



## Memorandum

Date: March 1, 2004

To: Technology Center Directors  
Patent Examining Corps

From: /s/  
Stephen G. Kunin  
Deputy Commissioner for Patent Examination Policy

Subject: Examiner treatment of electronic Information Disclosure Statements (e-IDS)

This memorandum sets forth guidance for examiners' treatment of electronic Information Disclosure Statements (e-IDS) and the procedures to follow in considering the information cited in an e-IDS.

As of May 2002, applicants can file an e-IDS using the Electronic Filing System (EFS). An e-IDS contains an electronic list of U.S. patent and U.S. patent application publication numbers. No copies of these documents are required to be submitted by applicants with an e-IDS. An individual e-IDS may contain a listing of up to 50 U.S. patents and 50 U.S. patent application publications. Other than U.S. patents and U.S. patent application publications, no other references may be cited in an e-IDS filing. Foreign patents and foreign patent application publications<sup>1</sup>, and non-patent literature (NPL) cannot be filed using e-IDS and must be filed in a traditional manner using a paper or facsimile filed IDS. The requirements of 37 C.F.R. 1.97 and 1.98, including the submission of a legible copy of the NPL and foreign patent documents, must be complied with in order for the IDS to be considered by the Office.

To file a complete e-IDS containing more than 50 U.S. patents and/or U.S. patent application publications, applicants are permitted to file more than one e-IDS. Similarly, applicants may file a portion of an IDS using e-IDS and with another portion using traditional paper or facsimile filing procedures for references that cannot be submitted using e-IDS (e.g., non-patent literature).

As stated in the notice published in the *Official Gazette* on September 17, 2002 at 1262 OG 94, if more than one e-IDS is necessary and/or it is necessary to file the e-IDS with a traditional paper or facsimile filed IDS for which a fee is required under 37 C.F.R. 1.17(p), only a single fee under 37 CFR 1.17(p) will be required under the following conditions:

- (1) the fee required by 37 CFR 1.17(p) is included with the first e-IDS submission;
- (2) all subsequent submissions making up the IDS should explicitly state that the fee was included in the earlier submission and request that the one fee be accepted for the second and any subsequent submission; and

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<sup>1</sup> Foreign patent application publications include published PCT applications.

(3) all subsequent submissions (electronic or paper) must be received by the Office on the same date as the first e-IDS submission with which the fee was included.

A subsequent paper or facsimile filed IDS submission is considered received by the Office on the same date as the first e-IDS submission with which the fee was included for purposes of the fee due under 37 CFR 1.17(p) if it is deposited in Express Mail under 37 CFR 1.10, deposited in first class U.S. mail with a certificate of mailing in accordance with 37 CFR 1.8, or transmitted by facsimile with a certificate of transmission in accordance with 37 CFR 1.8, on the same date as the first e-IDS submission with which the fee was included. If a subsequent e-IDS submission is received by the Office on a date later than the date the fee was paid, the later submission will require an additional fee.

### **HOW e-IDS IS ENTERED INTO IFW OR PAPER APPLICATION FILE**

A copy of the e-IDS form will be printed and placed in paper application files, similar to the forms SB008A and PTO-1449. **The e-IDS form has the title “Electronic Information Disclosure Statement” at the top which will distinguish it from a paper or facsimile IDS.** The e-IDS form will be printed and scanned to become part of the IFW for IFW applications. In all applications, the e-IDS will be added to the application file contents listing, and to the EXPO database record for the application. The IFW Table of Contents (TOC) only has a single code “IDS” code for an e-IDS, or a paper or facsimile filed IDS. Hence, an e-IDS cannot be identified in the IFW TOC except by reviewing the document unless an annotation describing the IDS as an e-IDS is added to the TOC.

### **EXAMINER CONSIDERATION OF e-IDS**

Examiners must consider the e-IDS for compliance with the timeliness requirements of 37 C.F.R. 1.97, and if timely, consider the e-IDS citations as set forth in MPEP § 609. Examiners may notice numbering gaps in the "Citation No." column on the printed e-IDS form due to an applicant data entry error. This data entry error will not affect the e-IDS and is not a sufficient reason to not consider the e-IDS.

**Consideration of the e-IDS may not be deferred and an e-IDS should not be treated as incomplete because an applicant did not submit paper copies of e-IDS references.**

An electronic list of all U.S. patents and U.S. patent application publications on an e-IDS form is available and accessible from the examiner’s workstation by clicking on the e-IDS icon,



on the workstation desktop.

Examiners should copy and paste U.S. patent and U.S. patent application publication numbers from the e-IDS to EAST and/or WEST, to review the references that are listed in the e-IDS.

Alternatively, for paper application files, the e-IDS (reference listing) form in the paper application file has bar codes for each cited reference that correspond to the patent numbers and patent application publication numbers which may be wanded using the Examiner's bar code reader.

For IFW applications, examiners must print out a copy of the e-IDS form in the IFW. The Examiner then completes the copy of the e-IDS form by initialing, signing, and dating the e-IDS form entries. The examiner completed copy of the e-IDS form should accompany the examiner's action (when it is turned in) to be mailed. It will then be scanned with the outgoing examiner's action to make it of record in the IFW.

For paper application file wrapper applications, the examiner should have a copy made of the original examiner completed e-IDS form. The original examiner completed e-IDS form should be retained in the paper application file wrapper. The copy of the examiner completed e-IDS form should accompany the examiner's action (when it is turned in) to be mailed to applicant.

### **ELECTRONIC SIGNATURE PERMITTED IN AN e-IDS**

The Office's EFS system, starting with version 5.1 released on April 14, 2003, permits applicants and registered practitioners to sign portions of an EFS submission with an electronic signature. The electronic signature is any typed combination of alphanumeric characters. The electronic signature does not have to be between forward slashes. The electronic signature may be on EFS transmittal letters, declarations, powers of attorney, fee sheets, and later filed biosequence listings. The pen and ink and copy requirements for signatures in 37 C.F.R. 1.4 are waived by notice in the *Official Gazette* on October 8, 2002 at 1263 OG 60. Accordingly, an e-IDS should not be denied consideration solely because it has an alphanumeric electronic signature if filed on or after April 14, 2003.

### **REPLACEMENT COPIES OF AN e-IDS MAY BE REQUESTED**

If the transmittal letter, fee authorization and listing of references form is not of record in an IFW or paper application file, examiners should have the technical support staff obtain a new copy of the e-IDS papers from the Customer Service Office of OIPE.

### **CONTACT INFORMATION**

For assistance using an e-IDS electronic tool, examiners should contact any available Information Technology Resource Providers (ITRP). Questions concerning policy issues on handling an e-IDS should be directed to Michael Lewis of the Office of Patent Legal Administration at 703-306-5585.