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Undersecretary of Commerce for
Intellectual Property and Director
Of the United States Patent and
Trademark Office
Washington, D.C. 20231

ATTN: Ronald, Deputy Chief Information Officer
Information Technology Services

Re: Proposed Plan for an Electronic Public Search Facility

In response to the request for comments published in the April 9, 2002 Federal Register, Hahn Loeser & Parks, LLP opposes the proposed plan to eliminate the paper patent and trademark collections from the public search facilities and to transition to electronic only patent and trademark information collections.

Hahn Loeser & Parks is a business and business litigation firm with more than 95 attorneys in three offices. Hahn Loeser & Parks has been active in patent and trademark matters since 1947 through the firm of Oldham & Oldham Co. LPA, which joined Hahn Loeser & Parks in 2001. Our clients include individual inventors, Fortune 500 corporations and international clients. Client industries include organic, inorganic and polymer chemistry; medical and life sciences; electromechanical systems; mechanical systems; and electronics.

PATENT COLLECTIONS

A major limitation to the electronic searching is that the inventor can be his own lexicographer. As a result, the use of keyword searching with words that may be commonly used by one skilled in the art will often not result in a complete or comprehensive search. For example, valve may be called a gate, or stopcock, or be described in many different ways, particularly if the application originated in a non-English speaking country. If a critical word appears once in a document and it is spelled incorrectly, the document may be missed completely. Another limitation with electronic searching is that invention can precede the technology. For example, lasers were invented several years before the acronym "laser" was coined to identify the invention. Thus locating a critical document can be totally dependent on the skill, or luck, of the searcher to pick a comprehensive list of keywords. Often, a document located using a computer text search will, after studying the patent; turn out to be irrelevant because the keyword was

listed as background material in the patent. While keyword searching can find many relevant patents, there is no substitute for a manual search. For many inventions, a picture is necessary to convey the invention. Therefore, flipping or browsing through the figures can quickly determine if a reference is relevant or not.

Currently, text searching is only available for patents issued since 1971. Therefore, electronic searching for patents prior to 1971 must be done by classification and subsequent downloading and viewing of each patent. The electronic systems do not provide the same ease and speed as the paper collection for the ability to quickly flip through the front pages and to readily switch to reading the relevant sections of a reference of interest. Even with newer faster computer equipment, viewing screen after screen of patent images is simply not as fast or efficient as scanning through paper pages.

TRADEMARK COLLECTIONS

Trademark records are such that, by their very unique and sometimes perverse nature, as a whole they often defy standard rules of "boolean logic" or even constructed "design codes" and thus cost effective electronic searching. As to word mark searching, during a search the paper files educate the searcher as to various aspects of the word(s) in question more effectively than do electronic systems by providing the researcher a overview of the word(s) spanning product and classification categories. That is not to say that at some time in the future cost effective and improved electronic search systems may not be devised such that the classified paper search records will no longer be unique, but for now such is not the case.

Many electronic searches using the USPTO current system are missing the image associated with the mark and some appear to be missing entirely. It makes little sense to eliminate one system in favor of another if such significant discrepancies in the data have not been identified and corrected. The automated system as it stands now is not a reliable substitute for the paper, just as the internet search system offered by the USPTO (TESS, TAM) is a poor substitute for X Search and TRAM.

In closing, while computer searching is and will no doubt continue to improve as a useful adjunct to paper searching, paper is still the resource of choice, particularly where long and often tedious searching efforts are concerned. Such searchers have also expressed their feeling that higher quality search results flow when paper is one of the searching resources used.

May 13, 2002

We applaud the significant efforts the USPTO has made to move into the electronic age, yet much has to be done to ensure a smooth transition with reliable data for accurate information dissemination. We continue to offer our assistance in any manner that might aid the agency in this endeavor.

Cordially,


HAHN LOESER & PARKS LLP



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