

Rethinking the Inequitable Conduct Doctrine in Patent Law

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Abstract

There is no consensus regarding the inequitable conduct doctrine in patent law. Some commentators see the doctrine as "overplayed" and its habitual assertion in litigation as "an absolute plague." Others conclude that the doctrine still allows patent applicants to play fast and loose with the United States Patent and Trademark Office ("USPTO"). Recent congressional actions further evidence the existing difference of opinion. In 2005, the House proposed reforms make it harder to prove inequitable conduct and move the whole inquiry out of district courts and into the USPTO. Then, in 2006, the patent reform bill before the House did not mention the doctrine. Now, the bill that passed the House and waiting for Senate approval codifies the doctrine and, arguably, strengthens it.

This Article takes a much needed fresh look at the inequitable conduct doctrine. First, instead of focusing on the doctrine's equitable roots, the Article examines how the doctrine effects patent quality. The doctrine can improve the quality of examination because it acts as a low cost information producer and information verifier for the USPTO. The doctrine also improves the quality of the patent application because it incentivizes the patent drafter to gain a greater knowledge and understanding of the invented subject matter and exercise greater care when drafting. All impacts on quality are not positive, however. The inequitable conduct doctrine can create information overload, impede the capture of fully allowable claim scope, and extract high upfront costs that may deter patenting.

Next, the Article observes that the doctrine inherently creates a tendency for over compliance. In sharp contrast to other areas of patent law, the patent attorney has an individual duty to comply with the doctrine and failure can lead to claims of malpractice and bar discipline. The doctrine is also a moral rule, adding an external motivation to comply. The personal nature of the doctrine causes patent attorneys to be risk adverse and act when the law does not actually require action.

The Article then applies these two insights to both evaluate the current debate regarding the doctrine and propose certain reforms. Notably, any reforms must both ensure that the level of intent required to prove inequitable conduct is high and keep any affirmative duties to search to a minimum.