

migration to electronic storage of documents, especially for voluminous documents, the Office proposes amending § 1.19 to reflect that the Office may, at its option, provide copies of documents where the copy is in electronic form on compact disc. Requests for voluminous documents can be economically provided in an expedited time frame without degrading service to other users if copies are furnished on compact disc. Requests for documents in other forms that would impair service to other users would be decided on a case-by-case basis as provided in new § 1.19(h).

Section 1.19(b) is proposed to be amended in view of the current migration of Office records from paper file wrappers to their electronic image equivalent with the image file wrapper (IFW) system as the repository of official Office records. See *USPTO Announces Prototype of Image Processing*, 1265 *Off. Gaz. Pat. Office* 87 (Dec. 17, 2002), and *See Changes To Implement Electronic Maintenance of Official Patent Application Records*, 68 FR 38611 (June 30, 2003). The instant proposed rule change clarifies how copies of IFW contents are to be charged, as the current rule would otherwise not provide a way for the public to obtain copies given the absence of a paper file wrapper for the Office to copy when IFW replaces the paper file wrapper as the source of copies.

Sections 1.19(b)(1) and (2) are proposed to be amended to reflect the change to IFW from paper file wrappers. Currently when documents are submitted to the Office in paper or on compact disc, copies of a file wrapper and documents contained therein may be made from the original paper or compact disc submission. If a scanned image is used to make copies of an application as originally filed, the scanned image corresponds to a paper file wrapper. In the future, there will be no paper file wrapper corresponding to scanned image files in the IFW System. As the Office uploads its records to the IFW system, the instant proposed change will permit the Office to supply to the public copies of Office documents directly from the IFW system regardless of format and media of the initial submission (e.g., paper, electronic, or compact disc). After uploading into IFW, the original submission may not be retained or be in an easily retrievable form for copying.

The existing §§ 1.19(b)(1) and (2) do not provide for supplying copies of the non-paper portion of a file wrapper (e.g., compact discs). Under the current practice, for example, copies of compact discs associated with a file wrapper

must be ordered under existing § 1.19(b)(3) and are not provided with an order under existing §§ 1.19(b)(1) or 1.19(b)(2). Nothing in these proposed rule changes will change this practice. Similarly, any materials not in the IFW portion of a file wrapper (e.g., blueprints, microfiche, and video cassettes) are not included in these current sections or as proposed to be amended. To the extent, however, that documents may be uploaded from compact discs to be part of an IFW, those documents will be included with the IFW copy. In the event the Office cannot fill an order solely from the IFW, and must complete an order in part by copying paper files or compact discs, the fees of § 1.19(b)(2)(i) for pages over 400 will apply to any copies made from paper files, except those provided for under § 1.19(g) (e.g., blueprints), in which case the fee of § 1.19(g) will apply, and the fee for compact disc copies under § 1.19(b)(3) will apply to the copies of compact discs.

Patent applications and patents will normally reference any compact discs that are a part of the application specification. The public should therefore review the specification to determine if an order for compact discs should be included with an order to obtain the contents of an application or file wrapper. Other materials associated with a file wrapper (e.g., blueprints, video cassettes, compact discs exhibits not part of the specification) are not referenced in the specification of an application or patent. The Office does not maintain an index of other materials associated with any specific file wrapper.

Accordingly, the public should carefully review the contents of a file wrapper to determine if other materials associated with a file wrapper need to be separately ordered.

Customers will not be able to select the source for documents under §§ 1.19(b)(1) and (2) for filling an order.

The Office's experience with providing copies from an image system is that it is faster than providing copies from paper and it allows the Office to provide copies for regular orders with the same speed as expedited service. The service is also cheaper for the public so that excess page fees can be eliminated in most cases. The Office is considering charging a single fee for copies made from the IFW to recover an average cost and limiting the additional fee of § 1.19(b)(2)(ii) to paper copy non-IFW documents rather than actual cost depending on size, if public comment is favorable. The Office believes public comment should be favorable because it will result in lower overall costs to the

public and faster service. Lowered costs to the public and the Office occur because there will not need to be separate analysis and billing of the number of pages and excess pages copied. Faster service will occur because the Office will not have to delay orders while additional charges for excess pages are processed. Also, since the Office can provide the copies within a short period of time which would be faster than a seven-day service, at the same fee, it is proposed to remove the references to the slower non-expedited service, i.e., "seven-day."

Section 1.19(b)(3) is proposed to be amended by revising "on compact disc" to "in electronic form on a physical media" so that documents submitted on electronic forms other than compact discs may be made available on compact disc for the same fee as documents submitted on compact disc.

Section 1.19(g) is proposed to be added to provide for copying material that is not image scanned. Materials such as large blueprints, microfiche, and video cassettes cannot be scanned as electronic image equivalents, and an average cost for pricing cannot be computed in advance, because the demand for such copies is so infrequent. The Office proposes to charge the actual cost of copying of these materials.

Section 1.19(h) is proposed to provide for a mechanism for requesting copies of documents in a form other than that normally provided by the Office. The copies would be provided at cost. For example, a copy of an application so voluminous that it required many boxes of compact discs might be requested under this part on some other media such as DVD media instead of compact discs. Petitions would be decided under this section based upon the ability of the Office to provide the requested service and the adverse impact to the Office and the public from diverting resources to fulfilling the order.

*Section 1.27:* Section 1.27 is proposed to be amended to make certain clarifying changes. The proposed changes would clarify that: (1) A security interest held by a large entity would not be a sufficient interest to bar entitlement to small entity status; (2) the requirements for small business concerns regarding transfer of rights and the size standards of the Small Business Administration are additive; and (3) business concerns are not precluded from claiming small entity status merely because they are located in or operate primarily in a foreign country.

Section 1.27 is proposed to be amended to revise paragraphs (a)(1), (a)(2)(i), and (a)(3)(i) to change "obligation" to "currently enforceable