

Avoiding the “Atomic Bomb of Patent Law”

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The U.S. Court of Appeals for the Federal Circuit once called the remedy for inequitable conduct “the atomic bomb of patent law.” Inequitable conduct is a defense against patent infringement that can render a patent unenforceable when the applicant for that patent intentionally deceived the U.S. Patent and Trademark Office (PTO) by misrepresenting or omitting material information during the patent prosecution process. Avoiding such patent Armageddon starts with inventors and applicants disclosing all known information that is “material to patentability” to the PTO before the patent is issued.

Origins and purpose of the duty of disclosure. Patent prosecution is a one-sided interaction between the applicant and the government. Because there is no adverse party to present contrary evidence or prior art, the PTO relies heavily on the applicant’s honesty and full disclosure. If the applicant fails to disclose information that the PTO does not otherwise have access to, the PTO may issue a patent that should not have been issued.

In 1977, the PTO rewrote its rules to require individuals associated with filing and prosecuting a patent application to disclose to the PTO all information known to be material to the patentability of that pending patent application. At last, there was a mechanism for the PTO to theoretically discover information that, until then, inventors and applicants could keep to themselves.

Who owes the duty? The duty of disclosure extends to anyone who is associated with the filing or prosecution of a patent application. This includes the inventor and joint inventors, who are often most familiar with the state of the art in their field. It includes the patent attorneys and agents who draft and prosecute the application. And it includes assignees or any other persons who are substantively involved, such as in-house counsel or company managers overseeing the filing. Because the scope of who has a duty is broad, organizations pursuing patents should establish procedures to ensure that relevant information reaches the prosecuting attorney and, ultimately, the PTO.

What must be disclosed? Any prior art or other information that is “material to patentability” must be disclosed. Prior art is any publicly available information that predates the patent application and relates to the subject matter of the claimed invention. Common examples include issued patents or published patent applications; academic papers, journal articles, and technical reports; public demonstrations, sales, or uses of a product; and marketing materials, product manuals, or trade show disclosures. Even non-traditional sources — such as online technical forums or open-source

repositories — can constitute prior art if they are publicly accessible. In evaluating whether the prior art or other information is “material to patentability,” the key is whether the information might influence an examiner’s assessment of the invention’s novelty or obviousness. That said, there is no duty to conduct an exhaustive worldwide search for prior art, which is why many patent applicants conduct no search at all prior to filing a patent application.

Mechanisms for disclosure. The formal vehicle for fulfilling this obligation is the information disclosure statement (IDS). An IDS is a document submitted to the PTO that lists the references that may be material to patentability. It typically includes bibliographic data for each reference, copies of non-U.S. documents, and sometimes explanations of their relevance. Applicants may file an IDS at various stages during prosecution — ideally as early as possible — but must comply with timing rules that vary depending on when the references are discovered.

Best practices for compliance. To ensure compliance, inventors, applicants, and their representatives should adopt clear procedures and habits to track known information material to any pending patent application. Inventors should be instructed to provide their attorneys with all potentially relevant information at the outset of the drafting process. Teams working on related technologies should record and update prior art references discovered during research and development. Companies should educate employees involved in innovation about their disclosure obligations.

Consequences for nondisclosure. A breach of the duty of disclosure can lead to a finding of inequitable conduct, “the atomic bomb of patent law,” that renders the entire patent unenforceable. While establishing inequitable conduct has become more difficult in recent years — a challenger must show both that the withheld information was material and that there was an intent to deceive the PTO — the doctrine remains a potent deterrent to nondisclosure.

The duty of disclosure is thus more than a bureaucratic formality — it is a moral and legal cornerstone of the patent system. By disclosing all relevant prior art, inventors help ensure that patents reward genuine innovation rather than accidental duplication. Upholding this duty protects the integrity of the patent process, preserves public trust, and sustains the balance between private rights and public knowledge that lies at the heart of U.S. patent law. **CEP**

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