

Federal Circuit Patent Bulletin: *Yeda Research & Dev. Co. v. Abbott GmbH & Co. KG*

September 20, 2016

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On September 20, 2016, in *Yeda Research & Dev. Co. v. Abbott GmbH & Co. KG*, the U.S. Court of Appeals for the Federal Circuit (Reyna,* Wallach, Hughes) affirmed the district court’s summary judgment upholding the Board of Patent Appeals and Interferences decision that U.S. Patent No. 5,344,915, which related to the TBP-II protein that binds to and neutralizes the Tumor Necrosis Factor (TNF) associated with various immunological diseases, was not invalid as anticipated under 35 U.S.C. § 102. The Federal Circuit stated:

The ‘915 patent’s invalidity turns on whether it benefits from the filing dates from either of two German patent applications—P39 15 072 (the “’072 application”) and P39 22 089 (the “’089 application”). If it does, then the field of prior art narrows to exclude the anticipating reference. Whether the ‘915 patent is entitled to benefit from the ‘072 application’s filing date depends on whether the ‘072 application provides adequate written description support for the invention claimed in the ‘915 patent. . . . The invention must be disclosed in a way that clearly allows a person of ordinary skill to recognize that the inventor invented what is claimed and possessed the claimed subject matter at the date of filing. . . .

Under the doctrine of inherent disclosure, when a specification describes an invention that has certain undisclosed yet inherent properties, that specification serves as adequate written description to support a subsequent patent application that explicitly recites the invention’s inherent properties. In this case, it is undisputed that TBP-II is the only protein with the same partial N-terminus sequence and additional traits disclosed in the ‘072 application. Therefore, the ‘072 application inherently discloses the remaining amino acids in the N-terminus sequence of TBP-II and serves as adequate written description support for the patent claiming TBP-II. It is not necessary for an application to disclose a protein’s complete N-terminus sequence in order to provide an adequate written description of that protein. . . .

Yeda also argues that prosecution history belies Abbott’s reliance on inherent disclosure. Yeda notes that in “the context of priority determinations, the allegedly inherent limitation cannot be material to the patentability of the invention.” Yeda asserts that the amino acids missing from the ‘072 application are material because

Abbott relied upon their absence to distinguish the prior art during prosecution of the '915 patent. The prosecution history, however, does not support Yeda's argument.

During prosecution of the '915 patent, the examiner rejected claims based on prior art that disclosed a protein with the same source, weight, and function as the protein claimed in the '915 patent. Abbott relied on the Engelmann article to argue that the cited art concerned only TBP-I, and that TBP-II includes a sequence of five amino acids not present in TBP-I that match the chain recited in the '915 patent claims. Abbott's response did not solely rely on amino acids missing from the priority applications; three of the five amino acids disclosed in Engelmann were disclosed in the '072 application and were themselves sufficient to distinguish TBP-I from TBP-II.

Finally, we reject Yeda's argument that the district court erred in finding that the Board's conclusion that the '072 application provides written description for the '915 patent is supported by substantial evidence. As the district court noted, the Board's decision rested on the facts that the '072 application identified nine of the fifteen amino acids of the N-terminus sequences recited in the relevant claim, as well as several biological characteristics of the protein. The parties do not dispute that no known protein other than TBP-II matches these characteristics. The district court correctly found that the Board's decision was supported by substantial evidence.