

which an IDS may be filed from the day of mailing of an Office action to the day before the mailing of an Office action.

Section 1.97(b)(3) is proposed to be amended to require filing of an IDS before the day of the mailing of the first Office action.

Section 1.97(b)(4) is proposed to be amended to require filing of an IDS before the day of the mailing of the first Office action after the filing of a request for continued examination under § 1.114.

Section 1.97(c) is proposed to be amended to require filing of an IDS before the day of the mailing of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, provided it is accompanied by one of: (1) The statement specified in § 1.97(e); or (2) the fee set forth in § 1.17(p).

With PAIR, applicants can easily determine when Office actions are mailed by reviewing the change of status information for an application that is available over the Internet. Unless applicants are required to submit an IDS before Office actions are mailed, applicants may unfairly delay prosecution to meet their short-term needs by mailing an IDS on the same day as Office actions are mailed upon seeing that a mailing occurred through PAIR. Therefore, in order to promote efficient processing and provide the benefits of PAIR, a change in the "mailing rule" is being proposed.

Section 1.98: Section 1.98 is proposed to be amended by adding a new paragraph (e), which provides that the requirement in § 1.98(a)(2)(i) for a copy of all listed U.S. patents and U.S. patent application publications does not apply to any IDS submitted in compliance with the Office's electronic filing system. Thus, for any IDS submitted to the Office via the Office's EFS, paper copies of U.S. patents and U.S. application publications cited in the IDS would no longer have to be supplied by applicants.

An EFS software upgrade has added an IDS, submitted under the provisions of §§ 1.97 and 1.98, as a type of electronic submission that may be made via the Office's EFS. Currently, the EFS may only be used to submit: (1) Certain non-provisional utility patent applications; (2) provisional applications; (3) biotechnology sequence listings; (4) copies of patent applications for purposes of having the copies of the patent application published (redacted publication, republication as amended, or voluntary publication); (5) assignments of patents and applications; and (6) Information

Disclosure Statements. *See Legal Framework for the Use of the Electronic Filing System*, 1263 *Off. Gaz. Pat. Office* 60, 61 (Oct. 8, 2002). With the EFS software upgrade, an applicant is able to electronically transmit an IDS with the filing of a new utility patent application, or as a subsequent filing. This EFS software upgrade is NOT usable for third party information disclosure submissions under § 1.99. The IDS submission via EFS is the only electronic substitute for a paper IDS submission contemplated. EFS has been available to the general public for limited electronic filing since October 2000. *See Electronic Filing System Available to Public*, 1240 *Off. Gaz. Pat. Office* 45 (Nov. 14, 2000).

Applicants may file an IDS via EFS by (1) entering the references' citation information in a fillable electronic form, equivalent to the paper PTO-1449 form (or revised form PTO/SB/08A and 08B) by using EFS software; and (2) transmitting the fillable electronic form data to the Office via EFS. This electronic EFS form currently allows only citations for U.S. patents and U.S. patent application publications. If any references to foreign patent documents or non-patent literature documents or unpublished U.S. applications are to be cited, then applicants will continue to submit those citations on a separate, conventional paper PTO-1449 form (or equivalent form) delivered with a printed copy of each cited foreign patent document, non-patent literature document and unpublished U.S. application via mail, facsimile transmission, or hand delivery. Applicants need not send the Office copies of any U.S. patent or U.S. application publication documents cited on a fillable electronic IDS form that is electronically transmitted to the Office via EFS. In those instances in which an applicant sends an IDS on the same day by EFS and by conventional delivery, and a fee under § 1.97 is due, only one fee will be due if the applicant informs the Office in the conventional submission that such a submission is associated with an electronic submission on the same day in which the fee was paid.

The EFS software provides a fillable electronic IDS form equivalent to a paper PTO-1449, Information Disclosure Statement form, in which citations for up to 50 U.S. patents and up to 50 U.S. patent application publications may be entered. This EFS fillable form has fields where statements of relevance and where notifications that the documents were cited in a communication from a foreign patent Office in accordance with § 1.97(e) may

be given. The EFS upgrade validates the format of data entered into the fillable electronic IDS form and provides the means to specify whether this fillable EFS IDS form is to be linked to an accompanying new application filing or is being filed in a previously filed application, and transmit the XML formatted IDS data on the fillable electronic form to the Office. The EFS software also provides fields to enter required fee payment information under §§ 1.97(c)(2) and (d)(2).

The fillable, EFS IDS form will be entered as a paper (but will actually be part of an electronic database) into the application file contents indicating that it was received on the date the complete transmission containing the form was received in the Office via EFS. This is the date the Office will refer to in considering compliance with § 1.97.

Examiners will consider the U.S. patents and U.S. application publications cited on an EFS transmitted IDS form provided the remaining requirements of §§ 1.97 and 1.98 are met, by reviewing electronic or printed copies produced from the Office's electronic databases. It will be most important that the cited patent and application publication numbers be accurate and devoid of transcription error. There will be no applicant-provided copies of the disclosed documents in the application file for the examiner to review. Instead, because the Office will electronically retrieve the patents and application publications so identified by those numbers, the examiner will only be able to consider the documents so identified. As a corollary, examiners will only consider what is actually cited. Where, for example, an error is made in transcribing a U.S. patent number, and the examiner, after retrieving the patent associated with the number as entered in the IDS, determines that the patent associated with the number as entered in the IDS is not the correct number, because the inventor's name and issue date entered in the IDS does not match the corresponding data on the patent associated with the patent number entered in the IDS, the examiner will follow the procedure regarding the handling of non-complying information disclosure statements set forth in section 609 III(C)(1) of the *Manual of Patent Examination Procedure* (8th ed. 2001) (MPEP). The examiner may either initial the paper copy printed from the electronic IDS to indicate that the erroneously cited patent has been reviewed or line through the citation as not in compliance with § 1.98.

The only procedure for having such documents considered when an