

# AIPLA

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

2001 JEFFERSON DAVIS HIGHWAY ■ SUITE 203 ■ ARLINGTON, Virginia 22202

October 29, 2001

Mr. Nicholas Godici  
Acting Under Secretary of Commerce for Intellectual Property and  
Acting Director of the United States Patent and Trademark Office  
United States Patent and Trademark Office  
Washington, D.C. 20231

Attn: Ronald Hack, Acting Chief Information Officer

Re: AIPLA Response to the USPTO's "Notice of Request for Comments  
on Development of a Plan to Remove the Patent and Trademark  
Classified Paper Files From the Public Search Facilities"  
66 Fed. Reg. 45012 (August 27, 2001)

Dear Acting Under Secretary Godici:

On October 9, 2001, the American Intellectual Property Law Association (AIPLA) submitted its views regarding the plan to remove patent paper files in response to the Notice of Request for Comments on Development of a Plan To Remove the Patent and Trademark Classified Paper Files From the Public Search Facilities, 66 Fed. Reg. 45012 (August 27, 2001). We are now in a position to augment those views with our comments on the plan to remove the trademark paper files.

The AIPLA is a national bar association of more than 13,000 members engaged in private and corporate practice, in government service, and in the academic community. The AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

As with the patent paper files, the AIPLA understands the burden on the USPTO of maintaining both electronic and paper collections of United States trademarks. We recognize that the USPTO must ultimately transfer or dispose of its paper collection.

With regard to the integrity of the data, it appears that most trademark attorneys, trademark owners and other interested members of the public are already, and have been for years, relying on the data in the automated systems. This is because the majority of persons and companies that conduct trademark searches prior to adopting a trademark do so either by using the USPTO's web-based automated systems or by employing private trademark search firms that maintain databases compiled

from electronic data purchased from the USPTO. A smaller number of users use the automated systems available on terminals and workstations in the public search library. So the vast majority of PTO customers and users of their data are already relying on the automated data to make important decisions regarding trademarks.

The USPTO has embarked on a program to encourage its customers to file trademark applications and other papers electronically and, in fact, has recently published a Federal Register notice seeking comment on its plans to make electronic filing of these documents mandatory. Currently about 25% of all applications are filed electronically. As the number of electronically-filed applications increases, either through voluntary use of the Office's electronic filing system, or if e-filing becomes mandatory, it makes less sense to maintain the paper file, as the source of most records will be electronic, not paper. In fact, the classified paper records in the public trademark search library are currently printed from the USPTO's electronic records.

The functionality and reliability of the systems and equipment used to access the data has been improved over the years and appears to be adequate. The USPTO's trademark examining attorneys rely on it exclusively when performing pre-allowance searches of newly filed applications. The functionality of the systems allows searching that is more efficient and flexible than in the paper file, where a manual alphabetical search must be performed.

It must be noted that a relatively small number of trademark practitioners and searchers, primarily based in the Washington, D. C.--Northern Virginia area, still use the paper file, generally in conjunction with the electronic systems, to perform searches and look-ups. While the USPTO should work to address any lingering concerns that those users may still have about the adequacy of the automated systems, the fact that most users in the US currently rely on the automated systems and records is powerful evidence of the sufficiency of those systems. At the very least, the USPTO should ensure that there will be an adequate number of terminals and workstations available to meet the additional demand caused by removal of the classified paper files.

Finally, it must be noted that the cost of maintaining the paper records is for the most part funded by application fees paid by all trademark owners. This money would be better spent in improving the Office's automated systems. In that regard, while this Association believes that the electronic systems and data are sufficiently accurate and reliable to allow elimination of the classified paper records, clearly the systems and data are not perfect and can be improved.

For the foregoing reasons, the AIPLA supports the USPTO's plan to eliminate the classified trademark paper records from the public search library.

Sincerely yours,

A handwritten signature in black ink that reads "Michael K. Kirk". The signature is written in a cursive, slightly slanted style.

Michael K. Kirk  
Executive Director