

# AIPLA

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AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

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January 15, 2004

Honorable Nicholas P. Godici  
Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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

Official Gazette: 23 December 2003

Dear Commissioner:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments on the subject notice.

AIPLA is a national bar association whose more than 15,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. The AIPLA represents a wide and diverse spectrum of individuals, companies and institutions involved directly and indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA supports and appreciates the efforts of the PTO to convert its operations to an electronic environment by adopting procedures and practices that will improve the effectiveness and efficiency of patent operations. We further support the concept of a pilot program to test and refine new practices before they are implemented on an Office-wide scale. Although we generally support the efforts of the PTO contained in the subject notice to convert its operations to an electronic environment, the comments we

have received from our members suggest that it is premature to implement the plan without further study, improvements to the system, and a longer period of time to prepare.

As we understand the plan, the PTO intends to (1) cease mailing copies of U.S. patents and U.S. patent application publications with Office Actions except for citations made during the international stage of a PCT International Application and those made during reexamination proceedings, and (2) provide electronic access to those documents via the PTO's Private Patent Application Information Retrieval (PAIR) System through a new feature called "E-Patent Reference." We understand that this plan will not involve or affect the current PTO practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions, at least until such time as substantially all applications have been scanned into the Image File Wrapper (IFW) System. The notice indicates that the PTO expects to implement its plan to cease mailing paper copies of U.S. patent references cited during examination of non-provisional applications as early as February 2, 2004.

We further understand that the PTO initiated on December 1, 2003 – some three weeks before the subject notice - a pilot program to evaluate the stability and capacity of the E-Patent Reference feature to reliably provide electronic access to cited U.S. Patent and U.S. Patent application publication references. During this pilot program, copies of these U.S. patent documents cited by Examiners will continue to be mailed with Office Actions, while applicants are only “encouraged” to use private PAIR and the E-Patent Reference feature to electronically access and download cited U.S. patent documents. Once an applicant has received the cited references, there is no incentive for the applicant to seek to download a second copy. The PTO states that this will enable it to objectively evaluate the performance of this new practice, but we seriously doubt the validity of this assumption. During this pilot program, registered practitioners and applicants not represented by a practitioner, are encouraged to experiment with this new feature, develop a proficiency in using the feature, and establish new internal processes for using the new access to cited U.S. patent documents to prepare for the anticipated cessation of current PTO practice of supplying copies of such cited references.

The AIPLA is concerned that the timing and design of the pilot program is not sufficient to provide the PTO with the information necessary to assess whether it is desirable or appropriate to implement its plan on an Office-wide scale at this time. We doubt a period of five and one-half weeks announced and begun during the end-of-December holidays, is adequate to fairly evaluate the concept and practice of not supplying U.S. patent references, and is certainly not adequate for many practitioners to adapt, develop and establish new practices. In addition, we doubt the pilot program that includes supplying copies of U.S. patent references is a fair test of a planned practice that will not include those copies when it is implemented. We suggest the pilot program be redesigned to include a time period when copies of U.S. patent documents are not

supplied with the Office Action, and that this practice be tested in a wide spectrum of technologies and types of practices--e.g., the sole practitioner, small and large law firms, small and large patent departments in corporations-- before it is implemented.

Based on the comments we have received, about 60 percent of which are negative and opposed to implementation of the proposed plan in the near future, we believe that the proposed plan will have a disproportionate adverse impact on small entities/parties and that even many large entities are not ready for the planned implementation. We would encourage the PTO to postpone the planned implementation and redesign its pilot project to test the viability of its plan, particularly with respect to small entities, small firms, and applicants not represented by a practitioner.

The PTO should recognize that optional practice features such as customer numbers and digital certificates have not been adopted by many, perhaps most, registered practitioners. The proposed plan to cease supplying U.S. patent documents with Office Actions would largely convert these optional tools of patent prosecution to mandatory equipment that must be used to conduct prosecution before the PTO (particularly when the plan is expanded to foreign patent documents and non-patent literature.) The comments we have received also would suggest that many practitioners are not even aware of and do not presently use these very useful features (customer numbers and digital certificates) of patent prosecution practice. These comments also suggest that even among those that presently use these features, many lack understanding of some of the benefits (e.g., up to two people can be listed and use a single digital certificate) and risks (e.g., a practitioner associating his/her name with more than one customer number and the potential for allegations of wrongdoing when the practitioner uses the wrong number) associated with their use.

As noted, AIPLA generally supports the efforts of the PTO to convert its operations to an electronic environment, but believe that implementation of this plan is premature in light of the concerns our members have expressed. Among the concerns raised by those who opposed the PTO plan were: (1) being forced to use the PTO customer number and digital certificate features to conduct patent prosecution before the PTO; (2) reliance on electronic distribution of references has significant reliability and bandwidth issues at both the PTO and applicant's ends; (3) the options of accessing commercial databases or the very slow page-by-page printing from the PTO website would increase the cost and time necessary to process a typical Office Action; (4) the PTO already has the infrastructure and staff for supplying copies of these documents that can perform this task relatively inexpensively; (5) the PTO's planned approach will have a disproportionate adverse impact on solo practitioners and those servicing small entities; and (6) the PTO should provide one-click access to these U.S. patent documents on its website before implementing this part of its plan.

Among the comments received by those who favored the PTO plan were: (1) the proposed plan is a step in the right direction to improve efficiency, reduce paperwork, and speed up the issuance of PTO actions; (2) many clients are converting to electronic files and do not want paper copies; (3) the PTO is going to do it anyway and there are more important issues that affect practice and procedure; (4) the PTO provided practitioners with an option to not provide paper copies of U.S. patent documents for Information Disclosure Statements submitted in applications filed after June 30, 2003, so we should accept the proposed change that will further reduce the exchange of paper between the PTO and applicants; (5) some comments, particularly from large firms and corporations, indicated that they had access to specialized software or services that make E-Patent Reference irrelevant for the purpose of obtaining copies of U.S. patent documents.

In summary, AIPLA believes the PTO should defer implementation of its proposed plan until it obtains better data on its potential impacts and ensures that systems are in place to address those impacts. This will require redesigning its pilot program to focus on the potential adverse impacts the plan could have on small entities, those with relatively small patent practices, and unrepresented applicants. Based on this information, the PTO will be able to develop appropriate systems to alleviate any adverse impacts it may find. We appreciate the opportunity to provide comments on the proposed plan and would be pleased to assist in any way we can.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael K. Kirk". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

Michael K. Kirk  
Executive Director