



International Trademark Association

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August 2, 2010

Ms. Candice Goodman
United States Patent & Trademark Office
600 Dulany Street
Alexandria, VA 22314-5796

Dear Ms. Goodman:

The International Trademark Association (INTA) appreciates the opportunity to provide the enclosed comments on the Office's Draft Strategic Plan for FY 2010-2015. Strategic planning is crucial to the success and management of any organization and we commend the Office for seeking its customers' feedback on the draft strategic plan. INTA is a not-for-profit membership association of more than 5,600 trademark owners and professionals, from more than 190 countries, dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective commerce.

This submission was prepared by INTA with the assistance of its USPTO Subcommittee as well as members of INTA's policy staff. Should you require further information about our comments, please contact INTA staff liaison, Ms. Michelle Sara King at mking@inta.org.

Sincerely,

A handwritten signature in black ink, appearing to read "Heather Steinmeyer", with a long horizontal flourish extending to the right.

Heather Steinmeyer
President

Enclosure

**Comments by the
INTERNATIONAL TRADEMARK ASSOCIATION (INTA)
on the United States Patent & Trademark Office Draft Strategic Plan
for FY 2010-2015**

INTA is pleased to have the opportunity to comment on the USPTO's Draft Strategic Plan as the agency charts its course for the future. We applaud the USPTO for its vision and commitment to the mission of protecting intellectual property as well as fostering innovation and global economic growth.

Quality, Pendency and Information Technology

INTA strongly supports the goal focused on quality and pendency as it is crucial to encourage innovation and stimulate economic growth. In order to achieve optimal trademark quality and timeliness, however, the Office should aggressively proceed further with the Trademarks Next Generation Program. A first step in this process is separation of the Trademark Office's IT Systems, from others at the PTO. The Trademark Office would greatly benefit by having control over its own IT resources and infrastructure. Rather than being incorporated in one, wide-ranging IT department for the entire PTO, Trademark Operations would benefit from separate management, development and support of its system. The "Trademarks Next Generation" effort will require extensive integration and modification to the existing systems, and this can best be accomplished by deploying dedicated resources to this project, under the supervision and control of those who best understand the needs of trademark customers, namely, Trademark Operations.

On a related issue, INTA strongly supports the Office's plan to physically separate Trademarks computer-based resources (CBRs) from other USPTO CBRs. The PTO should go further by allocating separate IT resources under the control of Trademark Operations in order to enable Trademarks to enhance and maintain its CBRs.

While we respect and support the need to adopt and deploy new technologies, INTA is concerned about the stated intention to move all Trademark CBRs to a cloud computing environment. Before taking such a significant step as changing the architecture of the entire system, the PTO must ensure that this environment is sufficiently secure, reliable and reproducible to support Trademark CBRs.

Examiner Utilization and Quality of Work

INTA supports the Office's proposals to move its examiners to "non-production activities" when workload slows down. This is an appropriate way to keep its employees actively and productively engaged.

INTA supports the continuing emphasis on quality of examination and the Office's new move to evaluate comprehensive excellent quality enabled by incentives, and looks forward to working with the USPTO to determine what measures of "excellent quality" should be included under the new standard. INTA also encourages the USPTO to evaluate the completeness of the examiner's

analysis and efficiency of the method chosen by the examiner to communicate (i.e., email for minor issues, priority action for issues that require a response but are easy to resolve versus an Office Action for more extensive issues). Further, INTA supports the Office's emphasis on using phone calls and/or informal email communication where appropriate, but we encourage the Office to ensure that a complete record of any communication is maintained in the file history, to ensure transparency of examination.

Descriptions of Goods and Services

INTA supports the Office's interest in ensuring accurate descriptions of goods and services in use-based registrations and renewals, and in ensuring that there is bona fide intent to use on all descriptions of goods and services when declarations are provided. However, there are challenges presented by applicants who are not familiar with a common law system and the nature of appropriate use in commerce, and whom may not understand the importance of excluding goods and services on which the mark is not actually being used. Further guidance from the USPTO on what activities or efforts demonstrate bona fide intent would also be helpful.

In addition, continuing improvements to the Acceptable Identification of Goods/Services Manual and greater flexibility in the review and acceptance of goods and services descriptions would help to increase the accuracy of goods and services claims. Education and training can help to address these issues, and INTA stands ready to assist the Office in this regard.

TTAB Case Resolution Methodologies

INTA supports the Trademark Trial and Appeal Board's interest in finding alternative ways to streamline the resolution of contested matters. However, if there are too many alternative methods for resolving cases, confusion can result and parties may find themselves involved in a negotiation over which method is best for their situation. Instead, INTA encourages the TTAB to study available methods for streamlining the resolution of cases and to implement only a limited number of the best methods that would benefit the most parties before the Board. This also will help to control the amount of training required for the TTAB to manage cases under these methods. Moreover, INTA will continue to encourage the TTAB to make more precedential decisions available.

Management Succession Planning

INTA strongly supports the formal recognition of the importance of succession planning within the PTO. During the last decade in particular, Trademark Operations has done an excellent job of bringing up new leaders and of introducing its talented senior staff to the user community. Continuing focus on the need to develop talent from within will ensure continuity at the Office and will foster a continuing positive relationship with its customers.

Fees and Funding

INTA supports the Office's desire to operate like a business and to be responsive to the needs of its customers. The Office's request, however, to have authority to set fees without the assurance

that the funds will remain available will hamper the Office's ability to operate efficiently. Under the current annual budget process whereby PTO fees and funding must be authorized and appropriated by Congress, the PTO does not, unless under exceptional circumstances, have the ability to spend additional revenue realized by fee changes during a particular fiscal year until the next congressional budget cycle. This often leads to diversion of funds from the PTO's budget, thus undermining the ability of the Office to support crucial innovations such as those described in the preamble to the Strategic Plan. Therefore, INTA can only support a proposal to give the PTO fee-setting authority if that authority is coupled with a definitive end to the diversion by Congress of PTO funds.

INTA also recommends that, given the desire to utilize user fees to respond to user needs, the PTO should separate trademark-derived fees from patent fees and should maintain separate accounts. The Commissioner for Trademarks, subject to the concurrence of the Director, should have full authority to manage the Trademark Office budget, including those overhead accounts which are presently combined and allocated between patent and trademark operations.

This is integral to the PTO's stated desire that each of its operational entities perform like a business and use their revenue to better serve their customers.

Conclusion

INTA believes that the Office has developed a strategic plan that will allow the Office to foster innovation and economic growth. INTA looks forward to working with the Office as it moves forward in implementing its new strategic plan.