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# Changes to the Best Mode Requirement in the Leahy-Smith America Invents Act: Why Congress Got It Right

## INTRODUCTION

The Leahy-Smith America Invents Act (AIA),<sup>1</sup> signed into law on September 16, 2011, represents the most significant overhaul of the United States Patent system since the Patent Act of 1952. In addition to making the United States a “first-to-file” system,<sup>2</sup> which is more in line with the patent law of other countries, the act institutes numerous other changes aimed at ensuring that the United States “maintains its competitive edge in the global economy.”<sup>3</sup> One of these changes eliminates failure to disclose the best mode as a defense in patent infringement litigation.<sup>4</sup> Proponents applaud the change for the positive effect it will have on patent litigation, specifically, reducing the time and cost of litigation by eliminating pre-trial discovery associated with trying to ascertain what the inventor knew when the patent application was filed.<sup>5</sup> The critics bemoan the change, arguing that the law removes the only enforcement mechanism to ensure that the inventor will fully disclose the invention to the public.<sup>6</sup> This Comment explores the reasons for making the change, the practical effect those changes will have on best mode disclosure, and why the new law will not have the undesirable effect of reducing best mode disclosure.

Essentially, a patent is a kind of *quid pro quo* between inventors and the public. In exchange for enabling the public to practice the invention by disclosing “the manner and process of making and using [the invention] in such full, clear, concise, and exact terms as to enable any person skilled in

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1. Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (to be codified in scattered sections of 35 U.S.C.).

2. *Id.* § 3, 125 Stat. at 285.

3. Wesley D. Markham, *Is Best Mode the Worst? Dueling Arguments, Empirical Analysis, and Recommendations for Reform*, 51 IDEA 129, 131 (2011) (quoting S. Rep. No. 111-18, at 1–2 (2009)).

4. Leahy-Smith America Invents Act, § 15, 125 Stat. at 328.

5. Markham, *supra* note 3, at 133.

6. *Id.* at 134.

the art to . . . make and use the same,”<sup>7</sup> the government grants the inventor the *exclusive* right to sell, make, and use the invention for a certain period of time.<sup>8</sup> This bargain between the inventor and the public also requires that the inventor “set forth the *best mode* contemplated by the inventor [for] carrying out his invention.”<sup>9</sup> The best mode requirement is in place to “restrain inventors from applying for patents while at the same time concealing from the public preferred embodiments of their inventions.”<sup>10</sup> Without the best mode requirement, inventors could *enable* the public to practice their invention without disclosing to the public the *best* way to practice the invention, thereby depriving the public of their complete share in the bargain—i.e., knowledge of the inventor’s full invention.<sup>11</sup>

A simplified example involves the inventor who receives a patent on a process (recipe) for making muffins—“extra delicious” muffins that are new and non-obvious.<sup>12</sup> Conceivably, the inventor’s patent could teach that her process for making these muffins is to bake them somewhere between 100 and 1000 degrees until golden brown. However, if the inventor knows at the time she files for her patent that the muffins are most delicious only when baked at 350 degrees for twenty minutes, she has an advantage when the patent expires. The public will not know how to make the most delicious version of the muffin because it is not disclosed in the patent and her virtual monopoly on the “extra delicious” muffin market will continue beyond the patent term. The inventor can protect the best mode of practicing the invention (baking at 350 degrees for 20 minutes) as a trade secret and therefore receive additional protection on her invention—both the patent law protection and trade secret law protection.<sup>13</sup> While it is true that the

7. 35 U.S.C. § 112 (2006). This language is commonly referred to as the “enabling requirement.”

8. *Id.* § 154. As of June 8, 1995, the patent term is 20 years from the date the application is filed. *Id.*

9. *Id.* § 112 (emphasis added).

10. *In re Gay*, 309 F.2d 769, 772 (C.C.P.A. 1962).

11. *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1360 (Fed. Cir. 2011) (“The best mode requirement creates a statutory bargained-for-exchange by which a patentee obtains the right to exclude others from practicing the claimed invention for a certain time period, and the public receives knowledge of the preferred embodiments for practicing the claimed invention.” (quoting *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 963 (Fed. Cir. 2001))).

12. The “new and non-obvious” language refers to other requirements for patentability. For a brief overview of these requirements, see *infra* notes 34–37 and accompanying text.

13. Trade secrets are generally governed by state law, but many states have based their statutes in large part on the Uniform Trade Secrets Act, promulgated by the Uniform Law Commission in 1979 (amended in 1985). *See* Steven Wilf, *Trade Secrets, Property, and Social Relations*, 34 CONN. L. REV. 787, 793 (2002). For example, Alabama’s Trade Secrets Act provides:

public could reverse engineer the ideal baking temperature,<sup>14</sup> that is not the bargain that society made with the inventor when she was granted the exclusive right to sell, make, and use the invention during the patent term.<sup>15</sup> The cost of that exclusive right is that the inventor must disclose how to make and use the invention *and* the best way to do so.

## I. BRIEF HISTORY OF UNITED STATES PATENT LAW

The patent system is derived directly from the United States Constitution which provides that Congress shall have 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.”<sup>16</sup> Congress set out early to create the patent system with the Patent Act of 1790,<sup>17</sup> just one year after adopting the Constitution. Since the first Patent Act more than 220 years ago, the best mode requirement and its accompanying defense to patent infringement have been through numerous changes.

### A. *The Best Mode Requirement*

The best mode requirement, though not explicitly codified as the “best mode” until the Patent Act of 1870,<sup>18</sup> has been a part of the patent laws from the beginning. The original Patent Act required the inventor to ensure that “the public may have the *full benefit*” of the invention.<sup>19</sup> This was

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A “trade secret” is information that:

- (a) Is used or intended for use in a trade or business;
- (b) Is included or embodied in a formula, pattern, compilation, computer software, drawing, device, method, technique, or process;
- (c) Is not publicly known and is not generally known in the trade or business of the person asserting that it is a trade secret;
- (d) Cannot be readily ascertained or derived from publicly available information;
- (e) Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy; and
- (f) Has significant economic value.

ALA. CODE § 8-27-2(1) (2011).

14. *See* *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 476 (1974) (“[T]rade secret law . . . does not offer protection against discovery by fair and honest means, such as . . . reverse engineering, that is by starting with the known product and working backward to divine the process which aided in its development or manufacture.”).

15. 35 U.S.C. § 154 (2006).

16. U.S. CONST. art I, § 8, cl. 8.

17. Patent Act of 1790, ch. 7, 1 Stat. 109 (repealed 1793).

18. Patent Act of 1870, ch. 230, § 26, 16 Stat. 198, 201.

19. Patent Act of 1790, ch. 7, § 2, 1 Stat. at 110 (emphasis added).

soon amended to require the inventor to “fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions.”<sup>20</sup> The “best mode” language itself did not appear until the 1857 case of *Page v. Ferry*.<sup>21</sup> There, Judge Wilkins interpreted the patent statutes to require that the “specification . . . teach the public the improvement patented; it must fully disclose the secret; must give the *best mode* known to the inventor, and contain nothing defective, or that would mislead artists of competent skill in the particular manufacture.”<sup>22</sup> The court’s discussion about the best mode was entirely separate from its discussion regarding enablement, thereby affirming the existence of a separate best mode requirement. Congress later codified this language in the Patent Act of 1870, requiring that the inventor “explain the principle [of the invention], *and the best mode* in which he has contemplated applying that principle.”<sup>23</sup> Finally, the Patent Act of 1952, the last major overhaul to the patent system prior to 2011, codified the modern version of the enablement and best mode requirements:

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 best mode contemplated by the inventor of carrying out his invention.*<sup>24</sup>

#### B. *A Defense to Patent Infringement: Failure to Disclose the Best Mode*

American patent laws have historically provided that a valid defense to patent infringement is to assert that the inventor failed to disclose the best mode. The original patent act set forth this “whole of the truth” defense, allowing an alleged infringer to defend the infringement action on the grounds that the patentee’s specification “does not contain the whole of the truth concerning his invention or discovery.”<sup>25</sup> The 1793 Act strengthened this defense, providing that if

[T]he specification . . . does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made,

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20. Patent Act of 1793, ch. 11, § 3, 1 Stat. 318, 321–22.

21. *Page v. Ferry*, 18 F. Cas. 979 (C.C.E.D. Mich. 1857).

22. *Id.* at 984 (emphasis added).

23. Patent Act of 1870, ch. 230, § 26, 16 Stat. at 201 (emphasis added).

24. 35 U.S.C. § 112 (2006) (emphasis added).

25. Patent Act of 1790, ch. 7, § 6, 1 Stat. 109, 111 (repealed 1793).

for the purpose of deceiving the public . . . judgment shall be rendered for the defendant . . . *and the patent shall be declared void.*<sup>26</sup>

The 1793 Act placed an emphasis on the inventor's intent to deceive the public, with significant consequences for doing so—voiding the *entire* patent.<sup>27</sup> The Patent Act of 1836 softened the consequences of failing to disclose the best mode, voiding only those claims that were affected rather than the entire patent.<sup>28</sup> Other than this softening of the requirement in 1836, the “whole of the truth” defense remained unchanged until 1952, when Congress reaffirmed the defense by providing that the “[i]nvalidity of the patent or any claim in suit for failure to comply with any requirement of section[] 112” is a defense to infringement.<sup>29</sup>

Substantively, this change had little effect on the defense, but the removal of the “whole of the truth” language led courts to begin construing the enablement and best mode requirements together, resulting in a temporary focus only on enabling the invention and not necessarily disclosing the best mode.<sup>30</sup> This was quickly corrected by the Court of Customs and Patent Appeals (CCPA) in 1962 when it declared that “separate and distinct from [enablement] is [the best mode requirement], the essence of which requires the inventor to disclose the best mode contemplated by him, as of the time he executes the application, of carrying out his invention.”<sup>31</sup> Thus, since the beginning of the American patent system, inventors have been required to disclose the best mode, and a person accused of infringing a patent could defend on the ground that the inventor failed to disclose the best mode—at least until last year.

The America Invents Act, signed into law September 16, 2011, has removed failing to disclose the best mode as a defense to patent infringement. Specifically, the act amends 35 U.S.C. § 282 to read:

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

26. Patent Act of 1793, ch. 11, § 6, 1 Stat. 318, 322 (emphasis added).

27. *Id.*

28. Patent Act of 1836, ch. 357, § 15, 5 Stat. 117, 123 (omitting the “and the patent shall be declared void” language found in the 1793 Act); see Jerry R. Selinger, *In Defense of “Best Mode”: Preserving the Benefit of the Bargain for the Public*, 43 CATH U. L. REV. 1071, 1075 (1994) (“[T]he Patent Act of 1836 . . . altered the whole truth defense by omitting the requirement that the court declare the patent void when the defendant presented sufficient evidence to establish the defense.”).

29. Patent Act of 1952, ch. 950, § 282, 66 Stat. 792, 812.

30. See Ryan G. Vacca, *Patent Reform & Best Mode: A Signal to the Patent Office or a Step Toward Elimination*, 75 ALB. L. REV. 279, 284 (2012) (citing *Zoomar, Inc. v. Paillard Prod., Inc.*, 152 F. Supp. 328, 334 (S.D.N.Y. 1957); *Lamm v. Watson*, 138 F. Supp. 219, 220 (D.D.C. 1955)).

31. *In re Gay*, 309 F.2d 769, 772 (C.C.P.A. 1962).

....

(3) Invalidity of the patent or any claim in suit for failure to comply with—

(A) 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*,<sup>32</sup>

Note that this does not remove the requirement to disclose the best mode. An inventor is still required to disclose what she perceives at the time of filing for the patent as the best mode of practicing the invention.<sup>33</sup> The new law simply prevents one from invalidating a patent claim after the patent is issued for failure to disclose the best mode.

## II. PATENT INVALIDITY'S HISTORICAL ROLE IN BEST MODE ENFORCEMENT

An invention must meet many requirements, in addition to the enablement and best mode requirements discussed above, in order to receive a patent. The invention must be novel,<sup>34</sup> useful,<sup>35</sup> non-obvious,<sup>36</sup> and qualify as patentable subject matter.<sup>37</sup> It is the duty of the United States Patent and Trademark Office (PTO) to examine over 500,000 applications filed each year for compliance with these requirements.<sup>38</sup> However, the PTO's current examination procedures make enforcement of the best mode requirement during the examination virtually impossible.

The difficulty in examining patent applications for compliance with the best mode requirement is the highly subjective inquiry it requires. In practice, whether an inventor complied with the best mode requirement is a two-prong test.<sup>39</sup> First, it must be determined whether "the inventor possessed a best mode of practicing the claimed invention" at the time of patent filing.<sup>40</sup> This looks solely at the state of mind of the inventor and "fo-

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32. Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 15, 125 Stat. 284, 328 (2011) (to be codified at 35 U.S.C. § 282) (emphasis added).

33. 35 U.S.C. § 112 (2006).

34. *Id.* § 102.

35. *Id.* § 101.

36. *Id.* § 103.

37. *Id.* § 101.

38. PATENT TECH. MONITORING TEAM, U.S. PATENT AND TRADEMARK OFFICE, U.S. PATENT STATISTICS CHART: CALENDAR YEARS 1963–2011 (2011), *available at* [http://www.uspto.gov/web/offices/ac/ido/oeip/taf/us\\_stat.htm](http://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.htm).

39. *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1360 (2011).

40. *Id.* ("This first prong is subjective, focusing on the inventor's personal preferences as of the application's filing date.").

cuses on what the inventor knows.”<sup>41</sup> Whether an inventor has met the best mode requirement initially depends on what the inventor knew at the time the application was filed.<sup>42</sup> Second, “if the inventor has a subjective preference for one embodiment of the invention over all others, the court must then determine whether the inventor ‘concealed’ the preferred mode from the public.”<sup>43</sup> This second inquiry objectively looks to see whether the inventor’s disclosure is adequate to enable a person of ordinary skill in the art to practice the inventor’s perceived best mode.<sup>44</sup> Because of the subjective nature of the first prong of the best mode inquiry, the PTO instructs its examiners simply to “assume the best mode has been disclosed unless there is evidence to the contrary.”<sup>45</sup>

Because of the inability of the PTO to check for compliance with the best mode requirement during the examination process, the risk of having a patent claim invalidated during litigation after the patent has issued has historically been the primary enforcement mechanism for disclosure of the inventor’s best mode.<sup>46</sup> Under the new law, many argue that the absence of this enforcement mechanism will lead to an increase in best mode concealment.<sup>47</sup> However, despite the apparent unenforceability of the best

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41. *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1050 (Fed. Cir. 1995) (quoting *Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 558 (Fed. Cir. 1994) (emphasis omitted)).

42. *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 926 (1990) (“The best mode inquiry focuses on the inventor’s state of mind as of the time he filed his application—a subjective, factual question.”).

43. *Wellman*, 642 F.3d at 1360 (quoting *Green Edge Enters., LLC v. Rubber Mulch Etc., LLC*, 620 F.3d 1287, 1296 (Fed. Cir. 2010)).

44. *Id.*

45. The Manual for Patent Examining Procedure provides:

The examiner should assume that the best mode is disclosed in the application, unless evidence is presented that is inconsistent with that assumption. It is extremely rare that a best mode rejection properly would be made in *ex parte* prosecution. The information that is necessary to form the basis for a rejection based on the failure to set forth the best mode is rarely accessible to the examiner, but is generally uncovered during discovery procedures in interference, litigation, or other *inter partes* proceedings.

DEP’T OF COMMERCE, U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 2165.03 (8th rev. ed. 2010).

46. See Markham, *supra* note 3, at 155 (pointing out the inability of the PTO to police best mode compliance during the patent examination process and recognizing that “if litigants cannot assert a best mode defense, then no one can effectively monitor a patentee’s compliance with the best mode requirement”). Markham goes on to argue, however, that this perceived reliance on litigants to enforce the best mode requirement may be overemphasized. *Id.*

47. See, e.g., Vacca, *supra* note 30, at 293 (“[T]here may be an incentive to actively conceal the best mode as long as the risks of PTO detection are sufficiently low.”).



mode requirement, it still has teeth. The remainder of this Comment demonstrates why the new law will work and highlights the benefits that the new law will have on patent litigation.

### III. ARGUMENTS FOR ELIMINATING THE BEST MODE REQUIREMENT COMPLETELY AND WHY CONGRESS WAS RIGHT NOT TO DO SO

To understand why best mode law was changed, it is important to consider the issues with the old version of the law. Prior to the AIA, two main camps formed: those arguing to eliminate the best mode requirement completely, and those hoping to retain the requirement as it was.<sup>48</sup> Those seeking to completely eliminate the best mode requirement cited three main reasons for doing so. First, it unnecessarily drives up the cost of patent litigation.<sup>49</sup> Second, because the enablement requirement generally requires disclosing the best mode anyway, a separate and distinct best mode requirement is redundant.<sup>50</sup> Third, because the best mode requirement is inconsistent with the rest of the world's patent laws, it is unnecessarily difficult for foreign inventors to receive patent protection in the United States.<sup>51</sup> While the first proposition is valid, the second and third arguments are misplaced. The compromise struck by Congress, eliminating the best mode defense that led to excessive litigation costs while retaining the best mode requirement to promote the public's benefit of the patent bargain, is the perfect solution.

#### A. *The Extreme Costs Associated with Best Mode Litigation*

The average patent suit costs between two and four million dollars, "with costs increasing proportionally to the dollar value at stake."<sup>52</sup> Contributing to this cost is the pre-trial discovery that surrounds any civil suit. However, when best mode claims are involved, the time and costs associated with discovery can increase significantly.<sup>53</sup> The reason for the increase relates directly to the elements of the claim itself. Courts impose a heavy

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48. Markham, *supra* note 3, at 132–35 (discussing the "pro-big business" group arguing to eliminate the best mode requirement and the "generic [pharmaceutical companies]-plus-others" group arguing to keep the requirement as it was).

49. *Id.*

50. *Id.*

51. *Id.*

52. Siddharth Fernandes, *A Realistic Analysis of § 271(g) and the ITC: Academic Hypothesis Aside, § 271(g) Does Not Violate the Paris Convention or TRIPS because its Affirmative Defenses Do Not Apply to § 337 Actions Before the ITC*, 17 FED. CIR. B.J. 473, 480 (2008).

53. Markham, *supra* note 3, at 141–42.

burden of proof on those asserting a best mode defense, requiring them to prove, *inter alia*, the inventor's state of mind at the time the application was filed—typically a state of mind as it existed years before discovery even begins.<sup>54</sup> Because of this subjective requirement, and the extensive time between discovery and the filing date, proof can usually only come from circumstantial evidence, which requires time-consuming and expensive depositions and investigations.<sup>55</sup>

While such costs could be justifiable if used solely to promote the disclosure of an inventor's best mode, in reality many litigators do not use a best mode defense for that purpose. In the realm of patent litigation, best mode claims are frequently “last resort” defenses, alleged by infringers with weak technical cases.<sup>56</sup> In fact, a recent review of district court and federal circuit case law indicated that best mode challenges succeeded only approximately 26% of the time.<sup>57</sup> Despite the rare success of best mode claims and the heavy burden of proof required to win a best mode challenge, a plausible best mode defense is easy to plead because the contours of the best mode requirements: “(1) are not precise, (2) are subject to continuing judicial interpretation, and (3) depend on facts and states of mind at precise points of time, usually many years before the date of litigation.”<sup>58</sup> Therefore, merely alleging a best mode violation can keep a weak case afloat when it should have been dismissed, leading to additional discovery that may not have been otherwise available.<sup>59</sup> Furthermore, this defense can allow an infringer to “try the person rather than the patent,” a strategy that focuses on the inventor's actions rather than the technical merits of the case.<sup>60</sup>

The counter to the “best-mode-is-expensive” argument is that there is little evidence “definitively linking a best mode defense to increased patent litigation costs.”<sup>61</sup> Measuring the costs and benefits of best mode enforcement is extremely difficult because of the myriad of other variables that affect the same costs and benefits.<sup>62</sup> Furthermore, some scholars argue that

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54. *See supra* notes 39–42 and accompanying text.

55. Markham, *supra* note 3, at 141–42.

56. 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).

57. Markham, *supra* note 3, at 149–50 (reviewing all district court cases from 2005 to 2009 and relying on another study reviewing federal circuit cases from 1989 to 1996). Both studies concluded that “the best mode is not typically a winning defense.” *Id.*

58. *Id.* at 142.

59. *Id.*

60. Chisum, *supra* note 56, at 279.

61. Markham, *supra* note 3, at 142–43.

62. *Id.* at 141.

because the inventor's state of mind will be relevant during discovery regardless of whether best mode compliance is challenged, eliminating the best mode defense would have little effect on pre-trial discovery costs.<sup>63</sup> However, when the Advisory Commission on Patent Law Reform reviewed the best mode defense in 1992, it concluded that the defense did increase the cost of litigation.<sup>64</sup> Moreover, while it may not be possible to conclusively show that eliminating the best mode defense will reduce pre-trial discovery costs, it cannot be argued that eliminating it will increase the costs. Therefore, in light of the fact that a best mode defense is often plead when it will not succeed, it is frequently used only to advance weak technical cases, and a congressional advisory committee determined that best mode defenses do increase litigation costs, the best mode defense has a negative effect on patent litigation.

### B. *Why the Best Mode Requirement is Not Redundant*

Some scholars argue that the best mode is useless in light of the enablement requirement.<sup>65</sup> Specifically, because there is no obligation for an inventor to update the best mode after filing,<sup>66</sup> and because the Federal Circuit has held that a company's best mode cannot be imputed to the inventor,<sup>67</sup> there is little incentive to disclose more than is necessary to meet the enablement requirement. Many argue that the additional disclosure resulting from compliance with the best mode requirement relative to the disclosure necessary to meet the enablement requirement is simply not worth the costs.<sup>68</sup>

However, despite these views, the best mode requirement is the "linchpin of the U.S. patent system."<sup>69</sup> The best mode requirement "com-

63. Selinger, *supra* note 28, at 1100–01.

64. ADVISORY COMM'N ON PATENT LAW REFORM, A REPORT TO THE SECRETARY OF COMMERCE (1992), available at [http://www.ipmall.info/hosted\\_resources/lipa/patents/patentact/acplr-1.pdf](http://www.ipmall.info/hosted_resources/lipa/patents/patentact/acplr-1.pdf).

65. Markham, *supra* note 3, at 143 (citing *Patent Reform: Injunctions and Damages: Hearing Before the Subcomm. on Intellectual Prop. of the Comm. on the Judiciary, U.S. S., 109th Cong. 11, 160 (2005)* (statement of Prof. Mark Lemley, Prof., Stanford Univ.)).

66. Whether an inventor contemplated a best mode for practicing the invention is determined by looking to the inventor's state of mind *at the time the patent application is filed*. See *supra* notes 39–42 and accompanying text.

67. See *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1052 (Fed. Cir. 1995) (“[I]t would be improper to impute a [corporate] patent attorney's knowledge of a best mode to the inventor for purposes of finding a best mode violation.”).

68. See Markham, *supra* note 3, at 144.

69. Dale L. Carlson, Katarzyna Przychodzen & Petra Scamborova, *Patent Linchpin for the 21st Century?—Best Mode Revisited*, 45 IDEA 267, 270 (2005) (citing W.L. Gore & As-

pels disclosure of the very heart of the invention as viewed from the inventor's perspective."<sup>70</sup> This requirement acts as a safeguard against the "natural human tendency" to disclose "only what they know to be inferior modes" of the invention so as to keep the best for themselves.<sup>71</sup> Without the additional requirement to disclose the best mode, the "primary purpose of the patent system would be frustrated because the inventor would be permitted to retain the details of his or her invention as trade secrets while gaining the benefit of the patent monopoly."<sup>72</sup>

Relying on the enablement requirement alone is insufficient because the two requirements are rooted in different policies.<sup>73</sup> Enablement focuses only on ensuring that a "person of ordinary skill in the art," without "undue experimentation," can make and use the invention.<sup>74</sup> However, by not requiring the best mode disclosure, the "evolutionary development of innovation" would certainly be slowed because inventors would be able to withhold their best mode and maintain a competitive advantage after the patent expires; a result that is contrary to the very foundations of the patent system.<sup>75</sup> Therefore, it would be improper to rely on the enablement requirement alone because inevitably inventors would withhold their best mode, depriving the public of the patent system's *quid pro quo* and inhibiting disclosure that could otherwise lead to technological growth.<sup>76</sup>

### C. *Why Keeping the Best Mode Requirement Will Harmonize United States Patent Law with the Rest of the World*

Many critics of the best mode requirement argue that it is unique to United States patent law and therefore serves as an impediment to foreign patentees.<sup>77</sup> Having unique requirements for patentability forces those ap-

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socs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1555 (Fed. Cir. 1983) ("Early public disclosure is a linchpin of the patent system.").

70. *Id.*

71. *Id.*

72. *Id.* at 271.

73. *Id.* at 272.

74. See *W.L. Gore & Assocs.*, 721 F.2d at 1556–57 ("A patent is invalid only when those skilled in the art are required to engage in *undue* experimentation to practice the invention.").

75. Carlson, Przychodzen & Scamborova, *supra* note 69, at 272–73.

76. See *id.* at 273 (arguing that removal of the best mode requirement would "slow down the evolutionary development of innovation[.]" and the presence of the best mode requirement "insure[s] that the 'public receives an honest disclosure in return for the grant of exclusivity'" (quoting Selinger, *supra* note 28, at 1079)).

77. NAT'L RESEARCH COUNCIL OF THE NAT'L ACADS., A PATENT SYSTEM FOR THE 21ST CENTURY 127 (Stephen A. Merrill et al. eds., 2004), available at <http://www.nap.edu/catalog/10976.html> ("The 'best mode' requirement . . . imposes an ad-

plicants who originally filed in countries without these requirements to do more than simply translate their foreign application for filing in the United States.<sup>78</sup> This additional burden, combined with the “dependence on discovery aimed at uncovering inventor records and intentions,” according to some, “justifies its removal from U.S. patent law.”<sup>79</sup> While the discovery associated with foreign best mode defense suits would be a burden on the patent litigation system,<sup>80</sup> the conclusion that the best mode requirement is unduly burdensome to foreign applicants is misplaced.

First, the general perception that the best mode requirement is unique to United States patent law is simply incorrect.<sup>81</sup> As of 2005, at least twenty-four countries required disclosure of the inventor’s best mode.<sup>82</sup> While some countries have dropped the best mode requirement in recent decades, the trend has generally been to adopt it.<sup>83</sup> Even Japan, one of the major patent markets in the world, has a variation of the best mode requirement.<sup>84</sup> There, the applicant “should give as many examples as possible of those which he considers bring about the best results.”<sup>85</sup> Because of the many benefits associated with best mode disclosure, such as furthering technological innovation and public disclosure, and because of the growing trend around the world to adopt various forms of the best mode requirement, embracing the best mode, rather than eliminating it, is the better path to global patent law harmonization.

Therefore, as the previous sections illustrate, Congress struck the ideal compromise between completely eliminating the best mode requirement and keeping it as it was. However, a critical premise of the new law’s success is that the best mode requirement will be enforceable without the threat of the best mode invalidity defense. As the rest of this Comment

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ditional burden and element of uncertainty on foreign patentees in the United States.”); Chisum, *supra* note 56, at 279 (“The best mode . . . requirement[] [is] especially vexing for foreign inventors and companies who seek U.S. patents . . .”).

78. See NAT’L RESEARCH COUNCIL OF THE NAT’L ACADS., *supra* note 77, at 127 (noting that the best mode requirement has “no analog in foreign patent law” and that this “imposes an additional burden and element of uncertainty on foreign patentees”).

79. *Id.*

80. See *supra* Part III.A.

81. See Carlson, Przychodzen & Scamborova, *supra* note 69, at 283–85.

82. *Id.* Those countries include the United States, Argentina, Australia, Bahamas, Barbados, Bolivia, Brazil, Canada, Costa Rica, Egypt, Ghana, Guatemala, Honduras, India, Jordan, Madagascar, Malawi, Malaysia, Mexico, New Zealand, Pakistan, Sri Lanka, Thailand, and Zambia. *Id.*

83. *Id.* at 285–86 (noting that England, South Africa, and Ireland have dropped the best mode requirement, generally citing a need to conform to the laws of neighboring countries).

84. *Id.* at 284–85.

85. *Id.* (noting, however, that “no Japanese court has yet invalidated a patent for failure to disclose this information”).

demonstrates, there is no reason to be concerned that the best mode requirement will become unenforceable.

#### IV. ENFORCING THE BEST MODE REQUIREMENT WITHOUT THE INVALIDITY DEFENSE

The biggest concern with eliminating the best mode invalidity defense is that without it there will be no incentive to comply with the best mode requirement. However, there are several reasons why the best mode requirement will still be enforceable despite the loss of defense in patent litigation. The primary reason lies in the fact that the majority of patent applicants utilize the services of a patent attorney or agent.<sup>86</sup> These patent practitioners are subject to strict ethics rules that prevent them from submitting an application while knowingly concealing the best mode.<sup>87</sup> Furthermore, filing a patent application that purposefully conceals the best mode could subject the applicant to criminal sanctions under the Federal Fraud and False Statements Statute (“FFS”).<sup>88</sup> Because applicants are required to sign an oath or declaration acknowledging their duty to provide all information material to patentability, submitting an application while knowingly concealing the best mode could result in criminal liability.<sup>89</sup> Alternatively, some scholars argue that no enforcement is necessary whatsoever because applicants will disclose the best mode anyway—either to comply with the law, to meet the enablement requirement, or simply because they either fear the law will change back to what it was.<sup>90</sup> However, one method of enforcement commonly believed to still be available that actually is not, is the defense of inequitable conduct.

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86. Despite significant efforts by some scholars, the number of *pro se* patent applications relative to the number of applications filed utilizing the services of a patent attorney or agent has not been determined. See generally Paul M. Swamidass, *Reforming the USPTO to Comply with MPEP § 707.07(j) to Give a Fair Shake to Pro Se Inventor-Applicants*, 9 J. MARSHALL REV. INTELL. PROP. L. 880, 882–83 (2010) (detailing efforts to determine the exact figure, including direct contact with the PTO). While the PTO keeps a myriad of detailed statistics regarding patent applications, the number of *pro se* applications is not yet included. *Id.* at 882. However, the author’s informal survey of patent attorneys, patent practitioners, and patent law professors has indicated that the number of applications filed with the help of a patent attorney or patent agent is, conservatively, over 90%.

87. See *infra* Part IV.C.

88. 18 U.S.C. § 1001 (2006).

89. See *infra* Part IV.B.

90. See *infra* Part IV.D.

A. *Why the Inequitable Conduct Doctrine Cannot Prevent Best Mode Concealment*

The inequitable conduct doctrine in patent law is a judge made doctrine that can be traced back to three Supreme Court opinions from the 1930s and 1940s.<sup>91</sup> These cases applied the “doctrine of unclean hands to dismiss patent cases involving egregious misconduct.”<sup>92</sup> Over time, inequitable conduct evolved from requiring “egregious affirmative acts of misconduct intended to deceive both the PTO and the courts” to also include “the mere nondisclosure of information to the PTO.”<sup>93</sup> Modernly, inequitable conduct requires the accusing party to prove two separate elements by clear and convincing evidence: “that the applicant (1) made an affirmative misrepresentation of material fact, failed to disclose material information, or submitted false material information, and (2) intended to deceive the [PTO].”<sup>94</sup> If these elements are proven, the court must then “weigh the equities to determine whether the applicant’s conduct before the PTO warrants rendering the entire patent unenforceable.”<sup>95</sup>

An inventor who affirmatively chooses to conceal her best mode has unquestionably met the requirements of inequitable conduct.<sup>96</sup> However, the new law specifies 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.”<sup>97</sup> This “otherwise unenforceable” language is most likely Congress’ way of saying that failure to disclose the best mode shall not be a valid defense, regardless of whether it rises to the level of inequitable conduct. One of Congress’ long time concerns has been the rising cost of patent litigation.<sup>98</sup> To invalidate the best mode defense but

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91. Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co., 324 U.S. 806 (1945); Hazel-Atlas Glass Co. v. Hartford-Empire Co., 322 U.S. 238 (1944), *overruled on other grounds by* Standard Oil Co. v. United States, 429 U.S. 17 (1976); Keystone Driller Co. v. Gen. Excavator Co., 290 U.S. 240 (1933).

92. *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1285 (Fed. Cir. 2011).

93. *Id.* at 1287.

94. *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1365 (Fed. Cir. 2008).

95. *Therasense*, 649 F.3d at 1287.

96. *Old Town Canoe Co. v. Confluence Holdings Corp.*, 448 F.3d 1309, 1322 (Fed. Cir. 2006) (“[B]ecause disclosure of the best mode is statutorily required, see 35 U.S.C. § 112, failure to disclose the best mode is inherently material and . . . reaches the minimum level of materiality necessary for a finding of inequitable conduct.” (quoting *Consol. Aluminum Corp. v. Fosco Int’l, Ltd.*, 910 F.2d 804, 808 (Fed. Cir. 1990))).

97. Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 15, 125 Stat. 284, 328 (2011) (to be codified at 35 U.S.C. § 282) (emphasis added).

98. ADVISORY COMM’N ON PATENT LAW REFORM, *supra* note 64, at 14 (“[T]o eliminate excessive transactional costs, the Commission recommends removing bases for challenging

leave the door open to the same litigation cost concerns would make little sense, particularly since the litigation costs associated with the best mode defense sit a distant third to inequitable conduct and willful misconduct claims.<sup>99</sup>

Furthermore, the argument that one seeking invalidity is asserting a direct basis of inequitable conduct, rather than a direct basis of failure to disclose the best mode, is also unlikely to prevail. As Professor Ryan Vacca explains, “section 15 [of the AIA] does not draw a distinction between failure to disclose the best mode as a direct basis and as an indirect basis.”<sup>100</sup> Therefore, even if one seeks to render the patent invalid on inequitable conduct grounds rather than for failing to disclose the best mode, the inequitable conduct would still trace back to a failure to disclose the best mode, which cannot be a “basis on which [the patent may be] held invalid or *otherwise unenforceable*.”<sup>101</sup> Thus, with the AIA’s changes to the law, the best mode requirement is likely unenforceable using the inequitable conduct doctrine.

### B. Criminal Sanctions

The FFS could be used to enforce compliance with the best mode requirement.<sup>102</sup> The FFS provides that any person who “knowingly and willfully . . . makes any materially false, fictitious, or fraudulent statement or representation; or . . . makes or uses any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry” to the government may be fined, imprisoned, or both.<sup>103</sup> As indicated earlier, concealing the best mode is material because it is a requirement for patentability, and failing to disclose the best mode would result in the PTO not issuing the patent.<sup>104</sup> Furthermore, one who purposefully conceals the best mode requirement has done so “knowingly and

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patent validity that do not provide a corresponding public benefit. In particular, the Commission recommends that the best mode requirement . . . be eliminated . . . .”); *see also* Markham, *supra* note 3, at 142 (calling for “eliminating the best mode requirement to reduce subjective and expensive pre-trial discovery and increase the predictability of patent disputes.” (citing *A Patent System for the 21st Century: Hearing Before the S. Comm. on the Judiciary*, 109th Cong. 144 (2005) (statement of Richard C. Levin, President, Yale Univ., & Mark B. Myers, Wharton School, Univ. of Pennsylvania))).

99. Markham, *supra* note 3, at 143 (citing NAT’L RESEARCH COUNCIL OF THE NAT’L ACADS., *supra* note 77, at 123).

100. Vacca, *supra* note 30, at 293 n.108.

101. Leahy-Smith America Invents Act § 15, 125 Stat. at 385 (to be codified at 35 U.S.C. § 282) (emphasis added).

102. 18 U.S.C. § 1001 (2006).

103. *Id.* §§ 1001(a)(2)–(3).

104. *See supra* note 96 and accompanying text.



willfully” under the FFS because all that is required is that the statement have “the natural tendency to influence, or have been capable of influencing, the agency.”<sup>105</sup>

Arguably, unless the applicant is asked directly by the PTO whether the best mode is disclosed, the applicant has not given a false statement that would fall under the purview of the FFS.<sup>106</sup> For example, Professor Vacca argues that submitting a patent application to the PTO that simply fails to disclose the best mode is not a false statement because it contains no statement “made with a conscious purpose of evading the truth.”<sup>107</sup> However, every patent application requires that the applicant sign an oath stating that they “acknowledge[] the duty to disclose to the [PTO] all information known to the person to be material to patentability as defined in [section] 1.56.”<sup>108</sup> Signing and submitting such an oath with an application that the applicant knows is lacking the required best mode disclosure could be construed as a false representation.<sup>109</sup> Therefore, unlike Professor Vacca, this Comment argues that such a misrepresentation would be punishable under the FFS considering the applicant’s legal duty to disclose the best mode and affirmative acknowledgement of the duty of candor in the oath.

However, despite the applicability of the FFS, there is a significant issue with criminal enforcement. The FFS is governed by a five-year statute of limitations.<sup>110</sup> The statute of limitations begins to run when the crime is complete, and the crime is complete when all of the elements of the crime have occurred.<sup>111</sup> The Tenth Circuit Court of Appeals has held that “the ability of the government . . . to learn of a particular offense is not a relevant factor” when considering whether to toll the statute of limitations.<sup>112</sup> Therefore, the clock would begin to run when the patent application is filed. Because the average time between filing the patent application and

105. *United States v. Dick*, 744 F.2d 546, 553 (7th Cir. 1984).

106. *See Vacca, supra* note 30, at 298–99.

107. *Id.* at 299.

108. 37 C.F.R. § 163(b)(3) (2011). Section 1.56(a) of title 37 of the Code of Federal Regulations provides further that “[e]ach individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability.” *Id.* § 1.56(a).

109. *See United States v. Richeson*, 825 F.2d 17, 20 (1987) (“[18 U.S.C. § 1001] prohibits the willful and knowing falsification or concealment of a material fact in any matter within the jurisdiction of any federal department or agency. Ordinarily, a defendant may not be convicted of concealment unless the defendant had a duty to disclose.” (citing *United States v. Irwin*, 654 F.2d 671, 678–79 (10th Cir. 1981))); *accord Hubbard v. United States*, 514 U.S. 695, 716–17 (1995).

110. 18 U.S.C. § 3282(a) (2006).

111. *United States v. Smith*, 740 F.2d 734, 736 (9th Cir. 1984) (citations omitted).

112. *United States v. Dunne*, 324 F.3d 1158, 1165 (10th Cir. 2003).

the issue of a patent is between three and four years,<sup>113</sup> it is very likely that no one would be aware of the offense until near, or potentially after, the statute of limitations has run. Furthermore, even if the patent issues in less than five years, someone would still need to discover that the violation has occurred. Because such a discovery would often not occur until after five years has elapsed since filing the application, criminal enforcement under the FFS for intentionally failing to disclose the best mode would often not be feasible.

### C. Ethical Enforcement

The best safeguard against rampant disregard for the best mode requirement is the fact that a significant percentage of patent applicants make use of a patent attorney or patent agent.<sup>114</sup> Patent attorneys and patent agents are subject to discipline by the PTO for violation of the patent bar's rules, including revocation of their patent bar license.<sup>115</sup> The patent rules provide, for example, that a "practitioner shall not . . . engage in conduct involving dishonesty, fraud, deceit, or misrepresentation."<sup>116</sup> Furthermore, patent attorneys and patent agents may not "advance a claim . . . that is unwarranted under existing law."<sup>117</sup> Members of the patent bar are also subject to a duty of good faith and candor and a duty to disclose information material to patentability.<sup>118</sup> These duties are two-fold for patent attorneys because they are also subject to their state bar's ethics rules, which have similar provisions against misrepresenting material facts.<sup>119</sup> Therefore, because of the significant disciplinary action that could result, a patent practitioner that is aware of a client's attempts to conceal the best mode would be very unlikely to aid the client's attempt.

However, the rules requiring a practitioner to inform the PTO of the best mode if the client refuses to do so conflict substantially with the practitioner's duty of confidentiality to the client.<sup>120</sup> This conflict was discussed

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113. John R. Allison & Mark A. Lemley, *Empirical Evidence on the Validity of Litigated Patents*, 26 AIPLA Q.J. 185, 237 (1998) ("The average time in prosecution for litigated patents in the population is 3.6 years . . .").

114. *See supra* note 86 and accompanying text.

115. 37 C.F.R. § 10.132 (2011).

116. *Id.* § 10.23(b)(4).

117. *Id.* § 10.85(a)(2).

118. *Id.* § 1.56(a).

119. *See, e.g.*, MODEL RULES OF PROF'L CONDUCT R. 3.3(a)(1) (2011) ("A lawyer shall not knowingly make a false statement of fact or law to a tribunal . . .").

120. 37 C.F.R. § 10.57(b) ("Except when permitted under paragraph (c) of this section, a practitioner shall not knowingly: (1) reveal a confidence or secret of a client[,] (2) use a confidence or secret of a client to the disadvantage of the client[,] [or] (3) use a confidence or secret of a client for the advantage of the practitioner or of a third person, unless the client

at length in *Molins PLC v. Textron, Inc.*, by the Federal Circuit in the context of a patent attorney faced with a conflict of interest while representing two clients attempting to patent similar technology.<sup>121</sup> The issue was whether the attorney should have disclosed the first client's patent application to the PTO in the prosecution of the second client's patent.<sup>122</sup> While the majority took no position on the matter,<sup>123</sup> Judge Newman and Judge Nies offered diverging opinions in a concurrence and a dissent, respectively. Judge Newman stated that the duty of confidentiality does trump the attorney's duty of candor because the "privilege [of confidentiality] is the client's, not the lawyer's."<sup>124</sup> Judge Nies argued that representing two clients in such similar technology areas provides "no justification for deceiving the PTO" and therefore "the record amply supports the . . . finding of . . . [an] ongoing effort to withhold material prior art . . . with an intent to deceive."<sup>125</sup>

It is important to note that *Molins* does not represent the situation where the patent attorney or the client is intentionally trying to conceal information they *know* to be material from the PTO. Under the common hypothetical addressed in this Comment, where the inventor knows of the best mode and is actively seeking to conceal it, the patent bar ethics rules and the Model Rules uniformly provide that an attorney is not subject to a duty of confidentiality if the client is using the lawyer's services to perpetuate a fraud.<sup>126</sup> In fact, after urging the client not to engage in the fraudulent behavior, the practitioner may be *required* to disclose the fraud to the PTO should the client insist on going forward.<sup>127</sup> However, the rules go on to provide an opportunity for the practitioner to simply withdraw from repre-

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consents after full disclosure."); MODEL RULES OF PROF'L CONDUCT R. 1.6(a) ("A lawyer shall not reveal information relating to the representation of a client . . .").

121. *Molins PLC v. Textron, Inc.*, 48 F.3d 1172 (Fed. Cir. 1995).

122. *Id.* at 1175–78.

123. *Id.* at 1179 (holding that the disclosure would have been cumulative and was therefore not necessary).

124. *Id.* at 1193 (Newman, J., concurring).

125. *Id.* at 1190 (Nies, J., dissenting).

126. 37 C.F.R. § 10.85(b)(1) (2011) ("A practitioner who receives information clearly establishing that: (1) a client has, in the course of the representation, perpetrated a fraud upon a person or tribunal shall promptly call upon the client to rectify the same, and if the client refuses or is unable to do so the practitioner shall reveal the fraud to the affected person or tribunal."); MODEL RULES OF PROF'L CONDUCT R. 1.6(b)(2) ("A lawyer may reveal information relating to the representation of a client to the extent the lawyer reasonably believes necessary . . . to prevent the client from committing a crime or fraud that is reasonably certain to result in substantial injury to the financial interests or property of another and in furtherance of which the client has used or is using the lawyer's services[.]").

127. *See* 37 C.F.R. § 10.85(b)(1). This is demonstrated through the use of the word "shall" in the rule.

sentation, which avoids any risk to the practitioner that he or she would violate the duty of confidentiality.<sup>128</sup> At least one group of scholars advises that withdrawing from representation in that situation is the best course of action for a patent practitioner.<sup>129</sup>

In light of this duty to report the fraudulent activity of a client, or at least to withdraw from representation of a fraudulent client, patent practitioners are extremely unlikely to aid inventors in concealing the best mode because doing so would lead to disciplinary action by either the PTO or the practitioner's state ethics board. Furthermore, unlike the criminal sanctions discussed above, the statute of limitations on ethics violations is ten years.<sup>130</sup> Therefore, even though discovery of such conduct would still be difficult without the availability of discovery during litigation, practitioners would have to wait 10 years from the date of filing the application to breathe easy. This will most likely induce the majority of patent practitioners to avoid behavior that would look anything like active concealment of the best mode.

#### D. *No Enforcement Needed Whatsoever*

Some scholars suggest that the best mode will effectively police itself without outside enforcement.<sup>131</sup> For example, registered patent agent and former patent examiner, Wesley Markham, asks us to consider the two classes of inventors relevant to this inquiry: honest inventors, and self-interested or dishonest inventors.<sup>132</sup> The honest inventor will disclose the best mode because that is what she is required to do and she will not want to break the law.<sup>133</sup> Ideally, this represents most inventors. However, Markham suggests that the dishonest inventor will also comply.<sup>134</sup> A dishonest or "self-interested" inventor would be restrained by the fear that Congress will amend the law once again to permit the best mode invalidity

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128. *See id.* § 10.84(b)(2) ("In representation of a client, a practitioner may: . . . (2) refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though there is some support for an argument that the conduct is legal."); MODEL RULES OF PROF'L CONDUCT R. 1.16(a)(1) (allowing for withdrawal if "representation will result in violation of the Rules of Professional Conduct or other law").

129. *See* Alan H. MacPherson et al., *Ethics in Patent Practice (A Brief Visit to Several Areas of Concern)*, 574 PRAC. L. INST./PAT. 657, 695–98 (1999).

130. Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 3, 125 Stat. 284, 291 (2011) (to be codified at 35 U.S.C. § 32).

131. *See* Markham, *supra* note 3, at 156.

132. *Id.* at 156–57.

133. *Id.* at 157.

134. *Id.*

defense.<sup>135</sup> Considering the wide range of views concerning the best mode, it is very possible that Congress could reverse itself and reinstate the best mode invalidity defense.<sup>136</sup> Therefore, the proliferation of honest inventors along with the mere threat of change could be all that is required to ensure substantial disclosure of inventors' best modes.

## V. CONCLUSION

Many fear that removing the “invalidity, unenforceability, and cancellation arrows from the quiver of best mode enforcement” will undoubtedly lead to increased intentional concealment of the inventor's best mode.<sup>137</sup> While it is true that the best mode invalidity defense was effective at encouraging inventors to disclose the best mode, the painful truth is that the costs, as seen through unending discovery leading to multi-million dollar patent infringement suits, far outweigh the best mode disclosures acquired.<sup>138</sup> By eliminating the best mode invalidity defense, Congress has eliminated a substantial financial burden on intellectual property owners. At the same time, Congress can hardly be said to have brought an end to best mode disclosure. The majority of patents filed in the United States are filed with the help of a registered patent attorney or agent. Because these individuals cannot and will not aid an inventor in intentionally concealing their best mode, most patent applications will still comply with the requirement. Furthermore, those individuals who do not use a patent practitioner will either fail to disclose the best mode because they are unfamiliar with the patent laws—in which case they will most likely fail to obtain a patent anyway—or will purposefully conceal it and be potentially subject to criminal liability under the FFS. Lastly, because the few dishonest or self-interested inventors must recognize the possibility that Congress could always change the law back, they will also be forced to comply with the best mode requirement. Therefore, the best mode requirement still has teeth, and the law now significantly reduces patent litigation costs. Congress struck the perfect compromise.

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135. *Id.* Markham also argues that the threat of inequitable conduct violations would dissuade a dishonest inventor from concealing the best mode. *Id.* However, as discussed earlier, inequitable conduct is no longer a threat to an intentional best mode concealer. *See supra* Part IV.A.

136. *See, e.g., Perspective on Patents, Harmonization and Other Matters: Hearing Before the Subcomm. on Intellectual Prop. of the S. Comm. on the Judiciary, 109th Cong. 9 (2005) (Statement of Christine J. Siwik, Partner, Rakoczy Molino Mazzochi Siwik, LLP, on Behalf of Barr Laboratories, Inc., Chicago, Illinois) (recommending strengthening the best mode requirement).*

137. Vacca, *supra* note 30, at 304.

138. *See* Markham, *supra* note 3, at 141–43.

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