

## Memorandum

DATE: April 28, 2010

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TO: **Any Client Wanting To File A “Provisional “ Patent Application Without An Attorney Working On The Application**

FROM: Tim Headley

RE: Disclosure Requirements For Patent Applications

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A provisional patent application merely helps to keep the inventor from shooting himself in the foot. That is, if an inventor publicly discloses, or offers for sale, his invention, before he has filed a patent application on it, then he loses any chance of a patent on the invention in most foreign countries. If the inventor files a provisional patent application, and then later files the normal non-provisional patent application, he is allowed to claim as a “priority date” for the non-provisional patent application the earlier date when he filed the provisional patent application. This overcomes what would have been a problem caused by his public disclosures and offers for sale after he filed his provisional patent application.

However, if he discloses merely a vague idea in his provisional, but later discloses and claims a very specific invention in his non-provisional patent application, his “priority date” will be worthless, giving him no protection against his disclosures and sales, because the law requires “full disclosure” of the claimed invention, in exchange for the monopoly defined by the patent claims. This “full disclosure” requirement actually includes three individual, specific requirements: 1) show possession of the invention; 2) enable others to make the invention; and 3) disclose the best form of the invention.

### **The Patent Application Must Show Possession Of The Invention.**

"[T]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon `reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 U.S.P.Q. 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 U.S.P.Q. 1089, 1096 (Fed. Cir. 1983)).

"This court in *Wilder* (and the CCPA before it) clearly recognized, and we hereby reaffirm, that 35 USC 112, first paragraph, requires a 'written description of the invention' which is separate and distinct from the enablement requirement. The purpose of the 'written description' requirement is broader than to merely explain how to 'make and use'; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*."

*Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111 (Fed. Cir. 1991) (reversing a summary judgment of invalidity under 35 U.S.C. 102 (b) of a utility patent, based on a finding of an insufficient description in a parent design application).

At the close of discovery, Earth Tool moved for partial summary judgment of invalidity of the '283 patent based on the on-sale bar of 35 U.S.C. §102(b). The parties did not dispute that commercial embodiments of the patented drill bit were sold during the spring and summer of 1996 — more than one year before the November 1997 filing date of the non-provisional application, but not more than one year before the filing date of the February 1997 provisional application to which it claimed priority. Earth Tool argued, however, that the utility application was not entitled to the priority date of the provisional because the disclosure in the provisional specification failed to adequately describe the invention claimed in the '283 patent as required by 35 U.S.C. §119(e)(1). The district court agreed, concluding "nothing in this [provisional specification] language states that the drill bit is 'angled with respect to the sonde housing' or otherwise describes the toe, the heel, or the toe-to-heel ratio." The court further found that Cox had admitted as much in his deposition, and that his later contrary declaration submitted in opposition to partial summary judgment could not, as a matter of law, create a genuine issue of material fact on this point. Thus, because the '283 patent was not entitled to claim the priority date of the provisional, New Railhead's mid-1996 commercial sales constituted a §102(b) bar.

*New Railhead Manufacturing LLC v. Vermeer Manufacturing Co.*, 63 USPQ2d 1843 (Fed. Cir. 2002).

## **The Patent Application Must Enable Others To Make The Invention.**

The patent must be written in such a way to pass the test of "enablement". The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent, coupled with information known in the art,

without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988), *cert. denied*, 109 S. Ct. 1954 (1989).

## **The Patent Application Must Disclose The Best Form Of The Invention.**

A patent specification must "set forth the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. § 112. "The purpose of the best mode requirement is to restrain inventors from applying for a patent while at the same time *concealing* from the public preferred embodiments of their inventions which they have in fact conceived." *Wahl Instruments, Inc. v. Acvious, Inc.*, 950 F.2d 1575, 1580, 21 USPQ2d 1123, 1127 (Fed. Cir. 1991) (reversing-in-part, vacating-in-part, and remanding a grant of summary judgment of invalidity for failure to disclose the best mode of making a clear, solid, plastic body having a layer of thermochromic material embedded in it). "A description of particular materials or sources or of a particular method or technique selected for manufacture may or may not be required as part of a best mode disclosure respecting a device. ...

"[I]f the inventor develops or knows of a particular method of making which substantially improves the operation or effectiveness of his invention, failure to disclose such peripheral development may well lead to invalidation. [citation omitted] On the other hand, an inventor is not required to supply "production" specifications. [citation omitted] Under our case law, there is no mechanical rule that a best mode violation occurs because the inventor failed to disclose particular manufacturing procedures beyond the information sufficient for enablement. One must look at the scope of the invention, the skill in the art, the evidence as to the inventor's belief, and all of the circumstances in order to evaluate whether the inventor's failure to disclose particulars of manufacture gives rise to an inference that he concealed information which one of ordinary skill in the art would not know." *Id.*

"[T]here is no *per se* requirement to provide names for sources of materials absent evidence that the name of the source would not be known or easily available." *Id.* "[T]he best mode requirement does not require an inventor to disclose production details so long as the means to carry out the invention are disclosed." *Transco Prods. Inc. v. Performance Contracting, Inc.*, 32 USPQ2d 1077 (Fed. Cir. 1994) (reversing a finding of invalidity, holding that the district court erred as a matter of law in holding that an applicant must update the best mode disclosure upon the filing of a continuing application containing no new matter, for a patent directed to thermal insulation for vessels and piping within nuclear power plants) (citing *Wahl Instruments, Inc. v. Acvious, Inc.*, 950 F.2d 1575, 1580, 21 USPQ2d 1123, 1127 (Fed. Cir. 1991); *In re Gay*, 309 F.2d at 774, 135 USPQ at 316). "This includes providing supplier/trade name



O: 713 467 8500

F: 713 467 8501

C: 713 398 1045

information where it is not needed, i.e., where such information would be `mere surplusage -- an addition to the generic description.'" "Such supplier/trade name information must be provided only when a skilled artisan could not practice the best mode of the claimed invention absent this information." *Id.*

Sincerely yours,

A handwritten signature in black ink that reads 'Tim Headley'.

Tim Headley