Patent Pending

USPTO Launches QPIDS Pilot Program to Consider Information Disclosure Statements

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For those of you who have experience with prosecution of utility patent applications before the United States Patent and Trademark Office, you are surely aware of the duty to disclose information that is material to the subject matter claimed in the patent application. Information that the applicant considers to be material to patentability is submitted to the patent Examiner at the United States Patent and Trademark Office as part of an Information Disclosure Statement.

Failure to submit known material information to the United States Patent and Trademark Office may lead to a subsequent finding of inequitable conduct (otherwise known in the patent community as “fraud on the Patent Office”), with the possibility that the resulting issued patent is unenforceable. Accordingly, it is important that all persons substantively involved in the prosecution of patent applications before the United States Patent and Trademark Office ensure that all known material prior art is submitted to the patent Examiner for consideration.

The United States Patent and Trademark Office has promulgated rules governing the submission of Information Disclosure Statements. 37 C.F.R. 1.97 dictates the timing and requirements for filing the Information Disclosure Statements.

According to 37 CFR 1.97 (a), [1] in order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement . . . considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within three months of the filing date of a national application other than a continued prosecution application . . .
(2) Within three months of the date of entry of the national stage . . . in an international application;
(3) Before the mailing of a first Office action on the merits; or
(4) Before the mailing of a first Office action after the filing of a request for continued examination.

Thus, 37 C.F.R. 1.97(b) provides initial time periods in which the applicant can submit an Information Disclosure Statement. Submission of the Information Disclosure Statement during the time periods described in 37 C.F.R. 1.97(b), for the most part, avoids the issuance of an Office Action on the merits of the patent application prior to having the Information Disclosure Statement considered by the patent Examiner.

In the event that the Information Disclosure Statement does not get submitted to the Examiner during one of the time periods provided in 37 C.F.R. 1.97(b), then the applicant must determine whether or not it can file the Information Disclosure Statement under 37 C.F.R. 1.97(d). 37 C.F.R. 1.97(d) provides, [A]n information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action . . ., a notice of allowance . . ., or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

(1) The statement specified in paragraph (e) of this section; or
(2) The fee set forth . . .

The provisions of 37 C.F.R. 1.97(c) address the situation where the patent applicant did not submit the Information Disclosure Statement during one of the time periods set forth in 37 C.F.R. 1.97(b), where the Examiner has issued an Office Action on the merits of the application, but where neither a final rejection or notice of allowance has been issued for the application. Under these circumstances, in order to have the items of information set forth in the Information Disclosure Statement, the patent application must either (1) make a statement that the information submitted was first contained in a counterpart foreign patent application or was not known to the applicant for more than three months, or (2) pay a fee. See 37 C.F.R. 1.97(e) below. While the fee is relatively inexpensive, it sometimes can be avoided by timely filing an Information Disclosure Statement in accordance with 37 C.F.R. 1.97(b).

In the event that the Information Disclosure Statement does not get submitted to the Examiner during one of the time periods provided in 37 C.F.R. 1.97(c), then the applicant must determine whether or not it can file the Information Disclosure Statement under 37 C.F.R. 1.97(d). 37 C.F.R. 1.97(d) provides, [A]n information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

(1) The statement specified in paragraph (e) of this section; and
(2) The fee set forth . . .

(e) A statement under this section must state either:

(1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or
(2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 1.56(c) more than three months prior to the filing of the information disclosure statement.

Accordingly, 37 C.F.R. 1.97(d) provides that the applicant may still file an Information Disclosure Statement in a patent application after the issuance of a final rejection or notice of allowance in a patent application, but before the payment of the issue fee. The filing of an Information Disclosure Statement under
37 C.F.R. 1.97(d) requires both the submission of a statement and payment of a fee. Many times patent applicants become aware of items of prior art that are material to the patentability of the subject matter claimed in a patent application after payment of the issue fee. This usually occurs when a counterparty foreign patent application is examined by a foreign patent office and the Examiner uncovers prior art that is different from the prior art already known to the applicant or that prior art cited by the Examiner examining the counterpart U.S. patent application. The current version of 37 C.F.R. 1.97 provides no mechanism by which the applicant can submit an Information Disclosure Statement to the United States Patent and Trademark Office and have the items of information considered by the Examiner. Consequently, the applicant is compelled to file a petition to withdraw the allowed application from issuance, and file a Request for Continued Examination for the sole purpose of submitting the Information Disclosure Statement. This results in increased costs for the applicant and delays the issuance of the application as a granted patent.

On May 10, 2012, the United States Patent and Trademark Office announced the launch of the Quick Path Information Disclosure Statement (QPIDS) pilot program. The QPIDS pilot program was designed to further advance the USPTO’s goals toward compact prosecution of patent applications and reducing the overall pendency of patent applications. The program was specifically designed to permit patent applicants to avoid having to file a Request for Continued Examination (RCE) to have an Information Disclosure Statement considered by the Examiner after the issue fee is paid.

Under the QPIDS pilot, the patent Examiner will consider the items submitted with the Information Disclosure Statement. Where the patent Examiner determines that no item of information submitted in the Information Disclosure Statement requires reopening of prosecution of the application, the application will be returned to issue and USPTO will issue a corrected notice of allowability for the application. In some cases, the prosecution of the application will be reopened where the patent Examiner determines that further prosecution is necessary to address one or more items submitted in the Information Disclosure Statement. In the event that no items of information submitted in the Information Disclosure Statement require further consideration by the Examiner, and prosecution is not to be reopened, the costs and delays normally associated with the filing of Requests for Continued Examination of patent applications are eliminated.

In order to be eligible to participate in the QPIDS pilot program, (1) the patent application must be a utility or reissue patent application, (2) the applicant must submit a transmittal form that clearly designates that the filing is a QPIDS submission, (3) the applicant must submit the Information Disclosure Statement, which must be accompanied by a statement under 37 C.F.R. 1.97(e), (4) the applicant must file an ePetition to withdraw the subject allowed application from issuance, and (5) a conditional Request for Continued Examination of the application. All documents associated with the QPIDS pilot program must be submitted via the EFS-Web system of the United States Patent and Trademark Office. The submission must include the official filing fee for the Request for Continued Examination. In the event that the Examiner determines that no item or items submitted in the Information Disclosure Statement necessitates the reopening of the prosecution of the application, then the Request for Continued Examination will not be processed and the official filing fee will be returned to the applicant.

According to the United States Patent and Trademark Office, a compliant petition to withdraw the application from issuance will be immediately granted, and the QPIDS Information Disclosure Statement will be identified and placed on the examiner’s expedited docket for consideration. The Examiner will review the QPIDS and determined whether or not prosecution of the application should be reopened. A non-compliant QPIDS submission that otherwise meets the requirements for filing a Request for Continued Examination will be treated as a normal Request for Continued Examination.

The QPIDS pilot program runs from May 16, 2012 through September 30, 2012. The USPTO has indicated that the QPIDS pilot program may be extended beyond September 30, 2012. The United States Patent and Trademark Office is strongly encouraging the user community to take advantage of this pilot program. Like any other pilot program initiated by the USPTO, however, the decision to extend the pilot program depends largely on feedback from the participants and the user community.

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