

REPORT

USPTO PILOT PROGRAM ALLOWS CONSIDERATION OF IDS AFTER PAYMENT OF ISSUE FEE WITHOUT RCE

May 14, 2012

The United States Patent and Trademark Office (USPTO) has recently announced the start of the "Quick Path Information Disclosure Statement" (QPIDS) pilot program. The QPIDS pilot program allows an applicant to avoid the delay and cost of a Request for Continued Examination (RCE) otherwise needed to obtain consideration of an Information Disclosure Statement (IDS) after payment of the Issue Fee, if the IDS meets certain requirements and the application remains in condition for allowance.

Currently, a Petition to Withdraw from Issue and an RCE must be filed with appurtenant fees to obtain consideration of an IDS filed after the Issue Fee is paid. The RCE may remain on the Examiner's docket for months before the IDS is considered. This may substantially delay issuance of the patent even when the application remains allowable. The QPIDS pilot program is intended to reduce pendency of applications by eliminating some RCE delays after the Issue Fee payment.

Under the QPIDS pilot program, an RCE and corresponding fee may be conditionally filed with an after-Issue-Fee-payment IDS. The Examiner will then consider the IDS. If the application remains allowable, the Examiner will acknowledge consideration of the IDS, the RCE will not be entered, the RCE fee will be refunded to the applicant, and the application will proceed to issue. Otherwise, the RCE will be entered and

the application will be further examined in due course.

I. Duration

The QPIDS pilot program will be effective as of May 16, 2012. It is currently scheduled to be available only until September 30, 2012. Therefore, unless the program is extended, any IDS filed under the QPIDS pilot program must be filed on or before September 30, 2012.

II. Requirements

The following requirements must be met for an IDS to be handled in accordance with the QPIDS pilot program:

- (1) The application must be a utility or reissue patent application (design and plant patent applications are not eligible).
- (2) The submission must be expressly designated as a QPIDS submission.
- (3) The IDS must include a "3-month certification" as set forth in 37 CFR §1.97(e)(1) or (e)(2), and the IDS fee (currently \$180).
- (4) The submission must include a Petition to Withdraw From Issue, and the petition fee (currently \$130).

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- (5) The submission must include an RCE, which will be treated as a "conditional" RCE, and the RCE fee (currently \$930 for a large entity).
- (6) All papers must be filed via the USPTO's online filing system.

III. Processing of QPIDS Submissions

A compliant QPIDS submission is granted immediately upon receipt. After being granted, the application is then placed on the Examiner's "expedited" docket for consideration.

If the Examiner determines that no item of information in the IDS necessitates reopening prosecution, the Examiner will issue a corrected Notice of Allowability indicating that the IDS has been considered and that the application remains in condition for allowance. In that case, the RCE will not be processed, and the USPTO will refund the RCE fee.

If the Examiner determines that any item of information in the IDS necessitates reopening prosecution, the RCE is processed and is placed on the Examiner's docket. In that case, the RCE is considered filed as of the date of the filing of the QPIDS submission, the USPTO will refund the IDS fee, and the USPTO will provide a notification that prosecution has been reopened. If the application is subsequently allowed, the applicant may request that the previously paid Issue Fee be reapplied.

In either case set forth above, the petition fee is not refunded. A non-compliant QPIDS submission that otherwise complies with the requirements for filing an RCE will be treated as an RCE. For example, a submission that fails to make the requisite certification in the IDS will be processed as an RCE. Similarly, a QPIDS submission that includes an amendment will be processed as an RCE.

IV. Recommendations

At present, there can be substantial delays when filing an IDS with an RCE after payment of the Issue Fee. The QPIDS pilot program appears to provide a useful tool to avoid those delays in cases where the references have not been available for more than three months. To take advantage of the QPIDS pilot program, we recommend acting as quickly as possible to avoid having the patent issue before the submission can be made. When considering whether to participate in the QPIDS pilot program, we recommend the following approach:

- (a) Review each reference to be cited to determine if it is not material to patentability (e.g., is merely cumulative). If not material, it is not necessary to submit the reference at all. However, if there is any doubt about materiality, we recommend submitting the reference. In this case, the QPIDS program may provide a relatively quick and inexpensive way to have the reference considered of record.
- (b) Consider whether it is also possible to certify under 37 C.F.R. §1.704(d) that each reference was first cited in a foreign office action received not more than thirty days prior to the filing of the IDS to avoid reduction of patent term adjustment.

Please let us know if you desire any additional information regarding the QPIDS pilot program, or if you have any questions about the duty of disclosure in patent applications.

For a discussion of the timeliness requirements for filing an IDS in circumstances other than the QPIDS pilot program, please see the complete Information Disclosure

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Requirements in the News & Events section of our website (www.oliff.com). Chinese, French, German, and Japanese language versions of the complete Information Disclosure Requirements document are available on our website.

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This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oliff & Berridge, PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.

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