

The America Invents Act: What Remains of Best Mode?

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I. Introduction

On September 16, 2011 the Leahy-Smith America Invents Act (“AIA”) was signed into law by President Obama, and lauded as a way to increase American jobs. The AIA presents the largest change to United States patent law since the Patent Act of 1952. For most changes, the effect on patent prosecution and litigation appear on their face to be straightforward. Much of the discussion surrounding the changes created by the AIA have revolved around the abolishment of the first-to-invent system in favor of a system resembling the first-to-file system. However, elimination of the failure to disclose the best mode as a means for challenging patent validity may have a greater immediate effect on patent law.

II. Changes to the Requirement to Disclose the Best Mode In Applications

The majority of the AIA changes will take effect within the next eighteen months. However, as of September 16, 2011 an applicant’s failure to disclose the best mode is no longer grounds for invalidating a patent.

A. Disclosure of the Best Mode Still Required

The AIA continues to require patent applicants to disclose the best mode contemplated by the inventor of carrying out the invention. Under the AIA, 35 U.S.C. § 112(a) “[t]he 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.” 35 U.S.C. § 112(a). While the requirement remains in the statute, it may be unenforceable due to the AIA amendments to 35 U.S.C. § 282(3)(A).

B. Elimination of an Invalidity Attack for Failure to Disclose Best Mode

Section 282(3)(A) sets forth the basis to challenge the validity of the patent, but expressly eliminates the failure to disclose the best mode as a basis for that invalidity. Under section 282(3)(A) the basis to challenge the patent or claim in suit can be invalidated for “failure to comply with...any requirement of section 112, except 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.” 35 U.S.C. § 282(3)(A). The basis for the elimination of best mode challenges may be to lower the costs of patent

litigation in the hope of encouraging economic stimulation. However, this immediate remedy may come with a larger price when those patent rights expire.

C. Possible Ramifications of the Elimination of an Invalidity Attack

Some patent practitioners have raised concerns that the elimination of best mode challenges will allow applicants to file without disclosure of any best mode. Without the possibility of losing a patent for failure to disclose, applicants may opt to disclose only so much of the “best mode” to satisfy the individual examiner, potentially preventing the public from knowing how the invention is best carried out. In theory, this would allow the applicant continued rights even after the patent has expired, as only the applicant would be privy to the knowledge of how the invention is best practiced. This would be in stark contrast to the basic reason for granting patent rights, in that the public is to be the beneficiary after those rights expire. Thus, the failure to disclose effectually increases the supposed costs saved in litigation through loss to the public.

This fear may be misplaced with the new Post Grant Review Process. Third parties will still have the possibility of best mode challenges brought under an inequitable conduct or similar principle when willful concealment is obvious. In addition, the application examiner still maintains the power to deny granting the application for failure to disclose the best mode. As a result, it will be in the best interest of the applicant to disclose the best mode, knowing at least the threat of a best mode challenge has been eliminated, even if the requirement has not.

D. Elimination of Best Mode Requirement in Claiming Priority to a Provisional, Continuation, Continuation in Part or Divisional Parent Application

The AIA eliminates the need of a parent application to comply with the best mode requirement for priority as long as it is based upon a domestic provisional application under 35 U.S.C. § 119(e)(1) or a continuation, continuation in part or divisional application under 35 U.S.C. § 120. Interestingly, the requirement for disclosure of the best mode in a parent application is not specifically eliminated in respect to priority based upon a foreign parent application under 35 U.S.C. § 119(a). It is possible the legislature did not see any need to address the foreign priority issue for two reasons. First, unlike sections 119(e)(1) and 120, section 119(a) makes no reference to the old section 112 or new section 112(a) for conditions for claiming the priority date of the foreign parent application. Without reference, it appears there was no need to make any changes to the law, and applicants would simply follow the requirements contained with section 119(a). Second, case law has indicated foreign priority should be determined based on the same requirements to claim domestic priority for continuing applications. (*Transco Products*, 38 F.3d at 558 n.7 (quoting *In re Gosteli*, 872, F.2d 1008, 1011 (Fed.Cir. 1989)).)

Unfortunately, confusion arises from further language in section 119(a) which provides that a foreign application “shall have the same effect as the same application would have if filed in this country...” 35 U.S.C. § 119(a). In order to comply with the

statutory language and maintain symmetry between sections 119 and 120, the foreign application would need to comply with the language of section 112(a). Yet the AIA remains quiet on this discrepancy. It may be an issue the judiciary will need to address at a later time.

III. Conclusion

For now, it is too soon to tell how the paradoxically opposed sections will eventuate in actual patent prosecution and litigation practice. As with any major changes to law, there will likely be much discussion and analysis before any set conclusions. In the meantime, the changes are something to be monitored.