

## INVENTOR'S CHECKLIST

### 1. Additional Disclosures to the Patent Office

**Background:** The U.S. laws that apply to patent applications require an applicant to disclose to the Patent Office any references or other materials that may be relevant to the patentability of the applicant's invention. These materials might include, for example, relevant patent publications, trade brochures and articles in technical or trade journals of which the applicant is aware. The consequences of failing to disclose may be severe and could include unenforceability of the entire patent. Because the duty of disclosure continues until issuance, if any, of the patent, you should notify us if you become aware of any relevant references or which were not previously disclosed to Patent Office in regards to your application.

Unless we receive your written instructions to the contrary beforehand, we will presume that you have no further references to add at this time.

- I have reviewed the enclosed information disclosure statement and have no further references to add.**
- Yes, I would like to add additional references, which are enclosed.**
- I need further information and would like to discuss this issue with you.**

### 2. Inventors

**Background:** Inventorship has a strict legal meaning under the patent laws and a patent can be invalidated on the basis that the named inventors intentionally failed to name a qualified inventor or included someone who was not a true inventor. Failing to correctly state inventorship can have harsh consequences, however, liberal correction procedures may be available to remedy errors in naming the inventors. Because the claims of a patent application determine who is and who is not an inventor and because inventorship in certain situations might not be easy to determine, you should consult with us if you have any inventorship questions regarding your application.

Unless we receive your written instructions to the contrary beforehand, we will presume that you do not wish to make any changes to the listed inventors at this time.

- I have reviewed the application and claims and do not wish to make any changes to the listed inventors.**
- Yes, I would like to revise the listed inventors as noted.**
- I need further information and would like to discuss this issue with you.**

### 3. Non-Publication Request

**Background:** The Patent and Trademark Office automatically publishes patent applications eighteen (18) months after the date of filing the application, which is often prior to the patent being issued. A request for non-publication can be filed along with the patent application, however, **if** you do not plan to file foreign applications, and if the invention is not yet the subject of a foreign patent application. In which case, the Patent and Trademark Office would not publish your application. The Request Not to Publish can **only** be made when the application is filed. If a foreign application is later filed, we **must** file a petition to rescind this request within 45 days after filing the foreign application or the application will become abandoned. If a Request Not to Publish is not filed concurrently with the application, no change can be made to withdraw the application from publication.

You should keep in mind that certain advantages from publication arise, including the possibility of post-publication royalties from infringers should the application issue as a patent. One drawback to publication is that potential infringers can closely study the application. You should consult with us regarding this matter as other options are available should you have any questions or concerns.

Unless we receive your written instructions to the contrary beforehand, we will presume that you do **not** wish to file the non-publication request.

- No, I do not wish to file a non-publication request with this application.**
- Yes, I would like a non-publication request prepared and filed.**
- I would like to discuss this issue with you further before making a decision.**

#### **4. Expedited Examination**

**Background:** In certain circumstances, an application may receive expedited review, or “accelerated examination,” at the Patent Office. The Patent Office recently implemented a new stricter practice regarding petitions for accelerated examination (or “petitions to make special”). In return for expedited examination, the applicant for a U.S. patent must **now** make certain representations to the USPTO and surrender certain rights. For example, a detailed prior art search encompassing U.S. patent publications, foreign patent publications and non-patent documents must accompany the application upon filing. The scope of the search and the relevancy of the identified documents to the patent claims must also be provided to the USPTO. This may limit the applicant’s ability to distinguish a prior art reference later in prosecuting the application. Also, a challenger to the validity of a patent may assert that the relevancy, or lack thereof, was mischaracterized to the patent office. Expedited examination may also limit the options available to an application who wishes to appeal the Patent Office’s final refusal of its application.

Because the requirements for a grantable petition are substantial, if you are considering expedited examination, we advise that you carefully consider whether the

added expense and waiver of certain rights balances the need for expedited examination of the application and that you consult with us regarding your needs.

Unless we receive your written instructions to the contrary, we will presume that you do **not** wish to seek expedited examination at this time.

- No, I do not wish to file a request for expedited examination with this application.**
- Yes, I am interested in filing a request for expedited examination.**
- I would like to discuss this issue with you further before making a decision.**