



Applicant's Duty of Disclosure to the U. S. Patent and Trademark Office

The U.S. Patent and Trademark Office (USPTO) has established rules concerning the submission of material information known to a patent applicant, e.g., prior art patents/publications, co-pending U.S. applications and commonly owned patents/publications. These rules define an applicant's "duty of disclosure." Granted U.S. patents may be legally challenged and potentially held unenforceable based upon a failure during prosecution before the USPTO to comply with the duty of disclosure through bad faith or intentional misconduct. It is, therefore, essential that the following guidelines be strictly followed.

I. SCOPE OF DUTY

Under U.S. law, it is essential that all prior art or information known to be material to patentability and examination of an application for patent be brought to the attention of the USPTO. This duty of candor and good faith rests on the inventor, on each attorney or agent who prepares or prosecutes the application, and on every other individual who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee, or with anyone to whom there is an obligation to assign the application (37 C.F.R. Section 1.56). This means that (1) company patent counsel, (2) outside patent counsel and (3) company technical personnel must be made aware of the duty of disclosure.

II. WHAT MUST BE DISCLOSED

All information that is known to be material to patentability must be disclosed to the USPTO. Information is considered "material to patentability" if it (1) establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim, or (2) refutes, or is inconsistent with, a position the applicant takes in either (i) opposing an argument of unpatentability relied upon by the PTO, or (ii) asserting an argument of patentability. A *prima facie* case of unpatentability is one which compels a conclusion that the claims are unpatentable under the preponderance of the evidence standard when the claims are given their broadest reasonable interpretation consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

A. Prior Art

Prior Art may consist of prior patents, published applications, printed publications, prior public uses in the U.S., prior public sales in the U.S., and sometimes even prior inventions by another or prior secret uses. All facts should be disclosed to your U.S. attorney for resolution of questions, and all doubts resolved in favor of disclosure.

B. Commonly Owned Disclosures/Co-pending U.S. Applications

It is especially important that all commonly owned prior art be promptly disclosed to the USPTO, such as related patents and publications and also co-pending U.S. applications. Even though such commonly owned patents and/or applications may not be "prior art" *per se*, they may be "material" to patentability, e.g., to the issue of "double patenting". In some situations, i.e., when co-pending applications are being cited, it may be advantageous to file a proprietary IDS in which case the contents of the information disclosure statement will not be open to the public; however, since nearly all newly filed U.S. applications are being automatically published, the use of proprietary IDS's are expected to decline, since the existence and contents of the co-pending applications will become public in any event.

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C. U.S. Published Applications

With the enactment of U.S. patent application publication at 18-months from the first filing date, which is effective for applications filed on or after November 29, 2000, disclosure requirements now include citing published U.S. patent applications.

D. Other Information and Standard of Materiality

Any other information which is known to render any pending claims of a patent application *prima facie* unpatentable must also be disclosed. This may include questions as to inventorship, information which may tend to contradict or cast doubt upon statements made in the application, unsuccessful experiments omitted from comparative data, and the like. As noted above, commonly-owned co-pending U.S. applications are especially important, even though they may not be "prior art".

III. TIME FOR SUBMITTING INFORMATION TO PTO

A. Within Three (3) Months of the U.S. Filing Date or Before First Office Action

An information disclosure statement will be considered untimely unless it is filed within three (3) months of the U.S. filing date of each application (original or PCT application entering national phase), or before issuance of the first Office Action, whichever comes later. Of course, the time at which the application will be examined cannot be accurately predicted. It is, therefore, particularly important to submit all known information within three (3) months of filing, especially commonly owned material.

NOTE: Even though only a search report (and no Office Action on the merits) has issued in the foreign country and even though you have not had any opportunity to evaluate the references in detail, all references cited in parallel foreign applications should be submitted immediately and automatically to the USPTO.

B. After the First Office Action

Information will not be considered at this time unless accompanied by either a statement of a sufficient reason or a fee as set forth in 37 CFR 1.17(p). Any statement of sufficient reason must aver either (1) that each item being submitted was first cited in a communication from a foreign patent office in a counterpart foreign application, dated not more than three months prior to the filing of the statement, or (2) that no item was known, to any individual responsible under the PTO Rules for its submission, more than three months prior to the filing of the statement.

C. After Allowance or Final Rejection or Action That Closes Prosecution But Before Payment of the Issue Fee

At this time, no information will be considered unless accompanied by a fee as set forth in 1.17(p), and a statement as described in item B. Since it may be difficult to meet these requirements, it is important to carefully analyze the art early in the prosecution of the application to determine whether the art raises a serious question of patentability or is closer than the art of record. If material prior art is discovered at this late stage of prosecution, it may be necessary to refile the application, e.g., by filing a Request for Continued Examination (RCE), in order to have the prior art considered by the PTO.

* If an application filed after May 29, 2000, is entitled to a patent term adjustment and a paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 is filed in the application, such a filing will not result in a reduction of patent term adjustment if it is accompanied by a statement that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart application *and that this communication was not received by any individual designated in § 1.56(c) more than thirty (30) days prior to the filing of the information disclosure statement.* This thirty-day period is not extendable (see 37 CFR § 1.704(d)). Therefore, in some instances an applicant should submit prior art cited in parallel applications within thirty (30) days, rather than the three (3) months otherwise provided, in order to obtain maximum patent term adjustment.

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D. After Payment of Issue Fee and Before Patent Issues

At this time, no information will be considered under any circumstances unless accompanied by a petition to withdraw the application from issue and to refile the application as a continuing application.

E. After the Patent Issues

In our opinion, it is not necessary to submit art discovered after the patent issues as a routine matter. However, if the art has a bearing on the patentability of the claims, consideration should be given to reexamination, reissue or other action. Such action is considered essential before licensing or other enforcement.

IV. PARTS NEEDED FOR COMPLETE INFORMATION DISCLOSURE STATEMENT

- A. Identification of document(s) or other item(s) of information and the relevant date or dates. When co-pending U.S. applications are cited, the serial number and filing date should be given.
- B. A copy of each document, including copies of U.S. co-pending applications and U.S. patent publications, or a full explanation of the circumstances if the information is not in documentary form.
- C. If the item is a non-English language document, any readily available English translation must be provided. If no translation is readily available, an abstract or other information or a concise explanation of the relevancy of the document which fairly apprises one of the relevancy of the reference must be submitted. The explanation should explain the relevance as it is understood by the individual best suited to understand such relevance. If the document was cited in a search report in a corresponding foreign application, submission of an English language version of the relevant portions of the search report shall suffice. You need not undertake a translation solely for this purpose, but note that a higher duty exists with respect to commonly owned references. In the case of patent references, if corresponding English language patents or applications are known, these must be provided to the PTO.
- D. No explanation of English language documents is required.
- E. If the art is cited after three (3) months from the U.S. filing date and after the issuance of a first Office Action, a fee or a statement excusing untimely submission as described in item B of Part III above is required.
- F. If the art is cited (1) after the application is allowed but before the issue fee has been paid, or (2) while the application is under final rejection or an action that closes prosecution, the documents described in item C of Part III above are required.

V. Submission of Information Disclosure Statement in Request for Continued Examination (RCE) Practice

Due to the streamlined processing for RCEs at the USPTO, it is expected that the examiner will issue an action on the merits well before three months from the filing date of the RCE. Since this is a continuing process, the USPTO takes the position that there was ample opportunity to file an IDS prior to filing of the RCE. Submission of an IDS should be done at the time of filing the RCE or must be done quickly. When filing a RCE, it is essential that:

- A. The IDS should be filed with the filing or very quickly after filing in order to precede the first or next Office action; or
- B. If more time is needed, simultaneously with filing the RCE, applicant may request a suspension of prosecution pursuant to 37 CFR 1.103, which is limited to three (3) months and requires payment of a fee.