



TECHNOLOGY LAW UPDATE

Callicrate
v.
Wadsworth Mfg.

Nos. 04-1597, -1598

Federal Circuit
Oct. 31, 2005

[A] patent specification may sufficiently enable a feature under § 112, ¶ 1, even if only the background section provides the enabling disclosure. [D]isparaging remarks in a background section or remarks characterizing the prior art as less effective do not remove those disclosures as enabling references.

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On October 31, 2005, the Federal Circuit reversed and remanded the district court's judgment entering the jury verdict that U.S. Patents No. 5,997,553 and No. 5,681,329, which related to castration tools, were not infringed and were invalid as anticipated and obvious. The Federal Circuit stated:

The jury also found the '329 and '553 patents anticipated by, and obvious in view of, Wadsworth's intervening [U.S. Patent No. 5,425,736]. The '329 and '553 patents, however, claim priority to [U.S. Patent 5,236,434], which was filed before the '736 patent. . . . The '736 patent can only qualify as prior art if the '329 and '553 patents cannot trace priority back to the '434 patent.

[A] "patent may only claim priority to an earlier application if the earlier application fulfills the requirements of § 112, first paragraph. [T]he district court determined that the '434 patent did not contain adequate "disclosure" or "support" for the use of a caulking gun-type tightening mechanism for three reasons: (1) the only disclosure of the caulking gun-type tightening mechanism is in the background section; (2) the background section contains disparaging remarks about this mechanism; and (3) Callicrate distinguished his winding assembly mechanism from the caulking gun-type tightening mechanism during prosecution. These three reasons, even in combination, do not support the district court's conclusion of no enablement.

[A] patent specification may sufficiently enable a feature under § 112, ¶ 1, even if only the background section provides the enabling disclosure. [T]he background section's discussion of problems with the caulking gun-type tightening mechanism does not mean that one of ordinary skill in the art would not, after reading this discussion, know how to make and use this feature. [Indeed,] disparaging remarks in a background section or remarks characterizing the prior art as less effective do not remove those disclosures as enabling references. [T]he '434, '329 and '553 patents all identify problems with the caulking gun-type tightening mechanism, but by no means indicate that this mechanism cannot perform the tightening/pulling function.

[T]he '434 patent's prosecution history is no more dispositive. [During] prosecution, the Examiner rejected the pending claims over Wadsworth's '704 patent . . . in view of U.S. Patent No. 2,487,425. Callicrate responded by challenging the motivation to combine these references because the '425 patent was non-analogous art. Callicrate further argued that, even when combined, the references do not teach a process that could "achieve quick and tight application of a ligature band to a body part in accordance with claim 1." . . . Callicrate pointed out the very same problems with these devices that already appeared in the background section. At no time, however, did Callicrate have any reason to explain how or why the caulking gun-type mechanism could not be used as a means for pulling in the '434 patent because the pending application did not claim that technology.

Thus, the district court did not articulate any sound reasons that the '434 patent does not enable the caulking gun-type mechanism. To the contrary, the '434 patent specifically referred to that prior art technology. Without any basis in this record to determine that one of skill in the art could not make and use a caulking gun-type tool with this disclosure, this court cannot sustain the district court's nonenablement conclusion. Thus, the '329 and '553 patents may claim priority based on their relationship to the '434 patent.