

Controlling the “Plague”: Reforming The Doctrine of Inequitable Conduct

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Abstract

Following its characterization of inequitable conduct as a “plague” in 1988, the Federal Circuit took steps to narrow the defense, and the United States Patent and Trademark Office (“PTO”) amended its rules to more clearly define the duty of disclosure. However, proliferation of the defense has proved difficult to control. In recent years, the Federal Circuit has issued a number of decisions that expand the defense, leading one judge, in dissent, to recently proclaim that the court had “return[ed] to the ‘plague’ of encouraging unwarranted charges of inequitable conduct.” This recent expansion, in turn, has fueled a series of patent reform proposals.

Reform of the inequitable conduct doctrine is necessary to rein in the assertion of inequitable conduct as a litigation tactic, and to stem a growing tide of inequitable conduct cases and establish an appropriate and sensible role for the doctrine within patent litigation.

This article advocates four reforms to the doctrine of inequitable conduct:

- Materiality should be explicitly linked to the PTO’s 1992 definition of materiality in its regulations.
- The standards for proving intent should be clearly defined.
- The step of “balancing” materiality and intent should be clarified and codified, making clear that even if thresholds of materiality and intent exist, the court retains equitable discretion to decline to find inequitable conduct.
- There should be a single, narrowed remedy. Only the claims directly affected by the inequitable conduct (rather than the entire patent) should be deemed unenforceable.