Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

IN RE: JOHN DOE
May 31, 1988

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Assistant Secretary and Commissioner of Patents and Trademarks

DECISION

Introduction

***1** On April 12, 1988, an order was issued in the case of John Doe (hereinafter Doe) to show cause why a serious breach of Patent and Trademark Office (PTO) regulations had not occurred and why his User Pass and visitor privileges should not be suspended or revoked. Specifically, Doe was charged with violating the following PTO regulations:

1) Visitors to the Patent Examining Group Search Areas must register with the designated Group Search Area representative indicating the times entering and leaving the area, User Pass number, and the class(es) to be searched. Section 2(f).

2) Documents removed from the files of Patent Examining Group Search Areas must be immediately returned to their proper location after use. Documents shall not be removed from the area in which they were obtained without specific written authorization from a Group Director or Supervisory Patent Examiner in the Examining Group where the material(s) reside. Such authorization will not be given for U.S. Patents and other material readily available through the Scientific Library. Section 2(g).

3) PROHIBITIONS

. . . Placing PTO files or documents, government property or government owned reference materials in rental storage lockers. Section 3(k).

Regulations Relating to the Use of Patent and Trademark Office Records or Search Facilities.' A hearing was held before the Commissioner on May 25, 1988.

Facts

On March 16, 1988, a PTO employee discovered a large number of PTO foreign references in a locker in the PTO's Patent Search Room. The PTO rents these lockers to members of the public. The lock of this particular locker (No. 61) did not operate. Along with these PTO references, certain papers identified as belonging to Doe were found in this locker. These materials were removed from the locker. On March 17, 1988, another large group of references were discovered in the same locker.

On that same day, Doe approached the PTO employees who had removed the references and requested the return of his personal papers. The personal papers were returned but the references (now totalling approximately 218) were retained. Doe has admitted that he did not follow proper PTO procedures when he entered the group Search Areas and removed the foreign references. The references had been removed from the Group Search Areas for at least several weeks. Doe attributed his violations of these PTO rules to the fact that his workload had greatly increased in the last several months and he took shortcuts to help alleviate the pressures created by this increased amount of work.

Opinion

In patent cases, the PTO has two important missions. First, it must examine patent applications and issue valid patents. Second, it must make information about patents readily available to businesses, other inventors, and members of the public. To help it meet its goal of issuing valid patents, the PTO has acquired vast amounts of resources which include U.S. patents, foreign references, and other technical literature. If the mission of the PTO was merely to issue valid patents much of this information would be restricted from public use to preserve the integrity of these records. Yet, the PTO has historically made these records available to the public so that private parties could make informed decisions in patent cases. The PTO took steps to balance the goals of document security and examiners' search file integrity with public access. U.S. patents are available to the public in the Patent Search Room by patent classification. The PTO regulations also allowed the public access to the Group Search Areas to search foreign references by classification. The removal of references from an examiners's search file by the public is allowed only with the permission of the appropriate PTO official.

***2** As with most Government institutions in a free society, the PTO was required to rely, to a certain extent, on the voluntary compliance on the part of the public with its procedures. The equally unpalatable alternatives were to either restrict public access or devote large expenditures of scarce public funds for elaborate security systems and additional security employees. Doe's decision to violate these PTO procedures for his own benefit was an extremely serious breach of those regulations. As a private searcher, Doe obviously knows how important it is to locate and search all relevant references before forwarding his search results to a client. Despite his own experience, he willfully deprived others of the opportunity to properly search the PTO's files. While it is unknown if any patents improperly issued because some of these references were missing from the examiners' search file, or if decisions were made by private parties without the benefit of the most pertinent references, Doe's violations of these PTO regulations make it possible that such consequences may have occurred.

It is also apparent that the PT may have relied too much on voluntary compliance by the public with PTO regulations and not enough on strict enforcement of its own regulations. Members of the public may have mistakenly belfieved that the PTO was not serious about the security of PTO foreign references. One of the purposes of this decision is to make it clear to the members of the public who use the PTO search facilities

that references must be promptly returned to the files and appropriate regulations must be followed.

Decision

There can be little argument that the removal of 218 foreign references from an Examiners' searchfile for several weeks without following established PTO procedures is a very serious breach of PTO regulations. Because of this Doe's User Pass and PTO visitor privileges are hereby revoked for a period of one year. In light of Doe's cooperation with the PTO in this case, his attitude at the hearing, his previous good record, and the possible misunderstanding on the part of the public of the necessity of strictly following PTO procedures when removing references, the final eleven months of the revocation of his User Pass and visitor privileges are suspended on the condition that Doe obey all PTO regulations set forth in 'Regulations Relating to the Use of Patent and Trademark Office Records or Search Facilities.' Doe's User Pass and visitor privileges will be revoked effective June 13, 1988.

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