

Professional Perspective

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Presenting Working & Prophetic Examples in Patent Applications

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On July 1, 2021, the U.S. Patent and Trademark Office (USPTO) issued a notice related to properly presenting working and prophetic examples in patent applications. The notice provided guidance regarding distinguishing between working examples and prophetic examples that are commonly found in U.S. patent applications. As outlined in the notice, distinguishing between these different types of examples is important in meeting the written description and enablement requirements, and complying with the duty of disclosure requirement.

This article will provide an overview of examples that are commonly found in U.S. patent applications, details of how examples are used to meet the written description and enablement requirements, how to comply with the duty of disclosure requirement when presenting examples, and ways of distinguishing between working and prophetic examples.

Examples in Patent Applications

In general, an example relates to a specific embodiment of an invention, which is often a description of an experiment. There are two general categories of examples: working examples and prophetic examples. Working examples relate to work that has already been performed. In particular, working examples often describe experiments that have previously been conducted, as well as results actually obtained from those experiments.

In contrast, prophetic examples describe experiments that have yet to be performed. They are often presented in a manner that predicts future results if the experiment were to be performed as described. However, prophetic examples do not require a guarantee of any particular result.

Meeting Written Description & Enablement Requirements

Examples are not required in a patent application. However, U.S. courts have held that examples can be used as a means to help satisfy the written description and enablement requirements, and so they are often used in applications. In other words, examples can be used to show that the applicant had possession of the invention at the time of filing—the threshold to meet the written description requirement—and to provide adequate guidance to a person of skill in the art regarding how to make and use the claimed invention, without undue experimentation—the threshold to meet the enablement requirement.

Art fields that are considered unpredictable, such as the biological and chemical arts, often include examples in their applications. In particular, these art fields will use examples to disclose results, which can prove that the claimed invention functions as expected—i.e., to show possession of the invention as a way to meet the written description requirement—and/or provide adequate guidance to a person of skill as to how to use the claimed invention without undue experimentation—i.e., enable the claimed invention.

In most circumstances, when an applicant uses examples to help meet the written description and enablement requirements, the USPTO does not question the disclosure of results. However, questions can arise if a prophetic example suggests or implies that its results are actual results based on experiments already performed instead of predicted results based on experiments that have yet to be performed. When this occurs, the adequacy of the disclosure can be called into question.

Under such circumstances, it is possible that patent claims could be rejected as a result of prophetic results being presented as actual results. This could occur because the applicant is relying on the results described in the examples to provide adequate support for the claims. In other words, the applicant is relying on the examples to meet either or both the written description and enablement requirements.

If it is determined that the results are not actual results, then the claim may no longer be adequately supported. In these circumstances, it may be possible for an applicant to overcome such a rejection through post-filing evidence that provides the results of an actual experiment that has been conducted.

Complying With Duty of Disclosure in Presentation of Examples

As mandated by the USPTO and relevant case law, the duty of disclosure requires that each individual associated with the filing and prosecution of a patent application has a duty of candor when dealing with the USPTO. The presentation of a prophetic example can implicate this duty of candor if the example implies or suggests that the experiments presented are actual experiments, instead of experiments that have yet to be performed.

In particular, it is possible that presenting prophetic results as actual performed experiments could raise inequitable conduct issues. Specifically, courts have found, in certain instances, that an applicant committed fraud when the applicant knowingly asserted that an actual result was obtained when, in fact, the experiment was not actually conducted. See, e.g., *Apotex Inc. v. UCB, Inc.*, 763 F.3d 1354, 1362 (Fed. Cir. 2014).

Thus, the notice makes clear that applicants should avoid inaccurate or misleading statements in their patent disclosures, which includes presenting prophetic examples as actual experiments. In particular, making clear that a prophetic example relates to work that has yet to be performed may avoid raising issues with an applicant's duty of disclosure. Ultimately, the USPTO and the public should be able to rely on the patent disclosure, which includes the prophetic examples, as being accurate.

Distinguishing Between Working and Prophetic Examples

To avoid any ambiguity in the presentation of working and prophetic examples, the notice mentioned some practices that applicants may want to consider. One potential way to avoid ambiguity is to not use past tense language in prophetic examples. Instead, future tense language can be used. Future tense language indicates that the experiments described in the prophetic example has yet to be performed. Past tense language can be used to describe working examples, which indicates that the experiments described in the example have already been performed. Notably, use of past tense language in prophetic examples has, in certain circumstances, raised issues of inequitable conduct.

Another potential way to avoid ambiguity is to separate working examples from prophetic examples in the patent disclosure. In other words, the disclosure could provide separately labeled sections for the working examples and the prophetic examples. Alternatively, or in conjunction with providing separate sections, working examples and prophetic examples could be individually labeled as “working” and “prophetic.”

In general, it should be clear in the presentation of prophetic examples that they are describing experiments that have yet to be performed.

The notice issued by the USPTO makes clear that properly distinguishing between working examples and prophetic examples in patent applications can be important in complying with the written description and enablement requirements, and can implicate issues with the duty of disclosure requirement. Accordingly, applicants are well-advised to practice due care to avoid inaccurate or misleading statements when presenting examples.