

RAI STRATEGIC HOLDINGS INC. v. PHILIP MORRIS PRODUCTS S.A., Appeal No. 2022-1862 (Fed. Cir. Feb. 9, 2024). Before Stoll, Chen, and Cunningham. Appealed from the PTAB.

Background:

The petitioner, Philip Morris, filed a post-grant review to challenge the validity of RAI's patent directed to a smoking article for receiving and vaporizing a disposable aerosol forming substance. With regard to certain dependent claims, Philip Morris argued that the claimed feature of "wherein the heating member is present on the heating projection along a segment having a length of about 75% to about 85% of a length of the disposable aerosol forming substance" lacked written description support under 35 U.S.C. §112(a). The specification of the patent disclosed a variety of ranges for the heating member, in particular ranges such as 75% to 125%, 80% to 120%, 85% to 115%, and 90% to 110%. Nonetheless, Philip Morris argued that the specification does not disclose a heater length range with an upper limit of 85%, as claimed.

The Board agreed with Philip Morris and held the claims at issue to be unpatentable for lack of written description support. RAI then appealed.

Issue/Holding:

Is the claimed feature of "wherein the heating member is present on the heating projection along a segment having a length of about 75% to about 85% of a length of the disposable aerosol forming substance" adequately supported by ranges disclosed in the specification that are both broader and different from the claimed range? Yes, vacated.

Discussion:

The Federal Circuit reversed the Board's decision regarding written description, holding that "we see no evidence suggesting that the broad described ranges of 'about 75% to about 125%', 'about 80% to about 120%', about 85% to about 115%, or about 90% to about 110% the length of the inhalable substance medium' disclose a different invention than the claimed range of 'about 75% to about 85%.' In other words, under the facts of this particular case, there is no evidence that the claimed subrange results in a different invention than the invention disclosed in the specification."

The Federal Circuit relied on several factors to reach this conclusion. Firstly, the case law provided several examples of written description support being present for patentees claiming a narrower range of values than disclosed. Secondly, the Federal Circuit emphasized that the particular technology at issue, which it defined as "electro-mechanical inventions," is a predictable art, and the Federal Circuit also emphasized that the simplicity of the claimed feature (the length of a heating member) results in a lower level of detail being required to satisfy the written description requirement.

Thirdly, the court also determined that "nothing in the specification indicates that changing the length of the heating member changes the invention, whether as to operability, effectiveness, or any other parameter."

As a result, although the court disavowed the use of any "mechanical rules," substantial evidence did not support the Board's conclusions regarding written description support. Vacated.