On May 25, 2011, the Federal Circuit set forth in its en banc Therasense opinion a new, heightened test requiring that a prior art reference, knowingly withheld by the applicant, be “but for” material to the patent’s issuance in order to constitute inequitable conduct that would render the obtained patent unenforceable. On January 8, 2015, the Federal Circuit denied the combined petition for panel rehearing and for rehearing en banc in its decision in American Calcar, Inc. v. American Honda Motor Co., Inc. (hereinafter “American Calcar II”). The inequitable conduct claims at issue had been evaluated previously by the court in June of 2011 (hereinafter “American Calcar I”), on the heels of the Therasense decision, and had been remanded to the district court for more detailed determinations of materiality and intent. With the original Therasense majority currently occupying merely a third of the seats and with Judge Prost, a member of the dissent, assuming the duties of chief judge, does American Calcar II break rank with post-Therasense precedent—including American Calcar I—and offer any clues as to what direction the court may be headed?

BACKGROUND

In the United States, a patent applicant owes a duty of candor and good faith to the U.S. Patent and Trademark Office (PTO). This duty may be breached whenever the applicant fails to disclose known material prior art references prior to the issuance of its patent. The Therasense court ruled 6–1–4 in favor of the adoption of a new, heightened standard for deciding the materiality of references withheld by an applicant seeking to deceive the patent office—a “but for” test. In other words, a reference is material “if it would have blocked patent issuance under the PTO’s evidentiary standards.” An applicant’s failure to disclose such references, if coupled with a specific intent to deceive the PTO, could lead to every claim in the offending patent being held unenforceable. The majority also tempered its test with an exception for instances of egregious misconduct, which would be categorically material.

Judge O’Malley argued in a concurring opinion that the new test was too inflexible and opted for the inclusion of a third, catch-all category to capture offensive behavior. The dissent argued for the same “prima facie case of unpatentability” standard applied by the PTO’s examiners, which was a lower bar than the majority’s but-for materiality standard and would include more references the applicant would be obligated to disclose. The dissent noted that the majority’s new test provides a perverse incentive: when faced with the choice of (1) obtaining a problematic patent that competitors would have the burden of proving unenforceable in litigation, or (2) no patent at all, applicants would be likely to choose the “dishonest but potentially profitable course” and withhold those “material” references to obtain an otherwise unobtainable patent.

The concurrence’s and dissent’s critiques of the majority’s overly delimited and stringent method of evaluating materiality will prove to be a recurring source of tension that will manifest first in Outside the Box and later in American Calcar II, as described below.

One month subsequent to Therasense, a panel consisting of Judges Lourie, Bryson, and Gajarsa decided American Calcar I, vacating the lower court’s finding of inequitable conduct with respect to three related patents—the ’497, ’465, and ’795 patents. Conversely, the panel affirmed the finding that the admitted prior art Acura 96RL navigation system that was allegedly withheld by the lead inventor was material to the ’497 patent. The jury had found the prior art system anticipated the asserted claims of the ’497 patent. The panel affirmed the finding that the admitted prior art Acura 96RL navigation system that was allegedly withheld by the lead inventor was material to the ‘497 patent. The jury had found the prior art system anticipated the asserted claims of the ‘497 patent, necessitating the conclusion that it was but-for material prior art. The case was remanded for further findings as to whether the same information was but-for material to the ‘465 and ’795 patents and whether the applicant had the requisite, specific intent to deceive the PTO.

Although the Acura navigation system was described as prior art in the common specification of the three patents, the model number

**Gino Cheng**

*Winston & Strawn LLP*

**Runaway Jurisprudence: Has the “But For” Test for Proving Inequitable Conduct in Patent Cases Gone Awry, Gone Rogue, or Gone Quiet?**
was not specified and its 56-page manual not disclosed in an IDS until April 6, 2007 in the ex parte reexamination of the ‘497 patent. The photographs of the navigation system’s display screen at various stages of use were taken by an unidentified Calcar employee. The lower court concluded that while preparing the drawings and other parts of the specification, the lead inventor copied and modified the illustrations and passages from the Acura manual. It was Calcar’s employees’ practice to copy owner manuals of vehicle navigation systems to prepare Calcar’s booklets. The lead inventor had also spent about thirty minutes test-driving the Acura RL vehicle and using its navigation system. He acknowledged that he used the navigation system as the basis of his own invention.

In parallel with the litigation, a third party, Crowell & Moring LLP, had brought an ex parte reexamination proceeding against the ‘497 patent, during which the patentee submitted the Acura 96RL manual to the PTO. At the conclusion of the reexamination proceeding in June of 2008, the PTO confirmed the patentability of claims 1–29. The applicant canceled claims 30–56 on April 6, 2007 in response to an office action rejection based on other prior art.

On remand, the district court again concluded that all three patents were unenforceable for inequitable conduct, finding that the only reasonable inference was that the lead inventor had specifically intended to deceive the PTO, because he knew that the prior art was material to his invention and that he made a deliberate decision to withhold that information. Calcar again appealed. In American Calcar II, the appellate panel affirmed the holding against Calcar. Subsequently the Federal Circuit denied the combined petition for panel rehearing and for rehearing en banc.

How difficult would it be to find the votes needed to overturn the materiality test set by the Therasense opinion? In 2012, Judge Linn elected to take senior status. He was succeeded by Judge Chen to fill the Circuit’s tenth seat. Former Chief Judge Rader retired in June of 2014. Accordingly, given the current composition of the Court, the original majority’s formulation may be embraced now by potentially no more than a third of the members on the active bench. T o answer this question, it may help to compare the instances where post-2011 panel decisions have come out split over the proper determination of a material omission and then examine whether the disagreeing judges are divided along the familiar doctrinal battle lines drawn in Therasense.

SURVEY OF OTHER POST- THERASENSE CASES

Looking at the fourteen Federal Circuit panel decisions opining on inequitable conduct from American Calcar I up through American Calcar II, one can make at least three observations. First, excluding two panel cases in September of 2012, there have not been any opinions decided by more than one judge from the original Therasense majority. Rather, each three-judge panel included two members from either the Therasense dissent or the concurrence (or their successors). For the most part—given the smaller number of separate opinions disputing the inequitable conduct ruling—the Federal Circuit members seem to have fallen in step with one another in their treatment of the but-for materiality inquiry. American Calcar II, however, may be a turning point, as described further below.

Second, Judge Newman of the original Therasense majority and Chief Judge Prost of the original Therasense dissent have participated in the largest number of panel hearings from which opinions on inequitable conduct issued: each judge participated in five of the fourteen cases.

Third, although seven of those fourteen panel decisions included either a separate concurring or dissenting opinion, only four of those seven minority opinions were directed to conflicting conclusions about inequitable conduct issues. In addition, Judge Newman authored four of those seven separate opinions. Her minority opinions are two of the four that are directed to inequitable conduct. The third and fourth were authored by Senior Judges Mayer and Clevenger respectively, neither of whom took part in the Therasense decision.

The earlier of the two minority opinions by Judge Newman was Outside the Box Innovations v. Travel Caddy, where the friction between the Therasense factions resurfaced, albeit with respect to the per se materiality exception to the but-for materiality test (for an applicant’s egregious misconduct), rather than with the application or scope of the but-for materiality test itself. Recall the naysayers in Therasense were critical of the majority’s new test for being overly restrictive and would therefore cast too narrow a net when capturing inequitable conduct. The dissenters believed the majority’s “but for” standard to be too high a bar. Meanwhile, the concurrence believed the majority’s proposed Band-Aid to the overly stringent bar—the egregious misconduct exception—was too constricted to be a catch-all and therefore insufficient to provide the requisite elasticity to address the universe of potential inequitable conduct scenarios. In Outside the Box, the dissenting faction from Therasense would have both the upper hand in numbers and the opportunity to exploit the inutility and/or gaucheness of the majority’s egregious misconduct exception.

There, the lower court had found egregious misconduct according to the letter of the law, i.e., the applicant’s filing of a small entity status declaration with the PTO that proved to be untrue seemed to fall squarely within the Therasense majority’s articulation of what would constitute per se material conduct even though that conduct was wholly unrelated to the application’s patentability and allowance. On appeal, Judge O’Malley, who wrote the separate concurring opinion in Therasense, and Judge Prost seized the opportunity to poke fun at the Therasense majority’s formulation of the egregious misconduct exception, the literal application of which would have exalted form over function and been ill-suited given the equities in the case.

Instead of correcting the lower court’s finding, Judges Prost and O’Malley’s per curiam opinion reversed the lower court’s conclusion of inequitable conduct on other grounds, i.e., lack of specific intent to
deceive. Their passing over the determination of egregious misconduct under the *Therasense* majority’s verbatim instructions—which, left intact, would have been a perverse and inconvenient result of following *Therasense*’s guidelines—was akin to intellectually sweeping under the rug an embarrassing, unintended byproduct left by *Therasense*. The import of the panel majority’s silence was not lost on Judge Newman who concurred in the result, but was forced to write a separate opinion to defend and circumscribe the *per se* materiality exception.

Soon thereafter, Judge Newman found herself outnumbered for the fourth time—and again at odds with Chief Judge Prost—in *American Calcar II*, but this time with respect to the application and scope of the contested “but for” inquiry itself. The third member of the panel was Judge Wallach, who succeeded Judge Gajarsa from the *Therasense* dissenters. Although Judge Wallach had since sat on three panels reviewing inequitable conduct claims, he had never participated in a split panel decision involving the *Therasense* factions. His casting lots with Judge Prost when the opportunity finally presented itself in *American Calcar II* signals that like his predecessor he stands on the dissent’s side of *Therasense*’s ideological divide.

**BRIEF NOTES ABOUT AMERICAN CALCAR II**

The defendants-appellees had argued that the lead inventor deliberately withheld material information from the PTO during the original prosecution of each of the patents-in-suit, and therefore the patents should be found unenforceable for the inventor’s inequitable conduct. In particular, the defendants-appellees alleged that the lead inventor knew of the system manual and Calcar’s photographs of the display but did not disclose them, or his personal experience with interfacing with the Acura 96RL navigation system, to the PTO. Therefore, the PTO could not have been fully aware of the prior art system’s “operational details.”

On remand from *American Calcar I*, the lower court had agreed with the defendants and found both the materiality and intent prongs of the *Therasense* test satisfied. On the materiality prong, it concluded that because the ‘465 and ‘795 patents would have been obvious in light of the prior art system, the PTO would not have allowed those patents to issue had it been aware of the operational details, and therefore the withheld information was but-for material. Of note, although this conclusion was premised on obviousness, the district court did not conduct a formal analysis under *Graham* and *KSR*, the jury having returned previously a verdict that those two patents were non-obvious over the prior art and their validity not at issue on remand from *American Calcar I*.

Reviewing these factual findings for clear error and the lower court’s ultimate finding of inequitable conduct for abuse of discretion, Chief Judge Prost and Judge Wallach affirmed. Although obviousness is a question of law, the panel did not conduct *sua sponte* a formal obviousness analysis either.

On the question of deceptive intent, the panel majority did not see as clearly erroneous the lower court’s finding that the lead inventor had “only disclosed the mere existence of the 96RL system without providing its operational details.” Given the inventor’s “personal knowledge of the 96RL system, test drives of the 96RL with the system, and use of figures from the 96RL owner’s manual in the patent application he drafted” and “the importance of the information,” the panel majority agreed with the lower court that the only reasonable inference was that the lead inventor had deliberately concealed the information. Chief Judge Prost found the inventor’s “limited disclosure” to be “intentionally selective,” and therefore supported the inference of deliberate omission. As support, she opportunely cited another panel opinion that she had authored. Accordingly, volunteering the existence of the Acura navigation system as prior art, without more, actually backfired against the applicant.

This appears to be a rare instance where something explicitly called out as admitted prior art in a specification is nonetheless deemed to have been withheld because relevant details about the same were not called out to the PTO in a separate IDS or affidavit from the inventor. Taking an extreme view of the holding, the result suggests that beyond the duty to disclose, the applicant now has the additional onus of explaining why the admitted or cited prior art is relevant to the invention, lest he or she risk the negative inference associated with partial disclosure should the PTO examiner fail to appreciate that art.

The adjudication also begs the question of whether the case would have come out differently had the 56-page navigation manual been disclosed in an IDS during the original prosecution of any of the three patents. The answer to the question of whether an earlier inclusion of the printed materials would have exonerated the inventor is not entirely clear from *American Calcar II*. Whereas the lower court suggests that the omitted material “operational details” may not have been sufficiently described in the manual *per se* either—rather, it may have required hands-on, real-time experience from using the device, which the inventor had engaged in for thirty minutes—the panel majority did not articulate whether it too considered the withheld material information to include the inventor’s personal knowledge. Likewise, Judge Newman’s dissent limits the purportedly material information in dispute to merely the manual and Calcar’s photographs.

Judge Newman would have reversed, disagreeing with the lower court’s conclusions on both the materiality and the intent prongs. Although the ‘497 patent had been invalidated by the jury, Judge Newman noted that the PTO did consider the manual and the defendants’ invalidity contentions during the *ex parte* reexamination of the ‘497 patent and nonetheless confirmed claims 1-29. She also found that the claim 1 was not disclosed in the manual. Based on either of these two reasons, she concluded that the omitted manual and photographs could not have been but-for material.

One notes, however, that in her dissent, Judge Newman extrapolates from the ‘497 reexamination results that the ‘465 and ‘795
patents would not have been rendered obvious by the Acura system. This extrapolation is analogous to the leap made by the majority to the conclusion of obviousness without a Graham and KSR analysis—which Judge Newman criticizes.

Moving on to the finding of intent, Judge Newman pointed out the inherent inconsistency in the majority’s position which alleged the concealment of the very art that was explicitly called out twice in the specification and that was also subsequently given to the PTO. By way of observation, taking the majority opinion at face value, an applicant that makes a partial disclosure runs the risk of doubly penalizing itself on the intent prong of the inequitable conduct inquiry—conceding knowledge of the reference’s existence in the first place, and then inviting the self-defeating inference that the applicant selectively manipulated the disclosure so as to mask and deliberately withhold material portions while surrendering instead only the non-material portions.

The frightening implication from the split panel decision is that prior art that the PTO actually considered and yet found insufficient to render obvious the claimed invention could nonetheless be deemed but-for material by the judiciary. Although paying lip service to the “but for” standard imposed by the Therasense majority, Chief Judge Prost and Judge Wallach appear to be operating at the fringes of familiar territory, having reached the conclusion of obviousness with out a formal analysis and seemingly overlooked the import of the ‘497 reexamination proceeding that confirmed the asserted claims. This latter point is not addressed in Chief Judge Prost’s majority opinion. Accordingly, American Calcar II provides a valuable point of reference for practitioners in order to test the current boundaries of the Therasense framework.

It is ironic that the Therasense dissent’s original aim to sweep more references within the bounds of the applicant’s duty of disclosure, which was premised on the PTO being the best suited to determine what it considered to be material, would be realized by Chief Judge Prost’s majority decision which did not consider—and indeed passed over—the PTO’s reexamination results. It is perhaps unsurprising, then, that the members of the Therasense dissent and their successors showed little interest in rehearing this case en banc, its facts making it possibly the least ideal test case with which to mount a potential overhaul of the current unenforceability doctrine.

CONCLUDING REMARKS

In sum, as to the question of whether the court’s treatment of Therasense’s test for the materiality prong of the inequitable conduct defense has gone awry, rogue, or quiet, American Calcar II suggests that it has gone awry. Taking Judge Newman’s dissent at face value, the panel majority—comprised of the members, or successors thereof, from the Therasense dissent—found as being “material” the prior art that she considered had failed the Therasense majority’s test.

Because only four of the original members of the Therasense majority are actively serving on the Federal Circuit, the majority’s framework for evaluating materiality would be vulnerable to revision at the next opportune en banc hearing. Yet, despite hints from the American Calcar II panel of the potential for altering the “but for” test, the Federal Circuit passed on the opportunity to rehear the issue en banc. This leaves uncertain the practical limits of the materiality inquiry whose scope appears to have subtly swollen since Chief Judge Prost took the helm. Perhaps a different perspective will emerge once Judge Taranto and Judge Rader’s successor have their respective opportunities to weigh in on panel decisions. For the time being, however, the takeaway is that practitioners should continue to err on the side of caution, opting for full—rather than partial—disclosure when prosecuting pending applications, and the same in the case of previously issued patents via supplemental examination under the AIA prior to initiating litigation.

The views expressed in this article are personal to the author and do not necessarily reflect the views of the author’s firm, the State Bar of California, or any colleagues, organization, or client.

© 2015 Gino Cheng.

Gino Cheng is a senior IP litigation associate and registered patent attorney in Winston & Strawn LLP’s Taipei and Los Angeles offices. He has experience with a wide range of technologies, including flash memory, semiconductors, optoelectronics, LEDs, photonics, telecommunications, and signal transport protocols. He may be reached at gcheng@winston.com.

Endnotes

2. See Appeal No. 13-1061, Dkt. No. 51. Judge Newman alone would have reheard the appeal en banc.
3. 768 F.3d 1185 (Fed. Cir. 2014).
4. 651 F.3d 1318 (Fed. Cir. 2011).
5. Eleven of the twelve active members of the Court participated. Former Chief Judge Michel’s seat had not yet been filled. Judge Rader penned the opinion and his majority further comprised Judges Newman, Lourie, Linn, Moore, and Reyna. Judge O’Malley filed a concurring opinion. Judges Bryson, Gajarsa, Dyk, and Prost dissented with respect to the issue of materiality.
6. See Therasense at 1304.
7. See id. at 1304 and 1306.
9. A reference is material only if the patent examiner would have refused to issue the patent “but for” the applicant’s having withheld the reference. See Therasense at 1291.
10. Id. at 1292.
11. See id. at 1288. Additional discussion of the intent prong, another prerequisite for finding inequitable conduct, and its determin-
nation in the context of omitted references that are potentially cumulative of those previously disclosed to the PTO, may be found in my previous New Matter article. See Gino Cheng et al., *Inequitable Conduct: One Thing Less to Worry About, One More Thing to Consider*, New Matter, March 2013, available at http://www.winston.com/en/thought-leadership/inequitable-conduct-one-thing-less-to-worry-about-one-more-thing-1.html.

12. See *Therasense* at 1293 (“Accordingly, the general rule requiring but-for materiality provides clear guidance to patent practitioners and courts, while the egregious misconduct exception gives the test sufficient flexibility to capture extraordinary circumstances…. When the patentee has engaged in affirmative acts of egregious misconduct, such as the filing of an unmistakably false affidavit, the misconduct is material”) (internal citation omitted); see also, e.g., Gino Cheng, *et al., The Future of “Egregious Misconduct” in Patent Cases*, LAW360, July 7, 2014, available at http://www.winston.com/en/thought-leadership/the-future-of-egregious-misconduct-in-patent-cases.html (analyzing the egregious misconduct exception in light of Federal Circuit decisions in 2012 through 2014).

13. See *Therasense* at 1300 (O’Malley, J., concurring) (“Both the majority’s and the dissent’s tests, moreover, fail to allow room to address conduct beyond their contours which equity should not ignore.”) and 1301–02 (“A desire to provide immutable guidance to lower courts and parties similarly is not sufficient to justify the court’s attempt to corral an equitable doctrine with neat tests.”).

14. See id. at 1300 (O’Malley, J., concurring) (“(3) the district court finds that the behavior is so offensive that the court is left with a firm conviction that the integrity of the PTO process as to the application at issue was wholly undermined”).

15. See id. at 1303 (Bryson, J., dissenting) (reasoning that the PTO “in the best position to know what information examiners need to conduct effective and efficient examinations, i.e., what information is material to the examination process”).

16. Id. at 1306 (Bryson, J., dissenting).


18. See id. at 1334.

19. See id. The jury had also entered an advisory verdict that there was no inequitable conduct (see id. at 1330), but granted the defendants’ motion finding inequitable conduct as a matter of law (see id.).

20. See id. at 1335.

21. See id. at 1335–36.


24. See *American Calcar, Inc. v. American Honda Motor Co., Inc.*, No. 06cv2433, 2012 WL 1328640 at *2 (S.D. Cal. April 17, 2012). This district court opinion will be referred to as *American Calcar III* for convenience.

25. See id. at *3 (“The evidence indicates the source of this information is the 96RL navigation system manual (‘the Manual’), given the similarities between the Manual and the application.”) and *5 (“When asked about these edits, Mr. Obradovich stated: ‘there was a lot of copying and copy on top of it, cutting and pasting.’”).

26. See id. at *1 (“Indeed, Calcar’s business model was based on copying the owner’s manuals and condensing them into “Quick Tips” booklets.”).

27. See id. at *2 (“Mr. Dinkel, Mr. Kent and Mr. Obradovich spent between ‘30 minutes to an hour’ in that car, during which they operated the navigation system and drove the automobile”).


29. See *American Calcar III* at *6.

30. See id.

31. See PTO Application No. 90/007,900 file history (April 7, 2014).

32. See *American Calcar II* at 1188 (citing *American Calcar III* at *9–10*).

33. A senior status judge does not participate in deciding whether to grant rehearing en banc or in voting as part of an en banc panel unless he or she had sat on the three-judge panel that originally heard the appeal. See Federal Circuit Internal Operating Procedures 13 and 14.

34. The first, *1st Media, LLC v. Elec. Arts, Inc.*, 694 F.3d 1367 (Fed. Cir. 2012), was decided by former Chief Judge Rader and Judges Linn and Wallach. The panel unanimously decided the issues on appeal relating to inequitable conduct. The second, *Santarus, Inc. v. Par Pharma*, Inc., 694 F.3d 1344 (Fed. Cir. 2012), was decided by former Chief Judge Rader and Judges Linn and Moore, all members of the original *Therasense* majority. The panel unanimously decided the issues on appeal relating to inequitable conduct.


36. See *Outside the Box Innovations, LLC v. Travel Caddy, Inc.*, 695 F.3d 1285 (Fed. Cir. 2012).


38. See *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1305 and 1312 (Fed. Cir. 2011) (en banc) (Bryson, J., dissenting); see also id. at 1298 and 1300 (O’Malley, J., concurring).

39. See *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1305 (Fed. Cir. 2011) (en banc) (Bryson, J., dissenting) (“[t]his court has repeatedly rejected the ‘but for’ test as too restrictive in light of the policies served by the inequitable conduct doctrine”) and id. at 1312 (“[t]he Office rejected [the ‘but for’] test, concluding that adopting such a narrow standard ‘would not cause the Office to obtain the information it needs to evaluate patentability so that its decisions may be presumed correct by the courts’”).

40. See id. at 1300 (O’Malley, J., concurring) (“I also cannot agree completely with the test proposed by the majority. Given the scope and complexity of PTO proceedings, misconduct can and
does occur outside the context of written affidavits." and 1298 ("The remainder of the majority opinion makes clear, moreover, that the majority's purpose, and that of the test it adopts, is to delimit and narrow the contours of the unclean hands doctrine when applied to the application process before the PTO, not to acknowledge flexibility in it.")

The Therasense dissenters also questioned the logistical application and practical effect of the majority's per se materiality exception. See id. at 1305 (Bryson, J., dissenting) ("[t]he distinction between 'affirmative acts' and 'nondisclosure' is thus apt to become fertile ground for litigation in the future, not to mention the distinction between 'egregious' misconduct and misconduct that is assertedly less than 'egregious'").

41. See Therasense, 745 F.3d at 1292 ("[w]hen the patentee has engaged in affirmative acts of egregious misconduct, such as the filing of an unmistakably false affidavit, the misconduct is material").

42. See Outside the Box Innovations, LLC v. Travel Caddy, Inc., 695 F.3d 1285, 1294 (Fed. Cir. 2012) ("[i]n other words, a false affidavit or declaration is per se material. Although on its face, it appears that a false declaration of small entity status would fall within the definition of an 'unmistakably false affidavit,' particularly since a party that claims entitlement to small entity status does so in a sworn written declaration, we need not decide that question.").

43. See id. at 1294–95.

44. See id. at 1306–07 (Newman, J., concurring) ("Although the panel majority also states that 'we need not decide that question' of materiality, id., they do decide the question of materiality, for they decline to correct the district court's ruling that improper payment of the small entity fee is material to patentability.... The court's equivocation on materiality and intent based on error in small entity status simply adds uncertainty when such is unwarranted.").

45. In 2011, Judge Wallach succeeded Judge Gajarsa, one of the original Therasense dissenters.


47. See id. at 1187–88.

48. Id. at 1188 and 1190 ("[W]e affirm the district court's determination that the undisclosed operational details of the 96RL navigation system are material to the patentability of the '465 and '795 patents").

49. See id. at 1188. The lower court also rejected Calcar's argument that the 96RL navigation system was merely cumulative of the information disclosed in the patents that Calcar had identified to the PTO via IDS. See American Calcar III at *8.

50. See American Calcar II, at 1190.

51. See American Calcar III at *8; see also American Calcar II at 1189.

52. See American Calcar II at 1192.

53. See id. at 1189–90 ("[t]herefore, the only limitation that Calcar claims as novel is that the object of the user's search has to be 'an aspect of the vehicle'" and 1190 ("the mere substitution of one kind of information as the object of the search—which, under a broadest reasonable interpretation of the claim, could be anything about the car—would be an obvious, and thus unpatentable, invention.").

54. Id. at 1191 (citing American Calcar III at *10).

55. American Calcar II at 1191.

56. Id.

57. Id.

58. Id. at 1190.

59. See id. at 1190 (citing Aventis Pharma S.A. v. Hospira, Inc., 675 F.3d 1324, 1335–36 (Fed. Cir. 2012)).

60. See 37 C.F.R. § 1.56.

61. Curiously, the implication from the split panel's lines of reasoning is that identifying the manual would not have mattered to the case's outcome. To the panel majority, even if the lead inventor had initially disclosed the manual to the PTO, the manual may not have contained the relevant information that the PTO needed and/or the court may still have found material the inventor's failure to disclose his use of the Acura system's relevant functionalities during the test-drive. It was moot to the dissent whether the lead inventor left that information off the IDS or included it, because on reexamination the claims-at-issue were ultimately allowed over the Acura system and therefore the information could not have been but-for material. Hence, the majority and dissent might still have respectively affirmed and reversed the lower court's finding of inequitable conduct.

62. See American Calcar III at *5 ("Mr. Obradovich did not 'detail any aspects of the user interaction of the 96RL system []' to the Patent and Trademark Office ('PTO')") and *11 ("[n]either Honda's PICs nor the Manual provided a complete picture of the functionality of the 96RL navigation system.... In other words, neither of these references provided the PTO with all of the relevant details about the 96RL navigation system.").

63. See American Calcar II at 1189–90.

64. See id. at 1192 (Newman, J., dissenting) ("[t]he only issue is whether Mr. Obradovich committed inequitable conduct by not providing the PTO, when the parent patent application was filed, with the Acura Owner's Manual and the photographs that the Calcar employees took of the Acura display").

65. See id. at 1192 (Newman, J., dissenting).

66. See id. at 1194 (Newman, J., dissenting) ("[w]e need not speculate about whether the PTO would have granted the Calcar patents 'but-for' the information in the Owner's Manual and the photographs, for the PTO's reexamination of the '497 patent provides the answer: the PTO confirmed patentability").

67. See id. at 1195 (Newman, J., dissenting) ("[t]his system was not described in the prior art, which includes the Acura 96RL Owner's Manual").

68. See id. at 1194–95 (Newman, J., dissenting) ("[o]n the correct law, 'but-for materiality' of the Owner's Manual and photographs was not shown by clear and convincing evidence. This alone negates a ruling of inequitable conduct.").

69. See id. at 1195 (Newman, J., dissenting).

70. See id. at 1195 (Newman, J., dissenting) ("[t]he majority ignores that the Acura navigation system was identified as prior art in all of the patent specifications, that any omission was remedied with the PTO via IDS. See also American Calcar III at *8.

71. See Therasense, Inc. v. Becton, Dickinson & Co., 649 F.3d 1276, 1310 (Fed. Cir. 2011) (en banc) (Bryson, J., dissenting) ("[i]n light of those policies, the court explained that the test for materiality 'cannot be applied too narrowly if the relationship of confidence and trust between applicants and the Patent Office is to have any real meaning,' and that findings of materiality should