

Day 2, Panel 1 Prosecution: Update on 112

Key Terms: Section 112, Enablement, Written Description, Indefiniteness, Means Plus Function, Section 112(f), Nonce Words, Possession of Invention, Full Scope Enablement, Undue Experimentation, Functional Claiming, Structural Support, Intrinsic Evidence, Specification Support, Wands Factors, Amgen v. Sanofi, Agilent v. Synthego, Enabling Prior Art, Anticipation Standard, Prophetic Examples, Working Examples, Asymmetric Enablement Standard, Quantity of Experimentation, Predictability of Art, State of Prior Art, Level of Skill in the Art, Reproducible Measurements, Structure-Function Relationship, Mondis v. LG Electronics, Written Description Violation, Inventor Possession, Original Disclosure, Prosecution Amendment, Examiner Amendment, Examiner Agreement, Continuation Practice, Claim Scope Broadening, File History, Priority Date, Inventor Declaration, Inventorship Check, Fintiv v. PayPal, Payment Handler, Nonce Word, Module, Mechanism, Handler, Corresponding Structure, Algorithm Requirement, Two-Step 112(f) Analysis, Rebuttal Presumption, Operable To, Configured To, Common API, Claim Term Audit, Robust Specification, Claim Term Drafting, Inventor Disclosure Meeting, Invention Intake, Drafting with Wands Factors, Claim Amendment Review, Specification Check, Multiple Embodiments, Breadth of Claims, Dependent Claims, Continuation Strategy, Target Product Drafting, Prior Art Workaround, Antibody Claims, Genus Claims, Functional Antibody Claims, Large Molecule Space, Small Molecule Space, Markush Claims, Polycrystalline Diamond Compacts, CRISPR Guide RNA, Composition of Matter Claims, Magnetic Properties, Coercivity, Cobalt Content, Mean Free Path, Prophetic Teachings, USPTO Examiner Training, 112 Rejection Trends, Examiner Interview, Non-Final Office Action, Information Disclosure Statement (IDS), Inequitable Conduct, Unenforceability Standard, 132 Declaration, Inventor Engagement, IDS Size Fees, Examiner Changes, SPE Review, Amgen v. Sanofi, Agilent v. Synthego, US Synthetic v. ITC, Mondis v. LG Electronics, Fintiv v. PayPal, Mark Lemley, Baker Botts, Procopio, DrenBio, Genentech, Lyft, Eastern District of Texas, Federal Circuit, PTAB, Supreme Court

This panel, Update on 112, was the first prosecution panel of the second day for the event, 26th Annual Berkeley-Stanford Advanced Patent Law Institute. This event was hosted by Berkeley Center for Law & Technology, UC Berkeley School of Law, and Stanford Law.

Moderator

Miku Mehta, Procopio

Speakers

Matthew Avery, Baker Botts

Anna Hyatt, Dren Bio

Kanda Ishihara, Lyft

[WAYNE]

Good morning, everyone.

[AUDIENCE MEMBERS]

Good morning.

[WAYNE]

So it happens when you put a trial lawyer with a very sensitive mic. Well, thank you for coming this morning. Again. Couple of things, we'll be recording these kind of sessions.

If you have questions, work with Miku on them. If you do have questions, make sure that Willie will get you a mic to, get them on the recording or we'll repeat them up here for you. But it's kind of important, we want to capture all of this knowledge for any of these discussions.

And in this type of room today, more nuance, we're hoping for more discussions when appropriate. So with that in mind, our first session for the day, we start with, with Miku Mehta from Procopio.

Miku's been with us for many, many years here at the Institute leading these panels and trying to drive discussion. So with that, I'm gonna get out of the way quickly and let Miku guide us through 112.

[MIKU MEHTA]

Thanks, Wayne. And thanks for bringing us all together for this program. We're very excited today to talk about the maybe least controversial topic from yesterday's discussions, which is 112.

You notice it wasn't mentioned much yesterday, when we talked about the courts and the USPTO diverging from each other. Everybody seems to be marching in a similar direction on 112. There wasn't much discussion of IPRs, 'cause it's not the subject of IPRs, maybe PGRs.

And it's getting more important. I hope this presentation is interesting.

And I'm very excited to have on our panel and to be having join us people from the industry and law firms. I think Kanda, Anna, and Matt, if you would like to briefly introduce yourselves, it'll be great.

[KANDA ISHIHARA]

So hi, everyone. Good morning.

I hope everyone's awake. I'm barely awake, I feel like. But it's nice and cold, so, I'm Kanda Ishihara.

I'm at Lyft. I manage the patent portfolio there. I've been there for almost five years. We actually, on a day-to-day basis, don't have very many issues with 112, so I feel like this is, like, the most I've thought about 112 in a long time in preparation for this panel.

But I'm, I'm a self-proclaimed prosecution nerd, so happy to have this discussion.

[ANNA HYATT]

Good morning, everyone. I'm Anna Hyatt. I'm currently the head of IP at a biotech company in San Carlos called DrenBio.

Before that, I spent about 10 years in the IP legal group at Genentech. Most of my prosecution experience is in the large molecule antibody space, where 112 is constantly on one's mind as a prosecutor.

So, looking forward to having a fruitful discussion today.

[MATT AVERY]

Hey, everyone. I'm Matt Avery, partner at Baker Botts in San Francisco. I've been there my entire career, since '09 since I graduated from Hastings where I also now teach patent prosecution. So, I love talking about patent prosecution basically not getting paid for it. So, glad to be on this panel.

[MIKU MEHTA]

Okay. Thanks, team. And uh, so as Wayne mentioned, my name is Miku Mehta.

I'm at Procopio Firm. I'm-- I've been doing patent prosecution and soft-- software and computer hardware and energy area probably for maybe about 25 years, and also mainly doing the drafting and prosecution. So joining the self-proclaimed nerd I'm also one on 112.

So just on the format, we're going to have a presentation on a series of four cases from today. And we're gonna go through-- we do have slides. Apologies for the slides. We have one for each case.

And talk a little bit about how this impacts prosecution. You should know, and maybe you know, that over the last 15 years, examiners have been receiving lots and lots of training.

The USPTO has hundreds of slides on their website on how to make some of these rejections and implement some of the law that's come down. They're-- in the last 10 years, going back to that Citrix case, there's also been Supreme Court cases.

A lot of this is in training. My numbers show that the number of 112 rejections and 112 citations has been going up, like, pretty quickly in the last 10 years, and pretty progressively, so we're getting good clarity of record on that.

So we'll dive into the cases, and as we get to the end, we'll have time for discussion. So, I think everybody's here for the 112. Is there anybody who has never experienced a 112 rejection in office action, who does patent prosecution? If you have, you can share your wisdom with us.

So we're all in the same boat, and you're all seeing it here. So I'm gonna try to click. So, look back, and see this is help, and our disclaimer, these are our own views, not the views of our organizations, since this is being recorded and maybe will be listened to again.

(laughing)

So Matt, do you want to lead off with the Agilent Techs. case?

[MATT HENRY]

Sure. So, first case we're gonna talk about is Agilent case. Which is kind of a funny 112 case 'cause it's maybe also more about 102 in anticipation.

But enablement was brought in, and it was a very interesting case, and we wanted to talk about this briefly today. I'm glad Professor Lemley's not in here. He argued this case and lost it, unfortunately. But it would have been a little nerve-wracking if he was in the front row, critiquing my evaluation of his handling of the case here.

So, let me back up and preface, talk about some prior 112 case law, which is Amgen versus Sanofi. Which you'll need to understand what's happening in this case.

So if you remember a couple years ago, there was a Supreme Court case, Amgen, that claims were about essentially like functional antibody claims, so genus claims to a genus of antibodies. And the Supreme Court there found those claims to be invalid under 112 enablement, saying that like the spec basically didn't have enough support for these functional claims. Notwithstanding the fact that the spec had like 26 working examples and also presented, you know, what was characterized as like a roadmap for coming up with more working, you know, functional antibodies. The Supreme Court said, "Well, you know, 26, "that doesn't seem to be enough because we have "no idea how big this family could be.

"It could be thousands, it could be millions, who knows? So 26 may not be representative."

[WAYNE]

And then also that, you know, the roadmap that they provided that was just basically like, "Here's a trial and error kind of way to work through, and maybe you'll find some more working, you know, functional antibodies. Maybe you won't."

And so that's not good enough, so claims invalid under 112. And so that's like, you know, where we are with 112 enablement this Supreme Court case from two years ago. So then we get up to this case.

And what happened here is we had two patents and the claims were directed to, sorry. So they were directed to guide RNAs for CRISPR systems. All right?

And the technology isn't that important. One interesting thing is that they were challenged in IPRs and the lead reference they brought against it was a 102 reference that was an abandoned patent application that taught similar technology. All right?

So also taught guide nucleotides. So at the PTAB the IPRs, the PTAB said, "Okay, Yeah this looks like it's anticipating art. We're gonna find these claims invalid under 102."

So it goes up to the Federal Circuit what they try what Professor Lemley tries to argue is that, well, one, this was not enabled prior art. It was not enabling prior art, right? And so, you know, those of you that have dealt with 102 rejections, right, there's this issue like that you could raise, try and get around the 102 rejection and say like, "Oh yeah, well, I mean, it may teach that on its face But it's not actually enabled."

And so that's what they tried to do here of course on appeal that's a matter of fact. And so, you know, the, the Federal Circuit just said, "Yeah, we're gonna defer to, you know, the, the PTAB on their factual finding that it is in fact enabling." So then we get to the clever argument that Professor Lemley tried to make which is that, "Well hey, you remember this Amgen case from two years ago that said that, you know, your spec needs to enable the full scope of your claims here, right?" So what he argued was like, "Well, you know, this abandoned patent application that you're using is a 102 reference.

That's not enabling for the full scope of my claims, right? If it was enabled, they would have had this claim.

They wouldn't have abandoned it, but, you know, their, this prior art reference was abandoned because it was just full of prophetic teachings and the examples in, that they had in there in fact did not work and that's why this company abandoned the application. And so, you know, why could this now then be enabling prior art to invalidate, you know, my claim where I actually prove that this thing does work? So Lemley kind of focused his argument on, you know, go back and look at Amgen which said you know, that your claim needs to be fully enabled by, you know by the specification and said it should also apply for enabling prior art.

So kind of the, the key holding of this case is that Federal Circuit said like, "No that's, you're confounding things. The enablement standard under 112 for enabling a claim is different than what it takes to be enabling prior art for anticipation purposes." Which is like, okay, great, that's something that we all probably assume should be the right way, right? That you know, the standard for getting a claim on something and getting your limited monopoly, like that should be higher, right, in terms of the what you have to show in your spec.

The thing that bothers me about this case, and, and what I liked about Lemley's, you know, clever argument here is like, "Well hey, but this was an abandoned reference, right? It was an abandoned application and they weren't able to, you know, they wouldn't have been able to get this claim that we're going after.

Yet you're saying that it's good enough to invalidate my application where I actually showed that this thing works." And so that seems to be some tension there at least.

You know perhaps arguably in unjust that, you know, kind of this junk reference full of prophetic reference you know, prophetic teachings that did not in fact work is good enough to, you know, and anticipate my claim where I actually prove that it does work. So you know, I think that's one thing that bothers me about it even though, you know, as a prosecutor, I'm, I'm happy to be able to get my claims easier and don't have to you know, worry about that as much.

[MATT AVERY]

But, you know, I think it also is problematic in that, maybe it's opening the door to people making more junk disclosures and like, I don't know, pumping out AI slop that just includes all sorts of, you know, prophetic disclosures just to, you know, muddy up the waters because apparently that is perhaps good enough to be anticipating, you know, enabled anticipating prior art under 102. So that's the, the Agilent case.

Miku.

[MIKU MEHTA]

Thanks. Thanks, that's, you know, that's a really good point. So, I was just thinking about this.

I don't know how this impacts our duty of disclosure, if at all in terms of, well, we have our own publications or our own patent applications that are enabled to a certain standard. But then, where there are different inventors, do we have to cite more in where our other inventors have invented in our companies, and that's prior art, should we be more aggressive in filing information disclosure statements given the difference?

I don't know. I mean, it's--

[MATT AVERY]

Good question. I'd like to see an inequitable conduct case where they actually found claims unenforceable because I failed to cite prior art, right? I mean, like--

[MIKU MEHTA]

Yeah, it doesn't--

[MATT AVERY]

It's been a long time, right, since the law changed back in what was it? 2014, right? Where they raised the unenforceability standard.

So, I mean, obviously you should disclose everything, right? Disclaimer that you know about. But, I mean, like, the risk there, I think is pretty minimal from a practical standpoint.

[ANNA HYATT]

But maybe when in doubt, if you know about it, just cite it.

[MATT AVERY]

Right. Unless you're about to go to 51 references for that extra fee. And then you got to think about it a little harder now, right? They're punishing us for disclosing more, so that's unfortunate.

[MIKU MEHTA]

So, any other comments from, from a panelist on this case?

[MATT AVERY]

One thing that I was thinking about was maybe, maybe what I should be doing when I'm drafting now is fill up my own applications with AI slop, right?

(laughing)

To thwart future patentees, right? I'll just like fill it with a bunch of prophetic references to, you know, deter you know, people trying to, you know, get patents in the same space in the future because that's, that's good enough to thwart my competitors, perhaps.

Of course, you get into the problem when that app publishes And then it's, you know, prior art against your own subsequent applications in 18 months, right? So that's why you make sure you then file all your applications like 17 months and 29 days before, you know, after that AI slop app you filed, right?

[TOM IRVING]

Yeah, dedication disclosure pushed to the limit, right?

(laughs)

So all good. All good. So there's any questions or comments from audience on this case? Yeah.

[KANDA ISHIHARA]

Good morning? Been holding several cases in the past. So I'm not sure? I'm not saying is just unreasonable but a case that does not have to be England is not a real case.

[MATT AVERY]

Right. So the comment there was like, there's a lot of case law in this space, essentially along the same lines, that like you know, and which the Federal Circuit repeated here. It's like, "Yeah, we are standing by our prior case law that You know, for prior art to be enabling, you just have to have like a teaching of a single embodiment that's enabled, that would fall within the scope of your claims," right?

So that's been repeated many times. So really, you know, what is new about this case is holding that up in the context of Amgen from 2023. You know, and what Synthego was trying to do,

which I thought was a clever argument, was like, "Hey, maybe it's changed now because look, you've got this new Supreme Court case."

And the Federal Circuit said like, "Nope, we don't think that changes anything." So, yeah.

[TOM IRVING]

Yeah. The other thing I noticed, so many times we look at invalidity defenses or we're asked to review invalidity, and it used to be where we would say, "Okay, well, if there's not a prior art invalidity position, then the patent must be pretty strong." But you can see so many Federal Circuit cases where 112 alone is now the basis for invalidating claims without prior art invalidity, and that's happening more and more. Last night when I was looking, there were two more Federal Circuit cases from last month and one from last week, where it was just almost 112 alone.

So it's that, it's not just that it's the law, it's that it's actually being used to invalidate patents on its own without you know, combination of 102, 103.

[MIKU MEHTA]

So that's, you know, one of the things we're seeing, so. The next case we have, and Anna, you'll have this one, US Synthetic Corp.

[ANNA PIETRETTI]

Yes. To continue on with the theme of enablement, this next case, US Synthetic versus ITC, this is a Federal Circuit decision came out early this year. It's in the context of composition of matter claims. Really, sort of spoiler, I'd say the case really reinforces the idea that Wands remains the governing framework for enablement analysis. So, and what I found interesting about studying this case was that it's in the material science space, whereas I generally practice in the large molecule antibody space, as I mentioned, and I got a little bit jealous reading this case because a lot of times this case came down to a lot about being--predictability was one of the Wands factors, and what you're able to enable and how you're able to tie structure to function.

Just a little bit of background. So USS is, manufactures these compounds called polycrystalline diamond compacts, or PDCs. They're essentially like these super hard cutting elements that can be used in drill bits. So the claims at issue were composition of matter claims, and they define specific properties like magnetic properties and they also said, tied these properties to a functional property, which was that they were produced without this process called leaching.

So initially, the administrative law judge and the ITC found that the claims were in fact infringed, and held that they were not invalid under 112, but they found them to be invalid under Section 101. So it went up on appeal and there, the Federal Circuit reversed the 101 ruling and also left the enablement finding intact.

But the intervenors had used that as a fallback position to 101. They-- they said, you know, that these claims are invalid under 112, and what they did is they tried to analogize it to the recently

decided Amgen v. Sanofi case. And they argued that the claims were not enabled because they covered every process under the sun that did not include leaching, so essentially saying that the claims were not commensurate with the scope of the disclosure.

[ANNA HYATT]

It was an interesting strategy, but the Federal Circuit rejected this argument, and they said that actually the spec had really detailed manufacturing guidance in the working examples, and also pointed out that because the claims themselves were not process claims, that they didn't have to disclose every possible method of manufacture. And so, what they really emphasized as well is they said, you know, looking at the Amgen case, they said that this is the same statutory enablement test that's been applied for over 100 years. One of the key holdings was that experimentation is permitted. And that the respondents had failed to prove that there was undue experimentation, I think really going back to the Amgen case, the issue there is they said that, you know, there's untold numbers of antibodies that could have fallen within the scope of that claim, and all these specifications really said is, "Go find them," that would have required an undue amount of experimentation.

And so, here they said, "You need to apply the Wands factors." Probably everybody in this room knows what those are, but looking at what's the quantity of experimentation needed, how much direction of guidances are in the spec, what do the working examples show, the nature of invention, the state of prior art. And key here is the predictability.

So what they found here was that the specification did describe the scientific basis that linked the functional properties, in this case, things like coercivity and magnetic saturation to the structural properties, which were mean free path and the cobalt content. And then the specification also disclosed process parameters that would produce the required structure, and in addition to that, they also included the measurement standards that you would need to use. And they had working examples where they compared all of their PDCs to the prior art and showed how they worked better.

So, sort of in conclusion, the Federal Circuit said they were enabled because they taught what the invention is, how to make it, and they demonstrated that it worked across the claimed ranges and anchored the claimed properties to reproducible measurements. So, I think some of the key takeaways from this case are that you can require some experimentation and still have the claims be enabled. It helps when it's in a more predictable art. I think that this is still going to be a significant challenge in the antibody space, for example, where it's much more difficult currently to tie structure to function.

Maybe in the future with more AI models and things like that it will become more predictable to be able to predict function based in structure. But here, they were able to measure specific properties and correlate those to structural features. So, I think just some sort of takeaway drafting, you know, practice lessons here might be we still can't rely on fully functional claiming, but as long as you have the data in your specification and you can tie structure and function together, you're in much better shape.

And keep in mind that the Wands factors reminds remains the governing framework and to draft with them in mind. And there, I think I'll stop there in case there are questions. Mm-hmm.

[MIKU MEHTA]

Yeah. Thank-- Thanks, thanks Anna. That's really good points on the difference in the level of skill in the art in different technologies. So I keep thinking, well, if we're working with different inventors, like even within an applicant, you can have different technologies from different inventors. How does that impact your, how you do your invention intake or disclosure? Because I think the inventors are at not at like an ordinary level of skill in the art.

They're at a very high level of skill in the art and when they tell us something, they may not be thinking about enablement the way that we do. And we have to ask sometimes some basic-- more basic questions to get things in the specification. So what, like in view of this case, would we change how we approach inventors to ask them some questions differently based on different technology areas, different levels of skill?

[ANNA HYATT]

Yeah, I think that's a great question. I mean, I think generally what I have to remember to do is when they bring something to me where, "Hey, we did this, we achieved this great result. We got this structure.

We got this product." And they say, "Here's how we did it." And they kind of, you know, mic drop.

But if you want to get some breadth in your claims, it does, it is helpful to include in the specification multiple ways that you could do that, and not just the one way that you did do it. So I think going back and saying, "Hey, you know, I know we did it this way, but are there other ways that would work as well? Let's make sure we describe those."

[MIKU MEHTA]

And is that, that's more or less consistent with what Amgen is, is saying in terms of disclosing more or less every, every species you want to claim?

[MATT AVERY]

Yeah. I think so in terms of like, I think what the takeaway from Amgen is, is you gotta provide more guidance on like how to, you know, if you, you're claiming a family, like how to interpolate other, other functional members in that family or extrapolate out, you know however, however, you know, what your disclosure is and the direction you're trying to go in your claims. And certainly, you know, Miku, to your point, like what should we be doing during disclosure meetings is like if the inventors have a few cool examples, but we wanna try and claim broader, like ask them, "Well, how, what if you wanted to go in this direction or that direction? Like what, what would be the guidance that you would provide to someone?"

How would you do that?" You know, sometimes the inventors know, sometimes they don't though.

[ANNA HYATT]

Maybe I can add to that too. In the large molecule antibody space, so sometimes by the time somebody comes with an invention disclosure, they're really focused on a particular candidate or a lead. And so one thing I'll look at is, look, how narrowly do we have to claim here? Are we really just claiming this one candidate?

Do we have other molecules that do the same thing? What else have you made and what does the data look like? And so really having to go back and say, "Can, what else do you have?"

What else can we include here?" Especially if you wanna get scope, we really need the data to support it. And sometimes we even say, look, if we want to get additional breadth here, say we wanna claim a particular consensus sequence, for example, then we need sometimes to go back and generate more data to show that the full scope of what we're claiming, you would get the functional properties that you're claiming.

[MATT AVERY]

So I'm wondering you mentioned something about drafting with the Wands factors in mind. And, you know, one of 'em is quantity of experimentation and predictability, right? What do you think about the idea of like just putting in your spec like, oh yeah, it would be easy to do this experiment like on, you know, on its face, just put in like these qualitative terms about like, oh yeah, it would not be, you know very hard to do this further experiment to get to where I wanna go to.

Or yeah, it would be totally predictable to arrive at that, you know, just so you have intrinsic statements in the spec you could point to, to say like, oh yeah, this, you know, I'm, I'm totally supported by the Wands factors.

[ANNA HYATT]

We definitely try that.

(laughter)

Somebody has a question.

(unintelligible)

[MATT AVERY]

Well, it cuts both ways, right?

[MIKU MEHTA]

A suggestion at least, right?

[ANNA HYATT]

Yeah. I think the tension there, I mean, you know, a lot of in the antibody space specifically, a lot of the screening techniques are routine, right? And so it's, that's sort of not the issue, right? It's actually just if you're claiming a functional property, but it's really hard to envision what are all of the antibodies that with, in specific sequences of their binding regions that would actually have that functional property. So I think there's some tension there.

[MATT AVERY]

So too clever by half.

[MIKU MEHTA]

One thing I will say, when we look at all of these 112 cases is we can see how drastically prosecution practice has changed since a couple of decades ago, where if you had a 101 rejection, all you do is add in, like, non-transitory, or 112 rejection was about changing between the, and a, or an. It's gotten a lot more away from just examining prior art and giving prior art rejections, which I feel like maybe, you know, 20 years ago, it was almost all prior art in all of these cases were focused on KSR. And with some of these patents that are in the Federal Circuit cases, they're not as recent as in some of the other Federal Circuit cases.

The one I'm looking at is from, I think it was, like, from 2007 or 2008. You can ask, if you had the time machine and this invention was made, you know, after we had all these cases, would we be working with inventors the same way and drafting the same way? And in hindsight, we can always say the conclusion would've been different, but, you know, are the things that we're doing now as practitioners different enough based on the changes in practice to be ahead of some of these things? That's a, that's not a question wait--

[ANNA HYATT]

Yeah.

[MIKU MEHTA]

For an answer, but it's a kind of a something to think about in the way we communicate with inventors and examiners, right?

[ANNA HYATT]

Yeah, I think across the technology areas, it's helpful in practice just to really have a conversation with the inventors about what data is there. Have you told me everything that might be relevant here? I think in the more predictable spaces, you might end up in a better spot with less data.

I think in the less predictable spaces, I don't know that it's entirely clear that we know how much data is enough, or if there is such a thing as enough data to get a broad claim.

[MIKU MEHTA]

Yeah. Yeah. So, any questions? We'll have more time at the end, but any--

[KANDA ISHIHARA]

I think, to extending on the how, I feel like we also should extend on, you know, not how you do it right now, but how do you think it could work in the future, right? Yeah. In terms of being wholesome, in terms of including all that.

[MIKU MEHTA]

Right. And in the more predictable areas--

[KANDA ISHIHARA]

Mm-hmm.

[MIKU MEHTA]

The more predictable arts we have to think, because we may get new challenges that we didn't get before.

[KANDA ISHIHARA]

Right. Right? Right.

[MIKU MEHTA]

So, any other comments or questions on this one?

[KANDA ISHIHARA]

Somebody-- You, you, you explained about the antibody cases, and I'm wondering that, like, small molecule, Markush claim, is it more likely to get a 112 rejection model?

[ANNA HYATT]

So, I don't practice in the small molecule space, but usually what I hear from my small molecule counterparts is that case law has been more settled there longer. They don't seem to run into as many issues. That said, I'm really shocked, because I see those Markush groups that seem to encompass untold numbers of species.

So, great question. I don't know if someone else-- anyone else on the panel has comments on that, but--

[MATT AVERY]

No.

[MIKU MEHTA]

No, it's a good point. Uh, I-- I'm not in that space, so I can't comment on it, but yeah.

[MATT AVERY]

So, I see we got 14 minutes left, Miku.

[MIKU MEHTA]

Oh yeah. So, we're onto the we're gonna move from enablement to written description, and we're gonna talk about a case from about four months ago, but the patent was prosecuted about 18 years ago. So, you're gonna have to put on your, go into your, the DeLorean and time travel back to 2007 or 2008 when it was just changing, you know, A to THE. To look at this case, the technology is related to display controls.

On your left is the main figure from the specification and on your right is the claim. So the key point is to have control of a display, there's a protocol for matching the number. It's like a layer address associated with it's a registered number associated with a display and determining if that display is matched, and if it's matched, the process or computer can take control of that display. If it's not matched, you're not allowed to take control of that display.

So, it's just a display control technology. And in the specification, the specification and drawings referred to Step 4, which is comparing a received ID number with a registered ID number. That's the disclosure in the specification. That's the key point of matching.

I did look at the file history of this case, and the claims were all rejected based on the prior art. I'll explain what the applicant and applicant's representative discussed with the examiner in just a minute here. But then we look at the claims here on your right, and you can see I've underlined what was added during prosecution after discussion between the USPTO and the applicant.

The matching was changed to, from identifying set for a number, identifying said display unit to a type of display unit, the unit itself. So this was added during prosecution, right? And you can see there's no type over here.

There's some background discretion in the background section of the patent, but it's not really relevant to this feature. There were, the office action, there were two interviews.

There was a first interview in which the applicant and the examiner agreed, and I made a screenshot of the information. It was from uh, March of 2007.

Examiner pointed out that the reference reads on the art, applicant disagrees. Then about a month later applicant confers that the Office Action is incorrect, and applicant proposes to more clearly specify the identification number as a type of display, which Examiner agrees will read over the previous prior art. So the examiners agreeing to this. This is in 2007.

Since then, there's been lots of training in the USPTO. We have lots of Federal Circuit cases on this. So what did the Federal Circuit do here?

So it was held that the claim 14 is invalid under 112, due to lack of written description. The Federal Circuit clarified that you don't need to explicitly state that it's a type of-- it-- that it's-- it's related to a type but you need to reasonably convey it in the specification.

And it wasn't reasonably conveyed in the specification. This is a written description issue; this is not an enablement issue. Enablement is explaining to the public how to use the invention.

Written description is showing that the inventor was in possession of the invention. They're two different things, and this is focused on that. And the other point is that there was some amount of expert testimony, and the Federal Circuit reminded us that the specification and drawings can show whether the inventor was in possession of the invention. Maybe different in enablement, or maybe you can provide 132 declaration for other reasons.

But when we're talking about written description, we're supposed to look at what was the original disclosure. And for me, this highlights the importance of having inventors, when you meet with them, they don't necessarily have an education on all of this law, and what is required of written description in the specification. We need to be sure that with enablement and written description, we do a good job of asking the right questions. And where we feel that they've given us an invention at a very high level, we've asked enough questions about exactly how it works to show the public, or to show the Patent Office that the inventor was in possession of the invention.

As I mentioned there was some discussion with the patent office, and even the patent office initially didn't check about this issue of the type. This was actually agreed between in an interview.

So, when you're prosecuting patent application, maybe sometimes you get a proposal for an examiner's amendment. Be very careful about making sure that when they propose something, you also check your specification. When your applicant proposes something, you check your specification. If it's an inventor or a member of the patent department, just make sure that everybody is checking and on the same page about this.

And again, I think there's been a lot more training in the patent office. There's been a lot more case law in this, we will be more focused on this now, and we are. But just keep this in mind for your drafting and prosecution. So yeah.

[KANDA ISHIHARA]

So, maybe I can add a little flavor to this case. I tried the earlier version of this patent to jury in the Eastern District of Texas. So, I've actually deposed these inventors.

But I think something that's interesting here is you're talking about having access to the inventors. This is a later version.

Nobody was talking to those inventors anymore. Those inventors never saw prosecution counsel after the patent application was filed, and now it was all through the attorneys from then on.

So you're talking about the crafting strategy, these patents were all crafted 100% with somebody's target product in front of them and then the prior art that we'd already put in front of them, so they were trying to get around. So here I think it's interesting because no one was trying to do the original prosecution well, they weren't thinking about the original inventor, they were deep into the continuation process.

So--

[MIKU MEHTA]

How product reads and things like that.

[KANDA ISHIHARA]

Yes. So I'd love to hear that description on, you know, how to skirt that line on 112 going forward, because this is a big deal for continuation practice.

[MIKU MEHTA]

Yeah.

[KANDA ISHIHARA]

And by Way, I was on the defense side, not the Mondis side so,

[MIKU MEHTA]

Well, one thing that's interesting is that you know, there used to be a more common practice of every time the claims are amended, getting a new inventor declaration. I don't know if anybody's familiar with that practice. I hadn't done it, but I've seen some firms and some companies say, 'We're gonna,' because they're, the inventor is declaring that the, you know, that they invented the claimed invention, right?

Or the claims, that they're inventor of the claims, that's all you can be the inventor of. So, you know, if these are really important patents, and you wanna be sure, keep the inventor engaged, and if that's your practice, then have them submitting to a declaration I'm not commenting on the merits of that, but that's a possibility, so. Yeah.

[ANNA PIETRETTI]

The administrator--

[MIKU MEHTA]

Yes.

[AUDIENCE MEMBER ONE]

This documents discontinuation practice, especially in the context that you were was saying of litigation targeting or even pre-litigation targeting

(unintelligible)

targets? These inventors may be long gone from the company. It could be many years later.
And--

[ANNA HYATT]
There's your mic.

[MIKU MEHTA]
Oh, I'm sorry.

[AUDIENCE MEMBER ONE]
Yeah, sorry about that. Thank you. So to this point, did I turn it off?

[ANNA PIETRETTI]
It's on.

[MIKU MEHTA]
It's on.

[AUDIENCE MEMBER ONE]
To this point, when you prosecute these cases long after, the reality is that the inventors are often long gone, and as you were saying there used to be this practice of getting a declaration. That actually would be a good policy, I think, simply because you're adding this specific thing to the independent claim, and I think in honesty, many of us don't go back and figure out, like, 'Do we actually have all the right inventors named in this application?' You know, if we change the fundamental nature of what we're trying to say we invented based on this application in a way that means that you should go back to the inventors and figure out who actually should be named.

[MIKU MEHTA]
Yeah, do an inventorship check. Yeah. That's a good point. Probably move on to the last one here. So, yeah. So, yeah, kinda we're onto--

[KANDA ISHIHARA]
Sure.

[MIKU MEHTA]
The 112 FAB.

[KANDA ISHIHARA]

Yeah, so we have about five minutes left. I'm gonna talk about Fintiv. It's probably good we only have five minutes. I think, feel like it's the least complicated one.

A little bit of background, so Fintiv is a small tech company that owns patents related to mobile wallet and e-payments. You might recognize the name from a case that they filed a few years ago against Apple, where the Apple's challenge in the PTAB led us with the Fintiv rules on when to deny patent review if there's a, a pending parallel district court case. Obviously, we're gonna talk about the 112 issues that came out of Fintiv's lawsuit against PayPal.

So, Fintiv sued PayPal based on four patents.

[KEERTI REDDY]

During claim construction, the District Court held that a term called Payment Handler in the claims were invalid due to indefiniteness. After they completed the two-step 112

(f)

analysis, where the first step is whether or not this is a means plus function, and the second step is identifying the corresponding structure in the specification. So the District Court determined that Payment Handler terms are means plus function, so 112

(f)

does apply. And if you replace the term Means with Payment Handler then that invokes 112

(f)

. And the language from the claims, there's like two different four cases, but two different limitations.

It's a Payment Handler that exposes a common API for interacting with different payment processors and a Payment Handler service operable to use APIs of different payment processors, including one or more APIs of banks' credit and debit card processors for bill payment processors." That's the claim language. And if you look at the spec, it's exactly identical in the spec. And so the District Court for for the second step concluded that the spec doesn't disclose any adequate corresponding structure, and in this case the algorithm, like the how of that limitation.

So they concluded that this is indefinite on 112

(f)

. And on appeal Fintiv argued that 112

(f)

is not invoked because there is structure. So just going through a little bit of some of the issues that came out in the last two minutes of this case is the first one is like, when is 112

(f)

is invoked. The legal framework is that if there's a rebuttal presumption that the claims turned, do not have means then that's not means plus function, but the and Fintiv argued that Handler and Payment Handler identify structure. The Court disagreed with that, and they failed to identify structure, and that Payment doesn't impart structure into that term.

So terms like-- And this is kind of the where the nonce word issue comes in the term Payment Handler. Payment Handler--

[KANDA ISHIHARA]

--so that, um, the Court's analysis on that was that these are nonce words, like module or mechanism and that these are, the, this is just hardware that performs specified functions without indicating the how. So I think the real important this, importance in this is like not really focusing on what the term is, but what the term does. Um, I think that's what Fintiv was missing in the claim language here. They also tried to argue that the connecting words, like operable to or configured to help them, but that didn't work in that case.

Um, so I think that I'll, I'll just skip to some of this uh, sort of prosecution steps, the do's and don'ts, 'cause I think we have one minute left, and I'm trying to speak s-- fast from New York, so I can do that. Let's see.

So do I think-- I feel like these are somewhat obvious, but maybe I think what is important, too, is in your claims, to audit all your terms and making sure that you have enough details in there. So go through and highlight what the terms does, like I said, and not really what it, like what it is. Um, red flags might be just adding E-Rs to Words handler, right?

And then make sure, include details in your algorithm. I think, and just with, for 112 generally, it sounds like, you know, the more the merrier maybe in terms of details. And then don't just repeat spec language and put into your claims.

Like if you look at the limitation in the claims of the case, and you look right to the spec, it's exactly the same, and that's all that appears. So, I think they sort of failed in that respect. I think we're running out of time if there's any comments or questions, but I feel like this was somewhat of the most least complicated one, in terms of just making sure that you have, you know, specific claim language and details in your spec to support it.

[MIKU MEHTA]

But it's one of the most common rejections we're getting now, so you hit it right on the head, and everybody should be really aware of that. So, we can go afterwards, right, Wayne, if there's, if there's questions. Yeah, yep. So thank you very much, and thank you, panelists, for a great work.

(audience applauding)

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 "[did] not discuss, or even cite to, the *Wands* factors (Commission affirmed)

-On appeal, Intervenor argues that the asserted claims are not enabled under § 112 since the "unleached portion. . .**broadly claims every process** that does not include leaching" Intervenor **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)

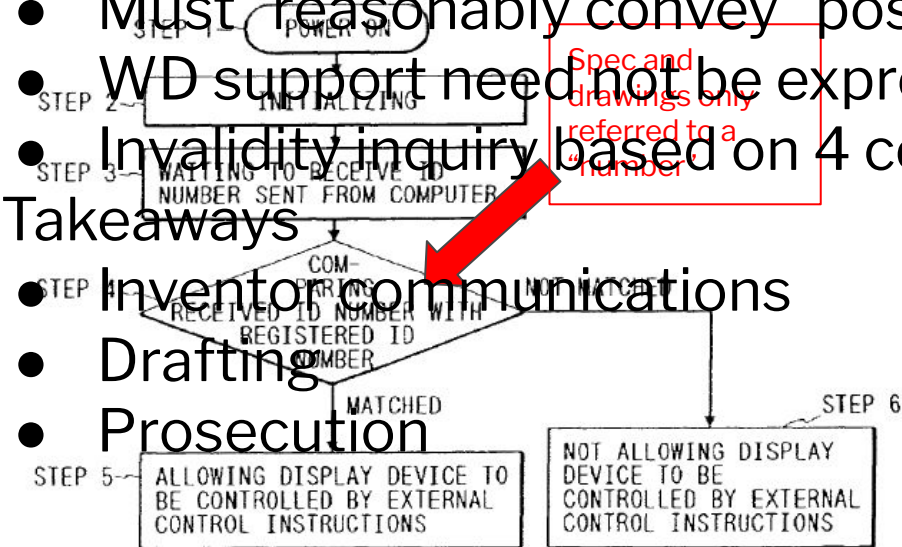
Held: Claim 14 is invalid under 35 USC §112(a) due to lack of written description

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



... 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).