

August 22, 2006

The Honorable Jon Dudas  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office  
Box Comments  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Mary Hannon  
Office of the Commissioner of Trademarks

Comments on Proposed Rules: "Removal of Paper  
Search Collection of Marks That Include Design Elements"  
71 Federal Register 36065 (June 23, 2006)

Dear Under Secretary Dudas:

The American Intellectual Property Law Association ("AIPLA") appreciates the opportunity to comment on the proposed rule to remove the paper search collection of marks that include design elements.

AIPLA is a national bar association whose more than 16,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, 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.

Currently, marks that include design elements are maintained in paper search files and in an electronic database. The paper search file, which contains a collection of registration certificates for active and some expired registrations, is maintained in a search facility located at 2900 Crystal Drive, Arlington, Virginia. The electronic database includes text and images of all marks in live registrations and pending applications, as well as marks in abandoned, cancelled and expired records dating back to 1984. The electronic database is searchable in the Public Search Facility on the premises of the USPTO (X-Search) and also on the USPTO Web site (Trademark Electronic Search System).

Different coding systems are used for the paper and electronic search systems. The paper design classification system, in which design marks are organized by specific designations (such as "trees," "grotesque humans" or "circles"), is unique to the USPTO. The electronic system uses the International Classification of the

Figurative Elements of Marks ("Vienna Classification") based on a multilateral treaty administered by the World Intellectual Property Organization.

The USPTO proposes to microfilm the existing paper search collection of marks and remove the paper files from the USPTO's Trademark Search Facility at 2900 Crystal Drive in Arlington, Virginia. Going forward, the USPTO would code new design mark registrations in its electronic search system with both the Vienna Classification and the design classification system that has been used to code the paper files.

Thus, a person searching design marks could search such marks using the Vienna Classification system in the electronic search systems and, from a date to be determined, could also search such marks using the current paper design classification which would be applied to new design mark registrations as they are placed into the electronic search system. For design marks registered before the date to be determined, they could be searched on microfilm using the current paper design classification.

AIPLA supports the USPTO's plan to provide the capability of searching design marks through the complimentary electronic and microfilm search systems. This approach should provide users with the same functionality they currently have through the combination of the electronic search system and the expensive-to-maintain paper search file. This new approach will have the added advantage of giving access to the current paper design classification to users outside of the Washington DC area. In this regard, although not required by the proposal to switch the back-file of design mark registrations from paper to microfilm, AIPLA believes that it would be desirable to add the classification on the design mark registrations in the paper back-file to the electronic search system as future resources permit. This would further enhance the utility of the electronic search system for users throughout the country.

Having determined that a paper collection of registered word marks is no longer necessary, the USPTO plans to remove that collection from its search facility in Arlington. Once the microfilming of the paper collection of design mark registrations is completed, the USPTO plans to remove these files as well. This would allow the Office to close its Arlington search facility and realize a savings it estimates to be in excess of one million dollars annually. Given these savings, we would support this planned course of action, with one caveat.

In discussions with Office personnel, we have been informed that there are ten microfilm readers currently in the Public Search Facility (PSF) at the USPTO campus in Alexandria, with space to add two more if needed. We have also been informed that the use of these readers is not great and that a reader is always available. While it may be that the number of readers will prove sufficient, we would urge the Office to make sure that the number of microfilm readers at the Alexandria PSF is sufficient to handle the anticipated volume of users who will be searching the microfilm of design mark registrations.

In this regard, we also note that the paper collection of marks containing designs will not be removed until the USPTO has certified that the implementation of

such plan will not negatively impact the public and that an additional notice to the public will be issued 60 days prior to removal. The Office should be able prior to such certification to address the question noted above.

We appreciate the opportunity to offer our comments and look forward to working with the Office to ensure a smooth transition to the new systems.

Sincerely,

A handwritten signature in black ink, reading "Michael K. Kirk". The signature is written in a cursive style with a large, stylized "M" and "K".

Michael K. Kirk  
Executive Director