

## THE PUBLIC'S RIGHT TO KNOW? OR A RED-TAPE NIGHTMARE? DEMANDING THAT BEST MODE DISCLOSURE BE UPDATED [n.1]

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### I. INTRODUCTION

Patent law has been described as a contract; however, unlike most contracts, the patent law contract is a social one. [n.3] Any social contract \*262 involves an enormous amount of public policy -- the patent law contract is no different. [n.4] And like all public policies, the interests of all the parties must be weighed and balanced against one another. [n.5] The only problem with all this theoretical "balancing" is just that -- what, in theory, looks good on paper may not always be "ideal" in reality. [n.6]

This abstract paradox is epitomized in the recent judicial fiasco surrounding Transco Products, Inc. v. Performance Contracting, Inc. [n.7] In Transco, the court weighed the rights of the inventor against those of the public, and the public won. [n.8] However, in the aftermath of the decision, reality has reared its ugly head. [n.9] The issue has thus become which of two worlds should prevail - absolute principle or absolute pragmatism.

\*263 In principle, the inventor who creates is rewarded by a patent, and the public learns from this patent. [n.10] Thus, ideally, the patent law system works on incentives and rewards. [n.11] The inventor works diligently, researching and developing, to create something new and useful. [n.12] He is rewarded by a seventeen year patent. [n.13] The public, in exchange for a limited "monopoly," receives a product or process, but more importantly, an increase in knowledge. [n.14] From this increase in knowledge, the patented invention can be improved upon, or entirely new inventions can be created. [n.15] Thus, progress spirals upward, not downward. [n.16]

In reality, the inventor can choose not to obtain a patent at all, but keep his invention a trade secret. [n.17] In doing so, the public gains no knowledge, and progress is at a standstill. [n.18] Many reasons exist which affect the decision of whether to protect an invention by trade secret or by patent. [n.19] One factor which weighs heavily on all but the most dedicated inventors is the incredible amount of money, time, and energy which will be spent in \*264 even trying to obtain a patent, let alone defend one. [n.20] Like the 400-meter relay hurdles, but with only two runners, the inventor must overcome many obstacles before he can even pass on the baton (the invention) to his partner (the lawyer) who will have to overcome more obstacles before crossing the finish line (obtaining the

patent). [n.21] These obstacles consist of both substantive and procedural statutory requirements. [n.22]

One of the procedural statutory requirements concerns the full disclosure of the invention according to 35 U.S.C. § 112. [n.23] In particular, the inventor must disclose: 1) a written description of the invention "distinctly claiming the subject matter which the applicant regards as his invention"; 2) in sufficient detail as to enable [n.24] one skilled in the art to make and use; and 3) \*265 carry out the invention in the best mode contemplated [n.25] by the inventor. [n.26] This article focuses on updating best mode disclosure in continuation and continuation-in-part applications, foreign applications, and reissue applications. [n.27] Public policy and applicable case law will be discussed. An attempt will be made to reconcile these precedents with public policy. Potential problems and possible solutions will be discussed in conjunction with recent case law demanding that best mode disclosure be updated.

## \*266 II. PUBLIC POLICY

The United States Constitution grants Congress the authority "to 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." [n.28] From this constitutional mandate, the First Congress enacted the progenitor to the patent law system over 200 years ago. [n.29] With respect to disclosure, the Patent Act of 1790 required the inventor to specify his invention with enough particularity to distinguish his invention from previous ones and to enable one skilled in the art to make, construct, or use the same. [n.30] The statute also provided a defense to infringement if the inventor, for the purpose of deceiving the public, did not specify the "whole truth" concerning the invention. [n.31]

Three years later, the Patent Act of 1793 kept the "whole truth" defense, but added the requirement that the inventor disclose the several modes contemplated by him in applying the principle behind the invention. [n.32] The United States Supreme Court over 165 years ago in *Pennock v. Dialogue* [n.33] expounded upon this statute with respect to disclosure:

While one great object was, by holding out a reasonable reward to inventors, and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius; the main object was "to promote the progress of science and useful arts" and this could be done best, by giving the public at large a right to make, construct, use and vend the thing invented, at as early a period as possible; having a due regard to the rights of then of the inventor. If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; . . . it would materially retard the progress of science and the useful arts . . . . [n.34]

\*267 In essence the Patent Act of 1793 has remained intact in all its glory. [n.35] The only material changes have been that of the inventor having to disclose "several modes"

of carrying out the mechanical invention to the disclosure of only the preferred or "best mode" [n.36] contemplated by the inventor in carrying out the invention. [n.37]

The Patent Act of 1793 has remained intact because the public policy behind the patent law system has provided a level, solid foundation. [n.38] In a recent guest appearance [n.39] into the patent judicial system, the United States Supreme Court provided an emphatic synopsis of public policy:

The Patent Clause itself reflects a balance between the need to encourage innovation and the avoidance of monopolies . . . . The federal patent system thus embodies a carefully crafted bargain for encouraging the creation and disclosure of new, useful, and nonobvious advances in technology and design in return for the exclusive right to practice the invention for a period of years. . . . Moreover, the ultimate goal of the patent system is to bring new designs and technologies into the public domain through disclosure. [n.40]

### III. APPLICABLE CASE LAW

Precedent indicates that best mode is measured as of the filing date. [n.41] If the inventor adequately discloses the best mode known at this time, no \*268 statutory duty exists to update this application. [n.42] Taken literally, then, whenever one files, the best mode must be disclosed. This is the viewpoint of those courts sticking to their principles - the "principled" courts. [n.43] The courts desiring to "waive" this best mode requirement have created the legal fiction that dependent applications are one continuous application, accorded the filing date of the original application. This is the viewpoint of the "real" or pragmatic courts. [n.44]

#### A. THE "PRINCIPILED" COURTS

If the goal of patent law is to "bring new designs and technologies into the public domain through disclosure," then those same principles applicable to disclosure should also be applicable to updating disclosure, which, of course, encompasses updating best mode disclosure. [n.45] And that is exactly the viewpoint taken by the "principled" courts. These courts stand firm, unfettered by the winds of reality, demanding full disclosure with the filing of any application because to hold otherwise would contradict the most basic \*269 principle: a patent is the antithesis of a trade secret. These "principled" courts are essentially acting in the best interests of the public, and, no matter what the costs, feel it is their duty to ensure that the public receives the consideration it has coming to them in the "patent bargain."

#### 1. THE DEFENDANT'S ARGUMENT IN GODFREY v. EAMES [n.46]

The Godfrey Court was the first to interpolate statutory requisites in conjunction with a continuation application. [n.47] Today's courts are not breaking any new ground -- the

"principled" courts follow the logic of the defendant's argument; the "real" courts follow the majority opinion's argument. The defendant argued that a continuation application is a statutorily independent application; [n.48] the majority held a continuation application is statutorily dependent on its original application. [n.49]

The defendant, per Mr. Brooks, argued:

[A]pplication papers are retained in the Patent Office, and further proceedings to obtain a patent require new papers, differing from former ones at least in time of execution and filing, and also perhaps presented to officers not before having acted in the matter, a first application cannot, in the nature of things, be the second, nor a second be also the first. [n.50]

\*270 The defendant's rationale is interesting, and one not explicitly afforded any weight by the "principled" courts - all the weight they need is that of principle/public policy. The defendant reasoned that allowing a continuation application to be accorded the original application's filing date could prolong the term of the patent prescribed by law, and "if this view of the law is sanctioned by this court, it becomes the interest of inventors to delay the grant of patents as long as possible by this very method, in order to prolong the term of enjoyment." [n.51]

## 2. THE TRANSCO DECISION

Side-stepping Godfrey and down-playing Sylgab, in principle, the Transco decision is, still, analytically sound. [n.52] Not only does the Transco court overlook any potentially applicable legal precedent set by Godfrey, but it even goes so far as to use this exact, potentially adverse precedent to allay those fears set out in Sylgab. [n.53]

In holding that an inventor is required to disclose any intervening best mode information, [n.54] the Transco court cited Godfrey in order to establish that: 1) a continuation application does not have to be identical to the original application and 2) changes in the specification which merely amend the original invention cannot affect the sufficiency of the original \*271 application. [n.55] Therefore, the court reasoned, information "that really explains rather than expands the nature and scope of the originally claimed invention" is indeed a continuation application entitled to the original application's earlier filing date. [n.56] As such, "it [is] abundantly clear that the concern expressed in Sylgab is really a non-issue" because disclosure of such a mode does not introduce new matter, [n.57] precluding any possibility of converting the application into a continuation- in-part. [n.58]

Almost as if the court realized its audience was becoming dizzy, the court clarified its stance, "What all of this comes down to is that there is no analytic reason that Sections 112 and 120 cannot coexist or, to put it differently, that the policy that informs Section 120 should trump the policy that informs Section 112." [n.59] And fearful that this statement may not be in plain English, the court added:

[T]he point is that, after all, a continuation application is a new filing that involves representations to the Patent and Trademark Office. As with every such representation, it ought to be truthful. And that being so, it is entirely appropriate to apply to those representations the policy that Congress enacted into law in Section 112: Absent express statutory or controlling precedent stating otherwise, this Court is constrained to impose the same best mode disclosure requirements on a continuation application as on an original filing. [n.60]

As the last quotation makes reference, the Transco court wisely narrowed the inventor's obligation from requiring the inventor to update any and all new information whenever it becomes known to requiring the inventor to update best mode information whenever a filing occurs. [n.61] The court likened "the situation to the responsibilities of a signing party under Rule 11 . . . : There is no obligation to correct statements that were in compliance with \*272 that Rule when made, but every new filing must speak the truth currently." [n.62]

#### \*273 B. THE "REAL" COURTS

In extreme juxtaposition to these "principled" courts are those courts, one could say, which are living in reality. "Real" courts are concerned with placing too heavy a burden on the patent system as a whole - from invention to prosecution to litigation. These "real" courts determine if the application can be considered a new application, which must meet all statutory disclosure requirements, [n.63] or part of the original application. [n.64]

These courts look to the "species" of the application to determine the application's status, i.e., either new or part of the original. The possible species are: continuation, continuation-in-part (Section 120), foreign (Section 119), and reissue (Section 251) applications. [n.65] Dependent applications which are usually considered to be part of the original application are continuation and reissue applications, because no new matter [n.66] is introduced. [n.67]

#### \*274 CONTINUATION AND REISSUE APPLICATIONS:

##### 1. THE MAJORITY'S OPINION IN GODFREY

With respect to continuation applications, the majority's opinion in Godfrey states the same argument as those opposed to mandated disclosure in Section 120 applications: 1) that early disclosure is desired; [n.68] 2) a right [n.69] to amend this disclosure exists; [n.70] and 3) any mere amendments of the substance of the invention originally claimed that have no adverse legal consequences "are to be considered as parts of the same transaction, and both as constituting one continuous application, within the meaning of the law." [n.71] Over one hundred years later, the court in Sylgab employed this same rationale to come to its decision. [n.72]

## 2. THE SYLGAB DECISION

In essence, the Sylgab court merely echoed the rationale of Godfrey; however, the court appeared to have been influenced by the faulty logic of the defendant's counsel. [n.73] The Sylgab court reasoned: 1) no statutory duty exists to impose the burden of updating a pending application; [n.74] 2) an inventor who has a preferred or best mode of carrying out the invention and has disclosed this information in the pending application has met all statutory disclosure requirements [n.75] since; 3) a continuation application is legally the same application as the pending application. [n.76]

\*275 The defendant's counsel argued that an inventor does have an obligation to update best mode disclosure in the form of filing a continuation- in-part application, thus complying with Section 112 while preserving the original filing date. [n.77] The Sylgab court correctly chastised this erroneous logic [n.78] and put salt in the wounds of the defendant. [n.79]

Employing the same public policy argument the "principled" courts thrive on, the court quoted Judge Rich, "Manifestly the sole purpose of this [best mode] requirement is to restrain inventors from applying for patents while at the same time concealing from the public preferred embodiments of their inventions which they have in fact conceived." [n.80] Adding even more salt, the court made a passing reference in a mere footnote that the inventor did not conceal anything; "indeed, he described it fully in his affidavit accompanying the continuation application." [n.81] And while the wound was still stinging, the court stated, "that there is no statutory basis for insisting that 'the mode disclosed be in fact the optimum mode of carrying out the invention,'" quoting Judge Rich again. [n.82]

A distinct and quite possibly the "real" reason why the Sylgab court held as it did is due to the inevitable burden the defendant's contention would impose upon the inventor - "to uphold defendant's contention in effect would be to require inventors to amend their pending patent applications each time an improved embodiment of the invention is discovered." [n.83] Again, this fear appears to be based upon the faulty argument by the defendant - if there is a "principled" argument to be made, it is to impose this obligation to update only when the inventor files with the PTO, as argued in Transco. [n.84]

### \*276 3. DOW CHEMICAL CO. v. AMERICAN CYANAMID CO. [n.85]

In Dow Chemical, Cyanamid argued that the Dow patents were invalid for failure to disclose the best mode discovered in the interim. [n.86] Cyanamid argued that Dow knew of problems with polymer formation within the reactor and learned how to eliminate them by maintaining a high linear velocity of fluid through the reactor. [n.87] The court however, rejected this argument by holding that the best mode does not need to be

updated in a reissue application because no new matter is permissible in reissue applications. [n.88]

#### CONTINUATION-IN-PART APPLICATIONS:

New matter is introduced into a continuation-in-part application, [n.89] thus, it is not usually considered to be a continuation of the original application.

#### 4. JOHNS-MANVILLE CORP. v. GUARDIAN INDUS. CORP. [n.90]

Johns-Manville may be considered a compromise position in demanding that best mode disclosure to be updated. [n.91] The court cited Sylgab for the general proposition that no obligation exists to update continuation applications "because the continuation made only minor technical and clerical changes." [n.92] However, the Johns-Manville court suggested that an \*277 applicant would be obligated to disclose a refinement "if it were essential to the successful practice of the invention, and if it related to amendments to the continuation-in-part which were not present in the parent application." [n.93]

#### FOREIGN APPLICATIONS:

Even though an application dependent on a foreign filing date usually contains no new matter, [n.94] courts hold that a foreign application can be considered either status. Those courts holding that a foreign application is a new application use the rationale that only those applications filed in the United States can be considered an original "parent" application entitling later dependent applications to its filing date. [n.95]

#### 5. STANDARD OIL v. MONTEDISON, S.p.A. [n.96]

In Standard Oil, Phillips Petroleum argued that Montedison had discovered a better catalyst during the interim period between its foreign filing and American filing, and that it should have disclosed this improvement in its Section 119 American application. [n.97] Phillips argued that the phrase "the \*278 same application" in Section 119 refers to "the subsequent American application"; therefore, compliance with the best mode requirement of Section 112 is to be measured as of the date of the American filing. [n.98] The court clearly stated that this is not the law, "Phillips' argument nevertheless ignores the clear language of the statute, which provides that the effective date of the subsequent American application is the date of Montedison's Italian filing." [n.99]

#### IV. A RECONCILIATION? THE NEW MATTER LINCHPIN?

An experienced traveler is given solace knowing that he at least has a compass while "lost" in a jungle. As such, an attempt will be made to harmonize the above cases. With the exception of Section 119 foreign priority applications, [n.100] the proverbial "North" may be that of "new matter." [n.101]

\*279 Transco makes it evident that Sylgab feared the introduction of a "new" best mode requirement might convert a continuation application into a continuation-in-part application, thereby denying the inventor the original application's earlier filing date. [n.102] Transco's solution -- that information which explains rather than expands is not new matter -- appears to legitimately preserve Section 120's early disclosure policy with Section 112's full disclosure policy. [n.103] Johns-Manville, decided before Transco, appears to give weight to this "new matter" harmonization. [n.104]

Johns-Manville implied that "essential" new matter would give rise to the obligation to update disclosure in either a continuation or a continuation-in-part application:

Plaintiff would have been obligated to disclose this refinement if it were essential . . . . [However,] [p]laintiff, not being aware that the heat shield combustion chamber comprised the best mode of the invention on December 22, 1972, was under no obligation to disclose it on a continuation-in-part application. . . . Because the continuation made only minor technical and clerical changes to the claims and specifications, no obligation arose to update disclosures when it was filed September 20, 1976. [n.105]

Standard Oil further buttresses the "new matter" theory when it firmly stated that Dow's patent was "not invalid for disclosing the best mode, as it is the reissue of the original '104 patent, and no new matter can be added to a patent in a reissue proceeding." [n.106] This statement implies that if new matter could have been added to a reissue patent, the court might possibly have considered its disclosure. The only evidence to the contrary was the mechanical repetition of the words, "The best mode required to be disclosed is the best mode of practicing the invention that is known to the inventor at the time the application for the patent is filed." [n.107]

#### \*280 V. POTENTIAL PROBLEMS -- THE RED-TAPE NIGHTMARE

"It is apparent that an already onerous prosecution burden is about to be substantially increased." [n.108] Edward Walterscheid did not utter this statement following the Transco decision, instead this prediction occurred over fifteen years ago in response to the then newly applied best mode defense. [n.109]

Walterscheid had good insight. Best mode has proved to be quite a burden indeed. [n.110] Some commentators want to eliminate best mode entirely. [n.111] Whether best mode disclosure should be updated whenever an inventor files an application is just one of the many issues plaguing the public's right to know. [n.112] When it comes to best mode, the practitioner might also ponder: \*281 What exactly is the scope of best mode disclosure? [n.113] What does "carrying out the invention" really mean? [n.114] How



does one "fully assess the validity of another's patent, without risking litigation to obtain discovery, when the best mode patentability requirement depends on what the inventor contemplated on a precise date years ago?" [n.115]

Compound these problems with those of Transco: What effect will requiring best mode to be updated have on continued prosecution? On foreign filing? On litigation? Will it be "a trap for the unwary?" [n.116] An applicant desiring to continue prosecution is aided by C.F.R. Rules 60 and 62. With the latter not even requiring a new oath or declaration, these rules would be deceptive formalities for those courts requiring best mode to be updated whenever one files with the PTO, i.e., the rules create a relaxed impression that the inventor is merely extending his original application and need not comply with all statutory requirements. [n.117] In addition, the United States is unique in that it is the only country which demands the best mode to be disclosed, [n.118] let alone updated. [n.119]

\*282 And once the applicant obtains the patent, the real battle may be just beginning. [n.120] Because the Examiner has very little time, no testing facilities, and no access to such information as laboratory notebooks and project reports, he is virtually forced into accepting the applicant's statements as true, thereby granting "applications irrespective of whether or not they have satisfied the [best mode] requirement." [n.121] Lulled into a feeling of security with patent in hand, the patentee's adequacy of disclosure is usually contested for the first time in an infringement suit. [n.122]

During litigation all applications, the original and its dependents, are fair game for alleged infringers searching for any failure of adequate disclosure. [n.123] Not only does the patentee's attorney face an evidentiary dilemma in defending adequate disclosure, [n.124] but there is also the possibility that the original application may constitute prior art against the dependent application(s). [n.125] In addition, the patentee's attorney must be ready to litigate those terms lodged in Transco and Johns-Manville which are \*283 inevitable nightmares. [n.126] With almost no level of predictability, the attorney must litigate the "explain vs. expound/'new matter'" in Transco (fearing converting the continuation application into a continuation-in-part application), and the "essential" in Johns-Manville (fearing invalidity). [n.127]

And it is the dependent applications, which Transco would demand be updated, which will almost certainly be the easiest targets:

[A]s an invention moves through the development process towards commercialization, the quantity of available technical information may grow dramatically, sometimes explosively. In a complex technology, the relevant technical information may grow from a few notebook pages to tens or even hundreds of thousands of documents relevant to some mode for carrying out the invention.

An inventor, faced with making successive best mode disclosures, during the course of completing a multi-year commercial development campaign [probably costing many millions of dollars], can be impossibly burdened: hundreds of hours of effort might be required to construct (or attempt to construct) a fool-proof disclosure of every aspect of the best mode. In effect, inventors would be obligated to disclose an array of

"commercial modes" of making and using an invention, forfeiting trade secret rights therein. (emphasis added). [n.128]

With so much against the patentee in an infringement suit with respect to the adequacy of disclosure, the conservative attorney might attempt to prevent this nightmare by updating the application in such full disclosure that the claim has now become a production specification - a result never intended by the patent system. [n.129] However, it is quite obvious that requiring an inventor to update best mode disclosure whenever an application is filed with the PTO will increase the storehouse of public knowledge. [n.130] Or will it? If the purpose of the best mode is to force an inventor to decide between a patent or trade secret, too many burdens on an inventor could have a "chilling" effect. [n.131] "There is a risk that the system can go too far - and in some cases has gone too far - where it can stifle ideas." [n.132]

\*284 This is the reality of enforcing public policy beyond the principles which compose its foundation. [n.133] If the "principled" courts are attempting to act in the public's best interests by ensuring the public receives its quid pro quo for the inventor's seventeen-year monopoly, then they must realize that strict adherence without any flexibility could result in fewer applications - in direct violation of the constitutional mandate to promote the progress of the useful arts. [n.134]

The reality is:

"that 34,000 applications in 1992 were continuations or continuations-in-part, and that 20,000 of those can be expected to issue. If the Federal Circuit affirms Transco, a large number of patents could be invalidated for failure to show an updated best mode disclosure," [Tegtmeyer] warned. [n.135]

\*285 Tegtmeyer forecasted even more red-tape -- the mother-lode of all red-tape -- "If on the other hand, the decision is upheld, Tegtmeyer predicted, retroactive remedial legislation addressing patents already issued is likely." [n.136]

## VI. POSSIBLE SOLUTIONS -- IS THERE A MIDDLE GROUND?

"But sometimes perception is more important than reality." [n.137] It seems apparent from the majority of commentators that a conservative approach, a patent system which utilizes the best mode requirement, is desired. [n.138] However, as it stands now, the best mode requirement, as a whole, is extremely unpredictable. [n.139] It thus needs to be clarified and streamlined. [n.140]

Ideally, as a starting point, the Federal Circuit needs to clearly define best mode in terms of "carrying out the invention." [n.141] This will determine the scope of the requirement. [n.142] It would be best to define it as narrowly as possible, i.e., only require disclosure for that which is claimed. [n.143] Next, in accordance with the constitutional mandate to promote the progress of the useful arts, require best mode to be fully disclosed whenever the inventor files with the PTO. [n.144]

In addition, the applicable C.F.R. rules should be amended to require a new oath or affirmation whenever an application is filed in order to alert the applicant. [n.145] Even though no United States' judicial decision can amend treaties or foreign patent systems, if the United States is to keep the best mode requirement, then it should be mandatory that all Section 119 foreign \*286 priority applications meet the best mode requirement - to require otherwise would merely allow a loophole in the system.

However, as the courts are slow to make such change, [n.146] and with full knowledge that compliance with the various requisites of Section 112 is highly case specific, [n.147] the lawyer who prepares and prosecutes applications should do so only with the utmost care. [n.148] A self-imposed burden of verifying, updating and re-verifying the final draft of the specification, ensuring that it is the inventor's current preferred mode of carrying out the invention, should become standard practice. [n.149]

## VII. CONCLUSION

It is not unreasonable to demand full disclosure as a prerequisite to the inventor's limited monopoly. [n.150] Without it, the public is left with the quid pro quo equal to a "white elephant" gift while the inventor steals the show in the form of, literally, a "patented trade secret." However, in order to keep the constitutional mandate of promoting the progress of the useful arts alive, strict adherence to principles without any guidelines, especially contradictory guidelines, is to exalt form over substance.

Demanding best mode disclosure to be updated whenever the applicant files with the PTO is contra precedents and C.F.R. rules, as well as certain treaties. As such, those courts strictly adhering to principle are placing an unfortunate burden on the applicant. Multiple burdens add up, sometimes stifling invention and/or the patent system. It should not have to be so. If the Federal Circuit decides to stick to its principles, as it should, then it must set the ground rules.

The first step to instilling badly needed confidence to the patent system should be for the Federal Circuit to clearly define the best mode requirement in terms of "carrying out the invention." This will determine the scope of the requirement in terms of the applicant's invention. Once defined, \*287 mandating full disclosure whenever an applicant files with the PTO would not be the straw that breaks the camel's back, but a mere chore to be expected from the world's only system which offers complete protection to both the inventor and the public. [n.151] In addition, the applicable C.F.R. rules should be amended to require a new oath or affirmation whenever an application is filed in order to alert the applicant. In the meantime, the practitioner should either check on the status of his malpractice insurance or protect himself with a standard practice of updating himself on current issues, especially those involving his client's best mode for carrying out the invention.

[n.1]. "Updated" is a misnomer. No duty exists to update an application. Either a dependent application i.e., one under 35 U.S.C. § 119 (foreign applications), 35 U.S.C. § 120 (continuation, divisional and continuation-in-part applications) [for purposes of this Article, divisional is synonymous with continuation], or 35 U.S.C. § 251 (reissue applications), is considered to be a new application and hence must meet all statutory disclosure requirements, or part of the original application, entitled to the original's filing date, from which disclosure is measured. See *infra* note 27.

[n.2]. Class of 1995, Thomas M. Cooley Law School; Summer Associate, Romero Arteta Ponce, Abogados, Quito, Ecuador, 1994; B.S., University of Florida, 1990.

[n.3]. E.g., Thomas L. Irving et al., *The Significant Federal Circuit Cases Interpreting Section 112*, 41 Am. U. L. Rev. 621, 622-23 (1992). The modern U.S. patent system has three purposes: first, to encourage invention by offering potential rewards to the individual inventor; second, to research developing products and introduce new products to the marketplace; and third, to discourage an atmosphere in which industrial design and technological development are clouded in secrecy, and scientific progress is hidden from the public.

This third purpose underscores the patent system's *quid pro quo* nature, in which the patent is a social contract or franchise. Disclosure by the inventor, then, is the consideration in the social contract between the inventor and the government [or public]. Title 35 Section 112 (35 U.S.C. § 112) sets forth the requirements of disclosure. If the disclosure is insufficient to enable a skilled person to make and use the claimed invention, then there is failure of consideration, and the patent is invalid. See *id.* at 623 nn.4-5 (the author cites *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516, 533-34 (1870), and *Century Elec. Co. v. Westinghouse Elec. & Mfg. Co.*, 191 F. 350, 354 (8th Cir. 1911) which describes the contractual relationship as between the inventor and society); Roy E. Hofer, *The Best Mode Defense After the Federal Circuit's First Decade*, C785 A.L.I.-A.B.A. 1, 10 (1992); Herbert F. Schwartz, *Patent Law and Practice*, Fed. Jud. Center 1988, at 60-61 (Educ. & Training Series, No. 1, 1988) ("In consideration for receiving the right to exclude others from making, using, or selling the invention for a specified period of time, the inventor must disclose his or her invention.") See generally William F. Herbert, *Failure to Disclose the "Best Mode": What the Public Doesn't Know Will Hurt Them*, 64 J. Pat. Off. Soc'y 12 (1982); Douglas S. McDougall, *The Courts are Telling Us: "Your Client's Best Mode Must Be Disclosed,"* 59 J. Pat. Off. Soc'y 321 (1977); Dale L. Carlson, *The Best Mode Disclosure Requirement in Patent Practice*, 60 J. Pat. Off. Soc'y 171 (1978).

[n.4]. See generally Herbert, *supra* note 3; McDougall, *supra* note 3.

[n.5]. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) ("From their inception, the federal patent laws have embodied a careful balance between the need

to promote invention and the recognition that imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy." See also Herbert, *supra* note 3; McDougall, *supra* note 3; Carlson, *supra* note 3, at 173; Richard M. Mescher, Patent Law: Best Mode Disclosure -- Genetic Engineers Get Their Trade Secret and Their Patent Too? -- *Amgen v. Chugai Pharmaceutical Co.*, 18 U. Dayton L. Rev. 177, 203 (1992) ("Maintaining an effective patent system necessitates a balance between requiring too much disclosure and requiring too little disclosure.").

[n.6]. See, e.g., Gary Sturgess, Smart Law: New Frontiers and Challenges in Intellectual Property, *Legal Times*, June 17, 1991, at 11: "Some of the decisions that come out don't seem to reflect a good insight into the real world of patent design," says William Thompson, manager of the patent department at Caterpillar Inc. "The area that comes quickest to mind is the best mode issue," says Thompson . . . . "The court has gone too far in interpreting that requirement to desire design detail of very minute, microscopic detail." *Id.*

[n.7]. 821 F. Supp. 537, 28 U.S.P.Q.2d 1739 (N.D. Ill. 1993), *rev'd in part and vacated in part*, 38 F.3d 551, 32 U.S.P.Q.2d (Fed. Cir. 1994) (holding that best mode does not have to be updated).

[n.8]. The *Transco* court held that continuation applications must be updated. *Id.* at 550.

[n.9]. See Conferences: Best Mode, Character Protection Are Among Topics at AIPLA Annual Meeting, 47 *Pat. Trademark & Copyright J. (BNA)* No. 1154, at 35 (Nov. 11, 1993) [hereinafter *AIPLA Annual Meeting*] (the Patent and Trademark Office [PTO] scheduled an "open dialogue" with the AIPLA for better understanding after the recent *Transco* decision in an effort to improve "customer service."). See also Conferences: ABA-IP Law Section Meeting in N.Y. Reviews I.P. Law and Harmonization, 46 *Pat. Trademark & Copyright J. (BNA)* No. 1144, at 375 (Aug. 26, 1993) [hereinafter *ABA-IP Law Section Meeting*]; Harold C. Wegner, Continued Prosecution in a Continuation Application, or a *Transco* Best Mode Trap for the Unwary?, 75 *J. Pat. & Trademark Off. Soc'y* 837 (1993) (This two-page article lists four reasons why the *Transco* decision is flawed and erroneous.).

[n.10]. *Universal Oil Co. v. Globe Co.*, 322 U.S. 471, 484 (1944).

[n.11]. See *Kewanee Oil Co. v. Bicron*, 416 U.S. 470, 480-81 (1974) (discussing the reward for inventions or incentive theory in addition to a second theory. This second theory, the disclosure theory, indicates that an adequate and full disclosure of new inventions adds to the "general store of knowledge," . . . "which disclosure, it is assumed,

will stimulate ideas and the eventual development of further significant advances in the art.").

[n.12]. *Id.* See also *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 145-53 (1989).

[n.13]. *Kewanee Oil*, 416 U.S. 480-81 (1974). See also 35 U.S.C. § 154 (1993) ("Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, . . . of the right to exclude others from making, using, or selling the invention throughout the United States . . . .").

[n.14]. *Kewanee Oil*, 416 U.S. at 480-81.

[n.15]. *Id.* See also Carlson, *supra* note 3, at 178, n.17.

[n.16]. See Herbert, *supra* note 3, at 38-39.

[n.17]. See, e.g., Carlson, *supra* note 3; S. Russell La Paglia, *Basic Considerations in Licensing from the Business Perspective*, *Technology Licensing 1987*, at 99 (PLI Pat., Copyrights, Trademarks, & Literary Property Course Handbook Series No. 235, 1987); Hofer, *supra* note 3, at 11, n.13 (suggesting that the best mode requirement forces the inventor to choose between patent or trade secret protection for an invention, citing Herbert, *supra* note 3, citing *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974)).

[n.18]. E.g., Carlson, *supra* note 3, at 178-79; Herbert, *supra* note 3, at 33 ("The public may have to involve itself with tedious and expensive experimentation to determine that which should have been expressly disclosed. Thus the mere failure to disclose lessens the degree to which the public's knowledge is advanced and fails to promote the arts as fully as possible.").

[n.19]. See, e.g., La Paglia, *supra* note 17.

[n.20]. *Id.* at 105: Obtaining the patent itself is regarded as costly to many small companies when one estimates that cost to be \$5,000 or more per patent . . . . Over the life of a foreign patent, the cost of these so-called annuities range from about \$3,000 in Japan up to \$15,000 in West Germany, and average about \$5,000 per country. A worldwide patent portfolio made up of 4,000 patents held by a large corporation will cost

over a million dollars a year to maintain. *Id.* For an in-depth discussion concerning the economics of patents, see Rebecca S. Eisenberg, *Patents and the Progress of Science: Exclusive Rights and Experimental Use*, 56 U. Chi. L. Rev. 1017 (1989).

[n.21]. Christopher S. Marchese, *Promoting the Progress of the Useful Arts By Narrowing Best Mode Disclosure Requirements in Patent Law*, 54 U. Pitt. L. Rev. 589, 623, nn.190-91, 193 (1993) referring to the system as an obstacle, quoting Gus Carlson, *American Ingenuity Could Suffer as Patent System Grows More Costly and Corporations Remain Inflexible*, *The Miami Herald*, Jan. 6, 1992, at Business Monday 18 ("Inventors . . . say the system that allows them to bring good ideas to the market - the patent process - has become too costly and too complicated."); *Field v. Manbeck*, No. 90-1030-LFO, 1990 U.S. Dist. LEXIS 10137, at \*6 (D.D.C. Aug. 2, 1990) ("In contrast to patent applicants to retain counsel, the pro se plaintiff may have encountered substantial difficulty in conforming to the procedures and practices required by the PTO.").

[n.22]. Substantively, the invention must meet the statutory requirements set out in 35 U.S.C. § § 101-103, i.e., it shall be of patentable subject matter which is novel, useful, and nonobvious. 35 U.S.C. § § 101- 103 (1993). Procedurally, the inventor must meet the statutory requirements set out in 35 U.S.C. § § 111-113, 115, i.e., the inventor or agent must submit in writing an application, accompanied by a fee, which "shall include: (1) a specification as prescribed by Section 112 of this title; (2) a drawing as prescribed by Section 113 of this title; and (3) an oath by the applicant as prescribed by Section 115 of this title." 35 U.S.C. § 111 (1993).

[n.23]. 35 U.S.C. § 112 (1993) concerns specification: 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 the invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. *Id.*

[n.24]. The enablement clause is separate and distinct from the best mode requirement. In *re Gay*, 309 F.2d 769, 772, 135 U.S.P.Q. 311, 315 (C.C.P.A. 1962). See also *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1532, 3 U.S.P.Q.2d 1737, 1742 (Fed. Cir. 1987): Enablement looks to placing the subject matter of the claims generally in the possession of the public. If, however, the applicant develops specific instrumentalities or techniques which are recognized at the time of filing as the best way of carrying out the invention, then the best mode requirement imposes an obligation to disclose that information to the public as well. *Id.*

[n.25]. A proper best mode analysis involves two steps. As the statute refers to the best mode "contemplated" by the inventor, the first step is a subjective one. If the inventor in fact contemplated a preferred or best mode of carrying out the invention at the time of filing the application, then it must be determined if the inventor adequately disclosed this mode. This step is an objective one which focuses on the metes and bounds of the claimed invention and the level of skill of those in the relevant art. "[T]he second part of the analysis compares what he [the inventor] knew with what he disclosed - is the disclosure adequate to enable one skilled in the art to practice the best mode or, in other words, has the inventor 'concealed' his preferred mode from the 'public'?" *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 927-28, 16 U.S.P.Q.2d 1033, 1036-37 (Fed. Cir. 1990).

[n.26]. 35 U.S.C. § 112 (1993).

[n.27]. A continuation application amends a specific reference to the earlier filed application. It is entitled to the parent application's earlier filing date, assuming the parent application met the procedural statutory requirements set out in 35 U.S.C. § 112. "To consider an application a 'continuing application' means, of course, that it is entitled to the earlier 'parent' - or 'grandparent' etc. - application's filing date in determining what is 'prior art' from the standpoint of validity." *Racing Strollers, Inc. v. Tri Indus., Inc.*, 878 F.2d 1418, 1421 n\*, 11 U.S.P.Q.2d 1300, 1303 (Fed. Cir. 1989).

In contrast, a continuation-in-part application adds new subject matter to the earlier filed application. This new subject matter is not entitled to the parent application's earlier filing date. 35 U.S.C. § 120 (1993). An applicant can file a continuation application in lieu of appealing to the Board of Patent Appeals and Interferences, i.e., the original application, with supportable amendments, is resubmitted to the Examiner without having to appeal, buying more prosecution time. For an excellent discussion on the basics of the patent process, see Wayne S. Brewer, *Know the Basics to Protect Your Inventions*, 100 *Chemical Engineering* 120 (1993).

An application filed in this country within twelve months of filing the same invention's foreign application is entitled to the foreign application's earlier filing date. 35 U.S.C. § 119 (1993).

A patent which is defective due to an inadvertent error in a specification or drawing, "or by reason of the patentee claiming more or less than he had a right to claim in the patent," shall be reissued for the unexpired part of the term of the original patent on the surrender of such patent and upon payment of a fee. The reissue application must not introduce new matter, and meet all statutory requirements, assuming the original patent was valid excepting the reissue portion. 35 U.S.C. § 251 (1993).

[n.28]. U.S. Const. art. I, § 8, cl. 8.



[n.29]. Act of April 10, 1790, 1 Stat. 109 (1790).

[n.30]. Act of April 10, 1790, ch. 7, § 2, 1 Stat. 109 (1790). See also 2 Donald S. Chisum, *Patents* § 7 (1993); Herbert, *supra* note 3, at 14 n.7, 28-31, nn.67-77; Hofer, *supra* note 3, at 11, n.14.

[n.31]. Act of April 10, 1790, ch. 7, § 6, 1 Stat. 109 (1790). See also Chisum, *supra* note 30; Herbert, *supra* note 3, at 14 n.7, 28-31, nn.67-77; Hofer, *supra* note 3, at 11-12 n.15.

[n.32]. Act of Feb 21, 1793, ch. 11, § 3, 1 Stat. 318 (1793). See also Chisum, *supra* note 30; Herbert, *supra* note 3, at 14 n.7, 28-31, nn.67-77; Hofer, *supra* note 3, at 12, n.16.

[n.33]. 27 U.S. (1 Pet.) 1 (1829).

[n.34]. *Id.* at 19 (emphasis added). See also *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 U.S.P.Q. 303, 310 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) ("Early public disclosure is a linchpin of the patent system."). Thus, the earlier a patent is published, theoretically speaking, the more time the public will have to learn and create from this knowledge, and progress spirals upward.

[n.35]. *Bonito Boats, Inc. v. Thunder Craft Boats*, 489 U.S. 141, 148 (1989).

[n.36]. Act of July 8, 1870, ch. 230, § 26, 16 Stat. 198 (1870). See also Chisum, *supra* note 30; Herbert, *supra* note 3, at 14 n.7, 28-31, nn.67-77; Hofer, *supra* note 3, at 12, n.17.

[n.37]. Act of July 19, 1952, ch. 950, 66 Stat. 798 (1952). See also Herbert, *supra* note 3, at 14 n.7, 28-31, nn.67-77. The 1952 statute omitted the "whole truth" defense; unintentional failure to disclose renders the claim invalid. For an in-depth discussion concerning the issue of intent, see Herbert, *supra* note 3.

[n.38]. *Bonito Boats*, 489 U.S. at 148.

[n.39]. Carlson, *supra* note 3, at 189-90; see also *infra* note 135.

[n.40]. *Bonito Boats*, 489 U.S. at 145-51. See also *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 330-31 (1945) ("The primary purpose of our patent system is not reward of the individual but the advancement of the arts and sciences. Its inducement is directed to disclosure of advances in knowledge which will be beneficial to society; it is not a certificate of merit, but an incentive to disclosure.").

[n.41]. *Chemcast Corp. v. Arco Industries Corp.*, 913 F.2d 923, 925, 16 U.S.P.Q.2d 1033, 1035 (Fed. Cir. 1990) (citing *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384-85, 231 U.S.P.Q. 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987)); *DeGeorge v. Bernier*, 768 F.2d 1318, 1324, 226 U.S.P.Q. 758, 763 (Fed. Cir. 1985); *In re Bosy*, 360 F.2d 972, 976, 149 U.S.P.Q. 789, 792 (C.C.P.A. 1966). See also *Chisum*, supra note 30, § 7.05[2], at 7-151-52 n.1 (citing e.g., *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1535, 3 U.S.P.Q.2d 1737, 1744 (Fed. Cir), cert. denied, 484 U.S. 954 (1987); *Wilden Pump & Engineering Co. v. Pressed & Welded Prod. Co.*, 655 F.2d 984, 213 U.S.P.Q. 282 (9th Cir. 1981); *Carter-Wallace, Inc. v. Riverton Labs., Inc.*, 433 F.2d 1034, 1038, 167 U.S.P.Q. 656, 659 (2d Cir. 1970)).

[n.42]. *Transco Products, Inc. v. Performance Contracting, Inc.*, 821 F. Supp. 537, 548, 28 U.S.P.Q.2d 1739, 1747 (N.D. Ill. 1993), rev'd in part and vacated in part, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994) (citing *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1535, 3 U.S.P.Q.2d 1737, 1744 (Fed. Cir. 1987)); *Porter Co., Inc. v. Gates Rubber Co.*, 187 U.S.P.Q. 692 (D. Colo. 1975)).

[n.43]. For simplicity in a complicated matter, the patent system has been broken down into "principled" courts and "real" courts. "Principled" courts are those courts demanding all applications to meet all statutory disclosure requirements. For "principled" courts, original/new status is a non-issue - all applications filed in the PTO are new; for "real" or pragmatic courts, original/new status is the issue.

[n.44]. See supra note 43.

[n.45]. E.g., *Chisum*, supra note 30, § 7.05[1] at 7-119-20 n.1b: A primary purposes [sic] of the patent system is to provide incentives for the disclosure of valuable inventions that might otherwise be kept secret. The Government offers a bargain: a limited period of statutory exclusivity for the claimed invention in exchange for full disclosure of the invention. The best mode provision, by definition, requires more than disclosure of the invention. It requires disclosure of preferred implementations that are not necessary for carrying out the invention. Those preferred implementations are potentially valuable as trade secret [sic]. *Id.* Judge Rich has so explained the purpose of the best mode requirement which, indeed, is parallel to that of full disclosure: One cannot read the wording of Section 112 without appreciating that strong language has been used for the

purpose of compelling complete disclosure. There always exists, on the part of some people, a selfish desire to obtain patent protection without making a full disclosure, which the law, in the public interest, must guard against. Hence, Section 112 calls for description in "full, clear, concise, and exact terms," and 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. *In re Nelson*, 280 F.2d 172, 184, 126 U.S.P.Q. 242, 253 (C.C.P.A. 1960); see also *In re Gay*, 309 F.2d 769, 772, 135 U.S.P.Q. 311, 315 (C.C.P.A. 1962).

[n.46]. 68 U.S. (1 Wall.) 317 (1863).

[n.47]. The *Transco* court indicated that no "Federal Circuit decision has explicitly addressed the question whether an applicant filing a continuation or continuation-in-part application under Section 120 must disclose a best mode arrived at after the initial application was filed." *Transco Products, Inc. v. Performance Contracting, Inc.*, 821 F. Supp. 537, 548, 28 U.S.P.Q.2d 1739, 1747 (N.D. Ill. 1993), rev'd in part and vacated in part, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994). This indeed is a true statement; however, as seen in *Godfrey*, the Supreme Court has implicitly addressed and answered this issue, almost 130 years ago.

[n.48]. *Godfrey*, 68 U.S. (1 Wall.) at 322-23.

[n.49]. *Id.* at 325-26.

[n.50]. *Id.* at 322-23. Mr. Brooks expounded upon the definition of "the application": "The application" must mean the one brought before him [the Examiner] for examination, and not some previous application never perhaps known to him . . . . "The application" means the several papers required by law to entitle an inventor to an examination of his alleged invention, and which, if the patent is granted, are annexed to the letters-patent to distinguish it and fix its character . . . . The applicant voluntarily substituted one application for another, as he says. If both were the same, his motive could not be one favored by the policy of the patent laws. If they were not the same, and he elected to give up one for the other, and did so, and got the benefit of so doing, he cannot now rely on both. *Id.* at 323. Ironically, plaintiff's counsel employed a similar "application" argument: The case is one of two consecutive applications (no time intervening) for patent for an invention. Why is the patent declared invalid upon the ground that the latter one - that which immediately preceded the grant - is the only one to which the statute relates?

There is no sufficient ground for such distinction upon the language of the statute, interpreted with reference to its reason and policy . . . . The provision of the act has been construed liberally to uphold the patent. The terms, "his application for patent," mean not any particular paper application, but his applying; his making an application; his

preferring a demand for a patent for his invention as new and useful (citing Pennock, referring to the policy of early disclosure, having due regard to the rights of the inventor). *Id.* at 319. Today we have come full circle in the debate. And the logic employed by plaintiff's counsel is the rationale used against today's plaintiff's attempting to enforce their patents in an infringement suit. Who is to win: the inventor or the public? Or in the words of Pennock: in the grand scale of things, upon balance, how much weight should we afford the "due regard to the rights of the inventor" in relationship to those rights of the public?

[n.51]. *Id.* at 322. However, Mr. Brooks may not be far off. See *In re Hogan*, 559 F.2d 595, 604 n.13, 194 U.S.P.Q. 527, 536 (C.C.P.A. 1977) (where numerous continuation applications amounted to a twenty-four year pendency. In response, though, the court stated, "a limit upon continuing applications is a matter of policy for the Congress, not for us."); *Intellectual Property Rights in the Biotechnology Field*, *Applied Genetics News*, April, 1993, § 9 ("[O]ne can, therefore, maintain a pending application for many years. Such an aggressive patent posture will maximize the dollars spent on obtaining patents.").

[n.52]. *Transco Products Inc. v. Performance Contracting, Inc.*, 821 F. Supp. 537, 547-50, 28 U.S.P.Q.2d 1739, 1746-49 (N.D. Ill. 1993), *rev'd in part and vacated in part*, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994).

[n.53]. *Id.*

[n.54]. *Id.* at 550, 28 U.S.P.Q.2d at 1749.

[n.55]. *Id.* at 549-50, 28 U.S.P.Q.2d at 1748-49.

[n.56]. *Id.* at 550, 28 U.S.P.Q.2d at 1748-49.

[n.57]. "New matter" is information which is added to the originally disclosed invention, not merely to clarify, but to materially expand the scope of claims or concepts not present in the parent application. *Id.* at 549-50, 28 U.S.P.Q.2d at 1748 (citing *Dart Industries, Inc. v. Banner*, 636 F.2d 684, 688 (D.C. Cir. 1980); *Chicago & N.W. Ry. Co. v. Sayles*, 97 U.S. 554, 563-64 (1878)).

[n.58]. *Id.* at 549-50, 28 U.S.P.Q.2d at 1748.

[n.59]. *Id.* at 550, 28 U.S.P.Q.2d at 1748-49.

[n.60]. *Id.* at 1749.

[n.61]. *Id.* at 549-50, 28 U.S.P.Q.2d at 1749.

[n.62]. *Id.* at 550 n.19, 28 U.S.P.Q.2d at 1749. For prior case law in accord with *Transco*, see *Carter-Wallace, Inc. v. Riverton Labs., Inc.*, 433 F.2d 1034, 1038, 167 U.S.P.Q. 656, 659 (2d Cir. 1970) (assuming the best mode requirement applies to disclosures made in continuation applications); *Studiengesellschaft Kohle m.b.H. v. Eastman Kodak Co.*, 616 F.2d 1315, 1339, 206 U.S.P.Q. 577, 599 (5th Cir.), cert. denied, 449 U.S. 1014 (1980), appeal after remand, 713 F.2d 128, 219 U.S.P.Q. 958 (5th Cir. 1983) (the best mode requirement applies whenever the inventor executes his application); *Engelhard Indus., Inc. v. Sel-Rex Corp.* 253 F. Supp. 832, 149 U.S.P.Q. 607 (D. N.J. 1966), aff'd on other grounds, 384 F.2d 877, 155 U.S.P.Q. 225 (3d Cir. 1967); *Wagoner v. Barger*, 463 F.2d 1377, 175 U.S.P.Q. 85 (C.C.P.A. 1972) (holding that the dependent application shall comply with Section 112's requirement that the specification shall contain a written description of the invention); *In re Hawkins*, 486 F.2d 569, 574, 179 U.S.P.Q. 157, 161 (C.C.P.A. 1973) ("[the] function of Section 112 in ensuring complete public disclosure is only violated if the disclosure is not complete at the time it is made public, i.e., at the issue date.") (emphasis added); but see *Sylgab Steel & Wire Corp. v. Imoco-Gateway Corp.*, 357 F. Supp. 657, 178 U.S.P.Q. 22 (N.D. Ill. 1972); *Johns-Manville Corp. v. Guardian Indus. Corp.*, 586 F. Supp. 1034, 221 U.S.P.Q. 319 (E.D. Mich. 1983).

With respect to statutes in accord with *Transco*, the literal words of 35 U.S.C. § 120 are absent any reference to the issue of updating disclosure.

For commentators exactly in accord with *Transco's* principles, see Cecil D. Quillen, Jr., *Proposal for the Simplification and Reform of the United States Patent System*, 21 *Am. Intell. Prop. L. Ass'n Q.J.* 189, 206-07 (1993): Surely it is not unreasonable to expect a patent applicant who is seeking an exclusive right from the public to disclose to the public the best mode known to him for practicing the invention as to which he seeks the exclusive right and to identify it as such. To do otherwise is to invite a lack of candor and encourage concealment. Applicants who file a provisional application or a complete application in lieu of a provisional application should disclose in their applications the best mode then known to them. Subsequently, when they convert to a complete application or amend the earlier filed complete application, they should disclose the best mode known to them at the time of the conversion or amendment. *Id.* See also John P. Sumner & Steven W. Lundberg, *Software Patents: Are They Here to Stay?*, 8 *The Computer Law.* 8, 15 (1991): There is no obligation to revise the patent application to include a "best mode" disclosure at a later date, unless a subsequent patent application is filed on the same or similar technology of the concept, in which case the "best mode" known at the time of the later filing would have to be disclosed. *Id.*

For conservative commentators who feel full disclosure is at least prudent practice and in accord with the principles of public policy, see Richard G. Berkley, *Some Practical*

Aspects of Amendment Practice in the Electronic- Mechanical Arts, Advanced Claim Drafting and Amendment Writing Workshop, at 189, 200 (PLI Pat., Copyrights, Trademarks, & Literary Property Course Handbook Series No. 327, 1991) ("[T]he question of whether the application discloses the then current best mode contemplated by the applicant should be revisited as a matter of prudent practice. Certainly if a continuation-in-part application is filed, the best mode of carrying out any newly added subject matter should be disclosed."); Carlson, *supra* note 3, at 180 ("[A]n extremely conservative posture should be taken regarding the withholding of any element of best mode for trade secrecy purposes prior to the filing date.") (emphasis in original); McDougall, *supra* note 3, at 333 ("[A] would be patentee will do well to 'tell it all' in his specification."); Melvin C. Garner, Electronics and Computer- Related Subject Matter, Advanced Claim Drafting and Amendment Writing Workshop 1992, at 265, 278 (PLI Pat., Copyrights, Trademarks, & Literary Property Course Handbook Series No. 353, 1992) (with respect to fulfilling the duty of disclosing all material prior art according to 37 C.F.R. § 1.56, "Information which becomes known after the filing of the application should be properly brought to the attention of the office with an updated Information Disclosure Statement."); Mark Gebhardt, Patent Law - Patent Law Policy and the Best Mode Requirement: *Randomex, Inc. v. Scopus Corp.*, 14 J. Corp. L. 1015, 1031 (1989) ("The commercial advantage of an inventor's monopoly is too great to require anything less than strict adherence to the statutory best mode requirement."); Donald S. Chisum, Duty of Disclosure and Inequitable Conduct: Recent Federal Circuit Decisions, *Electronic and Computer Patent Law* 1990, at 583, 584 (PLI Pat., Copyrights, Trademarks, & Literary Property Course Handbook Series No. 292, 1992) ("The inventor and others should err on the high side insofar as disclosure is concerned. If they give any serious thought to whether a reference or piece of information ought to be disclosed, then it should be disclosed!"); Mescher, *supra* note 5, at 203 ("Requiring a slightly higher degree of specificity is consistent with the policy set forth in Section 112.").

[n.63]. In essence, one cannot update a new application; a new application must meet all statutory requirements. "Update" can only refer to a dependent application which is considered to be part of the original application.

[n.64]. Essentially, all courts employ this analysis; however, for "principled" courts the original/new status is a non-issue - all applications filed in the PTO are new.

[n.65]. See *supra* note 27.

[n.66]. See *supra* note 57.

[n.67]. 35 U.S.C. § 251 (1993) ("No new matter shall be introduced into the application for reissue."); *Gage v. Herring*, 107 U.S. 640, 645-46 (1882) (citing numerous other cases holding no new matter in a reissue application).

[n.68]. *Godfrey v. Eames*, 68 U.S. 317, 325 (1863) (referring to the Act of 1839 which codified *Pennock*).

[n.69]. A right implies a privilege - not an obligation. *Black's Law Dictionary* 1324 (6th ed. 1990).

[n.70]. *Godfrey*, 68 U.S. at 324. See also 37 C.F.R. § § 1.60, 1.62 (for a continuation application mere formalities, not including a renewal of oath or affirmation, and the simple procedure of making a new "file wrapper" enable the applicant to continue prosecution).

[n.71]. *Godfrey*, 68 U.S. at 324-26.

[n.72]. *Sylgab Steel & Wire Corp. v. Imoco-Gateway Corp.*, 357 F. Supp. 657, 658-59, 178 U.S.P.Q. 22, 22-24 (N.D. Ill. 1973). See also *Smith v. Goodyear Dental Vulcanite Co.*, 93 U.S. 486, 500 (1876) (amendments and the original application are considered to be as one continuous application, citing *Godfrey*).

[n.73]. *Sylgab Steel & Wire Corp.*, 357 F. Supp. at 658-59, 178 U.S.P.Q. at 22-24.

[n.74]. *Id.*

[n.75]. *Id.* at 659, 178 U.S.P.Q. at 23.

[n.76]. *Id.*

[n.77]. *Id.* at 658, 178 U.S.P.Q. at 23.

[n.78]. *Id.* Filing a continuation-in-part application implies new matter - only subject matter in common with the original application is entitled to its priority date. See *supra* note 27.

[n.79]. Sylgab Steel & Wire Corp., 357 F. Supp. at 658-59, 178 U.S.P.Q. at 23-24.

[n.80]. Id. at 659, 178 U.S.P.Q. at 23-24, quoting *In re Gay*, 309 F.2d 769, 772, 135 U.S.P.Q. 311, 315 (C.C.P.A. 1962).

[n.81]. Id. at 659 n\*, 178 U.S.P.Q. at 23.

[n.82]. Id. at 659 quoting *In re Gay*, 309 F.2d 769, 773 (C.C.P.A. 1962).

[n.83]. Id.

[n.84]. *Transco Products Inc. v. Performance Contracting, Inc.*, 821 F. Supp. 537, 547-50, 28 U.S.P.Q.2d 1739, 1746-49 (N.D. Ill. 1993), rev'd in part and vacated in part, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994). Viewed as such, it appears the obligation in *Transco* is perhaps a compromise position. The obligation to update best mode disclosure arising only when the inventor files is, indeed, the middle ground between requiring the inventor to update whenever a new best mode is discovered and not requiring any updating at all.

For cases in accord with *Sylgab*, see *Engel Indus., Inc. v. Lockformer Co.*, 946 F.2d 1528, 1533, 20 U.S.P.Q.2d 1300, 1303 (Fed. Cir. 1991) ("Compliance with the best mode requirement of Section 112 is governed by the inventors' state of mind with respect to the invention that is described and claimed in the patent application."); *In re Hogan*, 559 F.2d 595, 604-05, 194 U.S.P.Q. 527, 535 (C.C.P.A. 1977) (best mode is measured as of the original filing date, citing *Godfrey*); *Ewing v. United States*, 244 U.S. 1 (1917). For a commentator in accord with *Sylgab*, see *Wegner*, supra note 9.

[n.85]. 615 F. Supp. 471, 229 U.S.P.Q. 171 (E.D. La. 1985), acq. in result 816 F.2d 617, 2 U.S.P.Q.2d 1350 (Fed. Cir. 1987).

[n.86]. Id. at 482, 229 U.S.P.Q. at 179.

[n.87]. Id.



[n.88]. *Id.* Accord with *Dow Chemical*, see the literal words 35 U.S.C. § 251 (1993) ("The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent . . . ") (emphasis added). *Id.*

[n.89]. See *supra* note 27.

[n.90]. 586 F. Supp. 1034, 221 U.S.P.Q. 319 (E.D. Mich. 1983).

[n.91]. *Chisum*, *supra* note 30, § 7.05[2] at 7-152 n.3.1.

[n.92]. *Johns-Manville*, 586 F. Supp. at 1066 n.33, 221 U.S.P.Q. at 345, citing *Sylgab Steel & Wire Corp. v. Imoco-Gateway Corp.*, 357 F. Supp. 657, 658, 178 U.S.P.Q. 22, 23 (N.D. Ill. 1972).

[n.93]. *Johns-Manville*, 586 F. Supp. at 1065, 221 U.S.P.Q. at 345. For prior case law in accord with *Johns-Manville*, see *Pennwalt Corp. v. Akzona Inc.*, 570 F. Supp. 1097, 1102 (D.C. Del. 1983) ("[I]n order to obtain the benefit of the filing date of a copending application, the claims of a C.I.P. [[continuation-in-part] application, in accordance with 35 U.S.C. § 120, must comply with the 'enabling' and 'best mode' disclosure requirements of the first paragraph of 35 U.S.C. § 112."); *General Foods Corp. v. Perk Foods Co.*, 419 F.2d 944, 948, 164 U.S.P.Q. 1, 3-4 (C.A. Ill. 1969), cert. denied, 397 U.S. 1038 (1970) ("35 U.S.C. § 120 providing for continuation-in-part applications must be read in conjunction with 35 U.S.C. § 112").

For prior commentary in accord with *Johns-Manville*, see Mark A. Litman, *Problems with the Best Mode Requirement of 35 U.S.C. 112 in Applications Claiming Priority Under 35 U.S.C. 119 and 35 U.S.C. 120*, 61 J. Pat. Off. Soc'y 431, 441 (1979) (Applicant must update new best mode for Section 119 and continuation-in-part applications, but not continuation applications as this is accorded the legal fiction of being part of the original application.); compare *Chisum*, *supra* note 30, § 7.05[2] (both continuation and continuation-in-part applications are new applications and therefore must meet all statutory disclosure requirements of Section 112).

[n.94]. It is typical for the foreign application to be directly translated in order to be filed in the United States.

[n.95]. See Litman, *supra* note 93, at 432.

[n.96]. 494 F. Supp. 370, 206 U.S.P.Q. 676 (D.Del. 1980), *aff'd*, 664 F.2d 356, 212 U.S.P.Q. 327 (3d Cir. 1981), *cert. denied*, 456 U.S. 915 (1982).

[n.97]. *Id.* at 387, 206 U.S.P.Q. at 696.

[n.98]. *Id.*

[n.99]. *Id.* at 387-88, 206 U.S.P.Q. at 696. For case law in accord with *Standard Oil*, see *ALM Surgical Equipment Inc. v. Kirschner Medical Corp.*, 15 U.S.P.Q.2d 1241 (D. S.C. 1990); *In re Gostelli*, 872 F.2d 1008, 10 U.S.P.Q.2d 1614 (Fed. Cir. 1989); *Tyler Refrigeration Corp. v. Kysor Indus. Corp.*, 601 F. Supp. 590, 225 U.S.P.Q. 492 (D. Del.), *aff'd*, 777 F.2d 687, 227 U.S.P.Q. 845 (Fed. Cir. 1985); but see *Eli Lilly & Co. v. Brenner*, 375 F.2d 599, 153 U.S.P.Q. 95 (D.C. Cir. 1967); *In re Hilmer*, 359 F.2d 859, 149 U.S.P.Q. 480 (C.C.P.A. 1966).

For statutes in accord with *Standard Oil*, see the literal words of 35 U.S.C. § 119 (1993) ("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 . . . .").

For comments *contra Standard Oil*, see *Litman*, *supra* note 93, at 438 (Section 119 foreign application merely establishes the date of novelty, but all other statutory requirements must be met, citing *Hilmer*; N. M. Brisikin, *Foreign Priority Rights Under Section 119 of the Patent Act of 1952 - The New Perspective as to Time of Filing Copy of Foreign Application*, 39 J. Pat. Off. Soc'y 94, 102 (1957)).

[n.100]. The Section 119 foreign priority application cases are hopelessly beyond any reconciliation. Absent express statutory or controlling precedent (an *en banc* Federal Circuit decision is needed (*South Corp. v. United States*, 690 F.2d 1368, 1370 n.2, 215 U.S.P.Q. 657, 658 (Fed. Cir. 1982))), no real guidelines can be given to the practitioner.

[n.101]. This "new matter" harmonization is applicable only to the "real" courts. For the "principled" courts, no guidelines are needed - they are always going to demand best mode disclosure to be updated whenever the inventor files with the PTO. As to whether the court is "principled" or "real," each forum is different; however, research on past decisions should give the practitioner insight.

[n.102]. *Transco Products Inc. v. Performance Contracting, Inc.*, 821 F. Supp. 537, 549, 28 U.S.P.Q.2d 1739, 1748 (N.D. Ill. 1993), *rev'd in part and vacated in part*, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994).

[n.103]. *Id.* at 547-50, 28 U.S.P.Q. at 1746-49.

[n.104]. *Johns-Manville Corp. v. Guardian Industries Corp.*, 586 F. Supp. 1034, 1065-66, 221 U.S.P.Q. 319, 345 (E.D. Mich. 1983).

[n.105]. *Id.*

[n.106]. *Dow Chemical Co. v. American Cyanamid Co.*, 615 F. Supp. 471, 229 U.S.P.Q. 171 (E.D. La. 1985), *acq.* in result 816 F.2d 617, 2 U.S.P.Q.2d 1350 (Fed. Cir. 1987).

[n.107]. *Id.* at 482, 229 U.S.P.Q. at 179 (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556, 220 U.S.P.Q. 303, 316 (Fed. Cir. 1983)).

[n.108]. Edward C. Walterscheid, *Re: The "Best Mode" Requirement of 35 U.S.C. 112*, 59 J. Pat. Off. Soc'y 779, 782 (1977).

[n.109]. See Carlson, *supra* note 3, at 196 (Carlson writes in 1977, "The district and circuit courts are sending clear signals that they are increasingly willing to entertain the best mode defense."). See also McDougall, *supra* note 3, at 321 ("Amazingly, however, I have not found a single case prior to 1965 in which a patent was actually held invalid for non-disclosure of the inventor's best mode.").

[n.110]. E.g., William S. Thompson, *Reforming the Patent System for the 21st Century*, 21 *Am. Intell. Prop. L. Ass'n.* 171, 172 (1993): Patent enforcement costs, driven by escalating infringement damage awards, are approaching prohibitive levels. The cost factor follows an ever-expanding, partially self-generated spiral: the greater the amount of money hanging on a litigation's outcome, the greater the incentive and justification to pursue every conceivable recovery theory or defense. One example: "best mode" defenses were unheard of thirty years ago but today routinely provoke extensive, expensive discovery in search of something, anything, the patentee concealed from his or her patent specifications. *Id.* See also Marchese, *supra* note 21, at 593 ("Confusion and uncertainty over the best mode requirement are particularly troubling."); CBEMA *Comments of Computer-Related Invention Patents*, 8 *The Computer Law.* 32 (1991): The U.S. best mode requirement is unique among the patent laws of industrialized countries and places foreign applicants at a disadvantage before the PTO. Though well-intended to prevent fraud on the public by disclosure of an inferior embodiment, the best mode requirement is very difficult to apply in the context of complex inventions such as computer program-related inventions. *Id.*

[n.111]. E.g., Wegner, *supra* note 9, at 838 (The Transco decision "provides a push toward elimination of the best mode requirement altogether that is being debated in patent reform circles."); Patent Advisory Commission Urges Fundamental Patent Law Reforms, *Daily Report for Executives* (BNA), Sept. 15, 1992, at 179 (The PTO's Advisory Commission September 14, 1992, presented a final report to the secretary of commerce recommending reducing the cost and complexity of enforcement, including the elimination of best mode challenges to patent validity.).

[n.112]. See *infra* notes 113-15. However, two issues which are settled are: 1) best mode is not synonymous with commercial embodiment, and 2) an inventor is held "strictly liable" to the best mode requirement, i.e., accidental or intentional concealment violates best mode. Hofer, *supra* note 3, at 17-19; Herbert, *supra* note 3.

[n.113]. For an excellent, in-depth discussion, see Marchese, *supra* note 21.

[n.114]. Hofer, *supra* note 3, at 20-21 (discussing the fact that the Federal Circuit has yet to give a definitive answer).

[n.115]. Chisum, *supra* note 30, § 7.05[2] at 7-162 n.1.

[n.116]. *Id.* ("The filing date rule tends to make the best mode requirement a trap for the unwary and a temptation to the unscrupulous."); Wegner, *supra*, note 9.

[n.117]. E.g., Wegner, *supra* note 9, at 838: The destabilizing effect of an aberrant case squarely at odds with the Rule 60 or 62 practice is manifest; to the extent the PTO maintains such rules, the PTO is particularly obligated to announce its disavowal of Transco . . . . Since Rule 116(b) is discretionary, some applicants would avoid updating the best mode under lenient Examiners, whereas updating Transco and a hardball approach to this rule would be the fate of others. *Id.* See also Chisum, *supra* note 30, § 7.05 [[2] at 7-152 n.3.1: [T]he filing of a continuation is often accomplished through one of the stream-lined procedures - either Rule 60 or Rule 62 (file wrapper continuation). In the latter, no new oath or declaration is required. Thus, the filing of such an application may not fairly alert the applicant (or his or her assignee) of the duty to review the best mode disclosure in the light of post-filing developments. *Id.*

[n.118]. See *supra* note 110.

[n.119]. See Hofer, *supra* note 3, at 16: The draft agreement on Trade- Related Aspects of Intellectual Property Rights (TRIPs) from the Final Act of the Uruguay Round of GATT addresses the best mode disclosure update issue clearly. The draft agreement provides that "parties . . . may require the applicants to indicate the best mode . . . known . . . at the filing date or, where priority is claimed, at the priority date of the application." This language is clear; under this rule, there would be no duty to update a best mode disclosure where a foreign priority date is claimed. *Id.* See also ABA-IP Law Section Meeting, *supra* note 9, at 375 ("The Transco decision, according to Ryan, presents problems for U.S. applications originally filed abroad which seek to get the benefit of the earlier foreign filing date under 35 U.S.C. 120.").

[n.120]. Carlson, *supra* note 3, at 190-91.

[n.121]. *Id.* at 191. See also Herbert, *supra* note 3, at 32 n.81 (indicating that the PTO is already overburdened); Carlson, *supra* note 3, at 190 ("[E]ach examiner spends an average of only 17 hours on the examination of an application about half of which is spent doing a prior art search, and there is simply not time for a best mode investigation.") (quoting former Commissioner Dann, Address to Wichita Manufacturers Association, quoted at 254 P.T.C.J. at A-16 (Nov. 20, 1975)).

[n.122]. Carlson, *supra* note 3, at 191.

[n.123]. Brief for Amicus Curiae Biotechnology Industry Organization in Support of Appellants Performance Contracting, Inc. and Performance Contracting Group, Inc. at 15, *Transco Products Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994) (No. 93- 1431).

[n.124]. An attorney faces an evidentiary dilemma, referred to as the 103/112 dichotomy: The "skilled artisan" is a player in both a § 103 and a § 112 case. A finding that the hypothetical skilled artisan would have been sufficiently knowledgeable to practice an invention can help rebut a § 112 invalidity case but the same finding may establish that the invention would have been obvious to that artisan. Thus, in attempting to rebut a § 103 invalidity case, the patentee's evidence regarding the difficulty in making the subject invention may be used to find that the best mode requirement was not met. Harold E. Wurst & Nancy J. Linck, *Trial of Liability Issues Part II: Invalidity, Obviousness, Best Mode and Other Statutory Defenses*, Patent Litigation 1991, at 441, 469 (PLI Pat., Copyrights, Trademarks, & Literary Property Course Handbook Series No. 320, 1987).

[n.125]. The publication of the parent application may constitute prior art against a continuation-in-part application, especially where a prior sale occurred over one year prior to updating. See *Chester v. Miller*, 906 F.2d 1574, 15 U.S.P.Q.2d 1333 (Fed. Cir. 1990) (parent application's disclosure of chemical species constituted Section 102(b) prior art against a continuation- in-part application on appeal); but see *In re Hogan*, 559 F.2d 595, 604, 194 U.S.P.Q. 527, 535 (C.C.P.A. 1977): [T]he references would not have been available in support of a 35 U.S.C. § § 102 or 103 rejection entered in connection with the 1953 application. To permit use of the same references in support of the 35 U.S.C. § 112 rejection herein, however, is to render the "benefit" of 35 U.S.C. § 120 illusory. *Id.*

[n.126]. Brief for Amicus Curiae Biotechnology Industry Organization in Support of Appellants Performance Contracting, Inc. and Performance Contracting Group, Inc. at 13-16, *Transco Products Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994) (No. 93- 1431).

[n.127]. *Id.*

[n.128]. *Id.* at 8.

[n.129]. See *Marchese*, *supra* note 21, at 634.

[n.130]. See *AIPLA Annual Meeting*, *supra* note 8, at 35 ("As for policy considerations, requiring an update promotes a full, maximum disclosure of the invention to the public, Tegtmeier acknowledged.").

[n.131]. See *Herbert*, *supra* note 3, at 37-38 ("The ultimate goal of the patent laws is to increase public knowledge and any increase is a function mostly of two factors: fuller disclosure and the number of patent applications."). Effectuating fuller disclosure might result in the expense of fewer applications, possibly leading to the failure of the patent laws to increase public knowledge to the greatest degree possible. *Id.*

[n.132]. *Sturgess*, *supra* note 6, at 11 (quoting Gary Hoffman, who heads the intellectual property group at D.C.'s Dickstein, Shapiro & Morin.).

[n.133]. See *Wurst & Linck*, *supra* note 124, at 445: [U]se "real world facts" and . . . avoid the dull analyses of pieces of paper called the patent and the prior art . . . . In *Rosemount, Inc. v. Beckman Industries, Inc.*, 727 F.2d 1540 [221 U.S.P.Q. 1] (Fed. Cir.

1984), the Court stated: "Lawsuits arise out of the affairs of people, real people facing real problems . . . . "

In the first Panduit decision, the Court added the following comment that should always be borne in mind: "That a court may be led to concentrate on lawyer's games played with the patent in suit and those in the prior art, while allowing an obscurement of the real world story that forms a major part of the landscape of this case, is a fourth phenomenon here present." *Id.* (citation omitted).

[n.134]. See *supra* note 3; Dan Rosen, A Common Law for the Ages of Intellectual Property, 38 U. Miami L. Rev. 769, 788 (1984): The popularity of trade secret protection is due, in part, to its flexibility. As a common law doctrine, courts can mold it to fit the circumstances. In contrast, courts are often shy about updating the copyright and patent law. If that were not the case, inventors might not avoid the statutory protection, and the public might receive its quid pro quo of disclosure. Far from interfering with a "unified" system of intellectual property, the courts might help achieve that goal. If courts applied the common law method to the statutes, evasion would be unnecessary. Flexibility would be built into the system, and the goal of Congress would be better served. Until that occurs, however, large numbers of inventions are likely to remain hidden in the netherworld of trade secret. *Id.*

[n.135]. AIPLA Annual Meeting, *supra* note 8, at 35. See also Brief for Amicus Curiae Bar Association of the District of Columbia in Support of Appellants Performance Contracting, Inc. and Performance Contracting Group, Inc. at 2, 7, *Transco Products Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994) (No. 93-1431): In enunciating a requirement that a continuation application disclose an intervening best mode, the district court has destroyed continuation practice and needlessly jeopardized the validity of many thousands of issued patents. This Court must exercise its power to edify and promote uniformity by uprooting this supposed requirement before it takes hold . . . . [T]he BADC urges this Court to address this issue and bury the notion that a continuation application need disclose an intervening best mode so deeply that it can never be disinterred. *Id.* However, although the Federal Circuit overruled *Transco* in part, the above quotation discloses the very fact that one Federal Circuit ruling does not make the issue moot (since it was not en banc); therefore, this article is written to expound upon the law, making all fully aware of the various positions.

[n.136]. *Id.*

[n.137]. *Sturgess*, *supra* note 6, quoting *Chisum*.

[n.138]. See *supra* note 64; but see *supra* note 117.

[n.139]. See supra p. 30; Marchese, supra note 21, at 621, n.180, 635.

[n.140]. See Quillen, supra note 62, at 206 ("The 'best mode' requirement should not be eliminated. If it is a source of confusion, it should be clarified.").

[n.141]. See supra note 114.

[n.142]. Hofer, supra note 3, at 21.

[n.143]. Marchese, supra note 21, at 635.

[n.144]. Thus the litigational nightmares with the terms in Transco and Johns-Manville, as well as many other problems, will be completely avoided. This decision will have to be rendered en banc in order to be controlling precedent; however, it should be made effective as of that date, i.e., only applications rendered after the opinion should have to meet this requirement - analogous to the situation in *Miranda v. Arizona*, 384 U.S. 436 (1966).

[n.145]. See Walterscheid, supra note 108, at 779.

[n.146]. Carlson, supra note 3, at 189-90; see also supra note 134.

[n.147]. One commentator has developed rough guidelines to help the practitioner deal with such factually specific case law. See Kenneth R. Adamo, *What's Better, What's Best - The Best Mode Requirement in U.S. Patent Practice*, 73 J. Pat. & Trademark Off. Soc'y 811, 840-41 (1991).

[n.148]. Irving et al., supra note 3, at 751-52.

[n.149]. Stuart P. Meyer, *Obtaining and Enforcing Patents for Software- Related Inventions: Avoiding the Pitfalls*, 5 Software L.J. 715, 726 (1992); Carlson, supra note 3, at 175-76; Irving et al., supra note 3, at 751-52; Litman, supra note 93, at 441; AIPLA Annual Meeting, supra note 9, at 35.



[n.150]. See supra note 62.

[n.151]. See supra note 110.