

**THE “NEW KAWAI”: THE ANACHRONISTIC AND
DISCRIMINATORY “BEST MODE” REQUIREMENT
OF THE *LEAHY SMITH AMERICA INVENTS ACT OF 2011* ***

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* Cf. T. Aoyama, *The Hoechst Case - A New Kawai*, 59 J. PAT. OFF. SOC'Y 263 (1977).

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I. OVERVIEW

This paper focuses upon the failed effort of the *Leahy Smith America Invents Act* of 2011 to effectively bury the “best mode contemplated” requirement which – instead of having been written out of the patent law – has continued in as part of 35 USC § 112(a). The drafters of the legislation had thought that they had, for all practical purposes, indeed “buried” this requirement through amendments to the patent law to effectively deny use of the “best mode contemplated” requirement by express legislative changes: These changes deal with enforcement in 35 USC §§119(e)(1), 120 and 282(b)(3)(A).

This set of changes, while clever, unfortunately, comes up short because in the first instance while priority may be obtained based upon a best mode-defective parent application that is a provisional or regular parent under 35 USC §§ 119(e)(1), 120, priority is denied for the same defect if the parent is a foreign priority document under 35 USC § 119(a). Equally important, there are further loopholes that keep the “best mode contemplated” requirement alive, including an express provision doing so as part of the *Manual of Patent Examining Procedure*.

This paper commences with a discussion of why the *Leahy Smith America Invents Act* of 2011 should be modified to eliminate the “best mode contemplated” requirement. See § II, *Fixing a Problematic New Law*. In the first instance, there is the obvious discrimination against the applicant who applies to the United States from abroad via the Paris Convention who loses priority if his “home country” application lacks the “best mode contemplated”; in contrast, the same defect in a provisional application or regular continuing application parent is *statutorily exempt* from this problem. See § II-A, *An Anti-Foreigner Discrimination, At What Price?*

But, doesn’t a change in the law, now, go against expectations of the intellectual property community at the time of enactment? Not at all! The consensus view of that community after enactment was that the new law *did* abolish for any practical purpose the “best mode contemplated” requirement. See § II-B, *Meeting Expectations of the Intellectual Property Community*.

The expectations of the legislature at the time of enactment had been that the combination of legislative changes for priority and enforcement would have made the “best mode contemplated” requirement a dead letter as a *practical* matter. Not quite. There remain open loopholes that still need to be fixed to reach that “dead letter” status. See § III, *A Problematic Apparent End to the “Best Mode”* In the first instance, the Patent Office did not go along with the apparent death sentence for the “best mode contemplated” requirement. The requirement *continues* as a viable part of the patent practice as seen from the *Manual of Patent Examining Procedure*. See § III-A, *Continued “Best Mode” Requirement at the PTO*. Additionally, the discrimination against the foreign patent community manifested by the new law is now for the first time gaining appreciation. See § III-B, *A “New Kawai”*.

The answer that should meet public policy concerns is to now simply bite the bullet. Congress should do now what should have been done in the first place: It should repeal the requirement for disclosure of the “best mode contemplated” in 35 USC § 112(a). See § IV, *Legislative Fix to Abolish an Arcane Requirement*. Proposed legislation is included as an Appendix.

II. FIXING A PROBLEMATIC NEW LAW

A. An Anti-Foreigner Discrimination, at What Price?

It is quite simple to perceive an anti-foreigner discrimination built into the *Leahy Smith America Invents Act* of 2011. On the one hand, a requirement for Paris Convention priority under 35 USC § 119(a) keyed to a “home country” application denies priority if the earlier application lacks a disclosure of the “best mode contemplated”. On the other hand, priority based upon a provisional application under 35 USC § 119(e) or regular parent under 35 USC § 120 is granted priority with the same “best mode contemplated” defect: This right to priority to the earlier filing is based upon specific statutory wording in §§ 119(e), 120, where that specific wording does not appear in § 119(a).

Whether the omission of the critical language in § 119(a) was deliberate or accidental is beside the point: The discrimination, whether intentional or accidental, has now lived on for five (5) years without any attempt to correct what appears to be a blatant, anti-foreigner discrimination built right into the statutory

wording of Title 35 of the United States Code. It is the *continued* discrimination that is impossible to defend.

The continuation of this obvious discrimination against foreign patent applicants represents an unnecessary black eye for the United States. This is reminiscent what happened beginning two generations ago with the continuation of the “Hilmer practice”: For more than two generations until the *Leahy Smith America Invents Act* of 2011 the notorious *Hilmer* case¹ discrimination continued. The international patent community was up in arms for the more than forty years.²

An accident to create a “new Hilmer” or “new Kawai” should not be permitted to survive.

B. Meeting Expectations of the Intellectual Property Community

Abolishing the “best mode contemplated” requirement would be consistent with the expectations of the patent community in the wake of enactment of the *Leahy Smith America Invents Act* of 2011: At the time the dominant view was that the combination of legislative changes had, in fact, thrown out the “best mode contemplated” requirement for all practical purposes.

Elimination today of the “best mode contemplated” requirement would also be entirely consistent with the dominant view of the patent community that the *Leahy Smith America Invents Act* of 2011 had eliminated this requirement. As explained by Professors Petherbridge and Rantanen: “The AIA adopted this recommendation in substantial part by stripping courts of the power to declare patents either invalid or unenforceable for failure to disclose a best mode. Therefore, while it is technically true that amended 35 U.S.C. § 112 still “requires” patent applicants to disclose a best mode if they know of one, courts will no longer

¹ *In re Hilmer*, 359 F.2d 859, (CCPA 1966), *subsequent proceedings*, 424 F.2d 1108 (CCPA 1970).

² Harold C. Wegner & Jochen Pagenberg, *Paris Convention Priority: A Unique American Viewpoint Denying ‘The Same Effect’ to the Foreign Filing*, 5 Int’l Rev. Indus. Prop. & Copyright L. 361 (1974).

enforce the requirement. There is little dispute that this development has, as a practical matter, effectively eliminated the best mode requirement from patent law.”³

Professors Love and Seaman conclude that “as a practical matter *** an inventor's failure to disclose in her patent the preferred method for carrying out the invention -- the so-called ‘best mode’ – will no longer invalidate her patent rights or otherwise render them unenforceable.”⁴

Fossen points out that “[a]fter AIA, an applicant will still be required to disclose the best mode in the application in order to obtain the patent, but a potential infringer will no longer be able to invalidate the patent based on a lack of best mode disclosure.”⁵

Professor Janicke explains that “Congress, while leaving the best mode provision in the disclosure requirements for a patent application, may have completely eliminated any effects of failing to include it in an application.”⁶ Professors Schultz and Urban interpret the new law as eliminating the “best mode” requirement.⁷

Priest concludes that under the new law “[t]he best mode requirement has essentially become a legal nullity[.]”⁸

³ Lee Petherbridge & Jason Rantanen, *In Memoriam Best Mode*, 64 STAN. L. REV. ONLINE 125, 126-27 (2012).

⁴ Brian J. Love & Christopher B. Seaman, *Best Mode Trade Secrets*, 15 Yale J. L. & Tech. 1, 3 (2012-2013)(footnote deleted).

⁵ Kayla Fossen, *The Post-Grant Problem: America Invents Falling Short*, 14 Minn. J.L. Sci. & Tech. 573, 585 (2013)(footnote deleted).

⁶ Paul M. Janicke, *Overview of the New Patent Law of the United States*, 21 Tex. Intell. Prop. L.J. 63, 75 (2013).

⁷ Jason Schultz & Jennifer M. Urban, 26 Harv. J.L. & Tech. 1, 22 n.112 (2012)(citing the Leahy-Smith America Invents Act § 15 as “eliminating the ‘best mode’ requirement)(“Until recently, there was *** a ‘best mode’ disclosure requirement.”)

⁸ Chelsea A. Priest, *Certificates of Correction Corrected: Their History and Retroactive Application*, 67 Stan. L. Rev. 961, 972 n.56 (2015)(“The best mode requirement has essentially become a legal nullity, as the America Invents Act did away with lack of a best mode disclosure as grounds for invalidity. Leahy-Smith America Invents Act, Pub. L. No. 112-20, sec. 15(a), §

Noted legislative expert Hayden Gregory concludes that the new law “eliminate[s] failure to comply with the best mode requirement as a defense to infringement[.]”⁹

Dean Holbrook explains that the “best mode” requirement “is rather toothless because failure to disclose the best mode is no longer a basis of invalidating a patent claim.”¹⁰ Professors Janis and Holbrook state that “the best mode requirement arguably has become a dead letter as a result of legislative changes in the America Invents Act.”¹¹

Pollock *et al.* have recognized that there is no best mode requirement for priority for continuations and provisionals, but do not explicitly deal with the different wording for priority based upon a foreign application.¹²

Professor Golden quotes the *Leahy Smith America Invents Act* for the proposition that failure to disclose the best mode [of practicing a claimed

282, 125 Stat. 284, 328 (2011) (codified at 35 U.S.C. § 282(b)(3)) (‘[T]he 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....’)).

⁹ Hayden W. Gregory, *Off and Running with the America Invents Act*, 4 No. 3 *Landslide* 2 (Jan./Feb. 2012).

¹⁰ Timothy R. Holbrook, *The Written Description Gap*, 45 *Loy. U. Chi. L.J.* 345, 347 n.4 (2013) (“The patentee is ... obligated to disclose the best mode of practicing the invention, though this obligation is rather toothless because failure to disclose the best mode is no longer a basis of invalidating a patent claim. See *id.* § 282(b)(3)(A) (providing invalidity as a defense ;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’).”).

¹¹ Mark D. Janis & Timothy R. Holbrook, *Patent Law’s Audience*, 97 *Minn. L. Rev.* 72, 113 (2012). At the end of this passage is a footnote that includes the statement that “[w]ith the enactment of the America Invents Act in September 2011, the best mode requirement is no longer a basis for invalidating or rendering a claim unenforceable.”

¹² Robert A. Pollock, Linda A. Wadler, Robert D. Litowitz, Joyce Craig, Bart A. Gerstenblith, Christina Szakaly, Zhenyu Yang & Mindy L. Ehrenfried, *2011 Patent Law Decisions of the Federal Circuit*, 61 *Am. U. L. Rev.* 785, 884 (2012) (footnotes deleted) (“With passage of the AIA, however, priority applications relied on for benefit of an earlier filing under 35 U.S.C. §§ 119(e) and 120 are made exempt from the best mode requirement.”)

invention] shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable.”¹³

Professor Rogers explains that a “best mode” violation “is no longer a basis for challenging the validity of a patent].”¹⁴

III. A PROBLEMATIC APPARENT END TO THE “BEST MODE”

Remarkably, the requirement for an applicant to set forth the “best mode contemplated” for carrying out his invention *remains* in 35 USC § 112(a) of the patent law while the Congress attempted to strip every method of enforcement of a violation of the requirement against a *patentee*.

Thus, under the new law, *all* patents are immune under the *Leahy Smith America Invents Act* of 2011 from a direct attack on validity based upon a violation of the “best mode” requirement.

Thus, it is expressly stated in 35 U.S.C.A. § 282(b)(3)(A) that “[t]he following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded: ... Invalidity of the patent or any claim in suit for failure to comply with – any requirement of section 112 , except that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid *or otherwise unenforceable...*”35 U.S.C.A. § 282(b)(3)(A)(emphasis added.)

A. Continued “Best Mode” Requirement at the PTO

The Patent Office *continues* to make a “best mode” violation basis for rejection of claims in *ex parte* procurement practice:

¹³ John M. Golden, *Patent Law's Falstaff: Inequitable Conduct, the Federal Circuit, and Therasense*, 7 Wash. J. L. Tech. & Arts 353, 356 n. 10 (2012) (quoting **Leahy-Smith America Invents Act**, H.R. 1249, 112th Cong. § 15 (2011)).

¹⁴ Douglas L. Rogers, *After Prometheus, Are Human Genes Patentable Subject Matter?*, 11 Duke L. & Tech. Rev. 434, 467 n.194 (2013) (“As a result of the passage of the Leahy-Smith America Invents Act, Pub. L. No. 112-29 (2011), the failure to comply with the best mode requirement of § 112 is no longer a basis for challenging the validity of a patent or as part of a post-grant review proceeding.”).

Even though it is clear from the statutory wording of the *Leahy Smith America Invents Act* of 2011 that the “best mode” defense cannot be used as a defense in an infringement litigation or as part of a declaratory judgment action for invalidity, the new law does not make it clear whether *patentability* can be challenged on this basis in an *ex parte* proceeding involving a patent application. Indeed, the Patent Office takes the view that it *can* reject a claim on the basis of a failure to meet the “best mode” requirement:

“Section 15 of the Leahy-Smith America Invents Act (AIA), Pub. L. 112-29, 125 Stat. 284 (September 16, 2011), did not eliminate the requirement *** for a disclosure of the best mode, (see 35 U.S.C. 112(a)) but effective September 16, 2011, it amended 35 U.S.C. 282 (the provision that sets forth defenses in a patent validity or infringement proceeding) to provide 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. As this change is applicable only in patent validity or infringement proceedings, it does not alter current patent examining practices *** for evaluation of an application for compliance with the best mode requirement of 35 U.S.C. 112.”¹⁵

None of the avenues to attack patentability or validity of the *Leahy Smith America Invents Act* of 2011 opens the door to a best mode challenge, whether it is the “preissuance submission by third parties”¹⁶ or procedures for inter partes

¹⁵ MPEP § 2165, *The Best Mode Requirement* [R-11.2013](downloaded from <http://www.uspto.gov/web/offices/pac/mpep/s2165.html#d0e216924>, August 28, 2016).

¹⁶ 35 USC § 122(e)(1)(“Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application[.]”).

review¹⁷ or post grant review.¹⁸ The problematic mode to challenge a patent through a “protest” may be the only avenue left open.¹⁹

¹⁷ 35 U.S.C. 311(b)(“A petitioner *** may request to cancel as unpatentable 1 or more claims of a patent *only* on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.”) (emphasis added).

¹⁸ 35 U.S.C. 321(b)(“A petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).” See 35 U.S.C.A. § 282(b)(3)(A) that makes a 35 U.S.C.A. § 112 violation basis for invalidity “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....”).

¹⁹ **37 CFR §1.291. Protests by the public against pending applications.**

“(a) A protest may be filed by a member of the public against a pending application ****. A protest submitted within the time frame of [§ 1.291](b) of this section, which is not matched in a timely manner to permit review by the examiner during prosecution, due to inadequate identification, may not be entered ****.

“(b) The protest will be entered into the record of the application if, in addition to complying with [§ 1.291(c)], the protest has been served upon the applicant in accordance with § 1.248 , or filed with the Office in duplicate in the event service is not possible; and, except for [§ 1.291(b)(1)], the protest was filed prior to the date the application was published under § 1.211 , or the date a notice of allowance under § 1.311 was given or mailed, whichever occurs first:

“(1) If a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is filed prior to the date a notice of allowance under § 1.311 is given or mailed in the application.

“(2) A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest; or the protest must comply with [§ 1.291(c)(5)]. This section does not apply to the first protest filed in an application.

“(c) In addition to compliance with [§§ 1.291(c) and 1.291(b)], a protest must include:

“(1) An information list of the documents, portions of documents, or **other information** being submitted, where each: * * *

“(v) Item of **other information** is identified by date, if known.

“(2) A concise explanation of the relevance of each item identified in the information list pursuant to [§ 1.291(c)(1)];

If a member of the public provides express notice to a patent applicant that his application is in violation of the “best mode” requirement, is there a duty of disclosure that compels the applicant to bring this information forward to the Examiner?

“(3) A legible copy of each item identified in the information list ***;

* * *

“(d) A member of the public filing a protest in an application under this section will not receive any communication from the Office relating to the protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgement by the Office that the protest has been received. The limited involvement of the member of the public filing a protest pursuant to this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, unless the submission is made pursuant to [§ 1.291(c)(5).

“(e) Where a protest raising inequitable conduct issues satisfies the provisions of this section for entry, it will be entered into the application file, generally without comment on the inequitable conduct issues raised in it.

“(f) In the absence of a request by the Office, an applicant need not reply to a protest.

“(g) Protests that fail to comply with [§§ 1.291(b) or 1.291(c)] may not be entered, and if not entered, will be returned to the protestor, or discarded, at the option of the Office.” (emphasis added).

37 CFR § 1.291 and MPEP § 1901 thus authorize the filing of a *protest* against a pending patent application, but under very limited circumstances that make this an often problematic procedure. Particularly if the applicant consents to such an action, a protest may then be based upon a “best mode” violation. See MPEP § 1901.02, *Information Which Can Be Relied on in Protest* [R-08.2012] (“37 CFR 1.291 is not limited to prior art documents. Protests may be based on any facts or information adverse to patentability. The content and substance of the protest are more important than whether prior art documents, or some other form of evidence adverse to patentability, are being relied on.” * * * The following are examples of the kinds of information, in addition to prior art documents, which can be relied on in a protest under 37 CFR 1.291: * * * (E) Information relating to sufficiency of disclosure or *failure to disclose best mode*, under 35 U.S.C. 112.”)(emphasis added)

B. A Second “New Kawai”²⁰

1. *Kawai*, a Notorious Symbol of Discrimination

“Kawai!”²¹

The *Kawai* case has been a symbol of American discrimination against foreign applicants.²² In essence, if a foreign applicant files first in his “home country” under his local disclosure standard, his American Paris Convention priority application is *denied* priority unless his “home country” application meets the standards for priority under what is 35 USC § 112(a) of the *Leahy Smith America Invents Act* of 2011.

It turns out that, whether deliberately or by accident, the new priority ground rules of the *Leahy Smith America Invents Act* of 2011 create a new priority discrimination: The issue concerns priority based upon an original application, whether the original application is a “home country” overseas priority application under the Paris Convention under 35 USC § 119(a), a parent provisional under 35 USC § 119(e) or a regular parent for continuing application under 35 USC §120. What happens if the original application fails to disclose the “best mode

²⁰ Cf. T. Aoyama, *The Hoechst Case - A New Kawai*, 59 J. PAT. OFF. SOC'Y 263 (1977).

²¹ For the *Kawai* case, see *In re Ziegler*, 992 F.2d 1197, 1200 (Fed. Cir. 1993)(citing *Kawai v. Metlesics*, 480 F.2d 880, 885–89 (CCPA 1973); *Anderson v. Natta*, 480 F.2d 1392, 1399 (CCPA 1973)) (“A foreign patent application must meet the requirements of 35 U.S.C. § 112, first paragraph, in order for a later filed United States application to be entitled to the benefit of the foreign filing date under 35 U.S.C. § 119.”).

²² See Todd R. Miller, *United States Provisional Patent Applications And Paris Convention Priority Rights--“The Same Effect”*, 37 IDEA: J.L. & Tech 161, 177 n. 93 (1996)(citing *In re “Allopurinol,”* 1975 GRUR 131 (German Federal Supreme Court), noted 7 INT'L REV. INDUS. PROP. AND COPYRIGHT L. 105 (1976); *In re Hoechst*, Tokyo High Court (1977); cf. *Alpha-interferons/Biogen*, T 301/87, 1990 O.J. EPO 335, noted 21 INT'L REV. INDUS. PROP. AND COPYRIGHT L. 838 (1990) (creating a legal fiction that broad claims are entitled to priority based upon narrow disclosure); *Snackfood/Howard*, T 73/88, 1990 OJ EPO No. 5, noted 22 INT'L REV. INDUS. PROP. AND COPYRIGHT L. 248 (1991) (elements that are not connected to function and effect of invention are not necessarily essential features for determining priority). See generally T. Aoyama, *The Hoechst Case - A New Kawai*, 59 J. PAT. OFF. SOC'Y 263 (1977) (discussing parallels between the *Hoechst* and *Kawai* cases); L. Walter, *Comment to the Hoechst Case*, 8 INT'L REV. INDUS. PROP. AND COPYRIGHT L. 566, 570 (1977) (Japanese government retaliated by establishing its own unity of invention disclosure standard.”)

contemplated” as of the original filing date? Is there basis for priority under 35 USC §§119(a), 119(e) or 120?

Under the express wording of the statute, to the extent the prior case law governs, priority is *denied* where priority is based upon a “home country” application under § 119(a), but due to statutory wording priority is *granted* for priority based upon a provisional or regular application under §§ 119(e), 120.

2. Conventional Wisdom: Overlooking *Kawai*

It is the conventional wisdom that “the [*Leahy Smith America Invents Act* of 2011] expressly removed the requirement of disclosing the best mode in an earlier application for the purposes of showing entitlement to priority/benefit.”²³

Not so fast.

Until the Federal Circuit decides a test case on point, the question remains open: Where a foreign priority application under the Paris Convention fails to disclose the “best mode contemplated” as of the foreign priority application date, does that failure void the priority right for a United States application?

This remains an open question, despite the fact it is now clear through statutory wording applicable to priority based upon a regular parent (e.g., continuation) or provisional that there is *no violation* in the case of a regular or provisional parent failure to disclose the “best mode contemplated” as of the parent priority application.

Prior to the *Leahy Smith America Invents Act* of 2011 it was clear that priority standards were substantive identical no matter the type of priority application. In each case, priority required that the parent application disclosed the same invention in the manner of what is today 35 USC § 112(a), which includes a disclosure of the best mode contemplated at the time of the parent application. Thus, there was an identical substantive standard used to judge whether priority should be granted

²³ MaCharri Vorndran-Jones, Donna M. Meuth, Tom Irving, Deborah Herzfeld & Stacy Lewis, *Top Five Dangers For The AIA Unwary*, *Landslide*, 5 No. 5 *Landslide* 10, 12 (May/June 2013)(footnote deleted). “[T]he best mode requirement is no longer enforceable.” See also Rochelle C. Dreyfuss, *Percolation, Uniformity, and Coherent Adjudication: The Federal Circuit Experience*, 66 *SMU L. Rev.* 505, 537 (2013).

based upon any form of parent application, whether the parent is a regular (non-provisional) application; a Paris Convention priority application; or a provisional application.²⁴

A statutory loophole in the *Leahy Smith America Invents Act* of 2011 now calls into question whether the “best mode” requirement must *still under the current law* be met for priority based upon a Paris Convention priority parent, while it is now clear under the new law that such disclosure is not required for a parent which is a provisional or “regular” parent (e.g., continuation).

It is thus left for a case of first impression at the Federal Circuit to determine whether Paris Convention priority should be awarded to a United States application where the “home country” priority application fully discloses how to make and use the invention *but fails to disclose the best mode contemplated* as of the priority date.

The uncertainty is created by specific changes in the law to *exclude* the best mode requirement as to a regular continuing application or to an application claiming priority from a provisional, while there is no parallel change to the statutory wording for priority under the Paris Convention:

Prior to the *Leahy Smith America Invents Act* it was clear that for a United States patent to be entitled to priority to an earlier filed application, the earlier filed application was required to meet the disclosure requirements of what is today 35 USC § 112(a). This was true whether the earlier priority application was a regular parent application for a continuation, continuation-in-part or divisional application or a provisional application.²⁵

What puts the issue of priority based upon a Paris Convention priority document is the fact that there is now a *statutory right* to priority based upon either a

²⁴ See *In re Gosteli*, 872 F.2d 1008 (Fed. Cir. 1989)(Paris Convention priority); *In re Ziegler*, 992 F.2d 1197 (Fed. Cir. 1993)(*id.*); *Kawai v. Metlesics*, 480 F.2d 880, 885-89 (CCPA 1973)(*id.*); *Anderson v. Natta*, 480 F.2d 1392, 1399 (CCPA 1973)(*id.*); *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290 (Fed. Cir. 2002)(Michel, J.)(priority based on provisional application).

²⁵ *Trading Techs. Int'l, Inc. v. eSpeed, Inc.*, 595 F.3d 1340 (Fed. Cir. 2010)(Rader, J.)(quoting *New Railhead Mfg. v. Vermeer Mfg.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002)(Michel, J.)), or a Paris Convention foreign priority application, *In re Gosteli*, 872 F.2d 1008 (Fed. Cir. 1989)(Paris Convention priority); *In re Ziegler*, 992 F.2d 1197 (Fed. Cir. 1993)(*id.*); *Kawai v. Metlesics*, 480 F.2d 880, 885-89 (CCPA 1973)(*id.*); *Anderson v. Natta*, 480 F.2d 1392, 1399 (CCPA 1973)(*id.*).

regular parent (e.g., the continuation scenario) or a provisional application, *but not* for a Paris Convention priority application:

Paris Convention Priority (AIA)(§ 119(a))(first sentence): “An application for patent for an invention filed in this country by any person who has *** previously regularly filed an application for a patent for the same invention in a foreign country *** shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country ***.”

Provisional Application Priority (AIA)(§ 119(e)(1)(first sentence): “An application for patent *** for an invention disclosed in the manner provided by section 112(a) (*other than the requirement to disclose the best mode*) in a provisional application filed under section 111(b) *** shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) ***.”

Domestic Application Priority (e.g., continuation) (AIA)(§ 120, first sentence): “An application for patent for an invention disclosed in the manner provided by section 112(a) (*other than the requirement to disclose the best mode*) in an application previously filed in the United States *** shall have the same effect, as to such invention, as though filed on the date of the prior application ***.”

The way to attack a patent where the parent foreign priority document fails to meet the “best mode contemplated” requirement as of the foreign priority date is to find prior art which has an effective date between the priority date and the U.S. filing date, and to use the violation of the best mode requirement as basis to deny priority.

The question remains, despite the clear statutory wording of the law, that there are many who had thought that the best mode requirement was eliminated from the patent law. Professors Petherbridge and Rantanen explain their understanding of the purpose of the revision of the “best mode” requirement:

“When the foreign inventor seeks to secure a patent for her invention in the United States, she may need to rely on the filing date of the application she filed in her home country to avoid prior art that would bar her entitlement to a U.S. patent. Relying on a foreign filing date was possible under U.S. law, but only if the application the inventor filed in her home country included the best mode. Thus, if a foreign inventor did not include a best mode in a foreign-filed application she

could not perfect her priority claim and might be barred from obtaining a patent in the United States. Moreover, if she nonetheless obtained a patent, because, for example, the patent office was unaware of the defect, its claims could be invalidated if challenged in litigation. Commentators long imagined that this chain of events affected a substantial margin of foreign inventors.

“The America Invents Act reflects Congress's desire to protect foreign inventors from this eventuality. It both strips courts of the power to declare patents either invalid or unenforceable for failure to disclose a best mode and gives foreign inventors a right of priority in their foreign-filed applications that is exempt from a requirement to disclose the best mode. The Act practically eliminated best mode from patent law because the failure to disclose it no longer holds any substantive legal consequences.” Lee Petherbridge & Jason Rantanen, *The Pseudo-Elimination of Best Mode: Worst Possible Choice?*, 59 UCLA L. Rev. Discourse 170, 171-72 (2012)(footnotes omitted).

The coauthors explain that “[t]o help foreign applicants that are supposedly disadvantaged by the substantive effects of best mode, Congress developed a right of priority in foreign- filed applications exempt from the [best mode] requirement.” Petherbridge & Rantanen, 59 UCLA L. Rev. Discourse at 173.

3. What Really Happened? Legislative History

The question may then be asked, was the failure to include a specific reference to the best mode requirement in terms of foreign priority an accidental or was the failure deliberate? There is a paucity of prospective legislative history to explain precisely why Congress failed to treat the requirement for priority based upon a foreign application differently than in the case of domestic priority.

There *is* prospective legislation history in the sense that there is an implicit assumption from the remarks of the legislators that the proposed statutory wording would eliminate the best mode requirement as basis to invalidate a patent. Indeed, in the weeks running up to the final enactment of the *Leahy Smith America Invents Act* of 2011 the “best mode” issue comes up several times. There was discussion in the *Congressional Record* of the “best mode” requirement and how this requirement was written out of the patent law through the text of the new law. But, this discussion nowhere focused upon the fact that the literal wording of the

proposed revisions to the law failed to take into account the requirement for disclosure of the “best mode” in a foreign priority application.²⁶

While *prospective* comments leading up to the enactment of legislation are properly considered as legislative history, *after* the law has been enacted, subsequent comments are *not* a part of the legislative history; they are pejoratively given the term “subsequent legislative history”; such *faux* legislative history is given little if any weight in the interpretation of a statute

To be sure there is “*subsequent* legislative history” but this is given little if any weight in the interpretation of a statute.²⁷

²⁶ There *was* a discussion about requirements for a *provisional* parent priority application (but not a foreign priority application). See *Leahy-Smith America Invents Act*, 157 Cong. Rec. S5402-02, S5431 (Sept. 8, 2011)(Remarks of Sen. Kyl)(“In remarks appearing at 157 Cong. Rec. S1095 (daily ed. March 2, 2011), it was suggested that a provisional application filed under the first-to-file system will be vulnerable to an attack that the inventor failed to disclose the best mode of the invention. This is incorrect.”). There was also a statement that the proposed law would eliminate the “best mode” issue as a defense to patent litigation. *Patent Reform Act of 2011*, 157 Cong. Rec. S1360-02 (March 8, 2011)(summary of the legislation)(“As part of a patent application, an applicant must disclose the ‘best mode’ for carrying out his or her invention. In subsequent litigation an accused infringer can offer as a defense that the best mode was not properly disclosed by the patent holder. *This section eliminates that defense*, which many consider subjective and possibly irrelevant, as the best mode may change over time. Best mode disclosure remains a requirement for patentability.”)(emphasis added). There was also a blanket statement that under the legislation that the best mode issue could not be used in a post-grant proceeding. See speech of Mike Pence, *America Invents Act*, 157 Cong. Rec. E1174-04, E1174 (June 23, 2011)(extension of remarks)(“American 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. *** “I am pleased that the bill before us *** only retains best mode as a specifications requirement for obtaining a patent. Once the examiner is satisfied that the best mode has been disclosed, the issue is settled forever. Going forward, *best mode cannot be used as a legal defense to infringement in patent litigation or a basis for a post-grant review proceeding.*”)(emphasis added). There is also blanket statements that the “best mode” requirement could never be used in a patent litigation. See *Leahy-Smith America Invents Act*, 157 Cong. Rec. S5402-02, S5431 (Sept. 8, 2011)(Remarks of Sen. Kyl)(“Section 15 of this bill precludes the use of the best-mode requirement as a basis for cancelling a claim or holding it invalid.”).

²⁷ *Solid Waste Agency Of Northern Cook County v. United States Army Corps Of Engineers*, 531 U.S. 159, 169 n.5 (2001)(quoting *Consumer Product Safety Commission v. GTE Sylvania, Inc.*, 447 U.S. 102, 118 n.13 (1980) (“[E]ven when it would otherwise be useful, subsequent legislative history will rarely override a reasonable interpretation of a statute that can be gleaned from its language and legislative history prior to its enactment.”); *Consumer Product Safety Comm’n v. GTE Sylvania, Inc.*, 447 U.S. 102, 118, n. 13 (1980) (“[E]ven when it would

A primary example of subsequent legislative history is provided by Robert A. Armitage, a principal author of much of the *Leahy Smith America Invents Act of 2011* states that the omission was *deliberate*:

“While it was not within the realm of the politically possible for Congress to simply repeal the ‘best mode’ requirement, any reading of the AIA confirms that Congress was fully aware of the absurdity of retaining any vestige of this requirement in the new law. It reached this conclusion for good reasons.

“The National Research Council of the National Academies of Science had urged abolition of the “best mode” requirement. Every major IP bar and trade organization supported outright repeal of the requirement. Patent reform bills dating back to the 109th Congress contained provisions to abolish the requirement. Nonetheless, for reasons that may not be subject to rational explanation, Congress elected to keep the requirement, at least nominally, but then render the requirement meaningless in any proceeding in which the issue of compliance with the “best mode” requirement might arise.

“Thus, while the ‘best mode’ requirement must be observed – for both compliance reasons and practical reasons – the AIA renders it otherwise a dead letter. Congressional savaging of the ‘best mode’ requirement took the following forms.

“First, the express portions of the patent statute that once required a “best mode” disclosure in order to secure priority or benefit from an earlier patent filing have been repealed. In § 119(e)(1) and § 120 of the patent statute, the respective provisions relating to priority from an earlier U.S. provisional patent filing and benefit from an earlier-filed U.S. nonprovisional patent filing have both been amended. Before the amendment, questions of priority-benefit of the earlier filing date of a provisional or nonprovisional patent filing required full compliance with the ‘written description,’ ‘enablement,’ and ‘best mode’ requirements now found in § 112(a). Congress acted in the AIA by striking this reference to ‘the first paragraph of section 112 of this title’ and inserting in its place ‘section 112(a) (other than the requirement to disclose the best mode).’ Thus, priority or benefit from an earlier U.S. patent filing will no longer require that the earlier filing contain a ‘best mode’ disclosure.

otherwise be useful, subsequent legislative history will rarely override a reasonable interpretation of a statute that can be gleaned from its language and legislative history prior to its enactment”).

“Second, this change will similarly impact the right to obtain priority from earlier foreign patent filings, for which the issue of priority arises under § 119(a). *Congress was aware that § 119(a) has never contained an explicit requirement for a § 112-type disclosure in order for an inventor to be entitled to priority, thus Congress had nothing to repeal or revise in order to ensure that no ‘best mode’ requirement would continue.*

“While Congress did not impose a ‘best mode’ condition for priority in § 119(a), the courts have done so – but on the sole ground that the reading-in of such a requirement was for ‘symmetry’ – to ensure that all §119 and §120 priority/benefit issues would be determined on a level playing field.³⁴⁸ Thus, by changing the rules for entitlement to benefit of an earlier patent filing in the United States (i.e., the § 119(f) and § 120 amendments), *Congress has sub silentio accomplished the same result for § 119(a) priority issues.*”²⁸

The most involved Congressional staff member working on the patent reform legislation at the time, Joe Matal, provides a further example of subsequent legislative history complementary to what Armitage has stated. Matal agrees that the failure to amend the best mode requirement out of the statutory wording relating to foreign priority was deliberate.²⁹

Matal says that:

“AIA [] does not repeal the best-mode requirement from § 119(a). This is because there is no best-mode language in § 119(a) to repeal. The courts have sought ‘to preserve symmetry of treatment between sections 120 and 119,’ and since pre-AIA § 120 expressly required best-mode disclosure in a domestic parent application, § 119(a) was read to also require such disclosure in a foreign application. Now that the best-mode requirement has been repealed from § 120, however, the same ‘symmetry’ rationale requires that best mode be read out of § 119(a) as well.”³⁰

²⁸ Robert A. Armitage, *Understanding the America Invents Act and its Implications for Patenting*, 40 AIPLA Q.J. 1, 88-89 (2012)(emphasis added; footnotes deleted).

²⁹ See Joe Matal, *A Guide to the Legislative History of the America Invents Act: Part II Of II*, 21 Fed. Circuit B.J. 539, 584 (201)(footnotes omitted).

³⁰ *Id.*

IV. LEGISLATIVE FIX TO ABOLISH AN ARCANE REQUIREMENT

There is no policy reason to continue the arcane to disclose the “best mode” when there are minimal ways to enforce the requirement, and when there is unnecessary friction created with international trading partners through the obvious anti-foreigner discrimination of the law.

Proposed legislation to remove the “best mode” requirement from the statute is attached as an appendix.

V. CONCLUSION

Given the clear statutory wording of the *Leahy Smith America Invents Act* of 2011, coupled with the absence of *prospective* legislative history to the contrary, it is difficult to express optimism as to how a test case would – or will – end up to determine whether or not priority determinations are made under a common standard. Given the simplicity of a legislative fix, it would be useful for Congress to remove the ambiguity and adopt the legislative discussion of Matal and Armitage.

APPENDIX: A LEGISLATIVE PROPOSAL

115TH CONGRESS
1ST SESSION

H. R. _____

To amend title 35, United States Code, to clarify the best mode disclosure requirement for patents, and for other purposes.

IN THE HOUSE OF REPRESENTATIVES/SENATE
_____, 2017

Mr./Ms. _____ introduced the following bill; which was referred to the Committee on the Judiciary

A BILL

To amend title 35, United States Code, to clarify the disclosure requirements for patents, and for other purposes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

SECTION 1. SHORT TITLE.

This Act may be cited as the “Best Mode Clarification Act of 2017”.

SEC. 2. BEST MODE.

(a) In Title 35, Section 112(a), delete “, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention”

(b) In Title 35, Section 119(e)(1), delete “(other than the requirement to disclose the best mode)”.

(c) In Title 35, Section 120, delete “(other than the requirement to disclose the best mode)”.

In Title 35, Section 282(b)(3)(A), delete “, 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”

SEC. 3. EFFECTIVE DATE. This bill shall become effective upon enactment and apply to any patent issued, or application for patent filed, before, on, or after the date of enactment, except for a civil action commenced before September 16, 2011.

Changes in the Text of Title 35

(as amended; deletions underlined in brackets)

35 U.S.C. 112 Specification.

(a) IN GENERAL.—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 or joint inventor of carrying out the invention*]. * * *

35 U.S.C. 119 Benefit of earlier filing date; right of priority.

* * *

“(e)(1) An application for patent filed under section 111(a) or section 363 for an invention disclosed in the manner provided by section 112(a) [*other than the requirement to disclose the best mode*] in a provisional application filed under section 111(b) , by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) ****.”

35 U.S.C. 120 Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by section 112(a) [*other than the requirement to disclose the best mode*] in an application previously filed in the United States, or as provided by section 363 or 385 which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. * * *

35 U.S.C. 282 Presumption of validity; defenses.

* * *

(b) DEFENSES.—The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

• * * *

(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*] * * *.

BLOWBACK: RESPONSE TO THIS PAPER .

There appears to be no argument against overall repeal of the “best mode” requirement. Issue is taken, however, as to whether, if the best mode requirement is maintained, a specific statutory exclusion should be made for priority based upon a foreign application that lacks a disclosure of the “best mode”.

The question is thus: Is it necessary that there should be a specific statutory exclusion for foreign priority such that the foreign priority application does not need to meet the “best mode” requirement?

As to this question, in the first instance, there is the question of *fairness*. This is discussed in the following section, *Whether there is a Violation of the Spirit of TRIPS*. This leads to a second question in the ensuing section, *Does the Foreign Applicant Receive TRIPS-Compliant Equal Treatment?*

According to an expert, there is no need for special language because of the statutory scheme, as explained in the final section, *The Argument that No Specific Statutory Wording is Necessary*.

WHETHER THERE IS A VIOLATION OF THE SPIRIT OF TRIPS

A further question is raised as to whether there is fair “national treatment” for the foreign applicant due to the different requirements within 35 USC § 119. In other words, as seen from the comparison at page 14 (reproduced in the next two paragraphs) a priority claim based upon a *foreign* priority document under § 119(a) is *denied* if the parent lacks a disclosure of the “best mode contemplated”; but a priority claim based upon a *domestic*, provisional priority document under § 119(e)(1) is *granted* where the parent lacks a disclosure of the “best mode contemplated”, if one looks, *in vacuo*, only at this one portion of the statute:

Paris Convention Priority (119(a))(first sentence): “An application for patent for an invention filed in this country by any person who has *** previously regularly filed an application for a patent for the same invention in a foreign country *** shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country ***.”

Provisional U.S. Priority (§ 119(e)(1)(first sentence): “An application for patent *** for an invention disclosed in the manner provided by section 112(a) (*other than the requirement to disclose the best mode*) in a provisional application filed under section 111(b) *** shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) ***.”

**DOES THE FOREIGN APPLICANT RECEIVE
TRIPS-COMPLIANT EQUAL TREATMENT?**

This is a question not raised in the original paper.

This further question is thus whether unequal treatment is consistent with at least the spirit (if not the letter) of TRIPS Article 3 (national treatment). In that Article, the TRIPS says that as to the rights of a foreign national of a TRIPS country, “[e]ach Member [State] shall accord to [such foreign national] *** treatment no less favourable than that it accords to its own nationals with regard to the protection of intellectual property ***.”

**THE ARGUMENT THAT NO SPECIFIC STATUTORY
WORDING IS NECESSARY**

An expert makes the argument that the statutory exclusion found for priority keyed to a domestic provisional application is unnecessary for a foreign priority application.

This is how the argument goes:

“On the § 119(a) issue, a[] good explanation of the reasoning behind the decision not to amend this subsection as part of the AIA is found in <https://1drv.ms/b/s!AkrOxHFGW3YVgdc8XwkwvruogWFyIlg> at p. 84:

“Congress did not repeal the best-mode requirement in §119(a) because there was no such language to repeal in §119(a). Best-mode disclosure in the parent application was expressly required in §120, and the courts simply concluded that ‘to preserve symmetry of treatment between sections 120 and 119,’ *In re Jacques Gosteli*, 872 F.2d 1008, 1011 (Fed. Cir. 1989), best mode should also be required to be disclosed under §119(a). See *Standard Oil Co. v. Montedison, S.p.a.*, 494 F. Supp. 370, 387-88 (D. Del. 1980). That same ‘symmetry’ rationale, of course, now compels that the ‘best mode’ requirement be read out of §119(a) as well. Indeed, *** this result is effectively compelled by the text of §119(a) itself.

“Subsection (a) provides that the foreign priority application ‘shall have the same effect as the same application would have if filed in this country.’ Because of the AIA’s amendments to §120, a parent application that fails to disclose the best mode nevertheless can entitle the applicant to the benefit of filing date of that parent application. And §119(a) expressly requires that an identical foreign-filed application ‘shall have the same effect’ as that U.S.-filed parent application. By the very words of §119(a), therefore, if the domestic parent application would entitle the applicant to its filing date, the foreign-filed application must as well.

* * * “Note also that *Transco*, 38 F.3d 551 (Fed. Cir. 1994) cites *Gosteli*, with approval at fn 7:

“ ‘In *In re Gosteli*, 872 F.2d 1008, 1011 (Fed.Cir.1989), this court stated:

“ ‘Section 119 provides that a foreign application ‘shall have the same effect’ as if it had been filed in the United States. 35 U.S.C. Sec. 119. Accordingly, if the effective filing date of what is claimed in a United States application is at issue, to preserve symmetry of treatment between sections 120 and 119, the foreign priority application must be examined to ascertain if it supports, within the meaning of section 112, p 1, what is claimed in the United States application.”

“If *Gosteli* were to be decided on the same rationale after the AIA took effect, the ‘shall have the same effect’ language should presumably produce the opposite result with respect to a “best mode” disclosure—there would seem to be no reason for § 119(a) to impose a non-statutory requirement with respect to an issue of priority that would be inapplicable to the issue of benefit.”