

UPDATE ON 112–UNDERSTANDING AND NAVIGATING THE USPTO’S APPLICATION OF THE LAW

- Panel
 - Miku Mehta, Procopio (moderator)
 - Matthew Avery, Baker Botts
 - Anna Hyatt, Dren Bio
 - Kanda Ishihara, Lyft
- *The views expressed in this discussion are our own, and do not necessarily reflect the views of our employers/organizations*

Agilent Techs., Inc. v. Synthego Corp.

Decided: June 11, 2025

Facts: Claims cover synthetic guide RNAs that improve stability and functionality in a CRISPR system.

Key claim element: “*wherein the synthetic guide RNA has gRNA functionality comprising associating with a Cas protein and targeting the gRNA:Cas protein complex to the target sequence*”

PTAB Decision (IPR): Claims invalid under 102 by an abandoned patent publication that taught a “guide polynucleotide” with equivalent functionality.

Key Issue on Appeal: Whether the prior art reference is enabling for 102 purposes for teaching gRNA functionality under *Amgen v. Sanofi* (2023).

Patentee argued that the gRNA examples in the prior art were prophetic and that it merely discussed “a research plan to test for functionality” of gRNA, and thus one of skill in the art would not know how to create a functional gRNA based on this disclosure.

Holding: The standard for enablement under 112 per *Amgen v. Sanofi* is different from the standard for prior art to be enabling under 102.

US Synthetic Corp. v. ITC (February 13, 2025)

Patentee: U.S. Synthetic (USS) **Patent:** 10,508,502 (polycrystalline diamond compact (PDC) composition used in Cutter

Facts: The ['502 patent](#) claims a type of composition known as polycrystalline diamond compact (PDC). Discloses methods of manufacturing a PDC with a high-degree of diamond-to-diamond bonding and contains a reduced amount of metal catalyst **without requiring leaching**.

-ITC Final Determination:

Administrative law judge (ALJ) determined that certain **claims were infringed and not invalid under 35 U.S.C. § 112** because Intervenor's "[did] not discuss, or even cite to, the *Wands* factors (Commission affirmed)

-On appeal, Intervenor's argue that the asserted claims are not enabled under § 112 since the "unleached portion. . .**broadly claims every process** that does not include leaching" Intervenor's **analogize their enablement argument to the reasoning in *Amgen***.

-The Federal Circuit agreed with the Commission that the asserted patents "disclose 'detailed manufacturing information' and 'working examples. . . ' such that a [skilled artisan] 'would know how the manufacturing information can be used to achieve the claimed PDCs'" The court noted that while "some experimentation might be required to make the claimed PDCs, **such experimentation is not undue**"

-The Court emphasized that *Amgen* applied the same "statutory enablement requirement" that the Supreme Court has enforced "[f]or more than 150 years" and reiterated that "a **specification may call for a reasonable amount of experimentation** to make and use a patented invention" ...Court found no error in its determination that Respondents failed to prove lack of enablement

-Takeaway: The Federal Circuit held that claims requiring **some experimentation** were still enabled under § 112 and *Amgen v. Sanofi*, because the experimentation was not undue. The court further clarified that ***Amgen* applies the same statutory enablement requirement**.

Mondis Technology Ltd. v. LG Electronics Inc.

(Fed Cir., Aug. 8, 2025)

Held: Claim 14 is invalid under 35 USC §112(a) due to lack of written description

Added during prosecution

- Must “reasonably convey” possession to POSA
- WD support need not be express
- Invalidity inquiry based on 4 corners of spec, C/C standard

Takeaways

- Inventor communications
- Drafting
- Prosecution



...g an image based on video signals inputted from an externally connected video source, comprising:

a video circuit adapted to display an image based on the video signals sent by the externally connected video source;

a memory in which at least display unit information is stored, said display unit information including an identification number for identifying at least a type of said display unit and characteristic information of said display unit; and

a communication controller capable of bi-directionally communicating with said video source;

wherein said communication controller is capable of communicating said display unit information other than said characteristic information to said video source.

Fintiv v. Paypal

Date: Decided by the Federal Circuit on April 30, 2025.

Summary: The Federal Circuit held that claims drafted in means-plus-function format that merely recite functional language without providing adequate structural disclosure are indefinite and therefore invalid.

Technology: The ['488](#), ['386](#), ['413](#), and ['196](#) Patents relate to a cloud-based transaction system where each patent claims a type of “payment-handler.” The payment-handler term claims the use of an API. Fintiv asserted these patents against PayPal.

Held: Federal Circuit affirmed District Court’s decision that the payment-handler terms were invalid due to indefiniteness under 35 USC §112(b) based on two-step §112(f) analysis

1. the payment-handler terms are means-plus-function terms subject to §112(f) because they are drafted in a format consistent with traditional means-plus-function limitations and merely replace the term “means” with “payment handler” or “payment handler service.”
2. the ’ specifications do not disclose adequate corresponding structure for the claimed functions of “using APIs of different payment processors” and “exposing a common API for interacting with different payment processors,” as the specification didn’t seem to disclose any structure at all. Thus, the claim is indefinite under 35 USC §112(b).