

REMINDER – DUTY OF DISCLOSURE AND INFORMATION DISCLOSURE STATEMENT (IDS)

Duty of Disclosure

The people substantively involved in the preparation and prosecution of a U.S. patent application have a continuing duty of candor and good faith to advise the U.S. Patent and Trademark Office (USPTO) of prior art or other information that may be “material” to the examination of the application. This duty continues until a Patent is issued. Under 37 C.F.R. §1.56(c), the people subject to this duty include the inventors, employees of the assignee, and foreign/U.S. attorneys and agents. Current USPTO regulations consider information as material (1) if it contradicts or is inconsistent with the applicant’s position, or (2) if it contributes to a prima facie case (likelihood) of unpatentability alone or in combination with other information. Courts have considered as material any information that a reasonable examiner would be substantially likely to consider important in deciding whether to allow an application to issue as a Patent.

Information for Submission in an IDS

Whether information is “material” is often difficult to determine precisely. We recommend that all information that is relevant to the claimed subject matter be disclosed to the USPTO in an Information Disclosure Statement (IDS) as soon as possible. Relevant information includes U.S. patent applications, publications and patents of the inventors or assignee, and references cited therein, related to what is being claimed. References cited by a foreign patent office in a counterpart foreign application, or cited in the International Search Report in a related PCT application are relevant. References discussed in the specification need to be listed in an IDS to be officially considered and made of record. Paper copies of U.S. patent references and U.S. patent application publication references need not be submitted (paper copies of all other references are required). For any information not in English, a concise explanation of relevancy is required, as best understood by the individual designated in §1.56(c) most knowledgeable about the content of the information. This statement of relevancy may be satisfied by an English translation of any foreign patent office communication discussing the information, or an International Search Report identifying the information in a related PCT application. An English translation of any foreign language information readily available to any individual designated in §1.56(c) must also be submitted.

IDS Before First Office Action

There is no government fee if the IDS is filed within 3 months of the U.S. filing date or before a first office action.

IDS After First Office Action but Before Notice of Allowance or Final Office Action

An IDS filed more than 3 months after the U.S. application filing date or after a first office action, whichever occurs last, must be accompanied by a \$180 fee or a statement under 37 C.F.R. §1.97(e) stating either:

(1) that each item of information contained in the IDS was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the IDS; or

(2) that no item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the IDS was known to any individual designated in §1.56(c) more than three months prior to the filing of the IDS.

To make such a §1.97(e) statement, for each piece of information, please advise whether it was FIRST cited in a communication from a foreign patent office in counterpart foreign application and, if so, provide us with a copy of the communication. If the communication is not available, please provide us with the date of the communication.

IDS After Notice of Allowance or Final Office Action

An IDS filed after a Final office action or Notice of Allowance, but before payment of the Issue Fee, must be accompanied by a §1.97(e) statement and a \$180 fee. If a §1.97(e) statement cannot be made, the USPTO will not consider the information. A Request for Continued Prosecution (RCE) or other continuation procedure will be necessary.

An IDS filed after the payment of the Issue Fee will not be considered by the USPTO. A Petition to withdraw the application from issuance and an RCE or other continuation procedure will be necessary for consideration of the IDS.

IDS and Patent Term Adjustment

The period of patent term adjustment (if any) may be reduced in accordance with 37 C.F.R. §1.704(c) if an IDS is not filed within 30 days of the date any individual designated in §1.56(c) received the information. To avoid a possible reduction in patent term adjustment, we would need to include a statement (1) that each item was cited in a communication from a foreign patent office and (2) that the communication was not received by any person defined in §1.56(c) more than 30 days before filing the IDS.