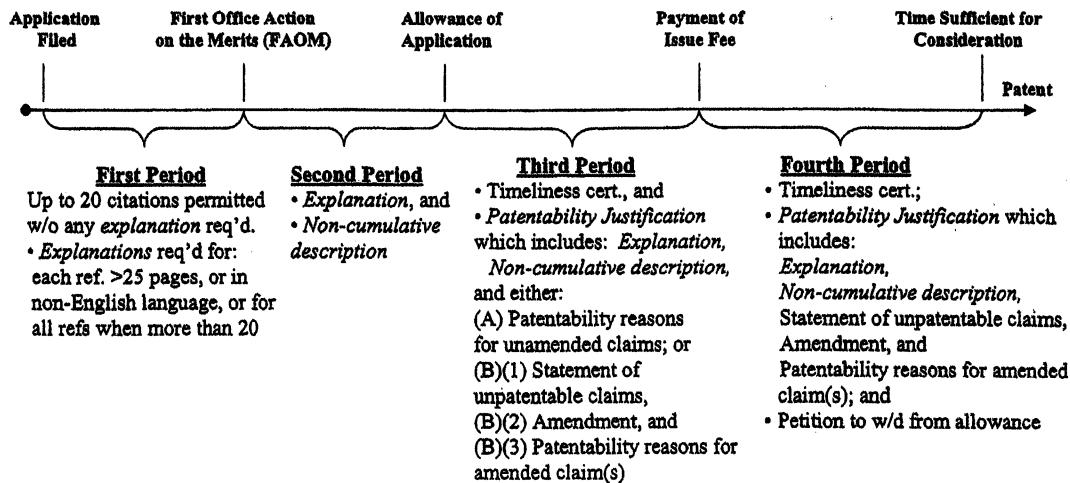


Application Prosecution Timeline and corresponding IDS requirements



U.S. PTO PROPOSED RULE CHANGES IN INFORMATION DISCLOSURE STATEMENTS¹ by Mel R. Quintos

This series of articles concerns U.S. Patent and Trademark Office (USPTO) proposed rule changes in prosecuting patent applications, including possible changes in Information Disclosure Statements (IDSs), Continuing Applications (RCEs, and Continuation and Divisional Applications), and examination of claims. Although these proposed rule changes have not yet been adopted, they are being seriously considered by the USPTO. Once they are adopted, the rule changes become effective fairly quickly.

This newsletter specifically addresses the proposed rule changes in IDSs. Corresponding IDS proposed requirements for each stage of prosecution are highlighted in the above timeline (first period through fourth period).

In the first period, no explanation is needed if the number of citations is 20 or less. An explanation is required for each reference in the first period if a reference is more than 25 pages or in a non-English language, or if the more than 20 references are submitted. For each of the second through fourth periods in the timeline, an explanation and a non-cumulative description are required for each cited reference.

An "explanation" is defined as: (1) an identification of: (i) the specific feature(s), showing(s) or teachings(s) that caused the reference to be cited, and (ii) a portion of the reference where the specific feature or the like may be found; and (2) a correlation of such feature or the like of the reference to a corresponding specific claim language or to a specific portion of the supporting specification. A "non-cumulative explanation" is, in part, defined as "a description [that] may be of a specific feature, showing, or teaching in a document that is not found in any other document of record."

A costly RCE may be avoided in the fourth period if the required reasons, as outlined in the above timeline, are submitted, along with the requisite Certification and a petition to withdraw from allowance. The Certification is, e.g., a statement that each citation contained in the IDS was first cited in a communication from a foreign patent office in a counterpart foreign application not more than 3 months prior to the filing of the IDS.

¹ This timeline is printed with permission from Mr. Robert Clark, Acting Director, Office of Patent Legal Administration, U.S. Patent and Trademark Office. This article is not intended to convey our legal opinion or advice. We disclaim any liability for any errors or omissions.