International Trademark Association
Representing the Trademark Community since 1878

Via Electronic Mail
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USPTO Strategic Plan
Coordinator
P.O. Box 1450
Alexandria, VA 22313-1450

The International Trademark Association (INTA) hereby submits its response to the request for comments by the U.S. Patent and Trademark Office (USPTO) on the agency's proposed strategic plan for 2007-2012.[1] INTA wishes to commend the USPTO and its leadership, especially Director Jon Dudas and Commissioner for Trademarks Lynne Beresford, for their efforts to continually drive the trademark operations forward and improve service for trademark owners and practitioners. INTA views strategic planning by the USPTO as a vital step in ensuring that the agency is able to meet the changing needs of its customer base. INTA welcomes the opportunity to provide further input in the process and particularly notes the continued efforts to use technological advances. Since the reliance on technology will increase, INTA strongly encourages the appropriate allocation or dedication of IT personnel and resources to the trademark operations that are the backbone of this proposed plan.

We provide below specific comments on aspects of Goals 2 and 3 in the proposal.

Goal 2: "Challenges and Opportunities"

Proposal: Work with the administration to identify options for securing long-term funding stability and flexibility to adjust fees in order to create a predictable and orderly operating environment for providing certainty for applicants with the ability to make and carry out cost-effective investment decisions.

Response: INTA certainly supports creating a more predictable and orderly operating environment for the USPTO, and we are committed to working with the agency to make that happen. This includes a dialogue on new options for budgetary planning. However, we note that the matter of USPTO fee diversion remains a very real possibility, and

[1] 71 Fed. Reg. 50048 (2006).

would need to be addressed prior to INTA agreeing to any proposals granting the USPTO greater flexibility in its fee setting authority.[2]

Goal 2, Objective 1: "Develop alternatives for predicting workloads, processing and managing the workforce and assigning work, reduce post-examination time by consolidating or eliminating redundant functions, and attract, hire and retain a highly qualified workforce."

Proposal: Achieve and maintain three month first action pendency by actively managing total inventory relative to production capacity with work assignments based on monthly production capacity.

Response: INTA supports reducing first action pendency to three months, but cautions that it should not be done at the expense of examination work product or quality and overall process efficiency. For example, allowing disposal pendency to languish in favor of first action pendency would not be an acceptable alternative. Staffing and funding are not typically susceptible to rapid monthly reallocation responsive to disposal pendency fluctuations. In any streamlining of available staffing and funding levels, INTA strongly urges the USPTO to incorporate initiatives which improve not only pendency but also improve the quality and efficiency of examination. Furthermore INTA encourages the USPTO to timely update and develop the quality, availability and accessibility of information resources used in examination (including technical updates and improvements).

Proposal: Regarding approval for publication, approved files to be reviewed immediately following approval by examining attorney and, where necessary, routed, corrected, and returned to publication queue quickly. Compressed printing schedule for Official Gazette to reduce several weeks of time also contemplated.

Response: INTA requests clarification from the USPTO as to the specific changes, including to post-approval application review, processing, workflow, job duties, responsibilities and performance plans, contemplated by this proposal. Illustrative examples will aid in a final assessment of this proposal. To the extent these proposed changes enhance the overall quality of examination and the issuance of a registration, INTA supports such improvements.

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[2] *See*, Statement of Kathryn Barrett Park, Executive Vice President of the International Trademark Association, Before the House Subcommittee on Courts, the Internet and Intellectual Property, July 18, 2002, at http://www.inta.org/index.php?option=com_content&task=view&id=680&Itemid=152&getcontent=3; Submission Of INTA On USPTO Strategic Plan, Agency Funding, and The Madrid Protocol Before the House Subcommittee on Courts, the Internet and Intellectual Property, April 3, 2003.

Proposal: Transfer most statement of use examination responsibilities to non-attorneys, leaving examining attorneys to handle only substantive issues raised, allowing greater focus on other examination.

Response: It is the understanding of INTA that the USPTO is undergoing pilot projects to assess allowing non-attorneys to approve statements of use when no substantive issue arises. INTA understands that the USPTO currently uses non-attorneys to review already non-substantive issues involving "informalities." In so far as the USPTO will continue to obtain attorney review for substantive issues, INTA supports this proposal.

Proposal: Expand the successful work at home program and continue to hire and train new examining attorneys in order to create a workforce that can maintain first and final action pendency at agreed upon goals.

Response: INTA believes that the work at home program has been successful and supports expanding this benefit offered to examining attorneys. We do recommend that USPTO continue or enhance mandatory educational activities and seminars for those trademark examiners who work at home so that they remain familiar with office procedures.

Goal 2, Objective 2: "Improve quality of examination by ensuring consistency and quality of searching and examination and provide internal on-line tools."

Proposal: Continue quality improvements that began with the adoption of a new quality standard and quality review process in FY 2003, which has resulted in a measurable improvement in examination quality as measured by deficiencies or errors.

Response: INTA understands that "final action deficiency" measures only final refusals and seeks confirmation that FY 2006 will show a reduction in such deficiencies. INTA supports any efforts to improve quality review measures that will result in overall improvements to the registration process.

Proposal: Starting in FY 2007, add 8,000 quality review results per year to those considered by piloting manager and senior reviews in the examining attorney evaluation process to assist in identifying problem areas requiring further guidance and training.

Response: In so far as this proposal seeks to improve quality review measures, INTA encourages and support such efforts. INTA understands that the USPTO will redefine "final action deficiency" beyond final refusals to include any type of final disposition of the application. INTA generally favors any efforts to improve the quality of the examination and registration processes.

Proposal: Manuals and work steps for examination functions will be created and updated, and will be made accessible through a comprehensive process map in development which documents application process work flow. Currency will be ensured to "process owners."

Response: INTA generally favors updating all source materials and status data, but has insufficient information and background by which to assess and comment on the specific changes contemplated by this proposal. Furthermore, INTA generally favors increased public accessibility to USPTO source and status information, and requests the USPTO take this into consideration in updating, developing and implementing systems and processes.

Proposal: Reassess and automate functions and procedures with a view to creating on-line dockets which permit closer tracking, assignment and monitoring of work. Revising employee performance plans in accordance with electronic work-flow and file management implementations to ensure establishment of accurate work evaluation and quality review measures.

Response: INTA generally favors continued automation of functions and processes, so long as sufficient safeguards exist to ensure reliability, accuracy and completeness.

Proposal: Pilot and then implement a more thorough quality review process for both final actions and other disposals.

Response: INTA understands that the USPTO is expanding what "final actions" should cover in order to provide a more accurate measurement for quality review. INTA supports this proposal, which we anticipate will improve the existing USPTO procedures for review and consideration of applications approved for publication, and the correction of procedural and substantive errors.

Goal 2, Objective 3: "Provide electronic file management and workflow by the end of FY 2009"

Proposal: Integrate existing electronic systems and make better use of sharing applicant data internally and improving official notifications by sending e-mail links instead of e-mailing office actions with large attachments.

Response: INTA confirms the growing problems with USPTO e-mails such as office actions containing large attachments which cause delivery delays or prevent delivery of the e-mails and/or attachments to the applicant or registrant. INTA strongly supports this initiative and urges the USPTO to implement this proposal quickly or consider a more immediate interim solution.

Goal 2, Objective 4: "Develop interactive on-line electronic filing capabilities by 2010 and upgrade e-tools."

Proposal: Create web based search tool encompassing databases enabling searching for confusingly similar marks as well as other information sources for evaluating descriptiveness and generic significance and the ability to identify trends and new terms as well as other potentially substantive examination issues.

Response: INTA generally favors upgrades which streamline and consolidate existing systems to enhance examination efficiency, but is concerned that the systems implemented are accurate, reliable and complete and promote consistency and quality of examination. Permitting public access should also be a significant consideration in the implementation of such systems. Such access enables the public to use and share in the improved system and information resulting in a better user experience.

Proposal: Begin to design TEAS to incorporate new technologies and user expectations, assisting new filers and increasing efficiency for experienced filers.

Response: INTA supports this proposal, but would appreciate more details on the nature of the new technologies contemplated by the USPTO.

Proposal: By 2010, create an on-line accessible docketing management system for attorneys and applicants to view and submit changes to files using customer accounts to manage a docket of cases and receive reminders and correspondence.

Response: INTA generally favors an on-line docketing system, so long as issues of security, access, unauthorized altering of application information and data, as well as accuracy and completeness of docket information are adequately considered and addressed. INTA looks forward to receiving more detailed plans as this idea comes closer to fruition.

Goal 3: Improve Intellectual Property Protection and Enforcement Domestically and Abroad

Goal 3, Objective 1: "Support efforts and initiatives aimed at strengthening intellectual property protection and curbing theft of intellectual property."

Proposals: Expand Foreign Postings of IP Experts; expand Global Intellectual Property Academy; expand training and capacity building; and negotiate and implement IPR chapters of Free Trade Agreements.

Response: INTA supports all of these proposals. In particular, we encourage:

- the provision of technical assistance and funding to governments seeking to upgrade trademark registration systems and enforcement of trademark rights;
- working with the World Custom Organization to facilitate exchange of information between Customs on exporters/importers of counterfeit merchandise;
- the posting of a USPTO enforcement official in an embassy in Africa;
- initiatives designed to work with other governments to establish prohibitory regimes against exports of counterfeit goods;
- working with other governments to take appropriate steps to ensure that all counterfeit goods are compulsorily destroyed, definitively removed from channels of commerce, or disposed of with the rights holders' consent where there is no health or safety risk;
- working with other governments to strengthen their criminal laws against counterfeiting;
- coordination and training between the U.S. and other governments, particularly with respect to Customs and border enforcement; and
- more activities directed to local businesses via industrial and commercial associations, to show, in a practical manner how local businesses may benefit from adequately protecting their properties.

Goal 3, Objective 2: "Continue efforts to develop unified standards for international IP practice."

Proposals: Advocate progress in IP-related norm setting bodies and develop guidance for electronic filing and processing. Specifically, the USPTO will increase electronic processing efficiencies in the U.S. and abroad; reduce redundancies among IP Offices; and work toward harmonization of the treatment of geographical indications.

Response: INTA supports these proposals, and with respect to the harmonized treatment of geographical indications, we respectfully urge continued consideration by the USPTO that protection of geographic indications must not prejudice other existing intellectual property rights, including trademarks. Harmonious co-existence of geographical indications and trademarks is possible as long as conflicts between these rights continue to be resolved pursuant to the well-established intellectual property principles of territoriality, exclusivity and priority. The priority principle espoused by INTA means that a validly registered prior mark should prevail against a later geographical indication and vice versa.

Goal 3, Objective 3: "Provide policy guidance on all domestic IP issues."

Proposals: Promote domestic policies that advance the effectiveness of IP. Initiatives, including IP reform proposals. The USPTO will establish IP enforcement reform focus groups to address other domestic policy issues to incorporate the principles of certainty, cost efficiency, accessibility, and quality through legislative and rule.

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Response: INTA supports these proposals and volunteers to participate as a member of the IP enforcement reform focus group on trademarks.

Proposals: Maximize best practices from TTAB decisions, including the achievement and maintenance of an enhanced level of precedential decisions (60-80 per year); citation of non-precedential decisions in briefs filed will be permitted no later than FY 2007, with use of those citations to identify needs for precedential decisions beginning in FY 2008.

Response: INTA supports all efforts to maximize the precedential value of TTAB decisions including the instructive use of non-precedential decisions.

Goal 3, Objective 4: "Foster innovation and competitiveness by delivering IP information and education worldwide, and providing effective customer experiences in obtaining USPTO services."

Proposals: Promote the importance of IP through community outreach and public awareness, including: expanded role for USPTO as IP leader; increased familiarity of the public with IP resources available through the USPTO; China road shows; Intellectual Property Awareness Campaign events; increased information provided to the general public on global IP and trade issues; expanded awareness on scam prevention; legislative and rule changes that would address accessibility and add clarity to a process that is not easily administered by the office or well understood to those outside the legal IP profession; and script suggestions to the USPTO's main call center, which will help USPTO better "triage" incoming calls.

Response: INTA supports the majority of these proposals. We will reserve our position, however, on the generally referenced legislative and rule changes pending their release and our review.

INTA appreciates the opportunity to submit its comments on the proposed strategic plan. We look forward to working with the agency as it finalizes this proposal. Should the USPTO have any questions concerning the INTA submission, please contact External Relations Manager Michael Heltzer at (212) 642-1741.

Sincerely,

Paul W. Reidl
President