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CLIENT ALERT

Specification That Discloses No Range of Values Does Not Provide Sufficient Written Description for Claiming a Specific Range of Values

FEBRUARY 17, 2022

Indivior UK Limited v. Dr. Reddy's Laboratories S.A., Nos. 2020-2073, 2020-2142 (Fed. Cir. Nov. 24, 2021)

This opinion concerns an appeal and cross-appeal of a Patent Trial and Appeal Board ("PTAB") *inter partes* review ("IPR") decision and addresses the question of whether claims in a later-filed application were entitled to the filing date of an earlier application. The patent-at-issue was the fifth continuation in a chain of applications, the earliest of which was filed on August 7, 2009 and was published on February 10, 2011. Petitioner challenged claims 1-5 and 7-14 in the IPR by alleging that the limitations reciting specific polymer weight percentages added to the claims by amendment do not have written description support in the earlier patent application, and thus, the challenged claims are not entitled to the benefit of the earlier patent application's filing date. Patent owner did not dispute that if the earlier patent application lacked written description of the challenged claims, making the publication of the earlier patent application prior art, the earlier patent application anticipated the challenged claims. PTAB found that the earlier patent application did not provide written description support for claims 1-5, 7, and 9-14, but it did for claim 8. Accordingly, PTAB invalidated claims 1-5, 7, and 9-14 and upheld the validity of claim 8.

On appeal, the Federal Circuit affirmed PTAB's findings. While noting that what is needed to satisfy the written description requirement is highly fact-dependent, the Federal Circuit agreed that for the polymer range limitations in claims 1, 7, and 12 that recited a specific range of values of polymeric content of a film, the earlier patent application did not provide a sufficient written description to support these claims. The Federal Circuit agreed with PTAB that a specific range of values of polymeric content of the film was neither expressly claimed in nor described in the earlier patent application. In addition, there are other indications of the polymeric content of the film in the earlier patent application that appear to be contrary to or inconsistent with the closed ranges recited in these claims. In the case of a claimed range, a skilled artisan must be able to reasonably discern a disclosure of that range, and the earlier patent application failed to do so here, rendering claims 1-5, 7, and 9-14 as unpatentable.

Claim 8, however, recited a specific value of the polymeric content of the film that PTAB found could be calculated by a person of ordinary skill in the art from the disclosures in Tables 1 and 5 of the earlier patent application. The Federal Circuit deferred to PTAB's fact finding on this issue because claim 8 does not recite a range, but rather a specific amount that was derivable from the disclosure in the earlier patent application. Accordingly, petitioner failed to demonstrate that claim 8 was anticipated by the earlier patent application.

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