

REPORT

**THE U.S. DUTY OF DISCLOSURE
AS APPLIED TO U.S. AND FOREIGN OFFICE ACTIONS**

October 9, 2009

Recent case law establishes that patentees are obligated to bring many Office Actions issued in related U.S. Patent applications to the attention of the U.S. Patent and Trademark Office (USPTO). Under older case law, similar disclosure of foreign Office Actions is not required, but the law may be evolving toward a requirement for such disclosure. It may also be advantageous to submit foreign Office Actions to support disclosure of other information. This Special Report will address the law and provide recommendations regarding submission of Office Actions to the USPTO to minimize the risk of a holding of inequitable conduct and thus unenforceability of a patent.

We recognize and regret that following our recommendations in this Special Report may increase overall U.S. patent portfolio costs at a particularly difficult time in the world economy. However, following extensive study and for the reasons discussed below, we believe that ensuring enforceability of a U.S. patent portfolio under the current state of U.S. law leaves little choice but to take the additional steps outlined below.

**I. The Basic Legal Standards
Regarding Inequitable Conduct**

Inequitable conduct occurs when an applicant fails to fulfill the duty of disclosure to the USPTO. If a court holds that inequitable conduct occurred in prosecution of a patent, the court will generally hold all claims of the patent unenforceable, and may sometimes also hold related patents unenforceable. Inequitable conduct occurs if an applicant (1) makes an affirmative misrepresentation of material facts or fails to disclose material information, and (2) intends to deceive the USPTO.¹

¹ *Eli Lilly v. Zenith Goldline*, 471 F.3d 1369, 1381 (Fed. Cir. 2006).

Current USPTO rules state that information is material if it (1) "establishes by itself or in combination with other information, a *prima facie* case of unpatentability of a claim" or (2) "refutes, or is inconsistent with, a position the applicant takes" in opposing an argument of unpatentability relied on by the USPTO or asserting an argument of patentability.² Courts also judge whether information is material based on a "reasonable examiner" standard. This standard asks whether a reasonable examiner would have considered the information important in deciding whether to allow the application to issue.³ Information does not have to render any patent claim invalid to be material. But information is not material if it is cumulative to, or less relevant than, information already of record.⁴

Material information that must be disclosed is not limited to prior art references. As will be discussed below, the existence and content of Office Actions and other communications in related applications may sometimes constitute material information. Courts judge whether an applicant intended to deceive the examiner based on "inferences drawn from facts" surrounding the non-disclosure of the material information. The inferences courts have drawn from the non-disclosure of information, such as information relating to Office Actions, vary considerably from case to case.

² 37 CFR §1.56(b).

³ *McKesson Information Solutions, Inc. v. Bridge Medical, Inc.*, 487 F.3d 897, 913 (Fed. Cir. 2007). This standard appeared in pre-1992 USPTO rules, and courts now routinely apply both standards. *Digital Control Inc. v. Charles Machine Works*, 437 F.3d 1309, 1315-16 (Fed. Cir. 2006).

⁴ *Larson Manufacturing Co. of South Dakota, Inc. v. Aluminart Products Ltd.*, 539 F.3d 1317, 1327 (Fed. Cir. 2009); §1.56(b).

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II. The Duty To Disclose Office Actions From Related U.S. Patent Applications

The U.S. Court of Appeals for the Federal Circuit ("the Federal Circuit") has made clear that the duty of disclosure extends to disclosure of certain Office Actions from certain other U.S. patent applications. However, the Court's guidance puts the burden on individual patent applicants to determine which Office Actions from which other patent applications must be disclosed.

A. What U.S. Office Actions May Be Material?

In 2001 the Federal Circuit first addressed the potential materiality of USPTO communications in *Li Second Family Limited Partnership v. Toshiba Corporation*.⁵ During prosecution, Li convinced an Examiner to withdraw a rejection by asserting that his application was entitled to an earlier filing date through a series of continuation applications (one of which was a continuation-in-part application). The Federal Circuit held that Li committed inequitable conduct by failing to disclose to the Examiner a USPTO Board of Appeals decision holding that a related case was not entitled to the earlier filing date.⁶ The Federal Circuit held that Li had an obligation to disclose the contrary decision to the Examiner, and had intentionally deceived the Examiner by failing to do so.

In 2003, the Federal Circuit addressed the materiality of an Examiner's rejection in a U.S. Office Action in *Dayco Products, Inc. v. Total Containment, Inc.*⁷ The Federal Circuit held that the text of an Office Action in a related patent application could be material because "a contrary decision of another examiner reviewing a substantially similar claim...[or] a potentially different interpretation [of the cited reference] is clearly important information that an examiner could consider important when examining an application."⁸ Thus, in analyzing materiality of an Office Action, the Court focused on both (1) contrary decisions

relating to patentability and (2) differing interpretations of a reference.

This year, the Federal Circuit went even further in *Larson Manufacturing v. Aluminart Products*. Larson was simultaneously prosecuting (1) an application for reissue of a patent, and (2) a continuation application of the patent under reissue. During prosecution of the reissue application, four Office Actions were issued in the continuation application. Larson disclosed the first two Office Actions and all of the references cited in those Office Actions to the reissue examiner. The cited references were U.S. patents. Larson did not disclose the third and fourth Office Actions to the reissue examiner, allegedly for two reasons. First, the references cited in the third and fourth Office Actions had already been made of record in the reissue file. Second, according to Larson, the third and fourth Office Actions provided "summary rejections without meaningful analysis."⁹

In other words, Larson maintained that the third and fourth Office Actions were not material because they were cumulative to the previously disclosed information. Larson reasoned that the examiner in the reissue proceeding was aware of the existence of the related continuation prosecution and was aware of every reference cited in that related prosecution. Larson further reasoned that the third and fourth Office Actions only applied the disclosed references in slightly different ways from how they were applied in the first and second Office Actions. Accordingly, Larson argued that the third and fourth Office Actions were not material.

The Federal Circuit disagreed. It held that the third and fourth Office Actions contained material information that was not cumulative to the previously submitted information. In the third Office Action, the examiner had asserted that a reference showed a screen extending into tracks. In both the continuation application and the reissue application, Larson argued that this interpretation was incorrect. The examiner in the continuation application agreed with Larson, and withdrew the incorrect interpretation in the fourth Office Action. The Federal Circuit held that even though the incorrect interpretation was later withdrawn, the potential interpretation of the reference was material during the year between the third

⁵ 231 F.3d 1373 (Fed. Cir. 2001).

⁶ *Li*, 231 F.3d at 1375-1378. The Board of Appeals had held that the claims of the continuation-in-part application (which gave rise to the claims of both the application at issue and the related application) were not supported by the original specification of its parent.

⁷ 329 F.3d 1358 (Fed. Cir. 2003).

⁸ *Dayco*, 329 F.3d at 1368.

⁹ *Larson*, 559 F.3d at 1337.

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and fourth Office Actions.¹⁰ Thus, according to *Larson* even Office Actions containing incorrect interpretations that are later withdrawn can be considered material.

The Court also held that the fourth Office Action was material because, in the Office Action, "the examiner found for the first time that the Kemp patent shows a 'screen end member actually being located in a screen track.'" In effect, the Court held that a new USPTO interpretation of a reference already of record might be considered important (and thus material) to an examiner to aid in the interpretation of similar claims.

Meanwhile, in 2007, the Court held that materiality is not limited to Office Actions containing rejections. In *McKesson*, the Federal Circuit held that the fact of issuance of a Notice of Allowance in a related patent application was material information because the claims of the ensuing patent could have given rise to a double patenting rejection.¹¹ The Federal Circuit also held that the district court was not required to show that the claims of the two patents were similar enough to sustain a double patenting rejection. The Court explicitly stated that "the test for materiality is whether a reasonable examiner would have considered the information important, not whether the information would conclusively decide...patentability."¹²

In summary, an Office Action in a related U.S. patent application may contain material information if it provides any potential grounds for rejection of pending claims, if it provides a USPTO interpretation of information that an examiner might rely upon to support a rejection of pending claims, or if it contradicts an argument being presented by the applicant.

B. What Constitutes a "Related" U.S. Patent Application?

U.S. courts have laid out several different scenarios in which U.S. patent applications will be considered related.

¹⁰ The Federal Circuit has long held that whether claims are patentable over withheld information is not conclusive as to whether an examiner would find the information material, and that inequitable conduct cannot be easily cured even while prosecution is ongoing. *A.B. Dick Co. v. Burroughs Corp.*, 798 F.2d 1392, 1398 (Fed. Cir. 1986).

¹¹ *McKesson*, 487 F.3d at 925.

¹² *McKesson*, 487 F.3d at 925 (emphasis added).

Family applications derived from an earlier application and claiming a benefit under U.S. law, such as continuations, continuations-in-part, divisionals, parents, siblings (continuing applications sharing a common parent), or any other applications claiming a relationship under 35 U.S.C. §120, are typically considered related.¹³ One exception is that references previously cited in a parent application do not need to be submitted when filing a divisional or continuation application.¹⁴ We believe the same logic also applies to already-issued Office Actions from the parent application when filing continuing applications.

Non-§120 applications filed by the same assignee, having claims similar enough to potentially give rise to a double patenting rejection, may also be considered related.¹⁵ The Federal Circuit has also inferred a relationship between two patents based on the fact that the same references were disclosed upon filing each application.¹⁶ It is also possible that courts will infer relationships between applications based on common (or similar) filing dates, common inventorship, and other similar connections.

C. Summary

In summary, a U.S. Office Action may be material to another application if it might have aided an examiner during his examination. The courts have held that a Board decision, a rejection or even a Notice of Allowance may be a material Office Action, as long as it might provide the examiner with some material information. This information may include information relating to technical interpretations of applied references, potential combinations of references, potential double-patenting rejections, or contrary findings relating to patentability. Applications that are related under §120 or even by being directed to very similar technical areas may be sufficiently related to qualify as involving material information in their Office Actions.

¹³ *Larson*, 559 F.3d at 1338.

¹⁴ *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 547 (Fed. Cir. 1998). However, it is our standard practice to submit a complete list of references cited in a parent application, when filing divisional and continuation applications, in order to have the references printed in the list of references considered on the face of the resulting patent.

¹⁵ *Akron Polymer Container Corp. v. Exxel Container, Inc.*, 148 F.3d 1380, 1382 (Fed. Cir. 1998).

¹⁶ *McKesson*, 487 F.3d at 904.

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III. Will Deceptive Intent Likely Be Inferred From A Failure To Disclose A U.S. Office Action?

Whether or not a court will find deceptive intent is a highly fact dependent issue. The law on the standard for finding deceptive intent is constantly evolving, with recent Federal Circuit decisions tending to impose a higher evidentiary burden on the patent challenger to prove deceptive intent. But it remains difficult to predict whether a court will find deceptive intent in any given case.

For example, in *Larson*, the Federal Circuit held that while the third and fourth Office Actions were material, the materiality alone was not high enough to infer deceptive intent on Larson's part for failing to disclose the Office Actions.¹⁷ The Federal Circuit remanded the case to the district court to determine whether there was evidence that Larson had withheld the Office Actions with deceptive intent. The Federal Circuit also instructed the district court to balance such evidence against evidence showing Larson's good faith in dealing with the reissue examiner. Specifically, the court noted that Larson had made the examiner aware of the continuation application and had submitted two Office Actions and every cited reference from the continuation prosecution.

By contrast, in *McKesson* the Federal Circuit was far more willing to infer deceptive intent. *McKesson* also failed to disclose Office Actions (both a rejection and a Notice of Allowance) from a related application.¹⁸ *McKesson* argued that the district court erred in inferring deceptive intent for failing to disclose the Office Actions because at the time "there was no awareness" of a requirement to disclose such Office Actions. *McKesson* also argued that the district court failed to account for evidence of good faith, such as two separate disclosures of the existence of the related application. The Federal Circuit responded by asserting that *McKesson* should have been aware of the requirement based on the USPTO's Manual of Patent Examining Procedure (MPEP). The Court nevertheless chose to infer deceptive intent for failing to disclose an Office Action, in prosecution that had been completed ten years before *Dayco* stated that U.S. Office Actions can be material.

The issue of intent was also addressed in a dissenting opinion in *McKesson* and a concurring opinion in *Larson*.

In the *McKesson* dissent, Judge Newman emphasized that at least a finding of inequitable conduct requires clear and convincing evidence of deceptive intent, not merely a mistake.¹⁹ Likewise, in a concurrence in *Larson*, Judge Linn emphasized that materiality should not presume intent.²⁰ Both Judges Newman and Linn stated that they believe that a far higher standard of proof should be required to prove deceptive intent than was demonstrated in either case.

This higher standard of proof also appears in very recent cases. For example, in *AstraZeneca Pharmaceuticals LP v. Teva Pharmaceuticals USA*, the Federal Circuit rejected Teva's argument that it needed to make a proportionally lesser showing of intent because it had shown a high degree of materiality. The Court emphasized that at least a "threshold level" of both materiality and intent must be established by clear and convincing evidence.²¹

Nevertheless, the conflicting guidance from the Federal Circuit makes it difficult to predict whether courts will infer intent in pre-*Dayco* or pre-*Larson* prosecutions where material U.S. Office Actions were not disclosed to the examiner. However, the *Li*, *Dayco*, *McKesson* and *Larson* decisions have put the patent community on notice that virtually any interpretation of a reference, unique combination of references, or justification for applying references put forward by the USPTO in a related patent application may be found to be material. As such, it will be easier for future courts to infer intent if applicants fail to disclose material U.S. Office Actions from related applications.

IV. Is There A Duty To Disclose Foreign Office Actions?

In 1998, well before issuance of the series of decisions discussed above, the Federal Circuit explicitly stated that "the details of foreign prosecution are not an additional category of material information."²² The Court explained

¹⁹ *McKesson*, 487 F.3d at 926 (Newman, dissenting).

²⁰ *Larson*, 559 F.3d at 1344 (Linn, concurring).

²¹ *AstraZeneca*, ___ F.3d __; 2009 WL 3051792, 7 (Fed. Cir. 2009).

²² *ATD*, 159 F.3d at 547 (emphasis added). Interestingly, the "foreign prosecution" there in issue was a PCT international search report prepared by the USPTO as the international search authority.

¹⁷ *Larson*, 559 F.3d at 1340-41.

¹⁸ *McKesson*, 487 F.3d at 922.

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that "it is the reference itself, not the information generated in prosecuting foreign counterparts, that is material to prosecution." Based on this authority, one could argue that it is not necessary to submit foreign Office Actions themselves to the USPTO (except when using such Office Actions as an explanation of relevance, as discussed below).

In the eleven years since *ATD*, however, the Federal Circuit has attached increased importance to the legal and technical content of Office Actions as a category of material information. This raises doubts about the continued vitality of the reasoning underlying the *ATD* decision. As such, we recommend either reviewing all foreign Office Actions in related cases for potential materiality or simply disclosing all foreign Office Actions from related cases.

A. Foreign Office Actions As Explanations Of Relevance Of Other Information

USPTO rules require that when an applicant discloses a non-English-language reference (such as a foreign language patent), the applicant must also submit any translation of the reference, or portion thereof, that is "within [its] possession, custody or control..., or is readily available" to it. For a foreign-language reference without a translation, an applicant must provide an "explanation of relevance" of the reference. This explanation of relevance must be in English. If such an explanation of relevance is not provided, the examiner will not consider the reference. Instead, the examiner will merely place the reference in the file, unconsidered.²³

The duty to provide an explanation of relevance of a non-English-language reference may generally be avoided by providing an English-language translation of the reference. The duty may alternatively be fulfilled by providing an Abstract of the reference or the text of a foreign Office Action citing the reference, but only if the Abstract or Office Action fully reflects the material

information in the reference. MPEP 609.04(a)III. If the Office Action is in a foreign language, an English-language translation of the Office Action must be provided for it to qualify as a statement of relevance. These alternatives are often less expensive than providing a full translation of the reference or creating an explanation of relevance. However, the submission of an Abstract or Office Action may not satisfy the duty of disclosure if the Abstract or Office Action does not reflect all of the material information in the reference.²⁴

B. Potential Materiality Of Foreign Office Actions

As noted above, the Federal Circuit held in *ATD* that foreign Office Actions are not themselves material references. Some district courts have since relied on this holding in *ATD*.²⁵ But the *ATD* decision predates the *Li*, *Dayco*, *McKesson* and *Larson* holdings that U.S. Office Actions are material. In view of these more recent Federal Circuit decisions, we believe that future courts may limit or overturn the *ATD* decision.

For example, in holding that foreign Office Actions are not material, *ATD* cited *Molins PLC v. Textron, Inc.*²⁶ *Molins* had held that it was not proper to automatically hold that a reference is material merely because it was cited in a related foreign Office Action, because of the differences in the standards of patentability between the United States and foreign countries.²⁷ Yet *Dayco* and *Larson* indicate that the materiality of some U.S. Office Actions may result from the existence of contrary technical interpretations of references in the Office Actions.²⁸ Technical interpretations in general are not affected by variations in standards of patentability. As such, there is reason to believe that the Federal Circuit acting *en banc* might overrule *ATD* if the issue came up again. Additionally, future Federal Circuit panels may distinguish *ATD* and require disclosure of foreign Office

²³ 37 C.F.R. 1.98(a)(3)(i) and (ii); 37 C.F.R. 1.97(i); and MPEP §609.04(a) and §609.05(a). See also our April 1, 2003 Special Report "Are JPO Website Computer-Generated Translations 'Readily Available'? Must They Be Submitted with Information Disclosure Statements?" (available in the "News & Events" section of our website www.oliff.com).

²⁴ See below for a more complete discussion of the impact of a partial translation of a reference on the issue of deceptive intent.

²⁵ See *Inverness Medical Switzerland. GmbH v. Acon Labs., Inc.*, 323 F.Supp.2d 227, 249 (D. Mass. 2004); *Goss International Americas, Inc. v. MAN Roland, Inc.*, 2006 WL 2251675 (D.N.H. 2006).

²⁶ *ATD*, 159 F.3d at 547, citing *Molins PLC v. Textron, Inc.*, 48 F.3d 1172 (Fed. Cir. 1995).

²⁷ *Molins*, 48 F.3d at 1180.

²⁸ *E.g., Dayco*, 329 F.3d at 1368.

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Actions under various factual scenarios.²⁹ Therefore, we now recommend developing a strategy for disclosing Office Actions.

V. Under What Circumstances Might Courts Infer Deceptive Intent For Failure To Disclose Material Foreign Office Actions?

As noted earlier, a finding of inequitable conduct requires both non-disclosure of material information and deceptive intent. When determining whether an applicant acted with deceptive intent, a court balances several factors. The Federal Circuit has also held that inconsistent disclosure practices may give rise to inferences of deceptive intent. In particular, we recommend that our clients make efforts to avoid three types of incomplete disclosures that may be damaging in future litigation.

A. Submission Of Partial Translations And The *SEL* Decision

In *Semiconductor Energy Laboratories v. Samsung Electronics* ("*SEL*"),³⁰ the Federal Circuit held that an applicant had intentionally deceived the USPTO by submitting a partial translation of a Japanese-language reference. *SEL* submitted the foreign-language reference to the USPTO along with a partial English-language translation of the reference. Samsung later accused *SEL* of hiding material information because the most relevant portions of the reference had been left untranslated. The Federal Circuit noted that the *SEL* employee who had prepared the translation was a native Japanese speaker and an expert in the relevant field. The court held that the translator would have fully comprehended the reference, and understood what portions were most relevant. Thus, the court held that his choice to leave the most damaging portions of the reference untranslated showed a clear intent to deceive the examiner, rendering the patent unenforceable.

The act of providing a partial translation of a foreign Office Action may similarly give rise to an inference that the applicant reviewed the entire Office Action and chose

²⁹ For example, the issue in *ATD* focused on an international search report - a document that likely included very little text. The Federal Circuit might distinguish a situation in which, for example, a detailed interpretation of a reference appears in a foreign Office Action.

³⁰ 204 F.3d 1368 (Fed. Cir. 2000).

which portions to translate. If a court later finds that an untranslated portion is material, it will be easier for the court to infer that the applicant intended to mislead the USPTO. Such an inference could arise regardless of whether the foreign Office Action was submitted as an explanation of relevance of a cited reference or submitted as potentially material information itself. Even if the partial translation was not prepared by the applicant, a court may find that the applicant would have been aware of the most relevant portions, especially if the Office Action is in the applicant's native language. Thus, it is important to either (1) submit complete translations of non-English language Office Actions or (2) ensure that any partial translations of non-English-language Office Actions, submitted for any reason, include a translation of all potentially material portions.

B. Submission Of Untranslated Foreign-Language Office Actions

On a similar note, courts in the future may infer deceptive intent when untranslated Office Actions are submitted to the USPTO. The USPTO notes that there is a strong inference that references cited by a foreign Office Action in a related case are material to patentability.³¹ The very act of submitting an Office Action, whether translated or not, may imply that an applicant considers the Office Action material. This implication will be even stronger if the Office Action is written in the applicant's native language.

As such, the submission of a foreign-language Office Action, without an English-language translation, may create the appearance of conceding the materiality of the Office Action, while at the same time intentionally failing to disclose the contents of the Office Action. Thus, if a non-English language Office Action is submitted, it is important that a translation of that Office Action be submitted with it.

C. Submission Of Only Some Foreign Office Actions

Finally, there is a possibility that the submission of some foreign Office Actions, but not others, may in some cases be perceived as evidence of deceptive intent. As explained above, in *SEL* the court held that an applicant's choice to leave the most damaging portions of a reference untranslated showed a clear intent to deceive the examiner.

³¹ 37 C.F.R. §1.56(a)(i); MPEP §2001.06(a)-(c).

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In *Larson*, the Court held that U.S. Office Actions that cited no undisclosed references were not cumulative to other disclosed Office Actions, and thus were material. Thus, a future court may hold that a decision to submit some foreign Office Actions, but not others, could be construed as evidence of deceptive intent if the court finds the non-submitted Office Actions to be material. A future court may also hold that the decision to disclose some foreign Office Actions negates any assertion that the applicant reasonably relied upon *ATD*'s holding.

To illustrate what might constitute inconsistent disclosure of foreign Office Actions, consider the following two contrasting hypotheticals. If a first foreign Office Action does not cite any non-English-language references, and a subsequent foreign Office Action also does not cite any non-English-language references, then submitting only one of the two Office Actions might raise an issue of selective disclosure that could raise inequitable conduct concerns. Similarly, if the first foreign Office Action is cited as an explanation of relevance of a non-English-language reference, and a second foreign Office Action includes additional potentially material information about the content of the reference, then failure to submit both Office Actions might raise similar selective disclosure issues. Thus, it is important to be consistent in connection with the submission of foreign Office Actions.

VI. Other Potential Material Information

Prior art references and Office Actions are not the only types of material information that must be disclosed to the USPTO. For example, the MPEP specifically notes that an applicant has the obligation to disclose the existence of U.S. litigation related to the application.³² An applicant must also disclose material information obtained through such litigation.

A similar potential source of material information may be third party oppositions in related foreign applications. Courts may analogize the legal and technical assertions made by a third party during an opposition to positions taken by an examiner in an Office Action. *Larson* held that a different (and even potentially inaccurate) technical or legal interpretation of a reference by one USPTO examiner might be considered important to an examiner to aid in his examination of similar claims. So too, future courts may assert that an examiner would have found the legal and

technical assertions of a third party opponent to be helpful in his examination of claims.

Of course, the existence of an opposition strongly suggests the possibility of future U.S. litigation, in which inequitable conduct allegations may be raised. Specifically, if a third party has taken a sufficient interest in a patent that it has filed a third party opposition, it likely makes or intends to make a potentially infringing product. If the applicant sues the third party for infringement after the U.S. patent issues, the third party will certainly consider asserting that the patent is unenforceable. For example, the third party may allege that the failure to bring material information raised during the third party opposition to the USPTO examiner's attention was inequitable conduct.

Thus, preventative steps taken in such a situation are likely to be worthwhile. These preventative steps can include disclosing the existence of the opposition, the third party's interpretation of the references, or both. We recommend disclosing both due to the enhanced likelihood of U.S. litigation.

VII. Recommendations

As discussed above, the Federal Circuit has now made clear that Office Actions in related U.S. patent applications may contain material information that should be disclosed. The reasoning in the more recent cases suggests that such holdings may be extended to foreign Office Actions. However, as with all legal matters, decisions should be based on the particular circumstances. Thus, we strongly recommend that you consult with us before making major decisions regarding disclosure policies. Based on our best understanding of the current case law, we provide the following general recommendations:

1. Establish a system to track U.S. patent applications that might be considered "related." Related applications include applications having filing date benefit relationships under §120, as well as applications arising out of common technical advances that are filed at approximately the same time and applications in which double patenting issues have been or may be raised. Such a system is already necessary to ensure that related applications and references cited in related applications are properly disclosed. These systems will also allow you to determine which Office Actions may need to be cross-disclosed and

³² MPEP §2001.06(c).

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- provide us with instructions to implement such cross-disclosure.
2. Submit copies of all Office Actions from related U.S. applications, other than parents when filing continuing applications. These Office Actions should include both rejections and notices of allowance. These Office Actions should be listed as references on USPTO Form 1449 when filing Information Disclosure Statements. This will ensure that there is a clear record of the Office Actions being submitted and a clear record that the examiner has considered the Office Actions.
 3. Choose a strategy for disclosing foreign Office Actions, such as:
 - a. Reviewing all foreign Office Actions in related cases and submitting translations of the substantive portion of those foreign Office Actions that contain material information; or
 - b. Consistently translating and disclosing the substantive portion of all substantive foreign Office Actions in related cases.
 4. Do not submit foreign-language Office Actions without a translation. Such a submission will not fulfill any duty to disclose the Office Action or serve as a statement of relevance of any reference cited in the Office Action. Yet at the same time, the submission may give rise to an inference that the applicant believes that the Office Action is material.
 5. Do not submit partial translations of foreign Office Actions without carefully reviewing the Office Actions and translations to ensure that all relevant portions have been translated.

6. Disclose the existence of third party oppositions in related foreign patent applications, the opposing party's interpretation of the applied references, and the opposing party's assertions as to how the references apply to the claims, preferably by submitting a copy and a translation of the opposition documents.
7. Work with us to prepare a tailored disclosure strategy that best meets budgetary and risk tolerance needs for the specific patent portfolio.

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