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Office of Research Compliance
Lakeside 1400
11100 Euclid Avenue
Cleveland, Ohio 44106
216.844.5576

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Patent Filing Requirements (Second of a Three Part Series)

A patent application generally consists of:

- (1) A *description* of the invention, and
- (2) One or more *claims* that define the inventor's patent rights.

Although the patent examination process focuses primarily on the claims, it is important for the inventor to review the adequacy of the description for compliance with the three requirements of 35 U.S.C. 112, First Paragraph under U.S. patent law:

- (1) **A written description of the invention;**
- (2) **The enablement requirement; and**
- (3) **The best mode contemplated by the inventor of carrying out the invention.**

Failure to comply with these requirements could result in the denial of a patent.

This issue will help the inventor understand what it takes to satisfy the second of the three requirements referenced above. Please reference Collaboration Corner Volume 3, Number 11 (1) for Part 1.

Part 2: Enablement

Policy Considerations – The United States Founding Fathers recognized that a strong patent system is important to the well-being of a nation. They also recognized that the publication of new inventions helps to foster and enhance the development of new ideas and the advancement of scientific knowledge. Accordingly, the requirement for an adequate *written description* that *enables* one skilled in the art to make and use an invention ensures that the public receives something in return for any patent rights granted to the inventor.

How to Satisfy the Enablement Requirement – To satisfy the enablement requirement, the patent application must describe the invention in such terms that one skilled in the art can make and use the invention without *undue experimentation*. There are many factors to be considered when determining whether any necessary experimentation is undue:

- **The nature of the invention;**
- **The level ordinary skill in that art (PhD Chemist or a Lab Technician);**
- **The existence of working examples; and**
- **The quantity of experimentation needed to make or use the invention.**

However, the fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. It is also important to note that although working examples may be helpful to satisfy the enablement requirement, they are not required. Essentially, the more unpredictable and undeveloped the art the greater the need for a working example to satisfy the enablement requirement.

It is important to note that this is just a brief summary of the enablement requirement that does not include many important nuances. However, the UH Technology Management Office is available to help you with these and other matters related to patent applications.

Contact CCRT's Technology Management Office

- **Stephen Behm, Director, Technology Management: (216) 844-1415**
- **William Fisher, Senior Research Business Specialist: (216) 844-5577**

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