

Wands Stands Test of Time: 1988 Case Prominent in *Amgen v. Sanofi* SCOTUS Argument

The Federal Circuit's seminal decision in *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988), was a frequent topic of conversation in the *Amgen v. Sanofi* argument at the US Supreme Court on Monday, March 27, 2023. *Wands* sets forth an eight-factor test that courts use to determine whether a skilled artisan could practice a claimed invention without "undue experimentation" (and thus whether the claimed invention is enabled). The eight factors include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. Notably, Amgen and Sanofi and the United States (appearing as amicus curiae) all agreed that *Wands* sets forth an appropriate framework for analyzing enablement. Given that agreement, it appears likely that, whatever the Supreme Court does with the *Amgen* case, *Wands* will remain a critical part of the legal standard for enablement.

The person responsible for establishing this now 35-year-old framework is none other than Sterne, Kessler, Goldstein & Fox's own Jorge Goldstein. Jorge successfully briefed and argued the *Wands* case in 1988 on behalf of the Massachusetts General Hospital, where Dr. Jack Wands was then a researcher. In response to the argument and references to *Wands*, Goldstein remarked, "I'm delighted that after more than three decades, spanning most of my legal career, *Wands* still is - and apparently will remain - good law on the enablement of patent claims."

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