

Trademark Office Public User Society

2518 Fort Scott Drive
Arlington, VA 22202

September 24, 2001

Under Secretary of Commerce for Intellectual
Property and Director of the United States
Patent and Trademark Office
Washington, DC 20231

Att: Ronald Hack, Acting Chief Information Officer

Re: **Docket No. 010126025-1025-01: Notice of Request for Comments on
Development of a Plan To Remove the Patent and Trademark Classified
Paper Files From the Public Search Facilities**

Dear Sir:

The Trademark Office Public User Society is an affiliation of professional trademark research firms and individuals who make use of the United States Patent and Trademark Office Public Search Facilities to conduct all manner of trademark research. Our customers include practically all intellectual property practitioners and either directly or by extension virtually every Fortune 500 entity. We submit the following comments on behalf of the Society to convey our grave concerns regarding the proposed elimination of the classified paper files from the Public Search Facilities.

We believe that the request for comments is premature. The request should not be for comments on the development of a plan to remove the files but rather whether the files should be removed at all. As the electronic records and search systems for both patents and trademarks are fraught with errors, omissions and search engine integrity issues, the paper records constitute the only check on the veracity of the electronic data and are thus essential to conducting a valid and reliable search. Given the problems and inaccuracies of the electronic databases, any action by the Office to remove or otherwise make the paper file less accessible to the public would result in searches replete with the database errors and result in unnecessary litigation, infringement proceedings and questions of liability, the ultimate cost of said proceedings being borne by any potential applicant affected by said searches.

Although the total cost of such proceedings is inestimable, those costs pale in comparison to the affiliated costs of advertising campaigns and materials, printing plates, etc. that will

have to be destroyed as a result of those search errors. Indeed, the aggregate administrative, litigation, business costs are incalculable and do not include the additional penalty of the loss of good will and brand identity in the market place.

As such, we advocate the retention of the paper file until such time as the integrity and validity of the electronic record is the equivalent of a parallel search of both the paper and electronic records.

Further, prior to any decision to remove the paper file, the Society believes that following information should be released by the Patent and Trademark Office:

1. The OMB analysis and comments of the notice, issues identified by OMB and the reasons for the ninety-day period between submission and publication of the notice.
2. Any reports submitted to the Committees on the Judiciary of the Senate and the House of Representatives detailing the plan to eliminate the paper files.
3. Details of the significant investment in the public search tools as it relates to trademarks as such information is not available in previously released budgets. Such details should include planned and actual expenditures from 1981 to 2001, identify each expenditure and its relation to public search tools versus in-house PTO search tools, identify shared expenditures for public and in-house systems, identify exclusive expenditures for both public and in-house systems, identify PTO depository library expenditures by location, product, service expenditures, staff, staff support, consulting expenses and overhead for the years 1981-2001.
4. Identify the USPTO portion of investment of fee income in the maintenance of trademark and patent databases as well as the development and enhancement of software and hardware search systems.
5. Explain the rationale of eliminating the paper file while allowing patent examiners to retain some paper files for purpose of examining and approving applications for patents.
6. Identify financial incentives, proposals and counter proposals offered to or by patent examiners to obtain their agreement on the phased elimination of the examiners' paper search files.
7. Confirmation that the USPTO is on schedule to complete its relocation and consolidation at the Carlyle campus in 2004 and delineate what if any components of the agency will not be located at the new campus.
8. Identify the amount of space to be allocated for the public search records and systems at the new campus and how the relocation will impact the maintenance of the public records.
9. Provide all reports, white papers, memoranda and executive decisions regarding decisions or policies for the placement and maintenance of the public records at the Carlyle campus.
10. Identify and provide details, including financial infrastructure, on the current USPTO planning approach to the dissemination of patent and trademark information and enhancements to patent and trademark databases.

11. Identify and provide details on the electronic capture of trademarks to include the cost per page, average cost per file for each processing stage of the application process for both paper filings and electronic filings.
12. Identify and provide details on the expected shelf life of digitized information by storage medium, plans for future technologies and expected changes to ensure the maintenance of digitized data for the next 25 years.
13. Identify and provide details on plans to recapture data lost in any past or future data migrations from one medium to another.
14. Identify what data has been lost by the USPTO in past data conversions or captures.
15. Identify the cost of maintaining digitized data by year for the years 1981-2001.
16. Identify all software programs used by the USPTO for patent and trademark data for the years 1981-2001, the reasons why programs are no longer used, the shelf life of each program, and programs that were not used for their expected service life.
17. Identify what programs did not meet their expected utility and the costs of each such program.
18. Identify how many registrations, amendments, corrections, etc. are missing from USAMARK, the reasons for their omission and plans to capture the missing data.
19. Identify and quantify the unavailability of the TESS and X-Search systems during the years 1999, 2000 and 2001 particularly noting the dates and number of hours for said dates that the systems were down.
20. Identify the dates and numbers of hours for each instance when TESS and X-Search systems did not give complete or accurate search results or experienced data loss for the years 1999, 2000 and 2001, and identify the reasons for such problems and how those problems came to the attention of the USPTO.
21. Detail all USPTO efforts to inform the examining corps and the public of problems with USPTO data systems.
22. Detail the USPTO estimation of the database search requirements and needs of the examining corps.
23. Detail the USPTO estimation of the database search requirements and needs of the public.
24. Detail the measures planned to ensure data quality upon elimination of the paper file.
25. Detail plans to ensure that an archival record of all patents and trademarks is maintained.
26. Identify each and every "non US trademark or service mark" mark required to be maintained on the register under 15 U.S.C. 11226(a) [44(a)] or by congressional statute, including WIPO and Fasteners Act. Explain which marks are and are not maintained on TESS and X-Search.
27. Identify total funds collected through the Patent Search Room and the Trademark Search Library from 1981-2001, including photocopy and microfilm machine usage.
28. Identify what assignments and recorded documents are not available on the PTO automated systems.
29. Identify with specificity the trademark classified search files maintained in the search library.
30. Identify with specificity all non trademark classified search files records maintained in the search library.

31. Explain the PTO's proposed backup system of search records in the event of unavailability of the automated records due to viruses or other contingencies.
32. Explain why only a thirty-day comment period was originally set with the notice, given the public's usage of the classified search files for over one hundred years.

We respectfully request that the comment period be extended at least for ninety days after receipt of the answers to the above listed questions.

Sincerely yours,

A handwritten signature in black ink, appearing to read 'Daphne Hammond', written in a cursive style.

Daphne Hammond, President