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The Precedent: Federal Circuit Clarifies that Issuance of an Amended Claim Does Not Provide Substantial Evidence of Compliance with the Written Description Requirement

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In this edition of *The Precedent*, we outline the decision in *Mondis Technology Ltd. v. LG Electronics Inc.*

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Overview

In *Mondis Technology Ltd. v. LG Electronics Inc.*, the Federal Circuit addressed the scope of the presumption of validity in the context of the written description requirement. Specifically, the Federal Circuit considered whether allowance of a claim limitation in an issued patent itself provides substantial evidence of compliance with the written description requirement. The Federal Circuit held that the allowance of a claim limitation does not alone provide substantial evidence of compliance with the written description requirement when there is no indication the examiner assessed whether the specification supports the limitation.

Issues

1. Whether the presumption of validity obviates any burden on the patentee to show adequate written description and supplies substantial evidence of compliance with the written description requirement.
2. Whether the patent's specification provided adequate written description support for the claimed feature at issue.

Holdings

1. The presumption of validity does not eliminate the patentee's burden to identify evidence of written description support when the patent on its face establishes that the specification does not support the full scope of the claims. Nor does allowance of a claim for reciting a feature not identified in the prior art, without evidence

that the examiner considered written description, provide substantial evidence of compliance with the written description requirement.

2. The specification did not provide adequate written description support for the claimed feature because the specification did not disclose, expressly or inherently, that feature.

Background and Reasoning

Mondis Technology Ltd. (“Mondis”) owns U.S. Patent No. 7,475,180 (“the ‘180 Patent”), directed to a system for controlling a specific display unit (e.g., a computer monitor) by communicating with an external video source, such as a computer, that uses stored identification numbers to authenticate and permit control of the display’s functions. Mondis sued LG Electronics, Inc. and LG Electronics U.S.A., Inc. (collectively, “LG”) alleging that LG televisions infringed claims 14 and 15 of the ‘180 Patent.

At trial, LG argued the asserted claims were invalid for lack of written description because, during prosecution, Mondis amended the claims to require an identification number that identifies a display unit type (“the type limitation”), a concept LG contended was not disclosed in the specification. A jury found the claims not invalid and found that LG infringed. LG moved for Judgment as a Matter of Law (JMOL) on the written description issue but the district court denied the motion without identifying support in the specification for the type limitation. Instead, the district court relied on the presumption of validity, which provides that a granted patent is presumed valid and puts the burden of persuasion on the patent challenger to show otherwise by clear and convincing evidence. The district court found LG had not clearly and convincingly proven invalidity and, therefore, upheld the verdict. On appeal, LG challenged the denial of JMOL of invalidity for lack of written description.

1. The Presumption of Validity’s Scope

Mondis argued it need not offer evidence of written description because patents are presumed valid. The Federal Circuit acknowledged that, due to the presumption of validity, there are situations where a patentee need not submit any evidence in support of validity. However, sometimes the patent on its face is clear enough that it establishes an inadequate written description for the full scope of the claimed invention, unless there is evidence otherwise. That was the case here, as the specification did not describe an identification number that identifies a display unit type. Rather, a lone reference to “type of display device” appeared in a background passage describing prior-art multiscan monitors. This was insufficient to provide written description support for the later-claimed type limitation because this use of “type” referred to a prior-art device, not the claimed invention.

Mondis also relied on the examiner’s allowance of the amendment adding the type limitation as substantial evidence of validity. The Federal Circuit noted that, while the issuance of a patent carries a presumption of validity, an examiner’s allowance by itself does not provide substantial evidence of compliance with the written description requirement. The interview summary reflected that the examiner viewed the amendment as avoiding the applied prior art but there was no indication the examiner evaluated whether the specification supported the new limitation. Allowance for overcoming prior art is not proof of compliance with the written description requirement. The Federal Circuit, therefore, found the allowance insufficient to support the jury’s finding.

2. The Adequacy of the Written Description for the Type Limitation

Having established that (1) the presumption of validity does not remove Mondis's burden to point to a supporting disclosure in the specification and (2) allowance does not itself supply substantial evidence of written description support, the Federal Circuit turned to whether the '180 Patent actually describes the type limitation. The '180 Patent's disclosure centers on a one-to-one relationship in which one identification number corresponds to one device. However, the only mention of display unit types appears in a background discussion of prior-art multiscan monitors, which is not an embodiment of the claimed invention and, thus, does not demonstrate possession of the later-claimed concept.

Moreover, Mondis's own expert acknowledged the specification did not expressly recite a type identifier, Mondis offered no rebuttal case on written description during trial and Mondis did not connect any embodiment to the type limitation. Mondis suggested that serial numbers could hypothetically function as type identifiers but the patent does not describe serial numbers at all, let alone as indicators of type.

Accordingly, the Federal Circuit held claims 14 and 15 invalid for lack of adequate written description, rendering infringement moot.