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THE BEST MODE DISCLOSURE  
REQUIREMENT IN PATENT  
PRACTICE\*

I. INTRODUCTION

Acting within the scope of the Congressional mandate to "Promote the Progress of Science and useful Arts",<sup>1</sup> Congress has given to inventors a limited monopoly in the form of a right to exclude others from making, using or selling the invention<sup>2</sup> in exchange for public disclosure sufficient to enable one skilled in the relevant art to practice the invention.<sup>3</sup> However, above and beyond such an "enabling disclosure" requirement, Congress has specified that the embodiment of the public disclosure, the patent application, must describe the "best mode contemplated by the inventor of carrying out his invention."<sup>4</sup>

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<sup>1</sup> U.S. Const., art. 8, § 8, cl. 8.

<sup>2</sup> Act of July 19, 1952, 35 U.S.C. § 154, amended July 24, 1965, Public Law 89-83, § 5, 79 Stat. 261. Section 154 reads:

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of issue fees as provided for in this title, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof. It is apparent that the patent grant is a "limited" monopoly as opposed to an absolute monopoly in view of the fixed seventeen year duration of the grant from the time the patent issues.

<sup>3</sup> Act of July 19, 1952, 35 U.S.C. § 112.

<sup>4</sup> *Id.* The relevant portion of Section 112, which contains both the "enabling disclosure" requirement and the "best mode" disclosure requirement, 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

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Until about 1960,<sup>5</sup> failure to satisfy the "best mode" disclosure requirement was seldom asserted as a defense to patent infringement. In 1965, a patent was held to be invalid for failure to comply with the best mode disclosure requirement,<sup>6</sup> thus setting the stage for significant changes in the practice of patent law. Today and in the decade ahead the attorney must be aware of all aspects of the requirement in order to insure that the inventor will benefit from the rewards associated with the invention.

It is the purpose of this article to fully analyze the best mode disclosure requirement using the following approach:

First, the public policy basis for the best mode disclosure requirement and the corresponding inventor and attorney obligations will be explored.

Second, the relevant court decisions rendered during the last decade will be discussed with emphasis on the most recent cases.

Third, the position of the Patent and Trademark Office on the best mode disclosure requirement will be considered.

Fourth, best mode will be examined in the broader context of current patent conflicts.

Fifth, illustrative examples of best mode problems will be set forth and resolved.

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best mode contemplated by the inventor of carrying out his invention.

It should be noted that the best mode requirement was originally established by Congress in 1870. Act of July 8, 1870, ch. 230, § 261, 16 Stat. 201.

Although the determination of which of several modes is "best" is a subjective one based on the state of mind of the inventor at the time of filing the patent application, commercial potential is often an objective measure of the best mode. Such factors as process efficiency, raw materials cost, process yield, process simplicity, and equipment cost would be important considerations in a best mode determination.

<sup>5</sup> See *In re Nelson*, 280 F.2d 172, 126 U.S.P.Q. 242 (CCPA 1960).

<sup>6</sup> *Flick-Reedy Corp. v. Hydro-Line Mfg. Co.*, 351 F.2d 546, 146 U.S.P.Q. 694 (7th Cir. 1965), *cert. denied* 383 U.S. 958.

Sixth, the outlook for the future of the best mode disclosure requirement will be determined.

## II. PUBLIC POLICY BASIS AND IMPLICATIONS

The best mode disclosure requirement strikes a balance in the interest of fairness between the competing societal needs of encouraging invention by the grant of a limited monopoly while, at the same time, encouraging free competition by preventing the misuse of the monopoly grant.<sup>7</sup> Assume, for the sake of argument, that the inventor discloses only the second-best means of carrying out the invention in the patent application. If a patent is granted in this instance, the patentee could enjoy patent protection simultaneously with trade secrecy protection<sup>8</sup> for

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<sup>7</sup> Such misuse would result if the patent monopoly were unlawfully extended beyond the seventeen year statutory period.

<sup>8</sup> A common law trade secret

may consist of any formula, pattern, device or compilation of information which is used in one's business, and which gives him an opportunity to obtain an advantage over competitors who do not know or use it. It may be a formula for a chemical compound, a process of manufacturing, treating or preserving materials, a pattern for a machine or other device, or a list of customers.

<sup>4</sup> Restatement of Torts § 757, Comment b (1939).

In contrast, the subject matter which is patentable is limited to a "process, machine, manufacture, or composition of matter or . . . improvement thereof," (35 U.S.C. § 101) which fulfills the conditions of novelty and utility as specified in 35 U.S.C. §§ 101 and 102, and nonobviousness as set forth in 35 U.S.C. § 103.

Section 101 states:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Section 102 states:

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the

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the single invention. The best mode disclosure requirement effectively obviates this problem by insuring that the most preferred means of carrying out the invention is disclosed in the patent application. Thus, it makes good sense from a public policy viewpoint that the inventor be required to set forth in the patent application the *best* mode for practicing the invention and not just *any* mode.

In view of the above-mentioned public policy considerations, the burden of insuring that the substantive disclosure requirement has been satisfied falls jointly upon the inventor and the attorney.

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date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Section 103 states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Before the filing date, patent and trade secrecy protection are mutually exclusive, and the inventor or the corporate proprietor of the invention must choose one form of protection for a given invention. Trade secrecy protection can be elected for all of the following: (a) clearly patentable inventions that are not patented, (b) doubtfully patentable inventions, and (c) clearly unpatentable inventions. *Kewanee Oil Co. v. Bicron Corp.* 416 U.S. 470, 181 U.S.P.Q. 673 (1974). Patent misuse might result, however, when the inventor or corporate proprietor of the invention attempts to enjoy the benefits of both forms of protection simultaneously for a single invention, and this can happen if there is a deliberate withholding of the disclosure of the best mode from the patent application in contravention of 35 U.S.C. § 112.

*A. Inventor's Obligation*

The inventor has the obligation to provide the attorney who is writing the patent application with information relating to the best mode of carrying out the invention in an amount sufficient to allow the attorney to properly incorporate the best mode into the application. The standard for measuring the sufficiency of the information is that knowledge possessed by the inventor at the time of filing the patent application. Thus, information relevant to best mode not known to the inventor at the time of filing is outside the scope of the disclosure requirement. In this regard, the inventor is at all times held to a good faith standard in the role as applicant for a patent in order to preclude the concealment of any information within the inventor's knowledge that might have a bearing on full disclosure of the best mode.

*B. Attorney's Obligation*

The attorney has an affirmative duty to insure that the best means of practicing the invention has been incorporated into the patent application prior to filing. Such a duty presupposes that the attorney must become thoroughly familiar with the invention and the inventor's thoughts regarding the best means of carrying out the invention. From a procedural standpoint, in view of the time period between the inventor's written invention disclosure and the filing of the completed patent application, it is suggested that the attorney consult with the inventor just prior to filing the application in order to obtain a confirmation that the best mode has been included in the application. Of course, a timely filing of the application after receipt by the attorney of the invention disclosure will minimize the likelihood of changes in the best mode from that given in the invention disclosure. By way of illustration, assume that Inventor S conceives of an invention on May 1, and reduces it to practice on May 15 using laboratory experiments. An invention disclosure detailing the conception and reduc-

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tion to practice is completed by the inventor on May 20 and received by the attorney on June 1. The attorney consults with Inventor S and is assured that the project report includes a best mode example. The attorney completes the preparation of a patent application containing the best mode example on August 15 and arranges a conference with Inventor S for the following day for the signing of the inventor's oath or declaration.<sup>9</sup> At the conference, another best mode check is made, this time in order to determine whether or not a better means of practicing the invention has been devised by the inventor during the period from the writing of the invention disclosure (May 20) to date (August 16). Such an improvement might result, for example, from additional experimental work conducted by the inventor for the purpose of removing flaws from the invention prior to scale-up from the laboratory to the production plant and subsequent commercial production. A final best mode check is made, as has been indicated above, just prior to filing the patent application in order to determine whether or not there has been an improvement in the invention during the period from August 16 to the filing date.<sup>10</sup>

By following the above procedure, the attorney can preclude the successful assertion of best mode as a defense to patent infringement. In other words, the attorney can assure that the patent owner will not lose the right to enforce the patent against infringers for failure to disclose best mode.

### *C. Interplay With Antitrust Law, and Trade Secrecy*

#### *(1) Antitrust Law*

There is an apparent conflict between the public policy objective of free competition in the marketplace, on the one hand, and the objective of protecting the proprietary

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<sup>9</sup> 35 U.S.C. § 115 and § 25.

<sup>10</sup> In actual practice, both multiple informational exchanges between the attorney and the inventor and re-drafting of the application are usually necessary. In this respect, the illustration in the text is simplified.

interests of the inventor, on the other. The antitrust laws such as the Sherman Act<sup>11</sup> and the Clayton Act,<sup>12</sup> and supplements to the antitrust laws such as the Federal Trade Commission Act,<sup>13</sup> apparently promote the former objective, whereas the patent statutes are seemingly directed toward the latter.<sup>14</sup> Absent best mode, such a dichotomy would operate in full force. That is, the inventor could secure statutory patent protection by means of a second-rate public disclosure in the patent, thereby preventing others from practicing the invention. At the same time, the inventor could effectively thwart competition by non-disclosure of the preferred method of practicing the invention - a classic case of having one's cake and eating it too.<sup>15</sup> The best mode disclosure re-

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<sup>11</sup> Sherman Act, 15 U.S.C. §§ 1 *et seq.* (1970). Section 1 states: Every contract, combination in the form of trust or otherwise, or conspiracy, in restraint of trade of commerce among the several States, or with foreign nations is declared to be illegal . . .

Section 2 states:

Every person who shall monopolize, or attempt to monopolize, or combine with any other person or persons, to monopolize any part of the trade or commerce among the several States, or with foreign nations, shall be deemed guilty of a misdemeanor . . .

<sup>12</sup> Clayton Act, 15 U.S.C. §§ 12 *et seq.* (1970). Although there is considerable overlap, the Clayton Act is generally more specific in its prohibitions than is the Sherman Act. The provision related to patents is Section 3 of the Clayton Act, 15 U.S.C. § 14 (1970). Section 3 states:

It shall be unlawful for any person engaged in commerce, in the course of such commerce, to lease or make a sale or contract for sale of goods . . . whether patented or unpatented, for use, consumption, or resale within the United States . . . or fix a price charged therefor . . . where the effect of such lease, sale, or contract . . . may be to substantially lessen competition or tend to create a monopoly in any line of commerce.

<sup>13</sup> Federal Trade Commission Act, 15 U.S.C. §§ 41 *et seq.* (1970). This act broadly prohibits unfair and deceptive trade practices and unfair competition.

<sup>14</sup> There are clear personal property rights in a patent. Patent Act of 1952, 35 U.S.C. § 261 (1970). Section 261 states:

Subject to the provisions of this title, patents shall have the attributes of personal property. Applications for patent, patents, or any interest therein, shall be assignable in law by any person by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

<sup>15</sup> What is being postulated here is the absence of the best mode disclosure requirement. In the face of the requirement, the inventor would not necessarily have his cake inasmuch as the failure to dis-

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quirement causes any apparent patent monopoly/free competition dichotomy to blur since the issuance of a patent containing best mode not only vests statutory rights in the inventor,<sup>16</sup> but also provides a touchstone for use by competitors in improving upon the best method known by the inventor at the time of filing. Thus, competitors are given the opportunity to improve upon the disclosed best mode-containing invention in order to produce another invention.<sup>17</sup>

### *(2) Trade Secrecy*

As has been indicated above, the best mode disclosure requirement prevents the simultaneous enjoyment of both patent and trade secrecy protection for a single invention.<sup>18</sup> In the absence of best mode, the two forms of protection would come in head-to-head conflict. On the one hand, the inventor (or corporate proprietor) would enjoy statutory patent protection for a seventeen year period<sup>19</sup> in exchange for a disclosure of the second-best mode. At the same time, the inventor would enjoy trade secrecy protection for a period of unlimited duration on the best mode. In view of the fact that there is no preemption of state trade secrecy by the federal patent laws,<sup>20</sup> the result would likely be the demise of both systems of protection. In the presence of best mode, however, the conflict disappears and the inventor must elect one form of protection<sup>21</sup> or the other since the invention cannot be divided into more preferred and less preferred pieces. In the instance where trade secrecy is chosen,

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close best mode would, if discovered, provide a basis for a holding that the patent is invalid and unenforceable against an alleged infringer.

<sup>16</sup> See note 2 *supra* and accompanying text.

<sup>17</sup> A competitor can in this manner obtain a patent on the new invention provided that it is patentably distinct from the original patent.

<sup>18</sup> See note 8 *supra* and accompanying text.

<sup>19</sup> 35 U.S.C. § 154.

<sup>20</sup> *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 181 U.S.P.Q. 673 (1974).

<sup>21</sup> *Id.*

the inventor has a period of one year of use of a patentable invention under secrecy before there will be forfeiture of any right to patent protection.<sup>22</sup> Adherence to the best mode disclosure requirement, therefore, actually promotes competition by providing individual and corporate competitors with information regarding processes having the greatest commercial potential;<sup>23</sup> information that would no doubt be kept secret using a trade secrecy agreement<sup>24</sup> in the absence of patent protection. Thus, there is a substantial public benefit associated with the best mode disclosure requirement both in terms of increased competition in the marketplace and protection of the proprietary interests of the inventor.

In view of the above discussion, it is clear that one cannot enjoy both patent and trade secrecy protection for the elements of best mode prior to the filing date. However, improvements made after filing would be prime candidates for trade secrecy protection. In light of this fact, good corporate planning would militate in favor of an early filing after reduction to practice in order to maximize the amount of information (e.g., pilot plant and full-scale processing information) that would be protectable under trade secrecy.

Some commentators have taken a conservative position toward best mode compliance—a position that this author fully supports.<sup>25</sup> Others argue that Section 112

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<sup>22</sup> 35 U.S.C. § 102(b).

<sup>23</sup> See note 4 *supra*.

<sup>24</sup> Secrecy agreements are commonly used to preserve a trade secret. A typical secrecy agreement is given below:

Company X and Company Y covenant and agree on behalf of their companies, officers, directors, employees and agents that each will maintain in strict confidence all technical information relating to Process A; with the proviso that each company is not precluded from disclosing information that was known to that company prior to the time of a disclosure by the other company.

No license to any patents of Company X or Company Y is granted by virtue of the disclosures of said technical information pursuant to this agreement.

This agreement shall terminate z years from the date given below.

<sup>25</sup> See generally McDougall, "The Courts Are Telling Us: 'Your Client's Best Mode Must Be Disclosed.'", 59 J. Pat. Off. Soc'y. 321 (1977); Bjorge, "Editorial Epilogue", 59 J. Pat. Off. Soc'y. 336 (1977).

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should be construed narrowly in order to maximize the amount of information protectable under trade secrecy before the filing date.<sup>26</sup> For example, it has been suggested that Section 112 "does not require a disclosure of the best mode of *making* the invention".<sup>27</sup> Using this reasoning, it is asserted that in the instance where the claimed invention encompasses a process, the apparatus employed therein would be a candidate for trade secrecy protection.<sup>28</sup> Such an assertion is untenable in view of recent case law<sup>29</sup> wherein it is pointed out that a claimed process cannot be carried out in a vacuum but must employ *some* apparatus, and the preferred aspects of the apparatus constitute an inherent part of the best mode disclosure. Thus, an extremely conservative posture should be taken regarding the withholding of *any* element of best mode for trade secrecy purposes prior to the filing date.

### (3) *Enforcement*

Further possibilities for the interplay among antitrust, trade secrecy and the best mode requirement are avail-

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<sup>26</sup> See Honeycutt, "Preserving Know-How and Trade Secrets While Complying With Section 112", 1977 Patent Law Developments 205 (15 Southwestern Patent Conference 205). Professor Roger M. Milgrim, the noted authority on trade secrets, endorses an approach that would achieve compliance with the patent statute while maximizing trade secrecy retention. See remarks of Prof. Milgrim at a symposium of the A.B.A.'s Section of Patent, Trademark and Copyright Law on August 8, 1977, reproduced at 1977 Proceedings of Section of Patent, Trademark and Copyright Law 131, 138-143.

<sup>27</sup> Honeycutt, "Preserving Know-How and Trade Secrets While Complying With Section 112", 1977 Southwestern Patent Conference Compendium 205, 212 (Matthew Bender Co.). Mr. Honeycutt distinguishes between "make and use" in the enablement portion of Section 112, on the one hand, and "carrying out" in the best mode portion. *Id.* at 211. This distinction, although novel, does not stand up to an analysis of the plain language of the statute. Clearly, best mode requires a disclosure of the series of steps necessary to produce the claimed invention, and this disclosure would correspond to "making" the invention.

<sup>28</sup> *Id.* at 214.

<sup>29</sup> Notes 59-65 *infra* and accompanying text. Mr. Honeycutt relies on a restrictive interpretation of case law (e.g., *ITT Corp. v. Raychem Corp.*, note 96 *infra*) that does not represent the prevailing view. In light of *Union Carbide Corp. v. Borg-Warner Corp.*, note 59 *infra*, an extremely conservative position toward disclosure is in order.

able in the area of enforcement. Under current law, an alleged infringer may challenge the validity of a patent on best mode grounds.<sup>30</sup> As a logical extension, relief in equity is presumably available on the theory of patent misuse when the patentee attempts to enforce patent rights while, at the same time, retaining protection for the best mode under trade secrecy. In such an instance, an alleged infringer can arguably go beyond asserting failure to disclose best mode as a defense, and can raise an antitrust violation as a counter-claim. For example, the alleged infringer might assert that the patentee's wrongful conduct amounted to unreasonable restraint of trade in violation of Section 1 of the Sherman Act<sup>31</sup> and/or a monopoly offense in violation of Section 2 of the Sherman Act.<sup>32</sup> In order to sustain a cause of action for one of these antitrust violations, the defendant counterclaimant must prove all of the necessary elements of the offense, i.e. proof of competitive injury resulting from the anticompetitive conduct proscribed by the law. Proof of such an antitrust violation would give rise to the recovery of treble damages under Section 4 of the Clayton Act.<sup>33</sup>

Whether or not failure to disclose best mode will give rise to broad enforcement, as discussed above, depends, of course, on the development of the law in the courts.<sup>34</sup> To date, defendants in infringement suits who have

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<sup>30</sup> Statutory basis for asserting the defense for failure to comply with 35 U.S.C. § 112 is provided in 35 U.S.C. § 282.

<sup>31</sup> See note 11 *supra*.

<sup>32</sup> *Id.*

<sup>33</sup> 15 U.S.C. § 15.

<sup>34</sup> To date there has been no case in which an antitrust counterclaim has been coupled with a best mode defense in an infringement suit. However, in the future such a counterclaim should be recognized where the failure to disclose best mode rises to the level of an antitrust violation. If the counterclaim is based on Section 2 of the Sherman Act, as would most probably be the case, all of the elements of at least one of the three types of monopoly offenses (i.e., monopolization, attempt to monopolize or conspiracy to monopolize) would have to be proven. If the counterclaim is based on Section 1 of the Sherman Act, it would be necessary to prove an *actual* unreasonable restraint of trade resulting from concerted action involving the patentee.

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raised best mode as a defense appear to have done so, almost as an afterthought, in connection with other arguments such as anticipation by prior art or obviousness over prior art. However, since some circuit courts have been receptive to a best mode defense, as is shown in the case law set forth below, it can be expected that defendants will be encouraged to use it more extensively in the future.

### III. CASE LAW DURING THE LAST DECADE

Beginning with bits of obiter dictum as to the meaning of the best mode requirement, a substantial body of case law has developed at the Federal District Court and U.S. Court of Appeals levels during recent years. For example, one significant piece of dictum is that the best mode requirement does not allow the inventor to disclose only the "second-best embodiment, retaining the best for himself."<sup>85</sup> Another example of dictum relates to the public policy of requiring best mode disclosure in order to prevent the concealment of "preferred embodiments" of the invention.<sup>86</sup> These statements provided the foundation for the increased assertion of failure to disclose best mode as a defense to a suit for patent infringement. Several cases relating to the assertion of this defense, some successfully and others unsuccessfully, are given below.

In *Benger Laboratories Ltd. v. R. K. Laros Co.*,<sup>87</sup> the defendants asserted undisclosed best mode as a defense to patent infringement. The District Court made a

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<sup>85</sup> Note 5 *supra* at 253.

<sup>86</sup> *In re Gay*, 309 F.2d 769, 135 U.S.P.Q. 311 (CCPA 1962). The Court stated at 315:

Manifestly, the sole purpose of this latter requirement [the best mode] is to restrain inventors from applying for patents while at the same time concealing from the public preferred embodiments of their inventions which they have in fact conceived.

See also *In re Bosy*, 360 F.2d 972, 149 U.S.P.Q. 789 (CCPA 1966).

<sup>87</sup> 209 F. Supp. 639, 135 U.S.P.Q. 11 (E.D. Pa. 1962), *aff'd*, 317 F.2d 455, 137 U.S.P.Q. 693 (3rd Cir. 1963), *cert. denied*, 375 U.S. 838, 139 U.S.P.Q. 566 (1963).

finding of fact that, at the time the patent application at issue had been filed, there was an active in-house dispute between the plaintiff's manufacturer and the inventor as to which of two methods of practicing the invention was preferred. In fact, the dispute was not settled until two years after the patent application was filed. The court held that, in view of the doubt in the inventor's mind as to which mode was the better mode, the disclosure of one mode was sufficient to satisfy the best mode disclosure requirement. The Court pointed out two important factors regarding the best mode disclosure: (a) that there be disclosure of the best mode *known* to the inventor at the time of filing, and (b) that the inventor act in good faith in his patent disclosure.<sup>38</sup> The Court of Appeals affirmed, stating that there had been "sufficient disclosure, good faith and no concealment"<sup>39</sup> on the plaintiff's part.

In *Flick-Reedy Corp. v. Hydro-Line Mfg. Co.*,<sup>40</sup> patent invalidity was asserted as a defense to alleged patent infringement of two patents by Hydro-Line. The best mode issue was raised with respect to one of the patents which encompassed a sealing device for preventing the escape of fluid from pressurized hydraulic cylinders employing a machined surface having a sealing relationship with another surface "described in terms of 'absolute concentricity,' 'zero clearance' and a 'metal to metal contact provided between the head and the cylinder tube [which] performs the function of sealing

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<sup>38</sup> *Id.* The District Court stated at 15:

A patentee must disclose the best method known to him to carry out the invention. Even if there is a better method, his failure to disclose it will not invalidate his patent if he does not know of it or if he does not appreciate that it is the best method. It is enough that he act in good faith in his patent disclosure. On the other hand, if he knows at the time the application is filed, of a better method to practice the invention and knows it for the best, it would make no difference whether or not he was the discoverer of that method.

<sup>39</sup> *Id.*

<sup>40</sup> 351 F.2d 546, 146 U.S.P.Q. 694 (7th Cir. 1965), *cert. denied*, 383 U.S. 958, 148 U.S.P.Q. 771 (1966).

against fluid leakage . . . ' ' .<sup>41</sup> The patent specification did not indicate how this machined surface was produced except by saying that a "special tool"<sup>42</sup> was used. The president of plaintiff's company indicated that plaintiff had elected to keep the "special tool" a trade secret and that one skilled in the relevant art would not know what was meant by the term "special tool".<sup>43</sup> In affirming the District Court's holding that that patent was invalid for failure to disclose the best mode, the Court of Appeals stated that to accept the patent monopoly and withhold the full disclosure required by 35 U.S.C. § 112<sup>44</sup> is the "selfish desire" against which this Section is directed.

The difference in the Court's holding in *Flick-Reedy* from that in *Benger* is attributable to the differences in (a) the inventor's conception of the best mode at the time of filing the patent application and (b) the inventor's reason for non-disclosure. In *Benger* the inventor was not certain as to which of two modes was the best mode in view of the inhouse dispute; the non-disclosure was apparently founded in good faith. In contrast, the inventor in *Flick-Reedy* knew what the best mode was and attempted to conceal it; the non-disclosure was intentional.

In *Engelhard Industries, Inc. v. Sel-Rex Corp.*,<sup>45</sup> plaintiff brought an action in District Court for a de-

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<sup>41</sup> *Id.* at 697.

<sup>42</sup> *Id.*

<sup>43</sup> Flick-Reedy's president stated:

Your Honor, there are times when you could apply for a patent, I believe, but the enforcement thereof, where it is a tool used for an exclusive purpose in a plant, the enforcement thereof would be most difficult, and you may try to keep the information of a secret nature

This is what we elected to do.

Obviously, Flick-Reedy was attempting to enjoy patent protection and trade secrecy protection simultaneously. See note 8 *supra* and accompanying text.

<sup>44</sup> Note 4 *supra*.

<sup>45</sup> 253 F. Supp. 832, 149 U.S.P.Q. 607 (1966), *aff'd*, 384 F.2d 877, 155 U.S.P.Q. 225 (3rd Cir. 1967).

claratory judgment of invalidity of defendant's patent on the grounds of (a) insufficient disclosure,<sup>46</sup> (b) failure to particularly point out and distinctly claim the subject matter of the invention,<sup>47</sup> (c) anticipation<sup>48</sup> and (d) obviousness.<sup>49</sup> Although the best mode question was not expressly raised by the plaintiff, the Court held that it was impliedly brought into issue by reference to the appropriate statutory section<sup>50</sup> since laboratory experiments showed the product produced by the invention to be of poor quality. The Court relied on *Benger*<sup>51</sup> in holding the patent to be invalid for failure of the inventor to disclose the best method known by him at the time of filing for carrying out the invention. The Court also held the patent to be invalid on the basis of obviousness, and the Court of Appeals affirmed on that basis without discussing best mode.

Another court went even further in extending the best mode disclosure requirement by holding a patent invalid for failure to disclose the "specific recipe" of a given composition, even though such a composition fell within the preferred ranges given in the patent application. In *Indiana General Corp. v. Krystinel Corp.*,<sup>52</sup> the invention, which related to ferrite materials, was disclosed in terms of broad ranges of the elements of the preferred composition, ranges which the District Court found "extended beyond the area representing significant technological advancement."<sup>53</sup> The patent was held to be invalid for failure to disclose the best mode, and this holding was affirmed by the Court of Appeals with no discussion of best mode. The *Indiana General* decision

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<sup>46</sup> 35 U.S.C. § 112. See note 4 *supra*.

<sup>47</sup> 35 U.S.C. § 112, para. 2.

<sup>48</sup> 35 U.S.C. § 102(e). See note 8 *supra*.

<sup>49</sup> 35 U.S.C. § 103. See note 8 *supra*.

<sup>50</sup> Note 47 *supra*.

<sup>51</sup> Note 37 *supra*.

<sup>52</sup> 297 F. Supp. 427, 161 U.S.P.Q. 82 (S.D. N.Y. 1969), *aff'd*, 421 F.2d 1023, 164 U.S.P.Q. 321 (2d Cir. 1970).

<sup>53</sup> *Id.* at 92.

demonstrates the concern that the public not be prevented from duplicating the patentee's most preferred form of the invention by an obscure disclosure in the patent application, especially if such unclear disclosure is intentionally made in order to prevent discovery by the public of a product or process having commercial value.

The unclear disclosure problem was extended to unintentional failure to disclose in a more recent decision. In *Dale Electronics, Inc. v. R.C.L. Electronics*,<sup>54</sup> the Court of Appeals, in affirming the District Court's holding of patent invalidity for failure to disclose the best mode, indicated that "unintentional obtuseness might be reason not to penalize someone; we do not see it as a reason for granting a seventeen year monopoly."<sup>55</sup>

The invention in *Dale Electronics* related to a beryllium oxide-core electrical resistor. The patentee knew at the time of filing, but did not disclose, that a commercial resin composition "Rogers RX 600" was a particularly preferred insulator for their resistors. After the District Court's holding of invalidity for failure to disclose the best mode, appellant filed reissue applications<sup>56</sup> in an effort to add the undisclosed information relative to "Rogers RX 600" and obtain a reissue patent. In *In re Hay*<sup>57</sup> the Court of Customs and Patent Appeals affirmed the rejection by the Board of Appeals of the Patent and Trademark Office of the re-

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<sup>54</sup> 488 F.2d 382, 180 U.S.P.Q. 225 (1st Cir. 1973).

<sup>55</sup> *Id.* at 230.

<sup>56</sup> 35 U.S.C. § 251. Section 251, para. 1 states:

Whenever any patent is, through error without deceptive intention, deemed wholly or partly inoperative or invalid, by reason of the patentee claiming more or less than he had a right to claim in the patent, the commissioner shall, on the surrender of such patent and the payment of fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

<sup>57</sup> 534 F.2d 917, 189 U.S.P.Q. 790 (CCPA 1976), *cert. denied*, ..... U.S. ...., 192 U.S.P.Q. 64 (1976).

issue applications, holding that granting a reissue application would violate the "no new matter" clause in the relevant statutory provision.<sup>58</sup>

Two more recent decisions further delineate the limits of the best mode disclosure requirement with respect to the inventor's knowledge at the time of filing.

*Union Carbide Corp. v. Borg-Warner Corp.*<sup>59</sup> concerned a suit brought by Union Carbide in District Court<sup>60</sup> for alleged patent infringement of one of their patents by Borg-Warner. The District Court found in favor of the defendants, holding that (a) claim 1 of the patent in issue was invalid because the process disclosed therein had been anticipated by prior art<sup>61</sup> and was obvious<sup>62</sup> in view of prior art, and (b) the patent was invalid in its entirety for failure to disclose the best mode contemplated to carry out the invention.<sup>63</sup> The Court of Appeals affirmed on the basis of best mode.

Union Carbide's patent<sup>64</sup> contained process claims for the molding of foamed thermoplastic articles. The claimed process was carried out using an apparatus that was illustrated by a drawing and description given in

<sup>58</sup> Note 56 *supra*.

<sup>59</sup> 550 F.2d 355, 193 U.S.P.Q. 1 (6th Cir. 1977).

<sup>60</sup> U.S. Dist. Ct., N.D., W.D., Ohio.

<sup>61</sup> 35 U.S.C. § 102(e). See note 8 *supra*.

<sup>62</sup> 35 U.S.C. § 103. See note 8 *supra*.

<sup>63</sup> 35 U.S.C. § 112. See note 4 *supra*.

<sup>64</sup> U.S. Patent 3,268,636. Claim 1 of the patent reads:

1. Process for molding foamed thermoplastic articles which comprises the steps of

(a) melting a mixture of a blowing agent and a foamable thermoplastic material in an extruder at a temperature above the foaming temperature of said blowing agent and at a pressure above the foaming pressure thereof;

(b) extruding the resulting molten mixture into an expanding accumulation zone while maintaining said mixture therein in the molten state and at a pressure above the foaming pressure thereof;

(c) establishing communication between said accumulation zone and a mold maintained at a pressure no greater than the foaming pressure of said molten mixture;

(d) rapidly forcing said molten mixture from said accumulation zone into said mold whereby the pressure differential between said accumulation zone and said mold causes said mixture to rapidly expand in said mold.

Note 59 *supra* at 2.

the specification as containing, *inter alia*, an extruder and a valve.<sup>65</sup> The facts brought out at trial indicated that a specially designed extruder and an improved valve had been developed, subsequent to the reduction to practice but prior to the filing of the patent application, for use in a pilot plant installation. The Court of Appeals held that, since the undisclosed improved valve and the undisclosed specially designed extruder were part of the best mode contemplated by the inventor to carry out the invention at the time of filing the patent application, the failure to disclose best mode caused the patent to be invalid.

In *Lockheed Aircraft Corp. v. United States*,<sup>66</sup> a petition was brought by Lockheed against the United States for compensation for use of a patented radar device. Disclosure was made in the patent specification of a broad band height finding receiver and a range detection receiver for use in the radar device,<sup>67</sup> and the issue faced

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<sup>65</sup> *Id.* The extruder is referred to specifically in steps (a) and (b) of claim 1, and the valve is referred to generically in steps (c) and (d) of claim 1. Thus claim 1 defines a system including the specifically mentioned extruder, the valve disclosed in the specification, and any equivalents of the valve disclosed in the specification.

This author feels that no proper analogy can be drawn between the specially designed extruder and improved valve of the instant case and the "special tool" of *Flick-Reedy*, *supra* note 6. Rather, the extruder and valve are analogous to the "improved equivalent" discussed in *Lockheed Aircraft*, *infra* note 66, in connection with pulse compression. That is, those of ordinary skill in the art would be able to design an "improved equivalent" extruder or valve if given the information that an extruder and valve are required in a given system, whereas one of ordinary skill in the art would have little knowledge of what is meant by the vague term "special tool". The difference in outcome between the instant case and *Lockheed Aircraft* appears to be attributable to the fact that the inventor in *Lockheed* was not "personally familiar" with pulse compression at the time of filing, whereas the Court in the instant case found evidence that the inventor was familiar with the improved valve and specially designed extruder.

<sup>66</sup> ..... F.2d ....., 193 U.S.P.Q. 449 (Ct. Cl. 1977).

<sup>67</sup> Claim 1 of Lockheed's patent recited the elements of the radar device in "means plus function" terminology. For example, the disclosed broad band height finding receiver corresponded to the following recitation in claim 1:

... receiving means connecting with said antenna means and being responsive to the electromagnetic energy reflected by the remote object from two energy paths, one path being on a direct line

by the Court was whether or not the patent was infringed by Government radar equipment that used pulse compression for height and range detection.<sup>68</sup> The Court concluded that there was equivalence of the devices within the system disclosed in claim 1 and held the United States to be liable for compensation.<sup>69</sup> In addressing the best mode disclosure requirement, the Court relied on *Jack Winter, Inc. v. Koratron Co.*,<sup>70</sup> for the proposition that the patentee need not disclose all conceivable modes for practicing the invention but only the mode conceived by him to be best at the time of filing.<sup>71</sup>

In view of the above-discussed case law, it is clear that there is an obligation to disclose all pertinent information known by the inventor regarding best mode at the time of filing. Failure to disclose any such information, whether intentional or inadvertent, will probably be discovered in *inter partes* courtroom proceedings and result in a holding of patent invalidity.

Regarding the subject matter that need be disclosed, the circuit courts are obviously not in agreement. For the most part, these courts appear to balance the equities on a case-by-case basis, often following lines of

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of sight between the antenna means and the remote object and the other path being indirect from the object to the antenna means via a reflection off the surface of the earth, . . .

*Id.* at 460.

Likewise, the disclosed range detection receiver corresponded to the following recitation in claim 1:

. . . means responsive to both the transmitted and received energy and providing an output representing the range of the remote object, . . .

*Id.* at 460.

<sup>68</sup> In determining whether or not the pulse compression radar equipment infringed claim 1 of Lockheed's patent, the Court applied the "doctrine of equivalents" and concluded that pulse compression is the equivalent of the broad band height finding receiver and the range detection receiver within the "means plus function" terminology of claim 1. *Id.* at 460-61.

<sup>69</sup> In order to be equivalents, the infringing device must perform substantially the same work in substantially the same manner to achieve substantially the same result. For a discussion of the "doctrine of equivalents", see generally *Tektronix Inc. v. United States*, 445 F.2d 323, 170 U.S.P.Q. 100 (1971).

<sup>70</sup> 375 F. Supp. 1, 181 U.S.P.Q. 353 (N.D. Cal. 1974).

<sup>71</sup> See notes 4 and 20 *supra* and accompanying texts.

authority that are the opposite of those followed by sister courts. The problem of conflicting decisions is compounded by the fact that the Supreme Court is loathe to hear patent litigation, and forum shopping will no doubt be the norm in the best mode area, as it is with respect to other issues in patent validity practice.

#### IV. POSITION OF THE PATENT AND TRADEMARK OFFICE

The Patent and Trademark Office<sup>72</sup> in its *ex parte* examination of applications for patentability does not have access to the extensive discovery available in *inter partes* courtroom proceedings. In view of this fact, the current rule governing Examiners is that the "Office practice is to accept an operative example as sufficient to meet this requirement of the Statute in the absence of information to the contrary."<sup>73</sup> In this vein, the Board of Appeals has indicated that the Patent and Trademark Office does not currently inquire as to whether or not any mode "adequately disclosed" is the best mode.<sup>74</sup> This means that the presence of at least one working example in a patent application will result in a *prima facie* presumption that the best mode requirement has been satisfied. Furthermore, the law is clear that the absence of a working example does not remove, or in any way alter, this presumption.<sup>75</sup>

The above-mentioned policy of the Office to presume that there has been a best mode disclosure at the application stage is one that is obviously borne out of necessity. First, each Examiner spends an average of only about 17 hours on the examination of an application<sup>76</sup>

<sup>72</sup> The Patent and Trademark Office is also referred to herein as "the Office".

<sup>73</sup> See M.P.E.P. § 608.01(h) (Rev. 44, Apr. 1975).

<sup>74</sup> *In re* Brebner, 455 F.2d 1402, 173 U.S.P.Q. 169 (CCPA 1972).

<sup>75</sup> *In re* Honn, 364 F.2d 454, 150 U.S.P.Q. 652 (CCPA 1966). The court stated:

Certainly the absence of a specific working example is not necessarily evidence that the best mode has not been disclosed, nor is the presence of one evidence that it has. *Id.*

<sup>76</sup> Former Commissioner Dann, Address to Wichita Manufacturers Association, quoted at 254 P.T.C.J. at A-16 (Nov. 20, 1975).

about half of which is spent doing a prior art search, and there simply is not time for a best mode investigation. Second, as has been stated above, the Examiner does not have access to such information as laboratory notebooks and project reports that would have a bearing on the best mode issue. Third, the Examiner, does not have access to a laboratory for the purpose of independently verifying whether or not the applicant's preferred embodiments of the invention produce a more effective result than do the less desirable embodiments. In view of the above, no substantive inquiry as to best mode is provided for, and, so long as current Office practice remains in force, patents will be granted on applications irrespective of whether or not they have satisfied the requirement.

In the future, however, as the best mode defense becomes increasingly asserted in the courts, there will no doubt be an impetus to get an assurance of best mode compliance at the application stage. This assurance can be obtained by requiring submission to the examiner of either (a) evidence bearing on best mode such as laboratory notebooks and project reports or (b) an inventor's declaration of compliance.<sup>77</sup> In view of the stringent time constraints under which examiners work today,<sup>78</sup> the inventor's declaration is probably the favored means of obtaining assurance of compliance since there is virtually no added demand placed upon the examiner. Of course, a good faith standard would be applicable to such a statement. The declaration requirement would have a positive effect on the patent system for the following reasons: First, the "double standard" that presently exists with respect to best mode at the application stage versus best mode at the validity stage would be eliminated,

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<sup>77</sup> The inventor's declaration of compliance could be implemented by inclusion of the following averment on all Declaration filing forms under 37 C.F.R. 1.65:

that I acknowledge a duty to disclose the best mode for carrying out the invention of which I am aware.

<sup>78</sup> Note 76 *supra* and accompanying text.

thereby producing consistency of application of the best mode clause of Section 112.<sup>79</sup> Second, the legal sanctions associated with a fraudulent declaration, as set forth below, will insure a strengthened presumption of validity<sup>80</sup> upon patent issuance. Third, a false declaration by the inventor would provide a basis for an allegation of fraudulent procurement of the patent and, hence, fraud on the Patent and Trademark Office. In this regard, a distinction is to be made between intentional fraud, on the one hand, and a good faith honest mistake - so-called "technical fraud", on the other. Under the rationale of *Walker Process*,<sup>81</sup> a patent obtained by intentional fraud can be the basis both for a counterclaim for a declaratory judgment of patent invalidity and for a counterclaim of antitrust violation under Section 2 of the Sherman Act.<sup>82</sup> As has been previously stated,<sup>83</sup> provided that monopolization or an attempt to monopolize under Section 2 is established, the treble damage provisions of Section 4 of the Clayton Act would be available. Instead of awaiting the filing of a threatened suit by the patentee in the instance where the patent has been obtained by intentional fraud, the injured party can bring an action for a declaratory judgment.<sup>84</sup>

V. DIFFERENCE BETWEEN THE COURTS' AND THE PATENT AND TRADEMARK OFFICE'S VIEW AS PART OF A GREATER CONFLICT

The above-discussed differences between the policies of the Patent and Trademark Office, on the one hand, and those of the Courts, on the other, lead to an unhappy situation. The following scenario occurs: A patent is granted on an application that does not satisfy the best mode requirement, and only after extended litigation and

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<sup>79</sup> Notes 3 and 4 *supra*.

<sup>80</sup> 35 U.S.C. § 282.

<sup>81</sup> *Walker Process Equipment, Inc. v. Food Machinery and Chemicals Corporation*, 382 U.S. 172, 147 U.S.P.Q. 404 (1965).

<sup>82</sup> Note 11 *supra*.

<sup>83</sup> Note 33 *supra* and accompanying text.

<sup>84</sup> 28 U.S.C. § 2201.

many thousands of dollars in legal fee expenditures is it determined that the patent is invalid. In this regard, however, best mode does not stand alone, but rather it is part of a much more pervasive problem. This problem has best been termed "the crisis of law in patents",<sup>85</sup> and it arises by virtue of the fact that patents are subjected to standards at the courtroom validity stage which are different from those used at the application stage in the Office and different from those employed in sister circuits. This difference in standards gives rise to the finding by the Office that fifty percent of litigated patents are held invalid.<sup>86</sup> In addition to eliciting considerable criticism,<sup>87</sup> many proposals have been made for reform of the patent system.<sup>88</sup> Two of these proposals are particularly relevant to best mode. First, a National Court of Appeals - composed of judges having expertise in patent law and technology - is envisioned as a device for providing uniform application of the patent laws.<sup>89</sup> The introduction of this Court into the patent system would provide for greater judicial uniformity regarding best mode than is provided by the circuit courts. Second, *inter partes* proceedings have been suggested to permit third party participation in validity determinations before the Patent and Trademark Office.<sup>90</sup> The suggested *inter partes* proceedings are mainly directed toward uncovering prior art not considered by the examiner or prior use or sale. Absent rather extensive discovery

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<sup>85</sup> Kayton, *Patent Property: Cases and Readings*, Part I, "The Crisis of Law in Patents", 214-229 (1975). Professor Kayton discusses mainly differences in circuit court standards regarding the Section 103 "nonobviousness" defense. However, the term is equally applicable to the different standards among the Office and the various circuit courts applied to best mode.

<sup>86</sup> Note 76 *supra*. This is a conservative estimate. Some commentators have suggested that as many as seventy percent of litigated patents are held invalid.

<sup>87</sup> See remarks of Mr. T. Arnold, October 20, 1972, APLA Bulletin 662, 685 (Oct.-Nov. 1972).

<sup>88</sup> See generally Pegram, "Current Proposals for Inter-Partes Proceedings", 4 A.P.L.A.Q.J. 56, 66-76 (1976).

<sup>89</sup> *Id.* at 59.

<sup>90</sup> Note 88 *supra* at 66-76.

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provisions, these proceedings would not be effective in uncovering best mode problems.

Although commentators have suggested that the patent bar is opposed to the implementation of any legislation that would strengthen the presumption of patent validity,<sup>91</sup> such assertions are of questionable merit. Rather, there seems to be no clear consensus within the bar as to the best means of strengthening the presumption without damaging the patent system as a whole.

### VI. ILLUSTRATIVE EXAMPLES

In order to expand upon the above-discussed case law, the following illustrative examples are given:

A. Inventor A who is employed by Company X is involved in a heated dispute with Company X's manufacturer as to which is the better of two methods of practicing his invention. Will the disclosure of only the inventor's preferred method satisfy the disclosure requirement?

The answer according to *Benger*<sup>92</sup> is yes. However, this case cannot be relied upon with any degree of assurance today. In view of the trend toward the increasing assertion of disclosure requirements at the validity stage, good practice would require the disclosure of both methods. Extending this reasoning, the applicant should disclose in detail elements of the invention that are considered to be "more desirable", "more preferred", or "most advantageous". If there is any doubt as to the significance of any particular element, disclosure should be made.

B. A patent owned by Company Y is declared invalid in District Court for failure to satisfy the best mode disclosure requirement. May Company Y obtain a reissue

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<sup>91</sup> See remarks of Mr. Bernard Nash, Assistant Counsel for the Senate Subcommittee on Antitrust and Monopoly, in an address to the Industrial Research Institute, October 18, 1976, quoted at 301 P.T.C.J. at A-8 - A-11 (October 28, 1976); 59 J. Pat. Off. Soc'y. 143 (1977).

<sup>92</sup> Note 37 *supra*.

patent on a reissue application that incorporates the inadvertently omitted material into the reissue application?

No. *In re Hay*.<sup>93</sup> Assume further that the patent does contain the best mode disclosure, but in the validity proceedings it is determined that an earlier filed application, upon which the patentee has relied for priority purposes under Section 120,<sup>94</sup> did not satisfy the best mode requirement. Does the patentee have the benefit of the application for priority? Although no court has yet considered this question, the answer is probably "no" especially if the nondisclosure in the application was intentional.

C. Company Z owns a patent on a device. A part for the device is produced according to the specification using a "special tool". Company Z intended to retain trade secrecy protection for the "special tool", and therefore provided no description in the patent of the tool. Is the patent invalid for non-disclosure of best mode?

Yes. *Flick-Reedy*.<sup>95</sup> *But see ITT Corp. v. Raychem Corp.*,<sup>96</sup> wherein an opposite result is reached on a similar set of facts. Despite these opposing lines of authority, good practice requires that disclosure be made on any similar set of facts. However, in the instance where the "special tool" is well-known by those skilled in the art to which the invention pertains, a brief description of the nature of the tool would suffice.

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<sup>93</sup> Note 57 *supra*.

<sup>94</sup> Note 80 *supra*.

<sup>95</sup> Note 40 *supra*.

<sup>96</sup> 538 F.2d 453, 191 U.S.P.Q. 1 (1st Cir. 1976). This case concerned a patent on insulated wire. The argument of patent invalidity for non-disclosure of a compound used in the process of manufacturing the wire was rejected by the Court of Appeals because (a) the patent claims covered the wire itself and not the process of manufacture and (b) the resulting properties of the wire were unaffected by the use of the non-disclosed compound. The conflict of this holding with *Flick-Reedy*, note 40 *supra*, is apparent. This author believes the holding in *Flick-Reedy* to be the better result since it compels full disclosure of all information closely related to a patented product that is likely to give the patent owner a competitive advantage in product manufacture over one who does not have such information.

D. Inventor B is aware of certain apparatus improvements made in a pilot-plant scale-up of an invention on a process that was reduced to practice without the improvements. The improvements were made prior to the filing of the patent application, but they are not included in the apparatus and process description provided in the patent application. Is the subsequently obtained patent invalid for failure to disclose best mode?

Yes. *Union Carbide*.<sup>97</sup> The inventor must set forth all information relative to best mode known to him personally prior to the filing of the patent application. However, information not known to him personally need not be disclosed. *Lockheed*.<sup>98</sup> As has been stated, although there is no clear-cut rule as to the requisite extent of disclosure, a common sense approach to the inventor's knowledge at the time of filing is suggested.

## VII. CONCLUSION AND OUTLOOK

The district and circuit courts are sending clear signals that they are increasingly willing to entertain the best mode defense. The present liberal federal discovery rules<sup>99</sup> will facilitate the increased success of that defense in the future. Coupled with the possibility of antitrust counterclaims,<sup>100</sup> the best mode defense raises the probability of a further weakening of the already rather feeble presumption of patent validity.<sup>101</sup>

The outlook for the future, however, is far from hopeless. Above and beyond the need for increased sensitivity on the part of the individual attorney to best mode issues at the application stage, there is a substantial need for reform at the Office level. No longer can the Office rely on the practice of accepting any operative example as sufficient to satisfy the best mode require-

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<sup>97</sup> Note 59 *supra*.

<sup>98</sup> Note 66 *supra*.

<sup>99</sup> Fed. R. Civ. P. 26(b).

<sup>100</sup> See notes 33 and 82 *supra* and accompanying text.

<sup>101</sup> See note 86 *supra* and accompanying text.

ment.<sup>102</sup> Rather, the best mode and "enabling disclosure" requirements of Section 112<sup>103</sup> are distinct entities that must be given separate consideration by the Office. Aside from strengthening the presumption of validity,<sup>104</sup> Office inquiry into best mode might help to reduce litigation in the case where best mode is the only defense available to an alleged infringer. Moreover, in view of the Speedy Trial Act which has effectively forced civil litigation to the bottom of the district court calendar, such a reduction in litigation, however small, would be helpful in saving time and expense for the parties involved.

The author favors reform by the Office at the application stage in the form of a requirement for an inventor's declaration of best mode compliance to be submitted at the time of filing. The declaration requirement would be relatively easy to implement and would place virtually no added demand upon the examiner. Abuse of the declaration requirement by the applicant would carry stiff sanctions based upon fraudulent procurement and possible antitrust violations. The adoption of such a requirement would contribute to the smoother operation of our incredibly complex, yet remarkably adaptive, system for protecting and encouraging invention.

#### EDITOR'S NOTE

The suggestion made by Mr. Carlson—that an inventor file an oath or declaration under 37 C.F.R. 1.65 or 1.67 affirming that he is aware of his duty to disclose the best made contemplated by him of carrying out his invention at the time of filing of his application and that he in fact has disclosed that best mode—would appear to be a workable solution to the problem posed by Walterscheid, "Re: The 'Best Mode' Requirement of 35 U.S.C. 112," 59 J. Pat. Off. Soc'y. 779 (1977).

<sup>102</sup> See note 73 *supra* and accompanying text.

<sup>103</sup> See note 4 *supra*.

<sup>104</sup> See note 80 *supra* and accompanying text.