Information Disclosure to the USPTO: How Much Information is Required and What Constitutes a Reasonable Inquiry

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Topics of Discussion

- 2006 Proposed Changes to the IDS Rules
- Duty to Make Reasonable Inquiry (37 CFR 10.18)
- Requirements for Information (37 CFR 1.105)

Proposed IDS Requirements

- The more substantive characterization of information provided to the USPTO by applicants, the less examination time required by examiners.

Proposed IDS Requirements

- Simple premise?
  - Yes.
- Realizable proposition under today's laws?
  - Probably not.

Proposed IDS Requirements

- The burden of examination and the burden of proof still lie with the USPTO and cannot simply be shifted to applicants via rulemaking.

Proposed IDS Requirements

- The August 01, 2006 proposed changes to the requirements for an IDS will very likely not be finalized.

Proposed IDS Requirements

- The proposed additional disclosure requirements will undoubtedly receive a *GSK* type challenge unless the USPTO is successful in appealing the *GSK* decision.

Proposed IDS Requirements

- The proposed additional disclosure requirements include characterizing disclosed references, and would be triggered before an action on the merits by disclosure of:
- (a) English language documents over 25 pages,
- (b) foreign language documents, or
- (c) more than 20 documents per application.

Proposed IDS Requirements

- One stated objective of the IDS rules package is to require applicants to "provide meaningful information."

Proposed IDS Requirements

- However, the examiner bears the initial burden, on review of prior art or on any other ground, of presenting a *prima facie* case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444-45 (Fed. Cir. 1992).

Proposed IDS Requirements

- The following USPTO advisory provided in the notice should not be ignored:

  Applicants … are reminded that the presentation of an IDS … is subject to the provisions of Sec. 10.18. The reasonable inquiry mandated … ***requires*** that information in an IDS be reviewed to assure its submission does not cause unnecessary delay or needlessly increase the cost of examination….

Proposed IDS Requirements

(cont'd)

….Failure to review can also implicate obligations of registered practitioners under Secs. 10.23(b) and (c), and Sec. 10.77(b). [Emphasis Added.]

Proposed Rules - 4 Time Periods

Time Period 1 (Proposed 37 CFR 1.97(b))

- Within 3 months of filing date of application (35 U.S.C. §111(a)), or request for reexamination
- Within 3 months of entry into national stage, or
- Prior to mailing of 1st OA

Time Period 2 (Proposed 37 CFR 1.97(c))

- After time period 1 and before earlier of:
  - Notice of Allowability or Allowance
  - Notice of Intent to Issue a Reexamination Certificate (NIRC)

Proposed Rules - 4 Time Periods

Time Period 3 (Proposed 37 CFR 1.97(d)(1))

- After time period 2 and before payment of issue fee

Time Period 4 (Proposed 37 CFR 1.97(d)(2))

- After payment of issue fee and in sufficient time to be considered by the examiner

Proposed IDS Rules: Nature of Characterization Required

- **Identification:**
  - Identifying (i) specific features or teachings that caused a document to be cited and (ii) a representative portion of a document where the specific features may be found
- **Correlation:**
  - Correlating specifically identified features to the corresponding specific claim language or to specification providing support for claim language (i.e., a 35 USC 112, ¶6 situation)

Proposed IDS Rules: Nature of Characterization Required

- **Non-Cumulative Description:**
  - Describing how each document is not merely cumulative of any other information cited
- **Patentability Justification:**
  - Providing reasons why independent claims are patentable over art, or
  - Providing (i) statement that one or more claims are unpatentable over art, (ii) amendment to claims, (iii) explanation why amended claims are patentable, and (iv) petition to withdraw from issue

Time Period 1 Key Requirements

- Time period 1
  - **Identification *and* Correlation**
- Must be provided for each foreign language document, each document over 25 pages, and for all documents if more than 20 are submitted

Time Periods 2-4 Key Requirements

- No more IDS Fees
- **Time Period 2:**
  - Identification, Correlation and Non-Cumulative Description
- **Time Periods 3 & 4:**
  - Identification, Correlation and Non-Cumulative Description, Patentability Justification and Certification

Duty to Make Reasonable Inquiry: Background

- 37 CFR 10.18(b)(2)(i) provides that:

  [b]y presenting to the Office … any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that ….

Duty to Make Reasonable Inquiry: Background

(cont'd)

… (2) To the best of the party's knowledge, information and belief, ***formed after an inquiry reasonable under the circumstances***, that -- (i) The paper is not being presented for any improper purpose, such as … to cause unnecessary delay or needless increase in the cost of prosecution before the Office …. [Emphasis added.]

Duty to Make Reasonable Inquiry: Background

- 37 CFR 10.18 in its current form has been in effect for over 10 years. However, the USPTO has recently taken to reminding practitioners of the 37 CFR 10.18 “mandates.”

Duty to Make Reasonable Inquiry: Background

- In the proposed IDS rules package, the USPTO stated that the reasonable inquiry duty requires that “information in an IDS be reviewed to assure its submission does not cause unnecessary delay or needlessly increase the cost of examination.”

Duty to Make Reasonable Inquiry: Background

- On September 11th and October 18th, 2007, Harry Moatz, Director of Enrollment and Discipline, informed the IPO and AIPLA, respectively, that OED is monitoring conduct that can be perceived as failing to make reasonable inquiry.

Duty to Make Reasonable Inquiry: Background

- Mr. Moatz asserted that the duty to make reasonable inquiry includes reading each paper submitted to the USPTO **in its entirety** regardless of the source of the paper.

Duty to Make Reasonable Inquiry: Background

- The AIPLA stated in its comments on the IDS rules package:

  The PTO is free, of course, to propose and adopt changes to its policies and practices. It would be manifestly unfair, however, to retroactively reinterpret its past policies and practices, and would create more uncertainty in an area of critical concern to the patent community, i.e., the doctrine of inequitable conduct.

Duty to Make Reasonable Inquiry: Background

- So what policies and practices did the USPTO establish in the 1997 Patent Practice and Procedure Rules Package when it last revised 37 CFR 10.18?

Duty to Make Reasonable Inquiry: Background

- In Comment 104, the USPTO advised that section 10.18(b)(2) tracks the language of Federal Rules of Civil Procedure Rule 11.

Duty to Make Reasonable Inquiry: Background

- The USPTO quoted *Hays v. Sony Electronics*, 847 F.2d 412, 418, 7 USPQ2d 1043, 1048 (7th Cir. 1988):
- "the amount of investigation required by Rule 11 depends on both the time available to investigate and on the probability that more investigation will turn up important evidence; the Rule does not require steps that are not cost-justified."

Duty to Make Reasonable Inquiry: Background

- The USPTO anticipated "that sanctions under § 10.18 (c) would be imposed only in rare situations …." See 62 FR 53132, 53176.
- The USPTO did not advise in its comment of a duty to review each document disclosed in an IDS.

Practice Tips in view of Rule 10.18

- In addition to advising clients of their duty of disclosure under Rule 56, clients should be advised that any information provided under Rule 56 should be reliable and not misleading. See 62 FR 53132, 53178.

Practice Tips in view of Rule 10.18

- A practitioner's "inquiry reasonable under the circumstances" duty under 37 CFR 10.18 will be met so long as the practitioner had no knowledge of information contrary to the information provided by the applicant or third party. See 1997 Patent Practice and Procedure Rules Package.

Read each reference before disclosing in an IDS???

- Does each reference disclosed in an IDS have to be read in its entirety by the practitioner before disclosure regardless of the source of the document?
  - The current answer from the USPTO is yes.

Read each reference before disclosing in an IDS???

- In *Innogenetics v. Abbott Laboratories*, 512 F.3d 1363, 85 USPQ2d 1641 (Fed. Cir. 2008), a practitioner admitted:
- (i) that he had not actually examined the art he characterized to the USPTO as irrelevant, and
- (ii) that his statement to that effect was boilerplate.

Read each reference before disclosing in an IDS???

- The Federal Circuit concluded in *Innogenetics* that the practitioner's mischaracterization of the art did not constitute a material omission or misrepresentation …

Read each reference before disclosing in an IDS???

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- "[g]iven that the [prior art] had been submitted…, [the examiner] was free to accept or reject the patentee's arguments…." 512 F.3d at 1378-79 and 85 USPQ2d at 1652.

Read each reference before disclosing in an IDS???

- Because an examiner is free to examine all art disclosed in an IDS, in light of *Innogenetics*, it is difficult to see the Federal Circuit finding a failure to review all documents disclosed in an IDS as inequitable conduct.

Safe Practice to Ensure Enforceability of Patents

- When in doubt, it is desirable and safest to submit information. As succinctly stated by the district court in *U.S. Industries v. Norton Co.*, 210 USPQ 94, 107 (N.D. N.Y. 1980) "the question of relevancy in close cases, should be left to the examiner and not the applicant."

Requirements for Information (37 CFR 1.105)

- 37 CFR 1.105 provides that:

  In the course of [examination], the examiner … may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter,….

Requirements for Information (37 CFR 1.105)

- 37 CFR 1.105 "includes a zone of information beyond that defined by section 1.56 …, and beyond that which is directly useful to support a rejection or conclusively decide the issue of patentability." *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 73 USPQ2d 1409 (Fed. Cir. 2005)

Requirements for Information (37 CFR 1.105)

Three zones of Information

- Zone 1 – Information required under Rule 56
- Zone 2 – Information "directly useful to support rejection or conclusively decide issue of patentability"
- Zone 3 – Rule 105 information "reasonably necessary to properly examine the application"

Requirements for Information (37 CFR 1.105)

Three zones of Information

- Zone 1 – Applicant/practitioner required to disclose information material to examination.
- Zone 2 – In order to require information from an applicant, the USPTO must first establish a *prima facie* case for the rejection. See *Hyatt v. Dudas*, 492 F3d 1365, 1369, 83 USPQ2d 1373, 1374 (Fed. Cir. 2007) (req'd information directly useful to support 35 USC 112, first paragraph, rejection) (citing *In re Oetiker*).
- Zone 3 – PTO has broad discretion to require disclosure. See *Star Fruit*.

Zone 2 Information

Hyatt v. Dudas

- Examiner stated “it is not enough that applicant show where each claimed element resides in the earliest filed application but must also provide support for the linkage of the claimed elements creating the embodiment.”
- Federal Circuit concluded that a *prima facie* case had been established because the examiner explained that the written description did not support a ***particular*** claimed combination of elements.
- Thus, burden shifted to the applicant to supply the information.

Information which can be required

- Examples of information which can be required pursuant to 37 CFR 1.105 include:
  - (v) **Information used in invention process:** A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

Zone 3

Information which can be required

(cont'd)

- (vi) **Improvements:** Where the claimed invention is an improvement, identification of what is being improved.

Zone 3

Information which can be required

(cont'd)

- (viii) **Technical information known to applicant.** Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other ***factual*** information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

Zone 2?

Practice Tips

The terms "factual" and "facts" are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR 1.105 are ***not requesting opinions*** that may be held or would be required to be formulated by applicant. MPEP 704.11

Practice Tips

- If an improper requirement for information is made in an office action pursuant to 37 CFR 1.105, the proper course of action is to traverse and request withdrawal of the requirement.
- Whether an examiner has made an improper requirement for information is not appealable issue and will likely result in abandonment of the application if not properly treated. A petition for relief is the proper course of action.
- A final agency denial on petition can be a basis for a district court action.

Information Disclosure and Requests for Information

Thank You