

Comments regarding retention of PTO paper files
(Docket No. 010126025-1231-02)
RIN 0651-AB34
Computer vs Paper file searching

I am sure that various reasons have been presented by others for retaining the paper files (file integrity of the paper files, integrity of the data base, etc.) and I will not reiterate them here.

I believe that an undesired deterioration in the PTO patent classification is due in part to heavy reliance on computer searching based on key words, forward citation, classification searching and the other tools available with computer searching. While I do not know the history involved in making a transition from paper to computer searching, I suspect that decisions made in anticipation of a functioning computer search system started the deterioration process.

This deterioration is evidenced by 1) Class definitions which provide less information, 2) poor classification of individual patents and 3) new Examiners who do not know the classification of their own arts.

In some ways, the most significant proof is the lack of concern and awareness by the PTO of the deterioration.

Looking at these points:

>>> Point 1) Class definitions which provide less information

There was a time when the definitions of the subclasses provided much more information than appeared on the schedule sheets. The definitions for any art collection reclassified in the last 10 or so years often do no more than take the words appearing on the schedule and make them into a complete sentence. Further, it is now uncommon for the class definition for a particular subclass to suggest a possible search in another subclass or subclasses -- at one time, most subclass definitions in some classes would suggest other subclasses which might be searched and very often the line or conditions which would make a search in the suggested subclass advisable. Generally, any class which has been reclassified within the last 10 years appears to have this problem.

Proof of point 1) will be self evident with any comparison of old and new class definitions.

>>> Point 2) poor classification of individual patents

I have only anecdotal experience to offer on this point. I know that patents found in a computer search and issued more than about 10 years ago are more likely to have cited references of interest than are patents issued more recently. I attribute this in part to a heavy dependence on hand searching in the past and a greater awareness by Examiners of other arts -- which awareness comes in part from hand searching paper files.

More recently issued patents are less likely to be cross referenced adequately. I believe that this results from Examiners who do not appreciate the potential of good classification (see point 3) below).

Poor classification of individual patents would not be a serious problem if patents could be assuredly found in a computer search. Unfortunately, a good computer search makes use of classification criteria.

>>> Point 3) new Examiners do not know the classification of their own arts
-- the Examiners do not know the classification of their own arts any

better than does a searcher. When I first started searching in 1972 and went to an Examiner for assistance, ~~only~~ the most junior Examiners ever looked in the Manual of Classification or the Class Definitions unless he was offering help in an art in which he had no experience (the expert Examiner was unavailable) or he was proposing a search in another class and he wanted to suggest a field of search in that class.

Patent searching by classification is a useful way to "thin" an answer set of patents which have been collected by a key word or other computer search scheme. However, computer searching does nothing to give the Examiner an awareness, a feel, for the classification of those patents which he or she finds. The Examiner who depends on computer searching does not have an awareness of the importance of classification and is unskilled in suggesting where an issued patent should be classified. Since the Examiner finds patents using a computer in his office, he gains so feel or sense of the physical location and the relation of that patent to other art which comes with finding a patent in an unchanging stack of patents (the stack being defined by the classification for that stack)

The classification system at one time was much more useful than it is today. More specifically, the classification system was much more specific with respect to defining where a given patent should be classified.

Retention of the paper files does not by itself solve the problem -- but loss of the paper files would make it impossible to correct the problem in the future by a simple change in training and required search procedures.

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