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Federal Circuit Finds Adequate Written Description Support Under the Doctrine of Inherent Disclosure

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The ’915 patent is directed to a protein called “TBP-II” and claims a particular N-terminus sequence of the protein. In 1996, the Board of Patent Appeals and Interferences (the “Board”) instituted an interference proceeding between the ’915 patent and a patent application owned by Yeda Research and Development Co., Ltd. (“Yeda”). The Board gave the ’915 patent a priority date of 1990—its application filing date—and held that a prior art reference describing TBP-II anticipates the claims. Although the ’915 patent claims priority to two applications filed in 1989, neither of the applications discloses the full N-terminus sequence claimed in the ’915 patent. Instead, they disclose a partial N-terminus sequence, but the only protein known to contain the partial N-terminus sequence is TBP-II.

Abbott sought review of the Board’s decision in the district court. The district court reversed and remanded the decision, finding that the first of the two priority applications inherently discloses the TBP-II protein. On remand, the Board changed its decision and found that the second priority application provides written description support for the ’915 patent. Again, Yeda sought review of the Board’s decision in the district court, and, this time, the district court affirmed the Board’s decision. Yeda appealed.

On appeal, the Federal Circuit affirmed that TBP-II is adequately disclosed by the second priority application. According to the court, “[u]nder 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.” Because “TBP-II

is the only protein with the same partial N-terminus sequence and additional traits" as those described in the application, the court concluded that the application inherently discloses the remaining amino acids in the N-terminus sequence and provides adequate written description of the protein claimed in the '915 patent.

Yeda Research & Dev. Co. v. Abbott GMBH & Co. KG, Nos. 2015-1662 and 2015-1663 (Fed. Cir. September 20, 2016).

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