

## Federal Circuit Patent Bulletin: *Tobinick v. Olmarker*

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May 19, 2014

*"[To satisfy the written description requirement in an interference context, the disclosure at issue] need only reasonably convey to one skilled in the art that [the applicant] had possession of at least one embodiment that meets the [interference counts]."*

On May 19, 2014, in *Tobinick v. Olmarker*, the U.S. Court of Appeals for the Federal Circuit (Lourie, Reyna,\* Wallach) reversed and remanded the Patent Trial and Appeal Board decision dismissing Interference No. 105,866 between U.S. patent application Serial No. 12/714,205 (Tobinick) and U.S. Patents No. 7,708,995 and No. 7,811,990 (Olmarker), which related to methods of inhibiting TNF-alpha via the local administration of a monoclonal antibody (TNF-alpha inhibitor) to the site of an affected nerve, because Tobinick lacked adequate written description support for the interference counts. The Federal Circuit stated:

In interference proceedings, a disputed claim is construed in the context of its originating disclosure rather than the interfering application. Here, the claim limitation "wherein the antibody is administered locally" is construed in light of the '995 and '990 patent specifications, not the '205 application. [T]he Board construed "administered locally" as administered "directly to the site where it is intended to act, that is, to the location where the nucleus pulposus is causing the symptoms of the nerve disorder." The Board also found that this limitation did not include "systemic administration away from the site where the TNF-alpha is intended to act." We agree with the Board. . . .

The parties dispute whether the '205 application provides written description support for the term "administered locally." . . . The purpose of the written description requirement is to require an inventor to disclose his invention to the public in such a manner as to allow "a person of skill in the art to recognize that the patentee invented what is claimed." The written description determination depends on "the nature and scope of the claims and on the complexity and predictability of the relevant technology." Accordingly, we must determine whether the disclosure of the '205 application "reasonably conveys to those skilled in the art" that Tobinick "had possession" of the claimed local administration. . . . The '205 application discloses "methods for

treating neurological . . . disorders in humans by administering a [TNF-alpha inhibitor].” The specification distinguishes between local and systemic delivery of TNF-alpha inhibitor and lists several unique benefits of local administration. . . . The specification plainly describes localized, epidural injection of a TNF-alpha inhibitor. Because the epidural space is precisely the area in which the nerve root extends from the spinal cord, the TNF-alpha administration described in the ’205 application is made “directly to the site where it is intended to act, that is, to the location where the nucleus pulposus is causing the symptoms of the nerve disorder.” . . . The ’205 application need only reasonably convey to one skilled in the art that Tobinick had possession of *at least one* embodiment that meets the Board’s construction of local administration. The epidural injection technique is such an embodiment. [W]e conclude that the Board’s finding of lack of adequate written description is not supported by substantial evidence. Accordingly, we reverse the Board’s decision to dismiss the interference and remand for further proceedings.