

Duty of Disclosure Requirement

Failure to disclose relevant information to the United States Patent and Trademark Office (USPTO) can result in a patent becoming invalid and unenforceable.

Everyone involved in the filing and prosecution of a US patent application has a duty to disclose to the USPTO all information which is relevant in assessing the patentability of the invention which is the subject of the patent application. This applies not only to the inventor(s) but also to anyone else who is involved with the patent application.

Information is considered to be “relevant” if the US examiner is likely to need to take it into account when examining the application, e.g. if it may arguably render any claim unpatentable. If there is any doubt about relevance, it is advisable to disclose the information so that the Examiner may have the chance to consider all possibly relevant information.

In order that we may comply with this duty of disclosure requirement, please could you let us know if you have any information relating to “prior art”, i.e. acts occurring before the priority date of the application. As a general guide, the following categories of information should be considered:

- i) patents or other published documents relating to the invention or to the technical field of the invention;

- ii) products or processes, either yours or someone else's, which are similar to your invention;
- iii) other US patents or patent applications which you may have in the same area of technology;
- iv) any other information which you think may be relevant.

Also of relevance is any use, sale, offer for sale or advertisement of the invention in the USA, but we assume that none of these have taken place before the priority date of the application, as this would affect your other application(s). Any dispute about ownership of the invention or the identity of the inventor(s) is also relevant, but we presume that there is no such dispute.

The duty to disclose relevant information is ongoing throughout the life of a US patent application. Thus, if you become aware of relevant information later, please also let us know as we may need to submit it to the USPTO.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com.

Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at York House, 23 Kingsway, London WC2B 6HP

LONDON
York House
23 Kingsway
London WC2B 6HP
Tel: 020 7240 4405
Fax: 020 7240 9339

BRISTOL
22-24 Queen Square
Bristol
BS1 4ND
Tel: 0117 945 1234
Fax: 0117 926 5692

MANCHESTER
Bridgewater House
Whitworth Street
Manchester M1 6LT
Tel: 0161 247 7722
Fax: 0161 247 7766

CAMBRIDGE
Newnham House
Cambridge Business Park
Cambridge CB4 0WZ
Tel: 01223 420383
Fax: 01223 423792