
Intellectual Property Law

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Beware And Being Aware Of Your Duty Of Disclosure Obligations To The Patent And Trademark Office

A patent has been deemed by its very nature to be affected with a public interest. As a result, the courts have held that those individuals who are associated with the filing and prosecution of a patent application have a duty of candor and good faith in dealing with the Patent and Trademark Office ("PTO"). The PTO requires each individual who owes this duty to disclose to the PTO all known information that is "material to patentability." This is commonly referred to as the "duty of disclosure" obligation.

For the average patent applicant (i.e., inventor), the "duty of disclosure" obligation is probably one of the most poorly understood aspects of the patenting process. However, the patent applicant who fails to understand what this duty means, and especially what they must do to satisfy it, do so at their peril. Being aware of this duty, and making sure it has been complied with, is often the difference between the life (and death) of a patent in litigation.

Because of the serious consequences that can occur if the duty is violated, it is important to consider the following questions:

- Who owes the duty? Individuals subject to the duty include: (1) each inventor named in the application; (2) each attorney or agent who prepares or prosecutes the application; (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, the assignee or anyone to whom there is an obligation to assign the application. This list covers a fairly broad range of individuals, so it is extremely important to identify all who have been involved with the patent application before, during and after it was prepared.
- What information is considered "material to patentability?" Information is considered "material to patentability" when it is not cumulative to information already of record and it: (1) establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim in a patent application; or (2) refutes, or is inconsistent with, a position taken by the patent applicant in: (i) opposing an argument of unpatentability relied on by the PTO; or (ii)

asserting an argument of patentability.

So what does this mean in lay terms? While it is not possible to give every instance of information that might be considered "material," here are some common examples:

- (a) any known prior patents and printed publications that might be considered relevant to the claimed invention, either alone or in combination;
- (b) any known prior uses, sales or offers for sale of the invention, or any improvement thereof, that have occurred more than 1 year prior to the filing date of the application;
- (c) data that could suggest a position contrary to that taken by the patent applicant during prosecution, or is potentially in conflict with other data that has been presented by the patent applicant during prosecution.

How long does this duty last? This duty lasts with respect to each pending claim in the patent application until it is cancelled, withdrawn from consideration, or the application is abandoned.

What happens if this duty is violated? Violations of the duty of disclosure can have extremely serious consequences. Any patent that has been obtained as a result of the duty being violated can be held unenforceable, invalid and usually both. Worse yet, a violation of the duty can be the basis for attorney's fees and court costs being awarded to the other side. If a violation is discovered during prosecution in the PTO, the patent application can also be stricken so that no patent is granted.

How do you comply with this duty? The accepted way to comply with the duty is to file with the PTO an Information Disclosure Statement ("IDS"). The IDS usually contains a list of the prior patents and printed publications to be cited on one or more PTO-1449 forms, as well as copies of the cited documents. The IDS also needs to be filed within 3 months of the filing date of the patent application or prior to the first PTO Office Action, whichever is later. Any submissions after this point will require a certification that the information was learned of recently (i.e., within 3 months) or payment of a fee. It is also not uncommon for the patent applicant to learn of "new" prior patents and printed publications (usually from foreign patent offices) during the prosecution of the patent application. Because the duty is an ongoing one, supplemental IDSs may need to be filed to cite these "newly discovered" documents.

In conclusion. It is extremely important that the patent applicant beware and be aware of their "duty of disclosure" obligations to the PTO. The complexity of this duty, and the serious consequences that can occur if it is violated, usually make it advisable to use the services of a registered patent attorney or agent. These patent professionals understand this duty well and

will know how to ensure compliance with it.

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