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

via facsimile  
703-308-7792

Attention: Mr. Ronald Hack  
Acting Chief Information Officer

Re: Paper Search Files, Federal Register, vol. 66, no. 166, page 45012

Dear Mr. Hack:

I welcome the opportunity to comment on issues relating to availability and retention of paper search files at the Patent and Trademark Office. I am a frequent, almost daily, user of the Public Search facilities. The comments are my opinions, not those of any organization.

The existing paper files represent an irreplaceable source of technological information, a source which should not be put into dead storage or destroyed unless and until electronic information products have been demonstrated to be equivalent to or better than the paper search files. It is reasonable for the PTO to identify redundant or underutilized paper search files and remove/store these files in order to mitigate increasingly serious demands for filing space.

The PTO should act conservatively in reducing its reliance on the paper files. Assuming there are acceptable electronic replacement techniques for selected search areas, the PTO might archive the related paper files, pending decisions on whether/when to destroy the paper files. At least for the foreseeable future and with the exception of extremely inactive art, the PTO should ensure that classified files in active arts remain available to the public. At a minimum, paper files, corresponding to those removed from the Examiners' search areas, should remain available to users of the Public Search Room.

Although computer workstations may eventually become an acceptable substitute for the paper files, my impression is that the computer workstations have met with mixed acceptance among public users. Enhancements in the workstations have ameliorated some of the numerous public objections to the workstations.

I believe there is continuing legitimate concern with respect to the quality of the images displayed, particularly with respect to legibility of text. Comments from people who normally search by viewing drawings are generally more favorable than comments from those who are required to read mainly textual material. Workstation users will require higher image quality than presently available in order to be able to use the machines for several hours each day without eyestrain. Improvements in the monitors with respect to glare/angle of viewing etc. are almost certainly needed for the monitors to become acceptable replacements for viewing of paper document copies for hours at a time.

A further concern with respect to substitution of the computer workstations for paper search files is system reliability. Based on numerous anecdotes shared with me, it appears that the system is plagued by "down time" problems. Without a highly reliable system, which is in running order 99+% of the time, users will be frustrated by (a) being unable to use the system at all during system outages and (b) loss of work product when the system goes down during the course of a search.

Despite the progress made in developing the electronic workstations, the workstations are not yet an adequate replacement for searching of the paper files. Therefore, at least highly used paper search files should continue to be available for use at the PTO for the foreseeable future.

I have no suggestions with respect to how integrity of the electronic files is to be maintained. I have experienced numerous instances in which the electronic files (EAST) in a particular subclass do not contain the same documents as the paper files, particularly very recent paper documents. The subclass listings, available on CASSIS, do not always agree with the documents in a particular electronic subclass (EAST). In addition, extremely recent documents in the paper files, classified on their faces in a particular subclass, are not always retrievable in an electronic search of the same subclass (EAST).

Theoretically, it should be possible to search identical document sets, whether or not the documents are in paper or electronic form. Until the paper and electronic files are internally consistent, this capability is not reliably available.

Regardless of the form in which the search files are available, it is imperative to maintain the U.S. Classification system (UCLA) and constantly update the classification system to accommodate the need for manageable searches of increasingly large and active subclasses (over 1000 documents).

The full-text electronic search capability is inherently limited by the fact that the applicant is his/her own lexicographer. The full-text and classified search capabilities are complementary, not coextensive, in their scope. The full-text data base is not indexed. Therefore, the information retrieved by a query in the full-text data base is limited by the way in which the query is framed.

The full-text capability will almost certainly fail under at least the following circumstances:

1. A critical word appears once in a document and is spelled incorrectly.
2. The applicant or patentee has used terminology, other than that contemplated by the searcher or inventor. This is particularly likely to happen when the applicant/patentee has used "unconventional" or "creative" language in order to avoid known prior art.
3. The invention involves chemical compounds, characterized by structural formulae and Markush claims, without particular compounds being named at all.
4. Terminology has evolved as a technology has developed.
5. Pertinent art predates 1974 and is not available in the full-text data base.

Concept-based classification, as exemplified by UCLA, is independent of terminology. Concept-based classification allows the applicant/patentee to describe the invention in terminology of his/her choosing and provides a framework in which the searcher can find pertinent references, regardless of how the invention is described. The importance of maintaining the UCLA and reclassifying overly large subclasses into manageable subclasses should not be underestimated.

It is not apparent that any of the proposed dispositions for the paper files for third-party acquisition/maintenance of the files (items D.1-D.4) is appropriate. None of the suggested third parties appears to have any compelling interest in maintaining or keeping the files available to the public, particularly if the third parties are required to make the files available to the public free of charge. The U.S. Patent and Trademark Office has the duty to keep the files available, so as to "promote the progress of science and the useful arts [Article I, Section 8]."

Mr. Ronald Hack  
September 25, 2001

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Thank you for your interest in this matter.

Respectfully submitted,

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