



TECHNOLOGY LAW UPDATE

LizardTech, Inc.
v.
*Earth Res. Mapping,
Inc.*

No. 05-1062

Federal Circuit
Oct. 4, 2005

[A] patentee cannot always satisfy the requirements of section 112, in supporting expansive claim language, merely by clearly describing one embodiment of the thing claimed.

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On October 4, 2005, the Federal Circuit affirmed the district court's summary judgment that ERM did not infringe U.S. Patent No. 5,710,835, which related to wavelet transforms, and that the patent was invalid under 35 U.S.C. § 112. The Federal Circuit stated:

The "written description" clause of section 112 has been construed to mandate that the specification satisfy two closely related requirements. First, it must describe the manner and process of making and using the invention so as to enable a person of skill in the art to make and use the full scope of the invention without undue experimentation. Second, it must describe the invention sufficiently to convey to a person of skill in the art that the patentee had possession of the claimed invention at the time of the application, i.e., that the patentee invented what is claimed.

Those two requirements usually rise and fall together. That is, a recitation of how to make and use the invention across the full breadth of the claim is ordinarily sufficient to demonstrate that the inventor possesses the full scope of the invention, and vice versa. This case is no exception. . . . Claim 21 is directed to creating a seamless array of DWT coefficients generically. The specification, however, is directed at describing a particular method for creating a seamless DWT, as opposed to using the disfavored, nonseamless prior art, and it teaches only that method of creating a seamless array. While the embodiment in LizardTech's specification covers only one way of creating a seamless DWT, claim 21 is not invalid simply for that reason. A claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language. That is because the patent specification is written for a person of skill in the art, and such a person comes to the patent with the knowledge of what has come before. Placed in that context, it is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the invention and to enable such a person to make and use the invention without undue experimentation. . . . LizardTech has failed to meet either requirement. After reading the patent, a person of skill in the art would not understand how to make a seamless DWT generically and would not understand LizardTech to have invented a method for making a seamless DWT, except by "maintaining updating sums of DWT coefficients." . . .

The single embodiment would support such a generic claim only if the specification would "reasonably convey to a person skilled in the art that [the inventor] had possession of the claimed subject matter at the time of filing," and would "enable one of ordinary skill to practice 'the full scope of the claimed invention.'" To hold otherwise would violate the Supreme Court's directive that "[i]t seems to us that nothing can be more just and fair, both to the patentee and the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent." Thus, a patentee cannot always satisfy the requirements of section 112, in supporting expansive claim language, merely by clearly describing one embodiment of the thing claimed. For that reason, we hold that the description of one method for creating a seamless DWT does not entitle the inventor of the '835 patent to claim any and all means for achieving that objective.