

## THE FUNDAMENTALS OF THE WRITTEN DESCRIPTION REQUIREMENT AND STRATEGIES FOR RESPONDING TO WRITTEN DESCRIPTION REJECTIONS – PART I BY MICHAEL KONDOUDIS

THIS POST IS THE FIRST OF A TWO-PART SERIES ON THE WRITTEN DESCRIPTION REQUIREMENT. THIS FIRST INSTALLMENT DISCUSSES THE FUNDAMENTALS OF THE REQUIREMENT, RELEVANT LAW, AND THE PROPER STANDARDS FOR COMPLIANCE. THE SECOND INSTALLMENT WILL PROVIDE EXAMPLES OF HOW TO MORE EFFECTIVELY RESPOND TO REJECTIONS BASED ON THE WRITTEN DESCRIPTION REQUIREMENT.

### THE BASIS FOR THE WRITTEN DESCRIPTION REQUIREMENT

THE WRITTEN DESCRIPTION REQUIREMENT ARISES FROM THE FIRST PARAGRAPH OF 35 U.S.C. § 112 STATES:

THE SPECIFICATION SHALL CONTAIN A WRITTEN DESCRIPTION OF THE INVENTION, AND OF THE MANNER AND PROCESS OF MAKING AND USING IT, IN SUCH FULL, CLEAR, CONCISE, AND EXACT TERMS AS TO ENABLE ANY PERSON SKILLED IN THE ART TO WHICH IT PERTAINS, OR WITH WHICH IT IS MOST NEARLY CONNECTED, TO MAKE AND USE THE SAME, AND SHALL SET FORTH THE BEST MODE CONTEMPLATED BY THE INVENTOR OF CARRYING OUT HIS INVENTION.

IN EX PARTE PROSECUTION, THE WRITTEN DESCRIPTION REQUIREMENT IS MOST OFTEN APPLIED AGAINST NEWLY PRESENTED OR AMENDED CLAIMS. THIS REQUIREMENT CAN ALSO BE APPLIED AGAINST ORIGINAL CLAIMS AND CLAIMS COPIED TO PROVOKE AN INTERFERENCE, HOWEVER.

### FUNDAMENTALS OF THE WRITTEN DESCRIPTION REQUIREMENT

1. THE WRITTEN DESCRIPTION REQUIREMENT (WDR) REQUIRES AN APPLICANT TO DEMONSTRATE POSSESSION OF EACH FEATURE OF A CLAIMED INVENTION. THE FEDERAL CIRCUIT HAS DESCRIBED THE FUNCTION OF THE WDR AS “[ENSURING] THAT, AS OF THE FILING DATE, THE INVENTOR CONVEYED WITH REASONABLE CLARITY TO THOSE OF SKILL IN THE ART THAT HE WAS IN POSSESSION OF THE SUBJECT MATTER OF THE CLAIMS. UNION OIL CO. OF CALIF. V. ATLANTIC RICHFIELD CO., 208 F.3D 989 (FED. CIR. 2000).

2. THE PATENT OFFICE’S GUIDELINES FOR EXAMINATION OF PATENT APPLICATIONS UNDER THE WRITTEN DESCRIPTION REQUIREMENT ARE FOUND IN SECTION 2163 OF THE MPEP. THIS SHOULD BE AN APPLICANT’S PRIMARY RESOURCE FOR AUTHORITY WHEN ARTICULATING RESPONSES TO WDR REJECTIONS.

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3. AN APPLICANT SATISFIES THE WDR BY DESCRIBING ALL OF THE FEATURES OF A CLAIM IN A MANNER THAT “REASONABLY CONVEYS” TO ONE OF ORDINARY SKILL IN THE ART THAT THE APPLICANT POSSESSED THE CLAIMED INVENTION AS A WHOLE. (MPEP § 2163(I)). TO DO SO, AN APPLICANT MAY RELY ON WORDS, STRUCTURES, FIGURES, DIAGRAMS, AND FORMULAE OF THE DISCLOSURE. (MPEP §§ 2163(I), 2163.02). A PATENT SPECIFICATION SATISFIES THE WDR WHEN IT DISCLOSES A CLAIMED INVENTION IN SUFFICIENT DETAIL SO THAT ONE SKILLED IN THE ART CAN “REASONABLY CONCLUDE” THAT THE INVENTOR HAD POSSESSION OF THE CLAIMED INVENTION AT THE TIME OF FILING. (MPEP § 2163(I)).

4. THERE IS NO ONE WAY TO SHOW POSSESSION OF A CLAIMED INVENTION. (MPEP § 2163(I)). RATHER, POSSESSION MAY BE SHOWN BY ANY DESCRIPTION OF SUFFICIENT, RELEVANT, IDENTIFYING CHARACTERISTICS THAT WOULD CAUSE A PERSON ORDINARILY SKILLED IN THE ART TO RECOGNIZE THAT THE INVENTOR HAD POSSESSION. (MPEP § 2163(II)(A)(3)(A)).

5. ALTHOUGH ORIGINALLY FILED SUBJECT MATTER DOES NOT IPSO FACTO SATISFY THE WDR, ORIGINALLY FILED SUBJECT MATTER ENJOYS A “STRONG PRESUMPTION” OF COMPLIANCE WITH THE WDR. (MPEP §§ 2163 (I)(A), 2163(II)(A), 2163(II)(A)(3)(A)). THIS IS BECAUSE A DESCRIPTION AS ORIGINALLY FILED IS PRESUMED TO BE ADEQUATE, UNLESS OR UNTIL EVIDENCE OR REASONING TO THE CONTRARY HAS BEEN PRESENTED BY THE EXAMINER SUFFICIENT TO REBUT THE PRESUMPTION. (MPEP § 2163.04). THE MPEP IDENTIFIES SOME FACTORS THAT ARE TO BE CONSIDERED IN A PROPER WDR ANALYSIS OF ORIGINAL CLAIMS. THESE FACTORS INCLUDE:THE LEVEL OF SKILL AND KNOWLEDGE IN THE ART;

THE DISCLOSURE OF PARTIAL STRUCTURE OR PHYSICAL/CHEMICAL PROPERTIES; AND

ANY FUNCTIONAL CHARACTERISTICS/CORRELATION BETWEEN STRUCTURE AND FUNCTION.

MPEP §2163 (I)(A). NOTE: THIS PRESUMPTION IS MOST OFTEN IMPLICATED IN REJECTIONS CONTAINED IN FIRST OFFICE ACTIONS, BUT THIS PRESUMPTION IS SOMETHING TO KEEP IN MIND ANYTIME ORIGINALLY PRESENTED SUBJECT MATTER IS REJECTED FOR FAILURE TO SATISFY THE WDR.

6. THREE MORE POINTS.A. THE FIRST PARAGRAPH OF 35 U.S.C. § 112 DOES NOT REQUIRE THAT AN APPLICANT TO DESCRIBE CLAIM LIMITATIONS EXACTLY. (MPEP § 2163.02). INSTEAD, AN APPLICANT NEED ONLY DO SO WITH “REASONABLE CLARITY” (MPEP § 2163.02) SO THAT A SKILLED ARTISAN CAN “REASONABLY CONCLUDE” THE APPLICANT’S POSSESSION.B. GENERALLY, THERE IS AN INVERSE CORRELATION BETWEEN THE LEVEL OF SKILL AND KNOWLEDGE IN THE ART AND THE SPECIFICITY OF DISCLOSURE NECESSARY TO SATISFY THE WRITTEN DESCRIPTION REQUIREMENT. (MPEP 2163(II)(A)(2)). THUS, INVENTIONS IN “PREDICTABLE” OR “MATURE” ARTS ARE THEORETICALLY SUBJECT TO LESS SCRUTINY UNDER THE WRITTEN DESCRIPTION REQUIREMENT,

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AND SHOULD REQUIRE A LESSER SHOWING OF POSSESSION THAN MORE “UNPREDICTABLE” ARTS.

C. AN APPLICANT NEED NOT DISCLOSE IN DETAIL, AND PREFERABLY OMITTS, THAT WHICH IS CONVENTIONAL OR WELL KNOWN IN THE ART. (MPEP § 2163(II)(A)(2)).

THE OFFICE ALWAYS BEARS AN INITIAL BURDEN WHEN MAKING A WRITTEN DESCRIPTION REJECTION

1. IT IS ALWAYS INCUMBENT ON AN EXAMINER TO FULLY DEVELOP THE REASONS FOR A WDR REJECTION. FIRSTLY, SECTION 706.03 OF THE MPEP WARNS EXAMINERS THAT “[W]HERE A MAJOR TECHNICAL REJECTION IS PROPER (E.G., LACK OF PROPER DISCLOSURE, UNDUE BREADTH, UTILITY, ETC.) SUCH REJECTION SHOULD BE STATED WITH A FULL DEVELOPMENT OF THE REASONS RATHER THAN BY A MERE CONCLUSION COUPLED WITH SOME STEREOTYPED EXPRESSION.” THUS, MERE CONCLUSORY STATEMENTS ARE INSUFFICIENT TO SUPPORT A REJECTION UNDER SECTION 112. SECONDLY, THIS OBLIGATION TO ESTABLISH A PRIMA FACIE CASE IS AFFIRMED BY THE MPEP IN ITS DISCUSSIONS OF EACH REQUIREMENT OF THE FIRST PARAGRAPH OF 35 U.S.C. § 112. (SEE, E.G., MPEP § 2163 (III)(A) (WRITTEN DESCRIPTION); MPEP § 2164.04 (ENABLEMENT))

2. A PRIMA FACIE CASE REQUIRES A REASONABLE BASIS TO CHALLENGE THE ADEQUACY OF THE WRITTEN DESCRIPTION. (MPEP § 2163.04). THE MPEP EQUATES THIS REASONABLE BASIS WITH “A PREPONDERANCE OF EVIDENCE WHY A PERSON SKILLED IN THE ART WOULD NOT RECOGNIZE IN AN APPLICANT’S DISCLOSURE A DESCRIPTION OF THE INVENTION DEFINED BY THE CLAIMS.” (MPEP § 2163(III)(A)). CONSEQUENTLY, THE OFFICE MUST ARGUABLY PROVIDE A REASONABLE BASIS TO REJECT A CLAIM FOR FAILING TO SATISFY THE WDR, AND THIS REQUIRES “A FULL DEVELOPMENT” OF THE REASONS SHOWING THAT, BY A PREPONDERANCE OF THE EVIDENCE, A PERSON OF ORDINARY SKILL IN THE ART WOULD NOT RECOGNIZE A DESCRIPTION OF THE CLAIMED INVENTION IN THE DISCLOSURE.

AN APPROACH FOR RESPONDING TO WRITTEN DESCRIPTION REJECTIONS

AN APPLICANT SHOULD FIRST CONSIDER WHETHER THE OFFICE HAS MET ITS BURDEN TO ESTABLISH A PRIMA FACIE CASE. THE BURDEN ON AN EXAMINER TO ESTABLISH A PRIMA FACIE CASE CANNOT BE OVEREMPHASIZED. IN THE ABSENCE OF A PRIMA FACIE CASE, AN APPLICANT IS UNDER NO OBLIGATION TO PRESENT A REBUTTAL. SO, UNTIL THE OFFICE HAS MET THIS INITIAL BURDEN TO “FULLY DEVELOP REASONS FOR THE REJECTION BY PROVIDING “PROPERLY REASONED AND SUPPORTED STATEMENTS,” THE OBLIGATION TO REBUT A WRITTEN DESCRIPTION REJECTION DOES NOT SHIFT TO THE APPLICANT. GENERALLY THEN, WHEN AN OFFICE ACTION PROVIDES MERELY CONCLUSORY STATEMENTS, THE REJECTION SHOULD BE TRAVERSED

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ON THIS GROUND ALONE SO AS TO AVOID ARGUMENT ESTOPPEL AND MINIMIZE EXPENSE.

NEXT, AN APPLICANT SHOULD ANALYZE EVERY SPECIFIC REASON FOR ITS PARTICULAR BASIS AND REASONING. FLAWS AND INCONSISTENCIES IN THE REASONING CAN BE USED TO TRAVERSE THE REJECTION SINCE FAULTY AND/OR INCOMPLETE REASONING LIKELY DOES NOT RISE TO THE LEVEL OF A PREPONDERANCE OF THE EVIDENCE.

## A BASIC TEMPLATE FOR A RESPONSE TO A WRITTEN DESCRIPTION REJECTION

WHEN TRAVERSING A WDR, IT IS USUALLY USEFUL TO CONSIDER INCLUDING THE FOLLOWING FIVE-POINT "ROADMAP":

1. A "WHEN / THEN" STATEMENT ARTICULATING THE APPROPRIATE LEGAL STANDARD (E.G., WHEN APPLICANT DOES THIS, THEN THE REQUIREMENT OF 35 U.S.C. § 112 IS SATISFIED);
2. REMINDING THE OFFICE THAT IT HAS THE BURDEN OF ESTABLISHING A PRIMA FACIE CASE;
3. ADVISING THE OFFICE RELEVANT EXAMINATION GUIDELINES INCLUDING PRESUMPTIONS OR INSTRUCTIONS;
4. EXPLAINING HOW THE OFFICE HAS NOT MET BURDEN; AND/OR EXPLAINING HOW THE APPLICANT HAS SATISFIED THE WDR.

## THE PATENT OFFICE'S TRAINING MATERIALS

THE PATENT OFFICE HAS PROVIDED EXAMINERS WITH SEVERAL DECISION TREES THAT ARE USEFUL TO MEASURE THE SUFFICIENCY OF A WDR REJECTION AS WELL AS A QUICK REFERENCE TO HELP UNDERSTAND WHAT AN EXAMINER MIGHT BE TRYING TO CONVEY. THESE MATERIALS CAN BE FOUND AT [HTTP://WWW.USPTO.GOV/MAIN/PAT\\_EXM\\_TRNG.HTM](http://www.uspto.gov/main/pat_exm_trng.htm).

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