



From Left to Right: Lisa Jakob, Angie Hankins, Matthew Siegal

On May 20, 2005, the NYIPLA Committees on Meetings and Forums, Copyrights, and Continuing Legal Education co-sponsored a CLE Luncheon Program featuring guest speakers Matthew W. Siegal, a partner with the firm of Stroock & Stroock & Lavan LLP, and Lisa Jakob, the Director of Patent Law at Schering-

Plough Corp. The topic of the CLE Program was the “Duty of Disclosure: Update and In-House Perspectives.” Mr. Siegal provided an update on the duty disclosure, while Ms. Jakob provided an in-house counsel’s perspective on the duty of disclosure.

The CLE Luncheon Program addressed the disclosure of foreign references and adverse testing results to the U.S. Patent & Trademark Office (“Patent Office”). Mr. Siegal began his portion of the presentation with a review of the duty of candor and good faith, and the duty of disclosure owed to the U.S. Patent Office under 37 C.F.R. §§ 1.56 (a), 1.97. Mr. Siegal illustrated the implications of the failure to conduct due diligence regarding possible on-sale bars prior to filing a patent application using *Brasseler, U.S.A. I, L.P. v. Stryker Sales Corp.*, 267 F.3d 1370 (Fed. Cir. 2001). Mr. Siegal also discussed the level of disclosure necessary when using a foreign language reference, the level of deference granted to a foreign reference, and whether the inventor has duty to provide a translation of a foreign reference if he can read the foreign reference; using the following cases *Central Soya Co. v. Geo. A. Hormel & Co.*, 723 F.2d 1573 (Fed. Cir. 1983), *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368 (Fed. Cir. 2001), and *Louis A. Grant, Inc. v. Kiebler Industries*, 377 F.Supp. 1069 (N.D. Ind. 1973).

Ms. Jakob began her presentation with a discussion of whether there is an affirmative duty to disclose adverse testing results. Next, Ms. Jakob discussed the timing of disclosure adverse testing results. Ms. Jakob also discussed the disclosure of a reference during reissue of a patent that the inventor was aware of during the original prosecution of the patent application. Ms. Jakob’s presentation included a discussion of *Kingsdown Medical Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 872 (Fed. Cir. 1988) and *Bristol-Myers Squibb co. v. Rhone-Pulenc Rorer, Inc.*, 326 F.3d 1226 (Fed. Cir. 2003).

The CLE Luncheon Program concluded with a lively question and answer period with topics that included burying references and the disclosure of phase three test results.