



International Trademark Association  
Representing the Trademark Community since 1878

*Via Electronic Mail*  
TMSearchComments@uspto.gov

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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Attention: Mary Hannon

The International Trademark Association (INTA) hereby submits its comments to the proposal of the United States Patent and Trademark Office (USPTO) on "Removal of Paper Search Collection of Marks That Include Design Elements."<sup>1</sup> According to the Federal Register notice, once the USPTO has developed and tested a new coding system for design marks, it will no longer add copies of design-coded registrations to the paper search collection. At that time, it also will begin to microfilm the paper search collection of design marks. When the microfilming is complete, the USPTO proposes to discard the paper search collection of design marks.<sup>2</sup> Consistent with its comments to the USPTO's 2001 proposal on the removal of the Office's paper search files,<sup>3</sup> INTA does not object to the removal of the paper search files containing design marks, provided "that the automated records that replace the paper files are complete, up-to-date and reliable."<sup>4</sup>

INTA understands that the USPTO has made great strides to upgrade the accuracy of data in the automated trademark search system, and appreciates that significant improvements in design coding have been achieved over time. For example, the reduction in error rate for the period November 2005 through April 2006, as stated on page 36067 of the Federal Register notice, is remarkable.<sup>5</sup> However, our members have voiced concerns about the existence of errors in earlier electronic design coding, which we understand is based upon the subjective perceptions of outside contract employees as to what the design marks consist of. Past errors are not likely to be corrected without a special undertaking. With this in mind, our members who utilize the paper search facilities rely upon the paper search files as a valuable means of determining when and what errors have occurred in the electronic design coding. We note that the USPTO's proposed new design-coding system will not be applied to the backfile (*i.e.*, records existing as of the time the new system is implemented). Therefore, once the paper design search files are reduced to microfilm and the hard copies are destroyed, verifying the accuracy of the design search records will be very difficult, if not impossible. Ideally, before any destruction or conversion of original search records is begun, there should be a verification of existing design records.

To promote continued improvements to the new design search system, INTA offers the following suggestions. First, we recognize that there are unique challenges in color mark coding. In the older paper files, colors were indicated by a lining system and/or provided in the description of the mark field and filed

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<sup>1</sup> 71 Fed. Reg. 36065 (2006).

<sup>2</sup> *Id.*

<sup>3</sup> *See*, INTA Response to USPTO RFC on Development of a Plan to Remove the Patent and Trademark Classified Paper Files from the Public Search Facilities, September 21, 2001.

<sup>4</sup> *Id.*

<sup>5</sup> Although we note a prior sample taken between September 2005 and November 2005, 1792 submitted requests for correction of design codes and pseudo marks resulted in 1583 corrections. *See* 71 Fed. Reg. 36066-67.

according to the pertinent color group. Therefore, if the description for a given mark included the word “aqua” or “teal,” the drawing may or may not have been included in the system as a “blue” mark, and thus may not have later been entered into the electronic search system as a “blue” mark. Similarly, an electronic search of “blue marks” would not necessarily disclose a mark originally described as “aqua” without searching for every possible term relevant to a shade of blue. It would appear that establishing a “universal” code for all shades of a given color would not only capture the data now in the paper system, but also would standardize color descriptions in the electronic system. Therefore INTA asks that the USPTO consider this as it formulates its plans for the electronic design coding system.

Second, INTA suggests that broader categories of design codes also be available for selection on the electronic form. In the paper files, one could select an option for categories such as “mammals.” Having such broader categories in the electronic system would avoid problems where relevant marks are not disclosed in a search because the specific category searched, for example, “giraffe,” discloses no relevant marks, but in fact, a nearly identical design exists, coded as a horse.

Third, in an effort to facilitate *pro se* applicants’ correct use of design codes in electronic applications (and conversely, to avoid continuing problems created when they enter incorrect data in the applications), it would be helpful for the USPTO to establish explicit directions for utilizing the electronic design coding system in electronic applications for design marks. If appropriate design codes are entered in the applications, this will improve the integrity of the information that appears in the electronic search database.

INTA appreciates the opportunity to submit its comments on the proposed changes to the maintenance of files by the USPTO. Should the USPTO have any questions or comments concerning the INTA response, please contact INTA External Relations Manager Michael Heltzer at (212) 642-1741.

Sincerely,



Paul W. Reidl  
President