

## **Waiver of the Copy Requirement in 37 CFR 1.98 for Cited Pending U.S. Patent Applications**

37 CFR 1.98 requires that for each cited pending U.S. patent application, an information disclosure statement (IDS) include a legible copy of 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. See 37 CFR 1.98(a)(2)(iii).

The United States Patent and Trademark Office (USPTO) has been scanning newly filed patent applications and the existing inventory of patent applications into USPTO's Image File Wrapper (IFW) system since June of 2003. See Notification of United States Patent and Trademark Office Patent Application Records being Stored and Processed in Electronic Form, 1271 Off. Gaz. Pat. Office 100 (June 17, 2003). Applications stored in the IFW system may be viewed by examiners on their desktop computers. Consequently, there is no longer a need to require a copy of the specification, including claims, and drawings of a U.S. patent application (or portion of the application) listed on an IDS when the cited application is stored in the USPTO's IFW system, and can be readily viewed by examiners, applicants and members of the public.

Therefore, the requirement in 37 CFR 1.98(a)(2)(iii) for a legible copy of the specification, including the claims, and drawings of each cited pending U.S. patent application (or portion of the application which caused it to be listed) is *sua sponte* waived where the cited pending application is stored in the USPTO's IFW system. See 37 CFR 1.183. This waiver is effective immediately.

Applications filed under 35 U.S.C. § 111 on or after June 30, 2003, and international applications that have entered the national stage on or after June 30, 2003, have been or are being scanned into the USPTO's IFW system. When citing to a pending application filed under 35 U.S.C. § 111 before June 30, 2003, or that entered the national stage before June 30, 2003, the applicant may check the private Patent Application Information Retrieval (PAIR) System to see whether the application is stored in the USPTO's IFW system in order to determine if a copy of the application (or portion of the application) is required to be provided with an IDS. The private PAIR System can be accessed over the Office's Internet Web site ([www.uspto.gov](http://www.uspto.gov)).

When citing to a pending U.S. patent application that has been published under 35 U.S.C. § 122(b) (eighteen-month publication), the USPTO prefers that the citation be to the patent application publication (by publication number) rather than to the application itself (by application number).

This waiver is limited to the specification, including the claims, and drawings in the U.S. application (or portion of the application). If material other than the specification, including the claims, and drawings in the file of a U.S. patent application is being cited in an IDS, the IDS must contain a legible copy of such material. See 37 CFR 1.98(a)(1)(iv).

Inquiries concerning this notice may be directed to Jeanne M. Clark, Senior Legal Advisor,  
Office of Patent Legal Administration, at (703) 306-5603.

*/s/*  
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