



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

PIN/NIP, Inc.
v.
Platte Chem.
Co.

No. 02-1056
Federal Circuit
Sept. 4, 2002

“[A] broad claim is invalid when the entirety of the specification clearly indicates that the invention is of a much narrower scope.”

On September 4, 2002, the Federal Circuit, *inter alia*, reversed the district court’s summary judgment that claim 33 of U.S. Patent 5,622,912 is not invalid under 35 U.S.C. § 112, ¶ 1. The patented technology related to a composition and methods for inhibiting sprout growth on tubers, such as potatoes. The Federal Circuit stated:

PIN/NIP argues that claim 33 is invalid for lack of a written description under 35 U.S.C. § 112, ¶ 1, because claim 33, in defining a spaced, sequential application of the chemicals, extends beyond the invention as described in the originally filed application, viz., a unitary mixture of CIPC and a substituted naphthalene. Platte responds by arguing that its originally filed disclosure does describe or at least enable one skilled in the art to make spaced, sequential applications of the chemicals separately. Platte further argues that the subject matter of claim 33 is actually disclosed in the patent specification. Finally, Platte argues that this situation is distinguishable from other cases in which we have held later-added claims to be invalid for violation of the written description requirement.

We agree with PIN/NIP that claim 33 is invalid. [N]othing in the specification indicates that the invention is anything other than a mixture of two chemicals. Platte added claim 33 to its pending patent application to encompass separate applications of the ingredients to tubers. Platte even admits that “claim 33, as written, is arguably broader than the examples disclosed in the ’912 patent.” While it is legitimate to amend claims or add claims to a patent application purposefully to encompass devices or processes of others, there must be support for such amendments or additions in the originally filed application. In this case, the originally filed application, which is devoid of any mention or even implication that the two chemicals can be applied in a spaced, sequential manner, does not support the later-added claim 33. . . .

[T]he ’912 patent specification indicates that the invention involves a “composition,” as we have construed the term, and methods for its application, while claim 33 is different, being directed to sequential application in multiple “steps.” In fact, as indicated earlier, it was the combination of two old chemicals that was patentable. Thus, use of multiple steps involving separate components is quite distinct from use of a composition containing those components. PIN/NIP’s argument that the subject matter of claim 33 is disclosed in the specification must also fail. The specification describes only three methods of treating tubers: application of a substituted naphthalene alone (prior art), application of CIPC alone (prior art), and application of a mixture of both chemicals. None of these methods is the same as the spaced, sequential application of the two chemicals, which is the subject matter of claim 33. New claim 33 is directed to new subject matter, and we hold that no reasonable juror could conclude otherwise. We therefore reverse the judgment that claim 33 satisfies the written description requirement and vacate the judgment that PIN/NIP infringed claim 33. Claim 33 is invalid.