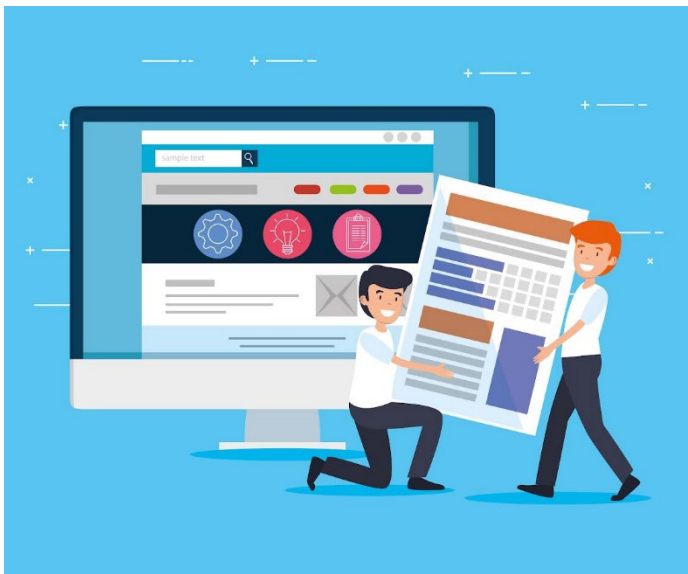


Unveiling the Importance of Information Disclosure Statements in US Patent Applications

Innoastra

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Introduction:



The process of obtaining a patent involves numerous steps and requirements, one of which is the Information Disclosure Statement (IDS). An IDS is a crucial document that accompanies a patent application and refers to a submission of relevant background art or information to the United States Patent and Trademark Office (USPTO) by the applicant. Prior art includes any publicly available information or existing patents that could potentially impact the novelty

or non-obviousness of the invention.

We will explore the significance of an Information Disclosure Statement, its purpose, and best practices for its preparation and submission.

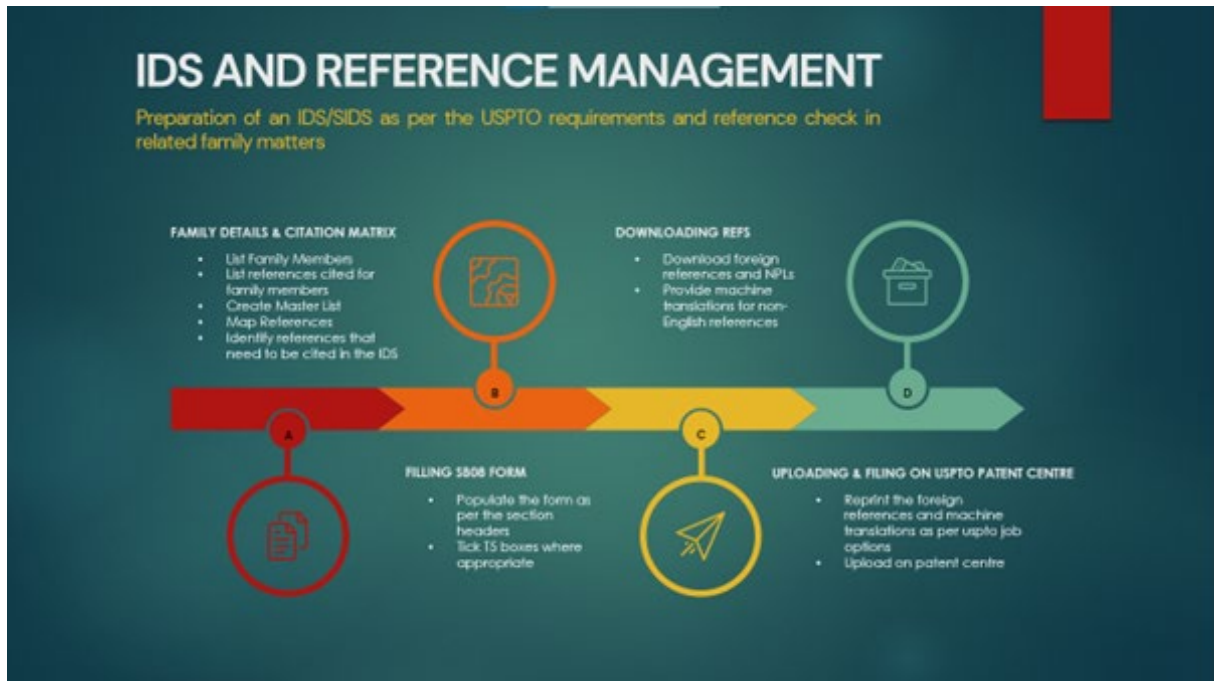
Importance of the Information Disclosure Statement:

Failure to file the IDS may invalidate your patent. If you don't submit the IDS, you may have breached your duty of candor and good faith in dealing with the United States Patent and Trademark Office (USPTO) as per 37 CFR 1.56.

Submitting an IDS ensures that the patent examiner has access to relevant prior art, helping them make an informed decision about the patentability of the invention. By disclosing prior art, the applicant shows transparency and avoids potential charges of inequitable conduct, which could lead to the patent being unenforceable.

Best Practices for Preparing an Information Disclosure Statement:

An applicant understands the significance of IDS and diligently conducts a thorough prior art search before submitting his application.



1. **Comprehensive Prior Art Search and identification of relevant prior art:** To conduct a comprehensive prior art search one may utilize various databases, patent registers, scientific literature, and online resources to identify any existing patents or publications related to the subject invention. Relevant prior art is that which impacts the invention's novelty and non-obviousness.
2. **Thorough Research:** Conduct a comprehensive search for cited prior art references in all family members of the subject patent. We may refer to the list of cited references by applicant and examiner for the US members and search and examination reports for the non-US members.
3. **Reference Organization:** Maintain a well-organized matrix of prior art references including details such as kind codes, publication dates, patentee information and first cited date. Create a master list of references and map them as cited in the family members.
4. **Populate the IDS Form:** Enter the selected references in the Form PTO/SB/08a IDS Form as per the prescribed format. Remember to tick the checkboxes where machine translations are being provided.

5. **Download and Prepare for Uploading:** Download all original copies of non-US references. Obtain machine translations for non-English references. Reprint these pdf copies as per the USPTO job options. Follow the same for NPLs as well.
6. **Timely Submission:** File the Information Disclosure Statement promptly after the identification of any new prior art. It is generally recommended to submit the IDS within three months of its discovery to ensure compliance with patent office rules and avoid potential penalties or delays.

What happens if new prior art is discovered after a Final Office Action or Notice of Allowance:

In such a scenario, the following steps can be taken:

- If the prior art references were first discovered less than 3 months ago, the applicant may file the IDS and pay a USPTO IDS fee.
- If more than three months have passed since the new prior art references were first uncovered, the applicant must file a Request for Continued Examination (RCE) and pay the USPTO fees for an RCE to in order file a supplemental IDS.

What happens if new prior art is discovered after Issue Fee Payment?

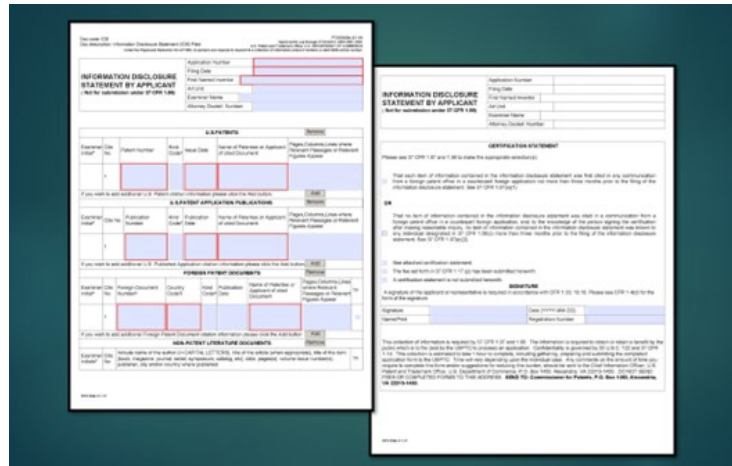
An applicant can file an IDS following the Quick Path Information Disclosure Statement or QPIDS.

Filing an IDS through QPIDS should include:

1. A transmittal form that designates the submission as a QPIDS submission, such as form PTO/SB/09.
2. An IDS, including a timeliness statement as set forth in 37 CFR 1.97(e) and the IDS fee set forth in 37 CFR 1.17(p).
3. A Web-based ePetition to withdraw from issue under 37 CFR 1.313(c)(2), including the petition fee set forth in 37 CFR 1.17(h).
4. Request for Continued Examination, treated as a conditional RCE, meaning that the RCE fee will be refunded if no item of information in the IDS necessitates reopening prosecution.
5. An authorization to charge all fees associated with the QPIDS submission to a USPTO deposit account.

How does IDS affect Patent Term Adjustment:

Patent Term Adjustment (PTA) can be negatively affected by IDS submissions when submitted after mailing of Notice of Allowance or after Request for Continued Examination. Also, filing a supplemental IDS more than 30 days after discovery may reduce the patent term adjustment.



Recent Changes:

The USPTO Patent Term Adjustment (PTA) rules include a “safe harbor” that avoids a PTA deduction for “Applicant delay” for IDS that are accompanied by **Patent Term Adjustment statement on USPTO form PTO/SB/133 using the appropriate document code “PTA.IDS”** declaring that the items being submitted were recently cited in another application. This action will not be considered a failure to engage in reasonable efforts to conclude the prosecution.

Effective July 17, 2023 this rule is applicable to any statement under 37 CFR 1.704(d).

Conclusion:

The Information Disclosure Statement is an essential component of the patent application process, demonstrating an inventor’s commitment to transparency and providing a comprehensive understanding of the prior art landscape. Embracing the importance of the Information Disclosure Statement contributes to the integrity and strength of the patent system, ultimately protecting and promoting innovation in various fields.

About InnoAstra

InnoAstra renders end-to-end IP life cycle management services to an array of entities for streamlining their IP processes – from conceptualization to actualization to commercialization.

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