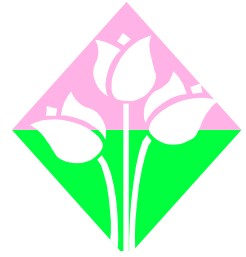




*Happy Spring!*

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# “Tip of the Month”

## Written Description and Enablement in Patents

### What’s the Fuss All About?

Lately, there has been a dispute whether the Patent Act requires a *written description* of the invention that is separate from the requirement of a disclosure that teaches *how to make and use* the invention. The Patent Act states “[t]he specification shall contain a written description of the invention and of the manner and process of making and using it . . . to enable any person skilled in the art which it pertains, . . . to make and use the same . . .” The difference may seem esoteric, however, the effect on patent applications based on pioneering inventions is profound.

Most of the time, there is no question that both of these requirements are met in a patent specification. The trouble arises when the inventor has discovered only one or two groups (the species) of a large category (the genus) and tries to claim the whole category (genus) that covers those one or two groups (species). The problem is more apparent when the claims use *functional language* to define the boundaries of a category (a genus). Functional language is a powerful tool that can be used by inventors to lay claim to a broad generic field. The issue particularly arises when the functional language simply describes a desired result without describing all the species that can be used to achieve that result. This was the case in a recent court opinion from the Court of Appeals for the Federal Circuit.

Simply stated, the court held that the specification must disclose both (i) what the invention is, and (ii) how to make and use it. The specification must show that the inventor has invented a sufficient number of species to support the claim to the genus. Further, the disclosure of the species must be within the four corners of the specification, and cannot be introduced later in response to Patent Office rejections.

How many species are enough? Unfortunately, there is no bright line rule.

If you would like to discuss the requirements for patent specifications, or how to properly celebrate World Intellectual Property Day on April 26, please contact the attorneys at Mesmer & Deleault, PLLC at 668-1971, or contact us by email at [mailbox@biz-patlaw.com](mailto:mailbox@biz-patlaw.com).

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