

**Executive Summary: Information Disclosure Statement Notice of Proposed Rulemaking (IDS NPR)**  
**71 Fed. Reg. 38808 (July 10, 2006); XX Off. Gaz. Pat. Office YY (August 1, 2006)**

**Objectives of the IDS NPR:**

- A) Improve the quality of the examination process by:
- 1) Getting IDSs to the examiner before initial examination,
  - 2) Reducing citations to the most pertinent, and
  - 3) Where large documents, foreign language documents or a large number of documents are submitted, imposing additional disclosure requirements that will assist and expedite an examiner's consideration of the IDS; and
- B) Address practitioners' concerns by providing them with an alternative to filing an IDS when they receive unsolicited documents from a third party.

**Item I. Four time periods, and the proposed requirements for filing an IDS within each of the periods.**

**Note: Definitions of the proposed additional disclosure requirements (“explanation,” “non-cumulative description” and “patentability justification”) are given in Item II below.**

**1<sup>st</sup> period:** ends the later of three months after filing, or prior to mailing of the 1<sup>st</sup> Office action on the merits.

**General rule:** IDSs may be filed during this time period without triggering any additional disclosure requirements.

**When additional disclosure requirement is triggered:** An “explanation” would be required for:

1. Any large (over 25 pages) document (excluding sequence & computer listings);
2. Any non-English language document; and
3. ALL documents in each IDS when the cumulative number of documents filed in the 1<sup>st</sup> period exceeds 20.

**Exception from the “explanation” requirement:** All documents cited by a foreign patent office in a counterpart foreign application would be exempt from the “explanation” requirement if a search report (ISR) is also filed.

**2<sup>nd</sup> period:** starts after 1<sup>st</sup> period; ends with mailing of a Notice of Allowability or Notice of Allowance, or a NIRC.

**General rule:** IDSs may be filed but an “explanation” and a “non-cumulative description” would be required for all IDS documents.

**Exception to general rule:** All documents cited by a foreign patent office in a counterpart foreign application would be exempt from the “explanation” and “non-cumulative description” requirements if: 1) a search report (ISR), and 2) a certification that each document in the IDS is being filed within three months of the date it was first cited by any foreign patent office in a counterpart foreign application, are also filed.

**3<sup>rd</sup> period:** starts after 2<sup>nd</sup> period; ends with payment of the issue fee.

**Rule:** IDSs may be filed if accompanied by:

1. A certification that each document in the IDS is being filed within three months of the date it:  
(a) was first cited by any foreign patent office in a counterpart foreign application, or (b) first became known to the applicant, and
2. One of the “patentability justifications,” including an amendment, if necessary.

**4<sup>th</sup> period:** starts after payment of the issue fee or mailing of NIRC; ends when there is no longer sufficient time for the IDS to be considered by the examiner prior to issuance of the patent or Reexamination Certificate.

**Rule:** IDSs may be filed if accompanied by:

1. A certification that each document in the IDS is being filed within three months of the date it:  
(a) was first cited by a foreign patent office in a counterpart foreign application, or (b) first became known to the applicant,
2. A petition to withdraw the application from issue, 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 a “patentability justification”.

**Note:** For each of the time periods, if the proposed requirements for the time period are not met when the IDS is filed, the examiner is not required to consider the IDS.

**Item II. Definitions of the “Explanation,” “Non-Cumulative Description,” and “Patentability Justification” additional disclosure requirements in IDSs:**

## Executive Summary: Information Disclosure Statement Notice of Proposed Rulemaking (continued)

- (A) An “explanation” of a document would include, for each reason for which the document is being submitted:
1. An identification of:
    - (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. A correlation of the specific feature(s), showing(s), or teaching(s) to corresponding specific claim language, or to a specific portion(s) of the supporting specification, if the document is cited for that purpose.
- (B) A “non-cumulative description” (only needed after 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.
- (C) A “patentability justification” (only needed after allowance) would require either:
1. 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; or
  2. 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.

### Requirements for meaningful submissions and updating:

1. The “explanations” and “non-cumulative descriptions” must be **meaningfully different** for each document. Pro forma explanations and non-cumulative descriptions will not be accepted. If the “non-cumulative descriptions” are not meaningfully different for different documents, the examiner may decline to consider the rest of the documents in the IDS. In such an instance, the examiner should initial each considered document, and place a line through the non-considered documents.
2. If amendments affecting the scope of the claims are later filed, updated “explanations”, or a statement that no updating is needed, will be required.

**Item III. Applicant may consent to the filing of a protest by a third party for unsolicited documents received from the 3<sup>rd</sup> party:** The protest rule is proposed to be revised to set forth that an applicant may consent to the filing of a protest by a third party as to any unsolicited documents that applicant has received from the third party (e.g., resulting from litigation in a related application/patent). Thus, instead of applicant filing the documents in their application via an IDS (along with any required additional disclosure requirements), applicants could, instead, consent to the 3<sup>rd</sup> party filing a protest, and thereby shift the burden of explaining the relevance of the documents, if any, back to the third party, who would have to comply with the protest rule submission requirements.

**Item IV. Changes would apply to Reexamination Proceedings:** Similar changes are being proposed for IDS submissions during *ex parte* and *inter partes* reexamination proceedings.

**Item V. Safe harbor created for any party complying with the additional disclosure requirements:** A new paragraph is proposed to be added to the duty to disclose rule (Rule 56) to create a safe harbor for parties submitting additional disclosure statements to comply with IDS requirements if they have acted in good faith, such as by making reasonable inquiry, and they have a reasonable basis for the statements they have made.

**Executive Summary: Information Disclosure Statement Notice of Proposed Rulemaking (continued)**

**Item VI. Fee requirements to be deleted:** All fee requirements for IDS submissions are proposed to be deleted.

**Item VII. Period of time for third party submissions to be expanded:** The permitted period for third party submissions of information is proposed to 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.

**Item VIII. Certain amendments would be permitted after allowance to decrease the need to file an RCE or a continuation:** After allowance of the application, amendments to the following items would be permitted: 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 formality amendments would also be permitted after payment of the issue fee if they are submitted in sufficient time to permit the patent to be printed with the amended information.

**Item IX. 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.

**Item X. 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) Detailed Summary - IDS NPR.

**Item XI. Contact Information:** The following persons may be contacted as to any questions regarding the IDS NPR:

Hiram Bernstein  
Office of Patent Legal Administration  
(571) 272-7707

Brian Hanlon  
Office of Patent Legal Administration  
(571) 272-5047

Robert J. Spar  
Director  
Office of Patent Legal Administration  
(571) 272-7700