

**REPORT OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
CONCERNING THE PAPER SEARCH COLLECTION OF REGISTERED
MARKS THAT INCLUDE DESIGN ELEMENTS**

SUMMARY: The United States Patent and Trademark Office (“USPTO”) has developed a plan to provide the public with access to United States trademark registrations that include design elements exclusively through its electronic search systems and through microfilm. Under the plan, the USPTO will microfilm, then remove from its Trademark Search Facility in Arlington, Virginia, the paper search collection of trademark registrations that include design elements. The USPTO has determined that the combination of the upcoming enhancement to its electronic search systems and the microfilming of the existing paper search collection will permit the same search functionality through these media as has been available through the paper search collection. This plan will permit the public to search for and retrieve information on trademark registrations that include design elements, in accordance with 35 U.S.C. § 41(i)(1). The USPTO Director has determined that implementation of this plan will not negatively impact the public, and is concurrently submitting a certification to that effect.

Section 4904(d)(1) of the American Inventors Protection Act of 1999 (“AIPA”) provides the USPTO the option of maintaining, *inter alia*, its collection of United States trademark registrations in electronic form. Section 4804(d)(2) of the AIPA requires that the USPTO not cease to maintain for use by the public its paper or microform collections of, *inter alia*, United States trademark registrations, except pursuant to notice and opportunity for public comment, and except where the USPTO Director has first submitted a report to the Committees on the Judiciary of the Senate and the House of Representatives detailing a plan to do so. No such statutory obligation exists for trademark applications. The report on elimination of a paper or microform collection must certify that the implementation of the plan will not negatively impact the public, and must include a “description of the mechanisms in place to ensure the integrity of such collections and the data contained therein, as well as to ensure prompt public access to the most current available information.” *Id.*

Section 41(i)(1) of Title 35 requires the USPTO to maintain for use by the public “paper, microform, or electronic collections of . . . United States trademark registrations arranged to permit search for and retrieval of information.” The requirement does not apply to trademark applications. The “paper, microform, or electronic collections” of registered marks must together allow for the requisite information search and retrieval. The USPTO’s enhanced electronic databases, coupled with the microform collection to be created from the paper search collection, will provide the same search functionality currently available through a search in the electronic databases and the paper search collection of registered marks that include design elements. The elimination of this paper search collection will allow the USPTO to channel resources previously devoted to the maintenance and upkeep of the paper collection toward maintenance and improvement of its electronic databases, which are more widely accessible to the public.

The USPTO published its proposed plan in the Federal Register on June 23, 2006 (71 FR 36065), and sought public comment thereon. Concurrently with submission of this report and accompanying certification, the USPTO is submitting a Federal Register notice responding to the public comments, and providing details regarding the final plan and schedule. Because the final plan provides for an enhancement to the USPTO's electronic trademark databases to allow for design searching using the same design categories as were used to organize the paper search collection, and further provides for the microfilming of the existing paper search collection prior to its removal, the Under Secretary and Director concludes that the plan will ensure the continued integrity and accessibility of the collection of trademark registrations that include design elements.

I. INTRODUCTION AND BACKGROUND

The USPTO currently maintains a searchable electronic database of registered marks and marks in pending applications, as well as text and images of marks in abandoned, cancelled and expired records dating back to 1984. Government insignia protected by U.S. law or by Article 6ter of the Paris Convention, and insignia that various federally and state recognized Native American tribes have identified as their official tribal insignia are also included. Trademark examining attorneys have relied exclusively on the electronic database since before 1990. The database available on the USPTO premises is called X-Search, and is accessible to the public at the USPTO's Public Search Facility in Alexandria, Virginia. On the USPTO web site, the database is referred to as the Trademark Electronic Search System ("TESS"). The X-Search and TESS databases are updated on a daily basis, Tuesday through Saturday. An additional system, known as the Trademark Information Capture and Retrieval System ("TICRS"), contains images of trademark registration certificates. This information can also be accessed through the USPTO web site, through Trademark Document Retrieval ("TDR"). TICRS and TDR are updated on a daily basis, Monday through Friday, with some additional, limited updating on Saturday and Sunday.

Marks that include design elements are searchable by design codes. A different design coding system is used with the electronic search systems than has been used with the paper collection of trademark registrations. The paper design coding system organizes design marks according to specific designations (such as "trees," "grotesque humans" or "circles"). Since 2001, these paper search designations ("PSD") have been used to code registrations, but no such coding of pending applications has occurred. The electronic design coding system is based on the International Classification of the Figurative Elements of Marks ("Vienna Classification"). The Vienna Classification arises out of a multilateral treaty administered by the World Intellectual Property Organization. It is a numerical classification index that codifies figurative design elements into categories. Each design element in a specific section is assigned a six-digit number. Design marks are coded by identifying the significant design elements and assigning the appropriate codes. The design codes cover all the possible designs that can appear in a trademark, and are used to search design marks. The USPTO applies its version of the Vienna Classification codes both to incoming applications and registrations.

The USPTO provides a Design Search Code Manual on its web site, which contains guidance about the scope of the specific codes of the Vienna Classification, cross-references directing the user to related codes, and other explanatory notes and guidelines. The USPTO has recently made significant enhancements to the Design Search Code Manual, including adding new design codes to refine searchability, identifying all the current applications or registrations of marks affected by the new design codes and updating the coding accordingly, and increasing and improving the examples given for the numerical design codes.

In response to a previous USPTO proposal to eliminate its paper search collection of marks that include design elements, some members of the public expressed the view that the ability to search both the paper collection and the electronic database provides better, more accurate search results, because if a design coding error is made under one system, the design mark is likely to be found by a paper search using the other system. The USPTO considered this concern and developed a plan to address it.

In the June 23, 2006, Federal Register Notice, the USPTO requested comments on its plan to remove the paper search collection of marks that include design elements from the USPTO's search facility in Arlington, Virginia, and replace the collection with an enhanced electronic search system and a microform collection of the paper search collection. The Notice announced the USPTO's plan to develop a new design code field for its TESS and X-Search databases, which will mirror the PSD. Under the announced plan, while the USPTO will continue to apply the Vienna Classification codes now used in TESS and X-Search, the USPTO will also code new registrations according to the PSD. This dual coding will permit searching of registered design marks using the Vienna Classification, the PSD, or both. The Notice further stated that, upon completion of the development of the new design code system, the USPTO will microfilm the existing paper search collection of registered marks, then remove the paper collection. The Notice provided that the new design code system will not be applied to the backfile, i.e., to applications filed or registrations issued before the date on which the system is implemented.

II. RESPONSE TO PUBLIC COMMENTS ON THE PLAN NOTICE

In response to the June 23, 2006 Notice, the USPTO received a total of nine (9) comments from four intellectual property organizations, three attorneys and law firms, and two individuals. The USPTO has carefully considered all comments it received concerning the proposed plan. One comment agreed with the plan and complimented the USPTO on its use of technology to offer reliable services to the public. Many comments either voiced no objection to or voiced support for the removal of the paper records, but requested that steps be taken to verify the accuracy of the electronic capture of the records and ensure that implementation of the USPTO's plan will not negatively impact the public. Other comments opposed the removal of the paper search collection. Responses to substantively relevant comments appear below.

Comment 1: Microfilm Access

Some comments expressed concern over the need for sufficient access to microfilm equipment for review of the microform collection, once it is completed.

Response:

The Public Search Facility in Alexandria, Virginia (“PSF”) contains ten microfilm reader workstations that enable users to view reels of microfilmed records. Use of such readers is available on a first-come, first-served basis. Usage of these workstations is monitored by PSF staff, and the levels of use suggest that no lack of access problems exist or are likely to arise. However, the PSF has arranged that in the event the use of such readers increases, and reaches certain threshold levels, the PSF will install more readers to meet the demand.

The paper collection has been maintained at a USPTO search facility in Arlington, Virginia, in a separate location from the PSF at the USPTO's main offices in Alexandria, Virginia, where most of the facilities and equipment for public searching are located. Once this microfilming project is complete, and the microfilmed records are relocated to the PSF in Alexandria, all trademark searching may be done in one location.

Comment 2: Design Coding Error Rate

Several comments expressed concerns about design coding errors under the Vienna Classification system in the USPTO's electronic database, and voiced reservations about relying solely on the design coding in the electronic databases.

Response:

As an initial matter, the USPTO's plan allows for the same redundant search capabilities as are currently available, with the significant improvement that for future registrations, they will be available through the electronic database to all members of the public, not just those on the premises of the USPTO. The USPTO's plan includes the replication of the PSD in the electronic database for all newly issued registrations. Thus, these records will be coded under both the USPTO version of the Vienna Classification system and the PSD system. The USPTO intends that the coding of all newly issued registrations with the PSD system will be done by the same personnel who have previously coded the paper records. With the continuity of the same staff using the same coding system, the introduction of an electronic format should not negatively impact the accuracy of the coding. Use of the same records found on paper but now in microfilm will provide searchers equivalent resources to those they already use. In addition, all records will continue to be coded under the Vienna Classification as well, providing a second design coding scheme which public searchers may use as part of a dual search strategy. Should an error have occurred with respect to the coding of an image in one system, it is unlikely that the same error would be made in the other system. Thus, search results will have the

same level of accuracy as currently produced in a dual search of both electronic and paper records.

Moreover, recent USPTO efforts to improve design coding under the existing Vienna Classification system have improved the quality and searchability of the electronic database. Within the USPTO's Trademark Services Division, the work of all contracted specially trained design coders has been subject to 100% quality review by federal employees for the past several years. The contracted workers receive training relating to design coding issues. In addition, the USPTO has created eighty (80) new design search codes to allow for greater specificity in identifying and coding designs, has identified all the active applications and registrations affected by the new design codes, and has updated the electronic databases accordingly. The new version of the Design Code Manual featuring these new codes was made available on the USPTO's web site on January 6, 2007.

In addition, the USPTO has continued to seek input from applicants whose marks contain design elements, informing them of the design codes applied to their marks and offering the applicants the opportunity to submit corrections or additions to the coding. Specifically, each applicant for a mark that includes design elements receives a notice from the USPTO explaining design coding, explicitly identifying the Vienna Classification design codes assigned to the applicant's mark, and providing detailed instructions on how to request supplements or revisions to the assigned codes. Since November 2005, the USPTO has sent approximately 82,000 such notices. Beginning in July 2007, the USPTO will seek similar input from registrants whose existing registrations are for marks that include design elements. The USPTO reviews proposed corrections from any source that pertain to design codes assigned to live registrations or applications, has designated internal and external e-mailboxes for this purpose, and makes changes where necessary. A notice announcing the procedure for submitting proposed corrections was previously published in the USPTO's Official Gazette and is posted on the USPTO web site.

Internal review of the quality of the USPTO's design coding indicates that the efforts to improve quality have succeeded. A recent USPTO study reflects a relatively low error rate in design coding under the Vienna Classification system. In the USPTO's May 7, 2003, report concerning the paper public search collections, the USPTO cited a 19% design coding error rate among a random sample of 1009 applications filed between January 2001 and March 2002. To reevaluate the quality of design coding in the wake of the many improvement initiatives undertaken by the USPTO, in 2006, the USPTO conducted recurring random searches of new applications featuring design-coded marks. Review of the accuracy of the codes applied to the marks revealed that only 4.5% of records contained errors relating to significant elements of a mark that would negatively impact the ability to retrieve such a mark during a search for confusingly similar marks. Thus, the USPTO's ongoing efforts have significantly reduced the error rate in design coding.

By the end of 2007, the USPTO will implement an additional quality enhancement to its design coding under its Vienna Classification system. Under the new procedure, upon acceptance of a registrant's § 8 affidavit, the registration file will be referred to the USPTO's design coders, who will review, and revise if necessary, the Vienna Classification design codes assigned to the registration. Upon completion of the review and any revision, the USPTO will notify the registrant of the Vienna Classification codes currently assigned to the registered mark, and provide information about how to request the addition or correction of these design codes.

Comment 3: Uncoded Backfile

Several comments expressed concerns that the plan to code only future electronic records with the PSD system would result in a hindered ability to accurately search the historic records of the backfile.

Response:

While the USPTO plans to apply the PSD system only prospectively to electronic records of registered marks, the historic copies of earlier registrations will be retained in microfilm under their originally assigned PSD. Thus, a searcher who wishes to search the backfile records using the PSD will be able to do so through the microfilm collection. The searcher can then also search the electronic database for the more recent registrations coded using the PSD system. Through this process, the search results will be identical to those that would have been retrieved in a search of the paper records. The USPTO notes that no legal obligation compels coding the entire backfile with the new PSD system in the electronic database. The USPTO has determined that the substantial costs and burdens associated with a voluntary undertaking of this nature outweigh any benefit of providing the service, particularly where the backfile can be searched with the equivalent of the PSD system through the microfilm records.

Comment 4: Requesting Coding Corrections

One comment noted that the USPTO began sending notices to applicants inviting them to correct or add to the design code entries assigned by the Office. The commenter recommended that the USPTO initiate a quality check invitation to owners of all "live" registrations to assist the Office in its quality control.

Response:

Beginning in July 2007, the filing receipts for post-registration filings submitted via the Trademark Electronic Application System ("TEAS") will notify registrants of the opportunity to request additions to or corrections of the Vienna Classification design codes assigned to their registrations. By the end of 2007, the USPTO intends to implement a new procedure whereby, upon acceptance of a registrant's § 8 affidavit, the registration file will be referred to the USPTO's design coders, who will review, and revise if necessary, the design codes assigned to the registration. Upon completion of the

review and any revision, the USPTO will notify the registrant of the Vienna Classification codes currently assigned to the registered mark, and provide information about how to request the addition or correction of design codes.

Currently, the USPTO reviews all proposed corrections from any source, regarding pending applications or registered marks, either sent electronically to the USPTO at TMDesignCodeComments@uspto.gov or received at 1-800-786-9199. A notice announcing such was published in the Official Gazette on October 19, 2004, and is posted on the USPTO's web site.

Comment 5: Accuracy of Microfilming

One comment expressed concern over the accuracy of the USPTO's microfilming efforts, citing an allegation that approximately 10,000 drawings may have been missed and not microfilmed in a previous paper record microfilming project.

Response:

The quality and accuracy of the microfilming effort will be overseen by the staff of the PSF. The PSF conducted two microfilming projects in 2006, one of the abandoned trademark application drawing pages and the other of the pending trademark application drawing pages. PSF staff members with trademark expertise have overseen both projects, and quality review inspections have been conducted during each project. Care was taken to ensure that the quality of the contents of the reels was excellent, and film quality has been found to be exceptionally high.

With respect to comprehensiveness of image capture, the comment appears to refer to an incident in one of the projects, where shoes of drawings that had not been removed during the initial retrieval were located. Specifically, 34 out of approximately 8,000 total shoes with approximately 270 drawings per shoe had not been removed initially. However, the oversight was identified while the microfilming project was still in progress, and these drawings were microfilmed and inserted into the correct order. Retrieval and filming of the missing records resulted in no impact on the final product. Thus, although these records were initially overlooked, this oversight was identified and corrected before completion of the project, ensuring thorough and accurate results for the project.

In order to ensure that the upcoming microfilming project is complete and accurate, the PSF will employ a comprehensive quality review procedure while the project is in progress. The quality review should ensure that all records are microfilmed. Moreover, there will be a significant "grace period" before destruction of the paper records, during which they will be available to the PSF staff if needed to correct the microfilm.

Comment 6: Marks under Paris Convention or Native American Tribal Insignia

Several comments referred to the alleged inadequacy of the electronic records with respect to the protected notifications under Article 6ter of the Paris Convention and the notified Native American tribal insignia.

Response:

As a threshold matter, the USPTO notes that these comments refer to records that are not registered trademarks, and therefore do not fall within the scope of the paper search collection at issue. Nonetheless, in response to the concern expressed in these comments, the USPTO has undertaken efforts to ensure that its electronic database for such records is complete. A project is nearly finished to load missing images into the Office's image data server to make them available for viewing on X-Search and TESS, and significant progress on the project has been made. The USPTO notes that the missing images identified by the project were also missing from the paper search collection. Thus far, over 125 missing images have been loaded into the Office's image data server. No paper copies of protected notifications or insignia will be eliminated until the project is complete.

Comment 7: Archiving the Paper Record Annotations

One commenter expressed concern that handwritten annotations made to the paper records of word marks, which may provide assistance in locating intentionally altered spellings or misspellings, have not been reviewed for potential incorporation into the pseudo-mark field in the electronic database.

Response:

The USPTO created the pseudo-mark field to improve the accuracy of searches in its electronic databases, but the USPTO notes that no statutory obligation compels the maintenance of this feature. The pseudo-mark field shows the literal equivalent of a pictorial representation of wording in a design mark, and/or spellings that are similar or phonetically equivalent to wording in a word mark. The assignment of pseudo-marks to electronic records is performed by the Trademark Office within the USPTO. PSF staff members regularly make recommendations for pseudo-mark assignments, which may reflect the type of information in the handwritten annotations to the paper records. Moreover, members of the public may also suggest the addition of pseudo-marks. As with the design codes, the USPTO has sought and applied public input regarding the pseudo-mark data in the USPTO database. For example, since April 4, 2006, the USPTO has notified applicants whose marks include a pseudo-mark, to allow them the opportunity to correct or add to the pseudo-mark field. The USPTO has sent approximately 83,600 such notices.

Although the pseudo-mark field provides a useful tool for searching, the USPTO is not required to provide this feature. Thus, a decision not to review an extensive number of

documents for potential additions to the pseudo-mark field does not negatively impact the public. The USPTO has determined that the burden associated with this type of nonessential review of each page in the paper search collection, for consideration of all the handwritten notations, is too great. Nonetheless, because the microfilmed records will accurately capture the handwritten notations made on the paper records, the full scope of these notations will be archived for future reference.

III. PLAN

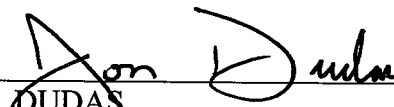
Trademark registrations that include design elements will be made available to the public through its electronic databases, and through the microfilm capture of the paper search collection. The USPTO will remove the paper search collection of registered marks that include design elements from the USPTO's search facility in Arlington, Virginia, and replace the collection with the electronic search system that allows for searching with the PSD and with a microform collection of the paper search collection. While the USPTO will continue to apply its adaptation of the Vienna Classification now used in TESS and X-Search, the USPTO will also code new registrations according to the PSD. This dual coding will permit searching of registered design marks using the USPTO's Vienna Classification, the PSD, or both. Once the enhanced electronic search system is in place, and prior to the elimination of the paper search collection, the USPTO will microfilm the existing paper search collection of registered marks that include design elements, and will make the resulting microform collection available to the public.

Because the microform collection will preserve the ability to use the PSD to search the equivalent of the paper search collection after its elimination, applications filed or registrations issued before the date on which the new electronic design coding system is implemented will not be coded with the PSD in the electronic database. The costs and burdens associated with such an undertaking would be prohibitive, and are unnecessary in view of the microform collection. In addition, given the purpose of the new design coding system to provide the same ability to search using the PSD as existed with the paper collection, the new design coding system will be applied only to trademark registrations, not to applications. Since 2001, no design coding with the PSD has been done for incoming applications in the paper search collection. Rather, design coding with the PSD has been applied only to registrations. Accordingly, in order to replicate the benefits of redundant searching currently available with the paper search collection, the new design coding system need only be applied to new registrations, not to incoming applications.

Accordingly, the USPTO will implement its plan upon the completion of development and testing of its new redundant design coding system, but no earlier than sixty (60) days from the date of the Federal Register Notice announcing the final plan. Under the plan, the USPTO will: (1) begin coding with the new coding system all new registrations of marks that include design elements; (2) stop adding design coded registrations to the paper search collection; and (3) begin microfilming the paper search collection of registered marks that include design elements. When microfilming is complete, the USPTO will remove the paper search collection of registered marks that include design

elements. The microform collection will be available to the public in the Public Search Facility at 600 Dulany Street, Alexandria, Virginia. The USPTO's plan ensures that all information currently available in the paper search collection remains available to the public, and therefore ensures that no negative impact on existing search capabilities will result from the cessation of maintenance of the current paper search collection of registered marks that include design elements.

Date: 6/7/07



JON W. DUDAS
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

**CERTIFICATION CONCERNING THE UNITED STATES PATENT AND
TRADEMARK OFFICE'S PAPER SEARCH COLLECTION OF REGISTERED
MARKS THAT INCLUDE DESIGN ELEMENTS**

According to 35 U.S.C. § 41(i)(1), the Director of the United States Patent and Trademark Office (USPTO) "shall maintain, for use by the public, paper, microform, or electronic collections of . . . United States trademark registrations arranged to permit search for and retrieval of information." This certification, which pertains only to the USPTO's paper search collection of trademark registrations that include design elements, is submitted pursuant to section 4804(d)(2) of the American Inventors Protection Act of 1999. This provision requires that the USPTO not cease to maintain for use by the public its paper or microform collections of, *inter alia*, United States trademark registrations, except pursuant to notice and opportunity for public comment, and except where the USPTO Director has first submitted a report to the Committees on the Judiciary of the Senate and the House of Representatives detailing a plan to do so. The report must certify that the implementation of the plan will not negatively impact the public, and must include a "description of the mechanisms in place to ensure the integrity of such collections and the data contained therein, as well as to ensure prompt public access to the most current available information." *Id.*

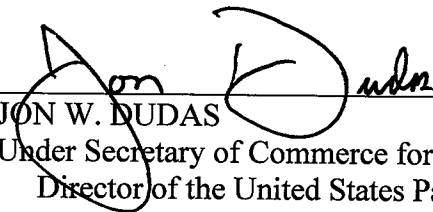
On May 9, 2003, the now-former Director of the USPTO certified that a plan to eliminate the paper search collection of trademark registrations containing only word marks would not negatively impact the public, and provided the requisite related report on the plan. As a result of litigation challenging the plan, however, the USPTO agreed, *inter alia*, to maintain its paper collections of trademark registrations – both word marks and marks including design elements – until January 1, 2006, and to provide sixty days advance notice, by publication in the Federal Register, before ceasing maintenance of paper trademark registration files. By notice dated March 6, 2007, the USPTO published its intention to microfilm and discard the paper search collection of trademark registrations containing only word marks.

With this certification and the attached *Report*, the USPTO intends to move forward with a plan to microfilm and discard the paper search collection of trademark registrations that include design elements. For the reasons discussed below, I now certify that the USPTO's plan to eliminate its paper search collection of marks that include design elements, and to rely upon electronic and microform collections, as outlined in the attached *Report of the USPTO Concerning the Paper Search Collection of Marks that Include Design Elements (Report)*, will not negatively impact the public and should be implemented.

As detailed in the attached *Report*, the functionality of the USPTO's paper search collection of registered marks that include design elements will be fully duplicated by a combination of secure and reliable electronic systems as well as microform copies of the paper collection that will remain available for public use.

Based on the attached *Report*, I hereby certify that implementation of the plan detailed therein will not negatively impact the public.

Date: 6/7/07



JON W. DUDAS
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office