

THE FORMAL STRUCTURE OF PATENT LAW AND THE LIMITS OF ENABLEMENT

Jeffrey A. Lefstin

Modern American patent law is characterized by two grand themes, both of which were first sounded in the formative years of patent law but have assumed center stage today. The first has been the condensation of the invention and the inventor's legal rights around the claim, a highly formal and abstract collection of properties defining the boundaries of the patent's reach. The second has been the drive to reduce patent law to a small set of formal principles, from which the essential doctrines of patent law may be logically derived. This Article argues that those two themes are fundamentally incompatible, and that one cannot succeed but at the expense of the other. In particular, a coherent doctrine of claim scope cannot be formulated in terms of patent law's enablement doctrine without abandoning the basic tenets of the claim system. If we are to preserve the modern claim system, we must invoke the doctrine of written description, a remnant of the pre-claim era whose nature and continued existence is hotly contested today. This Article contends that the true function of the written description doctrine is to serve as a doctrine of definition. Once this function is recognized, the essential role of written description in modern patent law becomes clear.