

Spectra-Physics, Inc. v. Coherent, Inc., 827 F. 2d 1524 (Fed. Circ. 1987)

US Court of Appeals for the Federal Circuit

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Summary

This case addresses the distinction between the requirements to disclose an invention to the public in general terms (enablement) and the separate requirement to disclose the best mode of carrying out the invention. The district court found the patents at issue invalid due to lack of enablement. The United States Court of Appeals (hereinafter: the Court) affirmed the judgment of the district court, but on different legal grounds, i.e. due to the failure to disclose the best mode of practicing the invention.

The facts

Coherent and Spectra-Physics, each, specialize in designing, manufacturing and marketing laser systems. In order to manufacture a laser which would be reliable enough for a commercially acceptable product it was essential for them to develop a laser with a suitable bond between so-called "copper cup" and "ceramic tube". Before 1981 both Coherent and Spectra-Physics had made several attempts - but without success. In 1981 an engineer, Wayne Mefferd, was brought into Coherent's team to solve the attachment problem and develop a suitable bond. His solution was *brazing*, which eventually resulted in Coherent's INNOVA laser, embodying the inventions of the patents in suit. The patents disclosed titanium-copper-silver "TiCuSil" as the preferred brazing material which required only one step. However, Mefferd knew that there were tradeoffs in the one-step braze cycle he had developed. In assessing the tradeoffs, he developed a six-stage cycle which produced much more reliable braze joint than the one-step cycle. The six-stage cycle was not disclosed in the patent claims. After Coherent introduced its INNOVA laser in 1981, Spectra-Physics resumed its work on its laser and hired a brazing expert, Dr. Leonard Reed, to develop a moly-manganese process for attaching the cups to the ceramic tube. Eventually, Spectra-Physics introduced its model "2020", which was based upon Coherent's laser technique. Spectra-Physics brought a declaratory judgment action against Coherent asking a holding of invalidity and non-infringement of Coherent's patents. Coherent counterclaimed for infringement and an adjudication of validity.

The legal issues

Both the district court and the Court found that Coherent's patents were invalid. The Court disagreed with the district court's view that the TiCuSil brazing technique was not adequately disclosed. Conversely, it found that Coherent had not adequately disclosed the best means truly known to the inventors.

The Court stated that the rationale behind the enablement requirement was to place the subject matter of the claims generally in the possession of the public. If, however, the applicant developed specific instrumentalities or techniques which were recognized by the applicant at the time of filing as the best way of carrying out the invention, then the best mode requirement imposed an obligation to disclose that information to the public as well. The Court stated:

"The essence of the enablement requirement is that a specification shall disclose an invention in such manner as will enable one skilled in the art to make and utilize it. Separate and distinct from enablement is the best mode requirement, the essence of which requires the inventor to disclose the best mode contemplated by him, as of the time he executes the application, of carrying out his invention. Manifestly, the sole purpose of this latter requirement is to restrain inventors from applying for patents while at the same time concealing from the public preferred embodiments of their inventions which they have in fact conceived.

[...]

*The situation before us is one in which the patent specifications disclose more than one means for making the claimed invention, but do not adequately disclose the best means actually known to the inventors. The district court recognized that the specifications were inadequate under Sec. 112, but incorrectly based its decision on a lack of enablement. As we explain, the problem is really one of best mode, and thus, while we disagree with the district court's views on these issues, the judgment that the patents are both invalid was correct and must be sustained."*¹

The Court ruled that if an invention pertained to an art where the result was predictable, e.g., mechanical as opposed to chemical arts, a broad claim may meet the enablement requirement even where it reads on another embodiment of the invention which was inadequately disclosed. The Court concluded:

"Coherent's failure to disclose its "six stage braze cycle" fully supports the defense of non-compliance with the best mode requirement of the first paragraph of Sec. 112 although the inventions as broadly claimed can be practiced without knowledge of it, which means that the patent specifications are enabling. The trial court evidently had a grasp on the essential facts but somehow got them into the wrong legal pigeonholes. With the aid of lawyers, this is not difficult to do.

*Spectra's claim in this declaratory judgment complaint that the two patents in suit are invalid must therefore be sustained on the ground that they fail to disclose the best mode contemplated by the inventors for practicing their respective inventions. 35 U.S.C. §§ 112 and 282.*²

¹ See under *1. Introduction--Adequate Disclosure Under Sec. 112*, 1st of the decision.

² See under *b. Adequate Disclosure of Best Mode* of the decision.

Points of significance

The Trips Agreement - Article 29 paragraph 1

- It is mandatory for WTO Members to require the patent holder to disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art. This corresponds to the enablement requirement discussed in this case.
- Members have flexibility to determine whether the patent holder must reveal the best method for carrying out the invention.

United States

- The *best mode* requirement is a separate and distinct requirement from the *enablement* requirement of 35 U.S.C. 112(a) or the first paragraph of pre-AIA (the Leahy Smith America Invents Act) 35 U.S.C. 112.³
 - a) The requirement to make the patent *enabling* ensures that the issued patent is actually a useful document from which the public can benefit.
 - b) The *best mode* requirement ensures that the inventor has not withheld information from the public about any “preferred embodiment” of the invention of which he or she may be aware when filing the patent application.
- Since the United States’ first Patent Act of 1790, the laws have required the disclosure of the best means known to the inventor of carrying out their invention as of the filing date of a patent application.⁴
- As part of the enactment of the AIA in 2011, failure to disclose the “best mode” in a patent application can no longer be used in a civil litigation as a ground to invalidate a patent. The elimination became effective immediately upon enactment, September 16, 2011.⁵
 - Defendant will thus no longer be able to invalidate a patent claim because of a failure by a patentee to disclose the best mode in its patent. This means that the case at hand would have been decided differently under the new legislation. Coherent’s patents would have been upheld.
 - However, the AIA did not alter the best mode requirement of 35 U.S.C. § 112, which still sets forth the requirement that patent applicants disclose

³ See generally *Bayer AG v. Schein Pharm., Inc.*, 301 F.3d 1306, 1314 (Fed. Cir. 2002) (stating that “[t]he best mode requirement is ‘separate and distinct’ from enablement . . .”) (Citing *In re Gay*, 309 F.2d 769, 772 (C.C.P.A. 1962)).

⁴ <http://www.stroock.com/siteFiles/Pub1137.pdf>

⁵ <http://www.stroock.com/siteFiles/Pub1137.pdf>

the best mode of practicing their invention in patent applications submitted to the United States Patent Office ("USPTO")⁶

- Despite the elimination of the best mode defense, it has been stated that patent applicants and practitioners will likely continue to disclose the best mode of practicing inventions in patent applications.⁷

Europe

- In contrast, European patent law does not require inclusion of the best mode in a patent applications. Article 83 of the European Patent Convention (EPC) only requires the inclusion of at least one method of practicing the invention.

Key words:

Patent, Patentability, Best Mode Requirement, Enablement Requirement, Disclosure.

Available at:

<https://law.justia.com/cases/federal/appellate-courts/F2/827/1524/3298/>

⁶ <http://www.uspto.gov/web/offices/pac/mpep/s2107.html>

⁷ <http://www.uclalawreview.org/?p=3629>