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NIPRA
National Intellectual Property Researchers Association
2101 Crystal Plaza Arcade
PMB 104
Arlington, Virginia 22202

October 26, 2001

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, DC 20231

Attention: Ronald Hack, Acting Chief Information Officer

Re: Docket No. 010126025-1025-01: Notice of 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:

Thank you for the opportunity to respond to the notice announcing plans to remove the Classified paper files from the Patent and Trademark libraries. The National Intellectual Property Researchers Association (NIPRA), a non-profit organization, represents the more than 150 professional researchers, including Patent Attorneys and Agents, engineers and scientists, who are daily, heavy users of the Public Search facilities of the USPTO. Our members represent, and conduct research for, thousands of companies, inventors, and law firms in the US and abroad, all of whom are the USPTO's customers. The views in this letter are those of the organization and its members. Legal issues, including OMB (Circular A-130) requirements, among others, are beyond the scope of this letter, and will be addressed in letters from individual members of NIPRA.

Although some other responding organizations may be considerably larger than NIPRA, our members are the only full-time users of the USPTO's Public Search facilities. The requirements of our members for a complete and organized collection of Patents and Trademarks exceed even that of USPTO Examiners: the burden of finding *all* relevant references is considered by clients to be a check on the Examiners' search. Indeed, most of our efforts are directed to finding better art than that found by the Examiner. Such thoroughness is demanded by our clients to protect them from the high costs of litigation, and results in a higher standard of patent and trademark quality at no cost to the USPTO.

Accordingly, NIPRA wishes to voice its strongest objection to any plans to dismantle, or even downgrade, either the Patent or Trademark Classified Paper Libraries. Both

collections, having evolved over a great many years, represent both the creative output of 200 years of invention, as well as the thoughtful deliberation by PTO examiners in classifying each into a system that is unique in all of technical literature. The Patent Library and the Trademark Library are working collections, heavily used by thousands of Examiners and Public Searchers daily.

The decision to remove the Libraries while the computer system, known as EAST / WEST, X-Search, and TESS, has yet to prove itself as a replacement, is premature to say the least: problems with the systems are experienced on an almost daily basis, sometimes lasting for many hours. Nonetheless, many users have observed an intentional disintegration in care of the paper files of both the Patent and Trademark Libraries that has amounted to a form of sabotage of the paper files: as the files become more disorganized, and as parts of the collections are purged (e.g. foreign patents and literature on the Patent side, and the Classified Drawing Collection in Trademarks), researchers are *forced* to become reliant on the computer systems. But the public is not being told by the USPTO that both the Patent and Trademark computer databases are flawed and incomplete; the public requires 100% integrity of the files they use.

Knowledgeable examiners and searchers alike attest to the attraction of computer searching: the increased speed in locating *some* results, even if not complete or the best; and the ease of sitting in one place to locate results, as opposed to seeking out paper files. The EAST/WEST system offers a shortcut to locating *some* patents, but routinely fails to provide thorough results equal to those of the traditional paper search. Examiners, public searchers, and attorneys alike are aware of the differences:

1. The use of EAST/WEST for searching patents has caused a migration from concept searching to word searching, and the results are totally dependent on the ability (or luck) of the searcher to match his choice of terms with those chosen by the writers of the patents he seeks. This disparity has been recognized for years by professionals in database technology: in databases such as NIH's Medline, journal articles and studies are indexed by experts to avoid the mismatch in terms-sought and terms-written. The lack of any form of indexing in the Patent database increases the gulf between Classification based searching and text searching to the point that there is often little similarity in results between a search conducted in the Classified paper files and the same search conducted using text.
2. Computer searching does not lend itself to locating chemical structural formulae or their equivalents.

3. Patents located during a computer text search often, after careful study, fail to be substantial enough to stand as references, as their basis for a "hit" came from a term found in, for example, listed background material in a patent.
4. The resolution of monitors employed at workstations is too low to enable the study of text and drawings needed to conduct a typical in-depth patent search. As a result, user fatigue sets in long before a difficult search can be completed. Users report abandoning a search before completion, and often printing large numbers of patents to more conveniently read in print form.

The Classified Libraries offer a number of advantages:

1. Paper files offer a cross-check for computer search results in both Patent and Trademark matters. Some computer search results are flawed to the extent that, especially in Trademark searches, the results cannot be relied on until duplicated in the paper files.
2. Paper patents are the basis for the Classification System. The fear of most serious searchers and examiners is that, with the loss of paper, Classification will be neglected and then disappear. Already, some subclasses have grown to over 4000 patents, and according to the Commissioner's recent House testimony, the use of text searching makes further breakdown of large subclasses unnecessary.
3. Location of the Libraries in the immediate vicinity of workstations and examining groups facilitate efficient location of needed material, and allow collaboration among users.
4. Finally, the Classified Libraries are by far the cheapest and most reliable system for searching patents and trademarks, and as such, are the best backup system available for a computer system subject to hardware / software / network / storage media failure, and hacker / terrorist attacks. The computer downtime, which is now considered routine, is more expensive in computer systems personnel and lost user time than the Classified Library costs to maintain.

Costs to maintain the Classified Libraries, a small fraction of computer development and maintenance costs, are totally covered by Applicant fees.

NIPRA recommends that the Examiner collections and the Public collection be combined into one Library accessible to both groups. The combination would include Foreign and Literature collections. The combination would take up slightly more than half of the

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present total space required, would cost less to maintain, allow for better organization, and in the process give more time to develop alternative solutions.

In summary, NIPRA's position is that Examiners and Public alike are best served by the combination of a well maintained paper library, and a well-designed and dependable computer system. The Classified Paper collection of Patents and Trademarks must be retained and restored to the level of completeness needed to have confidence in the work performed.

Sincerely,

Christopher E. Kondracki

NIPRA
Christopher E. Kondracki,
President