Duty of Disclosure and Duty of Reasonable Inquiry

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Duty of Candor and Good Faith (37 CFR 1.56(a))

- 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.
- This duty includes the duty to disclose all information known to be material to patentability.

Duty of Disclosure

Who has the duty to disclose? (37 CFR 1.56(c))

- "Individuals associated with the filing or prosecution of a patent application"
  - The inventor(s)
  - Attorney(s)/agent(s) who help with the application
  - Every other person who is substantively involved with the application
- Federal Register: Duties of Disclosure and Reasonable Inquiry During Examination, Reexamination, and Reissue, and for Proceedings Before the Patent Trial and Appeal Board (July 29, 2022)

Duty of Disclosure

What needs to be submitted? (37 CFR 1.56(b))

- Information that is “material” to patentability
- Information is “material” if:
  - It could be used by an examiner to reject a claim of the application; OR
  - It refutes a statement you made to the Office

Duty of Disclosure

What needs to be submitted? (MPEP 2001.06)

- Materiality is not based on the source of or how you become aware of the information.

Duty of Disclosure

- What needs to be submitted?
- Examples
  - Patents and publications material to your invention
  - Any previous selling or publicizing of the invention to the public
  - Inventorship conflicts

Duty of Disclosure

How do I submit information?

- Information should be submitted via an information disclosure statement ("IDS").
  - The IDS should be filed as early in prosecution as possible to avoid potential fees, see 37 CFR 1.97 for the full timing requirements.
  - Use of forms PTO/SB/08A and 08B, "Information Disclosure Statement," is encouraged to meet the content requirements of 37 CFR 1.98.
    - The form is available at: www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012
- For more information on IDS practice, see MPEP 609.
  - www.uspto.gov/web/offices/pac/mpep/mpep-0600.pdf

Duty of Disclosure

How do I submit trade secret, proprietary, and/or protective order materials? (MPEP 724)

- The submission must include:
  - An envelope or container that is clearly labeled as "Trade Secret," "Proprietary," or "Subject to Protective Order"
  - A transmittal letter with same identifying information
  - Petition to expunge under 37 CFR 1.59
  - Fee under 37 CFR 1.17(g)

Duty of Disclosure – Tips (MPEP 2004)

- Make sure all 1.56(c) individuals, especially foreign applicants and attorneys, understand their duty of disclosure.
- Submit information promptly.
- ***In close cases***, it is safest to submit the piece of information for consideration by the examiner.
- Avoid large information disclosure submissions (e.g., eliminate clearly irrelevant and cumulative information).

37 C.F.R. § 11.18(b) Certifications and Duty of Reasonable Inquiry

- "Presenters" of papers to the Office make several certifications to the Office by operation of 37 C.F.R. § 11.18(b).
- "Presenting" means signing, filing, submitting, or advocating. *See* 37 C.F.R. § 11.18(b).

Certifications under 37 C.F.R. § 11.18(b) (Part 1 of 2)

- A presenter certifies that all statements of the presenter's own knowledge are true.
- A presenter certifies that all statements made upon "information and belief" are believed to be true.
- A presenter acknowledges that 18 U.S.C. § 1001 is in play.

See 37 C.F.R. § 11.18(b)(1).

Certifications under 37 C.F.R. § 11.18(b) (Part 2 of 2)

A presenter certifies that, to the best of his or her knowledge, information and belief, formed after an inquiry reasonable under the circumstances:

- Factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery
- Factual denials have evidentiary support, or if specifically so identified, are reasonably based on a lack of information or belief
- Legal arguments are supported by existing law or a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law

See 37 C.F.R. § 11.18(b)(1)

Duty of Reasonable Inquiry under 37 C.F.R. § 11.18(b)

- Presenter's knowledge, information and belief are to be *". . . formed after an inquiry reasonable under the circumstances . . . ."*
- What is "reasonable under the circumstances" depends on the particular facts of each case.

Potential Adverse Consequences for Violating § 11.18(b) Certifications

- Include but not necessarily limited to:
  - Less probative value being given to offending paper
  - Striking of the offending paper
  - Precluding a party from presenting or contesting an issue
  - Terminating the proceedings
  - Referring a presenter-practitioner's conduct to the Office of Enrollment and Discipline (OED) for action (e.g. investigation and institution of formal disciplinary action for alleged violation(s) of the USPTO Rules of Professional Conduct)

See 37 C.F.R. § 11.18(c) and (d).

Referrals of Practitioners to OED

Some provisions of the USPTO Rules of Professional Conduct

- 37 C.F.R. §§ 11.101 (competence) and 11.103 (diligence)
- 37 C.F.R. §§ 11.303 (candor toward the Office) and 11.804(c) (dishonesty, fraud, deceit, misrepresentation)
- 37 C.F.R. § 11.804(d) - (conduct prejudicial to patent examination/issuance process)

Disciplinary Decisions Providing Guidance

- *In re Tendler,* D2013-17 (Jan. 8, 2014)
- *In re Anonymous,* D2014-05 (Apr. 1, 2014)
- *In re Hicks,* D2013-11 (Sep. 10, 2013)
- *In re Bollman,* D2010-40 (Oct. 19, 2011)
- *In re Janka,* D2011-57 (Nov. 21, 2011)
- *In re Hao,* D2021-14 (Apr. 2, 2022)
- *In re Han,* D2022-23 (Jan. 6, 2023)

Available at https://foiadocuments.uspto.gov/oed/


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