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From: MO'Neill@fchs.com [mailto:MO'Neill@fchs.com]  
Sent: Tuesday, January 06, 2004 3:31 PM  
To: eReference  
Subject: Comment on Plan To Cease Supplying Copies Of US Patent  
References

This is a comment in opposition to the USPTO's notice dated December 23, 2003, entitled "Notice of Office Plan to Cease Supplying Copies of Cited U.S. Patent References With Office Actions, and Pilot to Evaluate the Alternative of Providing Electronic Access to Such U.S. Patent References".

Opposition is based on two primary reasons, one statutory and one practical.

The practical reason concerns the inconvenient and time-consuming process of downloading patents, especially when coupled with the USPTO's restrictions on who is permitted to perform downloading. First, downloading is inherently slow, and is particularly slow with ordinary Internet connections (e.g., dial-up) and when server load at the USPTO is high. Already there are instances where high server load slows responsiveness, such as when performing searches at the USPTO's public search site. Even recognizing that additional servers are contemplated, responsiveness is certain to suffer since under the proposed system, every single patent applicant will be required to access to the site for every single Office Action; and there will be instances where there are multiple accesses for each Office Action, such as when the inventor, the attorney and the assignee all access the site independently of each other.

Moreover, restrictions on who may access the site unfairly shift clerical and administrative tasks to practitioners. The Notice indicates that access to private PAIR is required, meaning that clerical staff in our offices will not ordinarily have access. Recent advice from the USPTO indicates that it is acceptable for practitioners to delegate their digital certificate to an assistant, but since only one person is able use the certificate at any one time, such delegation effectively blocks the practitioner from PAIR access during the long periods needed by the assistant to download. The USPTO has also indicated that non-practitioners can obtain a certificate, but the procedures for doing so, and the upkeep required to keep the certificate current for newly-filed cases, make this option wholly impractical and not usable.

Finally, many practitioners rely on hard copies of references in their study, so that the references can be annotated and highlighted, and so that the references can be compared side-by-side with the Office Action and the application. This requires a print-out of the downloaded reference, which again is an unfair shift in burden and cost.

As for the statutory reason, 35 USC § 132 specifically requires the USPTO to provide "references", which is a mandate not fulfilled merely by providing a link from which references can be obtained:

"Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application..."

Thus, § 132 clearly requires the USPTO to provide "information and references", and there is a significant difference between providing a reference and merely making the reference available. US patent references have been available for many years in the Patent Depository Libraries around the country, but nobody could seriously argue that such availability complied with the statutory requirement for the USPTO to provide the references themselves. Therefore, the proposed plan which provides only a link-to-a-reference would not comply with the statute which requires the reference itself.

It should be understood that I am generally in favor of the USPTO's efforts to expand on-line tools available to the public and to practitioners, and it should be commended for its efforts to date. However, I am opposed to the USPTO's efforts to make those tools into the only available option.

Michael K. O'Neill  
FITZPATRICK, CELLA, HARPER & SCINTO  
650 Town Center Drive, Suite #1600  
Costa Mesa, CA 92626  
tel/ (714) 540-8700 (general)  
tel/ (714) 540-0841 (direct)  
fax/ (714) 540-9823  
e-mail/ mo'neill@fchs.com <mailto:moneill@fchs.com>  
<<http://www.fitzpatrickcella.com>>