

on any sheet including any other part of the specification. A title of the invention if it is provided as a heading on the first page of the specification is considered part of the specification.

Section 1.72

Paragraph (b) of § 1.72 has been amended to prohibit the paper presenting the abstract to include any other portions of the application or other material. Presentation of material other than the abstract on the same page as the abstract makes the electronic indexing of the application more difficult. In addition, the last sentence of § 1.72(b) has been removed to eliminate the prohibition on using the abstract to interpret the claims to conform the rule to be consistent with Federal Circuit case law. *See Hill-Rom Co. versus Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n.*, 54 USPQ2d 1437, 1440 n.1 (Fed. Cir. 2000).

Section 1.75

Paragraph (h) of § 1.75 has been amended to prohibit a paper presenting claims from including any other portions of the application or other material. Presentation of material other than the claims on the same page as one or more claims makes the electronic indexing of the application more difficult.

Section 1.98

Section 1.98 has been amended by adding a new § 1.98(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 will 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. *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. 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 fifty U.S. patents and up to fifty 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) in 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 § 609 III(C)(1) of the *Manual of Patent Examining Procedure* (8th ed. 2001) (Rev. 1, Feb. 2003) (MPEP). The examiner may either initial next to the citation on the listing of references 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 erroneous patent or application publication number is cited in an eIDS will be by citing the correct document identifying number in a subsequent IDS, either paper or electronic, that conforms to the requirements of §§ 1.97 and 1.98, as specified in MPEP § 609 III(C)(1) regarding corrections of the information in non-complying information disclosure statements.

The IDS may be submitted as part of an EFS electronic application filing, or subsequent to an application filing, either in paper or via EFS. The ePAVE program will prompt the filer to associate an IDS file with a new application file and to provide payment information, where either is appropriate. As with the other types of