

Keywords: best mode, written description, concealment, invalidity

General: Best mode requirement does not actually require a disclosure of the best mode, but rather requires sufficient disclosure to enable one of skill in the art to practice the best mode without undue experimentation.

Joy MM Delaware, Inc. v Cincinnati Mine Machinery, Co.
No. 2012-1153 (Fed. Cir. November 8, 2012)

I. Facts

Joy MM Delaware, Inc. (hereinafter “Joy”) owns U.S. Patent No. 6,662,932 (hereinafter “the ‘932 patent”), which is directed toward mining equipment. In particular, claim 2 of the ‘932 patent is directed toward an apparatus for use in mining and recites, *inter alia*, “A chain and flight assembly...including... drive pin retaining means for retaining said drive pins in said side plates...and a first flight having a flight head having two spaced apart indentations, each of which receives a different one of said first ends of said drive pins.”

Cincinnati Mine Machinery, Co. (hereinafter “CCM”) produced a mining machine referred to as a flight conveyor. Joy filed suit against CMM in October 2009 alleging that CMM’s flight conveyor infringed claim 2 of the ‘932 patent. CMM denied infringement and asserted defenses and counterclaims of invalidity, including that claim 2 failed the best mode requirement of 35 U.S.C. § 112. Of particular note, during the Markman hearing, the District Court construed the word “indentations” of claim 2 to mean: “recessed or concaved areas . . . into which something can be inserted, but through which it cannot pass.”

Based on the construction of the term “indentations” by the District Court, Joy conceded that the flight conveyor of CCM did not literally infringe. Further, the District Court determined that the flight conveyor of CCM could not meet the “two spaced apart indentations” limitation of claim 2 under the doctrine of equivalents. Joy argued that limitation was met by holes in the flight head of CCM’s flight conveyor, through which retaining pin are passed. However, the District Court’s construction of the term “indentations” necessitated that “indentations” were exact opposites of such holes.

Furthermore, during discovery, the inventor of the ‘932 patent admitted that press-fitting was the preferred way to retain the drive pins in the side plates for the invention of claim 2. However, only welding was discussed in the specification of the ‘932 patent as a means for retaining the drive pins. Both parties provided evidence that press-fitting was, to those of ordinary skill in the art, a well-known substitute for welding. In light of this evidence, the District Court held that the failure to disclose press-fitting as the best mode for the retaining means invalidated claim 2 under 35 U.S.C. § 112.

Accordingly, the District Court granted a summary judgment of noninfringement of claim 2, and granted summary judgment in favor of CMM regarding the invalidity of claim 2. Joy appealed both grants of summary judgment as well as the construction of the term “indentations.”

II. Issues

- 1) Did the District Court correctly construct the term “indentations,” recited in claim 2 of the ‘932 patent?
- 2) Did the District Court err in granting a summary judgment of noninfringement with respect to claim 2 of the ‘932 patent?
- 3) Did the District Court err in granting a summary judgment of invalidity with respect to claim 2 of the ‘932 patent?

III. Discussion

1) Regarding the construction of the term “indentations,” the Federal Circuit determined that the “indentations” recited in claim 2 describe the parts of the flight head structure that receive the end of the drive pins. However, these drive pins are not recited *as passing through* the indentations. Further, the specification of the ‘932 patent describes the feature in questions as being “indentations *or* holes,” while only “indentations” are recited in the claims. As such, the Federal Circuit established that the inventor must have appreciated that the commonly understood meaning of “indentations” excludes holes. Lastly, in portions of the claims directed to an actual hole, the claims recite a “bore” or an “opening” as opposed to “indentations.” Accordingly, the Federal Circuit declined to extend the construction of the term “indentations” to include holes and determined that the construction of the District Court was correct.

2) Regarding the question of noninfringement, the Federal Circuit agreed with the decision of the District Court based on the all-elements rule. That is, like the District Court, the Federal Circuit determined that if holes and “indentations” were to be construed as being equivalent, then the “two spaced apart indentations” limitation would be read out of claim 2. Further, the inventor’s use of “indentations *or* holes” in the specification while only reciting “indentations” in the claim was construed as a deliberate choice of the inventor to limit the claim to only one possibility. In light of that deliberate choice, the Federal Circuit held that the holes of CCM’s flight conveyor do not satisfy the “indentations” limitation of claim 2 under the doctrine of equivalents and affirmed the grant of summary judgment of noninfringement to CMM.

3) Regarding the question of invalidity, in order to establish that claim 2 fails the best mode requirement, the Federal Circuit determined that CCM must prove by *clear and convincing evidence* that the inventor of the ‘932 patent *concealed or withheld* from the public a best mode of practicing the claimed invention. Further, the Federal Circuit determined that an inventor has not concealed best mode when the inventor’s disclosure is adequate to enable one of ordinary skill in the art to practice the best mode of the invention without undue experimentation. Both parties submitted evidence that press-fitting was, to one of ordinary skill in the art, a well-known substitute for welding. Accordingly, CMM could not provide clear and convincing evidence that the omission of press-fitting from the specification of the ‘932 patent amounted to concealing from the public the preferred means for retaining the drive pin. As such, the Federal Circuit reversed the District Court’s grant of summary judgment to CMM that claim 2 is invalid for failing to comply with the best mode requirement.

IV. Conclusion

With respect to best mode: “An inventor does not conceal the best mode of an invention by disclosing only one of many modes for enabling a claim element when all of the other non-disclosed modes are already well-known substitutes in the art. One of ordinary skill in the art would not need to be reminded of those substitutes to practice the best mode of the invention.” With respect to term construction, beware that providing mutually exclusive options in the specification (e.g., “indentations *or* holes”) while only reciting one of these options in the claims (e.g., “indentations”) may prevent the doctrine of equivalents from being applied to cover the non-recited option.

V. AIA

The AIA addresses the best mode requirement. While the AIA leaves the best mode requirement in place, the new law prevents any post grant action (e.g., in court or the PTO) to challenge the validity or enforceability of a patent based on a failure to disclose the best mode. However, the best mode requirement of Section 112, first paragraph may still be applied during prosecution at the U.S.P.T.O.