

**Keywords:** 35 U.S.C. § 112, ¶1; Written Description Requirement; Enablement Requirement.

**General:** In common parlance, as well as in the case law, the three requirements of § 112, ¶ 1 are the “written description requirement,” the “enablement requirement,” and the “best mode requirement.” For the written description requirement, a description of what a claimed material does, rather than what it is, usually does not suffice. In this case, the Rochester ‘850 patent discloses nothing more than a hoped-for function for an as-yet-to-be discovered compound and a research plan for trying to find it.

*University of Rochester v. G.D. Searle & Co.*  
69 U.S.P.Q.2d 1996 (Fed. Cir. 2004)  
Decided February 13, 2004

**I. Facts**

The University of Rochester appealed from the decision of the District Court for the Western District of New York granting summary judgment to “Pfizer.” The District Court held that Rochester’s ‘850 patent does not comply with the written description requirement of 35 USC § 112, ¶ and, thus, is invalid.

In this chemical-arts case, the Rochester inventors on the ‘850 patent claimed a method for administering a compound that selectively inhibits activity of a gene product. However, the inventors did not disclose any such compound nor provide any suggestion as to how such a compound could be made or otherwise obtained other than by trial-and-error research. Indeed, there was no evidence that the inventors themselves knew of any such compound at the time their patent application was filed. The application was based on developments by the Rochester scientists (inventors) of a screening assay used in determining whether a particular drug displayed selectivity for inhibiting COX-2. However, the developed assay is only a technique for randomly testing various compounds to evaluate if the tested compounds exhibited the desired selectivity. The scientists never actually knew of such a compound.

On the day the ‘850 patent issued, Rochester sued “Pfizer,” alleging that Pfizer’s sale of its COX-2 inhibitors Celebrex® and Bextra® for treatment of inflammation infringed the ‘850 patent and sought injunctive and monetary relief. In response, Pfizer moved for summary judgment on invalidity of the ‘850 patent for failure to comply with the written description and enablement requirements of § 112, ¶ 1.

**II. Issues**

1. Does the written description requirement exist independent of enablement?
2. Does the University of Rochester’s ‘850 patent satisfy the written description requirement?

**III. Discussion**

1. Yes. In common parlance, as well as in the case law, the three requirements of § 112, ¶1 are referred to as the “written description requirement,” the “enablement requirement,” and the “best mode requirement,” respectively. Although there is often significant overlap between the three requirements, they are nonetheless independent of each other. The patent application must *describe, enable, and set forth the best mode* of carrying out the invention.

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As early as 1822, the Supreme Court recognized the existence of separate written description and enablement requirements. And although the patent statutes have been extensively revised since 1822, most notably in the addition of the requirement of claims, the language of the present statute is not very different in its articulation of the written description requirement. Furthermore, the United States Supreme Court recently acknowledged written description as a statutory requirement distinct not only from the best mode requirement, but also from enablement.

2. No. A description of what a material does, rather than of what it is, usually does not satisfy the written description requirement. The patentee is required to provide sufficient description to show one of skill in the art that the inventor possessed the claimed invention at the time of filing. It is not a question of whether one skilled in the art might be able to construct the patentee's device from the teachings of the disclosure of the application. Rather, it is a question of whether the application necessarily discloses that particular device.

The disclosure must allow one skilled in the art to visualize or recognize the identity of the matter reportedly described. For example, in the 19th century, use of the word "automobile" would not have sufficed to describe a newly invented automobile; instead, an inventor would need to describe what an automobile is, i.e., a chassis, an engine, seats, wheels on axles, etc. Generalized language may not suffice if it does not convey the detailed identity of an invention. In this case, there is no language, generalized or otherwise, that described compounds that achieve the claimed effect.

#### IV. Conclusion

The specification of a patent application shall contain a written description of the invention. Such a requirement is independent of the enablement and best mode requirements. *See* 35 U.S.C. § 112, ¶1. And in particular, disclosure of what a claimed material does, rather than what it is, usually does not satisfy the written description requirement. In this case, the Rochester '850 patent discloses nothing more than a hoped-for function for an as-yet-to-be discovered compound, and a research plan for trying to find it.