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April 21, 2010

Lynne Beresford
Commissioner for Trademarks
United States Patent and Trademark Office

(Via email to: TMideas@USPTO.gov)

Dear Commissioner Beresford:

We thank you for the invitation to comment on the USPTO's "Trademarks Next Generation" initiative.

The views expressed in the attached commentary are those of the Section of Intellectual Property Law of the American Bar Association. They have not been submitted to or approved by the ABA House of Delegates or Board of Governors, and should not be construed as views of the Association as a whole. These technical comments are within the Section's primary and special expertise, and were approved by the Section Council on April 16, 2010.

The ABA Section of Intellectual Property Law ("ABA IPL Section") is the largest intellectual property organization in the world and the oldest substantive Section of the ABA. Since 1894, we have advanced the development and improvement of intellectual property laws and their fair and just administration. As the forum for rich perspectives and balanced insight on the full spectrum of intellectual property law, the ABA IPL Section serves as the ABA voice of intellectual property law—within the profession, before policy makers, and with the public.

In light of the time period given to respond, our comments are directed to the list of ideas submitted by the Trademark Public Advisory Committee ("TPAC") which were attached to the March 1, 2010 Request for Comments. Specifically, we enumerate those TPAC ideas which we accept without change or comment, those to which we had comments or changes, and those which we do not support. We also set forth new ideas offered by the ABA IPL Section. The TPAC ideas highlighted in italics below are those that the ABA IPL Section requests be given priority. The paragraph numbers used below correspond to the TPAC list enclosed with the March 1, 2010 Request for Comments.

If you would like more information regarding the ABA IPL Section's positions on these issues, please contact Hayden Gregory, our legislative consultant for intellectual property issues by telephone at (202) 662-1772 or by email at gregoryh@staff.abanet.org.

Sincerely,



Don W. Martens
Chair
ABA Section of Intellectual Property Law

Response of the ABA Section of Intellectual Property Law to the Request for Comments from United States Patent and Trademark Office Commissioner for Trademarks Beresford dated March 1, 2010 regarding the Trademarks Next Generation Project

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I. TPAC IDEAS ACCEPTED BY THE ABA IPL SECTION WITHOUT CHANGE OR COMMENT

Externally

A. Owner Trademark Portfolio Management

2. Deposit Accounts: Mail alerts to the deposit account owner when deposits are made or withdrawn, or when the balance reaches a certain level, so that the applicant/registrant or attorney of record has current deposit account information.

5. An on-line “docketing system” is created that would permit both the attorney of record and the applicant/registrant to view all their upcoming deadlines.

7. USPTO automated systems maintain easily viewable lists of every version of the identification of goods or services that the applicant has submitted.

8. There is the ability for users to create a customized “watch service” in order to be notified of third party applications, etc., based on user input search strategies.

B. Ease of Use of System

9. *Official Gazette: (a) Links provided with the notice of publication open to the relevant trademark information rather than downloading the entire OG. (b) The OG is published in HTML rather than in PDF, with a download to PDF as an option.*

10. *Direct email links to the relevant examiners are included within the record for ease of communication.*

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.

17. Continued expansion of acceptable file formats: Systems will accept all popular file formats and users can retrieve information in a preferred format.

18. Unusual formats such as sound and video can be accessed and stored in the electronic file (today the TICRs and TDR databases).

19. *Development of a method to include all the attachments to an office action in a single file, as opposed to multiple files.*

20. *Constantly up-to-date, HTML versions of TMEP and TBMP.*

Internally

23. Examining attorneys will have a docketing system in which they can check applicable deadlines for filings related to any appeal of a final refusal to the TTAB, and can set the TTABVUE system to send them an e-mail or other communication reminding them of approaching deadlines and notifying them of filings by the applicant with the Board.

24. The TTAB's system will include docket management applications and the capability of producing for TTAB management and employees reports on productivity and timeliness of actions taken in regard to pending cases.

25. There is full electronic processing in from the time of application to the post registration process — including TTAB, OTQR etc.

28. All functionalities available to employees in the Office will be available remotely.

29. IT costs should stabilize, rather than increasing every year. In the most recent five years, the OCIO budget has had an increase each year. Although there have been claims that investing in newer, better technology or processes will reduce those costs, typically that has not been the result. The hope would be that once systems are developed in the target configuration, that costs would be contained and stabilized.

30. Provide real-time monitoring of Trademark resources on the network.

31. Plan and identify requirements and cost estimates in collaboration with business units and programs to develop strategic priorities in coordination with the budget formulation process to ensure funding exists to deliver on priorities.
32. Use the exhibit 300 and 53 process to coordinate IT projects with the budget request.
33. Develop a measure, in conjunction with Trademark management, to track that projects are on time and on budget.
34. Track performance and Return On Investment (ROI) for existing and planned systems.
35. Understand what systems cost now to enable reasonable future cost estimates.
36. Design, implement and enforce a Service Level Agreement commensurate with a high performance agency.
37. Provide intuitive report writing capabilities and support to users for extracting workload, financial, production, revenue, cost budget etc. linked data.

II. THE ABA IPL SECTION'S COMMENTS AND/OR CHANGES TO CERTAIN ENUMERATED TPAC IDEAS

Externally

A. Owner Trademark Portfolio Management

1. *The original TPAC idea read: "There is an option for an automated 'monitoring' service that notifies the requestor of certain status changes in any application or registration". The ABA IPL Section suggests that before this measure is implemented, the following issues should be considered: (1) The type of criteria a requestor could use to identify the applications or registrations for which status updates would be provided; (2) Whether the system would pick up newly filed applications meeting said criteria; and (3) Whether information about the identity of a party requesting information and the search criteria used would be public information.*
3. *Assignments:*
 - a. *automatic update to ownership data when an assignment is filed;*
 - b. *a PDF of the actual assignment document filed is available, not just a summary.*
 - c. *The ABA IPL Section suggests the following be added: Use of a method similar to Customer Numbers at the Patent Office, which would allow a registrant or attorney of record to automatically update address changes for all applications or registrations associated with that number.*

4. The original TPAC idea read: “Trademark owners or their representatives can manage application and registrations on line, making real time changes to the application and registration files.” The ABA IPL views this suggestion as currently drafted as ambiguous and potentially problematic. There are practice and procedural considerations for almost any change to an application's or registration's content. The ABA IPL Section would like more information regarding the proposed “real time changes” and the limits, if any, on when such changes could be made and by whom.

B. Ease of Use of System

21. *The TPAC's original idea read: “Office Actions contain hyperlinks to cited C.F.R. and the 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.” The ABA IPL Section requests this idea be changed to read as follows: Provide hyperlinks to all applications and registrations cited in an office action, and to all cited C.F.R. and TMEP sections (if the links can be kept updated as the TMEP itself is updated).*

22. The TPAC's original idea read: “Issuance of electronic certificates of registration with a paper certificate optional at extra cost.” The ABA IPL Section requests that the idea be clarified by inserting “,at no extra cost,” after registration.

Internally

26. The TPAC's original idea read: “Certain kinds of information are automatically supplied to examining attorneys at the time the application is first assigned (e.g. surname search, geographic search, computer dictionary, prior TTAB decisions).” Before being implemented, the ABA IPL Section requests that following issues be considered: (1) Who will conduct the research - would additional law office paralegal positions be added, or would Legal Instrument Examiners be tasked with this responsibility? Currently, the only paralegals within the Trademark Office are located in the Petition's Office and the TTAB. (2) Is an automated electronic system being considered? And (3), will the Examining Attorney be required to rely on the results from the preliminary search, or will they have the option to conduct additional research without penalty?

27. The TPAC's original idea read: “The USPTO can easily modify the drawing of the mark submitted by applicant so that the drawing is clear, appropriately sized, and if the mark is in color, the colors displayed are accurate.” The ABA IPL Section asks, would the USPTO's modification of the drawing of the mark be subject to applicant's approval through an Examiner's Amendment?

III. TPAC IDEAS NOT SUPPORTED BY THE ABA IPL SECTION

Externally

A. Owner Trademark Portfolio Management

6. The TPAC's original idea read: "Mail reminders can be sent automatically, as opposed to the more passive situation where the owner of record, either applicant or attorney of record can access the system to see deadlines. Note that USPTO errors in this area would not relieve the user of responsibility for meeting deadlines." The ABA IPL Section notes that requiring the Office to send out reminders seems like a potentially costly and unnecessary undertaking, especially since they cannot be relied upon. It would seem that the Office's resources and energy could be better spent on other projects. However, if this suggestion is implemented, the ABA IPL suggests that the following be considered: (1) How will notification errors by the USPTO be addressed? (2) How will the USPTO clarify who is sending the reminders (e.g., avoid scams, give clarity for pro se applicants? and (3) Will the practical effect of this notice result in changing existing law?

The ABA IPL Section believes that each of the following ideas proposed by TPAC is already inherent in the current system. Accordingly, the ABA IPL Section does not support their adoption because they are unnecessary:

11. The website recognizes—to the extent possible—the level of expertise of the applicant or registrant.

12. The filing system collects information and leads the user through the appropriate steps for what the user wants to do.

13. New applicants and *pro se* applicants 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 that the applicant must respond to.

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.

16. There's 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.

IV. ADDITIONAL IDEAS SUGGESTED BY THE ABA IPL SECTION

Externally

B. Ease of Use of System

- *Create a consistent placement of buttons for “back,” “next” and “clear” functionalities within all USPTO electronic filing systems.*
- Include a feature in the TMEP and Trademark Rules of Practice posted on the USPTO that would inform trademark customers of proposed changes to the rules of practice and procedure. The feature would flag sections of the TMEP and the Rules for which a proposed amendment is being considered and would include a hyperlink to the Federal Register notice containing the proposed rule changes.
- For older registrations for which the procedural history is tagged as unclassified, when such a registration is the subject of a Board proceeding or appeal, the electronic file should be updated to classify the relevant file history.