

Fed. Circ. In November: Looking For Patent 'Blaze Marks'

By **Jeremiah Helm and Sean Murray** (January 9, 2026)

This article is part of a [monthly column](#) that highlights an important recent patent appeal. In this installment, we examine the Federal Circuit's ruling in [Duke University v. Sandoz Inc.](#)

The [U.S. Court of Appeals for the Federal Circuit](#)'s Nov. 18 [decision](#) in *Duke University v. Sandoz Inc.* addresses a fundamental question in patent law: Can a patent applicant pick and choose from different pieces of the disclosure when crafting a claim to the invention?

In *Duke*, the Federal Circuit suggests that some degree of mixing-and-matching might be acceptable, but serves as a warning to patentees that the specification must provide some reason to take the path that ultimately led to the claimed invention.

If the patent discloses many different possibilities but does not provide sufficient guidance for a skilled artisan to arrive at the claimed invention, the claim lacks support and is invalid.

The patent at issue in *Duke*, U.S. Patent No. [9,579,270](#), relates to Latisse, a drug marketed by [Allergan PLC](#) to increase eyelash growth. According to its marketing materials, Latisse will result in fuller, longer and darker lashes. The active ingredient in Latisse is bimatoprost, an analog of a molecule called prostaglandin F.

The '270 patent claims a method of growing hair by administering an active ingredient selected from a genus of prostaglandin F analogs. This claimed genus includes a common structural core but allows substitution with different chemical moieties at different positions on the core. The specific compound bimatoprost falls within the scope of the genus recited in the claimed method of treatment.

During the jury trial, Sandoz argued that there was not sufficient disclosure to meet the written description requirement of Title 35 of the U.S. Code, Section 112(a). The written description requirement represents a part of the quid pro quo of patent law.

A patent applicant must disclose an invention with sufficient detail and specificity to



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demonstrate to those of skill in the art that the inventors had possession of the claimed invention when the application was filed.

This requirement prevents the patent applicant from claiming something that was neither invented nor contemplated in the disclosure. A description that does not support the claims leads to invalidity because the claims are not directed to the applicant's invention.

Written description is a factual inquiry. Sandoz argued that the '270 patent claimed a genus that included thousands of different compounds as active ingredients without a corresponding description of any specific embodiments of the claimed genus or sufficient common structural features that would have led a person of ordinary skill in the art to the claimed genus of compounds.

The jury considered Sandoz's evidence and found that Sandoz had failed to prove a lack of written description by clear and convincing evidence.

The Federal Circuit came to a different conclusion. In holding that the '270 patent claims did not have adequate written description support, the court repeatedly referred to "blaze marks," a concept that comes from forestry, not patent law.

The idea of blaze marks in a patent's description was introduced into patent law by U.S. Circuit Judge Giles Rich, one of the most prominent American patent law jurists. In his 1967 opinion, *In re: Ruschig*, Judge Rich wrote for the Federal Circuit's predecessor court and explained the link between forestry and patent law:

It is an old custom in the woods to mark trails by making blaze marks on the trees. It is no help in finding a trail or in finding one's way through the woods where the trails have disappeared — or have not yet been made, which is more like the case here — to be confronted simply by a large number of unmarked trees. Appellants are pointing to trees. We are looking for blaze marks which single out particular trees. We see none.

Judge Rich's analogy between trailblazing and the adequacy of a patent's disclosure lay largely dormant for several decades until the Federal Circuit increased judicial focus on the written description requirement as an independent basis for invalidity. Now, Judge Rich's blaze marks analogy is a crucial articulation of the written description requirement.

The *Duke* decision reinforces that a patent must guide the reader, almost inevitably, to the claimed invention and is inadequate if it leaves an incomplete or confusing trail of possible

twists and turns.

In *Duke*, the Federal Circuit explained, the patent specification disclosed billions of potential compounds that included the claimed backbone structure, but it did not provide a clear path to the specific modifications in the later-claimed genus of mere thousands of compounds; the blaze marks were insufficient to direct a skilled artisan to the more specific variations that were ultimately claimed.

The patentee argued that there were a relatively small number of variations claimed at specific positions, but the court disagreed, explaining that even a small number of branching possibilities gave rise to yet more branches, resulting in a vast number of options.

The *Duke* court focused on the totality of the specification's disclosure, and not just the isolated pieces that arguably supported each individual claim element. Thus, the court considered that the patent taught "preferred" or "more preferred" options that were not included within the scope of what was claimed.

The court explained this would have led an artisan on a path away from the one needed to arrive at the claimed genus of active ingredients. This demonstrated that the inventors did not possess what was eventually claimed as the invention.

In effect, these teachings placed blaze marks on trees that would inevitably guide the skilled artisan to a different invention, not the one ultimately claimed.

In the court's view, the specification provided a mazelike path, not a direct route, to the invention. Thus, the court indicated, the specification was more reasonably viewed as a laundry list of possibilities and therefore was insufficient to satisfy the written description requirement.

Duke is notable because it addresses the not-unusual situation where a patentee revises claims during prosecution by selecting from lists of disclosed elements. The court focused on the claimed combination of different elements and compared the narrowed claims to the billions of possibilities disclosed in the specification.

The court overturned the jury verdict because the specification did not provide the reader with sufficient blaze marks to differentiate the claimed subgenus of thousands of compounds from the disclosed genus of billions of compounds in a way that would

ultimately arrive at the claimed invention.

This approach of comparing the claimed combination of elements to the disclosure, as a whole, provides an important limit on retrospective claim drafting and reemphasizes the Ruschig ruling's requirement that the specification provide a clear path to the specific claimed invention, and not just the individual claimed elements in isolation.

Moving forward, Duke will likely provide patent challengers with a potent tool to attack claims revised during prosecution to recite a subgenus not specifically disclosed in the patent.

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