The Limited Monopoly™

The America Invents Act - Best Mode Requirement

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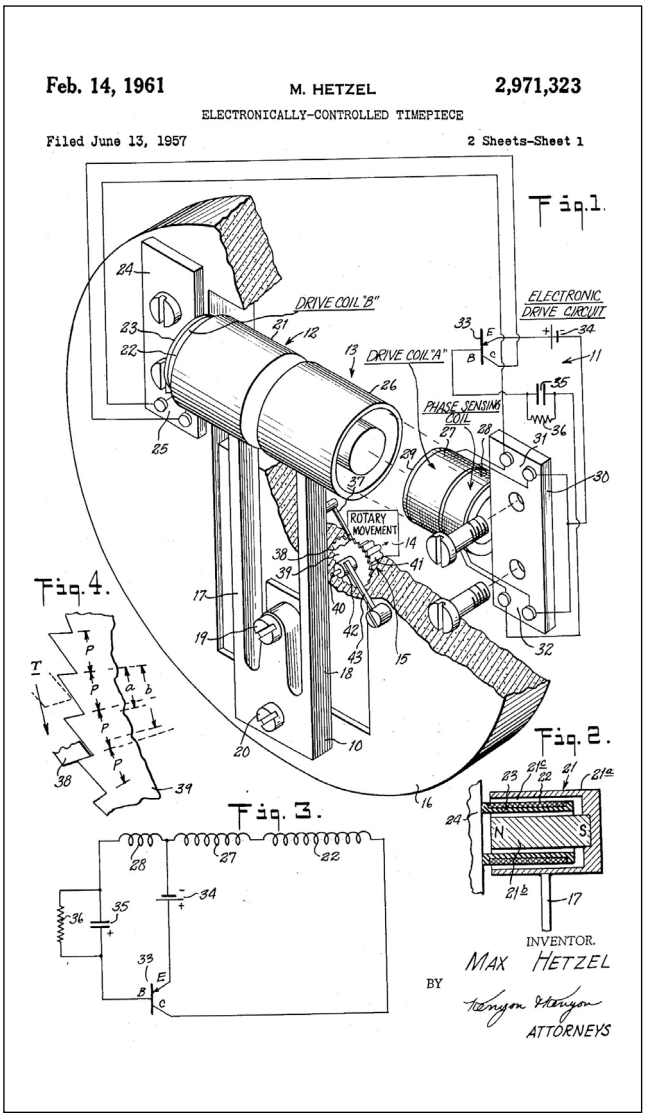
Patent Reform- The America Invents Act

Patent reform in the United States, known as the America Invents Act (AIA), was enacted on September 16, 2011, creating the most substantial changes to our patent laws in more than a century. Five important sections were effective as of enactment, with five more taking effect on September 16, 2012, and the "first inventor to file" provisions taking effect on March 16, 2013. In this article, we will discuss Section 15 of H.R. 1249, "Best Mode Requirement," that was effective as of the enactment date.

The Best Mode Requirement for a Patent Application

There are three basic requirements for the manner in which an invention is disclosed in a patent application[1]. First, there must be a "written description" of the invention. Second, the written description must meet the "enablement requirement" where the written description sets forth the manner and process of making and using the invention "in such full, clear, concise, and exact terms as to enable any person skilled in the art…to make and use the same." Third, the written description must set forth the "best mode" contemplated by the inventor of carrying out his invention. Since this "best mode" requirement has long been a statutory requirement for patentability, failure to comply with the "best mode" requirement has been a defense in actions involving infringement or validity of a patent, and courts have long had the power to determine if the "best mode" requirement has been met, and to invalidate patents that failed to meet this statutory requirement. While the "best mode" requirement remains in the statute, the consequences for not meeting the requirement have been removed.



Section 15 of H.R. 1249 - BEST MODE REQUIREMENT

Section 15 of the America Invents Act, entitled "Best Mode Requirement," amends the United States Code[2] so that failure to disclose the best mode shall no longer be the basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable. Prior to this change, if a patent holder did not disclose the best way to practice an invention disclosed in the patent specification, the relevant claims could be declared invalid. This requirement made sense, as the deal a patentee makes with the government is that he is provided a limited monopoly for a period of time, after which the public benefits from the full disclosure made in the patent specification. If a patentee were to keep secret details of the invention that have the most value, the public would receive less than fair compensation for the limited monopoly that was conferred to the patentee, essentially leaving the public with the short end of the stick. The requirement for a patent applicant to disclose best mode (if one is known) is still present under 35 U.S.C. §112, but the courts have been stripped of their ability to enforce the best mode requirement. Without enforcement, the best mode requirement will quickly become an anomaly in our patent laws unless other suitable enforcement mechanisms are put into place.

Effective Date

The changes to the best mode requirement described in section 15 of H.R. 1249 were effective upon the enactment date of September 16, 2011, and apply to "proceedings commenced on or after that date."

Impact of Section 15 on Current Patent Examining Practices

The changes made to the Best Mode Requirement in Section 15 of H.R. 1249 apply to patent validity or infringement proceedings. They do not apply to current patent examination practices that are described in detail in MPEP §2165. So it is now solely up to the Patent Examiner to determine if the best mode requirement has been met in a pending patent application, as there is now no opportunity for the courts to do so later. If a Patent Examiner believes that the best mode requirement has not been met, he may issue a rejection. In many instances, however, it would not be possible for a Patent Examiner to make such a technical determination.

Inequitable Conduct, Fraud and Failure to Disclose Best Mode

So if there is no penalty for non-compliance with best mode, why disclose it to the public and your competitors? Why not keep best mode as a trade secret? Since the best mode requirement still exists, even though court backed consequences are gone, what is left is the potential for charges of fraud or inequitable conduct against the USPTO[3], which would be referred to the Attorney General for possible prosecution[4]. This may be reason enough to continue to meet best mode requirements in your patent applications. It is still to be determined whether inequitable conduct based on an intentional concealment of the best mode requirement will continue to be a viable defense in litigation.

Long Term Impacts

While Section 15 of H.R. 1249 takes up only a third of a written page, this change will have repercussions for years to come. The "bargain" of a limited monopoly in exchange for full disclosure and benefit by the public after the patent expires is now distorted and compromised. Such a change surely creates an environment for abuse, where some sophisticated and not so honest inventors will attempt to protect their invention by both a patent and a trade secret, hiding the most commercially valuable information from the public. Surely this is not what Thomas Jefferson had in mind when he drafted the Patent Act of 1793, which is the foundation of today's patent laws.

A Final Note of Caution

It would be foolhardy to say that disclosure of the best mode is no longer required. It would also not be advisable to attempt to withhold the best mode in a patent application. The consequences of doing so may come down to inequitable conduct or fraud against the Patent Office. Although any resulting patent will no longer be subject to invalidation by the courts due to failure to meet best mode requirements, there could still be negative consequences to withholding such information.

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1. 35 U.S.C. §112, first paragraph
2. 35 U.S.C. §282
3. See also "The Limited Monopoly™" December 2006.
4. 18 U.S.C. §1001

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Note: This short article is intended only to provide cursory background information, and is not intended to be legal advice. No client relationship with the authors is in any way established by this article.

PHOTO CREDIT: Robert D. Gunderman, Jr.- "It's Five O'Clock Somewhere." Bulova Accutron Spaceview watch. 1969. Rebuilt 2012. U.S. Patent 2,971,323, now expired. Tuning fork movement seems to be "best mode."