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The Precedent: Federal Circuit Requires Jepson Claim Preambles Satisfy § 112's Written Description Requirement in In re: Xencor, Inc.

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In this edition of *The Precedent*, we outline the decision in *In re: Xencor, Inc.*

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Overview

This case addresses the written-description requirement for Jepson claims.

Issue

Whether the preamble of a Jepson claim must meet the written-description requirement.

Holding

Yes, the preamble of a Jepson claim must meet the written-description requirement.

Background and Reasoning

Xencor, Inc. ("Xencor") filed U.S. Patent Application No. 16/803,690 (the "'690 Application"), which was directed to a method for treating asthma and organ transplant patients. Claim 8 of the '690 Application was a Jepson claim. A Jepson claim is one in which the preamble refers to the state of the prior art and then claims an improvement over it. This form of claim drafting allows the patentee to use the preamble to recite elements or steps of the claimed invention that are otherwise conventional or well known.

The USPTO rejected claim 8 for lack of written description and the Patent Trial and Appeal Board ("Board") affirmed that rejection on the ground that the Jepson preamble is a claim limitation requiring § 112(a) support. Upon rehearing, the Board reiterated that the invention encompasses both the admitted-prior-art preamble and the

improvement and that the specification failed to describe a representative genus of anti-C5 antibodies or any concrete example of treating a patient with those antibodies. An Appeals Review Panel (“ARP” or “Panel”) agreed and Xencor appealed.

The Federal Circuit held that a Jepson claim preamble requires written description. The Federal Circuit held that a Jepson claim is to be treated as “a singular thing,” such that the invention is “the claimed improvement as applied to the prior art.” Citing its prior case law, the Federal Circuit held that every element of the preamble limits the claim and therefore the preamble must satisfy the written description requirement.

The Federal Circuit stated that “[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.” The Federal Circuit stated that “[f]or example, a patentee cannot obtain a Jepson claim with a preamble that says that a time machine is well-known in the art” if the patentee did not describe the time machine “in sufficient detail to make clear to a person of ordinary skill in the art that the inventor is in possession of such a time machine.” Adoption of an alternate position would “leave the patent system vulnerable to such abuse.”

The Federal Circuit upheld the Panel’s finding that Xencor’s specification was deficient and did not provide written description support for claim 8’s preamble. The Federal Circuit stated that “to provide adequate written description for a Jepson claim, 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.” The Federal Circuit agreed with the Panel that anti-C5 antibodies were not well known in the art. Xencor provided prior art publications discussing anti-C5 antibodies and expert testimony to show that anti-C5 antibodies were well known in the art but the Panel did not credit the expert testimony. The Panel did not credit the expert testimony because the expert did not “explain how the publications, coupled with the disclosure of the 5G 1.1 antibody in the Specification, convey possession of the full scope of the claimed genus.” As such, the Federal Circuit upheld the Panel’s holding that claim 8’s preamble lacked written description support.