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IP: Strengthen patents with full disclosure of information

Training your legal department to handle disclosure can save costs on outside counsel

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There are at least two main interests in developing a strong information disclosure system in-house:

1. Strengthen patents against invalidity attacks
2. Control costs with respect to the use of outside counsel

While there are different driving forces to each of the above, they dovetail at the same place: stronger and more enforceable patents.

Companies must have a system of cataloging and tracking all patents, patent applications, trade secrets and invention disclosures. All of these disclosures should be cross-referenced by subject matter keywords, inventors and related applications. When information is identified that may be relevant to one application, the database should be reviewed to determine if that information should be disclosed in other pending patent cases.

Additionally, if an examiner cites a reference in one patent application, it is up to the applicant to determine if it should be cited in other cases. In other words, don't count on examiners to review related patent applications from the same company or inventor to determine if there are other relevant references. If the company does not have a readily accessible database of its patents and patent applications, then the chances that something will not be cited increase.

The second consideration is learning what constitutes information that should be disclosed. The Patent and Trademark Office (PTO) states that information that is "material to patentability" must be disclosed during prosecution of each related patent application. This standard has been defined and redefined through recent case law—most of which involves a review of inequitable conduct—and many patent practitioners err on the side of disclosure of all information rather than making the decision as to whether something is material to patentability. In general, any form of information can be submitted, including patents, patent applications, journal articles, webpages, whitepapers, grant applications, etc.

Information that a company cites to the PTO may be used to effectively narrow the patent claims at issue, but that information will strengthen the patent against attacks. Basically, every patent is presumed valid over the art that is cited during prosecution (and shown on the first page of the issued patent).

Additionally, information that is considered "merely cumulative" will likely not be successful in challenging the validity of an patent.

Therefore, the likelihood of a successful petition for reexamination will decrease. In addition, these patents will be strengthened against attacks during litigation, such as a motion to invalidate the patent or a charge of inequitable conduct on behalf of the company, inventors or patent team.

An in-house team that is educated about the issues surrounding information disclosure in patent cases can handle a lot of the work, thus decreasing the need to direct the work to outside counsel. While it is important to keep outside patent counsel in the loop regarding what has been filed, much of the

paperwork can be completed by an in-house attorney or paralegal. Ask your outside patent counsel to prepare training materials and/or provide in-house training for inventors and paralegals as part of the firm's value-added services.

While it is beneficial to check with outside counsel in foreign countries for the relevant law in each country, many of these countries do not require information to be disclosed in the same manner as the U.S. The key point to remember, however, is that information cited during foreign patent prosecution should be considered for citation to the PTO in corresponding and/or related cases.

Finally, there is a new PTO initiative to reduce some of the costs associated with information disclosure late in the patent process. If information is identified and needs to be disclosed after allowance of the patent application, but before issue, the applicant does not need to submit a request for continued application (and fee) along with the information disclosure statement. This pilot program is scheduled to run until September 30.

The broad takeaway is that the in-house legal team and technical team need to understand the importance of disclosing information to the PTO and why certain references are relevant. Regular training coupled with an in-house standard operating procedure will go a long way to ensuring that all relevant references are disclosed during the process.

About the Author



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