In an 8–4 decision, the *en banc* US Court of Appeals for the Federal Circuit issued a *per curiam* order upholding its *earlier panel decision* finding a claim using the transitional phrase “consisting essentially of” to be indefinite because of inconsistencies in the manner in which the patent specification explained the meaning of “better drying time” in connection with use of the claimed formulation. The Court denied plaintiff’s petition for panel rehearing and for rehearing *en banc*. *HZNP Fin. Ltd. v. Actavis Labs. UT, Inc.*, Case No. 17-2149 (Fed. Cir. Feb. 25, 2020) (*per curiam*) (Lourie, J, joined by Newman, O’Malley and Stoll, JJ, dissenting). Judge Newman also dissented in the original panel decision.

In his dissent, Judge Lourie explained that the panel majority misconstrued the transition “consisting essentially of” in finding the phrase “better drying time” to be indefinite since that phrase is not recited in the claim at issue. The dissent reasoned that “it is the language of the claims that must not be indefinite, not the understanding or clarity of an advantage of the invention.” Thus, according to the dissent, it is incorrect to deem a claim indefinite based on a property of the invention that is not even recited in that same claim.

The dissent further explained that the transition “consisting essentially of” is clear, definite language indicating that the constituents of a claim cannot include
materials that affect the basic and novel properties of the claimed composition. In an infringement suit, the meaning of the “consisting essentially of” language is a factual question for the jury to determine whether the “presence of an unrecited material in an accused product is in fact inconsistent with, or defeats the purpose of, the claimed composition.” The jury should determine whether the amounts of an unclaimed ingredient have a material effect on the basic and novel characteristics of the invention. Moreover, under US patent law it is unnecessary to recite in the claims the utility (effect) of the claimed compound or how to measure that effect, the dissent noted.

The dissent argued that the utility of “better drying time” should not make the claim at issue indefinite, since it is merely an unclaimed advantage of the invention. The dissent concluded that “aspects of the utility or its measurement are not relevant to indefiniteness of the claims.” The dissent warned that “under the rule this opinion purports to adopt, any uncertainty concerning advantages, utility, or methods of determining such could . . . be translated into indefiniteness of claims.”

The dissent concluded that the panel majority erred in holding that the claim was indefinite because of inconsistencies in the meaning of “better drying time,” warned that the denial of en banc review is not based on “sound precedent,” and worried that the holding “could have unintended potential effects well beyond this particular case.”

**Practice Note:** Given that four Federal Circuit judges joined this dissent, it seems possible that HZNP might file a petition for writ of certiorari in the Supreme Court of the United States to clarify the “consisting essentially of” doctrine with respect to definiteness.

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