

Citation by IDS: So What if I Didn't?

Introduction

Though neither desirable nor recommended, a patent may issue from an application that in its specification mentions a reference that was not, during prosecution, separately cited in an Information Disclosure Statement (IDS).¹ Upon realizing that this has happened, what is the patentee² to think? To do? Should they do anything?³ Should they immediately seek reissue? How comfortable should they feel doing nothing?

In our view, the crucial question around which these scattered worries are dancing is this: what, if anything, does a patentee “get” for that mention of the reference⁴ in the specification, with respect to (1) any statutory (*i.e.*, § 282⁵) presumption of validity over that reference and (2) any increased or decreased likelihood of becoming the next victim of the “plague”⁶ of inequitable conduct?

For at least the reason that we do not believe that a complete, definitive answer to this question currently exists, we do not write today to offer one. Instead, and hopefully still usefully, we seek to provide an analytical structure to patentees finding themselves in this situation, to help them determine their level of comfort with the option of leaving well enough alone, and in the event that it becomes necessary, to arm them with the best arguments and authority we have been able to craft and identify to aid in their attempt to establish that the mention of the reference in the specification does in fact get them something.

With that, we turn in substance to our analysis, which we have found to be most usefully separated into three scenarios, treated below in descending order of the level of comfort we would expect an average patentee to have with each.

Scenario 1: Reference Cited by the Examiner

Our first—and for the patentee the most comfortable—scenario is that, although the specification does mention a reference that was not separately cited in an IDS, the Examiner cited that very reference during prosecution. As stated, this is the best case for the patentee, and of course the best case within the best case is that the Examiner applied the reference to the claims under § 102⁷ and/or § 103⁸, though a citation by the Examiner of the reference as pertinent but less relevant than the art that was applied to the claims would seem nearly—if not exactly—as beneficial to the patentee, as to both validity and inequitable conduct.

First, we think it quite clear that in this scenario the patent would enjoy the strongest presumption of validity that § 282 has to offer, over the entirety of the reference, just as if the reference had been cited in an IDS.⁹ In particular, making no distinction between applicant-submitted and Examiner-located prior art, the Federal Circuit stated in *Al-Site Corp. v. VSI*

*Intern., Inc.*¹⁰ that “[t]he [§ 282] presumption of validity . . . carries with it a presumption that the Examiner did his duty and knew what claims he was allowing. Therefore, the challenger’s burden is especially difficult when the prior art was before the [Examiner].”¹¹

That statement by the Federal Circuit in *AI-Site* is consistent with the language the court used some fifteen years earlier in the seminal case of *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*,¹² where the court stated that, “[when relying only on] prior art [that] was considered by the [examiner, the party challenging validity] has the added burden of overcoming the deference that is due [a] qualified government agency presumed to have properly done its job”¹³

And without more, we do not think that a patentee faced with this scenario should stay up nights worrying about inequitable conduct, since at least the first of the two primary prongs of the currently applicable formulation of the test¹⁴ for inequitable conduct—namely (1) withholding a material¹⁵ reference (2) with an intent to deceive the PTO—is impossible to establish when that reference was cited by the Examiner.¹⁶

In particular with respect to that first prong, the Federal Circuit stated in *Scripps Clinic & Research Foundation v. Genentech, Inc.*¹⁷ that “[w]hen a reference was before the examiner, whether through the examiner’s search or the applicant’s disclosure, it cannot be deemed to have been withheld from the examiner.”¹⁸ This is consistent with Rule 56, which states in pertinent part that “[t]he duty to disclose . . . is deemed to be satisfied if all information known to be material . . . was cited by the Office or submitted to the Office [in an IDS].”¹⁹ With respect to the second prong, authority is scarce, but one district court has opined that, without more, “the plain fact that [a reference] was cited . . . in [a] patent application [is] evidence of good faith,”²⁰ further crippling any charge of inequitable conduct.

Scenario 2: Reference Not Cited by the Examiner, but Incorporated by Reference

Our second—and for the patentee the second-most comfortable—scenario is that the specification mentions a reference that, was not separately cited in an IDS, and was not cited by the Examiner, but was incorporated by reference²¹ into the specification. As stated, within our tripartite structure, we would expect a patentee faced with this second scenario to feel less comfortable than one faced with the first scenario, as described above.

Our analysis of this second scenario involves a bit of construction, having near its foundation the PTO’s directive in 37 C.F.R. § 1.104 that, upon “taking up an application for examination . . . , the examiner shall make a thorough study thereof” Perhaps surprisingly, this construction arrives at a position of reasonable comfort for the patentee with respect to both presumed validity over the entire²² reference, and the unlikelihood of a finding of inequitable conduct.

And though they may be a bit less convincingly supported by controlling authority than our conclusions as to the first scenario, our conclusions as to the second are essentially that the

patentee deserves—but likely would be less likely to actually get—the same benefits as the patentee in our first scenario, and as such should be in the same position as if they had in fact cited the reference in an IDS (or if, as explained above, the Examiner had cited the reference).

We pause briefly here to point out that we have arrived at these conclusions notwithstanding the PTO's myriad of rulemaking attempts²³ to establish as law (or at least as an amalgam of what sounds like law) the proposition that the almighty IDS is the exclusive vehicle by which an applicant can make an Examiner aware of a reference and—by virtue of such disclosure—become entitled to consideration of the reference, paving the way for (1) a § 282 presumption of validity over the reference, and (2) as to inequitable conduct, securing at least one if not both of (a) a finding that the reference cannot be deemed withheld and (b) a finding that without more there can be no inference of an intent to deceive.

In addition to the litany of citations referenced in the endnote of the preceding paragraph, MPEP § 609.05(a) directly addresses the overarching fact pattern on which this article is focused, stating that, “[i]f information [is] listed in the specification rather than in a separate paper . . . , the information need not be considered by the examiner, in which case, the examiner should notify applicant in the next Office action that the information has not been considered.”²⁴

Need not, you say? Is that really correct where the listed reference was itself incorporated by reference? To proceed towards an answer, we now begin the above-mentioned construction of our analysis of this scenario with a point that was made in connection with the first: that the Examiner is presumed to have done his job properly.²⁵

This of course begs the question: when an application incorporates by reference a reference not separately cited in an IDS, what exactly is the job that the Examiner is presumed to have properly done?

For starters, as noted above, 37 C.F.R. § 1.104 states that, upon “taking up an application for examination . . . , the examiner shall make a thorough study thereof” That is, the Examiner is supposed to begin the examination by reviewing the application in its entirety before moving on to searching the prior art.²⁶ The next brick in the wall is that the reference that our exemplary specification incorporates by reference is considered by law to be part of the application as filed, just as if the incorporated reference had been fully replicated in the specification.²⁷

Thus, we believe that a court could (and we think should) hold that a reference that is incorporated by reference into the specification of an application has—at least constructively—passed before the eyes of the Examiner, and thus that the patent is entitled to a presumption of validity²⁸ over that reference, a position that is only buttressed by the Examiner being empowered to request from the applicant a copy of the incorporated reference.²⁹ And we would point out, with special emphasis on the above-quoted assertion in the MPEP that information listed in a specification “need not be considered by the examiner,” that it is well accepted that the MPEP does not carry with it the force and effect of law.³⁰

We feel that this conclusion—that a patent in this scenario would be entitled to a presumption of validity over the incorporated reference—could be solidly based on one or both of the following rationales:

(1) that the art was before the Examiner, who is presumed to do his job,³¹ a job that includes making a “thorough study” of the filed application,³² of which the incorporated reference is a part³³ and (2) that courts have applied this presumption with respect to references in situations that could only fairly be characterized as less compelling, such as the reference (a) being mentioned in (but not incorporated by reference into) the specification,³⁴ (b) having its relevant subject matter described in the specification as prior art without even identifying the reference by patent number,³⁵ and (c) being in the class or subclass searched by the Examiner.^{36,37}

We also observe that this scenario would seem to implicate MPEP § 707.05(b), which explains that, while “MPEP § 609 sets forth guidelines for applicants, their attorneys and agents who desire to submit prior art for consideration by the [PTO, such submitted] citations will not in any way . . . relieve examiners of [their obligation to cite] other pertinent prior art of which they may be aware.”³⁸ We would think it difficult to establish that an Examiner was not aware of an incorporated reference, which is among the materials they are instructed to review before even starting to search the prior art. It seems fair to conclude, then, that because we are assuming materiality (which would seem to subsume pertinence), that the issued patent would be presumed valid over a reference that the Examiner had an independent obligation to cite, but did not.

Turning now to inequitable conduct in connection with our second scenario, the news is again positive. While standing by our prior statement that your average patentee would be less comfortable with our second scenario than with our first, the second scenario does carry with it the possibility that a court could adopt an analysis similar to ours above, and thereby determine that the applicant actually disclosed the incorporated reference to the Examiner in its entirety, and therefore that it could not possibly be established that the reference had been withheld. Such a court may then not even deem it necessary to assess whether there was an intent to deceive.

This seems a tad optimistic, and it is our view that most courts would instead use the intent-to-deceive prong to dismiss the charge of inequitable conduct. And, in fact, several have done exactly that.³⁹ So while courts may be likely to avoid syllogistically finding that the patentee satisfied the disclosure prong, they would seem perhaps just as likely to scoff at the notion that a patentee who not only disclosed a reference in the specification, but also fully incorporated that reference into the specification, was somehow trying to hide something.⁴⁰ Indeed, the incorporating page of the specification would make for a nice trial exhibit.

Scenario 3: Reference Not Cited by the Examiner, and Not Incorporated by Reference

Our third scenario—and for the patentee the least comfortable of the three—is that the specification mentions a reference that was not separately cited in an IDS, was not cited by the

Examiner, and was not incorporated by reference into the specification. Three strikes and you're out? Not so much.

Still presumed to have done their job properly, including making a thorough study of the application, it would seem that in this scenario the Examiner could be presumed to be aware of the mention of the reference, as well as of any description of it that was also included in the specification. And as noted above, several decisions⁴¹ apply a presumption of validity based on the mere disclosure of a reference in the specification.

As such, it would seem that the patentee in this scenario should receive a presumption of validity over at least what is written about the reference in the specification, and likely over the reference in its entirety. Based on the above-cited cases applying the presumption on mere presence of a reference in the class or subclass searched by the Examiner,⁴² it seems reasonable to assume that the full presumption would apply in this third scenario as well.⁴³

With respect to inequitable conduct, it would seem that the analysis of this scenario would in most cases be nearly the same as that of the second. With the specification mentioning the reference at issue, a court would seem in most instances to have their choice of deeming the reference not withheld, finding no intent to deceive, or both. The one significant exception would seem to be where what is written in the specification about the reference is misleading in some important way, perhaps highlighting something other than its most relevant teaching, perhaps characterizing it in a way that discourages the Examiner from reviewing the rest of it, etc. In other words, this scenario is highly fact-intensive; in the words of one district court, while "the plain fact that [a reference] was cited . . . in [a] patent application [is] evidence of good faith, [the citation being done in a] deceptive and misleading manner [could evidence] an intent to deceive the PTO."⁴⁴

Conclusion

With the three scenarios now having been broken down and assessed, we think it worthwhile to pause and appreciate that, perhaps somewhat unexpectedly, having a patent that mentions a reference that was not separately cited in an IDS during prosecution is not necessarily a reason to panic, and that often this will have no negative consequences whatsoever. Thus, absent a particular reason for concern, such as finding oneself in the third scenario with a description of the reference in the specification that leaves something to be desired, the best option will quite often be to do nothing at all, rather than, e.g., rushing to file a reissue application.

We can think of and have identified no upside, however, to the fact that the mentioned reference was not separately cited in an IDS, and thus we are reminded of the age-old advice that an ounce of prevention is worth a pound of cure. To that end, we emphasize the importance of reviewing the specification of any application you are about to file, and any pending application you take over, to make sure that any references mentioned in the specification are, or have already been, separately cited in an IDS.

Also, you might consider revising the description of your standard 3-months-afterfiling IDS reminder—or, perhaps better, the description of a separate, specifically-created-for-this-purpose IDS reminder—to make reference to reviewing the specification for potential citations. And of course don't ignore these reminders.

And should you identify that the specification of a still-pending application does mention a reference that has not yet been separately cited in an IDS, it seems to us that the safe and prudent course of action will almost always be to file an IDS to remedy this situation, even if that means filing an RCE in a case already on allowance, or even one about to issue.

In other words, if you can still do something about it, do something about it.

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Endnotes

1. We note that the Patent Office (PTO) points out in § 609.04(a)-(b) of the most-recent revision (8th ed., rev. 8, July 2010) of its Manual of Patent Examining Procedure (MPEP) that citing a reference in a paper separate from the specification, so long as that paper satisfies both 37 C.F.R. § 1.97 (as to timing) and § 1.98 (as to content), is tantamount to correctly using an official PTO form (such as a PTO-1449 or the newer PTO/SB/08a and 08b forms). For simplicity of presentation, however, we summarily refer to the various options that each satisfy both § 1.97 and § 1.98 as citing a reference "in an IDS."
2. Again for simplicity of presentation, we summarily refer to the patent-controlling entity (e.g., patentee, assignee, exclusive licensee, etc.) as the "patentee."
3. We recommend at least reading the rest of this article.
4. Of course this could arise with respect to multiple references, and indeed if the number of references is sufficiently high that may change the analysis significantly, perhaps even dispositively, but yet again for simplicity of presentation, we write today with respect to one-reference examples. These are of the most interest to us, as they would seem to take the "burying the examiner" "what ifs" off the table, and isolate the threshold conditional inquiry, or base case—i.e., if a patentee gets no benefit whatsoever in the one-reference example, that would seem to obviate further analysis
5. See 35 U.S.C. § 282 ("A patent shall be presumed valid[, and t]he burden of establishing invalidity . . . shall rest on the party asserting such invalidity.").
6. See *Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 876 n.15 (Fed. Cir. 1988), where Judge Markey, the former (and first) chief judge of the Federal Circuit, approvingly cited the "one final word" added by Senior Circuit Judge Nichols to the decision earlier that same year in *Burlington Industries, Inc. v. Dayco Corp.*, 849 F.2d 1418, 1422 (Fed. Cir. 1988), namely that "the habit of charging inequitable conduct in almost every major patent case has become an absolute plague." 35 U.S.C. § 102.
7. *Id.* at § 103.
8. See, e.g., *Al-Site Corp. v. VSI Int'l., Inc.*, 174 F.3d 1308, 1323 (Fed. Cir. 1999).
9. 174 F.3d 1308 (Fed. Cir. 1999).
10. *Id.* at 1323 (internal citations omitted).
11. 725 F.2d 1350 (Fed. Cir. 1984).
12. *Id.* at 1359.
13. See, e.g., *Avid Identification Sys., Inc. v. Crystal Import Corp.*, 603 F.3d 967, 972 (Fed. Cir. 2010) together with *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1365 (Fed. Cir. 2008) (The party asserting the affirmative defense of inequitable conduct must establish by clear and convincing evidence that any (1) alleged failure to disclose, or misrepresentation regarding, material information (2) was made with an intent to deceive the PTO.).

15. We assume for purposes of this article that the reference mentioned in the specification is material, and we note that divining the proper standard of materiality in connection with the defense of inequitable conduct is both (1) outside the scope of this article and (2) among the subjects of the Federal Circuit's upcoming en banc review of *Therasense, Inc. v. Becton, Dickinson and Co.*, 593 F.3d 1289 (Fed. Cir. 2010), rehearing en banc granted, opinion vacated by 2010 WL 1655391, *1 (Fed. Cir. 2010) (requesting in pertinent part that the parties brief the following issues: "What is the proper standard for materiality? What role should the [PTO]'s rules play in defining materiality?").

For more on this case, see the article by Joshua R. Rich and John M. Schafer at page 12 of this edition of snippets.

For a recent and interesting analysis of that issue, touching on principles and disciplines such as separation of powers and administrative law, see David Hricik and Seth Trimble, *Congratulations on Your Hallucinations: Why the PTO's 1992 Amendment to § 1.56 is Irrelevant to Inequitable Conduct*, 38:1 AIPLA Q.J. 1 (2010). While that article is certainly interesting in its own right, it seems that, to the extent the authors' conclusions are correct, they would bear on the subject of the present article as well, and would suggest that the PTO is in fact powerless to determine what does and does not satisfy a failure-to-disclose element of a test for inequitable conduct, and is similarly powerless to determine when a reference has (or has not) been "before" or "considered by" an Examiner in connection with assessing the § 282 presumption of validity, and instead can only determine such things to the extent of the reach of its own rules, which bear not on the validity and enforceability of patents but instead on the enrollment and discipline of attorneys and agents registered to practice before it.

For a case that disagrees with this viewpoint, and concludes instead that an intent to deceive the PTO "might" indeed be inferable in the context of inequitable conduct when an experienced patent attorney handles a pending application in a manner that he knows or should know will not result in consideration by the Examiner of one or more (sort-of) cited references, see *Ortho Diagnostic Systems Inc. v. Miles Inc.*, 865 F. Supp. 1073, 1081-82 (S.D.N.Y. 1994) (where certain references were first cited in an amendment filed under 37 C.F.R. § 1.312 (i.e., after the close of prosecution on the merits), where that amendment was not compliant with the requirements to have references considered at that late stage of prosecution, and where the Examiner then notified the applicant that the references would not be considered, providing an opportunity—of which the applicant did not avail itself—to ensure consideration by, e.g., filing a continuation application.); see also MPEP § 2001.04 ("The Office does not believe that courts should, or will, find violations of the duty of disclosure because of unintentional noncompliance with 37 CFR 1.97 and 1.98. If the noncompliance is intentional, however, the applicant will have assumed the risk that the failure to submit the information in a manner that will result in its being considered by the examiner may be held to be a violation.").

All of this may be largely academic, however, in that applicants, agents, and attorneys are typically far more focused on avoiding findings of inequitable conduct than they are on avoiding disciplinary action by the PTO, believing (quite reasonably) that succeeding in the former will obviate the latter. More to the point, it is generally accepted—perhaps now a bit provisionally due to the possibility of a contradictory en banc decision in *Therasense*— that (1) satisfaction of the 37 C.F.R. § 1.56 duty of candor is not a safe harbor against a finding of inequitable conduct but that (2) the converse is not true—i.e., conduct that would not support a finding of inequitable conduct would almost (if not) never run afoul of Rule 56. For a photo-negative statement of the same principle, see *Monsanto Co. v. Bayer Bioscience N.V.*, 514 F.3d 1229, 1237 n.11 (Fed. Cir. 2008) ("Although all misstatements or admissions that satisfy Rule 56 are considered material, the converse is not true: [a] misstatement or admission can be material for the purposes of showing inequitable conduct even if it does not meet the standard for Rule 56 . . .").

16. See *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1582 (Fed. Cir. 1991).
17. 927 F. 2d 1565 (Fed. Cir. 1991).
18. *Id.* at 1582.
19. 37 C.F.R. § 1.56(a).
20. *IDEC Pharm. v. Corixa Corp.*, 2003 WL 24147449, *18 (S.D. Cal. 2003), vacated on other grounds by 2004 U.S. Dist. LEXIS 23859.
21. We assume for purposes of this article that any incorporation by reference was done properly, the best practices for and pitfalls of incorporation by reference being outside the scope of this article.
22. We further assume that any incorporation by reference was done with respect to the entirety of the incorporated reference, leaving to our third scenario the pesky issue of selectivity by an applicant with regard to the contents of a given reference.
23. Taken together, the pertinent sections of the C.F.R. and the MPEP relate nearly without exception to explaining seemingly *ad infinitum* that (1) citation by way of an IDS that complies with both 37 C.F.R. § 1.97 and § 1.98 is sufficient to satisfy an applicant's Rule 56 duty to disclose, and entitles the applicant to consideration by the Examiner of the IDS and that (2) a submitted IDS that does not comply with both § 1.97 and § 1.98 will not be considered by the Examiner, but will instead just be placed in the file. See 37 C.F.R. § 1.56(a) ("The duty to disclose . . . is deemed to be satisfied if all information known to be material . . . was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97 [and] 1.98."); MPEP § 609 ("37 CFR 1.97 [and 1.98] provide a mechanism by which patent applicants may comply with the duty of disclosure provided in 37 CFR 1.56." (emphasis added)); MPEP § 609 ("Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information."); 37 C.F.R. § 1.97(i) ("[if an IDS] does not comply with either this section or § 1.98, it will be placed in the file but will not be considered by the Office."); MPEP § 609, 609.05(a); MPEP § 609 ("In order to have information considered by the Office during the pendency of a patent application, an [IDS] must be (1) in compliance with the content requirements of 37 CFR 1.98, and (2) filed in accordance with the procedural requirements of 37

CFR 1.97.”); MPEP § 609.04(a) (“An [IDS] must comply with the provisions of 37 CFR 1.98 as to content for the information listed in the IDS to be considered by the Office.”); *but see* MPEP § 2001.04 (“The Office does not believe that courts should, or will, find violations of the duty of disclosure because of unintentional noncompliance with 37 CFR 1.97 and 1.98. If the noncompliance is intentional, however, the applicant will have assumed the risk that the failure to submit the information in a manner that will result in its being considered by the examiner may be held to be a violation.”).

24. MPEP § 609.05(a) (emphasis added). This section includes form paragraph 6.49.06, entitled “Information Disclosure Statement Not Considered, References Listed in Specification,” for Examiners to use to provide the required notice to applicants when the Examiners have identified an instance of this situation and have decided not to consider the information listed in the specification, as the MPEP says they “need not.” This paragraph reads:

The listing of references in the specification is not a proper [IDS]. 37 CFR 1.98(b) requires a list of all patents, publications, applications, or other information submitted for consideration by the Office, and MPEP § 609.04(a), subsection I. states, “the list may not be incorporated into the specification but must be submitted in a separate paper.” Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

It would seem to be a fair inference when an applicant (1) mentioned a reference in the specification and (2) did not receive the notice required by § 609.05(a), that although the Examiner “need not” have (but obviously was free to) consider that reference, the Examiner did in fact consider it.

25. *See, e.g., Al-Site*, 174 F.3d at 1323; *Am. Hoist*, 725 F.2d at 1359; *E.I. du Pont de Nemours & Co. v. Berkley & Co., Inc.*, 620 F.2d 1247, 1266 (8th Cir. 1980) (“The statutory presumption of validity flows from a congressional assumption that the PTO properly performs its administrative functions.” (citations omitted)).
26. *See* MPEP § 704.01 (“After reading the specification and claims, the examiner searches the prior art. [. . .] The invention should be thoroughly understood before a search is undertaken.” (emphasis added)).
27. *See, e.g., 37 C.F.R. § 1.57(f)* (“material incorporated by reference [may be amended] into the specification or drawings of an application”); *see also Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F. 3d 1272, 1282 (Fed. Cir. 2000) (“Incorporation by reference provides a method for integrating material from various documents into a host document . . . by citing such material in a manner that makes clear that the material is effectively part of the host document as if it were explicitly contained therein.” (citations omitted)); *S. Clay Prods., Inc. v. United Catalysts, Inc.*, 43 Fed. Appx. 379, 387 (Fed. Cir. 2002) (Mayer, J., dissenting) (“We have held that incorporating material by reference is the same as if the information were included directly in the host document.” (*citing In re Lund*, 376 F.2d 982, 989 (CCPA 1967))); *Cook Biotech Inc. v. Acell, Inc.*, 460 F.3d 1365, 1376 (Fed. Cir. 2006); *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1329 (Fed. Cir. 2001).
28. *See Al-Site*, 174 F.3d at 1323; *Am. Hoist*, 725 F.2d at 1359.
29. *See 37 C.F.R. § 1.57(e)* (“The examiner may require the applicant to supply a copy of the material incorporated by reference.”); *see also* MPEP § 608.01(p) (“The examiner may require a copy of the incorporated material to review and to understand what is being incorporated or to put the description of the material in its proper context.”).
30. *See, e.g., Regents of Univ. of N.M. v. Knight*, 321 F.3d 1111, 1121 (Fed. Cir. 2003) (“The MPEP sets forth PTO procedures; it is not a statement of law,” *citing Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1180 n.10 (Fed. Cir. 1995) (“While the MPEP does not have the force of law, it is entitled to judicial notice as an official interpretation of statutes or regulations as long as it is not in conflict therewith.”)).
31. *See, e.g., Al-Site*, 174 F.3d at 1323; *Am. Hoist*, 725 F.2d at 1359.
32. *See 37 C.F.R. § 1.104*.
33. *See supra*, n.27.
34. *See, e.g., Ind. Mills & Mfg. v. Dorel Indus. Inc.*, 458 F. Supp. 2d 890, 931 (S.D. Ind. 2006) (“Despite the fact that the examiner failed to list them in the appropriate sections of the prosecution history, the Court presumes that the examiner considered [two U.S. Patents] because those references were clearly cited in the specification.”); *Polaroid Corp. v. Eastman Kodak Co.*, 641 F. Supp. 828, 833 (D. Mass. 1986) (“prior art described in the specification [] is expected to be considered by the Examiner.” (citations omitted)); *Penda Corp. v. United States*, 29 Fed. Cl. 533, 561 (Fed. Cl. 1993) (“The examiner did consider [a particular patent], inasmuch as it is one of the references cited in the specification of the patent at issue.”). *Compare Am. Cyanamid Co. v. U.S. Surgical Corp.*, 833 F. Supp. 92, 105 (D. Conn. 1992) (Examiner not presumed to have considered prior art for purposes of double-patenting where prior art was cited in Applicant’s specification).
35. *See Gould v. Gen. Photonics Corp.*, 534 F. Supp. 399, 403 (N.D. Cal. 1982) (reference deemed considered by Examiner as prior art in issuing patent-in-suit due to specification discussing same subject matter as pertinent disclosure of reference).
36. *See, e.g., E.I. du Pont de Nemours & Co. v. Berkley & Co., Inc.*, 620 F. 2d 1247, 1267 (8th Cir. 1980) (“[T]he examiner’s search record is *prima facie* evidence that he considered all the references classified in the classes and subclasses searched and that he left uncited [sic] those he regarded as less relevant than those cited.”) (citations omitted)); *Polaroid Corp. v. Eastman Kodak Co.*, 641 F. Supp. 828, 833 (D. Mass. 1986) (“Polaroid has fulfilled its obligation to the Patent Office where the patent in suit is in the class of patents that was cited.” (citations omitted)).
37. Interestingly, though perhaps not immediately intuitive, it would appear that, while the fact that a reference is in the same class or subclass that was searched by the Examiner has been deemed sufficient to earn the patent-in-suit the § 282 presumption of

validity over that reference, that same fact is not at all helpful in trying to defeat a charge of inequitable conduct. This makes sense to us, however, for at least the reason that the particular classification of a given reference has absolutely nothing to do with any conduct on the part of the applicant, agent, attorney, etc.—*i.e.*, any “individual associated with the filing and prosecution of [the] application [that issued as the patent-in-suit].” See 37 C.F.R. § 1.56(a). In the recent and insightfully simple and crystallizing words of Judge Joan Ericksen of the District of Minnesota, “it is whether a reference was disclosed, not whether it was considered, that is relevant to inequitable conduct.” *Am. Med. Sys., Inc. v. Laser Peripherals, LLC*, 2010 WL 1957479, at *29 n.25 (D. Minn. May 13, 2010).

Thus, while constructive consideration can provide a bit of a “Get Out of Jail Free” card to a patentee in the context of the presumption of validity, no such card appears available in the context of inequitable conduct. For support for this latter proposition, see, e.g., *Driscoll v. Cebalo*, 731 F.2d 878, 885 (Fed. Cir. 1984), *overruled on other grounds by Kingsdown*, 863 F.2d at 876 (Fed. Cir. 1988) (“It cannot be presumed, where fraud or other egregious conduct is alleged, that the PTO considered prior art of particular relevance if it was not cited.”); see also *FMC Corp. v. Hennessy Industries, Inc.*, 836 F.2d 521, 526 (Fed. Cir. 1987), *citing Driscoll*, 731 F.2d at 885 (evidence establishing only that the examiner made “a generalized search” of the class and subclass that contained the omitted reference was not, in and of itself, sufficient to consider the patentee’s duty of candor to have been met); but see *Avco Corp. v. PPG Indus., Inc.*, 867 F. Supp. 84, 88 n.3 (D. Mass. 1994) (“[finding] that the . . . examiner knew about [a particular] patent [in the prior art, on the basis that there was no evidence contrary to the evidence establishing that the examiner actually searched a set of] categories and subcategories [that] would have revealed the [particular] patent[, relying on Federal Rule of Evidence 301 in initially adopting] the presumption that the patent categories listed by the . . . examiner are presumed to have been reviewed.”).

38. MPEP § 707.05(b) (emphasis added).
39. See *Am. Med. Sys., Inc. v. Laser Peripherals, LLC*, 2010 WL 1957479, at *29 (D. Minn. May 13, 2010) (“The [patent-in-suit] incorporated by reference [a certain] application, which discloses [a certain figure] and the related description. Such incorporation is inconsistent with any intent to deceive.” (citations omitted)); *Grantley Patent Holdings, Ltd. v. Clear Channel Communications, Inc.*, 540 F. Supp. 2d 724, 732 (E.D. Tex. 2008) (“[T]he fact that [the inventor] explicitly incorporated [a certain] publication by reference into the . . . specification is inconsistent with any intent to deceive.”).
40. While not central to our analysis, we note that there may also be some headway that could be made using the line of cases standing for the proposition that, when a reference was considered by the Examiner, no intent to deceive can be inferred from mere attorney argument (not involving material misrepresentations, but rather just the characterizations of a zealous advocate). See, e.g., *Rothman v. Target Corp.*, 556 F.3d 1310, 1328-29 (Fed. Cir. 2009) (“While the law prohibits genuine misrepresentations of material fact, a prosecuting attorney is free to present argument in favor of patentability without fear of committing inequitable conduct[, the court therefore seeing] little basis to find deceptive intent in the routine back and forth between examiner and applicant[, and the court further recognizing] that the Patent Act gives the examiner the discretion to reject or accept an applicant’s arguments based on the examiner’s own conclusions regarding the prosecution record.” (citations omitted)). The parallel here of course rests on the assumption that the court would deem the reference to have been actually considered by the Examiner, but could be useful to the extent that an accused infringer targets any characterization of the incorporated reference in the specification as evidencing an intent to deceive.
41. See *supra*, n.34.
42. See *supra*, n.36-37.
43. We arrive at this assumption even while mindful that, when explaining (albeit clearly in dicta) why the Supreme Court in *KSR* did not need to (and in fact did not) “reach the question [of whether the fact that a reference at issue as to validity was not before the Examiner] during the prosecution of [the patent-in-suit] voids the [§ 282] presumption of validity given to issued patents,” Justice Kennedy wrote that “[the unanimous Court] nevertheless [thought] it appropriate to note that [, in that circumstance,] the rationale underlying the presumption—that the PTO, in its expertise, has approved the claim— seems much diminished.” See *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 426, 127 S.Ct. 1727, 1745 (2007). As we also assert in the article proper, we think that a reference that is mentioned in the specification is “before the Examiner” as much as—if not more so than—a reference that, for example, happens to be in the class or subclass searched by the Examiner.
44. See *IDEC Pharm. v. Corixa Corp.*, 2003 WL 24147449, at *18 (S.D. Cal. Oct. 14, 2003), *vacated on other grounds by* 2004 U.S. Dist LEXIS 23859.