

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)

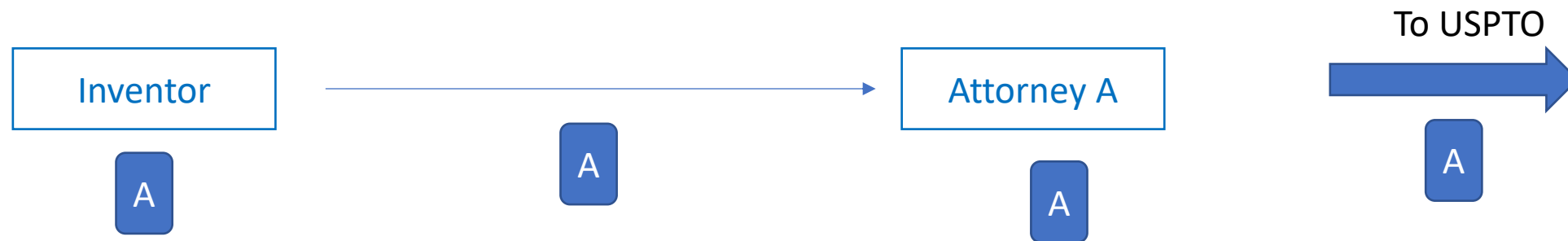
- **37 CFR 1.56 – Rule 56**
- Each **individual associated** with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a **duty to disclose** to the Office all information known to that individual to be **material to patentability**.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

Who owes a Duty of Disclosure?

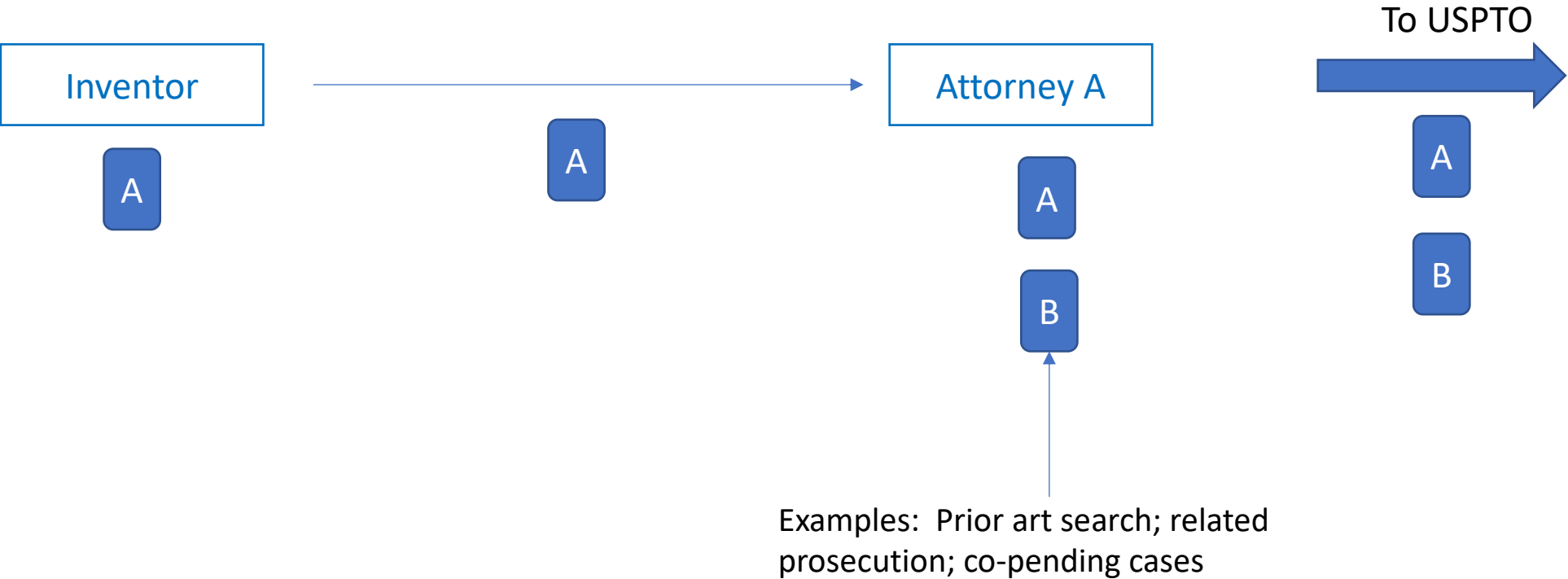
Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (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.

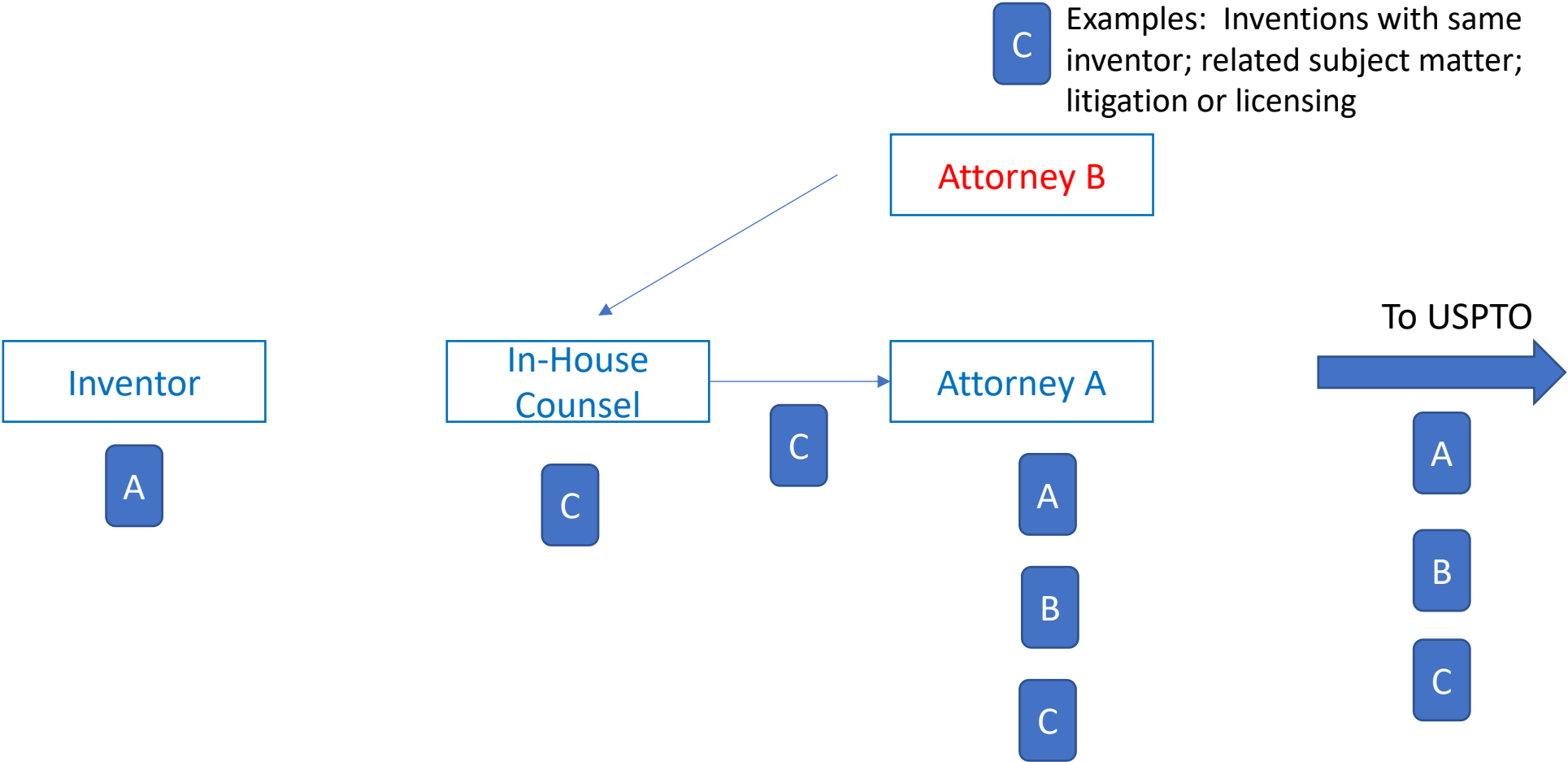
Duty of Disclosure - Scenarios



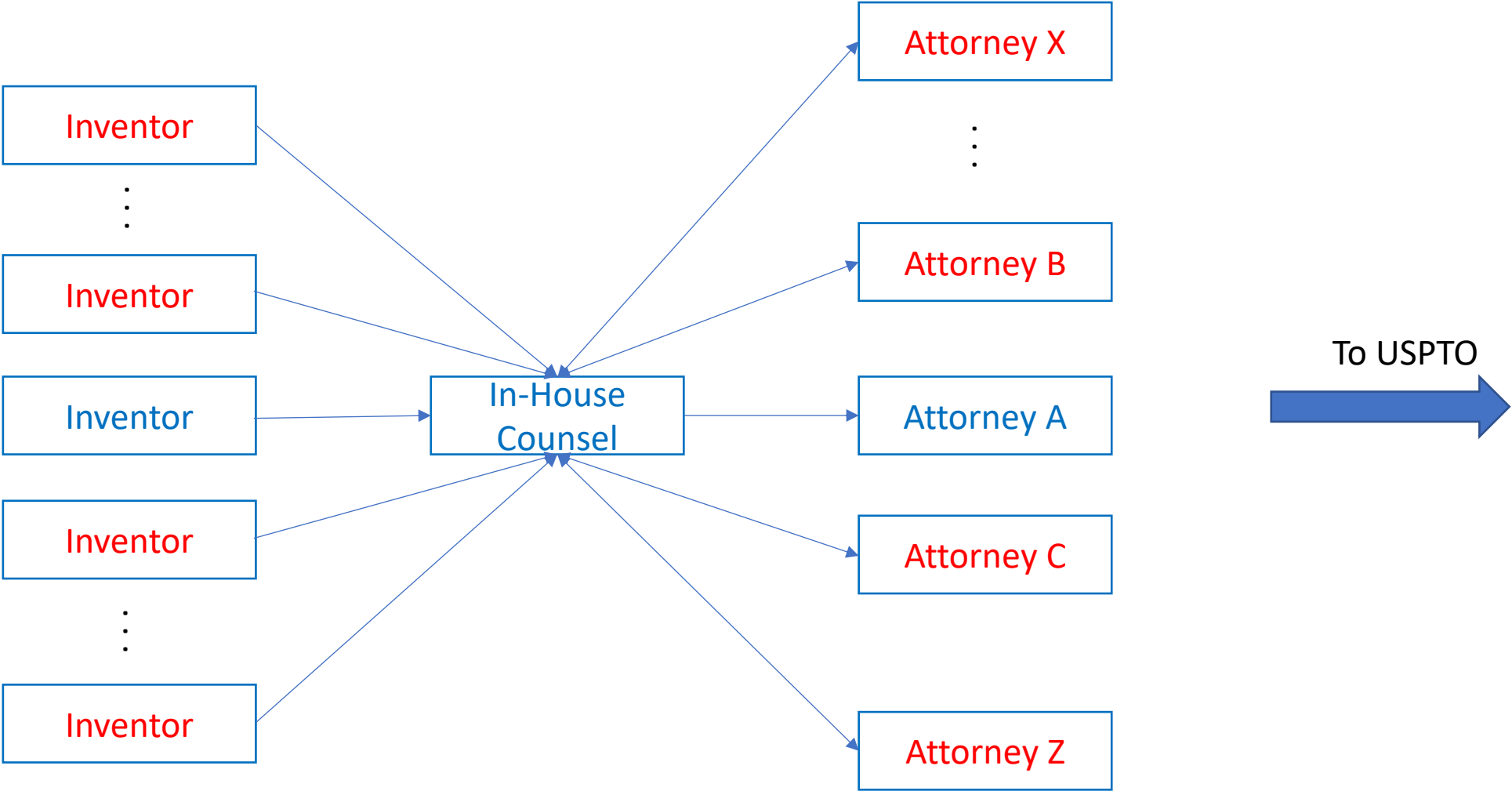
Duty of Disclosure - Scenarios



Duty of Disclosure - Scenarios



Duty of Disclosure - Scenarios



Rule 56 and Inequitable Conduct



Intent

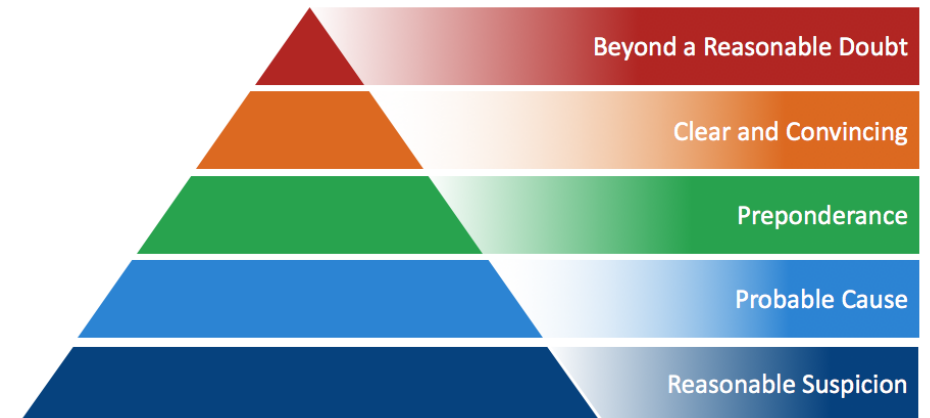
- 1) Applicant knew of the reference,
- 2) knew it was material, and
- 3) made a deliberate decision to withhold it.

- 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 Patent Office have allowed the claim if it had been aware of the undisclosed reference?
 - 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
 - Higher than current (Patent Office) Rule 56 standard
 - Lower than invalidity standard (clear and convincing, ordinary meaning)



Compliance with Duty of Disclosure

Submission of Information

IDS – Information Disclosure Statement

37 CFR 1.97

37 CFR 1.98

MPEP 609

Submission of Information

Timing of Disclosure:

- 1) Within 3 months of Filing (RCE)/Before First Office Action
 - No Fee
- 2) Prior to Final Office Action or Notice of Allowance
 - Statement OR Fee (\$240 LE)
- 3) After Allowance and Prior to Payment of Issue Fee
 - Statement AND Fee

Submission of Information

Statement – either:

- 1) First Cited in Counterpart Foreign Application within 3 Months, or
- 2) No Item Known by Any Individual for More Than 3 Months.

We will sometimes make Statement 1 – after Allowance, but do not recommend Statement 2.
Before Allowance – pay the Fee.

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**

IDS Best Practices

Three Phases:

1. Initial – Pre-Filing/Filing/Within 3 Months/Prior to 1st Office Action
2. Examination – Examination up to Allowance
3. Post-Allowance

IDS Best Practices

1. Initial Disclosure:

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. Examination:

- Information from Counterpart Foreign Applications
 - Information relating to or from Copending US Patent Applications
 - Information from Related Litigation and/or Trial Proceedings
 - prior art
 - search/exam reports/office actions
 - **inconsistent statements**
- Decide whether to submit reports/office actions or just prior art

IDS Best Practices

2. Examination:

- Timing – after 1st Office Action:
 - Pay IDS Fee
 - Do not use Statement

IDS Best Practices

3. Post-Allowance:

- Same information as Phase 2 Examination
- Timing:
 - Before Issue Fee
 - After Issue Fee

IDS Best Practices

3. Post-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 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



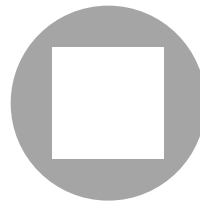
PRIOR INVENTION BY
ANOTHER



INVENTORSHIP
CONFLICTS



LITIGATION
STATEMENTS



OTHER

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