

From: gorecki@rcn.com
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To: eReference
Subject: comments on E-Patent Reference feature

The notice states that the references will be available through the PAIR system and only available for those applications associated with a particular customer number. It is often the situation that a law firm is handling a matter on behalf of a client, and that both the law firm and the client have different customer numbers. Also, both the law firm and the client may need to have access to the references. Enabling the references to be obtained for an application only through a particular customer number restricts the client's ability to prosecute the application and places a large burden on law firms to obtain these references for their clients.

Under the current state of things, either the law firms will be required to access the PAIR system and print out/download every patent cited in every office action to provide a copy to their clients, or the law firms will need to print out/download copies for their clients upon request. Either situation will present a significant burden for practitioners engaging in patent prosecution with the office. For example, a large law firm receiving 50 plus office actions per day, each with 5-10 cited references, may need to hire an extra employee simply to download, print, and associate the 500+ patent references with the respective cases every day.

An alternative solution would be for the office to e-mail the references to an e-mail account associated with the customer number. That would eliminate any drag on the PAIR system and minimize the amount of time required for a law firm to obtain references for its clients. A better solution would be for the office to enable multiple customer numbers to be associated with an application so that clients could have access to references. A still better solution would be for the office to continue providing paper copies of patents with office actions.

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