

# ENABLEMENT REQUIREMENT OF PATENTABILITY

## **Introduction**

Various patentability criteria have to be met for an invention to be patentable. One such patentability criterion relates to sufficiency of disclosure of the invention in a patent application. The instant criterion is commonly referred to as the enablement requirement of patentability. Broadly, the benchmark for meeting the enablement requirement of patentability is uniform across most countries. Further, most countries also require the disclosure of the best mode of carrying out the invention.

#### TRIPS Agreement

Trade-Related Aspects of Intellectual Property Rights (TRIPS) agreement obligates its members (member countries) to include a mandatory requirement that an applicant for a patent in their jurisdiction should provide a disclosure that enables a person skilled in the art to practice the invention. However, the TRIPS agreement makes it optional for its members to seek disclosure of best mode from patent applicants in their jurisdiction. Article 29(1) of the TRIPS agreement that deals with enablement requirement and disclosure of best mode is quoted below.

"1. Members <u>shall require</u> that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and <u>may require</u> the applicant to indicate the <u>best mode</u> for carrying out the invention known to the inventor at the filing date or, where priority is claimed, at the priority date of the application." (Emphasis added by the Author)

# **Implementation of TRIPS Agreement**

The current implementation of Article 29(1) of the TRIPS agreement by the European Patent Convention (EPC) is more patent applicant friendly than the US, and the implementation by the US is more patent applicant friendly compared to the implementation by India.

In the United States and India, 35 U.S.C. 112 and Section 10(4) of the Indian Patent Act, respectively, require disclosure of best mode of carrying out the invention, as contemplated by the inventor(s). In contract, EPC does not obligate the patent applicant to disclose the best mode of carrying out the invention. Article 83 of the EPC only requires the disclosure of the



invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Even though the United States and India require disclosure of best mode, the implication, post grant of patent, of not disclosing the best mode is staggeringly different. Prior to America Invents Act (AIA), failure to disclose best mode was one of the grounds for invalidating a patent in the US. However, AIA has removed failure to disclose best mode as a ground for invalidating a claim of a patent. In other words, the USPTO may raise objection to grant a patent on the grounds that best mode is not disclosed. However, once the patent is granted in the US, the patent's validity cannot be challenged based ground that best mode is not disclosed in the patent specification.

On the other hand, in India, failure to disclose best mode is a ground to challenge the validity of a patent. Section 64(1)(h) of the Indian Patent Act allows challenging the validity of a patent on the ground that the complete specification does not disclose the best method of performing the invention which was known to the applicant for the patent.

## Conclusion

Companies with patent portfolios spread across multiple jurisdiction should be wary of subtle yet impactful differences in patent laws of different countries. Taking into consideration such differences can lead to strategies for, drafting good patent specifications that may be filed in multiple jurisdictions, prosecuting patent applications and enforcing patent rights.

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Best regards – Team InvnTree

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