

March 26, 2002

Box Comments -- Patents
Attention: Robert A. Clarke
U.S. Patent and Trademark Office
Washington, DC 20231

Re.: AIPLA Response to the USPTO's Notice Entitled "Notification of Required and Optional Search Criteria for Computer Implemented Business Method Patent Applications in Class 705, and Request for Comments"
66 Fed. Reg. 30167 (June 5, 2001)

Dear Mr. Clarke:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to present its views on the above-identified Notice and Request for Comments published in the Federal Register, as well as the consideration given to these comments by the USPTO.

The AIPLA is a national bar association of more than 13,000 members engaged in private and corporate practice, in government service, and in academia. The AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

The Notice requested comments regarding the search resources employed in the examination of business method patent applications in Class 705. The Notice invited members of the public to recommend databases and electronic resources that the USPTO does not currently access for searching business methods prior art. The Notice included an appendix listing the non-patent literature and foreign patent databases searched by the USPTO.

With respect to the specific points on which comments are requested, AIPLA's comments are as follows:

- a) The AIPLA commends the USPTO for their persistent efforts to improve and enhance USPTO practices including practices related to search strategies and business method inventions.
- b) The published USPTO Internet Usage Policy provides that search queries relating to a patent application, other than a reissue application or

reexamination proceeding, should be restricted to the general state of the art unless on-line access to the databases is provided through a secure link. While AIPLA appreciates the concern for secure access and the ability to maintain secrecy with respect to unpublished patent applications, it questions the need for secrecy for published applications. Experience indicates that a majority of business method patent applications will have been published well before they are examined. Accordingly, AIPLA recommends that all potentially applicable databases be searched for published applications, regardless of whether such searching is provided through a secure link.

- c) Additionally, the AIPLA supports the USPTO's emphasis and recommends expanded efforts to increase the training and capabilities necessary for selecting and searching available databases. Further, the AIPLA encourages the use of trained "expert" personnel to assist Examiners with appropriate and efficient search techniques.
- d) In addition to the search resources identified in the Notice, the AIPLA recommends that the resources identified in the Attachment hereto be considered for either mandatory or supplemental Non-Patent Literature (NPL) resources when examining patent applications related to computer-implemented Business Methods in Class 705. Pursuant to the request for comments, each database listed in the attachment provides a rationale for its recommendation, identifies the database, describes the content, identifies accessibility, technical support availability, continuity, and the mode of access. For those database listings where information is not available, the best known information is provided.

In closing, the AIPLA appreciates the opportunity to provide comments on required and optional search criteria for computer-implemented business method patent applications in Class 705, and would be happy to further assist the USPTO in this matter.

Sincerely,



Michael K. Kirk
Executive Director

Enclosures:
Attachment

Attachment: Additional Search Resources

1. **Software Patent Institute**

The Software Patent Institute Database of Software Technologies consists of descriptions of software technologies.

Database Identification

- (a) Software Patent Institute Database of Software Technologies
- (b) Software Patent Institute
- (c) 9225 Indian Creek Parkway, Suite 1100
Overland Park, KS 66210-2009 USA
913-451-3355; fax: 913-451-3361
spi@spi.org; www.spi.org

Database Content

- (a) From 1955 - to current
- (b) Each record in the database is all or a portion of a source document (computer manuals, older textbooks and older journal articles, conference proceedings, computer science theses, and other such materials) that is generally not readily available on-line or in electronic form elsewhere. In particular, this database does not include patents and most current trade publications; but instead is interested in the “folklore” of the computing industry.
- (c) Publication dates are available.
- (d) Abstracts and full text.

Accessibility

- (a) The database is publicly available
- (b) 24 hours a day

Technical Support

- (a) Available via e-mail

Continuity

- (a) Unknown

Mode of Access

The database is accessible online on the Internet via a web browser at <http://www.spi.org/>

2. **IBM Product Offerings**

This database features an electronic catalog of IBM product offerings that can be searched by keyword or type of product.

Database Identification

- (a) IBM Product Offerings
- (b) International Business Machines Corporation
- (c) Same as (b)

Database Content

- (a) From 1983 - to current
- (b) An electronic catalog of IBM product offerings from hardware and software products

to services and solutions. Customer letters, announcement dates, and general and technical descriptions.

- (c) Publication dates are available.
- (d) Unknown

Accessibility

- (a) The database is publicly available
- (b) 24 hours a day

Technical Support

- (a) Available via e-mail

Continuity

- (a) Unknown

Mode of Access

The database is accessible online on the Internet via a web browser at <http://www-3.ibm.com/common/ssi/>

3. IBM Redbooks

This database is recommended due to the breadth of available material, the availability of full text documents, and the ease of search user interface.

Database Identification

- (a) IBM's Redbook, IBM's Redbooks, Redbook, Redbooks
- (b) International Business Machines Corporation
IBM Publications
Publications Customer Support
P.O. Box 29570
Raleigh, NC 27626-0570
USA
1-800-445-9269
redbook@us.ibm.com
- (c) Same as (b)

Database Content

- (a) From unknown - to current
- (b) Redbooks provide skills, technical know-how, and materials to technical professionals of IBM, Business Partners, customers, and to the marketplace generally regarding a variety of topics.
- (c) Documented publication dates are included

Accessibility

- (a) The database is publicly available
- (b) 24 hours a day

Technical Support

- (a) Available

Continuity

- (a) Unknown

Mode of Access

The database is accessible online on the Internet via a web browser at <http://www.redbooks.ibm.com/>

4. IBM Technical Disclosure Bulletin

This databases features the full-text of over 85,000 defensive publications made by IBM dating back to 1958. Many of these publications pertain to software or systems that relate to the various business categories represented by the Class 705 subclasses listed in the USPTO Request for Comments.

Database Identification

- (a) IBM Technical Disclosure Bulletin, TDB
- (b) International Business Machines Corporation
- (c) Same as (b)

Database Content

- (a) 1958 - to current
- (b) The full-text of over 85,000 defensive publications made by IBM dating back to 1958. Many of these publications pertain to software or systems that relate to the various business categories represented by the Class 705 subclasses listed in the USPTO Request for Comments.
- (c) Unknown

Accessibility

- (a) Available on the USPTO's in-house search system.
- (b) Unknown

Technical Support

- (a) Unknown

Continuity

- (a) Unknown

Mode of Access

Available on the USPTO's in-house search system.

5. IBM Journals: IBM Systems Journal and IBM Journal of Research and Development

This databases features the IBM Systems Journal dating back to 1994 and the IBM Journal of Research and Development dating back to 1993. These publications include articles related to software or systems that relate to the various business categories represented by the Class 705 subclasses listed in the USPTO Request for Comments.

Database Identification

- (a) IBM Journals
- (b) International Business Machines Corporation
- (c) Same as (b)

Database Content

- (a) From 1993 to current.
- (b) Articles related to software or systems including the various business categories represented by the Class 705 subclasses listed in the USPTO Request for Comments.
- (c) Documented publication dates are included.

Accessibility

- (a) The database is publicly available
- (b) 24 hours a day

Technical Support

- (a) Unknown

Continuity

- (a) Unknown

Mode of Access

The database is accessible online on the Internet via a web browser at <http://www.research.ibm.com/journal/>

6. Microsoft Knowledge Base

This database is recommended due to the wide range of Microsoft products supported, amount of material present, and user-friendly graphical user interface.

Database Identification

- (a) Microsoft Knowledge Base
- (b) Microsoft Corporation
Washington
- (c) Same as (b)

Database Content

- (a) Unknown
- (b) Microsoft Products Support
- (c) Unknown

Accessibility

- (a) The database is publicly available
- (b) 24 hours a day

Technical Support

- (a) Available

Continuity

- (a) Unknown

Mode of Access

The database is accessible online on the Internet via a web browser via <http://www.microsoft.com>

7. Microsoft Developer Network

This database is recommended due to the wide range of Microsoft products supported, amount of material present, and user-friendly graphical user interface.

Database Identification

- (a) Microsoft Developer Network
- (b) Microsoft Corporation
Washington
- (c) Same as (b)

Database Content

- (a) Unknown
- (b) Microsoft Developer Support
- (c) Unknown

Accessibility

- (a) The database is publicly available
- (b) 24 hours a day

Technical Support

- (a) Available

Continuity

- (a) Unknown

Mode of Access

The database is accessible online on the Internet via a web browser via <http://www.msdn.microsoft.com>

8. Research Index - The NCI Scientific Literature Digital Library

This database is recommended due to the very extensive documents and listings available, efficient and reliable search engine, ability to locate hard to find articles, journals, technical papers, etc., summary and document statistics, similar document citations, and related document citations.

Database Identification

- (a) Research Index, The NCI Scientific Literature Digital Library, NCI Research Institute
- (b) NCI Research Institute, Inc.
4 Independence Way
Princeton, New Jersey 08540-6634
(609) 520-1555
- (c) Same as (b)

Database Content

- (a) Unknown
- (b) Scientific literature in a variety of technical and business fields and disciplines
- (c) Document publication dates are included

Accessibility

- (a) The database is publicly available
- (b) 24 hours a day

Technical Support

- (a) Available via email.

Continuity

- (a) Unknown

Mode of Access

The database is accessible online on the Internet via a web browser via <http://citeseer.nj.nci.com/cs>

9. E-Commerce Times

This news article database is recommended due to its coverage and currency relating to Internet based businesses.

Database Identification

- (a) E-Commerce Times
- (b) E-Commerce Times
15260 Ventura Blvd., Suite 1420
Sherman Oaks, CA 91403 (USA)
- (c) Same as (b)

Database Content

- (a) Unknown
- (b) Literature in a variety of technical and business fields related to Internet businesses
- (c) Document publication dates are included

Accessibility

- (a) The database is publicly available
- (b) 24 hours a day

Technical Support

- (a) Available via email

Continuity

- (a) Unknown

Mode of Access

The database is accessible online on the Internet via a web browser at
<http://www.ecommercetimes.com/>

10. International Data Group

This news article database is recommended due to its coverage and currency relating to information technology and Internet businesses.

Database Identification

- (a) International Data Group
- (b) International Data Group
One Exeter Plaza
Boston, MA 02116-2851
- (c) Same as (b)

Database Content

- (a) Unknown
- (b) Literature in a variety of technical and business fields related to information technology covering a wide range of international publications
- (c) Document publication dates are included

Accessibility

- (a) The database is publicly available
- (b) 24 hours a day

Technical Support

- (a) Available via email

Continuity

- (a) Unknown

Mode of Access

The database is accessible online on the Internet via a web browser at

<http://www.idg.net/>

11. CMP Media

This set of news article databases is recommended due to its coverage and currency relating to a wide range of technical fields, particularly related to business and technology, including healthcare technology.

Database Identification

- (a) CMP Media
(b) CMP Media
Corporate Communications
516-562-5000
(c) Same as (b)

Database Content

- (a) Unknown
(b) Literature in a variety of technical and business fields related to information technology covering a wide range of international publications
(c) Document publication dates are included

Accessibility

- (a) The database is publicly available
(b) 24 hours a day

Technical Support

- (a) Available via email

Continuity

- (a) Unknown

Mode of Access

The databases are accessible online on the Internet via a web browser at

<http://www.cmp.com/totallist>

12. American Institute of Physics

This databases features access to magazines, books, journals, articles, and conference proceedings.

Database Identification

- (a) American Institute of Physics, Physics Today, The Industrial Physicist, AIP Conference Proceedings and Books, Online Journals, and SPIN Database
(b) American Institute of Physics
(c) Same as (b)

Database Content

- (a) Unknown - to current
(b) Access to Physics Today, The Industrial Physicist, AIP Conference Proceedings and Books, Online Journals, and SPIN Database

- (c) Unknown

Accessibility

- (a) Available online
- (b) Unknown

Technical Support

- (a) Unknown

Continuity

- (a) Unknown

Mode of Access

Available at http://webster.aip.org/site_search.html

13. E-inSite

This databases features access to publications, newsletters, and products.

Database Identification

- (a) E-inSite, The Electronics Industry Knowledge Network
- (b) Unknown
- (c) Unknown

Database Content

- (a) Unknown - to current
- (b) Access to numerous publications, newsletters, and products offered
- (c) Unknown

Accessibility

- (a) Available online
- (b) Unknown

Technical Support

- (a) Unknown

Continuity

- (a) Unknown

Mode of Access

Available at <http://www.e-insite.net/>

14. EDventure Holdings

This databases features a monthly technology report, PC forum, and high tech forum.

Database Identification

- (a) Edventure Holdings, Release 1.0, PC Forum, and High Tech Forum
- (b) Edventure Holdings Inc.
104 Fifth Avenue, 20th Floor
New York, NY 10011
Tel: 1 (212) 924-8800
Fax: 1 (212) 924-0240
Email: us@edventure.com
- (c) Same as (b)

Database Content

- (a) Unknown - to current
- (b) Covers software, the Internet, e-commerce, convergence, online services, Web applications, mobile commerce, groupware, data networking, streaming media, enterprise applications, wireless communications, intellectual property and other unpredictable topics
- (c) Unknown
- (d) Unknown

Accessibility

- (a) Available online
- (b) 24 hours a day

Technical Support

- (a) Unknown

Continuity

- (a) Unknown

Mode of Access

Available at <http://www.edventure.com/>

15. ESTIS Document Delivery Service

The Engineering, Science and Technology Information Service (ESTIS) provides scientific and business information to those outside the academic community as part of the public service mission of the University of Minnesota, a land grant institution.

Database Identification

- (a) ESTIS Document Delivery Service, ESTIS
- (b) University of Minnesota Document Delivery - ESTIS
158 Norris Hall
172 Pillsbury Dr SE
Minneapolis, MN 55455
Phone Number: (612) 624-2356
Fax Number: (612) 624-8518
- (c) Same as (b)

Database Content

- (a) Unknown - to current
- (b) Covers scientific and business information to those outside the academic community as part of the public service mission of the University of Minnesota, a land grant institution. Large databases of articles, journals, books, etc. are available through ESTIS
- (c) Usually contains bibliographic information
- (d) Both abstracts and full text is available

Accessibility

- (a) Available online
- (b) Unknown

Technical Support

- (a) Unknown

Continuity

- (a) Unknown

Mode of Access

Available at <http://www.lib.umn.edu/estis/>

16. National Academies

The National Academies provides access to numerous books and periodicals.

Database Identification

- (a) The National Academies, National Academy of Sciences, National Academy of Engineering, Institute of Medicine, National Research Council
- (b) National Academy of Sciences
2101 Constitution Avenue NW
Washington, DC 20418
202-334-2000
- (c) Same as (b)

Database Content

- (a) Unknown - to current
- (b) Covers numerous books and periodicals available including full text reports in a variety of technical fields
- (c) Unknown
- (d) Full text is available for some items

Accessibility

- (a) Available online
- (b) Unknown

Technical Support

- (a) Unknown

Continuity

- (a) Unknown

Mode of Access

Available at <http://www.nas.edu/>

17. TechWeb

This database provides definitions for numerous technical and non-technical terms in addition to access to numerous publications and news events.

Database Identification

- (a) TechWeb, The Business Technology Network, CMP, United Business Media
- (b) Corporate Communications
516-562-5000
cmp@cmp.com
- (c) Same as (b)

Database Content

- (a) Unknown - to current
- (b) Covers dictionary definitions for various terms in addition to access to numerous publications and news events

- (c) Publication dates are often provided
- (d) Full text is available for some items

Accessibility

- (a) Available online
- (b) 24 hours a day

Technical Support

- (a) Unknown

Continuity

- (a) Unknown

Mode of Access

Available at <http://www.techweb.com/>

18. Whatis.com

This database provides the ability to define and learn about various technology areas.

Database Identification

- (a) Whatis.com, techtarget, techtarget.com, what is tech target
- (b) whatis.com
117 Kendrick Street, Suite 800
Needham, MA 02494
- (c) Same as (b)

Database Content

- (a) Unknown - to current
- (b) Covers explanations of various technologies
- (c) Unknown
- (d) Unknown

Accessibility

- (a) Available online
- (b) 24 hours a day

Technical Support

- (a) Unknown

Continuity

- (a) Unknown

Mode of Access

Available at <http://whatis.techtargget.com/>