§ 1.98 Content of information disclosure statement.

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

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

(i) The application number of the application in which the information disclosure statement is being submitted;

(ii) A column that provides a space, next to each document to be considered, for the examiner’s initials; and

(iii) A heading that clearly indicates that the list is an information disclosure statement.

(2) A legible copy of:

(i) Each foreign patent;

(ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;

(iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

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

(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 applicant’s specification or incorporated therein.

(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

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

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(c) 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 as specified in paragraph (a) of this section may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

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

(1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and
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§ 1.102

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

§ 1.99 [Reserved]

EXAMINATION OF APPLICATIONS


§ 1.101 [Reserved]

§ 1.102 Advancement of examination.

(a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Director to expedite the business of the Office, or upon filing of a request under paragraph (b) or (e) of this section or upon filing a petition or request under paragraph (c) or (d) of this section with a showing which, in the opinion of the Director, will justify so advancing it.

(b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination.

(c) A petition to make an application special may be filed without a fee if the basis for the petition is:

(1) The applicant’s age or health; or

(2) That the invention will materially:

(i) Enhance the quality of the environment;

(ii) Contribute to the development or conservation of energy resources; or

(iii) Contribute to countering terrorism.

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the fee set forth in § 1.17(h).

(e) A request for prioritized examination under this paragraph must comply with the requirements of this paragraph and be accompanied by the prioritized examination fee set forth in § 1.17(c), the processing fee set forth in § 1.17(i), and if not already paid, the publication fee set forth in § 1.18(d). An application for which prioritized examination has been requested may not contain or be amended to contain more than four independent claims, more than thirty total claims, or any multiple dependent claim. Prioritized examination under this paragraph will not be accorded to international applications that have not entered the national stage under 35 U.S.C. 371, design applications, reissue applications, provisional applications, or reexamination proceedings. A request for prioritized examination must also comply with the requirements of paragraph (e)(1) or paragraph (e)(2) of this section.

(1) A request for prioritized examination may be filed with an original utility or plant nonprovisional application under 35 U.S.C. 111(a). The application must include a specification as prescribed by 35 U.S.C. 112 including at least one claim, a drawing when necessary, and the inventor’s oath or declaration on filing, except that the filing of an inventor’s oath or declaration may be postponed in accordance with § 1.53(f)(3) if an application data sheet meeting the conditions specified in § 1.53(f)(3)(i) is present upon filing. If the application is a utility application, it must be filed via the Office’s electronic filing system and include the filing fee under § 1.16(a), search fee under § 1.16(k), and examination fee under § 1.16(o) upon filing. If the application is a plant application, it must include the filing fee under § 1.16(c), search fee under § 1.16(m), and examination fee under § 1.16(q) upon filing. The request for prioritized examination in compliance with this paragraph must be present upon filing of the application, except that the applicant may file an amendment to cancel any independent claims in excess of four, any total claims in excess of thirty, and any multiple dependent claim not later than one month from a first decision on the request for prioritized examination. This one-month time period is not extendable.

(2) A request for prioritized examination may be filed with or after a request for continued examination in compliance with § 1.114. If the application is a utility application, the request must be filed via the Office’s