

Information Disclosure Statement:

A case study

Innoastra

Introduction:

The United States Patent and Trademark Office (USPTO) mandates patent applicants to submit Information Disclosure Statements (IDS) to disclose prior art references relevant to their inventions. An efficient IDS management strategy can significantly impact the patent prosecution process. This case study focuses on a technology company's experience in handling IDS submissions within the U.S. patent system.

Filing and prosecuting patents in the United States can be a costly endeavour, particularly when Requests for Continued Examination (RCEs) become necessary. An RCE prolongs the examination process and increases expenses for patent applicants. One effective strategy to reduce RCE costs is to optimize the filing of Information Disclosure Statements (IDS).

Challenges:

The company faced several challenges related to RCE filings:

1. **Managing Vast Patent Families:** The company's diverse patent portfolio required thorough scrubbing of family histories to identify prior art references.
2. **Timeliness:** Timely identification and submission of relevant prior art was essential to comply with USPTO regulations and avoid potential penalties.
3. **Rising Costs:** The increasing number of RCE filings was driving up the company's IP budget, leading to concerns about cost control and allocation.

Solution:

The company undertook a comprehensive IDS management strategy to address these challenges and reduce RCE costs:

1. **Enhanced IDS Practices:** The company engaged our services for monitoring and managing prior art citations across all family members. We created a citation matrix and mapped references within it, effectively streamlining the process and eliminating the need to start from scratch every time a new prior art reference was identified.
2. **Timeliness:** Identifying new prior art references each time we receive an office action in any of the family members and promptly filing an Information Disclosure Statement (IDS) has significantly contributed to reducing expenses associated with filing IDS submissions.
3. **Regular Portfolio Review:** Periodic portfolio reviews were conducted to identify patents with a high likelihood of RCE filings. For these patents, the company focused on proactive measures to timely file the IDSes.

Results:

The implementation of an efficient IDS management strategy yielded substantial results:

1. **Reduced RCE Filings:** By implementing a more efficient IDS process the company was able to reduce its RCE filings by 30% over the course of two years.
2. **Cost Savings:** The reduction in RCE filings translated into substantial cost savings, contributing to a more cost-effective IP strategy.
3. **Reduced Prosecution Delays:** Timely submission of IDS packages minimized examination delays, ensuring that patent applications moved through the prosecution process more swiftly.
4. **Compliance with USPTO Regulations:** The company consistently met USPTO requirements for IDS submissions, reducing the risk of penalties and maintaining good standing.

Conclusion:

Through partnership with Innoastra and optimization of IDS practices, the company successfully reduced its RCE filings, resulting in significant cost savings.