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Patent Filing Requirements (Final of a Three Part Series)

A patent application generally consists of:

- (1) A **description** of the invention, and
- (2) One or more **claims** that define the inventor's patent rights.

Although the patent examination process focuses primarily on the claims, it is important for the inventor to review the adequacy of the description for compliance with the three requirements of 35 U.S.C. 112, First Paragraph under U.S. patent law:

- (1) A written description of the invention;
- (2) The enablement requirement; and
- (3) The best mode contemplated by the inventor of carrying out the invention.

Failure to comply with these requirements could result in the denial of a patent.

This issue will help the inventor understand what it takes to satisfy the third of the three requirements referenced above. Please reference Collaboration Corner Volume 3, Number 11 (1) for Part 1 and Volume 4, Number 3(1) for Part 2.

Part 3: Best Mode

Policy Considerations – The United States Founding Fathers recognized that a strong patent system is important to enhancing commerce and rewarding innovation. They also recognized that the publication of new inventions helps to foster and enhance the development of new ideas and the advancement of scientific knowledge. “The best mode requirement creates a statutory bargained-for-exchange by which a patentee obtains the right to exclude others from practicing the claimed invention for a certain time period, and the public receives knowledge of the preferred embodiments for practicing the claimed invention.” *Eli Lilly & Co. v. Barr Laboratories Inc.*

How to Satisfy the Best Mode Requirement – Determining compliance with the best mode requirement requires a two-prong inquiry:

- (1) Whether, at the time the application was filed, the inventor possessed a best mode for practicing the invention; and
- (2) 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.

There is no requirement for the applicants to point out which of their embodiments they consider to be their best. However, failure to disclose the best mode may result in the rejection of the patent application or invalidation of an issued patent regardless of whether or not such failure was intentional. Furthermore, if the failure to set forth the best mode in a patent disclosure is the result of inequitable conduct (such as omitting crucial ingredients and disclosing fictitious ones instead), not only is the patent in danger of being held unenforceable, but other related patents by the inventor dealing with the same technology may also be held unenforceable.

The UH Technology Management Office is available to assist with these and other matters related to patent applications.

Contact CCRT's Technology Management Office

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