

# 11  
Rec'd 5/16/02

---

# NIPRA

National Intellectual Property  
Researchers Association

---

May 14, 2002

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

Att: Ronald Hack, Deputy Chief Information Officer  
For Information Technology Services

Re: FR Doc. 02-8544 Proposed Plan for an Electronic Public Search Facility

Dear Sir:

The United States Patent and Trademark Office (USPTO) is proposing to eliminate the paper patent and trademark registration collections from its public search facilities and replace them with electronic information collections. The National Intellectual Property Researchers Association (NIPRA) is opposed to such a transition at this time.

NIPRA is a not-for-profit organization comprised of intellectual property attorneys, agents, researchers and inventors dedicated to the maintenance and improvement of the United States Patent and Trademark Office with particular emphasis on improving the ability of its members to access patent and trademark information so that they might effectively support the Intellectual Property Community.

Upon review of the current state of the USPTO electronic systems, NIPRA is convinced that the USPTO is not yet ready to transition to an exclusively electronic search environment. Although the automated search systems have been a welcome adjunct to fill in the gaps and errors that have crept into the paper systems and NIPRA supports the development of a superior automated search system that could replace the paper collections, at present such a system does not exist. USPTO and recent independent studies have confirmed that the USPTO electronic search systems are **not** mature and reliable and although they may provide equivalent functionality to the paper collections, they do **not** provide the more important criteria, equivalent results.

The USPTO argues that a fully electronic search system will result in cost savings and that the "paper classified files are incomplete by nature of the format. There may be missing or misfiled documents, potentially impacted search results which rely only on the paper classified files". By the same token, the USPTO's proposal will force reliance on electronic search systems such as EAST, WEST, X-Search and TESS, systems that have been demonstrated to have numerous software issues and similar data quality problems. A recent NIPRA survey demonstrated a 52% error rate in the X-Search and TESS design code fields alone. (See Exhibit A) Those results are

buttressed by an August 2001 assessment of that same data by PriceWaterhouseCoopers (PWC), the USPTO's internal consultant. The PWC assessment indicated an 46% error rate in the initial data entered by USPTO contractors and a 36% error rate in the data uploaded to the electronic search systems subsequent to quality review by USPTO employees. (See Exhibit B) Similarly, test queries conducted on EAST indicate system problems such as a.) in excess of a one hundred thousand patents issued since 1971 that are not text searchable b.) numerous reclassification efforts that have not been entered into the database despite reclassification of the paper collection c.) identical search queries returning different results d.) discrepancies between the number of patents filed in a particular subclass in the paper collection and in the electronic database.

The inadequacy of the electronic search systems and the USPTO's development practices has been well documented for more than twenty years. Despite consistent negative reports by the Government Accounting Office (GAO) and the Department of Commerce's Office of the Inspector General, the USPTO has not learned from their previous mistakes. Since as early as 1979 the GAO has raised concerns about the effectiveness of electronic searching and noted that the USPTO has a difficult time defining quality measures, electronic systems development costs and proper systems specifications. These findings are repeated annually through the mid 1990's in a series of GAO reports lambasting the agency for poor systems development, extravagant costs and questionable contractor agreements. Similarly, as late as March 2001 the Office of the Inspector General (OIG) had found weakness in the development of electronic search systems. Specifically, the OIG identified the following problems with the development of the EAST system in Inspection Report No. PSE-12679/March 2001 (See Exhibit C.) 1.) ineffective management and monitoring by the Commissioner for Patents and the Chief Information Officer, 2.) incomplete systems specifications, 3.) poor communication with the end-users 4.) poor acceptance testing, and 4.) insufficient training in the use of the system.

Those official reports bear striking similarities to the comments received by the USPTO in response to its initial Notice of Request for Comments on Development of a Plan To Remove the Patent and Trademark Classified Paper Files From the Public Search Facilities published in the Federal Register August 27, 2001. The fifty comments received were overwhelming negative and reiterated many of the same concerns expressed by the GAO and OIG. (See Exhibit D)

There is no defense for these findings. The USPTO has however consistently engaged in a ritual of obfuscation and blame shifting. The PWC assessment of the electronic trademark data was never released to the public or, on information and belief, to the Chief Information Officer. Although the findings of the assessment have great import to the public user, the USPTO, in violation of OMB Circular A-130, suppressed the findings and did not inform the public about these limitations in the information dissemination product so that they might be fully aware of the quality and integrity of the information. Further, the USPTO has consistently responded to GAO and OIG criticism with a line by line dissection of their reports, pointing out minute semantic errors and ignoring the larger issues, ultimately placing blame for systems failures on budget cuts, uncertain funding, contractor delays and Government Services Administration interference. Similarly, the USPTO response to the overwhelming negative comments to its August 27, 2001 notice was to dismiss the substantive comments and questions regarding the

plan to eliminate the paper files as not germane to the issue. Given that the USPTO cunningly asked for comments on the development of a plan to remove the files rather than comments on whether the existent systems were adequate to proceed with the development of a such a plan, such contempt for the public input is not surprising. Nevertheless, it is curious that of the fifty Responses received to the notice, not one had a single comment or question that the USPTO considered "germane" to the issue.

Furthermore, the USPTO has published its Draft Data Quality Guidelines and appears to have determined that the data in the electronic search systems is exempt from those quality guidelines. We have contacted the USPTO Information Products Division for clarification on this issue and are convinced by their response that they neither understand what the data in those systems is nor how the data is entered. Our query with regard to what data was or was not exempt from the Data Quality Guidelines resulted in the following response ten days in the making: "The databases or systems you mention contain a variety of data or information types, and according to the guidelines it is possible that some of the information contained within a database or system may be exempt, while other information is not" and essentially review the OMB guidelines and make the determination for yourself.

Lastly, although the Federal Register notice denotes what the USPTO **shall not** do under Section 4804(d)(2) of the AIPA, it does not underscore that the Office is mandated to "maintain, for use by the public, paper, microform, or electronic collections of United States patents, foreign patent documents, and United States trademark registrations" and that those records must be "**arranged to permit search for and retrieval of information**". It should be noted that the trademark electronic search systems, principally X-Search and TESS do not fulfill that requirement as they are composed of bibliographic and image data that has been keypunched or tagged by USPTO employees and contractors and are not collections of the trademark registrations as issued. Given the General Counsel's fine interpretation of Section 4804(d)(2) in its determination that the pending trademark applications were not subject to the Act, that same fine interpretation should be used to analyze the electronic search systems compliance with Section 4804(d)(2).

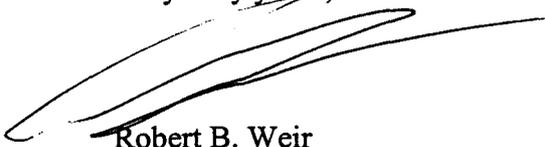
In short, the USPTO has embarked on twenty year campaign of misinformation and contemptuous disregard for GAO and OIG findings as well as public input with regard to its electronic systems development. To date, the potential damage that could result from absolute reliance on the USPTO electronic search systems has been mitigated by the existence of the paper patent and trademark collections that serve as validation for the results generated by those systems. Should the USPTO be allowed to proceed with the elimination of those records this valuable function will also be eliminated, jeopardizing the validity of all research conducted at the USPTO and resulting in serious damage to the United States' intellectual property system and economic harm for those who rely on the faulty USPTO electronic systems.

Given the USPTO's mandate to disseminate information it would seem reasonable that the USPTO should strive to create and maintain the most accurate and complete record possible. Despite the expenditure of untold millions of dollars, many of the problems identified by previous GAO, OIG and independent reports still remain and have not been addressed by the

agency. Thus, it seems premature to eliminate the paper search file until such time as significant improvement in the electronic systems data integrity can be verified.

NIPRA recommends that the USPTO immediately commission an independent study of the automated search systems by an independent organization to ensure correction of the existing data and creation of guidelines to correct the data flow and ensure future data quality. (See Exhibit E) This study should consist of a side-by-side comparison of the electronic and paper search systems until such time as the results of an exclusively electronic search are consistently the equivalent of a combined electronic and paper collection search. Pending the results of that study the agency must suspend all efforts to eliminate the paper patent and trademark collections. The office is also urged to advise users of the automated search systems of their deficiencies in accordance with OMB Circular A-130

Very truly yours,



Robert B. Weir