



[3510-16-P]

**DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

[Docket No. PTO-P-2011-0032]

**Establishment of a One-Year Retention Period for Patent-Related Papers That Have Been Scanned Into the Image File Wrapper System or the Supplemental Complex Repository for Examiners**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Notice.

**SUMMARY:** The United States Patent and Trademark Office (USPTO) published a notice on August 29, 2011 requesting comments on a proposal to establish a retention period of one year for patent-related papers that have been scanned into the Image File Wrapper system (IFW) or the Supplemental Complex Repository for Examiners (SCORE). The USPTO has considered the comment and is establishing a one-year retention period that: (1) began on September 1, 2011, for papers scanned into IFW or SCORE prior to September 1, 2011; or (2) began or begins on a paper's submission date, for papers scanned into IFW or SCORE on or after September 1, 2011. After the

expiration of the one-year retention period (after September 1, 2012, or later), the USPTO will dispose of the paper unless, within sufficient time prior to disposal of the paper, the relevant patent applicant, patent owner, or reexamination party files a bona fide request to correct the electronic record of the paper in IFW or SCORE, and the request remains outstanding at the time disposal of the paper would have otherwise occurred. The one-year retention period for papers scanned into IFW or SCORE replaces the USPTO's past practice of indefinitely retaining the papers, which has been rendered unnecessary and not cost-effective by improvements in scanning and indexing.

**DATES:** Effective Date: [Insert date of publication in the Federal Register].

Applicability Date: For papers scanned into IFW or SCORE prior to September 1, 2011, the one-year retention period began on September 1, 2011. For papers scanned into IFW or SCORE on or after September 1, 2011, the one-year retention period began or begins on the paper's submission date.

**ADDRESSES:** Comments concerning this notice may be sent by electronic mail message over the Internet addressed to IFWPaperRetention@uspto.gov, or submitted by mail addressed to: Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450. Although comments may be submitted by mail, the USPTO prefers to receive comments via the Internet.

The comments will be available for public inspection at the Office of the Commissioner for Patents, located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria,

Virginia, and will be available via the USPTO Internet Web site (address: <http://www.uspto.gov>). Because comments will be available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

**FOR FURTHER INFORMATION CONTACT:** Raul Tamayo, Legal Advisor, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy, by telephone at (571) 272-7728, or by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Raul Tamayo.

**SUPPLEMENTARY INFORMATION:** In August 2011, the USPTO published a notice requesting comments from the public on a proposal to establish a retention period of one year for patent-related papers that have been scanned into IFW or SCORE. See Establishing a One-Year Retention Period for Patent-Related Papers That Have Been Scanned Into the Image File Wrapper System or the Supplemental Complex Repository for Examiners, 76 FR 53667 (August 29, 2011), 1370 Off. Gaz. Pat. Office 211 (September 17, 2011). The August 2011 notice explained the USPTO's past practice of indefinitely retaining papers that have been scanned into IFW or SCORE. The August 2011 notice set forth in detail the USPTO's reasons for wanting to establish a one-year retention period for patent-related papers that have been scanned into IFW or SCORE, including how improvements in scanning and indexing have rendered the practice of indefinite paper retention unnecessary and not cost-effective.

The USPTO received one comment in response to the August 2011 notice. Specifically, the comment urged the USPTO to extend the retention period beyond one year. The comment expressed concern that the USPTO's system of scanning documents originally filed in paper may introduce a subtle error that may not become apparent until more than a year after filing. The comment noted that resolution of the error could require referring to the application papers as originally filed to prove that the papers were filed without the error.

The USPTO appreciates the comment and has considered it. However, as stated in the August 2011 notice, the number of issues that arise which actually require the USPTO to reference application papers as originally filed has steadily declined in the years since the USPTO started scanning, in part due to continued improvements in indexing techniques and scanning quality, to the point that continued indefinite retention of papers is not cost-effective. Furthermore, the August 2011 notice sets forth a procedure for resolving disputes concerning the content of papers as filed versus the content of papers as scanned, including any such disputes which arise beyond one year, i.e., after the USPTO has likely disposed of the relevant originally filed papers under the one-year retention period.

Therefore, the USPTO is establishing a one-year retention period for papers that have been scanned into IFW or SCORE. Specifically, the USPTO is establishing a one-year retention period that: (1) began on September 1, 2011, for papers scanned into IFW or SCORE prior to September 1, 2011; or (2) began or begins on the paper's submission

date, for papers scanned into IFW or SCORE on or after September 1, 2011. The one-year retention period is consistent with the USPTO's new USPTO-specific records disposition authority N1-241-10-1, item 4.4, which was approved by the National Archives and Records Administration (NARA) on October 27, 2011, and is available at [http://www.archives.gov/records-mgmt/rcs/schedules/departments/department-of-commerce/rg-0241/n1-241-10-001\\_sf115.pdf](http://www.archives.gov/records-mgmt/rcs/schedules/departments/department-of-commerce/rg-0241/n1-241-10-001_sf115.pdf). Papers that have not been scanned into IFW or SCORE, such as certain papers placed into Artifact Folders, are not subject to the one-year retention period and remain retrievable consistent with past practice. The procedures from the August 2011 notice for the USPTO to dispose of the paper, and to resolve disputes concerning the content of papers as filed versus the content of papers as scanned, are reiterated below.

After the expiration of the one-year retention period (after September 1, 2012, or later), the USPTO will dispose of the paper, unless within sufficient time prior to disposal of the paper, the relevant patent applicant, patent owner, or reexamination party files a bona fide request to correct the electronic record of the paper in IFW or SCORE, and the request remains outstanding at the time the paper would have been scheduled for disposal. Filers of requests to correct the electronic record are strongly advised to file their requests by EFS-Web using the document description "Electronic Record Correction" at least one month prior to the expiration of the one-year retention period to allow sufficient time to process the request. Requests that are not filed at least one month prior to the expiration of the one-year retention period may not be acted upon in time.

During the one-year retention period, a patent applicant, patent owner, or reexamination party who is considering filing a request to correct the electronic record of a paper, and who believes that the evidence establishes that the need for correction was caused by the USPTO, is advised to consider whether the initial submission date of the paper needs to be secured for the information being corrected. Such situations could involve (1) adding information that would not otherwise be supported by the original specification, (2) avoiding a reduction in patent term adjustment, or (3) avoiding an impact on the timeliness of an information disclosure statement under 37 CFR 1.97. If the initial submission date of the paper does not need to be secured for the information being corrected, the patent applicant, patent owner, or reexamination party should simply submit a corrective replacement document and accept the date of such submission for the corrective replacement document. If, however, the initial submission date of the paper needs to be secured for the information being corrected, a request for correction based on the initially submitted paper should be filed as a petition under 37 CFR 1.181. The request should specifically point out the error(s) in the electronic record of the paper in IFW or SCORE and be accompanied by a replacement copy of the paper, along with (1) any evidence to establish (a) that the need for correction was caused by the USPTO, and (b) the proper submission date of the original paper, and (2) a statement that the replacement copy is a true copy of what was originally filed.

When making a decision on the request, the USPTO's presumption will be that the electronic record of the paper in IFW or SCORE is accurate and correction is not merited. The USPTO will check to see whether it has the paper at issue. If the USPTO has the

paper, the USPTO's version of the paper will either support the request for correction, in which case the request will be granted, or the USPTO's version of the paper will not support the request, in which case the request will be dismissed.

On the other hand, if the USPTO does not have the paper, e.g., the paper has been lost, the presumption that the electronic record of the paper in IFW or SCORE is correct can be rebutted where the evidence submitted with the request is sufficient to overcome the presumption. A postcard receipt which itemizes and properly identifies the items that have been filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. However, while a postcard receipt may be the only evidence needed for the USPTO to accept, for example, the missing tenth page of a 10-page document that has been properly identified on the postcard as a 10-page document, the postcard receipt may be insufficient, on its own, for the USPTO to accept a replacement tenth page of a properly identified 10-page document, where all 10 pages were actually received by the USPTO and, for example, a sentence is missing on one page or a chemical structure is thought to have been changed.

Any decision dismissing a request to correct the electronic record will provide a two-month period to file a request for reconsideration of the decision, in accordance with 37 CFR 1.181(f).

The USPTO will not dispose of a paper for which, within sufficient time prior to disposal of the paper, a bona fide request to correct the electronic record of the paper has been

filed and remains outstanding at the time the paper would have been scheduled for disposal. A request is a bona fide request when it specifically points out the error(s) in the paper and is accompanied by any necessary evidence. A general allegation that a paper requires correction filed without evidentiary support is not a bona fide request. It would be inadequate to stay the disposal of the paper and would be dismissed. Once filed, a bona fide request to correct the electronic record remains outstanding unless the USPTO has either (1) issued a decision granting either the original request or a request for reconsideration of the original request, or (2) issued a final agency decision denying a request for reconsideration of the original request.

A patent applicant, patent owner, or reexamination party who is considering filing a request to correct the electronic record of a paper, but who cannot establish that the need for correction was caused by the USPTO, is advised to not file the request. Other options for relief may be available when it cannot be established that the need for correction was caused by the USPTO. For example, an amendment under 37 CFR 1.57(a) may be filed to address the problem of an application filed with inadvertently omitted material when the application contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application. See MPEP § 201.17. As another example, an amendment may be filed to correct an obvious error, along with any evidence, such as an expert declaration, necessary to establish that one of ordinary skill in the art would recognize both the existence of the error and the appropriate correction. See MPEP § 2163.07, II.

A patent applicant, patent owner, or reexamination party may file a request to correct the electronic record of a paper after the one-year retention period, if the evidence is believed to establish that the need for correction was caused by the USPTO, and the initial submission date of the paper needs to be secured for the information being corrected. The USPTO likely will have disposed of any paper for which a request to correct the electronic record is filed after the one-year retention period. Therefore, the typical request for correction filed after the one-year retention period will have to overcome the presumption that the electronic record of the paper in IFW or SCORE is accurate and correction is not merited. For certain instances, e.g., when a paper was inadvertently not scanned into SCORE or placed into an Artifact Folder, there will be a black and white image of the paper in IFW that can be used to corroborate any submitted evidence.

The procedure set forth in this notice for filing a request to correct the electronic record of a paper that has been scanned into IFW or SCORE is not a replacement for the USPTO's established procedure for responding to a notice (e.g., a "Notice of Omitted Item(s) in a Nonprovisional Application") from the Office of Patent Application Processing (OPAP) indicating that the application papers have been accorded a filing date, but are lacking some page(s) of the specification or some of the figures of drawings described in the specification. Applicants should continue to follow the procedure set forth at Change in Procedure for Handling Nonprovisional Applications Having Omitted Items, 1315 Off. Gaz. Pat. Office 103 (February 20, 2007), when responding to such a notice from OPAP.

In addition, the procedure set forth in this notice for filing a request to correct the electronic record of a paper that has been scanned into IFW or SCORE is generally applicable only to situations in which a certain document, or one or more pages of a certain document, contains an error caused by the USPTO that requires correction. The procedure set forth in this notice is not a replacement for the USPTO's file reconstruction procedures (37 CFR 1.251 and MPEP § 508.04). Paper sources for the image files in IFW are boxed in the order that they are scanned, rather than by application number or reexamination control number, such that a request to correct requiring the retrieval of papers from multiple boxes cannot be reasonably effected.

Date: January 17, 2012

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

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