

Predictability and Criticality of a Limitation May Be Relevant to the Written Description Analysis

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In re: Global IP Holdings LLC, No. 2018-1426 (Fed. Cir. July 5, 2019)

The patentee sought a broadening reissue of its patent to replace the claim limitation “thermoplastic” with “plastic.” The examiner rejected the reissue claims for failure to satisfy the written description requirement, and the Patent Trial and Appeal Board (PTAB) affirmed. The examiner reasoned that the specification only describes thermoplastic materials, and not broader “plastic materials.” The PTAB affirmed, finding that “regardless of the predictability” of using plastics generally “or the actual criticality of thermoplastics,” the broader claims are not supported by the specification such that they were possessed by the inventors.

The Federal Circuit vacated and remanded because the PTAB’s analysis conflicted with the court’s written description precedent. In particular, the predictability and criticality of the substituted alternative may indeed be relevant to the written description analysis. The level of detail required in the specification “varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” Moreover, if an element is not critical because it was not used to overcome prior art, that lack of criticality may be relevant to the level of detail required to satisfy the written description requirement.

[A copy of the opinion can be found here.](#)

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