

PTO Launches New IDS Program for Citing References After Issue Fee Has Been Paid

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Legal Update

On May 16, 2012, the United States Patent and Trademark Office (PTO) launched a new “Quick Path Information Disclosure Statement (QPIDS)” pilot program. The program is intended to reduce application pendency and applicant costs when it becomes necessary to submit an information disclosure statement (IDS) after the issue fee is paid for a patent application.

Previously, applicants faced with this situation were required to withdraw the application from issue and submit the IDS with a Request for Continued Examination (RCE). This process involved a substantial filing fee and could delay issuance of the patent for several months or more.

Under the new program, an IDS can be filed after issue fee payment with a “conditional” RCE. Applicants must also submit a petition to withdraw from issue, the \$130 petition fee required by 37 CFR 1.17(h), the \$180 IDS fee required by 37 CFR 1.17(p), and one of the timeliness statements set out in 37 CFR 1.97(e). An IDS that complies with the QPIDS program requirements will be considered by the examiner, who will then decide whether prosecution needs to be reopened based on any item cited in the IDS. If the examiner decides not to reopen prosecution, the application will be passed to issue without processing the conditional RCE, and the applicant will not be charged a filing fee for the conditional RCE. If prosecution is reopened, the conditional RCE will be processed, the RCE fee will be charged, and the IDS fee will be refunded.

In many cases, the QPIDS program will allow applicants to have an IDS considered after issue fee payment without the expense and delay associated with filing an RCE.

The QPIDS program is set to expire on September 30, 2012, however, it may be extended with or without modification depending on feedback received from applicants and the effectiveness of the program.

For additional information on the QPIDS program, readers should review the Official QPIDS Website:
http://www.uspto.gov/patents/init_events/qpids.jsp.

This advisory was prepared by Nutter's Intellectual Property practice. For more information, please contact your Nutter attorney at 617.439.2000.

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