

THE COALITION FOR 21ST CENTURY PATENT REFORM

Protecting Innovation to Enhance American Competitiveness

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Repeal the Best Mode Requirement

Current Law – the patent law currently requires that a patent application “set forth the best mode contemplated by the inventor of carrying out his invention” at the time the application is filed. This is in addition to the requirement that inventors must provide a full and exact description of how to make and use their inventions (enablement). This requirement does not add value for the public, but rather adds cost and unpredictability to patent lawsuits.

S. 1145/H.R. 1908 – would continue the existing law calling for inventors to disclose the best mode.

Coalition Position – the requirement for best mode should be repealed.

Public Policy Rationale – the requirement applies only to information and beliefs personal to the inventor, and cannot be established by imputation of knowledge of others in the inventor’s company or working group. Therefore, this doctrine, as applied, gives only limited assurance that the “true” best mode will be disclosed. Further, because the defense depends on historical facts and because the inventor’s state of mind usually can be established only by circumstantial evidence, litigation over this issue, especially discovery, can be extensive and time-consuming. The cost and inefficiency of this defense far outweigh any benefits of this disclosure requirement.

The United States is out of step with the rest of the developed world by imposing this requirement (only added to the U.S. patent statute in 1952). Not only do all of the foreign patent systems operate effectively without a best mode requirement, but the public interest in high-quality technical disclosures in patents can be fully realized by the existing “enablement” requirement.

The best mode requirement is a trap for the unwary – it only applies to what the inventor contemplated at the time of filing. This typically has little if any relationship to the modes later developed for carrying out an invention at the time of commercialization, so serves primarily as a basis for discovery hunting expeditions in search of a “gotcha” by infringers.

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