

Keywords: best mode requirement; use of product names; proprietary products; indefiniteness; enablement

General: An inventor avoids summary judgment for violation of the best mode requirement despite referring to a propriety product used in the preferred embodiment by a nonexistent trade name.

Green Edge Enterprises LLC v. Rubber Mulch Etc. LLC
96 U.S.P.Q.2d 1425 (Fed. Cir. 2010)
Decided September 7, 2010

I. Facts

Green Edge Enterprises LLC (“Green Edge”) owns U.S. Patent No. 5,910,514 (“the ‘514 patent”) and sued Rubber Mulch Etc. LLC (“Rubber Mulch”) for patent infringement. The ‘514 patent is directed to synthetic mulch made from rubber and colored with a “water based acrylic colorant” to “imitate a natural mulch.” According to the specification, the colorant “can be selected from a variety of different coloring systems, as long as the colorant is available in at least *earth tone colors*, readily adheres to rubber, and does not wash off the rubber when contacted by water.” (Emphasis added.) In addition, the specification states: “[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, Mo.” Further, claim 3 of the ‘514 patent recites: “said colorant is a water based acrylic called VISICHROME.”

During the district court proceedings, the parties agreed that Futura Coatings, Inc. (“Futura”) never sold any colorant systems under the name “Visichrome.” Instead, Green Edge used a colorant system sold by Futura under the product code “24009.” The basis for the use of “Visichrome” in the specification was a letter sent by the vice president of Futura to Green Edge that recommended using the “Visichrome” colorant system to coat the rubber particles developed by Green Edge. During questioning, the vice president could not remember why he used “Visichrome” in the letter to Green Edge.

The district court granted Rubber Mulch summary judgment of invalidity of the ‘514 patent for failure to disclose the best mode of the invention, pursuant to 35 U.S.C. § 112, paragraph 1. The district court found that “Visichrome” did not exist and that Green Edge had concealed the best mode by disclosing “a misleading, non-existent name instead of the number.” However, the district court did not grant Rubber Mulch summary judgment on the separate grounds of anticipation, obviousness, indefiniteness, and enablement. The district court also addressed other procedural issues with regard to trademark and Lanham Act claims. Green Edge appealed from the grant of summary judgment of invalidity.

II. Issue

Did the district court err by invalidating the ‘514 patent for failure to disclose the best mode of the invention?

III. Discussion

Yes. According to 35 U.S.C. § 112, paragraph 1, “[t]he specification . . . shall set forth the best mode contemplated by the inventor of carrying out his invention.” One of policies supporting this requirement is to prevent inventors from receiving the benefit of the right to exclude while concealing preferred embodiments from the public. Determining the sufficiency of the best mode disclosure is a question of fact and is determined as of the filing date of the application.

Compliance with the best mode requirement is based on a two-prong test. First, the court determines “whether, at the time the patent application was filed, the inventor possessed a best mode of practicing the claimed invention.” Specifically, “[t]he first prong is subjective; it focuses on the inventor’s personal preferences as of the application’s filing date.” If the first prong is met, the court next determines “whether the inventor ‘concealed’ the preferred mode from the public.” In other words, the court determines “whether the disclosure is adequate to enable one of ordinary skill in the art to practice the best mode of the invention.” In contrast to the first prong, the second prong is objective, as “it depends upon the scope of the claimed invention and the level of skill in the relevant art.”

Considering the first prong, the parties did not dispute that the inventors possessed a best mode, namely using the “24009” product from Futura. Turning to the second prong, the Federal Circuit referred to *U.S. Gypsum*, in which the court held that when an inventor uses a proprietary product in the preferred embodiment, the inventor must “at a minimum, . . . provide supplier/trade name information in order to satisfy the best mode requirement.” The Federal Circuit noted that without such information, a person of ordinary skill in the art would not be able to practice the inventor’s best mode at the time of filing. Turning to the facts of the instant case, the ‘514 patent was filed in October 1997 and the letter from the vice president of Futura was written in July 1997. Thus, the Federal Circuit suggested that a person of ordinary skill in the art contacting Futura in October 1997 asking for “Visichrome” would likely receive a response similar to that presented in the letter of July 1997. In fact, the district court found that contacting Futura about “Visichrome” “would have enabled a person to obtain the colorant.” Moreover, the Federal Circuit noted that the person of ordinary skill in the art could have also requested the “earth tone colors” mentioned in the specification.

Accordingly, the Federal Circuit held that there was a genuine issue of material fact regarding whether Green Edge had disclosed the best mode, thereby precluding summary judgment. Thus, the Federal Circuit reversed the district court’s grant of summary judgment and remanded for further proceedings.

Regarding the grounds of anticipation, obviousness, indefiniteness, and enablement put forth by Rubber Mulch, the Federal Circuit agreed with the district court that genuine issues of material fact existed to preclude granting summary judgment on these grounds. However, the Federal Circuit did provide some guidance for the district court. For example, Rubber Mulch argued that the term “look like” in claim 1 is indefinite. However, the Federal Circuit commented that the claim term “look like” is similar to other terms relating to appearance that have been held not necessarily indefinite if sufficiently defined in the specification. In addition, Rubber Mulch argued that the ‘514 patent did not enable manufacture of a product that “imitates natural mulch.” The Federal Circuit first noted that the district court incorrectly addressed enablement at the time of its decision, instead of at the time of the patent’s application. Despite this error, the Federal Circuit agreed with the district court’s decision to deny summary judgment because persons may be able to obtain the claimed colorant from Futura or from another source.

IV. Conclusions

35 U.S.C. § 112, paragraph 1 requires that the best mode contemplated by the inventor be disclosed in the specification. Whenever the inventor uses a proprietary product in the preferred embodiment, the inventor must, at a minimum, provide supplier/trade name information to satisfy the best mode requirement. However, it may also be prudent to verify the validity of any disclosed trade name with the supplier and to include in the specification a product code or number corresponding to the proprietary product.