No. 24-1078

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

DUKE UNIVERSITY, ALLERGAN SALES, LLC,

Plaintiffs-Appellees,

v.

SANDOZ, INC.,

Defendant-Appellant.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO
NO. 1:18-CV-997, HON. RAYMOND P. MOORE

PLAINTIFFS-APPELLEES DUKE UNIVERSITY AND ALLERGAN SALES, LLC'S COMBINED PETITION FOR PANEL REHEARING AND REHEARING EN BANC

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF INTEREST

Case Number 24-1078

Short Case Caption Duke University v. Sandoz Inc.

Filing Party/Entity Duke University; Allergan Sales, LLC

Instructions:

1. Complete each section of the form and select none or N/A if appropriate.
2. Please enter only one item per box; attach additional pages as needed, and check the box to indicate such pages are attached.
3. In answering Sections 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance.
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5. Counsel must file an amended Certificate of Interest within seven days after any information on this form changes. Fed. Cir. R. 47.4(c).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 01/20/2026

Signature: /s/ Lisa B. Pensabene

Name: Lisa B. Pensabene

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	**2. Real Party in Interest.** Fed. Cir. R. 47.4(a)(2).	**3. Parent Corporations and Stockholders.** Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. ☑ None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. ☐ None/Not Applicable
Duke University		Not Applicable
Allergan Sales, LLC		AbbVie Inc. (parent)

☐ Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

☐ None/Not Applicable ☑ Additional pages attached

5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

☐ Yes (file separate notice; see below) ☑ No ☐ N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

☑ None/Not Applicable ☐ Additional pages attached

CERTIFICATE OF INTEREST
Addendum to Question 4

4. Legal Representatives. List all law firms, partners, and associates that (a)appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

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TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Page(s)

CASES

TABLE OF AUTHORITIES
(continued)

Page(s)

STATEMENT OF COUNSEL

Based on my professional judgment, I believe this appeal requires an answer to a precedent-setting question of great importance: Whether a panel of this Court can decide the adequacy of written description—a question of fact—without deferring to a jury's verdict.

Based on my professional judgment, I further believe the panel decision is contrary to the "written description" requirement as articulated in this Court's precedent, including *Capon v. Eshhar*, 418 F.3d 1349, 1357, 1360 (Fed. Cir. 2005), and *Regents of Univ. of Minn. v. Gilead Scis.*, 61 F.4th 1350, 1358 (Fed. Cir. 2023).

/s/ *Lisa B. Pensabene*
Lisa B. Pensabene

INTRODUCTION[1]

The panel reversed because it misread the trial record. In concluding that the specification disclosed "billions" of compounds—and thus did not provide sufficient blaze marks to direct a skilled artisan to the claimed subgenus—the panel cited expert testimony it understood to refer to the patent-in-suit. Not so. Both experts used "billions" to describe the scope of the *prior art disclosure*. The panel built its written description analysis on a factual premise that is indisputably false.

That error matters because Sandoz bore the burden of proving invalidity. By relying on the breadth of the prior art instead of what the patent actually discloses about the invention, the panel excused Sandoz from proving the specification does not describe the claimed subgenus. Without evidence establishing that predicate, the panel could not find that Sandoz had met its clear and convincing burden of proving lack of written description—much less its "doubly high" burden (Op. 6) to reverse the jury's decision. That error warrants rehearing by the panel.

The panel also committed independent legal errors, which themselves warrant rehearing by the panel or the full Court. First, contrary to this Court's precedent, the panel held that whether a disclosed embodiment qualifies as a blaze mark turns on whether it is flagged as preferred and appears more often than

[1] Unless stated otherwise, all quotations are omitted and all emphases are added.

others, rather than on whether it directs a skilled artisan to the claimed invention. Second, the panel erroneously held that the specification must restate what was known in the prior art. Third, the panel improperly placed the burden on Plaintiffs to prove validity when it was Sandoz's burden to *disprove* validity. None of those rules finds support in this Court's precedents.

In combination, these errors converted the written description requirement from a factual determination for the jury into a decision for the Court to make independently without regard for the actual trial record or the jury's verdict. If the panel does not grant rehearing and correct its errors, en banc review is warranted.

BACKGROUND

The jury found that Sandoz failed to prove by clear and convincing evidence that Claim 30 of U.S. Patent No. 9,579,270 ("the '270 patent") was invalid. Appx8514-15. The district court denied Sandoz's motion for judgment as a matter of law. Appx47, 50. On appeal, the panel reversed and overturned the jury's verdict on written description. Op. 7, 17-18. Proceeding from the erroneous premise that the specification "could encompass billions of compounds," the panel determined that the '270 patent failed to provide sufficient blaze marks to direct a skilled artisan to the claimed subgenus. Op. 8-9, 17.

STANDARD OF REVIEW

A district court's denial of judgment as a matter of law is reviewed de novo; reversal is proper only if "without weighing the credibility of the witnesses the only reasonable conclusion is in the moving party's favor." *Stroup v. United Airlines, Inc.*, 26 F.4th 1147, 1156 (10th Cir. 2022). "Whether a patent claim is supported by an adequate written description is a question of fact." *AbbVie Deutschland GmbH & Co., KG v. Janssen Biotech, Inc.*, 759 F.3d 1285, 1297 (Fed. Cir. 2014). This Court "review[s] a jury's factual determination relating to compliance with the written description requirement for substantial evidence." *Id.*

REASONS FOR GRANTING PANEL OR EN BANC REHEARING

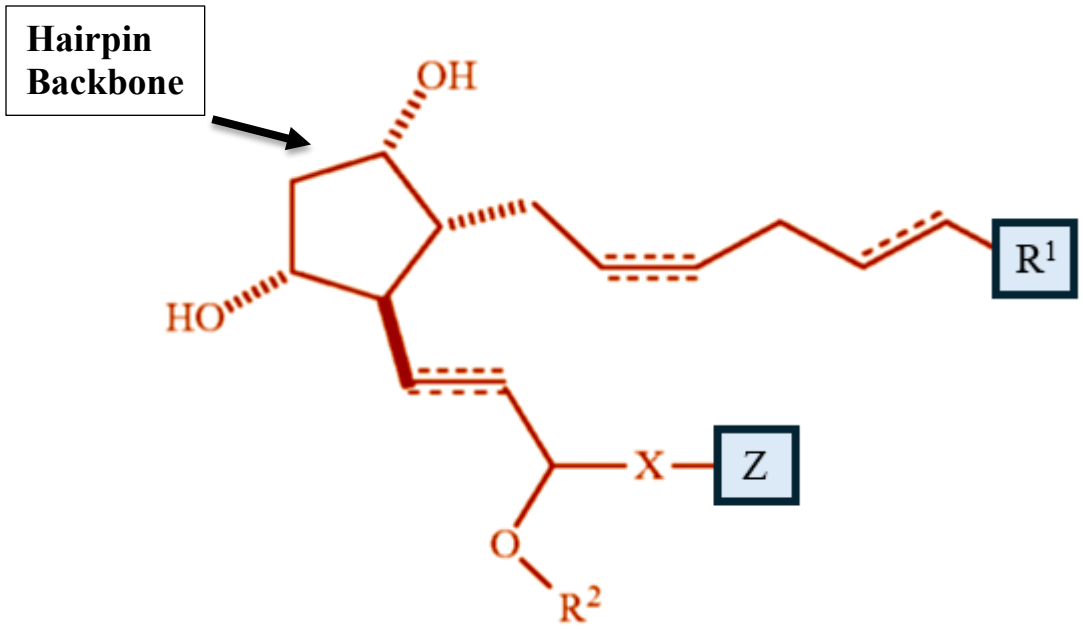
Rehearing is warranted on both factual and legal grounds. The panel erred factually by anchoring its analysis on the supposedly "uncontested" premise that the '270 patent specification encompassed "billions of compounds" from which the compounds used in the claimed method could not be discerned. Op. 8. The record contradicts this conclusion. Without this nonexistent premise, Sandoz failed to carry its burden to prove lack of written description and the panel was wrong to reverse. The panel also erred legally by embracing rules conflicting with this Court's precedent concerning written description and with the Seventh Amendment. Those errors also warrant either panel rehearing or en banc review.

ARGUMENT

I. The Panel Erred In Holding That "Any Reasonable Juror Had No Choice But To Find That The Specification Broadly Described Billions Of Compounds"

The panel's written description analysis turns on a supposedly "uncontested" premise: Plaintiffs' expert Reitz purportedly agreed that "billions of compounds are represented by [the specification's] backbone, based on the types of substituents." Op. 8 (alteration in original) (citing Appx10708). But the panel's use of brackets to change "this" to "the specification's" changes the meaning of Reitz's testimony.

This difference matters. Reitz was discussing the prior art generic prostaglandin backbone, which could accommodate substitutions at various positions (*i.e.*, substituents) to lead to billions of compounds. The specification and the claim at issue are far more limited. The '270 patent specification described a method using compounds with the prostaglandin hairpin backbone component disclosed in the Johnstone prior art patent application (shown below in red) and narrowed the potential substituents added to that known backbone down to only certain identified R^1s and Zs (shown below in blue boxes). The claimed method used only compounds with three amides at R^1 and a phenyl at Z, all of which were explicitly identified in the specification. Op. 3-4; Appx133 (4:2-3), 135 (8:9-17, 8:29-31, 8:48-53).



Appx165 (annotated). Review of the panel's citation and the record confirms that with respect to "billions," Reitz was referring to the backbone component of Johnstone—*not* the '270 patent specification. Appx10669, 10708.

The panel cited a single cross-examination exchange with Reitz to support its conclusion that he was referring to the '270 patent specification. Op. 8 (citing Appx10708). Sandoz's counsel asked Reitz: "And on [d]irect you said that billions of compounds are represented by this backbone, based on the types of substituents?" Appx10708. Reitz answered, "Yes." *Id.* The panel relied on the "Yes" answer but failed to recognize that, "on [d]irect," Reitz was addressing *not* the claimed invention but rather the backbone disclosed in the prior art.

Reitz addressed the backbone's "billions" of compounds three times on direct. First came this exchange:

> Q: Is this the broadest disclosure of the—all of the compounds in the Duke Patent?
>
> A: This is the broadest disclosure.
>
> Q: . . . Sandoz may say this broadest disclosure includes **billions** of compounds. Does that impact your opinion on written description?
>
> A: No, it doesn't. Actually, this is similar to the broadest disclosure in the Johnstone application.

Appx10669. Contrary to the panel's conclusion, Reitz did not here agree that the specification's description of the invention encompassed billions of compounds (Op. 8); rather, he noted only that the specification included a disclosure of the hairpin backbone and referenced Johnstone.

In the second exchange on direct, Reitz again explicitly referred to Johnstone:

> Many patents are written this way. . . . We look at the broad disclosure in the Johnstone application, see all of those letters down there, those are representation[s] of different parts of the molecule, and they can be very [*sic*] independently, and then taken together, and this, I would warrant, there are definitely **billions** of possible permutations.

Appx10669. Again, nothing in this testimony supports the panel's conclusion. Reitz was referring explicitly to Johnstone in describing the billions of permutations—not the '270 patent's description of its invention.

In the third exchange on direct, Reitz discussed the disclosure of possible R^1 substituents in the '270 patent:

> You know, I'm a chemist and I read these all the time. I know it can be a little daunting when you look at these lists, but **this is not where the billions of compounds come from**. These are 11 or 13, depending how you count them, functionalities; some of them can be further substituted, but I don't think it's an abnormally large list.

Appx10673. Here, Reitz expressly rejected the notion that the variability of the 11 or 13 functionalities of R^1 of the '270 patent specification resulted in "billions" of compounds.

Reitz's only remaining reference to "billions" of compounds is the cross-examination question and answer the panel cited. Appx10708. The cross-examination question referred specifically to Reitz's direct testimony ("on [d]irect you said"), and that direct testimony addressed Johnstone, not the '270 patent's description of the invention. *Id.*; Appx10669. The panel misread the testimony.

To be sure, the preceding cross-examination question referenced a demonstrative, 10.47, that itself referenced the '270 patent. Appx10708 ("I would like to go over another one of your slides, 10.47. This is another one of your slides, right?"). But to rely on this question to modify the scope of "this backbone" to mean the '270 patent specification would also be erroneous. First, a demonstrative is not evidence unless expressly entered into the record, which Sandoz failed to do. *See* Fed. R. Evid. 107. Second, the question itself does not reference the '270 patent specification. And third, the question itself contained qualifying language ("on [d]irect," "based on the types of substituents") that made

clear Reitz in answering was referring to the prior art backbone and was not accepting Sandoz's "billions" premise. *See* Appx10673, 10708. Moreover, if the record *were* ambiguous as to whether Reitz was referencing Johnstone or the '270 patent, the record then would have to be "viewed most favorably to the prevailing party"—here, Plaintiffs. *Stroup*, 26 F.4th at 1157.

The only other trial testimony referencing "billions" comes from Sandoz's expert Heathcock. But Heathcock also never suggested that the '270 patent described billions of compounds. Each reference in Heathcock's testimony to "millions" or "billions" of compounds concerns Johnstone or the variability of the Johnstone backbone component. *See*, *e.g.*, Appx10516 ("Well . . . you keep saying hairpin structure. I mean, the billions comes from all of the different variables that are allowed in that chain. It happens to have a five-membered ring in the middle of it."), 10496, 10502-04.[2] In sum: the panel's assertion that "any reasonable juror had no choice but to find that the specification broadly described billions of compounds," Op. 8, finds no support in the record.

That was not the panel's only factual error. The opinion states that Heathcock found Claim 30 to cover 1,620 compounds whereas Reitz found it to claim 4,230 compounds. *Id.* The opposite was true: *Heathcock* found it covered

[2] Plaintiffs reviewed all of Heathcock's trial testimony on this point—not only the testimony in the Joint Appendix. They did the same for Reitz. That testimony was in accord with the testimony included in the Joint Appendix and cited above.

4,320 compounds. *See* Appx10450, 10460, 10690-91, 10707. The panel also mistakenly characterized a carbon triple bond that appears in the X "linker" position of the '270 patent as a carbon double bond and suggested—without any record support—that one must choose a carbon double bond before selecting the preferred phenyl at the Z position. Op. 16 n.4; Appx135 (8:60-63).

Both of these errors warrant at least the issuance of an errata. But more is required to correct the panel's "billions" error. It was Sandoz's burden to prove the "vast discrepancy" it asserted "between the written description and the actual scope of the claim." Op. 7. The panel thought Sandoz satisfied that burden based on the supposedly undisputed fact that the specification described "billions" of compounds, which the panel believed made it impossible for the patent to have sufficiently directed a skilled artisan to the claimed invention as a matter of law. As shown above, however, that conclusion was demonstrably wrong. Written description requires *some* factual assessment of what the specification conveys as judged from the perspective of a skilled artisan. *See Immunex Corp. v. Sandoz Inc.*, 964 F.3d 1049, 1063 (Fed. Cir. 2020). Because Sandoz offered no evidence establishing the scope of the patent's disclosure relative to the claim, Sandoz could not carry its burden to show that the disclosure lacks written description of the claimed subgenus, let alone the "doubly high" burden (Op. 6) needed to overcome the jury's verdict. Rehearing is warranted.

II. The Panel's Multiple Legal Errors Independently Warrant Panel Or En Banc Rehearing Because They Contravene Existing Doctrine

A. The Panel Erred By Limiting Blaze Marks To Only "Preferred" And More Frequently Disclosed Embodiments

In three ways, the panel violated this Court's precedents by artificially restricting the expressly-listed embodiments that could constitute blaze marks.

***First*,** the panel found that Claim 30 lacked written description because amides were not among the R^1 action-end substituents listed as "preferred"—a new rule contrary to this Court's precedent. Op. 13. Blaze marks need only "guide attention to the claimed species or subgenus." *Regents of Univ. of Minn. v. Gilead Scis., Inc.*, 61 F.4th 1350, 1356, 1358 (Fed. Cir. 2023). There is no requirement that the disclosure must also highlight a claimed subgenus as *preferred* to alternative embodiments—indeed, this Court has expressly approved examining whether there are "blazemarks as to what compounds, *other than those disclosed as preferred*, might be of special interest." *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571 (Fed. Cir. 1996).[3]

The panel compounded this error by concluding that—because five of the twelve non-amide options in the specification were listed as "preferred" or "more

[3] Although the Court in *Fujikawa* found a lack of written description in part because the claimed subgenus in that case "diverge[d] from" the disclosed "preferred elements," 93 F.3d at 1571, the opinion clearly did not adopt an express rule that only preferred embodiments may serve as blaze marks, *see id.*

preferred"—those options "direct[ed] a skilled artisan *away from*, rather than toward, the claimed subgenus." Op. 13-14 (emphasis in original). No precedent has applied "teaching away" to blaze marks. Even in its obviousness analyses, where "teaching away" applies, this Court has established that labeling an embodiment as "preferred" does not teach away from other disclosed options. *See Meiresonne v. Google, Inc.*, 849 F.3d 1379, 1382 (Fed. Cir. 2017); *Syntex (U.S.A.) LLC v. Apotex, Inc.*, 407 F.3d 1371, 1380 (Fed. Cir. 2005) ("A statement that a particular combination is not a preferred embodiment does not teach away absent clear discouragement of that combination.").

***Second*,** the panel improperly focused on the breadth of disclosed embodiments *outside* of Claim 30's scope in finding a lack of written description *for* Claim 30. *See* Op. 11-12. The panel's focus on the embodiments outside the amides was error as this Court has long made clear that a specification may describe multiple claims through multiple blaze marks, and that written description must be assessed claim by claim. *See Capon v. Eshhar*, 418 F.3d 1349, 1360 (Fed. Cir. 2005); *In re Borkowski,* 422 F.2d 904, 909 n.4 (C.C.P.A. 1970) ("A disclosure may, of course, be insufficient to support one claim but sufficient to support another."). Here, even the panel acknowledged that the specification listed the three amides included in Claim 30 as one of thirteen potential R^1 paths. Op. 14. But the panel found that disclosure was overridden by the breadth of other

unclaimed paths. *See* Op. 11 ("vast number of options for C1"), 12 (noting that nine non-amide choices of the thirteen options "are categories, each requiring additional choices within them"). The panel wrongly treated the size of this broader "disclosed universe" as a basis to presume a lack of written description. Op. 8. However, the breadth of the specification's disclosure of alternatives unrelated to the choices for Claim 30 is immaterial to whether a skilled artisan would understand other disclosures in that same specification to show possession of Claim 30.

***Third*,** the panel discounted the specification's disclosure of the phenyl substituent at the Z-position—*even though it was identified as a preferred embodiment*—because other Z-position substituents appear more often. Op. 15-16. But asking whether phenyl has "the greatest number of appearances of a compound" in the Z position, Op. 16, is likewise not a test supported by this Court's precedent. Numerosity, like preference, does not determine how a skilled artisan would review the specification to evaluate possession. *See Centrak, Inc. v. Sonitor Techs., Inc.*, 915 F.3d 1360, 1366 (Fed. Cir. 2019) (specification's focus on one particular embodiment "does not necessarily mean that the inventors did not also constructively reduce to practice" other disclosed embodiments).

The jury heard testimony about how a skilled artisan would read the specification. They agreed with Reitz that the '270 patent disclosure provided

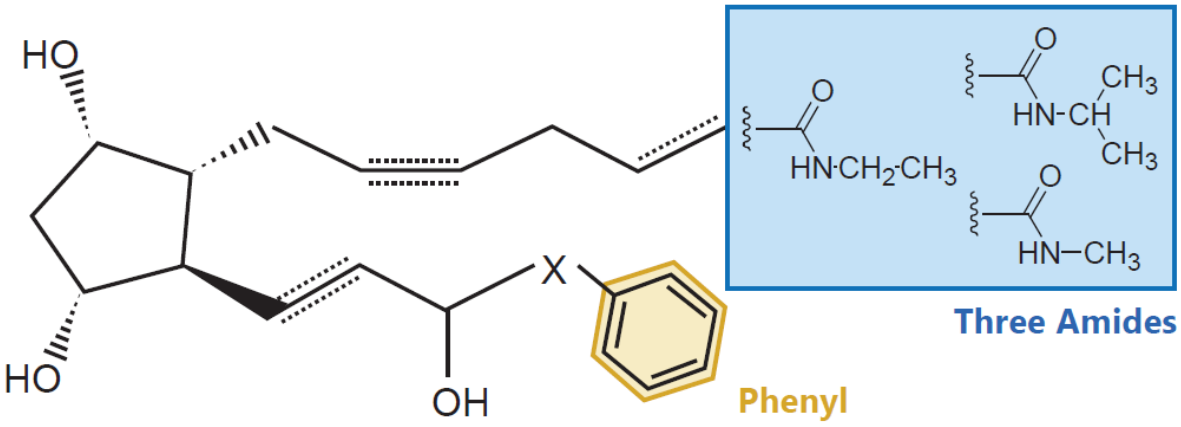
sufficient blaze marks to guide attention to Claim 30. The panel erroneously rejected that judgment—and created inconsistency and confusion in the Court's precedent—by overweighing "preferred" and more frequent embodiments and finding that they "point *away from* the combinations as recited in [C]laim 30." Op. 13 (emphasis in original).

B. The Panel Erroneously Required The Specification To Teach What The Johnstone Prior Art Had Already Disclosed

The panel found a lack of written description because "the hairpin structure does not provide sufficient guidance to account for the variation at the R^1 and Z positions." Op. 11. But the panel conflated the hairpin backbone component with the other distinct structural components, R^1 and Z, in its common-structural-features analysis. And, even as to the hairpin component itself, the prior art had disclosed that the variability there was permissible for hair growth. *See, e.g.,* Appx10531-32, 10676-78. The specification was not required to describe the prior art again to satisfy written description. *See Capon*, 418 F.3d at 1358 ("[P]recedent does not set a *per se* rule that the information [disclosed in the art] must be determined afresh.").

Claim 30 claims "[a] method of growing hair" by applying compounds with three separate components: (1) the well-known characteristic prostaglandin hairpin backbone; (2) at the end of the alpha chain, an R^1 "action end" limited to one of

three amides; and (3) at the end of the omega chain, an unsubstituted phenyl ring at the Z position. Appx164-65 (66:65-67:33, 67:44-46, 67:54); Appx11867.



Appx11867 (hairpin backbone indicated in black, R^1 group indicated in blue box, and Z group indicated in yellow hexagon).

Both experts agreed that the hairpin component is a characteristic portion of a prostaglandin recognizable to a skilled artisan and known to grow hair when paired with particular action ends. *See* Appx10486-87, 10504 (Heathcock); Appx10667, 10670, 10678 (Reitz). The hairpin backbone is distinct from the R^1 action end and the Z omega end—the three separate components that make up the invention structures. *See* Appx10480-81, 10517-18, 10522-23 (Heathcock acknowledging that $R^1$and Z are *not* part of the hairpin backbone). The experts also agreed that this generic hairpin backbone component accounts for nearly all of the variation in the '270 patent specification and that variation in the hairpin component was known in the prior art to be irrelevant to hair growth ability. *See* Appx10496, 10516, 10531-32 (Heathcock); Appx10670, 10676-78 (Reitz). The

structural diversity affecting hair growth occurs at the R^1 action end component. *See* Appx10487 (Heathcock); Appx10640 (Reitz).

This Court has confirmed that patentees may rely on what is "well-known in the art" to meet the written description requirement. *Ajinomoto Co. v. Int'l Trade Comm'n*, 932 F.3d 1342, 1359 (Fed. Cir. 2019). Where, as here, the variability in the hairpin was understood to be permissible for hair growth, that variability has no bearing on the written description of the claimed subgenus. *See Singh v. Brake*, 317 F.3d 1334, 1344 (Fed. Cir. 2003) (declaring case "simpler" because only certain subgenera were "biologically relevant"); *In re Driscoll*, 562 F.2d 1245, 1249 (C.C.P.A. 1977) (ignoring variation in substituents listed for one position when "the focus is unquestionably on the substituents at" another position that affected functionality). Only the variability of the R^1 and Z components was significant and the specification explicitly identified the choices for each.

The panel further erred by faulting Plaintiffs for failing to show how the "common structural feature" of the hairpin backbone "was unique to the claimed subgenus, as opposed to the entire genus." Op. 10-11. As noted *supra* at 10, written description requires only that the disclosure "guide attention to the claimed . . . subgenus," *Regents*, 61 F.4th at 1356, 1358, *not* that common structural features in that subgenus be "unique," Op. 10. This new "uniqueness" requirement for subgenera deviates from precedent without citing any authority for the panel's

new rule. *Id.* Whether a claim limitation is unique has no bearing on whether the inventors possessed it, which is the touchstone of written description law.

C. The Panel Placed The Burden Of Proof On The Patentee Who *Received A Favorable Verdict From* The Jury, Rather Than On The *Appellant* Who Did Not

The panel reversed the burden of proof in second-guessing the jury on a factual issue. It was Sandoz's burden to show by clear and convincing evidence that the specification failed to provide sufficient blaze marks for the subgenus of Claim 30. The jury found that Sandoz did not meet that burden. Yet the panel consistently faulted *Plaintiffs* for not presenting evidence to *prove* validity. *See* Op. 10 ("Allergan has not introduced evidence to show that a person of ordinary skill in the art would be able to 'visualize' the thousands of compounds claimed in [C]laim 30."), 14-16. The panel also applied an internally inconsistent standard, at times requiring *Plaintiffs* to justify why a skilled artisan would select non-preferred options, while elsewhere discounting expressly preferred disclosures—despite the burden being on Sandoz to prove lack of written description. Op. 14-16, 16 n.4.

The panel thus compounded its errors by placing the burden of proof on the wrong party. The panel was supposed to review the jury's factual findings only for substantial evidence. "The Federal Circuit may not substitute its judgment for the final determination of the decision maker on the ground that the court believes a contrary determination is *more reasonable* than the determination under review."

Kevin Casey et al., *Standards of Appellate Review in the Federal Circuit: Substance and Semantics*, 11 FED. CIR. B.J. 279, 308 (2002) (emphasis in original). Indeed, a court can determine that a jury's finding is clearly erroneous and yet still be constrained to find that it is supported by substantial evidence. *Id.* The panel's errors contravened the Seventh Amendment's "allocation of authority to review verdicts" and undermined Plaintiffs' jury-trial rights. *Gasperini v. Ctr. for Humans., Inc.*, 518 U.S. 415, 432 (1996).

CONCLUSION

For the foregoing reasons, this Court should grant panel rehearing or rehearing en banc.

Dated: January 20, 2026

Respectfully submitted,

/s/ *Lisa B. Pensabene*

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ADDENDUM

United States Court of Appeals for the Federal Circuit

DUKE UNIVERSITY, ALLERGAN SALES, LLC,
Plaintiffs-Appellees

v.

SANDOZ INC.,
Defendant-Appellant

2024-1078

Appeal from the United States District Court for the District of Colorado in No. 1:18-cv-00997-RM-KLM, Judge Raymond P. Moore.

Decided: November 18, 2025

JEFFREY A. LAMKEN, MoloLamken LLP, Washington, DC, argued for plaintiffs-appellees. Also represented by KAYVON GHAYOUMI, MICHAEL GREGORY PATTILLO, JR.; ELIZABETH KATHLEEN CLARKE, Chicago, IL; SARA MARGOLIS, New York, NY; LISA BARONS PENSABENE, HASSEN A. SAYEED, O'Melveny & Myers LLP, New York, NY.

WILLIAM M. JAY, Goodwin Procter LLP, Washington, DC, argued for defendant-appellant. Also represented by GABRIEL FERRANTE, New York, NY; VISHAL C. GUPTA, Steptoe LLP, New York, NY; ROBERT KAPPERS, Chicago, IL.

Before DYK, STOLL, and STARK, *Circuit Judges*.

STARK, *Circuit Judge*.

Sandoz Inc. ("Sandoz") appeals from a judgment of the U.S. District Court for the District of Colorado, holding that Sandoz failed to prove claim 30 of U.S Patent No. 9,579,270 (the "'270 patent") invalid for lack of adequate written description. We reverse.

I

Plaintiffs-appellees Duke University and Allergan Sales, LLC (collectively referred to herein as "Allergan") together own all rights in the '270 patent and certain related patents. The '270 patent issued in 2017 and has a priority date of 2000. It is entitled, "Compositions and Methods for Treating Hair Loss Using Non-Naturally Occurring Prostaglandins," and relates generally to treating hair loss using compositions containing prostaglandin F ("PGF") analogs. '270 pat. abstract.

As the district court explained:

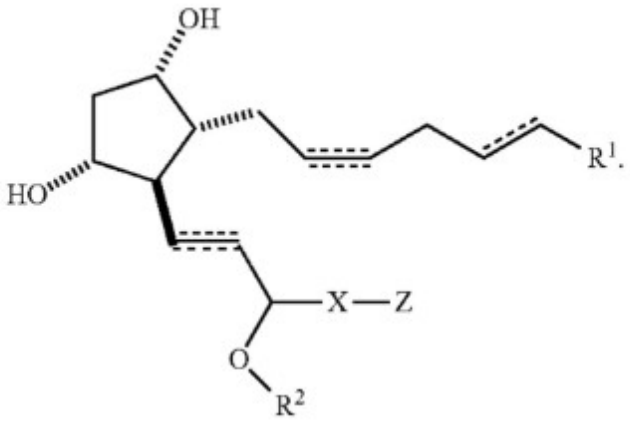
> The '270 Patent describes a method for growing hair by topically applying a chemical compound known as a prostaglandin. Prostaglandins are molecules that bind to certain receptors on cells in a living body and change how such cells function. The human body produces a variety of prostaglandins; the general type at issue here is known as prostaglandin F or PGF. Within the general category of PGF are many variants, some naturally-occurring and some synthesized. These variants are referred to as PGF analogs. Analogs differ from one another by virtue of various molecules that can attach to [the] base structure of the prostaglandin and which change its pharmacological properties. For example, the prostaglandin is much like a

> charm bracelet to which different charms can be attached at different points.

J.A. 5-6.

At issue in this appeal is claim 30 of the '270 patent. When read together with claims 17, 24, and 25, from which it depends, claim 30 recites:

> A method of growing hair, wherein the method comprises topically applying to mammalian skin a safe and effective amount of a composition comprising:
>
> . . . an active ingredient selected from the group consisting of a prostaglandin F analog of the following structure:



> and pharmaceutically acceptable salts thereof;
>
> wherein R^1 is C(O)NHR^3 [i.e., an amide];
>
> R^2 is a hydrogen atom;
>
> R^3 is methyl, ethyl, or isopropyl;
>
> X is selected from the group consisting of —C≡C—, a covalent bond, —CH=C=CH—, —CH=CH—, —CH=N—, —C(O)—,

> —C(O)Y—, and —$(CH_2)_n$—, wherein n is 2 to 4;
>
> Y is selected from the group consisting of a sulfur atom, an oxygen atom, and NH;
>
> and Z is phenyl.

'270 pat. at 66:65-67:54.

Allergan markets Latisse®, an FDA-approved topical solution for treatment of eyelash hair loss by stimulating hair growth. J.A. 10078-79. Latisse® consists of a 0.03% bimatoprost ophthalmic solution. J.A. 16. Bimatoprost is a PGF analog with an ethyl amide at its action end (the "C1 end" or "C1 location" and also known as the "R^1" position), and phenyl at the omega end, which is also referred to as the "Z" position.[1]

Sandoz manufactures and sells a generic version of Latisse®. In 2018, Allergan sued Sandoz, alleging its generic drug product infringes claim 30 of the '270 patent. J.A. 77. Sandoz stipulated to infringement but challenged the validity of the claim. J.A. 1-2, 7783.

During a five-day jury trial, Sandoz attempted to prove that claim 30 of the '270 patent is invalid for lack of adequate written description. In support of its contention, Sandoz presented the testimony of its expert, Dr. Clayton Heathcock. Dr. Heathcock opined that claim 30 lacks sufficient written description because "the Claim describes over 4,000 compounds that can cause hair to grow" but does not identify "a single" specific embodiment of the claim in the specification or disclose sufficient common structural features of the compounds encompassed by the claim. J.A. 10448-56. Allergan countered Sandoz's evidence with

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[1] Like the parties, we use C1 position and R^1 interchangeably throughout this opinion. We do the same for omega end and Z.

testimony from its own expert, Dr. Allen Reitz, who opined that the '270 patent "adequately describes the use of amides for growing hair . . . with three types of prostamides with a phenyl ring at the end of the omega chain." J.A 10679.

The jury found Sandoz had failed to prove that claim 30 was invalid for obviousness, lack of enablement, or lack of adequate written description and awarded Allergan $39 million in infringement damages. J.A. 8514-15. Sandoz filed a motion for a new trial and for judgment as a matter of law, both of which the district court denied. J.A. 37-50. Sandoz timely appealed. The district court had jurisdiction under 28 U.S.C. § 1338(a), and we have jurisdiction pursuant to 28 U.S.C. § 1295(a).

II

When a district court denies a motion for judgment as a matter of law, we review its decision under the law of that court's regional circuit. *See Promega Corp. v. Life Techs. Corp.*, 875 F.3d 651, 659 (Fed. Cir. 2017). This case arises out of the Tenth Circuit, which applies de novo review to a district court's denial of a motion for judgment as a matter of law. *See Stroup v. United Airlines, Inc.*, 26 F.4th 1147, 1156 (10th Cir. 2022). Thus, "a district court's refusal to grant judgment as a matter of law may be reversed only if the evidence is such that without weighing the credibility of the witnesses the only reasonable conclusion is in the moving party's favor." *Id.* (quoting *Elm Ridge Expl. Co., LLC v. Engle*, 721 F.3d 1199, 1216 (10th Cir. 2013) (internal brackets and quotation marks omitted).

Whether a patent provides adequate written description for a claim presents a question of fact. *See Gen. Hosp. Corp. v. Sienna Biopharmaceuticals, Inc.*, 888 F.3d 1368, 1371 (Fed. Cir. 2018). That question is whether the patent specification discloses that a person of ordinary skill in the art would conclude "the inventor possesse[d] the full scope of the invention" at the time of their patent application.

LizardTech, Inc. v. Earth Res. Mapping, Inc., 424 F.3d 1336, 1345 (Fed. Cir. 2005); *see also* 35 U.S.C. § 112(a) ("The specification shall contain a written description of the invention . . . ."); *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.,* 541 F.3d 1115, 1124 (Fed. Cir. 2008) ("[T]o satisfy the written description requirement for a claimed genus, a specification must describe the claimed invention in such a way that a person of skill in the art would understand that the genus that is being claimed has been invented, not just a species of the genus."). Like all invalidity defenses, lack of written description must be proven by clear and convincing evidence. *See Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 682 (Fed. Cir. 2015). Thus, Sandoz's "burden on appeal is doubly high," as it "must show that no reasonable jury could have failed to conclude that [its] case had been established by clear and convincing evidence." *Boehringer Ingelheim Vetmedica, Inc. v. Scherling-Plough Corp.*, 320 F.3d 1339, 1353 (Fed. Cir. 2003).

III

While Sandoz raises multiple issues on appeal,[2] we need address only one: its contention that the district court should have granted judgment as a matter of law that claim 30 of the '270 patent is invalid for lack of adequate written description. Sandoz argues that claim 30 covers the use of a specific subgenus of PGF analogs to grow hair, but that the specification fails to show a skilled artisan that

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[2] Sandoz's other principal arguments on appeal are that Allergan should have been collaterally estopped from litigating its obviousness defense due to prior decisions of this court, that the district court's instruction to the jury on teaching away was prejudicially flawed, and that claim 30 was not enabled. Because we have determined that claim 30 is invalid, *infra*, we need not resolve these additional issues.

the inventors were in possession of that full subgenus, including the specific embodiment at issue in this litigation, bimatoprost. According to Sandoz, the specification does not provide a single example of an actual compound claimed by claim 30 and also fails to identify sufficient commonalities of structure to provide a skilled artisan with the necessary "blaze marks" to lead them to the claimed compounds. Because we agree with Sandoz that no reasonable juror could have found that Sandoz failed to prove, by clear and convincing evidence, that claim 30 lacks adequate written description, we reverse the district court's judgment.

The written description requirement "reflects the basic premise of the patent system[:]" an inventor may "obtain[] a patent" only if she "discloses [the] invention" to the public, in sufficient enough detail that a person of ordinary skill in the art will understand that the inventor truly "possessed the invention as claimed." *Regents of the Univ. of Minn. v. Gilead Scis., Inc.*, 61 F.4th 1350, 1355 (Fed. Cir. 2023). "The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not." *Id.* (quoting *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (internal quotation marks omitted).

Sandoz contends that the specification of the '270 patent is written so broadly that it encompasses a "universe of billions of compounds," while claim 30 is limited to roughly 1,620 of these potential compounds. According to Sandoz, the patent fails to provide skilled artisans with the information they need to identify and obtain this subgenus of claimed compounds. Based on the vast discrepancy between the written description and the actual scope of the claim, Sandoz continues, the pertinent artisan would conclude that the named inventors did not actually possess the invention claimed in claim 30.

Certain premises underlying Sandoz's written description contentions are uncontested. Allergan's expert, Dr. Reitz, agreed at trial that the specification is written in such a manner – with multiple open positions on its chemical structure, each of which could be filled in various ways – that it could encompass billions of compounds. *See* J.A. 10708 (Dr. Reitz agreeing "billions of compounds are represented by [the specification's] backbone, based on the types of substituents"). Experts for both sides agreed that the number of compounds actually claimed by claim 30 is far smaller: either 4,230, which was Allergan's expert's view, or 1,620, as Sandoz's expert opined. J.A. 10676, 10690-91, 10707. Thus, any reasonable juror had no choice but to find that the specification broadly described billions of compounds, while claim 30 was directed to between just 1,620 and 4,230 of such compounds. In order to have adequate written description, the specification of the '270 patent needs to allow a skilled artisan to understand how to identify this subgenus of claimed compounds.

We have considered similar patents with some frequency. As we have previously held:

> Written description of an invention claimed as a genus of chemical compounds, as here . . . requires description not only of the outer limits of the genus but also of either a representative number of members of the genus or structural features common to the members of the genus, in either case with enough precision that a relevant artisan can visualize or recognize the members of the genus.

Regents, 61 F.4th at 1356; *see also Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1350-52 (Fed. Cir. 2010). In other words, the specification must provide sufficient indication as to how a skilled artisan would narrow the disclosed universe of billions of compounds described in the specification to the subset of just 1,620-4,230 compounds actually claimed.

Based on the evidence introduced at trial, no reasonable juror could find anything other than clear and convincing evidence that the '270 patent fails to describe either (i) a representative number of species of claim 30's subgenus or (ii) structural features common to all members of that subgenus. Allergan does not even argue that the patent satisfies the first of these alternatives, since the '270 patent does not expressly disclose even a single embodiment of claim 30. *See, e.g.*, '270 pat. at col. 8 (showing that only disclosed embodiment containing C(O)NHR^3 at C1 end and phenyl in Z position does not contain methyl, ethyl, or isopropyl in R^3 position, thus falling outside of claim 30); *see also* J.A. 7939 (jury instruction, which was limited to common structural features test); J.A. 10743-47 (parties discussing whether jury should be instructed on representative number instruction, with court stating "there's been no evidence that this . . . theory" applies.).

Allergan solely relies on the proposition that the patent nonetheless sufficiently discloses structural features common to all members of the claimed subgenus. To meet the written description requirement in this manner, the patent must "provide sufficient blaze marks" to direct a skilled artisan to the claimed subgenus. *Regents*, 61 F.4th at 1356-58. That is, the specification must "provide[] adequate direction which reasonably would lead persons skilled in the art to" the compounds actually claimed in claim 30. *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570 (Fed. Cir. 1996) (internal brackets and quotation marks omitted).

Allergan insists that the specification of the '270 patent satisfies this common-structural-features test because it discloses three features that are common to all members of the claimed subgenus: "[i] the characteristic prostaglandin hairpin, [ii] . . . with amides at the C1 position . . . [iii] connected to the unsubstituted phenyl ring at the omega [action] end." Ans. Br. at 49 (bracketed numerals added). No reasonable juror could agree.

As we explain in more detail below, the '270 patent, at best, discloses two prostaglandin hairpin structures and a menu of available atoms, moieties, and functional groups from which a skilled artisan could populate the R^1, R^2, R^3, R^4, X, Y, and Z positions of those structures. '270 pat. at 7:34-8:67. Under our precedent, this is inadequate. *See, e.g.*, *In re Ruschig*, 379 F.2d 990, 995 (CCPA 1967) (finding inadequate written description where specification leaves skilled artisan needing "to select[] from the myriads of possibilities encompassed by the broad disclosure, with no guide indicating or directing that th[e] particular selection[s] should be made rather than any of the many others which could also be made").

Start with the prostaglandin hairpin. It was undisputed at trial that this is a "generic" feature. *See* J.A. 10670 (Allergan's Dr. Reitz); J.A. 10574 (Sandoz's Dr. Hla); J.A. 10486 (Sandoz's Dr. Heathcock: "That's the basic carbon skeleton of all prostaglandins."). Both parties' experts agreed that the specification discloses a characteristic prostaglandin hairpin structure shared by all compounds disclosed in the specification. *See* J.A. 10517-18 (Dr. Heathcock agreeing specification contains "a characteristic backbone . . . with an R group attached at C1"); J.A. 10670 (Dr. Reitz explaining prostaglandin has "characteristic hairpin turn, including the linker," with R^1 being "the important position"); J.A. 10668 (Dr. Reitz describing hairpin as "common"). Billions of compounds contain this generic hairpin structure. J.A. 10708 (Dr. Reitz testifying that "billions of compounds are represented by th[e] backbone"). Allergan failed to identify how this common structural feature was unique to the claimed subgenus, as opposed to the entire genus described in the specification. Thus, Allergan has not introduced evidence to show that a person of ordinary skill in the art would be able to "visualize" the thousands of compounds claimed in claim 30, from among the billions of prostaglandin compounds described

in the specification, based on the written description of the widely shared hairpin structure.

Second, the hairpin structure does not provide sufficient guidance to account for the variation at the R^1 and Z positions. A reasonable juror would necessarily have found that the specification fails to provide sufficient blaze marks with respect to the C1 position. Allergan argues that "the specification undisputedly discloses *only 13 options* for [this] action end," with one of those options being the claimed amide, $C(O)NHR^3$. Ans. Br. at 51 (emphasis in original). But the characterization of the specification's disclosures for C1 as containing merely "13 options" is not correct, as most of the 13 options are themselves large categories within which numerous options exist. In reality, the specification's guidance with respect to the C1 position resembles a path with 13 branches, and most of those branches lead to additional branches, yielding in the end a vast number of options for C1.[3]

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[3] Allergan insists that Sandoz's expert, Dr. Heathcock, "agreed that the specification discloses only 13 possibilities for the action end, one of which is an amide." Ans. Br. at 17 (citing J.A. 10518-19) (internal quotation marks omitted); *see also id.* at 55 (asserting that "[Dr.] Heathcock repeatedly conceded" this point). No reasonable juror could have found that Dr. Heathcock admitted the 13 options listed are *only 13* and do not have embedded within them additional options. At no point, even in the cross-examination highlighted by Allergan, did Dr. Heathcock testify there are "only" 13. To the contrary, he consistently made clear that while he could visualize each of the "functional groups" listed for R^1 (i.e., C1), he further explained that it "would be hard, because there's so much variety with the Rs." J.A. 10519; *see also* J.A. 10520 (Allergan counsel acknowledging Dr. Heathcock "said there's variability in these– in each one of these 13").

In particular, the specification teaches:

> R^1 is selected from the group consisting of [1] C(O)OH, [2] C(O)NHOH, [3] $C(O)OR^3$, [4] CH_2OH, [5] $S(O)_2R^3$, [6] $C(O)NHR^3$, [7] $C(O)NHS(O)_2R^4$, [8] tetrazole, [9] a cationic salt moiety, [10] a pharmaceutically acceptable amine or [11] ester comprising 2 to 13 carbon atoms, and a [12] biometabolizable amine or [13] ester comprising 2 to 13 carbon atoms.

'270 pat. at 8:9-15 (internal numbering added). A skilled artisan would understand that only four of these 13 options (C(O)OH, C(O)NHOH, CH_2OH, and tetrazole) are singular items; the other nine options are categories, each requiring additional choices within them. Thus, selecting one of Allergan's "13 options" would, for nine of the branches on the path, be merely the first decision an artisan would need to make before having to make other decisions just to determine what to place at C1.

For example, one of the patent's disclosed options (number [3] above) is $C(O)NHR^3$. The inclusion of the substituent R^3 as a component of this option requires a further choice to be made (after choosing $C(O)NHR^3$ from among the 13 options for C1), because the specification discloses no fewer than 12 further *categories* from which the artisan must select to fill the R^3 position. *See* '270 pat. at 8:10-17; *see also id.* at 5:22-36 (defining one of the 12 categories, the "heterogenous group," as "a saturated or unsaturated chain containing 1 to 18 member atoms," which may be straight or branched in multiple spots, with or without (double and triple) bonds). Hence, even assuming a person of ordinary skill chose $C(O)NHR^3$ from among the "13 options" for C1, just to fill in the C1 position she would still have to (i) select 1 of 12 categories for the R^3 position, and then (ii) select a specific molecule from whichever category of those 12 she chose. While Dr. Reitz told the jury "any ordinary chemist could look at the functional groups, understand what's

intended, understand permutations that could result," J.A. 10670, and therefore might know not to pursue every one of the possible combinations the specification allows to be placed at C1 and its R^3 component, the incontestable fact is that the specification describes far more than just "13 options" for C1.

And as we have previously held: "Following [such a] maze-like path, each step providing multiple alternative paths, is not a written description of what might have been described if each of the optional steps had been set forth as the only option." *Regents*, 61 F.4th at 1357. Or, as we have similarly put it, "one cannot disclose a forest in the original application, and then later pick a tree out of the forest and say 'here is my invention.'" *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1326 (Fed. Cir. 2000). Instead, satisfaction of the written description requirement with a patent like the '270 patent requires disclosure of sufficient "blaze marks directing the skilled artisan to that tree." *Id.*; *see also Regents*, 61 F.4th at 1356. The specification does not do so, and therefore fails to adequately direct the skilled artisan to the proper selection at the C1 position in order to arrive at the subgenus of compounds claimed by claim 30.

Furthermore, the only blaze marks provided by the specification for this C1 selection point *away from* the combinations as recited in claim 30. A specification's description of "preferred embodiments do[es] blaze a trail through the forest." *Fujikawa*, 93 F.3d at 1571. The specification of the '270 patent calls out five of its 13 options for C1 as either "prefer[red]" or "more prefer[red]." '270 pat. 8:10-18. Notably, however, those five do *not* include $C(O)NHR^3$, which is the option a skilled artisan would need to choose to reach the claimed invention. This means that the "preferred" and "more preferred" blaze marks direct a skilled artisan *away from*, rather than toward, the claimed subgenus, which would again lead the artisan to conclude the inventors did not actually possess what they claimed. *See*

generally J.A. 10454 (Dr. Heathcock opining that specification describes carboxylic acid and esters as more preferred and does not note any preference for C1-alkylamides like bimatoprost).

If a skilled artisan were to ignore these blaze marks preferring five of the other "13 options" for C1, and remain on the nonpreferred C(O)NHR^3 path, the specification then provides help by teaching that R^3 in this group is "preferably . . . selected from the group consisting of methyl, ethyl, and isopropyl," '270 pat. at 8:30-31. But Allergan has not identified any persuasive reason why an artisan who ignored the first set of blaze marks, effectively directing her away from C(O)NHR^3, would then follow the blaze marks given for the R^3 location of this non-preferred group.

In a final effort to identify part of the written description that would assist an ordinarily skilled artisan at the C1 position, Allergan points to portions of the specification that teach methods for compound synthesis, including four examples of synthesizing compounds containing amides. Allergan argues this discussion would steer a skilled artisan to the placement of an amide at C1, and therefore direct that artisan to the right choice, C(O)NHR^3, out of the alleged "13 options" elsewhere called out (which we addressed above) as available for C1. *See* J.A. 10673-74 (Dr. Reitz testifying that specification points to amides at C1 because of their mentions in description of synthesis process); J.A. 10451 (Dr. Heathcock agreeing these disclosures are in specification); *see also* J.A. 10525 (Dr. Heathcock: "They definitely say [in the patent] that you can make an amide, but they didn't really give any explicit instructions on how to do that, although they did for sulfonamide."). In each of the four synthesis schemes disclosed, however, C1 can be any of the same variants listed above – that is, any of the "13 options," nine of which are categories requiring further embedded choices – but one ends up with an amide only if one selects option number six from that list, C(O)NHR^3. And while the syntheses described as

Formulas I and III of the specification call out amides as examples of the optional C1 manipulation, even these formulas do not indicate that amides should be preferred at C1. Moreover, Allergan's expert, Dr. Reitz, admitted that two specific examples provided in the synthesis schemes, which use sulphonamides or hydroxamic acid, are not within the scope of the '270 patent's claims. J.A. 10696-97.

Finally, we turn to Allergan's arguments about what the specification describes at the Z position. Claim 30's compounds require a phenyl group at Z. J.A. 10675. While Allergan contends that "the specification discloses only eight categories of options for Z, and . . . expresses a preference for phenyl," Ans. Br. at 55, in fact the specification makes clear that (as with C1) each of these eight categories requires additional embedded choices:

> Z is selected from the group consisting of a carbocyclic group, a heterocyclic group, *an aromatic group*, a heteroaromatic group, a substituted carbocyclic group, a substituted heterocyclic group, a substituted aromatic group, and a substituted heteroaromatic group.

'270 pat. at 8:48-53 (emphasis added). While the specification does identify phenyl as the most preferred aromatic group, *see id.* at 4:2-3, this guidance is only pertinent once the artisan selects an aromatic group from among the eight initially described options, which nothing in the specification directs such an artisan to do. *See* J.A. 10675 (Dr. Reitz opining that *when* "Z is selected from an aromatic group," a skilled artisan "would know that a phenyl is [an] aromatic group" and "the most preferred aromatic group is

phenyl," but not identifying a reason why an artisan would select an aromatic group in the first place).[4]

Allergan's argument that "at least ten of the patent's example compounds employ unsubstituted phenyl at the omega end," Z, Ans. Br. 52, does not overcome these problems. The specification lists 95 example compounds and gives no reason to prefer the ten examples containing phenyl. Ten is not even the greatest number of appearances of a compound at the omega end; flurobenzene is used at Z in 18 of the 95 example compounds disclosed in the patent.

Thus, even accepting that the specification guides a skilled artisan towards the hairpin structure, leaving only variability at the C1 and Z ends to be navigated, the specification does not provide sufficient "blaze marks" to guide a skilled artisan to a PGF analog with an amide at the C1 position and a phenyl at the Z position, which are both required elements of the compounds comprising claim 30's subgenus. To the contrary, as in *Fujikawa*, 93 F.3d at 1571, the specification of the '270 patent does not "direct one to the proposed tree in particular, and does not teach the point at which one should leave the trail to find it." Instead, the specification may only reasonably be viewed as a mere "'laundry list' disclosure of every possible moiety for

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[4] The specification further recites a preference for Z being selected from among a "group consisting of furanyl, thienyl, and phenyl." '270 patent at 4:59-63. However, for that blaze mark to be pertinent to the skilled artisan, she would need to have already chosen a —C=C— bond for the X position. *See id.* at 8:54-63. Such a —C=C— bond is just one of as many as 15 options for X, *see id.* at 8:41-47; and it is the only one that if selected contains a blaze mark pointing to phenyl. Therefore, the skilled artisan must first reach a conclusion regarding X, the linker, before the specification may, but in most cases will not, prompt her to prefer phenyl.

every possible position," making it inadequate to satisfy the written description requirement of 35 U.S.C. § 112(a). *See id.*

Thus, this is a case in which the appellant has overcome the doubly high burden of persuading us to overturn a jury verdict of no invalidity. The multiple, branching paths of the '270 patent's specification are clear on the face of the patent, were explained in detail by Sandoz's expert, and their existence was not disputed by Allergan's expert. Given our precedent, any reasonable juror would have found, by clear and convincing evidence, that a person of ordinary skill in the art, reviewing the specification of the '270 patent, would be unable to visualize or recognize the members of the subgenus claimed by claim 30 based upon the specification's disclosures. The specification fails to provide the relevant artisan with sufficient blaze marks or structural commonalities among the claimed compounds to lead her to conclude that the inventor actually possessed the claimed invention.

Therefore, we reverse the judgment of the district court that claim 30 is not invalid for lack of a written description. *See, e.g.*, *BASF Plant Sci., LP v. Commonwealth Sci. & Indus. Rsch. Org.*, 28 F.4th 1247, 1269 (Fed. Cir. 2022) (reversing judgment of adequate written description where "jury had no reasonable basis to reject [accused infringer's] evidence . . . of inadequate written-description support"); *Idenix Pharms. LLC v. Gilead Scis. Inc.,* 941 F.3d 1149, 1164 (Fed. Cir. 2019) (reversing same where patent "fail[ed] to provide sufficient blaze marks to direct a POSA to the specific subset" of claimed compounds).

IV

We have considered Allergan's remaining arguments with respect to written description and find them unpersuasive. Accordingly, for the reasons set out above, we conclude that no reasonable factfinder, taking the evidence in the light most favorable to Allergan, could have found

anything other than clear and convincing evidence that claim 30 of the '270 patent is invalid for lack of adequate written description. The judgment of the district court is reversed.

REVERSED

CERTIFICATE OF COMPLIANCE

I hereby certify that the foregoing petition complies with the relevant type-volume limitations of the Federal Rules of Appellate Procedure and Federal Circuit Rules because it has been prepared in a proportionally spaced typeface in 14-point font and includes 3,675 words, excluding the parts exempted under the Rules.

January 20, 2026

/s/ *Lisa B. Pensabene*
Lisa B. Pensabene