

## **THE DUTY OF DISCLOSURE TO THE PATENT AND TRADEMARK OFFICE AND SIGNING OF THE PATENT APPLICATION**

### **A. DUTY OF DISCLOSURE**

Patent applicants, their assignees, and the attorneys prosecuting patent applications are all under a duty of candor in their dealings with the Patent and Trademark Office (PTO). Misstatements or omissions of material fact and a failure to cite known relevant prior art in connection with a patent application are grounds for rejection of a patent application by the PTO, and may render an issued patent unenforceable subsequent to issuance or create other liabilities. The duty to disclose material information extends not only to information known prior to or at the time of filing the application, but also to information acquired during prosecution of the application. The duty of disclosure continues until the patent is actually granted. The attached paper entitled Applicant's Duty of Disclosure to the U.S. Patent and Trademark Office should be carefully reviewed, and all relevant information brought to the attention of the patent attorney.

### **B. INVENTORSHIP**

The patent application must list the proper inventor(s) and this list must not include persons not actually inventors and must not exclude others who are. It may be necessary to call disputes or possible disputes about inventorship to the attention of the PTO.

### **C. BEST MODE**

The best mode known to the inventor of carrying out the invention at the time of filing must be set forth in the application. The requirement is violated where the inventor knew of a specific superior method of carrying out the invention at the time of filing the application and yet concealed it. Although this type of rejection is relatively rare during prosecution before the PTO, the question of disclosure of the best mode may be raised in patent infringement litigation.

### **D. REVIEW OF THE PATENT APPLICATION**

The inventor should review the patent application prior to signing to ensure the accuracy of the application. Care should be taken that inaccurate statements or inaccurate experiments are not introduced into the specification, either inadvertently or intentionally. For example, stating that an experiment "was run" or "was conducted" when in fact the experiment was not run or conducted could be a misrepresentation of the facts. No results should be represented as actual results unless they have actually been achieved. Paper or prospective examples should not be described using the past tense. Also, misrepresentations can occur when experiments are inaccurately reported in the specification, e.g., an experiment is changed by leaving out one or more ingredients.

The inventor should also recognize his or her responsibilities in signing the patent application declaration. The declaration should be carefully reviewed before it is signed. The person signing the declaration must review and understand the contents of the specification (including the claims), believe the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought, and acknowledge the duty to disclose information which is material to the examination of the application. The application must not be altered after signing. If changes should be made in the application, contact the attorney handling the application.

The claims of the application should be particularly reviewed to verify that they accurately cover the invention. Prior art known to the inventor which relates to features claimed in dependent claims should also be brought to the attention of the patent attorney even though features believed to be most important may be set out in the independent claims of this application.