

## GENTRY GALLERY, INC. V. BERKLINE CORP.

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Patents are worth less today than they were last year. In particular, poorly drafted patents are limited by patent scope. Patent scope, which is affected by the disclosure doctrine and infringement analysis, largely governs the economic worth of a patent.<sup>1</sup> 35 U.S.C. § 112 is increasingly invoked to define patent scope through the specification, rather than through the claims.<sup>2</sup> In *Gentry Gallery, Inc. v. Berkline Corp.*,<sup>3</sup> the Federal Circuit narrowed the scope of patents through the written description requirement of section 112 by announcing an omitted element test.<sup>4</sup> This test mandates that an “essential” element be included in every claim of a patent.<sup>5</sup> The Federal Circuit confined patent scope by proclaiming that “claims may be no broader than the supporting disclosure, and therefore that a narrow disclosure will limit claim breadth.”<sup>6</sup>

### I. BACKGROUND

Claims, which delineate the legal boundaries of an invention, define the scope of patents.<sup>7</sup> Section 112 mandates that a patent consists of claims and a specification, which comprise “a written description of the invention.”<sup>8</sup> The written description requirement provides that “the description must clearly allow persons of ordinary skill in the art to recognize that [the applicant] invented what is claimed.”<sup>9</sup> Fulfillment of the re-

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1. See generally Robert H. Merges and Richard R. Nelson, *On the Complex Economics of Patent Scope*, 90 COLUM. L. REV. 839 (1990).

2. See Welsey W. Whitmyer Jr., *Only Obvious Variations Infringe*, 80 J. PAT. & TRADEMARK OFF. SOC'Y 645, 649 (1998).

3. 134 F.3d 1473, 45 U.S.P.Q.2d (BNA) 1498 (Fed. Cir. 1998).

4. See *id.* at 1479-80, 45 U.S.P.Q.2d at 1503. The test was named the “omitted element test” by the court in *Reiffin v. Microsoft Corp.*, 48 U.S.P.Q.2d 1274, 1277 (N.D. Cal. 1998).

5. See *Gentry*, 134 F.3d at 1479-80, 45 U.S.P.Q.2d at 1503.

6. *Id.* at 1480, 45 U.S.P.Q.2d at 1503.

7. See 35 U.S.C. § 112, ¶ 2 (1998) (“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”).

8. 35 U.S.C. § 112, ¶¶ 1-2 (1998). See also DONALD S. CHISUM, *PATENTS: A TREATISE ON THE LAW OF PATENTABILITY, VALIDITY, AND INFRINGEMENT* § 7.04 (1998).

9. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 U.S.P.Q.2d (BNA) 1111, 1116 (Fed. Cir. 1991) (citations omitted).

quirement is a question of fact.<sup>10</sup> The standard for review at the appellate level is the clearly erroneous standard.<sup>11</sup>

The written description requirement is primarily invoked in three situations. First, when an application is filed, any claims added after filing must be supported by the original specification.<sup>12</sup> Second, when a foreign application is filed in the United States or a continuation application is filed, claims in a later-filed application must have support in the specification in the earlier-filed foreign or United States applications under 35 U.S.C. § 119 or 35 U.S.C. § 120, respectively.<sup>13</sup> Third, when an interference action is invoked, claim(s) at issue in the interference need adequate support in the specification.<sup>14</sup>

The origin of a written description requirement separate from an enablement requirement was first articulated in *In re Ruschig*.<sup>15</sup> In *Ruschig*, the appellants presumed that the patent rejection was based on the enablement requirement, but the *Ruschig* court stated that the issue was “whether the specification discloses the compound to [a person skilled in the art], specifically, as something appellants actually invented.”<sup>16</sup> In other words, “[d]oes the specification convey clearly to those skilled in the art, to whom it is addressed, in any way, the information that appellants in-

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10. See *id.* at 1563, 19 U.S.P.Q.2d at 1116.

11. See *id.*

12. See CHISUM, *supra* note 8, § 7.04.

13. See *Vas-Cath*, 935 F.2d at 1560, 19 U.S.P.Q.2d at 1114. See generally Alton D. Rollins, 35 U.S.C. § 120—*The Description Requirement*, 64 J. PAT. & TRADEMARK OFF. SOC'Y 656 (1982), for discussion of interaction of 35 U.S.C. § 112 ¶ 1 with 35 U.S.C. § 120.

14. See *Vas-Cath*, 935 F.2d at 1560, 19 U.S.P.Q.2d at 1114.

15. 379 F.2d 990, 154 U.S.P.Q. (BNA) 118 (C.C.P.A. 1967). See generally *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560-64, 19 U.S.P.Q.2d (BNA) 1111, 1114-17 (Fed. Cir. 1991), CHISUM, *supra* note 8, § 7.04[1], Janice M. Mueller, *The Evolving Application of the Written Description Requirement to Biotechnological Inventions*, 13 BERKELEY TECH. L.J. 615, 616-28 (1998), and Laurence H. Pretty, *The Recline and Fall of Mechanical Genus Claim Scope Under “Written Description” in the Sofa Case*, 80 J. PAT. & TRADEMARK OFF. SOC'Y 469, 470-74 (1998), for a historical overview of the development of written description jurisprudence. Compare Lance Leonard Barry, *A Picture is Worth A Thousand Words: Vas-Cath, Inc. v. Mahurkar*, 76 J. PAT. & TRADEMARK OFF. SOC'Y 5, 16-18 (1994) (arguing that separate requirement accords with germane statutory and case law) with Kevin S. Rhoades, *The Section 112 “Description Requirement”—A Misbegotten Provision Confirmed*, 74 J. PAT. & TRADEMARK OFF. SOC'Y 869 (1992) (arguing against a separate written description requirement).

16. *In re Ruschig*, 379 F.2d at 995, 154 U.S.P.Q. at 123.

vented that specific compound?"<sup>17</sup> A specification can enable, although not describe, the invention.<sup>18</sup>

The rationale for a separate written description requirement is two-fold.<sup>19</sup> First, historically, a written description was required in patents at a time when claims were not required.<sup>20</sup> Second, the written description requirement "guards against the inventor's overreaching by insisting that he recount his invention in such detail that his future claims can be determined to be encompassed within his original creation."<sup>21</sup>

## II. GENTRY GALLERY, INC. V. BERKLINE CORP.

The Gentry Gallery ("Gentry") owns U.S. Patent 5,064,244, claiming a sectional sofa with a pair of reclining seats facing in the same direction.<sup>22</sup> Prior to Gentry's invention, reclining seats were located at the opposite

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17. *Id.* at 996, 154 U.S.P.Q. at 123.

18. *See In re DiLeone*, 436 F.2d 1404, 1405, 168 U.S.P.Q. (BNA) 592, 593 (C.C.P.A. 1971).

19. *See Vas-Cath*, 935 F.2d at 1560-61, 19 U.S.P.Q.2d at 1114-15; Mueller, *supra* note 15, at 618-23.

20. *See Vas-Cath*, 935 F.2d at 1560, 19 U.S.P.Q.2d at 1114.

21. *See Rengo Co. v. Molins Mach. Co.*, 657 F.2d 535, 551, 211 U.S.P.Q. (BNA) 303, 321 (3d Cir.), *cert. denied*, 454 U.S. 1055 (1981).

22. The broadest claim of the patent, claim 1, reads:

A sectional sofa comprising:

a pair of reclining seats disposed in parallel relationship with one another in a double reclining seat sofa section, said double reclining seat sofa section being without an arm at one end whereby a second sofa section of the sectional sofa can be placed in abutting relationship with the end of the double reclining seat sofa section without an arm so as to form a continuation thereof,

each of said reclining seats having a backrest and seat cushion and movable between upright and reclined positions, said backrests and seat cushions of the pair of reclining sets lying in respective common planes when the seats are in the same positions,

a fixed console disposed in the double reclining seat sofa section between the pair of reclining seats and with the console and reclining seats together comprising a unitary structure,

said console including an armrest portion for each of the reclining seats, said arm rests remaining fixed when the reclining seats move from one to another of their positions,

and a pair of control means, one for each reclining seat; mounted on the double reclining seat sofa section and each readily accessible to an occupant of its respective reclining seat and when actuated causing the respective reclining seat to move from the upright to the reclined position.

U.S. Patent No. 5,064,244, issued Nov. 12, 1991.

ends of a L-shaped sectional sofa because the adjustment controls needed to be on the arms of the recliners, and arms had to be at the exposed ends of the linear sections.<sup>23</sup> This arrangement caused the two recliners to face in different directions and, thus, caused occupants of the recliners to turn their heads to watch television.<sup>24</sup> The inventor, James Sproule ("Sproule"), solved this problem by inserting a fixed console to house the controls of both recliners between the two recliners so that the recliners could face in the same direction.<sup>25</sup>

Berkline Corp. ("Berkline") manufactures a sectional sofa with two parallel recliners.<sup>26</sup> A seat separates the two recliners and houses the controls for both recliners.<sup>27</sup> The seat has a back cushion that pivots down onto the seat to serve as a tabletop.<sup>28</sup>

### A. District Court Decision

Gentry sued Berkline for infringement in the United States District Court for Massachusetts.<sup>29</sup> The district court granted Berkline's motion for summary judgment on the grounds of non-infringement, but declined to find Gentry's patent invalid and unenforceable.<sup>30</sup> The court held that Berkline's sofas neither infringed Gentry's patent literally nor under the doctrine of equivalents.<sup>31</sup> The sofas did not have a "fixed console" as defined by Sproule in a Petition to Make Special ("PTMS"),<sup>32</sup> which distin-

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23. See *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1474-75, 45 U.S.P.Q.2d (BNA) 1498, 1499 (Fed. Cir. 1998).

24. See *id.* at 1475, 45 U.S.P.Q.2d at 1499.

25. See *id.*

26. See *id.* at 1475, 45 U.S.P.Q.2d at 1499-1500.

27. See *id.*

28. See *id.*

29. See *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1475, 45 U.S.P.Q.2d (BNA) 1498, 1499 (Fed. Cir. 1998). Berkline's earlier action in the United States District Court for the Middle District of North Carolina had sought a declaration that the patent was invalid and not infringed. This action was transferred to the District of Massachusetts and consolidated with Gentry's suit. Berkline added a counterclaim alleging inequitable conduct. See *id.* at 1475, 45 U.S.P.Q.2d at 1500.

30. See *Gentry Gallery, Inc. v. Berkline Corp.*, 30 U.S.P.Q.2d (BNA) 1132 (D. Mass. 1994) (Gentry I).

31. See *id.* at 1136-38.

32. New applications are examined in the order filed. See U.S. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURES § 708.02 at 700-69 (6th ed. rev. 1997) [hereinafter MPEP]. A Petition To Make Special (PTMS) allows an earlier examination under certain conditions. See 37 C.F.R. § 1.102 (1997). These conditions include prospective manufacture, actual infringement, applicant's health, applicant's age, environmental quality, energy, inventions relating to recombinant DNA, superconductiv-

guished a prior art reference, U.S. Patent 3,8744,747 (“Brennan”), from Sproule’s invention.<sup>33</sup>

In a bench trial,<sup>34</sup> the district court held that the patent was valid because Sproule’s invention was nonobvious<sup>35</sup> and novel.<sup>36</sup> The court held Gentry did not engage in inequitable conduct<sup>37</sup> but denied attorney fees to Gentry.<sup>38</sup> Furthermore, the court held that Gentry’s claims that did not limit the location of the controls to the console were valid under 35 U.S.C. § 112, ¶ 1.<sup>39</sup> The court cited *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*<sup>40</sup> to frame the issue.<sup>41</sup> According to *Ethicon Endo-Surgery*, a broad claim is allowable, while a claim not supported by the specification is not.<sup>42</sup> The claims in Gentry’s patent were directed to an “inside” recliner and covered controls in other locations.<sup>43</sup> Such claims were supported by an embodiment describing the control on the console.<sup>44</sup>

Gentry appealed the non-infringement and attorney fees decisions, while Berkline cross-appealed the invalidity decision.<sup>45</sup>

## B. Federal Circuit Decision

The Federal Circuit in *Gentry* affirmed the district court’s findings of non-infringement and non-obviousness and its denial of attorney fees.<sup>46</sup> However, the Federal Circuit reversed the district court ruling on written

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ity technologies, inventions relating to HIV/ AIDS and cancer, inventions for countering terrorism, and biotechnology applications from small entities. See MPEP § 708.02.

33. See *Gentry I*, 30 U.S.P.Q.2d at 1137.

34. See *Gentry Gallery, Inc. v. Berkline Corp.*, 939 F. Supp. 98, 100, 41 U.S.P.Q.2d (BNA) 1345, 1347 (D. Mass. 1996) (*Gentry I*).

35. See *id.* at 105, 41 U.S.P.Q.2d at 1351.

36. See *id.* at 100, 41 U.S.P.Q.2d at 1347.

37. See *id.* at 100-01, 41 U.S.P.Q.2d at 1347-48. Berkline failed to prove its contentions that Gentry deliberately did not disclose a prior art reference and a pending patent application. See *id.*

38. See *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1476, 45 U.S.P.Q.2d (BNA) 1498, 1500 (Fed. Cir. 1998).

39. See *Gentry II*, 939 F. Supp. at 106, 41 U.S.P.Q.2d at 1352.

40. 93 F.3d 1572, 40 U.S.P.Q.2d (BNA) 1019 (Fed. Cir. 1996).

41. See *Gentry Gallery, Inc. v. Berkline Corp.*, 939 F. Supp. 98, 105, 41 U.S.P.Q.2d (BNA) 1345, 1351 (D. Mass. 1996) (*Gentry II*).

42. See *Ethicon Endo-Surgery*, 939 F.3d at 1582 n.7, 40 U.S.P.Q.2d at 1027 n.7.

43. See *Gentry II*, 939 F. Supp. at 106, 41 U.S.P.Q.2d at 1352.

44. See *id.*

45. See *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1475-76, 45 U.S.P.Q.2d (BNA) 1498, 1500 (Fed. Cir. 1998).

46. See *id.* at 1474, 45 U.S.P.Q.2d at 1499.

description as required by 35 U.S.C. §112, ¶1 under a clearly erroneous standard.<sup>47</sup>

The Federal Circuit upheld the district court decision of non-infringement. Although Berkline's sofas meet the "fixed" limitation, they do not have a "console."<sup>48</sup> The court accepted Gentry's definition of "fixed" because the explanatory clause in the claim comported with Gentry's characterization of "fixed" as requiring that the console be attached to the recliners.<sup>49</sup> Berkline's interpretation of "console" as defined in the PTMS prevailed.<sup>50</sup> Sproule had distinguished a prior art reference, Brennan, by arguing that Brennan's invention did not have a console because it showed "a complete center seat with a tray unit in its back."<sup>51</sup> The court found that Berkline's fold-down tray table was indistinguishable from Brennan's tray unit.<sup>52</sup> Because Berkline's sofas did not have a console as defined by Gentry during the prosecution history, Berkline did not infringe Gentry's patent.<sup>53</sup>

The Federal Circuit affirmed the district court holding of nonobviousness. Obviousness is determined by four factors: the scope and content of prior art, differences between the prior art and the claims, the level of ordinary skill in the art, and secondary considerations.<sup>54</sup> A combination of prior art references is obvious if "the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process"<sup>55</sup> and if "the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success."<sup>56</sup> Berkline did not overcome the statutory presumption of validity by showing obviousness because the combination of prior art references did not suggest a

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47. *See id.*

48. *See id.* at 1477, 45 U.S.P.Q.2d at 1501. In addition, prosecution history estoppel resulting from the PTMS precludes infringement under the doctrine of equivalents. *See id.*

49. *See id.*

50. *See id.*

51. *See Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1477, 45 U.S.P.Q.2d (BNA) 1498, 1501 (Fed. Cir. 1998).

52. *See id.*

53. *See id.*

54. *See Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Secondary considerations include commercial success, long felt but unsolved needs, and failure of others. *See id.* at 17-18.

55. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d (BNA) 1438, 1442 (Fed. Cir. 1991).

56. *Id.*

“fixed console.”<sup>57</sup> In addition, expert testimony showed that the recliner in U.S. Patent 4,668,009 (“Talley”) opened prematurely when the combination of the Talley recliner in a sectional sofa was attempted.<sup>58</sup>

The Federal Circuit reversed the district court ruling on patent validity based on the written description requirement. The written description requirement was not met for claims in which the location of the recliner control was not on the console, and, therefore, those claims were invalid.<sup>59</sup> The court cited *Lockwood v. American Airlines, Inc.*<sup>60</sup> and *Regents of the Univ. of Cal. v. Eli Lilly & Co.*,<sup>61</sup> a biochemical case, to support its proposition that “the scope of the right to exclude may be limited by a narrow disclosure.”<sup>62</sup>

In analyzing whether the patent disclosure limits the patent claim, the court looked at the original disclosure, the original claim, and the inventor’s testimony.<sup>63</sup> The original disclosure showed only one location for the controls, on the console, and stated that the purpose of the console is to house the controls.<sup>64</sup> The broadest original claim located the controls on the console.<sup>65</sup> Sproule himself testified at trial that he considered the console as the location for the controls.<sup>66</sup> The court concluded that the disclosure limits the claims to those in which the recliner control is located on the console of the sofa.<sup>67</sup>

The court rebutted Gentry’s reliance on *Ethicon Endo-Surgery* and *In re Rasmussen*.<sup>68</sup> According to the court, *Ethicon Endo-Surgery* permits an applicant to draft a claim broadly only if the missing limitation from the claim was not an essential element of the invention.<sup>69</sup> Furthermore, the written description in *Rasmussen* was satisfied because the missing limitation was unimportant.<sup>70</sup> Consequently, in *Gentry*, because the missing

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57. See *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1478, 45 U.S.P.Q.2d (BNA) 1498, 1502 (Fed. Cir. 1998).

58. See *id.* at 1478, 45 U.S.P.Q.2d at 1502.

59. See *id.* at 1480, 45 U.S.P.Q.2d at 1504.

60. 107 F.3d 1565, 41 U.S.P.Q.2d (BNA) 1961 (Fed. Cir. 1997).

61. 119 F.3d 1559, 43 U.S.P.Q.2d (BNA) 1398 (Fed. Cir. 1997).

62. *Gentry*, 134 F.3d at 1479, 45 U.S.P.Q.2d at 1503.

63. See *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479, 45 U.S.P.Q.2d (BNA) 1498, 1503 (Fed. Cir. 1998).

64. See *id.*

65. See *id.*

66. See *id.*

67. See *id.*

68. 650 F.2d 1212, 211 U.S.P.Q. (BNA) 323 (C.C.P.A. 1981).

69. See *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479, 45 U.S.P.Q.2d (BNA) 1498, 1503 (Fed. Cir. 1998).

70. See *id.* at 1480, 45 U.S.P.Q.2d at 1503.

limitation was an essential element, the patent was invalid.<sup>71</sup> The court concluded that *Ethicon Endo-Surgery* and *Rasmussen* established that “claims may be no broader than the supporting disclosure, and therefore that a narrow disclosure will limit claim breadth.”<sup>72</sup>

The Federal Circuit declined to rehear the case *en banc*.<sup>73</sup> The Supreme Court has yet to grant or deny certiorari.<sup>74</sup>

### III. DISCUSSION

#### A. Omitted Element Test

##### 1. Omitted Element Test

The court in *Gentry* introduced a new test, the omitted element test, into written description jurisprudence.<sup>75</sup> If an element of an invention is essential, then that element limits claim breadth.<sup>76</sup> As support for its new test, the court relied on *Ethicon Endo-Surgery* and *Rasmussen*, which stated that the disclosure of an element does not serve to limit claim breadth. However, neither court used the term “essential” in its analysis. Nevertheless, the omitted element test is supported by the two cases.

The situation in *Ethicon Endo-Surgery* was remarkably similar to the situation in *Gentry*. The issue in *Ethicon Endo-Surgery* was whether the location of a device was limited to the one disclosed in the specification.<sup>77</sup> The court in *Ethicon Endo-Surgery* applied a subjective test, stating that the device was not limited to the location disclosed in the specification if the inventor did not consider the location to be an element of his invention.<sup>78</sup> The court distinguished between broad claims, which are permissi-

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71. See *id.* at 1480, 45 U.S.P.Q.2d at 1503-04.

72. *Id.* at 1480, 45 U.S.P.Q.2d at 1503.

73. See *id.* at 1473, 45 U.S.P.Q.2d at 1498.

74. See *Reiffin v. Microsoft Corp.*, 48 U.S.P.Q.2d (BNA) 1274, 1277 n.3 (N.D. Cal. 1998).

75. The test was first named the “omitted element test” by the court in *Reiffin v. Microsoft Corp.*, 48 U.S.P.Q.2d (BNA) 1274, 1277 (N.D. Cal. 1998); but see John D. Vandenberg and James E. Geringer, *Biplane Sinks Submarine: The Omitted Element Prong of Patent Law’s Written Description Requirement*, SD20 A.L.I.-A.B.A. Course of Study 245, 248-49 (1998) (arguing that the omitted element test has been the law for at least one hundred years).

76. See *Gentry Gallery, Inc. v. Berklene Corp.*, 134 F.3d 1473, 1479-80, 45 U.S.P.Q.2d (BNA) 1498, 1503 (Fed. Cir. 1998).

77. See *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1582 n.7, 40 U.S.P.Q.2d (BNA) 1019, 1027 n.7 (Fed. Cir. 1996).

78. See *id.*



ble, and claims unsupported by the specification, which are not.<sup>79</sup> The distinction between broad and unsupported claims depends on whether the disputed limitation is an element of the invention.<sup>80</sup> If the limitation is not an element of the invention, then the inventor is entitled to a patent claim as broadly as permitted by the prior art.<sup>81</sup> A broad claim may be supported by the specification even though it does not disclose other potential embodiments.<sup>82</sup>

If Sproule did not consider the precise location of the controls to be an element of his invention, then he is allowed to write a broad claim excluding the location of the controls as a limitation. While the claim may be read as broad rather than unsupported, the evidence cited by the Federal Circuit does not support this view,<sup>83</sup> relied on by the district court. The Federal Circuit thought that the limitation of the console location was an element of the invention, while the district court did not. Therefore, the district court held that a broad claim to a recliner that maintained its stability was supported by the disclosure of two recliners with a console between them.<sup>84</sup>

In addition, if one skilled in the art understands that it is unimportant how an element is accomplished so long as the element is accomplished, then the claim breadth would not be limited by the disclosure.<sup>85</sup> This objective test was applied in *Rasmussen*, where it was unimportant how the element was accomplished.<sup>86</sup> The "how" was important in *Gentry* given the difficulties of producing a sectional sofa with parallel recliners.<sup>87</sup>

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79. *See id.*

80. *See id.*

81. *See id.*

82. *See id.*

83. *See Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479, 45 U.S.P.Q.2d (BNA) 1498, 1503 (Fed. Cir. 1998).

84. *See Gentry Gallery Inc. v. Berkline Corp.*, 939 F. Supp. 98, 106 (D. Mass. 1996) (Gentry II).

85. *See In re Rasmussen*, 650 F.2d 1212, 1215, 211 U.S.P.Q. (BNA) 323, 327 (C.C.P.A. 1981).

86. *See id.*

87. *See Gentry II*, 939 F. Supp. at 103, 41 U.S.P.Q.2d at 1349. The district court commented on the long felt need for two recliners facing the same direction on a sectional sofa. *See id.* at 104, 41 U.S.P.Q.2d at 1350-51. However, no furniture company had been able to accomplish this seemingly simple task. *See id.* at 104, 41 U.S.P.Q.2d at 1350. Industrial sofa designer Billy Metts had tried other configurations, such as locating the controls on the side of the wedge and under the cushion, but these locations did not work. *See id.* at 103, 41 U.S.P.Q.2d at 1349.

## 2. *Standard used in the omitted element test*

Less than six months after *Gentry*, the United States District Court for the Northern District of California issued a summary judgment in *Reiffin v. Microsoft Corp.*,<sup>88</sup> almost entirely based on *Gentry's* omitted element test.<sup>89</sup> The court in *Reiffin* interpreted *Gentry* to hold that patent claims were invalid if "they omit an element that someone skilled in the art would understand to be essential to the invention as originally disclosed."<sup>90</sup> The court did not have the benefit of the inventor's testimony, so it focused its analysis on the patent itself in invalidating Reiffin's patent for omission of four essential elements.<sup>91</sup>

The omitted element test is problematic in that it is uncertain whether the applicable standard is a subjective or objective one. The Federal Circuit derived the omitted element test from the analyses of the *Ethicon Endo-Surgery* and *Rasmussen* cases.<sup>92</sup> In *Ethicon Endo-Surgery*, the court used a subjective test, one that depends on whether the *applicant* considered the limitation to be an element of the invention.<sup>93</sup> In contrast, in *Rasmussen*, the court applied an objective test, whether "one skilled in the art who read [the] specification would understand that it is unimportant how the layers are adhered, so long as they are adhered."<sup>94</sup>

It is unclear whether the *Gentry* court employed an objective or subjective standard in its analysis. The court looked at the original disclosure and the original claim to determine whether the location of the console controls was an essential element of the invention.<sup>95</sup> In addition, Sproule's own subjective interpretation, his testimony at trial, lent weight to the significance of the element.<sup>96</sup> However, the court did not indicate whether it

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88. 48 U.S.P.Q.2d (BNA) 1274 (N.D. Cal. 1988).

89. *See id.* at 1277-78.

90. *Id.* at 1277 (citations omitted).

91. *See id.* at 1279-80. Specifically, the court examined the "Summary of the Invention," "Object of the Invention," "Description of Prior Art," background, and title sections in the original disclosure for references to the importance of the four elements. In addition, the original claims directly or indirectly reference the four elements. *See id.* at 1279.

92. *See Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479-80, 45 U.S.P.Q.2d (BNA) 1498, 1503 (Fed. Cir. 1998).

93. *See Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1582 n.7, 40 U.S.P.Q.2d (BNA) 1019, 1027 n.7 (Fed. Cir. 1996).

94. *In re Rasmussen*, 650 F.2d 1212, 1215, 211 U.S.P.Q. (BNA) 323, 327 (C.C.P.A. 1981).

95. *See Gentry*, 134 F.3d at 1479, 45 U.S.P.Q.2d at 1503.

96. *See id.* *See also* Pretty, *supra* note 15, at 478-79 ("To adopt a subjective test for 'written description' as to what the inventor subjectively considered 'essential' in terms

looked at the evidence from the viewpoint of the inventor (subjective) or one skilled in the art (objective). On the contrary, the court added to the confusion by stating later in the case that *both* Sproule, the inventor, considered and one skilled in the art would consider the location to be essential.<sup>97</sup>

This contradiction is further compounded in the *Reiffin* case. The *Reiffin* court stated that *Gentry's* omitted element test was a purely objective one: whether "a person skilled in the art would have understood those elements to be essential to the disclosed invention."<sup>98</sup> However, the court supported *Gentry's* rule by citing *Ethicon Endo-Surgery*, where a subjective test is applied.<sup>99</sup> The *Reiffin* court ignored this difference and proceeded to announce that the *Ethicon Endo-Surgery* test was to be analyzed from either an objective or subjective viewpoint.<sup>100</sup>

In order to be consistent with written description precedent, the omitted element test should be a purely objective one. To meet the written description requirement, "the description must clearly allow persons of ordinary skill in the art to recognize that [the applicant] invented what is claimed."<sup>101</sup> This requirement is purportedly an objective test,<sup>102</sup> and the omitted element test in the written description requirement should be similarly objective. An objective standard would conform to other standards, such as the obviousness and enablement standards, in patentability analysis.<sup>103</sup> In an obviousness determination, an invention is not patentable if it is obvious to "a person having ordinary skill in the art."<sup>104</sup> Similarly, for enablement purposes, the specification must enable "any person skilled in the art" to make and use the invention.<sup>105</sup>

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of elements not recited in his claimed invention at the time of filing will open a Pandora's box of inquiry in litigation and discovery.").

97. See *Gentry*, 134 F.3d at 1479, 1480, 45 U.S.P.Q.2d at 1503.

98. *Reiffin v. Microsoft Corp.*, 48 U.S.P.Q.2d (BNA) 1274, 1277 (N.D. Cal. 1998).

99. See *id.*

100. See *id.*

101. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 U.S.P.Q.2d (BNA) 1111, 1116 (Fed. Cir. 1991) (citations omitted).

102. *But see* Rhoades, *supra* note 15, at 893-94 ("The possession standard shifts the focus from those skilled in the art—the specification's audience—to the inventor."); Harris A. Pitlick, *Looking Beyond Blazemarks on Trees—It's Time to Revisit the Description Requirement in the Wake of Warner-Jenkinson*, 79 J. PAT. & TRADEMARK OFF. SOC'Y 625, 635 (1997) (quoting Rhoades).

103. By contrast, the best mode requirement is a mixed objective and subjective test. See 35 U.S.C. § 112 ¶ 1 (1998) ("The specification ... shall set forth the best mode contemplated by the inventor of carrying out his invention.").

104. See 35 U.S.C. § 103(a) (1998).

105. See 35 U.S.C. § 112 ¶ 1 (1998).

### 3. *Implications of the omitted element test*

The application of the *Gentry* omitted element test has many potential effects on patent prosecutors and litigators. Accused infringers should examine the file history of a patent to determine whether the asserted claims are missing limitations that were in the broadest original claims.<sup>106</sup> Patent attorneys would be well advised to omit the "objects of the invention" section of a specification<sup>107</sup> and list several alternative embodiments in the specification.<sup>108</sup> In addition, inventors may have to expend time and money to create routine variations obvious to one skilled in the art so that patent attorneys would have sufficient alternative embodiments to satisfy the *Gentry* omitted element test.<sup>109</sup> This expenditure of inventor's time may result in lost opportunity costs for the inventors to innovate.<sup>110</sup>

## B. Persuasiveness of Reliance on *Lockwood* and *Eli Lilly*

### 1. *Different factual situation in Lockwood*

The court cited *Lockwood* to support its proclamation that claim breadth is limited by a narrow disclosure.<sup>111</sup> However, in *Lockwood*, the inventor claimed an individual terminal with a video disk player but disclosed a television set with a keypad.<sup>112</sup> The disclosed invention was simply not an embodiment of the claimed invention. The inventor failed the written description test because an inventor cannot claim an invention different from the one disclosed in the specification.<sup>113</sup> In contrast, Sproule did disclose an embodiment of his claimed invention as required by 35 U.S.C. § 112, but his claims were limited by the specific embodiment of the invention he disclosed.

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106. See Jeffrey R. Kuester, *Effective § 102, 103, 112 Defenses: What can Defendants Do to Win with Them Today?*, 531 PLI/PAT 933, 953 (1998).

107. See James C. Pistorino, *Recent Developments in Patent Law*, 6 TEX. INTELL. PROP. L.J. 355, 364-65 (1998) ("The court's consideration of the 'purpose' of the invention and its limiting effect in this case should cause practitioners to further avoid the already suspect practice of listing 'objects of the invention' in the specification.")

108. See Laurence H. Pretty, *The Judicial Attack on Infringement*, 531 PLI/PAT 219, 246-47 (1998).

109. See Interview with Robert P. Merges, Wilson Sonsini Professor of Law, University of California at Berkeley (Boalt Hall), in Berkeley, Cal. (Dec. 2, 1998).

110. *Id.*

111. "[C]laims may be no broader than ... supporting disclosure, and therefore ... a narrow disclosure will limit claim breadth." *Gentry Gallery, Inc. v. Berklene Corp.*, 134 F.3d 1473, 1480, 45 U.S.P.Q.2d (BNA) 1498, 1503 (Fed. Cir. 1998).

112. See *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q.2d (BNA) 1961, 1966 (Fed. Cir. 1997).

113. See *id.*

## 2. *Implications of Reliance on Eli Lilly*

The court in *Gentry* hinted that the distinction between predictable and unpredictable art in the written description requirement is irrelevant by citing *Eli Lilly*, a case from the unpredictable biochemical arts, in support of its proposition that claims may be limited by a narrow disclosure.<sup>114</sup> However, the court in *Eli Lilly* refused to follow *Utter v. Hiraga*,<sup>115</sup> a case from the predictable arts, because such a case has no relation to one with complex biochemical claims.<sup>116</sup> Since the *Gentry* patent also involves predictable art, the *Gentry* court should have followed *Utter*, rather than *Eli Lilly*.<sup>117</sup> If the *Gentry* court had followed *Utter*, it is likely that the *Gentry* patent would have been valid.<sup>118</sup>

The Federal Circuit's reliance on *Eli Lilly* in *Gentry* extends the limitations on written description in the unpredictable arts to the predictable arts.<sup>119</sup> *Eli Lilly* stands for the proposition that the description of one member of a group is not necessarily sufficient to claim the entire group in the unpredictable arts.<sup>120</sup> The *Gentry* patent claimed a sectional sofa with two parallel reclining seats, but described only one specific embodiment, a sofa with the control mechanism located on a console.<sup>121</sup> In invalidating the *Gentry* patent, the Federal Circuit effectively narrowed patent scope to the specific embodiment in the written disclosure by requiring that every claim embody every "essential" element.<sup>122</sup> The Federal Circuit not only

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114. See *Gentry Gallery*, 134 F.3d at 1479, 45 U.S.P.Q.2d at 1503.

115. 845 F.2d 993, 6 U.S.P.Q.2d (BNA) 1709 (Fed. Cir. 1988).

116. See *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1568, 43 U.S.P.Q.2d (BNA) 1398, 1406 (Fed. Cir. 1997).

117. Interestingly enough, *Reiffin v. Microsoft Corp.*, 48 U.S.P.Q.2d (BNA) 1274, 1277 (1998), cited two cases from older case law to support its application of the *Gentry* omitted element test, both in the unpredictable arts. See *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668 (1942); *In re Sus*, 306 F.2d 494, 134 U.S.P.Q. (BNA) 301 (C.C.P.A. 1962).

118. See *Pretty*, *supra* note 15, at 477.

119. See generally *Pretty*, *supra* note 15; Laurence H. *Pretty*, *Federal Circuit Narrows the Protection of Patents Closer Toward Their Specific Disclosures*, 16 NO. 3 INTELL. PROP. L. NEWSL. 8 (1998) ("[The] court's extension in *Gentry* of its 'written description' reasoning from the unpredictable art of biochemistry to the predictable art of machinery is contrary to its own case law [because] [c]hanging the location of mechanical controls on a sofa [is obvious to person of ordinary skill in predictable art of machinery].").

120. See *Eli Lilly*, 119 F.3d at 1568, 43 U.S.P.Q.2d at 1405.

121. See U.S. Patent No. 5,064,244, issued Nov. 12, 1991.

122. See *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479-80, 45 U.S.P.Q.2d (BNA) 1498, 1503 (Fed. Cir. 1998).

followed *Eli Lilly* in limiting claim breadth<sup>123</sup> but also further narrowed patents through its newly announced omitted element test.

#### IV. CONCLUSION

The *Gentry* court announced a new test, the omitted element test, citing *Ethicon Endo-Surgery*, *Rasmussen*, *Lockwood* and *Eli Lilly* as precedent. If an element is "essential" to the invention, then the element must be included in the claims. While neither the *Ethicon Endo-Surgery* court nor the *Rasmussen* court employed the term "essential" in its analysis, the cases do adequately support the *Gentry* omitted element test. The use of *Eli Lilly* as precedent may signal a harmonization of the written description requirement for the predictable and unpredictable arts. Although the *Gentry* court introduced this new test, the objectivity or subjectivity of the standard has yet to be resolved.

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123. See Mueller, *supra* note 15, 615 (1998) ("The *Lilly* decision may profoundly limit the scope of protection available for new gene inventions; viewed in tandem with recent decisions interpreting the enablement requirement of § 112 of the Patent Act, it represents the latest advance in an ominous trend towards imposition of uniquely heightened patentability requirements for biotechnological inventions."). See also Michael Delmas Plumber, Note, *Genetic, Inc. v. Novo Nordisk & University of California v. Eli Lilly and Co.*, 13 BERKELEY TECH. L.J. 149, 159 (1998) (noting that the *Eli Lilly* "ruling gives only very narrow protection to genetic engineering patents").