KeyCite Yellow Flag - Negative Treatment
Distinguished by Enzo Biochem, Inc. v. Gen-Probe Inc., Fed.Cir.(N.Y.), April 2, 2002

935 F.2d 1555
United States Court of Appeals,
Federal Circuit.

VAS–CATH INCORPORATED and Gambro, Inc., Plaintiffs–Appellees,
v.
Sakharam D. MAHURKAR, and Quinton Instruments Company, Defendants–Appellants.

Nos. 90–1528, 91–1032.
|
June 7, 1991.
|
Rehearing Denied July 8, 1991.
|
Suggestion for Rehearing In Banc Declined July 29, 1991.

Corporation, its licensee and its sublicensee filed suit seeking declaratory judgment that their dual-lumen hemodialysis catheters did not infringe defendant's United States patents. The District Court, 745 F.Supp. 517, Frank H. Easterbrook, Circuit Judge, sitting by designation, held that two of defendant's patents were invalid. Appeal was taken. The Court of Appeals, Rich, Circuit Judge, held that material issues of fact existed as to whether design application's drawings provided "written description" of invention adequate to support claims of invalidated patents.

Reversed and remanded.

Attorneys and Law Firms

***1556** William L. Mentlik, Lerner, David, Littenberg, Krumholz & Mentlik, Westfield, ***1557** N.J., argued, for plaintiffs-appellees. With him on the brief, were Roy H. Wepner, John R. Nelson and Joseph S. Littenberg.

Raymond P. Niro, Niro, Scavone, Haller & Niro, Chicago, Ill., argued, for defendants-appellants. With him on the brief, were Joseph N. Hosteny and John C. Janka. Of Counsel was Michael P. Mazza.

Michael J. Sweedler, Darby & Darby, New York City, represented defendants-appellants, Quinton Instruments Co.

Before RICH, MICHEL and PLAGER, Circuit Judges.

Opinion

RICH, Circuit Judge.

Sakharam D. Mahurkar and Quinton Instruments Company (collectively Mahurkar) appeal from the September 12, 1990 partial final judgment [1] of the United States District Court for the Northern District of Illinois, Easterbrook, J., sitting by designation, in Case No. 88 C 4997. Granting partial summary judgment to Vas–Cath Incorporated and its licensee Gambro, Inc. (collectively Vas–Cath), the district court declared Mahurkar's two United States utility patents Nos. 4,568,329 ('329 patent) and 4,692,141 ('141 patent), titled "Double Lumen Catheter," invalid as anticipated under 35 U.S.C. § 102(b). In reaching its decision, reported at 745 F.Supp. 517, 17 USPQ2d 1353, the district court concluded that none of the twenty-one claims of the two utility patents was entitled, under 35 U.S.C. § 120, to the benefit of the filing date of Mahurkar's earlier-filed United States design patent application Serial No. 356,081 ('081 design application), which comprised the same drawings as the utility patents, because the design application did not provide a "written description of the invention" as required by 35 U.S.C. § 112, first paragraph. We *reverse* the grant of summary judgment with respect to all claims.

1 The district court directed entry of final judgment as to the issue of patent invalidity pursuant to Fed.R.Civ.P. 54(b).

BACKGROUND

Sakharam Mahurkar filed the '081 design application, also titled "Double Lumen Catheter," on March 8, 1982. The application was abandoned on November 30, 1984. Figures 1–6 of the '081 design application are reproduced below.

***1558**

FIG. 1

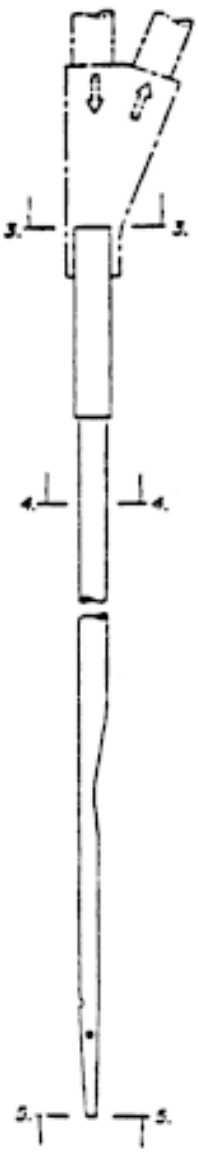
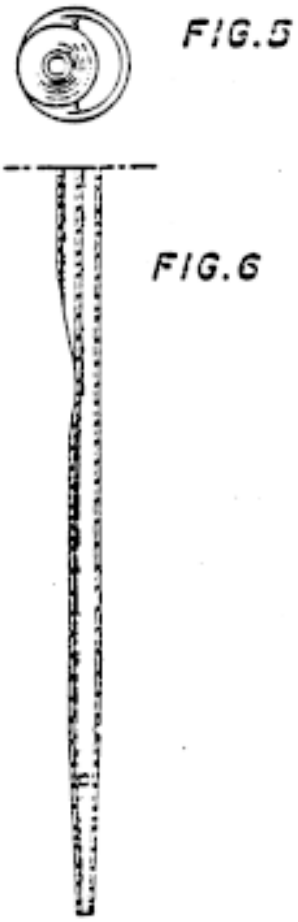


FIG. 2

FIG. 3

FIG. 4



As shown, Mahurkar's catheter comprises er comprises a pair of tubes (lumens) designed to allow blood to be removed from an artery, processed in an apparatus that removes impurities, and returned close to the place of removal. Prior art catheters utilized concentric circular lumens, while Mahurkar's employs joined semi-circular tubes that come to a single tapered tip. Advantageously, the puncture area of Mahurkar's semicircular catheter is 42% less than that of a coaxial catheter carrying the same quantity of blood, and its conical tip yields low rates of injury to the blood. The prior art coaxial catheters are now obsolete; Mahurkar's catheters appear to represent more than half of the world's sales. 745 F.Supp. at 520, 17 USPQ2d at 1353–54.

After filing the '081 design application, Mahurkar also filed a Canadian Industrial Design application comprising the same drawings plus additional textual description. On August 9, 1982, Canadian Industrial Design 50,089 (Canadian '089) issued on that application.

More than one year later, on October 1, 1984, Mahurkar filed the first of two utility patent applications that would give rise to the patents now on appeal. Notably, both utility applications included the same drawings as the '081 design application.[2] Serial No. 656,601 ('601 utility application) ***1559** claimed the benefit of the filing date of the '081 design application, having been denominated a "continuation" thereof. In an Office Action mailed June 6, 1985, the Patent and Trademark Office (PTO) examiner noted that "the prior application is a design application," but did not dispute that the '601 application was entitled to its filing date. On January 29, 1986, Mahurkar filed Serial No. 823,592 ('592 utility application), again claiming the benefit of the filing date of the '081 design application (the '592 utility application was denominated a continuation of the '601 utility application). In an office action mailed April 1, 1987, the examiner stated that the '592 utility application was "considered to be fully supported by applicant's parent application SN 356,081 filed March 8, 1982 [the '081 design application]." The '601 and '592 utility applications issued in 1986 and 1987, respectively, as the '329 and '141 patents, the subjects of this appeal. The independent claims of both patents are set forth in the Appendix hereto.

2 The utility patent drawings contain additional but minor shading and lead lines and reference numerals not present in the design application drawings.

Vas–Cath sued Mahurkar in June 1988, seeking a declaratory judgment that the catheters it manufactured did not infringe Mahurkar's '329 and '141 utility patents.[3] Vas–Cath's complaint alleged, inter alia, that the '329 and '141 patents were both invalid as anticipated under 35 U.S.C. § 102(b) by Canadian '089. Vas–Cath's anticipation theory was premised on the argument that the '329 and '141 patents were not entitled under 35 U.S.C. § 120[4] to the filing date of the '081 design application because its drawings did not provide an adequate "written description" of the claimed invention as required by 35 U.S.C. § 112, first paragraph.

3 Vas–Cath's apprehension of suit apparently arose from a 1988 Canadian action instituted by Mahurkar for infringement of Canadian '089.

4 Section 120, titled "Benefit of Earlier Filing Date in the United States," provides (emphasis ours):

> An application for patent for an invention *disclosed in the manner provided by the first*

> *paragraph of section 112 of this title* in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

Mahurkar counterclaimed, alleging infringement. Both parties moved for summary judgment on certain issues, including validity. For purposes of the summary judgment motion, Mahurkar conceded that, if he could not antedate it, Canadian '089 would represent an enabling and thus anticipating § 102(b) reference against the claims of his '329 and '141 utility patents. 745 F.Supp. at 521, 17 USPQ2d at 1355. Vas–Cath conceded that the '081 design drawings *enabled* one skilled in the art to practice the claimed invention within the meaning of 35 U.S.C. § 112, first paragraph. *Id.* Thus, the question before the district court was whether the disclosure of the '081 design application, namely, the drawings without more, adequately meets the "written description" requirement also contained in § 112, first paragraph, so as to entitle Mahurkar to the benefit of the 1982 filing date of the '081 design application for his two utility patents and thereby antedates Canadian '089.

Concluding that the drawings do not do so, and that therefore the utility patents are anticipated by Canadian '089, the district court held the '329 and '141 patents wholly invalid under 35 U.S.C. § 102(b), *id.* at 524, 17 USPQ2d at 1358, and subsequently granted Mahurkar's motion for entry of a partial final judgment under Fed.R.Civ.P. 54(b) on the validity issue. This appeal followed.

DISCUSSION

The issue before us is whether the district court erred in concluding, on summary judgment, that the disclosure of the '081 design application does not provide a § 112, first paragraph "written description" adequate to support each of the claims of ***1560** the '329 and '141 patents. If the court so erred as to any of the 21 claims at issue, the admittedly anticipatory disclosure of Canadian '089 will have been antedated (and the basis for the court's grant of summary judgment nullified) as to those claims.

[1] In reviewing the district court's grant of summary judgment, we are not bound by its holding that no material facts are in dispute, and must make an independent determination as to whether the standards for summary judgment have been met. *C.R. Bard, Inc. v. Advanced Cardiovascular Systems,* 911 F.2d 670, 673, 15 USPQ2d 1540, 1542–43 (Fed.Cir.1990). Summary judgment will not lie if the dispute about a material fact is "genuine," that is, if the evidence is such that a reasonable jury could return a verdict for the nonmoving party. *Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 248, 106 S.Ct. 2505, 2510, 91 L.Ed.2d 202 (1986).

The "Written Description" Requirement of § 112

The first paragraph of 35 U.S.C. § 112 requires that

> [t]he 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, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

(Emphasis added). Application of the "written description" requirement, derived from the portion of § 112 emphasized above, is central to resolution of this appeal. The district court, having reviewed this court's decisions on the subject, remarked that "[u]nfortunately, it is not so easy to tell what the law of the Federal Circuit is." 745 F.Supp. at 522, 17 USPQ2d at 1356. Perhaps that is so, and, therefore, before proceeding to the merits, we review the case law development of the "written description" requirement with a view to improving the situation. [5]

[5] For additional background, *see* Rollins, "35 USC 120—The Description Requirement," 64 *J.Pat.Off.Soc'y* 656 (1982); Walterscheid, "Insufficient Disclosure Rejections (Part III)," 62 *J.Pat.Off.Soc'y* 261 (1980).

The cases indicate that the "written description" requirement most often comes into play where claims not presented in the application when filed are presented thereafter. Alternatively, patent applicants often seek the benefit of the filing date of an earlier-filed foreign or United States application under 35 U.S.C. § 119 or 35 U.S.C. § 120, respectively, for claims of a later-filed application. The question raised by these situations is most often phrased as whether the application provides "adequate support" for the claim(s) at issue; it has also been analyzed in terms of "new matter" under 35 U.S.C. § 132. The "written description" question similarly arises in the interference context, where the issue is whether the specification of one party to the interference can support the claim(s) corresponding to the count(s) at issue, i.e., whether that party "can make the claim" corresponding to the interference count.

To the uninitiated, it may seem anomalous that the first paragraph of 35 U.S.C. § 112 has been interpreted as requiring a separate "description of the invention," when the invention is, necessarily, the subject matter defined in the *claims* under consideration. *See In re Wright,* 866 F.2d 422, 424, 9 USPQ2d 1649, 1651 (Fed.Cir.1989). One may wonder what purpose a separate "written description" requirement serves, when the second paragraph of § 112 expressly requires that the applicant conclude his specification "with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

One explanation is historical: the "written description" requirement was a part of the patent statutes at a time *before* claims were required. A case in point is *Evans v. Eaton,* 20 U.S. (7 Wheat.) 356, 5 L.Ed. 472 (1822), in which the Supreme Court affirmed the circuit court's decision that the ***1561** plaintiff's patent was "deficient," and that the plaintiff could not recover for infringement thereunder. The patent laws then in effect, namely the Patent Act of 1793, did not require claims, but did require, in its 3d section, that the patent applicant "deliver a written description of his invention, and of the manner of using, or process of compounding, the same, in such full, clear and exact terms, as to distinguish the same from all things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound and use the same...." *Id.* at 430. In view of this language, the Court concluded that the specification of a patent had two objects, the first of which was "to enable artizans to make and use [the invention]...." *Id.* at 433. The second object of the specification was

> to put the public in possession of what the party claims as his own invention, so as to ascertain if he claims anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented. It is, therefore, for the purpose of warning an innocent purchaser, or other person using a machine, of his infringement of the patent; and at the same time, of taking from the inventor the means of practising upon the credulity or the fears of other persons, by pretending that his invention is more than what it really is, or different from its ostensible objects, that the patentee is required to distinguish his invention in his specification.

Id. at 434.

A second, policy-based rationale for the inclusion in § 112 of both the first paragraph "written description" and the second paragraph "definiteness" requirements was set forth in *Rengo Co. v. Molins Mach. Co.,* 657 F.2d 535, 551, 211 USPQ 303, 321 (3d Cir.), *cert. denied,* 454 U.S. 1055, 102 S.Ct. 600, 70 L.Ed.2d 591 (1981):

> [T]here is a subtle relationship between the policies underlying the description and definiteness requirements, as the two standards, while complementary, approach a similar problem from different directions. Adequate description of the invention guards against the inventor's overreaching by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original creation. The definiteness requirement shapes the

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.