

AIPLA

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

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October 9, 2001

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

Attn: Ronald Hack, Acting Chief Information Officer

Re: AIPLA Response to the USPTO's "Notice of Request for Comments
on Development of a Plan to Remove the Patent and Trademark
Classified Paper Files From the Public Search Facilities"
66 Fed. Reg. 45012 (August 27, 2001)

Dear Acting Under Secretary Godici:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to present its views on the Notice of Request for Comments on Development of a Plan To Remove the Patent and Trademark Classified Paper Files From the Public Search Facilities, *Federal Register*, August 27, 2001, pages 45012-45014.

The AIPLA is a national bar association of more than 13,000 members engaged in private and corporate practice, in government service, and in the academic community. The AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

The AIPLA understands the burden on the USPTO of maintaining both electronic and paper collections of United States patents. We recognize that the USPTO must ultimately transfer or dispose of its paper collection. The AIPLA also recognizes that the EAST and WEST electronic search systems are a vast improvement over the former APS system. Our principal concern, however, is that we do not believe that the USPTO has adequately informed the public about the merits of the electronic collection and the increasingly limited ability of the paper collection. In order to obtain wide public acceptance of this proposal, the plan which the USPTO is required to submit to the Senate and House Committees on the Judiciary must address a number of public perceptions concerning the relative merits of the electronic and paper collections.

The USPTO's plan must address the perception held by some members of the public that the electronic collections are in some ways inferior to the paper collections. For example, there is a belief that certain classes/subclasses are still unavailable electronically, that the down time of the system is excessive, that there are insufficient terminals, and that there are no foreign patents available electronically. The Office should establish that its electronic collections are in fact complete and fully searchable with little or no down time. The comparative integrity of its electronic and paper collections should be publicized. The USPTO should also explain its plan for maintaining an adequate number of terminals and the options available for searching the foreign art.

The USPTO's plan must address the perception held by some members of the public that the functionality of the electronic search tools may be inferior to searching by hand. A large part of the public does not know that the Office has provided numerous search terminals with 21-inch monitors, that drawing figures can be rotated and enlarged, that patent text can be enlarged or that patents can still be searched by class/subclass just like the paper collection is searched. Some still believe that a fee is charged for searching the electronic files. Thus, the Office must do a better job of publicizing the capabilities of its electronic search facilities.

The USPTO's plan should contain a commitment to provide adequate training of the public in the use of the electronic search facilities, both to train new users and assist infrequent users. The USPTO's plan should also explain what backup systems will be employed in the event of a catastrophic failure.

We believe that the USPTO's plan should set forth the steps it proposes to take to upgrade the electronic searching facilities to include the full-text of U.S. patents prior to 1971. The plan should also provide some reassurance to the public of its commitment to continue to provide for class and subclass searching capability, a functionality which is critical for effectively searching in certain technologies.

There are those who make a living conducting searches, but who will never feel comfortable using the electronic collections. AIPLA does not know how large this group is at this time. However, before the USPTO transfers or discards its paper collections, the Office should make reasonable efforts to ensure that the users of the paper collections are generally satisfied with the performance of the electronic search facilities. We agree that reasonable efforts should be made to transfer the paper collection to an entity that would maintain it before discarding the collection, but the failure to find a third-party to assume maintenance of the paper collection should not prevent final disposition.

In summary, the USPTO's plan should inform the public about the capabilities of the electronic search collections and the electronic search tools, address the training of the public in the use of the electronic search facilities, and explain its plans to enhance and improve the electronic searching capabilities.

Sincerely yours,



Michael K. Kirk
Executive Director