

Welcome to Hauptman Ham, LLP's Case Law Review, a summary of recent important intellectual property decisions.

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WRITTEN DESCRIPTION IS REQUIRED ONLY FOR WHAT IS CLAIMED

Novartis Pharms. Corp. v. MSN Pharms. Inc.

Appeal No. 23-2218 (Fed. Cir., Jan. 10, 2025, Lourie, Prost, Reyna)

Author: *Reina Kakimoto*

Key Points:

- A patent claim is not invalid for lack of written description where the specification did not describe a later improvement not recited in the claim.
- 專利權利要求不會因說明書中未描述權利要求中未提及的後續改進內容而因缺乏書面描述被認定無效。
- 明細書が、クレームが要件としていない後の改良を開示していない場合、そのクレームが記載要件違反により無効とはならない。
- 명세서가 청구항에서 설명하는 사후 개선사항을 개시하지 않은 경우, 그 청구항은 기재요건 위반으로 인해 근거가 없다고 볼 수는 없다.

Background:

Novartis Pharmaceuticals Corporation (“Novartis”) sued MSN Pharmaceuticals Corporation (“MSN”) and other generic drug manufacturers for patent infringement after they sought FDA approval for generic versions of Entresto® (sacubitril/valsartan), a drug used to treat chronic heart failure and hypertension. The case centered on U.S. Patent 8,101,659 (“’659 patent”). The District Court found the patent invalid for lack of written description but not invalid against obviousness and enablement challenges.

Holding:

The Court of Appeals for the Federal Circuit (CAFC) reversed the District Court’s finding of lack of written description, ruling that the patent sufficiently described what was claimed.

Discussion:

The key dispute revolved around the term "wherein said [valsartan and sacubitril] are administered *in combination*." MSN argued that the patent lacked a sufficient written description of *valsartan-sacubitril complexes* (the single unit-dose form through weak, non-covalent bonds, which is the actual state of the two drugs in Entresto® that was not known before the '659 patent’s priority date). The District Court had agreed, declaring the patent invalid.

The reviewing court determined that the lower court had misconstrued the written description requirement, finding that the patent did not need to describe later improvements and that the specification adequately supported the claims. As explained by the reviewing court, the patent needs to describe what is *claimed*, which is the two drugs “in combination.”

Emphasizing that the written description requirement is satisfied if the patent sufficiently describes what is actually claimed, the CAFC rejected MSN’s contention that because the patent does not describe a complex of the two drugs the claims are invalid. The reviewing court held that because the '659 patent does not claim valsartan-sacubitril complexes, those complexes did not need to be described in the specification. The CAFC was not asked, and did not determine, whether the scope of the claims can fairly cover the complexes at issue.

‘COMPRISING’ LIMITED BY DESCRIPTION

HD Silicon Sols. LLC v. Microchip Tech. Inc.

Appeal No. 2023-1397 (Fed. Cir., Feb. 6, 2025, Lourie, Stoll, Cunningham)

Author: Gregory Brummett

Key Points:

- Notwithstanding the presence of an inclusive word, the phrase “comprising tungsten” was limited in scope to elemental tungsten by clear and repeated reference, in the specification, to tungsten as the elemental form.
- 尽管存在包容性措辞，但通过说明书中对钨元素形态的明确且反复提及，“包含钨”这一短语的范围被限定为单质钨。
- 包括的な用語の存在にかかわらず、“タングステンを含む”という表現は、その明細書中で明確なかつ繰り返し用いられている元素としてのタングステンの引用により、タングステン元素としての範囲に限定される。
- 포괄적인 용어가 있음에도 불구하고, “텅스텐을 포함한다”는 표현은 명세서에서 원소 형태인 텅스텐을 명시적이고 반복적으로 언급하여 그 범위를 텅스텐 원소로 제한했다.

Background:

HD Silicon Solutions LLC (“HDSS”) appealed a decision by the Patent Trial and Appeal Board (PTAB) holding claims 1–7 and 9–17 of U.S. Patent 6,774,033 (“’033 patent”) unpatentable as obvious. The patent

pertains to a local interconnect layer in an integrated circuit. The PTAB had construed the phrase “comprising tungsten” as encompassing both elemental tungsten and tungsten compounds.

Holding:

The Court of Appeals for the Federal Circuit (CAFC) found the claim construction adopted by the PTAB erroneous, but nonetheless affirmed the PTAB’s obviousness decision, finding the claim construction error harmless.

Discussion:

HDSS challenged PTAB's interpretation of the term “comprising tungsten” in the claims of the '033 patent, arguing that PTAB had included not only tungsten as an element but also its compounds, and that this interpretation was overly broad. The CAFC examined the specification and found that the PTAB had relied on a single sentence to justify their interpretation. However, ultimately, the CAFC determined that the term "comprising tungsten" refers only to elemental tungsten, either pure or with impurities, but not to tungsten compounds. The reviewing court explained that the specification and claims refer expressly to compounds in every case where a compound is intended, and that every mention of “tungsten” in the specification refers only to elemental tungsten. The reviewing court further noted the use, for example in claim 12, of an open-ended modifier when referring to materials that include both compounds and elements. Claim 12 recites a “chlorine-based etchant,” which the specification defines as including both chlorine compounds and elemental chlorine. No such description or usage appears in connection with “tungsten.”

The CAFC found, however, that the erroneous construction by the PTAB did not affect the outcome because the prior art references reviewed by the PTAB taught use of tungsten, both in elemental and compound form. The CAFC thus affirmed the PTAB’s ultimate conclusion of obviousness.

PATENTED FEATURE CANNOT ALSO BE TRADEMARKED

CeramTec GmbH v. CoorsTek Bioceramics LLC

Appeal No. 2023-1502 (Fed. Cir., Jan. 3, 2025, Lourie, Taranto, Stark)

Author: Reina Kakimoto

Key Takeaways:

- Patenting a feature is evidence, for trademark purposes, that the feature is functional.
- 从商标法角度而言，对某一特征申请专利的行为可作为该特征具有功能性的证据。
- ある特徴が特許されていることは、商標の目的において、その特徴が機能的であることの証拠である。
- 어떤 특징으로 특허를 받았다는 것은 상표의 목적상 그 특징이 기능적이라는 증거이다.
- Trademark protection cannot be used to prevent the public from using a patented feature after the patent expires.
- 在专利到期后，商标保护不得用于阻止公众使用已过期的专利特征。

- 特許権満了後にある特許された特徴を公衆が使用することを妨げるために、商標保護を用いることができない。
- 특허권 만료 후 특허받은 특징을 대중이 사용하는 것을 막기 위해 상표 보호를 사용할 수 없다.

Background:

CeramTec GmbH (“CeramTec”) manufactures ceramic hip components made from zirconia-toughened alumina (ZTA) and sought trademark protection for the pink color of these components. CoorsTek Bioceramics LLC (“CoorsTek”) challenged the trademarks, arguing that the pink color was functional because it resulted from chromia, which enhances material hardness and toughness. Agreeing with CoorsTek, the Trademark Trial and Appeal Board (TTAB) canceled the trademarks. CeramTec appealed.

Holding:

Aligning with Supreme Court precedent holding that patenting a feature is strong evidence that the feature is functional, the Court of Appeals for the Federal Circuit (CAFC) affirmed, finding that the pink color was functional and thus not eligible for trademark protection.

Discussion:

The CAFC applied the functionality doctrine, particularly the “Morton-Norwich factors,” which assess whether a feature serves a useful purpose. The CAFC determined that chromia in the ceramic directly contributed to hardness, making the pink color an inherent functional feature rather than a distinctive trademark.

Key evidence based on the “Morton-Norwich factors” included:

- CeramTec’s own patents, which describe chromia’s functional benefits and claim the color pink.
- Advertising materials emphasizing chromia’s role in improving durability.
- Lack of evidence showing that alternative colors could achieve the same performance.

Given these findings, the CAFC held that the pink color could not be monopolized through trademark law. The court explained that to hold otherwise, to permit trademark protection for a patented feature, would frustrate the purpose of the patent system to permit public use of an invention after the patent has expired.

ADDITIONAL INFORMATION

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