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“Full Scope” Enablement — An Invalidity Bonanza

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Recent rulings from the Federal Circuit on the issue of claim enablement have become an important focus for infringement defendants in their attempts to invalidate a plaintiff's patents.

Understandably, inventors and their patent attorneys try to claim an invention as broadly as the prior art will allow. Even if such claims are found to be distinguishable over the prior art during examination of the application, the enablement requirement of Section 112 of the Patent Act may present an intractable dilemma for patent holders. Section 112 requires, in part, that the "specification … 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…" Over the years, courts have required that the specification of a patent application, i.e., the drawings and the description of the preferred embodiments, describe the invention in enough detail to enable a person skilled in the art to practice the claimed invention without undue experimentation.

In *Automotive Technologies, Inc. v. BMW, et al.* (Federal Circuit 2007), the patent contained claims to a side impact crash sensor for automotive airbags. The claim was broad enough to cover both mechanical and electronic sensors. The mechanical sensor was well described and illustrated in multiple figures, However, the electronic sensor was described in broad terms and illustrated in only a single conceptual figure. Rejecting ATI's argument that the specification must only enable one mode of practicing the invention, the Federal Circuit ruled that the claim was invalid. The court stated that the electronic sensor must be particularly enabled because it is "distinctly different" from the enabled mechanical sensor. Thus, the specification failed to enable the "full scope" of the claims that include both mechanical and electrical sensors. In its ruling, the court recalled its decision earlier that year in *Liebel-Flarsheim v. Medrad* (Federal Circuit 2007) in which claims to a jacketed needle holder were invalidated because they were not fully enabled.

Most recently, in *Sitrick v. Dreamworks* (Federal Circuit 2008), the court reviewed claims directed to a method for combining user-generated audio and visual effects into video games or movies. The asserted claims were construed as covering both video games and movies. The court, though, determined that use in movies was insufficiently enabled. Citing its *Automotive* decision last year, the court reiterated that the full scope of the claimed invention must be enabled. It further stated that the scope of the claims must be less than or equal to the scope of the enablement to ensure that the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims.

The above decisions do not appear to bode well for broad or generic patent claims, even when the claim is fully enabled for at least one preferred embodiment. In fact, most claims which use open terminology, such as "comprising" or "including," necessarily contemplate a wide range of additional elements or limitations which may not be fully enabled in the specification. Because these decisions are sure to form the basis for invalidity contentions from accused infringers, at least two cautionary notes are in order. First, patent applicants and their attorneys should reconsider the breadth of their claims during prosecution in view of the specific embodiments described. Second, in the litigation context, plaintiffs should carefully structure their arguments pertaining to claim interpretation and scope, as proffering an overly broad construction may expose such claims to enablement problems.