

Knobbe Practice Webinar Series: Strategic Considerations in Applicant Duty of Disclosure and Information Disclosure Statement (IDS) Submissions

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Duty of Disclosure (and Candor and Good Faith)

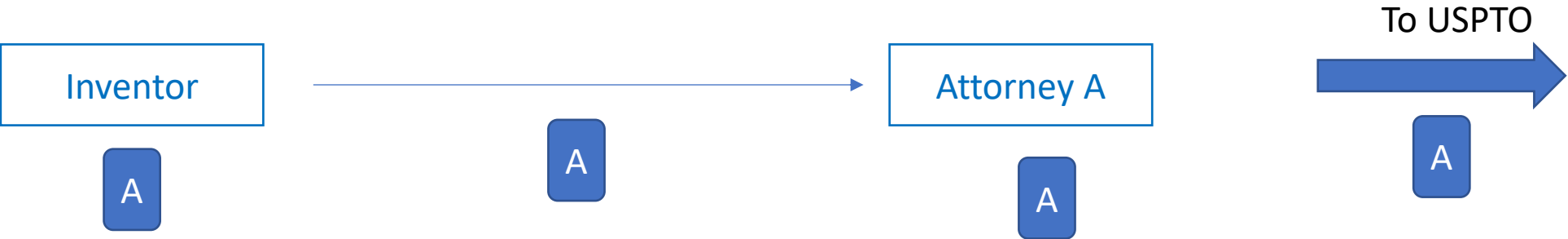
- **37 CFR 1.56 – Rule 56**
- Each **individual associated** with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a **duty to disclose** to the Office all information known to that individual to be **material to patentability**.
- Duty of Disclosure satisfied if:
 - 1) **cited by the Office**, or
 - 2) submitted to the Office.

Who owes a Duty of Disclosure?

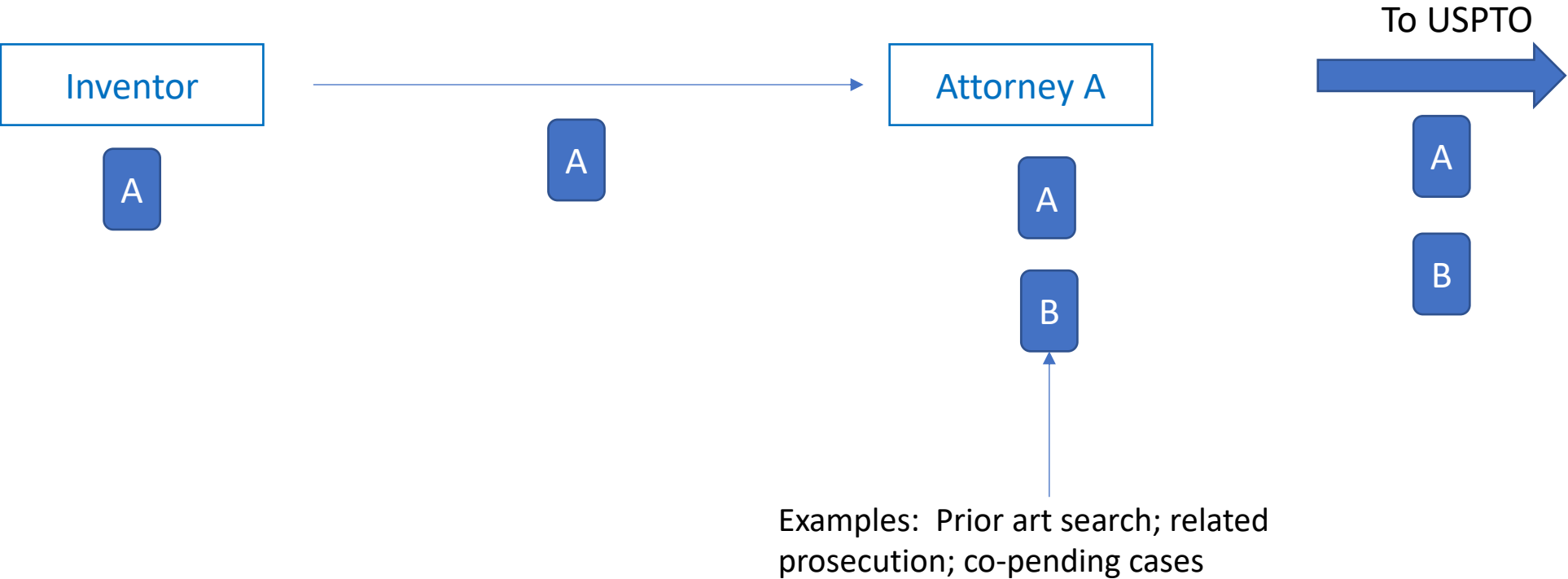
Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (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, the applicant, an assignee, or anyone to whom there is an obligation to assign the application.

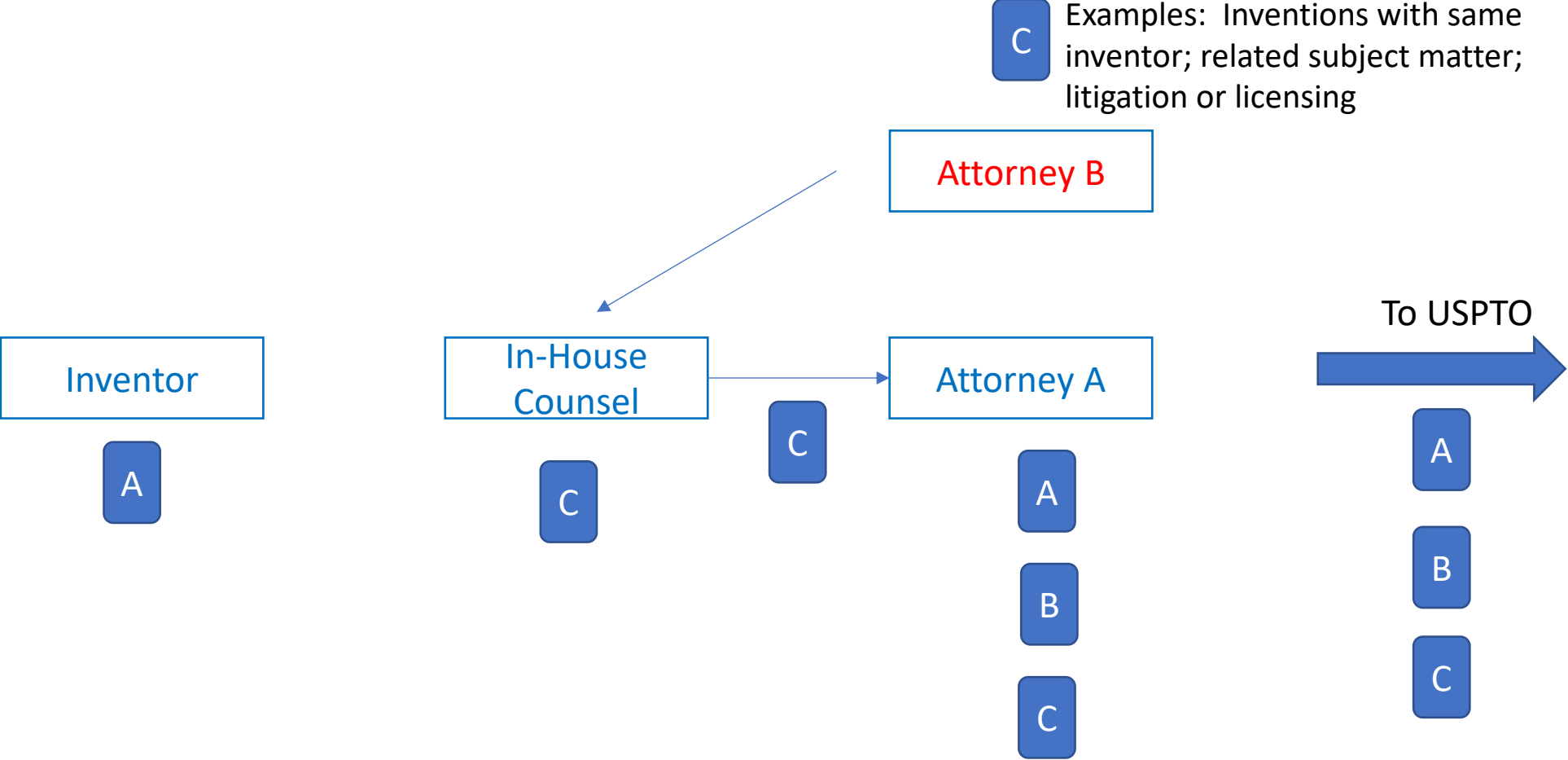
Duty of Disclosure - Scenarios



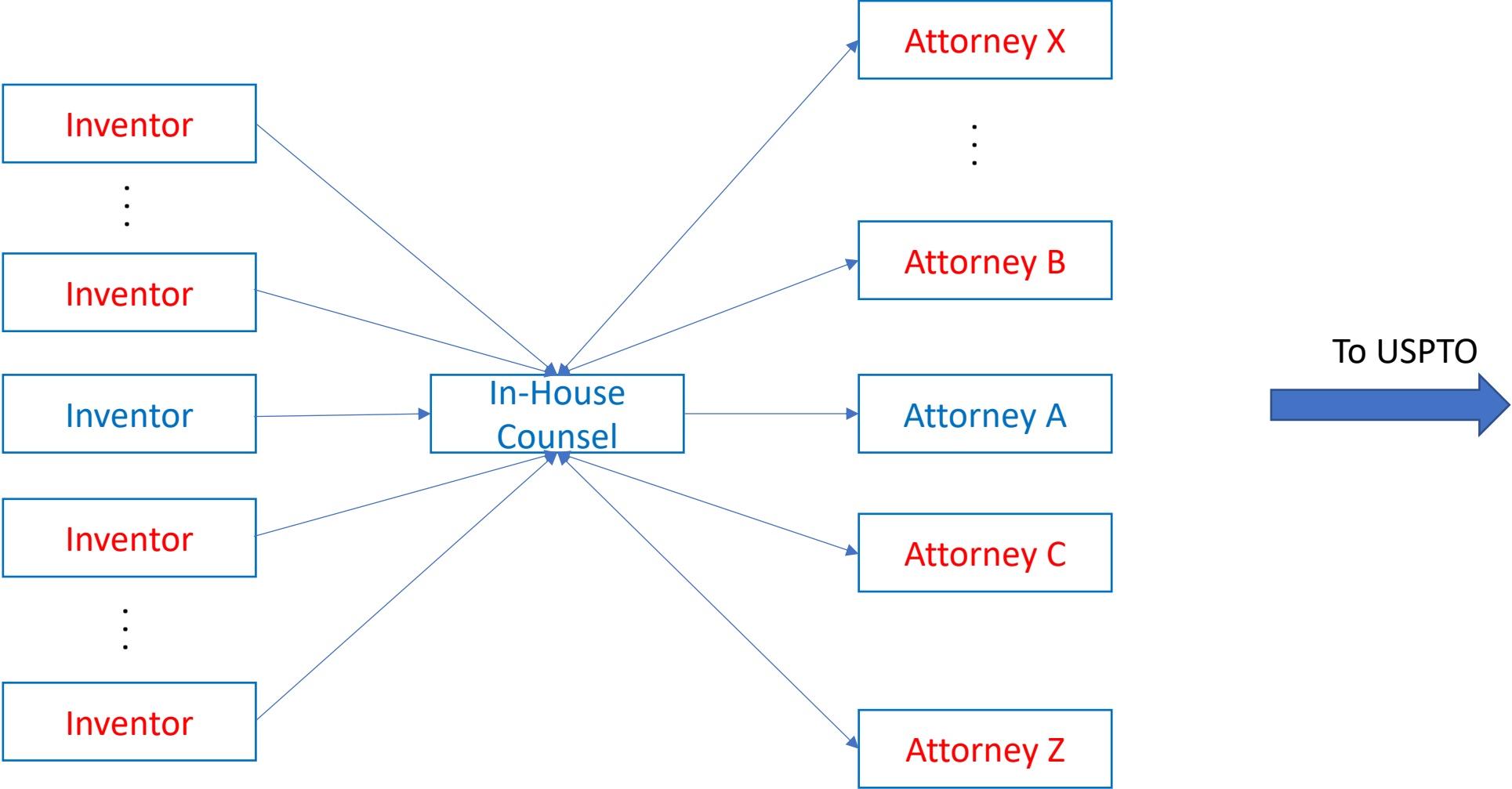
Duty of Disclosure - Scenarios



Duty of Disclosure - Scenarios



Duty of Disclosure - Scenarios



Inequitable Conduct – Evolution

Before, those accused of infringement often responded by accusing the patent holder of “inequitable conduct” in obtaining the patent—typically by alleging that relevant prior art was withheld from the patent office.

Old rule: Disclose any information “where there is a substantial likelihood that a reasonable examiner would consider it important in deciding” patentability.

Rule 56 and Inequitable Conduct



Inequitable Conduct – Post-*Therasense*

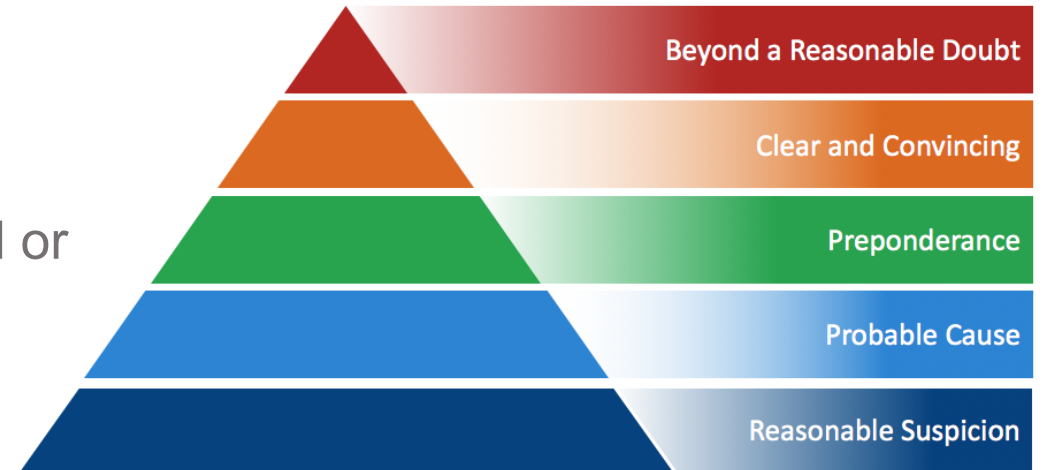
Intent

- 1) Applicant knew of the reference,
 - 2) knew it was material, and
 - 3) made a deliberate decision to withhold it.
-
- No sliding scale, may not infer intent from materiality
 - May infer intent from indirect and circumstantial evidence
 - Specific intent to deceive must be the single most reasonable inference

Inequitable Conduct – Post-*Therasense*

Materiality

- “But-for” materiality. Would the knowledge have prevented the Patent Office from allowing the claim?
- Information is material to patentability when it is **not cumulative** to information already of record or being made of record in the application
- Preponderance of the evidence standard
- Broadest reasonable interpretation
- Different from invalidity standard (clear and convincing, ordinary meaning)



Compliance with Duty of Disclosure

Sources of Law

Multiple types of law in the U.S.

- Napoleonic approach (statutes)
- Anglo-Saxon approach (judge-made law)
- Byzantine approach (regulations)

For the duty of disclosure, case law led the way

- Regulations now generally conform

Submission of Information

IDS – Information Disclosure Statement

[37 CFR 1.97](#)

[37 CFR 1.98](#)

[MPEP 609](#)

IDS Best Practices

Develop a **practical** process

- Can be (relatively) automatic after initial set-up
 - Cross-citing of related/similar applications
- Not too burdensome on Inventors/IP Staff
 - Cross-citing patent families vs. categorization of all prior art
- Does not result in too many references per application
 - Product category vs. product feature
- Apply materiality filter (e.g., for cross-referenced applications)?
 - Determine at the outset

So that you can **stick to the process**

Submission Timing

IDS submission treated differently during three phases of prosecution:

1. Initial – with filing / within 3 months / prior to 1st Office Action
 - No fee
2. Examination – up to allowance
 - Statement OR Fee (\$240 LE)
3. After Allowance and Prior to Payment of Issue Fee
 - Statement AND Fee

IDS Best Practices

Is it worth making either of these “statements” to avoid the IDS fee in time periods 2 or 3?

- 1) “First cited” in “communication from foreign patent office in a counterpart foreign Application” within last 3 months
- 2) Statement 1 does not apply AND “to the knowledge of the person signing the certification after making reasonable inquiry, no item . . . was known to any individual designated in § [1.56\(c\)](#)” within last 3 months

We will sometimes make Statement (1) after allowance.

We do not recommend Statement (2); before allowance, pay the fee.

IDS Best Practices

1. Submit with Initial Filing

Closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines

- Pre-Filing Patentability Search Results
- Institutionally Known Prior Art
 - Predecessor/Benchmark Own Product(s) & Patent Documents (incl. applications)
 - Predecessor/Benchmark 3rd Party Product(s) & Patent Documents
 - Relevant Non-Patent Technical Literature
- Other Information
 - Especially possible prior public uses, sales, offers to sell
 - Purchase (sale) of Prototype

IDS Best Practices

2. Submit during examination

- Information from related prosecution
 - Decide whether to submit reports/office actions or just prior art
- Information from related litigation and/or trial proceedings
 - prior art
 - search/exam reports/office actions
 - **inconsistent statements**
- Timing – after 1st Office Action:
 - Pay IDS Fee
 - Do not use Statement

IDS Best Practices

3. Submit after allowance

- Materiality determination:
 - If Material or Possibly Material – File RCE
 - If Clearly Not Material – Submit for placement in file history
- Before Issue Fee
 - Simply file RCE
- After Issue Fee
 - Withdrawal from Issue – Petition with RCE
 - QPIDS – requires Statement and conditional RCE

IDS – Resolving Potential Problems

What if an examiner complains you are citing too much?

What if you discover an un-cited reference?

- is it cumulative?
- submit for the file?
- partial certification?

IDS Best Practices

Continuing Applications:

1. Initial Disclosure

- Information from Phases 1-3 of Parent
- Information not submitted in Parent (too late – after payment of issue fee)

2. Examination

- same as original application

3. Post-Allowance

- same as original application

Types of Information



Technical Prior Art



Other Information

Technical Prior Art - Categories



PATENT PUBLICATIONS



PRODUCTS/PRODUCT
LITERATURE



TECHNICAL
PUBLICATIONS

Other Information



INFORMATION ON
ENABLEMENT



POSSIBLE PRIOR
PUBLIC USES, SALES,
OFFERS TO SELL



DERIVED KNOWLEDGE



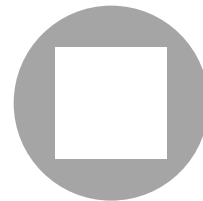
PRIOR INVENTION BY
ANOTHER



INVENTORSHIP
CONFLICTS



LITIGATION
STATEMENTS



OTHER

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