

October 29, 2001

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

Attn: Ronald Hack
Acting Chief Information Officer

Re: Request for Comments: Removal of Paper Files From Public Search Facilities

Dear Mr. Under Secretary:

In a Federal Register Notice dated August 27, 2001, the PTO requested public comments on its development of a plan to remove the classified patent and trademark paper files from the PTO Public Reading Room in Crystal City, Virginia. The purpose of this letter is to present the comments of the Section of Intellectual Property Law of the American Bar Association (IP Law Section of the ABA) on the PTO request.

The PTO requested comments on the following points:

- A. Measures required to ensure the integrity of electronic records.
- B. Comparable functionality for searching and retrieving information from electronic records
- C. Re-classification of the patent electronic file
- D. Paper Disposition

The IP Law Section of the ABA opposes the removal of the paper files. The members of the IP Law Section believe that the paper files are an important tool for searching patents, particularly in the mechanical and chemical arts. The paper files contain easy access to drawings and chemical structures that are often difficult to review on the available patent databases. At present, many of the patent databases require additional software or additional downloading steps to view the chemical structures or drawings of patents. The electronic records are simply not as efficient as a manual search in some cases.

In addition, the paper files may serve as a check or additional source if there is an error in the electronic records. For example, if page images in electronic copies are incorrect because the document was improperly scanned or read, the paper copies can serve as a source for correction. The IPL Section also encourages the PTO to make the electronic records more complete. Thus, certificates of corrections and reexamination certificates should be easily accessible from the original patent.

In response to A, the IPL Section encourages the PTO to ensure the highest integrity and quality for the electronic records. It is crucial that the electronic records be maintained up to date, and in searchable form.

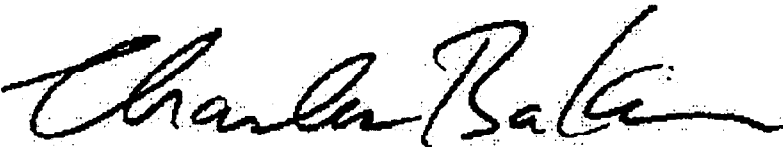
In response to B, it is important that there be greater access to the electronic records, with easy and quick access to non-text images, including drawings and chemical structures. Without the ability to review these parts of the patent, any electronic access is insufficient and cannot replace the paper files. It is preferred that the available search engines be able to allow for use of wildcards, truncators, expressions, and the (and) and (or) functions.

In response to C, the IPL Section favors continuation of the present classification system, since it is familiar to patent practitioners.

In response to D, the IPL Section favors options D1 or D2, that is to transfer the paper records to another government agency or a not-for profit organization that will promise to keep the paper files up to date. It is preferred that the organization keep at least one set of the paper copies available in classified form during regular business hours, preferably in the Washington, D.C. metro area.

Thank you for providing the IP Law Section of the ABA the opportunity to comment on the development of a plan for the PTO to remove the patent and trademark classified paper files from the Office's public search libraries. If you have questions regarding these comments, please contact me or one of the co-chairs of our Committee on Patent and Trademark Office Affairs—Patents. They are John C. Todaro (telephone 212 527-7659; e-mail jtodaro@darbylaw.com) and Mark Garscia (telephone 626 795-9900; e-mail meg@cph.com).

Sincerely,



Charles P. Baker
Chair
Section of Intellectual Property Law
American Bar Association