

INFORMATION DISCLOSURE REQUIREMENTS

You are required by Patent Office Rule 56 to disclose to the U.S. Patent and Trademark Office (USPTO) any information of which you are aware that is "material to patentability." The proper route to submit this information to the USPTO is by an Information Disclosure Statement (IDS). This IDS must be timely disclosed in order to avoid incurring government fees.

Information That Must Be Disclosed

Any information known to Applicants or those involved in the prosecution of the patent application that is "material to patentability" must be disclosed in an IDS. That information can include, but is not limited to, the following: prior art references; prior publications of the invention; prior public uses, sales, or offers for sale of the invention; pending or published applications directed to closely related subject matter; Search Reports and Office Actions issued in counterpart foreign patent applications or in related U.S. patent applications; and contradictory positions taken in counterpart foreign patent applications or in related U.S. patent applications.

For any non-English-language document, an English-language statement of relevance must be provided. An acceptable English-language statement of relevance, generally in order of preference, can include a complete human- or machine-generated translation of the document, a corresponding English-language publication (such as an English-language counterpart of a non-English-language patent publication), a partial human- or machine-generated translation of the relevant portions of the document, an English-language version of a foreign or PCT search report or Office Action discussing the document, or an English-language summary or abstract of the document. If a complete human- or machine-generated translation of the document is readily available, such as if the translation has already been prepared or if a machine-generated translation can be readily obtained such as from the EPO or JPO websites, then it must generally be provided.

Information to be Provided to Us

Once we receive information from you, we will promptly prepare and file an IDS to submit that information to the USPTO. Thus, if any known material information has not yet been provided to the Patent Office, please (1) furnish us with a list and copies (or complete identification including date of publication) of such information; (2) advise us as to when each item of information was first cited or otherwise discovered; and (3) provide us with any available English language translation of each non-English language document. For cases in which we are not already handling the corresponding foreign applications, please also (4) provide us with an English language version of any relevant foreign search report and/or Office Actions; and (5) provide us with a concise explanation of the relevance of each untranslated non-English language reference not included in the search report and/or Office Actions.

Due Dates for Filing an IDS

The requirement to disclose any information that is "material to patentability" continues throughout prosecution of a patent application, and only ceases upon issuance of the patent. Whether particular information is considered by the Examiner, and whether a petition fee must be paid or other action taken to obtain that consideration, depends upon the current status of the application when an Information Disclosure Statement is filed. The following general guidelines apply to submission of an IDS.

Furthermore, regardless of the timeliness of filing an IDS, the filing of an IDS in some circumstances can result in a reduction of patent term adjustment that may otherwise be accorded a patent issuing on the patent application. In particular, an IDS filed (1) within one month of issuance of an Office Action or Notice of Allowance and requiring remailing of a new Office Action or Notice of Allowance, (2) after filing a reply to an Office Action, or (3) after issuance of a Notice of Allowance, can be counted as Applicant delay that can reduce otherwise available patent term adjustment. However, even in these instances, a filing containing only an IDS will not be considered Applicant delay if the IDS includes a statement that each item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart application and that this communication was not received by any individual associated with the filing or prosecution of the patent application more than thirty days prior to the filing of the IDS. See 37 CFR 1.704(d).

If such a thirty-day certification statement cannot be made in the IDS, waiting to file the IDS until after the next Office Action is issued would also avoid accruing Applicant Delay. However, if the next Office Action is non-final, the IDS may need to be filed with the government fee for filing the IDS after the three-month certification period expires. Also, if the next Office Action is (1) made final, (2) a Quayle Action, or (3) a Notice of Allowance, the IDS would need to be filed with an RCE.

Accordingly, waiting to file the IDS until the next Office Action is issued may incur significant government fees and examination delays. Thus, absent your express instructions to the contrary, in such instances where a thirty-day certification is needed to avoid accruing Applicant Delay but cannot be made, we will **not** wait to file the IDS until the next Office Action is issued.

Before Issuance of a First Office Action on the Merits

An IDS filed within three months of the U.S. filing date of an application must be considered by the Examiner. No petition fee is required. This applies regardless of whether an Office Action has already issued in the application.

An IDS filed after three months from the U.S. filing date, but before issuance of a first Office Action on the merits, likewise must be considered by the Examiner. No petition fee is required.

After Issuance of a First Office Action on the Merits But Before Close of Prosecution

An IDS filed more than three months after the U.S. filing date and after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, Notice of Allowance, or other action that closes prosecution (e.g., Quayle Action), must be considered by the Examiner. However, a petition fee may be required. No petition fee is required if each item of information contained in the IDS was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the IDS, or if no item of information in the IDS was known to any individual associated with the filing or prosecution of the patent application more than three months prior to the filing of the IDS. Otherwise, a petition fee of \$180 must be paid in order to obtain entry and consideration of the IDS.

After Close of Prosecution But Before Payment of the Issue Fee

An IDS filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection, Notice of Allowance, or other action that closes prosecution (e.g., Quayle Action), but before payment of the Issue Fee, will only be considered by the Examiner if a petition fee is paid and if the IDS is timely filed. The petition fee is currently \$180. An IDS is timely filed only if each item of information contained in the IDS was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the IDS, or if no item of information in the IDS was known to any individual associated with the filing or prosecution of the patent application more than three months prior to the filing of the IDS. If the IDS cannot be timely filed, then a Request for Continued Examination will be required in order to have the IDS considered.

With or After a Request for Continued Examination

An IDS filed with a proper Request for Continued Examination, or after the filing of a RCE but before issuance of a first Office Action on the merits thereafter, must be considered by the Examiner. Thereafter, the above criteria for filing an IDS after issuance of an Office Action continue to apply.

After Payment of the Issue Fee

Once the Issue Fee has been paid, an IDS will not be considered by the Examiner. In order to have an IDS considered by the Examiner at this stage, a Petition to Withdraw the Application From Issue and a Request for Continued Examination (or Continued Prosecution Application in the case of a design application) must be filed along with the IDS.