

Changes to Information Disclosure Statement Requirements and Other Related Matters,
71 Fed. Reg. 38808 (July 10, 2006) Notice of Proposed Rulemaking;
XX Off. Gaz. Pat. Office YY (August 1, 2006)
Detailed Summary

IDS Objectives: An objective of the IDS NPR is to improve the quality of the examination process by getting the most pertinent prior art before the examiner so it can aid in the preparation of a complete first Office action on the merits. An additional objective is to have applicants with large submissions utilize their knowledge of the documents (their reason for their submission) to draw the examiner's attention to the relevant feature(s), showing(s), or teaching(s) that caused submission of the documents based on the claimed invention or supporting specification. A further objective of the IDS NPR includes providing applicants with an alternative to filing a IDS when they receive unsolicited documents from a third party.

I. Four time periods (§§ 1.97(b), (c), (d)(1), and (d)(2)) and requirements for submitting IDSs:

1st period: ends the later of three months after filing, or prior to 1st Office action on the merits (§ 1.97(b));

General rule: IDSs may be filed during this time period without triggering any additional disclosure requirements (see II below).

When additional disclosure requirement is triggered: An explanation is required for each of the following submitted in an IDS:

1. Any English-language document over 25 pages (excluding sequence & computer listings);
2. Any non-English language document (abstracts or translations would be treated as 1. above); and
3. ALL documents when their cumulative number exceeds 20 in all IDSs filed in this first time period.

Exception: An explanation is not required for documents resulting from a foreign search or examination report in a corresponding foreign application, where the report is submitted.

See: § 1.98(a)(3)(i) (additional disclosure requirements); § 1.98(a)(3)(viii)(A) (exception)

2nd period: starts after 1st period, ends with the earlier of a notice of allowance or notice of allowability, or a NIRC for reexamination proceedings (§ 1.97(c));

Requirements for all documents:

1. An explanation, and
2. A non-cumulative description

Exception: Documents submitted with a timeliness certification and a copy of a foreign search or examination report from a corresponding foreign application do not require an explanation or non-cumulative description.

See: § 1.98(a)(3)(ii) (requirements); § 1.97(e)(1) (timeliness certification); § 1.98(a)(3)(viii)(B) (exception)

3rd period: starts after 2nd period, ends with payment of the issue fee (§ 1.97(d)(1));

Requirements for all documents:

1. A timeliness certification, and
2. One of patentability justifications (A) or (B) (see II below).

See: § 1.98(a)(3)(iii) (requirements), § 1.97(e)(1) or (e)(2) (timeliness certifications); (2) § 1.98(a)(3)(vi)(A) or (B) (patentability justifications)

4th period: starts after payment of the issue fee or issuance of NIRC, ends when there is no longer sufficient time for the IDS to be considered by the examiner prior to issuance of a patent or publication of Reexamination Certificate (§ 1.97(d)(2));

Requirements for all documents:

1. A timeliness certification,
2. A petition to withdraw an application from issue, or a reexamination proceeding from publication, and
3. An unequivocal statement that one or more claims are “unpatentable” in view of the cited information, an amendment to such “unpatentable” claims, and the patentability justification (B) (see II below).

Detailed Summary (continued)

See: § 1.98(a)(3)(iii) (requirements); § 1.97(e)(1) or (e)(2) (timeliness certifications); § 1.313(c)(1), § 1.98(a)(3)(iii)(B) (petitions to withdraw); § 1.98(a)(3)(vi)(B) (patentability justification)

II. Additional disclosure requirements for certain IDS submissions (§ 1.98):

An explanation under § 1.98(a)(3)(iv) would require:

(1) Identification of (§ 1.98(a)(3)(iv)(A)):

(i) The specific feature(s), showing(s), or teaching(s) that caused a document to be cited, and

(ii) a portion(s) of the document where the specific feature(s), showing(s), or teaching(s) may be found (e.g., by page and line number), and

(2) Correlation of the identified specific feature(s), showing(s), or teaching(s) to corresponding specific claim language, or to a specific portion(s) of the supporting specification, where the document is cited for that purpose. § 1.98(a)(3)(iv)(B).

Notes: (a) A mere statement that the entire document is relevant would not comply. (b) Documents representing merely background information should not be submitted via an IDS but discussed in the specification or the remarks section of a reply. (c) The alternative correlation to a specific portion of the specification is available in limited circumstances, such as aspects of the specification that define claim scope, e.g., in support of a means-plus-function claim pursuant to 35 U.S.C. 112, paragraph 6, or support compliance with the patent statutes, e.g., utility, written description, or enablement. (d) Where applicant utilizes different claim language to recite a particular element of the invention, applicant must correlate the cited document(s) that teach the element to at least one instance of each of the different recitations. (e) Where identified claim language would not be readily recognized as correlating to a cited document's teaching, explanatory material would be needed in addition to a mere reference to claim language.

A non-cumulative description under § 1.98(a)(3)(v) (not needed during the first time period, e.g., prior to a first Office action) would require: a description of how each document is not merely cumulative of any other document, e.g., a description of a specific feature, showing or teaching in each cited document that is not found in any other citation in any (prior or current) IDS, or any information cited by the examiner. See § 1.98(c), below.

A patentability justification under § 1.98(a)(3)(vi) (only needed after allowance) would require either patentability justification (A) or (B) as follows:

(A) (Only applicable to third time period, prior to or with payment of the issue fee): An explanation, a non-cumulative description, and reasons why the independent claims are patentable over the information in the IDS being submitted, considered together, and in view of any information already of record (§ 1.98(a)(3)(vi)(A)); or

(B) (May be used within the third time period, and must be used during the fourth time period): An explanation, a non-cumulative description, and reasons why an amendment causes claims, admitted to be unpatentable over the information submitted in an IDS, to now be patentable over such information when considered together, and in view of any information already of record (§ 1.98(a)(3)(vi)(B)).

Meaningful compliance, § 1.98(a)(3)(vii):

(1) The explanations provided must include a level of specificity commensurate with the specifics of the feature(s), showing(s), or teaching(s) which caused the document to be cited, and must not be pro forma types of explanations.

(2) The non-cumulative descriptions must be significantly different so as to point out why the cited document is not merely cumulative of other information currently being cited, or previously of record.

(3) The reasons for patentability must discuss specific claim language relative to specific feature(s), showing(s), or teaching(s) of specific documents.

(4) If the explanation, non-cumulative description, or patentability justification do not comply with requirements, the Office may decline to consider the IDS.

Detailed Summary (continued)

Updating, § 1.98(a)(3)(ix): With each amendment to the claims, or specification affecting the scope of the claims, other than an examiner's amendment, filed after an IDS, the explanation for all previous IDSs must be reviewed and updated where necessary in view of the amendments, or a statement must be supplied to the effect that updating of the previous explanations is unnecessary. Note: Failure to comply with the updating requirement, including the minimum requirement of a statement that updating is unnecessary, may result in a reply containing the amendment being treated as not fully responsive.

Cumulative documents, § 1.98(c): The submission of cumulative documents must be avoided. See also § 1.98(a)(3)(v), above. Where review of an IDS reveals the presence of a pattern of merely cumulative information to such extent that the utility of further review of the IDS is called into question, the Office may terminate further review of the IDS.

Note: Documents could be merely cumulative notwithstanding the presence of different explanations (e.g., two documents both containing only the same features A and B of the claimed invention, the explanation for the first document is to feature A, and the explanation for the second document is to feature B).

Translations, § 1.98(a)(3)(xi): The current requirement for submission of a translation that is within the possession, custody, or control of a § 1.56(c) individual is retained, notwithstanding any other additional disclosure requirements.

Note: A translation does not count towards the 20 cumulative documents total of § 1.98(a)(3)(i)(C), but is subject to the over twenty-five page threshold value of § 1.98(a)(3)(i)(B).

III. Applicant may consent to the submission of a protest for prior art which was served on applicant

(1.291(b)):

- (1) Section 1.291 would make explicit a mechanism for an applicant to consent in writing to the filing of a protest by a third party as to any unsolicited documents that applicant has received from a third party (e.g., resulting from litigation in a related application/patent). Thus, applicant would not feel obligated to file the documents with the USPTO, and the burden of complying with the requirements of the protest rules would remain with the third party. Section 1.291(b)(2).

Note: (a) Consents may only be limited by express terms to: (i) the length of time for which the consent is in effect, at least 30 days, and (ii) a specific party who can file the protest. (b) Where unsolicited documents have been received from an unknown party, a consent may be filed with the Office in the appropriate application file. (c) Applicant will have one month from date of service of the protest to object that a protest has not been consented to or is not within the terms of the consent.

- (2) Section 1.291 would be revised to specifically provide that protests may only be filed by third parties, not by applicant, to make clear that applicants cannot circumvent the requirements of §§ 1.97 and 1.98.
- (3) Options other than utilizing a written consent are also identified for applicant, such as (i) submitting the unsolicited information in an IDS, which would require applicant to ensure compliance with the concise explanation requirement, and (ii) not to submit the information, such as where the information has been reviewed and there is no information that is material as defined by § 1.56.

IV. Reexamination Proceedings: For patent owners in *ex parte* and *inter partes* reexamination proceedings, similar changes are being proposed. For third party submissions made during *inter partes* reexamination proceedings, the proposed Rule 1.98 requirements would be applied.

V. Safe harbor for any required submission of additional disclosure (§ 1.56(f)): A new paragraph has been added to Rule 1.56, the duty of disclosure rule, to create a safe harbor for parties when they submit statements to comply with the additional disclosure requirements of § 1.98(a)(3) when they have acted in good faith, such as by making reasonable inquiry and having reasonable basis for the statements made.

Detailed Summary (continued)

VI. Fee requirements deleted: All fee requirements for IDS submissions have been deleted.

VII. Third party submissions (§ 1.99):

- (1) The period ending for submission of information pursuant to § 1.99, would be extended from two months after pre-grant publication of the application to six months after pre-grant publication of the application, or mailing of a notice of allowance, whichever occurs first.
- (2) The applicability of the rule to a member of the public has been clarified to be other than a § 1.56(c) party (i.e., a third party).

VIII. Copies of abandoned applications (§ 1.98(a)(2)(ii)): The submission of a copy of an abandoned U.S. application's specification, including the claims, and drawing(s), when cited in an IDS would no longer be required if the Office has a copy of the file in electronic form, currently referred to as image file wrapper.

IX. Entry of certain amendments after allowance permitted to decrease the need to file an RCE or continuation: Section 1.312 would be amended to permit entry after allowance of amendments affecting the following items: bibliographic data, a reference to a joint research agreement, addition of a benefit or priority claim, changing the order of inventors, and correction of inventorship. Such amendments would also be permitted after payment of the issue fee if submitted in sufficient time to permit the patent to be printed with the amended information.

X. Duty to review (§10.18(b)): Each item of information being contemplated for inclusion in an IDS must be reviewed before submission of the IDS to the Office to assure that the information selected for submission will not:

- (1) Cause unnecessary delay or needlessly increase the cost of examination, or
- (2) Result in the obscuring of material information.

XI. Other related documents: For additional information the following related documents may be consulted (available via the "More Information" hyperlink associated with the Notice's title at the following USPTO webpage: <http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>):

- (1) Slide set - IDS NPR ,
- (2) Charts of: "The Four Time Periods for Submitting an IDS and Their Corresponding Requirements,"
- (3) Application Prosecution Timeline, and
- (4) Executive Summary - IDS NPR.

XII. Contact Information: The following individuals may be contacted as to any questions regarding the IDS NPR:

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Detailed Summary (continued)

XIII. Comments: Comments on the proposed rules and their implementation may be submitted by September 10, 2006 to: AB95.comments@USPTO.gov. Comments may also be submitted by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450; or by facsimile to (571) 273-7707, marked to the attention of Hiram H. Bernstein. As comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.