

Green Edge Enters., LLC v. Rubber Mulch Etc., LLC

Nos. 09-1455, -1479, Fed. Cir. (Rader, Lourie,* Bryson)

[A]n inventor using a proprietary product in his preferred embodiment must, “at a minimum, . . . provide supplier/trade name information in order to satisfy the best mode requirement.”

On September 7, 2010, the Federal Circuit affirmed-in-part, reversed-in-part and remanded the district court’s summary judgment, inter alia, that U.S. Patent 5,910,514, which related to a synthetic mulch that is colored with a “water based acrylic colorant” to imitate natural mulch, was invalid for failure to comply with the best mode requirement of 35 U.S.C. § 112. The Federal Circuit stated:

The sufficiency of the disclosure of the best mode is determined as of the filing date. Determining compliance with the best mode requirement is a two-pronged inquiry. First, the court must determine whether, at the time the patent application was filed, the inventor possessed a best mode of practicing the claimed invention. The first prong is subjective; it focuses on the inventor’s personal preferences as of the application’s filing date. Second, if the inventor has a subjective preference for one mode over all others, the court must then determine whether the inventor “concealed” the preferred mode from the public. The second prong asks whether the inventor has disclosed the best mode and whether the disclosure is adequate to enable one of ordinary skill in the art to practice the best mode of the invention. The second inquiry is objective; it depends upon the scope of the claimed invention and the level of skill in the relevant art.

In this case, the parties do not seriously dispute that the inventors of the '514 patent possessed a best mode of practicing the claimed invention, viz., using Futura’s 24009 product as the claimed colorant. Green Edge, however, asserts that it disclosed that mode; it did not conceal it from the public. The question thus relates to the second inquiry, whether Green Edge disclosed its best mode when it disclosed a material by a name that did not exist and failed to identify the material that it actually used in its own work.

We have held that an inventor using a proprietary product in his preferred embodiment must, “at a minimum, . . . provide supplier/trade name information in order to satisfy the best mode requirement.” The purpose of the requirement of a supplier and a trade name is to allow the public to practice the inventor’s best mode at the time of filing. [T]here is a genuine issue as to whether

the name “Visichrome” was descriptive of a sufficiently specific product so that one seeking to obtain and practice the best mode of the invention, product number 24009, would have succeeded.

The disclosure might have, at the time the application was filed, been specific enough to describe the colorant so as to enable a person of ordinary skill in the art to make the claimed product using Futura’s 24009 product. The application for the ’514 patent was filed in October 1997, and Jarboe’s letter describing Futura’s “Visichrome” colorant system was written in July 1997. Thus, despite Jarboe’s inability to remember why he used the term “Visichrome” in his letter, it is at least possible, even likely, that in October 1997, at the time of filing, someone contacting Futura to obtain the “Visichrome” colorant system would have received a response similar to Jarboe’s letter of that July. Indeed, the district court stated that the name “Visichrome” combined with the ability to contact Futura “would have enabled a person to obtain the colorant.” The colorant described in the letter appeared to be a specific formulation that could be made in a variety of different colors. Thus, the name “Visichrome” supplied in the ’514 patent would not have described the precise color preferred by the inventors, but it could have allowed a person to obtain a product with the best formulation. The person contacting Futura could then have requested the “earth tone colors” described in the ’514 patent. We therefore agree with Green Edge that there was a genuine issue of material fact relating to whether the best mode was disclosed, precluding summary judgment of invalidity. The Jarboe letter, viewed in a light most favorable to Green Edge, shows that at the time of filing, a person of ordinary skill could have contacted Futura, inquired of the identity of Visichrome, and been led to the 24009 product, which the parties do not dispute constituted the best mode. Such a determination should be made by the district court, not by this court.

The previous statements are for information purposes only, and do not constitute legal advice. Questions regarding the matters discussed above, and any requests to be subscribed to the free electronic distribution of this publication, may be directed to Lawrence M. Sung, Ph.D., at +1 202.346.7850 or lsung@dl.com, or to any other Dewey & LeBoeuf LLP attorney with whom you regularly consult.

NEW YORK | LONDON MULTINATIONAL PARTNERSHIP | WASHINGTON, DC
ALBANY | ALMATY | BEIJING | BOSTON | BRUSSELS | CHICAGO | DOHA | DUBAI
FRANKFURT | HONG KONG | HOUSTON | JOHANNESBURG (PTY) LTD. | LOS ANGELES | MADRID | MILAN | MOSCOW
PARIS MULTINATIONAL PARTNERSHIP | RIYADH AFFILIATED OFFICE | ROME | SAN FRANCISCO | SILICON VALLEY | WARSAW