What You Need to Know and Do

United States' Patent Rules require that "[e]ach individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the [Patent] Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability". Patent applicants fulfill this requirement by filing an Information Disclosure Statement (IDS).

This publication serves to answer some of the common questions about Information Disclosure Statements.

Who has the duty of candor and good faith?

Anyone who is substantively involved in the preparation and/or prosecution of a patent application. This includes the inventors, each attorney or agent who prepares or prosecutes the application, and every other individual who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

What information must be disclosed?

Any and all material information, which is information that either creates a *prima facie* case of unpatentability of a claim (when considered alone or together with information already of record in the application), or information that would refute or be inconsistent with a position with respect to patentability already put forth by the applicant. A non-exhaustive list of possible forms of material information includes:

(i) Prior Art

Prior art refers to art that was available prior to the date an application was filed that contains support for a claim in a patent application (either the priority date or the U.S. regular filing date). Prior art may consist of: prior patents, published patent applications, printed publications (for example, books, journal articles, abstracts, advertisements, promotional literature, theses, applications for grants, reports relating to grants, slide shows, poster presentations), internet disclosures, poster presentations and commercial activity (for example, prior public exhibits, uses, experimental uses, sales or offers for sale anywhere in the world).

(ii) Related patent applications

The Patent Office should be informed about the existence of related U.S. applications for double patenting purposes. Applications can be either related by priority claim or by other criteria related to the materiality standard (for example, common inventor, specification of one application is supportive of claims in another application, applications include claims that are substantially similar or are not patentably distinct, and the presence of any common issue, fact or argument that an Examiner might consider material to patentability).

Copies or summaries of office actions and responses from related foreign applications should be provided if the contents therein are material to patentability (for example, where the foreign examiner takes a position that is different from an interpretation taken by the U.S. examiner, or identifies a feature or passage relevant to a determination of novelty or obviousness, and it appears that the U.S. examiner has overlooked that interpretation or that passage).

(iii) Other information
Any other information known to be material to patentability must be disclosed. This may include, for example, questions as to inventorship, information which may tend to contradict or cast doubt upon statements made in the application, unsuccessful experiments omitted from comparative data and information about related litigation or proceedings under the America Invents Act.

Do I need to perform a search?

There is no requirement for an inventor or applicant to perform a prior art or literature search for their invention. If a search is performed, any material results from that search must be disclosed to the Patent Office.

When must an IDS be filed?

Information material to the patentability of a claim generally must be filed in an IDS within three months of the U.S. filing date of an application or before the mailing date of the first Office Action, whichever occurs later.

Any newly discovered information material to the patentability of a claim generally must be filed within three months after such information becomes known to any person upon which the duty of candor and good faith rests.

An IDS disclosing art cited in a counterpart foreign application must be filed within three months of the date of the foreign search report.

Material information that becomes discovered after the filing of a first IDS is filed in one or more supplementary IDSs.

What if I do not file the information within these time limits?

Generally, information filed after the set time limits can still be filed as long as it is accompanied by the set government fee.

What do I need to provide to my Patent Agent?

You will need to provide a list of material information of which you, and anyone else who has the duty of candor and good faith listed above and is under your direction, are aware. Copies of any non-patent information must also be provided. Ideally, this information should be provided in electronic form.

When does the duty of candor and good faith end?

When the patent issues. It is not necessary as a routine matter to submit art discovered after the patent issues but if the art has a bearing on the patentability of the issued claims, consideration should be given to reexamination, reissue or other action. This action is essential before licensing or other enforcement.

The above represents a general overview of the Information Disclosure Statements. It is not legal advice.