

From: Bob Ryan
Sent: Friday, October 05, 2012 6:52 PM
To: fitf_rules
Cc: Craig Macy; Connor McCune; Gay Groves
Subject: First-Inventor-to-File (Response to Proposed Rules)
Importance: High

To: The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

Dear Under Secretary Kappos:

Attached are Comments to Proposed Rules for Implementation of the America Invents Act.

Respectfully submitted,

Robert C. Ryan
Patent Attorney/Partner
HOLLAND & HART LLP
5441 Kietzke Lane
Second Floor
Reno, Nevada 89511
Main: 775-327-3000
Direct: 775-327-3042
Cell: 775-247-8803
Fax: 775-786-6179
Skype: rcryanh
www.hollandhart.com



MEMORANDUM

October 5, 2012

Via Electronic Mail: fitf_rules@uspto.gov

TO: The Honorable David J. Kappos, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

FROM: Robert C. Ryan, Esq. (Reg. No. 29,343)
Craig H. Macy, Esq. (Reg. No. 68,344)
Connor L McCune (Reg. No. 69,726)

DATE: October 5, 2012

RE: First-Inventor-to-File (Response to Proposed Rules)

Dear Under Secretary Kappos:

Below are our comments on proposed rule 1.78 as seen in Vol. 77, No. 144 of the Federal Register, dated Thursday, July 26, 2012.

PROBLEMS PRESENTED BY PROPOSED RULE 1.78(a)3

Proposed section 1.78(a)(3) requires that, if an applicant believes new matter is added to a nonprovisional application claiming priority to a provisional application filed before March 16, 2013, the applicant must certify that the application includes new matter so that the PTO can determine which law to apply to the application. This requirement should not be enacted because it imposes a very serious, costly, and risky burden on applicants and their counsel, and reduces the incentive to patent, innovate, expand human knowledge, and create new products, services, enterprises, and jobs.

I. First, every attorney has the duty “zealously to protect and pursue a client's legitimate interests, within the bounds of the law.”ⁱ A duty to concede the existence of “subject matter not also disclosed in (the) provisional application” runs directly counter to that duty.ⁱⁱ Like obviousness, and thus materiality, the determination of what constitutes new matter can involve

Holland & Hart LLP Attorneys at Law

Phone (775) 327-3000 Fax (775) 786-6179 www.hollandhart.com

5441 Kietzke Lane Second Floor Reno NV 89511

Aspen Billings Boise Boulder Carson City Cheyenne Colorado Springs Denver Denver Tech Center Jackson Hole Las Vegas Reno Salt Lake City Santa Fe Washington, D.C.

substantial subjective, complex, and unpredictable underlying inquiries (such as enablement support, written description support, and additional detailed teaching when 35 U.S.C. § 112 ¶ 6 (functional claiming) is or may be applicable, the latter inquiry being exceptionally complex). These are things about which reasonable people can and do disagree.ⁱⁱⁱ

As a result, if (i) an advocate were to take a position that given matter is supported and not new (in compliance with the advocate's duty to advocate zealously), but (ii) that question were later decided contrary to the position taken by the advocate, the advocate then would be at risk of being accused of having violated the duty of candor and engaged in inequitable conduct. The duty of candor and its potential consequence of being accused of inequitable conduct thus places the advocate at serious risk of advocating zealously when the advocate believes there is arguable, but not necessarily un-debatable, support in the priority document. The proposed rule thus runs counter to the duty to advocate zealously because of the duty of candor and the potentially serious consequence of being accused of having violated that duty due to someone's later disagreement with, or argument contrary to, the argument position taken by the advocate for the client.

In addition, this rule raises the risk that applicants and advocates will over-state the scope of new matter, to try to comply with the duty of candor and avoid any possible inequitable conduct. The proposed rule thus incentivizes, in multiple ways, conduct by advocates counter to, among other things, their duty to advocate zealously.

II. For reasons noted above, requiring applicants and advocates to compare applications and scour their provisional applications for support for all matter in the nonprovisional will be a time consuming and costly task. Thus, the proposed rule will significantly increase the time involved in, and cost of, preparing nonprovisional applications, with little to no benefit to the applicants. The substantial cost of compliance with the proposed rule thus will create yet further disincentive to patent, which will create yet further disincentive to innovate, add to the scope of human knowledge, and create new products, services, enterprises, and jobs.

III. It has historically been the job of the Examiner, not the patent applicant or its advocate, to determine if a claim in a nonprovisional application claiming priority to a provisional application is supported by the disclosure in the provisional application.^{iv} For example, the MPEP states that each claim in a nonprovisional application claiming priority to a provisional application must be supported by the provisional to comply with 35 U.S.C. § 112 ¶ 1.^v Further, the Examiner's note to form paragraph 2.10 of that section gives the standard Examiner response to such a situation.^{vi}

Thus, the Examiner is already under a duty to verify support in the provisional application for each claim. Consequently, we respectfully submit that the reasons given for the proposed rule are without merit. The proposed rule requires the Examiner to perform the same function and involves only a minimally increased burden on that Examiner by further requiring

the Examiner to compare dates and determine if the new law applies. This negligible increase in effort by the Office does not justify: (i) placing such a high burden and level of risk on patent applicants and their representatives; (ii) disincentivizing advocates' zealous advocacy on behalf of their client applicants; and (iii) the resulting negative incentive to innovate, expand human knowledge, and create new products, services, enterprises, and jobs.

IV. This proposed rule presents problems similar in nature to those created by an earlier version of a section in 37 C.F.R. enacted in 1977 as further described in the MPEP at the time. (See Exhibit A attached.) This latter rule had required the applicant and the applicant's advocate to summarize the prior art filed in an IDS in order to aid the Examiner in examining the application.^{vii} By requiring the applicants and their advocates to characterize cited prior art, this rule created serious risks for the applicants and their advocates before the Office. The rule also ran counter to the advocates' duty to advocate zealously for their clients. This requirement obviously presented the same types of issues presented by the present proposed rule to identify the presence of new matter. As a result, the duty to summarize prior art was finally repealed in 1992.^{viii}

We therefore respectfully request that the Office decline to enact this new proposed rule for the same reasons that the duty to summarize the prior art was repealed in 1992 as well as for the other reasons explained above.

We thank you for consideration of our comments. If you have any questions, please do not hesitate to contact us at any time.

Very truly yours,



Robert C. Ryan, Esq.
(Reg. No. 29,343)
Craig Macy, Esq.
(Reg. No. 68,344)
Connor McCune
(Reg. No. 69,726; Nevada Bar Admission Pending)

ⁱ Module Rule of Professional Conduct, Comment to R 1.3, Preamble ¶¶[2], [9].

ⁱⁱ “Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act,” 77 Federal Register 144, p. 43747 (July 26, 2012).

ⁱⁱⁱ MPEP 706.03(o) “New Matter”; MPEP 2163.06 “Relationship of Written Description Requirement to New Matter”; MPEP 2163.07 “Amendments to Application Which Are Supported in the Original Description”; *See* 85 J. Pat. & Trademark Off. Soc’y 133 (2003) (“The requirement which is at the core of this article, the written description requirement, is the perfect example of the rather unstable interpretation of some of the patentability requirements. This requirement has given rise to considerable debate and disagreement concerning the exact ambit and scope within the CAFC.”).

^{iv} MPEP 201.11.

^v *Id.*

^{vi} *Id.*

^{vii} 37 C.F.R. §1.98, Jan. 1977 (*see* 42 FR 5590-91, 94 for comments); MPEP 609 3rd ed., 52nd revision, p. 60 - 60.2 (Apr. 1977).

^{viii} 37 C.F.R. §1.98, Jan. 1992 (*see* 57 FR 2030-31, 35 for comments); MPEP 609 5th ed., 14th revision, p. 600-66 – 600-68 (Nov. 1992).

Exhibit A

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1.	42 F.R. 5590-5595 (concerning 37 C.F.R. §1.98) Jan. 1977.....	2
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comments on proposed § 1.56. The Court noted that the standard of materiality should not be so low that persons would be "subjected to liability for insignificant omissions or misstatements," or so low that the fear of liability would cause management "simply to bury the shareholder in an avalanche of trivial information—a result that is hardly conducive to informed decision making."⁶

Although the third sentence of § 1.56 (a) refers to decisions of an examiner, it is intended that the duty of disclosure would apply in the same manner in the less common instances where the official making a decision on a patent application is someone other than an examiner—e.g., a member of the Board of Patent Interferences or the Board of Appeals. This is implicit in the duty "of candor and good faith" toward the Office that is specified in the first sentence of § 1.56(a).

Comments and questions were received concerning the term "information" used in the second and third sentences of § 1.56(a) and elsewhere. It means all of the kinds of information required to be disclosed under current case law. In addition to prior art patents and publications, it includes information on prior public uses, sales, and the like. It is not believed practicable to define information in the text of the rule at this time. However, the rule is not intended to require disclosure of information favorable to patentability—e.g., evidence of commercial success of the invention. Neither is it meant to require disclosure of information concerning the level of skill in the art for purposes of determining obviousness.

Several comments were received concerning the duty to disclose information the patent applicant regards as confidential, including information the applicant has received from another party under an injunction of secrecy. This problem has existed prior to amendment of § 1.56. The Patent and Trademark Office, of course, keeps information disclosed by applicants confidential until a patent is issued. It has been suggested that the Office should develop a mechanism for continuing to hold information in confidence after issuance of a patent if in the judgment of the examiner the information is not material to the examination of the application. The feasibility of offering a rule for public comment on this topic at a later date will be considered.

New § 1.56(b) is added to make clear that information may be disclosed to the Office through an attorney or agent of record or through a pro se inventor, and that other individuals may satisfy their duty of disclosure to the Office by disclosing information to such an attorney, agent or inventor. Information that is not material need not be passed along to the Office.

Proposed sections 1.56 (b) and (c) have been revised and shortened and appear at §§ 1.56 (c) and (d). The proposal was

criticized for leaving it open to the Office to apply a different standard of materiality from the one set forth in § 1.56. Section 1.56(d) as adopted states that an application "shall" be stricken when the criteria set forth are met. Thus § 1.56(d) as adopted establishes a single standard for striking applications.

The term "inequitable conduct" is dropped from § 1.56(d) as covering too great a spectrum of conduct to be subject to mandatory striking. Inequitable conduct that is equivalent to fraud is intended to come within the definition of fraud. The Court of Customs and Patent Appeals already has interpreted "fraud" in existing § 1.56 to encompass conduct of this sort.⁷ Moreover, § 1.56(d) as adopted calls for striking an application either for fraud or for a violation of the duty of disclosure.

In § 1.56(d) "bad faith" is substituted for the term "deliberate" that was used in the proposal. This change is to make clear that an intent to deceive (or gross negligence equivalent to such an intent) must be shown before an application will be stricken. Bad faith is not present if information is withheld as a result of an error in judgment or inadvertence.

Several comments concerned whether attorneys and agents could represent their clients' interests and at the same time comply with § 1.56. Similar comments were directed to §§ 1.97 to 1.99. It is of course in the interest of the client to have a valid patent and this cannot be obtained without disclosure of known material facts. It is not inconsistent for an attorney or agent to fulfill his duty of candor and good faith to the Office and to act as an advocate for his client. The submission of information under § 1.56 does not preclude the submission of arguments that such information does not render the subject matter of the application unpatentable.

In § 1.65 a new third sentence is added to require the patent applicant to acknowledge the duty of disclosure. The language is changed from the proposal to be consistent with changes made in § 1.56. To allow time for the Office and applicants to revise printed oath and declaration forms now in use, the mandatory acknowledgement of the duty of disclosure in amended § 1.65 does not become effective until January 1, 1978. Applicants at their option may include the new language in oaths and declarations filed prior to the effective date. The Office will publish a separate notice in the FEDERAL REGISTER adding a sentence acknowledging the duty of disclosure to appropriate forms in 37 CFR Part 3, "Forms for Patent Cases."

The word "statement" is deleted from the title of § 1.65 to avoid confusion with the prior art statement of §§ 1.97 through 1.99.

Amended § 1.346 emphasizes that there must be a reasonable basis to support

every allegation of improper conduct made by a registered practitioner in any Office proceeding. The language that was proposed is clarified in the section as adopted. Although § 1.346 is limited to papers filed in Office proceedings, the amendment to § 1.346 is not intended to imply that disciplinary action never will be taken against a registered practitioner under § 1.348 for a groundless allegation of improper conduct in a court proceeding.

PRIOR ART STATEMENTS

New §§ 1.97, 1.98 and 1.99 deal with prior art statements and provide a mechanism by which patent applicants may comply with the duty of disclosure provided in § 1.56. The sections have been substantially changed from the proposal, in response to comments received.

Unlike the corresponding part of the proposal, the sections as adopted are not mandatory, though applicants are strongly encouraged to follow the procedures described in them. Applications will be examined whether or not a prior art statement is filed and whether it complies with the rules or is defective. It is nevertheless believed that applicants will find that the use of prior art statements complying fully with the requirements of §§ 1.97 through 1.99 will be the best way to satisfy the duty of disclosure. The Patent and Trademark Office cannot assure that prior art disclosed in other ways will be considered by the examiner.

Sections 1.97 through 1.99 do not prescribe the content of what materials should be submitted in the prior art statement; this is for the applicant and the attorney or agent to decide in the light of the duty of disclosure expressed in § 1.56. The only criterion contained in §§ 1.97 through 1.99 as to content of the art cited is in § 1.97(b). This subsection indicates that the statement will be construed as a representation that the prior art listed includes what the submitter considers to be the closest art of which he is aware. The submitter need not decide which particular items of prior art are the closest or identify any items as such; the representation is simply that he is not withholding known prior art which he considers closer than that which is submitted. Section 1.97(b) makes clear that the prior art statement is not a representation that a search has been made or that no better art exists.

In § 1.97(a) the time for filing the prior art statement is extended from the two months of the original proposal to three months. In most cases prior art submitted within three months will be available to the examiner before he takes up the case for action, though it will be helpful if citations are made as promptly as possible.

Section 1.98 lists the elements of the prior art statement: a listing of the art, a concise explanation of the relevance of each listed item, and copies of the art or the pertinent portions thereof.

The prior art statement resembles somewhat the "patentability statement"

⁷ See discussion accompanying proposed rules in FEDERAL REGISTER of October 4, 1976, page 43731, first sentence.

⁸ *Norton v. Curtiss*, 433 F. 2d 779, 792, 167 USPQ 532, 543 (CCPA 1970).

⁶ 426 U.S. at —, 48 L. Ed. 2d at 765, 96 S. Ct. at 2132, 44 U.S.L.W. at 4855.

of the proposal and the "patentability brief" proposed elsewhere.⁹ The name has been changed to reflect a change in the requirements of § 1.98(a). Unlike the proposed version of this paragraph, which called for an explanation of why the claimed invention is believed patentable over the cited art, the paragraph as adopted calls only for a concise explanation of the relevance of each listed item. This may be nothing more than identification of the particular figure or paragraph of the patent or publication which has some relation to the claimed invention. It might be a simple statement pointing to similarities between the item of prior art and the claimed invention. It is permissible but not necessary to discuss differences between the prior art and the claims. It is thought that the explanation of relevance will be essentially as useful to the examiner as the formerly proposed explanation of patentability, and should be significantly less burdensome for the applicant to prepare.

Section 1.98 requires a copy of each patent or publication cited, including U.S. patents, to accompany the prior art statement. Several comments questioned the need for burdening the applicant to supply copies of materials that are present in the Office's files. However, substantial time and effort often is needed to locate a document in the Office's files. Since the person submitting the prior art statement generally has available a copy of the item being cited, it is believed that expense and effort can be minimized by having that person supply the copy in all cases. Consideration has been given to proposals to allow the applicant to submit an order for copies of the patents along with his statement instead of actually submitting copies. This will be further studied, but to date no way has been found to assure that the copies will be available to the examiner by the first action unless the applicant submits them with the prior art statement.

Other changes to §§ 1.97 through 1.99 from the proposal eliminate unnecessary language and clarify the requirements.

A notice published in 1974¹⁰ contained guidelines for the citation of prior art by applicants. Many of those guidelines are repeated or superseded by §§ 1.97 through 1.99. In order to allow applicants, attorneys and agents time to adjust their procedures to comply with the requirements for prior art statements, the effective date of §§ 1.97 through 1.99 will be July 1, 1977. Until these new sections become effective, applicants should continue to follow the 1974 guidelines. Issuance of a revised notice, to take effect July 1, 1977, is under study.

A survey conducted by the Office in 1976 concludes that many applicants have not been citing prior art to the Office.¹¹ It is hoped that with the duty

of disclosure expressly set forth in § 1.50, applicants will perceive that it is to their advantage to use the procedures of §§ 1.97 through 1.99.

Section 1.51 is amended by designating the existing rule as § 1.51(a) and adding new § 1.51(b) which contains a reference to §§ 1.97 through 1.99.

FOREIGN LANGUAGE OATHS

Amended § 1.52 and new § 1.69 are adopted as proposed.

Section 1.69 requires that oaths and declarations be in a language which is understood by the individual making the oath or declaration, i.e., a language which the individual comprehends. If the individual comprehends the English language, he must use it. If the individual cannot comprehend the English language, any oath or declaration must be in a language which the individual can comprehend. If an individual uses a language other than English for an oath or declaration, the oath or declaration must include a statement that the individual understands the content of any documents to which the oath or declaration relates. If the documents are in a language the individual cannot comprehend, the documents may be explained to him so that he is able to understand them.

The Office will provide approved translations for as many of the oath or declaration forms which appear in Part 3 of Title 37 of the Code of Federal Regulations as practicable, and in as many languages as practicable, probably using a side-by-side English/foreign language format. The availability of the foreign language forms will be announced in the Official Gazette at a later date.

The change in § 1.52, providing for an exception to the requirement that oaths and declarations be in the English language, is necessitated by the adoption of § 1.69.

Although very few persons opposed §§ 1.52 and 1.69, several suggested that the philosophy behind the change be extended to the specification, requiring the applicant to be in a language which the applicant understands, accompanied by an English translation. This suggestion was not considered feasible because of the obvious burdens on the applicant and the danger to the applicant and the public if the translation is not literally correct. Also, if a large number of applications were filed in a foreign language, there would be significant administrative burdens on the Office. Attention is directed to the Manual of Patent Examining Procedure, § 608.1, which permits non-English language applications to be filed in certain limited circumstances.

Other suggested modifications of the proposed rule included: (1) using an English language oath or declaration with one additional clause in a language understood by the person making the oath or declaration, the clause stating that the person understands all the documents to which the oath or declaration relates; and (2) extending the two month grace period for filing an English translation of an oath or declaration filed under § 1.65.

After due consideration, suggestion (1) was believed not to accomplish the objectives of the rule as well as the adopted rule. Suggestion (2) would cause unsatisfactory delays in the initial processing of applications.

DECISIONS AND FILES MADE PUBLIC

Section 1.14(d) makes more explicit the conditions under which significant decisions of the Patent and Trademark Office will be made available to the public, and includes reference to decisions of the Board of Patent Interferences, in addition to decisions of the Board of Appeals and the Commissioner.

A large majority of the comments received were favorable. Several commentators felt that more decisions would be made available as a result of the proposed section and that it would assist in publicizing aspects of Office procedure which may not have been available previously.

Some negative comments were based on the view that the Freedom of Information Act¹² required all decisions of the Office to be made publicly available. A greater number of those opposing the proposed section, however, felt that applicants should have an absolute right to have their applications maintained in confidence and that no information should be made public without specific authorization from them. One commentator felt that rulemaking on this subject should be deferred until currently pending litigation¹³ under the Freedom of Information Act was finally resolved.

The section as adopted is applicable to decisions deemed by the Commissioner to involve an interpretation of patent laws or regulations that would be of significant precedent value, where such decisions are contained in either pending or abandoned applications or in interference files not otherwise open to the public. It is applicable whether or not the decision is a final decision of the Patent and Trademark Office.

The parenthetical phrase in the first sentence of the proposed section, which cited other provisions of the rules under which decisions are open to public inspection, is deleted as unnecessary and possibly confusing. Also, in view of several comments received, the period of time during which an applicant or party in interest may object to having a decision made public is extended from one month to two months. At least twenty days is given to request reconsideration and seek court review before a decision is made public over an objection.

Section 1.14(d) is considered to place a duty on the Patent and Trademark Office to identify significant decisions and to take the steps necessary to inform the public of such decisions, by publication of such decisions, in whole or in part. It is anticipated, however, that no more than a few dozen decisions per year will be deemed of sufficient importance to warrant publication under the authority of this section.

¹² 5 USC 552.

¹³ *Irons v. Gottschall*, Slip Opinion, No. 74-1365 (D.C. Cir., October 21, 1976).

⁹ E.g., FEDERAL REGISTER of September 9, 1963, 34 FR 14176, 866 O.G. 1402; S. 2255, 94th Congress, § 131(b).

¹⁰ Notice of August 12, 1974, 926 O.G. 2.

¹¹ BNA's Patent, Trademark and Copyright Journal, No. 301, October 28, 1976, page D-1.

Amended § 1.14(b) allows public inspection of abandoned applications referred to in defensive publications. The comments received on the proposed amendment on this topic in 1974 expressed no opposition and the proposal is adopted without change.

The amendment is intended to encourage use of the defensive publication program provided under § 1.139. The objective of that program is to make available to the public the technical disclosure of applications in which the owner prefers to publish an abstract in lieu of obtaining an examination. Existing §§ 1.11(b) and 1.139 open the complete defensive publication application to inspection by the general public upon publication of the abstract. With the amendment, an abandoned application referred to in a defensive publication application will likewise be open to public inspection, avoiding any need to repeat its contents in the defensive publication application. Thus, public availability of the applications involved should be of benefit both to the applicant and the public.

A suggestion was made that the section be extended still further to include abandoned applications referred to in foreign patents. This suggestion, however, goes too far beyond the proposal that was published and has too uncertain an impact to be adopted at this time.

Amended § 1.11(a) provides earlier access to the file of an interference which involved a patent or an application on which a patent has issued. All comments that were submitted on the 1974 proposal on this topic were favorable and two commentators felt the proposal should be extended further. The proposal is being adopted without change.

Under present practice, access to the file of an interference is not permitted until judicial review of the decision of the Board of Patent Interferences has been exhausted. The amended section allows access to the file after final decision of the Board of Patent Interferences if that decision is an award of priority as to all parties. It is believed that such earlier access will be of benefit to members of the public by making available information relevant to the issuance of the patent whether or not the interference decision is still being adjudicated.

PATENT APPEALS

Section 1.194 clarifies the circumstances in which oral hearings should be requested, provides for oral arguments by or on behalf of examiners in certain appeals, and reduces the time permitted for oral arguments.

Comments relating to this section were favorable by a very substantial majority, although there were several reservations to the effect that § 1.194(a) tended to discourage or downgrade oral arguments. Participation by examiners was considered to be desirable not only from the standpoint of improving the overall presentation of the argument, particularly in complex cases, but also

for the educational and experience benefits to the examiners themselves.

The only opposition to the section was based on the feeling that oral hearings would be discouraged. The rule is intended to discourage oral hearings only to the same extent as the Office's 1975 Official Gazette notice on the subject.¹⁴ Section 1.194(a) indicates that oral hearings should not be requested as a matter of course in every appeal, but only in those circumstances where the appellant feels that such a hearing will be of material assistance to the proper presentation of the appeal. The section expressly provides that equal consideration will be accorded in deciding all appeals, whether or not an oral hearing is held.

In appeals where the appellant has requested an oral hearing, § 1.194(b) provides for oral argument by, or on behalf of, the primary examiner, if such argument is considered to be helpful by either the primary examiner or the Board. This provision incorporates the present practice of permitting examiners to present an oral argument before the Board.¹⁵ It gives the Board additional discretionary authority to request presentation of an oral argument by, or on behalf of, the examiner to ensure that all issues are fully and accurately presented.

Section 1.194(c) provides, as does existing § 1.194, that appeals will be assigned for consideration and decision without an oral hearing where none has been requested by the appellant. Where an oral hearing has been requested, a day of hearing will be set, and both appellant and the primary examiner will be notified. A provision for notice to the examiner is added to the proposed version. Additionally, § 1.194(c) reflects the present practice of limiting oral argument on behalf of the appellant to twenty minutes.¹⁶ The time permitted for argument by the examiner has been shortened from twenty minutes, as proposed, to fifteen minutes. The examiner, unlike the appellant, will not ordinarily need time to present the facts of the case or for rebuttal.

In any appeal where oral argument is to be presented by, or on behalf of, the primary examiner, the appellant will be given due notice of that fact.

Proposed § 1.196(b) would have authorized the Board of Appeals to reject allowed claims, in cases before it, whenever the Board had knowledge of grounds for so doing.

While a majority of those commenting on this section favored in principle the concept of allowing the Board to have this right, significant concern was voiced that there was no statutory authority for the Board to actually reject allowed claims. Further, the question of proper authority for judicial review of such action by the Board was a matter of concern. Other reasons advanced in opposi-

tion to the section were that applicants would be inhibited from appealing by the risk of having allowed claims rejected and that the proposal would create a higher presumption of validity in cases reviewed by the Board. A significant number commented that it would be more appropriate for the Board to remand the case to the primary examiner for consideration of the grounds raised by the Board. This would afford the applicant an opportunity to demonstrate the patentability of the claims and would remove any question as to statutory authority.

In view of the comments received, existing § 1.196(b) will not be modified, but a new § 1.196(d) is added providing express authority for the Board of Appeals to include, in its decision, a statement of any grounds for rejecting any allowed claim that it believes should be considered by the primary examiner. Section 1.196(d) provides that the Board may remand the case to the examiner for such consideration, and that the applicant shall have an opportunity to respond to the grounds set forth by the Board prior to consideration by the examiner. If the previously allowed claims are rejected by the examiner, the rejection may be appealed to the Board.

The new section further provides that a decision of the Board which includes a remand will not be considered as a final decision in the case, but that the Board, following conclusion of the proceedings before the primary examiner, will either adopt its earlier decision as final or will render a new decision based on all appealed claims, as it considers appropriate. In either case, final action by the Board will give rise to the existing alternatives available to an appellant following a decision by the Board.

In situations where the primary examiner concludes after consideration of all the evidence and argument that the remanded claims should be allowed, the new rule dealing with reasons for allowance (§ 1.109) provides an appropriate mechanism for him to explain, on the record, his reasoning for coming to this conclusion, notwithstanding the grounds set forth by the Board in its statement.

Promulgation of new § 1.196(d) does not affect the Board's existing authority to remand a case to the primary examiner without rendering a decision in appropriate circumstances. Section 1.196(d) is not intended as an instruction to the Board to reexamine every allowed claim in every appealed application. It is, rather, intended to give the Board express authority to act when it becomes apparent, during the consideration of rejected claims, that one or more allowed claims may be subject to rejection on either the same or on different grounds from those applied against the rejected claims.

REASONS FOR ALLOWANCE

New § 1.109 is intended to emphasize and formalize the examiner's authority to state his reasoning for allowing a claim or claims. The authority is discretionary with the examiner and is only to

¹⁴ See notice of March 20, 1975, 933 O.G. 1010.

¹⁵ MPEP, § 1209.

¹⁶ See notice of March 20, 1975, 933 O.G. 1010.

be used when the record does not otherwise reveal the reasons for allowance.

A majority of the comments received favored the rule as proposed because it would tend to provide courts and others who were reviewing the patent with a clearer record. Those who opposed the rule most often gave the reason that the examiner might fail to state all the reasons or the strongest reasons why a claim was allowed, which could place unnecessary limitations on the claims or create an estoppel in subsequent litigation or licensing.

To help insure that the examiner's statement of his reasoning in allowing a claim will not unnecessarily limit the claims or create an estoppel, a final sentence is added to the proposal which states that failure of the applicant to comment upon or rebut the examiner's reasoning "shall not give rise to any implication that the applicant agrees with or acquiesces in the reasoning of the examiner."

Several commenters suggested that stricter enforcement of §§ 1.111 and 1.133 would eliminate the need for a new rule concerning reasons for allowance. Situations exist, however, where a statement of reasons for allowance could be helpful, for example when an examiner withdraws a rejection for reasons not suggested by the applicant; when an applicant submits several arguments for allowing a claim and the examiner finds not all of them persuasive; when an examiner allows a claim on the first Office action after citing very close prior art; and when the examiner allows a claim after remand from the Board of Appeals (see new § 1.196(d)).

The first sentence of the proposed rule is changed to define more precisely the circumstances in which an examiner's statement is appropriate, as well as to define more precisely the content of the statement. The statement will include the examiner's "reasoning." The examiner may state his reasoning whenever he "believes that the record of the prosecution as a whole does not make clear his reasons for allowing a claim or claims."

Several persons commented that the rule should provide a procedure for appeal from the examiner's statement of his reasoning. The rule does permit applicants to comment upon the examiner's reasoning. If the applicant does not wish to comment, he may reserve for a later proceeding, without prejudice, any rebuttal.

TEXT OF RULES ADOPTED

After consideration of the comments received and pursuant to the authority contained in § 6 of Title 35 of the United States Code, Part 1 of Title 37 of the Code of Federal Regulations is amended as set forth below.

1. Section 1.11 is revised to read as follows:

§ 1.11 Files open to the public.

(a) After a patent has been issued, the specification, drawings, and all papers relating to the case in the file of

the patent are open to inspection by the general public, and copies may be obtained upon paying the fee therefor. After an award of priority by the Board of Patent Interferences as to all parties, the file of any interference which involved a patent, or an application on which a patent has issued, is similarly open to public inspection and procurement of copies. See § 2.27 for trademark files.

(b) All reissue applications and all applications in which the Office has accepted a request filed under § 1.139, and related papers in the application file, are open to inspection by the general public, and copies may be obtained upon paying the fee therefor. The filing of reissue applications will be announced in the *Official Gazette*. The announcement shall include at least the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and examining group to which the reissue application is assigned.

2. In § 1.14 paragraphs (b) and (d) are revised to read as follows:

§ 1.14 Patent applications preserved in secrecy.

(b) Except as provided in § 1.11(b) abandoned applications are likewise not open to public inspection, except that if an application referred to in a U.S. patent, or in an application which is open to inspection pursuant to § 1.139, is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant. Abandoned applications may be destroyed after 20 years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

(d) Any decision of the Board of Appeals or the Board of Patent Interferences, or any decision of the Commissioner on petition, not otherwise open to public inspection shall be published or made available for public inspection if:

(1) The Commissioner believes the decision involves an interpretation of patent laws or regulations that would be of important precedent value; and (2) the applicant, or any party involved in the interference, does not, within two months after being notified of the intention to make the decision public, object in writing on the ground that the decision discloses a trade secret or other confidential information. If a decision discloses such information, the applicant or party shall identify the deletions in the text of the decision considered necessary to protect the information. If it is considered the entire decision must be withheld from the public to protect such information, the applicant or party must explain why. Applicants or parties will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of decisions are made

public over their objection. See § 2.27 for trademark applications.

3. Section 1.51 is revised to read as follows:

§ 1.51 General requisites of an application.

(a) Applications for patents must be made to the Commissioner of Patents and Trademarks. A complete application comprises:

(1) A specification, including a claim or claims, see §§ 1.71 to 1.77.

(2) An oath or declaration, see §§ 1.65 and 1.68.

(3) Drawings, when necessary, see §§ 1.81 to 1.88.

(4) The prescribed filing fee. (See 35 USC section 41 for filing fees.)

(b) Applicants are encouraged to file a prior art statement at the time of filing the application or within three months thereafter. See §§ 1.97 through 1.99.

4. In § 1.52 paragraph (a) is revised to read as follows:

§ 1.52 Language, paper, writing, margins.

(a) The specification and oath or declaration must be in the English language except as provided in § 1.69. All papers which are to become a part of the permanent records of the Patent and Trademark Office must be legibly written or printed in permanent ink or its equivalent in quality. All of the application papers must be presented in a form having sufficient clarity and contrast between the paper and the writing or printing thereon to permit the production of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes. If the papers are not of the required quality, substitute typewritten or printed papers of suitable quality may be required.

5. Section 1.56 is revised to read as follows:

§ 1.56 Duty of disclosure; striking of applications.

(a) A duty of candor and good faith toward the Patent and Trademark Office rests on the inventor, on each attorney or agent who prepares or prosecutes the application and on every other individual who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application. All such individuals have a duty to disclose to the Office information they are aware of which is material to the examination of the application. Such information is material where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent. The duty is commensurate with the degree of involvement in the preparation or prosecution of the application.

(b) Disclosures pursuant to this section may be made to the Office through an attorney or agent having responsibility for the preparation or prosecution of the application or through an inventor who is acting in his own behalf. Disclosure to such an attorney, agent or

inventor shall satisfy the duty, with respect to the information disclosed, of any other individual. Such an attorney, agent or inventor has no duty to transmit information which is not material to the examination of the application.

(c) Any application may be stricken from the files if: (1) Signed or sworn to in blank, or without actual inspection by the applicant; or

(2) Altered or partly filled in after being signed or sworn to.

(d) An application shall be stricken from the files if it is established by clear and convincing evidence that any fraud was practiced or attempted on the Office in connection with it or that there was any violation of the duty of disclosure through bad faith or gross negligence.

6. In the heading preceding § 1.65 "STATEMENT;" is deleted.

7. In § 1.65 the heading and paragraph (a) are revised to read as follows:

§ 1.65 Oath or declaration.

(a) (1) The applicant, if the inventor, must state that he verily believes himself to be the original and first inventor or discoverer of the process, machine, manufacture, composition of matter, or improvement thereof, for which he solicits a patent; that he does not know and does not believe that the same was ever known or used in the United States before his invention or discovery thereof, and shall state of what country he is a citizen and where he resides and whether he is a sole or joint inventor of the invention claimed in his application. In every original application the applicant must distinctly state that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States more than one year prior to his application or patented or described in any printed publication in any country before his invention or more than one year prior to his application, or patented or made the subject of an inventor's certificate in any foreign country prior to the date of his application on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in this country. He must acknowledge a duty to disclose information he is aware of which is material to the examination of the application. He shall state whether or not any application for patent or inventor's certificate on the same invention has been filed in any foreign country, either by himself, or his legal representatives or assigns. If any such application has been filed, the applicant shall name the country in which the earliest such application was filed, and shall give the day, month, and year of its filing; he shall also identify by country and by day, month, and year of filing, every such foreign application filed more than twelve months before the filing of the application in this country.

(2) This statement (i) must be subscribed to by the applicant, and (ii) must either (a) be sworn to (or affirmed) as provided in § 1.66, or (b) include the personal declaration of the applicant as

prescribed in § 1.68. See § 1.153 for design cases and § 1.162 for plant cases.

* * * * *
8. Section 1.69 is added to read as follows:

§ 1.69 Foreign language oaths and declarations.

(a) Whenever an individual making an oath or declaration cannot understand English, the oath or declaration must be in a language that such individual can understand and shall state that such individual understands the content of any documents to which the oath or declaration relates.

(b) Unless the text of any oath or declaration in a language other than English is a form provided or approved by the Patent and Trademark Office, it must be accompanied by a verified English translation, except that in the case of an oath or declaration filed under § 1.65, the translation may be filed in the Office no later than two months after the filing date.

9. The heading "PRIOR ART STATEMENT" is added following § 1.95 and preceding § 1.97.

10. Section 1.97 is added to read as follows:

§ 1.97 Filing of prior art statement.

(a) As a means of complying with the duty of disclosure set forth in § 1.56, applicants are encouraged to file a prior art statement at the time of filing the application or within three months thereafter. The statement may either be separate from the specification or may be incorporated therein.

(b) The statement shall serve as a representation that the prior art listed therein includes, in the opinion of the person filing it, the closest prior art of which that person is aware; the statement shall not be construed as a representation that a search has been made or that no better art exists.

11. Section 1.98 is added to read as follows:

§ 1.98 Content of prior art statement.

(a) Any statement filed under § 1.97 or § 1.99 shall include: (1) A listing of patents, publications or other information and (2) a concise explanation of the relevance of each listed item. The statement shall be accompanied by a copy of each listed patent or publication or other item of information in written form or of at least the portions thereof considered by the person filing the statement to be pertinent.

(b) When two or more patents or publications considered material are substantially identical, a copy of a representative one may be included in the statement and others merely listed. A translation of the pertinent portions of foreign language patents or publications considered material should be transmitted if an existing translation is readily available to the applicant.

12. Section 1.99 is added to read as follows:

§ 1.99 Updating of prior art statement.

If prior to issuance of a patent an applicant, pursuant to his duty of disclosure under § 1.56, wishes to bring to the attention of the Office additional patents, publications or other information not previously submitted, the additional information should be submitted to the Office with reasonable promptness. It may be included in a supplemental prior art statement or may be incorporated into other communications to be considered by the examiner. Any transmittal of additional information shall be accompanied by explanations of relevance and by copies in accordance with the requirements of § 1.98.

13. Section 1.109 is added to read as follows:

§ 1.109 Reasons for allowance.

If the examiner believes that the record of the prosecution as a whole does not make clear his reasons for allowing a claim or claims, the examiner may set forth such reasoning. This shall be incorporated into an Office action rejecting other claims of the application or be the subject of a separate communication to the applicant. The applicant may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure to file such a statement shall not give rise to any implication that the applicant agrees with or acquiesces in the reasoning of the examiner.

14. In § 1.175 paragraph (a) is revised to read as follows:

§ 1.175 Reissue oath or declaration.

(a) Applicants for reissue, in addition to complying with the requirements of the first sentence of § 1.66, must also file with their applications a statement under oath or declaration as follows:

(1) When the applicant verily believes the original patent to be wholly or partly inoperative or invalid, stating such belief and the reasons why.

(2) When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing," particularly specifying such defects.

(3) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.

(4) When the applicant is aware of prior art or other information relevant to patentability, not previously considered by the Office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid, particularly specifying such prior art or other information and requesting that if the examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent.

(5) Particularly specifying the errors or what might be deemed to be errors relied upon, and how they arose or occurred.

(6) Stating that said errors, if any, arose "without any deceptive intention" on the part of the applicant.

15. Section 1.176 is revised to read as follows:

§ 1.176 Examination of reissue.

An original claim, if re-presented in the reissue application, is subject to re-examination, and the entire application will be examined in the same manner as original applications, subject to the rules relating thereto, excepting that division will not be required. Applications for reissue will be acted on by the examiner in advance of other applications, but not sooner than two months after announcement of the filing of the reissue application has appeared in the Official Gazette.

16. Section 1.194 is revised to read as follows:

§ 1.194 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which the appellant considers such a hearing necessary or desirable for a proper presentation of his appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Appeals as appeals decided after oral hearing.

(b) If appellant requests an oral hearing, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board.

(c) If no request for oral hearing has been made by the appellant, the appeal will be assigned for consideration and decision. If the appellant has requested an oral hearing, a day of hearing will be set, and due notice thereof given to the appellant and to the primary examiner. Hearing will be held as stated in the notice, and oral argument will be limited to twenty minutes for the appellant and fifteen minutes for the primary examiner unless otherwise ordered before the hearing begins.

17. Section 1.196 is amended by adding new paragraph (d) to read as follows:

§ 1.196 Decision by the Board of Appeals.

(d) Although the Board of Appeals normally will confine its decision to a

review of rejections made by the primary examiner, should it have knowledge of any grounds for rejecting any allowed claim that it believes should be considered, it may include in its decision a statement to that effect and remand the case to the primary examiner for consideration thereof. In such event, the Board shall set a period, not less than one month, within which the applicant may submit to the primary examiner an appropriate amendment, or a showing of facts or reasons, or both, in order to avoid the grounds set forth in the statement of the Board of Appeals. If the primary examiner rejects the previously allowed claim or claims on the basis of such statement, the applicant may appeal to the Board of Appeals from the rejection. Whenever a decision of the Board of Appeals includes a remand, that decision shall not be considered as a final decision in the case, but the Board of Appeals shall, upon conclusion of the proceedings before the primary examiner on remand, either adopt its decision as final or render a new decision on all of the claims on appeal, as it may deem appropriate.

18. Section 1.291 is revised to read as follows:

§ 1.291 Protests and prior art citations by public.

(a) Protests against pending applications will be acknowledged and referred to the examiner having charge of the subject matter involved. A protest specifically identifying the application to which the protest is directed will be entered in the application file and, if timely submitted and accompanied by a copy of each prior art document relied upon, will be considered by the examiner.

(b) Citations of prior art and any papers related thereto may be entered in the patent file after a patent has been granted, at the request of a member of the public or the patentee. Such citations and papers will be entered without comment by the Patent and Trademark Office.

(c) Protests and prior art citations by the public and any accompanying papers should either (1) reflect that a copy of the same has been served upon the applicant or patentee or upon his attorney or agent of record; or (2) be filed with

the Office in duplicate in the event service is not possible.

19. In § 1.292 paragraph (b) is revised to read as follows:

§ 1.292 Public use proceedings.

(b) The petition and accompanying papers should either (1) reflect that a copy of the same has been served upon the applicant or upon his attorney or agent of record; or (2) be filed with the Office in duplicate in the event service is not possible. The petition and accompanying papers, or a notice that such a petition has been filed, shall be entered in the application file.

20. Section 1.346 is revised to read as follows:

§ 1.346 Signature and certificate of attorney.

Every paper filed by an attorney or agent representing an applicant or party to a proceeding in the Patent and Trademark Office must bear the signature of such attorney or agent, except papers which are required to be signed by the applicant or party in person (such as the application itself and affidavits or declarations required of applicants). The signature of an attorney or agent to a paper filed by him, or the filing or presentation of any paper by him, constitutes a certificate that the paper has been read; that its filing is authorized; that to the best of his knowledge, information, and belief, there is good ground to support it, including any allegations of improper conduct contained therein; and that it is not interposed for delay.

Effective date: These amendments become effective on March 1, 1977, except for §§ 1.51, 1.97, 1.98, and 1.99 which become effective on July 1, 1977, and §§ 1.65 and 1.69 which become effective on January 1, 1978.

Dated: January 18, 1977.

C. MARSHALL DANN,
*Commissioner of Patents
and Trademarks.*

Approved: January 19, 1977.

BETSY ANCKER-JOHNSON,
*Assistant Secretary for
Science and Technology.*

[FR Doc.77-2528 Filed 1-27-77;8:45 am]

608.04(a)

cations, and all additions thereto, must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from or an addition to the original disclosure, cannot be added to the application even though supported by a supplemental oath, and can be shown or claimed only in a separate application.

In establishing a disclosure applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it. Note § 608.01(1).

While amendments to the specification and claims involving new matter are ordinarily entered, such matter is required to be canceled from the descriptive portion of the specification, and the claims affected are rejected.

A "new matter" amendment of the drawing is ordinarily not entered. Neither is an additional or substitute sheet containing "new matter" even though stamped APPROVED by the Draftsman and provisionally entered by the clerk. See § 608.02(h).

The examiner's holding of new matter may be petitionable or appealable, § 608.04(c).

NOTE.—New matter in reissue application, § 1401.07. New matter in substitute specification, § 714.20.

608.04(a) Matter Not in Original Specification, Claims or Drawings [R-23]

Matter not in the original specification, claims or drawings is usually new matter. Depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See *Ex parte Vander Wal et al.*, 1956 C.D. 11; 705 O.G. 5 (physical properties), *Ex parte Fox*, 1960 C.D. 28; 761 O.G. 906 (new formula) and *Ex parte Ayers et al.*, 108 USPQ 444 (new use). For rejection of claim involving new matter see § 706.03(o).

NOTE.—Completeness of disclosure, § 608.01(p); Trademarks and trade names, § 608.01(v).

608.04(b) New Matter by Preliminary Amendment [R-23]

An amendment is sometimes filed along with the filing of the application. Such amendment does not enjoy the status as part of the original disclosure. Its test as to involving new matter is the same as though filed on a subsequent date. *Ex parte Leishman*, 137 Ms. 336, Pat. No.

1,581,937, and *Ex parte Adams*, Pat. No. 1,789,921.

608.04(c) Review of Examiner's Holding of New Matter [R-52]

Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. Sections 1.181 and 1.191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

609 Prior Art Statement [R-52]

37 CFR 1.97 Filing of prior art statement. (a) As a means of complying with the duty of disclosure set forth in § 1.56, applicants are encouraged to file a prior art statement at the time of filing the application or within three months thereafter. The statement may either be separate from the specification or may be incorporated therein.

(b) The statement shall serve as a representation that the prior art listed therein includes, in the opinion of the person filing it, the closest prior art of which that person is aware; the statement shall not be construed as a representation that a search has been made or that no better art exists (effective July 1, 1977).

37 CFR 1.98 Content of prior art statement. (a) Any statement filed under § 1.97 or § 1.99 shall include: (1) A listing of patents, publications or other information and (2) a concise explanation of the relevance of each listed item. The statement shall be accompanied by a copy of each listed patent or publication or other item of information in written form or of at least the portions thereof considered by the person filing the statement to be pertinent.

(b) When two or more patents or publications considered material are substantially identical, a copy of a representative one may be included in the statement and others merely listed. A translation of the pertinent portions of foreign language patents or publications considered material should be transmitted if an existing translation is readily available to the applicant. (effective July 1, 1977).

37 CFR 1.99 Updating of prior art statement. If prior to issuance of a patent an applicant, pursuant to his duty of disclosure under § 1.56, wishes to bring to the attention of the Office additional patents, publications or other information not previously submitted, the

additional information should be submitted to the Office with reasonable promptness. It may be included in a supplemental prior art statement or may be incorporated into other communications to be considered by the examiner. Any transmittal of additional information shall be accompanied by explanations of relevance and by copies in accordance with the requirements of § 1.98 (effective July 1, 1977).

Although new sections 1.97 through 1.99 are not effective until July 1, 1977, and are not mandatory upon applicants, they provide an ideal mechanism for complying with the duty of disclosure under 37 CFR 1.56. The statements should be submitted in accordance with the following guidelines:

- 1) Prior art statements should be submitted at the time of filing the application or within three months thereafter and may be separate from the specification or incorporated therein. The statement shall serve as a representation that the person preparing it has included therein what he believes to be the closest prior art of which he is aware and shall not be construed as a representation that no better art exists or that a search has been made. If the first action in the application is received prior to three months after filing of the application and no prior art statement has been submitted, the prior art statement may be submitted with the response to the first action and be considered timely.
- 2) The statement shall include a listing of the patents, publications or other information which the preparer of the statement wishes to cite and a concise explanation of the relevance of each listed item. Copies of the pertinent portions of all listed documents shall be supplied along with the statement, both when incorporated into the specification and when filed separately. If two or more patents or publications considered material are substantially identical, a copy of a representative one shall be included with the statement and others may merely be listed with an indication of which are considered to be substantially identical.
- 3) A translation of the pertinent portions of foreign language patents or publications considered material should be transmitted if an existing translation is readily available to the applicant. It will be sufficient, however, to transmit an equivalent English language patent or publication so long as it is identified as an equivalent.

Where the applicant has submitted copies of prior art in accordance with these guidelines in a prior application, reference to the prior application and the submission therein will be sufficient for the continuing application as far as the copies are concerned. As far as the statement per se is concerned, the relevance of the prior art to the claimed subject matter must be indicated if it differs from its relevance as explained in the prior application.

- 4) If prior to the issuance of a patent an applicant, pursuant to his duty of disclosure under 37 CFR 1.56, wishes to bring to the attention of the Office additional patents, publications or other information not previously submitted, the additional information should be submitted to the Office with reasonable promptness. It may be included in a supplemental prior art statement or may be incorporated into other communications to be considered by the examiner. Any transmittal of additional information shall be accompanied by explanations of relevance and by copies in accordance with the requirements aforementioned. The transmittal should include a statement explaining why the prior art was not earlier submitted.

While the Patent and Trademark Office will not knowingly ignore any prior art which might anticipate or suggest the claimed invention, no assurance can be given that cited art or other information not submitted in accordance with these guidelines will be considered by the examiner.

After the claims have been indicated as allowable by the examiner, e.g., by the mailing of an Ex parte Quayle action, a notice of allowability (PTOL-327), an examiner's amendment (PTOL-37), or a Notice of Allowance (PTOL-85), any citations submitted will be placed in the file. Since prosecution has ended, however, such submissions will not ordinarily be considered by the examiner unless the citation is accompanied by:

- (a) A proposed amendment cancelling or further restricting at least one independent claim and narrowing the scope of protection sought;
- (b) A timely affidavit under 37 CFR 1.131 with respect to the material cited; or
- (c) A statement by the applicant or his attorney or agent that, in the judgment of the person making the statement, the prior art or other information cited raises a serious question as to the pat-

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entability of the claimed subject matter, or is closer prior art than that of record.

If the material is submitted after the base issue fee has been paid, it must also be accompanied by a petition under 37 CFR 1.183 requesting a waiver of 37 CFR 1.312. Such petition, if granted, would result in review of the art by the examiner and possible entry of the amendment.

In each instance where an examiner considers, but does not cite on form PTO-892, specific prior art referred to in a paper placed in the application file, the examiner will place a notation adjacent to the reference according to the following:

If included in the specification, the examiner will write his or her initials adjacent to any references checked and enter "checked" in the left margin opposite the initials. If presented in a separate paper or in the remarks of an amendment, the examiner's initials and "checked" will be entered adjacent to the citations or wherever possible to indicate clearly those checked.

37 CFR 1.98(a) calls only for a concise explanation of the relevance of each listed item. This may be nothing more than identification of the particular figure or paragraph of the patent or publication which has some relation to the claimed invention. It might be a simple statement pointing to similarities between the item of prior art and the claimed invention. It is permissible but not necessary to discuss differences between the prior art and the claims. It is thought that the explanation of relevance will be essentially as useful to the examiner as the formerly proposed explanation of patentability, and should be significantly less burdensome for the applicant to prepare.

Section 1.98 requires a copy of each patent or publication cited, including U.S. patents, to accompany the prior art statement. Substantial time and effort often is needed to locate a document in the Office's files. Since the person submitting the prior art statement generally has available a copy of the item being cited, it is believed that expense and effort can be minimized by having that person supply the copy in all cases.

Reply: The certification under § 1.97(e) should be made by a person who has knowledge of the facts being certified. The certification can be made by a practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making a reasonable inquiry.

Comment 57. One comment stated that the language of proposed § 1.97(e) would preclude the use of the certification in an application by corporations whose practitioners have over the years reviewed thousands of patents and technical publications, even though they are unaware of the relevance of any one thereof to the application.

Reply: The language of § 1.97(e) is not intended to preclude use of the certification by representatives of corporations. The certification can be based on present, good faith knowledge about when information became known without a search of files being made. The Office, however, does desire to have information considered promptly by applicants as to materiality and to have information submitted to the Office early in the prosecution of an application.

Comment 58. One comment suggested that proposed § 1.97(e) should permit certification only as to information submitted within four months of receipt from a foreign patent office, with all other late-submitted information requiring a fee so as to not open a legal quagmire implicit in the proposed certification requirement.

Reply: The suggestion in the comment is not adopted. The certification set forth in § 1.97(e) is preferable since it provides the avoidance of the payment of a fee by a person who is submitting information promptly to the Office. An applicant has the option under the circumstances described in § 1.97(c), however, to not make the certification and to pay the fee instead if so desired.

Comment 59. One comment suggested that proposed § 1.97(f) be modified to specify that not less than one month will be given if a bona fide attempt is made to comply with § 1.98 but part of the required content is omitted. Another comment suggested that § 1.97(f) should state that the Office will give (rather than may give) additional time for compliance with § 1.98.

Reply: The suggestions in the comments are not adopted. The language of § 1.97(f) parallels present

§ 1.135(c) since the practice and considerations are similar for both rules. The Office intends to provide one month to comply with § 1.98 where a bona fide attempt has been made to do so.

Comment 60. One comment stated that proposed § 1.97(f) should specify that the Office shall inform the applicant if a reference will not be considered due to noncompliance with § 1.98 so as to avoid any argument in litigation that a certain reference was not considered due to clerical noncompliance.

Reply: The Office plans to notify applicants in accordance with §§ 1.97 (f) and (i) is submitted information will not be considered. The examiner will also indicate in the application record what information has been considered. Further details will appear in the Manual of Patent Examining Procedure in due course.

Comment 61. One comment suggested that proposed § 1.97(g) should be modified to state that the filing of an information disclosure statement shall not be construed as a representation that no other material information exists such as is set forth in current § 1.97(b).

Reply: The suggestion in the comment has not been adopted since referring to "no other material information" would imply that the information being submitted was admitted to be material. There is no requirement that information being submitted be material to the application.

Comment 62. One comment suggested that proposed § 1.97(h) be modified to state that information not considered by the Office will be deemed in all respects to have not been submitted by the applicant since this would make a noncompliant submission clearly not a fulfillment of the duty of candor.

Reply: The suggestion in the comment is not adopted. The Office has no need or desire to rule on lack of fulfillment of the duty of candor in such a situation. The rules are drafted such that § 1.56 sets forth what information is material to patentability and §§ 1.97 and 1.98 set forth procedures to assure consideration of information by the Office.

Comment 63. One comment stated the Office has a duty to consider information even if this involves withdrawing an application from issue or publishing a cancellation notice and that proposed § 1.97(h) should be changed to so state. Another comment stated that it would be an abdication of the duty that the Office owes to the public for information in the file to be ignored since issuance of an invalid patent can be used to discourage others in the field. The comment suggested that the Office should leave in doubt

whether the information will be considered or not.

Reply: It is necessary for the Office to balance its need and desire to consider all information relevant to an application with its need for an efficient operation and its capability to consider information at various stages in the prosecution of an application. The Office is setting forth when information will and will not be considered to provide certainty for the public.

Comment 64. One comment requested information on how a United States patent application or other information (§ 1.98(a)(1)(iii)) should be listed on a PTO 1449 form.

Reply: The PTO 1449 has been drafted so as to provide spaces for listing documents which are available to the public and which will be printed on the patent at issuance. Other information should be listed separately from the PTO 1449 form.

Comment 65. One comment stated that § 1.98(a)(2)(i) should not require the submission by applicants of United States patents listed in an information disclosure statement since the Office is better equipped to provide examiners with copies of those documents than inventors and their attorneys. Alternatively, the comment suggested that the Office should establish a procedure whereby an order for the Office to provide the copies of the patents at the usual fee can accompany the information disclosure statement.

Reply: At the present time, when the Automated Patent System has not been fully implemented, the overall cost of the Office obtaining copies of patents and associating them with application files would be greater than for applicants to provide copies with information disclosure statements. Presumably, the applicant would be using a copy of the patent in preparing the statement and could easily make a copy for submission to the Office.

Comment 66. One comment suggested that § 1.98(a)(2)(iii), as proposed, be clarified by substituting "except that no copy of a U.S. patent application need be included" for the proposed phrase "except a U.S. patent application."

Reply: The suggested clarification to the language of the rule has been adopted.

Comment 67. A number of comments objected to the requirement in § 1.98(a)(3) for a concise explanation of the relevance of all items of information being submitted.

Reply: In response to the comments, § 1.98(a)(3) has been modified to require a concise explanation only of patents, publications or other information listed

in an information disclosure statement that are not in the English language. Applicants may, if they wish, provide concise explanations of why English-language information is being submitted and how it is understood to be relevant. Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability.

Comment 68. Five comments stated that the proposed rules should be modified to state that if information is being submitted from a foreign search report, the requirement for a concise explanation in proposed § 1.98(a)(3) may be satisfied by submitting an English-language version of the search report.

Reply: The language of § 1.98(a)(3) has been modified so that no concise explanation is required for information submitted in the English language. The concise explanation requirement for non-English language information may be met by the submission of an English language version of the search report indicating the degree of relevance found by the foreign office. It is not necessary that this detail be included in the rule.

Comment 69. Five comments questioned whether the requirement in proposed § 1.98(a)(3) would be satisfied by a statement that the references were cited in the prosecution of a parent application.

Reply: The requirement in § 1.98(a)(3) for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a parent application. The concise explanation must explain the relevance as presently understood by the person designated in § 1.56(c) most knowledgeable about the content of the information.

Comment 70. One comment suggested that proposed § 1.98(a)(3) should be modified to require a concise explanation of "what is believed to be" the relevance of information listed to avoid the accusation of violation of duty of disclosure merely because more relevant portions of the information are later found. Another comment suggested that the concise explanation should state what is "reasonably understood by the person submitting the statement." Another comment stated that the applicant should be required to explain (1) only what is understood or believed about the item of information at the time the disclosure is made, or (2) why the item is listed.

Reply: The suggestions in the comments have been substantially adopted in modifying the language of § 1.98(a)(3).

Comment 71. One comment stated that proposed § 1.98(b) should not require the date (unless material) and place of publication of journal articles since such information is not given on search reports from foreign patent offices or on journals published by the American Chemical Society, which just give the year. Another comment indicated that sometimes it is not clear where the place of publication is.

Reply: The suggestions in the comments are not adopted. The date of publication is necessary for the Office to be able to determine if the information may be used in a rejection of the claims in an application. The place of publication refers to the name of the journal, magazine or other publication in which the article was published, which should be available in the vast majority of cases.

Comment 72. One comment suggested that § 1.98(c) should not require a translation of a non-English language document to be filed if a translation is within the possession, custody or control of an individual designated in § 1.56(c) because such person may not recall that there is a translation somewhere in the records of the individual, perhaps having been made for another application years earlier.

Reply: The requirement of the rule for a translation to be submitted under limited conditions is not a change in practice. See prior §§ 1.56(j) and 1.97(b). Since the requirement has caused little, if any, problem in the past, the suggestion of the comment is not adopted.

Comment 73. One comment suggested that § 1.98(c) should be revised to make it clear that a reference that is essentially cumulative to another reference need not be listed in an information disclosure statement.

Reply: The concept that cumulative information is not material is set forth in § 1.56(b). Section 1.98 does not deal with what information must be submitted, but provides an exception for cumulative information to the requirement for a copy to be submitted of each item of information listed in an information disclosure statement.

Comment 74. One comment stated that a sentence in the preamble discussion of proposed § 1.98(c) was burdensome because it would require submission of incomplete or inexact translations which may have been made of an item of information. The sentence in question reads:

But if the individual has the ability to translate the non-English language into English and has done so for the purposes of reviewing the information relative to the

claimed invention, the translation would be considered "readily available."

Another comment stated that proposed § 1.98(c) should be modified to require a translation if the non-English language document is to be considered by the examiner since the attorney would want to prepare an accurate translation of particularly relevant references. One comment suggested that § 1.98(c), or the preamble discussion, should make it clear that an English-language translation of a foreign language material reference need not be submitted where an individual merely reads in the reference in its original language and translates it mentally but does not prepare a written translation. Five other comments requested clarification on this point.

Reply: The Office does not intend to require translations unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. Applicants should note, however, that most examiners do not have the ability to understand information which is not in English and that the Office will not routinely translate information submitted in a non-English language. The examiner will consider the information insofar as it is understood on its face, e.g., drawings, chemical formulas, English-language abstracts, but will not have the information translated unless it appears to be necessary to do so. Applicants are required to aid the examiner by complying with the requirements for a concise explanation in § 1.98(a)(3) for information submitted in a non-English language.

Comment 75. One comment stated that § 1.98(d) should be clarified to state that a copy of an item of information listed in an information disclosure statement need not be submitted if the reference was cited by the Office or previously submitted to the Office in connection with a prior application.

Reply: The suggestion in the comment is adopted. The language of § 1.98(d) has been modified to state that a copy of an item of information is not required if it was previously cited by the Office or previously submitted to the Office in a prior application being relied on for an earlier filing date under 35 U.S.C. 120.

Comment 76. One comment suggested that proposed § 1.98(d) should be revised to not require the submission of a copy of the information listed in an information disclosure statement if a copy of the information has previously been submitted to the Office in a prior application, whether or not the earlier

application is being relied upon for an earlier filing date under 35 U.S.C. 120.

Reply: The suggestion in the comment is not adopted. The exception to the requirement for a copy of each item of information to be submitted has been made with regard to prior applications which will normally be available to, and considered by, the examiner. It would not be efficient for the examiner to be required to seek out unrelated application files to obtain a copy of an item of information when a copy could easily be submitted by applicant.

Comment 77. One comment questioned what would be considered "timely" under § 1.291 so that information would be considered by the examiner without payment of a fee, in contrast to proposed § 1.97 which may require a fee.

Reply: Section 1.291 has not been amended to redefine timeliness. The comment seems to imply that the fee requirements of § 1.97 can be avoided through the use of a protest submitting information, but such a course of action might raise questions regarding compliance with the duty of candor and good faith required in dealings with the Office.

Comment 78. One comment stated that the Office should not drop the acknowledgment of a protest having been filed under § 1.291 in a reissue application because the acknowledgment served as an indication that the protest had been received in the examining group from the mail room.

Reply: The suggestion in the comment is not adopted. Any perceived benefit from retaining the acknowledgment is outweighed by the administrative burden it causes. There is no good reason to treat the filing of protests in reissue applications differently from the filing of protests in original applications or from the filing of other papers in the Office.

Comment 79. One comment questioned whether an application could be withdrawn from issue pursuant to proposed § 1.313(b)(5) without admitting unpatentability.

Reply: There is no requirement that unpatentability must be admitted before an application can be withdrawn from issue pursuant to § 1.313(b)(5). The rule provides for applications to be withdrawn from issue and abandoned for consideration of information in a continuing application. This differs from a petition under § 1.313(b)(3) based on unpatentability of one or more claims.

Comment 80. One comment questioned whether, if an application is withdrawn from issue pursuant to proposed § 1.313(b)(5), an information

disclosure statement can be submitted in the continuing application under § 1.97(b) without a certification.

Reply: A continuing application is treated like any other application with regard to the times set forth in § 1.97(b). Thus, for example, an information disclosure statement could be filed without a fee or certification in a continuing application within three months of the filing date of the continuing application.

Comment 81. One comment questioned whether an application withdrawn from issue pursuant to § 1.313(b)(5) could have new art and amendments considered in that application rather than in a continuing application. The comment also questioned the handling of applications withdrawn from issue pursuant to § 1.313(b)(3).

Reply: The language of § 1.313(b)(5) makes it clear that an application withdrawn from issue thereunder is to be abandoned without further prosecution. This differs from an application withdrawn from issue pursuant to § 1.313(b)(3) because applicant had admitted the unpatentability of one or more claims.

Comment 82. One comment questioned whether the continuing application mentioned in proposed § 1.313(b)(5) could be a file wrapper continuing applicants under § 1.62 and how applicants can accomplish the withdrawal from issue under proposed § 1.313(b) late in the prosecution of an application.

Reply: The continuing application mentioned in § 1.313(b)(5) can be a file wrapper continuing application under § 1.62. Even though § 1.62 requires a file wrapper continuing application to be filed before the payment of the issue fee, the Office will consider the filing of a petition to withdraw from issue under § 1.313(b)(5) as sufficient grounds to waive that requirement of § 1.62. Late in the prosecution of an application, the Office has difficulty in matching papers with the application file. Papers requesting that an application be withdrawn from issue after the issue fee is paid should be directed, or preferably hand-carried, to the Office of Petitions in the Office of the Assistant Commissioner for Patents.

Comment 83. Seven comments suggested that § 1.555(a) should not be amended to require the submission of "all information material to patentability" since a reexamination proceeding is limited to consideration of patents and printed publications.

Reply: The suggestion in the comments has been adopted. A paragraph (b), which defines what

information is material to patentability in a reexamination proceeding, has been added to the rule.

Comment 84. One comment suggested that proposed § 1.555(a) should be modified to make clear that there is no duty of disclosure on employees of a corporate patent owner if the employees are not substantively involved in the preparation of the reexamination request of the reexamination proceeding.

Reply: The suggestion in the comment to modify the language in § 1.555(a) has not been adopted. The rule refers to individuals who are substantively involved on behalf of the patent owner in a reexamination proceeding.

Comment 85. Two comments stated that the Office should consider fraud or other inequitable conduct issues in interference proceedings.

Reply: The suggestion in the comments has been adopted. The Office will consider inequitable conduct issues in interference proceedings as announced on November 19, 1991, in the Official Gazette of the Patent and Trademark Office at 1132 Off. Gaz. Pat. Off. 33.

Comment 86. One comment requested more examples with regard to proposed § 10.23(c)(10) of what alteration of combination of alterations in a declaration would be considered material.

Reply: It is not the function of the rules or the rulemaking process to provide a detailed listing of what alterations may be considered to be improper. This consideration will necessarily be made in view of the totality of the circumstances involved. Practitioners would be well advised to avoid filing applications which contain alterations which have not been initialed and dated.

Comment 87. Two comments stated that § 10.23(c)(10) should be amended to prohibit knowingly attempting to mislead the Office in the drafting or prosecution of a patent application. One comment stated that attempted fraud or inequitable conduct would not be prohibited by proposed § 10.23(c)(10) because such conduct would not be a violation of proposed §§ 1.56 and 1.555.

Reply: No amendment is necessary to the language of § 10.23(c)(10). It should be noted that the duty of candor and good faith in dealing with the Office is included in §§ 1.56 and 1.555. This duty includes a prohibition against knowingly attempting to mislead the Office.

Comment 88. Five comments stated that it would be unfair to impose the new disclosure requirements and fees on applications that are pending before

the Office on the effective date of the new rule. Another comment stated that the rules should be immediately effective for all pending applications with some grace period for making the initial disclosure without penalty and without fee.

Reply: The Office will apply the new rules to all applications pending on, or filed on or after, the effective date of the rules. While this implementation may cause some burden on some applicants, other applicants will obtain benefits not otherwise available. This decision will also ease the administrative burden on the Office in implementing the new rules.

Other Considerations

The rule change is in conformity with the requirements of the Regulatory Flexibility Act, 5 U.S.C. 601 *et seq.*, Executive Orders 12291 and 12612, and the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.*

The General Counsel of the Department of Commerce has certified to the Small Business Administration that the rule change will not have a significant adverse economic impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)) because the rules as adopted do not require individuals to submit information that they are not already aware of and are not already under an obligation to provide to the Office. The rules further promote the efficiency of the examination process by encouraging a timely submission of an information disclosure statement and by substantially eliminating rejections based on inequitable conduct, thereby reducing the costs to all patent applicants.

The Patent and Trademark Office has determined that this rule change is not a major rule under Executive Order 12291. The annual effect on the economy will be less than \$100 million. There will be no major increase in costs or prices for consumers, individual industries, Federal, state or geographic regions. There will be no significant adverse effects on competition, employment, investment, productivity or innovation, or on the ability of the United States-based enterprises to compete with foreign-based enterprises in domestic or export markets.

The Patent and Trademark Office has also determined that this rule change has no Federalism implications affecting the relationship between the National Government and the States as outlined in Executive Order 12612.

This rule contains a collection of information requirement subject to the Paperwork Reduction Act, which has

previously been approved by the Office of Management and Budget under Control No. 0651-0011. Each information disclosure statement is estimated to take approximately 30 minutes, including time for reviewing instructions, gathering and maintaining data needed, and completing and reviewing the collection of information. The time estimate has been reduced from that stated in the proposal since the requirement for a concise explanation of the relevance of each item of information cited in an information disclosure statement has been limited to information submitted in a language other than English. Send comments regarding this burden estimate to the Patent and Trademark Office, Office of Management and Organization, and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Washington, DC 20503. (Attention Paper Reduction Project 0651-0011)

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Inventions and patents, Reporting and record keeping requirements, Small businesses.

37 CFR Part 10

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and record keeping requirements.

For the reasons set forth in the preamble, 37 CFR parts 1 and 10 are amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for part 1 continues to read as follows:

Authority: 35 U.S.C. 6, unless otherwise noted.

2. In § 1.17, paragraph (i)(1) is revised and paragraph (p) is added to read as follows:

§ 1.17 Patent application processing fees.

(i)(1) For filing a petition to the Commissioner under a section of this part listed below which refers to this paragraph—\$130.00.

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.53—to accord a filing date.

§ 1.55—for entry of late priority papers.

§ 1.60—to accord a filing date.

§ 1.62—to accord a filing date.

§ 1.97(d)—to consider an information disclosure statement.

§ 1.103—to suspend action in application.

§ 1.177—for divisional reissues to issue separately.

§ 1.312—for amendment after payment of issue fee.

§ 1.313—to withdraw an application from issue.

§ 1.314—to defer issuance of a patent.

§ 1.334—for patent to issue to assignee, assignment recorded late.

§ 1.666(b)—for access to interference settlement agreement.

* * * * *

(p) For submission of an information disclosure statement under § 1.97(c)—\$200.00.

3. Section 1.28, paragraph (d)(2) is revised to read as follows:

§ 1.28 Effect on fees of failure to establish status, or change status, as a small entity.

* * * * *

(d)(1) * * *

(2) Improperly and with intent to deceive

(i) establishing status as a small entity, or

(ii) paying fees as a small entity shall be considered as a fraud practiced or attempted on the Office.

4. Section 1.51, paragraph (b) is revised to read as follows:

§ 1.51 General requisites of an application.

* * * * *

(b) Applicants are encouraged to file an information disclosure statement. See §§ 1.97 and 1.98.

* * * * *

5. Section 1.52, paragraph (c) is revised to read as follows:

§ 1.52 Language, paper, writing, margins.

* * * * *

(c) Any interlineation, erasure, cancellation or other alteration of the application papers filed should be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67(c). After the signing of the oath or declaration referring to the application papers, amendments may be made in the manner provided by §§ 1.121 and 1.123 through 1.125.

* * * * *

6. Section 1.56 is revised to read as follows:

§ 1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application 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 as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
 - (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.
- (b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and
- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
 - (2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
 - (2) Each attorney or agent who prepares or prosecutes the application; and
 - (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.
- (d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

7. Section 1.63, paragraphs (b)(3) and (d) are revised to read as follows:

§ 1.63 Oath or declaration.

* * * * *

(b) * * *

(3) Acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

* * * * *

(d) In any continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, the oath or declaration must also state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

8. Section 1.67 is amended by adding a new paragraph (c) to read as follows:

§ 1.67 Supplemental oath or declaration.

* * * * *

(c) A supplemental oath or declaration meeting the requirements of § 1.63 must also be filed if the application was altered after the oath or declaration was signed or if the oath or declaration was signed:

- (1) In blank;
- (2) Without review thereof by the person making the oath or declaration; or
- (3) Without review of the specification, including the claims, as required by § 1.63(b)(1).

9. Section 1.97 is revised to read as follows:

§ 1.97 Filing of information disclosure statement.

(a) In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement in compliance with § 1.98 should be filed in accordance with this section.

(b) An information disclosure statement shall be considered by the Office if filed:

- (1) Within three months of the filing date of a national application;
- (2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; or
- (3) Before the mailing date of a first Office action on the merits, whichever event occurs last.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, but before the mailing date of either:

- (1) A final action under § 1.113 or
- (2) A notice of allowance under § 1.311,

whichever occurs first, provided the statement is accompanied by either a certification as specified in paragraph (3) of this section or the fee set forth in § 1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed after the mailing date of either:

- (1) A final action under § 1.113 or
- (2) A notice of allowance under § 1.311,

whichever occurs first, but before payment of the issue fee, provided the statement is accompanied by:

- (i) A certification as specified in paragraph (e) of this section,
- (ii) A petition requesting consideration of the information disclosure statement, and

(iii) The petition fee set forth in § 1.17(i)(1).

(e) A certification under this section must state either:

(1) That each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the 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 or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in § 1.56(c) more than three months prior to the filing of the statement.

(f) No extensions of time for filing an information disclosure statement are permitted under § 1.136. 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 given to enable full compliance.

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

(h) 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) Information disclosure statements, filed before the grant of a patent, which do not comply with this section and § 1.98 will be placed in the file, but will not be considered by the Office.

10. Section 1.98 is revised to read as follows:

§ 1.98 Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include:

(1) A list of all patents, publications, or other information submitted for consideration by the Office;

(2) A legible copy of:
 (i) Each U.S. and foreign patent;
 (ii) Each publication or that portion which caused it to be listed; and
 (iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included; and

(3) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent,

publication, or other information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein.

(b) Each U.S. patent listed in an information disclosure statement shall be identified by patentee, patent number and issue date. Each foreign patent or published foreign patent application shall 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. Each publication shall be identified by author (if any), title, relevant pages of the publication, date and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. If a written English-language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in § 1.56(c), a copy of the translation shall accompany the statement.

(d) A copy of any patent, publication or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the Office in a prior application, provided that the prior application is properly identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120.

§ 1.99 [Removed]

11. Section 1.99 is removed and reserved.

12. Section 1.175, paragraph (a)(7), is revised to read as follows:

§ 1.175 Reissue oath or declaration.

(a) * * *
 (7) Acknowledging the duty to disclose to the Office all information known to applicants to be material to patentability as defined in § 1.56.
 * * * * *

§ 1.193 [Amended]

13. Section 1.193(c) is removed and reserved.

14. Section 1.291, paragraphs (a) and (c), are revised to read as follows:

§ 1.291 Protests by the public against pending applications.

(a) Protests by a member of the public against pending applications will be referred to the examiner having charge of the subject matter involved. A protest specifically identifying the application to which the protest is directed will be entered in the application file if:

(1) The protest is timely submitted; and

(2) The protest is either served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.

Protests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues. Protests which do not adequately identify a pending patent application will be disposed of and will not be considered by the Office.
 * * * * *

(c) A member of the public filing a protest in an application under paragraph (a) of this section will not receive any communications from the Office relating to the protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgment by the Office that the protest has been received. The Office may communicate with the applicant regarding any protest and may require the applicant to respond to specific questions raised by the protest. In the absence of a request by the Office, an applicant has no duty to, and need not, respond to a protest. The limited involvement of the member of the public filing a protest pursuant to paragraph (a) of this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered unless such submission raises new issues which could not have been earlier presented.

15. Section 1.313, paragraph (b), is revised to read as follows:

§ 1.313 Withdrawal from issue.

(b) When the issue fee has been paid, the application will not be withdrawn from issue for any reason except:

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims;
- (4) For interference; or
- (5) For abandonment to permit consideration of an information disclosure statement under § 1.97 in a continuing application.

Relatively short computer program listings (10 pages or less) must be submitted on paper and will be printed as part of the patent. If the computer program listing is 11 or more pages in length, it may be submitted on either paper or microfiche, although microfiche is preferred.

Copies of publicly available computer program listings are available from the Patent and Trademark Office on paper and on microfiche at the cost set forth in 37 CFR 1.19(a)(5) and (6).

OTHER INFORMATION

The micrographic standards referred to in 37 CFR 1.96(b)(2) may be obtained from either the National Micrographic Association, 8719 Colesville Road, Silver Spring, Maryland, 20910 or the American National Standards Institute, 1430 Broadway, New York, New York 10018.

The effect of 37 CFR 1.96 is that if a computer program listing (printout) is 11 or more pages long, the applicant may submit such listing in the form of microfiche. Relatively short computer program listings (10 pages or less) must be submitted on paper and will be printed as part of the patent, as in the past. When the computer program listing is 11 or more pages in length, it may be submitted on either paper or microfiche, although microfiche is preferred. A microfiche filed with a patent application will be referred to as a "Microfiche Appendix," and will be identified as such on the front page of the patent, but will not be part of the printed patent. "Microfiche Appendix," denotes the total microfiche, whether only one, or two or more. One microfiche is equivalent to a maximum of either 63 (9x7) or 98 (14x7) frames (pages), or less.

The face of the file jacket will bear a label to denote that a Microfiche Appendix is included in the application. A statement must be included in the specification to the effect that a microfiche appendix is included in the application. The specification entry must appear at the beginning of the specification immediately following any cross reference to related applications, 37 CFR 1.77(c)(2). The patent front page and the Official Gazette entry will both contain information as to the number of microfiche and frames of computer program listings appearing in the microfiche appendix.

When an application containing microfiche is received in the Correspondence and Mail Division, a special pocket will be affixed to the center section of the inside of the file wrapper underneath all papers, and the microfiche inserted therein. The application file will then proceed on its normal course, and when it reaches the Application Branch, a label which sticks up above the file wrapper will be placed at the center section of the face of the wrapper. When the application file reaches the Micrographics Division, the Microfiche Appendix label will be placed on the face of the file wrapper. When the Allowed Files and Assembly Branch of the Office of Publications receives the application file, the person placing the patent number on the face of the file, upon seeing the Microfiche Appendix label, will give the file to the Supervisor who will call Micrographics Division and give the serial number and patent number, and request copies of the micro-

fiche. Micrographics Division personnel will then put the patent number on the microfiche(s), making certain each microfiche is the most recent, and numbering each correctly, e.g., 1 of 1, 1 of 2, etc. Upon completion, two copies will be produced and provided to Allowed and Assembly Branch Files — one for the grant head and one for the file wrapper.

At the time of assembly, the Microfiche Appendix will be placed inside the grant head behind the patent grant for eyeletting, ribboning, and mailing to the patentee/attorney. During the signing of the grant heads by the Attesting Officer, the patent will be checked to assure proper assembly prior to mailing.

609 Information Disclosure Statement [R-14]

37 CFR 1.97 Filing of information disclosure statement.

(a) In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement in compliance with § 1.98 should be filed in accordance with this section.

(b) An information disclosure statement shall be considered by the Office if filed:

- (1) Within three months of the filing date of a national application;
- (2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; or
- (3) Before the mailing date of a first Office action on the merits, whichever event occurs last.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, but before the mailing date of either:

- (1) A final action under § 1.113 or
- (2) A notice of allowance under § 1.311,

whichever occurs first, provided the statement is accompanied by either a certification as specified in paragraph (3) of this section or the fee set forth in § 1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed after the mailing date of either:

- (1) A final action under § 1.113 or
- (2) A notice of allowance under § 1.311,

whichever occurs first, but before payment of the issue fee, provided the statement is accompanied by:

- (i) A certification as specified in paragraph (e) of this section,
- (ii) A petition requesting consideration of the information disclosure statement, and

(iii) The petition fee set forth in § 1.17(i)(1).

(e) A certification under this section must state either:

(1) That each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the 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 or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in § 1.56(c) more than three months prior to the filing of the statement.

(f) No extensions of time for filing an information disclosure statement are permitted under § 1.136. 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 given to enable full compliance.

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

(h) 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) Information disclosure statements, filed before the grant of a patent, which do not comply with this section and § 1.98 will be placed in the file, but will not be considered by the Office.<

[Amended, 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992]

37 CFR 1.98 Content of information disclosure statement.

(a) ****>**Any information disclosure statement filed under § 1.97 shall include:

(1) A list of all patents, publications or other information submitted for consideration by the Office;

(2) A legible copy of :

(i) Each U.S. and foreign patent;

(ii) Each publication or that portion which caused it to be listed;

and

(iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included; and

(3) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein.

(b) Each U.S. patent listed in an information disclosure statement shall be identified by patentee, patent number and issue date. Each foreign patent or published foreign patent application shall 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. Each publication shall be identified by author (if any), title, relevant pages of the publication, date and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. If a written English-language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in § 1.56(c), a copy of the translation shall accompany the statement.

(d) A copy of any patent, publication or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the Office in a prior application, provided that the prior application is properly identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120.<

[Amended, 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992]

****>**Applicants and other individuals substantively involved with the preparation and/or prosecution of a patent application have a duty to submit to the Office information which is material to patentability as defined in 37 CFR 1.56. These individuals also may want the Office to consider information for a variety of other reasons, e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was consid-

ered by the individuals that were substantively involved with the preparation or prosecution of a patent application.

An information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 1.98 provides the procedure available to an applicant to submit information to the Office so that the information will be considered by the examiner assigned to the application. The requirements for the content of a statement have been simplified in the new rules which became effective on March 16, 1992, to encourage individuals associated in a substantive way with the filing and prosecution of a patent application to submit information to the Office so the examiner can determine its relevance to the claimed invention. The procedures for submitting an information disclosure statement under the new rules are designed to encourage individuals to submit information to the Office promptly.

In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement in compliance with 37 CFR 1.98 as to content must be filed in accordance with the procedural requirements of 37 CFR 1.97. The requirements as to content are discussed in A below. The requirements based on the time of filing the statement are discussed in B below. Examiner handling of information disclosure statements is discussed in C below.

The Office has set forth the minimum requirements for information to be considered in 37 CFR 1.97 and 1.98. Once the minimum requirements are met, the examiner has an obligation to consider the information. These rules provide certainty for the public by defining the requirements for submitting information to the Office so that the Office will consider information before a patent is granted. Information submitted to the Office that does not comply with the requirements of 37 CFR 1.97 and 1.98 will not be considered by the Office, but will be placed in the application file.

The filing of an information disclosure statement shall not be construed as a representation that a search has been made. 37 CFR 1.97(g). There is no requirement that an applicant for a patent make a patentability search. Further, 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 37 CFR 1.56(b). 37 CFR 1.97(h). See MPEP § 706.02(b) regarding admissions by applicant.

Multiple information disclosure statements may be filed in a single application, and they will be considered, provided each is in compliance with the appropriate requirements. Use of form PTO-1449, "Information Disclosure Citation," is encouraged as a means to provide the required list of information. See C(2) below.

Information which is cited or submitted to the Office in the parent application of a file wrapper continuing application under 37 CFR 1.62 will be part of the file before the examiner and need not be resubmitted in the continuing application. Likewise, the examiner will consider information cited or submitted to the Office in a parent application when examining a continuing application, and a list of the information need not be submitted in the continuing application unless applicant

desires the information to be printed on the patent.

A. CONTENT

An information disclosure statement must comply with the provisions of 37 CFR 1.98 as to content in order to be considered by the Office. Each information disclosure statement must comply with the applicable provisions of A(1), A(2) and A(3) below.

A(1) Each information disclosure statement must include a list of all patents, publications, or other information submitted for consideration by the Office.

37 CFR 1.98(b) requires that each U.S. patent listed in an information disclosure statement be identified by patentee, patent number, and issue date. Each foreign patent or published foreign patent application 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. Each publication must be identified by author (if any), title, relevant pages of the publication, date (at least month and year) and place of publication. The place of publication refers to the name of the journal, magazine or other publication in which the information being submitted was published.

To comply with this requirement, the list may not be incorporated into the specification but must be submitted in a separate paper. A separate list is required so that it is easy to confirm that applicant intends to submit an information disclosure statement, and because it provides a readily available checklist for the examiner to indicate which identified documents have been considered. A copy of a separate list will also provide a simple means of communication to applicant to indicate the listed documents that have been considered and those listed documents that have not been considered. Use of form PTO-1449, "Information Disclosure Citation," is encouraged. See C(2) below.

A(2) In addition to the list, each information disclosure statement must also include a legible copy of:

- (i) Each U.S. and foreign patent;
- (ii) Each publication or that portion which caused it to be listed; and
- (iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included.

There are exceptions to this general rule that a copy must be provided. First, 37 CFR 1.98(d) states that a copy of any patent, publication or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the Office in a prior application, provided that the prior application is properly identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120. The examiner will consider information cited or

submitted to the Office in a prior application relied on under 35 U.S.C. 120. This exception to the requirement for copies of information does not apply to information which was cited in an international application under the Patent Cooperation Treaty. If the information cited or submitted in the prior application was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application. See A(3) below.

Second, 37 CFR 1.98(c) states that when the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. The examiner will then consider only the patent or publication of which a copy is submitted and will so indicate on the list or form PTO-1449 submitted, e.g., by crossing out the listing of the cumulative information.

37 CFR 1.98(c) further states that if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR 1.56(c), a copy of the translation shall accompany the statement. Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the examiner will consider the information in view of the concise explanation and insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches.

A(3) Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is **not in the English language**. The concise explanation may be either separate from the specification or incorporated therein.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a translation of the information into English is submitted with the foreign language information, no concise explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. There is no requirement for the translation to be verified. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a

concise explanation of relevance can be satisfied by submitting an English language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y" or "A" indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a parent, related, or copending United States application.

The concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims.

Applicants may, if they wish, provide a concise explanation of why English-language information is being submitted and how it is understood to be relevant. Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability.

B. TIME FOR FILING

The procedure and requirements for submitting an information disclosure statement are linked to four stages in the processing of a patent application: (1) within three months of filing, or before first Office action, whichever is later; (2) after the period in (1), but before final Office action or a Notice of Allowance, whichever is earlier; (3) after the period in (2) but on or before the date the issue fee is paid; and (4) after the period in (3) and up to the time the patent application can be effectively withdrawn from issue. The procedures and requirements apply to applications filed under 35 U.S.C. 111 (utility), 161 (plants), 171 (designs), and 251 (reissue), as well as international applications entering the national stage under 35 U.S.C. 371.

The requirements based on the time when the information disclosure statement is filed are summarized as follows.

<u>Time when IDS is filed</u>	<u>37 CFR 1.97 Requirements</u>
(1) Within 3 months of filing or before first Office action on the merits, whichever is later.	None (always considered).
(2) After (1) but before final action or notice of allowance.	Certification or 1.17(p) fee.
(3) After final action or notice of allowance and before payment of issue fee.	Certification, petition, and petition fee.

B (1) Statement filed **BEFORE** first action on the merits or within three (3) months of actual filing date (37 CFR 1.97(b)).

An information disclosure statement will be considered by the examiner if filed:

- (i) within three months of the filing date of a national application;
- (ii) within three months of the date of entry of the national stage as set forth in 37 CFR 1.491 in an international application; or
- (iii) before the mailing date of a first Office action on the merits,

whichever event occurs last. A statement filed within this period requires neither a fee nor a certification of prompt filing.

The term "national application" includes continuing applications (continuations, divisions, continuations-in-part) so three-months will be measured from the actual filing date of an application as opposed to the effective filing date of a continuing application.

All information disclosure statements that comply with the content requirements of 37 CFR 1.98 and are filed within three months of the filing date will be considered by the examiner, regardless of whatever else has occurred in the examination process up to that point in time. Thus, in the rare instance that a final Office action or a notice of allowance is prepared and mailed prior to a date which is three months from the filing date, any information contained in a complete information disclosure statement filed within that three-month window will be considered by the examiner.

Likewise, an information disclosure statement will be considered if it is filed later than three months after the filing date but before the mailing date of a first Office action on the merits. An action on the merits means an action which treats the patentability of the claims in an application, as opposed to only formal or procedural requirements. An action on the merits would, for example, contain a rejection or indication of allowability of a claim or claims rather than just a restriction requirement (37 CFR 1.142) or just a requirement for additional fees to have a claim considered (37 CFR 1.16(d)). Thus, if an application was filed on January 1 and the first Office action on the merits was not mailed until six months later on July 1, the examiner would be required to consider any proper information disclosure statement filed prior to July 1.

An information disclosure statement will be considered to have been filed on the day it was received in the Office, or on an earlier date of mailing if accompanied by a properly executed certificate of mailing under 37 CFR 1.8, or Express Mail certificate under 37 CFR 1.10. An Office action is mailed on the date indicated in the Office action.

B (2) Statement filed after B(1), but **BEFORE** mailing of final action or notice of allowance (37 CFR 1.97(c)).

An information disclosure statement will be considered by the examiner if filed after the period specified in B(1) above, but before (not on the same day as) the mailing date of either

a final action under 37 CFR 1.113 e.g., final rejection or notice of allowability, or
a notice of allowance under 37 CFR 1.311,

whichever occurs first, provided: (1) the statement is accompanied by either a certification as specified in 37 CFR 1.97(e) or (2) the fee set forth in 37 CFR 1.17(p). If a final action or notice of allowance is mailed in an application and later withdrawn, the application will be considered as not having had a final action or notice of allowance mailed for purposes of considering an information disclosure statement.

(i) If information submitted during the period set forth in 37 CFR 1.97(c) with a certification is used in a new ground of rejection on unamended claims, the next Office action will not be made final since in this situation it is clear that applicant has submitted the information to the Office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office. The information submitted with a certification can be used in a new ground of rejection and the next Office action made final, however, if the new ground of rejection was necessitated by amendment of the application by applicant. Where the information is submitted during this period with a fee, the examiner may use the information submitted, e.g., printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 706.07(a). If a new ground of rejection is introduced that is neither necessitated by an amendment to the claims nor based on the information submitted with the fee set forth in 37 CFR 1.17(p), the Office action shall not be made final.

(ii) A certification under 37 CFR 1.97(e) must state either

(a) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or

(b) 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 or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in 37 CFR 1.56(c), more than three months prior to the filing of the statement.

A certification can contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a communication, such as a search report, from a patent office outside the U.S. in a counterpart foreign application not more than three months prior to the filing date of the statement. Under this certification, it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report. The date on the communication by the foreign patent office begins the three-month period in the same manner as the mailing of an Office action starts a three-month shortened

statutory period for response. If the communication contains two dates, the mailing date of the communication is the one which begins the three month period. The date which begins the three-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner. Likewise, the statement will be considered to have been filed on the date the statement was received in the Office, or on an earlier date of mailing if accompanied by a properly executed certificate of mailing under 37 CFR 1.8, or Express Mail certificate under 37 CFR 1.10.

The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application).

In the alternative, a certification can be made if 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, neither was it known to any individual having a duty to disclose more than three months prior to the filing of the statement.

The phrase "after making reasonable inquiry" makes it clear that the individual making the certification has a duty to make reasonable inquiry regarding the facts that are being certified. The certification can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a certification under 37 CFR 1.97(e)(2) to the Office until a satisfactory response is received. The certification can be based on present, good faith knowledge about when information became known without a search of files being made.

Certification need not be in the form of an oath or a declaration under 37 CFR 1.68. Certification by a registered practitioner or any other individual that the statement was filed within the three-month period of either first citation by a foreign patent office or first discovery of the information will be accepted as dispositive of compliance with this provision in the absence of evidence to the contrary. For example, a certification could read as follows:

"I hereby certify that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more

than three months prior to the filing of this statement.", or

"I hereby certify that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of this Information Disclosure Statement."

An information disclosure statement may include two lists and two certifications, similar to the above examples, in situations where some of the information listed was cited in a communication from a foreign patent office not more than three months prior to filing the statement and some was not, but was not known more than three months prior to filing the statement.

A copy of the foreign search report need not be submitted with the certification, but an individual may wish to submit an English-language version of the search report to satisfy the requirement for a concise explanation where non-English language information is cited. The time at which information "was known to any individual designated in 37 CFR 1.56(c)" is the time when the information was discovered in association with the application even if awareness of the materiality came later. The Office wishes to encourage prompt evaluation of the relevance of information and to have a date certain for determining if a certification can properly be made. A statement on information and belief would not be sufficient. Examiners should not remind or otherwise make any comment about an individual's duty of candor and good faith, but questions about the adequacy of any certification received in writing by the Office should be directed to the Office of the Assistant Commissioner for Patents.

B(3) Statement filed after B(2), but Prior to Payment of Issue Fee (37 CFR 1.97(d)).

An information disclosure statement will be considered by the examiner if filed on or after the mailing date of either a final action under 37 CFR 1.113 or a notice of allowance under 37 CFR 1.311, whichever occurs first, but before or simultaneous with payment of the issue fee, provided the statement is accompanied by:

- (i) a certification as specified in 37 CFR 1.97(e) (see the discussion in B(2)(ii) above),
- (ii) a petition requesting consideration of the information disclosure statement, and
- (iii) the petition fee set forth in 37 CFR 1.17(i)(1).

These requirements are appropriate in view of the late stage of prosecution when the information is being submitted, i.e., after the examiner has reached a final determination on the patentability of the claims presented for examination. The petition should be directed to the Group Director of the exam-

ining group handling the application. The petition need do nothing more than request consideration of the information being submitted. Payment of the petition fee (37 CFR 1.17(i)(1)) and submission of the appropriate certification (37 CFR 1.97(e)) are the essential elements for having information considered at this advanced stage of prosecution, assuming the content requirements of 37 CFR 1.98 are satisfied.

The requirements of 37 CFR 1.97 provide for consideration by the Office of information which is submitted within a reasonable time, i.e., within 3 months after an individual designated in 37 CFR 1.56(c) becomes aware of the information or within 3 months of the information being cited in a communication from a foreign patent office in a counterpart foreign application. This undertaking by the Office to consider information would be available throughout the pendency of the application until the point where the patent issue fee was paid. If an applicant chose not to comply, or could not comply, with the requirements of 37 CFR 1.97(d), a continuing application could be filed to have the information considered by the examiner. The parent application could be permitted to become abandoned by not paying the issue fee required in the Notice of Allowance, for example, or by the filing of a file wrapper continuing application under 37 CFR 1.62. It would not be proper to make final a first Office action in the continuing application if the information submitted is used in a new ground of rejection.

B(4) Statement filed after Payment of Issue Fee.

After the issue fee has been paid on an application, it is impractical for the Office to attempt to consider newly submitted information. Information disclosure statements filed after payment of the issue fee in an application will not be considered but will merely be placed in the application file. See C below. The application may be withdrawn from issue at this point, however, pursuant to 37 CFR 1.313(b)(5) so that the information can be considered in a continuing application. In this situation, a file wrapper continuing application under 37 CFR 1.62 could be filed even though the issue fee had already been paid. The Office will consider the filing of a petition under 37 CFR 1.313(b)(5) as sufficient grounds to waive the requirement that an application under 37 CFR 1.62 be filed before payment of the issue fee. Alternatively, for example, a petition pursuant to 37 CFR 1.313(b)(3) could be filed if applicant states that one or more claims are unpatentable. This statement that one or more claims are unpatentable over the information must be unequivocal. A statement that a serious question as to patentability of a claim has been raised, for example, would not be acceptable to withdraw an application from issue under 37 CFR 1.313(b)(3).

If an application has been withdrawn from issue under one of the provisions of 37 CFR 1.313(b)(1)-(4), it will be treated as though no notice of allowance had been mailed and the issue fee had not yet been paid with regard to the time for filing information disclosure statements. Petitions under 37 CFR 1.313(b) should be directed to the Office of Petitions in the Office of the Assistant Commissioner for Patents.