The Federal Circuit's en banc written description requirement: time again for the Supreme Court to reverse again?

The Federal Circuit in Ariad vs. Eli Lilly finally settled en banc the long-running dispute on whether 35 U.S.C. §112, paragraph 1, contains a written description requirement separate from an enablement requirement. According to the Court, such a requirement exists and exists to “convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” It is unfortunate that the Court should choose to promote a judicially constructed doctrine with no statutory basis to be one of the basic patentability requirements. The problem with the Court’s written description “possession” doctrine is two fold.

First, it fails to properly frame the patent quid pro quo as a basic bargain struck from the perspective of the public for the benefit of the public. To the extent the notion of “possession” is relevant to the patent quid pro quo, it is only the placement of something in the “possession” of public – the teaching of something that contributes to the art – that matters. Two, the Court’s written description “possession” doctrine, by providing the courts with an undisciplined but convenient tool to strike down ad hoc claims the courts do not like, shields the court from having to deal with more fundamental problems in patent law brought on by an economy transitioning from an industrial to an information and biological based economy. The paper explores some of this incoherence in terms of traditional disputes over the number of species required to support the claiming of a genus, whether “functional” descriptions are truly less “descriptive” than “structural” descriptions, and when contributions to knowledge are too “abstract” and “general” to be eligible for patenting. While a true resolution of many of these issues will require coming to grips fundamentally with complicated questions of fact (involving what is actually “enabled” for experts working in the field) as well as questions of law and policy (involving determinations of scopes of contributions made to the art by pioneers vis-à-vis that of subsequent inventors), the paper argues that the Federal Circuit’s possession-based written description doctrine stands in the way of clearer understanding of the issues and should be overturned.