

## PROPOSED CHANGES TO IDS RULES

The USPTO proposed changes to the rules for submitting an information disclosure statement (IDS). The proposed changes would eliminate the fee requirements for submitting an IDS, but would impose various burdens on the applicant.

Submitting an IDS before a first office action on the merits that lists more than 20 references, includes a reference exceeding 25 pages, or includes a non-English reference, would require the applicant to provide an explanation of which portions of such references are relevant and how the relevant portions relate to the application. There would be an exception for references cited in a foreign search or examination report.

Submitting an IDS after a first office action but before a notice of allowance would require the explanation and a non-cumulative description of how each reference is not merely cumulative of any other cited reference. There would be an exception for references cited in a corresponding foreign application that are submitted within three months of the date first cited by the foreign patent office. Notably, there does not appear to be an exception for other references (those not related to a corresponding foreign

application) that the applicant has recently become aware of.

Submitting an IDS between a notice of allowance and payment of the issue fee would require the explanation, the non-cumulative description, reasons why the independent claims are patentable over the references, and certification that references were either (i) cited by a foreign patent office not more than three months prior to the IDS or (ii) not known to the applicant for more than three months prior to the IDS.

According to the USPTO, some applicants have submitted large numbers of references or excessively long references without identifying portions that are relevant to patentability. There is concern that such practices are for the purpose of obscuring relevant information. The proposed rule changes are intended to curtail this behavior. The proposed new rules are intended to get the most relevant information to the examiner as early as possible and to improve the quality of first office actions.

The USPTO is accepting written comments regarding the proposed changes until September 8, 2006. Comments may be emailed to [AB95.comments@uspto.gov](mailto:AB95.comments@uspto.gov) or sent via regular mail.

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