



that the written description requirement does not exist. He also said that the Federal Circuit has been criticized for not properly explaining the doctrine.

“Court and legal commentators alike have expressed concern that the Court has never clearly articulated what is necessary to satisfy the written description-possession test,” Whealan wrote. “In sum, the written description doctrine has essentially taken on a life of its own[.]”

He further argued that Congress never intended for inventors to describe their inventions in the abstract. Instead, he wrote, the reason the term “written description” is included in the patent code at all is purely to facilitate what is known as the “enablement” doctrine: “to enable a person of ordinary skill to make and use the invention.”

He warned that if the court continues to require written descriptions in patents, there will be “severe adverse consequences for research universities and biotechnology companies” by reducing incentives for research and chilling development.

In essence, Bromberg said, Ariad’s argument hinges on convincing the Federal Circuit that a written description requirement is merely a subset of the enablement requirement rather than its own separate test.

“If the patent enables, then it counts,” Bromberg said in summarizing Ariad’s case. “You don’t need some detailed description. And that’s significant, primarily because in the biotech field, for a person of ordinary skill in the art, it’s a very high level of skill, typically a Ph.D. in a serious, difficult subject, plus some years of lab experience. So if you’re a person like that, and you know these things, maybe you have enough, right? You’re enabled to do it.”

### ‘May not reap where he has not sown’

In a brief written by Howard W. Levine of Finnegan, Henderson, Farabow, Garrett & Dunner in Washington D.C., Eli Lilly argued that the written description requirement is an important protection against overly broad patent claims.

“[A] patent applicant may not reap where he has not sown,” Levine wrote. “The patent statute requires a description of the

**“What’s at stake in the business world is, ‘How far do we need to get [in development] before we can get our patent?’”**

— Professor Michael J. Meurer

invention, beyond mere enablement, that ensures that what has been patented is a completed invention[.]”

Levine argued that Ariad had audaciously claimed all methods of inhibiting a certain kind of molecule’s activity in a cell, even though it had not actually invented any means of doing so.

The written description requirement prevents such “preemption of great swaths of fertile research ground by those whose ideas have not yet advanced to the point of a full and complete conception,” he wrote.

That argument — that it is impossible to see whether the inventors of a patent were

really in possession of the invention unless they accompany it with a detailed explanation — is a favorite of those who support the written description requirement, Bromberg said.

But whether the possession argument trumps the enablement doctrine is “a real dilemma,” he added. “It’s not easy to resolve.”

Meurer said that the possession argument is especially problematic because the courts have applied it only to biotech and chemical patents, while patents for simpler products, such as electronic appliances, are not penalized if they are submitted before the product is completed.

“If I invented a new DVR, no one would have ever expected me to have actually made the DVR by the time I filed my application,” he said. “That’s another reason why the biotech patent people really hate [the written description requirement]. They feel like they’re being picked on, like they’re being singled out. And they are.”

Still, Meurer said he finds it unlikely that the Federal Circuit will grant Ariad’s request to abolish the written description entirely.

“That’s not going to happen,” he said. “The reason that I’m so confident that the court is going to maintain the separate written description requirement is that it’s pretty solidly entrenched in the caselaw, and it’s also valuable. If they decided to jettison it, they would probably run into more trouble with the Supreme Court.”

**MLW**

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