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# TECHNOLOGY LAW UPDATE

*A report of the latest Federal Circuit updates brought to you by Preston Gates.*

## CFMT, Inc. v. Yieldup Int'l Corp.

No. 01-1452 (Fed. Cir. Nov. 12, 2003)

***“[I]mprovement and selection inventions are ubiquitous in patent law; such developments do not alone cast doubt on enablement of the original invention.”***

On November 12, 2003, the Federal Circuit, *inter alia*, vacated and remanded the district court's summary judgment that U.S. Patents No. 4,778,532 and No. 4,917,123, which related to cleaning systems for semiconductor wafers, were invalid for lack of enablement. The Federal Circuit also reversed the district court's ruling following a bench trial that the patents were unenforceable for inequitable conduct. The Federal Circuit stated:

[W]hen an invention claims a general system to improve the cleaning process for semiconductor wafers, the disclosure enables that invention by showing improvements in the overall system. Of course, if a patent claimed a system that achieved cleanliness up to a specified numerical particle-free range, then enablement would require disclosure of a method that enables one of ordinary skill to achieve that range without undue experimentation. Thus, the level of disclosure necessary to satisfy section 112 of title 35 varies according to the scope of the claimed invention. . . . “Patents are not production documents, and nothing in the patent law requires that a patentee must disclose data on how to mass-produce the invented product. [T]he law requires that patents disclose inventions, not mass-production data, and that patents enable the practice of inventions, not the organization and operation of factories.”

[The] district court essentially concluded that the invention claimed in the patents at issue simply did not work, that is, could not clean wafers, and therefore it would require undue experimentation to carry out the invention. [Although] the district court's major premise is correct that an inoperable invention is not enabled, the district court erred in its minor premise that the claimed invention is inoperable and lacks utility. The inoperability standard for utility applies primarily to claims with impossible limitations. Moreover, where a patent discloses several alternative combinations of methods (as most systems claims will), the party asserting inoperability must show that all disclosed alternatives are inoperative or not enabled. The [patents] do not claim an impossible result or an inoperative invention.

[I]mprovement and selection inventions are ubiquitous in patent law; such developments do not alone cast doubt on enablement of the original invention. [F]ew patented inventions are an immediate commercial success, [and] most inventions require further development to achieve commercial success. Thus, additional inventive work does not alone show nonenablement. [T]he district court [presumed] incorrectly that development of an improvement patent, the '761 [here], implies extensive experimentation. To the contrary, patent acquisition does not require any threshold level of effort or ingenuity. [T]he '761 improvement patent alone is not conclusive evidence of undue experimentation.

[T]he district court concluded that CFMT committed inequitable conduct in its comments about the advantages of the invention during prosecution of the '532 patent to overcome a rejection for obviousness. [A]n applicant cannot prove unexpected results with attorney argument and bare statements without objective evidentiary support, [but] may submit objective factual evidence to the PTO in the form of patents, technical literature, and declarations under 37 C.F.R. § 1.132 submitting expert testimony and, at times, test data. The advantages advocacy in this case does not fit any of these categories and was [not] asserted to be supported by any factual evidence. [A] reasonable examiner would not have found it important in deciding whether to allow the application. [T]he district court clearly erred in finding that the applicants' statements to the PTO were misrepresentations and in finding that those statements were highly material to the examiner's actions.