

March 22, 2005

Re: **UNITED STATES LAW'S DUTIES OF  
DISCLOSURE AND CANDOR**

Dear Colleagues:

United States law imposes duties of disclosure and candor on the inventors, assignees, United States' attorneys, and foreign attorneys involved in procuring a United States patent. In the event of litigation involving the patent, failure to comply with these duties (1) allows for a charge of inequitable conduct and (2) may result in the United States patent being held unenforceable. Therefore, we recommend that you take the actions noted below to comply with these duties.

1. **Prior Publications:** Promptly disclose to us all relevant prior art publications. Disclose to us all prior publications in which an inventor is also an author of the publication and the publication relates to the field of the claimed invention. When filing a continuation-in-part application, disclose to us all relevant information which became available up to the filing date of the continuation-in-part application.

2. **Offers for Sale and Sales:** Promptly disclose to us any prior sale or offer to sell a product or process embodying the invention being claimed. If a product defined by the claimed invention was offered for sale/sold in the United States more than one year before the filing date of the United States application, subject to narrow exceptions, the claimed invention cannot be patented in the United States. United States law may interpret (1) sale of an invention which has not been fully reduced to practice to be "on sale" and (2) sales activities entirely outside of the United States which would have an effect on the United States market to be a sale "in the United States."

3. **Public Use:** Promptly disclose to us any use of a product or process embodying the claimed invention which occurred prior to the filing date of the United States application.

4. **Foreign Patent Office Proceedings:** Promptly send to us all office actions, search reports, and references cited therein which you may receive from any patent office relating or corresponding to the invention being claimed in the United States application.

5. **Claims to Similar Inventions in Other Applications:** Promptly disclose to us United States applications and patents (1) in which you have presented similar claims to the claims in the application we are prosecuting or (2) in which at least one of the inventors is the same as at least one of the inventors of the application we are prosecuting.

6. **Ownership/Assignment:** Promptly disclose to us any inventors that were not obligated to assign their rights to the claimed invention to the client company either (1) at the time that the invention was made or (2) at the time that the first application for the invention was filed. Promptly disclose to us disputes between companies and inventors over ownership of any claimed invention.

7. **Duty of Candor - Accurate Information:** Promptly disclose to us any information you have suggesting that data provided in the specification or submitted to the examiner in prosecution is either inaccurate or incomplete.

8. **Duty of Candor - Partial Translations:** Promptly provide to us relevant information in foreign language documents in writing and in an English language translation or summary. English language summaries or partial translations are acceptable. However, they must disclose in English *all relevant information*. Either provide to us English language summaries, translations of all relevant information, or instruct us to obtain English language translations of specified documents you believe an examiner may consider relevant to the claimed invention.

If you have any specific questions regarding these or any other issues, please do not hesitate to ask us for advise.

Very truly yours,  
Richard A. Neifeld  
President, Neifeld IP Law, PC

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