What's Left of "Best Mode" After Patent Reform?

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Effective September 16, 2011, Section 15 of the Leahy-Smith America Invents Act modifies the requirement that patent applications disclose the "best mode" of performing the claimed invention. Section 15 eliminates challenges to best mode in litigation and expressly removes the requirement for "earlier filed" applications, which include priority applications and continuation-in-part applications.

Eliminating best mode challenges may reduce the cost of patent litigation. However, it remains to be seen whether such challenges may emerge under a different guise, such as inequitable conduct or a similar principle.

Elimination of the best mode requirement in earlier-filed applications affects applications claiming priority to provisional applications, applications filed as continuation-in-part applications, and national stage applications claiming priority to international PCT applications. This change permits the best mode to be disclosed in the subsequent application without risk of invalidity based upon a failure to disclose the best mode in the earlier-filed application, while appearing to reaffirm that the best mode requirement still remains.

Some patent practitioners have opined that these changes eliminate the best mode requirement and that applicants can now file applications without concern about disclosing it. That approach should not be considered without weighing the ethical issues it may raise, as well as the risks attendant to the new Post Grant Review process. For now, the conservative approach for applicants is to continue to comply with the best mode requirement, but with the knowledge that a potential litigation challenge to the validity of their patents has been eliminated.