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The American Invents Act and the Best Mode Requirement: Where Do We Go From Here?

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THE AMERICA INVENTS ACT AND THE BEST MODE REQUIREMENT: WHERE DO WE GO FROM HERE?

*Andrew Thomas Robinson**

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I. INTRODUCTION

The Constitution of the United States grants Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”¹ Since the founding of the republic, Congress has passed, repealed, replaced, and tweaked numerous patent statutes. Throughout all of the patent statute changes over the centuries and decades, the best mode requirement has been a central feature of patent law in the United States dating back to its inception.² The best mode requirement commands inventors who apply for a patent to disclose “the best mode contemplated by the inventor of carrying out his invention.”³ Until recently, the best mode requirement was available as a defense in patent infringement litigation.⁴ If a court found that an inventor had violated the best mode requirement, it could be considered grounds for invalidation of the original patent, and judgment would be entered for the defendant.⁵

On September 16, 2011, President Obama signed the America Invents Act into law. The Act represented the largest overhaul of United States patent law in over fifty years and made significant changes to numerous portions of Title 35 of the United States Code, which contains the main body of patent law in the United States.⁶ One of the principle changes made by the law concerns the future role and operation of the best mode requirement in patent litigation.⁷ While the new law left the best mode requirement intact, it eliminated the best mode requirement as a defense in all future patent litigation.⁸ Therefore, violation of the best mode requirement can no longer be considered grounds for invalidation of a patent.⁹ Essentially, an argument can now be made that

¹ U.S. CONST. art. I, § 8, cl. 8.

² See Patent Act of 1790, 1 Stat. 109 (repealed 1793).

³ 35 U.S.C. § 112 (2006), amended by Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284-341 (codified in scattered sections of 35 U.S.C.).

⁴ *Id.* § 282.

⁵ *Id.*

⁶ Ryan Vacca, *Patent Reform and Best Mode: A Signal to the Patent Office or a Step Toward Elimination?*, 75 ALB. L. REV. 279, 279 (2011–2012).

⁷ Zahra Hayat et al., *How the America Invents Act Will Change Patent Litigation*, THOMSON REUTERS NEWS AND INSIGHT (Nov. 18, 2011), http://newsandinsight.thomsonreuters.com/LeGal/Insight/2011/11_-_November/How_the_America_Invents_Act_will_change_patent_litigation/.

⁸ *Id.*

⁹ Leahy-Smith America Invents Act § 15 (stating that “the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable”).

there is a legal requirement in federal patent law that includes no real punishment for its violation.

Now that Congress has passed the America Invents Act and President Obama has signed it into law, many questions surround the future of the best mode requirement in the United States. Will the United States Patent and Trademark Office (USPTO) continue to enforce the best mode requirement? Given that there is seemingly no effective punishment for violating the requirement, should the USPTO even bother to continue to enforce the requirement? In light of the perceived weakening of the requirement, what are some of the options available to USPTO to convince inventors and patent applicants to take the requirement seriously if they continue to enforce it? In terms of future patent litigation, is there any potential role left for the best mode requirement to play, and are there other legal remedies available to continue the enforcement of the best mode requirement in court? From an ethical standpoint, what should inventors and patent attorneys take into consideration with respect to the best mode requirement when applying for a patent or defending a patent in litigation?

This Note seeks to provide answers to the foregoing questions. Part II of this Note lays out the history of the best mode requirement in United States patent law, including its development and maturation beginning in 1793 and concluding with the America Invents Act 2011. The operation of the best mode requirement in patent litigation will also be examined. Part III discusses the legislative history of the America Invents Act and how Congress interpreted the compromise position it ultimately adopted concerning the best mode requirement. Part IV of the Note will analyze and discuss arguments that have been made both for and against the presence of the best mode requirement in American law. Part V will lay out potential options available to the USPTO and the courts in enforcing the best mode requirement under the new patent law regime. Finally, Part VI will include the author's recommendation for the effective enforcement of the best mode requirement as patent law moves into the twenty-first century.

II. HISTORY OF THE BEST MODE REQUIREMENT IN U.S. PATENT LAW

A. THE PATENT ACTS OF 1790 AND 1793

The origins of the best mode requirement are found in the language of the Patent Act of 1790, otherwise entitled "An Act to promote the progress of

useful Arts.”¹⁰ The 1790 statute constituted Congress’s first effort to pass a piece of comprehensive patent legislation.¹¹ Under the law, patent applicants had an obligation to “describe the said invention or discovery, clearly, truly, and fully.”¹² Furthermore, the Act stated that in patent cases where the evidence showed that the “specification filed by the plaintiff [did] not contain the whole of the truth concerning his invention or discovery,” the court had an obligation to enter a verdict in favor of the defendant.¹³ While the term “best mode” was not used in the Patent Act of 1790, the provisions of the Act laid the foundation on which the best mode requirement would ultimately be built.

In 1793, Congress passed the second major piece of patent legislation in the United States. In one respect, the Patent Act of 1793 actually rolled back some of the foundational language of the 1790 Act.¹⁴ The 1790 language requiring that an invention’s description be clear, full, and truthful was replaced with language simply requiring “a short description of the said invention or discovery.”¹⁵ However, the 1793 Act did, in the case of a machine patent, require that a patent applicant “fully explain the principle, and the several modes in which he has contemplated the application of that principle.”¹⁶ Additionally, the Act left the litigation defense of failing to disclose the “whole truth” concerning an invention or discovery completely intact and added language stating that failure to disclose the “whole truth” would result in invalidation of a patent.¹⁷ The passage of the Patent Act of 1793 thus marked the first time a piece of American patent legislation asserted that an inventor had a responsibility to reveal any type of mode of use for a new invention.¹⁸

B. THE PATENT ACTS OF 1870 AND 1952

Significant changes to the best mode requirement occurred with the passage of the Patent Acts of 1870 and 1952. The Patent Act of 1870 was the first patent law enacted in the United States to use the term “best mode.”¹⁹ The Act

¹⁰ Patent Act of 1790, 1 Stat. 109-112 (repealed 1793).

¹¹ *A Brief History of the Patent Law of the United States*, LADAS & PERRY LLP (July 17, 2009), <http://www.ladas.com/Patents/USPatentHistory.html>.

¹² Patent Act of 1790, ch. 7, § 1, 1 Stat. 109-112 (repealed 1793).

¹³ *Id.* § 6.

¹⁴ Patent Act of 1793, ch. 11, § 1, 1 Stat. 318-323, *repealed by* Patent Act of 1836, ch. 357, 5 Stat. 117.

¹⁵ *Id.*

¹⁶ *Id.* § 3.

¹⁷ *Id.* § 6.

¹⁸ *Id.* § 3.

¹⁹ David J. Weitz, *The Biological Deposit Requirement: A Means of Assuring Adequate Disclosure*, 8 HIGH

stated that before any inventor or discoverer could receive a patent, he must reveal the best mode of use.²⁰ However, like the Act passed by Congress in 1793, the best mode requirement was limited to patent applications for machines.²¹ In 1952, Congress enshrined the best mode requirement into Title 35 of the United States Code.²² The new law expanded the best mode requirement to all patents, not just those concerning machines.²³ The law required that all patent applications to “set forth the best mode contemplated by the inventor of carrying out his invention.”²⁴ Furthermore, the law reinforced the best mode requirement as a defense in patent litigation, stating that failure to comply with the best mode requirement was legitimate grounds for patent invalidation.²⁵

C. THE BEST MODE REQUIREMENT IN PATENT LITIGATION

Due to the provisions of Title 35 of the United States Code, the best mode requirement has become one of the main focal points of patent infringement litigation over the last fifty years.²⁶ The courts typically have held patents to be invalid for violations of the best mode requirement in two types of situations.²⁷ In the first situation, patents will be declared invalid when “they do not adequately disclose a preferred embodiment of the invention.”²⁸ In the second type of situation, patents will be invalidated when the inventor “fail[s] to disclose aspects of making or using the claimed invention” and the information not disclosed “materially affect[s] the properties of the claimed invention.”²⁹

TECH. L.J. 275, 282 (1993); Patent Act of 1870, ch. 230, § 26, 16 Stat. 198-217 (repealed 1874).

²⁰ Patent Act of 1870, ch. 230, § 26, 16 Stat. 198-217 (repealed 1874).

²¹ *Id.*

²² 35 U.S.C. § 112 (2006).

²³ *Id.*

²⁴ *Id.*

²⁵ *Id.* § 282 (stating that invalidity of a patent could result from “failure to comply with any requirement of sections 112 or 251 of this title”).

²⁶ See *Bayer AG v. Schein Pharm., Inc.*, 301 F.3d 1306 (2002); see also *Great N. Corp. v. Henry Molded Prods., Inc.*, 94 F.3d 1569 (Fed. Cir. 1996); *Dana Corp. v. IPC Ltd. P’ship*, 860 F.2d 415 (Fed. Cir. 1988).

²⁷ *Bayer AG*, 301 F.3d at 1319.

²⁸ *Id.*; see also *U.S. Gypsum Co. v. Nat’l Gypsum Co.*, 74 F.3d 1209 (Fed. Cir. 1996) (finding that an inventor violated best mode requirement by not disclosing a particular type of perlite glass that presented advantages in his invention); *N. Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir. 1990) (finding that an inventor violated the best mode requirement by not disclosing a preferred embodiment of his invention that used a specific type of audiotape).

²⁹ See *Great N. Corp.*, 94 F.3d at 1569 (finding that an inventor’s failure to disclose preferred diamond indentations constituted a violation of the best mode requirement because the undisclosed information materially affected the properties of the invention); *Dana Corp.*, 860 F.2d

Furthermore, courts have stated that a patent will be declared invalid in light of “clear and convincing evidence that the inventor both knew of and concealed a better mode of carrying out the claimed invention” than that disclosed in the information submitted on the original patent application.³⁰ From this, the judiciary developed a two-prong test with both a subjective and objective component to evaluate compliance with the best mode requirement.³¹ For a court to find a violation of the best mode requirement, both prongs of the test must be met.³²

The first prong of the test, which is extremely subjective, involves the court making a determination of whether or not, at the time the patent application was filed, the inventor or applicant possessed a best mode of practicing the claimed invention.³³ This aspect, as expected, can be very difficult for a party to litigation to prove in court. Requiring evidence of what was in an inventor’s head on the day a patent application was filed presents an obvious stumbling block to the use of the best mode requirement in patent litigation. If, however, it can be shown that an inventor did indeed have a best mode on the date the application was filed, the court then moves to the second prong of the test.

The second, more objective prong of the test requires the court to determine whether or not an inventor concealed the best mode from the public.³⁴ In short, this part of the test determines whether the inventor’s disclosure of a mode on the original application is adequate to enable “one of

at 415 (discussing an inventor who failed to disclose a certain type of fluoride surface treatment that prevented leakage on a valve stem seal in an internal combustion engine. Because the undisclosed information would have prevented leakage, the court found that it had a material effect on the properties of the invention; therefore, failure to disclose the information was a violation of the best mode requirement.).

³⁰ *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1330–31 (Fed. Cir. 2002) (citing *Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 560 (Fed. Cir. 1994)).

³¹ *Green Edge Enters. v. Rubber Mulch Etc., LLC*, 620 F.3d 1287, 1296 (Fed. Cir. 2010); *see also Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1360 (Fed. Cir. 2011) (“The best mode requirement has two parts. First, the court must determine whether, at the time of patent filing, the inventor possessed a best mode of practicing the claimed invention. . . . Second, if the inventor has a subjective preference for one mode over all others, the court must then determine whether the inventor ‘concealed’ the preferred mode from the public.”); *Ajinomoto Co.*, 597 F.3d at 1273 (laying out the two-pronged inquiry used by courts to determine compliance with the best mode requirement).

³² *High Concrete Structures, Inc. v. New Enter. Stone & Lime Co.*, 377 F.3d 1379, 1382 (Fed. Cir. 2004) (citation omitted).

³³ *Id.*; *see also Bayer AG*, 301 F.3d at 1320 (discussing the first, subjective prong of the two-prong test used to determine compliance with the best mode requirement).

³⁴ *High Concrete Structures, Inc.*, 377 F.3d at 1382; *see also N. Telecom Ltd. v. Samsung Elecs. Co.*, 215 F.3d 1281, 1286 (Fed. Cir. 2000) (laying out the second, objective prong of the two-prong test used to determine compliance with the best mode requirement).

ordinary skill in the art” of the inventor to practice the best mode.³⁵ Courts have noted that this second prong is dependent on two things—“the scope of the claimed invention and the level of skill in the relevant art.”³⁶

Through its interpretations of § 112 and use of the two-prong test, the judiciary has also imposed some limitations on the use of the best mode requirement as a defense in patent litigation. First, the subjective prong of the best mode test must, obviously, be applied specifically to an inventor as an individual.³⁷ It is insufficient for a defendant to produce evidence of what the inventor should have or could have known as a person of skill in his art.³⁸ The evidence must show that the specific inventor had a best mode in mind and chose not to reveal it when the original patent application was filed.³⁹

The best mode requirement does not require the disclosure of the best mode in any absolute sense.⁴⁰ Instead, it simply requires disclosure of the best mode subjectively possessed by the inventor at the time the patent application was filed.⁴¹ Furthermore, the United States Court of Appeals for the Federal Circuit has stated that a violation of the best mode requirement demands proof of deceptive intent on the part of the inventor at the time the patent application was filed.⁴² The subjective nature of the first prong, coupled with the requirement of proof of deceptive intent, presents a heightened evidentiary standard that serves as a limitation on the applicability of the best mode defense to a particular case.

Another limitation on the best mode requirement in litigation is that it is limited to the invention as defined by the original claims.⁴³ Therefore, any subject matter that is outside the scope of the claims is outside the statutory scope of the best mode requirement.⁴⁴ In applying this principle to patent

³⁵ *Bayer AG*, 301 F.3d at 1320 (quoting *N. Telecom. Ltd.*, 215 F.3d at 1281).

³⁶ *Id.*

³⁷ *Green Edge Enters.*, 620 F.3d at 1296; see also *Ajinomoto Co.*, 597 F.3d at 1273 (explaining subjective nature of first prong of the test to determine compliance with the best mode requirement).

³⁸ *Ajinomoto Co.*, 597 F.3d at 1273.

³⁹ *Id.*

⁴⁰ *Phillips Petroleum Co. v. U.S. Steel Corp.*, 673 F. Supp. 1278, 1333 (D. Del. 1987) (citing 3 DONALD S. CHISUM, CHISUM ON PATENTS § 7.05[1] (1987)).

⁴¹ *Ajinomoto Co.*, 597 F.3d at 1273.

⁴² *High Concrete Structures, Inc.*, 377 F.3d at 1382–83.

⁴³ *Ajinomoto Co.*, 597 F.3d at 1273; see also *Zygo Corp. v. Wyko Corp.*, 79 F.3d 1563, 1567 (Fed. Cir. 1996) (“[O]ur precedent is clear that the parameters of a section 112 inquiry are set by the CLAIMS.”); *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 927 (Fed. Cir. 1990) (“The other objective limitation on the extent of the disclosure required to comply with the best mode requirement is, of course, the scope of the claimed invention.”).

⁴⁴ *Ajinomoto Co.*, 597 F.3d at 1273; see also *AllVoice Computing PLC v. Nuance Commc’ns*,

litigation, courts have stated that the threshold step in any best mode analysis is to “define the invention by construing the claims.”⁴⁵ If the subject matter of the lawsuit falls outside of the claims, then a court simply will not proceed to the two-prong test used to evaluate best mode compliance.⁴⁶

III. LEGISLATIVE HISTORY OF THE BEST MODE REQUIREMENT IN THE AMERICA INVENTS ACT

Congress began its efforts to overhaul the patent system in the House of Representatives with the introduction of the Patent Reform Act of 2005.⁴⁷ The bill completely eliminated the best mode requirement from United States patent law.⁴⁸ The following year, the Patent Reform Act of 2006 was introduced in the United States Senate.⁴⁹ The Senate version of the legislation failed to mention the best mode requirement and left the requirement and the best mode defense in place.⁵⁰ In effect, the best mode requirement remained exactly the same.⁵¹

Congressional efforts to overhaul the patent system continued in 2007 when another version of the Patent Reform Act was introduced in the House of Representatives.⁵² This bill was the first to embrace the “compromise” position that would ultimately be enacted into law in 2011.⁵³ One section of the bill eliminated the use of the best mode requirement as a defense in patent litigation, while a second section of the bill eliminated the use of a best mode violation as grounds for instituting a post-grant review of a patent.⁵⁴ However, the bill did keep in place the best mode requirement of 35 U.S.C. § 112.⁵⁵ In its report accompanying the bill, the House Judiciary Committee reaffirmed what it believed to be the important function of the best mode requirement in U.S.

Inc., 504 F.3d 1236, 1246–48 (Fed. Cir. 2007).

⁴⁵ *Ajinomoto Co.*, 597 F.3d at 1273; *see also* *Engel Indus., Inc. v. Lockformer Co.*, 946 F.2d 1528, 1531 (Fed. Cir. 1991) (“The best mode inquiry is directed to what the applicant regards as the invention, which in turn is measured by the claims. Unclaimed subject matter is not subject to the disclosure requirements of § 112 . . .”).

⁴⁶ *Ajinomoto Co.*, 597 F.3d at 1273.

⁴⁷ Patent Reform Act of 2005, H.R. 2795, 109th Cong. (2005).

⁴⁸ Matthew J. Dowd et al., *Nanotechnology and the Best Mode*, 2 NANOTECHNOLOGY L. & BUS. 238, 253 (2005); *id.* § 4(D)(1)(B).

⁴⁹ Patent Reform Act of 2006, S. 3818, 109th Cong. (2006).

⁵⁰ *Id.*

⁵¹ *Id.*

⁵² Patent Reform Act of 2007, H.R. 1908, 110th Cong. (2007).

⁵³ Wesley D. Markham, *Is Best Mode the Worst? Dueling Arguments, Empirical Analysis, and Recommendations for Reform*, 51 IDEA 129, 159 (2011).

⁵⁴ Patent Reform Act of 2007, H.R. 1908, 110th Cong. §§ 6, 13 (2007).

⁵⁵ *Id.*

patent law and explained why it chose to adopt a compromise position.⁵⁶ The Committee asserted that keeping the requirement in place would help to ensure that inventors provided a full disclosure of their inventions and that the public would ultimately benefit from that full disclosure once the patents expired.⁵⁷ In eliminating best mode as defense in patent litigation, the Committee felt that it was removing “the incentive to engage in speculative analysis” during litigation.⁵⁸ In short, the Committee believed that the compromise position allowed it to retain a necessary and fundamental component of patent law, while simultaneously preventing its abuse during litigation.⁵⁹

A separate version of the Patent Reform Act of 2007 was introduced in the United States Senate.⁶⁰ Like the 2006 patent reform legislation in the Senate, the bill did not address the best mode requirement thereby leaving it in place.⁶¹ Two years later, the Patent Reform Act of 2009 was introduced in the Senate.⁶² The bill adopted the compromise position that had been proposed in the House of Representatives in 2007.⁶³ Section 14 of the legislation eliminated the best mode requirement as a defense in patent litigation, and section 5 of the legislation eliminated a violation of best mode as grounds to initiate a post-grant review of a patent.⁶⁴ However, like the 2007 House legislation, the bill left the best mode requirement in place.⁶⁵ In its report accompanying the bill, the Senate Judiciary Committee explained its reasoning for adopting the compromise position.⁶⁶ The Committee believed the elimination of best mode as a litigation defense effectively addressed the valid concerns of many who felt that the requirement had become counterproductive overall and particularly problematic and subjective in litigation.⁶⁷ The Committee also felt that keeping the requirement in the law was important because committee members viewed the public disclosure requirements of patent law as too important to simply

⁵⁶ H.R. REP. NO. 110-314, at 43–44 (2007).

⁵⁷ *Id.* at 44.

⁵⁸ *Id.*

⁵⁹ *Id.* at 43–44.

⁶⁰ Patent Reform Act of 2007, S. 1145, 110th Cong. (2007).

⁶¹ *Compare id.*, with Patent Reform Act of 2006, S. 3818, 109th Cong. (2006).

⁶² *Compare* Patent Reform Act of 2009, S. 515, 111th Cong. (2009), with Patent Reform Act of 2007, S. 1145, 110th Cong. (2007).

⁶³ Patent Reform Act of 2007, H.R. 1908, 110th Cong. §§ 5, 14 (2007); *see also* Markham, *supra* note 53, at 160 (explaining the adopted compromise).

⁶⁴ Patent Reform Act of 2007, H.R. 1908, 110th Cong. § 5 (2007).

⁶⁵ Patent Reform Act of 2009, S. 515, 111th Cong. (2009).

⁶⁶ S. REP. NO. 111-18, at 24–25 (2009).

⁶⁷ *Id.*

abandon altogether.⁶⁸ With the passage of the Leahy-Smith America Invents Act in 2011, this compromise position was enacted and now governs patents, patent application procedures, and patent litigation in the United States.⁶⁹

IV. COMPETING ARGUMENTS CONCERNING THE BEST MODE REQUIREMENT

The best mode requirement has been the at the center of fierce debate in the academic and legal communities ever since it was put into Title 35 in its current form in 1952.⁷⁰ Opponents of the best mode requirement helped to make the abolition of the requirement one of the central issues surrounding Congress's efforts to reform the patent system beginning in 2005.⁷¹

A. ARGUMENTS IN FAVOR OF THE BEST MODE REQUIREMENT

1. *The Best Mode Requirement is Sound on Public Policy Grounds.* The fundamental argument in favor of the best mode requirement is that strong public policy rationales support it.⁷² In reporting the Patent Reform Act of 2007 to the House of Representatives, the House Judiciary Committee explained the basic public policy arguments in favor of the best mode requirement.⁷³ First, the Committee stated that the best mode requirement "goes to the heart of the reason that patents exist in the United States . . ."⁷⁴ The Constitution states that inventors shall have the exclusive right to their inventions for a limited period of time.⁷⁵ According to the Committee, the best mode requirement is intended to prevent an inventor from maintaining a monopoly or an unfair advantage in producing his or her invention beyond the limited period of time specified in the Constitution.⁷⁶

⁶⁸ *Id.* at 25.

⁶⁹ Leahy-Smith America Invents Act, H.R. 1249, 112th Cong. (2011) (enacted).

⁷⁰ Steven B. Walmsley, *Best Mode: A Plea to Repair or Sacrifice This Broken Requirement of United States Patent law*, 9 MICH. TELECOMM. & TECH. L. REV. 125 (2002); Jerry R. Selinger, *In Defense of "Best Mode": Preserving the Benefit of the Bargain For the Public*, 43 CATH. U. L. REV. 1071 (1994); Todd R. Miller, *The Public's Right to Know? Or a Red-Tape Nightmare? Demanding That Best Mode Disclosure Be Updated*, 35 IDEA 261 (1995).

⁷¹ Markham, *supra* note 53, at 132–34.

⁷² H.R. REP. NO. 110-314, at 43 (2007).

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ U.S. CONST. art. I, § 8, cl. 8.

⁷⁶ H.R. REP. NO. 110-314, at 43.

Second, the Committee felt that if an inventor could withhold the best mode of practice of his invention from the public, then he would effectively be able to retain a trade secret while simultaneously receiving patent protection.⁷⁷ This, the Committee felt, would be unfair and would “break faith with the fundamental bargain of patent law.”⁷⁸

2. *The Best Mode Requirement Helps to Prevent Unnecessary Reinvention and the Unauthorized Extension of a Patent.* Proponents of the best mode requirement also argue that its presence in American patent law prevents the unnecessary reinvention of patented material when a patent expires and also prevents the unearned extension of patents.⁷⁹ During the debates over Congressional reform of the patent system between 2005 and 2011, numerous organizations espoused these arguments.⁸⁰ These organizations were opposed to the elimination of the best mode requirement, and included the Generic Pharmaceutical Association⁸¹ and the Professional Inventors Alliance.⁸² According to the Generic Pharmaceutical Association (GPHA), the idea of a patent is to grant an inventor a temporary monopoly over his or her invention.⁸³ In exchange for that temporary monopoly, an inventor has an obligation to reveal the best mode and “most efficient known method” of producing the invention.⁸⁴ The GPHA asserted that if the inventor was allowed to withhold information concerning the best mode, then the public would lack technical knowledge to which it otherwise would have had access when the patent expired.⁸⁵ Therefore, the presence of the best mode requirement in the law helps to ensure that patent holders do not receive an unearned extension of the monopoly inherent in a patent.⁸⁶ In short, without the best mode requirement, the temporary monopoly discussed in the Constitution could effectively become a permanent monopoly. Furthermore, the GPHA asserted that the unauthorized extension of the patent monopoly would result in the public spending an inordinate amount of time “reinventing” products after these products’ patents expired.⁸⁷

⁷⁷ *Id.*

⁷⁸ *Id.*

⁷⁹ GENERIC PHARMACEUTICAL ASSOCIATION [hereinafter GPHA], <http://www.gphaonline.org/issues/patent-reform> (last visited Oct. 23, 2011).

⁸⁰ *Patent Harmonization: Hearing Before the Subcomm. on Courts, the Internet, and Intellectual Prop. of the H. Comm. on the Judiciary*, 109th Cong. 100 (2006) (statement of Mr. Pat Choate).

⁸¹ *Id.*

⁸² *Id.*

⁸³ GPHA, *supra* note 79.

⁸⁴ *Id.*

⁸⁵ *Id.*

⁸⁶ *Id.*

⁸⁷ *Id.*

The Professional Inventors Alliance, an organization founded in order to provide independent inventors all over the nation a united voice to influence public policy,⁸⁸ asserted that expanding public knowledge is one of the most important functions of the American patent system and that a patent constitutes a covenant between the inventor and the public.⁸⁹ That covenant consists of the exclusive use and production of the product by the inventor in exchange for imparting new knowledge to the public.⁹⁰ The Alliance argued that the elimination of the best mode requirement would lead to an unearned extension of the government-licensed exclusivity for the inventor, while also denying to the public “the full knowledge to which [it is] entitled” under American patent law.⁹¹

B. ARGUMENTS TO ELIMINATE THE BEST MODE REQUIREMENT

1. *Harmonization of American Patent Law with International Patent Law Systems is Desirable.* Opponents of the best mode requirement frequently argue that the requirement is unique to American law and that it hinders legal harmonization with international patent systems.⁹² The House Judiciary Committee laid out this argument in its report accompanying the Patent Reform Act of 2007.⁹³ The Committee noted that one of the most common objections to the best mode requirement was “the expense it adds to international filings.”⁹⁴ This additional expense, the argument goes, is a result of foreign and international patent applicants being forced to prepare and amend their patent applications to conform to the requirement in order to have their inventions protected in the United States.⁹⁵

In 2004, just prior to the beginning of Congressional debates on overhauling the patent system, the National Research Council of the National Academies released a report recommending steps to overhaul the American patent system as the nation moves further into the twenty-first century.⁹⁶ The Council made

⁸⁸ PROFESSIONAL INVENTOR’S ALLIANCE, http://www.piausa.org/general_info/about_us/index.html (last visited Oct. 8, 2012).

⁸⁹ *Patent Harmonization*, *supra* note 80, at 61.

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² H.R. REP. NO. 110-314, at 43.

⁹³ *Id.*

⁹⁴ *Id.* at 44.

⁹⁵ *Id.*

⁹⁶ COMM. ON INTELLECTUAL PROP. RIGHTS IN THE KNOWLEDGE-BASED ECON., NATIONAL RESEARCH COUNCIL OF THE NATIONAL ACADEMIES, A PATENT SYSTEM FOR THE TWENTY-FIRST CENTURY (Stephen A. Merrill et al. eds., Nat’l Acad. Press 2004) [hereinafter NATIONAL RESEARCH

numerous recommendations for overhauling the patent system, including the elimination of the best mode requirement.⁹⁷ The Council, noting that the best mode requirement is unique to the United States, asserted that foreign patent applicants often cite the best mode requirement as unfair and as an impediment to filing their previously filed patent applications in the United States.⁹⁸ For these reasons, the Council recommended the abolition of best mode once an overhaul of the patent system was undertaken.⁹⁹

2. *Legal Analysis of Best Mode is too Subjective for the Requirement to be Effectively Enforced.* Another argument against the best mode requirement is that the subjective nature of the legal analysis concerning best mode makes it difficult to consistently and effectively enforce.¹⁰⁰ In 1992, the Advisory Commission on Patent Law Reform asserted that the principal objective of the best mode requirement appeared to be “a full and fair disclosure of the preferred embodiment of an invention—in other words, a ‘high quality’ patent disclosure.”¹⁰¹ Due in part to the subjective nature of the best mode requirement, the Commission felt that it did not compel these “higher quality disclosures.”¹⁰² Because the best mode requirement only mandates disclosure of what the inventor believed to be the superior mode at the time of filing the patent application, if an inventor did not consider one mode of use to be better than any other (or simply had no best mode of use in mind), then the disclosure made under the requirement usually is not high in quality or usefulness.¹⁰³ Furthermore, “[i]f, at the time the patent application is filed, the applicant does not view one mode as being superior to others, there is no best mode to disclose.”¹⁰⁴ This type of situation simply produces no high quality disclosures. Finally, the Commission pointed out that the best mode requirement imposes no absolute duty on inventors to discover a best mode of practicing an invention before filing a patent application.¹⁰⁵ Therefore, the disclosure of a best mode is often “not a mandatory element of a patent disclosure,” which in

COUNCIL REPORT], available at <http://www.nap.edu/openbook.php?isbn=0309089107.html>.

⁹⁷ *Id.* at 82–83.

⁹⁸ *Id.* at 121.

⁹⁹ *Id.*

¹⁰⁰ THE ADVISORY COMM’N ON PATENT LAW REFORM, A REPORT TO THE SECRETARY OF COMMERCE 102 (1992) [hereinafter ADVISORY COMMISSION REPORT], available at http://ipmall.info/hosted_resources/lipa/patents/patentact/ACPLR-3.pdf.

¹⁰¹ *Id.* at 101.

¹⁰² *Id.* at 102.

¹⁰³ *Id.*

¹⁰⁴ *Id.*

¹⁰⁵ *Id.*

turn leads to a lack of higher quality best mode disclosures on patent applications.¹⁰⁶

Professor Donald S. Chisum suggests that the subjective nature of best mode legal analysis has led to its use in patent litigation in a manner that many would find somewhat objectionable.¹⁰⁷ Chisum points out that the best mode requirement often becomes a “last resort” defense for accused patent infringers who have otherwise weak technical cases.¹⁰⁸ He further states that the ability to raise the defense has been made easier for three reasons, all of which are the result of its subjective nature: (1) it is not precise; (2) it is subject to continual judicial interpretation; and (3) it depends on facts and states of mind at precise points in time, usually several years before the beginning of litigation.¹⁰⁹ Because of the subjective nature of best mode, accused infringers with weak technical cases can “try the person rather than the patent.”¹¹⁰

The National Research Council argued that the subjectivity of best mode offered “only limited assurance that the best mode will be disclosed.”¹¹¹ This is because the best mode defense applies to information that was personal to the inventor at the time of filing the patent application.¹¹² Accordingly, an inventor is not even required to disclose a best mode imparted to him by others in his “company or working group.”¹¹³ Therefore, a violation of the best mode requirement, the most powerful tool used to encourage best mode compliance, can be difficult to establish in litigation seeking to invalidate a patent. If the very nature of the requirement weakens the strongest tool available to enforce the requirement, then by default, there is a strong argument for abolition of the requirement altogether. Finally, the Coalition for 21st Century Patent Reform, an organization that lobbied Congress for the elimination of the best mode requirement during Congressional debate over patent reform, asserted that the subjectivity of the best mode requirement often raised more questions than answers and should simply be abolished.¹¹⁴

¹⁰⁶ *Id.*

¹⁰⁷ Donald S. Chisum, *Best Mode Concealment and Inequitable Conduct in Patent Procurement: A Nutshell, A Review of Recent Federal Circuit Cases and A Plea for Modest Reform*, 13 SANTA CLARA COMPUTER & HIGH TECH. L.J. 277, 279 (1997).

¹⁰⁸ *Id.*

¹⁰⁹ *Id.*

¹¹⁰ *Id.*

¹¹¹ NATIONAL RESEARCH COUNCIL REPORT, *supra* note 96, at 121.

¹¹² *Id.*

¹¹³ *Id.*

¹¹⁴ *Patent Reform In the 111th Congress: Legislation and Recent Court Decisions: Hearing Before the S. Comm. on the Judiciary*, 111th Cong. 162 (2009) [hereinafter *Johnson Testimony*] (statement of Philip S. Johnson).

3. *The Best Mode Requirement is Expensive to Litigate.* Many opponents of the best mode requirement have argued in favor of its abolition because it is expensive to litigate. The 1992 Advisory Commission on Patent Law Reform pointed out that a defendant in a patent infringement suit can assert the best mode defense “without any significant burden.”¹¹⁵ In asserting the defense, the defendant becomes entitled to discovery concerning the subjective beliefs and intentions of inventors prior to and on the date of the patent application filing.¹¹⁶ This, according to the Commission, “provides ample opportunities for discovery abuse,” which in turn unnecessarily increases the costs of patent litigation in the United States.¹¹⁷ Finally, the Commission notes that a “sad irony” of the best mode requirement is that it imposes the highest costs on American inventors.¹¹⁸ In recent decades, the vast majority of inventors who have had to use extensive resources, including financial resources, to defeat best mode litigation challenges have been American.¹¹⁹ The Commission views this irony as further grounds for abolition of the requirement altogether.¹²⁰

The alleged high cost of best mode requirement litigation was addressed by opponents of best mode during patent reform debates in Congress.¹²¹ The Coalition for 21st Century Patent Reform asserted that subjective elements of American patent litigation, including best mode, which made litigation more contentious and expensive, should, at the very least, be removed as a defense for an accused patent infringer.¹²² The Biotechnology Industry Organization believes that the requirement should be completely eliminated “with the goal of making the patent system more objective and less costly.”¹²³

4. *Best Mode is Often Obsolete by the Time Litigation Begins.* The House Judiciary Committee noted that one of the principle grounds upon which opponents object to the best mode requirement involves the requirement’s applicability only to modes supposedly known by the inventor at the time the patent application was filed and not to modes that may have been refined or created

¹¹⁵ ADVISORY COMMISSION REPORT, *supra* note 100, at 101.

¹¹⁶ *Id.*

¹¹⁷ *Id.*

¹¹⁸ *Id.*

¹¹⁹ *Id.*

¹²⁰ *Id.*

¹²¹ COALITION FOR 21ST CENTURY PATENT REFORM, http://www.patentmatter.com/issue/pdfs/20110125_basic_principles.pdf (last visited Aug. 23, 2012).

¹²² *Id.*

¹²³ *Patent Reform In the 111th Congress: Legislation and Recent Court Decisions: Hearing Before the S. Comm. on the Judiciary*, 111th Cong. 110 (2009) (statement of the Biotechnology Industry Organization).

after the filing date.¹²⁴ Because of this, by the time litigation begins, the best mode in question may already be obsolete.¹²⁵ This undermines the entire principle supporting the best mode requirement.

The 1992 Advisory Commission asserted that the best mode requirement was especially ill-suited to modern times.¹²⁶ The Commission asserted that in today's modern business world, the best mode requirement was of little use for two reasons: (1) in rapidly evolving technologies, including biotechnology and computer-program or software-related inventions, the best mode of an invention on the filing date will likely be very different from—and possibly inferior to—the best mode of an invention at the time a patent is granted; and (2) the competitive pressures of today's business world often require corporations and universities to file for a patent application very early in the development cycle, when it is often extremely difficult, if not impossible, to put forth a best mode of utilizing the invention or technology under development.¹²⁷ It is therefore likely that, in many situations, the best mode disclosed on the original patent application will be obsolete by the time litigation begins. As previously noted, this undermines the basic premise supporting the best mode requirement.

5. *The Best Mode Requirement is not Necessary to Obtain Sufficient Disclosures from Inventors.* The 1992 Advisory Commission stated that the best mode requirement is simply not necessary to ensure full and fair disclosure on the part of inventors concerning their inventions.¹²⁸ The Commission asserted that the objective requirements of the enablement and written description requirements help to ensure that sufficient descriptions are disclosed on patent applications.¹²⁹ To support its argument, the Committee pointed to examples of foreign nations that did not have a best mode requirement but still enjoyed high levels of industrial competitiveness and high quality disclosures on patent applications.¹³⁰

V. FUTURE ENFORCEMENT OF THE BEST MODE REQUIREMENT

Now that the compromise position adopted by Congress governs patent law in the United States, it is necessary to consider if and how the United States

¹²⁴ H.R. REP. NO. 110-314, at 44 (2007).

¹²⁵ *Id.*

¹²⁶ ADVISORY COMMISSION REPORT, *supra* note 100, at 102.

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Id.*

¹³⁰ *Id.*

Patent and Trademark Office (USPTO) and the courts will enforce the best mode requirement moving forward. This Part analyzes several potential options available to USPTO and the courts to enforce the best mode requirement under the new patent law regime, as well as potential problems with each option.

A. DO NOT STRICTLY ENFORCE THE BEST MODE REQUIREMENT

One option that the USPTO and the courts have concerning the best mode requirement is simply to not enforce the requirement in any meaningful way. In passing the America Invents Act and removing the best mode litigation defense, Congress effectively gutted the best mode requirement and eliminated any incentive for inventors to comply with the requirement. If the requirement has been gutted, why should USPTO and the courts put forth any meaningful effort to enforce the requirement? While this is a valid argument, there is one principal problem with its premise—in passing the America Invents Act, Congress evidently intended that the best mode requirement continue to be enforced.¹³¹

While debating patent reform between 2005 and 2011, Congress considered several different pieces of legislation to overhaul the patent system of the United States.¹³² In only one of them did either house of Congress consider the complete elimination of the best mode requirement.¹³³ The Senate Judiciary Committee and the House Judiciary Committee both reaffirmed Congress's commitment to the best mode requirement.¹³⁴ The House Judiciary Committee went so far as to state that the public policy rationale behind the best mode requirement goes “to the heart of the reason that patents exist in the United States.”¹³⁵ Furthermore, the Senate Judiciary Committee stated that, while the best mode litigation defense should be eliminated to remove its “inherently subjective” use in patent litigation, the best mode requirement should be kept in place due to the Committee's belief that public disclosure was an important and vital aspect of United States patent law.¹³⁶ Congress made it very clear throughout the debate on patent reform that it believed the best mode

¹³¹ H.R. REP. NO. 110-314, at 43–44 (2007); *see also* S. REP. NO. 111-18, at 24–25 (2009).

¹³² *See* Patent Reform Act of 2005, H.R. 2795, 109th Cong. (2005); *see also* S. 3818, 109th Cong. (2006); H.R. 1908, 110th Cong. (2007); S. 1145, 110th Cong. (2007); S. 515, 111th Cong. (2009); H.R. 1249, 112th Cong. (2011).

¹³³ Patent Reform Act of 2005, H.R. 2795, 109th Cong. (2005).

¹³⁴ H.R. REP. NO. 110-314, at 43–44 (2007); *see also* S. REP. NO. 111-18, at 24–25 (2009).

¹³⁵ H.R. REP. NO. 110-314, at 43 (2007).

¹³⁶ S. REP. NO. 111-18, at 24–25 (2009).

requirement played a vital role in American law and that the changes made to the law were primarily to prevent abuse of the requirement during litigation.¹³⁷ A refusal by USPTO and the courts' to enforce the requirement would violate the intent and spirit of the America Invents Act as well as the will of Congress.

B. USE THE CODE OF FEDERAL REGULATIONS TO ENFORCE THE BEST MODE REQUIREMENT

1. *Canons and Disciplinary Rules of Patent and Trademark Office Code of Professional Conduct.* USPTO has a second option available to it for potential enforcement of the best mode requirement in the future. Title 35 of the United States Code gives the Patent and Trademark Office the authority to establish rules and regulations governing the actions of attorneys who represent clients/inventors in their dealings with the Office.¹³⁸ These rules and regulations are found in Part 10 of Title 37 of the Code of Federal Regulations (CFR).¹³⁹ Part 10 of Title 37 sets out the Patent and Trademark Office Code of Professional Responsibility, which, in turn, lays out the canons and disciplinary rules that govern attorneys who practice before the Patent and Trademark Office.¹⁴⁰

Canons are defined as “statements of axiomatic norms, expressing in general terms the standards of professional conduct” expected of attorneys who practice before the Patent and Trademark Office in their relationships with the legal system, the legal profession, and the public.¹⁴¹ The following two canons are relevant to requirement enforcement of the best mode:

- Canon 1 – A practitioner should assist in maintaining the integrity and competence of the legal profession.¹⁴²
- Canon 7 – A practitioner should represent a client zealously within the bounds of the law.¹⁴³

Assuming an attorney's complicity in his client's actions, a client's failure to disclose a best mode could be construed as a violation of these two canons. The first canon states that an attorney should assist in maintaining the integrity

¹³⁷ *Id.*

¹³⁸ 35 U.S.C. § 2 (2010).

¹³⁹ Patent and Trademark Office Code of Professional Responsibility, 37 C.F.R. §§ 10.12–190 (2011).

¹⁴⁰ *Id.*

¹⁴¹ Canons and Disciplinary Rules, 37 C.F.R. § 10.20 (2011).

¹⁴² *Id.* § 10.21.

¹⁴³ *Id.* § 10.83.

of the legal profession.¹⁴⁴ If an attorney assists a client who violates the best mode requirement, an argument could be made that that attorney has harmed the integrity of the legal profession through non-compliance with a provision of the law.

A strong argument can also be made that a failure to comply with the best mode requirement is a violation of Canon 7. Under the new patent law regime, it is conceivable that not disclosing a best mode could actually be in the best interests of a client, given that many believe the best mode requirement has been effectively stripped of its power. However, the seventh canon clearly requires that a client's best interests be represented within the provisions of the law, including the best mode requirement.¹⁴⁵ Therefore, a best mode violation could also be seen as a violation of the seventh canon of the Code of Professional Responsibility.

Part 10 of Title 37 also lays out disciplinary rules for attorneys practicing before the Patent and Trademark Office.¹⁴⁶ Disciplinary rules are described as mandatory and defined as "the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action."¹⁴⁷ Several different disciplinary rules laid out in Part 10 are relevant to best mode enforcement. First, a rule found in section 10.23 of Part 10 states that a legal practitioner "shall not engage in disreputable or gross misconduct."¹⁴⁸ The CFR goes on to explain that a violation of this rule includes "knowingly giving false or misleading information or knowingly participating in a material way in giving false or misleading information" to the USPTO or to any employee of the office or to a client with any prospective, immediate, or pending business before the USPTO.¹⁴⁹ The disclosure of a best mode is still a part of the disclosure requirements that must be met in order to obtain a patent in the United States.¹⁵⁰ Because the best mode requirement is still enshrined in the law, the USPTO has a strong argument that disregarding the requirement when trying to obtain a patent constitutes "knowingly giving false or misleading information" to the Office in violation of the disciplinary rule in section 10.23 of Title 37 of the C.F.R.

¹⁴⁴ *Id.* § 10.21.

¹⁴⁵ *Id.* § 10.83.

¹⁴⁶ 37 C.F.R. §§ 10.20–170 (2011).

¹⁴⁷ *Id.* § 10.20.

¹⁴⁸ Misconduct, 37 C.F.R. § 10.23(a) (2011).

¹⁴⁹ *Id.* § 10.23(c)(2), (c)(2)(i); *id.* § 10.23(c)(2)(ii).

¹⁵⁰ 35 U.S.C. § 112 (2011).

The second relevant disciplinary rule is found in section 10.85 of Title 37.¹⁵¹ The rule states that, in the representation of a client, a practitioner cannot “conceal or knowingly fail to disclose that which the practitioner is required by law to reveal” or “counsel or assist a client in conduct that the practitioner knows to be illegal or fraudulent.”¹⁵² Once again, given the fact that the best mode requirement is still enshrined in patent law, USPTO could make a strong case that failure to disclose a best mode amounts to concealment of or a knowing failure to disclose information that an attorney and his or her client were required to disclose by law. Furthermore, USPTO could likely make a case that failure to disclose a best mode in violation of section 112 constitutes assisting a client in conduct that the attorney knows to be fraudulent or illegal.

Finally, there is another rule found in section 10.85 that is potentially relevant to best mode enforcement.¹⁵³ The rule states that a practitioner who receives information establishing that a client has “perpetrated a fraud upon a person or tribunal” should demand that the client rectify the situation, and, if the client does not or is unable to rectify the situation, the practitioner should report the fraud to the affected person or tribunal.¹⁵⁴ This rule is somewhat different from the first two in that it involves a situation in which the practitioner is not aware of the fraud from the beginning, but subsequently discovers it at a later date. In this situation, an attorney or practitioner who discovers that his client failed to comply with the best mode requirement after the fact should ask the client to rectify the situation. If the client refuses to rectify the situation, the practitioner has a duty to report the violation to the affected individual or tribunal, which is most likely an employee of USPTO or USPTO itself. If these steps are not taken, USPTO could find that the attorney violated the disciplinary rules found in section 10.85 of Title 37 of the Code.

2. *Advantages of Using the CFR for Best Mode Enforcement.* Title 35 of the United States Code gives the Patent and Trademark Office the authority to discipline attorneys for violations of its disciplinary rules.¹⁵⁵ The law specifically gives the director of the office the power to suspend or exclude from practice before the USPTO any “person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations” established by the Office for representing clients in patent matters.¹⁵⁶ This avenue of enforcement is attractive for a couple of reasons.

¹⁵¹ 37 C.F.R. § 10.85(a)(3) (2011).

¹⁵² *Id.* § 10.85(a)(3), (7).

¹⁵³ *Id.* § 10.85(b)(1).

¹⁵⁴ *Id.*

¹⁵⁵ 35 U.S.C. § 32 (2010).

¹⁵⁶ *Id.*

First, many inventors and patent applicants are represented and assisted by attorneys in the application process as well as in patent litigation. If USPTO were to take a firm stance on compliance with best mode requirement by initiating discipline proceedings against patent attorneys for violations of the Patent and Trademark Office Code of Professional Responsibility, it would likely lead to a higher level of compliance with section 112 disclosure requirements under the new patent law regime. If attorneys know they will be held accountable under the Code of Professional Conduct, it is rational to think that they, in turn, would make an effort to ensure their client's compliance with the best mode requirement. Second, the use of the disciplinary rules as an enforcement mechanism would utilize existing personnel and divisions of the Patent and Trademark Office. USPTO has already established the Office of Enrollment and Discipline, which is staffed with employees who are presumably familiar with the Code of Professional Conduct and the enforcement of the Code.¹⁵⁷ Attorney discipline, as is evident from the name of the division, is one of its main functions.¹⁵⁸ Therefore, this option for compelling enforcement is attractive because it would not require USPTO to set up a new apparatus or infrastructure to handle rule violations and consequent disciplinary actions.

3. *Problems with Using the CFR for Best Mode Enforcement.* While the canons and rules enumerated in the Code of Federal Regulations offer USPTO an avenue through which to compel continued compliance with the best mode requirement, there are several problems with using this method. First, as already discussed, many of the disciplinary rules laid out in the CFR require that the attorney in question have knowledge of his client's actions or dishonesty and that he either did nothing about it or was complicit in it.¹⁵⁹ This could be very hard for USPTO to prove in many cases. Second, any use of the rules of the CFR would require a subjective analysis of each individual patent application and the state of mind of each inventor who is under investigation.¹⁶⁰ In order for USPTO to hold an attorney liable, it must be able to prove that the mode given on the application is not the best mode required by section 112. It has already been noted that the subjective analysis required during best mode examination makes it difficult for courts to undertake.¹⁶¹ It is unlikely that this

¹⁵⁷ UNITED STATES PATENT AND TRADEMARK OFFICE — OFFICE OF ENROLLMENT AND DISCIPLINE, <http://www.uspto.gov/ip/boards/oed/> (last visited Sept. 7, 2012).

¹⁵⁸ *Id.*

¹⁵⁹ 37 C.F.R. § 10.23(c)(2)(i) (2011); *see also id.* § 10.85(a)(3).

¹⁶⁰ *Id.*

¹⁶¹ *Bayer AG v. Schein Pharm., Inc.*, 301 F.3d 1306, 1320 (discussing the first, subjective prong of the two-prong test used to determine compliance with the best mode requirement).

same subjective analysis of what is in an inventor's head at the time the patent application was filed would be any easier in this proceeding. In fact, it would likely be more difficult for the Patent and Trademark Office to undertake than for a court of law to undertake. Third, there is also the risk of punishing attorneys for the actions of inventors about which the attorneys had no knowledge or participation. While the rules require attorney knowledge and complicity, the risk that a mistake could be made remains. Finally, the use of the CFR as an enforcement mechanism could potentially be expensive. While the Patent and Trademark Office already has an infrastructure in place through the Office of Enrollment and Discipline, a decision to use the CFR to compel best mode compliance could spur the need to hire more staff, train more staff, and initiate a larger number of disciplinary proceedings and tribunals.

C. THE AMERICAN BAR ASSOCIATION CODE OF ETHICS

1. *Relevant ABA Rules of Professional Conduct.* The American Bar Association Rules of Professional Conduct offer another potential avenue through which compliance with the best mode requirement could be encouraged; although, in this instance, professional organizations—including state bar associations and professional disciplinary bodies—as well as the courts would be more involved with disciplinary proceedings than would USPTO. No matter the area of law in which an attorney practices, he or she is expected to comply with and uphold the ethical standards of the legal profession.¹⁶² These ethical standards and rules are set forth in the American Bar Association's Model Rules of Professional Conduct, which have been adopted or adapted in some form in all American jurisdictions.¹⁶³ An attorney who is found to have violated the Rules of Professional Conduct could face disciplinary action.¹⁶⁴ Several rules could potentially be relevant to best mode enforcement.

Rule 8.4(c), which governs professional misconduct on the part of attorneys, states that it is professional misconduct for an attorney to “engage in conduct involving dishonesty, fraud, deceit, or misrepresentation.”¹⁶⁵ This rule could be implicated if an attorney was found to be complicit with his client's failure to comply with the best mode requirement of section 112 of Title 35. Another rule that could be relevant to best mode disclosure is Rule 3.3, which governs an attorney's duty of candor toward the tribunal.¹⁶⁶ Rule 3.3 states that “a

¹⁶² MODEL RULES OF PROF'L CONDUCT Preamble and Scope (2012).

¹⁶³ MODEL RULES OF PROF'L CONDUCT (2011).

¹⁶⁴ *Id.* R. 8.5.

¹⁶⁵ *Id.* R. 8.4(c).

¹⁶⁶ *Id.* R. 3.3.

lawyer shall not knowingly offer evidence that the lawyer knows to be false.”¹⁶⁷ Furthermore, the rule states that “a lawyer who represents a client . . . that intends to engage, is engaging or has engaged in criminal or fraudulent conduct” related to a trial, tribunal, or hearing has a duty to take reasonable measures to remedy the situation.¹⁶⁸ This rule could come into play if an attorney’s client knowingly violates the best mode requirement, the attorney is aware of the violation of the law, and the attorney continues with the proceedings as normal without properly addressing his client’s actions.

2. *Advantages and Disadvantages of Using the ABA Model Rules of Professional Conduct for Best Mode Enforcement.* The rationale behind using the ABA Rules of Professional Conduct as an enforcement mechanism is much the same as is the rationale behind using the Code of Federal Regulations. If attorneys feel that they will be held responsible for some of the actions of their clients, they are more likely to ensure that their clients comply with every provision of the law, including the best mode requirement.

The problems with using the ABA Rules of Professional Conduct are virtually identical to those with using the CFR. First, the language of the rules makes it clear that enforcement of the rules would require a showing that the attorney involved was aware of the legal wrongdoing and was complicit in the wrongdoing.¹⁶⁹ In terms of best mode compliance, this likely will not be easy to prove. Second, like the CFR, enforcement of the ABA rules would likely require a subjective analysis of what knowledge a specific inventor or attorney had in his head concerning a best mode on the date the patent application was filed. This, as has already been noted, is almost always difficult to prove. Finally, under the Model Rules, attorneys also have a duty of confidentiality to current clients, which severely limits the information that they may or must reveal concerning their clients or the representation of their clients.¹⁷⁰ The requirements of Rule 1.6 would only make enforcement through the Model Rules that much more difficult.

D. TITLE 18 OF THE UNITED STATES CODE

Title 18 of the United States Code offers potential statutory authority on which to compel compliance with the best mode requirement. Section 1001 of Title 18 makes it a crime for anyone “in any matter within the jurisdiction of the executive, legislative, or judicial branch of the government of the United States

¹⁶⁷ *Id.* R. 3.3(a)(3).

¹⁶⁸ *Id.* R. 3.3(b).

¹⁶⁹ *Id.* R. 3.3.

¹⁷⁰ *Id.* R. 1.6.

[to] knowingly and willfully make any materially false, fictitious, or fraudulent statement or representation” or to make or use any document or writing that contains “any materially false, fictitious, or fraudulent statement or entry.”¹⁷¹ The penalty for violating this statute includes a fine and up to five years in prison.¹⁷² This statute could be used to hold both attorneys and inventors liable for violation of the best mode requirement.

As an agency of the Department of Commerce, the Patent and Trademark Office falls within the jurisdiction of the United States Government.¹⁷³ Therefore, if an inventor or his attorney files a patent application that does not truthfully detail best mode as required by the law, he could be found to have violated Title 18 of the United States Code. Furthermore, if an inventor or his attorney were found to have made false or misleading statements or representations to USPTO concerning the best mode listed on a patent application, he could be found in violation of Title 18. If USPTO chose to use this provision to prosecute inventors or attorneys for best mode violations, it would send a very strong message that the Office is serious about enforcing the best mode requirement, which would likely result in much higher levels of compliance with section 112 of Title 35.

1. *Advantages and Disadvantages of Using Title 18 to Enforce the Best Mode Requirement.* The biggest advantage of using Title 18 to enforce the best mode requirement is that it can be applied to both attorneys and inventors alike. Unlike most of the other options already discussed, Title 18 offers a way to hold the inventor directly liable for failure to comply with the best mode requirement.

The major problem with using Title 18 as a method of enforcement of the best mode requirement is the penalty for violating the statute. As far as the author is aware, there has never been a prosecution under this statute concerning misinformation on a patent application, a transgression that many would likely view as much too minor to merit such a harsh penalty. While the use of this statute to enforce compliance with the best mode requirement would undoubtedly send a message, it is unclear whether it is a practically feasible enforcement option in its current form.

¹⁷¹ 18 U.S.C. § 1001(a)(2)–(3) (2010).

¹⁷² *Id.* § 1001(a).

¹⁷³ THE UNITED STATES PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/about/index.jsp> (last visited Oct. 8, 2012).

E. THE INEQUITABLE CONDUCT DOCTRINE

1. *Explanation of the Inequitable Conduct Doctrine.* Another option for the continued enforcement of the best mode requirement is the use of the inequitable conduct doctrine. The inequitable conduct doctrine applies to all of a patent applicant's duties before USPTO and requires the inventor to disclose all information to USPTO that is relevant to the patentability of an invention.¹⁷⁴ This includes information such as non-obviousness, utility, novelty, and adequate disclosure.¹⁷⁵ If an inventor is found to have violated the duty of candor imposed by the doctrine of inequitable conduct, it is grounds for the immediate invalidation of a patent.¹⁷⁶ It is also important to note that the duty of candor created by the inequitable conduct doctrine extends to a patent applicant's representative.¹⁷⁷ The doctrine can potentially be so far reaching that, in some instances, a violation results in the invalidation of patents that are simply related to the patent being litigated.¹⁷⁸

The disclosure of an inventor's best mode of use is still part of the disclosure requirements of Title 35.¹⁷⁹ As previously noted, the inequitable conduct doctrine applies to all information relevant to patentability, including adequate disclosure.¹⁸⁰ Therefore, if an inventor is found not to have disclosed his or her best mode of use in violation of section 112, the inequitable conduct doctrine could be used to invalidate a patent in much the same way as the now-defunct best mode litigation defense. Furthermore, the Federal Circuit has held that the knowledge and actions of a patent applicant's attorney are chargeable to the applicant.¹⁸¹ In short, the inequitable conduct doctrine offers a legitimate alternative to the best mode defense in compelling compliance with the best mode requirement. In fact, the inequitable conduct doctrine has the potential to punish inventors even more severely than the best mode litigation defense, given the fact that, in some circumstances, it could nullify numerous patents that an inventor may hold.

2. *Advantages of Using the Inequitable Conduct Doctrine to Enforce the Best Mode Requirement.* The inequitable conduct doctrine is an attractive enforcement

¹⁷⁴ Christopher A. Cotropia, *Modernizing Patent Law's Inequitable Conduct Doctrine*, 24 BERKELEY TECH. L.J. 723, 725 (2009). See also *Molins PLC v. Tectron, Inc.*, 48 F.3d 1172, 1178 (Fed. Cir. 1995).

¹⁷⁵ Cotropia, *supra* note 174, at 725; see also *Molins PLC*, 48 F.3d at 1178.

¹⁷⁶ Cotropia, *supra* note 174, at 725.

¹⁷⁷ *FMC Corp. v. Manitowoc Co.*, 835 F.2d 1411, 1415 n.8 (Fed. Cir. 1987).

¹⁷⁸ Cotropia, *supra* note 174, at 725.

¹⁷⁹ 35 U.S.C. § 112 (2011).

¹⁸⁰ Cotropia, *supra* note 174, at 725.

¹⁸¹ *FMC Corp.*, 835 F.2d at 1411.

option for a couple of reasons. First, it is an established doctrine of patent law that is familiar to courts, patent attorneys, and USPTO. Because the doctrine is established and frequently used, there is already a legal framework in place for analyzing inequitable conduct claims. Second, many of the other possible enforcement mechanisms discussed in this Note indirectly encourage inventor compliance with the best mode requirement through threats of disciplinary action directed towards the inventor's legal representatives, if the best mode disclosure in the patent application is not adequate. The inequitable conduct doctrine has the advantage of holding inventors directly liable for best mode violations and, therefore, applying direct rather than indirect pressure to comply with best mode.

3. *Problems with Using the Inequitable Conduct Doctrine to Enforce the Best Mode Requirement.* There are problems, however, with using the inequitable conduct doctrine to enforce best mode compliance. Obviously, the issue of the subjective nature of best mode analysis remains a concern. However, perhaps the biggest problem facing the inequitable conduct doctrine is the action taken by Congress regarding inequitable conduct in its passage of the America Invents Act. In the Act, Congress established a new post-patent issuance proceeding that is called "Supplemental Examination."¹⁸² The establishment of this new proceeding is intended to address Congress's concern over the use of the inequitable conduct doctrine in patent litigation.¹⁸³ The Federal Circuit echoes Congressional concern and has asserted that the use of the inequitable conduct doctrine has "become an absolute plague" in almost all major patent cases.¹⁸⁴

The new supplemental examination process seemingly aims to cut down on the use of the inequitable conduct doctrine in patent litigation. Under the new supplemental examination procedure, information regarding a patent or patent application that was incorrect, was inadequately considered, or was not originally considered at all can be presented to USPTO for further examination before the start of litigation.¹⁸⁵ If the Office, after further examination of the information, determines that the information does not present any substantial new questions of patentability and does not affect the validity of the patent in question, that information cannot later be used in patent litigation to invalidate a patent on the basis of inequitable conduct.¹⁸⁶ Congress seems to view this

¹⁸² WENDY H. SCHACHT & JOHN R. THOMAS, CONG. RESEARCH SERV., R42014, THE LEAHY-SMITH AMERICA INVENTS ACT: INNOVATION ISSUES 14 (2011).

¹⁸³ *Id.* at 14–15.

¹⁸⁴ *Id.* at 15 (quoting *Burlington Indus., Inc. v. Dayco Corp.*, 849 F.2d 1418 (Fed. Cir. 1988)).

¹⁸⁵ H.R. REP. NO. 112-98, at 50 (2011), *reprinted in* 2011 U.S.C.C.A.N. 67, 81.

¹⁸⁶ *Id.*

new supplemental examination procedure as a means to prevent inequitable conduct from being so easily asserted in court.

While it is unclear how this new supplemental examination procedure will actually play out, it could potentially serve as a major roadblock to asserting inequitable conduct concerning a best mode disclosure in court. If USPTO and inventors begin to really utilize this new procedure to analyze questions of patentability, it could drastically cut down on the ability of attorneys and their clients to assert inequitable conduct claims against patents in court, including inequitable conduct claims concerning best mode disclosure. On the other hand, best mode analysis still contains an important subjective component, and it is unclear whether USPTO can undertake that type of analysis more effectively than the courts. It is also unclear at this point what sort of deference the courts will give to the conclusions reached by USPTO through this supplemental examination process. In short, while the inequitable conduct doctrine is a potential mechanism by which compliance with the best mode requirement can be compelled, it could potentially be undercut by the new post-grant supplemental review process outlined in the America Invents Act.

VI. RECOMMENDATION FOR FUTURE ENFORCEMENT OF THE BEST MODE REQUIREMENT

In all likelihood, the passage of the America Invents Act marks the end of the line for any type of strict enforcement of the best mode requirement. In removing the best mode litigation defense while at the same time actually keeping the best mode requirement in place, Congress severely limited the prospects for effective future enforcement of a requirement that many courts have already found difficult to enforce. However, Congress clearly intended for the best mode requirement to continue to be enforced under the new patent law regime, and the perceived continued importance of the best mode requirement was one of the principal reasons given for the adoption of the compromise position that ultimately won the day.¹⁸⁷ Therefore, this enforcement recommendation is made in light of Congress's apparent intention that the best mode requirement continue to be enforced.

Of all of the potential enforcement options discussed in this Note, the most viable enforcement option appears to be the provisions of Title 18 of the United States Code. To recap, section 1001 of Title 18 makes it a crime for anyone "in any matter within the jurisdiction of the executive, legislative, or judicial branch" of the United States government to knowingly and willfully

¹⁸⁷ H.R. REP. NO. 110-314, at 43-44 (2007); *see also* S. REP. NO. 111-18, at 24-25 (2009).

make “any materially false, fictitious, or fraudulent statement or representation” or to make or use any document or writing that contains “any materially false, fictitious, or fraudulent statement or entry.”¹⁸⁸

The use of Title 18 is a better future best mode enforcement tool than the other options discussed in this Note for two principal reasons. First, unlike the use of the Code of Federal Regulations and the Model Rules of Professional Conduct, Title 18 can be used to hold the inventor or patent applicant directly liable for a best mode violation.¹⁸⁹ The ability to compel enforcement directly rather than indirectly will likely result in higher levels of best mode compliance than might otherwise be achieved under the new regime established by the America Invents Act. Second, the next best option inequitable conduct doctrine seems to have fallen out of favor, and Congress has taken action to limit its use in patent litigation with the establishment of the new supplemental examination procedure.¹⁹⁰ While it is still too early to determine exactly how the inequitable conduct doctrine will be affected by the passage of the America Invents Act, it is not too early to say that the doctrine has, at the very least, fallen out of favor and could potentially be greatly weakened as a result of Congress’s action in the America Invents Act.

The principal problem with using section 1001 of Title 18 as an enforcement mechanism is the penalty imposed for violating the statute, currently a fine and up to five years in prison.¹⁹¹ Understandably, many people find the idea of a potential prison sentence for violating a provision of patent law to be repugnant. However, most people would likely find the imposition of a substantial fine in relation to patent law violations, such as a violation of the best mode requirement, to be reasonable. Therefore, the most effective option for future enforcement of patent disclosure requirements, such as best mode, would be the use of section 1001 of Title 18 to levy substantial fines on those who do not comply with the law. Obviously, the amount of the fine would depend on the specifics of the individual case and should serve as a real deterrent to repeat offenses.

Another potential option is the formulation of a section 1001-like statute specifically concerning the filing of patent applications and the information required to be included in patent applications. The statute could contain a minimum fine amount and a provision for fine increases, depending on the circumstances of a particular case and the parties involved in that case.

¹⁸⁸ 18 U.S.C. § 1001(a)(2)–(3) (2011).

¹⁸⁹ 18 U.S.C. § 1001(a) (2010).

¹⁹⁰ WENDY H. SCHACHT & JOHN R. THOMAS, CONG. RESEARCH SERV., R42014, THE LEAHY-SMITH AMERICA INVENTS ACT: INNOVATION ISSUES 14–15 (2011).

¹⁹¹ 18 U.S.C. § 1001(a) (2011).

VII. CONCLUSION

In September 2011, the patent reform process that began in Congress in 2005 came to a conclusion when President Obama signed the America Invents Act into law.¹⁹² In passing the Act, Congress made substantial reforms to the patent system for the first time in over fifty years and changed the nature of the best mode requirement, a fundamental tenant of U.S. patent law almost since its inception.¹⁹³ In adopting the compromise position of keeping the best mode requirement while also eliminating a violation of the requirement as grounds for patent invalidation, Congress most likely dealt a fatal blow to any meaningful enforcement of the requirement moving forward, especially since, historically, it has been hard to enforce, even with the litigation defense in place. However, Congress has made clear its intention that the requirement continue to be enforced.¹⁹⁴

In light of Congress's intentions, it is necessary to consider potential enforcement mechanisms at the disposal of the USPTO moving forward. These mechanisms include using the Code of Federal Regulations and the ABA Model Rules of Professional Conduct to hold attorneys liable for non-compliance with the requirement and, in turn, to put pressure on both inventors and their legal representatives to comply with the requirement. The use of the inequitable conduct doctrine presents another potential enforcement mechanism, but given the changes made in the America Invents Act concerning the application of the doctrine in litigation, it is unclear how effective it will be as a method of compelling best mode compliance in the future. Finally, section 1001 of Title 18 offers a statutory means through which to compel enforcement by threatening potential violators with prison time and fines. While the use of prison time to enforce the best mode requirement is likely off the table, the potential use of substantial fines under section 1001 provides the most effective means of compelling enforcement with the best mode requirement moving forward. Although this solution is not perfect, it is the best solution to the problem of enforcing the best mode requirement in this new America Invents Act world.

¹⁹² Hayat et al., *supra* note 7.

¹⁹³ *Id.*

¹⁹⁴ H.R. REP. NO. 110-314, at 43-44 (2007); *see also* S. REP. NO. 111-18, at 24-25 (2009).

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