

## Preparing and IDS/SIDS (Foreign Search Report/Prosecution Document)

### Preliminary work – Reviewing and prepping the matter for an IDS

1. Log into FIP
2. Go to the matter from which the foreign search report originated.
  - a. Check the references screen to ensure that the foreign search report/prosecution document has been entered as a reference. (It will probably be marked and will not appear if you are using the unmarked filter)
  - b. Determine the deadline for the filing of the IDS/SIDS based on this art (3 months after the document was generated).
3. Go the related matters screen find all related pending US matters. Each of these matters may need an IDS/SIDS.
  - a. If a US matters is Abandoned or Issued it does NOT need an IDS/SIDS
4. Go to the each US matter that requires an IDS/SIDS
  - a. Check the unmarked references currently in the matter.
    - i. Ensure that the foreign document is entered and is unmarked.
    - ii. Note the references that did not originate from foreign sources (or those that are older than 3 months).
  - b. Check all the related matters for any missing prosecution documents.
    - i. Check the matter management note to see when the P.D. were last updated. If they have not been updated recently look through the activities and enter any missing art.
  - c. Check to see if the matter has any un-cited US related matters.

### Merging the documents and preparing the IDS

1. Open Sidebar
2. Click on the “merges” tab
3. Enter the matter number into the “Matter #” box
4. Check to see that “Merge Roles” is set to IDS-Other
5. (If necessary – See step 4 c from preliminary work) Click merge next to “Header - Communication Concerning Prior or Copending Applications”
  - a. Select any Green (Not Red or Blue) highlighted US applications (NOT PRV or USA)
6. Click Merge next to “IDS – 1449 Form”
  - a. Note the number of documents in the pop up box (look quickly, it will disappear).
  - b. Thoroughly examine the 1449 look for and fix any errors including Misspelled references, improperly entered references, or any other errors.
    - i. Make all corrections in FIP
    - ii. If you make any corrections re-merge 1449

7. Click Merge next to "IDS – Communication"
  - a. Fill out the form

The screenshot shows the "IDS Communication" form with several red annotations and arrows pointing to specific fields:

- Two "Leave this alone" boxes with arrows pointing to the top blue header bar.
- Radio buttons for "E-Filing" (selected) and "Paper Filing", and "Deposit Account" (selected) and "Check".
- A "Check this if SIDS" box with an arrow pointing to the "Supplemental IDS" checkbox.
- A "Check only one of these" box with an arrow pointing to the "IDS Being Filed within 3 months of the filing date or before the first Office Action" checkbox.
- A "Check this if all art was received from a foreign matter within the last 3 months" box with an arrow pointing to the "References First Cited in a Search Report in a Foreign Application less than 3 months ago" checkbox.
- A "Do not check any of these three unless you have special instructions" box with an arrow pointing to the "List McKesson References in the body of the IDS Communication" checkbox.
- A "Select Sort Order" section with radio buttons for "Serial #" (selected) and "Source Matter #".
- An "Include Foreign McKesson References Paragraph" checkbox.
- A "Mail Stop:" field with the text "MS Amendment".
- "Continue" and "Cancel" buttons at the bottom.

8. Click merge next to "Transmittal – General"
  - a. Fill out the form

**General Transmittal**

☒ E-Filing ☐ Paper Filing Change this to "Other"

Due Date

# of Pages

☒ Deposit Account ☐ Check

# of Months being Extended:

Extension Fees

☐ Recalculate Necessary Fees

Claims remaining after amendment

Total Claims  Highest number previously paid for

Independent Claims

☐ Multiple dependent claims presented (and fee not paid previously)

# of pgs in Comm  # of pgs in 1449

IDS/SIDS Pages  1449 Pages  ☐ Supplemental IDS # of docs being submitted

Fee (if necessary)  # Documents  ☐ Documents Not Enclosed

If fee put 180.00

Information Concerning Prior and Copending Applications Pages

Formal Drawings (# of Sheets)

Terminal Disclaimer # of pages  Click here

Mail Stop ☒ Mail Stop Amendment ☐ Mail Stop AF

☐ Mail Stop Appeal Brief - Patents ☐ Other

Additional Documents

This should be checked

If filing CCRA put # of pgs in here

9. Save all documents to Wordox
  - a. Transmittal

The screenshot shows the 'WORLDX - Microsoft Word 2007 - File Save As' dialog box. The 'Description' field contains '899.190US1 IDS Xmit'. The 'Profile Group' is 'SLWK General Profile'. The '1. Author' is 'PMCNALLY' (McNally, Patrick). The '2. Doc Type' is 'XMIT' (Transmittal). The '3. Client' is '899' (Starkey Laboratories, Inc.). The '4. Matter' is '190'. The '5. Country' is 'US' (United States). The '6. Ext' is '1' (First). The '7. Cre By' is 'PMCNALLY' (McNally, Patrick). The 'Add'l Comments' field is empty. The 'Doc ID' is '[NewDoc]'. The 'Save As Format' is 'Word 97-2003 Document (\*.doc)'. The 'Security' button is 'Unsecured'. The 'Options', 'OK', and 'Cancel' buttons are visible. On the right, the '8.My Profiles' and '9.Public Profiles' tabs are shown, with 'Quick Profiles' selected. The 'By Profile Group' list shows 'SLWK General Profile'. A 'Load' button is at the bottom right.

- b. CCRA

The screenshot shows the 'WORLDX - Microsoft Word 2007 - File Save As' dialog box. The 'Description' field contains '899.190US1 IDS CCRA'. The 'Profile Group' is 'SLWK General Profile'. The '1. Author' is 'PMCNALLY' (McNally, Patrick). The '2. Doc Type' is 'COMM' (Communications). The '3. Client' is '899' (Starkey Laboratories, Inc.). The '4. Matter' is '190'. The '5. Country' is 'US' (United States). The '6. Ext' is '1' (First). The '7. Cre By' is 'PMCNALLY' (McNally, Patrick). The 'Add'l Comments' field is empty. The 'Doc ID' is '[NewDoc]'. The 'Save As Format' is 'Word 97-2003 Document (\*.doc)'. The 'Security' button is 'Unsecured'. The 'Options', 'OK', and 'Cancel' buttons are visible. On the right, the '8.My Profiles' and '9.Public Profiles' tabs are shown, with 'Quick Profiles' selected. The 'By Profile Group' list shows 'SLWK General Profile'. A 'Load' button is at the bottom right.

c. Communication

WORLDQX - Microsoft Word 2007 - File Save As

Description: 899.190US1 IDS Comm

Profile Group: SLWK General Profile

1. Author: PMCNALLY McNally, Patrick

2. Doc Type: IDS Enter code or click on Doc Type button for table.

3. Client: 899 Starkey Laboratories, Inc.

4. Matter: 190

5. Country: US United States

6. Ext: 1 First

7. Cre By: PMCNALLY McNally, Patrick

Add'l Comments:

Doc ID: [NewDoc]

Save As Format: Word 97-2003 Document (\*.doc)

Security: Unsecured.

Options OK Cancel

8.My Profiles 9.Public Profiles

Quick Profiles

By Profile Group

SLWK General Profile

Load

d. 1449

WORLDQX - Microsoft Word 2007 - File Save As

Description: 899.190US1 IDS 1449

Profile Group: SLWK General Profile

1. Author: PMCNALLY McNally, Patrick

2. Doc Type: IDS Information Disclosures

3. Client: 899 Starkey Laboratories, Inc.

4. Matter: 190

5. Country: US United States

6. Ext: 1 First

7. Cre By: PMCNALLY McNally, Patrick

Add'l Comments:

Doc ID: [NewDoc]

Save As Format: Word 97-2003 Document (\*.doc)

Security: Unsecured.

Options OK Cancel

8.My Profiles 9.Public Profiles

Quick Profiles

By Profile Group

SLWK General Profile

Load

10. Download all saved documents from Worldox
11. Combine all documents together into one PDF (Order below)
  - a. Xmit
  - b. CCRA
  - c. Comm
  - d. 1449
12. Send email to attorney for signature
  - a. CC the IDS Specialist
  - b. Subject line = <Matter Number> - Documents for signature
    - i. Add "ASAP" If necessary. Also, if necessary, check the "High Importance Flag"
  - c. Body
    - i. I have prepared a SIDS for <Matter Number> in response to a foreign office action received in a related matter. I prepared the SIDS to cite the received document and all currently unmarked references in FIP. If this is satisfactory, please sign and return the attached document. If not, please let me know what changes you would like made.
  - d. Attach the document
  - e. Send

#### Filing the SIDS

1. Once you have received the signed document back from the attorney you can begin filing.
2. Save the signed copy (I recommend creating a folder for each matter)
3. Check the document
  - a. Make sure the attorney signed everywhere required
  - b. Make sure there are no errors
  - c. Make sure the month in the signature block is correct
4. Add your own signature and name
5. Flatten the document (Print through Adobe PDF).
6. Go to the matter in FIP
  - a. Check to make sure the status of the matter has not changed
  - b. Go to the references screen
    - i. Make sure there are no new references
    - ii. Download all foreign and NPL references for submission.
      1. Check to make sure all references were saved
      2. Check to make sure the number of references downloaded matches the number of files in the folder.
7. Open Sidebar
  - a. Click on the "Toolbox" Tab
  - b. Click on "IDS Tools"
  - c. Enter the matter number into the "Matter #" box
  - d. Click Locate Folder (Select the folder to which the references were saved)
  - e. Click "Get References"

- f. Click Bulk Rename
  - g. Click through prompt
  - h. Close sidebar
- 8. Flatten all references
  - a. Set default printer to Adobe PDF
  - b. Highlight all the references
  - c. Right click – select “Print”
    - i. Wait – this can take a while some times
  - d. Check the resulting references
    - i. Make sure the number of flattened files matches the number of originals.
    - ii. Make sure they are all still renamed
    - iii. Make sure no file is larger than 25 MB

9. Open a new window and login to USPTO – EFS

a. Certification Page

- i. Check the box for “I certify that I am working under the authority of the certificate holder: <NAME HERE>”
- ii. Check the box for “Existing application/patent”
  1. Check the box for “Document/Fees for an existing application”
    - a. Fill in the information. This information can be found either on the documents you are filing (Upper right corner) or in the matter in FIP under “Details”.

iii. Click continue

b. Attach Documents Page

- i. Select the signed PDF fill out the fields appropriately (example below)

EF S Registered

Registered eFilers | Please Read Announcements | Application Data | Attach Documents | Review Documents | Calculate Fees | Confirm & Submit | Pay Fees | Receipt

**Attach Documents**

A submission has not been filed officially at the USPTO until the e-filer executes the Submit function and the documents are received at the USPTO Eastern Time. The Acknowledgement Receipt is evidence of this submission.

I have no documents for this filing, please continue to [Calculate Fees](#).

**This is the application data associated with your filing. If any information is incorrect, please click [Cancel](#)**

Application Number	12027151
Title of Invention	ANTENNA USED IN CONJUNCTION WITH THE CONDUCTORS FOR AN AUDIO TRANSDUCER
First Named Inventor	Jeffrey Paul Solum
Customer Number or Correspondence Address	21186
Filed By	Gregory W. Smock/Patrick McNally
Attorney Docket Number	899.170US1
Application Type	Utility under 35 USC 111(a)

Files to be Submitted	Category	Document Description		
1 C:\Users\RapidCity1\Desktop\Proj1				
Does your PDF file contain multiple documents? <input checked="" type="radio"/> Yes <input type="radio"/> No				
	Category	Document Description	Page Start	Page End
	General Transmittal	Miscellaneous Incoming Letter	1	1
	General Transmittal	Miscellaneous Incoming Letter	2	3
	IDS/References	Transmittal Letter	4	5
	IDS/References	Information Disclosure Statement (IDS) Filed (SB/08)	6	6

[Add Document](#)

[Add File](#)

1. Upload and validate the Signed SIDS document

ii. Click Attach Files

1. Add all references to be submitted as files.
  - a. For Foreign Publications select “IDS/References” and Foreign Reference”
  - b. For NPL documents select “IDS/References” and NPL
2. You can only submit 20 documents and one time and only 60 per filing.



- iii. Check for any errors
  - 1. Documents over 25 MB
    - a. Open the file in Adobe
    - b. Click "Document"
    - c. Click "Reduce file size"
    - d. Select "Acrobat 7.0 or later"
  - 2. Unembedded Font
    - a. Flatten document – If printing through Adobe PDF doesn't work contact me.
  - 3. Pages size to large
    - a. Flatten document
- c. Calculate Fees Page
  - i. You shouldn't have to do anything here as any IDS/SIDS you are filing should be free.
- d. Submit Application Page
  - i. Check everything over one last time – Click Submit
- e. Receipt page
  - i. Save the E-filing receipt.

#### 10. Update FIP

- a. Go to the matter in FIP.
  - i. SIDS activity
    - 1. Click edit for the unfinished SIDS activity.
      - a. Fill in the dates for filing and e-filing receipt received.
      - b. Click Save
    - 2. Click on the open folder for the SIDS activity
      - a. Add the submitted SIDS as a reference
        - i. Leave select as other
      - b. Add the E-filing receipt as a reference
        - i. Select confirmation first
    - 3. Click the green calculator for the SIDS activity
      - a. Add billing for preparation (p38 is the code for SIDS prep)
        - i. Add time billed
        - ii. Add client billing code if necessary
      - b. Add billing for filing (p42 is the code for filing)
        - i. Add client billing code if necessary.
  - ii. CCRA Activity (Only if you filed a CCRA)
    - 1. Create CCRA Activity (Code = CCRA)
    - 2. Add document
    - 3. Add billing (P40 is code)
      - a. Add time as billed
    - 4. Go to related matters screen and mark all references cited as cited
- iii. Go to the references screen mark all references cited as cited