

Patent Drafting for Beginners
Prof. Feroz Ali
Department of Humanities and Social Sciences
Indian Institute of Technology, Madras

Lecture - 46
Enabling Disclosure

Enabling Disclosure; now, let us look at this requirement, we already said enabling disclosure is a part of the sufficiency requirement; the sufficiency requirement also has an additional requirement that whatever you see has to be clear and intelligible. That is a language requirement if you ask if it is not clear and intelligible, then the basic requirements of the English language has not been satisfied.

Now, we are concentrating on the legal requirements and sufficiency has this requirement called the enabling disclosure. So, the disclosure that you make should enable or empower a person skilled in the art to perform or to make your invention; because a disclosure to be enabling there are certain conditions that it has to be satisfied.

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What is Enablement?

- The specification must teach a skilled person how to make and how to use the invention
- Not sufficiently enabling disclosure—revocation of patent
- Requirement of disclosure

S.10(1)— “...describe the invention...”



Now, let us look at what enablement is. The specification must teach a skilled person how to make and how to use the invention. So, making and using the invention has to be thought through the specification. So, whenever you see a comparison with a prior art, you may find a statement that the such and such prior art teaches the invention or such

and such prior art has already anticipated the invention. So, teaching the invention is something which every specification is expected to do.

So, the specifications roll apart from carving a private right to the inventor, the role of the specification which is a role that is directed towards the public just to teach the people who do not know anything about the invention to perform and to use the invention.

So, once you describe in detail how the invention can be made, which is once you teach the invention through your specification there is the danger of others copying you. So, patent law comes in to allow an applicant an inventor do closest invention in full in such a way that others can make it, but grants a monopoly or an exclusivity over a period of time, such that though the teaching is there in the public domain others cannot use it without your permission.

So, this is the balance that patent law tries to strike at one end it puts the knowledge into the public domain people can use the knowledge to a limited extent they can experiment with it they can use it for instruction; they can teach others about it falling short of commercial exploitation. They could do quite a lot of things that is one part of the pattern bargain and the other part is that though you have put this thing into the public domain patent law protects you from others copying your invention. So, whatever you have claimed becomes your private property and because you have claimed you have the right to enforce it against people, who may copy your invention which is what we call infringement.

Now, if you do not satisfy this requirement, if you do not teach a skilled person now it is addressed to a skilled person. So, it need not teach the invention to a person on the street. So, you could assume so many things that is expected of a skilled person in your art whatever that art is. So, if you do not do this, if you do not teach a skilled person to perform or to use the invention, then it could be a ground for revocation because section 64 has a whole lot of grounds on which a patent can be revoked, one ground is the fact that your disclosure is not enabling.

Now, enablement is a requirement of the disclosure and this is captured in the language of section 10 1 which we had seen already where it mentions that the complete

specification shall describe the invention. So, the description law states that the description should be of such a nature that it enables the person to do it.

So, section ten only tells us this simple three words describe the invention, but there are other provisions in the act which explain what this description has to be.

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What is Enablement?

- Requirement of disclosure

S.64(1)(h)— "...sufficiently and fairly describe the invention...the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection."

- Ability to practice the invention without further input from the inventor



Now, here is that requirement the enablement requirement or the fact that a disclosure has to be enabling or the applicant has to make an you know enabling disclosure there are various ways, in which you can express the same idea it is contained in section 64 1 h now this is a ground section 64 generally deals with the grounds on which a patent can be revoked, they could be grounds that are extrinsic there is a prior art you had anticipates the invention that is an extrinsic round because you have to compare the pattern with, something that has gone out.

They could be a obviousness objection the fact that the invention does not involve an inventive step again you need to compare something with the prior art the enabling disclosure requirement, which can be a ground for revoking the patent is an analysis which you would do internally. You would read the specification and see whether it discloses the invention in a manner in which a person who reads the specification, whom we call the person skilled in the art to whom normally all patents are expected to be addressed to. So, all patents are addressed to a person skilled in that art.

So, when a person of that background reads the invention, he is unable to perform it he is unable to use it. So, in by which we understand that the applicant has not made an enabling disclosure. So, not making an enabling disclosure is an internal requirement, because the analysis will completely come out from the specification itself, there is no mapping or matching with something outside it is going to be an internal analysis.

So, let us look at that. So, this is the ground for revocation. So, and in complete specification can be revoked if it does not sufficiently and fairly describe the invention. So, it is put in a negative language, I have just quoted the relevant part that is to say it continues the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves, sufficient to enable a person.

So, it has to enable a person in India the person has to be in India processing average skill in an average knowledge of the art. So, average skill and knowledge we understand this as a person skilled in the art. So, it should enable a person skilled in the art in India which means it should teach the person skilled in the art in India the art to which the invention relates to.

So, it should what should it do what should how should it enable a person? It should enable the person to work the invention. Now this is the enabling requirement the sentence continues also to include the next requirement, that is the best method that it does know or that it does not disclose the best method of performing it, which was known to the applicant for the patent and for which he is entitled to claim at a protection.

This repeats the language of section ten we had already quoted section 10. So, a patent can be revoked a granted patent can be revoked if it does not disclose the best method or if it does not enable a person skilled in the art to perform the invention to work the invention.

Now, the requirement of enablement refers to the ability to practice the invention, without any further input from the inventor. So, you should which means the document should be self-contained you just read the document or a person skilled in the art reads the document and he should be able to practice the invention there should not be any need to get back to the inventor with further information has to what did you mean when

you meant heating heated at a particular temperature how is the heating done or on what equipment the heating is done.

So, it should contain all the details. So, that you do not have to get back to the inventor or there is no need for you to get back to anybody else in the sense that, you know you need to consult another expert as to what was mentioned here. So, it is viewed from the perspective of a person skilled in the art and it should enable a person skilled in the art to practice the invention.

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Scope of Enablement

- Applies only to claimed subject matter
- If method is not claimed, it need not be disclosed
- Trade secrets
- Enablement is addressed to the skilled person
- “well known”, “commonly used” — not enabling
- All information to reproduce the invention
- **Average skill and average knowledge**



Now, let us look at the scope of the enablement requirement, it applies only to the claimed subject matter. So, what you have claimed you should enable. So, if your claim is covered to what you have mentioned in your principal claim the main claim, then the enablement requirement should cover what you have claimed there is no need for you to enable a person with something which you have not claimed.

If the method is not claimed it need not be disclosed. So, this again flows from the earlier point. So, you only claim an apparatus and a product and you do not claim the method. There is no method claim or process claim in your application. So, there is no need for you to disclose or to enable a person to show in what method you had achieved the product or the apparatus trade secrets.

Because of the enablement requirement, you cannot include trade secrets because trade secrets are contrary to the enablement requirement, you cannot say that we would not disclose a part of our invention because it is a trade secret and you would also understand this better when you know that patent law came as a replacement to the trade secret regime, because earlier before patent law came into effect we had only the trade secret regime, which means people used to keep their invention as a secret.

So, far as they could do it because there were some technologies which could be reverse engineered, and which could not be kept as a secret, but if the technology allowed you to keep it as a secret the person keeps it as a secret.

So, patent law or the patent bargain by which we mean you teach the public how to perform the invention and in lieu of your disclosure you are granted an exclusivity. So, that came to replace the trade secret regime, because in a trade secret regime you do not make a disclosure. So, trade secrets and the enablement requirement do not go hand in hand. So, you cannot claim any of specification saying that this was not disclosed because it is a trade secret. So, if it is a trade secret you keep it outside the purview of patent law.

And the enablement as we have already mentioned is addressed to a skilled person in that art. If it is mechanical invention pertaining to automobiles more specifically on internal combustion technology for engines then the person skilled in the art is a person who belongs to that field who has the expertise in this that field and who can work the invention in that field. So, enablement should be viewed through the eyes of a skilled person, it should not be viewed through the eyes of a commoner or a person on the street a common man.

Now, some specification in order to make the specification brief and to save time, they may use things like well known process or a commonly used device. So, those terms have been interpreted as not enabling a person. So, when you say it is by well known means, you have to actually mention what those well known means are. So, words such as well-known and commonly used and other variants which would signify something that is already known to everyone still may need an explanation depending on the field of the art.

Now, the enablement requirement requires the applicant to disclose all information that is needed to reproduce the invention. And the standard in India is that the skilled person should be of average skill and average knowledge. Now, in U.S. it is called ordinary skill a person having ordinary skill in the art in this particular context, we use average skill and there is a difference in the wording in the patterns act in India itself.

In this context alone the word average appears and in every other context; especially when it comes to inventive step it is just the person skilled in the art this is the average qualification is not there though.

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Skilled Addressee

- Skill is determined as on date of filing
- No need to explain how & why the invention works
- Should not be subject to **undue experimentation**
- Claims should match the disclosure



So, as we said the pattern is addressed to the skilled addressee and the enablement requirement is viewed and determined through the eyes of the skilled addressee. The skill itself is determined as on the date of the filing. So, if there are certain improvements to the art after the date of the filing or if there are certain clarifications which have come to the field after the date of filing they will not be considered in determining whether there was an enablement requirement because the enablement requirement goes back to the date of filing, the day on which the applicant made the application did he enable the person skilled in the art.

Now, they may not be a need to explain the how and why the invention works. Now you explain the invention, you carve an exclusivity for your apparatus or for the method, but the theory or the logic behind its working need not be explained. You can just explain the

fact that how the invention is made, the fact that how it can be put to use all that is fine, but the theory or the explanation as to how or why it works is not expected from the patentee.

Now, one of the requirements in this field is that because it is addressed to a skilled addressee, the skilled person in a particular art there is quite a lot the skilled person would already know now if it is a internal combustion engine, and if you are drafting a specification on an internal combustion engine if the skilled person will know how an internal combustion engine works the parts of it, how it is to be assembled you can assume quite a lot of knowledge because it is addressed to a person who already has that skill.

But nevertheless you should ensure that the description that you give our self sufficient, and there is no need for the skilled person to involve or participate in undue experimentation. Now, undue experimentation is when a person reached the specification and still is not able to perform the invention and he is required to carry out certain experiments to attain the invention.

So, undue experimentation means experimentation which is needed it is undue. So, it is qualified experimentation which is more than what is usually required. So, if a person skilled in the art is a specification he has to go to the lab he has to do a number of things; before he can actually find it or if he has to do some more experiments, then that is a criteria which the courts will regard as not having satisfied the enabling disclosure requirement.

Now, the claim should also match what has been disclosed. Now, this is the principle which we discussed earlier, the enablement requirement is only for the claims what you have claimed. So, the claims this is the other side of it the claim should match the enabling disclosure.

So, what you would do because as we have taken the approach of drafting the claims first, you will ensure that the claim the main claim is not disclosed the way of performing, it is disclosed in detail in the specification. So, it also turns out that the claims would eventually match that disclosure.