

MADAY PATENT LAW, PLLC Jeffrey J. Maday REGISTERED US PATENT ATTORNEY <a href="http://www.madaypatentlaw.com">www.madaypatentlaw.com</a>	Suite 200, Two Penn Center Plaza 1500 John F. Kennedy Blvd. Philadelphia, PA 19102 215-854-6427 (tel) 215-569-0216 (fax)
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**Subject: US IP law - duty of disclosure and duty of candor -**

### **Information To Let Your Patent Attorney Know About**

Dear Inventors:

The U.S. Patent and Trademark Office (USPTO) has 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.

Below are some items that you should disclose to your US patent attorney. US law imposes duties of disclosure. If we do not comply, there could be charges of inequitable conduct and possibly findings that render the US patent unenforceable. Many of the patent rules are complex and fact specific.

**Prior Publications:** Please disclose to us all relevant prior art publications.

Especially give to us all publications where an inventor is an author of the publication and the publication relates to the invention. Disclose to us any upcoming submissions of paper or articles and planned publication dates.

**Offers for Sale and Sales:** Disclose to us any prior sale or offer to sell a product or process using the invention. If a product defined by the claimed invention was offered for sale/sold in the United States more than one year before the filing date of the United States application, subject to some exceptions, the claimed invention cannot be patented in the United States. United States law may interpret sales activities entirely outside of the United States which would have an effect on the United States market to be a sale "in the United States".

**Public Use:** Disclose to us any public use of a product or process in the US using the claimed invention which occurred prior to the filing date of the US application.

**Commonly owned Disclosures/Co-pending U.S. Applications:** 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".

Commonly owned inventions are where at least one of the inventors is the same as at least one of the inventors of the application we are prosecuting.

5. **NON-US Patent Office dealings:** Send us all office actions, search reports, and references cited therein which you may receive from any patent office relating to the invention being claimed in the US application.

Please let me know if you have any questions.

Thank you,

Jeff Maday

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Appendix

The following is the Duty of Disclosure section from the uspto MPEP

[http://www.uspto.gov/web/offices/pac/mpep/documents/2000\\_2001.htm](http://www.uspto.gov/web/offices/pac/mpep/documents/2000_2001.htm)

**2001 Duty of Disclosure, Candor, and Good Faith - 2000 Duty of Disclosure**

**2001 Duty of Disclosure, Candor, and Good Faith**

**37 CFR 1.56 Duty to disclose information material to patentability.**

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be **material to patentability** as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) Prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

**(b)** Under this section, information is **material to patentability** when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
  - (i) Opposing an argument of unpatentability relied on by the Office, or

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(ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction 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.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
- (2) Each attorney or agent who prepares or prosecutes the application; and
- (3) Every other person 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.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

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**37 CFR 1.56** defines the duty to disclose information to the Office.