



## TECHNOLOGY LAW UPDATE

***Pandrol USA, LP***  
**v.**  
***Airboss Ry. Prods.,  
Inc.***

No. 04-1069

Federal Circuit  
Sept. 19, 2005

*"The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required 'to recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.'"*

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On September 19, 2005, the Federal Circuit affirmed the district court's summary judgment that U.S. Patent No. 5,110,046, which related to a railroad track fastening system, was not invalid for inadequate written description requirement under 35 U.S.C. § 112. The Federal Circuit stated:

The district court observed that the "statements in the '046 patent are more than adequate to satisfy the written description requirement of 35 U.S.C. § 112." A patent specification must contain an adequate written description. . . . "The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required 'to recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.'" Compliance with § 112 requires sufficient information in the specification to show that the inventor possessed the invention at the time of that original disclosure. The possession test requires assessment from the viewpoint of one of skill in the art.

With respect to the "adhering material" claim limitation, the original written description of the '046 patent describes a closed cell foam pad. During prosecution, amendments were made to both the claims and the specification. Thus, for the purposes of the written description analysis, this court's focus is on the original disclosure. . . . The written description of the '046 patent discloses an "adhering material," as claimed, in sufficient detail to show possession of the full scope of the invention.

The specification discloses that the invention provides an effective adhesive seal between the plate and concrete rail tie. . . . At another point, the specification describes an effective seal as "essential." The '046 patent then discloses two alternatives for achieving this feature: either with epoxy or with an HDPE closed cell foam gasket. [The specification] passages show that one way of providing an effective adhesive seal between the plate and concrete rail tie is a closed cell foam pad.

With respect to the "sole means" limitation, claim 1 says that the adhering material is the "sole means" for adhering the abrasion resistant plate to the rail ties. The '046 patent describes and shows "a rail 2 which . . . sits on a rail pad 4 interposed between rail 2 and the concrete tie 1." "The rail is held in place by rail clamp 6 which is held in clamp support 5" and has a toe portion that "bears down on rail flange 3 through the insulator 7." Those passages, however, do not establish that the mechanical clamping system also performs the adhering function. The patent shows that the clamping system secures or clamps some parts mechanically but does not adhere. The record does not show that the pressure exerted by the railed clips causes or contributes to the adhering performed by the HDPE foam. Thus, the disclosed adherents remain the "sole means" for that function.

In addition, the sole means limitation refers to the specific bonding of the rail tie to the rail pad to prevent erosion of the concrete rail tie with a watertight seal. Thus, the foam gasket primarily prevents erosion. In contrast, the primary purpose of the clamps is to lock or hold the system in place. The district court correctly discerned that the specification provides adequate distinctions between clamping and adhering to show possession of the "sole means" aspect of the claimed invention.