

Director of Patents and Trademarks

Attn: Robert W. Bahr

Response to Proposed Rulemaking Due August 9, 2000

Treatment of Unlocatable Application and Patent Files 37 CFR part 1 Section 1.251

We disagree with the proposed rule change in its entirety and request that rule not be entered. Particularly, the Office can not adequately define the term "reasonable search", the rule puts unnecessary burden on the applicant or patentee to provide copies of documentation, Section 125.1 (c) puts responsibility for maintaining public records on the applicant or patentee and penalizes them if they can not comply, and finally, the rule does not solve the problem of the lack of training by the Office for the staff or private contractor staff that use the equipment on a daily basis which is the main reason there are so many lost or misplaced files in the first place.

"Lost" or "missing" files at the United States Patent and Trademark Office is certainly a problem that needs attention. This rule change however does not address the true nature of the problems with the current system and is not the appropriate solution to the situation.

Section 1.251 is proposed to be added to set forth a procedure for the reconstruction of the file of a patent application, patent, or other patent related proceeding that cannot be located after a reasonable search. The Office does not adequately define the term "reasonable search."

Over the years, this organization has made several hundred "Official Search" requests. Requests for pending applications, patented, Interference, and abandoned files. On average, the found rate of files found during this process is less than 1%. Rarely do the Office personnel find files in the first 30 days from such "Official Search" requests. Practice at the "Official Search" Branch does not adequately service the users of the patent system today. It is understood that currently no individual performs a physical search for the file. Once a request is made to the "Official Search" Branch, the request sits for a 30 day period and then notification is made that the file was not found after a cursory review of the Office's PALM tracking system.

In situations involving pending applications, our organization has found it extremely difficult when working with Office personnel to locate misplaced files. The clerical staff charged with finding these requests make cursory reviews for the files at best. They certainly have more value added tasks to attend to then to look for missing files.

These are examples of common practice at the Office and are not in the least a valid attempt at a "reasonable search." We can only assume that nothing will change with the addition of this new rule.

We would support this rulemaking if the search were physically conducted in locations where the file might be found. This would include a search at both the last listed location and the location to which a file was sent by a competent, trained individual.

If the proposed rule were instituted, it would place an unnecessary burden on the applicant or patentee to provide copies of those files. The Office notes that several addresses are kept for each applicant's file. We agree that this is problematic but the users of the system did not create this situation. It is up to the Patent Office to correct this fallacy by creating one address, which all correspondence can be sent. Additionally, the Patent Office charges \$150 for a copy of any file. This is of course the marginal cost to produce a copy of any file by the Patent Office. This rule does not compensate the applicant or patentee for a similar amount. It would be reasonable to compensate the provider of the information in similar fashion since they too would be asked to incur similar costs to make a copy; however, this is not the case. Furthermore, the rule suggests that applicant or patentee provide their file to the Patent Office for copying. If the Patent Office lost their own copy, applicant or patentee surely should not trust them to have the only remaining copy.

Section 125.1 (c) penalizes an applicant for lost records when it is the fault of the Patent Office. This part of the rule is an interesting addition in view of the current series of customer focus events that the Patent Office stages across the country. It is the Patent Office's fault for losing the information and because of their inadequacies, the applicant is penalized for the Patent Office's error. A typical real world customer focused business would not punish the customer for the business's error. Deadlines for responding to such Patent Office requests are typically very short so it would be highly likely that an application would go abandoned even when an applicant responded in a timely fashion because of the bureaucratic paperwork pile up and papers are now lost on a regular basis. This creates additional problems for the Patent Office.

The true problem of this situation is that the Patent Office has problems transferring files internally because files are not properly "wanded" into the tracking system. The solution to the problem is much easier than punishing an applicant or patentee. The solution is to provide better training for the Patent Office staff and require proper supervision of Contractors that handle the files. Private Contractors handle a large portion of this type of work for the Patent Office. It is obvious that the Patent Office cannot properly supervise its Contractors. If better training or better management practices were in place, all parties would be happier and files would not become lost.

This proposed rule change is NOT in the best interest of applicant or patentee as written.

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