THE NATIONAL
LAW JOURNAL
WWW.NLJ.COM THE WEEKLY NEWSPAPER FOR THE LEGAL PROFESSION MONDAY, NOVEMBER 7, 2005 ALM

OPINION

■ PATENT REFORM ACT ■

Don't ax 'best mode'

By Dale L. Carlson SPECIAL TO THE NATIONAL LAW JOURNAL

CONGRESS IS NOW considering several amendments to the Patent Act, enacted in 1952. In my opinion, any patent reform must continue to encourage the full disclosure of each invention through the "best mode" requirement, not accommodate the veiling of parts of the invention in a cloak of secrecy.

The Federal Trade Commission (FTC) and the National Academies of Science, among others, have suggested sweeping reforms to the U.S. patent system in an apparent effort to improve the system. This has culminated in a bill identified as H.R. 2795 and known as the Patent Reform Act of 2005, introduced by Representative Lamar Smith, R-Texas, chairman of the House Intellectual Property Subcommittee. One provision in the bill relates to the elimination of the best- mode requirement in patent practice. This requirement mandates an inventor on a patent application to disclose in the application the best aspects of the invention known to him or her at the time of filing the patent application.

The requirement ensures that the inventor will not be able to "have his cake and eat it too" by disclosing only nonpreferred aspects of the invention while keeping the invention's "crown jewels" a trade secret. A trade secret kept under wraps can have a duration that lasts forever—or at least as long as it provides the holder with a competitive advantage and is not generally known in the industry to which it pertains.

Without the best-mode disclosure requirement, the public is denied the benefit of access to the "heart of the invention" in the published patent. Such a result would have the effect of stifling innovation by undermining the functioning of the patent system, and increasing technology development costs to society and other would-be inventors.

Moreover, elimination of best mode runs counter to the FTC's stated interest in making patents easier to attack. To the contrary, such elimination would make patents harder to attack by allowing patents that do not describe the inventor's best mode to nonetheless stand as valid patents. The best-mode disclosure requirement has stood the test of time in our patent system since 1870. It should not be eliminated without good reason. The reasons that have been offered to date do not pass muster.

It is commonly asserted that the United States is unique among nations in requiring best-mode disclosure, and therefore our country should eliminate it in order to "conform to international practice." The premise for this conclusion is plainly wrong. In fact, some 20 countries subscribe to the best-mode requirement. Accordingly, it is illogical and counterproductive to cast the requirement aside in order to conform to international practice. Instead, the underlying public policy implications need to be taken into consideration before altering, much less abolishing, this disclosure requirement.

Disclosing the core of inventions

From a public policy perspective, the best-mode requirement is the linchpin of our patent system for the simple reason that it speaks not only to the quantity of information contained in the patent application, but also to the quality of the disclosure. The best-mode requirement compels disclosure of the very heart of the invention as viewed from the inventor's perspective. The existence of the requirement provides a safeguard to the public against the natural tendency for inventors to disclose only what they know to be inferior modes of the invention, while maintaining the best for themselves. Most inventors will comply with the requirement—at least most inventors who are properly informed of the downside risk associated with nondisclosure of the best mode. That risk is that the patent will be held invalid.

Keeping the best-mode requirement in our patent system helps to ensure that the public will understand not only how to make and use the invention, but also the best way contemplated by the inventor of carrying it out. It helps ensure that others will have sufficient information to allow them to compete fairly with the patentee after the patent expires.

Eliminating best mode would doubtless slow down the evolutionary development of innovation. Such slowing would surely have detrimental economic and societal implications. To allow the disclosure in a patent application to be watered down by elimination of the best-mode requirement would deprive the public of much-needed information about the invention, while allowing the inventor to have what is tantamount to a "patented trade secret" that could outlive the duration of the patent. Such a result would short-change society in the bargain that the inventor strikes with the public in exchange for the patent grant.

In conclusion, elimination of best mode is ill-conceived and ill-advised. It should be taken out of the bill when Congress next considers the bill. NLJ

Dale L. Carlson is a partner in the New Haven, Conn., office of Wiggin & Dana, and an adjunct professor of patent law at Quinnipiac University School of Law in Hamden, Conn. He is co-author of a more in-depth study of best mode appearing in IDEA: The IP Law Review, *Vol. 45, No. 3, at 267-292 (2005).*