

**Sufficiency of Disclosure – Prosecution vs. Enforcement  
A Comparative National and International Approach**

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## Four-way Comparison of Sufficiency of Disclosure Practice

- I. **USPTO/US courts**
- II. **EPO/selected European country courts**
- III. **USPTO/EPO**
- IV. **US courts/selected European country courts**

## Overall Impression

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- Application of **US** law on sufficiency of disclosure is **unified** because of one country, one reviewing court
- **US** law on sufficiency of disclosure is **complicated** and harder to understand
- **European** law is **simpler**: only one requirement
- European **application** can be **inconsistent** despite generally harmonized laws because of **lack of common court** reviewing at least the national courts

## Rationale for Sufficient Disclosure

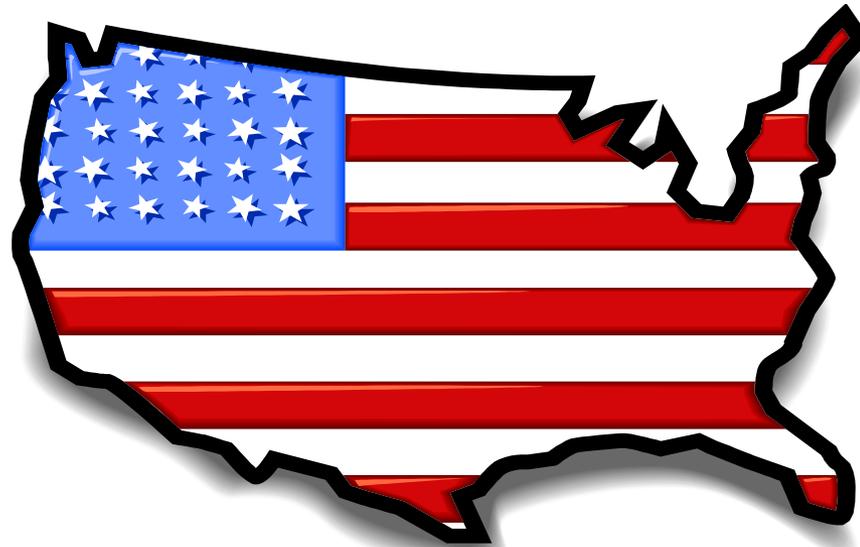
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- In **exchange** for a **monopoly** for a limited time, the inventor or patent proprietor must **teach** the public how to **make and use** her invention
- This **bargain** is **violated** if the inventor or patent proprietor **fails** to provide this teaching, whether intentionally or not
- The **penalty** for an insufficient disclosure may be **denial** of an **application** during the prosecution phase **or revocation** of all or part of a **patent** after grant

## National Approaches

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### The United States of America



## 35 U.S.C. § 112, First Paragraph

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- “ *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.* ”
- Courts hold that **35 U.S.C. § 112, 1st paragraph** contains **three** separate and distinct **requirements** for the specification

## 35 U.S.C. § 112, First Paragraph

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- Courts hold that **35 U.S.C. § 112, 1st paragraph** contains **three** separate and distinct **requirements** for the specification:
  - Provide a **written description** of the invention
  - Provide an **enabling** disclosure (teach the manner and process of practicing the invention)
  - Disclose the inventor's **best mode** of carrying out the invention
- The “invention” is the **claimed subject matter**.

## Written Description

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### *Goals of the Written Description Requirement*

- Describe the technology that is sought to be patented in sufficient detail that one skilled in the art can reasonably conclude that the **inventor had possession** of the claimed invention.

### *Compare to Enablement and Best Mode Requirements*

- Describing the invention does not necessarily teach **how to make and use the invention** or the inventor's **best way** to do so. A limitation added later may be enabled but not described in the original application.

## Enablement

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- Any analysis of whether a particular claim is supported by the disclosure in an application or patent requires a **determination** of whether that disclosure, **when filed**, contained sufficient information regarding the subject matter of the claims as **to enable one skilled in the pertinent art to make and use the full scope of the claimed invention**
- *In re Wands* test: the test of enablement is whether one reasonably skilled in the art could **make or use the invention** from the disclosures in the patent coupled with information known in the art **without undue experimentation**.

## Best Mode

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- Section 15(a) of H.R. 1249, the Leahy-Smith America Invents Act, provides 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.**” This section is applicable to all
- Disclosing the **best mode** in the application, however, is **still a requirement** for patent applications and failure to disclose is still a basis for invalidating patent claims in proceedings brought **before the enactment of the Act.**

## Best Mode(Ct' d)

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- Determining compliance with the best mode requirement requires a **two-prong inquiry**:
  - First, it must be determined whether, **at the time the application was filed**, the inventor possessed a mode she **considered** to be **best** for practicing the invention.
  - Second, **if** the inventor did possess a **best mode**, it must be determined whether the written **description disclosed** the **best mode** such that a person skilled in the art could **practice** it.

## USPTO Application of the 112 Requirements

- Examiners determine whether the specification meets **ALL THREE REQUIREMENTS.**
- Examiners **do not presume** the claims to be valid and give the claims the **broadest reasonable interpretation**
- The applicant may **rewrite claims** to avoid problems with the disclosure, either in the original application or in a reissue application
- Examiners have technical expertise and training in patent law, but **cannot spend much time** examining an application
- **New post-grant review proceeding** will allow challenge in the USPTO to a newly-granted patent on grounds of insufficient disclosure other than failure to disclose best mode but this procedure will not apply to all patents until **March 16, 2013**

## USPTO Written Description Practice

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- **Strong presumption** exists that the specification has an **adequate written description** of the invention of an original claim. Rejection of such claims on that ground is very rare
- The issue is more likely to come up when a claim is amended or added, or priority for a claim is sought from an earlier domestic or foreign application
- If a **claim** is **amended** to include subject matter, limitations, or terminology **not present** in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner will conclude that the **claimed** subject **matter** is **not described** in that application

## USPTO Written Description Practice (ctd)

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- An applicant may **show possession** of the claimed invention by:
  - describing the claimed invention with **all of its limitations** using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention
    - Combination of **structural and functional** limitations
  - describing an **actual reduction to practice**
  - describing **distinguishing identifying characteristics** sufficient to show that the applicant was in possession of the claimed invention

## USPTO Enablement Practice

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- The examiner will assume that the **specification satisfies** the enablement requirement if it contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented
- **Exception**: the examiner has a **reasonable doubt** about the objective truth of the statements in the specification.
- Once the examiner has made a **reasoned case** for lack of enablement, the **burden** of persuasion and going forward **shifts** to the applicant, who may submit arguments and evidence

## USPTO Enablement Practice(C' td)

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- Enablement must be **commensurate** with the **scope** of the claims
- The specification must be **enabling** as of the **relied-on filing date**
- The **scope** of the required enablement **varies inversely with** the degree of **predictability** involved, but even in unpredictable arts, a disclosure of every operable species is not required

## USPTO Best Mode Practice

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- Leahy-Smith America Invents Act did **not remove** the obligation for the applicant to disclose **the best mode** of practicing the invention
- The examiner **will assume that the best mode is disclosed in the application**, unless evidence is presented that is inconsistent with that assumption.
- It is **extremely rare** that a best mode rejection properly would be made in *ex parte* prosecution.

## US Courts

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- A finding that **just one** of the requirements is not met will **invalidate** the corresponding claim(s)
  - Patent claims are presumed to **be valid**
  - **Clear and convincing evidence** is required to invalidate a claim
- **No cure** or amendment is **possible** with respect to claim(s) **lacking** proper **support** in the specification
  - **Reissue** of the patent, **however**, may be **available** after issue of the patent and claims may be amended in reexamination proceedings

## US Courts (C' td)

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- The courts of **first instance** (district courts, Court of Federal Claims, U.S. International Trade Commission) **do not specialize** in only patent cases
- The **judges** of the courts of first instance will be **generalists** lacking a technical background. The plaintiff **may** demand a **lay jury** in the district courts
- **Appeals** from patent cases go to only one court, the **Federal Circuit**, which has a varied subject matter jurisdiction and has judges who often lack a technical background
- The Federal Circuit **also** hears all appeals **from the USPTO** and **Section 145** original actions
- The **Supreme Court** occasionally reviews the Federal Circuit

## Comparative Issues USPTO/US courts

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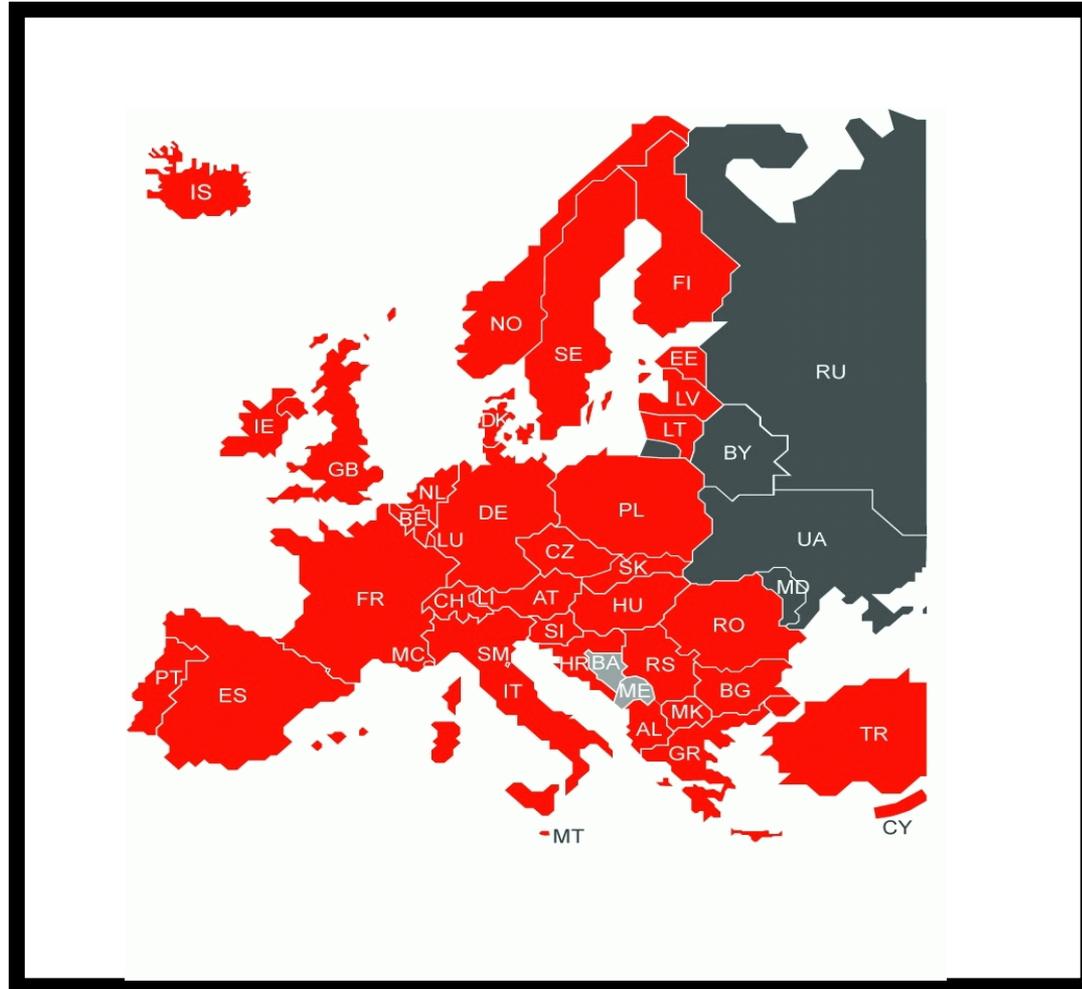
- **Both** apply the **same** federal patent **law**
- **USPTO** gives **no presumption** of validity to patent applications and patents in reissue and reexamination proceedings whereas **courts** must **presume** that patents are **valid**. **The new post-grant review proceeding, however, will require only preponderance of the evidence.**
- The courts of **first instance** require **clear and convincing** evidence to invalidate patents

## Comparative Issues USPTO/US courts (C' td)

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- **Issues** that are usually **not significant** in the **examination** stage, such as written description and best mode, can be more **significant** in the **courts**
- An applicant can **amend** claims before the **USPTO** in order to deal with insufficient disclosure
- The patentee **cannot** amend claims in **court** (*but will be able to do so in the new post-grant review proceeding*)

# Europe (European Patent Organization)



## Article 83 and 84 EPC

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### Article 83 EPC:

- The European patent application shall disclose the invention in a manner **sufficiently clear and complete** for it to be **carried out** by a **person skilled in the art**.

### Article 84 EPC:

- The claims shall define the matter for which protection is sought. They shall be **clear and concise** and be **supported** by the description.

## Rule 42 EPC:

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- The description shall:
  - a) specify the **technical field** to which the invention relates;
  - b) indicate the **background** art which, as far as is known to the applicant, can be regarded as useful to understand the invention, draw up the European search report and examine the European patent application, and, **preferably, cite the documents** reflecting such art;

## Rule 42 EPC:

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- The description shall:
  - c) disclose the invention, as claimed, in such terms that the **technical problem**, even if not expressly stated as such, and its solution can be **understood**, and state any **advantageous effects** of the invention with reference to the background art;

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- e) describe in detail **at least one way of carrying out the invention claimed**, using examples where appropriate and referring to the drawings, if any.

## Sufficiency of Disclosure, EPC

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- A European patent application **must** contain:
  - **sufficient information** to allow a person skilled in the art, using her common general knowledge
  - to perceive the **technical teaching** inherent in the claimed invention and to **put it into effect**
- The disclosure of the invention **must** permit the invention to be **reproduced without undue burden**
- An **insufficient** disclosure may **not** be **cured** by adding disclosure **after** the date of filing

## Prosecution in the EPO

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- The European patent examiner **will examine** the application to determine the **sufficiency** of disclosure
- Insufficiency is **grounds** for **refusing** a patent and may be a basis of an **opposition** under *Article 100(b) EPC*
- The **technical problem** solved by the invention need **not** be **specifically identified** as such
- The EPC and its implementing rules are the **only governing law** and have nothing to do with national law
- The EPO **harmonizes** the application of the EPC using the **Enlarged Board of Appeal**

## European National Courts

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- Currently, **patent infringement** and related **post-opposition** period validity challenges are tried **exclusively** by **national** courts
- Article **138(1)(b) EPC**
  - permits a national court to revoke a European patent “with **effect for a Contracting State**” due to insufficiency of disclosure
- National courts apply **national patent law**, although in general they have **amended** their national laws so that patents issued by their national patent offices and the EPO should be judged by the **same standard**
- **No single court** reviews the decisions of the national courts. The **national courts can disagree** on the validity of a patent facing an insufficient disclosure attack

(19)  **Europäisches Patentamt**  
**European Patent Office**  
**Office européen des brevets**



(11) **EP 0 455 750 B1**

(12) **EUROPEAN PATENT SPECIFICATION**

- (45) Date of publication and mention of the grant of the patent:  
**24.11.1999 Bulletin 1999/47**
- (21) Application number: **90904485.1**
- (22) Date of filing: **16.01.1990**
- (51) Int. Cl.<sup>6</sup>: **B42D 15/00**
- (86) International application number:  
**PCT/US90/00221**
- (87) International publication number:  
**WO 90/08046 (26.07.1990 Gazette 1990/17)**

(54) **METHOD OF MAKING A NONREPLICABLE DOCUMENT**

VERFAHREN ZUR HERSTELLUNG EINES FÄLSCHUNGSSICHEREN DOKUMENTS  
 PROCEDE DE PRODUCTION D'UN DOCUMENT NON REPRODUCTIBLE

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|--|---|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|------------------------|--|
| <p>(84) Designated Contracting States:<br/> <b>AT BE CH DE DK ES FR GB IT LI LU NL SE</b></p> <p>(30) Priority: <b>18.01.1989 US 298020</b></p> <p>(43) Date of publication of application:<br/> <b>13.11.1991 Bulletin 1991/46</b></p> <p>(60) Divisional application:<br/> <b>99102243.5 / 0 938 981</b></p> <p>(73) Proprietor: <b>WICKER, Ralph, C</b><br/> <b>Rochester, NY 14607 (US)</b></p> <p>(72) Inventor: <b>WICKER, Ralph, C</b><br/> <b>Rochester, NY 14607 (US)</b></p> | <p>(74) Representative:<br/> <b>Wagner, Karl H., Dipl.-Ing. et al</b><br/> <b>WAGNER &amp; GEYER</b><br/> <b>Patentanwälte</b><br/> <b>Gewürzmühlstrasse 5</b><br/> <b>80538 München (DE)</b></p> <p>(56) References cited:</p> <table border="0"> <tr> <td><b>EP-A- 0 046 327</b></td> <td><b>DE-C- 3 602 563</b></td> </tr> <tr> <td><b>GB-A- 1 138 011</b></td> <td><b>GB-A- 2 217 258</b></td> </tr> <tr> <td><b>US-A- 0 027 857</b></td> <td><b>US-A- 0 341 429</b></td> </tr> <tr> <td><b>US-A- 2 065 605</b></td> <td><b>US-A- 2 952 080</b></td> </tr> <tr> <td><b>US-A- 3 109 239</b></td> <td><b>US-A- 3 675 948</b></td> </tr> <tr> <td><b>US-A- 3 862 501</b></td> <td><b>US-A- 4 033 059</b></td> </tr> <tr> <td><b>US-A- 4 066 280</b></td> <td><b>US-A- 4 168 088</b></td> </tr> <tr> <td><b>US-A- 4 506 914</b></td> <td><b>US-A- 4 525 858</b></td> </tr> <tr> <td><b>US-A- 4 579 370</b></td> <td><b>US-A- 4 582 346</b></td> </tr> <tr> <td><b>US-A- 4 588 212</b></td> <td></td> </tr> </table> | <b>EP-A- 0 046 327</b> | <b>DE-C- 3 602 563</b> | <b>GB-A- 1 138 011</b> | <b>GB-A- 2 217 258</b> | <b>US-A- 0 027 857</b> | <b>US-A- 0 341 429</b> | <b>US-A- 2 065 605</b> | <b>US-A- 2 952 080</b> | <b>US-A- 3 109 239</b> | <b>US-A- 3 675 948</b> | <b>US-A- 3 862 501</b> | <b>US-A- 4 033 059</b> | <b>US-A- 4 066 280</b> | <b>US-A- 4 168 088</b> | <b>US-A- 4 506 914</b> | <b>US-A- 4 525 858</b> | <b>US-A- 4 579 370</b> | <b>US-A- 4 582 346</b> | <b>US-A- 4 588 212</b> |  |
| <b>EP-A- 0 046 327</b>   | <b>DE-C- 3 602 563</b>  |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |  |
| <b>GB-A- 1 138 011</b>   | <b>GB-A- 2 217 258</b>  |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |  |
| <b>US-A- 0 027 857</b>   | <b>US-A- 0 341 429</b>  |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |  |
| <b>US-A- 2 065 605</b>   | <b>US-A- 2 952 080</b>  |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |  |
| <b>US-A- 3 109 239</b>   | <b>US-A- 3 675 948</b>  |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |  |
| <b>US-A- 3 862 501</b>   | <b>US-A- 4 033 059</b>  |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |  |
| <b>US-A- 4 066 280</b>   | <b>US-A- 4 168 088</b>  |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |  |
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| <b>US-A- 4 588 212</b>   |   |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |                        |  |

## Lack of Consistency

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### *EP 0 455 750 B1*

- European patent issued **without opposition** and **nationalized** in AT, BE, DE, ES, FR, GB, IT, LU, NL
- European Central Bank brought proceedings for **revocation/nullification** in the courts of these countries
- As of 2010, the **patent** was **upheld** in **DE, ES, and NL**
- Patent was **revoked/nullified** in **AT, BE, FR, GB**
- **Infringement** proceedings were underway in **DE, ES, and NL**

## France

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- Patent **infringement** actions may be brought only before certain **Tribunaux de Grande Instance**.
  - Issues of **invalidity** are dealt with by **these courts**.
- **Invalidity** is a **defense** and the defendant may **counterclaim** for revocation of the patent

## Germany

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- **Infringement** and **validity** of patents are determined by **different** courts in Germany
- The Federal Patent Court (**Bundespategericht**) is the court of first instance for declarations of patent **nullity** and can nullify a patent for insufficient disclosure
- District courts (**Landsgerichte**) decide patent **infringement** cases
- District courts have to decide the **scope of the claims** as interpreted with the help of the specification and drawings (Article 14 of the German patent law).
- An **insufficient disclosure may limit the scope** of the claims in **infringement** proceedings

## Italy

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- **Infringement** actions are brought in **special IP sections** of 12 district courts (**Tribunale**). These courts may determine both **validity** and **infringement** issues.
- The court will most likely **appoint an expert** to advise the judges on **technical issues**

## United Kingdom

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- A patent may be **revoked** under **Section 72.-(1)(c)** of the United Kingdom's Patents Act 1977 (as amended) “if the specification of the patent does **not** disclose the invention **clearly enough and completely enough** for it to be **performed** by a person skilled in the art.”
- Application for revocation may be to the **court** in **infringement** proceedings or to the **comptroller** in **revocation** proceedings
- The revocation may be **in whole or in part**
- The patent owner **may amend** the patent in either **infringement** or **revocation** proceedings with the **permission** of the court or the comptroller

## Comparison of Approach: EPO/European National Courts

- **EPO** and the European national **courts** apply the **same enablement standard** for sufficiency of disclosure
- The national **courts** will look to **EPO** precedent for **guidance**. The **EPO** does **not consider national** patent laws or cases to be precedent
- The EPO is **self-reviewing**
- **No** court **reviews** the **national** courts

## US/European Comparison: Legal Framework

- **No** requirement to disclose a **subjective best mode** in Europe; currently **required** in **US**
- **Enabling** disclosure **required** in **both** Europe and US
- **Europe** does **not** have a “ **written description** ” requirement like that of the US

## USPTO / EPO Comparison

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- **USPTO reviews** applications for compliance with **three requirements**
- **EPO reviews** applications for compliance with only **one** requirement
- Both **USPTO** and **EPO prohibit cure** of insufficient disclosure **by** addition of **new matter** in the prosecution stage
- **USPTO decisions** to reject an application on the basis of insufficiency of disclosure are **reviewed** by **same court** that reviews courts of **first instance**
- **EPO** is **independent** of any **national** court but the **national** courts **rely** on **EPO** appeal decisions for guidance

## US Courts/European National Courts

- The **US** courts of **first instance** are **reviewed** by the **same court**, which also reviews the **USPTO**
- **European** courts are **independent** of **each other** and may reach **divergent** decisions on the same European patent
- **European courts** may be **specialized** courts as in DE and GB **or generalist** courts as in FR and IT
- **US courts** have **diverse** subject matter **jurisdiction** and the **judges** are usually **not technically** trained
- **US courts** will allow **a lay jury** to determine if a patent is invalid for lack of sufficient disclosure
- **US courts don't** allow **amendment** of claims although may stay litigation for reexamination

## Thank you for attending

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