



PTAB Invalidates Claims for Section 112 Failures

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The PTAB found that the claims failed the enablement requirement under § 112. First, Petitioner's evidence showed that the claimed method was inoperative within the claimed temperature range. Specifically, Petitioner described two tests in which none of the tested devices exhibited the claimed deformation. Second, the PTAB found that undue experimentation would be required to practice the full scope of the claimed invention. The specification provided only one narrow example and failed to discuss how to achieve the desired deformation under the broadly claimed temperature range. Third, the PTAB relied on the testimony of the sole named inventor, who did not believe it was possible to achieve the claimed deformation results as of the effective filing date.

In addition, the PTAB concluded that the '991 patent lacked a sufficient written description. The PTAB explained that the disclosure of one species was insufficient to support the genus of the claimed temperature range. The PTAB relied on the two tests showing that the disclosed embodiments were inoperative and on the inventor's testimony to show that he was not in possession of the invention.

Moreover, the PTAB clarified that a determination of failure to satisfy the enablement and written description requirements under § 112 was not inconsistent with a finding of anticipation. When a claim covers several compositions, the claim is anticipated if one of them is in the prior art. Accordingly, the PTAB found the claims invalid as being anticipated by the prior art.

US Endodontics, LLC v. Gold Standard Instruments, LLC, Case PGR2015-00019 (PTAB Dec. 28, 2016). [Goodson (opinion), Cocks and Jung]

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