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VIA FAX (703) 308-7792

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: Comments on Development of a Plan
To Remove the Patent and Trademark
Classified Paper Files from the
Public Search Facilities

Dear Sir:

Notaro & Michalos P.C. is an intellectual property law firm composed of five registered patent attorneys who operate at offices in New York City and in Orangeburg, New York.

It has been our policy to conduct patent searches for patentability, right to use, validity, state of the art and other purposes utilizing the paper patent collections at the public search room of the Patent and Trademark Office. We also utilize databases of the Office as well as Internet resources and proprietary databases in connection with various searches.

Our respective offices are equipped with broadband capability (cable and DSL), and we operate on a Windows 2000 platform with dual servers with 1.8 gigabyte capacity and most of our individual PCs have a 933 MHz operating speed.

We wish to express concerns that we have regarding the proposed elimination of patent paper collections equipment.

Although we regularly utilize existing U.S. Patent and Trademark Office databases, we find that it is very time consuming to access a patent, take it to an image screen and review and/or print each imaged page. It is not unusual, in our experience, to find that the Patent and Trademark Office web site is not available, or to find that our cable or DSL provider is down, or to have a problem with our computer system. Anyone of these events impedes our ability to search or otherwise use the Patent and Trademark Office database.

In our experience, computer searching of patents, even at the Patent Search Room, is much slower and, in many respects, less accurate, than paper searching.

The ability to quickly scan the entire history of a certain useful development, from the earliest to the most current patents, cannot be reproduced or simulated by any known computer search technique. Often, many class/subclass combinations must be searched to conduct a proper novelty search. A validity or right-to-use search usually requires access to an even greater number of subclasses. Subclasses which physically follow or are before the specific subclasses of interest in the "stacks" also often yield prior art of interest and an entire new avenue of search which had not occurred to the "searcher" before. These and many other techniques of searching are not available from any known computer search system.

Boolean searching is very limited to the use of key words and the like. Often the drawings more quickly reveal the relevance of a patent. In certain arts, such as the chemical arts, word searching is very efficient. In others, no unique words are available. A valve, for example, may be called a gate, or a stop cock, or be described in a hundred different ways by a hundred different patent attorneys, all correctly. One drawing unifies the meaning of what has been shown, however, in a way that any number of words cannot.

Aside from the clear limitations of all known computer searching techniques, there is also the fact that no U.S. patents earlier than those issued in 1976 can be "word searched" and no foreign papers would be available.

The examiner's search rooms which have some foreign and non-patent references at the end of most subclasses, and which have been available to the public upon request, will have to become restricted (if they too are not also closed) since all experienced searches will try for access if the public stacks are eliminated.

The following points correspond to the Issues Section of the Federal Register Notice:

- II A. Will the USPTO invest in disaster recovery/backup location services to minimize downtime/loss of electronic records?

There are often several terminals which are "locked" by program errors – how will these occurrences be minimized?

- II B. In our opinion, there is no comparable functionality available at present for search electronic records versus paper records. There is a fundamental difference between reading paper and reading a computer screen in that you cannot just flip to a page with the electronic screen—you have to select a particular page and wait for it to be generated. Even with new, fast computers and connections, viewing screen after screen of patent images is simply not as fast or efficient as scanning through paper pages. Although the computer screens in the PSR are large, it is still difficult to get a 100% size image of each patent, making reading difficult or requiring zooming in, which is more time consuming than putting paper closer to your nose. Screen presentations of printed pages can be difficult to read as well due to issues with screen resolution. There can be a significant time delay between displays of images. Generally, reading a computer screen image of a patent is more stressful on the eyes compared to reading printed paper patents.

While a conventional search by reviewing each patent in a particular class and subclass can be supplemented by using keyword searches to find relevant patents, there is no substitute for physically reviewing each patent due to differences in terminology between patentees and the fact that patents prior to about 1976 are not available in full text search. Thus, replacing the paper search files with electronic searches does not increase the accuracy of searches beyond where it is now.

Finally, our searchers have found the two available systems, EAST & WEST, to be very annoying to use. It is difficult to navigate and often easier to start over than to try and backtrack to a previous search result.

- II C. Obviously, electronic records can be reclassified in a fraction of the time needed to do the same with paper records and from the same desk, rather than physically moving anything—PTO saving effort on their part is all that is going on here.
- II D. Options D1 and D2 would be preferable to D3 and D4, so that the records are still available for free to the public—keeps the spirit of the open

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disclosure of inventions, as opposed to the only copies being available by purchase and inspection only possible via electronic means or for pay for access.

We thank you for your consideration of the foregoing.

Respectfully submitted,

NOTARO & MICHALOS P.C.


Angelo Notaro
For the Firm