

New Matter Isn't Always Bad: Overcoming the International Best Mode Problem by Liberalizing Amendment Practice

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The U.S. patent law imposes a requirement that the inventor must reveal in a patent application the “best mode” he or she knows for practicing the claimed invention (35 U.S.C. § 112). The rest of the world has no such requirement. This disparity can create hardships for foreign inventors who draft their applications without such a requirement in mind, but who subsequently wish to file a U.S. patent application. If the foreign application fails to disclose the best mode, it will not be patentable in the U.S. (or, if a patent does issue despite the omission, it may later be invalidated in litigation). I propose solving this problem via the relatively simple fix of allowing the foreign applicant to amend the application to add the best mode application upon filing in the U.S. This change would require a relaxation of the present “new matter” rule (35 U.S.C. § 132), which bars applicants from adding any new matter to the disclosure in the patent application after its priority date is established by filing with the U.S. Patent & Trademark Office. By preventing the addition of new matter after this priority date, the new matter prohibition plays an important role in preventing applicants from claiming matter that was invented after the application’s filing date while still relying on that date for priority over others. It also ensures that the inventor complies with the requirements of 35 U.S.C. § 112 that the inventor be in possession of the invention and have enabled others to use the invention as of the priority date.

However the policies implemented by the new matter prohibition are not implicated in the context of the § 112 requirement that the inventor reveal the best mode. Indeed, the policies of the best mode requirement (to prevent the patentee from getting a general patent on the invention while keeping the best way of practicing it a secret, and to give the public the benefit of the best way the inventor knows of practicing the claimed invention) are better served the later the best mode matter is added, as this extra time allows further research that might allow an even better mode to be found. Thus, permitting the addition of new matter that describes the best mode (via a rule carefully tailored to this specific purpose) allows foreign inventors who omitted that disclosure from their applications to protect their rights in the U.S. without sacrificing any of the policies protected by the new matter prohibition.