

PTO Considering Substantial Changes to Information Disclosure Statement Requirements

By Andrew C. Wegman

Parties involved with prosecution of a patent application have a duty to disclose to the United States Patent and Trademark Office (PTO) information which may be material to patentability in an Information Disclosure Statement (IDS). On July 10, 2006, the PTO published proposed rules with changes regarding submission of IDSes.¹

The new rules, if enacted, will place a substantial new burden on patent applicants in many common situations. For example, anytime an applicant submits more than 20 references, the applicant must explain what features, showings, or teachings caused the reference to be cited, and point out the portions of the reference where this information can be found.

The stated purposes of the changes are to enable the Examiner to focus on the relevant portions of submitted information at the outset of the examination process, give higher quality first actions, and minimize wasted time. The rules as published do not indicate whether they would apply retroactively to pending applications, or if they would only affect applications filed after a certain date.

The proposed rules, similar to the current rules, specify different rules with respect to IDSes submitted during four distinct periods of time:

First Period: Within three months of filing, within three months of entry into the national stage, or prior to a first Office action on the merits.

Generally, an IDS may be filed during this time period without triggering additional disclosure requirements. However, additional information will be required along with the following:

- Submission of more than twenty documents in one or more IDSes
- English language documents over twenty-five pages in length
- Foreign language documents.

The additional information, or explanation, includes:

- the features, showings, or teachings that caused the reference to be cited, and
- portions of the reference where this information can be found.

¹ "Changes To Information Disclosure Statement Requirements and Other Matters," 71 Fed. Reg. 38808 (2006)

What is new is that in applications in which the twenty document limit has been exceeded, additional information is required for each cited document. Documents submitted in reply to a request for information or resulting from a foreign search report would not count toward the twenty document limit.

Second Period: After a first Office action on the merits up to mailing of a Notice of Allowability, Notice of Allowance, or Notice of Intent to Issue a Reexamination Certificate (NIRC).

An IDS may be submitted during this Period, but the proposed rules require:

- an explanation for each reference, and
- a description of how the disclosure in each cited document is not present in any other document of record (i.e., a description of "non-cumulative" disclosure).

Third Period: After the Second Period up to payment of the Issue Fee.

Submission of an IDS during this Period must be accompanied by:

- a certification that each reference is being cited within three months of the date it was first cited by any foreign patent office in a counterpart foreign application or first became known to applicant, and
- a "patentability justification."

Along with an explanation and a description of a non-cumulative disclosure, a patentability justification requires either:

- an explanation of why the independent claims are patentable over the information submitted in the IDS, or
- an explanation with an amendment that causes claims to be patentable over the information submitted in the IDS.

Fourth Period: After payment of the issue fee or mailing of an NIRC up to the point at which there is no longer sufficient time for the IDS to be considered by the Examiner prior to issuance of the patent or Reexamination Certificate.

Submission of an IDS during this period must be accompanied by:

- a certification that each reference is being cited within three months of the date it was first cited by any foreign patent office in a counterpart foreign application or first became known to applicant,
- a petition to withdraw the application from issue, and
- an unequivocal statement that one or more claims are unpatentable in view of the cited information, an amendment to the unpatentable claims, and a patentability justification.

Along with the additional disclosure requirements, the PTO has proposed a "safe-harbor" provision to the duty of disclosure rule to apply to individuals "who, in good faith and to

the best of the person's knowledge, information and belief, formed after a reasonable inquiry under the circumstances, took reasonable steps to comply with the additional disclosure requirements."²

The new rules propose eliminating fees in connection with submission of IDSeS. Also, under the proposed rules, an applicant could provide consent to a third party that has provided unsolicited information to file a protest based on the information in order to shift the burden of explanation to the third party.

The proposed rules were approved by the U.S. Office of Management and Budget (OMB) on December 10, 2007. To date, the final rules (and any effective date) have not been made publicly available.

² 71 Fed. Reg. at 38811