

Code of Conduct

Last week, the companies responding to the ITC complaint by Revolaze made their initial filings and, on first glance, things seem to have gone in an unexpected direction. While I haven't had an opportunity to review the actual filings, based on the news reports I have seen it appears that the respondents are claiming inequitable conduct by Revolaze.

In general, inventors, patent attorneys and agents, and people who are substantively involved in the preparation and prosecution of patents have an obligation to deal with the USPTO in candor and good faith. These people also have a duty to disclose information they are aware of when this information is material to the patentability of an invention. This is generally referred to as the Duty of Disclosure

The failure to comply with the duty of disclosure will result in a finding of inequitable conduct and the cancellation of the entire patent.

Operating with candor and good faith are the key to meeting this requirement. What the USPTO requires and expects is that applicants will share with them everything they know.

There are two areas I want to focus on when dealing with the duty of disclosure.

The first focus area involves prior art. It commonly happens that applicants come across prior art that is material to patentability after an application been filed. The important thing here is to forward this information to the USPTO as soon as possible. And by ASAP, I mean immediately – the sooner this information gets to the USPTO the easier it is for everybody.

The second focus area involves properly identifying the inventors. Unfortunately determining the inventor can be a touchy subject. What I have observed is that after a project is successfully completed the politics will kick in and everybody involved in the project will want their name on the patent. Unfortunately, it just doesn't work that way. The people to list as the inventors are only those people who came up with the critical elements of the inventive concept. And unfortunately, the inventors can change through the patent prosecution process. There are a number of reasons this will happen but a common example is when an application is "divided," or split into two applications. When an application is divided along the lines of an inventor's contributions, then some inventors will have to be removed from the original application.

In the Revolaze case, the respondents appear to be claiming that Revolaze was deceptive when they identified the inventor. And if that is true, that would be very bad news for those patents.

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