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September 23, 2001

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Washington D.C. 20231

Attn: Ronald Hack, Acting Chief Information Officer

Re: Request for Comments on Development of a Plan to Remove the Patent and Trademark Classified Paper Files from the Public Search Facilities

Dear Mr. Hack:

I am writing as a member of the intellectual property community in response to your recent request for comments. In my three plus years at the Office of Technology Licensing (OTL) at the University of Washington (UW), I have regularly interacted directly and indirectly with the USPTO. My interaction has largely involved patent applications, and interference and opposition proceedings. My opinions expressed in this letter are not necessarily those of OTL or UW.

I favor the premise of your plan to remove the paper records and make the information available electronically. This plan is consistent with the American Inventors Protection Act and with the overwhelming shift to electronic access of the relevant records. These physical documents are only accessible in a very small area of the country, making access realistically available only to those U.S. residents and global residents with the monetary capacity to do so. I personally have been very pleased with the great leaps in electronic access on your website, which I have used over the past few years.

However, I felt two key pieces of statistical information were missing from your request for comments. To really understand the scope of what must remain physically, publicly available until it is available electronically, we need to know 1. how many records are referenced in subsequent patent applications, and 2. how often the non-electronically available records were physically accessed in the past few years.

Access to these not yet electronically available records is essential for patent examiners, attorneys, search firms, and individuals. If they are going to successfully research whether there is prior art, this older information must be available. I do not believe that these older, less accessed records should necessarily be made electronically available. The decisive information on what cut off date should be implemented would, in my opinion, come from a study of the frequency of information accessed. A cut off date will

need to be chosen that reflects the best balance of amount accessed, efficiency, and the monetary expense, and which meets the NARA guidelines of maintaining records that have been referenced in other patent applications.

The main tension that I see is that between disposing of the physical records and maintaining the integrity of the electronic records. It is my understanding that 35 U.S.C. § 4745, does not allow relief of the Director's responsibilities in any assignment or delegation of his functions. Maintenance of records received or generated by the USPTO, a federal agency, is one of those functions. However, the National Archives and Records Administration (NARA) allows for disposal of records kept by federal agencies under 44 U.S. § 3302 and 36 C.F.R. § 12. Therefore, the USPTO cannot transfer any record to any other entity, including federal government, without first going through the NARA prescribed disposal steps. The most relevant requirement is that any record that is named in any patent application must be photographed or mimeographed before it can be disposed of.

It is my interpretation that once the NARA prescribed requirements are met, that the records can be disposed of and the Director's responsibility for the records pertains solely to the electronic versions. Therefore, in the interest of maintaining the integrity of the electronic documents, I believe that only the electronic documents available from the USPTO website should be allowed to be admitted as evidence or documentation in any patent prosecution or proceeding. Once the physical documents are transferred to any other entity, the Director releases control over those documents. If the USPTO wants to maintain some level of control over those physical documents, perhaps it could consider a licensing arrangement with the chosen entity that would provide for integrity-ensuring measures.

As for the disposition of the records, the most preferable choice would be an arrangement with a research university in the D.C. area. This would keep the records close to where the patent prosecution and adjudication occurs, and would favorably draw individuals to the university. Any payment for this sale, of course, has to be turned over to the Treasury, as required by 44 U.S. § 3313. A second option would be to take advantage of the Record Center Revolving Fund and make the not yet electronically available records available under a fee-for-service program (Public Law 106-58).

Obviously, all records must remain physically available until electronically available, as prescribed by NARA. Otherwise, a person without access to this information is unable to conduct a prior art search or prepare for an interference proceeding, opening him or herself up to charges of malpractice by the client and frivolous patent prosecution under Rule 103 .

I hope that you find my comments useful and will give them consideration in the formulation of your plan. I would be happy to provide any further information or clarification, and can be reached via e-mail at n_brewster@hotmail.com.

Best regards,

Natalie R. Brewster