

## THE BEST MODE REQUIREMENT UNDER 35 U.S.C. 112: BEFORE AND AFTER THE AMERICA INVENTS ACT

### The Best Mode Requirement Before the America Invents Act

By: William G. Kratz, Jr.

**T**he U.S. Court of Appeal for the Federal Circuit (CAFC) case of *Ateliers de la Haute-Garonne v. Broetje Automation USA Inc.*, decided on May 21, 2013, among other claims, included a patent infringement charge of U.S Patent Nos. 5,011,339 and 5,143,216. The claimed invention is a process and an apparatus for dispensing objects (such as, rivets) through a pressurized tube having grooves so as to provide a rapid and smooth supply of rivets for use in manufacturing.

The U.S. District Court granted summary judgment for the defendants on the basis that the claims were invalid for failing to disclose the best mode of carrying out the invention under 35 U.S.C. §112, first paragraph.

The issue on best mode related to the number of grooves in the tube. The specification showed three grooves. During trial testimony, the need for an odd number of grooves was declared, but the patent did not say that an odd number of grooves was best. The district court referred to the testimony and noted that the patents did not state that an odd number of grooves was better than an even number, and that the identification of a lone embodiment sharing a trait with the inventor's best mode is insufficient to satisfy the best mode requirement.

While the best mode requirement does not permit an inventor to disclose only what he knows to be his second-best embodiment, retaining the best for himself, **the requirement is that a best mode violation requires intentional concealment of a preferred embodiment.**

Since, at the time the patent application was filed, the three-groove tube was the preferred embodiment, there was no intentional concealment of a better mode and the CAFC reversed the invalidity decision of the district court.

**Decision:** The CAFC reversed the invalidity finding and stated that a violation of the best mode requirement requires intentional concealment and that an innocent or inadvertent failure to disclose does not invalidate a patent. The court found that, at the time the patent application was filed, the inventors primarily used a three-groove tube, and that there was no evidence of intentional concealment of a better mode than was disclosed.

**The Best Mode Requirement After the America Invents Act****By: Darren R. Crew**

A question is raised as to what effect the America Invents Act (AIA) will have on future infringement cases involving best mode. Before the AIA, patent applicants were required to disclose a best mode in the specification, and courts could declare claims invalid during patent litigation for failure to disclose the best mode.

**After the AIA, patent applicants are still required to disclose a best mode in the specification, pursuant to 35 U.S.C. §112, first paragraph, but failure to disclose the best mode is not a defense in litigation involving validity or infringement of a patent (35 U.S.C. §282(b)(3)(A)).** Thus, after the AIA, courts do not have the power to cancel a claim, hold a claim invalid, or hold a claim unenforceable, based on a failure to disclose the best mode.

As discussed above, in the case of *Ateliers de la Haute-Garonne v. Broetje Automation USA Inc.*, the district court applied the pre-AIA law and held, for the defendants, that the claims were invalid on the basis that the best mode was not disclosed. **The post-AIA law, to the contrary, indicates that failure to disclose the best mode shall not be a basis on which any claim may be canceled, held invalid, or held unenforceable.**

**Summary:** After the AIA, even though patent applicants are required to disclose a best mode in the specification, failure to disclose the best mode is not a defense in invalidity litigation or infringement litigation.

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