

---

---

**SUPREME COURT REVIEW OF PATENT CASES:  
WHAT WILL FOLLOW EBAY, MEDIMMUNE, AND KSR?**

Donald Steinberg, David Chavous\*

Cite as 8 J. HIGH TECH. L. 185 (2008)

I. Introduction

Since its inception, the United States Court of Appeals for the Federal Circuit (“Federal Circuit”) has had an evolving relationship with the United States Supreme Court. Congress established the Federal Circuit pursuant to the Federal Courts Improvement Act of 1982, in part, to eliminate inconsistent decisions rendered in patent-related cases.<sup>1</sup> In many ways, this was in response to Congress’s expressed displeasure with the state of patent law and enforcement in the United States as of 1982.<sup>2</sup> It was under those circumstances that the Federal Circuit came into being, and assumed its role as the overseer of the patent system.

Of course, the Federal Circuit has not replaced the Supreme Court as ultimate arbiter on issues of patent law. Nevertheless, the Federal Circuit operated with little oversight from the Supreme Court on patent-related matters for the majority of its history. In its first twelve years, the Supreme Court granted certiorari to only six decisions relating to patent cases.<sup>3</sup> Unsurprisingly, the lack of Supreme Court oversight leads commentators to look to the Federal Circuit as the nation’s top patent

---

\* Donald Steinberg is chair of the Intellectual Property Department at Wilmer Hale, JD, *cum laude*, Harvard Law School, 1988, BSE, Electrical Engineering and Computer Science, *magna cum laude*, Princeton University, 1984. David Chavous is an associate in Wilmer Hale’s Intellectual Property Department, JD, *cum laude*, Boston College Law School, 2004, PhD, Biology, Boston College, 2001, BS, Biology, University of Massachusetts, Amherst, 1995.

1. See Pub. L. No. 97-164, § 302, 96 Stat. 25 (1982); see also Chem. Eng’g Corp. v. Marlo, Inc., 754 F.2d 331, 332 (Fed. Cir. 1984).

2. See Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp., 383 F.3d 1337, 1343 (Fed. Cir. 2004).

3. Hon. Arthur J. Gajarsa & Dr. Lawrence P. Cogswell, *The Federal Circuit And The Supreme Court*, 55 AM. U. L. REV. 821, 821-22 (2006).

court – implying that it is the only court that matters on issues of patent law.<sup>4</sup>

The situation, however, may be changing. The Supreme Court has granted certiorari on an increasing number of patent cases.<sup>5</sup> In many of these cases, the Court primarily granted certiorari to deal with perceived splits among different panels, or judges, in the Federal Circuit.<sup>6</sup> In this role, the Court acted to resolve conflicts within Federal Circuit case law.

Currently pending before the Supreme Court is the question of whether the Federal Circuit's jurisprudence regarding patent exhaustion conflicts with Supreme Court jurisprudence.<sup>7</sup> In *Quanta Computer*, the petitioners contend that the Federal Circuit undermined the principle that an authorized sale of a patented article or an article embodying essential features of a patented invention exhausts the patentee's patent rights relating to that article.<sup>8</sup>

While the outcome in *Quanta Computer* remains to be seen, the Supreme Court recently identified divergences between its jurisprudence and the Federal Circuit's application of its jurisprudence.<sup>9</sup> Most recently, the Supreme Court articulated its concern in a unanimous decision rejecting the Federal Circuit's "rigid approach" to applying the teaching-suggestion-motivation test in *KSR*.<sup>10</sup> The Court held the Federal Circuit's application of the test to be "inconsistent with § 103 and this Court's precedents."<sup>11</sup> In finding the claimed invention

---

4. See Marcia Coyle, *Critics Target Federal Circuit*, *The National Law Journal*, (Oct. 19, 2006) archived at <http://www.webcitation.org/5WYwOxwMT>.

5. See Gajarsa & Cogswell, *supra* note 3, at 821-22 (noting that, in the 2005 and 2006 terms, the Supreme Court heard four patent cases).

6. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 723 (2002) (noting significant disagreement among the Federal Circuit judges); *Dickinson v. Zurko*, 527 U.S. 150, 153 (1999) (noting disagreement in Federal Circuit); *Pfaff v. Wells Elecs.*, 525 U.S. 55, 60 (1998) (noting Federal Circuit law diverging from previous regional Circuit case law); *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997) (noting disagreement within the Federal Circuit).

7. See *LG Elecs, Inc. v. Bizcom Elecs., Inc.*, 453 F.3d 1364 (Fed. Cir. 2006), *cert. granted sub nom Quanta Computer, Inc. v. LG Elecs., Inc.*, 128 S.Ct. 28 (2007).

8. See Brief for Petitioners in *Quanta Computer, Inc. v. LG Electronics, Inc.*, No. 06-937 (Nov. 5, 2007).

9. See *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007); *MedImmune, Inc v. Genentech, Inc.*, 127 S.Ct. 764 (2007); *eBay Inc. v. MercExchange, L.L.C.*, 126 S.Ct. 1837, 1839 (2006).

10. See *KSR Int'l Co.*, 127 S.Ct. at 1739.

11. *Id.* at 1730.

obvious, the Court observed that rigid, preventive rules, such as the Federal Circuit's application of the "teaching-suggestion-motivation test," which prevents the use of common sense, were neither necessary, nor consistent with the Court's case law.<sup>12</sup> Nevertheless, the "teaching-suggestion-motivation test" was not completely rejected in *KSR*.<sup>13</sup> The Court merely rejected the Federal Circuit's application of the test.<sup>14</sup> It noted that the "teaching-suggestion-motivation test" had diverged from precedent, and applied in a manner inconsistent with the public's desire to prevent the withdrawal of knowledge from the prior art into a patent's monopoly.<sup>15</sup> Lower courts, therefore, could not continue to apply the test as it had been applied in *KSR* and other cases.

Before *KSR*, the Court reversed the Federal Circuit regarding the standing requirement for a patent licensee to bring declaratory judgment proceedings in District Court.<sup>16</sup> The Court found that the reasoning of the Federal Circuit diverged from its precedent and the common interpretation of the Declaratory Judgment Act in other courts.<sup>17</sup> The majority was particularly concerned with the apparent willingness of the Federal Circuit to distinguish its precedent to reach a certain conclusion, particularly noting that, even if its precedent could be distinguished, the Federal Circuit's test still contradicted the Federal Circuit's own precedent.<sup>18</sup>

In 2006, prior to the decision in *MedImmune, Inc. v. Genetech, Inc.*<sup>19</sup>, the Court questioned the Federal Circuit's application of equitable principles in evaluating requests for permanent injunctions following a finding of infringement.<sup>20</sup> The majority held that "well-established principles of equity" were to be applied to the granting of permanent injunctions in patent cases.<sup>21</sup> The Court expressed concern with the categorical grant of relief under the Federal Circuit's "general rule."<sup>22</sup> As in *MedImmune*, the Court rejected an established Federal Circuit rule under the premise that the Federal Circuit's rule conflicted with

---

12. *See id.* at 1742-43.

13. *See id.* at 1741-42.

14. *See KSR Int'l Co.*, 127 S.Ct. at 1732.

15. *See id.*

16. *See MedImmune, Inc.*, 127 S.Ct. at 766-67.

17. *See id.* at 773-74 (noting that *Altwater v. Freeman* was fortuitously close on its facts and citing several cases from regional circuits and state courts showing the common interpretation of the Declaratory Judgment Act).

18. *See id.* at 774.

19. 127 S.Ct. 764 (2007).

20. *See eBay*, 126 S.Ct. at 1837.

21. *See id.*

22. *See id.* at 1839, 1841.

precedent.

If the opinions in *KSR*, *MedImmune*, and *eBay* are any indication, Federal Circuit jurisprudence may face an eventful new period of Supreme Court review. The Court is reviewing Federal Circuit decisions more closely for consistency with earlier Supreme Court decisions and principles.

The Supreme Court has not ruled on some issues related to patent law in decades (*e.g.*, patent exhaustion, as in *Quanta Computer*,<sup>23</sup> or assignor estoppel) and has never directly ruled on other issues (*e.g.*, willful infringement). The Federal Circuit, therefore, is not necessarily inconsistent with the Supreme Court in these and other areas. It is, after all, deciding cases in an evolving area of law and in the context of new technologies. Nonetheless, any perceived divergence between Federal Circuit reasoning and Supreme Court precedent will be open to review in this new era of Supreme Court patent law activism. In the following analysis, we identify three areas of potential conflict (other than patent exhaustion) between Federal Circuit case law and Supreme Court precedent: willful infringement, assignor estoppel, and the written description requirement.

## II. Willful Infringement

Patent infringement involves making, using, selling, or offering for sale a patented (claimed) invention without the permission of the patent owner.<sup>24</sup> Patent infringement does not require a showing of intent to infringe, and can occur even when ignorant of the patent.<sup>25</sup> Nonetheless, showing intent can allow a patent owner to obtain increased damages against an alleged infringer pursuant to 35 U.S.C. § 284.<sup>26</sup> The Federal Circuit requires a showing of willful infringement for such increased damages because it is a form of punitive damages, awarded to punish the behavior of the infringer.<sup>27</sup>

The Supreme Court has rarely ruled on the concept of enhanced damages in patent law. It last ruled directly on this matter in *Topliff v.*

---

23. See Brief for Petitioners, *Quanta Computer, Inc.*, No. 06-937 at 10-11.

24. See 35 U.S.C. § 271(a) (2007); see also *Standard Oil Co. v. Amer. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985).

25. See 35 U.S.C. § 271(c).

26. 35 U.S.C. § 284 reads, in part: "Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement...[t]he court may increase the damages up to three times the amount found or assessed." See *Fla. Prepaid Postsecondary Educ. Expense Bd. v. College Sav. Bank*, 527 U.S. 627, 645 (1999).

27. See *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1574 (Fed. Cir. 1996).

*Topliff*, prior to the turn of the twentieth century.<sup>28</sup> Still, the Supreme Court has ruled extensively on the concept of punitive damages as it relates to tort law. Those decisions elucidate the Court's views on enhancing damages, especially with regard to purely economic harms such as patent infringement.<sup>29</sup> The following review of Supreme Court case law is merely to provide a very brief overview on the Court's reasoning as it applies to willfulness generally. It is not intended to fully analyze Supreme Court case law as it relates to enhanced damages in tort law, as that discussion is beyond the scope of this article.

The Supreme Court holds that punitive damages (*i.e.*, exemplary damages) may be awarded where wanton, malicious or deliberate actions occur in tort.<sup>30</sup> In the Court's view, these actions are punishable by increased damages.<sup>31</sup> Punitive damages serve the legitimate interests of the government by punishing unlawful, deliberate conduct and deterring repetition.<sup>32</sup> The award of punitive damages is not without its limits.<sup>33</sup> First, the plaintiff must establish that the defendant's behavior was "reprehensible,"<sup>34</sup> requiring that the "defendant's culpability, after having paid compensatory damages, is so reprehensible as to warrant the imposition of further sanctions to achieve punishment or deterrence."<sup>35</sup> Therefore, acts that do not rise to the level of "reprehensible" conduct do not warrant the imposition of punitive damages.<sup>36</sup>

Additionally, the award must not be excessive. The Supreme Court explained that punitive damages awards cannot be grossly excessive as compared to the harm suffered and the facts and circumstances surrounding the defendant's conduct.<sup>37</sup> Even relatively minor punitive damages awards can be excessive in cases where, as in patent cases, the harm to the plaintiff was merely economic and the plaintiff could be

---

28. See *Topliff v. Topliff*, 145 U.S. 156 (1892); see also *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 508 (1964) (stating in dicta that punitive damages were available for willful infringement).

29. See *Topliff*, 145 U.S. at 156.

30. See, e.g., *Seymour v. McCormick*, 57 U.S. 480, 488-89 (1854) ("where the injury is wanton or malicious, a jury may inflict vindictive or exemplary damages, not to recompense the plaintiff, but to punish the defendant").

31. See *id.* at 489.

32. See *BMW of N. Am. v. Gore*, 517 U.S. 559, 568 (1996) (citing *Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974)).

33. See *Gore*, 517 U.S. at 576-77.

34. See *id.* at 568.

35. See *id.* at 575.

36. See *id.*

37. See *Gore*, 517 U.S. at 575 (citing *Day v. Woodworth* 13 U.S. 363 (1 How. 1852)).

made whole by compensatory damages.<sup>38</sup> In order to determine whether a particular punitive damage award is fair in light of the defendant's actions, three guideposts are considered prior to the imposition of punitive damages, 1) the degree of reprehensibility of the defendant's misconduct; 2) the disparity between the actual or potential harm suffered by the plaintiff and the punitive damages award; and 3) the difference between the punitive damages awarded by the jury and the civil penalties authorized or imposed in other cases.<sup>39</sup> Even if the defendant's conduct is reprehensible, the damages award must satisfy the Due Process clause's guarantees against excessive awards.<sup>40</sup>

The Supreme Court adopted a restrictive position on punitive damages in patent law as well.<sup>41</sup> In *Seymour*, the plaintiff brought an infringement suit against defendant's grain reaping device, and alleged that the defendant willfully infringed his patent.<sup>42</sup> The plaintiff had licensed the patent to the defendant, but the defendant refused to complete payments on the license based upon its belief that the plaintiff was not the true inventor.<sup>43</sup> The trial court ruled that the defendant had pirated (*i.e.*, willfully infringed) the patent, and awarded increased damages.<sup>44</sup> In vacating the damages award, the Supreme Court noted that property law generally did not recognize treble damages for taking the property of another.<sup>45</sup> In addition, it was improper to award punitive damages when the defendants had "in ignorance or in good faith" believed that another patentholder was the true inventor.<sup>46</sup> The Court also observed that treble damages were acceptable in only those instances when "wanton or malicious" conduct was punished.<sup>47</sup>

In *Seymour*, the Supreme Court equated treble damages awards in patent infringement to other punitive—exemplary—damages awards in tort.<sup>48</sup> The conduct of an infringer had to be "wanton or malicious," which would qualify as "reprehensible" under recent Supreme Court punitive damages decisions.<sup>49</sup> The message from the Supreme Court is

---

38. *See id.* at 576-77.

39. *See id.* at 575.

40. *See id.* (citing *Shaffer v. Heitner*, 433 U.S. 186 (1977) (Stevens, J., concurring)).

41. *See Seymour*, 57 U.S. at 488.

42. *See id.* at 485.

43. *See id.*

44. *See id.*

45. *See Seymour*, 57 U.S. at 488-89.

46. *See id.* at 488.

47. *See id.*

48. *See id.*

49. *See Seymour*, 57 U.S. at 488-489; *see Gore*, 517 U.S. at 575-576.

that *limited* punitive damages awards further the state's legitimate interest to punish *reprehensible* behavior, not to recompense a plaintiff or punish merely bad behavior.

The patent laws, however, have been shaped by the Federal Circuit to include an inquiry into whether an infringer's actions were "willful." Even though the patent statute does not use the word "willful," the Federal Circuit shaped the doctrine of willful infringement in patent law through a series of decisions starting with *Underwater Devices Inc. v. Morrison-Knudsen Co.*<sup>50</sup> In *Underwater Devices*, the Federal Circuit explained that where an infringer has actual notice of another's patent rights, the infringer had an affirmative duty to exercise due care to determine whether or not it is infringing the patent, including seeking competent legal advice before beginning potentially infringing activity.<sup>51</sup> As an affirmative duty, the infringer was responsible for showing that it tried to avoid infringement, even if it was not necessarily apparent that the defendant was infringing the patent.<sup>52</sup> To find willful infringement, a court must review the totality of the circumstances presented in the case to determine whether the defendant failed to exercise a duty of due care.<sup>53</sup>

The totality of the circumstances approach is exemplified in *Central Soya Co.*<sup>54</sup> In upholding the district court's finding of willful infringement, the Federal Circuit noted several instances of questionable behavior.<sup>55</sup> The panel found that the defendant obtained legal advice in which counsel did not attempt to search for prior art.<sup>56</sup> The Federal Circuit concluded that the defendant "had not only [failed] to show an opinion from competent counsel but also that it had exercised reasonable and good faith adherence to the analysis and advice."<sup>57</sup> In its inquiry, the panel required the defendant to show that it tried to avoid infringement

---

50. 717 F.2d 1380 (Fed. Cir. 1983).

51. *See id.* at 1389. The Federal Circuit has heard argument en banc in *In re Seagate Technology L.L.C.*, in which it is considering whether the court should reconsider the duty of care standard announced in *Underwater Devices*. This reconsideration relates to the other issue the court is considering in *Seagate Technology*: the scope of a waiver of the attorney-client privilege and of work product when an accused infringer relies on the advice of counsel.

52. *See id.* at 1389-90.

53. *See Cent. Soya Co. v. Geo. A. Hormel & Co.*, 723 F.2d 1573, 1577 (Fed. Cir. 1983) (noting that the counsel's opinion by itself was not dispositive, and further noting that the counsel's opinion reviewed prior art from the file history alone).

54. 723 F.2d 1573 (Fed. Cir. 1983).

55. *See id.*

56. *See id.*

57. *See id.*

or it had reason to believe the patent was invalid.<sup>58</sup> The totality of the circumstances test essentially shifted the burden to the defendant to show that it acted in good faith.<sup>59</sup>

The *Central Soya* and *Underwater Devices* opinions established willful infringement as an instrument to punish defendants who fail to show that they exercised their duty of due care. As the Federal Circuit later ruled, an infringer having “actual notice of another’s patent rights” and failing to exercise an affirmative duty of due care is a willful infringer subject to increased damages.<sup>60</sup> Over the years, the Federal Circuit found indicia of willful behavior to include failure to obtain an opinion of counsel,<sup>61</sup> failure to consult an attorney following an infringement charge<sup>62</sup>, not procuring a patent search<sup>63</sup>, and oral opinions consisting of conclusory statements without supporting reasons.<sup>64</sup> Under *Knorr-Bremse*, withholding an opinion of counsel no longer carries a negative inference, and opinions of counsel are but one of many factors in a determination of willful infringement, not the only factor to be considered.<sup>65</sup> However, the existence of a substantial defense to infringement is not necessarily sufficient to defeat a claim for willful infringement, and the test remained “whether a prudent person would have sound reason to believe that the patent was not infringed or was invalid or unenforceable, and would be so held if litigated.”<sup>66</sup> Clearly, the standard trended toward conduct that encompassed negligent action, which fell short of the standard for enhanced damages or even willful conduct explained in Supreme Court precedent.<sup>67</sup>

The development of the “willfulness” or “duty to exercise due care”

---

58. *See Cent. Soya Co.*, 723 F.2d at 1577.

59. *See L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1226 (Fed. Cir. 1993) (defendant “introduced no evidence . . . or any other support for a good faith belief that it was entitled to perform the infringing acts”).

60. *See Rolls-Royce, Ltd. v. GTE Valeron Corp.*, 800 F.2d 1101, 1109 (Fed. Cir. 1986).

61. *See id.* (defendant introduced “no evidence of whether it obtained an opinion of counsel that the '081 patent was not valid or not infringed”).

62. *See Del Mar Avionics, Inc. v. Quinton Instrument Co.*, 836 F.2d 1320, 1328 (Fed. Cir. 1987).

63. *See id.*

64. *See Bott v. Four Star Corp.*, 807 F.2d 1567, 1572 (Fed. Cir. 1986), *overruled on other grounds*, *A.C. Aukerman Co. v. R.L. Chaides Const. Co.*, 960 F.2d 1020 (Fed. Cir. 1992).

65. *See generally Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004).

66. *See id.* at 1347, *quoting SRI Int'l, Inc. v. Advanced Tech. Labs, Inc.*, 127 F.3d 1462, 1465 (Fed. Cir. 1997).

67. *See id.* at 1342.



standard may lie in the Federal Circuit's understanding of why it came into being. The panel majority in *Knorr-Bremse* observed that "fundamental to determination of willful infringement is the duty to act in accordance with the law [and] [r]einforcement of this idea was a foundation of the Federal Circuit at a time . . . when widespread disregard of patent rights was undermining . . . innovation."<sup>68</sup> With this worldview and pursuant to the "increased damages" provision of section 284 of the Patent Act, the Federal Circuit set out to punish infringers who showed little or no regard for patent rights.<sup>69</sup> Willful infringement serves this function, allowing courts to deter willful patent infringement, which, "like other civil wrongs, is disfavored and . . . warrants deterrence."<sup>70</sup> The Federal Circuit assumed the mantle of protecting the nation's patent system by enforcing the idea that infringers must act in accordance with the patent law.<sup>71</sup>

However, its standard diverged somewhat from the principles of tort law that underpin the doctrine and the *patent statute itself*. As an initial matter, the doctrine conflicted with Supreme Court law that described such conduct as more than merely negligent behavior<sup>72</sup>, defining "willful" to be intentional, reckless, or deliberate.<sup>73</sup> Even in the one patent case discussing enhanced damages, the Court required that "wanton or malicious" behavior be shown prior to the imposition of increased damages, which is more in line with the "reprehensible" conduct standard than a negligence standard.<sup>74</sup> Nonetheless, in patent law willful infringement merely required "actual notice of another's patent rights" and lack of evidence that the defendant exercised a duty of due care.<sup>75</sup> No requirement existed to show intentional or deliberate infringement to establish that the defendant's conduct was "wanton or malicious,"<sup>76</sup> mere knowledge sufficed.

Recognizing that its standard appeared to be in tension with Supreme Court precedent and noting significant issues relating to the waiver of privilege under its case law, the Federal Circuit reviewed its *Underwater*

---

68. *See id.* at 1343, *citing* Advisory Committee on Industrial Innovation Final Report, Dep't of Com. (Sept. 1979).

69. *See Knorr-Bremse*, 383 F.3d at 1342.

70. *Id.* at 1342.

71. *See id.* at 1341.

72. *See McLaughlin v. Richland Shoe Co.*, 486 U.S. 128, 133 (1988).

73. *See, e.g., id.* at 133; *see Safeco Ins. Co. of Am. v. Burr*, 127 S.Ct. 2201 (2007).

74. *See Seymour*, 57 U.S. at 488.

75. *See, e.g., Rolls Royce*, 800 F.2d at 1109.

76. *See, e.g., Underwater Devices*, 717 F.2d at 1389.

*Devices* reasoning in *In re Seagate*.<sup>77</sup> The case involved an infringement suit in which the alleged infringer received three opinions of counsel regarding invalidity and non-infringement of patent claims at issue.<sup>78</sup> The alleged infringer notified the patentholder of its intent to rely on these opinions and the patentholder argued that the alleged infringer waived its attorney-client privilege to communications with both its opinion counsel and trial counsel.<sup>79</sup> The district court agreed, ordering production of all documents relating to the validity and non-infringement of the claims.<sup>80</sup> The alleged infringer filed a writ of mandamus requesting review of the finding of waiver of privilege for communications of trial counsel; the Federal Circuit took the appeal.<sup>81</sup>

In reversing the district court, the Federal Circuit *en banc* went beyond the limited question of whether a waiver of privilege of communications with trial counsel occurs when relying on an opinion letter from opinion counsel, explicitly overruling its *Underwater Devices* willful infringement standard.<sup>82</sup> The Court stated that “the duty of care announced in *Underwater Devices* sets a lower threshold for willful infringement that is more akin to negligence.”<sup>83</sup> The Federal Circuit, then set out to explain that the Supreme Court—when analyzing statutes that included the word “willful” within their text—had ruled that a finding of “willful” conduct required a showing of at least reckless behavior on the part of the tortfeasor.<sup>84</sup> The Supreme Court explained that “to establish willful infringement, a patentee must show by clear and convincing evidence that the infringer acted despite an *objectively high likelihood that its actions constituted infringement of a valid patent*.”<sup>85</sup> In short, the Federal Circuit abandoned its prior standard, replacing it with an “objective recklessness” standard underpinned by Supreme Court precedent analyzing “willful” conduct in a statutory context.<sup>86</sup>

Notable from the *Seagate* reasoning is the analysis of Supreme Court precedent dealing with the meaning of “willful” in the statutory text.<sup>87</sup> The term “willful” does not appear in 35 U.S.C. § 284, which only states

---

77. See 497 F.3d 1360 (Fed. Cir. 2007).

78. See *id.* at 1366.

79. See *id.*

80. See *id.*

81. *Seagate*, 497 F.3d at 1365.

82. See *id.* at 1371.

83. See *id.*

84. See *id.* (citing *Safeco Ins. Co. of Am.*, 127 S.Ct. 2201); see also McLaughlin, 486 U.S. at 132-33.

85. See *Seagate*, 497 F.3d at 1371.

86. *Id.* at 1370.

87. See *id.* at 1371.

that “. . . the court may increase the damages up to three times the amount found or assessed.”<sup>88</sup> There is no indication that willfulness was intended by Congress to establish enhanced damages when it passed section 284.<sup>89</sup> Nonetheless, the Federal Circuit explained away this apparent inconsistency by noting that while “a trial court’s discretion in awarding enhanced damages has a long lineage in patent law, the current statute, similar to its predecessors, is devoid of any standard for awarding them.”<sup>90</sup> In so observing, the Court did not consider Supreme Court precedent on the very point of what constituted conduct allowing enhanced damages for patent infringement.<sup>91</sup> In a case on point, the Supreme Court ruled that enhanced damages required a showing of “wanton or malicious” behavior.<sup>92</sup> With this in mind, the Federal Circuit would have been led to a long line of Supreme Court tort cases requiring “reprehensible” conduct before awarding enhanced damages.<sup>93</sup> Instead, the Federal Circuit retained the “willful infringement” standard and underpinned it with a test inquiring into the “objective recklessness” of the alleged infringer’s conduct.

It appears that the reasoning in *Seagate*, therefore, is in tension with Supreme Court precedent. From its decisions, the Federal Circuit expressed an implicit concern with the Supreme Court’s limited approach regarding punitive or enhanced damages.<sup>94</sup> The standard for enhancing damages appears to require reprehensible conduct, defined as “indifference or reckless disregard for health or safety.”<sup>95</sup> It is obvious that this standard will not award punitive damages for only economic harms such as patent infringement.<sup>96</sup> Even to the extent that the *Seymour* Court’s “wanton or malicious” conduct requirement is a lower standard than the reprehensible conduct standard, it is still a higher level of egregious conduct than showing an “objectively high likelihood that [an infringer’s] actions constituted infringement of a valid patent.”<sup>97</sup> The Supreme Court set a high bar for imposing punitive damages or enhanced damages in tort law, and it is not evident that patent infringement should have a special standard.

Although the *Seagate* standard of infringement requires an objective

---

88. 35 U.S.C. § 284 (2007).

89. *See id.*

90. *See Seagate*, 497 F.3d at 1368.

91. *See id.*

92. *See McLaughlin*, 486 U.S. at 133.

93. *See State Farm*, 538 U.S. at 408, 419, quoting *Gore*, 517 U.S. at 575.

94. *See Seagate*, 497 F.3d at 1370.

95. *See State Farm*, 538 U.S. at 419.

96. *See id.*

97. *Seagate*, 497 F.3d at 1371; *See Seymour*, 57 U.S. at 489.

showing of recklessness to find willful infringement, it is not clear that this standard is any more helpful than the standards put forth by the Supreme Court. To the contrary, it can be said that the standard does not provide any greater clarity in imposing enhanced damages under section 284 as compared to a “reprehensible” conduct standard.<sup>98</sup> It appears to leave open the likelihood that willful infringement claims will continue to be asserted against alleged infringers for conduct that represents careless or negligent behavior, inflicting high attorney’s fees and costs on alleged infringers for conduct that would not be subject to enhanced damages in other areas of law.

The Federal Circuit has a legitimate interest in protecting the patent system from bad faith infringers and the Patent Act provides for increased damages in exceptional cases.<sup>99</sup> To be sure, willful infringers exist. The Supreme Court, however, has generally viewed punitive damages in a negative light.<sup>100</sup> For most of its history, it has explained that punitive damage awards are not the norm, and should be awarded in especially exceptional circumstances where a defendant’s conduct must be punished to send a message to the rest of society. In recent decisions, the majority of the Court has gone so far as to limit punitive damages awards in cases of even egregious conduct.<sup>101</sup> Even after *Seagate*, the Federal Circuit’s test does not limit punitive damages to reprehensible conduct nor does it require a showing that the defendant acted intentionally, deliberately, or wantonly and maliciously. Thus, the Federal Circuit’s present test for willful infringement appears to be in conflict with Supreme Court precedent.

### III. Assignor Estoppel

The doctrine of assignor estoppel prevents an assignor from denying the novelty and utility of a patent that it assigns.<sup>102</sup> Assignor estoppel protects the assignee from the risk of paying valuable consideration for a patent, and having the assignor – who is best positioned to have information concerning validity and utility – deny the validity of his pat-

---

98. The Federal Circuit admitted as much stating, “We fully recognize that “the term [reckless] is not self-defining.” See *Seagate*, 497 F.3d at 1371, quoting *Farmer v. Brennan*, 511 U.S. 825, 836 (1994).

99. See 35 U.S.C. 284 (2007).

100. See, e.g., *State Farm*, 538 U.S. at 417.

101. See *id.* at 420.

102. See *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969); see also *Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co.*, 266 U.S. 342, 348 (1924); The general rule applied assignor estoppel to prevent an assignor from presenting any evidence concerning validity or utility of the assigned patent.

ent.<sup>103</sup>

Even with the patent policy concerns underpinning the doctrine, the Supreme Court limited the application of assignor estoppel in *Westinghouse*. In that case, a defendant in privity with the assignor sought to assert that the patent, which was assigned prior to issuance, was either invalid or the claims were limited due to prior art.<sup>104</sup> The Supreme Court ruled that the assignor could use prior art to narrow the scope of the claims.<sup>105</sup> The Court first observed that the doctrine of assignor estoppel prohibited an assignor from arguing that it had assigned an interest in an invalid patent.<sup>106</sup> However, the Court noted that the assignor had assigned an interest in an application that later issued into a patent.<sup>107</sup> According to the majority, the doctrine of assignor estoppel did not prohibit an assignor from challenging the scope of a patent that was assigned prior to issuance.<sup>108</sup> The Court explained that, when assigning a pending patent, the assignor merely promised that the invention justified the issuance of a patent, not that the patent had a certain scope.<sup>109</sup> It reasoned that an assignee could use prior art to limit the scope of claims in an application because the assigned application could not include subject matter that rendered the issued patent invalid.<sup>110</sup>

Under the *Westinghouse* reasoning, the Supreme Court stepped away from a broad prohibition against the assignor challenging the assigned patent. In *Westinghouse*, the Court conveyed an unwillingness to ascribe a scope to the claims that would clearly render the claims invalid as against the prior art, even to the detriment of the assignee.<sup>111</sup> The majority was clearly uncomfortable with the prospect that an invalid patent – issuing after assignment – could be asserted against an alleged infringer who, by operation of common law, could not assert invalidity defenses.<sup>112</sup> To avoid this result, the majority struck a balance. It maintained assignor estoppel as a viable doctrine, albeit a more restricted doctrine, while allowing assignors of patent applications to utilize invalidity defenses in certain circumstances against those applications when they issue as patents.<sup>113</sup>

---

103. See *Westinghouse*, 266 U.S. at 349.

104. See *id.* at 343-44.

105. See *id.* at 351.

106. See *id.* at 349.

107. See *Westinghouse*, 266 U.S. at 352.

108. See *id.* at 354.

109. See *id.*

110. See *id.*

111. See *Westinghouse*, 266 U.S. at 351.

112. *Id.*

113. See *id.* at 347.

The Supreme Court revisited the issue of assignor estoppel in *Scott Paper Co. v. Marcalus Man. Co.*<sup>114</sup> In *Scott*, the assignor argued that its accused machine was a copy of a device from an expired prior art patent, and it could not be infringing the patent.<sup>115</sup> In other words, the assignor argued that it was practicing the prior art, which was same as arguing that the assignor's device (if found to infringe) was anticipatory prior art. The petitioner contended that the assignor was indirectly attacking the validity of the assigned patent.<sup>116</sup> As argued by the assignor-respondent, such an argument should be prohibited.<sup>117</sup> The Court rejected the assignee's arguments, holding that assignor estoppel did not foreclose the assignor from using an invention of an expired patent.<sup>118</sup> The Court seemed particularly concerned with preventing the assignee from obtaining more than what it obtained in the patent grant.<sup>119</sup> According to the majority, "[the patent laws] do not contemplate that anyone by contract or any form of private arrangement may withhold from the public the use of an invention . . . which has been appropriated to the use of all."<sup>120</sup>

The *Scott/Westinghouse* reasoning worked to cull back the broad expanse of the assignor estoppel doctrine. Even if assignor estoppel retained vitality, the Court created exceptions to the doctrine that essentially allowed an assignor to limit the scope of the claims in an assigned patent by introducing prior art defenses to infringement suits.<sup>121</sup> The "general rule" that an assignor could not present any evidence concerning validity no longer applied.

More than two decades after *Scott*, the Court appeared to eviscerate the vitality of assignor estoppel in *Lear, Inc. v. Adkins*.<sup>122</sup> In *Lear*, the Court ruled on the application of the doctrine of licensee estoppel to a licensee asserting that the licensor's patent was invalid.<sup>123</sup> In that case, the licensee sought to invalidate the patent it licensed.<sup>124</sup> The Court held that the doctrine of licensee estoppel, as applied to prevent a licensee – who had repudiated a license – from challenging the validity of a patent,

---

114. 326 U.S. 249 (1945).

115. *See id.* at 251.

116. *See id.* at 253.

117. *See id.*

118. *See Scott*, 326 U.S. at 254.

119. *See id.* at 256.

120. *See id.* at 256-57.

121. *See Scott*, 326 U.S. 249; *see also Westinghouse*, 266 U.S. 342.

122. 395 U.S. 653 (1969).

123. *See id.* at 660.

124. *Id.* at 656.

frustrated federal patent policy, and was no longer the law.<sup>125</sup> Notably, the Court analyzed, in great detail, a “general rule” of estoppel as it applied to licensees *and* assignors.<sup>126</sup> The “general rule” had been to apply estoppel to any instance in which a licensee or assignor sought to defend itself on the grounds that a patent was invalid or unenforceable.<sup>127</sup> It reasoned that the “general rule” had been undermined by *Westinghouse* and *Scott*.<sup>128</sup> The *Scott* ruling established a broad mandate that allowed the assignor to attack the validity of an assigned patent:

If patent policy forbids estoppel when the old owner attempts to show that he did no more than copy an expired patent, why should not the old owner also be permitted to show that the invention lacked novelty because it could be found in a technical journal or because it was obvious to one knowledgeable in the art?<sup>129</sup>

Under the most conservative interpretation, assignor estoppel became a significantly limited doctrine that the Supreme Court no longer favored. In fact, many courts held that the doctrine was no longer the law.<sup>130</sup> In its decisions, the Court implicitly favored the public’s interest in protection against invalid patents over the interest to protect an assignee from a duplicitous assignor. The reasoning in *Scott* and *Lear*, therefore, left the assignee to protect itself in contract law, rather than granting the assignee additional protections in equity.

The Federal Circuit, however, took a different view. In its first foray into assignor estoppel in *Diamond Scientific Co. v. Ambico, Inc.*,<sup>131</sup> the Federal Circuit applied the doctrine to prevent a former employee from attacking the validity of a patent for a vaccine that he assigned to his employer.<sup>132</sup> Shortly thereafter, the employee left the company and formed a new company to produce vaccines.<sup>133</sup> His former employer brought suit for infringement, and the assignor/inventor asserted the affirmative defenses of obviousness and lack of novelty.<sup>134</sup> The district court granted a motion to strike the defenses, ruling that the doctrine of

---

125. *See id.* at 670.

126. *See Lear*, 395 U.S. at 670.

127. *See id.* at 664-65.

128. *See id.*

129. *See id.* at 666 (citing *Scott*, 326 U.S. at 258-64 (Frankfurter, J., dissenting)).

130. *See, e.g.*, *Marvacon Indus. v. Thermacon Indus.*, No. 79/1121, 1980 WL 30274 (D.N.J. May 28, 1980); *see also Coastal Dynamics Corp. v. Symbolic Displays, Inc.*, 469 F.2d 79 (9th Cir. 1972) (per curiam); *Nat. Welding Equip. Co. v. Hammon Precision Equip. Co.*, 165 F. Supp. 788 (N.D.Cal. 1958).

131. 848 F.2d 1220 (Fed. Cir. 1988).

132. *See id.* at 1222.

133. *See id.*

134. *See id.*

assignor estoppel prohibited the affirmative defenses.<sup>135</sup> The Federal Circuit affirmed the district court and held that the doctrine of assignor estoppel prohibited the assertion that the assigned patent was invalid.<sup>136</sup> The court observed that public policy favored the assignee in this case<sup>137</sup>, explaining that “despite the public policy encouraging people to challenge potentially invalid patents, there are still circumstances in which the equities of the contractual relationships between the parties should deprive one party (as well as others in privity with it) of the right to bring that challenge.”<sup>138</sup> In other words, the court favored the contractual interest of the assignee over public interests in order to insure the issuance of valid patents.

How did the Federal Circuit reach this decision in the face of *Westinghouse*, *Scott*, and *Lear*? The panel in *Diamond* opined that the Supreme Court had not offered any “definite or definitive” opinion on the doctrine.<sup>139</sup> According to the *Diamond* panel, the *Scott* decision merely “sidestepped” the merits of the doctrine, and “once more” carved out an exception from the “general rule.”<sup>140</sup> While the *Lear* opinion significantly narrowed licensee estoppel, according to *Diamond* it only questioned assignor estoppel in dicta.<sup>141</sup> Thus, the Federal Circuit found assignor estoppel to be a viable doctrine.<sup>142</sup>

The *Diamond* court heralded a new beginning for assignor estoppel. The Federal Circuit established a balancing test in which the weight of the equities between assignor and assignee determined whether estoppel would apply.<sup>143</sup> After *Diamond*, the Federal Circuit rapidly expanded the reach of the doctrine. In *Q.G. Products, Inc. v. Shorty, Inc.*, the court stated, “where a party assigns a patent . . . the assignor implicitly attests to the value of the assigned patent.”<sup>144</sup> Based on this reasoning,

---

135. See *Diamond*, 848 F.2d at 1222.

136. See *id.* at 1226.

137. See *id.* Notwithstanding the employer/employee relationship that existed between assignee/assignor, the judges were particularly cognizant of the “rewards” reaped by the former employee, rewards that included a job with benefits, a salary, and bonuses. *Id.*

138. *Id.* at 1225.

139. 848 F.2d at 1226.

140. *Id.* at 1222-23.

141. See *id.* at 1222, 1223.

142. *Id.* at 1227.

143. See *Shamrock Techs., Inc. v. Med. Sterilization, Inc.*, 903 F.2d 789, 793 (Fed. Cir. 1990) (citing *Diamond*, 848 F.2d at 1225) (“assignor estoppel is mainly concerned with the balance of the equities between the parties”). However, if the equities weighed in favor of an assignee/employer as against an assignor/employee, it was not likely that the equities would favor many assignors.

144. 992 F.2d 1211, 1212 (Fed. Cir. 1993).



its rulings distinguished Supreme Court precedent and broadened assignor estoppel so that it is the exceptional case when estoppel does *not* apply.<sup>145</sup> Assignor estoppel is now premised upon the concept that the risk when entering into a contractual agreement should be shifted to the assignor, implicitly assuming that the assignor should not benefit from an invalid patent.<sup>146</sup> Under this reasoning, the assignor suffers the consequences for assigning a potentially invalid patent.<sup>147</sup>

Tension exists between the present construction of assignor estoppel and Supreme Court precedent. Prior to the Federal Circuit's decision in *Diamond*, the Supreme Court had been carving out exceptions to the "general rule" of assignor estoppel.<sup>148</sup> Subsequent to the Court's decision in *Lear*, it was unclear whether the doctrine retained any vitality. Even so, it was clear that assignor estoppel no longer constituted the "general rule" that it had prior to *Westinghouse*. It was equally clear that the Supreme Court favored the public's interest in ensuring the issuance of valid patents at the expense of the parties' interest in fair dealing. The Federal Circuit endorsed a broad application of the doctrine that appears to follow pre-*Westinghouse* reasoning. The policy underpinning the Federal Circuit's reasoning is one in which the assignee's interest in fair dealing trumps the public's interest in valid patents. As applied by the Federal Circuit, the assignor estoppel doctrine is returning to the "general rule" that the Supreme Court abandoned in *Lear*.

#### IV. Written Description

Title 35 U.S.C. § 112 reads in part:

The specification shall 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, or with which it is most nearly connected to make and use the same . . . .<sup>149</sup>

---

145. See *Diamond*, 848 F.2d at 1226 (stating that *Westinghouse* applied to applications in which the claims were broadened *after* an assignment).

146. See *Mentor Graphics Corp. v. Quickturn Design Sys., Inc.*, 150 F.3d 1374, 1378 (Fed. Cir. 1998) (exceptional circumstances did not include disclaiming in the assignment document any warranty as to validity).

147. In the *Q.G. Products* case, the assignee was prosecuting the application and could have performed an analysis of the inventorship. Also, the assignee was a former associate of the alleged infringer and had full knowledge of the issues associated with the application. *Q.G. Products*, 992 F.2d at 1212.

148. See *e.g.*, *Scott*, 326 U.S. 249; see also *Westinghouse*, 266 U.S. 342.

149. 35 U.S.C. § 112 (1975).

The so-called written description requirement of the patent statute signifies the bargain struck between the public and the patentee. The bargain is simple: the public will grant a limited monopoly for a novel and useful invention provided that the patentee donates his invention to the public knowledge base at the end of the patent term. To fulfill the patentee's part of the bargain, the statute requires that the patentee describe his invention using "such full, clear, concise, and exact terms" to enable one with skill in the art to make and use the invention.<sup>150</sup> Consequently, a patentee is required to divulge to the public what he knows about his claimed invention.

Though a straightforward notion, the meaning of "such full, clear, concise, and exact terms as to enable any person skill in the art . . . to make and use the same" is not necessarily straightforward in application.<sup>151</sup> What precision does the patent statute require in describing embodiments of an invention? Must a patentee describe what he considers to be the invention (i.e., what is new as against what is not new) clearly, concisely, and exactly?

The Supreme Court has continuously wrestled with these questions, beginning in the early 1800's when first hearing patent cases. While the early patent statutes did not require claims as they are written today, early Supreme Court decisions discussed the detail required in the written description. Beginning with *Evans v. Eaton*, the Court established a rule that a patentee needed to provide an "exact and minute" description of the invention that "distinguishes what the [invention] is, and state[s] in what it consists, [and] how far the invention extends."<sup>152</sup> More than a century later, the Supreme Court in *Permutit Co. v. Graver Corp.*<sup>153</sup> affirmed the exacting written description requirement of *Evans*, rejecting the contention that the specification and drawings can "presuppose" a theory of operation that would be obvious to one with skill in the art.<sup>154</sup> The Court explained that where the patentee failed to describe or claim a particular embodiment of the invention, the patentee could not avail itself of what was known in the art.<sup>155</sup> Under the *Permutit Co.* standard, the written description must "inform the public during the life of the patent of the limits of the monopoly asserted."<sup>156</sup>

The Supreme Court revisited the written description requirement

---

150. *Id.*

151. *Id.*

152. *See* *Evans v. Eaton*, 20 U.S. 356, 434 (1822).

153. 284 U.S. 52 (1931).

154. *See id.* at 58-59.

155. *See id.* at 60.

156. *See id.*

again in *General Electric Co. v. Wabash Appliance Corp.*<sup>157</sup> In that case, the patentee invented an improvement allowing tungsten filament bulbs to burn longer.<sup>158</sup> In particular, the specification described a method of making the tungsten filament to prevent “sagging.”<sup>159</sup> The claims, however, were directed to a particular tungsten filament composition.<sup>160</sup> In affirming the appeals court decision on invalidity, the Court ruled that the claims were indefinite and did not distinctly and specifically claim what was new.<sup>161</sup> The Supreme Court further observed that the specification insufficiently described the nature of the filament product because the only description of the invention concerned the process of making the filament.<sup>162</sup> Apparently, the Court found that the statute required a more precise description of the claimed invention than a description of a process for making an invention.<sup>163</sup>

The Supreme Court briefly revisited this issue in *Markman v. Westview Instruments, Inc.*<sup>164</sup> *Markman* dealt with the issue of claim construction and whether this was a question of fact or law.<sup>165</sup> In addition, the Court reiterated its position on the exacting standard for a written description, explaining that “[i]t has long been understood that a patent must describe the exact scope of an invention and its manufacture to “secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them.”<sup>166</sup> The Court observed that “these objectives are served by two distinct elements of a patent document . . . a specification describing the invention ‘in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same . . . and claims.’”<sup>167</sup> Though admittedly dicta, the language in *Markman* illustrates the Supreme Court’s position that an exact description of the claimed invention is required in a specification.

Underlying the Supreme Court’s written description jurisprudence is a basic premise: an exact disclosure of the claimed invention is required so that the subject matter of the patent is “dedicated ultimately to the

---

157. See generally 304 U.S. 364 (1938).

158. See *id.* at 366-67.

159. See *id.*

160. See *id.*

161. See *Gen. Elec. Co.*, 304 U.S. at 371-73.

162. See *id.* at 373-74 (if “a patentee who does not distinguish his product from what is old except by reference, express or constructive, to the process by which he produced it, cannot secure a monopoly on the product by whatever means produced”).

163. See *id.* at 369.

164. 517 U.S. 370 (1996).

165. See *id.*

166. *Id.* at 373, (citing *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891)).

167. *Id.*

public.”<sup>168</sup> The disclosure of the invention also serves to “inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured.”<sup>169</sup> The written description standard established by the Supreme Court protects the public interest, even to the detriment of certain inventors.<sup>170</sup>

The Federal Circuit’s predecessor court, the United States Court of Customs and Patent Appeals, occasionally reached the issue of sufficient written description. Of particular note, the CCPA required that a specification exactly describe the claimed invention.<sup>171</sup> The *Ruschig* court confronted an unusual situation in which a claimed compound was not specifically described in the specification, but one of skill in the art could have made and used the compound if he had used the proper materials disclosed in the specification.<sup>172</sup> However, the specification described processes for making a group of over 1,000 potential compounds, of which the claimed compound was a member.<sup>173</sup> In holding the claim unpatentable, the court noted that the applicants had not “blaze marked” (*i.e.*, pointed out) to one of skill in the art the process of making the claimed invention.<sup>174</sup> The court was neither impressed by the broad disclosure in the specification nor the fact that the compound was disclosed *if* one of skill in the art had chosen the right reagents to put together.<sup>175</sup> According to the court, the compound was “not . . . specifically named or mentioned, one is left to the myriads of possibilities . . . in the broad disclosure.”<sup>176</sup> In other words, an exacting disclosure, as explained by the Supreme Court, was required.

The written description requirement adhered to in *Ruschig* remained the standard in subsequent CCPA decisions.<sup>177</sup> Even to the extent that undisclosed subject matter was obvious to one of skill in the art, the court required explicit disclosure of the claimed embodiment in the specification.<sup>178</sup> Referring to the statute, the CCPA held that the written

---

168. *Gen. Elec. Co.*, 304 U.S. at 369.

169. *Id.*

170. *See Gen. Elec. Co.*, 304 U.S. at 368-74 (inventor described process of making and using sufficiently, but did not describe what was new).

171. *In re Ruschig*, 379 F.2d 990 (C.C.P.A. 1967).

172. *See id.* at 993-95.

173. *See id.*

174. *See id.* at 995.

175. *See Ruschig*, 379 F.2d at 995.

176. *Id.*

177. *See In re Barker*, 559 F.2d 588 (C.C.P.A. 1977).

178. *See id.* at 593 (noting that “a person skilled in the art might realize from reading the disclosure that such a step is possible is not sufficient indication to that person that that step is part of appellants’ invention. Such disclosure is the least that

description of the invention had to disclose three different subjects: the invention itself; the manner of making it; and the mode of putting it to practical use.<sup>179</sup>

Recent Federal Circuit decisions relaxed the requirements for a sufficient written description. Starting with *In re Gosteli*, the Federal Circuit began to view section 112 as merely requiring that the specification “allow [for] persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”<sup>180</sup> This language – especially the “allow” part – does not come from the statute nor does it proclaim an adherence to the exacting standard of the Supreme Court or the CCPA. Indeed, the Federal Circuit applied the less rigid written description requirement in *Vas-Cath, Inc. v. Mahurkar* to find that figures alone could provide literal support for a claimed invention.<sup>181</sup> In *Vas-Cath*, a declaratory judgment plaintiff argued that the defendant’s utility application was not entitled to claim the benefit of a design patent priority date.<sup>182</sup> The utility claims recited a dual lumen catheter, including a range of diameters for the catheter lumens.<sup>183</sup> The dual lumen catheter was also claimed in the design patent, which showed various views of the catheter.<sup>184</sup> The plaintiff argued that the design patent figures did not provide an adequate written description to allow the defendant to claim the benefit of the priority to the design patent because the figures did not show one of ordinary skill in the art the full breadth of the claims, which rendered the utility patent invalid over intervening prior art.<sup>185</sup> In reversing the district court’s finding of no adequate written description in the design patent application, the Federal Circuit rejected the plaintiff’s arguments, pointing out that the written description requirement does not require exact description of the claimed subject matter, but merely enough to allow persons of ordinary skill in the art to recognize that the applicant invented what is claimed.<sup>186</sup> Furthermore, the court stated that the written description allows one of ordinary skill in the art to make and use the invention.<sup>187</sup> The Federal Circuit only required that a specification “convey with reasonable clarity” to one of or-

---

is required for a description.”).

179. *See id.* at 592.

180. *See Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479 (Fed.Cir. 1998), (quoting *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989)).

181. 935 F.2d 1555 (Fed. Cir. 1991).

182. *See id.* at 1559.

183. *See id.*

184. *See id.*

185. *See Vas-Cath*, 935 F.2d at 1563.

186. *See id.*

187. *Id.*

dinary skill in the art that the applicant invented the claimed subject matter.<sup>188</sup> Under *Vas-Cath*, the written description requirement – with particular attention to the term “convey” – no longer required an exact description of the invention.<sup>189</sup>

In later decisions, the Federal Circuit continued to find no requirement for an exact disclosure of the claimed invention.<sup>190</sup> In *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, the court considered whether depositing biological material at a public depository was sufficient to satisfy the written description requirement.<sup>191</sup> The patentees did not disclose the nucleic acid sequence of their invention nor did they disclose the length of the deposited sequence.<sup>192</sup> The panel majority still found the disclosure to be sufficient.<sup>193</sup> First, the majority noted that the sequences were publicly available and undue experimentation would not be required to identify the exact sequence.<sup>194</sup> They also observed that it may be possible for “a person of skill in the art [to] glean from the written description . . . the entire scope of the claims.”<sup>195</sup> In short, the written description requirement did not demand an exact disclosure so long as one of ordinary skill in the art could “glean” from the written description the full scope of what the patentee had claimed.<sup>196</sup>

Other decisions used different language, yet still described a relaxed written description requirement.<sup>197</sup> The Federal Circuit explained that “[t]he written description requirement does not require the applicant ‘to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’”<sup>198</sup> Essentially, one of ordinary skill in the art can use extrinsic knowledge (*i.e.*, knowledge in the art, including prior art) not found in the specification to recognize what the inventor invented.

Two points of view regarding the written description requirement

---

188. *See id.* at 1566.

189. *See Vas-Cath*, 935 F.2d at 1562-63.

190. *See Enzo Biochem, Inc. v. Gen.-Probe, Inc.*, 323 F.3d 956 (Fed. Cir. 2002) (holding a deposit in public depository can constitute adequate description of claimed material for purpose of written requirement).

191. *See id.*

192. *See id.* at 963.

193. *See id.*

194. *See Enzo Biochem*, 323 F.3d at 965-66.

195. *Id.* at 966.

196. *See id.*

197. *See Moba, B.V. v. Diamond Automation, Inc.* 325 F.3d 1306 (Fed. Cir. 2003).

198. *See Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000) (citing *Gosteli*, 872 F.2d at 1012).

crystallize from this analysis. On the one hand, the Supreme Court's exacting written description requirement is founded on the principle of protecting the public interest.<sup>199</sup> Whether it is a claim of unclear scope or disclosure that does not clearly describe the claimed invention, the Supreme Court and the CCPA were willing to sacrifice the rights of patentees to champion the public interest.<sup>200</sup> On the other hand, the Federal Circuit approach champions the patentee's interests.<sup>201</sup> The relaxed written description requirement still demands that the claimed invention is sufficiently disclosed to the public.<sup>202</sup> Yet, the Federal Circuit is more concerned with protecting a patentee's rights.<sup>203</sup> These different approaches to the written description requirement reflect different perspectives on the primary interest being protected.

## V. Conclusion

The Federal Circuit exercises exclusive jurisdiction over patent cases. Since its inception in 1982, it has developed a rich body of patent law. The Supreme Court only rarely hears cases relating to the patent law. When it does, the Court generally resolves disagreements among the panels or judges. With *Quanta Computer*, *eBay*, *MedImmune* and *KSR*, the Supreme Court is reviewing the Federal Circuit's work like never before. Thus, it is likely that seeming conflicts between Supreme Court precedent and Federal Circuit jurisprudence are going to face close scrutiny in the future. We outlined a few of the areas in which the Federal Circuit may have departed from Supreme Court precedent. This is not to say that the Federal Circuit is incorrect in its reasoning or disregarded Supreme Court precedent. However, these and probably other areas indicate that the Supreme Court will have ample opportunities to review Federal Circuit jurisprudence that proceeded in a different direction than the Supreme Court.

---

199. See *Markman*, 517 U.S. 370, 373 (citing *McClain v. Ortmayer*, 141 U.S. 419, 424 (1891)).

200. See *Markman*, 517 U.S. 370; *General Elec. Co.*, 304 U.S. 364; *Evans*, 20 U.S. 356.

201. See, e.g., *Vas-Cath*, 935 F.2d 1555.

202. See *id.* at 1566.

203. See, e.g., *Enzo Biochem*, 323 F.3d 956.

