

*IN RE CURTIS**354 F.3d 1347 (Fed. Cir. 2004)*

The Federal Circuit held that when the evidence indicates persons having ordinary skill in the relevant art cannot predict the operability in the invention of any species other than the one disclosed, a patentee will not be deemed to have invented species sufficient to constitute the genus by virtue of having disclosed a single species.

The patentees (collectively “Curtis”) filed a patent application claiming they “unexpectedly discovered” that dental floss, when made with a floss filament coated with microcrystalline wax (“MCW”), would provide a coefficient of friction that hits the right balance between usability and effectiveness. Two continuation-in-part applications ensued, resulting in two issued patents. In the first patent, Curtis repeated the language of the original application about the MCW, but nowhere did he mention other kinds of coating materials that could increase the coefficient of friction. In the second patent and a related reissue application, Curtis added genus claims that read on “at least one friction enhancing coating.”

Subsequently, a third party challenged the later broader claims based on a prior-art patent that was not before the Patent and Trademark Office (PTO) during the prosecution of the second patent. The PTO, merging the reexamination challenge and the reissue request, ruled that the disclosure in the first patent did not provide written description support for the later-claimed generic subject matters, and therefore Curtis could not benefit from the earlier priority date. The PTO issued a final rejection. Curtis appealed to the Board of Patent Appeals and Interferences, which ultimately affirmed the examiner’s decision. Curtis then appealed to the Federal Circuit.

The Federal Circuit held that a disclosure of a species does not always suffice to describe a genus. In supporting its decision, the court considered the unexpected aspects of the invention, the lack of mention of other materials in the patents, and statements regarding the difficulty of the art. In addition, the court rejected declarations filed by Curtis during the PTO proceedings since they came more than ten years after the filing of the earlier patent. The court held that the applicable test is whether, upon reading the disclosure of a species, a person of ordinary skill in the art would “instantly recall” other species of the later-claimed broad genus. Applying that test, the court held that no evidence in the record indicated one of ordinary skill had stored in their minds any friction-enhancing coating other than the MCW.