
Federal Circuit Tightens Inequitable Conduct Standards

Date: 06/09/11

In *Therasense, Inc. v. Becton, Dickinson & Co.*, the United States Court of Appeals for the Federal Circuit, sitting *en banc*, clarified and tightened the standards for establishing the "inequitable conduct" defense in patent infringement proceedings. In a split decision intended to make more difficult the invocation of the defense of inequitable conduct, the court held that defendants seeking to assert the inequitable conduct defense in a patent infringement suit must prove that (1) the patentee acted with specific intent to deceive the Patent and Trademark Office ("PTO") when applying for the patent; and (2) but for the patentee's deception, the PTO would not have issued the relevant patent. In doing so, the court rejected looser approaches employed by previous courts. Additionally, the court instructed that even when specific intent and but-for materiality are proven, courts should apply principles of equity and only rule a patent unenforceable due to inequitable conduct "where the patentee's misconduct resulted in the unfair benefit of receiving an unwarranted claim."

Attorney

- Charles A. Gilman