

October 29, 2001

**Nicholas P. Godici
Acting Under Secretary of Commerce for
Intellectual Property and Director of the
United States Patent & Trademark Office**

**Attn: Ronald Hack
Acting Chief Information Officer**

**Re: Federal Register Notice of August 27, 2001,
Entitled "Notice of Request for Comments
On Development of a Plan to Remove the
Patent & Trademark Classified Paper Files
from the Public Search Facilities", &
Extension of such Notice dated October 4, 2001**

Gentlemen:

The following comments, directed primarily toward patent considerations, but also having some bearing on trademark considerations, are submitted pursuant to the above-identified notice and are my personal views based on over forty-five (45) years of experience in the intellectual property field, first as an Examiner and subsequently as a patent agent, with primarily a search practice. I have also been granted, as sole inventor, over a dozen US patents.

Before any plan is submitted to the judiciary committees at least the following items should be addressed and rectified as necessary.

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1. Public Patent Electronic Search Systems Reliability

The subject systems are still exhibiting considerable down time and other problems.

It is recommended that the trouble-log-keeping by the Patent Public Search Room (PPSR) PTO personnel at the CSIR and PPSR control desks be made more rigorous; be compared monthly with logging kept by the Chief Information Officer's technical staff; and that an analysis of such log keeping and comparison be made public each month.

Such a system would give the public and probably also the PTO a better understanding of the search systems' reliability than they now have. Such logging should apply to all PPSR electronic search systems including CASSIS.

Related to the above, how would PTO PPSR users be accommodated (in the absence of paper files) if some or all of Patent Electronic Search Systems were down.

2. How does the PTO plan to accommodate first time or seldom-seen PPSR users in the absence of paper files, in particular if the novice or seldom-seen user is not computer literate?

It is noted that many walk-in visitors come to search one time only. With paper files the instructions by the PTO PPSR Technical Information Specialists (TIS) before the novice is able to search is short. Since the PPSR electronic search systems have a rather complex keyboard command requirements, would the PTO plan to have the TIS personnel key-board for the novice or seldom-seen user? If so would it offer such service at no charge, (as paper pre-search instructions have always been given)?

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3. How would any PTO plan justify or rationalize that less searching resources (i.e. searching without paper files) are better than more, particularly when the US paper classified patent files are an obvious bargain compared to the electronic systems. PTO could prepare an annual cost chart of paper versus electronic systems, say 1988 to date so the judiciary committees and the public generally could know budgetary facts of life.

4. What system or improvements should the PTO put in place to ensure the integrity of the content of their computerized databases relative to the US paper patent classified files before considering removing or destroying these files. East/West are known to have considerable disintegrity versus the paper files. Here are a few examples of patents found in the subclasses noted in the paper files, which will not be found in subclass searching on the PPSR electronic systems:

US Patent 2,816,361 in Class 33, subclass 5; 4,579,479 in Class 404, subclass 103 & US 3,851,084 in Class 426, subclass 808.

Many other instances of paper subclasses versus computerized subclasses disintegrity are also known to exist with the computerized subclasses sometimes lacking only single US patents found in the paper files and sometimes several patents.

5. East/West currently lacks the ability to allow full-text searching of the content of about 4,500 Re-examination Certificates. These certificates by their very being are some of the most strongly prosecuted items in the US patent literature, the results of their re-examinations are often of vital interest to various segments of the intellectual property community. How does the PTO plan to make these re-exams and other after original issue materials full text searchable?

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6. How does the PTO plan to expand or modify it's electronic systems security measures in view of the recent (September 11th) Pentagon terrorism (which only missed the PTO Crystal City complex by about a mile), and in view of the Examiners' work-at-home arrangement. It would seem that this latter arrangement could offer miscreants opportunities to compromise the PTO's electronic systems that did not exist before such arrangement.

7. How does the PTO plan to address the on-going decrease in re-classification efforts, which is leading to larger and larger subclasses? (This, of course, impacts both electronic and paper searching.)

8. Ancillary to paper removal it is questioned on what grounds, in view of the statutory section quoted in the subject Federal Register notice, the PTO has failed to maintain the microfilm (or microform) collection of patents subsequent to December 1999 since it is believed that no plan to stop maintaining this resource has been submitted to the judiciary committees.

9. Professional searchers of my acquaintances, almost without exception, have expressed to me their feelings that, while computer searching is and will no doubt continue to improve as a useful adjunct to paper searching, paper is still their resource of choice, particularly where long and often tedious searching efforts such as encountered in infringement and validity searching are concerned. Such searchers have also expressed their feeling that higher quality search results flow when paper is one of the searching resources used. I agree strongly with both of these just-mentioned feelings.

10. It is believed that multiple site public hearings should be conducted on the PTO's plan after it is developed, but before it is sent to the judiciary committees, whereby the public can critique and possibly cause the PTO to re-consider or amend same.

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11. With regard to any paper removal/disposition decision, it is strongly suggested that any final decision in this regard should be postponed until the move to the new PTO location is imminent. Further, it is suggested that any removal/disposition be confined to the local area and preferably to a location readily available to the new PTO location, and that such decision not include destruction or dismemberment of the US paper files resources.

Respectfully submitted,

A handwritten signature in cursive script that reads "Glenn E. Wise". The signature is written in dark ink and is positioned above a horizontal line.

Glenn E. Wise
Registration No. 19,370