

Fed. Circ. In June: When Courts Can't Correct Patent Errors

By **Sean Murray and Jeremiah Helm** (August 3, 2026, 4:17 PM EDT)

*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 *Enanta Pharmaceuticals Inc. v. Pfizer Inc.**

Typos and other inadvertent mistakes are common in patents, more common than patent attorneys would care to admit to their clients. Once a patent is asserted in litigation, you can be sure the accused infringer's attorney will seek to capitalize on each and every mistake. For example, a mistake can allow the accused infringer to argue that the claims are indefinite, invalid for lack of written description, or not infringed by the accused product.

Where an error in the patent is clear and obvious, the patent owner can ask the district court to correct it. But there are limits to what a court can correct. The U.S. Court of Appeals for the Federal Circuit explored and clarified those limits in its June 23 **decision** in *Enanta Pharmaceuticals Inc. v. Pfizer Inc.*



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Enanta sued Pfizer for infringing a patent directed to compounds and methods for inhibiting coronavirus replication. Enanta's patent claimed a compound including an "optionally substituted C1-C8 alkyl" group. The notation "C1-C8 alkyl" meant that the alkyl group could have between one and eight carbon atoms. The protease inhibitor in Pfizer's accused Paxlovid product, nirmatrelvir, had an alkyl group with one carbon atom.

Pfizer argued that Enanta's patent was invalid in view of a public disclosure of nirmatrelvir that Pfizer made before Enanta's patent application. Pfizer had disclosed nirmatrelvir in a presentation it made publicly available in April 2021, months before Enanta filed its patent application in November 2021.

However, Pfizer's disclosure was not earlier than Enanta's provisional patent application, which was filed in July 2020. Whether Enanta's patent was valid therefore turned on whether the patent was entitled to the July 2020 priority date of its provisional application.

Under Title 35 of the U.S. Code, Section 112, a patent claim is entitled to the priority date of a provisional application if the provisional contains written-description support for the

claimed invention. Enanta's challenge stemmed from the fact that its provisional application differed from its issued patent.

In discussing the claimed compound's "optionally substituted C1-C8 alkyl" group, the patent defined "substituted" and listed compounds that qualified as "substituents." One of the listed substituents was "C1-C12 alkyl," an alkyl group containing between one and 12 carbon atoms. The patent's own written description therefore supported claims to compounds with between one and 12 carbon atoms.

Unfortunately for Enanta, its provisional application contained ever-so-slightly different language than the issued patent. The provisional's definition of "substituent" listed "C2-C12 alkyl" groups, rather than "C1-C12 alkyl" groups.

The provisional therefore disclosed only alkyl groups with between two and 12 carbon atoms, and did not provide written description support for claims covering single-carbon alkyl groups. That meant Enanta's patent could not claim priority to the date of the provisional and was likely invalid in view of Pfizer's public disclosure.

Enanta protested that the whole matter was a tempest in a teapot because the provisional's recitation of "C2-C12 alkyl" was just a typo. Surely a patent cannot be invalid because someone made a mistake in typing a single subscript number. Enanta argued that the provisional contained an obvious error and asked the district court to exercise its discretion to correct it.

The court declined to do so and instead granted Pfizer's motion for summary judgment of invalidity.

On appeal, the Federal Circuit noted that there was no real dispute that the provisional's subscript "2" did not provide adequate written description support for the patent's "1." The court therefore focused on Enanta's argument that the district court should have corrected the provisional.

The Federal Circuit ruled that the district court was not authorized to correct a provisional application. In concluding that it had the power to do so, the district court incorrectly relied on the 1971 decision from the U.S. Court of Customs and Patent Appeals in *In re: Oda*, which held that the U.S. Patent and Trademark Office may correct an error in a patent by reissuing the patent under Title 35 of the U.S. Code, Section 251. But that statute does not authorize district courts to reissue patents.

The Federal Circuit also distinguished its 2003 ruling in *Novo Industries LP. v. Micro Molds Corp.*, and similar decisions that authorize a district court to correct an obvious error "in a patent" if the correction is not subject to reasonable debate. *Novo Industries* was inapposite because *Enanta* had asked the district court to correct an error in its provisional application, not the patent itself.

No authority authorized the district court to do so. The Federal Circuit therefore affirmed both the district court's ruling that *Enanta*'s patent was not entitled to the priority date of the provisional and its concomitant judgment of invalidity.

Although *Enanta* lost, its position was far from unreasonable. *Enanta* had compelling evidence that its provisional contained an obvious error. The Federal Circuit focused on the provisional's definition of "substituted," but another part of the provisional contained an obvious error involving the phrase "C2-C12 alkyl."

Specifically, in defining "alkyl," the provisional stated that "'C1-C4 alkyl,' 'C1-C6 alkyl,' 'C1-C8 alkyl,' 'C2-C12 alkyl,' 'C2-C4 alkyl,' or 'C3-C6 alkyl,' refer to alkyl groups containing from one to four, one to six, one to eight, one to twelve, 2 to 4 and 3 to 6 carbon atoms respectively."

The statement that "C2-C12 alkyl ... refers to ... one to twelve" carbon atoms is obviously an error. *Enanta* therefore could have reasonably hoped that the Federal Circuit might extend the holding in *Novo Industries* to patent applications.

In dicta, the Federal Circuit held that even if the district court could have corrected a provisional application, "the existence of an error in the '048 provisional is certainly 'subject to reasonable debate.'" This argument would have been stronger if the court had focused on whether the proposed correction — rather than "the existence of an error" — was subject to reasonable debate.

Novo Industries states that an error can be corrected only if "the correction" is not subject to reasonable debate. While *Enanta* may have shown a disconnect between the phrases "C2-C12" and "one to twelve," it is not clear which of these phrases is erroneous. Perhaps "one to twelve" was meant to be "two to twelve."

While *Enanta* was ultimately unsuccessful, the course of action it adopted at the Federal Circuit was its best option. *Enanta* had little hope of persuading the Federal Circuit that the

provisional's disclosure of C2- C12 supported claims to C1.

Its best bet was to ask the courts to extend Novo Industries to allow the correction of obvious errors in patent applications. This appears to have been an issue of first impression that could have gone either way. Enanta ultimately lost, but its argument was worth making.

The obvious takeaway from the Enanta decision is that patent attorneys should carefully proofread even provisional applications before filing them. Patent attorneys know to proof nonprovisional applications, and in particular the claims in those applications. Enanta appears to have done that in this case, as the specification of its nonprovisional application and its issued claims both correctly recited C1.

But many attorneys treat a provisional as a quick-and-dirty rough draft of the nonprovisional. They dump as much disclosure as possible into the document and file it as quickly as they can to secure the earliest possible priority date.

The temptation to act hastily has only increased since the America Invents Act moved the U.S. to a first-to-file system. But as Enanta demonstrates, a typo in a provisional can be just as harmful as one in a nonprovisional.

Ironically, Enanta would have been better off if its mistake had been in its nonprovisional application, rather than its provisional. Because that error would have appeared in the issued patent, the district court would have had the power to correct it.

Perhaps going forward patent owners should spend their prosecution budgets differently, carefully proofreading their provisionals and filing quick-and-dirty nonprovisionals.

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