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TECHNOLOGY LAW UPDATE

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

Bilstad v. Wakalopulos

No. 03-1528 (Fed. Cir. Oct. 7, 2004)

“[D]isclosure of a species may be sufficient written description support for a later claimed genus including that species [but] unpredictability in the particular field may warrant closer scrutiny of whether disclosure of a species is sufficient to describe a genus.”

On October 7, 2004, the Federal Circuit affirmed-in-part, vacated-in-part, and remanded the decision of the Board of Patent Appeals and Interferences that awarded judgment to Wakalopulos in an interference between U.S. patent application Serial No. 09/294,964 (Bilstad) and U.S. Patent No. 6,140,657 (Wakalopulos), which related to the sterilization of three-dimensional objects using non-deleterious ionizing radiation. The Federal Circuit stated:

Bilstad next argues that the Board erred in insisting that Bilstad’s application must describe every embodiment within the range of two to infinity to support the count, copied by Bilstad, under the Board’s construction of the term “plurality.” The question requires consideration of whether the Bilstad disclosure, as filed, “reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date.” [S]everal cases have considered the issue of written description support for an added genus claim when only a species is disclosed. [T]his court has continued to apply the rule that disclosure of a species may be sufficient written description support for a later claimed genus including that species. [H]owever, exceptions [exist] to the general rule that disclosure of a species provides sufficient written description support for a later filed claim directed to the genus.

[U]npredictability in the particular field may warrant closer scrutiny of whether disclosure of a species is sufficient to describe a genus. [The crux is] what would be reasonably conveyed to a person skilled in the art at the time of the original disclosure. If the difference between members of the group is such that the person skilled in the art would not readily discern that other members of the genus would perform similarly to the disclosed members, i.e., if the art is unpredictable, then disclosure of more species is necessary to adequately show possession of the entire genus. . . .

[T]he Board never truly discussed the understandings of persons skilled in the art and whether Bilstad’s written description would reasonably convey to a person skilled in the art that Bilstad had possession of the claimed subject matter at the time of filing. [T]he Board made no findings on the unpredictability in the art or on whether Bilstad’s disclosure expressly disclaimed manipulation in a larger number of directions than the “small number” that the Board found his disclosure taught. In the mechanical world—a fairly predictable field—it is wholly conceivable that manipulation in a small number of directions may convey to one skilled in the art that Bilstad indeed described manipulation in a “plurality” of directions. [T]he record contains no analysis of what one skilled in the art would have understood from the Bilstad disclosure or the degree of predictability of technical variations in this field of art. The Board noted that Bilstad’s written description disclosed manipulating objects in only a small number of directions and concluded that this was insufficient to support the manipulation of objects in a range bounded by two and infinity. Under the circumstances of this case, however, the Board erred in failing to consider the knowledge of one skilled in the art and the level of predictability in the field.

[A] resolution of the question of whether Bilstad’s disclosure of manipulation in a small number of directions would reasonably convey to a person skilled in the relevant art that Bilstad had possession of manipulation in a plurality of directions as of his filing date requires fact findings this court is not permitted to make. Accordingly, we vacate the Board’s decision [and] remand for reconsideration under the proper test for support of the count.