CHAPTER VIII. — DISCLOSURE OF APPLICATION

Sec 52. Disclosure and New Matter

The first paragraph of 35 USC 112 reads: "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." This language follows generally the first portion of old RS 4888. In determining whether applicant has adequately disclosed his invention, the disclosure of the application drawing, if any, is necessarily taken into account, hence the subject of disclosure is not confined to "specification" and may logically be covered here, in a separate chapter.

The statute quoted from does not mention benefit of foreign filing, § 47 hereof, but by implication it applies to that right. All that is said hereinafter about disclosure of a domestic application applies equally to disclosure of a foreign application that is claimed to give an effective domestic date.

The subject of disclosure is largely one of substantive law, no comprehensive treatment being attempted in this book. Literature is cited.[1] Chemistry involves some special problems.[2]

Besides Rule 71, Rules 117 and 118 may be examined, but in practice the terms of the rules have never had much influence on questions of disclosure.

Since the chief consideration for the grant of a patent is the disclosure of the invention, the examiner must see to it that the disclosure is adequate.[3]

An application wherein the disclosure is not sufficiently comprehensible to support claims may be rejected for failure to comply with the statute.[4] Where the disclosure is insufficient, rejection may be based on that ground.[5] Or if the examiner notes upon preliminary examination that the disclosure is thus defective he may immediately, without either searching or rejecting claims, require revision: MPEP 702.01. A claim presented later than the original filing may be rejected for want of identity with the invention originally presented.[6] A question whether

1 STRINGHAM 1937 *Outline* §0730-0990. V. I. RICHARD 1916 *Disclosure* 8 JPOS 307-321, 443-448, 494-496, 530-536, 587-599. MPEP 608-608.01(h), 706.03(o).
2 Joseph ROSSMAN 1934 *The Law of Patents for Chemists* 2d Ed, Chap VIII, XII. Edward THOMAS 1950 *Chemical Inventions and Chemical Patents* § 27-37
3 Ex parte *Gould* 1876 CD 164, 10 OG 203
4 Ex parte *Cameron* 1926 CD 6, 342 OG 255
5 Ex parte *Stevens* 1905 CD 502, 119 OG 1258. In re *Stauber* 18 CCPA 774, 45 F2d 661, 1931 CD 65, 7 PQ 258, 403 OG 245. Ex parte *Henry* 1893 CD 88, 64 OG 299
6 Ex parte *Clancy* 1913 CD 66, 188 OG 1051. Ex parte *Thomas* 1913 CD 133, 191 OG 832

or not the terms used in the specification were inaccurate and misleading was held appealable where, if the specification were amended as the examiner wished, the claims would no longer read on it.[7]

Rule 71 paraphrases the statutory language above quoted, but since the 1949 revision of the rules has included the added requirement that the specification "must describe completely a specific embodiment" of the invention. In a mechanical case, this requirement would normally be satisfied by the detailed description of the device shown in the drawing. In a process application, it is not satisfied by disclosure of a step of "heating said oil to a temperature and under a pressure suitable for vaporization . . . "[8] In a chemical case applicant would normally be required to set forth a number of examples; but where the invention related merely to the procedure for carrying out known chemical reactions, one "illustrative embodiment" was sufficient.[9] In cases involving chemistry or compositions of matter, an element may be designated by a group name if the group is reasonably small and those skilled in the art would know which members of the group were suitable.[10] Other favorable rulings as to disclosure in chemistry applications are cited.[11]

The rigid requirements of the Office as to the form of the description, drawings, and claims have necessarily resulted in the doctrine that an applicant must be given the privilege of amending freely. The limits of the doctrine are set by the last sentence of 35 USC 132: "No amendment shall introduce new matter into the disclosure of the invention," and by Rule 118, which prohibits the introduction of matter "involving a departure from or an addition to the original disclosure."[12] Such disconforming matter is now called "new matter" in the Patent Statute (§ 132, 251), the rules (Rule 173), MPEP (608.04 et seq., and elsewhere), and in this text.

Prior to the Patent Act of 1952, the proscription against new matter (except in reissue applications, old RS 4916) was a case-law doctrine. In a leading case[13] the patent was held invalid as embodying a "material addition to, or variance from, the original." A feature which is relied upon to distinguish over the prior art cannot be said to be of so little importance as not to be classed as new matter.[14] But applicant may insert a disclosure of the correct principles even though he did not understand them when he filed his application.[15]

If a proposed amendment merely expresses the same idea in a different way,

7 Ex parte *Brasier* 1906 CD 517, 125 OG 2364
8 Ex parte *Yost* (BA:1953) 102 PQ 462
9 Ex parte *Roberts* (BA:1956) 113 PQ 205
10 Ex parte *Cross* (BA:1956) 113 PQ 547. Ex parte *Diffley* (BA:1957) 113 PQ 352
11 Ex parte *Butler* (BA:1956) 116 PQ 527. Ex parte *Butler* (BA:1957) 116 PQ 532
12 MPEP 608.04-608.04(c)
13 *Railway Co v Sayles* 97 US 554, 1879 CD 349, 15 OG 243
14 Ex parte *Cherry* (BA:1934) 25 PQ 48
15 *Cleveland Foundry Co v Detroit Vapor Stove Co* (CCA-6:1904) 131 Fed 853