Industry & Invention
Patent

Utility Patents: Disclosure

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- Patentable subject matter
- Novelty
- Nonobviousness
- Utility
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35 U.S.C. § 112(a)

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 or joint inventor of carrying out the invention.

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There are at least two key reasons for the requirements of § 112(a):

- Forcing the inventor show that they **actually invented** the invention they are claiming.
- Forcing the inventor to fulfill the implicit bargain of the patent system by ensuring that after the exclusive rights expire, **society at large will have full benefit of the invention**.

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Traditionally three requirements are identified in § 112(a) …

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Three requirements under the heading of what we're calling the disclosure requirement

- enablement
- written description
- best mode

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Enablement

The specification must enable a PHOSITA "to make and use" the invention "without undue experimentation."

- Recall that the "specification" is the patent's drawings and descriptions – the part of the patent other than the claims.
- "PHOSITA" is the popular name for the hypothetical Person Having Ordinary Skill In The Art.
  - (The PHOSITA is used for nonobvioiusness, too.)

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Written Description

The "written description" requirement is generally recognized as distinct from "enablement." (But there is some overlap.)

The essence is that the inventor shows they are in possession of the invention they are claiming at the date of filing.

The requirement is used to prevent abuses of applicants amending claims to capture later developed technology—i.e., advances since the filing date.

Guarding against overbroad claims for things not yet invented …

- In Morse's telegraph patent, he claimed specific embodiements of his invention. Then he threw in a very broad claim as Claim 8: "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."
- *O'Reilly v. Morse* (U.S. 1853) invalidated Claim 8, refusing Morse patent rights to a "manner and process which he has not described and indeed had not invented."
- In modern terms, this could be construed as a failure of enablement, a failure of written description, or both.

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Best Mode

- Although the specification can be abstract and embracing of many different modes of making and using the invention, and the claims can embrace many embodiments, in the specification the inventor must set forth the best mode for making and using the invention.
- This can be seen as stopping the inventor from keeping key insights away from the public—holding on to valuable trade secrets over the invention notwithstanding the patent grant.
- Before the AIA, infringement defendants could get a patent invalidated on failure to disclose the best mode. Since the AIA, however, this requirement, while extant, has little teeth.

Related, practical DIY advice from David Pressman's *Patent It Yourself* (1/2)

In writing the specification of a patent application … your goal is to disclose clearly everything you can think of about your invention. In case of doubt as to whether or not to include an item of information, put it in. … As part of doing this, it may help if you keep well in mind the "exchange theory" of patents. …

Related, practical DIY advice from David Pressman's *Patent It Yourself* (2/2)

Another reason for disclosing as much as you can about your invention is ... to block others from getting a subsequent improvement patent on your invention. ... If you get a patent that shows only that one embodiment [that you disclosed], someone may later see your patent and think of another embodiment ... that may be better than yours. [They can get a patent on the improvement, and then] you won't be able to make, use or sell the improvement without a license from the person who owns that patent.