

Patent Information Disclosure Statement (IDS) Management- USPTO Filings

Introduction

- While prosecuting patent applications in the US under the US Patent law, it is the duty of the inventor(s), applicant(s), or attorney(s)/agent(s) representing the applicant to divulge, in good faith, all the known prior art references that are known or discovered during the course of prosecution up to the date of patent issuance (37 C.F.R §1.97), before the United States Patent and Trademark Office (USPTO) in a specified format, known as the Information Disclosure Statement (IDS). The said prior-art references include patent (published applications, issued patents, etc.) and/or non-patent references (all the scientific articles that have appeared in journals, presentations, paper submissions, poster presentations, advertisements, product brochures, doctoral thesis, standards as prescribed, publications, magazines, books, or any other information that there might be) that are material to patentability of the invention (37 C.F.R. §1.56) claimed through the respective application.



Documents to be submitted

- The documents that come to the knowledge of the inventor/applicant, or attorney/agent representing the applicant, e.g., published applications or issued patents that are identified after filing the application.
- The references cited by the examiner/controller during office actions of PCT or foreign prosecution of the same (or closely related) application.
- The references identified during the International Search Report (ISR) are valid references for IDS submission.
- The references from a related PCT application or a foreign patent office examining a foreign counterpart application at later dates can also be filed as supplemental IDS submissions.
- Regarding the submission of NPL documents, full-text of the NPL reference based on availability or the level of information ‘publicly available’ needs to be submitted.



Document Formats

USPTO has specified the formats for filing the IDS, which include two parts i.e.

- IDS form comprising the required bibliographical information cited in a specific manner of all the references that are to be submitted; and
- PDF copies of the references that are listed in the IDS form.
- The PDF copies submitted should meet the criteria such as specific size and clarity for uploading the same on the USPTO website. If the list includes the non-Latin patent reference, then a translation of the same without deviating from the original meaning of the original reference (to the best of the knowledge), needs to be submitted. In this case, the original document and the translated version should be combined and submitted as a single reference.



When to file the IDS?

The procedures and requirements under 37 CFR 1.97 for submitting an information disclosure statement are linked to four stages in the processing of a patent application:

- (1)(a) For national applications (not including CPAs), within three months of filing, or before the mailing of a first Office action on the merits, whichever is later;
- (b) For international applications, within three months of the date of entry of the national stage as set forth in 37 CFR 1.491 or before the mailing of a first Office action on the merits in the national stage application, whichever is later;
- (c) For continued examinations (i.e., RCEs filed under 37 CFR 1.114) and CPAs filed under 37 CFR 1.53(d), before the mailing of a first Office action on the merits;
- (d) For international design applications, within three months of the date of publication of the international registration under Hague Agreement Article 10(3) or before first Office action on the merits, whichever is later;

When to file the IDS?

➤ Disadvantages of not Filing IDS

- (2) after the period in (1), but prior to the prosecution of the application closes, i.e., before the mailing of a final Office action, a Notice of Allowance, or an Ex parte Quayle action, whichever is earlier;
 - (3) after the period in (2) but on or before the date the issue fee is paid; and
 - (4) after the period in (3) and up to the time the patent application can be effectively withdrawn from issue under 37 CFR 1.313(c).
- The requirements based on the time when the information disclosure statement is filed are summarized in MPEP § 609.01.

Disadvantages of not Filing IDS: Failing to file a complete and accurate Information Disclosure Statement (IDS) can have significant legal consequences:

Duty of Disclosure: Non-compliance with the duty of disclosure may result in allegations of inequitable conduct, potentially invalidating the patent.

Patent Invalidity: If material prior art or information is intentionally withheld, the patent may be deemed unenforceable, affecting its legal protection.

Prosecution History Estoppel: Failure to disclose relevant prior art can narrow the scope of patent claims in future litigation, restricting enforcement rights.