Jepson Claims No Substitute for Written Description in Patents

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Federal Circuit Holds That the Preamble of *Jepson*-Style Claims Must Be Supported by an Adequate Written Description

U.S. patent claims have a preamble, and, in most cases, the preamble is not limiting.[1] *Jepson*-style patent claims, however, do typically have a limiting preamble.[2] In *Jepson*-style claims, the preamble can be used to describe the "conventional or known" elements or steps, followed by a transition phrase such as "wherein the improvement comprises" and then an identification of the elements that "the applicant considers as the new or improved portion."[3] In other words, the preamble can first recite the prior art and then claim an improvement over the prior art.[4]

In *In re Xencor, Inc.* ("*Xencor*"), the Federal Circuit recently held that the preamble in a *Jepson*-style patent claim must be supported by an adequate written description even though there is an implied admission that most, if not all, of the preamble is known, prior art.[5] *Xencor* is important because it precludes the use of *Jepson*-style claims to expand the scope of the written description contained in the patent specification by simply including additional information in the preamble and, thereby, implicitly asserting that the new information is well-known in the art. This is particularly significant for the so-called unpredictable arts, such as the life sciences and chemistry, where the written description requirements are often more stringent.[6]

In *Xencor*, the Federal Circuit considered whether the preamble of a *Jepson*-style claim must also meet the written description requirement for patents.[7] Under 35 U.S.C. § 112(a), the specification of a patent must "contain a written description of the invention."[8] To satisfy the written description requirement of § 112(a), "the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed."[9]

On March 13, 2025, in *Xencor,* the Federal Circuit rejected the patent applicant's argument that because the "invention" in a *Jepson* claim is the improvement, only the improvement, and not the prior art in the preamble, needed sufficient written description.[10] Rather, the Federal Circuit held that the preamble in a Jepson claim requires an adequate written description.[11] In other words, "the applicant must establish that what is claimed to be well-known in the prior art is, in fact, well-known in the prior art."[12]

In reaching this conclusion, the Federal Circuit explained that when the *Jepson* format is used, the preamble defines the claimed invention and limits the scope of the claims.[13] Although a *Jepson* claim is directed to the improvement made to the prior art, the Federal Circuit further explained that "the claim is a singular thing and cannot be separated; its totality is what must have written description support, which necessarily includes support sufficient to lead an ordinary artisan to understand that the inventor did, indeed, possess what the patent contends was in the prior art."[14] According to the Federal Circuit, "[a] patentee cannot be permitted to use a Jepson claim to avoid the requirement that she be in possession of the claimed invention simply by asserting something is well-known in the art."[15]

The Federal Circuit further explained that "[t]he amount and content of the disclosure that is necessary to supply an adequate written description will vary depending on factors including the level of knowledge of the person of ordinary skill in the art, the unpredictability of the art, and the newness of the technology."[16] As with all written description inquiries, the finder of fact conducting a written description inquiry for a Jepson claim may consider not only the

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disclosures in the patent itself, but also evidence outside the patent in order to understand what a person of ordinary skill in the art would have known.[17]

The patent application at issue in *Xencor* was related to modifying antibodies with certain amino acid substitutions in order to provide for longer staying power in the body and reduce the need for more frequent treatment.[18] The application included a *Jepson*-style claim for an improvement of "a method of treating a patient by administering an anti-C5 antibody with an Fc domain."[19] However, an appellate review panel ("ARP") and administrative review board ("Board") both determined that the limitation in the *Jepson* preamble, the anti-C5 antibodies, was not well-known in the art and the specification did not otherwise contain an adequate written description to support it.[20] As noted by the ARP, "[t]the Specification does not describe what patients with what diseases or conditions can be successfully treated with an anti-C5 antibody. Nor is there a single working example describing treatment of patients with a disease or condition with an anti-C5 antibody possessing the claimed Fc modifications."[21] Ultimately, the Federal Circuit affirmed the ARP's and the Board's rejection of the *Jepson* claim as unpatentable for lack of written description.[22]

Even before *Xencor*, *Jepson*-style claims were infrequently used in U.S. patent applications. Following *Xencor*, the *Jepson* format may still prove beneficial in a few specific, limited circumstances. For example, a *Jepson*-style claim can be used to distinguish one claimed invention from another, particularly when seeking to overcome, or prevent, a double patenting rejection for a similar invention. Likewise, use of the *Jepson* format is common in some foreign countries, so U.S. applications that originate outside the United States sometimes include *Jepson* claims.

Jepson-style claims, however, have several disadvantages. In contrast to the general rule, the preamble of a Jepson claim is not only limiting, but *Xencor* now also requires an adequate written description to support it.[23] In addition, use of the *Jepson* format is often taken as an implied admission that the previous invention described in the preamble is prior art.[24] While the implied admission can be rebutted, this typically occurs only when the *Jepson* format was used to avoid a double patenting rejection in a co-pending application.[25]

These potential disadvantages, including the new written description requirement for the preamble, should be considered by a practitioner when deciding whether to draft a claim using the *Jepson* format. The *Xencor* decision makes it clear that including a limitation in the preamble of a Jepson-style claim does not automatically mean that it is well-known in the art. Instead, patent practitioners should ensure that there is adequate support to satisfy the written description requirement for the preamble of a *Jepson*-style claim, either in the patent itself or through extrinsic evidence that conclusively establishes the knowledge of a person of ordinary skill in the art.

If you have any questions about the impact of *Xencor* or patent issues more generally, please contact your Miller Canfield attorney or the authors of this alert.

[1]*E.g., Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1358-59 (Fed. Cir. 2010) (quoting *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1346 (Fed. Cir. 2002)). Nonetheless, a preamble may limit a claim "if it recites essential structure or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim." *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 2839 F.3d 801, 808 (Fed. Cir. 2001) (quoting *Piney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)).

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[2] *E.g., Catalina Mktg. Int'l, Inc.*, 289 F.3d at 808 ("Jepson claiming generally indicates intent to use the preamble to define the claimed invention, thereby limiting claim scope").

[3] *Artic Cat Inc. v. GEP Power Prods., Inc.*, 919 F.3d 1320, 1330 (Fed. Cir. 2019) (quoting 37 C.F.R. § 1.75(e)). This practice was approved in *Ex parte Jepson*, 243 Off. Gaz. Pat. Office 525, 528 (1917) ("When an applicant presents a claim, as in this case, which does particularly point out his exact invention, there is certainly nothing in the law to interdict his doing it by including the old parts of the structure in a preamble and set apart from the structure which constitutes the real invention."). The practice has since been codified in 37 C.F.R. § 1.75(e):

When the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or know, (2) a phrase such as "wherein the improvement comprises," and (3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

[4] *Dow Chemical Co. v. Sumitomo Chemical Co., Ltd.*, 257 F.3d 1364, 1368 (Fed. Cir. 2001).

[5] *In re Xencor, Inc.*, 130 F.4th 1350, 1361 (Fed. Cir. 2025).

[6] *E.g., Juno Therapeutics, Inc. v. Kite Pharma, Inc.*, 10 F.4th 1330, 1341 (Fed. Cir. 2021).

[7] *In re Xencor, Inc.*, 130 F.4th at 1360-63.

[8] 35 U.S.C. § 112(a).

[9] *E.g., Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010); *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 74 F.4th 1360, 1370 (Fed. Cir. 2023).

[10] *In re Xencor, Inc.*, 130 F.4th at 1360-61.

[11] *Id.* at 1361.

[12] *Id.* at 1362.

[13] *Id.* at 1361 ("The invention is not only the claimed improvement, but *the claimed improvement as applied to the prior art*, so the the inventor must provide written description sufficient to show possession of *the claimed improvement to what was known in the prior art.*") (emphasis in original).

[14] *Id.*

[15] *Id.* at 1362.

[16] *Id.*

[17] *Id.*

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[18] *Id.* at 1354.

[19] *Id.* at 1354-55.

[20] *Id.* at 1362.

[21] *Id.* at 1356.

[22] *Id.* at 1362-63.

[23] *Id.* at 1361.

[24] *In re Fout*, 675 F.2d 297, 301 (C.C.P.A. 1982) ("We hold that appellants' admission that they had actual knowledge of the prior Pagliaro invention described in the preamble constitutes an admission that it is prior art to them."); *see also Application of Ehrreich*, 590 F.2d 902, 909-10 (C.C.P.A. 1979) ("We agree that the preamble elements in a Jepson-type claim are impliedly admitted to be old in the art, but it is only an implied admission.") (citations omitted).

[25] *See Ehrreich*, 590 F.2d at 909-10.