

Revisiting the Duty of Disclosure and How Best to Comply: A Refresher

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Basics

Everyone who participates in filing and prosecuting a patent application encounters the Duty of Disclosure, whether you be an inventor, a technology group manager, inside intellectual property (IP) counsel, or inside litigation counsel (hopefully this is not your first encounter!). Most of the information here is pretty basic, but it is worth a revisit from time-to-time. Also, there are some proposed new procedures in the U.S. Patent Office that promise to make complying a little less worrisome and a little less expensive.

As all patent owners know, during the prosecution of a patent application, it is required that prior art be disclosed to the U.S. Patent Office. Prior art is any information that was public knowledge before the filing of the patent application that could bear on the patentability of the claims. Prior art can be any publically available information, including issued patents (worldwide), patent publications (worldwide), web site pages, seminar presentations, academic theses, and so on.

"Rule 56", more formally known as [37 CFR 1.56](#), describes the duty to disclose in detail.

Background Regarding Compliance

Policies

There are various approaches to compliance that sometimes depend on the size of the patent applicant company. For example, some very large companies train their technical staff to refrain from searching prior art based on an "if you don't know you can't trigger the duty" theory. This makes sense in a very large company for a couple of reasons. For one thing, if there are hundreds of technical experts looking at possible prior art and emailing their initial opinions around the company or even outside the company

without looping in corporate counsel, it invites a possible later patent invalidation based on non-disclosure under Rule 56.

For small to mid-size companies, compliance is arguably more manageable provided technical staff is briefed on what Rule 56 means and how important it is to comply. As stated in the Rule, everyone involved in the prosecution of a patent application is implicated in the Rule. That said, inventors, technical managers, and corporate legal staff should be made aware that if they encounter a disclosure that reminds them of their latest inventions, they should let corporate legal staff or outside Intellectual Property (IP) counsel know.

Regardless of the company size or technology focus, it is smart to have a policy in place for compliance with Rule 56.

Logistics Overview

Once everyone who is implicated by the Rule has been made aware of its existence, there should be a route for reporting possible prior art to a manager, inside counsel, or outside counsel. The attorneys prosecuting the patent application then can file one or more Information Disclosure Statements (IDS) to the U.S. Patent Office so that the references will be considered by the assigned Examiner. Although the Examiner does a prior art search before examining the application, it is very useful to present any known possible prior art to the examiner as soon as possible so that it can be considered during the prosecution of the patent application.

Domestic Counterpart Applications

Any U.S. Patent Application that can be considered to be related is fair game for having all of the references cited by the U.S. Patent Office cited in every other related U.S. Application. Whether to cite individual references is technically a judgement call, meaning that the prosecuting attorney can determine whether each reference is relevant such as to be implicated by Rule 56. In reality of course, this detailed analysis of each reference is typically not practical because of cost restraints. Partly as a result of this, the default has evolved to be "disclose everything".

"Disclose everything" in some cases has meant patent applicants performing prior art searches and disclosing the resulting 100+ references to the U.S. Patent Office. Some companies have even mandated that all office actions from the U.S. Patent Office be disclosed verbatim. This seems to be mainly a long-term strategy anticipating litigation. However, it is unlikely that anyone analyzed 100+ references, including anyone implicated by Rule 56 on the applicant side or the Examiner on the U.S. Patent Office side.

Foreign Counterpart Applications and Foreign References

As the Rule states, references are considered worldwide. That is to say if a person implicated under the Rule is aware of a reference in a foreign country that was publically available before the filing of the U.S. Patent Application, that reference falls under the rule.

Similarly, if there are foreign counterparts to the U.S. Patent Application, any reference not cited in the

U.S. but cited in the foreign jurisdiction must be reported to the U.S. Patent Office.

Practical Tips for Compliance

1. It does not take a lot of time to gather the relevant people implicated by the Rule and decide on a policy for compliance that fits the size of the company and the company's manner of sharing information.
2. Understand that this requirement is a serious one, and takes a bit of thought and expense, but once an established policy is in place it is much smoother and less expensive.
3. **BRIGHT SPOT:** [The U.S. Patent Office](#) has recently announced that it may automatically cross-cite references from related patent applications. This would reduce the cost of complying and the risk of something getting "missed".



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