

## Judy He in Intellectual Property Magazine: SCOTUS Denies Actavis' Drug Patent Petition

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Haynes Boone Associate Judy He talked with *Intellectual Property Magazine* about the U.S. Supreme Court (SCOTUS) declining to hear a patent case concerning whether a patent's specification should contain a written description of all the limitations of a patent's claims, not just a 'substantially equivalent' disclosure.

Here is an excerpt:

According to the court's order list released last week (26 May), SCOTUS denied a petition in *Actavis v Nalpropion*, in a move that Haynes Boone's Judy He describes as leaving practitioners "with the possibility that a 'substantially equivalent' disclosure may satisfy the written description requirement in certain situations".

The case relates to Actavis' attempts to invalidate patents utilised in weight management drugs by Nalpropion, with its attempts being rebuffed by both district court and the federal circuit, which found the patents to not be obvious.

Reacting to the denial, He commented, "This is an important issue because the hallmark of written description is disclosure, ie, patentee provides world with enabling disclosure of invention in exchange for patent rights, and the possibility of satisfying this requirement with what is 'substantially equivalent,' depending on a 'flexible, sensible interpretation,' may introduce ambiguity into boundaries that should be well defined.

"While the impact of this case may be narrow and fact-dependent, a question to consider is where (and how) to draw the line between "substantially equivalent" (which may satisfy written description) and "non-equivalent" (which does not satisfy written description)."

Looking past the decision not to hear the case, He concluded that patent practitioners "should be mindful of these issues as they assess the strength of their written description positions with respect to their overall strategy".

To read the full article, click [here](#). (Subscription required)