



## “Possession” – Beyond Enablement

The Emerging Disclosure Requirement

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## “Possession” – Beyond Enablement

- Enablement: Sole TRIPS Disclosure Requirement
- TRIPS Article 29(1): A “disclos[ure]... sufficiently clear and complete for the invention to be carried out by a person skilled in the art....”
- There must be an *enabling* disclosure

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## 35 USC § 112, ¶ 1

- The specification shall [disclose] the manner and process of making and using [the invention], in such full, clear, concise, and exact terms as to enable any person skilled in the art... to make and use the [the invention]....



## Beyond Enablement: Enzo Possession

*Enzo*: Specification must also have “written description” to establish *possession* of the invention at the filing date

Examples in the specification as filed



## Chief Judge Paul Michel on Possession:

“[T]he greatest needs of nearly all patent systems is [first,] [b]etter claim drafting *especially linkage to the written description to each claim.*”

– Chief Judge Paul Michel (2006)

Hon. Paul Michel, *Optimizing Balances between Patentees and Rivals*, principal plenary address on May 23, 2006, to the FICPI World Congress in a session, Balancing fair protection of inventions with a reasonable degree of certainty to third parties, <http://www.ficpi.org/>.

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## European “Plausibility”

Only *some* of the Technical Boards of Appeal have established this requirements

Problem and solution may not be “plausible” without evidence in the specification

Defect is *Fatal* if Information is not part of Original Specification

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## EPO Plausibility Internal Conflicts

- Split amongst the Technical Boards of Appeal
- What has been said by the EPO Enlarged Board of Appeals?



## EPO Enlarged Board of Appeals

The President *should* refer the plausibility conflict to the Enlarged Board

A Technical Board *also* should refer the conflict

Neither the President nor a Technical Board has lived up to obligations

Balkanized EPO Precedent



## “Possession” as of the Priority Date?

- Kawai (CCPA 1973)
- § 112, ¶ 1, required as of priority date



## Does Paris Require “Possession”?

- The only stated disclosure requirement for priority based upon a “home country” application is found in Art. 4H of the Paris Convention



## Paris Convention Article 4H

“Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that ***the application documents as a whole specifically disclose such elements.***”



## “Completion” as of the Priority Date?

■ Hoechst (Tokyo High Court 1977)

Japanese Patent: Working Examples to prove enablement

German Priority Case: Full Enablement without Working Example

Priority denied: No “Completion” Proven as of Priority Date



## **Hoechst – Globally Criticized**

Retaliation Against American *Kawai*

Leading Commentaries:

T. Aoyama, *The Hoechst Case - A New Kawai*, 59 JPOS 263 (1977);

Lutz Walter, *Comment*, 8 IIC 566, 570 (1977).



## **European “Plausibility” and Paris Priority**

If it is a requirement of European patent law that a particular invention have a disclosure of an example in the *original* specification, and if the identical disclosure was earlier filed in the United States or Japan, *but without the “plausibility” evidence*, should Paris Convention priority be denied?