



## Competition Law Association

British Group of the  
Ligue Internationale du Droit de la Concurrence  
(International League for Competition Law)  
[www.competitionlawassociation.org.uk](http://www.competitionlawassociation.org.uk)

### CLA EVENING MEETING: 25 MAY 2011

**Dr. Christian Mammen**

#### **Disclosure to Patent Offices: *Therasense v. Becton Dickinson***

Dr Christian Mammen gave an interesting talk about the US law of inequitable conduct for the purpose of invalidating a patent and its imminent review by the US Court of Appeals for the Federal Circuit in the *Therasense v Becton Dickson* case. Dr Mammen had been closely involved in that appeal, having written an IP law professors' amicus brief in the case.

Under US patent law, inequitable conduct is a potential defence to allegations of patent infringement. Even if it is established that a patent is otherwise valid and infringed, the court ruling on infringement may otherwise exercise its discretion in equity to refuse to enforce the patent if the patentee has behaved inequitably. The question to be assessed is whether the patentee has breached his duty of candour and good faith while applying for a patent at the US Patent and Trademark Office. Typical examples of the breach have included failures to submit known prior art and providing misstatements of fact or inventorship.

The talk considered the historical genesis of the inequitable conduct jurisdiction and the procedural context into which allegations of inequitable conduct are usually made. Dr Mammen dissected the various different tests for whether inequitable conduct had been established and demonstrated that there was little consistency in the previous case law.

Following the talk it transpired that the Court of Appeals had coincidentally produced its decision on the same day. The result was to severely limit the activities that can constitute 'inequitable conduct'. The court adopted a 'but-for' standard for assessing whether the alleged inequitable conduct was material and a 'knowing and deliberate' standard for the assessment of whether the applicant had intent to deceive.

The decision can be obtained at:

<http://www.cafc.uscourts.gov/images/stories/opinions-orders/08-1511.pdf>