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5/16/02

Comments
regarding
Proposed Plan for an Electronic Search Facility
5/16/02

I'm Lee Grantham. I work for a local 35 attorney firm. I manage the firm's search department. I've been searching for 13 years.

Introduction

We've been asked to comment today on a plan to create an electronic search facility which means the elimination the PTO paper files. PTO argues that functional equivalency has been reached regarding electronic patent storage and retrieval. I have to agree. The new search tools are congruent with the necessary methods of the information age. The paper based search system has been made better. I expect additional features to be added regularly thereby further enhancing our work effort.

The question at this point, today, regards expectations that the work product derived from using electronic techniques in comparison to the paper files will produce comparable results. With electronic capability we expect efficiency, we expect thoroughness and, especially, we expect to identify germane prior art. We expect the new methods and techniques to enable the user to produce a work product of equal quality to that provided by the system now being replaced.

The new search tool is powerful. The precision of keyword searching directs the user to relevant prior art. One can check cited references with the snap of a finger. You can even insert a search term in a particular document after you've identified the document as potentially pertinent. So, the introduction of electronic techniques must result in an improved system to find prior art, right? I don't think so. (The key word is must.) The expectations are not guaranteed.

The fruits of technological progress do not result without a vision and a reasonable understanding of current systemic dynamics. The decision makers must understand that the cross impact effects of various players, even those simply engaging in their daily tasks, can have totally unanticipated effects. Current trends must be identified and carried to their logical conclusion so the decision maker can better evaluate the steps necessary to reach expected outcomes. The assumption, it seems, is that we have a fine search system that works so contributing more capacity or more searching power or more efficiency will results in an improved outcome. It's as if PTO feels there is black box where you put in something good, let it mix around a little and out pops progress -- new and improved. That is not how success works. The goal must be defined and attentive steps taken to reach it. The technology analysts long ago recognized that every time a new technology is introduced into a social system there are unintended consequences.

That's what I am going to address today -- unintended consequences.

The Users

There are two different types of searchers. There is the public sector searcher and the private sector searcher. Even though each access the same source material each has different objectives and each faces different constraints.

The public sector searcher is considered an expert due to their narrow focus. They are expected ~~to learn the art within~~ their areas. They are expected to search quickly and over time, as they learn the art, to search even quicker. Historically, this has been a fact, it has worked. Presumably, the public sector searcher is ~~expected to be~~ thorough despite the fact that they ~~work under strict time constraints that preclude extensive searching~~. Searching is only one responsibility that this group has. They, the public searchers, are the examiners.

The private sector searcher is a generalist. We work in all the art units. We always have more time to search. We regularly spend 8-12 hours doing patentability studies. We sometimes rely on primary examiners to provide a search field thereby the saving the generalist some time.

The reality of the matter is that the examining corp heavily influence the overall makeup of the search system. This is true even though the examiners search results are the product of minimal searching time. As the shear number of patents has exploded searching has become more entailed.

Trends

In order to achieve a proficient system it is imperative to evaluate current systemic trends that can impede attainment of the goal. The goal in this case is a well organized, accessible patent searching facility. Because the examining corp has great influence on the system it is necessary to look at trends emanating from that group. I want to be clear that what I am stating here are the observations of a private sector searcher but I believe that they are representative of intrinsic trends that do not bode well for a proficient search system. My point is not to attack but only to illuminate.

The following encounters have all happen to me in the past year. The experiences are replicated fairly often by other private searchers. For instance:

1. Showing a disclosure to an examiner and being told "I'm not sure where to look but I would just keyword it";

2. Asking an examiner where the paper files are for their class and are told "I don't know, we don't search paper anymore." When you mention that you're looking for the foreign shoes the response -- "the foreign is on the database";

3. Take a disclosure that acknowledges the use of known old technology (although the application in the environment was new), see two examiners, get two different search fields, and get the same puzzlement/surprise from each along with the same comment that the old technology was different; only to find out latter that the technology was not obscure and that there were about 2 dozen examples patented between 1900 and 1920. The art was not in any of the subclasses provided by either examiner. The correct subclass was eventually identified using electronic search techniques but remember I have ample time to look.

4. We are starting to see simple patents issuing that have pertinent issued prior art not identified by the examiner. We are finding invalidating prior art that predates 1971 or uses different lexicography.

5. I am subject to comments from attorneys that office actions are being issued that cite patents that have little to do with the invention but do contain appropriate keywords.

The five examples show a number of things. I believe that importantly they show a disconnect regarding the existence of old art. Old art is buried in the subclasses. More to the point there is a disconnect regarding prior art that is not key word searchable. The general trend, therefore, indicates a reluctance to manually search class/subclass even though this is doable electronically. The result is diminished reliance on the classification system.

The elimination of the paper files removes the need to physically put yourself in the art. The organization on which the paper system was founded is now rendered out of hand, out of sight, and out of mind. This development is understandable and in some cases it was even predictable. Subclasses in many mechanical fields are simply growing too large, which is another trend. The problem is acute in the mechanical arts because the mechanical arts do not lend themselves to keyword searching and one must manually search.

Conclusion

Brigid Quinn recently commented that the paper had no intrinsic value. On this matter she was wrong. The value of the paper files resides in the fact that they provided a well organized method of finding prior art. The foundation of the paper system must be continued. If the classification system is allowed to atrophy the goal of improved search capability will be missed; it might not even be up to the demands of the information age. A system dependent on text searching will not be efficient and it will not be comprehensive. Technology historians realized long ago that with the introduction of new technology something old is lost. In this case it appear that we are losing the classification

system. The private sector requires a system that works especially in view of burgeoning prior art.

Thank you.