

Electronic Filing of Information Disclosure Statements

BY CARL OPPEDAHL

The Patent Office recently released Version 4.1 of its ePave electronic filing software which offers a new feature, namely the electronic submission of Information Disclosure Statements. This article describes how the IDS-submission software works and gives a few tips and tricks for its use.

37 CFR section 1.98 specifies the form and content of an Information Disclosure Statement ("IDS"). It requires that copies of the disclosed references be provided. It also requires that the applicant provide a checklist which the Examiner may use to check off the references as they are considered by the Examiner. After the Examiner has signed and dated the checklist (called a "substitute form 1449" or "form PTO/SB/08A") then the Examiner mails the form to the applicant attached to an Office Action.

The new version of ePave permits filing the IDS electronically, so long as the references to be disclosed are US patents or US published patent applications. Up to 50 U.S. patent and 50 U.S. published patent application citations may be included on each Information Disclosure Statement filed via EFS. In other words, if you need to disclose a reference that is not a US patent or a US published patent application, you will still need to do it on paper, the old-fashioned way.

To do the electronic filing of an IDS, you need to have everything you would need for electronic filing of patent applications. In particular, you need a USPTO-Direct cryptographic certificate and ePave software with version number 4.1. The procedure for obtaining a cryptographic certificate, and instructions for downloading the ePave software, are described in *Electronic Filing of US Patent Applications*, Intellectual Property Today, January 2001, page 16, and more information is given at <http://www.patents.com/efs>.

If you have already done electronic filings of patent applications using ePave, then you already have the cryptographic certificate needed for electronic filing of IDSs. Unless you have upgraded your ePave software to version 4.1, however, you will need to do that upgrade before you can file IDSs.

The ePave software requires the following for an IDS:

- first and last name of first-named inventor
- application serial number
- application filing date

- confirmation number
- full title of invention

It optionally permits you to provide:

- attorney docket number
- name of Examiner
- group art unit
- your email address

For each cited reference you must provide:

- the patent number
- the patentee name (that is, the inventor's name)
- issue date

For each reference you may optionally provide:

- the "kind code"
- the class and subclass

See MPEP Section 1851 for a description of "kind codes".

It is best to gather all of the required items before starting the EFS submission. For a recently filed application, the problem will be that you do not yet know the confirmation number. If you don't know how to use PAIR-Direct (the online secure system for status of patent applications) then you would have to wait until the filing receipt arrives, which is the first time the confirmation number is communicated on paper to the applicant. But if you have a cryptographic certificate associated with your customer number, and if you filed the patent application using your customer number, then you can find out the confirmation number quite soon after filing, using PAIR-Direct. (Information about PAIR may be found at <http://www.patents.com/pair>.) The free Partridge software (<http://www.patents.com/partridge>) can also be helpful in letting you know of the confirmation number as soon as it is assigned.

To file an IDS electronically, when you launch ePave it is necessary to select "new" and "information disclosure statement." When you do, you are asked to select a folder where the IDS will be stored. It is crucial to make this a new folder, rather than trying to re-use some existing folder. You then complete the required fields (listed above) and the optional fields if desired. When you click "submit" the IDS is encrypted, digitally signed, and transmitted to the Patent Office.

There are four situations where IDSs may be filed without having to pay a fee: (1) if filed before the first office action; (2) if filed within three months of the application filing date; (3) if the references were cited in a counterpart foreign search report and if the IDS is being

filed within three months of the mailing date of the foreign search report; and (4) if the applicant was unaware of the reference more than three months before the filing date of the IDS. Options 3 and 4 each require that a certification be signed under penalty of perjury. ePave makes it easy for the filer to check a box to provide the certification for options 3 and 4.

An IDS that does not fall into one of these four categories requires payment of a \$180 fee. Suppose that you have references to disclose, and some are not US patents or publications. In this case there is no choice but to file on paper for the references that are not US patents or publications. Yet you might wish to submit electronically the references that are capable of being submitted electronically. As of the date this article is being written, the USPTO had just settled upon a policy that a single \$180 fee will cover both filings.

A related question arises if the number of references to be disclosed exceeds fifty, because ePave limits a single IDS to fifty references. If you have fifty-one references and if you were to use ePave, you would have to do two ePave IDS filings. Again, the recently devised USPTO policy is that a single \$180 fee will cover both filings.

To use this USPTO policy, all of the IDS filings (one or more electronic IDS filings and/or a paper IDS filing) must all "arrive" in the Patent Office on the same day. This means that if there is to be a paper IDS filing, it must carry a certificate of mailing dated the same day as the electronic filing. The fee is paid in the electronic IDS filing. The paper filing must also carry a statement that its fee was paid in the electronic IDS filing. If you do two or more electronic IDS filings on a particular day, the second and subsequent filings must carry a statement that their fee was paid in the previous electronic IDS filing.

When you file a paper IDS, it is an easy enough matter to make a photocopy of the IDS to be placed in the file, providing a clear record of what was disclosed. The ePave software provides an official receipt indicating that an IDS was filed, but the receipt says nothing about the numbers of the disclosed patents and patent applications. It is, of course, desirable to be able to put a piece of paper into the file that makes clear exactly what was disclosed. But the ePave software only stores a "zip" file on your computer that cannot be readily printed. To print out a copy of what was filed, use an "unzip" program to extract the contents of the "zip" file. One file, starting with "tran" and ending with ".xml," is a transmittal page which you should print. Another file, starting with "ids" and ending with ".xml," is the IDS itself, listing patents and published patent applications. This too should be printed. The transmittal page and the IDS page can then be placed in the file along with a printout of the IDS filing receipt. 