

**By: Thomas McKiernan and Michael Badagliacca**

**Larson Manufacturing Co. of South Dakota, Inc. v. Aluminart Products, Ltd.**

**Decided March 18, 2009**

**Office Actions from a Continuation Application found to be Material to Patentability of Parent**

During reexamination of U.S. Patent No. 6,618,998('998), Larson submitted an Information Disclosure Statement (IDS), citing a pending continuation application and the first two Office Actions issued with respect to the continuation application. However, Larson did not disclose the third and fourth Office Actions issued with respect to the continuation application.

The U.S. District Court for the District of South Dakota found that the third and fourth Office Actions were material to patentability. The District Court therefore held the '998 patent unenforceable due to inequitable conduct.

The Federal Circuit agreed with the District Court. The Federal Circuit reasoned that, in addition to the cited references, the examiner's comments in the office action are important. The Federal Circuit relied on *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003), which held that a contrary decision of another examiner reviewing a substantially similar claim was material. Even though the third Office Action included a reference (Johnson) cited in the earlier Office Actions, the third Office Action included a new explanation of the rejection based on Johnson. The fourth Office Action included a new rejection based on Johnson and Kemp. Therefore, the third and fourth Office Actions were not cumulative to the earlier Office Actions.

Practice Tip: When Office Actions issue in related applications, cite the Office Actions in an IDS.