

CLASS 4
PATENT DOCUMENT II:
WRITTEN DESCRIPTION, BEST MODE,
DEFINITENESS

PATENT LAW & POLICY
PROFESSOR WAGNER



Today's Agenda

Enablement vs. Written Description

The Best Mode Requirement

Definiteness

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Enablement vs. 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. . . .

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 a 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?

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Enablement?

Claims

methods involving the reduction of the (activity / bindings) between NF-KB recognition sites

not limited to particular substances/molecules

method of reducing NF-KB activity

1. A method of reducing NF-KB activity

comprising

administering to a patient

an agent

capable of

reducing NF-KB activity

in a patient

wherein the agent

is selected from the group consisting of

1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, 77, 78, 79, 80, 81, 82, 83, 84, 85, 86, 87, 88, 89, 90, 91, 92, 93, 94, 95, 96, 97, 98, 99, 100.

2. A method of reducing NF-KB activity

comprising

administering to a patient

an agent

capable of

reducing NF-KB activity

in a patient

wherein the agent

is selected from the group consisting of

1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, 77, 78, 79, 80, 81, 82, 83, 84, 85, 86, 87, 88, 89, 90, 91, 92, 93, 94, 95, 96, 97, 98, 99, 100.

3. A method of reducing NF-KB activity

comprising

administering to a patient

an agent

capable of

reducing NF-KB activity

in a patient

wherein the agent

is selected from the group consisting of

1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, 77, 78, 79, 80, 81, 82, 83, 84, 85, 86, 87, 88, 89, 90, 91, 92, 93, 94, 95, 96, 97, 98, 99, 100.

4. A method of reducing NF-KB activity

comprising

administering to a patient

an agent

capable of

reducing NF-KB activity

in a patient

wherein the agent

is selected from the group consisting of

1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, 77, 78, 79, 80, 81, 82, 83, 84, 85, 86, 87, 88, 89, 90, 91, 92, 93, 94, 95, 96, 97, 98, 99, 100.

5. A method of reducing NF-KB activity

comprising

administering to a patient

an agent

capable of

reducing NF-KB activity

in a patient

wherein the agent

is selected from the group consisting of

1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, 77, 78, 79, 80, 81, 82, 83, 84, 85, 86, 87, 88, 89, 90, 91, 92, 93, 94, 95, 96, 97, 98, 99, 100.

6. A method of reducing NF-KB activity

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wherein the agent

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1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, 77, 78, 79, 80, 81, 82, 83, 84, 85, 86, 87, 88, 89, 90, 91, 92, 93, 94, 95, 96, 97, 98, 99, 100.

Disclosure

hypothesizes three kinds of molecules that can reduce NF-KB activity: decoy, dominantly interfering, and specific inhibitor.

[W]e have not specifically addressed [enablement] in relation to the type of claims at issue here--that is, claims written broadly enough to cover any method for achieving a particular result. It may be ... that such a claim can never be valid, since the specification cannot enable unknown methods. This is an important issue that we have left unresolved. It is an issue that we would have been compelled to reach had the case been decided on enablement grounds, a basis found in section 112, instead of on written description grounds, a separate basis not justified under that section or any other provision of the Patent Act.

**How do you comply with the written
description requirement?**

Deposit a sample?

**Is a requirement that an inventor “prove
possession” of her invention useful?**

Is it truly separable from enablement?

How will it impact patenting behavior?

2

The Best Mode Requirement

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)

The Best Mode 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. . . .

AIA Amendment: The Best Mode Requirement

[America Invents Act] SEC. 15. BEST MODE REQUIREMENT.

(a) IN GENERAL.—Section 282 of title 35, United States Code, is amended in the second undesignated paragraph by striking paragraph (3) and inserting the following:

(3) Invalidity of the patent or any claim in suit for failure to comply with—

(A) any requirement of section 112, except that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable; or

(B) any requirement of section 251.

... (c) EFFECTIVE DATE.—The amendments made by this section shall take effect upon the date of the enactment of this Act [Sept. 16, 2011] and shall apply to proceedings commenced on or after that date.

The Best Mode Requirement

**You (the inventor) select a mode
by chance or convenience.**

Must you disclose the mode?

The Best Mode Requirement

**You select a mode because it
makes the invention easier/
cheaper to produce.**

Must you disclose the mode?

The Best Mode Requirement

**Assume you mistakenly or
inadvertently fail to disclose the
best mode.**

Problem?

The Best Mode Requirement

**You work on a corporate
research team:**

**A (non-inventor) colleague determines a
better mode than you do, and tells you
before the filing date.**

Must you disclose the mode?

The Best Mode Requirement

**You work on a corporate
research team:**

A (non-inventor) colleague determines a better mode than you do, but does not tell you before the filing date.

Must you disclose the mode?

The Rect Mode Requirement

**You work on a corporate
research team:**

A (non-inventor) colleague determines a better mode than you do, but does not tell you before the filing date. She tells upper management.

Must you disclose the mode?

3

The Definiteness Requirement

35 U.S.C. § 112. - Specification

[...¶1]

[...¶2]The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

under the agreement to the availability of electronic services available for downloading to the defendant. Thus, the evidence submitted in the hearing indicates that the defendant has not been able to provide the evidence.

III. CONCLUSION

Because the defendant's evidence was not in accordance with the law, the Board's determination of the evidence is not and its evidence with the law and the defendant is a matter, therefore, is not and is not.

given that the defendant's evidence was not in accordance with the law, the Board's determination of the evidence is not and its evidence with the law and the defendant is a matter, therefore, is not and is not.

Respectfully,
The Court of Appeals, First Circuit Judge, said that the defendant's evidence was not in accordance with the law.

Datamize v Plumtree Software (Fed. Cir. 2005)

DATAMIZE, LLC, Plaintiff-Appellee,

v.

PLUMTREE SOFTWARE, INC.,

Defendant-Appellee.

No. 04-1584.

Circuit Court of Appeals,

Patent Division.

May 5, 2005.

Background: Patent holder brought action against defendant alleging infringement of patent for software program.

REVEREND, JUDGE

1. **Plaintiff-Appellee**

Plaintiff's complaint of infringement and damages is based on the fact that the defendant's software program is identical to the plaintiff's software program.

The defendant's software program is identical to the plaintiff's software program.

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[in an electronic kiosk system ...] providing a plurality of pre-defined interface screen element types, each element type defining a form of element available for presentation on said custom interface screens, wherein each said element type permits limited variation in its on-screen characteristics in conformity with a desired uniform and aesthetically pleasing look and feel for said interface screens on all kiosks of said kiosk system,

According to the Supreme Court, “[t]he statutory requirement of particularity and distinctness in claims is met only when [the claims] clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise.”

The definiteness requirement, however, does not compel absolute clarity. Only claims “not amenable to construction” or “insolubly ambiguous” are indefinite. Thus, the definiteness of claim terms depends on whether those terms can be given any reasonable meaning.

Furthermore, a difficult issue of claim construction does not ipso facto result in a holding of indefiniteness. “If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds.”

Why not have a strict definiteness requirement?

NEXT CLASS

NOVELTY REQUIREMENT I

PATENT LAW & POLICY
PROFESSOR WAGNER

