
More New Rules from the PTO?

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Over a year ago, the US Patent and Trademark Office published proposed new rules relating to the filing of Information Disclosure Statements. (*Information Disclosure Statement Notice of Proposed Rulemaking*, 71 Federal Register 38808 (July 10, 2006)). On December 10, 2007, the Office of Management and Budget concluded its review of the proposed rules as "Consistent without Change." New rules relating to how and when an IDS may be filed are likely to be published by the PTO within the next two to six weeks, and become effective shortly thereafter.

The exact substance of the new rules is not known, but they are likely to be much like those published for comment in July 2006. If so, they could substantially limit an applicant's ability to file an IDS, and significantly increase the substance and costs of such a submission.

Under the 2006 proposal, an applicant could file an IDS **before** a first office action in much the same way applicants can do so now. The exceptions would be when any document submitted with the IDS is more than 25 pages long, or when more than 20 documents are filed, in which cases the applicant must provide an "explanation" ("identification of specific feature(s), showing(s), or (teachings) that caused a document to be cited, and a representative portion(s) of the document where [they] may be found") and a "correlation" of these to the claims (and in some circumstances to the specification).

An IDS filed later would be more complicated, and the requirements under the 2006 proposal would increase with time. Depending on exactly when the applicant filed the IDS, it would have to include a "non-cumulative description" of how each document is not cumulative of any other document submitted or cited by the examiner, and perhaps also a "patentability justification" that, in addition to giving an explanation and non-cumulative description, would explain **either** (a) why the independent claims are patentable over the information submitted in the IDS, or (b) why an amendment, admitting that the existing claims are unpatentable, cures the unpatentability.

When it published its proposed rules some 17 months ago, the PTO said that an estimated 2,807,539 respondents would have to spend an additional 1.8 minutes to 12 hours per response. The requirements and cost of compliance with the rules that OMB has now approved remain to be seen. If the new rules generally follow the proposal, patent applicants will have a greater incentive to file information disclosure statements early.

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