

April 15, 2010

The Honorable Lynne Beresford  
Commissioner for Trademarks  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Comments on “Trademarks Next Generation” Information Technology Initiative

Dear Commissioner Beresford:

The American Intellectual Property Law Association (“AIPLA”) appreciates the opportunity to offer comments regarding the United States Patent and Trademark Office’s (“USPTO”) “Trademarks Next Generation” Information Technology Initiative, as set out in your March 1, 2010, correspondence and the Trademark Public Advisory Committee (“TPAC”) attachment.

AIPLA is a national bar association with more than 16,000 members who 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, 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 fully supports the USPTO’s efforts to improve information technology and create new systems to better support both internal and external Trademark procedures. You have kindly invited our comments, suggestions, and ideas that may relate to the specific automated and electronic functions that currently exist or potential new systems.

As a general comment, AIPLA encourages the USPTO to consider enhancements in information technology and automation implemented in other Trademark Offices as part of its initiative. The Trademark Law Treaty and Singapore Treaty have harmonized many procedural requirements across Trademark Offices. To further harmonize trademark practice and procedure, users should also have a relatively common experience across the electronic systems of all Trademark Offices. At the very least, these systems should be interoperable to permit a future where priority documents, assignments, and other common documents may be exchanged in a trusted electronic environment, and where Madrid applications can be filed internationally and enter into national processing completely electronically.

With respect to specific electronic/information technology features, our members are primarily external users and customers of the USPTO. Thus, we have focused our comments on proposed external system improvements and changes as set forth below.

### **Externally – Owner Trademark Portfolio Management**

1. *An option for automated “monitoring” service that notifies the requestor of certain status changes in any application or registration.* AIPLA supports this proposal. AIPLA is aware that the Office for Harmonization in the Internal Market (“OHIM”) is proposing to extend its e-tooling capability to permit users to automatically monitor third-party applications and registrations. In the OHIM system, the monitoring service is available to system “users” (i.e., applicants) who can access the service through a “MyPage” personal portal on a confidential basis. While it is not clear whether the USPTO is proposing a similar service, AIPLA believes that similar capabilities should be available through the USPTO system. The system should allow monitoring for system users’ own applications and registrations, as well as third-party applications and registrations. To the extent that private vendors already offer similar types of monitoring services, AIPLA considers this proposal a lower priority.
2. *A system that allows email alerts regarding the status of deposit accounts, including deposits made or withdrawn, is a welcome improvement.* AIPLA supports this proposal. The system should provide an option for the user to select the frequency of email alerts or to opt out of them. In addition to the deposit account, the system should allow an option for automatic credit card charging for all USPTO fees, including the ability to retain and store credit card information for routine use, overdrafts, and reoccurring fees, if the user agrees. The USPTO already offers a credit card option for filing fees, so that expanding the use of credit cards should be relatively easy to implement. A credit card option, or a credit card backup to a deposit account, may avoid the need for burdensome monitoring of deposit accounts and intermittent or emergency transfer of funds. Further, the credit card option may also make application filing and registration maintenance easier for *pro se* users. Any automated credit card system should have the appropriate encryption and safeguards to protect against credit card fraud and other privacy/disclosure issues.
3. *The automatic updating of ownership data when an assignment is filed and the online availability of the actual assignment documents as filed before the USPTO.* AIPLA believes that this proposal should be a high priority. Such information will assist trademark owners in maintaining the most current correspondence address of record. In addition, such information is important for, among others, those searching the trademark registry for possibly conflicting marks and those preparing and serving complaints in proceedings before the TTAB. To the extent that actual assignment documents contain confidential information, AIPLA recommends that the system provide a warning to users that such documents will become public record upon filing.

4. *A system that allows trademark owners or their representatives to manage application and registrations online, making real time changes to the application and registration files.* AIPLA needs more information in order to provide a meaningful response to this proposal, which has raised numerous questions and concerns. What types of real time changes to an application or registration are referred to? Can real time changes be made at any time during the pendency of an application, including after publication? How do real time changes affect an Office Action response period? How and when will an Examining Attorney review an application or issue an Office Action if the applications and/or cited registrations are subject to constant, real time changes? In addition, AIPLA is concerned that constant, real time substantive amendments to an application or registration (e.g., amending the identification of goods and services, the mark, or the basis for registration) may result in the dissemination of inaccurate or outdated information. For example, any searches of the USPTO database for possible conflicting third-party marks (prior pending applications or registrations) may be inherently unreliable or outdated because of real time changes made during or immediately after the search. That said, with appropriate safeguards, AIPLA believes that this type of system is worth exploring.
5. *An on-line “docketing system” that would permit either the attorney of record or applicant/registrant to view all their upcoming deadlines.* AIPLA supports this proposal. However, AIPLA proposes a system that permits users (particularly larger filers) to create personal portals to consolidate their portfolios (both applications and registrations) into a single view, not limited to files with current deadlines. These portals should include all oppositions and cancellation deadlines involving the user, including those that have been completed. That said, AIPLA believes that any docketing system should include a warning to users that they are ultimately responsible for monitoring and tracking the accuracy and timing of all ex parte and inter partes deadlines. In addition, there should be a warning that USPTO errors do not relieve the user of its responsibility for meeting deadlines. Further, an encryption system should be established to prevent unauthorized access to any docketing system. To the extent that private vendors already offer similar types of services, AIPLA considers this proposal a lower priority.
6. *Any automatic email reminders of upcoming deadlines should be tied to the online USPTO “docketing” system noted above.* AIPLA supports this proposal. As with any docketing or reminder system, however, the USPTO should adopt consistent timing intervals for reminders and allow users to opt for personalized reminders (e.g., frequency, type of reminder, opting out). As noted above, the reminder system should have a clear warning to users that they are ultimately responsible for monitoring and tracking the accuracy and timing of all ex parte and inter partes deadlines. In addition, there should be a warning that USPTO errors do not relieve the user of its responsibility for meeting deadlines. Such an automatic docketing or reminder system should be encrypted to prevent unauthorized access. To the extent that private vendors already offer similar types of services, AIPLA considers this proposal a lower priority.

7. *An automated system to maintain easily viewable lists of every version of the identification of goods or services that an applicant or registrant has submitted.* AIPLA supports this proposal, noting only that the system should be both easily viewable and accessible.
8. *The ability for users to create a customized “watch service” in order to be notified of third-party applications and registrations based on user input search strategies.* AIPLA supports this proposal, with similar features noted in response to No. 1 above.

#### **Externally – Ease of Use of System**

9. *Official Gazette (“OG”): (a) Links provided with the notice of publication open to the relevant trademark information rather than downloading the entire OG and (b) The OG is published in HTML rather than in PDF, with a download to PDF as an option.* AIPLA supports this proposal. In addition, the ability to search the OG by class, trademark owner, goods/services, etc., would be helpful.
10. *Direct email links to the relevant Examining Attorney are included within the record for ease of communication.* AIPLA supports this proposal and considers it a high priority item. The Examining Attorney’s email address is often omitted from the Office Action. With so many Examining Attorneys working remotely, it is often difficult to contact them to discuss an Office Action or enter an Examiner’s Amendment. AIPLA strongly supports efforts to improve mechanisms and systems to facilitate easier and efficient collaboration between the Office and its external customers.
11. *The website recognizes—to the extent possible—the level of expertise of the applicant or registrant.* AIPLA needs more information in order to provide a meaningful response to this proposal. It may be fine to provide helpful “wizards” when an applicant or registrant seems to hesitate or make inconsistent choices. On the other hand, a system that diverts inexperienced users to a simplified form or path may not lead to the appropriate trademark protection (e.g., inaccurate identification of goods or services or basis of registration). If the system diverts users to a simplified form or path, it should include clear warnings and hyperlinks to the relevant TMEP sections to educate the user about each choice taken or question asked by the system. Moreover, AIPLA disfavors a system that would permanently “track” or keep records of the performance or skill level of particular users. In particular, AIPLA does not believe the system should store or track non-public information, such as the searches a user has conducted.
12. *The filing system collects information and leads the user through the appropriate steps for what the user wants to do.* AIPLA incorporates by references its response to No. 11 above.

13. *New applicants and pro se users responding to an Office Action can be successful without knowing anything about the internal working of the Office. There will be a pre-built response form tailored to the office action that will identify all issues.* While a “pre-built” response may be helpful for addressing pro forma objections, an applicant should be able to opt out of a pre-built response to file a customized response or portion of a response. Moreover, the “pre-built” response should have links to the relevant C.F.R., TMEP, or TBMP authorities to assist the user.
14. *To the user, all USPTO records regarding a particular application/registration are seamlessly combined and accessible, whether from the Trademark Operation, the TTAB, the Assignment Division, or the Finance Office, resulting in total end-to-end electronic processing for all matters.* AIPLA supports this proposal and considers it a high priority. The lack of interface between electronic documents in trademark prosecution before the USPTO and in the TTAB (TTABVUE) is a major omission in the current system.
15. *Users filling out an application can peruse the USPTO ID Manual and in one step simply check off each ID to be inserted in the application.* AIPLA supports this proposal. However, AIPLA also believes that such a system should be optional. Moreover, any automatically populated information or fields should contain a clear message to users about the importance of accurate identification of goods and services, and the potential fraud and lack of *bona fide* intent issues.
16. *An easily available, up-to-date, process map on the web site that will link to up-to-date processing times for each application or registration.* AIPLA supports this proposal. However, to the extent that this proposal will primarily benefit only some inexperienced users, it should be given lower priority.
17. *Continued expansion of acceptable file formats: Systems will accept all popular file formats and users can retrieve information in a preferred format.* AIPLA supports this proposal and considers it a high priority. At a minimum, TIF, Word, and Open Document Format files should be acceptable file formats.
18. *Unusual formats such as sound and video can be accessed and stored in the electronic file (today the TICRs and TDR databases).* AIPLA supports this proposal.
19. *Development of a method to include all the attachments to an office action in a single file, as opposed to multiple files.* AIPLA supports this proposal.
20. *Constantly up-to-date, HTML versions of TMEP and TBMP.* AIPLA supports this proposal, with certain caveats. It is important to inform users of the time and date any changes are made to the manuals. AIPLA’s concern is that both the Examining Attorneys and practitioners (and *pro se* users) rely on the manuals in issuing and/or responding to Office Actions.

Thus, all users must know what version of the manual(s) (and corresponding rules of practice and procedure) were in place at the time the Office Action issued and/or the time the response was filed. Further, users should not be penalized in any way if changes are made to the manuals *after* a response or paper is filed with the USPTO or TTAB. Further, AIPLA also proposes adding a feature that would flag proposed or entered amendments to the TMEP, TBMP, and Trademark Rules of Practice and Procedure, including links to the relevant Federal Register notices (if any).

21. *Office Actions contain hyperlinks to cited C.F.R. and TMEP sections if the links can be kept updated as the TMEP itself is updated. A constantly updated TMEP/TBMP is the preference if the updated links cannot be achieved.* AIPLA supports this proposal. As noted in response to No. 20 above, however, certain safeguards should be in place to ensure that the Examining Attorneys and practitioners (and *pro se* users) know what version of the manuals and/or rules were in place at the critical time periods (*e.g.*, the time and date the Office Action issued and the response or paper is filed).
22. *Issuance of electronic certificates of registration with a paper certificate optional at extra cost.* AIPLA supports this proposal. AIPLA is aware that OHIM is working on a similar option. AIPLA recommends, however, that the electronic certificates contain an imprint or other electronic footprint to confirm authentication.

#### **AIPLA’s Additional Recommendations**

23. A system that allows users to perform multiple online actions at one time, such as mass renewal filings and changes of correspondence address across multiple application or registration files.
24. The ability to automatically populate new applications with an applicant’s previously accepted identification of goods or services which is otherwise publicly available, and to save, at the customer’s request, customized identifications of its goods and services to selectively import into new applications.
25. A searchable database of marks that interfaces with the IT systems of other Trademark Offices to allow multi-jurisdiction searches.
26. For Office Actions concerning relatively straightforward issues (*e.g.*, changes to the identification of goods or services or disclaimers), a TEAS (or similar) response button linked within or at the bottom of the Office Action to expedite response filings.

27. A system that allows Examining Attorneys and applicants (or their representatives) to improve communication and collaboration on relatively straightforward Office Action issues (*e.g.*, changes to the identification of goods or services or disclaimers), such as an automatic calendar and telephone call-in number link (similar to an Outlook invitation that may be accepted, rejected, or modified by participants) to arrange for a telephone or video conference to discuss issues.
28. A search tool that would allow users to simultaneously search all documents filed before and issued by the USPTO, including but not limited to the TTAB. An ideal search tool would access all USPTO trademark databases, and return a list of hits on things such as Office Actions, responses to Office Actions, orders, petitions and decisions on petitions, TTAB motions and decisions on motions, post-registration actions, TTAB final decisions, etc. The list of search results would, ideally, include hyperlinks to the actual texts of the documents. Such a tool would allow a user to search for a key word or phrase across all USPTO procedures, in order to permit them, for example, to see how particular rules or case holdings are currently being applied broadly within the USPTO. Similar tools are now available on commercial web sites, which tap into USPTO XML data, but we believe it would be better to have a single USPTO-based tool that would be reliable, complete and up-to-date. We believe that this type of search system would facilitate knowledge and utilization of current law and practice by users and USPTO officials alike, and would foster more efficient and consistent filings before the Office as well as decision-making by the Office.
29. Online webcasting of TTAB hearings.
30. Allow case cites in Office Actions and TTAB decisions to have hyperlinks to the full text of the cited decision or to the text of the rule in effect at the time.
31. Allow status updates on TARR to link automatically to the Office Action that is referenced, without having to go to the separate "TDR" page (the way it works on TTABVUE).
32. Conform all USPTO and TTAB electronic form documents so the user can forward each to a second party for signature (*e.g.*, electronic Recordation Form Cover Sheet and Request for Extension of Time to Oppose, Notices of Opposition). This system will allow multiple attorneys, clients, or paralegals to prepare and revise the forms and then forward them to the attorney for review and filing.
33. Implement an easier system for searching design marks. Currently, searching for design marks is an advanced search. There should be an easier system to conduct at least a preliminary design/logo search.

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AIPLA appreciates the opportunity to comment on this important initiative. Please contact us if you would like us to further consider the initiative and/or provide more details on any issue.

Sincerely,

A handwritten signature in black ink, appearing to read "Alan J. Kasper". The signature is fluid and cursive, with the first name "Alan" and last name "Kasper" clearly distinguishable.

Alan J. Kasper  
President  
AIPLA