

OCTOBER 27, 2006

Go Medical Indus. Pty., Ltd. v. Inmed Corp.

Nos. 05-1241, -1267, -1588, Federal Circuit (*Michel*, Archer, Linn)

In determining whether the best mode requirement of 35 U.S.C. § 112, ¶ 1 is met, we first determine whether [the inventor] subjectively considered a particular mode of practicing the invention to be superior to all other embodiments at the time [the] application was filed. If so, we then ask whether he provided a sufficient disclosure to allow others to practice that best mode.

On October 27, 2006, the Federal Circuit, *inter alia*, affirmed the district court's summary judgment that U.S. Patent No. 4,652,259, which related to a urinary catheter, was invalid as anticipated by the inventor's 1982 article because the '259 patent was not entitled to claim a 1979 priority date for failure to disclose the best mode under 35 U.S.C. § 112, ¶ 1. The Federal Circuit stated:

A patent application for an invention disclosed in a previously-filed application in a manner that satisfies all the requirements of 35 U.S.C. § 112 is entitled to the benefit of the earlier filing date. A continuation-in-part application "contains subject matter from a prior application and may also contain additional matter not disclosed in the prior application." New subject matter does not receive the benefit of the earlier priority date.

The claims of the '259 patent require the catheter sheath to be inserted "about 1.5 cm" or up to (but not beyond) a "known position of maximum pressure." The specification of the 1979 application discloses that "the stop means can be set [at] a predetermined distance along the sheath depending on the usual extent of bacteria within the passage." ... The specification further discloses that the sheath should be inserted "to an extent whereby its distal end penetrates beyond bacteria disposed adjacent the proximal end of the passage," such that in at least one embodiment, the distal end of the cover is at the area marked "X" in Figure 1.

In determining whether the best mode requirement of 35 U.S.C. § 112, ¶ 1 is met, we first determine whether Dr. O'Neil subjectively considered a particular mode of practicing the invention to be superior to all other embodiments at the time the 1979 application was filed. If so, we then ask whether he provided a sufficient disclosure to allow others to practice that best mode....

Dr. O’Neil admitted during his deposition that at the time he filed his patent application in 1979, he had already made sample catheters where the distance from the stop member to the distal end of the sheath was 1.5 cm. He further characterized it as “the preferred embodiment at that stage.” The ‘259 patent ... describes this distance as “crucial” to preventing bacteria from being pushed into the bladder by the catheter or by the sheath itself. The district court thus correctly concluded that Dr. O’Neil possessed a best mode— i.e., a sheath length of 1.5 cm.

We also agree with the district court that the 1979 application lacked sufficient disclosure to allow others to practice the best mode. There is no dispute that the preferred length of 1.5 cm was not expressly disclosed. Dr. O’Neil even testified at his deposition that when drafting the 1979 application, he purposely “avoid[ed] any comment with relation to length” because he “was aware that numbers would become limiting themselves.”

Nor were the drawings submitted with the 1979 application sufficient. There is no indication that Figure 1 was drawn to any particular scale, much less one where the distance between the “X” and the outer end of the urethra is exactly 1.5 cm. “[P]atent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.”

Moreover, Dr. O’Neil also testified that “[i]t took [him] a few weeks of experiments to define the distance” and others would “have to do a small amount of experimental work” to reach the same conclusion. In other words, one of ordinary skill would not know from reading the 1979 application that the preferred length between the stop member and the distal end of the sheath was 1.5 cm.

In sum, we conclude that the invention of the ‘259 patent was not disclosed in the 1979 application in a manner that satisfies the best mode requirement — and no reasonable jury could find otherwise — such that Go is not entitled to claim the priority date of that application. Thus, the 1982 article anticipates. In light of this ruling, we need not address whether the district court erred in finding that the 1979 application also failed to meet the written description requirement. We affirm the grant of summary judgment of patent invalidity.

For more information on these issues or other intellectual property law matters, please contact **Lawrence M. Sung, Ph.D.** at lsung@nixonpeabody.com or 202-585-8221.

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