

extensions of time available under § 1.136, except in the case of perishables. The Office intends to set a one-month period of time from the mailing date of the notification for applicant to make arrangements for a return, unless the item is a perishable, in which case the time period will be shorter. Failure by applicant to establish that arrangements for the return of a model, exhibit or specimen have been made within the time period set in the notice, will result in the item being discarded by the Office.

Section 1.98: Section 1.98(a) is proposed to be amended by revising paragraph (a)(1) to require a specified format/identification for each page of an IDS, and that U.S. patents and U.S. patent application publications be listed in a section separately from citations of other documents. Section 1.98(a)(1) is specifically proposed to be amended to require that U.S. patents and U.S. patent application publications must be listed separately from the citations of other documents. This will permit the Office to optical character recognition (OCR) scan the U.S. patent numbers and the U.S. patent application publication numbers such that the document could be made available electronically to the examiner to facilitate searching and retrieval of U.S. patents and U.S. patent application publications on the Office's search databases. Applicants will comply with this proposed requirement if they use forms PTO/SB/08A and 08B (or the more commonly used PTO-1449), which provide a separate section for listing U.S. patents and U.S. patent application publications. Applicants who do not use these forms for submitting an IDS must make sure that the U.S. patents and U.S. patent application publications are listed in a separate section from citations of other documents.

Current § 1.98(a)(1) does not require the use of a form such as the PTO/SB/08A and 08B because the Office wishes to provide applicants the flexibility to use other types of lists. The Office, however, experiences problems associated with lists that do not properly identify the application in which the IDS is being submitted: *e.g.*, when applicants submit a list that includes copies of PTO-1449 or PTO-892 forms from other applications. Even though the IDS transmittal letter has the proper application number, each page of the list does not include the proper application number, but instead has the application numbers of the other applications. Should the pages of the list become separated, the Office cannot associate the pages with the proper application. Therefore, the rule is

proposed to be amended to require that each page of the list must clearly identify the application number of the application in which the IDS is being submitted.

Section 1.98(a)(1) is also proposed to be amended to require that a list must include a column that provides a space next to each document listed in order to permit the examiner to enter his or her initials next to the citations of the documents that have been considered by the examiner. This provides a notification to the applicant and a clear record in the application to indicate which documents have been considered by the examiner for the application. Applicants are strongly discouraged from submitting a list that includes copies of PTO/SB/08 (PTO-1449) or PTO-892 forms from other applications. A completed PTO/SB/08 or PTO-1449 form from another application may already have initials of another examiner and the application number of another application. The burden is then on the Office to correct the incorrect information. Furthermore, when the spaces provided on the form have initials of another examiner, there are no spaces available next to the documents listed for the examiner of the subsequent application to provide his or her initials.

Section 1.98(a)(1) is also proposed to be amended to require that each page of the list includes a heading that clearly indicates that the list is an information disclosure statement. Since the Office treats an IDS submitted by the applicant differently than information submitted by a third-party (*e.g.*, the Office may discard any non-compliant third-party submission under § 1.99), a heading on each page of the list to indicate that the list is an IDS would promote proper treatment of the IDS submitted by the applicant and reduce handling errors.

Section 1.98(e) is proposed to be amended to provide that the requirement in § 1.98(a)(2) for a copy of the U.S. patents or U.S. patent application publications listed in an information disclosure statement does not apply: (1) In any national patent application filed after June 30, 2003; (2) in any international application that has entered the national stage under 35 U.S.C. 371 and § 1.495 after June 30, 2003; or (3) in any information disclosure statement submitted in compliance with the Office's electronic filing system. *See Information Disclosure Statements May Be Filed Without Copies of U.S. Patents and Published Applications in Patent Applications filed after June 30, 2003*, 1273 *Off. Gaz. Pat. Office* 55 (Aug. 5, 2003).

Section 1.102: Section 1.102(c) would be amended to provide by rule for a petition to make an application special without a fee when the application relates to a counter-terrorism invention. The Office currently accords "special" status to patent applications relating to counter-terrorism technology so long as the fee under § 1.17(h) is included with the petition. Amending § 1.102(c) to cover applications relating to counter-terrorism inventions will eliminate the requirement for a fee.

Under current § 1.102(c), there are two types of inventions that qualify as a basis for making an application special without a fee (other than on the basis of an applicant's age or health), namely: (1) Inventions that will materially enhance the quality of the environment; and (2) inventions that will materially contribute to the development or conservation of energy resources. It is proposed that inventions that will materially contribute to countering terrorism be added as a third type of invention for making an application special without a fee under § 1.102(c). As set forth in MPEP § 708.02, XI (Inventions For Countering Terrorism), the types of technology for countering terrorism include, but are not limited to, systems for detecting/identifying explosives, aircraft sensors/security systems, and vehicular barricades/disabling systems. This is appropriate considering that such inventions may help maintain homeland security. In view of this proposed amendment, the basis for making applications relating to counter-terrorism technology special would be transferred from § 1.102(d) to § 1.102(c).

Pursuant to the proposed amendment, § 1.102(c) sets forth two bases for making an application special: (1) Applicant's age or health; or (2) that the invention is one of the three qualifying types of inventions (*i.e.*, the invention is one that will materially enhance the quality of the environment, materially contribute to the development or conservation of energy resources, or materially contribute to countering terrorism). In view of the divergent subject matter covered by § 1.102(c)(1) and (c)(2), a petition under § 1.102(c)(1) or (c)(2) must identify the particular basis under which applicant is petitioning for special status so that the Office can determine how to evaluate an application's entitlement to special status. In addition, MPEP § 708.02 indicates that a "petition for special status should be accompanied by a statement explaining how the invention contributes to countering terrorism" as defined in MPEP § 708.02, XI, Inventions For Countering Terrorism.