45. *See id.* at 1354, 47 U.S.P.Q.2d at 1131.

46. Hyatt v. Boone, 146 F.3d 1348, 1354, 47 U.S.P.Q.2d (BNA) 1128, 1131 (Fed. Cir. 1998).

47. *Id.*

The Board rejected Hyatt's argument, which was supported by witness testimony, that "the absent description would have been apparent to persons of skill in this field."[48] The Board reasoned that "if 'program means' can be a circuit (processor) that responds to a program as indicated by [Hyatt's] witnesses, it is at least as likely that it can be a memory that merely stores a program without processing operands."[49] Further, the Board ruled that witness testimony cannot be used to provide facts which the specification itself should provide.[50] Though courts have held that known details need not be disclosed in a patent specification,[51] the Board concluded that the content of the missing subject matter was not merely known details, but rather significant claim limitations.[52] The Board found that "the missing subject matter was not shown to be part of the prior art that would be understood as part of the description of the subject matter of the count."[53] Consequently, the Board did not grant Hyatt priority as to his '881 application and canceled the relevant claims of his '516 patent.[54] Hyatt disputed the denial of priority and contested the filing date awarded to Boone.[55]

After Boone initiated an interference with Hyatt and after Boone's '541 application was rejected on the ground of double patenting, Boone moved for permission to convert his '541 application to a Statutory Invention Registration ("SIR").[56] A SIR permits an inventor to waive the rights to receive a patent while still preserving the opportunity to contest priority through interference proceedings.[57] Boone contended that the conversion of his '541 application to a SIR "removed the only obstacle to patentability raised by the double patenting rejection, i.e. that of extension of effective patent life."[58] Since a SIR is not an enforceable patent, it would not effectively extend Boone's right to exclude others from practicing the invention.[59] A SIR would only preserve Boone's ability to practice his own

48. *Id.* at 1353, 47 U.S.P.Q.2d at 1131.

49. *Id.*

50. See *id.*

51. *See In re* Eltgroth, 419 F.2d 918, 921, 164 U.S.P.Q (BNA) 221, 223, (C.C.P.A. 1970).

52. *See* Hyatt v. Boone, 146 F.3d 1348, 1354, 47 U.S.P.Q.2d (BNA) 1128, 1132 (Fed. Cir. 1998).

53. *Id.*

54. *See id.* at 1351-52, 47 U.S.P.Q.2d at 1129.

55. *See id.* at 1352, 47 U.S.P.Q.2d at 1129.

56. *See id.* at 1356-1357, 47 U.S.P.Q.2d at 1134.

57. *See* 35 U.S.C. § 157 (1998).

58. Hyatt v. Boone, 146 F.3d 1348, 1357, 47 U.S.P.Q.2d (BNA) 1128, 1134 (Fed. Cir. 1998).

59. *See id.*

prior invention as against any later inventor and prevent a later inventor from obtaining a patent on the invention.[60] Boone argued that he was entitled to a decision as to patentability even though he would not obtain a patent.[61] Because Boone had requested a SIR, the Board refused to rule on the patentability of Boone's claims.[62] Boone challenged the Board's refusal to enter judgment of patentability.[63]

III. THE FEDERAL CIRCUIT OPINION

Hyatt appealed the decision of the Board, which entered judgment against Hyatt and canceled the relevant claims of his '516 patent.[64] Boone cross-appealed the Board's entry of judgment against him.[65] The Federal Circuit affirmed the Board's judgment against Hyatt, but modified the Board's judgment to declare Boone the prevailing party in the interference.[66]

As discussed earlier, both Hyatt and Boone claimed the benefit of earlier-filed patent applications and relied on these applications as constructive reduction to practice.[67] Judge Newman of the Federal Circuit established that conception was not at issue in the appeal, and that neither party presented evidence of actual reduction to practice.[68] The only issue was each party's entitlement to certain asserted dates of constructive reduction to practice. The Federal Circuit reviewed the Board's findings under the standard of clear error because compliance with the written description requirement is a question of fact.[69]

Judge Newman stated that "for an earlier-filed application to serve as constructive reduction to practice of the subject matter of an interference count, the applicant must describe the subject matter of the count in terms that establish that he was in possession of the later-claimed invention, including all of the elements and limitations presented in the count, at the

60. *See id.* at 1356, 47 U.S.P.Q.2d at 1134.
61. *See id.*
62. *See id.* at 1356-57, 47 U.S.P.Q.2d at 1134.
63. *See id.*
64. *See* Hyatt v. Boone, 146 F.3d 1348, 1351, 47 U.S.P.Q.2d (BNA) 1128, 1129 (Fed. Cir. 1998).
65. *See id.*
66. *See id.*
67. *See id.*
68. *See id.*
69. *See* Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 U.S.P.Q.2d (BNA) 1111, 1116 (Fed. Cir. 1991).

time of the earlier filing."[70] Although the court agreed with Hyatt's contention that known details do not have to be included in a patent specification,[71] Judge Newman stated that when an explicit limitation in an interference count is not present in the earlier written description, a person of ordinary skill must have understood, at the time of filing, that the description requires that limitation.[72] Further, Judge Newman emphasized that in order to establish priority, a sufficient written description must unambiguously describe all limitations of the count.[73] The Federal Circuit did not find clear error in the Board's decision that the missing subject matter was unknown details.[74] The court determined that significant claim limitations were absent from Hyatt's application, and that "the missing subject matter was not shown to be part of the prior art that would be understood as part of the description of the subject matter of the count."[75]

Hyatt argued that even if the Board's findings were not in error as to the content of the written description, the Board applied an erroneous legal standard in requiring that the specification "necessarily" describe the entire subject matter of the count.[76] Relying on *Vas-Cath Inc. v. Mahurkar*, Hyatt claimed that he only needed to "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he ... was in possession of the invention."[77] Hyatt contended that he fulfilled this prerequisite because claim 40 of his '881 application reasonably conveyed to persons of skill in this field that he possessed the invention of the count.[78] Hyatt stated that "reasonably conveys to the artisan" is a less rigorous and more reasonable determinant of the written description requirement than the "necessary and only reasonable construction" standard that the Board applied.[79]

Examination of case history reveals that a number of different expressions, including the "reasonably conveys to the artisan" and the "necessary

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70. Hyatt v. Boone, 146 F.3d 1348, 1353, 47 U.S.P.Q.2d (BNA) 1128, 1131 (Fed. Cir. 1998).

71. *See id.* (citing *In re* Eltgroth 419 F.2d 918, 921, 164 U.S.P.Q. (BNA) 221, 223 (C.C.P.A. 1970)).

72 . *See Hyatt*, 146 F.3d at 1353, 47 U.S.P.Q.2d at 1131.

73. *See id.* at 1354, 47 U.S.P.Q.2d at 1131.

74. *See id.* at 1354, 47 U.S.P.Q.2d at 1131-1132.

75. *Id.*

76. *See* Hyatt v. Boone, 146 F.3d 1348, 1354, 47 U.S.P.Q.2d (BNA) 1128, 1132 (Fed. Cir. 1998).

77. *Id.* (quoting Vas-Cath v. Mahurkar, 935 F.2d 1555, 1563-1564, 19 U.S.P.Q.2d (BNA) 1111, 1117 (Fed. Cir. 1991)).

78. *See Hyatt*, 146 F.3d at 1354, 47 U.S.P.Q.2d at 1132.

79. *See Hyatt*, 146 F.3d at 1354, 47 U.S.P.Q.2d at 1132.

and only reasonable construction" have been used by various courts.[80] In an attempt to reconcile the apparently diverging standards of the written description requirement, Judge Newman emphasized that, in all cases, the purpose of the description requirement is "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him."[81] Thus, the Federal Circuit held that "the written description must include all of the limitations of the interference count, or the applicant must show that any absent text is necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed."[82] The court concluded that the Board did not clearly err in finding that the written description of Hyatt's '881 application did not establish that Hyatt possessed the entire subject matter of the count, and thus affirmed the denial to Hyatt of the benefit of the '881 application date as constructive reduction to practice of the interference count.[83]

With regard to Boone's cross-appeal, the Federal Circuit affirmed the Board's decision that Boone was not entitled to a patent on the '541 application.[84] The court stated that although an inventor may withdraw a SIR application at any time before the PTO announces its intent to publish it, this option was foreclosed to Boone because of the intervening interference proceeding.[85] Because Boone requested a SIR which he could not withdraw, the Board correctly ruled that Boone was not entitled to a patent.[86] The Federal Circuit decided, however, that the Board was required to determine which party had prevailed on the issue of priority.[87] In fact, the Federal Circuit concluded that the Board had, in fact, decided priority.[88] Although Boone was not entitled to a patent, an adjudication of priority in his favor was permissible. Hence, the Federal Circuit modified the

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80. *See id.*

81. *Id.* at 1354, 47 U.S.P.Q.2d at 1132 (quoting *In re* Edwards, 568 F.2d 1349, 1351-1352, 196 U.S.P.Q. (BNA) 465, 467 (C.C.P.A. 1978)).

82. Hyatt v. Boone, 146 F.3d 1348, 1354-55, 47 U.S.P.Q.2d (BNA) 1128, 1132 (Fed. Cir. 1998).

83. *See id.* at 1355, 47 U.S.P.Q.2d at 1132.

84. *See id.* at 1357, 47 U.S.P.Q.2d at 1134.

85. *See id.*

86. *See id.*

87. *See id.*

88. *See* Hyatt v. Boone, 146 F.3d 1348, 1357, 47 U.S.P.Q.2d (BNA) 1128, 1134 (Fed. Cir. 1998). Because the Board held that Hyatt was not entitled to his '881 application date, and confirmed that Boone was entitled to the benefit of his '565 application date of July 19, 1971, priority had been decided. *See id.*

Board's judgment to state that priority as to the count was awarded to Boone.[89]

IV. DISCUSSION

In *Hyatt*, Judge Newman evaluated the various expressions used to define the sufficiency of the written description requirement for purposes of section 112. A clear and consistent written description standard is indispensable to inventors and practitioners in both the preparation and litigation of patent applications. The written description requirement frequently becomes an issue of contention in three circumstances.[90] First, a written description question is likely to arise when claims not presented at time of filing are presented at a later time.[91] Second, problems occur in cases in which patent applicants seek the benefit of the filing date of an earlier-filed application.[92] Finally, as in *Hyatt*, a written description question may arise in an interference proceeding in which one party must support the claim of the interference count.[93]

Admittedly, the Federal Circuit has used different expressions in describing a sufficient written description.[94] Judge Newman, however, "[did] not view these various expressions as setting divergent standards for compliance with [section] 112."[95] She emphasized that, in all cases, the purpose of the written description requirement was to ensure that the inventor had possession of the claimed invention at the time of the application filing date.[96] Analysis of historical and policy rationale of section 112 supports Judge Newman's view of the written description requirement.

A. The Written Description Requirement: History and Policy Rationale

Consideration of the historical and policy rationale of the written description requirement facilitates reconciliation of apparently inconsistent standards.[97] The Patent Act of 1793 required that a patent applicant "de-

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89. *See id.*

90. *See* Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1560, 19 U.S.P.Q.2d (BNA) 1111, 1114 (Fed. Cir. 1991).

91. *See id.*

92. *See id.*

93. *See id.*

94. *See* Hyatt v. Boone, 146 F.3d 1348, 1354, 47 U.S.P.Q.2d (BNA) 1128, 1132 (Fed. Cir. 1998).

95. *Id.*

96. *See id.*

97. *Cf.* Janice M. Mueller, *The Evolving Application of the Written Description Requirement to Biotechnological Inventions,* 13 BERKELEY TECH. L.J. 615, 618-623 (Spring

liver a written description of his invention ... in such full, clear and exact terms, as to distinguish the same from all things before known, and to enable any person skilled in the art ... to make, compound and use the same."[98] Based on this requirement, the Supreme Court in *Evans v. Eaton*[99] identified the two goals of a patent specification. The first object was "to enable artizans [sic] to make and use [the invention]...."[100] The second aim of the specification, as interpreted by the *Evans* court, highlighted the underlying policy behind the written description requirement. The *Evans* court stated that an inventor must "put the public in possession of what the party claims as his own invention, so as to ascertain if he claims anything that is in common use, or is already known."[101] Thus, the Supreme Court enunciated a "notice" function of a patent specification which would presumably "guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented."[102] The written description was necessary, then, to both warn "an innocent purchaser, or other person using a machine, of his infringement of the patent" and to prevent the inventor from "pretending that his invention is more than what it really is."[103] At the time *Evans* was decided, claims were not required, and the written description served to put the public on notice of the scope of the patentee's invention.[104]

The Patent Act of 1870 expressly required the inclusion of claims.[105] In this "post-claim" era, the United States Court of Customs and Patent Appeals ("CCPA") differentiated the two goals of the patent specification in *In re Ruschig*,[106] decided in 1967. The CCPA held that the "make and use," or enablement provision, was separate from the written description provision.[107] The court emphasized that "the question is not whether [one skilled in the art] would be so enabled but whether the specification discloses the [invention] to him, specifically, as something appellants actually invented."[108] The pertinent question in determining the sufficiency of

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1998) (discussing the purpose and development of the written description requirement in relation to biotechnological inventions).

98. Patent Act of 1793, § 3, 1 Stat. 318, 321 (repealed 1836).
99. 20 U.S. (7 Wheat.) 356 (1822).
100. *Id.* at 433.
101. *Id.* at 434.
102. *Id.*
103. *Id.*
104. *See* Mueller, *supra* note 97, at 619-620.
105. *See id.*
106. 379 F.2d 990, 995-996, 154 U.S.P.Q. (BNA) 118, 123 (C.C.P.A. 1967).
107. *See id.*
108. *Id.* at 995, 154 U.S.P.Q. at 123.

the written description then became: "does the specification convey clearly to those skilled in the art, to whom it is addressed, *in any way*, the information that appellants invented that specific [invention claimed]?"[109]

Hence, the written description requirement evolved from a notice requirement, as described in *Evans*, to a requirement that the inventor demonstrate that he or she was in possession of the invention at the time of the application filing date.[110] Thus, Judge Newman's proposal that the fundamental principle underlying the written description requirement is that the inventor show that he was in possession of the claimed subject matter is consonant with the modern function and policy rationale of the written description requirement.

B. Precedential Analysis of the Various Expressions Used to Define a Sufficient Written Description

An analysis of case history reveals that courts have used a number of different written description standards, including the "necessary and only reasonable construction" standard used by the Board in the instant case and the "reasonably conveys to the artisan" standard championed by *Hyatt*.[111] In *Vas-Cath*, the court stated that the applicant must "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention."[112] Similarly, a number of courts have also stated that "the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question."[113] But, courts have also adopted a seemingly more stringent approach in stating that the disclosure relied on must constitute "a full, clear, concise and exact description in accordance with [section] 112, first paragraph, of the invention claimed."[114]

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109. *Id.* at 996, 154 U.S.P.Q. at 123 (emphasis added).

110. *See* Mueller, *supra* note 97, at 620.

111. *See* Hyatt v. Boone, 146 F.3d 1348, 1354, 47 U.S.P.Q.2d (BNA) 1128, 1132 (Fed. Cir. 1998).

112. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-1564, 19 U.S.P.Q.2d (BNA) 1111, 1117 (Fed. Cir. 1991).

113. *See* Fujikawa v. Wattanasin, 93 F.3d 1559, 1570, 39 U.S.P.Q.2d (BNA) 1895, 1904 (Fed. Cir. 1996); Fiers v. Revel, 984 F.2d 1164, 1170, 25 U.S.P.Q.2d (BNA) 1601, 1606 (Fed. Cir. 1993) (same); *In re* Kaslow, 707 F.2d 1366, 1375, 217 U.S.P.Q. (BNA) 1089, 1096 (Fed. Cir. 1983); *In re* Ruschig, 379 F.2d 990, 996, 154 U.S.P.Q. (BNA) 118, 123 (C.C.P.A. 1967) ("Does the specification convey clearly to those skilled in the art, to whom it is addressed, in any way, the information that appellants invented that specific compound?").

114. *In re* Wertheim, 646 F.2d 527, 538-539, 209 U.S.P.Q. (BNA) 554, 565 (C.C.P.A. 1981).

As stated earlier, the *Ruschig* court noted that a specification must "convey clearly to those skilled in the art" that the applicant invented the claimed invention.[115] At first glance, this statement seems to exemplify a less rigorous standard than a "necessary and only reasonable construction" standard. Closer examination of the *Ruschig* decision, however, suggests that the underlying legal philosophy was much more stringent. In declaring a particular written description to be inadequate, Judge Rich provided the following colorful analogy:

> It is an old custom in the woods to mark trails by making blaze marks on the trees. It is no help in finding a trail or in finding one's way through the woods where the trails have disappeared—or have not yet been made, which is more like the case here—to be confronted simply by a large number of unmarked trees. Appellants are pointing to trees. We are looking for blaze marks which single out particular trees. We see none.[116]

As in the *Ruschig* decision, purportedly lenient written description requirements can be unveiled to reveal more rigorous standards in a number of cases following *In re Ruschig*. For instance, in *Fujikawa v. Wattanasi*, the Federal Circuit stated that "ipsis verbis disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question."[117] However, the *Fujikawa* court, extending the *Ruschig* analogy, proclaimed that "it is easy to bypass a tree in the forest, even one that lies close to the trail, unless the point at which one must leave the trail to find the tree is well marked."[118] Hence, an adequate written description must not only direct one to the proposed tree in particular, but also teach the point at which one should leave the trail to find it.[119] Moreover, the *Fujikawa* court stated that even if, in hindsight, a particular substitution, invention, or embellishment seems simple and foreseeable, it must have been clear to one of ordinary skill at the time of the disclosure.[120]

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115. *In re Ruschig* 379 F.2d at 996, 154 U.S.P.Q. at 123.

116. *Id.* at 994-995, 154 U.S.P.Q. at 122.

117. *Fujikawa*, 93 F.3d at 1570, 39 U.S.P.Q.2d at 1904 (citing *In re* Edwards, 568 F.2d 1349, 1351-52, 196 U.S.P.Q. (BNA) 465, 467 (C.C.P.A. 1978)).

118. *Id.* at 1571, 39 U.S.P.Q.2d at 1905.

119. *See* Fujikawa v. Wattanasin, 93 F.3d 1559, 1571, 39 U.S.P.Q.2d (BNA) 1895, 1905 (Fed. Cir. 1996).

120. *See id.*

In *Fiers v. Revel*, the Federal Circuit also used a "reasonably conveys to the artisan" standard.[121] However, the court noted that correspondence between the language of the count and language in the specification was insufficient to satisfy the written description requirement when none of that language *particularly* described the contested claim.[122] Extrapolating this sentiment to *Hyatt*, Hyatt's contention that the language of claim 40 corresponded to the subject matter of the interference count remains unpersuasive.

Judge Newman's position that compliance with section 112 requires a demonstration that the inventor was in possession of the claimed subject matter even comports with the views expressed in *Vas-Cath*—the very case on which Hyatt relies. Although the standard in *Vas-Cath* appears to be "reasonably conveys to the artisan," the *Vas-Cath* court ruled that "the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was *in possession* of the invention."[123]

Recently, legal scholars have expressed concern that the Federal Circuit is moving towards a heightened written description requirement, particularly in the field of biotechnology.[124] In *Regents of the University of California v. Eli Lilly,*[125] the court held that a functional description of DNA was inadequate for the purposes of section 112. Instead, a sufficient description of DNA required "specificity usually achieved by means of the recitation of the sequence of nucleotides that make up the DNA."[126] Although, the *Lilly* court's elevation of the written description requirement is a valid concern in biotechnology patents, Judge Newman did not extrapolate this newly evolved heightened standard to *Hyatt.* Rather, by emphasizing that an inventor demonstrate possession of the claimed invention, she reverted back to the roots of the written description requirement.

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121. See Fiers v. Revel, 984 F.2d 1164, 1170, 25 U.S.P.Q.2d (BNA) 1601, 1606 (Fed. Cir. 1993).

122. *See id.* at 1171, 25 U.S.P.Q.2d at 1606.

123. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-1564, 19 U.S.P.Q.2d (BNA) 1111, 1117 (Fed. Cir. 1991) (emphasis added).

124. *See generally* Mueller, *supra* note 97 (stating that the Federal Circuit's decision in *Regents of the Univ. of Cal. v. Eli Lilly* established rigorous rules for description of biotechnological inventions, and contorted the written description requirement away from its historical and policy rationale). *See generally* Michael Delmas Plimier, Note, *Genentech, Inc. v. Novo Nordisk & University of California v. Eli Lilly and Co.*, 13 BERKELEY TECH. L.J. 149 (1998) (discussing the implications of recent Federal Circuit decisions which illustrate the court's reluctance in granting overly broad patents).

125. 119 F.3d 1559, 43 U.S.P.Q.2d 1398 (Fed. Cir. 1997).

126. *Id.* at 1569, 43 U.S.P.Q.2d at 1406.

Although precedent has used different phrases in describing a sufficient written description, the underlying principle in these cases is not malleable. In line with Judge Newman's approach, these previous cases established that an inventor must prove that he or she was in possession of the claimed invention at the time of filing.

V. CONCLUSION

In *Hyatt*, the Federal Circuit attempted to reconcile the apparently divergent written description standards that have been advanced by previous decisions. Judge Newman enunciated that the written description, in all cases, served to verify that the inventor had possession of the claimed subject matter.[127] In light of the policy reasons for the written description requirement, debate over precisely which standard should used is misguided; the real issue is whether the inventor had possession of the claimed subject matter at the time of filing. In the instant case, it is not clear that Hyatt did.

It is unlikely that the opinion in *Hyatt* will quell the debate over the written description requirement. Opposing parties will inevitably debate the "true" meaning of the phrase "the inventor had possession." The opinion in *Hyatt* would have been more complete had Judge Newman offered a clear definition of how the Federal Circuit defines "possession." Nonetheless, Judge Newman's approach to the written description requirement is a step towards enlightening both inventors and practitioners as to "what the law of the Federal Circuit is."[128]

127. *See* Hyatt v. Boone, 146 F.3d 1348, 1354, 47 U.S.P.Q.2d (BNA) 1128, 1132 (Fed. Cir. 1998).

128. Vas-Cath Inc. v. Mahurkar, 745 F. Supp. 517, 522 (N.D. Ill. 1990), *rev'd* 935 F.2d 1555, 19 U.S.P.Q.2d (BNA) 1111 (Fed. Cir. 1991).