

INTELLECTUAL PROPERTY LAW SECTION



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Summary

The attached letter to Commissioner of Patents and Trademarks, Bruce Lehman, was drafted by the Steering Committee of the Intellectual Property Law Section and the Chair of the Trademark Committee of that Section. It relates to certain difficulties which Section Members have encountered in the processing of trademark applications and related documents. The letter offers the cooperation of the Intellectual Property Law Section in addressing issues of Trademark Office operations. The letter also requests a response from the Commissioner regarding steps which the Office may take to address the specific concerns raised by Section Members.

The letter does not comment upon any proposed or contemplated legislation or regulations. The letter does volunteer the participation of the Section should the Patent and Trademark Office create a public/private advisory group to serve as a forum for addressing administrative issues that may arise in Trademark Office operations.

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June 14, 1996

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Honorable Bruce A. Lehman
 Assistant Secretary of Commerce and
 Commissioner of Patents and Trademark
 United States Patent and Trademark Office
 Washington, D.C. 20231

Re: Trademark Office Operations

Dear Commissioner Lehman:

We write on behalf of the Intellectual Property Law Section of the D.C. Bar. The Intellectual Property Law Section includes more than 1,500 members who practice in the patent, trademark and copyright fields.

During the course of the past year, we have received a number of expressions of concern from our Section Members regarding the operations of the Trademark Office. Based upon these expressions of concern, the Intellectual Property Law Section would like to work with the PTO to improve and streamline customer service.

We understand that for several months the PTO has been formulating new guidelines for a public/private advisory group concerned with improving trademark services. We encourage the formation of such a group at the earliest opportunity. The Intellectual Property Law Section of the D.C. Bar would be pleased to appoint one or more of its leading members to serve in this group.

We hope that your office, with the assistance of the public/private advisory group, can address the concerns of our Section Members, who have advised us of various difficulties with Trademark Office operation such as:

1. Filing receipts for new applications generally appear to require at least sixty (60) days, and sometimes up to four or five months, for the PTO to process, leading to concerns by clients that their applications may not have been properly filed or are lost at the PTO;

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2. New applications may not reach the PTO search records for 45 days or more after filing, making searches for proposed new marks unreliable;
3. First office actions may not issue for up to eight (8) months after an application is filed, again leading clients to question whether their applications are progressing properly through the registration process or have been lost or forgotten;
4. Assignment documents submitted five (5) months or more ago have not yet been recorded;
5. Numerous typographical errors in the assignment records have been detected;
6. Lost files are becoming more common, with several attorneys advising us that they have recreated two or more trademark application files for the PTO this year;
7. Post-registration delays in processing of up to twelve (12) months have been encountered.

Meanwhile, clients are becoming alarmed at the slow pace of the trademark application process. Marketing decisions for new products are made on a more time sensitive basis which requires both up to date trademark search records and much more rapid reaction by the PTO to newly filed applications. In several instances, our membership has reported that the life cycle of certain products has been exhausted before a federal trademark registration for the brand could be obtained; even in instances where the application did not encounter any substantial obstacles to registration.

Over the last year, representatives of the Trademark Office have requested the patience of the Bar while proposed changes are implemented. However, these promises of positive change have yet to be realized. We hope that input from the Bar can assist in bringing rapid constructive change to PTO operations.

We look forward to learning of the steps you are taking in relation to the specific issues our Section Members have raised. We would also like to know when you plan to implement the proposed public/private advisory group and whether our Section will be permitted to participate in that group.

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We look forward to working with the PTO to improve the operations of the Trademark Office. Thank you for your attention to this letter.

Very truly yours,

William F. Herbert, Co-Chair

Gary Krugman, Co-Chair

Paul F. Kilmer, Member

Stephen Jeffries, Trademark Chair