



Patent Resources Group

Inequitable Conduct Under Current Federal Circuit Law Course Syllabus

- I. BRIEF OVERVIEW OF INEQUITABLE CONDUCT**
 - A. The Basic Principles of Inequitable Conduct Law
 - B. The Materiality Standard
 - C. The Intent Element
 - D. Balancing Materiality and Intent
- II. WITHHOLDING MATERIAL INFORMATION**
 - A. Failure to Disclose Prior Art
 - 1. Withholding Prior Art Publications
 - 2. Withholding Merely Cumulative Prior Art Is Not Inequitable Conduct
 - 3. Withholding Translations of Foreign Prior Art Publications
 - 4. Withheld Prior Sales Information
 - B. Failure to Disclose *Potential* Prior Art Events, i.e., Events That Are Arguably Not Prior Art
 - 1. Withholding Arguably Prior Art Sales or Use Activities
 - 2. Withheld Information Concerning Potential Prior Inventorship
 - C. Withholding Other Information Potentially Affecting Patentability
 - 1. Withholding Inventorship Information
 - 2. Withholding Information Regarding Enablement
 - 3. Withholding Description of the Best Mode
 - 4. Withholding Information Relevant to Co-Pending Applications
 - 5. Withholding Declarant's Relationship With the Applicant
 - 6. Withholding Information Inconsistent With Applicant's Argument for Patentability
 - 7. Withholding Information Arising in Concurrent Litigation
- III. SUBMISSION OF FALSE OR MISLEADING INFORMATION**
 - A. False or Misleading Information in the Specification
 - 1. Misrepresentations Regarding Examples Described in the Specification
 - 2. Misrepresentations About the Advantages of an Invention – i.e., "Advantages Advocacy"
 - 3. Misrepresentations Regarding Prior Art
 - 4. Making a Priority Claim to an Earlier-Filed Application That Does Not Provide §112, ¶1 Support



Patent Resources Group

Inequitable Conduct Under Current Federal Circuit Law Course Syllabus

- B. Misrepresentations During Prosecution
 - 1. Misrepresentations in Practitioner's Arguments for Patentability
 - 2. Misrepresentations in Affidavits
- C. Misrepresentations Unrelated to Patentability
 - 1. Misrepresentation Regarding Prior Art Search in a Petition to Make Special
 - 2. Misrepresentation of Unintentional Abandonment in a Petition to Revive
 - 3. Misrepresenting Small Entity Status