

The duty of disclosure – what it is, how and when to satisfy it | IP Frontiers

■ STEPHEN P. SCUDERI SPECIAL TO THE DAILY RECORD



Stephen P. Scuderi

Under U.S. law (i.e., 37 CFR § 1.56) each and every individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the United States Patent and Trademark Office (USPTO). This includes a duty to disclose to the USPTO all information known to that individual to be material to patentability of any claim in a pending application. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned or the application issues as a patent. However, how to satisfy the duty to disclose, what needs to be disclosed, and when, can be confusing. Hopefully, this paper will help clear some of that confusion up.

Basically, information is material to patentability if:

- it could be used by an examiner to reject a claim of the application; or
- it refutes a statement made by an individual to the USPTO during prosecution.

This includes, for example, any patents and publications that are material to the claims of an application, any previous selling or public disclosures of the claimed invention, or any inventorship conflicts.

The duty of disclosure applies to inventors, attorneys or agents who help with the application, or any person who is substantively involved with the application. Individuals other than the attorney, agent or inventor may satisfy their duty of disclosure by disclosing the material information to the attorney, agent or inventor. However, the duty to disclose all information known to be material to patentability is satisfied if all such material information was cited by the USPTO during prosecution of the application or submitted to the USPTO in an Information Disclosure Statement (IDS) in accordance with 37 CFR § 1.97 (herein “§ 1.97”) and 37 CFR § 1.98 (herein “§ 1.98”).

The content requirements of filing an IDS are governed by § 1.98. It is strongly encouraged by the USPTO to use their forms PTO/SB/08A and 08B, titled: “Information Disclosure Statement”, because those forms are formatted to meet the content requirements of § 1.98.

The timing requirements of filing an IDS are governed by § 1.97. The USPTO encourages the filing of an IDS

as early in the prosecution process as possible to enable an efficient and thorough examination of the claims and to avoid potential fees associated with § 1.97. However, filing early in the prosecution process is not always possible for several reasons. For example, prior art may be discovered by the inventor or attorney well into the prosecution process. Additionally, an application in the U.S. may have several counterpart foreign applications, wherein foreign patent offices may cite related material references very late in the U.S. prosecution process. Therefore, the timing requirements under § 1.97 will be discussed in some detail herein.

Any information submitted in an IDS will be considered by the USPTO if it meets the content requirements of § 1.98 and is filed within the time limits described in one of paragraphs (b), (c) or (d) of § 1.97. Each of those paragraphs describe situations that are successively later into the prosecution process and, therefore, have requirements that are successively more stringent or expensive to meet.

Under paragraph (b) of § 1.97, an IDS must be considered by the USPTO if it is filed within the following time periods:

- (1) within three months of the filing date of a national appli-

cation other than a continued prosecution application;

- (2) within three months of the date of entry of the national stage in an international application;
- (3) before the mailing of a first Office action on the merits;
- (4) before the mailing of a first Office action after the filing of a request for continued examination (RCE); or
- (5) within three months of the date of publication of the international registration in an international design application.

Note, items 2 and 3 in the above list can be very helpful. They say that any material reference, whether foreign or domestic, must be accepted by the USPTO in an IDS as long as it's filed before the first office action (item 2 above), or as long as it's filed before the first office action after an RCE is filed (item 3 above). Therefore, no matter how late in the U.S. prosecution process a material reference is discovered, unless the application has already issued, the reference can always be submitted in an IDS by first filing an RCE to reset the prosecution. Of course, one must pay the fees associated with the RCE, which can be substantial. However, avoiding the consequences of not meeting the duty of disclosure can easily outweigh the disadvantage of paying the RCE filing fees.

Paragraph (c) of § 1.97 describes situations that are later in the prosecution process than paragraph (b). Under paragraph (c) an IDS shall be considered by the USPTO if filed after the period specified in paragraph (b), provided that the information disclosure statement is filed before the mailing date of any of a final office action, a notice of allowance, or an action that otherwise closes prose-

cution in the application, and it is accompanied by one of:

- (1) The statement specified in paragraph (e) of 1.97; or
- (2) The fee set forth in 37 CFE 1.17(p).

The statements specified in paragraph (e) are as follows:

- (1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or
- (2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 1.56(c) more than three months prior to the filing of the information disclosure statement.

Note that under paragraph (c) one has a choice of paying a fee or making a statement. However, one cannot always make the statements listed in (e), so paying the fee may be the only way to file the IDS, other than filing an RCE.

Paragraph (d) describes situations that are even later in the prosecution process. Under paragraph (d), an information disclosure statement shall be considered by the Office if filed by the applicant after the pe-

riod specified in paragraph (c), provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

- (1) The statement specified in paragraph (e); and
- (2) The fee set forth in 1.17(p).

It is important to note that under paragraph (d), one has no choice and must pay the fee plus make the statement. Also, paragraph (d) does not apply during the period of time after the issue fee has been paid and before the patent has issued. When one cannot make the statements in (e) or if the issue fee has already been paid and the patent has not issued, then the only way to have the IDS considered by the USPTO is to file an RCE.

With regards to good practice tips, it is important that:

- All individuals that have a duty of disclosure under 37 CFR 1.56(c), especially foreign applicants and foreign attorneys, clearly understand their duty of disclosure.
- Any submissions in an IDS should be made as soon as reasonably practicable.
- In cases where there is a question of materiality, the information should be submitted for consideration by the examiner.
- Clearly irrelevant and cumulative information should not be submitted in an IDS.

Stephen P. Scuderi is an associate with the law firm of Heslin Rothenberg Farley & Mesiti P.C. His practice involves all phases of intellectual property law, including the drafting of hundreds of patents in the electrical and mechanical arts. Stephen can be reached at (518) 452-5600 or at stephen.scuderi@hrfmlaw.com.