

From: iplaw@walkerandjocke.com  
Sent: Wednesday, January 14, 2004 9:38 AM  
To: eReference  
Subject: Re: Notice of Office Plan to Cease Supplying Copies Of Cited U.S. Patent References With Office Actions

Electronic Business Center (EBC)  
U.S. Patent and Trademark Office

Re: Notice of Office Plan to Cease Supplying Copies Of Cited U.S. Patent References With Office Actions

Dear Sirs,

The undersigned respectfully requests that the U.S. Patent and Trademark Office continues to supply copies of cited U.S. Patent references with Office Actions.

I have personally tested the Pilot program for accessing U.S. Patent references through the PAIR system. Although the Pilot program successfully downloaded the references, the process necessary to access, download, produce PDF files and print the references is exceptionally time consuming even with a broadband connection.

Further, under the current system, copies of the cited U.S. Patent references are often marked-up and include Examiner's notes and underlining relevant to the rejections cited in the Action. Such notes and underlining provide additional insight into the Examiner's rationale for his/her rejections.

Unfortunately, the system for accessing the references through PAIR does not provide marked-up copies of the cited references and thus lacks valuable information currently available under the current system.

Although a fully electronic system of reviewing and responding to Office Actions is theoretically possible. As a practical matter, paper copies of U.S. references will remain necessary for the foreseeable future to efficiently prosecute a Patent Application. The reasons for this are many, but in particular many practitioners and Applicants find it easier to analyze long references on paper rather than on a computer screen.

Thus, ultimately the U.S. references will still be printed out, either by the Applicant under the proposed system or by the U.S. Patent and Trademark Office under the current system. As the U.S. Patent and Trademark Office currently has the means to continue to provide paper copies of the U.S. references, and the U.S. Patent and Trademark Office is highly efficient at this practice, it is not practical to shift this burden to the Applicant.

If it is a matter of cost, in my opinion, Applicants would be willing to pay a reasonable amount (say \$5) for each paper U.S. reference supplied by the U.S. Patent Office with Office Actions to avoid the unnecessary burden of accessing the references through the PAIR system. As with the Publication Fee, such U.S. patent reference fees could be paid with the Issue Fee.

Respectfully,

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