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Lynch LLP Delivers Patent Applications that Get It Right the First Time

A quick review of “Indivior UK v. Dr. Reddy’s Labs” shows how time, money, and strategy can be saved by paying attention to detail.

SOUTHERN CALIFORNIA, CALIFORNIA, UNITED STATES, January 17, 2022 /EINPresswire.com/ -- “Getting your patent application right the first time not only saves time and money, but it also ensures a greater chance of securing strategic intellectual property protection,” said Brian Lynch, counsel at Lynch LLP, a southern California intellectual property firm.

“When patent attorneys write patents, we include all kinds of details about the invention. All these details go into the written description, and one practice we use to ensure we fully describe an invention is to describe number ranges,” said Lynch. “For example, if an inventor tells us that for a drug to be made, it must contain 7% of chemical 1 and 43% of chemical 2, patent practitioners will often encompass those values by ranges. For example, we might write, ‘the drug comprises chemical 1 and chemical 2, where chemical 1 can range from 4–11% (preferable 7%) and chemical 2 can range from 35%–50%. (preferably 43%).’

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“It is important to have a well-trained, and seasoned lawyer in your corner when it comes to patents,” said Lynch. “Making sure that it is filed correctly the first time, can save you time and money.”

Lynch LLP recommends getting familiar with a specific legal case: Indivior UK v. Dr. Reddy’s Labs.

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Indivior involves an IPR (inter partes review) proceeding. Ordinarily, IPRs are limited to prior art issues, though occasionally, Section 112(a) issues come up when the challenged patent tries to claim priority back to one or more prior filings. In short, that is what happened here.

Indivior attempted to claim a sublingual film that contained some drug treatment. The limitations at issue:
- Claim 1 recited: “about 40 wt % to about 60 wt % of a water-soluble polymeric matrix”
- Claims 7 & 12 recited: “about 48.2 wt % to about 58.6 wt %”
- Claim 8 recited: “about 48.2 wt %”

But the original specification failed to directly describe any of these amounts or ranges. Instead, the specification included two tables that featured four examples. Those examples, when computed out, resulting in values that fall within the range of 48.2–58.6%. The process of carrying out those computations is not expressly described in the specification, and that specification also fails to give any reasons why those examples, computed out, should result in endpoints that form a range of values. On appeal, the Court wrote, “[f]or written description support of a claimed range, more clarity is required.”

The Court continued:
Here, one must select several components, add up the individual values, determine the aggregate percentages, and then couple those aggregate percentages with other examples in the ’571 application to create an otherwise unstated range.

Performing these calculations resulted in the four examples resulting in values that included the lower value of 48.2% and the higher values of 58.6%. These values, the Court asserted, are expressions of inventive values, not an invitation to undertake additional post-hoc inventing. Thus:

Indivior failed to provide persuasive evidence demonstrating that a person of ordinary skill would have understood from reading the ’571 application that it disclosed an invention with a

range of 48.2 wt % to 58.6 wt %. A written description sufficient to satisfy the requirement of the law requires a statement of an invention, not an invitation to go on a hunting expedition to patch together after the fact a synthetic definition of an invention. “[A] patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.” Brenner v. Manson, 383 U.S. 519, 536 (1966).

“So what should we learn from this?” asks Lynch. “Well, nothing most practitioners don’t already know: it is better to include too much than too little, and we especially cannot rely on unstated mathematics to flesh out our disclosures. If a range is intended, write that out explicitly. If you intend for a range to be created via example, then summarize the range at the end and explain how to perform the relevant computations. This case appears to showcase a patentee making an effort to expand on their written description by reading between the lines, so to speak, and the Court pushed back.”

About Lynch LLP

Lynch LLP helps clients large and small protect their inventions across a wide range of practice areas. We have specialized expertise in a wide range of technical fields and focus our practice on providing strategic guidance and services including patent prosecution as well as strategic patent counseling. We also have experience with clearance searching, prior art searching, product licensing, as well as litigation and enforcement of patent and other intellectual property rights.

Patent attorneys at Lynch LLP have focused technical backgrounds that give us the breadth of scientific knowledge to write patent applications that not only capture a new and novel invention, but that also creates an umbrella of coverage extending beyond the exact confines of the invention. We combine our experience as patent attorneys with our experience with patent litigation to prepare and file patent applications of all types that are created to withstand scrutiny and to maximize enforceability. Our expertise extends into negotiating and drafting licensing agreements.

We have experience representing plaintiffs and defendants in a wide variety of proceedings before courts and the USPTO, crafting patent strategies that complement and further our clients’ business interests.

We have experience filing utility patents and design patents to protect all aspects of your invention. Visit Lynch LLP at www.lynchllp.com to set up a free consultation.

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