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August 22, 2006

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1415

Via email TMSearchComments@uspto.gov

Attention: Mary Hannon, Esq.

Re: Request for Comments on Removal of Paper Search Collection of Marks That
Include Design Elements

These comments are in response to the *Federal Register* Notice dated June 23, 2006, as
above identified.

As a point of introduction, Jennison & Shultz, P.C. is a law firm that specializes in
trademark law. Since 1939, members of our firm have utilized the records contained in
the U.S. Patent and Trademark Office (previously known as the U.S. Patent Office) on a
daily basis. Our firm is very familiar with the contents of the paper and electronic search
systems of the U.S. Patent and Trademark Office (USPTO) and members of our firm
have been considered experts in the field. As a matter of fact, our founder Ellsworth M.
Jennison, Sr. was called upon many times by USPTO officials to teach new examiners
how to search these records.

Jennison & Shultz, P.C. is pleased to note that the USPTO has finally identified plans to
improve the electronic trademark records for the public and taken certain steps to
improve the quality and integrity of its electronic search system.

In 2002, in response to a previous notice issued by the USPTO, members of this firm
stated that they did "not object to the development of a plan to remove the trademark
classified paper files from the search facilities, provided that prior to the plan's
implementation and removal of any paper files, the USPTO must completely demonstrate
to the satisfaction of the user-public and the Congress that the automated records that
replace the paper files are complete, up-to-date and reliable with respect to all of the data
currently maintained in the non-automated records."

While the members of this firm appreciate the very recent improvements that the USPTO
has initiated or announces that it will implement, the USPTO has not demonstrated that

the automated records are complete, up-to-date and reliable with respect to all of the data currently maintained in the non-automated records.

We note that on April 4, 2006, the USPTO began sending notices to applicants inviting them to correct or add to the pseudo-mark field and that the USPTO considers this “an optimal quality check, since applicants have the strongest interest in assuring that the public can find their applications and registrations.” It is our opinion that this is not the “optimal quality check,” for a number of reasons including the facts that a large percentage of the applicants are *pro se* and one time filers, who do not have knowledge about USPTO pseudo mark or design code entries, and some applicants do not have the strongest interest in assuring that the public can find their applications. An applicant’s strongest interest is obtaining a registration with a certain inherent, limited interest in giving notice of her claimed rights in the mark until registration is secured.

On the other hand, *registrants*, especially those with incontestable marks, have the strongest interest in making sure that the public is on notice and can find their trademarks when searches are conducted of the USPTO’s records by the public and the examining attorneys. We therefore recommend that the USPTO initiate a quality check invitation to owners of all “live” registrations, including those recently issued and those with renewal and affidavit filings, to assist the Office in its quality control. The implementation of such a review to upgrade the word, pseudo-mark and design element fields of all registrations, in addition to the application invitation, would have the capability of vastly improving the quality check of the trademark registration data.

However, the full responsibility for the maintenance and integrity of the federal trademark records must fall on the capable shoulders of the USPTO whose primary mission is to maintain a complete and accurate federal register for the public. The public and the Congress have placed their trust in the Office to meet its responsibilities.

Therefore, because studies conducted by Price Waterhouse and NIPRA of the trademark application and registration data, and ones performed either internally by the USPTO and by interested members of the public, have identified unacceptable error rates ranging from 54% to 18%, it is incumbent for the USPTO administration to not be derelict or negligent in its duties, but to assume its mission, perform its work and accomplish the goals as befitting an agency of its caliber. This is the job of no less than the Under Secretary of Commerce for Intellectual Property and Director of USPTO, and this firm stands willing to assist him and his good offices. However, the Under Secretary cannot accomplish his goal without the full cooperation of his staff and the full disclosure of the status of the automated efforts to the public. Any omission or lack of full disclosure by staff members will expose the Under Secretary’s congressional testimony to doubts of validity, veracity and credibility.

Pseudo-Marks.

The Pseudo-mark field was added to the electronic system to assist users in locating relevant marks. A pseudo-mark consists of spellings that are similar or phonetically

equivalent to a word mark. The electronic pseudo-mark field is not unlike the tens of thousands of hand written annotations and additional filings under the “pseudo-mark concept” initiated and instituted in the more than 100 year old paper search records system. For example, under the paper search records the mark “XL” would be filed under the two letters as well as the word “EXCEL.” These paper record annotations provide an additional search tool for locating intentionally altered spellings or misspellings of normal English words, phrases or initialisms. To date, the USPTO has not reviewed the existing paper records to incorporate these paper record annotations and additional search filings entered by the capable and experienced Search Library staff members, who have assisted members of the public in locating potentially confusing marks.

Proposed Changes: Word Marks.

The USPTO has declared that, with respect to Word Marks, the electronic search system provides equivalent functionality to the paper files, and plans to remove the paper collection of active and expired registrations that consist only of words. Unfortunately, such a move at this time would adversely affect the public and increase the difficulty of searching for active records that contain certain hand written annotations (pseudo-marks), certificates of corrections, amendments, marks under Article 6ter of the Paris Convention, and United States agency notices.

As discussed above, the paper search records contain tens of thousands of annotations and pseudo-mark paper filings that have not been entered in the automated system. Further, with respect to a considerable number of registrations, the paper search records hold the only filed copies of amendments and certificates of corrections issued by the USPTO. Duplicate copies were not placed into the bound volumes that contain the copies of the original registrations in numerical order. Because the Office only used the bound volume copies for the creation of the USPTO X-search database, the database does not contain a complete record including these amendments and corrections. Additionally, other electronic record shortcomings and data absence relate to marks protected under Article 6ter of the Paris Convention and United States government agency notices that only exist in the paper records for search location and duplication.

Therefore in light of the data only found in the paper records, the USPTO claim that “even absent the microfilming project (of the paper collection), removal of the paper collection will not negatively impact the public” is patently untrue. To conduct searches of the microfilm records is a time consuming and onerous task. These records are kept in a separate room than the Search Library, supervised by separate members of the USPTO staff with specific machines and in a separate environ. The necessity of utilizing the microfilm to complete a full and complete search adds considerable costs to the quick and efficient use of the paper records.

Further, we have learned that after the recently performed 2006 project to microfilm drawings for pending applications and abandoned applications located in the paper search records, it was discovered that approximately 10,000 drawings were missed and not

microfilmed. This is further evidence that the USPTO continues to encounter problems with the implementation of its plans. Once the original paper documents are destroyed, it is nearly impossible to go back and correct the problem when an oversight such as this occurs.

Proposed Changes: Design Marks.

In the *Federal Register* the USPTO states that “[t]he paper design classification system, in which design marks are organized by specific designations is unique to the USPTO.”

We agree.

Further, in the *Federal Register* the USPTO states that it is developing a new design code field to be added to TESS and X-Search which will *mirror the paper search files.* (Emphasis added.) After development of the new coding system, the USPTO will test it, begin coding all design marks in incoming applications and new registrations, stop adding design coding registrations to the paper collection and begin microfilming the paper search collection.

Unfortunately the USPTO does not state what the test is or if the new coding system has to pass the test prior to cessation of maintenance of the paper search records.

It is important to note that in 2002 the USPTO planned to remove the paper search records despite testing that identified an error rate of above 54%. Thus the act of testing should not be accepted as an act of faith.

Further, the USPTO states it will remove the active design search records (“backfile”) that contain the very system that only new application and registration records will have, and which the new system is intended to mirror. Thus the backfile of active registrations containing design marks will be relegated to, or buried in microfilm and the result will negatively impact the public’s efficient and quick access. (Again we note the USPTO’s abysmal performance in 2006 of microfilming pending application and abandoned trademark drawings from the paper search records that missed approximately 10,000 drawings, and thus one can reasonably predict that the plans to prematurely remove and microfilm the paper search records will negatively and adversely impact the public.)

Below, for illustrative purposes, we will note some examples of active registrations that would be missed for search purposes if the USPTO goes forward with its plan as outlined. The inability of locating the registrations would not only adversely and negatively impact the public but potentially damage registrants’ notice rights and cost registrants considerable funds in defending against innocent infringers.

It is extremely important that the Office finally recognizes the point that when, for example, a *pro se* applicant has missed a registered or pending mark in his or her search and files for an application, considerable costs are incurred and burdened by several parties- costs that may be avoided were the automated trademark data quality improved.

These several parties include the *pro se* applicant, the registrant with priority rights, the USPTO examining corps, the Trademark Trial and Appeal Board (TTAB), other applicants and the general public.

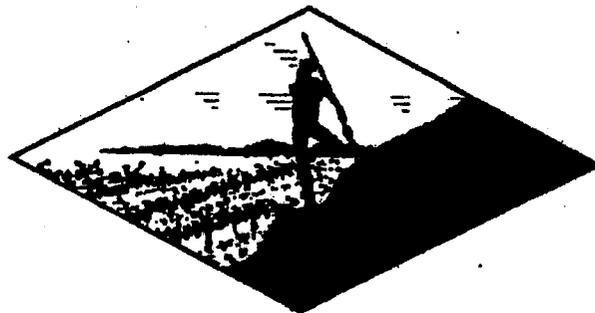
The applicant's costs are incurred by loss of the application fee; the good will associated with adopting the trademark; printing, advertising and promotion costs; and the time required for clearing and adopting a new trademark. The registrant's costs are incurred by increased watch and legal services as it must enforce its trademark rights against innocent infringers with legal actions. The USPTO's costs are incurred with the filing of letters of protest or petitions that are based on evidence that the examining attorney has missed an exact or confusing similar citation because the mark is not properly entered into the electronic search records. The TTAB costs are incurred when a registrant with priority locates the published application or recent registration and institutes an adversary proceeding that was avoidable with quality trademark data.

The USPTO should not negligently act to adversely and negatively impact the public notice of trademark rights as required by the Lanham Act, and increase stakeholders' external costs to accomplish the all electronic environment as proposed in the *Federal Register*.

The following are registrations with word or design elements that are easily located in the Trademark Search Library paper search records, but would not be located by critical design or word elements that a *pro se* member of the public in the expected electronic X-search or online search strategies:

1) Registrant: E. & J. Gallo Winery
Registration No. 2,427,598

Mark



Design Coded by USPTO Electronic Records: Men, mountains, marinas, cemeteries, canes, diamonds, labels.

Critical Missing Design Code: Fields, vegetation.

2) Registrant: E. & J. Gallo Winery
Registration No. 2,169,695

Mark

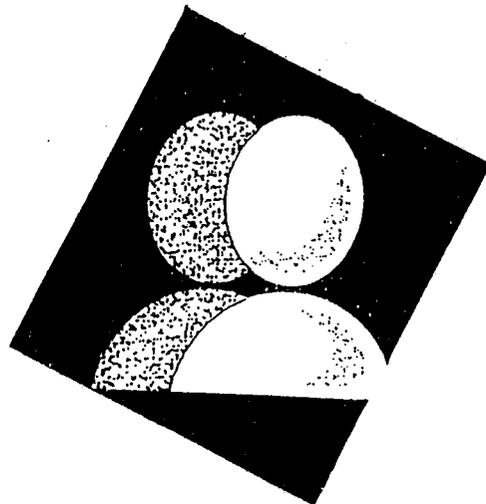


Design Coded by USPTO Electronic Records: Cacti, labels, rectangles.

Critical Missing Design Code: Lizard, grotesque animal, cross.

3) Registrant: Microsoft Corporation
Registration No. 2,378,045

Mark

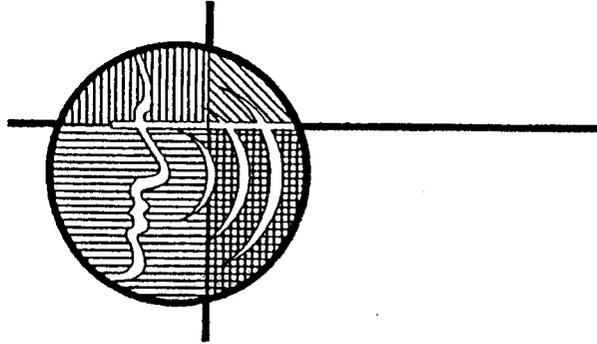


Design Coded by USPTO Electronic Records: Circles, ovals, squares.

Critical Missing Design Code: Humans, grotesque humans.

4) Registrant: Microsoft Corporation
Registration No. 2,388,356

Mark

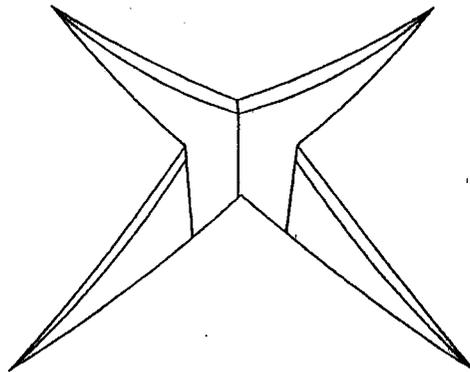


Design Coded by USPTO Electronic Records: Circles, bands, bars, lines.

Critical Missing Design Code: Human face, grotesque human.

5) Registrant: Microsoft Corporation
Registration No. 2,915,065

Mark

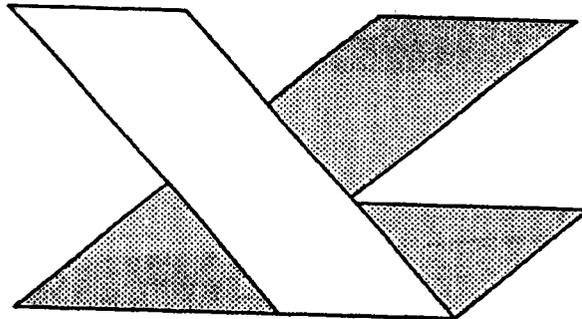


Design Coded by USPTO Electronic Records: Star.

Critical Missing Word Mark & Pseudo Mark: Letter "X."

6) Registrant: Microsoft Corporation
Registration No. 1,626,863

Mark



Design Coded by USPTO Electronic Records: Triangles, quadrilaterals.

Critical Missing Word Mark & Pseudo Mark: Letter "XL."

7) Registrant: Exxon Mobile Corporation
Registration No. 2,389,377

Mark



Design Coded by USPTO Electronic Records: Circles, ovals, bands.

Critical Missing Design Code: Human face, grotesque humans.

8) Registrant: United States Golf Association
Registration No. 2,356,274

Mark



Design Coded by USPTO Electronic Records: Sunrise, oval, bands.

Critical Missing Design Code: Golf ball, sports equipment.

9) Registrant: March of Dimes Birth Defects Foundation
Registration No. 2,637,996

Mark

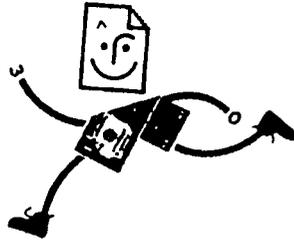


Design Coded by USPTO Electronic Records: Objects forming a person, snowman.

Critical Missing Design Code: Mother and child, grotesque humans.

12) Registrant: Citicorp.
Registration No. 2,513,264

Mark

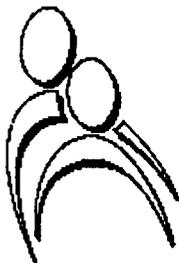


Design Coded by USPTO Electronic Records: Human, footwear, bands, objects forming person, snowmen.

Critical Missing Design Code: Currency, dollar bill.

13) Registrant: Kimberly-Clark Worldwide, Inc.
Registration No. 2,802,895

Mark



Design Coded by USPTO Electronic Records: Circles, bands, curved lines.

Critical Missing Design Code(s): Humans, grotesque humans.

14) Registrant: SBC Communications
Registration No. 2,675,159

Mark



Design Coded by USPTO Electronic Records: Circles, bands.

Critical Missing Design Code: Ovals.

15) Registrant: AT&T Corporation
Registration No. 1,936,038

Mark



Design Coded by USPTO Electronic Records: Circle, bands.

Critical Missing Design Code: Triangle.

16) Registrant: Philip Morris Incorporated
Registration No. 1,647,064

Mark



Design Coded by USPTO Electronic Records: Fire, smoke, drops, cigarettes, circles.

Critical Missing Word Mark Pseudo Mark: Letter "S."

17) Registrant: Preferred Computer Trading Corporation
Registration No. 2,921,021

Mark



Design Coded by USPTO Electronic Records: Squares.

Critical Missing Design Code: Ship, boat.

It can not be overstated. It is in the best interests of the trademark owners and the public in general that the valuable information contained in the USPTO's records is complete, accurate, and easily accessible by all. It has a direct impact not only on the trademark owners, but on the United States and international economies. The USPTO should use all of its resources to ensure that none of this information is lost forever by the premature elimination of the paper search records.

Our firm, as always, will continue to work with and assist the USPTO in its efforts to safeguard the integrity and completeness of the federal trademark records. The USPTO should not eliminate the valuable search tools only available in the paper records until such time as it can be established that the electronic search system contains all searchable information currently located in the paper search records. At the present time, this is not the case.