

Information Disclosure Statement (IDS) SUMMARY

DUTY OF DISCLOSURE

The applicant, agent or attorney and/or every individual who is substantially involved in the preparation or prosecution of a patent application has a duty to disclose all information (prior art) material to the examination of the application.

WHAT IS MATERIAL?

Basically, anything that a reasonable Examiner would consider important in deciding allowability of the claims (37 CFR 1.56). Specifically, Rule 56(b) defines "material to patentability" as:

1. establishing by itself or in combination with other information a prima facie case of unpatentability, or
2. refutes or is inconsistent with the position the applicant takes in:
 - 2.1 opposing an argument of patentability relied on by the Patent and Trademark Office (PTO) or
 - 2.2 asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion of unpatentability under the preponderance of evidence, burden-of-proof standard.

In addition to prior art such as patents and publications, material information includes, for example, information on possible prior public uses, sales, offers to sell, derived knowledge, prior invention by another, inventorship conflicts, and the like. Applicants and other individuals who have a duty to disclose should also advise us of:

- (1) any prior art cited in search reports of a foreign patent office in a counterpart application,
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines,
- (3) any material prior art or other information cited or brought to their attention in any related foreign application,
- (4) information within their knowledge as to other copending United States applications which are "material to patentability" of the application in question, and
- (5) the existence of any litigation relating to the subject matter for which a patent is being sought, as well as any other material information arising from such litigation.

HOW CAN THE DUTY OF DISCLOSURE BE COMPLIED WITH?

The Patent and Trademark Office (PTO) requires the filing of an Information Disclosure Statement (IDS) (37 CFR 1.97-1.98).

WHEN TO FILE?

Generally, you must file the IDS within three (3) months of the filing date in the U.S. or when you find out about the information, whichever is later; otherwise there will be a \$180 government processing fee. Specifically:

1. An IDS will be considered by the PTO if filed:

- 1.1 within 3 months of the **filing date** or 3 months of the date of entry into the **national stage** in the U.S. of a PCT application, or
 - 1.2 before the mailing of the **first Official Action** on the merits, whichever occurs last.
 2. If the IDS is filed after 1 above, but before the mailing date of either:
 - 2.1 the **Final Rejection** or
 - 2.2 the **Notice of Allowance**
- then the IDS will be considered if accompanied by either a **Certification** or a \$180 government fee.
3. If the IDS is filed after 2 above but before the payment of the **Issue Fee**, it will be considered if it is accompanied by:
 - 3.1 a **Certification** and
 - 3.2 a \$180 processing fee requesting consideration of the IDS.
 4. A **Certification** must certify:
 - 4.1 that each item of information was cited for the first time in any communication from a foreign patent office on an equivalent application less than 3 months ago or
 - 4.2 that no item of information was cited for the first time in any communication identified in 4.1 above nor, after reasonable inquiry, was known to anyone with the duty to disclose more than 3 months prior to the **Certification**.

WHAT TO FILE?

- A.) A list and a copy of all relevant information (patents, publications, etc.). When two or more pieces of relevant prior art are substantially identical, send a copy of the representative one and merely list the other(s).
- B.) If any information is not in English and if an English translation is available, such translation must be included, at least of the pertinent portions of the information.
- C.) A **Statement of Relevancy**, which concisely explains how the U.S. pending claims are patentable over each piece of information that is not in the English language and for which a translation is not provided, must be filed. NOTE - it is not necessary to comment on the relevancy of English language information in order to comply with your duty to disclose, but it has been held that failure to point out a relevant passage buried in an otherwise less than relevant or non-relevant text could result in a violation of your duty (MPEP 2002.03).

WHEN DOES THE DUTY END

There is a continuing duty to inform the PTO of relevant information as it becomes known, e.g., references in equivalent foreign applications, litigation, etc. Once the U.S. application issues into a patent, subsequently learned of information can be placed in the file at the PTO but will not be considered by the PTO. If such information is pertinent, a **Re-issue** or **Re-examination** must be considered.

SUMMARY

A duty to disclose continually exists. If in doubt as to the relevancy of a piece of information, err on the safe side and send a copy for filing. We urge that reasons be given why the English language prior art does not teach or make obvious the pending U.S. claims, or ask us to study and comment on the prior art, so a **Statement of Relevancy** can be filed. A **Statement of Relevancy** must be filed for non-English information. Although filing a Statement of Relevancy will increase the cost of the IDS, a savings may ultimately result if the Examiner is convinced not to apply that prior art against the claims.

Should pertinent information be knowingly withheld from the PTO, grant of a patent could be refused.