

## How Not to Undersell the Invention in a Patent Application

A patent application must enable a person having ordinary skill in the art (“PHOSITA”) to make or practice the invention. When determining whether a patent application meets this standard, the patent office takes into consideration the description of the invention in the application as well as the knowledge a PHOSITA would have. Another requirement is that the invention was not described in a printed publication prior to the filing of the application. When determining whether the prior publication describes the invention, the patent office also takes into consideration the knowledge a PHOSITA would have. As a recent court decision makes clear, a patentee’s own statements regarding a PHOSITA’s knowledge may be used against the patentee.

In *in re: Morsa*, the Court of Appeals of the Federal Circuit (“Federal Circuit”) held a patent, which was drafted and prosecuted by an inventor himself, to be invalid as anticipated over a prior art reference. In finding anticipation, the Federal Circuit relied both on the description in the prior publication as well as the knowledge a PHOSITA would have. To determine what knowledge a PHOSITA would have, the Federal Circuit looked to Morsa’s own patent application.

Morsa’s invention was directed to a system to make benefits and benefit information available to individuals or companies qualified for those benefits. Morsa’s patent claims required essentially four limitations: (1) storage of benefit information, (2) a request for benefits, (3) that a computer match the request with the benefits and (4) that results are reported to the requester. A prior art publication entitled *Peter Martin Association Press Release (“PMA”)*, unambiguously described the first limitation, i.e. the storage of benefit services. PMA also stated that “consumers use the web to screen themselves for benefits.” Morsa argued that this sentence is not an enabling prior art sufficient to anticipate limitations (2)-(4) because it would require undue experimentation to arrive from this broad disclosure to the limitations at issue which require programming a computer to be implemented.

The Federal Circuit disagreed and found that PMA discloses the remaining (2)-(4) limitations of Morsa’s patent claims as follows: (2) the consumers are requesting the benefits when they go on the web; (3) they use the web to get the benefits; and (4) they are requesting and getting results. With respect to Morsa’s argument that PMA is not enabled, the Federal Circuit found that the specification of Morsa’s patent stated clearly that a PHOSITA knew about central processing units and memory and “that the system described in the patent [could] be implemented by...[one] skilled in the art using commercially available development tools.” Thus, the Federal Circuit relied on certain statements in Morsa’s own disclosure to find the asserted prior art to be enabled.

It is not certain that Morsa’s patent claims would have been patentable if he did not describe in the patent application that a PHOSITA had knowledge of basic computer programming. However, attention to such details is a part of a patent attorney’s training in creating a well drafted patent application.

In drafting patent applications, we at Wood Phillips take the time to ensure that our clients' inventions are fully protected. If you have any questions about whether your idea is patentable, please contact an attorney at Wood Phillips.