

CLASS 3

THE PATENT DOCUMENT I
ENABLEMENT & WRITTEN DESCRIPTION

PATENT LAW & POLICY
PROFESSOR WAGNER



Today's Agenda

The "Enablement" Requirement

The "Written Description" Requirement

**Disentangling the Enablement & W/D
Requirements**

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Overview of Course Design

Course Design

The Standards for Patentability

The Enforcement of Patents

The Institutional Design of the Patent System

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Enablement

The Standards for Patentability

A valid patent must be . . .

- Fully and appropriately described (§ 112)
- In compliance with statutory bars (§ 102)
- Novel (§ 102)
- Nonobvious (§ 103)
- The work of the inventors (§ 116)
- Useful (§ 101)
- Within the appropriate subject matter (§ 101)

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Disclosure Theory

The Enablement Requirement

35 U.S.C. § 112. - Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. . . .

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The Best Mode Requirement

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O'Reilly v. Morse (1854)

UNITED STATES PATENT OFFICE.

A. S. A. MORSE, OF PROVIDENCE, RHO. ISLAND.

IMPROVEMENT IN ELECTRO-MAGNETIC TELEGRAPHS.

Specification forming part of a Patent granted to the said A. S. A. Morse, for the said Invention, on the 11th day of August, 1846.

Be it remembered, that I, A. S. A. Morse, of the County of Providence, State of Rhode Island, do hereby certify that the following is a true and correct copy of the original specification of an improvement in electro-magnetic telegraphs, as the same appears in the files of the Patent Office, in and to which I claim the right of property.

And I do hereby certify that the following is a true and correct copy of the original claims of the said invention, as the same appear in the files of the Patent Office, in and to which I claim the right of property.

Witness my hand and seal, at Providence, Rhode Island, this 11th day of August, 1846.

A. S. A. MORSE.

It is to be understood that the first object of the said invention is to provide a means of communicating intelligence by means of the electric or galvanic current, which I call "electro-magnetism," however developed, for marking or printing intelligible characters, signs, or letters at any distances, being a new application of that power of which I claim to be the first inventor or discoverer.

And it is to be understood that the second object of the said invention is to provide a means of communicating intelligence by means of the electric or galvanic current, which I call "electro-magnetism," however developed, for marking or printing intelligible characters, signs, or letters at any distances, being a new application of that power of which I claim to be the first inventor or discoverer.

ORS.

8. I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims, the essence of my invention being the use of the motive power of the electric or galvanic current, which I call "electro-magnetism," however developed, for marking or printing intelligible characters, signs, or letters at any distances, being a new application of that power of which I claim to be the first inventor or discoverer.

SAMUEL R. MORSE.

Why is this claim invalid?

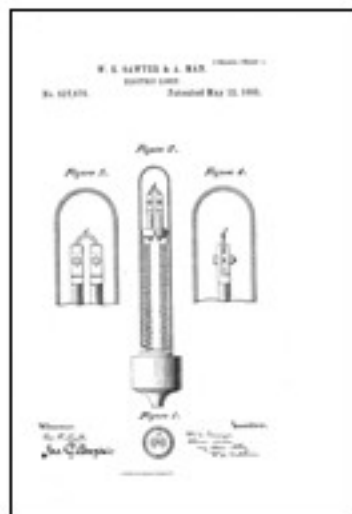
if this claim can be maintained, it matters not by what process or machinery the result is accomplished. For aught that we now know, some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's specification. His invention may be less complicated -- less liable to get out of order -- less expensive in construction, and in its operation. But yet if it is covered by this patent, the inventor could not use it, nor the public have the benefit of it, without the permission of this patentee....

No one, we suppose will maintain that Fulton could have taken out a patent for his invention of propelling vessels by steam, describing the process and machinery he used, and claimed under it the exclusive right to use the motive power of steam, however developed, for the purpose of propelling vessels.

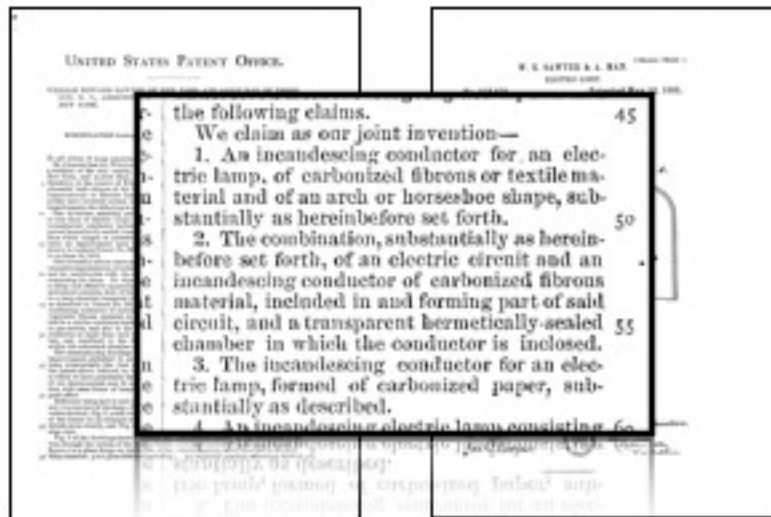
Now the patent law requires an inventor, as a condition precedent to obtaining a patent, to deliver a written description of his invention or discovery and to particularly specify what he claims to be his own invention or discovery. If he has truly stated the principle, nature, and extent of his art or invention, how can the Court say it is too broad, and impugn the validity of his patent for doing what the law requires as a condition for obtaining it? ...

If it be in the use of the words "however developed" that the claim is to be adjudged too broad, then it follows that a person using any other process for the purpose of developing the agent or element of electro-magnetism than the common one now in use and described in the patent may pirate the whole art patented.

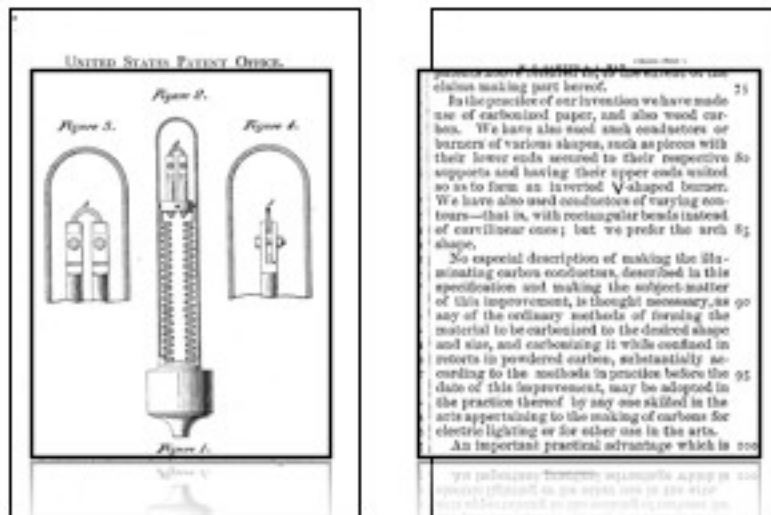
The Incandescent Lamp Patent



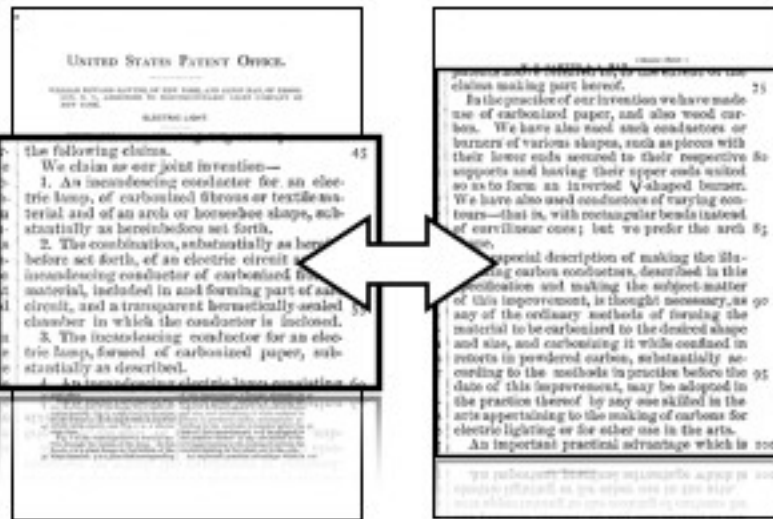
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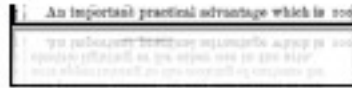
The Incandescent Lamp Patent

If the patentees had discovered in fibrous and textile substances a quality common to them all, or to them generally, as distinguishing them from other materials, such as minerals, etc., and such quality or characteristic adapted them peculiarly to incandescent conductors, such claim might not be too broad.

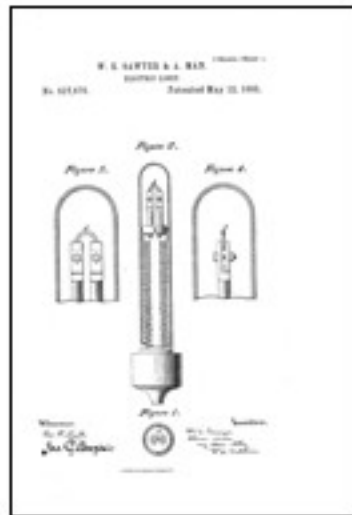
The Incandescent Lamp Patent



Applying this principle to the patent under consideration, how would it be possible for a person to know what fibrous or textile material was adapted to the purpose of an incandescent conductor, except by the most careful and painstaking experimentation?



The Incandescent Lamp Patent



The Policy of the Enablement Requirement

Two Purposes?

Standard of Disclosure?

What is the optimal claim scope?

[... & how does the disclosure requirement affect this?]



Tight Disclosure
Requirement

Relaxed Disclosure
Requirement

"Commensurability"

Disclosure

Light signaling apparatus
with red, yellow, green lights



Claim

Light signaling apparatus
with red, yellow, blue lights



"Commensurability"

Nat'l Recovery Technologies (Fed. Cir. 1997)
Disclosure Claim

*If, by following the steps set forth in the specification,
one of ordinary skill in the art is not able to replicate the
claimed invention without undue experimentation, the
claim has not been enabled...*



"Commensurability"

Disclosure

Light signaling apparatus
with red, yellow, green lights



Claim

Light signaling apparatus
with red, yellow, blue lights



"Commensurability"

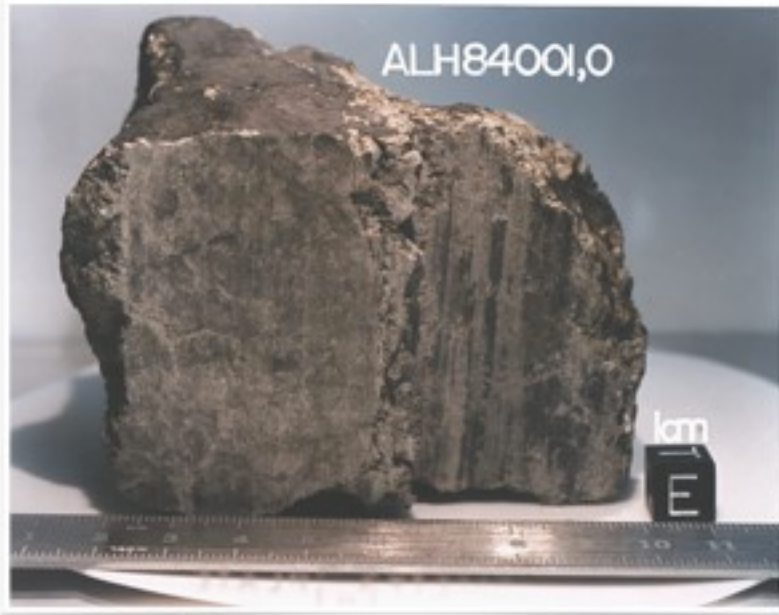
Disclosure

Light signaling apparatus
with red, yellow, green lights



Claim

Light signaling apparatus
with lights



The Three Principles of Enablement

The scope of disclosure required

=

scope of the claims.

**The quantity of disclosure is related to
the predictability in the art.**

**The measurement of the disclosure is
as of the filing date.**



Disclosure Theory

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Written Description

The Written Description Requirement

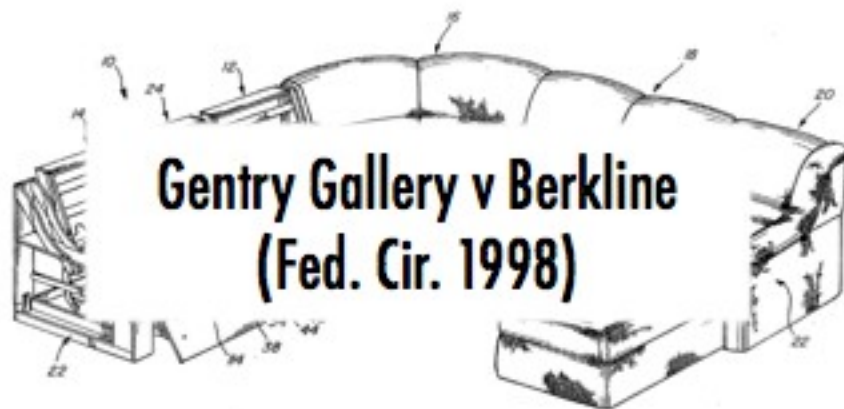
35 U.S.C. § 112. - Specification

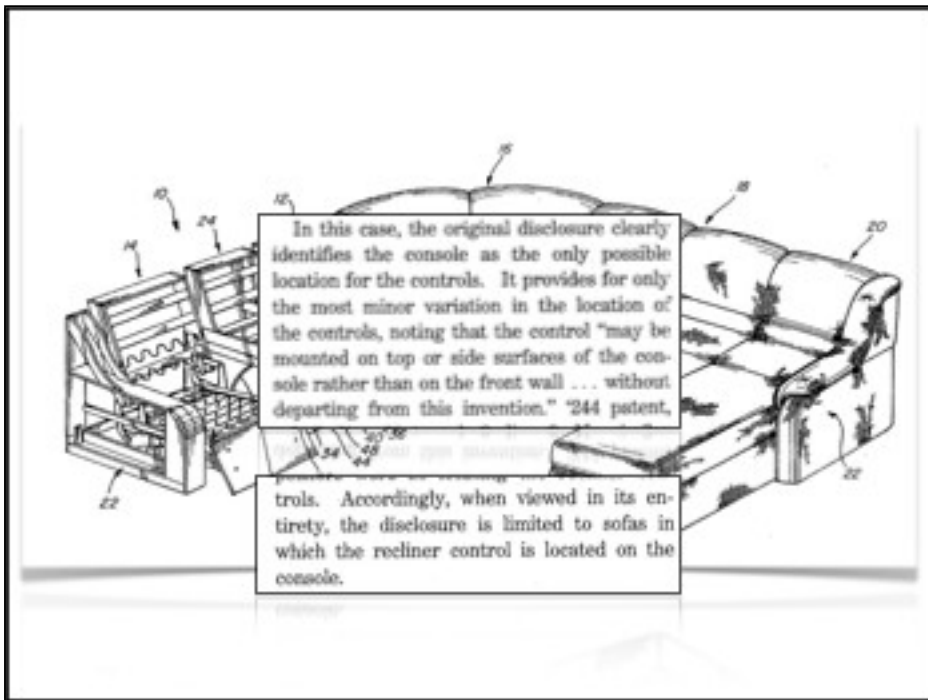
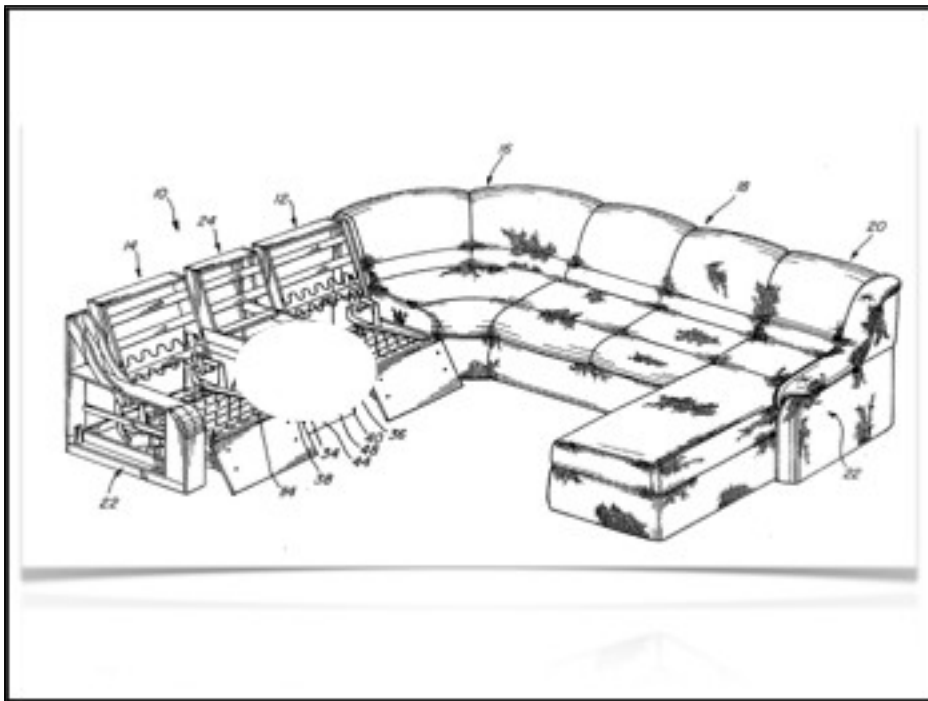
The specification shall contain a

How is this different from enablement?

(Any statutory clues?)

any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. . . .





Johnson Worldwide v. Zebco (Fed. Cir. 1999):

Thus, this case is unlike Gentry Gallery, in which this court's determination that the patent disclosure did not support a broad meaning for the disputed claim terms was premised on clear statements in the written description that described the location of a claim element — the "control means" — as "the only possible location" and that variations were "outside the stated purpose of the invention." Gentry Gallery, then, considers the situation where the patent's disclosure makes crystal clear that a particular (i.e., narrow) understanding of a claim term is an "essential element of [the inventor's] invention." Here, however, the patent disclosure provides ample support for the breadth of the term "heading"; it does not "unambiguously limit[]" the meaning of "heading" to the direction of the motor.



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Enablement vs. Written Description

35 U.S.C. § 112. - Specification

The specification shall contain a written description of the invention, and of the manner and process of making, using, and repairing it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. . . .

Why Have A Separate

Written Description Requirement?

NEXT CLASS

THE PATENT DOCUMENT II

WRITTEN DESCRIPTION (PART 2)

PATENT LAW & POLICY
PROFESSOR WAGNER

