

**KRATZ, QUINTOS & HANSON, LLP**  
**IP NEWSLETTER**

**A PATENT SPECIFICATION THAT USES A PRODUCT NAME, WHICH DOES NOT EXIST, IN DESCRIBING THE PREFERRED EMBODIMENT OF THE INVENTION DOES NOT NECESSARILY VIOLATE THE “BEST MODE” REQUIREMENT UNDER 35 U.S.C. §112, FIRST PARAGRAPH**

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Volume IV, Issue No. 8

In the Court of Appeals for the Federal Circuit (CAFC) case of *Green Edge Enterprises, LLC v. Rubber Mulch Etc., LLC*, decided September 7, 2010, Green Edge Enterprises (owner of U.S. Patent No. 5,910,514) sued Rubber Mulch and others for infringement.

The patent claims are directed to a synthetic mulch (a protective covering placed on the earth around growing plants) that is colored with a “water based acrylic colorant” to imitate natural mulch. More particularly, the claimed synthetic mulch, “colored to imitate a natural mulch,” is comprised of a plurality of rubber particles “designed and dimensioned to look like natural mulch,” and the “water based acrylic colorant” coats the rubber particles (Claim 1). The claimed colorant is “a water based acrylic called VISICHROME” (Claim 3). According to the patent’s specification:

*[t]he most preferred colorants are water based acrylic systems such as the colorant systems sold under the name ‘VISICHROME’, by Futura Coatings, Inc. of Hazlewood, [Missouri].”* (Emphasis added.)

In the district court, the parties agreed that the “VISICHROME” colorant, sold by Futura Coatings, Inc., did not exist. Instead, the patent owner, Green Edge Enterprises, had used a product that Futura sold under the product code “24009.” Due to the disclosure of a non-existent “VISICHROME” as the preferred colorants, the district court granted a summary judgment of invalidity because the patent specification does not meet the best mode requirement in 35 U.S.C. §112, first paragraph, which requires that:

the specification...shall set forth the best mode contemplated by the inventor of carrying out his invention.

Green Edge Enterprises appealed the district court’s granting of the summary judgment of invalidity.

On appeal, the CAFC stated that regarding the best mode requirement, the sufficiency of the disclosure of the best mode is determined as of the filing date (see, *Application of Glass*, 492 F.2d 1228, 1232 (CCPA 1974)); and a patentee cannot receive the benefit to exclude others from his patented invention while at the same time concealing from the public preferred embodiments of his invention (see, *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1330 (Fed. Cir. 2002)).

*“[T]he disclosure [must be] adequate to enable one of ordinary skill in the art to practice the best mode of the invention.”*

*U.S. Court of Appeals for the Federal Circuit*

In determining compliance with the best mode requirement, the court outlined the following tests:

(1) Determine whether, at the time the application was filed, the inventor possessed a best mode of practicing the claimed invention.

(a) Focus on the inventor's personal preferences as of the filing date.

(b) Determine whether the inventor "concealed" the preferred embodiment from the public.

(2) Determine whether the inventor 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.*

As to the first test, the court found that the parties had agreed that the use of Futura's "24009" product was the best mode of the invention, and that Green Edge did not conceal this mode from the public.

The problem lies on the second test because Green Edge disclosed a material by a name (VISICHROME) that did not exist. However, the CAFC held that the second test is passed because:

the name "Visichrome" supplied in the '514 patent would not have described the precise color preferred by the inventors, but it would 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.

Consequently, at the time of filing the patent application, "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."

Thus, the patent specification includes the requisite information to enable one of ordinary skill to practice the best mode of the invention; and the district court erred in granting the summary judgment of invalidity.

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