

Navigating the Patent Application Disclosure Requirement in the US

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What is the Disclosure Requirement?

- Everyone involved
 - Not just the inventors, but also anyone else who is involved with the patent application, for example, patent owners and patent attorneys
- 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.

What is “Relevant” Information

- Prior art
- Products or processes
- Offers for sale
- Data disclosures
- Any other information “material to patentability”
- Information communicated to/by a patent office
- Does not necessarily need to be pre-filing!

What is Not Required

- There is no affirmative duty to conduct a search
- No searching is required, but what is already known to people involved in the patenting process?
- No need to provide any analysis – the relevant document is sufficient

Consequences?

- Submitting evidence is not an admission as to its relevance
- Could lead to patent invalidity/unenforceability
- Can it be corrected?

Thank You



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