

**Keywords:** Enablement requirement of 35 U.S.C. § 102; Anticipation

**General:** A patent application specification may be used as evidence of the knowledge or skill that one of ordinary skill in the art possesses to enable prior art.

*In re Steve Morsa*

U.S. Court of Appeals Federal Circuit

No. 2015-1107

Decided: October 19, 2015

**I. Facts**

Steve Morsa filed U.S. Patent Application No. 60/211,228 (the ‘228 application) on April 12, 2001. The ‘228 application generally relates to a system and method for searching a benefit information database, matching benefits in the database to a user request, and providing benefit information to the user.

During prosecution, the examiner rejected claims 271 and 272 of the ‘228 patent as anticipated by a printed publication entitled, “Peter Martin Associates Press Release” (PMA) published on September 27, 1999. The PMA described the release of “Helpworks, Web Edition,” which is a program allowing caseworkers and consumers to search for benefits, services, or health risks in an eligibility library to maximize the services that a consumer may receive. Specifically, the PMA discloses:

HelpWorks Web Editions supports both a professionally directed deployment model – in which end users are professional caseworkers, [and] a self-service model in which consumers use the Web to screen themselves for benefits, services, health risks, or anything else an agency wishes to implement via its eligibility library.

The power behind this unprecedented flexibility in application and access is PMA’s newly released Expert Eligibility Server (EES) technology. The EES engine allows an agency to utilize HelpWorks – Web Edition as well as other applications that will leverage this dynamic technology. With EES as the backbone, agencies can rapidly deploy eligibility solutions for touch-screen kiosks, interactive voice response systems, the Web and many other platforms.

Morsa appealed the Examiner’s rejection and argued that the PMA was not enabling Morsa pointed to the absence of detail in the PMA and that the Examiner relied only on the two

paragraphs above to reject claims 271 and 272. The Board found that the PMA was presumed enabling and upheld the Examiner's rejection. Specifically, the Board required that Morsa provide affidavits or declarations to establish that the PMA was not enabling. Morsa requested a re-hearing, but denied re-hearing for the enablement issue.

Morsa appealed to the Federal Circuit, which determined that the Board incorrectly applied the enablement presumption for a prior art reference. The Federal Circuit held that a reference that does not appear to be enabling on its face does not require expert opinions to rebut the presumption of enablement. Accordingly, the Federal Circuit remanded the case to the Board to determine whether the PMA was enabling. The Board determined that the PMA was enabling by essentially taking official notice of the missing elements in the PMA and by relying on admissions in the specification of the '228 application related to the knowledge of a person of ordinary skill in the art.

The specification of the '228 application states that central processing units of the described system are "well known to those skilled in the art," that the central processing units are "used in conventional ways to process requests for benefit information in accordance with stored instructions," that the system described in the application "can be implemented by *any programmer of ordinary skill* in the art using commercially available development tools," and that "search routines for accomplishing this purpose are *well within the knowledge of those of ordinary skill in the art.*" (Emphasis added) Morsa again appealed to the Federal Circuit.

## **II. Issue**

Did the Board err in using the '228 application's specification to determine that the PMA was enabling?

## **III. Discussion**

No. The specification of a patent application may be used as evidence of the knowledge of a person of ordinary skill art to enable a prior art reference.

The Federal Circuit first set forth the rule for enablement of a prior art reference. Enablement of a prior art reference under 35 U.S.C. § 102 "requires that the reference teach a *skilled artisan* – at the time of filing – to carry out what it discloses in relation to the claimed invention without undue experimentation." (Emphasis added). Therefore, the court noted that the knowledge of one of ordinary skill in the art must be determined. The majority concluded that admissions in the specification of the patent application may be used to establish that level of knowledge.

Morsa argued that Board erred by taking official notice of various facts in its enablement analysis, that the PMA would require a person of ordinary skill in the art to conduct undue experimentation, and that the PMA fails to disclose elements of claim 271. The court held that the PMA disclosed each element of claims 271 and 272 and that the Board properly relied on admissions in the specification of the '228 application establishing the knowledge of one of ordinary skill in the art. Specifically, the court found that undue experimentation would not be required to make the claimed invention because the specification specifically stated that a person

of ordinary skill in the art could program the described system. However, Judge Prost did clarify that she was relying on the specification of the '228 application solely as evidence of the knowledge of a person of ordinary skill in the art, and not to fill in gaps in the PMA.

#### **IV. Conclusion**

The Federal Circuit affirmed the Board's finding that the PMA was enabling.

#### **V. Dissent**

Judge Newman dissented, asserting that it is not permissible to look beyond a cited reference during an anticipation analysis. Newman distinguished anticipation from obviousness, which specifically allows multiple references to be combined to form a rejection. Newman noted that the Board's use of official notice to fill in the gaps of the PMA was not appropriate, and that the Board should have at least performed an inherency analysis. Newman asserted that the PMA did not disclose each and every element of claims 271 and 272, and that the majority was utilizing the specification of the '228 application to show that a person of ordinary skill in the art could fill in the gaps of the PMA. Finally, Judge Newman distinguished the enablement requirement for anticipation under 35 U.S.C. § 102 from the enablement requirement under 35 U.S.C. § 112, and argued that for a prior art reference to be enabling under 35 U.S.C. § 102, the enablement must come from the prior art reference itself.

#### **VI. Noteworthy Points**

- A 102 reference must be enabled
- The specification of an examined patent application may be used to determine the knowledge of a person of ordinary skill in the art for the purposes of determining whether a 102 reference is enabling

#### **VII. Practice Tips**

- Avoid discussion in the specification regarding what is known to a person of skill in the art
- Avoid stating that a person of ordinary skill could develop the disclosed system using ordinary tools

Claims at issue:

271. A benefit information match mechanism comprising:  
storing a plurality of benefit registrations on at least one physical memory device;  
receiving via at least one data transmission device a benefit request from a benefit desiring seeker;  
resolving said benefit request against said benefit registrations to determine one or more matching said benefit registrations;  
automatically providing to at least one data receiving device benefit results for said benefit requesting seeker;  
wherein said match mechanism is operated at least in part via a computer compatible network.

272. A method of generating a benefit result list in real or substantially real time in response to a benefit match request from a benefit seeker using a computer network, comprising:  
maintaining at least one database stored in and/or on an article of manufacture including a plurality of benefit listings;  
receiving a benefit match request transmitted from an article of manufacture from said seeker, said request including said seekers criteria;  
identifying using a processing device those of said benefit listings having criteria which generate a match with said match request;  
generating automatically a message to a receiving article of manufacture to inform said seeker via said computer network of those of said benefits which match said seekers criteria.