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October 29, 2001

Acting Under Secretary of Commerce for Intellectual Property
and Acting Director of the United States Patent and Trademark Office
Washington, D. C. 20231

Attention: Ronald Hack, Acting Chief Information Officer

Re: Notice of Request for Comments on Development of a Plan
To Remove the Patent and Trademark Classified Paper Files
From the Public Search Facilities

Dear Mr. Hack:

We are members of a law firm that specializes in trademark law. Members of our firm have been using the Trademark Search Library of the United States Patent and Trademark Office since 1939. In addition, members of our family have been associated with the USPTO and its predecessor agencies since 1909. Therefore, we have had a close relationship with the workings of the trademark search facilities for close to a century.

Based on our knowledge and experience, we are very aware of the value of the data contained in the public search records. We are familiar with the many reasons that the public needs and uses the information contained in the records through our continuous relationships with and representations of individuals as well as small and large companies and corporations. In addition, we are and have been the Washington associates for many U.S. and international firms. We understand the need for maintaining the integrity of the valuable resources located in the public records of the USPTO. As a result of our constant daily working with the records, both automated and paper, maintained by the agency, we have been able to study the benefits and the problems that appear in each of the formats.

We do not object to the development of a plan to remove the trademark classified paper files from the public search facilities, provided that prior to the plan's implementation and removal of any paper files, the USPTO must completely demonstrate to the satisfaction of the user-public and the Congress that the automated records that replace the paper files are complete, up-to-date and reliable with respect to all of the data

currently maintained in the non-automated records. At the present time, the USPTO is unable to demonstrate this to the necessary extent.

The following issues are illustrative of the points that should be addressed prior to making a final decision:

Discrepancies in search results

In order to provide our clients with the most comprehensive and accurate information from the public records, we conduct searches of the paper and the automated records currently maintained in the Trademark Search Library. We continue to find discrepancies in both formats. We have documented and reported thousands of references in the paper records that are incorrect or inexplicably missing from the automated records. The problem is caused by several factors, including input errors, data maintenance and the limited capability to retrieve the information from the automated search systems. We have also discovered that information has been inexplicably purged from the automated search system. When inquiry has been made to USPTO officials, it is apparent that the problem had not been discovered internally and probably would not have been addressed if our inquiry had not been made.

Prior to the TICRS system, classified drawings for trademark applications covering stylized and design marks were, in many instances, clearer and easier to search in the paper records than in the automated search systems. While the manual and automated application drawings use the same TICRS drawing for 76/ and 78/ series, the search systems are different and present different searching capability. The high incidence of keystroke error in data entry permanently "misfiles" alphabetical based marks and fails to give notice by the automated system of the claimed trademark rights to the public. The design search system utilized in the classified paper records provides a quality control that enables correction of the design coding problems that have been described in the past as a "disaster" by Robert Anderson, now Deputy Commissioner of Trademarks. As noted above, we conduct search of both the paper and automated search records available in the Trademark Search Library. The PTO has made improvements in the automated system that aid searching and, in some search strategies, enhance search capabilities. At the present time, however, our clients will be damaged by the elimination of the classified paper drawings and registrations because the automated records alone fail to give notice of trademark rights.

It should be noted that commercial trademark search firms, which purchase the electronic data from the Office, place disclaimers on search reports that they are not responsible for "incomplete or inaccurate data provided by the U.S. Patent and Trademark Office."

Rise in Section 2(d) errors by examining attorneys

Moreover, at the Trademark Public Advisory meeting held earlier this month, comments were made by PTO officials pertaining to the rise in Section 2(d) errors by examining attorneys. Has the agency adequately reviewed this trend to see if the reason for the increase relates to the sufficiency of the automated search system? According to your notice, "the trademark examining attorneys rely solely on electronic records for examining and approving marks for Federal registration." Has the Office recently done any comparative searches of the paper classified records with searches of the electronic search records? We suggest that this would be a great tool to see the adequacies of both systems.

Incompatible electronic search systems

When we talk about the adequacy of the electronic records, which records are we discussing.

One of the problems with the PTO's automation projects centers on the existence of too many different and in most instances incompatible systems. According to a memorandum dated October 18, 2001 signed by Catherine Hollan, Manager Public Search Facilities, "in an effort to improve the quality of our products and services, Trademark Search Library patrons are reminded that discrepancies found in the various products can be reported using the 'on-line/electronic database discrepancy form' located at the information counter." Discrepancy forms are also available to report data difference in the paper and the automated search systems. Therefore, the public is providing quality control assistance and providing the Office with data to assist in the subject decision. Has this information been tabulated?

What information is needed by the public

In our opinion, officials looking into the subject issue do not fully understand how the Trademark Search Library is used. The Office is only concerned with 2(d) citations. They do not have any use for information relating to abandoned applications or cancelled or expired registrations; therefore, they do not maintain this information indefinitely in the automated records. It is maintained, however, in the paper records and the microfilm records in the Search Library. These records provides valuable information in the areas of possible common law use, marks that have run into problems in the past and ownership questions. We have been asked to find out about old marks. For example, we have been asked, "Who filed for this mark? Did anyone ever have a registration for this mark? or Did someone in Cuba or Czechoslovakia own a registration for this mark prior

to the country falling to a communist regime?" A significant portion of this "old" information was never entered into the automated search systems. As time goes by, will the Office delete similar information from its electronic databases as it was forced to do with the previous X-search system when it reached "data saturation?" If so, where will the permanent and complete records be maintained? Will the Office microfilm the paper classified registrations that have been marked cancelled or expired and the classified application drawings for marks abandoned since 1990 (the last time the records were purged) before disposing of the paper records? The microfilming of such records is a policy that has been in place for decades.

Past decisions made without proper data backup

Previously, the Office decided that it no longer wanted to maintain the original records for assignment and other changes in title recorded prior to 1955. The records were forwarded to the National Archives and Records Administration. The PTO did not make microfilm copies of the documents prior to forwarding them to NARA. Recently, we attempted to obtain copies of the documents. We made inquiry at the PTO and we were told that the assignment records in question were "no longer our records" and the PTO was "no longer responsible." Further, we were told that the Office did not know the location of the records.

Therefore, it was necessary for us to make numerous phone calls to locate the documents. When we finally contacted a person with knowledge of the records, we were told that she was unavailable for three weeks and because no one else knew how to use the records, we would have to wait until her return. We were also informed that the Archive records were not open to the public for search purposes; therefore, only by requesting specific documents, were we able to obtain the needed copies. The process took four months.

This proves that the Office must and should make complete federal trademark records available to the public in one place. If the Office completely satisfies the public and the Congress that the classified paper records may be disposed, the collection should be maintained intact. Transfer of the documents to the NARA will limit the public's access. What is the rationale for transferring the documents to another federal or state government agency that does not have any expertise in the area? This does not seem like an appropriate suggestion. Offering the collections for sale will limit the availability of the collection to the public and is not an appropriate alternative. Dividing the collection is not an option. The remaining alternative, transfer ownership of the collection to an educational or not-for-profit entity that agrees to keep them current and to make them available to the public (no exchange of money), may be a possibility; however, specifics must be outlined.

Good Faith Issue

We are deeply disappointed by the attitude recently shown by the agency as evidenced by the notice posted in the Trademark Search Library on October 18, 2001. Prior to the closing of the comment period for the above noted subject, the agency has already announced the "discontinued support for the paper classified drawings, also referred to as the pending drawings digest, effective November 5, 2001. After this date, no new information will be added to this collection. The paper classified drawings will be retained until the space is needed for other uses. Paper copies of classified trademark registrations will continued to be maintained in the Trademark Search Library until further notice."

Query: has the decision already been made?

For centuries the intent of a trademark from common law to statutory protection is to give notice of claimed rights. For over one hundred years the agency has maintained the paper classified records. The paper classified drawings have been maintained for public searching over half of a century since Commissioner Daphne Leeds recognized the importance of application drawings as an integral part of the Federal Register. Commissioners Samuels and Hampton, as former and future practitioners, continued the tradition to treat the drawings as part of the Register. It should also be noted that the former Patent and Trademark Commissioners faced extraordinary budgetary and agency constraints and, through their leadership, still managed to prioritize the needs of trademark notice to the public over internal agency desires to reduce such responsibility. Indeed, no practitioner would limit a search to registrations and no trademark examining attorney would either. It is incomprehensible that the agency would make the specious and insidious argument that it is not necessary to maintain the pending paper classified drawing records. It is also very strange that an administration would make such a finding and not proudly announce it to the bar or publish it in the Official Gazette. Indeed the Office has continued to maintain the paper classified drawings after implementation of the American Inventors Protection Act, thereby continuing the true spirit of the Lanham Act and giving practitioners reliance on the Office's actions. Congress has also made its intentions clear in letters from Representatives Howard Coble and Howard L. Berman to Acting Under Secretary Godici that the paper classified records were to maintained and any review of the maintenance was for the next permanent Director when appointed, not the interim administration. This view was reiterated by former Director Q. Todd Dickinson when he stated in San Francisco that the review of the paper classified papers was a task for the next Director.

Paper Record Singular Importance

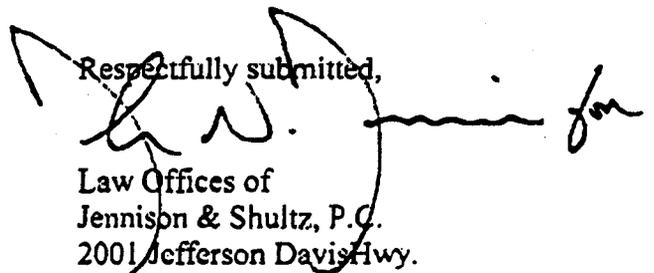
As discussed above, the paper classified records maintain registration certificates, application drawings and registration and application status data that are not available in the automated system, but they also maintain amendment, correction and status information that the Office has failed to capture and maintain in the automated search and status systems. Again, Mr. Anderson has discussed problems with such amendment and correction certificates that were filed in the search records but that all other copies were destroyed. The paper classified records also maintain 44(a) statutory required information that is not available and/or searchable in the automated records. We also agree with other comments made to the superiority of the paper classified records for searching nontraditional trademarks. We add that the paper classified search system is of such flexibility that new non-trademark search categories such as Fasteners or Indian Tribal Symbols can be easily initiated, maintained and reviewed.

Conclusion

Because the USPTO has not completely demonstrated to the satisfaction of the user-public and the Congress that the automated records that replace the paper files are complete, up-to-date and reliable with respect to all of the data currently maintained in the non-automated records, it is premature for the agency to cease to maintain, for use by the public, paper classified application and registration records, and it is premature to plan the removal of the records.

These comments were prepared by Ellsworth M. Jennison, Kathryn Jennison Shultz, John N. Jennison, Carl E. Jennison and other staff of the firm. Thank you for the opportunity to submit these comments.

Respectfully submitted,



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