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USPTO introduces New Information Disclosure Statement (IDS) Size Fee and Size Fee Assertion

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OUTLINE

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- II. Changes to IDS practice**
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Changes to USPTO Patent Fees in 2025

- **Effective January 19, 2025, the final rule sets or adjusts 433 patent fees, including the introduction of 52 new fees.**
- *See Final 2025 Patents Fee Setting Rule, 89(224) Fed. Reg. 91898 (November 30, 2024)*
- The USPTO justified the increase by citing rising inflation and increased operating costs relative to nonlabor activities since the last fee increase in October 2020.

USPTO Patent Fees Increase in 2025

- <https://www.uspto.gov/learning-and-resources/fees-and-payment/summary-2025-patent-fee-changes>

Summary of 2025 patent fee changes

As part of our regular assessment of fees under our [fee-setting authority](#), we are announcing updated patent fees in a [final rule](#), effective January 19, 2025. For a complete list of fees set or adjusted, see the [final rule](#).

To view the Patents fees effective through January 18, 2025, see the [Patents fees effective through January 18, 2025](#).

The [USPTO Fee Schedule](#) will be updated on Saturday January 18, 2025, to reflect the fees that take effect on Sunday, January 19, 2025.

We've compiled three Quick Reference Guides to help address questions applicants may have about the patent fee final rule:

1. **General Quick Reference Guide** - addresses general questions and also includes several weekend/holiday scenarios that may arise.
2. **Continuing Application Fee (CAF) Quick Reference Guide** - addresses issues such as how to determine if a CAF is due, what is an "Earliest Benefit Date," what happens if applicants don't pay the CAF, application of the fee to reissue applications, and examples.
3. **Information Disclosure Statement (IDS) size fee Quick Reference Guide** - addresses the new requirements for the IDS size fee and size fee assertion, how applicants/patent owners should count references, what happens if the fee isn't paid, and examples.

Contact us at 800-786-9199 or FeesHelp@uspto.gov for questions about fee changes.



Some Fee Increases

- Excess Claim Fees
 - Each independent claim over three increases from \$480 to **\$600**
- Design Patents
 - Filing, search and examination fees rise by $\approx 48\%$
- Request for Continued Examination (RCE)
 - Second and subsequent RCE fees rise by $\approx 48\%$ to **\$2,860**
- Continuing Applications
 - Continuing applications filed 6+ years after the earliest benefit date will now incur a **\$2,700** surcharge
 - Continuing applications filed 9+ years after the earliest benefit date will now incur a **\$4,000** surcharge
- Unintentional Delay
 - Petitions filed 2+ years after a missed deadline cost **\$3,000**



New IDS Fees

- New fees for any IDS filed on or after January 19, 2025 where the cumulative number of Applicant-cited items listed in an IDS exceeds certain thresholds: 50 items, 100 items, and 200 items.
 - Exceeding 50 applicant-cited references but not exceeding 100: **\$200**;
 - Exceeding 100 applicant-cited references but not exceeding 200: **\$500**, less any amount previously paid; and
 - Exceeding 200 applicant-cited references: **\$800**, less any amount previously paid.

New IDS Fees

- No discount for small or micro entities for this new IDS fee.

Miscellaneous patent fees			Back to top		
Fee code	37 CFR §	Description	Fee	Small entity fee	Micro entity fee
1832/2832/3832	1.17(v)(1)	Filing an Information Disclosure Statement that causes the cumulative number of applicant-provided or patent owner-provided items of information to exceed 50 but not exceed 100	200.00	200.00	200.00
1833/2833/3833	1.17(v)(2)	Filing an Information Disclosure Statement that causes the cumulative number of applicant-provided or patent owner-provided items of information to exceed 100 but not exceed 200	500.00, less any amount previously paid	500.00, less any amount previously paid	500.00, less any amount previously paid
1834/2834/3834	1.17(v)(3)	Filing an Information Disclosure Statement that causes the cumulative number of applicant-provided or patent owner-provided items of information to exceed 200	800.00, less any amount previously paid	800.00, less any amount previously paid	800.00, less any amount previously paid



37 C.F.R. § 1.97 amended

37 C.F.R. § 1.97 is amended by revising paragraph (a) to read as follows:

(a) In order for an [applicant](#) for a patent or for a reissue of a patent to have an information disclosure statement in compliance with [§ 1.98](#) considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section **and be accompanied by any applicable information disclosure statement fee under § 1.17(v).**



37 C.F.R. § 1.98 amended

37 C.F.R. § 1.98 is amended by revising paragraph (a) to read as follows:

(a) Any information disclosure statement filed under [§ 1.97](#) shall include the items listed in **paragraphs (a)(1) through (4)** of this section.

(4)

A clear written assertion that the information disclosure statement is accompanied by the applicable information disclosure statement size fee under § 1.17(v) or a clear written assertion that no information disclosure statement size fee under § 1.17(v) is required.

IDS Requirements under 37 C.F.R. § § 1.97 and 1.98

- The IDS must comply with the timing requirements of § 1.97 and the content requirements of § 1.98. In a reexamination proceeding, the IDS must meet the content requirements of § 1.98.
- No specific regulatory limits to the number of items of information that may be included in an IDS.
- Most applications contain relatively few items of information provided by applicants for consideration. Approximately 87% of applications contain 50 or fewer applicant-provided items of information, and approximately 77% contain fewer than 25.
- USPTO estimates additional cost of \$10 million annually for approximately 80,000 hours each year to consider large IDS submissions

New IDS Fees

- The USPTO estimates that:
 - about 5% of applications contain 51 to 100 applicant-provided items of information and would incur only the first fee in § 1.17(v)(1),
 - about 4% of applications contain 101 to 200 applicant-provided items of information and would incur the first and second fees in § 1.17(v)(1) and (v)(2), and
 - only 4% of applications contain more than 200 applicant provided items of information and would incur all three fees in § 1.17(v)(1), (v)(2), and (v)(3).

Duty of Disclosure

- The FR states that the duty of disclosure under § § 1.56 and 1.555 only requires the submission of information material to patentability.
- Material information is described in § § 1.56(b) and 1.555(b) as information that is not cumulative to information already of record and (1) establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or (2) refutes or is inconsistent with a position the applicant takes in opposing an argument of unpatentability relied on by the USPTO or asserting an argument of patentability.

Duty of Disclosure

- The United States Court of Appeals for the Federal Circuit uses an even higher standard for materiality than the § § 1.56(b) and 1.555(b) standards by requiring “but-for” materiality, such that the USPTO would not have allowed a claim had it been aware of the undisclosed information.
Therasense, Inc. v. Becton, Dickinson & Co., 649 F.3d 1276, 1288, 99 USPQ2d 1065, 1071 (Fed. Cir. 2011) (*en banc*).
- Neither the § § 1.56(b) and 1.555(b) standards nor the Federal Circuit’s “but-for” standard require the submission of clearly irrelevant or marginally relevant information.



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MPEP 2004, item 13

13. It is desirable to avoid the submission of long lists of documents if it can be avoided. **Eliminate clearly irrelevant and marginally pertinent cumulative information.** If a long list is submitted, **highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance.** See *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), *aff'd*, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), *cert. denied*, 414 U.S. 874 (1974). But cf. *Molins PLC v. Textron Inc.*, 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).



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MPEP 2004, item 10

10. When in doubt, it is desirable and safest to submit information. **Even though the attorney, agent, or applicant does not consider it necessarily material, someone else may see it differently and embarrassing questions can be avoided.** The court in *U.S. Industries v. Norton Co.*, 210 USPQ 94, 107 (N.D. N.Y. 1980) stated “[i]n short, **the question of relevancy in close cases, should be left to the examiner and not the applicant.**” See also *LaBounty Mfg., Inc. v. U.S. Int’l Trade Comm’n*, 958 F.2d 1066, 22 USPQ2d 1025 (Fed. Cir. 1992).

IDS Requirements

- The requirement/duty to disclose continues throughout prosecution of the patent application
- Must submit information “material to patentability” in an IDS, including but not limited to:
 - prior art references;
 - prior publications of the invention;
 - prior public uses, sales, or offers for sale of the invention;
 - pending or published applications directed to closely related subject matter;
 - Search Reports and Office Actions issued in counterpart foreign patent applications or in related U.S. patent applications;
 - contradictory positions taken litigation or counterpart applications; etc.

IDS Requirements

- For a non-English-language document, an English-language statement of relevance must be provided, such as:
 - complete human- or machine-generated translation of the document,
 - a corresponding English-language publication (such as an English-language counterpart of a non-English-language patent publication),
 - a partial human- or machine-generated translation of the relevant portions of the document,
 - an English-language version of a foreign or PCT search report or Office Action discussing the document, or
 - an English-language summary or abstract of the document.

IDS Requirements

- A minimum level of public accessibility is required in order for non-patent literature (NPL) documents or information to qualify as prior art.

MPEP § 2128.01 states:

The statutory phrase “printed publication” has been interpreted to mean that before the critical date the reference must have been sufficiently accessible to the public interested in the art; dissemination and public accessibility are the keys to the legal determination whether a prior art reference was “published.” *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568, 7 USPQ2d 1057, 1062 (Fed. Cir. 1988).

- If copies are unavailable, then the information might not be publicly accessible. If copies are available, there would appear to be no excuse for failing to procure a copy of the NPL information to be included in an IDS.

MPEP § 2128.01

Some examples from MPEP:

I. A Thesis Placed In A University Library Or A Document Placed In An Online Database May Be Prior Art If Sufficiently Accessible To The Public

II. Orally Presented Paper Can Constitute A “Printed Publication” If Written Copies Are Available Without Restriction

III. Internal Documents Intended To Be Confidential Are Not “Printed Publications”

IV. Publicly Displayed References Can Constitute A “Printed Publication” Even If The References Are Not Disseminated By Copies Or Indexed In A Library Or Database

MPEP § 2128.01

- **“We have consistently held that indexing or searchability is unnecessary for a reference to be a printed publication.”** *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1359, 127 USPQ2d 1485,1493 (Fed. Cir. 2018). **But see** *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 773, USPQ2d 1507, 1514 (Fed. Cir. 2018)(**an electronic technical report did not constitute a “printed publication” because the indexing or searchability was deficient, and an interested skilled artisan, using reasonable diligence, would have to skim through potentially hundreds of titles in the same year, with most containing unrelated subject matter**).

IDS Timing

- The IDS must be timely filed to be considered during prosecution

37 C.F.R. § 1.97(b)(1) & (2)

- An applicant may file an IDS **within 3 months of the U.S. filing date.**
- No need to file a 37 C.F.R. § 1.97(e) statement or a government fee.

37 C.F.R. § 1.97(b)(3) & (4)

- An applicant may file an IDS **before the mailing of a first office on the merits or when filing of a Request for Continued Examination (RCE) before a first action.**
- No need to file a 37 C.F.R. § 1.97(e) statement or a government fee.



IDS Timing

37 C.F.R. § 1.97(c)

- *After the period specified in 37 C.F.R. § 1.97(b):* An applicant may file an IDS **before the mailing of a Final Office action, a Notice of Allowance, or an Ex parte Quayle action.**
- The IDS must be accompanied by either a 37 C.F.R. § 1.97(e) statement, or the government fee set forth in 37 C.F.R. § 1.17(p).

37 C.F.R. § 1.97(d)

- *After the period specified in 37 C.F.R. § 1.97(c):* An applicant may file an IDS **before or with payment of the issue fee.**
- The IDS must be accompanied by both a 37 C.F.R. § 1.97(e) statement and the government fee set forth in 37 C.F.R. § 1.17(p).
- If a 37 C.F.R. § 1.97(e) statement cannot be made, then an applicant must file an RCE to have the IDS considered by the Examiner.



35 C.F.R. § 1.97(e) states

“A statement under this section must state either:

(1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application **not more than three months prior to the filing of the information disclosure statement;** or

(2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, **no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.”**



IDS Fees

- The exiting IDS statement under 37 CFR 1.97(e) is still required
- The IDS size fee is a separate/additional fee
- To avoid confusion, IDS-related forms and form paragraphs can refer to the existing IDS fee in 37 CFR 1.17(p) as the “IDS timing fee” and the new IDS size fee in 37 CFR 1.17(v) as the “IDS size fee”

New IDS Fees

- Fees may be paid by check or money order (made payable to the Director of the United States Patent and Trademark Office), credit card (Form PTO-2038), or deposit account.
- When paying by deposit account, **the amount of the IDS size fee to be charged to the deposit account must be specified** to comply with 37 CFR 1.98(a)(4).
- General authorizations to charge fees to a deposit account are **not compliant** written assertions.
- Applicants are encouraged to use the USPTO-provided form SB/08c to make IDS size fee assertions



IDS Fee Size Assertion

- There is no specific language required for the written assertion, but it should be readily identifiable on the IDS and clearly convey the applicable IDS size fee by specifying the particular paragraph in § 1.17(v) that applies (*e.g.*, “the fee due under 1.17(v)(2)”), if any.
- *Acceptable language:* “the Director is authorized to charge the § 1.17(v)(2) fee for the IDS submitted on July 1, 2026 to deposit account XX–XXXXX” would be a compliant written assertion because reference to paragraph (v)(2) particularly identifies the IDS size fee due.
- *Unacceptable language:* “the Director is authorized to charge any applicable IDS size fee to deposit account XX–XXXXX” would not be a compliant written assertion because it fails to establish which IDS size fee is due.

IDS Fee Size Assertion

- An IDS must include an affirmative statement by the Applicant/Patent Owner that the IDS is accompanied by the appropriate IDS size fee or that no IDS size fee is required.
- The certification allows the examiner to promptly ascertain whether the IDS is compliant.
- Without an affirmative statement as to whether or not an IDS size fee is due, the USPTO will likely not consider the IDS and will likely issue a notice indicating that the IDS is non-compliant.
- It is okay to use notation 200+

Quick Path Information Disclosure Statement (QPIDS) program

- The duty of disclosure continues until the patent issues. If the issue fee is paid, it is possible to pay the issue fee by filing a QPIDS.
- The QPIDS program requires a proper request, a conditional RCE and the appropriate fees.
- Based on the newly submitted art, the conditional RCE provides the Examiner with the option to reopen prosecution if needed. The fee for the conditional RCE may be refundable if the Examiner does not reopen prosecution.



Quick Path Information Disclosure Statement (QPIDS) program

- An IDS that lacks the IDS size fee assertion and/or IDS size fee is non-compliant.
- If such a non-compliant IDS is filed in the QPIDS program, the submission does not comply with the requirements of the QPIDS program.
 - The non-compliant IDS should not be considered, and Applicant should expect the Office to **enter the conditional RCE**. Entry of the RCE will provide a time period for Applicant to submit a compliant IDS
 - Unless Applicant promptly submits a compliant IDS fixing the deficiencies, the subsequent Office Action will most likely be a re-allowance (because the non-compliant IDS should not be considered)
 - QPIDS transmittal form (SB/09) has been revised to specify that the IDS size fee assertion and any applicable IDS size fee are required to comply with the QPIDS program

Cumulative Count—Child applications

- Under current IDS practice, an examiner will consider items of information that were considered in a parent application when examining a child application (*e.g.*, a continuation, continuation-in-part, or divisional application) without any action required on the applicant's part. See MPEP 609.02 for information about this practice.
- Examiners will continue to follow current IDS practice with respect to considering items of information that were cited in parent applications. To be clear, an item of information that an applicant cited in a parent application will not be counted in a child application for purpose of the IDS size fees unless it is resubmitted, *i.e.*, provided by the applicant on an IDS in the child application. Thus, **applicants who wish to avoid paying the IDS size fees in a child application for items of information considered in a parent application may do so by not resubmitting the items.** An item of information must be resubmitted in the continuing application if the applicant desires the item of information to be printed on the patent. See MPEP 609.02, subsection II.A.2.



MPEP 609.02 , subsection II.A.2.

2. Continuation Applications, Divisional Applications, or Continuation-in-Part Applications Filed Under 37 CFR 1.53(b)

The examiner will consider information which has been considered by the Office in a parent application (other than an international application; see subsection I., above) when examining: (A) a continuation application filed under 37 CFR 1.53(b), (B) a divisional application filed under 37 CFR 1.53(b), or (C) a continuation-in-part application filed under 37 CFR 1.53(b). A listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.

If resubmitting a listing of the information, applicant should submit a new listing that complies with the format requirements in 37 CFR 1.98(a)(1) and the timing requirements of 37 CFR 1.97.

Applicants are strongly discouraged from submitting a list that includes copies of PTO/SB/08 or PTO-892 forms from other applications. A completed PTO/SB/08 form from another application may already have initials of an examiner and the application number of another application. This information will likely confuse the record. Furthermore, when the spaces provided on the form have initials of an examiner, there are no spaces available next to the documents listed for the examiner of the subsequent application to provide his or her initials, and the previously relevant initials may be erroneously construed as being applied for the current application.

Cumulative Count

- Each item provided (listed) on an IDS, including each instance of a particular item, will count toward the cumulative number of Applicant-cited items.
- For instance, if the applicant lists a particular item (e.g., a journal article authored by Marie Curie) twice on the same IDS, each listing will count.
- If you submit an English-language abstract of a foreign reference, and then file a machine translation of the foreign reference, each listing will count.
- Similarly, if the applicant lists the same item in multiple IDSs in the same application, each of those listings will count.
- Each listed items will count (even if they don't need to be submitted, e.g., U.S. Patents)

Cumulative Count

- However, if a particular item provided by an applicant or patent owner on an IDS was not considered because the item was non-compliant and that particular item is provided on an IDS a second time in the same application or patent, it will not be counted again.

Cumulative Count

- The count does not include items placed in the file by others, *e.g.*, items cited in a third-party submission, or items provided by a third-party requester in a reexamination.
- The count does not include items cited by the Examiner or by the Office as part of an Office program such as the Relevant Prior Art initiative
- The count does not include items cited in parent applications (unless resubmitted in the child application)

Cumulative Count

- When making the count, don't want to make a false statement to the USPTO for any reason
 - IPR petition or Declaration, along with exhibits?

Cumulative Count—U.S. Applications

- When a U.S. application is listed on an IDS, the examiner will only consider the specification (including the claims) and drawings of the application.
- If the applicant seeks consideration of documents in the prosecution history of the application such as particular Office actions, they must list such documents separately. *See* MPEP 609.04(a)(I).

Cumulative Count

- Items provided by Applicant/Patent Owner before the effective date should be considered part of the cumulative count when determining if an IDS size fee is due for an IDS that is filed on or after the effective date of the new IDS rules.
- If the cumulative count already exceeds one of the thresholds before the effective date, then a subsequent IDS filing made on or after the effective date will not incur an IDS size fee unless it causes the cumulative count to exceed a higher threshold.

Cumulative Count

- The cumulative count is determined for each application or patent separately.
- The count from an application does not carry over to any continuing applications, CPAs, reissue applications, or any post-issuance proceedings such as supplemental examinations or reexamination proceedings.
- Continuing, CPA, and reissue applications and postissuance proceedings will start with a count of zero.
- A request for continued examination (RCE) is not the filing of a new application, and thus the count will not reset when an RCE is filed.

Cumulative Count

- It is the applicant's and patent owner's responsibility to track the cumulative number of items of information provided in the application and provide a written assertion of any applicable IDS size fee due.
- In accordance with § 1.97(i), an IDS filed in an application without the written assertion or the necessary IDS size fee will be placed in the file but not considered.
 - The applicant may then file a new IDS accompanied by the written assertion or necessary IDS size fee, but the date the new IDS is filed will be the date of the IDS for purposes of determining compliance with § 1.97. See MPEP 609.05(a).
- An IDS filed in a reexamination proceeding without the written assertion or the necessary IDS size fee will be placed in the file and will remain of record, but the IDS will not be considered.

IDS Example 1 (from the FR)

- *Single IDS submission with cumulative count less than fee threshold:*
 - If an applicant submits a single IDS during prosecution with 30 items of information, no IDS size fee would be due.

IDS Example 2 (from the FR)

- *Single IDS submission with cumulative count exceeding fee threshold:*
 - If an applicant submits a single IDS during prosecution with 101 items of information, the \$500 fee under § 1.17(v)(2) for exceeding 100 items of information, but not exceeding 200, is due.
 - At the time of submitting the IDS, the applicant must certify that the § 1.17(v)(2) fee is due and pay the fee.

IDS Example 3 (from the FR)

- *Re-submission of item previously refused consideration:*
 - Applicant submits a first IDS with 49 items of information. At the time of submitting the IDS, the applicant certifies that no IDS size fee is due.
 - *When the Examiner* evaluates the first IDS, the examiner discovers that the copy of a particular item (a journal article authored by Marie Curie) provided by Applicant is blurry and illegible. Accordingly, the examiner does not consider the Curie article.
 - Subsequently, in that same application, the applicant files a second IDS with two items of information, including the same Curie article previously listed and a newly cited item.

IDS Example 3 (from the FR)

- *Con't*
 - Because the Curie article was previously before the examiner and refused consideration for being noncompliant, its resubmission in the second IDS is not counted again. Thus, the cumulative number of items of information in the application after submission of the second IDS is only 50 (the total of the 49 items from the first IDS and the newly cited item from the second IDS), and no IDS size fee would be due. At the time of submitting the second IDS, the applicant certifies that no IDS size fee is required.



IDS Example 4 (from the FR)

- *Multiple IDS submissions covered by the same fee:*
 - If an applicant files a first IDS with 61 items of information, the \$200 fee under § 1.17(v)(1) for exceeding 50 items of information, but not exceeding 100, is due. At the time of submitting the first IDS, the applicant certifies that the § 1.17(v)(1) fee is due and pays the fee.

IDS Example 4 (from the FR)

- *Con't*
 - Subsequently, in that same application, if the applicant files a second IDS with 10 items of information, the cumulative number of items of information in the application would be 71. No additional fee would be due, because the cumulative number of items is still in the range covered by the § 1.17(v)(1) fee that was previously paid.
 - While the applicant must still include a certification with the second IDS, the applicant may certify that no IDS size fee is required with submission of the second IDS.

IDS Example 5 (from the FR)

- *Multiple IDS submissions requiring additional fees:*
 - If an applicant files a first IDS with 51 items of information, they would certify that the § 1.17(v)(1) fee for exceeding 50 items of information, but not exceeding 100, is due and pay the fee of \$200.

IDS Example 5 (from the FR)

- *Con't*
 - Subsequently, in that same application, if the applicant files a second IDS with 50 items of information, the cumulative number of items of information in the application would be 101.
 - The applicant would then certify that the § 1.17(v)(2) fee for exceeding 100 items of information, but not exceeding 200, is due, and pay \$300 (the \$500 fee under § 1.17(v)(2) minus the \$200 previously paid).

IDS Example 5 (from the FR)

- *Con't*
 - Further, in that same application, if the applicant files a third IDS with 100 items of information, the cumulative number of items of information in the application would be 201.
 - The applicant would then certify that the § 1.17(v)(3) fee for exceeding 200 items of information is due and pay \$300 (the \$800 fee under § 1.17(v)(3) minus the \$500 previously paid).
 - Thus, in this example, the applicant would pay a combined IDS size fee of \$800 for the three IDSs filed during the pendency of the application.

IDS Example 6 (from the QRG)

- *Multiple IDS submissions not requiring additional fees:*
 - Prior to the effective date of the Fee Rule, applicant filed a first IDS with 55 items. No IDS size fee was due for the first IDS because it was filed before the effective date.
 - After the effective date, Applicant files a second IDS citing 10 cites. The cumulative count of items provided by the Applicant is now 65 items.
 - However, no IDS size fee is due for the second IDS, because it did not cause the cumulative count to exceed any of the thresholds specified in the rule.
 - Applicant must still include an IDS size fee assertion in the second IDS indicating that no IDS size fee is due.

IDS Example 7 (from the QRG)

- *Multiple IDS submissions requiring additional fees:*
 - Prior to the effective date of the Fee Rule, applicant filed a first IDS with 35 items. No IDS size fee was due for the first IDS because it was filed before the effective date.
 - After the effective date, Applicant files a second IDS citing 30 cites. The cumulative count of items provided by the Applicant is now 65 items.
 - The applicant would then certify that the § 1.17(v)(1) fee for exceeding 50 items of information, but not exceeding 100, is due, and pay \$200.

IDS Example 8 (from the QRG)

- *Multiple IDS submissions requiring additional fees:*
 - Prior to the effective date of the Fee Rule, applicant filed a first IDS with 70 items. No IDS size fee was due for the first IDS because it was filed before the effective date.
 - After the effective date, Applicant files a second IDS citing 40 cites. The cumulative count of items provided by the Applicant is now 110 items.
 - The applicant would then certify that the § 1.17(v)(2) fee for exceeding 100 items of information, but not exceeding 200, is due, and pay \$500.

IDS Example 9 (from the QRG)

- *Multiple IDS submissions not requiring additional fees:*
 - Prior to the effective date of the Fee Rule, applicant filed a first IDS with 205 items. No IDS size fee was due for the first IDS because it was filed before the effective date.
 - After the effective date, Applicant files a second IDS citing 10 cites. The cumulative count of items provided by the Applicant is now 215 items.
 - However, no IDS size fee is due for the second IDS, because it did not cause the cumulative count to exceed any of the thresholds specified in the rule.
 - Applicant must still include an IDS size fee assertion in the second IDS indicating that no IDS size fee is due.

Review of IDS

- Use PAIR for the “Display References” tab

- Application Data
- Documents & Transactions
- Continuity
- Patent Term Adjustment
- Foreign Priority
- Fee payment history
- Address & Attorney/Agent Information
- Supplemental Content
- Assignments
- Display References**
- eGrant

Display references

U.S. Patent Documents (1) **Reference Forms (3)** Foreign Patent and Non Patent Documents (3)

3 documents found

Mailroom Date	Doc Code	Document Description	Pages	Preview	Quick Download
05/22/2023	892	List of references cited by examiner	1	Preview	PDF
05/22/2023	1449	List of References cited by applicant and considered by examiner	1	Preview	PDF
03/29/2023	IDS	Information Disclosure Statement (IDS) Form (SB08)	1	Preview	PDF

10 per page



According to 37 C.F.R. § 1.704(d), the filing of an IDS can result in a **reduction of the PTA** when an IDS is filed:

- (1) less than one month before the mailing of an office action or notice of allowance that requires the mailing of a supplemental office action or supplemental notice of allowance;*
- (2) after a response to an office action has been filed;*
- (3) after a decision by the Board of Patent Appeals and Interferences or Federal Court, less than one month before the mailing of an office action or notice of allowance that requires the mailing of a supplemental office action or supplemental notice of allowance; and*
- (4) after a notice of allowance has been mailed.*



37 CFR 1.704 Reduction of period of adjustment of patent term.

(a) The period of adjustment of the term of a patent under [§ 1.703\(a\) through \(e\)](#) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application.

...

c(6) Submission of a preliminary amendment or other preliminary paper less than one month before the mailing of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or notice of allowance, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is eight months from either the date on which the application was filed under 35 U.S.C. 111(a) or the date of commencement of the national stage under 35 U.S.C. 371(b) or (f) in an international application and ending on the date the preliminary amendment or other preliminary paper was filed;

...

(c)(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;



- **(9)** Submission of an amendment or other paper after a decision by the Patent Trial and Appeal Board, other than a decision designated as containing a new ground of rejection under [§ 41.50\(b\)](#) of this title or statement under [§ 41.50\(c\)](#) of this title, or a decision by a Federal court, less than one month before the mailing of an Office action under [35 U.S.C. 132](#) or a notice of allowance under [35 U.S.C. 151](#) that requires the mailing of a supplemental Office action or supplemental notice of allowance, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date of the decision by the Patent Trial and Appeal Board or by a Federal court and ending on date the amendment or other paper was filed;
- **(10)** Submission of an amendment under [§ 1.312](#) or other paper, other than an amendment under [§ 1.312](#) or other paper expressly requested by the Office or a request for continued examination in compliance with [§ 1.114](#), after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in [§ 1.703](#) shall be reduced by the number of days, if any, beginning on the day after the date of mailing of the notice of allowance under [35 U.S.C. 151](#) and ending on the date the amendment under [§ 1.312](#) or other paper was filed;

37 C.F.R. § 1.704(d) states:

...a paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will **not** be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section **if** it is accompanied by a **statement** that each item of information contained in the information disclosure statement was **first cited** in any **communication from a foreign patent office in a counterpart application** and that this communication was not **received** by any individual designated in § 1.56(c) **more than thirty days** prior to the filing of the information disclosure statement. This thirty-day period is not extendable. (Emphasis added.)

**PATENT TERM ADJUSTMENT
STATEMENT UNDER 37 CFR 1.704(d)**

Application Number	Conf. No.:
Filing Date	
First Named Inventor	
Art Unit	
Examiner Name	
Practitioner Docket No.	

APPLICANT HEREBY STATES THE FOLLOWING (please review 37 CFR 1.704(d) before filing this form):

Each item of information contained in the information disclosure statement was first cited in any communication from a patent office in a counterpart foreign or international application or from the Office, and this communication was not received by any individual designated in 37 CFR 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

AND/OR

Select this box if citing references on the SB08

Each item of information contained in the information disclosure statement is a communication that was issued by a patent office in a counterpart foreign or international application or by the Office, and this communication was not received by any individual designated in 37 CFR 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

Select this box if citing OA/SR on the SB08

INSTRUCTIONS:

- This form will not satisfy the requirement of 37 CFR 1.97(e). The present statement is filed under 37 CFR 1.704(d) and will not substitute for compliance with any of the requirements of 37 CFR 1.97 and 1.98. For an information disclosure statement to comply with 37 CFR 1.97(c) or (d), the information disclosure statement must be accompanied by a statement under 37 CFR 1.97(e) notwithstanding any statement filed under 37 CFR 1.704(d).
- The present form (PTO/SB/133) should be filed concurrently with the information disclosure statement to derive benefit under 37 CFR 1.704(d).

Signature		Date	
Typed or Printed Name	Test Responsible Attorney	Practitioner Registration Number	88888



37 C.F.R. § 1.704(d) requires that the PTO/SB/133 form be used. Applicants who submit a statement under 37 CFR 1.704(d)(1) in **any manner other than on Office form PTO/SB/133** will be treated as not having submitted the statement, under 37 CFR 1.704(d)(1), as required for the “safe harbor” of 37 CFR 1.704(d).

(3) The statement under [paragraph \(d\)\(1\)](#) of this section must be submitted on the Office form (PTO/SB/133) provided for such a patent term adjustment statement using the appropriate document code (PTA.IDS). **Otherwise, the paper or request for continued examination will be treated as not accompanied by a statement** under [paragraph \(d\)\(1\)](#) of this section unless an application for patent term adjustment, in compliance with § 1.705(b), is filed, establishing that the paper or request for continued examination was accompanied by a statement in compliance with [paragraph \(d\)\(1\)](#) of this section. No changes to statements on this Office form may be made. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of this form, whether by a practitioner or non-practitioner, constitutes a certification under [§ 11.18\(b\)](#) of this chapter that the existing text and any certification statements on this form have not been altered.

- If an IDS citing newly-cited prior art from a communication from a foreign patent office is filed within thirty days of receipt along with the statement set forth in 37 C.F.R. § 1.704(d), the filing of the IDS will not result in a loss of PTA.
- Because foreign associates can be considered to be an “individual” as defined in 37 C.F.R. § 1.56(c), the thirty day period may begin when the foreign associate receives the office action/references from the foreign patent office.
- The statement under 37 C.F.R. § 1.704(d) is separate from the certification under 37 C.F.R. § 1.97(e)(1)

The PTA box should only be used if submitting an IDS would cause any PTA deduction (set in 37 C.F.R. § 1.704(c)(6), (c)(8), c(9) and c(10)), for example,

- (1) when the IDS will be filed **after** a reply (e.g., reply to an Office Action or Restriction/Election of Species Requirement)/RCE has been **submitted** and the next office action has not be issued;
- (2) when the IDS will be filed after Notice of Allowance is issued; or
- (3) when the IDS will be filed after a notice of appeal has been filed but prior to jurisdiction passing to the Patent Trial and Appeal Board.



Birch
Stewart
Kolasch
Birch LLP

Thank you!

§ 1.97 Filing of information disclosure statement.

(a) In order for an [applicant](#) for a patent or for a reissue of a patent to have an information disclosure statement in compliance with [§ 1.98](#) considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section **and be accompanied by any applicable information disclosure statement fee under § 1.17(v).**

(b) An information disclosure statement shall be considered by the Office if filed by the [applicant](#) within any one of the following time periods:

(1) Within three months of the filing date of a national application other than a continued prosecution application under [§ 1.53\(d\)](#);

(2) Within three months of the date of entry of the national stage as set forth in [§ 1.491](#) in an [international application](#);

(3) Before the mailing of a first Office action on the merits;

(4) Before the mailing of a first Office action after the filing of a request for continued examination under [§ 1.114](#); or

(5) Within three months of the date of publication of the international registration under Hague Agreement Article 10(3) in an international design application.

§ 1.97 Filing of information disclosure statement.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in [paragraph \(b\)](#) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

- (1)** The statement specified in [paragraph \(e\)](#) of this section; or
- (2)** The fee set forth in [§ 1.17\(p\)](#).

(d) An information disclosure statement shall be considered by the Office if filed by the [applicant](#) after the period specified in [paragraph \(c\)](#) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

- (1)** The statement specified in [paragraph \(e\)](#) of this section; and
- (2)** The fee set forth in [§ 1.17\(p\)](#).

§ 1.97 Filing of information disclosure statement.

(e) A statement under this section must state either:

(1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or

(2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the [person](#) signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in [§ 1.56\(c\)](#) more than three months prior to the filing of the information disclosure statement.

(f) No extensions of time for filing an information disclosure statement are permitted under [§ 1.136](#). If a bona fide attempt is made to comply with [§ 1.98](#), but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

§ 1.97 Filing of information disclosure statement.

(g) An information disclosure statement filed in accordance with this section shall not be construed as a representation that a search has been made.

(h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in [§ 1.56\(b\)](#).

(i) If an information disclosure statement does not comply with either this section or [§ 1.98](#), it will be placed in the file but will not be considered by the Office.



§ 1.98 Content of information disclosure statement.

(a) Any information disclosure statement filed under [§ 1.97](#) shall include the items listed in **paragraphs (a)(1) through (4)** of this section.

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

- (i)** The application number of the application in which the information disclosure statement is being submitted;
- (ii)** A column that provides a space, next to each document to be considered, for the examiner's initials; and
- (iii)** A heading that clearly indicates that the list is an information disclosure statement.

(2) A legible copy of:

- (i)** Each foreign patent;
- (ii)** Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
- (iii)** For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
- (iv)** All other information or that portion which caused it to be listed.

§ 1.98 Content of information disclosure statement.

(3)

(i) A concise explanation of the relevance, as it is presently understood by the individual designated in [§ 1.56\(c\)](#) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from [applicant](#)'s specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in [§ 1.56\(c\)](#).

(4)

A clear written assertion that the information disclosure statement is accompanied by the applicable information disclosure statement size fee under § 1.17(v) or a clear written assertion that no information disclosure statement size fee under § 1.17(v) is required.

§ 1.98 Content of information disclosure statement.

(b)

(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.



§ 1.98 Content of information disclosure statement.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications as specified in [paragraph \(a\)](#) of this section may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in [paragraph \(a\)](#) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

- (1)** The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under [35 U.S.C. 120](#); and
- (2)** The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.