The Limited Monopoly

The Whole Truth and Nothing But the Truth: The Duty of Candor in Proceedings before the U.S. Patent and Trademark Office

Basic Principles

The prosecution of a patent application in the U.S. Patent and Trademark Office is an *ex parte* proceeding. This means that with few exceptions, the process of examination of a patent application occurs on behalf of only one party (the applicant), without any input from another party with an adverse interest (such as a competitor). Thus the only information that patent examiners consider in determining patentability of inventions is what they discover in their own searches, and what the applicants voluntarily provide to them.

In order to protect the public interest, the Patent Office has codified rules regarding the "Duty of Disclosure, Candor, and Good Faith" in all dealings by applicants, inventors, and practitioners with the Office. "Rule 56"[1] states as follows:

> *"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 all information known to that individual to be material to patentability..."*

Information is considered "material to patentability" when it a) it establishes by itself or in combination with other information a *prima facie* case of unpatentability of a claim in the application, or b) it refutes or is inconsistent with a position the applicant takes in asserting an argument of patentability, or opposing an argument of unpatentability relied on by the Office.

The "individuals associated with the filing and prosecution of a patent application" are defined as a.) each inventor named in the application; b) each agent or attorney who prepares or prosecutes the application; and c.) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, assignee, or anyone to whom there is an obligation to assign the application.

So what does this all mean? It boils down to a few simple principles.

Don't hide what's true.

Although it is advisable to perform a search prior to submitting a patent application, the applicant/inventor is not required to do so. However, in the event that a search is done, or in the normal course of R&D on the invention, if information is discovered that is material to patentability, it *must* be submitted to the Patent Office for consideration by the Examiner.

> ***"What if you're not sure a piece of information is material to patentability? A simple principle: When in doubt, submit it to the Patent Office."***

Typical sources of "prior art" information are patents/published applications, journal articles, web publications, competitors' sales literature, and trade shows. (In addition to "prior art," material information may relate to enablement, possible prior public uses, sales, offers to sell, derived knowledge, invention by another, and inventorship conflicts[2].)

So what if you're not sure a piece of information is material? Here's another simple principle: when in doubt, get it out. Submit it, along with any other material information, in an Information Disclosure Statement to the Patent Office. Having the Examiner consider it will ultimately result in a stronger patent if the application is allowed to issue.

More importantly, if the patent is ever litigated, it will avoid questions of materiality and inequitable conduct. You might think "oh, this information is so obscure, nobody will find it." Don't count on it. In a lawsuit, opposing counsel will hire a squad of professional searchers, and they will dig like a pack of Jack Russells in a tight foxhole. And

if they do find it, not only will the validity of your patent be challenged because the Examiner didn't have it to consider, but you may be dealing with charges of inequitable conduct or fraud if it is discovered that you knew of the information but withheld it. The end result can be a ruling that your patent is unenforceable.

Don't submit what's false.

The second prong of the duty of candor is to refrain from submitting false information in a patent application, or in any supporting documents during prosecution. One example of false information is the practice of representing "paper" (theoretical) examples of the invention in the application as work that was actually done. Paper examples should never be described using the past tense, which implies that experiments were performed to achieve the stated results.

Another example is the submission of false information during prosecution. In one recent case, *Frazier v. Roessel Cine Photo Tech, Inc., et al.* [3], Frazier had obtained a patent directed to a camera lens that achieved increased depth of field. Subsequently, Frazier sued Roessel Cine Photo Tech for infringement of its patent. During prosecution, Frazier had submitted a video purportedly taken using the camera lens of the invention in support of their arguments for patentability. Trouble was, the video was shot with a different lens that was *not* of the invention. And this came out at trial. Bad news for Frazier. The court ruled the patent to be unenforceable due to inequitable conduct... and also awarded attorneys fees to Roessel. *Ka-chinggg.*

Sleep well.

Obtaining a patent is a challenging business task. If you finally succeed, you don't want it tainted by something questionable that you did or didn't do along the way. Exercising your duty of candor according to the rules will make your patent stronger. And make you sleep better as well. ❑

---

1. 37 CFR 1.56
2. Manual of Patent Examining Procedure, §2001.05
3. CAFC, Nos. 04-1060 and -1092, 8/2/2005.

Authors John M. Hammond P.E. (Patent Innovations, LLC www.patent-innovations.com) and Robert D. Gunderman P.E. (Patent Technologies, LLC www.patentechnologies.com) are both registered patent agents and licensed professional engineers. They offer several courses that qualify for PDH credits. More information can be found at www.patenteducation.com. ***Copyright 2006 John Hammond and Robert Gunderman, Jr.***

Note: This short article is intended only to provide cursory background information, and is not intended to be legal advice. No client relationship with the authors is in any way established by this article.