Information Regarding Duty to Disclose

This memorandum explains the duty to disclose associated with your U.S. patent application under United States Patent and Trademark Office (USPTO) rules.

Who has a duty to disclose?

Everyone associated with filing or prosecuting the application owes a duty of candor and good faith to the USPTO. That obligation includes disclosing material information related to patentability of the pending claims. Examples of people subject to this duty include:

- each inventor;
- each attorney or agent who prepares or prosecutes the application;
- every other person who is substantively involved in the preparation or prosecution of the application; and
- individuals other than the attorney, agent, or inventor, who have disclosed information to the attorney, agent or inventor.

How do I satisfy the duty?

Your duty is satisfied by providing us with the relevant information. We will in turn review the information and submit it to the USPTO if necessary, via a document known as an Information Disclosure Statement (IDS).

What information should be disclosed to the USPTO?

You should disclose any publication of which you are aware that describes a device or method similar to that claimed in the patent application, or that discloses a significant concept or feature of the invention. Publications include, for example, printed documents such as patents, articles, promotional literature, user manuals, and conference proceedings; and electronic files publicly available anywhere on the Internet, the World Wide Web, or any other computer service or network.

Are publications and patents the only items that must be disclosed?

No. You should disclose any public use, public disclosure, sale, or offer for sale of the invention or any similar device that occurred anywhere in the world prior to the filing date of the application. A public use or disclosure is one made to others who are not under an obligation of confidentiality. Offers for sale may include promotional displays, marketing tests, price lists, beta tests, or other acts indicating an intent to commercialize the invention, whether made in public or under a non-disclosure agreement. You should also disclose any knowledge or use of the invention by others, of which you are aware, before your filing date.

Do you need copies of the relevant documents from me?

At a minimum, we need citations to the relevant documents that you have identified. Depending on the nature of the document cited, we may need to obtain a copy of the document from you or from a third-party source. If you do provide a copy of a relevant document, you should make sure that the copy of the material that you send us is legitimate and that you have complied with all third party rights, including copyrights, in obtaining the material. By forwarding any material to us, you are confirming that you have all necessary rights to do so, and we will rely on your representation in connection with our use and potential disclosure of the material to the USPTO. If you are not sure about whether you have the necessary rights, please let us know and we will work with you to obtain the document with all required rights.

Do I have to disclose my own publications or patents?

Yes. You should submit all publications, patents, and other information, even if you are the author or inventor.

Do I have to do a search for prior art?

No. You have to disclose only that material information of which you are actually aware. You do not have to search actively for such information. However, we suggest that you thoughtfully consider any publications you have access to, and any public uses, public disclosures, sales, and offers for sale that may have
been made by the company, by you, or by others
associated with you.

What happens if I fail to disclose information of which
I am aware?

Failure to make a full disclosure, as described above,
may seriously jeopardize the patent owner’s ability to
enforce any patent that might issue. Willful failure to
provide material information may cause any
subsequently issued patent to be unenforceable and
may result in an action for damages against the patent
owner. Where any doubt exists, we encourage you to
bring the relevant information to our attention so that
we can determine whether it should be disclosed to the
USPTO.

How long does the duty of disclosure last?

The duty of disclosure is an ongoing duty that lasts
throughout the pendency of the patent application.
Accordingly, if you become aware of any material
information at any time before the patent issues, you
should promptly forward it to us for timely submission
to the USPTO.

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