Patent and Disclosure by Best Method

Prantik Garai

Available at: https://works.bepress.com/prantik_garai/1/
“Patent and Disclosure by Best Method”

By:

Prantik Garai

WEST BENGAL NATIONAL UNIVERSITY OF JURIDICAL SCIENCES
Introduction

THE HISTORY OF PATENT LAW IN INDIA

In India, the first patent law was passed in the year 1856 and was known as the Act VI of 1856 on Protection of Inventions. This was modified in the year 1859 as Act XV. The Act was replaced in the year 1872 with the Patents and Designs Protection Act, which was later replaced by the Protection of Inventions Act, 1883. Then in the year 1888, this Act was replaced by the Inventions & Designs Act. In the year 1911, this Act was replaced with the Indian Patents & Designs Act and thereafter with the Patents Act, 1970. The Patents Act, 1970 has been amended in the years 1999, 2002 and 2005. Presently, the patent system in India is governed by the Patents Act, 1970 as amended by the Patents (Amendment) Act, 2005 and the Patents Rules, 2003 as amended by the Patents (Amendment) Rules, 2006. The latest amendment in the year 2005 was made in order to bring the patent law in India into compliance with the TRIPS Agreement.

Patent is an exclusive right conferred by the Patent Office on an inventor to exploit his invention for a limited period of time in exchange of an in exchange for a disclosure of an invention. During this limited period the inventor under the patent law of that country gets the exclusive right for the use of the invention. Once any new idea or invention is conceptualized it becomes necessary to get a patent. Only a patent can certify that the invention is original. To get the patent the patent holder has to disclose its invention into the public domain for the common good. If inventors did not have the legal protection of patents they would prefer or tend to keep their inventions secret. Awarding patents generally makes the details of new technology publicly available, for exploitation by anyone after the patent expires, or for further improvement by other inventors. Furthermore, when a patent's term has expired, the public record ensures that the patentee's idea is not lost to humanity. The disclosure is also required for the people who are skilled in the particular art to find out whether the specification discloses the best method. The best method theory may be stated as the best way know to the inventor at the time of the filling of the patent application to arrive at the invention.
To get patent protection the inventor has to make the following specification in the patent application:\(^1\)

- The title of the invention.
- A full description of the invention and its operation and use and the method by which it is to be performed;
- A disclosure of the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection, if necessary with the help of drawings, examples etc.
- A statement of claim or claims defining the scope of the invention for which protection is sought.

The essential rules for drafting the specification are three fold\(^2\):

a. A specification should be a written description meaning that it should enable any person skilled in the art studying the written description to come to the one and only conclusion that the inventor had in his possession the invention at the time of filing the application.

b. The specification should enable any person skilled in the art to duplicate the experiment of the inventor without undue experimentation.

c. The specification should disclose the best mode of carrying out the invention known to the inventor and if there are more than one best mode of carrying out the invention the inventor should disclose them all in the patent specification.

Therefore the specification should meet the three cardinal principles:

1. Written description.
2. Enablement.
3. Best mode.

---

\(^1\) Indiapatent.com

\(^2\) Banerjee, An Analytical Understanding of the Concept of Inventive Step Requirement of Patents, pg 56
Section 112 of the U.S. Patent Act 35 U.S.C. deals with the concept of the Best Method or the Best mode in disclosing a patent. The concept of “disclosure of best method” is very useful in many ways which the researcher is going to discuss. The best method theory is important in the present time for the widespread technological advancements taking place all over the world. The technological development would not be possible if the best method that was used was not disclosed. The disclosure helps in further development of that particular product. The concept of Best method or the best mode is an important concept in the US patent Regime.
Requirement of Section 112 of the U.S. Patent Act 35 U.S.C

1. **Written Description**

The issue of an inadequate *written description* usually arises during patent infringement cases in circumstances where a claim was added to a patent application at some stage after the original filing date and the additional claim's limitations are not adequately described in the original specification. The *written description requirement* usually surfaces in three contexts: (1) a section 119 and 120 of US Patent Act assertion of an earlier filing date; (2) an interference context; and (3) in an *ex parte* case.

When drafting patent claims, the applicant's overall goal is to make the claims as broad as the Patent and Trademark Office (PTO) will allow. Under the Act, to obtain a valid patent an applicant must include in his or her application a specification adequately disclosing the invention and how to make and use it. The purpose of the requirement of adequate disclosure guarantees that the public will receive the full benefit of the knowledge of the patent in exchange for the limited monopoly granted to the inventor. The written description requirement ensures that the applicant had in his or her possession, as of the filing date of the application, the specific subject matter claimed by the applicant. As a consequence of its primary purpose, the written description requirement allows subsequent “intervenitors to develop and obtain patent protection

---

4 Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1560 (Fed. Cir. 1991) as cited in http://www.bc.edu/bc_org/avp/law/st_org/iptf/commentary/content/2002020101.html
7 35 U.S.C. § 112, para. 1; As cited in http://www.bc.edu/bc_org/avp/law/st_org/iptf/commentary/content/2002020101.html
for later improvements and subservient inventions that” build on the original applicant’s invention.9

The written description requirement usually arises in litigation when a claim that is not present in the original patent application is added by the applicant at a later time during the patent prosecution process and the scope of the later claim differs from the scope of the original claims.10 The issue presented in these situations is whether the original application's specification provides adequate support for the claims that were added later.11 If the limitations of the claim that was added later is not adequately disclosed in the original specification, the written description requirement is not met, and the benefit of the original filing date is lost as to the subsequently added claim.12

The term written description itself is ambiguous but fulfills a vital function as well as several policy objectives in modern patent practice. Written description serves two functions: first, it shows possession of the invention as of the time of the filing of the patent application; and, second, it teaches others what the invention is and how to make and use it, i.e. enablement. Additionally, the written description requirement prevents the introduction of new matter in a patent application beyond the scope of the originally filed specification.

2. **Enablement**

The enablement requirement refers to the requirement of Sec 12 of US Patent Act first paragraph that the specification describe how to make and how to use the invention. The invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the particular application or patent. The purpose of the requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The information

9 Donald S. Chisum, Chisum on Patents § 7.01 (2000) As cited in http://www.bc.edu/bc_org/avp/law/st_org/iptf/commentary/content/2002020101.html
10 Supra n 3
11 The court in Vas-Cath Inc. also stated that the issue of adding claims at a later time in the hope of gaining the protection of the earlier filing date has also been analyzed in terms of “new matter” under 35 U.S.C. section 132. Id. As cited in http://www.bc.edu/bc_org/avp/law/st_org/iptf/commentary/content/2002020101.html
12 Supra, n 8
contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention

**Best Mode**

The Section 112 of the US Patent Act speaks of enablement requirement. that has been “contemplated by the inventor”\(^1\). There is no objective or parameter to judge which is the best mode of disclosure. Only evidence of “concealment”\(^2\) whether accidental or intentional can only be considered. Only specification of disclosure require to require to comply with the best mode requirement must be determined by the knowledge of facts within possession of the inventor at the time of filing of the application.

In United States patent system provides the inventor with a period of exclusivity during which the inventor has the right to prevent others from making, using, or selling the invention. In return, the public receives a free right to practice the invention after the patent expires.\(^3\)

In order to make sure that patents are self-speaking and enable the public to practice the invention, the patent statute establishes certain disclosure requirements. More specifically, the patent application must provide a detailed description of the invention and of the manner of making and using it in such full, clear, concise, and exact terms that any person skilled in the art to which the patent pertains can make and use the same. This portion of the statute, which is generally described as the "enablement provision," has been interpreted as requiring the inventor to provide a sufficiently detailed disclosure so that someone skilled in the art can practice the invention without undue experimentation. A second and distinct requirement of the statute is that

---

\(^1\) Barret, Intellectual property cases and Material, 2nd edn, p 215
\(^2\) ibid
the specification must "set forth the best mode contemplated by the inventor of carrying out his invention."\textsuperscript{16}

A patent can be invalidated for failure to comply with either of these standards; both must receive careful attention during the preparation of a patent application. For example, an inventor could provide an enabling disclosure while withholding the "best mode" of practicing the invention.\textsuperscript{17} Frequently inventors are tempted to withhold key elements that contribute meaningfully to the most advantageous practice of the invention while seeking the full benefit of the patent system. This is not only an undesirable practice, but can result in the patent being invalidated.

The best mode requirement focuses specifically on the best mode known to the inventor at the time the application is filed. It is a subjective standard. Suppose that the inventor faced with options A, B, and C with respect to a particular feature of the invention concludes at the time of filing that application A is the best mode. If it is subsequently determined that either B or C is in fact a better mode, this will not jeopardize the validity of the patent since the inventor has, in good faith, provided information to the best of his or her knowledge at the filing date.\textsuperscript{18}

While the concept of "best mode" will generally be interpreted as referring to what is technically best, this will not always be the case. For example, suppose the inventor recognizes that the best performance technically might be achieved by making a given component out of gold, silver, or platinum, but realizes that the cost of such a component would be unrealistic and, as a result, that approach would never be adopted commercially.\textsuperscript{19} It would be appropriate for the inventor to mention that the best mode would involve the manufacture of a component of aluminum or steel as being a technically satisfactory and economically practical material. This is the place where the concept of industrial application comes. An invention to be patented requires it to be applicable in industry and feasible for production in the term of cost. the above mentioned invention would not have been feasible because of the fact the fact that the cost of the invention is too high.

\textsuperscript{16} Section 112 of the US Patent Act
\textsuperscript{17} \url{http://www.tms.org/pubs/journals/JOM/matters/matters-9412.html}
\textsuperscript{18} ibid
\textsuperscript{19} ibid
Since the best mode test is a subjective one, the inventor is not required to be an expert in the field, to perform extensive research to ascertain the best mode, or to understand how the invention works. Such credentials and activities are not otherwise required by the patent system, and the best mode requirement does not add a requirement of this type. All that is required is that the inventor fully shares his or her state of knowledge on the issue as of the filing date. The inventor merely needs to teach another how to practice the invention through an appropriate enabling disclosure that complies with the best mode requirement.

The nature of the technology and complexity of the invention can have a significant influence on how much an inventor must disclose in order to satisfy the best mode requirement. There is no need to clutter a patent application with words and drawings that disclose details that would be well known to those skilled in the art. For example, if a set screw is employed in the invention, it is not necessary to state that a screwdriver should be employed to adjust the position of the screw. When in doubt, however, it is best to err in the direction of providing too much information rather than too little.20

An inventor might conclude that any of a group of solvents usable in the invention would perform equally well. It is not necessary for the inventor to make a judgment call and select a specific solvent. The inventor might state that the best mode of practicing the invention involves using a solvent selected from the group consisting of X, Y, and Z. Alternatively, the inventor might describe the solvent according to the desired properties found in solvents that give the best performance.21

In general, the best practice is for the inventor to provide a full disclosure to the patent attorney and for the two of them to make decisions regarding what should be disclosed in the application in order to make sure that there has been compliance with the best mode requirement. All decisions must be handled on a case-by-case basis. It is of utmost importance that the inventor acts in good faith and direct attention to the best mode requirement.

The final requirement of Section 112(1) of the US Patent Act is that the specification set forth best mode contemplated by the inventor of carrying out his invention. The best mode

20 ibid
21 Supra n 14
requirement ensures that the public receives the most advantageous implementation of the technology known to the inventor, allowing competitors to compete with the patentee on equal footing after the patent expires. It compels inventors to disclose information that might otherwise be maintained as a trade secret.

In *Chemcase Corp v Arco Industries Corp* an inventor invented and obtained a patent on a grommet designed to seal an opening in a sheet metal panel. When the plaintiff alleged that there was a patent infringement, the defendants argued that the patent failed to disclose the best mode known to the inventor. They urged that the absence of type, hardness, supplier and trade name of material used to make the locking portion of the grommet was fatal to the patent.

The court set forth a two prong test to determine whether a patent specification fulfills the best mode requirement. The first inquiry was whether the inventor knew of a mode of practicing the claimed invention that he considered superior to any other. If this first subjective standard was met, then the court should consider whether the specification identifies and discloses sufficient information to enable persons of skill in the art to practice the best mode.

Considering the first the court ruled that the inventor had the knowledge of the best mode as he had preferred a rigid PVC composition for the use of the locking portion of the grommet. Proceeding to the second prong of the best mode inquiry the court found the inventor’s specification wanting as it failed to disclose the trade name of the composition used in making the locking portion of the grommet, its supplier in the market place or even the preferred material hardness. Since the inventor had concealed the best mode for operating the invention, the patent was invalidated.

The point that the best mode requirement only applies to the inventor named in the patent application has been well illustrated in *Glaxo Inc v Novopharm Ltd*. The inventor in this case was an employee of Glaxo. He invented an anti ulcer medication during his employment with Glaxo. Consistent with an employment contract, Glaxo filed an application on behalf of the

---

23 913 F.2d 923 (Fed.Cir.1990)
24 Supra n 20 p.402
25 Ibid
26 Ibid
27 52 F.3d 1043
employee. The application matured into a patent claiming the compound and disclosing a method of making it. While Glaxo knew that other employees had invented a better technique of making the compound originally discovered, it never informed the inventor about it, prior to the filing of the application. The court opined that the wording of the statute expressly limited the best mode requirement to knowledge held by the inventor. Since in this case there was no evidence that suggested inventor himself knew of a better way to manufacture medication, the court ruled that there was no best mode violation which occurred.\(^{28}\)

\(^{28}\) Supra n 15 p.403
The term *written description* itself is ambiguous but fulfills a vital function as well as several policy objectives in modern patent practice. Written description serves two functions: first, it shows *possession* of the invention as of the time of the filing of the patent application; and, second, it teaches others what the invention is and how to make and use it, i.e. enablement. Additionally, the written description requirement prevents the introduction of new matter in a patent application beyond the scope of the originally filed specification.

If this evaluation of the best mode is handled on a good faith basis with full disclosure of the inventor's state of knowledge at the time the application filed, changes in the invention subsequent to the filing of the patent application are irrelevant to this issue. Honesty and good faith are the key elements required to avoid a challenge to validity of any resultant patent based upon failure to comply with this standard.
BIBLIOGRAPHY

Statutes

• U.S. Patent Act 35 U.S.C

Books

• Barret, Margreth, Intellectual property cases and Material, 2nd edn, (St. Paul, West group 2001)

• Banerjee, Nilanjan, "An Analytical Understanding of the Concept of Inventive Step Requirement of Patents", LLM 2006-2008 Batch, WBNUJS


**Electronic Sources**

• Anonymous, ‘Intellectual Property Rights’, as visited in


• Mansfield, Edwin, ‘Patents and Innovation: An Empirical Study’, as visited in

• Goldschmid, Mark R. t, The Written Description Requirement - An Ambiguous Yet Critical Requirement for Patent Applicants as cited in
  http://www.bc.edu/bc_org/avp/law/st_org/iptf/commentary/content/2002020101.html