the course of the standards rulemaking process, the Department will perform a detailed analysis of the impact of possible standards on manufacturers, as well as a more disaggregated assessment of their possible impacts on user-subgroups.

B. Future Proceedings

The Department will begin, therefore, the process of establishing testing requirements for small electric motors, which it expects will result in the publication of a proposed rule. During the rulemaking process, the Department will consider the Institute of Electrical and Electronics Engineers (IEEE) Standard 114–2001, *Test Procedures for Single-Phase Induction Motors.*

The Department also will begin a proceeding to consider establishment of energy conservation standards for small electric motors. Throughout the rulemaking process, the Department intends to adhere to the provisions of the Process Rule, where applicable. During the standards rulemaking, the Department will review and analyze the likely effects of industry-wide voluntary programs, such as ENERGY STAR and NEMA Premium®. In addition, any efforts by NEMA and SMMA to strengthen their efforts to promote voluntary standards for small motors will be considered. The Department will collect additional information about design options, inputs to the engineering and LCC analyses, and potential impacts on the manufacturers and consumers of small motors. During the standards rulemaking process, the Department will evaluate whether standards are technologically feasible and economically justified, and are likely to result in significant energy savings in accordance with the requirements of EPCA. (42 U.S.C. 6295(o)) If further analyses reveal that standards are not warranted, DOE will revise this determination and will not proceed to promulgate standards.

Issued in Washington, DC, on June 27, 2006.

Alexander A. Karsner,

Assistant Secretary, Energy Efficiency and Renewable Energy.

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DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO–P–2005–0024]

RIN 0651–AB95

Changes To Information Disclosure Statement Requirements and Other Related Matters

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The United States Patent and Trademark Office (Office) is proposing changes to information disclosure statement (IDS) requirements and other related matters to improve the quality and efficiency of the examination process. The proposed changes will enable the examiner to focus on the relevant portions of submitted information at the very beginning of the examination process, give higher quality first actions, and minimize wasted steps. The Office is proposing the following changes relating to submissions of IDSs by applicants/patent owners: Before a first Office action on the merits, require additional disclosure for English language documents over twenty-five pages, for any foreign language documents, or if more than twenty documents are submitted, but documents submitted in reply to a requirement for information or resulting from a foreign search or examination report would not count towards the twenty document limit; permit the filing of an IDS after a first Office action on the merits only if certain additional disclosure requirements have been met; and eliminate the fees for submitting an IDS. Updates to the additional disclosure requirements would be required as needed for every substantive amendment. The Office is also proposing to revise the protest rule to better set forth options that applicants have for dealing with unsolicited information received from third parties.

DATES: To be ensured of consideration, written comments must be received on or before September 8, 2006. No public hearing will be held.

ADDRESSES: Comments should be sent by electronic mail over the Internet addressed to: *AB95.comments@uspto.gov*. Comments may also be submitted by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450; or by facsimile to (571) 273–7707, marked to the attention of Hiram H. Bernstein. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (*http://www.regulations.gov*) for additional instructions on providing comments via the Federal eRulemaking Portal.

The comments will be available for public inspection at the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, currently located at Room 7D74 of Madison West, 600 Dulany Street, Alexandria, Virginia, and will be available through anonymous file transfer protocol (ftp) via the Internet (address: *http://www.uspto.gov*). Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Hiram H. Bernstein ((571) 272–7707), Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy; or Robert J. Spar ((571) 272–7700), Director of the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, directly by phone, or by facsimile to (571) 273–7707, or by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450.

SUPPLEMENTARY INFORMATION: The Office is proposing changes to the rules of practice in title 37 of the Code of Federal Regulations (CFR) to revise IDS practice. The Office is specifically proposing changes to §§ 1.17, 1.48, 1.55, 1.56, 1.97, 1.98, 1.99 1.291, 1.312, 1.555, and 1.948.

The Office will post a copy of this notice on its Internet Web site (*http://www.uspto.gov*). Additionally, individuals or organizations that need a copy for the purpose of providing comments, may send a request by phone or e-mail to Terry Dey at ((571) 272–7730 or *terry.dey@uspto.gov*) to receive an e-mail copy of the notice. When making a request for an e-mail copy, it is requested that persons please specify whether they wish to receive the document in MS-Word, WordPerfect, or HTML format.

The following definitions are intended to facilitate an understanding of the discussion of the proposed rules.

The words "information," "citation" and "document" are used to describe any item of information listed in an IDS. Unless otherwise indicated, the term "applicant" is intended to cover the "patent owner" in regard to submissions of IDSs in *ex parte* or *inter partes* reexaminations. The words "§ 1.56(c) individual" are intended to cover all parties identified in § 1.56(c).

Background and Rationale: Persons associated with a patent application have a duty to disclose certain information to the Office. This duty was codified as § 1.56 in 1977. Pursuant to § 1.56(a), each individual associated with the filing and prosecution of a patent application must disclose to the Office "all information known to that individual to be material to patentability." It must be emphasized that there is no duty to disclose information to the Office if the information is not material. As a companion to § 1.56, §§ 1.97 and 1.98 were added to provide "a mechanism by which patent applicants may comply with the duty of disclosure provided in § 1.56." *See Manual of Patent Examining Procedure* § 609 (8th ed. 2001) (Rev. 3, August 2005) (MPEP).

Although § 1.56 clearly imposes a duty to disclose material information, that rule neither authorizes nor requires anyone to file unreviewed or irrelevant documents with the Office. Such documents add little to the effectiveness of the examination process and, most likely, negatively impact the quality of the resulting Office determinations.

One goal of the changes proposed in this notice is to enable an examiner to identify the most relevant prior art in an efficient and expeditious manner, even when an IDS containing a large number of documents is submitted. The changes proposed in this notice accomplish this by requiring in certain circumstances additional disclosure about documents cited in an IDS. Applicants and their representatives are reminded that the presentation of an IDS, like any other paper filed in the Office, is subject to the provisions of § 10.18. The reasonable inquiry mandated by §§ 10.18(b)(2) and 10.18(b)(2)(i) requires that information in an IDS be reviewed to assure its submission does not cause unnecessary delay or needlessly increase the cost of examination. Failure to review can also implicate obligations of registered practitioners under §§ 10.23(b) and (c), and § 10.77(b). Likewise, when an IDS includes several documents of marginal relevance, combined with other evidence suggesting that the marginally relevant information was submitted with the intent to obscure material information, this may run afoul of the duty of candor and good faith set forth in § 1.56(a). In such circumstance, an inference that the applicant or their representative attempted to cover up or conceal a material reference could be drawn. See § 10.18(b); *and see Molins PLC* v. *Textron, Inc.*, 48 F.3d 1172, 1184, 33 USPQ2nd 1823, 1831 (Fed. Cir. 1995) ("burying a particularly material reference in a prior art statement containing a multiplicity of other references can be probative of bad faith").

Current IDS requirements are ineffective: Current §§ 1.97 and 1.98 do not encourage applicants to bring the most relevant information to the attention of the examiner early in the examination process, at least, in part, because applicants and practitioners mistakenly believe that people associated with a patent application must submit questionably or marginally relevant documents in order to ensure compliance with the § 1.56 duty of disclosure. A limited amount of time is available for an examiner's initial examination of the application, which includes at least a mandatory cursory review of each document cited. Thus, when large IDSs are submitted without any identification of relevant portions of documents, some of the examiner's limited time is diverted to consider the cited documents, and efforts to perform a quality examination may be adversely affected. This is especially true when the submission includes irrelevant or marginally relevant documents, and the situation is worsened when a large number of the documents are irrelevant, marginally relevant, or cumulative. It appears that applicants sometimes file large collections of information for the examiner's review without having first reviewed the information themselves for relevance in the mistaken belief that such action is permitted under the current rules. If irrelevant information is filtered out before an IDS is filed, the examiner will be able to focus upon the more relevant information, and perform a more efficient, effective examination.

The effectiveness and quality of the examination process, as well as the resulting patentability determinations, stand to improve if the most pertinent information about the invention is before the examiner during examination, and especially before the first Office action. Early submission of pertinent information by the applicant goes hand in hand with an examiner's prior art search in making sure that the goals of improving the effectiveness and quality of the examination process, and the resulting patentability determinations, are achieved. The Office recognizes, however, that sometimes not all pertinent information is available for submission prior to the first Office action on the merits. Therefore, to allow for such circumstances while still achieving these goals, the later a document is submitted during the prosecution process, the greater the amount of additional disclosure that the applicant will be required to provide. The Office is proposing a structure for filing IDSs that will enable applicants to provide meaningful information to the examiner in the most effective and efficient manner.

Elimination of fee requirements (§ 1.17(p)): The fee requirement under § 1.17(p) for submitting an IDS is proposed to be eliminated. Under current § 1.97, an applicant can delay the examiner's receipt of relevant information until after the initial stage of examination by simply paying the fee under § 1.17(p). Under the proposed rules, an applicant wishing to submit an IDS after a first Office action on the merits and before the mailing date of a notice of allowability or a notice of allowance under § 1.311 could only do so if applicant meets the certification requirements under § 1.97(e)(1) (that the information was discovered as a result of being cited by a foreign patent office in a counterpart application and is being submitted to the Office within three months of its citation by the foreign patent office), or applicant complies with applicable additional disclosure requirements.

The current requirements under §§ 1.97 and 1.98 for submitting an IDS after a notice of allowance are proposed to be revised by providing two windows, one before, or with, and one after, payment of the issue fee. Submission of an IDS during either of these two windows will require compliance with heightened additional disclosure requirements (compared to those required for submissions after a first Office action but prior to a notice of allowance or notice of allowability), which will depend upon whether a current claim is unpatentable in view of the information in the newly submitted IDS.

Threshold number of cited information: Under the proposed rules, when an applicant submits an unusually large amount of information before a first Office action, the applicant must help to ease the burden on the Office associated with the examiner's consideration of the information. The Office has surveyed, across all technologies, 3,084 small entity applications and 9,469 non-small entity applications, covering a six-week period of allowed applications to determine the

appropriate threshold number of cited information. In this survey, which includes all IDSs submitted at any time during the prosecution process of an application, approximately eighty-five percent of the sample included twenty or fewer submitted documents, while eighty-one percent of applications included fifteen or fewer submitted documents. Thus, the Office has determined that for IDSs submitted prior to a first Office action on the merits, a threshold of twenty documents best balances the interests of the Office and of the applicants. It should be noted that a threshold of twenty documents for IDSs submitted prior to a first Office action on the merits would not require a change in practice for most applications. The Office expects that more than eighty-five percent of IDSs filed prior to first Office action on the merits would not require any explanation because the threshold number only applies to IDSs filed prior to first Office action and has certain exceptions, while the above-mentioned survey included all IDSs filed throughout the entire prosecution of the application with no exceptions. The threshold of twenty cited pieces of information is deemed adequate, particularly in view of the fact that documents resulting from a foreign search or examination report when accompanied by a copy of the foreign search or examination report, would be excepted (not counted toward the threshold number). In addition, documents submitted in reply to a requirement for information under § 1.105 would also be excepted.

Additional Disclosure Requirements: The Office is proposing additional disclosure requirements for some IDS submissions to promote effective and efficient examination. First, for applications in which twenty or fewer documents have been cited in one, or more IDS prior to a first Office action on the merits, an explanation is required only for English-language documents over twenty-five pages, and for non-English-language documents of any length. Second, for applications in which more than twenty total documents have been cited in one, or more, IDS prior to a first Office action on the merits, an explanation is also required for each cited document. The required explanation must identify information in each document that is relevant to the claimed invention or supporting specification. These required explanations are intended to provide meaningful information to the examiner when a large IDS, considering all IDSs cumulatively which are filed within this window of time, is presented before a first Office action on the merits has been given.

More extensive disclosure requirements would apply to IDS submissions after a first Office action on the merits. Thus, applicant would be required to provide a non-cumulative description as well as an explanation, or a copy of a recently issued foreign search or examination report, for each document submitted after a first Office action on the merits. Where an IDS is filed after the mailing date of a notice of allowability or a notice of allowance under § 1.311, applicant would be required to provide an appropriate patentability justification, which includes the explanation and non-cumulative description required after a first Office action, and reasons why the claims are patentable over the cited document(s).

If an applicant presents unusually long documents, foreign-language documents, or a large number of documents, more than a brief review by the examiner is likely to be needed to reveal the most pertinent portions of the documents. In such situations, the applicant's help is needed so that the examiner may provide the best and most efficient examination possible. Therefore, the proposed amended rules require that in appropriate cases applicants must provide additional disclosure, such as an identification of a portion of a document that caused it to be cited, and an explanation of how the specific feature, showing, or teaching of the document correlates with language in one or more claims. In those rare instances, where the specific feature, showing, or teaching cannot be correlated to a claim limitation, correlation to a specific portion of the supporting specification would be required.

If an applicant presents cumulative information, review of such information would waste examiner resources. Accordingly, an IDS must not cite documents that are merely cumulative of other cited information or supply information merely cumulative of what is already present in the record. To aid in compliance with this prohibition, applicants are required to submit a non-cumulative description for IDSs submitted after a first Office action and after allowance. A non-cumulative description is one that describes a disclosure in the cited document that is not present in any other document of record.

Thus, while there may be substantial overlap between a currently cited document and a document previously of record, the currently cited document must include a teaching, showing, or feature not provided in other documents of record, and the non-cumulative description must point this out.

Examiner's consideration of information: Documents submitted in an IDS are reviewed in the same manner as items of information obtained by the examiner from other sources. That is, a document is given an initial brief review in order to determine whether it warrants a more in-depth study. Two indicators of the need for a more thorough review are: (1) That the document has been applied in a rejection, or specifically commented on by an examiner, in a case drawn to the same or similar subject matter; or (2) that the document has been particularly described by the applicant and its relevance to the claimed invention and/or supporting specification clarified. This practice reflects the practical reality of patent examination which affords the examiner a limited amount of time to conclude all aspects of the examination process.

Unsolicited information supplied to applicants by third parties: Some applicants receive large amounts of unsolicited information from third parties, sometimes accompanied by an allegation that the information is relevant to particular technologies or applications. Currently, many applicants simply submit such information to the Office via an IDS. The Office is proposing to avoid the burdens to both the Office and applicants occasioned by this practice by clarifying that applicant may opt to provide written consent to the filing of a protest by the third party based on such information, thus shifting the explanation burden back to the third party.

Conclusion: The Office believes that the proposed changes will enhance the examination process for both examiners and applicants. Ensuring a focused and thorough examination is a joint responsibility of the examiner and the applicant, particularly as examination is not seen by the Office as an adversarial process. The proposed changes provide an incentive to the applicant to cite only the most relevant documents, and are designed to provide the examiner with useful and relevant information early in the examination process. All parties involved with, or affected by, the patent system want the patent examination system to "get it right" the first time. Concentrating the patent examiner's review on the information most pertinent to patentability prior to a first Office action on the merits will significantly help in achieving this goal.

Discussion of the Specific Rules

Title 37 of the Code of Federal Regulations, Part 1, is proposed to be amended as follows:

Section 1.17: Section 1.17(h) is proposed to be amended to provide a petition fee for a petition to withdraw a reexamination proceeding from the publication process under § 1.98(a)(3)(iii)(B). This proposed amendment reflects that there is no withdrawal of a reexamination proceeding from issue available under § 1.313; thus, a petition to withdraw a reexamination proceeding from the publication process would be filed under § 1.98(a)(3)(iii)(B), not under § 1.313.

Section 1.17(p) is proposed to be revised to delete the IDS fee requirements in §§ 1.97(c) and (d), as a conforming change.

Section 1.48: Section 1.48 is proposed to be amended in the title, paragraph (h), and by the addition of paragraph (k), including (k)(1) through (k)(3), to address a change in the order of inventors' names, and a change in the spelling, or updating of an inventor's name in pending or abandoned applications.

Section 1.48(h) would be revised to clarify the exclusion of correction of inventorship via reexamination or reissue under § 1.48. This exclusion of reexamination is analogous to the exclusion of correction of inventorship in patents under § 1.48 clarified by § 1.48(i).

Section 1.48(k) would require that the requests pursuant to § 1.48(k) be accompanied by a processing fee of $130.00 pursuant to § 1.17(i) for non-provisional applications, or $50.00 pursuant to § 1.17(q) for a provisional application (where applicable). Additionally, each request pursuant to § 1.48(k) should also be accompanied by a supplemental application data sheet, pursuant to § 1.76, for changes in a nonprovisional application. The concomitant submission of a supplemental application data sheet pursuant to § 1.76 with a request pursuant to § 1.48(k) is strongly advised as the best means to ensure that the Office will recognize such requested change, particularly after the mailing of a notice of allowance, when such information is needed for printing inventorship information on the face of any patent to issue. The requests permitted under § 1.48(k) are limited to non-reissue applications and do not cover issued patents, which would require that a certificate of correction procedure be used. Thus, § 1.48(k) is not applicable to reissue applications or reexamination proceedings. A newly executed § 1.63 oath or declaration is not required. The submission of a newly executed § 1.63 declaration would not be effective; rather, applicant must proceed via § 1.48(k) to effectuate the changes permitted by this provision.

Section 1.48(k)(1) would provide that the order of the inventors' names may be changed to another specified order, except in provisional or reissue applications. Currently, such requests would generally be done by petition under § 1.182 with a petition fee of $400. MPEP § 605.04(f).

Section 1.48(k)(2) would provide a means to change the spelling of an inventor's name in either a provisional or nonprovisional application. Currently, such requests, other than typographical or transliteration errors, would be done in nonprovisional applications by petition under § 1.182 and a petition fee of $400.00. *See* MPEP § 605.04(b). Section 1.48(k)(2) would cover all requests for a spelling change, including typographical errors (made by applicant) and transliteration errors. This would eliminate the time consuming back and forth correspondence as to whether a change in spelling was in fact a typographical or transliteration error, or whether a petition has to be filed, particularly as many requests for change in spelling are attempted to be submitted under the umbrella of typographical or transliteration errors when clearly they are not.

Section 1.48(k)(3) would provide a means to update an inventor's name (*e.g.*, changed due to marriage) when it has changed after the filing of an application (excluding reissue applications). A request for updating an inventor's name must be accompanied by: (i) An affidavit signed with both names and setting forth the procedure whereby the change of names was effected; or (ii) a certified copy of a court order for name change. Such change in name is currently accomplished by the filing of a petition under § 1.182 and a petition fee of $400. MPEP § 605.04(c). Where an inventor's name was changed prior to the filing of an application, yet the old name was utilized in an executed § 1.63 declaration, a petition under § 1.48(a) would be required.

Section 1.55: Section 1.55(a)(2) is proposed to be amended to be consistent with the proposed changes to § 1.312, which provides an expanded opportunity for applicants to have entered certain technical amendments after the close of prosecution in an allowed application without withdrawal of the application from issue. Specifically, under the proposed changes to § 1.312(a)(2), a foreign priority claim made after the payment of the issue fee may be included in the patent if submitted in sufficient time to allow the patent to be printed with the priority claim and a petition to accept an unintentionally delayed priority claim pursuant to § 1.55(c) has been filed (if required) and granted. In addition, § 1.312(b) is proposed to be amended to provide that if the patent does not include the amendment filed after payment of the issue fee, the amendment would not be effective unless the patent is corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323. See the proposed changes to §§ 1.312(a)(2) and (b).

Accordingly, the last sentence of § 1.55(a)(2) is proposed to be amended to delete the phrase "but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323" and to insert a new last sentence, "If the patent did not publish with the priority claim, the amendment adding the priority claim will not be effective unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323." The change in language in § 1.55 is for conformance with the changes proposed to § 1.312. The current language being replaced in § 1.55 presumes that a priority claim filed after the date the issue fee is paid will not be entered and will not, therefore, be effective and the addition of a priority claim must therefore be treated as a certificate of correction after the patent has issued. The proposed amendment to § 1.312 would permit the entry of a priority claim after the issue fee has been paid, provided it is submitted in sufficient time to allow the priority claim to be printed on the face of the patent and a grantable petition under § 1.55(c) to accept an unintentionally delayed priority claim is filed, if required. Accordingly, the new language to § 1.55 addresses the situation where sufficient time was not present to allow printing of the priority claim on the face of the patent and the amendment adding the priority claim must be corrected by certificate of correction.

Section 1.56: Section 1.56 is proposed to be amended by the addition of paragraph (f) that would provide a "safe harbor" for a § 1.56(c) individual who, in good faith and to the best of the person's knowledge, information and belief, formed after a reasonable inquiry under the circumstances, took reasonable steps to comply with the additional disclosure requirements of § 1.98(a)(3). While the proposed amendment to § 1.56 may not act as a

complete defense in all situations, particularly as the court is not bound by any one duty of disclosure standard established by the Office, the Office is hopeful that a court in deciding a duty of disclosure issue will take the proposed safe harbor into account.

Section 1.97: Section 1.97(a) is proposed to be amended to reflect the applicability of § 1.97 to reexamination proceedings and to add other clarifying language.

Sections 1.97(b), (c), (d)(1), and (d)(2) would identify four time periods for submission of information disclosure statements (IDSs). Section 1.98(a)(3) would set forth "Additional disclosure requirements" specific to each time period that must be met for submission of IDSs during each of these time periods.

Section 1.97(b) would identify a "First time period" for submitting IDSs, with paragraphs (b)(1) through (b)(3) reciting the current periods for submitting an IDS within three months from the filing date of a national application or entry of the national stage, or before the mailing of a first Office action, or within three months of the filing of a reexamination. The expression "filing date" means the actual filing date of the application and does not include filing dates for which a benefit is claimed under 35 U.S.C. 119, 120, 121, or 365. Thus, an IDS may be submitted within three months of the actual filing date of a continuation, divisional, or continuation-in-part application pursuant to § 1.97(b)(1).

Section 1.97(b)(1) is also proposed to be amended to add "35 U.S.C. 111(a)," the statutory basis for the recited national application.

Section 1.97(b)(4) is proposed to be deleted. Any IDS filed with a request for continued examination under § 1.114 (RCE), or after an RCE is filed but before a first Office action is mailed in the RCE, would need to comply with the time requirements of §§ 1.97(c) or (d), whichever is applicable.

Section 1.97(c) would identify a "Second time period" for submitting IDSs and would apply to IDSs filed after the period specified in paragraph (b) of this section, and before the earlier of the mailing of a notice of allowability or a notice of allowance under § 1.311 for an application, or the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC) for a reexamination proceeding.

Currently, a second time period for submission of IDSs pursuant to § 1.97(c) permits submission of an IDS in an application simply by payment of a fee or by compliance with the statements provided by § 1.97(e), relating to discovery of the information within three months of its submission to the Office. The proposed "Second time period," § 1.97(c), would eliminate the fee payment option, while retaining a § 1.97(e)(1) option. Applicants/patent owners, in proposed § 1.98(a)(3)(ii), would be offered an additional option, other than compliance with § 1.97(e)(1), provided the applicant/patent owner is willing to comply with additional disclosure requirements referenced in §§ 1.98(a)(3)(iv) and (a)(3)(v).

The references, in current § 1.97(c), to a final action under § 1.113 or actions that otherwise close prosecution, are unnecessary and thus deleted. IDSs that are submitted after close of prosecution, such as after a final rejection, are inherently included in the expression "submitted prior to the mailing of a notice of allowance." The § 1.97 practice of treating an IDS submitted after a final Office action under § 1.113, such as a final rejection, would not change other than removal of the fee requirement and would still continue to be considered by the examiner in the next Office action, as appropriate. If there is no next Office action (*e.g.*, the application goes abandoned), the IDS will be placed in the file but not considered, as in current practice.

Section 1.97(c) would also be amended to provide for its applicability to reexamination proceedings in regard to the issuance of a Notice of Intent to Issue a Reexamination Certificate ("NIRC").

Section 1.97(d)(1) is proposed to be amended to be labeled a "Third time period," and would permit consideration of an IDS filed in an application after the period set forth in § 1.97(c) (after the earlier of a notice of allowability or notice of allowance), and before or with payment of the issue fee. Submission under the "Third time period" would be under more limited conditions than the conditions for submitting an IDS during the "Second time period"; however, the fee under § 1.17(p) would be eliminated. Because reexamination proceedings are not required to pay an issue fee, this "Third time period" is not applicable to reexamination proceedings. All IDSs filed in reexamination proceedings after the NIRC will be in the "Fourth time period" defined in proposed § 1.97(d)(2).

Proposed § 1.97(d)(2) would be labeled a "Fourth time period," and would permit consideration in an application of an IDS filed after payment of the issue fee and in sufficient time to be considered by the examiner before issue of the application, under more limited conditions than under the "Third time period" pursuant to § 1.97(d)(1). In a reexamination proceeding, this time period would begin when the NIRC is issued and end at issue of a Reexamination Certificate under § 1.570 or § 1.997.

Section 1.97(e) would be amended by changing "statement" to "certification" and "state" to "certify," to clarify this requirement in light of the requirements of proposed § 1.98(a)(3).

Section 1.97(f) would be amended to contain a reference to § 1.550 and § 1.956 (for reexamination proceedings).

Section 1.97(g) would be amended to replace "section" with "§ 1.98."

Section 1.97(h) is provided merely for context and no amendments are proposed therein.

Section 1.97(i) would be amended by reformatting the current material as paragraph (i)(1), and adding paragraph (i)(2). In addition, § 1.97(i)(1) would contain a reference to § 1.98(a)(3)(vii)(C), requiring meaningful compliance with the requirements for explanations, non-cumulative descriptions, and reasons supporting a patentability justification or the Office may decline to consider the information disclosure statement.

Section 1.97(i)(2) would permit applicant to obtain additional time to complete the required information to accompany the IDS where a portion of the information was inadvertently omitted. The grant of additional time would be solely at the discretion of the Office.

New § 1.97(j) would be added to make clear that IDSs filed during the "Fourth time period" (after the issue fee is paid or the NIRC) would not be effective to withdraw the application from issue, hence the requirement in § 1.98(a)(3)(iii)(B), or to withdraw a reexamination proceeding from the publication procedure for a reexamination certificate.

Sections 1.97(a), (b)(1), (c), and (d)(2) would be amended to explicitly set forth the required time frames for filing an IDS in a reexamination proceeding. Pursuant to current § 1.555(a), an IDS in a reexamination proceeding "must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding." Section 1.555(a) then sets forth a recommended time for filing an IDS, stating that the IDS "should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible." The need to obtain the best art in the proceeding as soon as possible is even greater in a reexamination proceeding than in an application, since by statute (35 U.S.C. 305, and 314(c)) reexamination

proceedings are to be "conducted with special dispatch within the Office." Accordingly, it is proposed to revise the regulatory statement of the time frames for IDS submissions in reexaminations by revising §§ 1.97(a), (b)(1), (c), and (d)(2), thus making the time frames for reexaminations track the time frames for IDS submissions in applications. It is also proposed that § 1.555(a) be amended to delete the optional time frame appearing therein, and to require the time frames set forth in § 1.97, as it is proposed to be revised.

Section 1.98: Section 1.98 is proposed to be substantially amended, including § 1.98(a)(3) defining "Additional disclosure requirements" composed of: (1) Paragraphs (a)(3)(i) through (a)(3)(iii), which define the type of additional disclosure requirements to be met based on the time period of submission of the IDS, including the particular documents requiring the additional disclosure; (2) paragraph (a)(3)(iv), which defines a two-part explanation requirement (identification of at least a portion of a cited document, and correlation of the portion(s) identified to specific claim language or to a specific portion of the specification when the document is cited for that purpose); (3) paragraph (a)(3)(v), which defines a non-cumulative description requirement; and (4) paragraph (a)(3)(vi), which defines two alternative types of patentability justification.

Section 1.98(a), (a)(1) and (2), and (a)(1)(i) are proposed to be amended for technical corrections or conforming amendments.

Section 1.98(a)(2)(iii) is proposed to be amended to no longer require submission of a legible copy of each cited pending or abandoned U.S. application's specification, including the claims, and drawing(s) when the cited pending or abandoned U.S. application is stored at the Office in the electronic form currently referred to as the image file wrapper (IFW). If the cited pending or abandoned U.S. application is not stored in the Office's IFW, a legible copy of the application or the portion of the application which caused it to be cited is still required. In addition, even if the cited pending or abandoned U.S. application is stored in the Office's IFW, consideration of any portion of the application file outside of the specification, including the claims, and drawings requires that a legible copy of that portion be included in the IDS. This proposed amendment implements a previous limited waiver of the requirement in § 1.98(a)(2)(iii), and also expands on the previous waiver by including abandoned applications in addition to pending applications. *See Waiver of the Copy Requirement in 37 CFR 1.98 for Cited Pending U.S. Patent Applications*, 1287 *Off. Gaz. Pat. Office* 162 (Oct. 19, 2004).

Sections 1.98(a)(3)(i) and (a)(3)(ii) are proposed to be significantly amended and incorporated into newly proposed § 1.98(a)(3).

Section 1.98(a)(3) is proposed to set forth "Additional disclosure requirements" specific to each time period identified in §§ 1.97(b), (c), (d)(1), and (d)(2) that must be met for submission of IDSs during each of these time periods.

Section 1.98(a)(3)(i) would provide that IDSs submitted within the "First time period" of § 1.97(b) (*e.g.*, prior to a first Office action) that contain: (1) Foreign language documents (§ 1.98(a)(3)(i)(A)); (2) any document over twenty-five pages excluding sequence listings or computer program listings (§ 1.98(a)(3)(i)(B)); or (3) more than twenty documents, calculated cumulatively (§ 1.98(a)(3)(i)(C)), would be required to provide additional disclosure in accordance with proposed § 1.98(a)(3)(iv) of an explanation (an identification of at least one portion causing the document to be cited, including a specific feature, showing, or teaching, and correlation to specific claim language, or where correlation to claim language is not possible, correlation may be made to a specific portion of the supporting specification), with exceptions set forth in §§ 1.98(a)(3)(viii)(A) and (a)(3)(viii)(C). In addition, where a foreign language document is being submitted, any existing translation would also be required, § 1.98(a)(3)(xi).

Foreign language documents of any length would trigger the explanation and translation requirements. English language documents (non-foreign language) include: English language nonpatent literature, U.S. patent documents (patents and patent application publications), and English language foreign patent documents. Use of foreign language terminology or expressions such as for Latin proper names for plants and animals would not make an otherwise English language document a non-English language document. Similarly, the presence of an English language abstract would not make a foreign language document an English language document for the purpose of § 1.98(a)(3)(i)(A).

The threshold for document size is over twenty-five pages. In calculating documents over twenty-five pages, sequence listings, or computer program listings, pursuant to § 1.52(e)(1) would be excluded (§ 1.98(a)(3)(i)(B)). In determining the number of pages of a document, all sheets of the document being submitted are counted, including drawing sheets and cover sheets (but not sequence listings or computer program listings). Applicant is permitted to submit only a portion of a document and is encouraged to do so where that portion can be considered without further context and is the only portion that is relevant to the claimed invention. When applicant elects to submit selected pages of a document, those pages will be counted to determine the length of the cited (partial) document and whether an explanation is required for that document.

The threshold number of documents for one or more IDSs filed before a first Office action is twenty calculated cumulatively in a single application or proceeding. The threshold number of documents can be reached either in multiple (sequential) IDSs each containing fewer than the twenty trigger value, or all at once in a single IDS. Documents that do not comply with the timeliness requirements of § 1.97, or the technical requirements of § 1.98, (and thus may not be considered) would not count toward the cumulative total pursuant to § 1.98(a)(3)(i)(C). Additionally, a document that is not compliant with the requirements of § 1.98 would not be double counted toward the threshold number if it was resubmitted to cure the non-compliance. Accordingly, for example, an applicant who realizes that a twenty-three-document IDS submission made prior to the mailing of a first Office action on the merits did not contain the required additional disclosure may either submit the additional disclosure for the twenty-three documents, or withdraw three of the documents, provided such action is taken within the time frame of § 1.97(b)(3).

Documents that are not included in an IDS but are mentioned in the specification as background information would not count toward the threshold number. The examiner is under no obligation to review documents cited in the specification. *See* MPEP § 609 III C (1), Noncomplying Information Disclosure Statements. Where applicant desires review of a particular document, that document must be cited in a compliant IDS.

For continuing applications, documents of a compliant IDS in the prior application, which were required to be reviewed by the examiner therein (*see* MPEP § 609 I, IDS IN CONTINUED EXAMINATIONS OR CONTINUING APPLICATIONS), would not be considered as part of the cumulative total in a continuing application unless they are resubmitted in the continuing

application (so that they will appear on the face of the patent that issues from the continuing application). In addition, all other documents (*e.g.*, previous documents that were noncompliant with §§ 1.97 and 1.98 and never considered by the examiner in the prior application) in prior applications would not be counted toward the threshold number in a continuing application, unless they are resubmitted in the continuing application.

Section 1.98(a)(3)(i) would provide for exceptions to the additional disclosure requirements by reference to §§ 1.98(a)(3)(viii)(A) and (a)(3)(viii)(C). For IDSs submitted in the first time period, applicant may submit documents resulting from a foreign search or examination report where a copy of the report is submitted (§ 1.98(a)(3)(viii)(A)), and documents submitted in reply to a requirement for information pursuant to § 1.105 (§ 1.98(a)(3)(viii)(C)), without triggering any additional disclosure requirements.

Section 1.98(a)(3)(ii) would provide that all information in IDSs submitted within the "Second time period" of § 1.97(c) (*e.g.*, after a first Office action and prior to the earlier of a notice of allowability or a notice of allowance), must be accompanied by additional disclosure in accordance with § 1.98(a)(3)(iv) (explanation) and § 1.98(a)(3)(v) (non-cumulative description), with exceptions set forth in §§ 1.98(a)(3)(viii)(B) and (a)(3)(viii)(C). Additionally, when a foreign language document is being submitted, any existing translation would also be required, § 1.98(a)(3)(xi).

Section 1.98(a)(3)(ii) would provide for exceptions to the additional disclosure requirements by reference to §§ 1.98(a)(3)(viii)(B) and (C). For IDSs submitted in the second time period, applicant may, without triggering any additional disclosure requirements, submit documents accompanied by a certification pursuant to § 1.97(e)(1) and a copy of the foreign search or examination report (§ 1.98(a)(3)(viii)(B)), and documents submitted in reply to a requirement for information pursuant to § 1.105 (§ 1.98(a)(3)(viii)(C)).

Section 1.98(a)(3)(iii) would provide that all documents submitted within the "Third time period" (*e.g.*, after the earlier of a notice of allowability or a notice of allowance and prior to payment of the issue fee), and the "Fourth time period" (*e.g.*, after payment of the issue fee and in sufficient time to be considered) must be accompanied by a certification under either §§ 1.97(e)(1) or (2).

Section 1.98(a)(3)(iii)(A) would provide that information submitted within the "Third time period" of § 1.97(d)(1) must be accompanied by either of two patentability justifications pursuant to § 1.98(a)(3)(vi)(A) (explanation, non-cumulative description and reasons supporting the patentability of the independent claims) or (B) (explanation, noncumulative description, an amendment, and reasons supporting the patentability of the amended claims).

Section 1.98(a)(3)(iii)(B) would provide that information submitted within the "Fourth time period" of § 1.97(d)(2) must be accompanied by a petition to withdraw from issue pursuant to § 1.313(c)(1), or to withdraw a reexamination proceeding from the publication process, and the patentability justification under § 1.98(a)(3)(vi)(B).

Section 1.98(a)(3)(iv) would provide a definition of the explanation that must be submitted to meet the additional disclosure requirements of § 1.98(a)(3). The explanation requirement consists of three parts, two in regard to an identification (§ 1.98(a)(3)(iv)(A)) and one in regard to a correlation, § 1.98(a)(3)(iv)(B).

Section 1.98(a)(3)(iv)(A) would provide for the identification portion of the explanation requirement. Section 1.98(a)(3)(iv)(A) would require an identification of specific feature(s), showing(s), or teaching(s) that caused a document to be cited. Where applicant is unaware of any specific relevant portion(s) of a document, that document should not be submitted to the Office. The bare recitation that a document was provided to applicant by a third party or was discovered during a pre-examination search is an insufficient identification.

Section 1.98(a)(3)(iv)(A) would provide for the identification of a portion(s) of a document where the specific feature(s), showing(s), or teaching(s) may be found. For example, a proper identification would indicate, by page and line number(s), or figure and element number(s), where to look in the document for the portion.

The identification requirements require applicant to identify at least one appearance in the document (a representative portion) of a specific feature, showing, or teaching for which the document is being cited. Where applicant is aware that such feature, showing, or teaching appears in more than one portion of the document, applicant would not need to specifically point out more than one occurrence, although applicant may wish to, particularly where the additional appearance may not be apparent to the examiner and may have some additional significance over its first identified appearance. Where applicant recognizes that a document is relevant for more than one feature, showing, or teaching, and is being cited for more than one feature, showing, or teaching, applicant would need to specifically identify each additional feature, showing, or teaching (and the portion where the feature, showing, or teaching appears in the document).

A mere statement indicating that the entire document, or substantially the entire document, is relevant, would not comply, and may result in the examiner electing not to consider the document. Where applicant believes that an entire document or most portions thereof are relevant and caused the document to be cited, applicant may make such statement so long as applicant establishes such fact by sufficient recitation of examples from the document. Sufficiency of recitation of examples will vary on a case-by-case basis. Applicant should, therefore, be wary of not identifying at least one specific portion of a document since noncompliance may, if not corrected in a timely and proper manner, result in the document not being considered.

Documents merely representing background information may be identified and discussed in the specification. There is generally little utility in submitting a background document as part of an IDS, particularly after a first Office action. In the isolated situation where applicant wishes to identify a purely background document after a first Office action on the merits, the document can be discussed as part of the Remarks/Arguments section of a reply to the Office action. Clearly, background documents can be supplied prior to a first Office action on the merits in an IDS without discussion where twenty or fewer documents are being submitted, provided that the background document is less than twenty-five pages, and the document is not in a foreign language.

Section 1.98(a)(3)(iv)(B) would additionally require a correlation of the specific feature(s), showing(s), or teaching(s) identified pursuant to § 1.98(a)(3)(iv)(A) to specific corresponding claim language, or to a specific portion(s) of the specification that provides support for the claimed invention, where the document is cited for that purpose. Optionally, applicant may indicate any differences between the specific claim language and what is shown, or taught, in the document. The specific claim language may be in either an independent claim or a dependent claim.

The alternative of correlation to a specific portion of the specification, rather than to a specific claim, is available in the limited circumstances where correlation cannot be made to specific claim language, as the document is not cited for that purpose. The alternative correlation is intended to include aspects of the supporting specification that define claim scope or support compliance with requirements of the patent statutes. For example, where a document is submitted to identify a particular scope of a claim, such as where there is a means-plus-function claim limitation pursuant to 35 U.S.C. 112, ¶ 6, the correlation explanation would be satisfied when drawn to this aspect. Additionally, where a document is being submitted that relates to utility of the claimed invention, compliance with the written description requirement, or enablement, the correlation explanation would be satisfied when drawn to these aspects rather than being drawn directly to specific claim language.

A particular correlation between a specific feature, showing, or teaching of a document and an element of a claim may not be representative of variations of the same specific feature, showing, or teaching as recited in another claim. For example, a specific feature, showing, or teaching may be recited by certain language in one claim, while that specific feature, showing, or teaching may be recited by entirely different claim language in another claim. In such circumstances, in order to comply with the correlation requirement, applicant would need to identify one instance of each different recitation of the specific feature, showing, or teaching in the different claims.

The correlation explanation, whether to specific claim language or the supporting specification, must make clear why a specific feature, showing, or teaching in a document that is being correlated to the claimed invention, actually correlates thereto.

The Office does not contemplate that complying with the identification and correlation of additional requirements will require an extensive submission. The Office believes that, in most cases, a compliant submission would include several sentences that: identify a specific feature, showing, or teaching causing submission of a document (*e.g.*, rotary pump, element 32), identify the portion of the document where the feature, showing, or teaching may be found (*e.g.*, Figure 3 in Patent A), and correlate the specific feature, showing, or teaching to specific claim language (*e.g.*, the rotary pump in Figure 3, element 32 of Patent A correlates to the rotary pump in claim 1 of the application).

Applicant's attempted correlation of a specific feature, showing, or teaching in a document may not, for example, be readily recognizable as actually correlating to identified claim language, particularly where such claim language may be a more generic or alternative way of reciting the feature, showing, or teaching. In such instances, applicant would need to add some explanatory material, particularly to avoid a possible finding of noncompliance by the examiner with the correlation requirement.

Section 1.98(a)(3)(v) would define a non-cumulative description requirement that must accompany an IDS submission when the IDS is submitted in the second, third, or fourth time periods, as citation of merely cumulative information must be avoided, § 1.98(c). The non-cumulative description would require a description of how each document being submitted is not merely cumulative of any other IDS-cited document previously submitted, any document previously cited by the examiner, or any document cited under §§ 1.99 and 1.291. The description may be of a specific feature, showing, or teaching in a document that is not found in any other document of record. The non-cumulative description requirement for the second time period (§ 1.97(c)) is subject to the exceptions set forth in §§ 1.98(a)(3)(viii)(B) and (a)(3)(viii)(C), while the non-cumulative description requirement for the third time period (§ 1.97(d)(1)) is subject to the exception set forth in § 1.98(a)(3)(viii)(B).

Section 1.98(a)(3)(vi) would define alternative patentability justifications (§§ 1.98(a)(3)(vi)(A) and (a)(3)(vi)(B)), which would be applicable for IDSs submitted during the third time period (*e.g.*, after allowance), with the § 1.98(a)(3)(vi)(B) justification required during the fourth time period (*e.g.*, after payment of the issue fee). Section 1.98(a)(3)(vi)(A) would require an explanation pursuant to § 1.98(a)(3)(iv), a non-cumulative description pursuant to § 1.98(a)(3)(v), and reasons why (each of) the independent claims are patentable over the information in the IDS being submitted considered together, and in view of any information already of record, but particularly in view of information previously used to reject the independent claim(s).

The expression "information previously used to reject" includes applied prior art used in a rejection which was subsequently withdrawn and is no longer utilized in a pending rejection.

A foreign search or examination report may be acceptable as the required explanation of patentability or the statement of unpatentability under either of the above requirements, respectively, if the report provides sufficient details to comply with § 1.98(a)(3)(vi).

Section 1.98(a)(3)(vi)(B) is the only procedure for IDSs submitted in the fourth time period (after payment of the issue fee or NIRC). In this time period, information may be submitted only if a claim is unpatentable over the information being submitted either considered alone or in combination with information already of record. This patentability justification would require an explanation pursuant to § 1.98(a)(3)(iv) of this section, a non-cumulative description pursuant to § 1.98(a)(3)(v) of this section, and reasons why an amendment causes claims, admitted to be unpatentable over the information submitted in an IDS, to now be patentable over such information when considered together, and in view of any information already of record, but particularly in view of information previously used to reject such claims.

While the alternative patentability justifications require consideration of certain documents, the "reasons why" supplied need only address the most relevant documents and need not discuss all the documents required to be considered.

Section 1.98(a)(3)(vii) would recognize that applicant must meaningfully comply with the additional disclosure requirements.

Section 1.98(a)(3)(vii)(A) would require that the explanations pursuant to § 1.98(a)(3)(iv) must include a level of specificity commensurate with specifics of the feature(s), showing(s), or teaching(s) which caused the document to be cited. These explanations must not be *pro forma* explanations. Additionally, it would be required that the non-cumulative descriptions pursuant to § 1.98(a)(3)(v) must be significantly different so as to point out why the cited document is not merely cumulative of any other information currently being filed, or previously of record.

Section 1.98(a)(3)(vii)(B) would require that the reasons for patentability justification, pursuant to § 1.98(a)(3)(vi), must address specific claim language relative to the specific feature(s), showing(s), or teaching(s) of the cited documents, or those already of record. Section 1.98(a)(3)(vii)(C) would provide that where the explanations or non-cumulative descriptions do not comply with § 1.98(a)(3)(vii)(A), or the reasons

for patentability justification do not comply with § 1.98(a)(3)(vii)(B), the Office may decline to consider the information disclosure statement. See also § 1.97(i)(1). The examiner may optionally, however, choose to cite a reference contained in a non-compliant IDS.

Section 1.98(a)(3)(viii) would provide for three possible exceptions to the additional description requirements of § 1.98(a)(3).

Section 1.98(a)(3)(viii)(A) would provide an exception pursuant to § 1.98(a)(3)(iv) for documents submitted within the first time period (*i.e.*, prior to first Office action) that result from a foreign search or examination report where a copy of the report is submitted with the IDS. A specific certification pursuant to § 1.97(e) is not required nor must the three-month time frame be met.

Section 1.98(a)(3)(viii)(B) would provide an exception to the explanation and non-cumulative description requirements when an IDS is submitted in the second time period (§ 1.97(c)) and is accompanied by a certification pursuant to § 1.97(e)(1) and a copy of the foreign search or examination report.

Section 1.98(a)(3)(viii)(C) would provide an exception to the explanation and non-cumulative description requirements when an IDS is submitted in the first (§ 1.97(b)) and second (§ 1.97(c)) time periods for documents submitted in reply to a requirement for information pursuant to § 1.105.

Section 1.98(a)(3)(ix) would provide a requirement for updating previous IDSs for amendments affecting the scope of the claims, other than examiner's amendments, submitted after an IDS. Section 1.98(a)(3)(ix)(A) would provide that any previously provided explanation pursuant to § 1.98(a)(3)(iv) must be reviewed and updated where necessary in view of subsequently filed amendments. If, however, no update is warranted because all previous explanations are still relevant and accurate, § 1.98(a)(3)(ix)(B) would provide that a statement must be supplied to the effect that updating of the previous IDS is unnecessary. Failure to comply with the update requirements, including the need for a statement that an update is needed, may result in a reply containing the amendment being treated as not fully responsive, pursuant to MPEP § 714.03, with a correction required.

Section 1.98(b)(3) would be amended to replace "inventor" with "applicant" as a technical amendment to conform to the language of § 1.98(b)(2).

Section 1.98(c) would be amended to require that the submission of merely cumulative documents be avoided, and that the Office may decline to consider an information disclosure statement citing documents that are merely cumulative. The submission of cumulative information may obscure other more relevant information from the examiner. MPEP § 2004, item 13. Where review of an IDS reveals the presence of a pattern of merely cumulative documents to such extent that the utility of further review of the IDS is called into question, the IDS may be presumed to be non-compliant, and the Office may terminate further review of the IDS. In such instance, on the listing of the documents, the examiner will initial all citations that have been considered up to that point, including the cumulative documents, and line through all other documents not yet considered. In the next Office action, the examiner will identify to applicant the merely cumulative documents, and the non-compliant status of the IDS. Applicant could choose to resubmit the IDS in reply to the Office action provided applicant complies with any additional disclosure requirements, including the non-cumulative description, which will aid applicant in avoiding the submission of merely cumulative information.

Documents could be merely cumulative, notwithstanding the presence of different explanations (*e.g.*, two documents both containing only the same features A and B of the claimed invention, the explanation for the first document is to feature A, and the explanation for the second document is to feature B).

Section 1.98(d) would be amended: By replacing the reference to paragraph (a) with a reference to paragraph (a)(2), clarifying the recitations to earlier and later submitted information disclosure statements in paragraphs (d) and (d)(1), correcting the tense of "complies" to "complied" in paragraph (d)(2), and making a conforming change by removing the reference to paragraph (c) of § 1.98, and limiting the effect of paragraph (d)(2) to paragraphs (a)(1), (2), and (b) of § 1.98.

Section 1.99: Section 1.99 is proposed to be amended to change the time period for a submission under § 1.99 to within six months from the date of publication of the application (§ 1.215(a)), or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier. Section 1.99 currently requires that any submission § 1.99 be filed within two months from the date of publication of the application (§ 1.215(a)), or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier. Section § 1.99 is also proposed to be amended to eliminate the provision for filing a belated submission under § 1.99. The time period for a submission under § 1.99 (or the time period for a protest under § 1.291) is to limit any right of third parties to have information entered and considered in a pending application for administrative convenience. This time period for a submission under § 1.99 (or the time period for a protest under § 1.291) does not vest the applicant with any right to prevent the Office from *sua sponte* making such information of record in the application or relying upon such information in subsequent proceedings in the application (*i.e.*, the time period does not limit the authority of the Office to re-open the prosecution of an application to consider any information deemed relevant to the patentability of any claim).

It is to be noted that a § 1.99(a) submission by a third party is not a means for applicant to circumvent the requirements of § 1.97 and § 1.98. Rather, the treatment of the information in a § 1.99(a) submission is dependent upon the linchpin concept that it is being submitted by a (true) third party, and that there has been no solicitation of the third party by the applicant, or anyone acting on applicant's behalf. Section 1.99(a), and § 1.99 in general, are directed to a third party that is not in privity with the applicant, and is not any § 1.56(c) individual. Section 1.99(e) is proposed to be amended to state only that a submission by a member of the public to a pending published application that does not comply with the requirements of § 1.99 will not be entered.

Section 1.291: Sections 1.291(b), (b)(1) and (b)(2) would have their provisions rearranged and revised, and §§ 1.291(b)(3) through (b)(5) would be added. Section 1.291(c)(2) would be revised to set forth the degree of consideration given to items of information submitted in a compliant protest.

Section 1.291(b) as proposed would contain the descriptive label "Treatment of a protest."

Sections 1.291(b)(1)(i) through (b)(1)(iii) would set forth the conditions to be met for entry of protests into the record that are currently set forth in § 1.291(b). Section 1.291(b)(1)(iii) would contain the consent provision for entry of a protest which is currently set forth in § 1.291(b)(1), and § 1.291(b)(2) would provide consent specifics.

Pursuant to § 1.291(b)(1)(ii), the protest must be served on the applicant in accordance with § 1.248, or filed with

the Office in duplicate if service is not possible. In the usual case where the protest has been served on the applicant in accordance with § 1.248, the applicant will have one month from the date of service to file any objection that the protest has not in fact been consented to, or that the protest is not within the scope/terms of the consent. It should be rare that service of a protest is not possible since the applicant has consented to the filing of a protest and should therefore be available to be served. Where such a situation arises, however, the protest is submitted to the Office in duplicate with a statement that service is not possible. The Office will serve a copy of the protest on the applicant and the applicant will have one month from the date of Office service to file any objection that the protest has not in fact been consented to, or that the protest is not within the scope/terms of the consent.

Section 1.291(b)(2) would contain the introductory label "Applicant consent and protestor statement." Section 1.291(b)(2) (together with § 1.291(b)(1)(iii)) would retain the current provision permitting consideration of a protest that is filed on or after the date an application is published if, and only if, the protest is filed based on the written consent of the applicant, and in time to match the protest with the application to permit review of the protest during examination of the application. The written consent of the applicant may be filed together with the protest, or it may already be of record in the application.

Section 1.291(b)(2)(ii) would provide that a consent to a protest may be limited by express terms only to: (1) The length of time for which the consent is in effect, at least thirty days (to give sufficient time for its submission), and (2) a specific party who can file the protest (if the identity of such a party is known to the applicant). The consent, however, must not be otherwise limited.

Section 1.291(b)(2)(iii) would provide that a protest filed based upon a consent under paragraph (b)(2) of this section must contain a statement that the submitted protest is based on the written consent of the applicant and falls within the terms of the consent. The statement would identify the consent, for example, as "the written consent accompanying the instant protest" or "the written consent filed in the record of the application on [Provide date consent filed]." The statement would inform the Office that the protester is a party permitted by the consent to file the protest, and that the protest is timely filed. A certificate of mailing or transmission under § 1.8 may be used to comply with any timeliness requirement imposed by applicant in the consent. Likewise, the protest may be filed in the Office by "Express Mail" pursuant to § 1.10.

Section 1.291(b)(3) would highlight the options that an applicant currently has in treating unsolicited information received from a party other than a § 1.56(c) individual, *i.e.*, a third party. This would not be a change in practice.

Section 1.291(b)(3)(i) recognizes that upon receiving unsolicited information (directed to an application) from a third party, applicant may submit the unsolicited information as an IDS, provided that applicant complies with the IDS requirements of §§ 1.97 and 1.98.

Section 1.291(b)(3)(ii) recognizes that applicant can provide a written consent pursuant to § 1.291(b)(2) to the third party (if known) for that third party to file unsolicited information with the Office as (part of) a protest. The section also provides for the alternative that if the third party is unknown, the written consent to the submission of a protest may be filed in the application. Given this alternative, an applicant need not feel compelled to submit such unsolicited information to the Office via an IDS.

Section 1.291(b)(3)(iii) recognizes that an applicant could submit the unsolicited information to the Office as a protest on behalf of the third party, even where the third party is yet unknown. In keeping with § 1.291(b)(2), applicant would not need to submit an explicit written consent to the protest along with the information, since applicant has made the submission. Applicant would, however, need to comply with § 1.291(c), including the requirement for a concise explanation, drafting the explanation itself if need be. Where the third party has provided an explanation that amounts to the concise explanation required by § 1.291(c)(2), applicant may rely on such explanation. Applicant would, however, need to review the explanation provided by the third party to determine whether it complies with the concise explanation standard and whether the concise explanation is accurate.

It is to be noted that a § 1.291(b)(3)(iii) protest submission on behalf of the third party is not a means for applicant to circumvent the requirements of § 1.97 and § 1.98. Rather, the treatment of unsolicited information in § 1.291(b)(3), and § 1.291 protests in general, is dependent upon the linchpin concepts of a (true) third party, and (actually) unsolicited information. Section 1.291(b)(3)(iii), and § 1.291 in general, are directed to a third party that is not in privity with the applicant, and is not any § 1.56(c) individual.

Applicant's knowledge of prior art gained during litigation or through license negotiations, for example, may qualify under § 1.291(b)(3)(iii) as receiving unsolicited information for the filing of a protest on behalf of a third party.

While §§ 1.291(b)(3)(i) through (b)(3)(iii) recognize several options that an applicant has in treating unsolicited information supplied by a third party, applicant may have other options depending on the facts of each situation. One option may be not to submit any of the information, such as where the information has been reviewed and there is no information that is material.

Third parties should recognize that, rather than send unsolicited information to an applicant, third parties may have the opportunity to submit such information directly to the Office pursuant to § 1.99.

Section 1.291(b)(4) would provide a recognition that nothing in § 1.291 is intended to relieve a person subject to § 1.56(c) from submitting to the Office information that is subject to the duty of disclosure under § 1.56. Newly proposed § 1.291(b)(3) attempts to help an applicant deal with unsolicited information supplied by a third party, particularly in view of the proposed amendment of § 1.98 requiring different explanation requirements.

Section 1.291(b)(5) would be created to contain the current provision of § 1.291(b)(2). Other than for the first protest filed in an application, a statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest; or the protest must comply with paragraph (c)(5) of this section.

Section 1.291(c)(2) would be revised to set forth the degree of consideration given to items of information submitted in a compliant protest. As to the "concise explanation of the relevance of each item listed pursuant to paragraph (c)(1)" provided by the protester, items in a compliant protest will be considered by the examiner at least to the extent of the provided explanations. See also the above discussion of the degree of consideration for §§ 1.97 and 1.98 submissions.

Section 1.312: Section 1.312 is proposed to be amended to create paragraphs (a) and (b) and to permit certain amendments filed after allowance to be entered without withdrawal of the application from issue.

Section 1.312(a)(1)(i) through (a)(1)(vi) would provide that the

following amendments if filed before or with the payment of the issue fee may be entered: (1) Amendment of the bibliographic data to be indicated on the front page of the patent; (2) amendment of the specification to add a reference to a joint research agreement (§ 1.71(g)); (3) addition of a benefit claim of a prior-filed provisional application under 35 U.S.C. 119(e), a prior-filed nonprovisional application under 35 U.S.C. 120, or a prior-filed international application that designated the United States under 35 U.S.C. 365(c) (§ 1.78); (4) addition of a priority claim of a prior foreign application under 35 U.S.C. 119(a)–(d) or (f) or 365(a) or (b) (§ 1.55); (5) changing the order or spelling of the inventors' names; or (6) changing the inventorship pursuant to § 1.48.

Any request to add a benefit claim under § 1.78, or foreign priority claim under § 1.55 pursuant to § 1.312 must comply with the requirements for timeliness, or be accompanied by a grantable petition to accept an unintentionally delayed claim for priority under § 1.78(a)(3), § 1.78(a)(6), or § 1.55(c) if needed (e.g., such a petition would not be necessary for an application filed before November 29, 2000).

Any request to change inventorship pursuant to § 1.48 must comply with all the provisions of that rule. Consequently, a § 1.48 request accompanied by a petition under § 1.183 requesting waiver of any of the requirements under § 1.48 would not qualify for entry under § 1.312.

Section 1.312(a)(2) would provide that when such amendments are filed after the date the issue fee is paid, the amendments may also be entered if submitted in sufficient time to permit the patent to be printed with the amended information (§ 1.312(a)(2)(i)), and with a processing fee pursuant to § 1.17(i) (§ 1.312(a)(2)(ii)).

Section 1.312(b) would provide that if the patent does not include the amendment filed after payment of the issue fee, the amendment would not be effective unless the patent is corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323 or otherwise corrected in another post-issuance proceeding. The expression "as appropriate" has been used to recognize that the failure to include a benefit claim to a provisional application cannot be fixed by a certificate of correction after issue of the patent.

Section 1.555: Section 1.555(a) is proposed to be amended to delete the optional time frames for IDS submissions in reexamination proceedings appearing therein, and instead require the § 1.97 time frames. Currently, § 1.555(a) sets forth an optional time for filing an IDS, stating that it "should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible." Obtaining the best art in the case as soon as possible is even more important for a reexamination proceeding than for an application, because the statute mandates (35 U.S.C. 305, 35 U.S.C. 314(c)) that reexamination proceedings be "conducted with special dispatch within the Office." Thus, § 1.555(a) would be amended to track application time frames by incorporating the § 1.97 time frames (and revising § 1.97 to refer to reexamination proceedings, as above discussed). Currently, § 1.555(a) requires filing of an IDS with the items listed in § 1.98(a). Section 1.555(a) would likewise be amended to track applications and require compliance with all the requirements of § 1.98, rather than only § 1.98(a). Accordingly, it is proposed that the last sentence of § 1.555(a) be amended to read: "Any IDS must be filed with the items listed in, and pursuant to the requirements of, § 1.98 as applied to individuals associated with the patent owner in a reexamination proceeding, and must be filed within the time frames set forth in § 1.97."

Section 1.948: Section 1.948 is proposed to be amended to set forth that the provisions of § 1.98 would apply to a third party requester of an *inter partes* reexamination in a manner analogous to the manner that § 1.98 would apply to the patent owner. It is reasonable that the requirements of § 1.98 be applied to the third party requester in a reexamination proceeding, since the considerations and burdens on the Office that exist with respect to an IDS submitted by a third party requester are the same as those for a patent owner. Additionally, the third party requester is in the best position to provide the explanations required in § 1.98 for the information that it cites.

It is to be noted that there is no need to apply § 1.98 to a reexamination requester as to the request for *ex parte* reexamination pursuant to § 1.510 or the request for *inter partes* reexamination pursuant to § 1.915, since the requirements for explaining the art/information cited vis-à-vis the claims in the request are already at least as comprehensive as the explanation requirements of § 1.98. Also, the requirements for explaining the art/information cited in a reexamination request applies to all of the art/information cited, as opposed to the requirements in § 1.98 that only apply to certain documents, or to all the art after a threshold number of documents has been cited.

Rulemaking Considerations

Administrative Procedure Act

The changes in this notice relate solely to the procedures to be followed in submitting information for consideration by the Office during the examination of an application for patent or reexamination of a patent. Non-compliance with these rules results only in the Office possibly not considering information in an information disclosure statement. If an applicant (or patentee in a patent under reexamination) submits an information disclosure statement that does not comply with these rules, the Office will either notify the applicant and provide a time limit within which the information disclosure statement may be corrected (37 CFR 1.98(f)), or advise the applicant that the information disclosure statement has been placed in the application or reexamination file with the non-complying information not being considered (MPEP 609.05(a)). The failure to correct an information disclosure statement within such a time limit does not result in abandonment of the application, but only in the Office advising the applicant that the information disclosure statement has been placed in the application or reexamination file with the non-complying information not being considered (MPEP 609.05(a)). Therefore, these proposed rule changes involve rules of agency practice and procedure under 5 U.S.C. 553(b)(A). *See Bachow Communications Inc.* v. *FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are "rules of agency organization, procedure, or practice" and are exempt from the Administrative Procedure Act's notice and comment requirement) and *JEM Broadcasting Co.* v. *FCC*, 22 F.3d 320, 327 (D.C. Cir. 1994) (rule under which any flawed application is summarily dismissed without allowing the applicant to correct its error is merely procedural despite its sometimes harsh effects on applicants); *see also Merck & Co., Inc.* v. *Kessler*, 80 F.3d 1543, 1549–50, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) (the rules of practice promulgated under the authority of former 35 U.S.C. 6(a) (now in 35 U.S.C. 2(b)(2)) are not substantive rules (to which the notice and comment requirements of the Administrative Procedure Act apply)), and *Fressola* v. *Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995) ("it is extremely doubtful whether any of the rules formulated to govern patent or trade-mark practice are

other than "interpretive rules, general statements of policy, * * * procedure, or practice.' ") (quoting C.W. Ooms, *The United States Patent Office and the Administrative Procedure Act*, 38 Trademark Rep. 149, 153 (1948)). Accordingly, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). Nevertheless, the Office is providing this opportunity for public comment on the changes proposed in this notice because the Office desires the benefit of public comment on these proposed changes.

Regulatory Flexibility Act

As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), neither an initial regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) are required. *See* 5 U.S.C. 603.

Executive Order 13132

This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

Executive Order 12866

This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

Paperwork Reduction Act

This notice involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information involved in this notice have been reviewed and previously approved by OMB under OMB control numbers 0651–0031. This notice proposes changes to the rules of practice to change the provisions for information disclosure statements to require additional disclosure when citations exceed a set number, a citation exceeds a set number of pages, a citation is in a foreign language, or a citation is not timely submitted prior to the Office examining the application, and eliminate the fee requirements for submitting an IDS, as well as eliminating the applicant's ability to file an IDS prior to the close of prosecution just by paying a fee. The proposed changes will enable the examiner to focus on the relevant portions of submitted information at the very beginning of the examination process, give higher quality first actions, and minimize wasted steps. The United States Patent and Trademark Office is resubmitting an information collection package to OMB for its review and approval because the changes in this notice affect the information collection requirements associated with the information collection under OMB control number 0651–0031.

The title, description and respondent description of these information collections are shown below with an estimate of the annual reporting burdens. Included in the estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collections of information.

OMB Number: 0651–0031.

Title: Patent Processing (Updating).

Form Numbers: PTO/SB/08, PTO/SB/17i, PTO/SB/17P, PTO/SB/21–27, PTO/SB/24A, PTO/SB/24B, PTO/SB/30–32, PTO/SB/35–39, PTO/SB/42–43, PTO/SB/61–64, PTO/SB/64a, PTO/SB/67–68, PTO/SB/91–92, PTO/SB/96–97, PTO–2053–A/B, PTO–2054–A/B, PTO–2055–A/B, PTOL 413A.

Type of Review: Approved through July of 2006.

Affected Public: Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions, Farms, Federal Government and State, Local and Tribal Governments.

Estimated Number of Respondents: 2,317,539.

Estimated Time Per Response: 1.8 minutes to 12 hours.

Estimated Total Annual Burden Hours: 2,807,641 hours.

Needs and Uses: During the processing of an application for a patent, the applicant/agent may be required or desire to submit additional information to the United States Patent and Trademark Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosures and documents, requests for extensions of time, the establishment of small entity status, abandonment and revival of abandoned applications, disclaimers, appeals, expedited examination of design applications, transmittal forms, requests to inspect, copy and access patent applications, publication requests, and certificates of mailing, transmittals, and submission of priority documents and amendments.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to: (1) The Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10202, 725 17th Street, NW., Washington, DC 20503, Attention: Desk Officer for the Patent and Trademark Office; and (2) Robert J. Spar, Director, Office of Patent Legal Administration, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450.

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

For the reasons set forth in the preamble, 37 CFR Part 1 is proposed to be amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

2. Section 1.17 is amended by revising paragraphs (h) and (p) to read as follows:

§ 1.17 Patent application and reexamination processing fees.

* * * * *

(h) For filing a petition under one of the following sections which refers to this paragraph: $130.00

§ 1.19(g)—to request documents in a form other than provided in this part.

§ 1.84—for accepting color drawings or photographs.

§ 1.91—for entry of a model or exhibit.

§ 1.98(a)(3)(iii)(B)—for filing a petition to withdraw a reexamination proceeding from the publication process.

§ 1.102(d)—to make an application special.

§ 1.138(c)—to expressly abandon an application to avoid publication.

§ 1.313—to withdraw an application from issue.

§ 1.314—to defer issuance of a patent.

* * * * *

(p) For a submission under § 1.99(b): $180.00

* * * * *

3. Section 1.48 is amended by revising its heading and paragraph (h), and by adding a new paragraph (k) to read as follows:

§ 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35 U.S.C. 116, a change in the order of the inventors' names, or a change in the spelling, or an updating of an inventor's name.

* * * * *

(h) *Reissue applications and reexamination proceedings not covered.* The provisions of this section do not apply to reissue applications or to reexamination proceedings. See §§ 1.171 and 1.175 for correction of inventorship in a patent via a reissue application. See § 1.530(l) for correction of inventorship in a patent via an *ex parte* or *inter partes* reexamination proceeding.

* * * * *

(k) *Certain changes of inventors' names (excluding reissue applications and patents).* When accompanied by the appropriate processing fee pursuant to § 1.17(i) or (q), a request, which should also be accompanied by a supplemental application data sheet pursuant to § 1.76 for changes in a nonprovisional application, may be submitted to:

(1) Change the order of the inventors' names to another specified order in a pending application, except in provisional applications;

(2) Change the spelling of an inventor's name; or

(3) Update an inventor's name when it has changed after the application has been filed, where this request is also accompanied by:

(i) An affidavit signed with both names and setting forth the procedure whereby the change of name was effected; or

(ii) A certified copy of a court order for name change.

4. Section 1.55 is amended by revising paragraph (a)(2) to read as follows:

§ 1.55 Claim for foreign priority.

(a) * * *

(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event be filed before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i). If the patent did not publish with the priority claim, the amendment adding the priority claim will not be effective unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

* * * * *

5. Section 1.56 is amended by adding new paragraph (f) to read as follows:

§ 1.56 Duty to disclose information material to patentability.

* * * * *

(f) The additional disclosure requirements for documents in § 1.98(a)(3) would be deemed satisfied where a § 1.56(c) individual has made reasonable inquiry of the relationship of the documents cited in an information disclosure statement to the claimed invention, including the supporting specification, and the individual has acted in good faith to comply with the disclosure requirements by having a reasonable basis for the statements made in such disclosure.

6. Section 1.97 is revised to read as follows:

§ 1.97 Filing of information disclosure statements.

(a) *General.* In order for an applicant for a patent, or for a reissue of a patent, or a patent owner in a reexamination proceeding, to have an information disclosure statement considered by the Office during the pendency of the application, or the reexamination proceeding, the information disclosure statement must satisfy the requirements of § 1.98 specific to the time period of submission of the information disclosure statement as set forth in one of paragraphs (b) through (d) of this section.

(b) *First time period:* Within one of the following time frames:

(1) Three months from the filing date of a national application under 35 U.S.C. 111(a) other than a continued prosecution application under § 1.53(d), or three months from the filing date of a request for reexamination under § 1.510 or § 1.915;

(2) Three months from the date of entry of the national stage as set forth in § 1.491 in an international application; or

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

(c) *Second time period:* After the period specified in paragraph (b) of this section, and before the earlier of the mailing date of a notice of allowability or a notice of allowance under § 1.311 for an application, or of a Notice of Intent to Issue a Reexamination Certificate (NIRC) for a reexamination proceeding.

(d)(1) *Third time period:* After the period specified in paragraph (c) of this section, except for reexamination proceedings, and before or with payment of the issue fee for an application.

(2) *Fourth time period:* After payment of the issue fee for an application and in sufficient time to be considered by the examiner before issuance of the application. For a reexamination proceeding, after the period specified in paragraph (c) of this section and in sufficient time to be considered by the examiner before issuance of a Reexamination Certificate under § 1.570 or § 1.997.

(e) *Certification.* A certification under this section referenced in §§ 1.98(a)(3)(iii) and 1.98(a)(3)(viii)(B) must certify 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) *Extensions.* No extensions of time for filing an information disclosure statement are permitted under § 1.136, § 1.550 or § 1.956.

(g) *Search.* An information disclosure statement filed in accordance with § 1.98 shall not be construed as a representation that a search has been made.

(h) *Admissions.* 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) *Noncompliance.* (1) If an information disclosure statement does not comply with this section and § 1.98 (see also § 1.98(a)(3)(vii)(C)), it will be placed in the file but will not be considered by the Office.

(2) 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 granted, within the sole discretion of the Office, to enable full compliance.

(j) *Withdrawal.* An information disclosure statement submitted under paragraph (d)(2) of this section will not by itself be effective to withdraw an application from issue, or a reexamination proceeding from the publication procedure for a Reexamination Certificate.

7. Section 1.98 is revised to read as follows:

§ 1.98 Content of information disclosure statements.

(a) *General.* Any information disclosure statement filed under § 1.97 shall comply with the items listed in paragraphs (a)(1), (a)(2), and (a)(3) of this section.

(1) *Listing of items:* A list is required of all patents, publications, applications, or other information submitted to the Office for consideration. 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/proceeding number, if known, of the application/proceeding 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) *Copies of items requirements:* A legible copy must be submitted 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) Each pending or abandoned U.S. application, or that portion which caused it to be listed including any amended claims directed to that portion, unless the cited pending or abandoned U.S. application is in the Office's image file wrapper system. If the cited pending or abandoned U.S. application is in the Office's image file wrapper system, a copy of the application's specification, including the claims, and drawings is not required; and

(iv) All other information or that portion which caused it to be listed.

(3) *Additional disclosure requirements:* (i) The following submitted during the time period defined in § 1.97(b) require the explanation in compliance with paragraph (a)(3)(iv) of this section, except for documents meeting one of the exceptions of paragraphs (a)(3)(viii)(A) and (a)(3)(viii)(C) of this section:

(A) Foreign language documents (see also paragraph (a)(3)(xi) of this section),

(B) Any document over twenty-five pages, excluding sequence listings, or computer program listings, pursuant to § 1.52(e)(1), and

(C) All of the documents, if more than twenty documents are submitted, calculated cumulatively.

(ii) All documents cited in an information disclosure statement submitted during the time period defined in § 1.97(c) require the explanation in compliance with paragraph (a)(3)(iv) of this section and the non-cumulative description in compliance with paragraph (a)(3)(v) of this section, except for documents meeting one of the exceptions of paragraphs (a)(3)(viii)(B) and (a)(3)(viii)(C) of this section.

(iii) All documents cited in an information disclosure statement submitted during the time periods defined in §§ 1.97(d)(1) and (d)(2) require a certification pursuant to § 1.97(e)(1) or (e)(2) and must meet one of the following:

(A) When the information disclosure statement is submitted during the time period defined in § 1.97(d)(1), compliance is required with either patentability justification pursuant to either paragraph (a)(3)(vi)(A) or (a)(3)(vi)(B) of this section; or

(B) When submitted during the time period defined in § 1.97(d)(2), the information disclosure statement must be accompanied by a petition to withdraw an application from issue pursuant to § 1.313(c)(1), or a reexamination proceeding from publication pursuant to this paragraph and the fee set forth in § 1.17(h), and the patentability justification pursuant to paragraph (a)(3)(vi)(B) of this section.

(iv) *Explanation:* An explanation must include:

(A) *Identification:* Identification of specific feature(s), showing(s), or teaching(s) that caused a document to be cited, and a representative portion(s) of the document where the specific feature(s), showing(s), or teaching(s) may be found; and

(B) *Correlation:* A correlation of the specific feature(s), showing(s), or teaching(s) identified in paragraph (a)(3)(iv)(A) of this section to corresponding specific claim language, or to a specific portion(s) of the specification that provides support for the claimed invention, where the document is cited for that purpose.

(v) *Non-cumulative description:* A non-cumulative description requires a description of how each document is not merely cumulative of any other information disclosure statement cited document, document cited by the examiner, or document cited under §§ 1.99, or 1.291, as citation of merely cumulative information must be avoided pursuant to paragraph (c) of this section. The description may be of a specific feature, showing, or teaching in a document that is not found in any other document of record. Note the exceptions set forth in paragraphs (a)(3)(viii)(B) and (a)(3)(viii)(C) of this section.

(vi) *Patentability justification:* A patentability justification requires either:

(A) An explanation pursuant to paragraph (a)(3)(iv) of this section, a non-cumulative description pursuant to paragraph (a)(3)(v) of this section, and reasons why the independent claims are patentable over the information in the information disclosure statement being submitted, considered together, and in view of any information already of record; or

(B) An explanation pursuant to paragraph (a)(3)(iv) of this section, a non-cumulative description pursuant to paragraph (a)(3)(v) of this section, and reasons why an amendment causes claims, admitted to be unpatentable over the information in the submitted information disclosure statement, either alone or in combination with any information already of record, to now be patentable over such information when considered together, and in view of any information already of record.

(vii) *Meaningful compliance:* (A) The explanations pursuant to paragraph (a)(3)(iv) of this section must include a level of specificity commensurate with specifics of the feature(s), showing(s), or teaching(s) which caused the document to be cited. These explanations must not be *pro forma* types of explanations. The non-cumulative descriptions pursuant to paragraph (a)(3)(v) of this section must be significantly different so as to point out why the cited document is not merely cumulative of any other information currently being filed, or previously of record.

(B) The reasons for patentability justification presented pursuant to paragraph (a)(3)(vi) of this section must discuss specific claim language relative to the specific feature(s), showing(s), or teaching(s) of specific documents that are being cited, or already of record.

(C) If the explanations or non-cumulative descriptions do not comply with (a)(3)(vii)(A) of this section, or the reasons for patentability justification do not comply with (a)(3)(vii)(B) of this section, the Office may decline to consider the information disclosure statement. See also § 1.97(i)(1).

(viii) *Exceptions:* (A) Compliance with paragraph (a)(3)(iv) of this section is not required for documents cited within a time frame set forth in § 1.97(b) that result from a foreign search or examination report where a copy of the report is submitted with the information disclosure statement.

(B) Compliance with paragraphs (a)(3)(iv) and (a)(3)(v) of this section is not required for documents cited within

the time frame set forth in § 1.97(c) when submitted with a certification pursuant to § 1.97(e)(1) and a copy of the foreign search or examination report.

(C) Compliance with paragraphs (a)(3)(iv) and (a)(3)(v) of this section is not required for documents submitted in reply to a requirement for information pursuant to § 1.105.

(ix) *Updating:* With each amendment to the claims or the specification affecting the scope of the claims, other than an examiner's amendment, filed after an information disclosure statement:

(A) The required explanation under paragraph (a)(3)(iv) of this section for all previous information disclosure statements must be reviewed and updated where necessary in view of the amendment(s); or

(B) A statement must be supplied to the effect that updating of the previous explanation(s) submitted with information disclosure statement(s) is not needed.

(x) *Format of additional disclosure:* The additional disclosure requirements pursuant to paragraph (a)(3) of this section, may be supplied as an attachment to the list in paragraph (a)(1) of this section, or included in the application specification with the page(s) and lines of specification where it is incorporated being noted in the list (similar to the treatment of non-English documents) or partially provided in each.

(xi) *Translations:* For Non-English language documents of any length, a copy of a translation in English thereof must be submitted along with the document where a translation is within the possession, custody, or control of, or is readily available to, any individual listed in § 1.56(c). A translation does not count towards the cumulative total of paragraph (a)(3)(i)(C) of this section, but is subject to the over twenty-five page threshold value of paragraph (a)(3)(i)(B) of this section.

(b) *Content of Listing:* (1) Each U.S. patent listed in an information disclosure statement must be identified by the inventor(s), patent number, and issue date.

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

(3) Each U.S. patent application listed in an information disclosure statement must be identified by the applicant(s), 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.

(c) *Avoid cumulative information:* Citing documents that are merely cumulative of other documents cited must be avoided. The Office may decline to consider an information disclosure statement citing documents that are merely cumulative.

(d) *Information cited in prior application:* A copy of any foreign patent, publication, pending or abandoned U.S. application or other information, as specified in paragraph (a)(2) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending or abandoned U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application (containing an earlier information disclosure statement), unless:

(1) The earlier application is properly identified in the (later submitted) information disclosure statement and the earlier application (containing the earlier submitted or cited information) is relied on in the application in which the information disclosure statement is submitted for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complied with paragraphs (a)(1), (a)(2) and (b) of this section.

8. Section 1.99 is amended by revising paragraphs (a) and (e) to read as follows:

§ 1.99 Third-party submission in published application.

(a) A submission by a member of the public other than a § 1.56(c) individual (*i.e.*, a submission from a third party) of patents or publications relevant to a pending published application may be entered in the application file if the submission complies with the requirements of this section and the application is still pending when the submission and application file are brought before the examiner. A submission under this section must be filed within six months from the date of publication of the application (§ 1.215(a)), or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier.

* * * * *

(e) A submission by a member of the public to a pending published application that does not comply with the requirements of this section will not be entered.

* * * * *

9. Section 1.291 is amended by revising paragraphs (b) and (c)(2) to read as follows:

§ 1.291 Protests by the public against pending applications.

* * * * *

(b)(1) *Entry:* The protest will be entered into the record of the application if:

(i) It complies with paragraph (c) of this section;

(ii) The protest has been served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event such service is not possible; and

(iii) The protest was filed prior to the date the application was published under § 1.211, or a notice of allowance under § 1.311 was mailed, whichever occurs first, or alternatively, the applicant has provided written consent to the protest pursuant to paragraph (b)(2) of this section.

(2) *Applicant consent and protester statement:* (i) If a protest is accompanied by the written consent of the applicant, or such written consent is of record in the application, the protest will be considered if the protest is matched with the application in time to permit review during prosecution of the application.

(ii) A consent may be limited only insofar as it may expressly designate the length of time for which the consent is in effect, at least thirty days, and a specific party who can file a protest. Any other limitation will not be given effect.

(iii) Any protest filed based upon a consent under paragraph (b)(2) of this section must contain a statement that the submitted protest is based on the written consent of the applicant and falls within the terms of the consent.

(3) *Unsolicited information:* Upon receiving unsolicited information from a party other than a § 1.56(c) individual (*i.e.*, from a third party), an applicant may exercise one of the following options:

(i) *Submit as an information disclosure statement:* Submit the unsolicited information as an information disclosure statement, provided there is compliance with §§ 1.97 and 1.98.

(ii) *Provide consent:* Provide a written consent pursuant to paragraph (b)(2) of this section to the third party, if known, for that third party to file the unsolicited information with the Office as (part of) a protest. If the third party is unknown, the written consent to the submission of a protest may be filed in the application.

(iii) *Submit as a protest:* Submit the unsolicited information to the Office as a protest on behalf of the third party, provided there is compliance with this section (other than paragraph (b)(1)(ii) of this section), including the requirements of paragraph (c) of this section. A submission by applicant of the unsolicited information under this paragraph, as a protest on behalf of the third party, shall be deemed a consent to the protest pursuant to paragraph (b)(2) of this section.

(4) *Material information:* Nothing in this section is intended to relieve a person subject to § 1.56(c) from submitting to the Office information that is subject to the duty of disclosure under § 1.56.

(5) *First protest statement:* A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest; or the protest must comply with paragraph (c)(5) of this section. This paragraph does not apply to the first protest filed in an application.

(c) * * *

(2) A concise explanation of the relevance of each item listed pursuant to paragraph (c)(1) of this section. Items in a compliant protest will be considered by the examiner at least to the extent of the provided explanations;

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10. Section 1.312 is revised to read as follows:

§ 1.312 Amendments after allowance.

(a) No amendment may be made as a matter of right in an application after the mailing of the notice of allowance, except as provided in paragraphs (a)(1) and (a)(2) of this section. Any amendment in addition to those provided in paragraphs (a)(1) and (a)(2) of this section may be entered on the recommendation of the primary examiner, approved by the Director. Any amendment entered pursuant to this section may be made without withdrawing the application from issue.

(1) *Amendments filed before or with the payment of the issue fee:* The following amendments may be entered when filed after allowance but before or with payment of the issue fee:

(i) Amendment of the bibliographic data to be indicated on the front page of the patent;

(ii) Amendment of the specification to add a reference to a joint research agreement (§ 1.71(g));

(iii) Addition of a benefit claim of a prior-filed provisional application under 35 U.S.C. 119(e), a prior-filed nonprovisional application under 35 U.S.C. 120, or a prior-filed international application that designated the United States under 35 U.S.C. 365(c) (§ 1.78), subject to any petition required pursuant to § 1.78;

(iv) Addition of a priority claim of a prior foreign application under 35 U.S.C. 119(a) through (d) or (f) or 365(a) or (b) (§ 1.55), subject to any petition required pursuant to § 1.55;

(v) Changing the order of the inventors' names, the spelling of an inventor's name, or the name of an inventor, pursuant to § 1.48(k); or

(vi) Changing the inventorship pursuant to § 1.48.

(2) *Amendments filed after the date the issue fee is paid:* The amendments identified in paragraph (a)(1) of this section may be entered when filed after the date the issue fee is paid provided:

(i) The amendments are submitted in sufficient time to permit the patent to be printed with the amended information, and

(ii) The processing fee set forth in § 1.17(i) is submitted.

(b) If the patent does not include the amendment filed after payment of the issue fee, the amendment will not be effective unless the patent is corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323 or otherwise corrected in another post-issuance proceeding, as appropriate.

11. Section 1.555 is amended by revising paragraph (a) to read as follows:

§ 1.555 Information material to patentability in *ex parte* reexamination and *inter partes* reexamination proceedings.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective reexamination occurs when, at the time a reexamination proceeding is being conducted, the Office is aware of and evaluates the teachings of all information material to patentability in a reexamination proceeding. Each individual associated with the patent owner in a reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding. The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding. The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding until the claim is cancelled.

Information material to the patentability of a cancelled claim need not be submitted if the information is not material to patentability of any claim remaining under consideration in the reexamination proceeding. The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement in compliance with §§ 1.97 and 1.98. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. Any information disclosure statement must be filed with the items listed in, and pursuant to the requirements of, § 1.98 as applied to individuals associated with the patent owner in a reexamination proceeding, and must be filed within the time frames set forth in § 1.97.

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12. Section 1.948 is amended by adding paragraph (b) to read as follows:

§ 1.948 Limitations on submission of prior art by third party requester following the order for *inter partes* reexamination.

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(b) Notwithstanding any provision of these rules, any submission of prior art or other information as set forth in § 1.98 by a third party requester must comply with the requirements of § 1.98.

Dated: June 28, 2006.

Jon W. Dudas,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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