

UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK PUBLIC ADVISORY COMMITTEE MEETING

JUNE 16, 2003

Held at: U.S. Patent and Trademark Office
2121 Crystal Drive
Crystal Park Two
Room 911
Arlington, VA

Reported by: Frances M. Freeman,
Conference Reporter

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EXHIBITS

-NONE-

1 MR. ALEXANDER: Let me call the meeting to
2 order. And rather than going around and introducing
3 everybody, because this is a large crowd, is there
4 anybody here that is not on the TPAC or not with the
5 USPTO?

6 Would you just introduce yourself?

7 MR. WEIR: Bob Weir, Government Liaison
8 Services.

9 MR. ALEXANDER: Thank you very much. We're
10 going to try to have a very interactive morning and I
11 understand that we may go outside of the agenda because
12 I think -- where is Bob? There you are.

13 You are not available this afternoon so we're
14 going try to take you --

15 MR. ANDERSON: I'm available most of the
16 afternoon. I have to leave at about 11 for a medical
17 appointment.

18 MR. ALEXANDER: Would you be back by 3
19 o'clock?

20 MR. ANDERSON: That's up to my doctor. I
21 should be back; it shouldn't be more than an hour.

1 MR. ALEXANDER: Would you rather do it the
2 latter part of the morning just to be safe? I would
3 hate to --

4 MR. ANDERSON: Yes, I will be back by 3. It
5 should be about an hour or so.

6 MR. ALEXANDER: Then we won't break at that
7 part of the agenda. John is not going to be here until
8 about 10:30 as I understand it?

9 MS. CHASSER: I just left a message. When he
10 comes back from the executive management team meeting
11 over at the Department of Commerce he will be coming
12 in.

13 That meeting is not always timely finished.
14 He will stop in when he gets back.

15 MR. ALEXANDER: I want to welcome everybody,
16 indicate that there has been a number of advanced
17 mailings to the TPAC, which we will make as a matter of
18 public record that TPAC has an opportunity to review
19 them.

20 We'll have questions on them and they go to
21 such issues as quality control, work force, and

1 customer satisfaction as such, that all of those items
2 are on the agenda and will be a matter of public
3 record.

4 With that said, I would like to move on.

5 Anne, would you do your welcome remarks?

6 MS. CHASSER: Thank you, Miles. Today, as
7 Miles mentioned, we are planning to have a very
8 interactive discussion with the members of the public
9 advisory. I have asked the team leaders from all our
10 different areas within trademarks to be available so
11 that they can also participate in the discussion.

12 Do we want to introduce those folks now,
13 Miles?

14 MR. ALEXANDER: Surely.

15 MS. CHASSER: I would like to ask the
16 individuals that are on the perimeter of the room to
17 identify yourself and your role within the trademark
18 organization. These are the folks that make things
19 happen within trademarks.

20 MR. ALEXANDER: Please, speak up so that the
21 reporter can catch what you say.

1 MS. COHN: I'm Debbie Cohn, I'm one of the
2 two group directors for the trademark law offices.

3 MS. BRUCE: I'm Mary Frances Bruce, I'm the
4 senior administrator for the TTAB. MR.

5 SAMS: I'm David Sams, Chief Judge TTAB.

6 MR. TOUPIN: Jim Toupin, general counsel.

7 MR. DONINGER: Chris Doninger, Senior
8 Attorney, office of Title V.

9 MR. WILLIAMS: Ron Williams, group director
10 of the trademark law offices, acting director of
11 trademark services.

12 MS. MARSH: Sharon Marsh, Administrative for
13 trademark policy and procedure.

14 MR. MORRIS: Craig Morris, head attorney,
15 electronic filing system.

16 MS. FAINT: Catherine Faint, title examiner
17 in law office 103, and vice president of NTEU 245.

18

19 MR. SUSSMAN: Ron Sussman, helping Anne with
20 TIS on the Madrid implementation. MR.

21 PESKA: Kevin Peska, I'm with the office of Trademark

1 Quality Review and training.

2 MS. STROHECKER: Karen Strohecker of
3 trademark, budget and financial data.

4 MR. CANNON: I'm Gary Cannon, I am manager of
5 the trademark program control program.

6 MR. GEWEHR: Wes Gewehr, OCIO.

7 MS. CHASSER: Thank you. This, as we have
8 mentioned, is the final meeting chaired by our esteemed
9 Chair, Miles Alexander.

10 Anyone who has read the transcripts of the
11 TPAC meeting knows immediately that the TPAC members
12 have been deeply engaged and knowledgeable about the
13 affairs of trademark operations.

14 Under Miles' leadership, you have expended
15 tremendous and considerable amount of time providing
16 input into the drafting and the redrafting of the
17 revised strategic plan.

18 We very much appreciate your support of our
19 electronic filing efforts and you have made some very
20 valuable suggestions on how that program can be
21 expanded.

1 Under your tenure, Miles, the use of TEAS has
2 grown substantially to the point where we're now more
3 than 55 percent of all of our new applications are
4 filed electronically.

5 I think that's a major milestone. I think
6 that when you first took over leadership of the
7 trademark public advisory committee about three years
8 ago, we were looking at about 14 percent or so of our
9 initial filings electronically.

10 I want to thank you for your leadership on that and
11 also on your leadership on the subcommittees that
12 addressed issues regarding examiner training and
13 quality.

14 I also want to thank our other two members
15 who will be serving at their last meeting this week,
16 Joe Nicholson of Kenyon and Kenyon, and of course,
17 David Stimson of Eastman Kodak.

18 We very much appreciate your involvement,
19 look forward to your involvement and contributions
20 through this meeting and through the end of your term,
21 which ends on July 12th of this year.

1 I know a major concern of the public advisory
2 has been that the period between the members leaving
3 the committee and the new members being appointed by
4 Secretary of Commerce, I understand that the process is
5 underway, that the communications have taken place
6 between the department of the secretary -- Department
7 of Commerce and the USPTO.

8 And we're very hopeful that the new members
9 will be sworn in at the same time as the members that
10 are leaving this year will be ending their term.

11 Let's keep our fingers crossed, right,
12 Miles? I know you are a doubter.

13 As you can see we are very much focussed in
14 trademarks. We have 139 days left until that very
15 important date of November 2nd, 2003, which of course
16 is a Sunday, and the United States will be prepared at
17 that point to accept its first international
18 application for registration or extension of protection
19 into the United States.

20 And we do plan to accept that electronically.

21 It's a Sunday, so for those trademark practitioners

1 who are working Saturday night in their offices, we
2 very much expect to receive an application at 12:01 on
3 November 2nd, 2003.

4 We're focused not only on Madrid, but also
5 delivery of our trademark information system, which you
6 saw the demonstration.

7 Again, I want to thank Chris Doninger for
8 that impressive presentation on one of the final stages
9 of our trademark information system which is the first
10 action system for trademarks.

11 Under this we have been focused in terms of
12 the strategic plan, the 21st century strategic plan
13 delivery of our end to end electronic processing as
14 well as delivery of implementation in Madrid, are our
15 major first deliverables for the agency under the 21st
16 century strategic plan.

17 The plan commits us to implement changes to
18 ensure that we manage our operation with greater
19 timeliness, greater productivity, more efficiency, and
20 cost-effectiveness.

21 It requires us to transform ourselves into a

1 quality focused responsive organization that supports a
2 market driven intellectual property system. I think
3 we're well underway to delivering that to our
4 customers.

5 I very much look forward to your comments
6 from the user community and advice and counsel on your
7 observations of how we're doing. We're very much
8 interested in that.

9 As we mentioned, in previous meetings our
10 goal in the strategic plan is to receive 80 percent of
11 all of our communications in and out of the trademark
12 operation at a level of 80 percent electronically by
13 2004.

14 We believe that with the continuing and
15 growing success of TEAS, we are moving towards
16 achieving that goal. As we mentioned TEAS has grown
17 tremendously during the three years that the members
18 have -- actually since the trademark public advisory --
19 new trademark public advisory committee has been
20 reconstituted.

21 We have offered a number of enhancements

1 recently because we have been listening to our
2 customers.

3 One example of an enhancement is since we
4 last met in February, we have upgraded TEAS to allow a
5 single submission to include as many as 50 images of
6 documents to a TEAS application.

7 So that would include specimens, foreign
8 registration certificates, and evidence in support of
9 claims of acquired distinctiveness.

10 We also mentioned earlier that the USPTO now
11 provides an assignment form that users can complete on
12 line and transmit electronically. It is accessible
13 through the TEAS site.

14 So the success and growing popularity of TEAS
15 demonstrates that we're well on our way, I think, of
16 meeting our strategic goal. Doing more and more of our
17 business with applicants electronically, and using E
18 government as the primary means of doing business with
19 applicants and registrants.

20 It will also be the sole means of doing
21 business inside the trademark operation. What we want

1 to do is eliminate once and for all the problems of
2 mismatched papers, lost filing receipts, lost files.

3 And as we receive more and more papers
4 electronically, we're doing less and less by paper
5 means within the office inside our operation.

6 You saw the demonstration of FAST this
7 morning. Chris mentioned about our information
8 retrieval system referred to as TICRS, T-I-C-R.

9 FAST works in conjunction with other E
10 government projects within the trademark operation and
11 that is the TICRS database that features images of all
12 the documents that we receive and generate.

13 That database is available to all examining
14 attorneys at their desk top so that as they are
15 assigned cases through FAST, they can utilize the TICRS
16 system to view and examine other am applications.

17 We did mention in previous meetings that we
18 have been scanning all incoming documents since April
19 '99. Since July of this year, we have also been
20 scanning all external -- all outgoing -- excuse me,
21 correspondence as well.

1 We have also implemented a system where we
2 are scanning all of back files. And that is to better
3 prepare us for the date of November 2nd, 2003, while we
4 implement our trademark information system.

5 (Thereupon, Ms. Kane entered the room.)

6 MS. CHASSER: Quality is a big issue. And we
7 sent out advance materials on quality and Kevin Peska
8 will be available -- who is our acting manager for the
9 office of quality, will be available to answer any
10 questions and to participate in the discussion.

11 I think we're doing some very exciting things
12 in the area of quality because we're now reviewing
13 current in process actions, as well as final actions.

14 I wanted to talk a little bit, very briefly,
15 about where we are in terms of our strategic plan and
16 our fast track examination.

17 As I mentioned, our strategic plan envisions
18 that the trend is towards more and more electronic
19 processing will continue. It also requires that we
20 take less time to dispose and act on those actions.
21 The fast track program is designed to further both of

1 those goals.

2 Jon Dudas, in his remarks to the TPAC will be
3 advising you on the status of our fee legislation,
4 which under the fee legislation would implement a three
5 track examination with the financial incentives for
6 fast track electronic filing and paper filing.

7 With our fast track program, it envisions
8 that the trademark applicant will choose between three
9 different filing options or tracks and that the fees
10 would be associated with each of those tracks.

11 The fee for the fast track would be the
12 lowest and would utilize -- and to utilize the track,
13 the applicants would file their application using TEAS
14 and their application would be complete in all
15 respects.

16 So by making the job easier for us, we can
17 pass that savings on to the customers.

18 We are in the process of finalizing the rule
19 for fast track and it will be coming out a little later
20 this year.

21 It is possible that one of -- and one of the

1 requirements under fast track examination is that the
2 identifications in goods and services must conform with
3 entries in our acceptable identification of goods and
4 services.

5 We have put out a notice requesting that the
6 public submit identifications ID's for cutting edge
7 goods and services. And I'm happy to report that we
8 have had fairly positive response, especially, from one
9 major computer company who has filed over 50 proposed
10 ID's.

11 We accepted, I believe, about 47 of those and
12 they are already in the manual to be used and would be
13 accepted immediately.

14 I understand from members of the INTA
15 subcommittee, as well as the IPO subcommittee, and
16 AIPLA subcommittee that they are planning to undertake
17 the project of finding those cutting edge ID's and
18 providing them to us so that we can include that in our
19 electronic identification -- acceptable identification
20 of goods and services manual.

21 I would also welcome the TPAC, or invite the

1 TPAC to identify ways that we might expand that.

2 Because as we have more and more of this
3 information on line available, it will eliminate,
4 again, a lot of the issues and the problems that we
5 have encountered from our applicants, often times the
6 concerns about the identification of goods and
7 services.

8 So I would invite you to look at that.

9 Since we last met we had a consolidation of
10 our law offices. We have turned over three floors of
11 office space to the agency. We have consolidated from
12 16 law offices to 12 law offices. We have revised and
13 as a result of that, we have been able to turn over the
14 rent for those three office spaces back to the agency.

15 So in part of our strategic goal, under the
16 strategic plan is to run a more efficient operation. I
17 think we're demonstrating that by the consolidation of
18 our law offices.

19 We also expanded our work at home program
20 where all of our examining attorneys who are working at
21 home are working under the hoteling concept where their

1 office at home is essentially their primary office
2 location. We have offices available on a
3 reservation basis for examining attorneys to use if
4 they choose to come into the office. The requirement
5 is that examining attorneys would come to the office
6 for two weeks -- two hours, excuse me, every week or
7 four hours every biweek to handle administrative
8 matters that could not be handled electronically.

9 You saw from the demonstration earlier today
10 that the examiners are now pulling new cases and
11 examining completely from the electronic record.

12 With regard to hiring, we have no plans to
13 hire additional -- any hires in the trademark examining
14 floor until filing levels increase significantly.

15 We provided ahead of time the second quarter
16 statistics so that -- and I hope you have all had an
17 opportunity to look at that. We won't be giving you
18 any of those facts and figures in this presentation.

19 With regard to hiring in other areas, though,
20 we are looking at hiring in other areas, primarily,
21 areas that involve problem resolution.

1 That would include our petition staff within
2 my office, our office of trademark program control,
3 which handles all of the electronic infrastructure
4 support of our electronic systems, our customer service
5 areas, and in our trademark assistance center, as well
6 as in our TEAS system as well.

7 I know there were some issues raised about
8 our ability to problem solve and that does come up
9 quite often on our customer satisfaction survey, the
10 ability to resolve problems.

11 I wanted to report that since we last met in
12 February, our trademark assistance center, which is our
13 primary center for customer service and problem
14 resolution, has broadened its services to include
15 further problem resolution through an internal customer
16 service mechanism, which is an employee mailbox.

17 And under the terms of broadened services,
18 our staff has committed to contact -- respond to
19 customers, our internal customers within 24 hours of
20 notice either by telephone, e-mail, fax, or in person.

21 And that the resolution of the problem will

1 be completed within three days. And thus far, our
2 trademarks assistance center has been meeting that goal
3 with resolutions at 2.9 days. We'll take that as a
4 victory.

5 Ninety-seven percent of the problems that are
6 sent to the trademarks assistance center by e-mail are
7 resolved within 24 hours. Those that are received by
8 telephone we're resolving those at about 92 percent of
9 those within 24 hours.

10 I just have a couple other broad updates.
11 One is from a policy -- international policy
12 perspective. In May, the USPTO participated in the
13 third annual trademark trilateral cooperation meeting
14 with our trilateral partners, OHIM, and the Japanese
15 patent office.

16 And after the technical experts worked behind
17 the scenes for the past year since we met last year in
18 Alicante at OHIM, we were very pleased with progress
19 that we made in the past year.

20 In our effort to try to harmonize trademark
21 filing around the world, last year we agreed to look at

1 identifications of goods and we agreed to look at class
2 35.

3 And over the past year, the three offices
4 looked at over 400 identifications in class 35 and we
5 were able to agree on, I think, it was 343 or so of
6 those classes.

7 This year we agreed to look at class 25,
8 clothing, and then class 36 and 37.
9 Now, I know at this pace it might take up to 15 years
10 to get all of the classes, but our game plan is to
11 start slow and work towards speeding up the process.
12 So we're very pleased with that.

13 Also, the trilateral partners agreed on
14 developing a web site, as well as looking at developing
15 a common application that would be accepted by all
16 three offices.

17 And the common application basically would be
18 structured on international application for Madrid
19 protocol under the Mecca system, which is the system
20 that's being used by WIPO.

21 And then look at the five elements in order

1 that are required under TLT, so that a filing date
2 could be received by -- could be assigned by each of
3 those offices then the requirements could be handled
4 subsequent to receiving filing date.

5 Those were, I think, really major
6 developments in working together with the three offices
7 that comprised over 50 percent of all trademark filings
8 in the world. So we're making good progress along
9 those lines and look forward to continuing those
10 efforts.

11 Finally, I wanted to just update you very
12 briefly on where we are on our new facility. In just
13 about 18 months trademarks will be moving. Patents
14 will begin moving in December of 2003. The building is
15 progressing quite nicely.

16 The plan is for trademarks to be the last as
17 I said, organization to move to the Carlisle facility
18 and that is scheduled for December of 2004.

19 So I think that we have made tremendous
20 progress in our march toward fully electronic
21 government and toward meeting the goals of the

1 strategic plan.

2 We have been managing our operation to keep
3 trains running while very much focused on the many
4 changes that are occurring within trademarks as a
5 result of implementation of Madrid protocol.

6 And we have also, I believe, made some great
7 strides in our efforts to measure and improve quality
8 of our work.

9 We're very much looking forward to further
10 discussions of these and other issues today with the
11 members of the TPAC, and I would be happy to answer any
12 questions that you might have at this point or if you
13 would like to handle it, Miles. Thank you.

14 MR. ALEXANDER: Are there any questions
15 before we go into the electronic filing? This is the
16 first subcategory of our morning session.

17 MR. FRIEDMAN: I don't have a question, but
18 I'm wondering if with your indulgence I could spend a
19 few minutes sort of talking about the impact these and
20 other issues have had on attorneys. I think most of
21 what we're going to be talking about today is going to

1 impact attorneys.

2 Since the TPAC committee has sort of had some
3 frame of reference from the offices perspective, before
4 we go through these initiatives I was hopeful that the
5 committee could also have the benefit of the employees'
6 perspective before we go through.

7 MR. ALEXANDER: I'd be delighted, I'm sorry
8 you weren't here in earlier sessions because of some
9 personal emergency, but I think that you are more than
10 entitled to some time to bring us up to date on your
11 views.

12 MR. FRIEDMAN: I appreciate that.

13 There is a number of these I would like to do
14 really what I would like to focus on is the impact we
15 feel things have occurred regarding the employees.
16 Most, if not many, of all these initiatives as I said
17 do impact employees.

18 Unfortunately, the employees and the union
19 have had very little, if any, input on these
20 initiatives. I think, frankly, that's an important
21 point to keep in mind.

1 What I would like to do is sort of walk
2 through almost all the initiatives we have talked about
3 and will be talking about, so that as we talk about
4 them individually you will have a frame of reference as
5 to what our 250 attorneys have faced, are facing, and
6 will face in the past, now, and in the future. And in
7 that regard I may flip flop back and forth.

8 Think about our attorneys and what kind of
9 job you want them to do and then perhaps translate it
10 to some of the things that go on in your practice, what
11 goals you're looking to achieve, and if these kind of
12 things will work in your firm either as a managing
13 attorney or an attorney on the corporate side, how you
14 would react, either as a manager or as someone who is
15 doing the work.

16 MR. ALEXANDER: Howard, let me ask, I had
17 work force issues as a separate category, but I'm
18 assuming this is more of an overview --

19 MR. FRIEDMAN: Correct.

20 MR. ALEXANDER: Okay. Go ahead.

21 MR. FRIEDMAN: In that regard let's keep in

1 mind, I hope, the following as we walk through the day.

2 As a reminder we have over 100 attorneys,
3 less attorneys here, which means as a reminder we have
4 250 plus attorneys doing the work of 375 attorneys. In
5 that regard, obviously from our perspective, there has
6 been an impact when it comes to the distribution of
7 dockets.

8 In that regard, think about how your firm or
9 your corporation would operate when you are going
10 through how to parcel work.

11 The difference perhaps would be your getting
12 back to your clients and saying, I'll get to your work
13 when I can. For us, obviously, we need to continue
14 doing the work. The work is there it hasn't gone away.

15 In that regard, as I understand it, since
16 July of last year we had a backlog of about 55 or 60
17 thousand cases. We now have a backlog, I believe, of
18 over 96 thousand cases.

19 And in that regard, though I don't think Anne
20 touched upon this, I believe pendency now is 5.7 for
21 first actions, 19.5 for disposal pendencies, both of

1 which facts and figures, I think, appeared Friday and
2 over the weekend on the PTO's web site for the first
3 time at least for May.

4 MR. ALEXANDER: Has there been any change in
5 the -- from the projected reduction of applications
6 that occurred?

7 MR. FRIEDMAN: That's a good question.
8 Obviously, Bob and Anne and others can speak to that.
9 Remembering back to what was discussed 10 months ago in
10 August, and even reflecting upon what was discussed in
11 February, what had been made clear by the office was
12 the following: one, that when it comes to pendency,
13 that's largely driven by staff.

14 On the other hand, the variables that were
15 put in place that were presented in those proceedings
16 were as follows: one, the office anticipated that
17 pendency would be held in check.

18 I know there was back and forth between you
19 and Bob talking about the impact of the RIF and its
20 impact on pendency. And I believe the office was very
21 clear that assuming no more than 265,000 applications

1 were filed and it doesn't look like more than that will
2 be filed this year, assuming attrition stays in check -
3 - one of the other factors mentioned assuming attrition
4 was held in check, and the last I looked, I think,
5 we've lost three attorneys in the past three or four
6 months. So clearly attrition has been in check.

7 Assuming those variables stay that way, and
8 they have, the office felt that pendency would stay in
9 check. Unfortunately, it doesn't seem to be the case
10 because it has gone from 4.4, I believe at the end of
11 the fiscal year, to 5.7.

12 I believe, with the exception of the month of
13 March as a general rule even though applications are
14 down compared to 2000 and 2001, we still work on less
15 cases, new cases each month than come through the door.

16 And until that's addressed somewhere along
17 the line, especially in view of the give and take
18 between Anne and Leslie, talking about the fact that
19 FAST doesn't accelerate on pendency, what it
20 accelerates is on the processing point before it gets
21 to the attorney.

1 MR. MOYER: Do you happen to know how many
2 examining attorneys there were in 1999?

3 The reason I ask that question is that is
4 when there seems to be a real increase in the number of
5 applications, though I know the USPTO staffed up. And
6 I don't know if you happen to know that number.

7 MR. FRIEDMAN: I would assume probably --

8
9 MS. CHASSER: I can answer that, 389.

10 MR. ANDERSON: Not in '99.

11 MS. STROHECKER: I think we had about 280, if
12 I recall correctly. That's when we really began to
13 push the hiring. I can check that number.

14 MR. MOYER: There were a large number of
15 examiners hired the year 2000. It was about 200.

16 MS. STROHECKER: Oh, no.

17 MR. MOYER: It wasn't that many?

18 UNKNOWN SPEAKER: 150, 130.

19 MR. ANDERSON: Over a period of two years we
20 hired about 200 people.

21 MR. FRIEDMAN: Wait. Karen, you said about

1 280?

2 MS. STROHECKER: That's my memory.

3 MR. ANDERSON: We don't know for sure.

4 MS. STROHECKER: I'm going to check. I'll
5 get back to you.

6 MR. FRIEDMAN: I think more or less not far
7 off to what they were in 1999, of course right now it
8 would be about 250 or 51 examining attorneys versus --
9 whatever Karen said, 258, I guess.

10 I'll just keep that in mind, think about some
11 of the things I'm saying because I think there has been
12 an impact on examination when it comes to quality, when
13 it comes to pendency.

14 Miles, back to the question, filings have
15 more or less been in check compared to the variables
16 that were raised in August.

17 Attrition, people haven't gone anywhere
18 because more or less there isn't anywhere to go. But
19 nevertheless pendency has come up and that's obviously
20 what we had suggested was going to occur back in
21 August. And even though having checked the

1 transcript of the February meeting, the office believed
2 in February that two months after February pendency
3 would start going down, that has not been the case.

4 MR. STIMSON: I apologize for talking ahead,
5 but to help me understand, because the number of
6 applications has gone down.

7 The number of examiners have gone down but
8 pendency is going up. Is there a measure of cases
9 handled per examiner? I'm trying to figure out why
10 this is. Are examiners handling fewer cases or -- I
11 just don't understand why if they both go down the
12 ratio doesn't stay pretty much the same.

13 Or has the decrease in examiners exceeded the
14 decrease in the pending applications, what is the
15 reason? Regardless of the reason, do you have figures
16 on what the cases per examiner ratio was, say, two
17 years ago versus what it is now?

18 MR. FRIEDMAN: I don't. I assume the office
19 does and I would assume for the reasons I'm probably
20 going to mention, examiners are probably working on
21 less cases than they have in the past.

1 In part for some of the reasons I'll talk
2 about, whether it is working on all goods or handling
3 additional administrative tasks compared to before.

4 I think some of the other nuts and bolts
5 answers to your questions are even with filings
6 comparable to maybe '99 versus 2000 and 2001, to repeat
7 myself they are still coming in at a greater level than
8 we're working on which was even the case last year when
9 we had a full compliment of attorneys. So,
10 obviously, that's one of the reasons we have gone from
11 65,000 to 95,000.

12 So, I think examiners -- that's one of the
13 reasons why I think the level keeps going up as well as
14 some other points I'm going to touch on in a minute.

15 MR. STIMSON: I would be interested in
16 hearing from whomever some information about cases
17 handled per examiners. Then we can look at why that
18 may be.

19 The assumption, I think, is that their
20 examiners are handling fewer cases for example. Was I
21 correct?

1 MR. FRIEDMAN: I can touch on some of the
2 reasons right now.

3 MR. STIMSON: Is the underlying fact correct,
4 that examiners are handling fewer cases?

5 MR. FRIEDMAN: I don't know that for sure.
6 Since we, obviously, have taken the position and still
7 take the position --

8 MR. ALEXANDER: What I would like to do is
9 let Howard go ahead and finish his presentation rather
10 than have a back and forth -- TPAC perfectly welcome to
11 answer questions.

12 I don't want to get the office and Howard
13 going back and forth on reasons for something. I would
14 rather have the office answer all at one time after
15 Howard finishes and then Howard certainly can comment
16 on that.

17 MR. STIMSON: I wasn't asking the office to
18 come up with reasons. I was just trying to get the
19 basic facts before we go any further; I wanted to try
20 to understand what factual basis for what we are
21 talking about was. I still don't understand what that

1 is.

2 MR. FRIEDMAN: I think perhaps two other
3 factual reasons are as follows: one, examiners are
4 doing all goods and services.

5 And we believe that that is more time consuming.

6 I presume amongst other reasons as a
7 reminder, TPAC believes that too, which they made very
8 clear in last annual report that they were not in favor
9 of everybody doing all goods, to the contrary they were
10 in favor of specialization which is obviously a topic
11 we're going to be tackling this afternoon.

12 And two, amongst other things, not
13 withstanding Chris's fine presentation this morning,
14 clearly one of the additional burdens examiners have
15 assumed is more administrative tasks.

16 In that regard, without going through the
17 litany of our list, amongst other things we're
18 responsible for database, electronic database which
19 hasn't been the case to the extent it is today.

20 And frankly, as we all know the buck stops
21 more or less at the examiner's desk, and frankly, when

1 somebody has a question they are going to call the
2 examiners not somebody else.

3 So, there are a myriad of administrative
4 tasks that we're assuming that we haven't had to assume
5 in the past to the extent we do now.

6 In that regard, it is a poor analogy, but
7 again, to try to put yourself -- to try to have me put
8 myself in your shoes and vice versa.

9 Maybe it is not akin when it comes to
10 specialization to you deciding all of a sudden or
11 someone in your office deciding all of a sudden that
12 you are going to do a little real estate, you're going
13 to do a little probate work.

14 If that's the case maybe all it reflects is
15 that you are going to do some billing or eat some time.

16 For us we can't eat the time.

17 Every time we pick up something that takes --
18 and we have gone through this before -- where it's
19 worth going through today is it touches on just about
20 every issue.

21 We have to do a file in 40 or 50 minutes if

1 it takes five minutes more that's an eight or 10
2 percent hit we take. And whether it is taking on
3 administrative tasks working on steps we're less
4 familiar with, et cetera, et cetera, it's a difficult
5 proposition.

6 In that regard, the demonstration you got
7 with FAST -- we have problems with FAST. Let's make
8 sure we get it on the table so everybody can look at it
9 as we go through the morning and the afternoon.

10 We made very clear at the office that,
11 frankly, what should have happened from our
12 perspective, I appreciate reasonable minds differ, is
13 that as we had suggested in proposals way back in
14 August, there should have been a pilot program. It
15 should have been rolled out to one or two offices,
16 worked out the kinks.

17 I never take it as a good sign when the help
18 desk which is where people can call when they have
19 problems, and if I'm wrong I'm wrong, I don't believe I
20 am, I never take it as a good sign when the help desk
21 assigns people to handle a particular issue.

1 have had on their productivity. It is important to you
2 on their quality and even most important on customer
3 service.

4 I have them Miles. I would be happy to pass
5 them out, share them with the office and TPAC, and
6 discuss them throughout the day. Hopefully, we can do
7 that maybe after I finish.

8 As a few of you have pointed out going back a
9 number of months, including myself, there are a number
10 of contradictions in the strategic plan relative to
11 what is in the plan and what the goals of the office
12 are.

13 In that regard, keep in mind throughout the
14 day that I think there is definitely a conflict between
15 your goals and, frankly, the president's
16 administration's goals when it comes to what this
17 administration is trying to do in the federal sector.

18 I'm not commenting on whether it is right or
19 wrong. I'm just pointing out is what the president's
20 goals may be, whether it is the work force, out
21 sourcing, aligning budgets with the performance goals,

1 financial criteria, may not be in line and may directly
2 conflict, in fact, with customer service, quality,
3 pendency.

4 That's something I think TPAC has to probably
5 deal with, probably has to struggle with. It is
6 probably something frankly, the agency has to struggle
7 with and appreciate that in their capacity they have to
8 do what each new administration puts on the table.

9 That doesn't mean TPAC necessarily has to
10 agree to it and I think needs to give their input as to
11 what is important to them and the office of course,
12 will factor that in when it determines how it is going
13 to go about meeting its goals.

14 Everybody is doing all goods. Everybody is
15 handling more administrative tasks. Most of our
16 bargaining unit, probably 90 percent are GS-14s where
17 they have gone through a particular process.

18 As a reminder, when we get to the afternoon
19 if not before, the TPAC group took great pains again,
20 in its most recent annual report that it was not in
21 favor of certification.

1 TPAC believes there are other ways of making
2 sure people are trained. In that regard we obviously
3 feel very strongly that the best way we can help the
4 office when it comes to E government quality and
5 pendency is by giving us more training time and more
6 examination time.

7 Finally, after you think about all of the
8 things that have occurred in the last year, things that
9 I have noted, the reduction in staff, going to E
10 commerce electronic commerce, FAST, the factor I left
11 out is a move, and any time a move occurs you are
12 always going to drop in pendency. That's what occurred
13 here.

14 Historically, it always occurred at the PTO.
15 It will occur in the future when we move to Carlisle,
16 probably even more. But as you move, as you do all
17 goods, as you're responsible for the database, as you
18 debate whether there should be second set of eyes, as
19 you also discussed whether there should be
20 certification.

21 And of course as we think about what happens

1 in 100 plus days now when we go to Madrid, even after
2 all of that, the office still has on the table looking
3 at its work force, using examination teams, bringing in
4 paralegals, which is one of the hugest contradictions I
5 can see, because it has been made very clear over the
6 last six months that the attorneys are responsible for
7 doing many more administrative tasks than we have ever
8 done, point one.

9 Point two, the strategic plan has made very
10 clear that one of the reasons the office wants to use
11 paralegals is so that we can focus on substantive
12 examination and paralegals can focus on administrative
13 tasks, which is clearly in direct contradiction to the
14 administrative task that the office has required us to
15 do over the past six months.

16 I don't quite know if we go through
17 examination teams from your perspective how that's
18 going help quality. I don't know how it is going to
19 help customer service. The more people who touch a
20 file generally the worse off things are.

21 I don't quite understand how it is going to

1 help in pendency. I would presume, again to stretch
2 that poor analogy, but I'm still trying to relate some
3 of this to you, you generally even if using a paralegal
4 want to handle that file, you want to do the work, it
5 is probably the most efficient way of doing it.

6 If we need or require the working file within
7 40 or 50 minutes, I'm not quite sure how much more
8 efficient time wise we can get if we have more people
9 touching the file than just one person.

10 MS. KANE: Is that a requirement of the
11 office, that you complete your examination in 45 to 50
12 minutes?

13 MR. FRIEDMAN: Most people are GS-14s, the
14 production rate is 1.3 an hour. I think it comes out
15 to 48 or so minutes.

16 As we have emphasized over the past year you
17 are supposed to do something in 48 minutes and you take
18 a 4.8 hit, that's a 10 percent hit and that adds up
19 throughout the day.

20 In any event --

21 MR. ALEXANDER: The ones we saw today were a

1 very quick processing, they were all descriptive you
2 just immediately reject. I'm sorry, go
3 ahead.

4 MR. FRIEDMAN: Miles, I wish it could be so
5 easy. I wish.

6 I know it was tongue and cheek, but that's
7 why in part we had surveyed the bargaining unit.
8 Because there is the office's perspective obviously,
9 we're not going to be on the same page on a lot of
10 things. Frankly, we have been on different books in
11 most things of late.

12 But we felt it was important to go directly
13 to the people who are doing the work who have to assume
14 all these tasks and that's why we did the survey.

15 We would be pleased to share with you the
16 results of that survey. I have many more things to
17 say, but I think I have indulged the TPAC committee
18 enough. I'm sure I'll be chiming in once or twice or
19 15 times throughout the day anyway, so I appreciate
20 your time.

21 MR. ALEXANDER: Thank you very much.

1 MR. NICHOLSON: I would actually like to see
2 the survey if there was any way we could do that
3 sometime today.

4 Generally, I was just wondering if you could
5 tell us what you would describe as the morale of the
6 bargaining unit overall at this point in time?

7 MR. FRIEDMAN: Terrible.

8 MR. NICHOLSON: Okay. I assume it is for the
9 reasons you have just gone through?

10 MR. FRIEDMAN: Those and other reasons,
11 absolutely.

12 It is because -- let me make this clear, not
13 only because we deal with different bargaining units
14 throughout the office, but because I don't want TPAC
15 members who we see once every three months -- I want
16 them to have the full picture.

17 We have no problem and have never had a
18 problem with embracing technology. I know Miles had
19 raised the issue about typing, yeah, we have people,
20 regardless of their ages, who struggle with it. But we
21 never took the position that we were going to come up

1 with different plans when it came to people who type.

2 We need to use the computer. We understand
3 the benefit of using computer.

4 What we have a problem with is being given enough time
5 to be trained to use those tools, to understand how
6 best those tools work so that we can turn around and
7 provide you with the quality service and timely service
8 you are looking for.

9 And to continue to be trained so that we know
10 best how to examine. And that's really when it comes
11 right down to people feel they are not comfortable with
12 the training.

13 They don't feel they have been given enough
14 time to examine. They've obviously been encumbered by
15 taking on the additional work from their friends and
16 colleagues who have left.

17 They have assumed a number of additional
18 duties including administrative tasks. They don't have
19 a comfort level yet with doing all goods versus --

20 MR. ALEXANDER: We're getting repetitive on a
21 couple of things in terms of a broad range of goods and

1 time for training and such. I would like to really
2 move on.

3 I would like to give everybody the figures,
4 which I saved from a couple meetings ago on staffing.
5 These are for fiscal year ends.

6 In 1998, there were 225 positions, and I
7 won't give you the new hires and attritions, but it
8 went from 225 to 281 in '98.

9 Started in '99 with 281 and it went up to
10 367. To give you an idea, in that year there were 136
11 new hires and 50 attritions. In 2000 it went -- it
12 started at 367 and went to 383.

13 In 2001, dividing it into two parts -- I'm
14 sorry, 2001 it went from 383 to 389 that Bob was
15 talking about. In 2002 it went from 389. There were
16 eight attritions, no hires, it went down to 381.

17 And that gives you sort of where it was at
18 the time of the RIF, as I see it, from the figures I
19 have.

20 I can give you some figures in terms of
21 backlog and inventories, and a peak in the second

1 quarter of '01 the inventory as about 250,000. It went
2 down to below 140,000 in the third quarter of '02 when
3 filings dropped drastically and the staff did not.

4 And that is the point of departure, I think,
5 at the time of the RIF.

6 Let's take a minute. John has arrived and
7 wanted to say a couple of words of welcome.

8 MR. DUDAS: I want to note that everyone
9 here, as a group of lawyers after that lightbulb broke,
10 that was my first thought you are all special
11 government employees today.

12 Thanks very much for introducing me. I
13 wanted to first, thank you for your service as
14 chairman. I know this is your last meeting as
15 chairman, it has been wonderful. You are the first
16 chairman at TPAC under IPA.

17 MR. ALEXANDER: Unless we call a July 6th
18 meeting.

19 MR. DUDAS: I won't talk about last. Let me
20 keep it at thank you. I will especially note David
21 Stimson and Joe Nicholson, as well, who are coming up

1 on three year terms. Thank you all.

2 MR. ALEXANDER: Jon, thank you very much.

3 MR. DUDAS: Thanks, I appreciate it. Thanks
4 everybody.

5 MR. ALEXANDER: I would like to move on to
6 the first subheading under the 9:30 to 1 o'clock
7 session, which is E government progress and incentives.

8 I can sort of start it off by wondering
9 whether there is any reason that the USPTO has found
10 that some firms that will file close to 1,000
11 applications a year are at 97 or 95 percent electronic
12 filing. Some firms are at the 10 and 20 percent
13 electronic filing. There must be some sort of
14 rationale with numbers that large.

15 I noticed one of the smaller firms are --
16 several have zero firms that USPTO has particularly
17 good connections with. Is there any rationale for this
18 that anybody knows? Anything we can do about educating
19 those firms that are not on board?

20 I have pressed in a couple of firms to find
21 out what the problem is with those that are under 50

1 percent but working up towards going over 50 percent.

2 I get feedback on signatures, which I really
3 don't understand, people that are not comfortable with
4 filing an application unless they have the signature of
5 the responsible executive because they have to get the
6 information from three or four people and they don't
7 really have direct contact with the executive signing
8 the application. And therefore, they don't
9 want to file electronically until they have the
10 signature.

11 One of the memorandums talks in terms of,
12 basically, saying the rules require the signature to be
13 under oath and you cannot patch it on electronically.

14 PTO only accepts its electronic forms that is
15 why we cannot cut and paste from the OHIM web site to
16 incorporate complicated specifications goods into 44 D
17 and E applications but have to retype in PTO.

18 We could enter the same information on PTO's
19 on line and affix the client's electronic signature
20 ourself, but that is the same as signing the client's
21 name which we cannot do without a power of attorney.

1 And some boards require board resolution for a power of
2 attorney.

3 Electronic signature has to be affixed by the
4 authorized signatory who verifies the document on
5 behalf of the applicant see rule 2.33 D1.

6 Any input on what a response to that would be
7 by the USPTO? How has the signature problem resolved
8 with others?

9 Corporations have no problem, because they have the
10 authorized person right there on line.

11 MR. MORRIS: We have really made signature as
12 easy as possible in terms of giving four different ways
13 of signing the application either sign directly. We
14 understand that might be a problem, so we enhanced the
15 form that you can e-mail the application very easily to
16 another location for some to sign.

17 If you don't want to do it through e-mail you
18 can still do it through a signed paper document that
19 can then be scanned, that image attached to the
20 electronic form. Or the electronic application can be
21 submitted with no signature at all.

1 So we kind of remain at a loss at this point
2 unless you all are willing to really fight to have
3 signature requirement eliminated entirely. What else
4 can we do from our end in terms of solving any
5 perceived signature problems.

6 I think quite honestly it remains just an
7 educational problem inasmuch as when I go out to do the
8 presentations, people seem very surprised when they see
9 how the application can be signed.

10 Again, we're not sure from our perspective
11 what more we can do to educate people in terms of those
12 different options.

13 MR. ALEXANDER: That had been my
14 understanding. In the latter, the unsigned
15 application, what happens, what is the process with
16 that?

17 MR. MORRIS: The process is the same with the
18 paper submission. It becomes a requirement during
19 examination that a signed declaration be submitted
20 before the application can go to publication.

21 But in terms of getting a filing date,

1 signature is not a filing date requirement. So you
2 could submit the electronic application with no
3 signature at all and at least get today's filing date
4 and worry about signature later in the process.

5 MR. ALEXANDER: So the person gets a paper
6 application fully signed by the applicant subsequent to
7 filing it electronically without signature, that can be
8 scanned in at a later time. And how is it scanned in,
9 it is not with the original application anymore?

10 What would the outside counsel do to scan
11 that in and send it in to the USPTO so that it would be
12 accepted? Because it is no longer going to be on the
13 electronic form.

14 MR. MORRIS: Right. You could use our
15 electronic -- either preliminary amendment form or
16 response to office action to submit that signed scanned
17 declaration.

18 MR. ALEXANDER: That would keep everything
19 electronic?

20 MR. MORRIS: Correct.

21 MR. ALEXANDER: Would you mark this to type

1 up separately for me to send to a number of people?

2 MR. MULLER: Does the office have any
3 information on the breakdown of electronic filings on
4 1A, 1B, and section 44 from outside firms, and are they
5 using it in one vehicle but not in another?

6 MR. ALEXANDER: Does anybody here know?

7 MR. MULLER: Does anybody know the answer to
8 that? That could be a clue as to why people are not
9 relying upon signatures, for instance, from clients
10 from Asia or Europe. Do they feel uneasy about that?
11 They may feel uneasy about bringing their signature on
12 an intent in the application.

13 MR. ALEXANDER: I suspect not. Because a
14 couple of the law firms that do an immense amount of
15 foreign and US work are at 97 percent and 94 percent
16 electronic. Whereas, one of the biggest firms of the
17 country that does both is down at 20 percent.

18 MR. MOYER: I have a question. Currently, the
19 electronic filings are about 55 percent. The goal is
20 to get to 80 percent?

21 MR. ALEXANDER: Right.

1 MR. MOYER: Two questions, by when do you
2 hope to be at 80 percent and do you have a plan, I
3 mean, what is the plan to close the gap?

4 MS. CHASSER: Our goal to get to 80 percent
5 was established when we believed that the fee bill
6 would go into effect on October 1, 2003, which would be
7 our 2004 fiscal year. We, from our
8 perspective we feel that we have gone as far as we can
9 in terms of incentives. We introduced the one eight
10 rule as you recall, which gave us a bump from about 25
11 percent -- I guess it was about 28 percent up to our
12 current rate.

13 We believe now that if there is a financial
14 incentive. And under the fee legislation, there would
15 be a financial incentive, and I think the public
16 advisory discussed this extensively in our previous
17 meetings that there is a differential between
18 communicating completely electronically versus in the
19 paper format, that that would certainly encourage those
20 firms to discuss that option with their client and
21 would incentivize electronic filing.

1 We are continuing our outreach effort. We
2 have been -- Craig, as he mentioned has literally been
3 all over the country talking to bar groups, talking to
4 law firms.

5 We have had a number of groups in the office
6 to observe our operation. We were enhancing the web
7 site looking at how we might make that more user
8 friendly than it already is and that's what we have
9 been working on thus far.

10 I don't know, Bob, do you have anything else
11 you would like to add?

12 MR. ANDERSON: One thing that might impact
13 too is in 2004 we are 100 percent positive that Madrid
14 filings will be 100 percent electronic.

15 I believe law firms have to move to
16 electronic filing to use the Madrid environment. That
17 will encourage them to take a look at electronic filing
18 across the board. I tend to think that the
19 Madrid system we're setting up will encourage law firms
20 to move towards electronic filing also.

21 MR. MOYER: One other question. I get this

1 all the time, the top 300 IP law firms and everyone
2 wants to be in the top box. That information obviously
3 is all available to the public.

4 The number of applications that one does
5 electronically, is that information available to the
6 public?

7 MS. CHASSER: It is not actually available to
8 the public. It is available to us. That's actually
9 the document that Miles is looking at.

10 We did an internal evaluation when that
11 information came out of the top 100 law firms and brand
12 owners. We did an internal study to see what
13 percentage of electronic filings versus paper filings
14 from those top 100 organizations were.

15 MR. STIMSON: David, are you suggesting they
16 be made public?

17 MR. MOYER: Yes. That's what I'm saying. If
18 that information is made public a reporter will
19 presumably be interested in that because it is
20 information.

21 MR. ALEXANDER: I have heard of doing so.

1 Nobody in this world is as competitive as law firms.
2 If one law firm has 98 percent and another has 20
3 percent, it will appear in the selling material of the
4 law firm with 100 percent.

5 MR. MOYER: It has to be information, I think
6 -- well again, it is nice to have this take care of
7 itself. It is a public information -- it is
8 information that should be made available to the
9 public, reporters can look at it, and it's a piece of
10 data.

11 I mean, it is an informational world. I just
12 think that is one way when you are looking at closing
13 gaps -- I understand Madrid, the fee scales, and
14 everything else, but as Miles says to the extent you
15 can benchmark among corporations -- if I'm not doing
16 well and my boss sees I'm not doing as well as somebody
17 else, he is going to ask what is going on, Dave?

18 MR. ALEXANDER: Or she.

19 MR. MOYER: Or she. I happen to have a male
20 for a boss, so it was okay for me to say. I expect to
21 get questioned on those things -- I expect law firms --

1 if it gets benchmarked, if it gets out in the public
2 that would be my suggestion.

3 MS. CHASSER: We have disclosed the
4 corporations in the past through public vehicles. We
5 have been reluctant to disclose the law firms because
6 of the sensitivity.

7 If that is a recommendation that the public
8 advisory committee would like to make to us that we
9 consider publicizing law firms as well as corporations
10 -- we believe that the corporate data was more public
11 than the law firm data.

12 So we were sensitive to the law firms issues
13 of not disclosing that information. But it is
14 certainly available for us to make available if that
15 would be something that you would recommend.

16 MR. ALEXANDER: Could I have a motion to that
17 effect?

18 MS. CHASSER: We'll say at the recommendation
19 of the public advisory.

20 MS. KANE: I have a question. If you are
21 going to public disclosure, who is going to be publicly

1 disclosed? Just this so-called 100 or 400? What would
2 be your parameters?

3 MR. ALEXANDER: How about a motion for
4 anybody that files more than 100 applications a year?

5 MS. LOTT: Or you could just publish the top.
6 If the objective is as an incentive to bring out the
7 competitive edge, the competitive instincts of law
8 firms, you could just publish the top 100 law firms
9 based on percentage not on raw numbers.

10 That probably would draw less heat from the
11 ones --

12 MR. NICHOLSON: Has any consideration gone
13 into maybe the PTO, I don't know if this would be
14 appropriate, but actually sending the nonusers the
15 special communication saying we are available to train
16 you -- Craig does an excellent presentation, just
17 educate them to the fact that they could be educated in
18 a more specific way.

19 MR. STIMSON: We're about to publish a list
20 in a few months.

21 MR. ALEXANDER: We do that at campaign guides

1 for -- in line of legal aide. You just tell everybody
2 that here is the standard we expect and we're going to
3 publish a list of givers and nongivers shortly.

4 MS. KANE: I am a little reluctant on the
5 publish disclosure aspect of it. Because there are
6 going to be at least on a very broad based public
7 disclosure, I think there are going to be situations in
8 some cases with some clients where you are going to
9 want to have that client's name on a dotted line, not
10 in the middle of the prosecution, but in advance.

11 And people pay attention when they know
12 there's scoring, or at least they should when they are
13 scoring for something. I'm not conversant with all the
14 ways you can get around it.

15 I don't think the answer is necessarily to
16 file a document in the middle of the prosecution when
17 someone is going to say sure, (inaudible) going swear
18 to it.

19 MS. CHASSER: On the information that we
20 pulled it was initial application filing, so it
21 wouldn't be --

1 MS. KANE: No, what I'm saying is to make a
2 broad based statement that you are a bad person if you
3 don't file electronically causes me some concern,
4 because there are some situations where there may be
5 some valid reasons for not, initially, filing
6 everything electronically.

7 MR. ALEXANDER: I don't want to press the
8 group to do something it has a reluctance to do. I
9 will say this, all of this information is public
10 information. Somebody could go on line
11 and put together, I think, exactly what the USPTO has
12 done, if I'm not mistaken, by finding out every
13 application that has been filed, what firm filed it.
14 You can do it through Thompson and Thompson right now.

15 MS. KANE: Have you tried contacting -- you
16 mentioned, Miles, a nameless firm, right, that does
17 thousands and thousands of applications?

18 MR. ALEXANDER: Nobody does thousands, but
19 over 1,000 over 900 a year.

20 MS. KANE: Whatever. Have you tried going to
21 somebody like that, a big number, which is really a big

1 number is going to make a big difference to you guys as
2 opposed to some firms that file 10 or 15 a year, and
3 asking them why and trying a special presentation to
4 the big guns, so to speak?

5 MR. MOYER: Here's maybe what can happen, I
6 understand the concerns and here is a reason why, it is
7 a different consideration versus a law firm.

8 Is the information whether someone files
9 electronically, is it available to the public, is that
10 something that happens behind the scenes? I think it
11 probably is.

12 MS. CHASSER: Technically, if somebody wanted
13 -- Gary can speak to this, because he actually pulled
14 together the list, his office. It would be much more
15 difficult to go item by item. We can set up a program
16 to --

17 MR. CANNON: Would that list look for
18 particular names and finding out which of those, which
19 percentage were electronic and which were not?

20 UNKNOWN SPEAKER: You can search through
21 public information. All the data is in the database.

1 You can search for attorneys, and since that's a field
2 in the database, whether or not it's an electronic --

3 MR. ALEXANDER: You would be able to do it by
4 fee shortly.

5 MR. MOYER: Here is a way that maybe the PTO
6 could go about this. Again, it would be a positive way
7 as opposed to a negative way.

8 Perhaps looking at the firms that file over
9 70 -- the goal is 80 percent? The firms that file over
10 80 percent of their applications electronically should
11 be publicized as a -- give them a gold star.

12 They are hitting -- they are acting in
13 compliance with what the USPTO wants.

14 Then, there will be a lot of firms not on the
15 list and all those firms can then look at themselves
16 and say, why does this firm do it and why are we not
17 doing it.

18 So you would not be publically critical of
19 firms that are not at 80 percent. I just picked 80
20 percent because that is your goal.

21 MR. ALEXANDER: That's the legal aid

1 approach.

2 MR. MOYER: It is something to consider.

3 MR. ALEXANDER: Do we want to -- we're at the
4 electronic agenda item. Do we want to give some
5 consideration to this and come back to it, or do we
6 want to take a motion on it?

7 MR. STIMSON: Let's wrap it up now.

8 MR. ALEXANDER: Do I hear a motion?

9 MR. MOYER: I'll make a motion that the USPTO
10 publicize in a good way, positive way, firms that are
11 filing over 80 percent of their applications
12 electronically.

13 MR. STIMSON: I'll second the motion.

14 MR. ALEXANDER: By firms you mean
15 corporations and --

16 MR. MOYER: Corporations and law firms.

17 MR. ALEXANDER: Do you want to have a cutoff
18 of over a certain number of applications?

19 MR. MOYER: I would say firms that file over
20 100 applications a year as a reasonable cutoff, because
21 this will involve work on the part of the USPTO to pull

1 this information together.

2 Does that sound reasonable?

3 MR. CANNON: Yes. We look for a particular
4 firm's name if we have the name of every firm that
5 filed over 100 we could look for that.

6 MS. CHASSER: We have it.

7 MS. KANE: You already have a list?

8 MS. CHASSER: There was a publication that came out
9 several months ago was it brand names? I think
10 everyone around -- it was a glossy publication that
11 came out around the time of the INTA meeting that
12 listed the top 100 law firms in terms of filings to the
13 USPTO and the top corporations in terms of filing.

14 It was a publication that got the information
15 from our public records. We took that list and --

16 MS. KANE: What I'm trying to get at is how
17 many firms would there be in the firms that file 100 or
18 more a year?

19 MS. CHASSER: I can't tell you that.

20 MR. ALEXANDER: It is not going to be more
21 than 30 or 40.

1 MR. MOYER: But it will be that many when you
2 add corporations together with law firms?

3 MR. ALEXANDER: With corporations it would be
4 more.

5 MR. MORRIS: Two follow-up points, do you
6 have a recommendation that in effect we would be cold
7 calling some of these firms?

8 If you were one of those firms, if I were to
9 contact you putting a positive spin, not being
10 accusatory as why aren't you doing this, just trying to
11 find out, gee, is there anything we might be able to
12 help you, would you all feel I was overstepping my
13 bounds in terms of questioning your practice? That's
14 the first question.

15 Second, is kind of a factual point to
16 emphasize even were we to get some of our large filers
17 to file electronically, that apparently is not going to
18 make a difference. I'm surprised to find out
19 even if we converted that group -- Karen, is that what
20 we found? It is kind of the lower level filers, we
21 have to get a lot more of them in the program and

1 those are harder to reach, I think.

2 MR. ALEXANDER: If you have somebody that is
3 filing 1,000 applications a year, and only 10 or 20
4 percent are electronic, you would have to get a lot of
5 small companies and small filers to match what you
6 could get if you could convert that to 100 percent.

7 I think what the TPAC was saying was, why not
8 try to identify large filers who are problems and
9 contact them directly and even offer to put on a
10 seminar if necessary and most of those firms would pay
11 you to do so. They would pay your expenses to come.

12 Just as you have come to Chicago, and
13 Boston, Atlanta, a lot of those firms attended at those
14 sessions. I think I speak for the TPAC in saying we
15 would welcome the patent and trademark office
16 identifying large filers who are not electronic and
17 contact them individually if that is what you are
18 asking.

19 Is there any descent from that?

20 MR. PRICE: No. I certainly concur with
21 that.

1 MR. ALEXANDER: Thank you, Griff. Anybody
2 else?

3 MR. MULLER: Just one clarification, I
4 remember reading somewhere that the top 500 filers or
5 maybe top 100 filers was only five percent of the
6 filings. Is that right, is that what you are getting
7 at, Craig?

8 MR. MORRIS: That is what I'm getting at.
9 Correct.

10 MR. MULLER: So, on a differential getting
11 from 54 to 80 is going to be more difficult than just
12 getting those people to file electronically.

13 MR. ALEXANDER: Yes, but you can take a 10 or
14 15 percent jump, I would think, and I don't know how it
15 breaks out between the small filers and large filers.
16 Do you have any statistics on that?

17 Somebody told me the small filers are better
18 at electronic filing than some of the large ones.

19 MR. MORRIS: I think initially that was
20 certainly the case. I think large filers have come up
21 to speed more recently.

1 Again, on a related point, my concern remains
2 at this point in the game it is not now a situation
3 where these firms don't know how to do it. I think
4 initially, it was a learning curve.

5 My going out and I'm certainly willing to
6 continue to do this. I have the feeling that there
7 has to be something else going on at some of these
8 firms as to why their level is zero percent.

9 And I don't know think it is a question of
10 my going there and doing a demonstration and saying,
11 oh, this is how you do it.

12 Unfortunately, I don't have the answer. And
13 maybe that's information you all would have a better
14 feel for, what might be going on at those firms. I
15 don't know.

16 MR. MULLER: Craig, let me clarify one thing.

17 If you want to file an actual signature, in other
18 words, a paper copy signature you can still do that
19 electronically from what you told us. Right?

20 MR. MORRIS: Correct. It is a hybrid
21 approach where you would begin the process

1 electronically but the middle piece you are able to
2 create a paper document with fax or mail that to a
3 client.

4 They would sign in conventional pen and ink
5 manner, mail or fax it back to you. Then you would
6 scan that actual declaration and affix it back to the
7 electronic form.

8 If you have clients that only will deal in
9 paper, the system can accommodate that.

10 MR. MULLER: I just can't imagine why people
11 wouldn't do that.

12 MR. ALEXANDER: Nor can I.

13 MR. MOYER: Let me add one other factor.
14 Maybe this isn't something that gets reported, but what
15 has happened in the past. Rather PTO is going to start
16 reporting this beginning January 1, 2004, based on the
17 last six months kind of thing.

18 Law firms at least know it is going to get
19 tracked and get reported, if that makes sense. Again,
20 we don't want to alienate folks.

21 MR. ALEXANDER: Let me restate what I

1 understand the motion before the TPAC is. USPTO will
2 publicize beginning January 1, 2004 as of the last
3 fiscal year -- well, maybe not.

4 Maybe that doesn't give enough time because
5 fiscal year is going to end and people will have
6 already been frozen where they are beginning with the
7 fiscal year 2004, which is -- October 1, 2003, the
8 USPTO is going track filings by major filers.

9 We don't have to get number (ph) -- and
10 publicize those who have met the 80 percent standard.

11 MS. LOTT: Point of clarification, this is
12 not a directive to the PTO; this is a suggestion from
13 the TPAC. We could also leave it to the PTO to decide
14 exactly when and how.

15 It is our suggestion that they track it and
16 report this as a means of encouraging electronic
17 filing.

18 MS. KANE: I just have another question.
19 Leslie's e-mail had a lot of very interesting
20 information in it, talked about problems with documents
21 getting stripped. I'm wondering if that is a reason why

1 some people are not filing.

2 This is not my area of expertise.

3 MS. LOTT: If I may speak to that, there were several
4 points raised by other users of the PTO that I would
5 like to touch on just one or two briefly, but I think
6 maybe after we have this resolution.

7 MS. KANE: Does that relate to filing
8 applications with specimens and why people may not be
9 doing it?

10 MR. ALEXANDER: For my purposes, the problems
11 with paper filing are much greater than the problems
12 with electronic filing in our office, anyway, in terms
13 of lost and not having filing dates.

14 I mean if you have a choice of which way to
15 go, the lesser of two evils in terms of where the
16 problems were, my office found lesser problems were
17 with electronic filing. You didn't have filing
18 receipts lost, you didn't have all sorts of things,
19 dates -- you didn't have files lost as much.

20 MR. MULLER: When you restated the resolution
21 you didn't put a cap on there.

1 MR. ALEXANDER: I want to find out are we
2 happy with the top 100?

3 MR. MOYER: 100 applications a year?

4 MR. ALEXANDER: Yes. We're really dealing
5 with just applications not section 815 and other
6 things.

7 I think that people that are doing
8 applications are more likely to be doing everything
9 electronically. So, there are three elements. One, to
10 the recommendation one is we recommend that notice be
11 given to the trademark bar commencing 2004, filings are
12 going to be tracked.

13 Secondly, that the top 100 filers are going
14 to be publicized to congratulate those who have met the
15 80 percent standard. Is that basically what everybody
16 understands it to be?

17 MS. KANE: You said top 100 filers?

18 MR. ANDERSON: Yes.

19 MR. MOYER: I thought it was 100
20 applications.

21 MR. ALEXANDER: I'm sorry. Do you want to

1 make it 100 applications?

2 MR. MOYER: Yes. 100 applications.

3 MR. ALEXANDER: Okay, anybody filing over 100
4 applications.

5 MS. CHASSER: What we'll do is we'll look at
6 the top law firms by that published list.

7 MR. ALEXANDER: Law firms and corporations?
8 Or do you just want to leave it to the discretion of
9 the top filers determined at the discretion of USPTO to
10 publicize?

11 I think that's better, then nobody knows if
12 they are in it.

13 MS. CHASSER: I can pull that document for
14 you and just see a copy of the document so that you can
15 -- has special government employees that we pull that
16 information from and you might just want to take a look
17 at that. Okay?

18 MR. STIMSON: I'm firmly in favor of this.
19 I'm not in favor of spending anymore time on it in view
20 of everything else we have.

21 MR. ALEXANDER: All in favor raise their

1 hand. Griff?

2 MR. PRICE: Yes.

3 MR. ALEXANDER: Opposed?

4 Unanimously carried.

5 MR. MORRIS: Those questions that were in
6 that e-mail Leslie -- I believe, my assistant prepared
7 answers. Did you all get the handout with that? I do
8 have a written copy with the answers.

9 MR. ALEXANDER: That would be helpful.

10 MS. CHASSER: We can provide that to the
11 members.

12 MR. ALEXANDER: Is there anything else on
13 electronic filing before we move on to quality issues?
14

15 MS. LOTT: If I may just raise two of the
16 things. I don't want to rehash anything you have
17 prepared in written form, but there were two things in
18 particular that seemed to come up over and over again.
19

20 One, was the -- some glitches with
21 attachments. I believe Commissioner Chasser has

1 addressed that already. That provision has been made
2 for, what did you say, attaching up to 50 pages?

3 I don't know if that's the same thing as the
4 problem with attachments sometimes being detached or
5 lost. I think another one was that one problem is
6 apparently you cannot file electronically for a
7 supplemental registration. Is that still true?

8 MR. MORRIS: I'll answer the second one
9 first. Back in November, we had put up four new forms.
10 And the supplemental was one of those forms along with
11 certification mark, collective membership mark, plus
12 the trademark mark service line.

13 That's been an ongoing problem that kind of -
14 - we call the myths about trademark electronic filing.
15 You know something was true a long time ago and the
16 word never goes out that we made the change. But yes,
17 it is definitely available.

18 As far as to the images being lost, most
19 commonly, that is a browser issue that the USPTO has
20 absolutely no control over. In fact, we have in the
21 instructions a very clear statement alerting you that,

1 in fact, those images are going to be stripped out and
2 they must be reattached prior to submission.

3 It is not something that is a design flaw
4 with our site. That is simply how browsers in general
5 work and there is nothing that we can do about it.

6 However, if you are using for example, the E
7 signature approach, then that doesn't happen there.
8 We're trying to really push people in that direction.

9 So, yes. The problem if you will is out
10 there, but it's not a problem, it's a glitch in the
11 system.

12 MS. LOTT: If I can just say one thing in
13 connection with the comments I have heard and I assume
14 others of us from people who are using the electronic
15 filing system, even though what we intended to do at
16 the invitation of Commissioner Chasser to see if there
17 were problems or glitches.

18 I want you to know what we're hearing back is
19 people are very happy with it.

20 It is, I think personally, very impressive
21 what the office has done, to run the two systems in

1 tandem the paper system and the electronic system in
2 tandem, and bring them on-line. And people who
3 responded to me overall thought that -- they were very
4 impressed with what was being done and generally
5 favorable.

6 And in raising what they saw as problem
7 areas, they did it in the spirit and in the context of
8 trying to be helpful. It looks like there may still be
9 a problem here and that sort of thing. But on balance,
10 it was not a negative reaction by any stretch of the
11 imagination.

12 MR. MORRIS: Was there also a recommendation
13 that we could, in fact, directly contact some of these
14 firms?

15 MR. ALEXANDER: Yes, I think there was
16 unanimity on that.

17 MR. FRIEDMAN: What is your desire regarding
18 the issue I had brought up earlier, which is we had
19 done a survey? We are still totalling the results, but
20 we could have some preliminary results dealing with E
21 government.

1 MR. ALEXANDER: I think everybody here would
2 like to see that if you can distribute it.

3 MR. FRIEDMAN: With your indulgence I'll pass
4 them out now.

5 MS. LOTT: Miles, can we have copies that
6 Craig referred to as well?

7 MR. ALEXANDER: Yes. I would like to -- you
8 need to recognize whatever we are doing now is going to
9 be a matter of public record.

10 MR. FRIEDMAN: I can recognize that.

11 MR. ALEXANDER: Okay.

12 MS. CHASSER: I would also like to suggest
13 that we'll send that to all the members electronically,
14 so if you've had inquiries from colleagues you can just
15 forward on the questions and answer period.

16 MR. ALEXANDER: Does anybody want to take a
17 five minute break? Why don't we do that while we hand
18 these out?

19 (Thereupon, an in-place recess was taken.)

20 MR. ALEXANDER: Reconvening at 11:35 or so.
21 I would like to take our quality and quality control

1 initiatives together as a single topic although they
2 cover two different elements to it.

3 I'll open up the floor to any questions from
4 TPAC members with respect to the submissions that were
5 made to us that are in the notebook as well as in your
6 advance materials.

7 I reference you to trademark assistance
8 center report on problem resolutions and the OTQR
9 quality review examination sections in your notebook
10 and survey information as well.

11 MS. LOTT: I have a question. The summary
12 that was -- status of trademark operations, there is
13 one line in particular that I am curious about, for
14 writing it says 88 of first action letters had no
15 deficiencies with regard to writing quality.

16 So much of the substance of office actions are form
17 letters. So I assume we're not talking about grammar
18 and syntax. What are you talking about in terms of
19 writing quality?

20 MS. CHASSER: I'm going to let Kevin Peska,
21 who is the head of the office of quality, address that

1 issue and how you handle the evaluations.

2 MR. PESKA: What you are asking is that this
3 may be an artificially high number because you don't
4 expect a lot from a first action? Is that what --

5 MS. LOTT: No, I'm not making a judgment one
6 way or another. I'm just asking when you say writing
7 quality, what is it that you mean? What is it you are
8 looking at?

9 MR. PESKA: Hopefully, you saw some of the
10 examples of a database that we're using, in fact, I
11 sent examples of both a first and final action complete
12 database that we used to look at the quality. It is
13 pretty detailed.

14 Just to give you an example, let's say, for a
15 search or actually lets go to the writing category
16 since that's what we're talking about under 2D, we're
17 talking about a few things.

18 Number one, we're going to say is the
19 decision appropriate, but more to the point, we're
20 going to measure something that has never happened
21 before. Was it deficient, satisfactory or excellent.

1 based on how many answered yes or no to those different
2 details. They still have to decide whether they
3 thought the overall writing quality of that letter was
4 satisfactory, or sufficient, or excellent.

5 MS. LOTT: Thank you.

6 MR. ALEXANDER: I have a question with
7 respect to the survey overview.

8 I'm going to the customer satisfaction, which
9 I view as a quality issue, of course, as well.

10 The paragraph that says no significant change
11 in overall satisfaction since the inception, which is
12 1995, it says some yearly fluctuations, but generally
13 the overall satisfaction level has been between 64
14 percent and 70 percent satisfaction.

15 If my law firm got a response like that,
16 heads would roll. We would find out where the
17 satisfaction and dissatisfaction was.

18 I'm wondering why the office year after year
19 at that level appears to not be identifying. Maybe they
20 are identifying the specific problems of the other 30
21 to 35 percent that are dissatisfied and what has been

1 done to address those problems.

2 MS. CHASSER: I'm going to ask Marty Rader
3 who is our statistician -- and his office is
4 responsible for managing the customer satisfaction
5 survey, and he is an expert in statistics.

6 I would like you to address that specific
7 issue, if you could, Marty.

8 MR. ALEXANDER: If this were a -- if this
9 sort of satisfaction among GI's in the field, I would
10 understand it. But these are customers that are
11 usually sophisticated lawyers, I assume.

12 MR. RADER: What we found is -- first of all,
13 customer satisfaction and especially in this
14 organization is such a lagging indicator. We have yet
15 to find something that is moving along with the office
16 changing.

17 The 60 to 70 percent -- we say there is
18 fluctuation, it has probably shown a slight increase
19 since we've started doing these surveys. It is just
20 that the sampling error in survey, we have to say, hey,
21 we haven't had any significant changes.

1 We haven't hit that 80 percent yet where we
2 can say, okay, we have made this great lead. To be
3 honest with you, as the statistician and the people
4 that are looking at the data, we would be shocked if we
5 see it all of a sudden jump up to 80 percent.

6 We do not have competition here. In the
7 private sector or through its competition to come here,
8 our customers don't have the opportunity to say, hey, I
9 have a choice of where I'm bringing my business to.

10 And therefore, that 70 percent might be the
11 maximum that we can ever achieve. We know that we're
12 not going to be 90 percent. I mean, we're not going to
13 see 90 percent in employee satisfaction. We're not
14 going to see 90 percent in customer satisfaction.

15 It's a lagging indicator. It is a snapshot
16 of one given day. You might be basing it on your most
17 recent application, whatever has happened to you that
18 day, what is happening in the office that day.

19 It is a year later when we get the data and
20 get it summarized.

21 MR. STIMSON: David, I have a fact question

1 which I think would be helpful to the discussion.

2 I assume this summary overview is based on
3 question C 13, which is considering all your experience
4 how satisfied are you. Overall, there are five
5 categories. There are two dissatisfaction, and two
6 satisfaction, and there is also one in the middle that
7 says neither dissatisfied nor satisfied.

8 Of the remaining 30 to 36 percent that didn't
9 say they were satisfied, how much of that is in the
10 neutral, neither dissatisfied or satisfied, and how
11 many were in the one of the two negative categories?

12 MR. RADER: Typically, we have run about 10
13 to 15 percent in the dissatisfied grouping. It has
14 been under 15 percent consistently. So the fluctuation
15 really is in between that neutral and satisfied.

16 The folks that have been very satisfied, and
17 I don't know the breakouts between satisfied and very
18 satisfied right offhand, but the very satisfied
19 grouping stayed about the same. The very dissatisfied
20 grouping stayed about the same.

21 A lot of the fluctuations, that five percent

1 that we have seen jump back and forth, are the people
2 that are five percent satisfied one year, neutral the
3 next, satisfied.

4 We haven't really seen any change in that
5 group that is less than neutral.

6 MR. STIMSON: And that's about 10 to 15
7 percent?

8 MR. RADER: Ten to 15 percent, exactly.

9 In the customer satisfaction business, again,
10 we don't have a loyalty indicator where if our
11 satisfaction hits this you are not going to come back
12 to us next year. We don't have that indicator.

13 In that type of organization, 15 percent is
14 actually a pretty good number. You start hitting that
15 20 percent is where the red flags come on. We say the
16 20 percent not because they are going to leave and go
17 elsewhere, research has shown that's about where it
18 starts costing you more to deal with these customers.

19 They are making more phone calls to you, they
20 are interrupting your practice, and that's where the
21 red flag. As far as why we haven't seen it jump up and

1 that was one of your original questions there, we have
2 a pretty comprehensive survey here.

3 We asked for a wide range of topics we see it
4 in every customer satisfaction survey we do in this
5 organization for different business units whether it is
6 TTAB, whether it is patents, with all those questions
7 in the survey the most we can really explain in terms
8 of somebody's overall satisfaction level is about 70
9 percent.

10 We know there is still about 30 percent of
11 things in their decision matrix that is not being
12 measured in that survey. We can't find what that is.

13 It is the same thing when we go to address
14 quality. We have asked customers for ages how would
15 you like us to address quality, what should we
16 measurement. We have some 700 and some data points now
17 we are looking at and we still get customers who say I
18 don't know. I know quality when we see it.

19 We can't put that into questions on the survey. We
20 tried. We have identified 10, 15 items that explain a
21 lot of customer satisfaction, but the rest of it varies

1 from customer to customer.

2 We can ask pendency questions. We can ask
3 quality questions. But then customer A and customer B,
4 that 30 percent of their matrix, it is something
5 different. It is really hard to focus on that.

6 Then at the same time, when you are doing
7 improvement strategies our surveys are asking 100
8 questions and we're coming up with a model that says
9 this is what is driving satisfaction.

10 Well sure, if we can improve all 15 of those
11 items at the same time, that would drive satisfaction.

12 But that's just not -- we can't do that from a cost
13 perspective. The return on investment for doing that,
14 the data does not warrant that.

15 To dump all this money at these 15 items
16 because most customer surveys -- all that's going to,
17 okay, I'm satisfied with that, now let me attack this
18 issue. We are going to have a new key driver next
19 year. We see that happen.

20 I have asked you to give me E commerce for 10
21 years, you got that, I'm 90 percent satisfied. That

1 goes off the map. Let's get you something new. And
2 that's really the problem we see right now of trying to
3 get that leading indicator and we don't have it yet.
4 It is the holy grail for us, at least for me.

5 MR. MULLER: I was trying to correlate the
6 survey with the publication that Director Rogan (ph)
7 put out on the 2002 customer satisfactory report.

8 In that, it looks like there is about 60
9 percent dissatisfied under 2 E and 2 D over the last
10 four years. How does that relate to the survey that
11 you have done that shows you have about 60 percent
12 satisfied?

13 MR. RADER: That data all comes from the same
14 circuit. That blue book there, the customer
15 satisfaction report, our office puts that together.

16 Those might show up as 60 percent
17 dissatisfied. But really when we have come up with the
18 main survey and don't highlight that result what that
19 is saying is that didn't prove to be a key driver of
20 overall satisfaction.

21 It might have an impact but there is a lot of

1 items where we have two percent dissatisfaction. It is
2 coming into this overall question. Again, it gets into
3 how do people interpret this overall question.

4 MR. ALEXANDER: Are you saying that you may
5 have very high degree of dissatisfaction in a couple
6 areas but when they get to the last question of overall
7 satisfaction they give a different answer?

8 MR. RADER: Exactly. You have asked them
9 about ITU. You have asked them a lot of things.
10 Hopefully, that customer when they get to the last
11 question of the survey go, okay, given everything, how
12 do I feel.

13 Some do. Some don't. Some sit there and say
14 I remember I put dissatisfied for 2 D back there.

15 MR. ALEXANDER: When you get over half the
16 people dissatisfied in a given area, what sort of focus
17 takes place in that area at that point?

18 MR. RADER: I can't answer that one. We can
19 point out if we think it's driving toward satisfaction,
20 we leave that up to the offices to decide. I'm not a
21 member of trademark so -- we can point out an item if

1 we think it warrants attention.

2 If it doesn't correlate data wise to an
3 overall satisfaction measure or some other overall
4 measure of quality, then we go to the open end comments
5 that are in that survey.

6 We have a notebook full of comments that come
7 from the survey. Then if we see it being a topic in
8 there, we say, hey, this might be one of those items
9 that can sneak up and bite you.

10 You are focusing on these key drivers but
11 keep your eyes over here. It is a not a key driver
12 yet, but there is enough comments, the data is pretty
13 poor for it, watch it.

14 That's about all we do as far as pointing out
15 whether or not it is an item to address.

16 MS. LOTT: Did we understand you to say that
17 you are seeing different -- and when you say key
18 drivers, we're talking about kind of the hot buttons,
19 the points of dissatisfaction?

20 MR. RADER: Exactly. I can try to predict
21 customer satisfaction by looking at these five items

1 that you mentioned.

2 MS. LOTT: Did we understand you to say that
3 those five items tend to be different? It is not the
4 same five items year in and year out? You tend to face
5 different sets of problems in different years?

6 MR. RADER: They will be the same until the
7 office improves them. Once the office improves them,
8 they might go off the map, because, okay, I'm satisfied
9 with them, now here is a new problem for you to focus
10 on.

11 MS. LOTT: The distinction I'm trying to draw
12 is between the hypothetical of what might happen and
13 what you are actually seeing on the surveys, if you
14 know off the top of your head.

15 Are you actually -- because you are going
16 exactly to the heart of my question. Are your survey
17 results indicating effectiveness in the office in
18 addressing the hot buttons or are you seeing the same
19 things come up over and over again so that that is
20 something we should look at?

21 MR. RADER: I think the biggest problem with

1 it -- we are seeing improvements, definitely. You see
2 the largest improvements in the items that you can
3 address pretty quick. Whether it is returning phone
4 calls, customer service related items, problem
5 resolution.

6 If it is a culture shift or an educational,
7 it is something that costs money and it takes a year or
8 two to improve, we don't see immediate results.

9 First of all, I'm going to send the survey
10 back out to somebody that has been surveyed for a
11 number of years and that have been doing business with
12 this office for 20 years.

13 If they suddenly see a small improvement in
14 customer service, they are not going to change the
15 results of survey yet. They are going wait and see,
16 hey, am I really satisfied with the service or was this
17 a blip last year.

18 We do see little stuff. The models that we
19 come up with that say you can improve satisfaction if
20 you improve pendency on first actions, if you improve
21 this, you improve that, it really requires improvements

1 in all of those areas at the same time and that just
2 not cost effective.

3 MR. MULLER: I have a follow-up question.
4 I'm still not understanding the survey and how you do
5 this. Because on the last page you have percent better
6 and, for instance, under 2 D, you have 10 percent were
7 more satisfied in 2002, then a blank in 2001.

8 But on the page before the number satisfied under 2 D
9 went from 39 percent satisfied to 36 percent satisfied.
10 That doesn't make any sense to me.

11 MR. RADER: You are absolutely right, it
12 doesn't.

13 There is a separate section in the
14 questionnaire where we actually ask -- we're not
15 providing customers -- we're not asking them to rate
16 satisfaction with 2 D last year and rate satisfaction
17 with 2 D this year. We're saying give
18 me your satisfaction with 2 D. Later on in the
19 questionnaire we have an item that says do you think
20 the office is getting better, worse, about the same,
21 drastically better. We use those to help

1 measure whether or not customers are kind of -- are
2 they being a little restrictive back here when they
3 answer this 2 D question. Again, it goes back to my
4 how is the memory affecting this survey.

5 I have seen improvements in 2 D, which I will
6 put over here that yes, 2 D is getting better. But I'm
7 still dissatisfied because it is -- it helps us, gives
8 us a little bit -- measures of are there slight
9 improvements taking place.

10 Maybe not enough to move them from a
11 satisfied for a very satisfied group yet, but there is
12 indications whether or not better. It helps us take a
13 little bit away from old system.

14 We would like everybody to take a clean slate
15 and say look at my services in the past year. But
16 customers don't do that, I don't do that. We don't use
17 those questions very much. They haven't been very
18 helpful for us.

19 The percent better, percent worse it does not
20 correlate very well with the other findings we have.

21 MR. SANDELIN: If you look at the percentage

1 response rate if a person is not happy and they have an
2 opportunity to express themselves then they will jump
3 at it. If they are kind of okay or happy and they see
4 the size and they're struck by the size of the survey
5 and how much effort and time it will take to complete
6 it, then they are much more likely not to respond to
7 it.

8 If you look at the two-thirds who haven't
9 responded to this my guess would be that the
10 satisfaction rate is enormously higher.

11 MR. RADER: In 2000, that guess would have
12 been wrong. We did do a study, we went with the same
13 hypothesis too and we tested that.

14 What we did -- now whether or not again there
15 is still biases that we can't measure, and whether or
16 not those customers said, boy, you're pestering me, if
17 I say I'm satisfied or neutral will you leave me alone,
18 that can be taking place.

19 In 2000, we did go back and we basically
20 found out that there were two reasons they weren't
21 taking the survey. One, they felt maybe the survey

1 results weren't being used. That's when we came out
2 and advertised. They say, hey, I'm too busy. Takes
3 too much time.

4 I think that if you get somebody very happy
5 they are going to fill out the survey just to give the
6 kudos. Hopefully, those kudos are going out without
7 the survey. The dissatisfied customers they
8 are letting the office know they don't need the survey
9 just to say how dissatisfied they are. But no, we have
10 not found that.

11 I think, what our plan is to every couple
12 years maybe go out there and get our quotes on that to
13 make sure -- you are right. If you don't see
14 improvements in eight years, I'm throwing it in the
15 trash.

16 MR. MULLER: Can I ask one more question?
17 Then I'll quit beating this to death.

18 If you just look at the percent satisfied
19 from '98 to 2002, it is really highly complimentary to
20 what the office has done. The track is going through
21 more and more satisfied.

1 I think it would be helpful if we had this
2 information in some kind of graph form to show the plot
3 up in the percent satisfied.

4 I think that's more important than the
5 empirical number, because of the survey as Jon has
6 indicated and as Leslie has indicated what the office
7 is doing with this data.

8 But I was thankful that I could look at this
9 and see that the process is getting better not getting
10 worse. I think that's what this survey really should
11 be all about, doing better.

12 Just a comment.

13 MR. ALEXANDER: Any other questions? Thank
14 you very much, very helpful.

15 MS. CHASSER: When we met with the other
16 groups this week, we asked the question from those that
17 came to the office what are you seeing in terms of
18 quality from the office from your personal experience.

19 Have you seen an improvement in quality. The
20 reason I'm asking is because right now we have the most
21 senior examining corps that we have ever had.

1 Most of our examiners are at the GS-14 level,
2 which is the very highest government service level for
3 trademark examining attorneys. Most of our examiners
4 have been here four years or more as 14s. One of the
5 requirements for a GS-14 is that examiners be experts
6 in all classes.

7 So, I'm just wondering anecdotally what you
8 are seeing in your own experience and what you have
9 heard from your colleagues in terms of the overall
10 quality, coupled with our aggressive approach in
11 measuring different quality points than we did in
12 previous years.

13 MR. ALEXANDER: I'm not sure that anecdotal
14 materials are going to be much help. People like
15 Leslie and I earlier sent in individual anecdotal
16 problems.

17 Leslie indicated overall people were
18 satisfied. These were basically, if not, aberrational
19 glitches in certain areas. I long ago
20 learned that anecdotal information is not going to be
21 projectable which is why the survey is so important.

1 Certainly, if anybody has a general feel from their
2 practice -- we have corporate practitioners here from
3 major corporations in the world. We have leading
4 practitioners here from the firm.

5 If you have any comments, I was not trying to
6 cut them off, I'm just trying as a matter of record to
7 make it clear anecdotal is not projectable.

8 MS. KANE: I wanted to add that I circulated
9 Leslie's comments to the people who do most of this
10 stuff at our firm and the comments I got back was that
11 she hit the nail on the head, a lot of those comments
12 did.

13 I realize that doesn't necessarily indicate
14 overall dissatisfaction, but the dimensions seem to
15 strike a chord.

16 MS. LOTT: If I may comment on the reaction I
17 got, I just invited people I knew who were
18 practitioners to let me know what their thinking was
19 and what their experience was.

20 In looking back at the comments, one of the
21 things that was really striking is that virtually none

1 of the comments looked to the quality of the examining
2 corps, the quality of the work that has been turned out
3 by the attorneys.

4 I think that what Commissioner Chasser said
5 about the seniority of the attorneys is really
6 important here. That is certainly equally true of the
7 trademark trial and appeal board.

8 The quality of the work, I didn't see -- I
9 saw only positive comments there. I think this speaks
10 in part to what Howard mentioned, that, you know, there
11 are -- the examining corps is working under some
12 hardships unquestionably and with morale issues and
13 with training issues and new things coming in and new
14 ways of doing things and so many different things going
15 on.

16 And yet, the quality of examination does not
17 seem to have suffered from that. I personally would --
18 I think that we should highly, highly commend the
19 dedicated people in this office, the examining corps in
20 particular, the trademark trial and appeal board, for
21 the work they are doing under a situation that we

1 recognize to be difficult.

2 It is growing pains in many ways. It is a
3 situation we're going through to get us to a better
4 place. But that's difficult.

5 MR. ALEXANDER: Howard, you had said
6 something.

7 MR. FRIEDMAN: I had a number of comments,
8 but now I have even more in view of some of the things
9 Anne and Leslie said.

10 First off, on behalf of 250 of my colleagues
11 and friends, I appreciate the kind words. We'll be
12 sure to pass them on to the examining corps who would
13 be interested in hearing those things, particularly a
14 few people from the outside who we work with very
15 closely.

16 To sort of bleed into the afternoon, quickly,
17 if quality is not as much of an issue to the outside
18 bar, I would only suggest that it adds even further
19 concerns to us as to the need to do the in process
20 reviews, as to the need to talk about second set of
21 eyes, as to the need to certify the attorneys.

1 Some of it is in the morning, but some of it
2 is in the afternoon.

3 MR. ALEXANDER: Howard, I would not make the
4 assumption that the quality is not of interest to the
5 bar. It is of great interest. We haven't gotten into
6 some of the things we're going to discuss with quality
7 yet.

8 We haven't discussed the TTAB situation. We
9 haven't discussed the fact that there is 11 percent
10 where major issues are missed in the first action or
11 the final action.

12 Eleven percent error rate in a major
13 consideration trademark application is serious. So,
14 don't assume that quality is not of interest to us
15 because it is.

16 MR. FRIEDMAN: That leads to my second point,
17 which is I couldn't agree more. As I probably said to
18 some degree this morning, will probably say a few times
19 before the day is over and will continue to say, as I
20 had mentioned to a few TPAC members during the break,
21 the best way we know, the most prudent way we know to

1 improve quality is to give examiners more time to
2 examine and more training time.

3 And we think a number of the quality issues
4 that you have raised as well as other issues at TPAC
5 that our members and customers have and will raise can
6 be handled by giving more time.

7 As an example to sort of address very quickly
8 the in process reviewing, as I go through these remarks
9 either now and in the afternoon, let me make very clear
10 that I have a lot of respect for a number of people
11 that run these offices, whether it is Kevin Peska,
12 Chris Doninger, or others. But that doesn't mean we
13 don't have problems with what is rolled out from these
14 offices.

15 In that regard, when we were talking about in
16 process reviews some of the things that were passed
17 out, whether an action was excellent or deficient, one
18 of the problems we had is those files started to be
19 reviewed before any standards were passed out to the
20 bargaining unit.

21 So no one had any idea -- people had an idea

1 of what was going on but had no idea how those cases
2 were initially going to be reviewed. So that they
3 could, of course, try to address them in whatever
4 office actions they were provided.

5 There were some standards that came out
6 later, but they didn't come out when the in process
7 review began. That was a problem that I heard from a
8 number of people in the bargaining unit. It's a
9 problem I continue to hear.

10 Additionally, it is one thing once that
11 office decides to send out training materials and exam
12 guides to give us aid on how to go about it, but if
13 we're not given the time away from examination to read
14 the training materials, to digest the exam guides, and
15 we haven't been, then you are doing it on your own time
16 trying to improve your quality, trying to meet the
17 office's goals, trying to meet your goals and generally
18 and often doing it on your own time.

19 Finally, back to the -- real quick, back to
20 the customer satisfaction survey, having been around
21 for a few of those surveys, and I know some of you have

1 and some of you haven't, I do have to give kudos to the
2 office in particular to one area.

3 That is, I think, what has universally
4 occurred over the past five or so years is that one of
5 the primary problems the outside bar has had or
6 customers have had, to put it very generically, is that
7 files go into a black hole and no one knows where they
8 are and where they go.

9 And while the office may have moved a year or
10 two late, specifically, in the last year or two, they
11 have taken real good strides to try -- whether through
12 TAC or other areas to try to resolve those cases.

13 When they disappear you want to know where
14 they have gone. You can find out where they have gone.

15 That was I know that's always been mentioned as one of
16 the key drivers in determining whether somebody is
17 satisfied. At least when it comes to non attorney, not
18 examination activities.

19 One of the key things that, I think, drive
20 the -- whether people are satisfied or not or whether
21 they still go into the black hole --

1 MR. ALEXANDER: What has happened to some of
2 those? We have reproduced over the years a number of
3 files for the USPTO that just disappeared. I think
4 everybody has had that experience.

5 MR. FRIEDMAN: Of course the poor man's joke
6 would be the examiner -- they have gone up into the
7 ceiling waiting to be worked on sometime down the road.

8
9 The more serious response, probably better by
10 the office, is sometimes when you have 200, 300, 400
11 people examining applications along with hundreds of
12 other people processing those applications, some or
13 many of whom are government contractors in one or two
14 buildings, handling admittedly hundreds and hundreds of
15 thousands of files, things just don't get from point A
16 to point B.

17 I would presume that happens in a number of
18 private organizations not much different than the
19 difficulties that the PTO faces.

20 MR. ALEXANDER: They disappear at our office
21 too. I understand that.

1 MR. FRIEDMAN: To their credit, I think they
2 have done, on that particular issue, have done a good
3 job of setting processes.

4 MR. ALEXANDER: It is not to work at home or
5 some other identifiable source where they disappear.

6 MR. FRIEDMAN: In response to that, we're
7 obligated under our guidelines to bring files in in
8 certain period of time if you or anybody else requests
9 them. That's not where the problem is.

10 MR. ALEXANDER: Other questions?

11 MS. KANE: I noted a reference in the handout
12 to E learning modules. One was on handling the
13 scandalous and disparaging trademarks.

14 One, I think, is being developed on
15 likelihood of confusion regarding weak and diluted
16 trademarks. I'm wondering if they could be made
17 publicly available.

18 I think it would be useful for us to know
19 what the examiners are being taught. We might even be
20 able to contribute something in terms of maybe you
21 should add something or, you know.

1 MS. CHASSER: That's being handled out of --
2 I don't know if Sharon or Lynn would like to address
3 that, what we're doing on our E learning.

4 MS. MARSH: Less than a year ago we procured
5 an E learning program. We're very excited about the
6 possibilities that that's going to give us for
7 training.

8 I think the difference between -- the
9 exciting thing about E learning is that instead of just
10 sitting and listening to somebody talk to you, you have
11 to read a bunch of material, look at examples and then
12 throughout the course you have to apply what you have
13 learned by doing some examples during the course and
14 then at the end there is a testing function where you
15 take a quiz and see how well you have assimilated the
16 material that you have learned.

17 We are just getting up and running with this.
18 Kevin's group is going to hire four more people this
19 month. We're going to put some people full-time on
20 creating programs for examiners.

21 I think it is really the most exciting thing

1 regarding training that we have seen at the trademark
2 office for a very long time.

3 I suppose, I don't know that we have
4 electronic copies, we could give you paper copies.

5 MS. KANE: We don't want to see the tests and
6 the results.

7 MR. ANDERSON: We don't want to take the
8 test.

9 MS. KANE: Right, we don't want to take the
10 test. To see what is being taught would be very
11 useful.

12 MS. BERESFORD: Part of the process of doing
13 this is because materials won't be available is they
14 have to be run through our sister office. They have to
15 be looked at by a number of people and read by a number
16 of people to make sure the questions are not ambiguous.

17
18 When we get all the materials to where we
19 think they can be shared we would be happy to share
20 them, that would be no problem.

21 MR. ALEXANDER: How many different modules

1 are there, just out of curiosity?

2 MS. BERESFORD: At this point I think there
3 are three.

4 MR. ANDERSON: Three that are named in the
5 report here.

6 MS. BERESFORD: We're getting ready to start
7 another one. We have a long list of areas where we
8 want to create these learning modules.

9 MR. ALEXANDER: In the quality review you
10 indicate 5,000 first and final office actions this
11 fiscal year, 7,500 next year. How are those selected
12 are they random?

13 MS. BERESFORD: I'll turn it over to Kevin,
14 he'll be happy to tell you how.

15 MR. PESKA: Yes, they are randomly selected.
16 It is a statistically reliable amount of the cases
17 based on the work we do. They are randomly selected
18 from throughout the offices so that an even amount from
19 each law office is selected.

20 MR. ALEXANDER: Going back to my earlier
21 question when you had 11 or 12 percent in the beginning

1 when you talk about evidence, you have 98 percent of
2 all first action letters reviewed had no deficiency
3 with regard to evidence quality and '96 percent of all
4 final actions had no deficiency in this area.

5 Then you go down to missed issues and you
6 have 89 percent had no missed issues, indicating 11
7 percent did. I'm trying to key the evidence issue to
8 the missed issues. How can the evidence have no
9 deficiencies in 98 percent of the cases if 11 percent
10 missed key issues?

11 MR. PESKA: The way we measured the data,
12 there has to be either evidence or where we think there
13 should be evidence tied to an actual refusal to measure
14 that.

15 If there is a missed issue we're noting that
16 as a missed issue, but we're not going to rate the
17 sufficiency of the evidence. There probably isn't or
18 shouldn't be any evidence. And I think, again, Marty
19 could probably better answer this, but to me it would
20 skew the numbers.

21 What we are trying to measure is where there

1 is evidence or -- where there is a refusal and where
2 there is evidence where we think there should be
3 evidence, we're going rate that evidence.

4 But to also lump in with that where there are
5 missed issues, to me, you are not getting a real
6 picture of measuring that evidence.

7 MR. ALEXANDER: Let me go to the missed
8 issues. That's helpful. You can miss an issue, have a
9 refusal anyway and it doesn't go to publication in a no
10 foul, no harm concept.

11 What if you miss an issue that should have
12 resulted in a rejection and you have a trademark
13 published and passes to a registration? Does anybody
14 divide the missed issues up into those that affect the
15 outcome and those that do not?

16 How do you rate the missed issues? What type
17 of issues are you talking about when you say missed
18 issues?

19 MR. PESKA: For one thing, because it is in
20 process, everything is a first or final action. We're
21 not even looking at post publication actions. So the

1 one good thing about that is corrective action can be
2 taken.

3 As far as whether they affect eventual
4 registration --

5 MR. ANDERSON: Let me stop you there.

6 Corrective action can be taken. This is sort
7 of a sampling that you are talking about and it's a
8 projectable sampling. If you take 1,000 out of 10,000,
9 you can take corrective action at the 1,000 but not the
10 other 9,000 that you haven't done because mistakes are
11 projectable across the board.

12 So, I don't accept it is correctable.

13 MR. PESKA: That is right. Certainly not
14 beyond the ones that we sample. But as far as what is
15 a missed issue, anything and everything is a missed
16 issue. We note them separately.

17 For instance, we would know how many missed 2
18 D's there are. We also know how many missed
19 citizenship requirements there are.

20 So it goes from what may be to some people
21 the most mundane requirements to the most important.

1 We're going to note each of those as a missed issue.

2 We can group them as missed issue or we can
3 say just show me what the percentages of missed entity
4 issues there are.

5 We would be able to know that data based on
6 whether it is a first action or final action as well.

7 MR. ALEXANDER: Do you determine whether or
8 not the missed issues are reoccurring with the same
9 examiners so that two percent of the examiners may be
10 giving examine corps a bad name and 98 percent of them
11 don't have any missed issues?

12 MR. PESKA: We can right now we can report
13 the data both TMRY as well as by law. If we go into
14 the law offices we can naturally look at -- we do note
15 who the examiner is and we can find that data if we
16 wanted to.

17 MR. ALEXANDER: Why would you not want to?

18 MR. RADER: Let me answer this. When we
19 developed the sample, what we looked at is statistical
20 reliability at certain levels throughout the process.

21 At the quarterly level, for every quarter

1 statistics we provide, we've got statistical
2 reliability at the corps wide number. By the time we
3 break it down to 16 law offices, there is 5,000 cases
4 we're reviewing a year, we can have statistical
5 reliability at the law office level for year end data.

6
7 Now, when you start getting down into
8 examiner and breaking that data down further you are
9 only talking 100 cases that you are looking at for that
10 particular breakout, you really have no confidence in
11 that data where you can say examiner A or even type of
12 examiner.

13 We can go to law office or we can go by
14 corridor, but beyond that, I think the sample sizes
15 needed to support that we are well away from.

16 MR. ALEXANDER: What you are saying basically
17 is that you may only have one office action and final
18 action by an examiner so there is no basis of
19 determining whether it is a reoccurring problem.

20 Is that correct?

21 MR. RADER: Exactly. You take 5,000 divided

1 by the 200 some examiners -- exactly.

2 MR. ALEXANDER: Is there any system which
3 determines competency of individual examiners that is
4 projectable?

5 MR. RADER: Not that I'm involved in.

6 MS. MARSH: The performance appraisal plan --
7 each examining attorney has the performance appraisal
8 plan -- has cases reviewed throughout the year by the
9 manager.

10 MR. ALEXANDER: So the managing examiner is
11 the one who basically identifies by reviewing quality
12 control of those that they are supervising?

13 MS. MARSH: Yes.

14 MR. ALEXANDER: And does the managing
15 examiner examine a sufficient number of office actions
16 and final actions to make that appraisal, if so, how
17 many do they examine?

18 MS. MARSH: I don't know the --

19 AUDIENCE: They examine three per month per
20 examiner.

21 MR. ALEXANDER: So it's 36 over a year that

1 they see.

2 AUDIENCE: 36 over a year. But if they
3 detect a problem with a particular employee they can
4 examine -- they can review additional cases as needed.

5 If a particular employee shows a problem area
6 or an issue that needs to be addressed, the examiner
7 can use additional cases. I might add that the cases
8 reviewed by Kevin's office are not part of the
9 examining attorney's (inaudible), not at all.

10 MS. COHN: But the cases that the office of
11 quality review looks at all go back to the managing
12 attorney and the examining attorney.

13 So the managing attorney is aware of any
14 possible problems or any errors that are made. It is
15 not that they are lost. There is feedback given on
16 those.

17 MR. ALEXANDER: So if the 11 percent that are
18 defective identify individual examiners --

19 MS. COHN: Absolutely.

20 MR. ALEXANDER: I was concerned. You kept
21 saying you could identify them, but you didn't say you

1 did.

2 You're saying they are passed on?

3 MS. COHN: They are passed on, yes.

4 MR. PESKA: The actual errors are absolutely passed
5 on both for the manager as well as the examining
6 attorney. They know when it happens, absolutely.

7 MR. NICHOLSON: I would be interested to know
8 the situation with the TTAB in terms of review of the
9 quality.

10 Is it a similar system?

11 JUDGE SAMS: We don't have any systemized
12 quality review office of function. Our quality review
13 is basically having three judges for final decisions.
14 And all of those cases that are designated as citable
15 precedent of the board are circulated among all the
16 judges for comments and are cleared through the office
17 of general counsel. That's the quality review approach
18 we take with final decisions.

19 On the interlockatory orders, we have left it
20 pretty much to management and supervision. We have sub
21 supervisors looking at the work.

1 Plus, the fact in contested motions which
2 have to be decided by three judges, feedback comes from
3 those judges to both myself and to Mary Frances Bruce,
4 who is in charge of interlockatory staff.

5 That's the way we are doing quality control
6 at this point.

7 MR. ALEXANDER: Judge Sams, have you read
8 some of the input of concerns expressed by, again, sort
9 of an ad hoc basis of problems that -- at the trademark
10 trial and appeal board that didn't seem to gel with the
11 statistics?

12 JUDGE SAMS: Right. The principal problem I
13 noticed in feedback dealt with the specific situation
14 involving the issuance of inadvertently issued
15 registrations, even in the presence of timely filed
16 extensions of time or notices of opposition which
17 obviously cost us a great deal of trouble too.

18 For example our statistics now are showing
19 we're processing extensions of times within 20 days of
20 mail room date and opposition -- new oppositions
21 instituted within 30 days or so of their filing. Which

1 sort of belies that problem.

2 When we looked at it and we looked at all the
3 inadvertent issue registrations since the beginning of
4 the year that were attributable to the extension of
5 time not being processed or oppositions not being
6 processed, we found that almost all of them came from a
7 certain period of time around October, November time
8 frame.

9 Not all of them but virtually all of them
10 were first extension were filed in October or November
11 and the opposition was filed in that time frame.

12 When we looked at those further, we noticed
13 what seemed to be the problem was we never got them.

14 Our process now, now that we're
15 electronically scanning everything and have been doing
16 for a year or more, is that when it comes up from the
17 mail room within 24 hours, it is scanned into our
18 system. And if it's an extension of time or a notice
19 of opposition, there is an automatic transaction that
20 withdraws it from issue.

21 What confused us was how is this happening

1 when it is automatically -- when that automatic
2 function is there. What happened was that we weren't
3 getting them at all. They didn't come up from mail
4 room for that period.

5 There is some speculation of why that
6 happened during the transition to the contract mail
7 contractors. When we discovered this, we talked with
8 the managers responsible for supervising the
9 contractors in the mail room.

10 They have been extremely cooperative and
11 verified our conclusions about when it happened and
12 maybe why it happened.

13 As far as what we've done about it, is again,
14 with cooperation of the mail room staff managing the
15 mail room contractor, the contractor is now doing spot
16 checks in our facilities to check mail room dates to
17 see how timely they are getting to us and whether or
18 not there are any problems.

19 Plus they did a complete inventory of the
20 mail room facility to make sure -- and the law offices
21 to see, if any misdirected mail for the board, and they

1 found some, could be forwarded to us.

2 I think the problem is one of the past.
3 That's the principal problem that was raised to me.
4 And one, obviously, of concern to us too as early as
5 last December when we first started getting phone calls
6 and we contacted the mail room at that point but the
7 problem didn't surface in its full ugliness until a
8 little bit later.

9 MR. ALEXANDER: There are some other problem
10 areas that were raised on delays, general
11 interlockatory rulings, and lack of oral conferences
12 and such.

13 Have you focused on any of those?

14 JUDGE SAMS: In general, our statistics are showing
15 we are deciding contested motions and summary judgment
16 motions within -- I think, summary judgment motions are
17 around 15, 14 something weeks from the time they are
18 ready for decision and contested motions just slightly
19 longer than that.

20 There are however, vestiges from the paper
21 records before we started doing electronic scanning,

1 which are still on the docket shelves and occasionally
2 emerge.

3 I think that is where the problems are
4 arising as far as the delays. Because our statistics
5 don't bear out that there are delays where we actually
6 know that their motion is ready for decision.

7 Now, again, there is some anecdotal evidence
8 to the contrary. I think most of those are cases where
9 it has been principally a paper record keeping problem.

10 As far as the issue of telephone conferences,
11 as managers of the board, we have been pretty vocal
12 with everyone who is handling interparty's cases at the
13 interlockatory level to use the telephone whenever they
14 believe it advances the proceedings to do so.

15 I have heard some reports that not everybody
16 is doing that. But they are not specific enough so
17 far, for you to be able to do anything about it.

18 As I said, we always at every opportunity
19 talk to the interlockatory staff, encourage them to
20 handle things as expeditiously as possible by telephone
21 as possible.

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1 More information from you would be helpful.

2 MR. ALEXANDER: Do you have a counterpart or
3 does the trademark assistance center also deal with
4 TTAB problems?

5 JUDGE SAMS: They refer them to us. We do
6 have two contact representatives who handle at least
7 initially, problem cases. But they are generally
8 funneled from that area if they can't handle it to the
9 supervisory staff.

10 We don't have a separate office.

11 MR. ALEXANDER: Has somebody tried to
12 correlate those problems to determine whether they are
13 reoccurring ones at TTAB?

JUDGE SAMS:
14 We know there are some that are recurring.

15 MR. ALEXANDER: What are those?

16 JUDGE SAMS: Usually deals with as far as quality
17 problems, returning phone calls, which are usually
18 inquiries about things like my extension of time was
19 filed and yet there is an inadvertently issued
20 registration.

21 They are basically related to processing

1 problems. The approach we have taken is the electronic
2 processing is going to help both the underlying issues
3 plus to the extent that those are taken care of
4 returning phone call issue sort of falls away of its
5 own weight.

6 MR. ANDERSON: I would ask this to you as
7 well as the regular operations. How is the trademark
8 assistance center promoted and advertised to the user
9 community?

10 Do you feel like the entire user community is
11 aware of the fact that that is there and available?

12 MS. CHASSER: I wish I brought the numbers to
13 tell you what the numbers of calls are we receive every
14 day.

15 MR. ALEXANDER: Here they are.

16 MS. CHASSER: These are the internal calls.
17 These aren't necessarily -- this was our statistics for
18 our mailbox. But in terms of the number of calls that
19 we're receiving daily, they keep going up. As far as
20 publicizing our trademark assistance center we
21 publicize that on our web site.

1 When people call in to various offices around
2 the trademark operation for example, law office or
3 something we ask the customer to first check or
4 transfer the call back to the customer assistance
5 center. We're really trying to work
6 hard to make that the one stop shop for any customer
7 complaints.

8 We have not had an advertising campaign. We
9 have not promoted it in publications or anything of
10 that sort. It is really -- we're hoping that good
11 customer service will be advertisement enough that if
12 people are receiving a positive experience by calling
13 the assistance center, then they will pass that on.

14 MR. ALEXANDER: I was wondering whether we
15 could kill two birds with one stone here.

16 Howard's concern that trademark examiners
17 tend to get called if there is a problem with the
18 examination, and that takes up administrative time that
19 doesn't ever let the office know that there is a
20 problem. Only the trademark examiners knows that that
21 examiner has had a problem doing something or hasn't

1 had a problem, and correct it.

2 Would it make sense with the first office
3 action giving that number and urging people to call
4 that number if they have any problem just as you go
5 into a hotel room.

6 Is there any reason not to publicize that
7 number?

8 MS. CHASSER: We certainly can add things to
9 first action. We add information to that all the time.

10 MR. NICHOLSON: See what anything --

11 MR. ANDERSON: I would like to suggest a
12 motion to that effect. Because I think that will
13 really start centralizing where the problems are.

14 I am troubled by the fact that if the source
15 of the problem is the trademark examiner and they get
16 the complaints, you may never hear about it.

17 In addition, it takes up the trademark
18 examiner's time with something that they may not have
19 anything to do with in terms of fault. It may be some
20 glitch in the computer or glitch in the process.

21 MS. KANE: If you did something like that,

1 would you try to indicate the demarcation in terms of
2 subject matter that you would call assistance line for
3 versus what you would call the examiner for?

4 MR. ALEXANDER: I would not think you would
5 want to call the examiner for anything other than
6 substantive matters with respect to the application.

7 MS. KANE: What I'm suggesting is if you put
8 a form thing on it, you would want to indicate just
9 what you said, Miles, that for substantive questions,
10 you call the examiner but for administrative --

11 MR. ALEXANDER: I would leave the wording to
12 the office as to what they put on there. I'm assuming
13 -- what I'm looking for is something that -- and I
14 realize once you get into this problem you're kicking a
15 tar baby, but it seems to me there ought to be a way of
16 doing what every business does finding out if a
17 customer is dissatisfied in some way or is having a
18 problem.

19 I think lawyers are smart enough to know if
20 they are trying to overcome a descriptive argument that
21 they are not going to go to the hotline. But if they

1 are dissatisfied with the quality of the examination or
2 records have been lost, they ought to have a hotline to
3 go to.

4 MS. LOTT: So moved.

5 MR. NICHOLSON: Second.

6 MR. ALEXANDER: I think the motion is that
7 USPTO put an appropriate notice of the availability of
8 the hotline or the trademark assistance center or
9 whatever wording they want to put on it that is
10 appropriate to make it clear that that is available if
11 the user is dissatisfied for some reason with some
12 aspect of the operations of the office.

13 MS. BERESFORD: That's a slightly different
14 thing, that the trademark assistance center is doing
15 now they problem solve and they answer questions. They
16 aren't necessarily focused on taking calls from people
17 who are who have specifically -- especially
18 dissatisfaction with a particular examiner.

19 I'm sure they are more focused on answering
20 factual questions about the status of the application,
21 or where things are, or problem-solving, like my papers

1 are lost, I sent this in and I don't see any record of
2 it.

3 That would be broadening their mandate a bit.

4 I personally don't have a problem with it and I think
5 putting the trademark assistance center number on
6 office actions is a fine idea.

7 At the same time, I want -- the complaints
8 office gets -- often we send these office actions and a
9 lot of boiler plate. We are putting assistance center
10 information in there adding another paragraph of boiler
11 plate which may be very useful, but it may not be for
12 some people.

13 Again, we'll look at it, we'll come up with
14 some language. We don't have problem, we want people
15 to use the trademark assistance center. It is
16 phenomenally popular even without advertising. They
17 get thousands of e-mails a month which we respond to.

18 We'll work on how to best word this to get
19 the people calling us instead of calling the examiners.

20 MR. FRIEDMAN: Whatever we come up with, I
21 think it would be helpful in office action that we post

1 in the USPTO web site.

2 MR. ALEXANDER: It is already, I think.

3 MR. FRIEDMAN: If we were to come up with
4 something now, so that as we encourage electronic
5 filing people go on the web site if whatever notice we
6 use in the office actions, if someone can put in the
7 appropriate place in the web site that would also
8 direct people to this office.

9 MR. ALEXANDER: This is just an effort on the
10 departing members to haunt you forever.

11 MS. BERESFORD: No problem.

12 MS. CHASSER: I understand the -- and correct
13 me Ron and Debbie, but the practice if there is a
14 problem with a particular examiner, that the normal
15 course of action is to call the managing attorney in
16 that law office and discuss the issue with the law
17 office manager, who then of course would have immediate
18 access to the files.

19 MR. ALEXANDER: I would think the people who
20 staff the trademark assistance center can be given
21 instructions as to what type of problems should be

1 referred to whom. That's probably the best place to go
2 to find out where you direct people as opposed to
3 having them guess.

4 Most people wouldn't know to call a managing
5 attorney if their life depended upon it, unless they
6 worked at this office.

7 Anything else in the quality area?

8 AUDIENCE: Did we vote on your motion?

9 MR. ALEXANDER: All in favor? Opposed?

10 Griff, are you still there?

11 MR. PRICE: In favor.

12 MR. ALEXANDER: My compliments for your
13 perseverance.

14 MS. LOTT: Actually, before we -- it may be
15 too late to do this before we leave the TTAB, but I had
16 kind of a follow up question for Judge Sams.

17 That is the other issue that seemed to come
18 up was on the time it takes to get responses from the
19 TTAB on things that I think, maybe aren't even going to
20 the inter- lockatory attorneys, I think are probably
21 handled at the level of the clerk, things like when a

1 suspension is lifted on a proceeding, it takes several
2 months just to get new dates. Do you know what I mean?

3 That's not something where something is
4 coming in and then after it comes in you have to start
5 deciding what to do. That's something where a
6 suspension being lifted is a date that you know way in
7 advance is coming up.

8 It seems like getting new dates would be a
9 pretty functionary sort of thing. JUDGE

10 SAMS: It should be. I don't have any data on whether
11 that's an universal problem or just occasional.

12 MR. ALEXANDER: Let me read an e-mail I've
13 got. We have cases that have languished in default for
14 six to eight months before the TTAB even issues a show
15 cause order and then it is another six to eight months
16 before they act on the order.

17 JUDGE SAMS: I'm going to suggest that could
18 still be a problem with the paper call up system that
19 we were still operating under until fairly recently.

20 We now have an electronic system which does
21 the call ups and cues them in when the call update is

1 set.

2 It is automatically set, I believe, now or
3 going to be it will dubiously will be automatically
4 set. I think it's been a call up problem before.

5 It is not because we're not staffed to do it.
6 They are completely on top of their clerical work
7 loads. There is no backlog in their clerical queue.
8 It is just a question of surfacing those so they can
9 get to the proper people.

10 MS. BRUCE: If I can add, we're finding --
11 the oldest things I'm finding now are ones where the
12 last thing that was filed, and this is why the
13 suspension issue strikes me, was filed in paper before
14 we started scanning. We have never scanned a new
15 document, which automatically moves the case into a
16 cue.

17 So some of those may be misfiled on a shelf.
18 Some one missed in it a call up. Since we have never
19 received another paper to trigger it in paper queue
20 until someone goes through the paper files again, we
21 won't find it.

1 Now, we have just come up with a schedule and
2 a plan in the office to go through every single paper
3 file to make sure that we catch those because we have
4 seen a few old ones surfacing.

5 I also wanted to just mention that on the
6 extensions of time, you can currently file a first
7 extension of time to oppose electronically.

8 It doesn't have to go through the mail room.

9 It goes immediately into our work close system and is
10 withdrawn from the covenant issue cycled that night,
11 just as the others are withdrawn the day they are
12 scanned. If you file electronically, those will
13 automatically be withdrawn.

14 In November we will have the ability to file
15 any extension of time and the notices of opposition
16 electronically. They go right into the work pile.
17 They are automatically withdrawn. You don't have that
18 problem in getting (inaudible).

19 MS. LOTT: Can I just follow up? It sounds
20 like a big, big part of this is transitional, which is
21 great news. But if you are having to take hard copies

1 of paper and scan them in that's obviously an extra
2 step.

3 Is the provision yet for these documents to
4 be filed with you initially electronically or are you
5 still having to scan in for an additional period of
6 time?

7 MS. BRUCE: Well, we have -- currently as a
8 pilot we brought up the first extension of time to
9 oppose. There is also the ability to file documents as
10 an attachment to an e-mail but no fee documents.

11 That means the notice of opposition cancellation
12 petition can't be filed because we can't process the
13 fees that way. But in November we'll have forms that
14 will allow the filing of notice of opposition, all
15 extensions of times, and other motions and filings.

16 Then we'll be adding the cancellation
17 documents and the exparty appeal documents probably by
18 February. So at that point everything will be able to
19 be filed electronically.

20 JUDGE SAMS: Right now we have scanning
21 operation contractors -- three contractors who do the

1 scanning. We're hoping with the success of electronic
2 filing to scale that back as soon as we can.

3 MS. KANE: This was in your e-mail, Leslie.
4 I assume this is still the case, but maybe you are
5 going to change it. When you do an extension on line
6 there is only provision for a 30 day extension.

7 I think the person who made the comment that
8 frequently they want to ask for a lot more time right
9 from the beginning because then you don't have to go
10 back, because you know it is going to take you X time
11 to talk to your client, to do an investigation. Can
12 that be provided for on line?

13 JUDGE SAMS: Yes. When November forms come
14 up, anything that you can file on paper you will be
15 able to file electronically in extension of time.

16 MR. ALEXANDER: Tell me this, is there a way
17 of doing the same thing we suggested doing with respect
18 to the first action?

19 In other words, providing a number to you
20 call if some place in the TTAB process people are
21 dissatisfied as a result of the quality of the service?

1
2 Doesn't it make sense to have something like
3 that go out when you first schedule in that notice of
4 scheduling, so you can find out where the problems are?

5 JUDGE SAMS: I'm trying to think what we do
6 send out. We do send out something. I think it may
7 identify me, but yes, that is probably a good idea.

8 MR. ANDERSON: What I'm suggesting is not
9 identify you. Lawyers who may have you on the case are
10 not interested in complaining to you about something
11 that is going on in the office for fear it is going to
12 reach the Judge who is going to decide their case.

13 I'm talking about an ombudsman type thing.
14 It would seem to me if you would provide a person, and
15 it probably only takes one person, who doesn't pass on
16 the identity of the party necessarily but sees where
17 the quality problems are and can deal with them, and
18 you can see whether they are recurring.

19 Just like any office, you might have one person there
20 that is creating 80 percent of the problems and not
21 know about it because nobody is -- everybody is afraid

1 to report it to the Judge.

2 Like you never call a Judge and ask why
3 haven't you decided the case. Because the old rule is
4 they are going to say I have just decided against you.

5

6 JUDGE SAMS: It is an idea we'll look at.

7 On the clerical processing end because there
8 are assignments by number range we can tell if there
9 are recurring problems, because when we get a phone
10 call we'll know who did it. Somewhat true in the
11 interlockatory motions area. It might be better to
12 have central person to filter those calls.

13 MR. ALEXANDER: Does it make sense to have a
14 motion recommending something like this be done at the
15 TTAB, have them draft a notice that goes out with all
16 of their scheduling that if somebody has a problem here
17 is who they ought to call?

18 MS. LOTT: So moved.

19 MR. MULLER: Second.

20 MR. ALEXANDER: Discussion?

21 All in favor?

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1 AUDIENCE: Aye.

2 MR. PRICE: Aye.

3 MR. ALEXANDER: Thank you.

4 I think if we take action with a specific
5 recommendation, it probably helps because that will
6 appear in the minutes it will be a reminder.

7 Anything else with respect to quality before
8 we move on to pendency and we have dealt with as far as
9 I'm concerned, quality, quality control issues,
10 measuring customer satisfaction, survey and
11 methodology.

12 Leaving and we have had some discussion of
13 work force issues and pendency, but I would like to
14 finish up those two categories before we move on past
15 there.

16 MS. LOTT: I just want to mention and I won't
17 go into a discussion, but there were just a couple of
18 other areas that seem to be recurring areas. I would
19 just like to put them on the record for whatever
20 discussion people would like to pursue them.

21 Number one, there seems to be a lot of

1 problems with assignment. Once an assignment is made
2 even after it's recorded in the office in the
3 assignment division, that information never seems to
4 catch up with the files and the files then seem to have
5 the original applicant's name connected with it from
6 then on. And that's something --

7 MR. ALEXANDER: And the right person doesn't
8 get a notice of opposition or anything else.

9 MS. LOTT: All kinds of problems stem from
10 that. That is one thing that has been identified as a
11 recurring problem. It certainly has been my own
12 experience.

13 Number two, indirectly in connection with
14 electronic filing, two things that seem to come up
15 repeatedly were the idea of getting inconsistent office
16 actions on copending files, which seems to flow from
17 the change in policy that copending applications are no
18 longer going to the same examiner.

19 They go to different examiners given the
20 level of subjectivity involved in examination,
21 naturally there is some inconsistencies caused by that.

1 Secondly, with respect to electronic filings,
2 there still are some problems with the identification
3 of goods and services. Not to amplify, but we may want
4 to talk about that in a little more detail.

5 Problems with papers lost, papers not being
6 associated with the correct files, I appreciate that
7 going to electronic filing changes a lot of that, but
8 still 50 percent of the filings in this office are
9 still paper.

10 I think it is still important to pay
11 attention to paper. There is something that really
12 seems to be going on that wasn't going on in the past
13 in the transitional period.

14 Then the final thing that I wanted to note,
15 and this has been raised by several people, Griff Price
16 among them, and it's not an office problem, but the
17 problem is that our clients are continuing to get these
18 official looking notices from the trademark government
19 -- what do they call them -- a number of different
20 things. But private companies send out official
21 looking notices. And induce our clients to send them

1 money for renewals and maintenance things.

2 Even though it is certainly not -- that
3 problem certainly is not arising at the PTO, you need
4 to know about it. It maybe appropriate -- there may be
5 some corrective action that should be taken at this
6 level.

7 MS. CHASSER: I'll start at the last point,
8 the sort of scam mails that go out. That is being
9 handled by the Department of Justice through our
10 general counsels office. I just saw Jim Tukan (ph)
11 walk out right before the question.

12 We are very cognizant of that and we are
13 working closely with Department of Justice on that. I
14 think the issue is that much like trademark
15 infringement in civil action versus criminal action, it
16 is kind of hard to get the attention of the Department
17 of Justice maybe on this issue when there are other --
18 I don't even know that I want to put that in the record
19 after I said that, but that would be my guess why we're
20 not seeing greater action on that right now.

21 MR. PRICE: Was there some comment that the

1 FTC was also considering taking some action? I don't
2 know any details about the status of that possibility.

3

4 MS. LOTT: I think the function of the office
5 is just to let people know who to contact. Right? It
6 is not just that -- MS. MARSH: At one
7 point we were collecting -- we got a lot of phone calls
8 about some of these organizations and people would send
9 us copies of the ads and perhaps a letter outlining
10 their experience.

11 We were forwarding those over to our general
12 counsel's office so they either could either could have
13 an investigation -- so I should check with them. But I
14 think they are still collecting those kinds of
15 complaints.

16 If you send them to me at the commissioner's
17 office, I will give you a fax number.

18 MS. LOTT: Or we can just tell people that
19 goes through the general counsel's office, basically.

20 MR. NICHOLSON: I just wanted to mention it
21 is not a problem that's limited to the United States by

1 any means. We have a lot of foreign client with the
2 same problem. WIPO I know has the same problem.

3 You might just want to coordinate with people
4 at OHIM and WIPO and see what they are doing about the
5 problem.

6 MR. MULLER: It is not just a problem with
7 trademarks the same thing happens with maintenance fee
8 and patents.

9 If we could combine the two maybe the Justice
10 Department would look at these a little bit more
11 carefully.

12 MR. ALEXANDER: Anne, do you have something
13 else?

14 MS. CHASSER: I was just going to say that we
15 can possibly look to see if we might be able to put an
16 article in a publication. I know that there was an
17 article several years ago about scams in the public
18 side. I'll put that on our to do list.

19 With regard to some of the issues regarding
20 inconsistency and copendency, and the copendency
21 policy, and identification of goods and service, I'm

1 going let Debbie Cohn or Ron Williams address those as
2 they are the directors of law office.

3 MR. ALEXANDER: When you direct it would you
4 please tell me why the policy was changed and the
5 justification for it?

6 MS. COHN: Talking about the copendent
7 policy, this has been a major issue in the examining
8 operation for years.

9 Just stepping back a few years even when we
10 had what we thought was a fairly stringent copendent
11 policy, there still were consistency problems and
12 issues.

13 With our E commerce pilot program, which went
14 on for over two years, we experimented with doing away
15 with the copendent policy.

16 The reason we did that is one of the pit
17 falls of that policy is the transferring of new cases
18 around and the delays in examination that it causes.

19 The examiners would complain that they would
20 get cases, they would pull cases, begin to look at them
21 only to find that they would have to give more than

1 half of them up.

2 So we decided to look at what the objectives
3 were with our copending policy and pure and simple that
4 was just getting consistency with examination.

5 In our E commerce pilot, doing away with the
6 copending policy meant that examiners still had to act
7 consistently they just didn't have to transfer the
8 cases around.

9 We found that there weren't really any
10 additional problems with consistency. The managers of
11 those three offices were very much in favor of
12 continuing to do away with the copending policy.

13 As we moved toward E commerce throughout the
14 law offices and as we now have particulars available
15 which allows examining parties to review a first action
16 done by anybody in the office, we see a way to
17 establish a policy of consistency without having to
18 transfer those files around. That's
19 what we're trying to do here, is to allow examining
20 attorneys to examine the cases that they get but
21 require them to look at what is being done and to act

1 consistently with what has been done what normally
2 would have been considered a copending application.

3 Having said that, and we had this discussion
4 about a week ago with the IATA PTO subcommittee, and
5 they brought these issues up, having said that, there
6 has always been a problem in determining exactly what a
7 copending application is.

8 You know, which issues have to be similar in
9 order for the examining attorney to examine all of
10 those cases. Is it all cases filed by a single
11 applicant, is it a similar mark, is it an identical
12 mark?

13 There are some real problems that have always
14 contributed to our ability to formulate a copending
15 policy.

16 So our discussion lead to the question, tell
17 us what you think a copending application is. We're at
18 the stage right now where we're just trying to
19 establish a policy that will achieve consistency but
20 allow for efficient examination.

21 We're not completely wedded to a particular

1 way of operation. We would like to do what is best for
2 our customers and in that process establish a way to
3 examine efficiently and with high quality.

4 We are actually waiting to hear from the IATA
5 PTO subcommittee what they would suggest as a viable
6 copending policy, how they would like to see it
7 handled. We're kind of -- that's where we are right
8 now.

9 I hope that answers your question as to why.

10 MR. ALEXANDER: That is a very rabbinical
11 approach, to answer a question with a question.

12 How do you determine it now? You obviously
13 are doing something presently. What is your current
14 definition of copendency?

15 MS. COHN: We're not transferring any cases
16 except for those -- what we call special marks.

17 MR. ALEXANDER: I understand that, but you
18 are saying that an examiner must give deference to the
19 first action on a copendency matter. You have to
20 determine what copendency is for examiner to do that.
21 Don't you?

1 MS. COHN: We generally look at where it is
2 the same --the same applicant has filed on a similar
3 mark and look at the issues. And then of course if an
4 examiner in looking at a previously filed application
5 sees that there are issues of common trademark
6 identified in the copendent policy, they will want, I
7 assume, to do the right thing and handle things in a
8 consistent way.

MR. ALEXANDER: Let's say
9 the same applicant we saw this morning in the
10 demonstration was an applicant who was filing a lot of
11 what I viewed as descriptive marks for magazines and
12 publications and so forth. I would have
13 regarded those as all copendency, all involving the
14 same problem, though in each field they might have
15 different differences.

16 MS. COHN: I'm sorry, I wasn't at the
17 demonstration were the marks the same?

18 MR. ALEXANDER: No, the marks were not the
19 same but they were all marks -- one mark might be
20 sports today, another one may have been women's issues
21 today, another one may have been -- all very

1 descriptive terms as I viewed it.

2 MS. COHEN: Under any copendency policy those
3 would not have been considered copending applications
4 because the marks are not the same at all.

5 If there were some common element of the mark
6 that was something that tied them altogether, it is
7 possible that they would have been copending.

8 In the situation you are describing I think
9 they would not have been considered. That's of course,
10 one of the issues that we expect to INTA to raise.

11 MR. ALEXANDER: My next question, let's
12 assume they were copendent. Let's say they filed ten
13 of these at the same time and they were all descriptive
14 names of magazines, sort of like filing for domain
15 names that are descriptive, one for books, one for
16 furniture.com, and so forth.

17 Does the examiner -- how does the examiner
18 determine particularly if they are filed at the same
19 time who is the first one to act? It doesn't make any
20 sense for all the examiners to be researching the same
21 issue hypothetically on descriptiveness if they are all

1 going to conform to the first response.

2 How do they determine who makes the first
3 response so the don't work on it together?

4 MS. COHEN: Under our previous copending
5 policy the examiner who got the case assigned to them
6 first would be the one to handle all of them.

7 MR. ALEXANDER: If there is a difference of
8 opinion between examiners as to how it should have been
9 treated and the first response comes out, is the
10 response sent before it's run by the other copendency
11 examiners who might have a different approach or is it
12 just sent out and if a difference arises they have to
13 work it out between them?

MS. COHEN: The
14 latter. The office action would be sent and then the
15 second examining attorney would you have the ability to
16 look at on particulars.

17 If there is a problem, then the second
18 examining attorney if they feel they can't act
19 consistently should discuss it with their managers and
20 the managers would get involved in making a decision at
21 that point.

MR. ALEXANDER: Howard, do you

1 have a view on copendency?

2 MR. FRIEDMAN: I think one of the issues that
3 has arisen of late is how copending applications are
4 transferred under FAST.

5 We were always under the impression that
6 under FAST, to the extent they were going to be
7 transferred and we could do it electronically, which I
8 think in the best of all worlds would work out.

9 Of late I guess there have been, I guess in
10 clarification from the office, that from our
11 perspective more time consuming and frankly, confusing.

12 Apparently, you have to go through your managers
13 docket clerks to transfer those files, which is sort of
14 the opposite of trying to promote electronic
15 communications.

16 I guess the software as of the moment isn't
17 available to be able to do it that way that would seem
18 to be the way to most easily do it. But right now we
19 have to take some timeconsuming steps through the
20 paper, through other channels to do it.

21 MS. COHN: I'm going to ask Chris Doninger to

1 speak to the software issue. MR.

2 DONINGER: Actually, FAST was designed to do this so
3 that we could lump cases together, so the examining
4 attorney asking would get similar marks.

5 The problem is the technology is ahead of the
6 papers. We have 12 different law offices with 12
7 different case dockets. There is no way for the
8 software to go through 12 different dockets and lump
9 the cases together.

10 When we're in a position that we actually
11 have a single new case docket and all the cases come in
12 through one part and they are all assigned
13 electronically through the same queue we then have some
14 more tools at our disposal to actually go through the
15 cases and kind of lump them together as they come in
16 the door and assign them.

17 The other problem with the copendings and the
18 reason we stopped doing it, we have different
19 pendencies across the different offices, as you know.
20 In order to try to even that out we wanted to stop
21 passing cases back and forth.

1 If somebody in a law office that is a month
2 behind the average is waiting for some other copending,
3 if the applicant who filed one of those copending is
4 ahead in another office all of a sudden they are thrown
5 to the previous office and their pendency actually
6 starts to go backwards through no fault of their own.

7 What we're planning on doing in the future is
8 to combine all the dockets into one single case dockets
9 so copendency will be even across the board. That also
10 gives us the option of playing around with algorithms
11 to decide what is a copending and what is not, so that
12 they get assigned at the same time to the same
13 examiner.

14 MR. ALEXANDER: What is the time table for
15 that?

16 MR. DONINGER: That would have to wait until
17 we move because we really don't have the facilities to
18 put all hundred plus, thousand new cases we have
19 sitting around in one location.

20 MR. ALEXANDER: That being said, when would
21 that be?

1 MS. CHASSER: December of '04 is when our
2 scheduled move will occur.

3 MS. KANE: I know you explained this but I'm
4 afraid I don't quite understand why we are dividing
5 these applications.

6 I think at our last meeting, TPAC meeting, it
7 was the consensus that it was useful to have the same
8 examiner examining what we would call copending or
9 relating, or however you want to describe it.

10 And that that would be a time saver. Not
11 only a time saver for particular applications, but a
12 time saver in terms of this also relates to how you
13 hand out the work in terms of examiners experience in
14 particular classes versus just getting whatever file
15 comes down to them.

16 I'm not convinced now that that still
17 shouldn't be a goal. Somebody try to convince me.

18 MS. CHASSER: I'm going to let Debbie address
19 this.

20 MS. COHN: I would like to point out that the
21 examiners still are able to get copending cases that

1 are later filed.

2 So if for example, Howard, were to pick up a
3 file and sees that there are, you know, ten copending
4 files in different law offices that were filed after
5 that one that he's got, he can get those cases and he
6 should get those cases.

7 We're just talking about cases that are
8 previously assigned where office actions either have
9 already gone out or people are already working on those
10 files, that we believe and this was actually in
11 response to examiner requests as well, that it is more
12 efficient to not transfer those cases, but to have the
13 examiner act consistently with what has previously been
14 done.

15 But in terms of later filed applications that
16 are already in our system, the examining attorney
17 should go ahead and get those copendings.

18 MS. KANE: I still have the question about
19 why aren't examiners specializing in their area of
20 expertise?

21 MR. ALEXANDER: That's a
different question.

160

1 MS. KANE: It is a little related.

2 MR. ALEXANDER: Let's just finish this one first. I
3 agree with you. It is very relevant. Is there
4 anything else on copending?

5 Let's go on to the interesting question you
6 post.

7 MR. MOYER: Assignments, we still have to
8 come back to assignment.

9 MS. CHASSER: We also have the identification
10 issue about the examination of identification and what
11 our policy is that we continually communicate about
12 acceptable ID's.

13 MS. COHN: This issue also did come up in the
14 IATA PTO subcommittee meeting.

15 Our policy is that if an identification of
16 goods is in the manual the examining attorney should
17 accept that. As far as I know, the examining attorneys
18 are -- like that policy. People don't want to have to
19 deal with the identification issues.

20 One of the problems that arose in the meeting
21 is people are saying that, well even the ID's in the

1 manual the examining attorneys are asking for more
2 information that maybe they don't have to ask for that
3 there are still issue that are being raised.

4 And I guess if that's the case, you know, we
5 do need to deal with that because that's contrary to
6 policy.

7 However, when we have investigated individual
8 complaints you know over the years, what we generally
9 find is that there are nuances or there are things that
10 need to be required in a particular situation.

11 It is not necessarily in case of the
12 examining attorney blindly ignoring what is in the
13 indication manual.

14 That being said, we are planning on issuing
15 instructions, detailed instructions on the
16 identification of goods manual.

17 The administrator, Jesse Marshall, happens to
18 be out of town this week. We discussed it last week
19 after the IANTA meeting we're going to reissue some
20 instructions that went out and actually that are part
21 of the current manual, kind of get them out in front of

1 people so that everybody is refreshed on how to handle
2 goods and services in the identification manual.

3 MR. WILLIAMS: Also at the (inaudible) should
4 the applicant have the registration and registered
5 within the last two years, they would accept the
6 identification also.

7 MS. LOTT: That's a policy now as well?

8 MR. WILLIAMS: Yes. Unless it is clearly
9 wrong. I mean, what we try to (inaudible) is a decent
10 registration is an impossibility. Give us that same
11 registration ID back, we could accept it.

12 MS. LOTT: Your comment unless it is clearly
13 wrong, goes right to the other area. Because there
14 have been situations where an applicant was required to
15 slavishly adhere to the wording in the manual when it
16 truly did not describe the applicant's goods or
17 services.

18 In many cases there wasn't something that --
19 you know, but what are you doing to address that sort
20 of situation? The objective is to get the registration
21 active. MS. COHN: What we're doing as Anne

1 mentioned earlier, we're asking for additional
2 suggestions to add to the manual. Just
3 because something is not in the manual doesn't mean it
4 won't be accepted, it is just we're trying to expand
5 the manual to include as many acceptable
6 identifications as we can possibly get.

7 In your situation where an applicant is being
8 required to adhere to the manual and where it is not
9 appropriate to the goods and services, that is clearly
10 an examination quality issue.

11 I don't see that as being something
12 widespread.

13 MS. LOTT: But that's not the policy of the
14 office.

15 MS. COHN: No, it is not.

16 MR. ALEXANDER: I'm going to ask everybody to retain
17 in their minds exactly what their next question may
18 have been. Siegrun, I think your question is on this
19 afternoon's agenda, anyway in specialization.

20 MS. CHASSER: We can do that quickly.

21 MR. ALEXANDER: One o'clock and we've got to

1 run a closed session.

2 MS. CHASSER: That has been a constant
3 problem, the assignment area. That's because the
4 assignment area doesn't necessarily, the data isn't
5 transferable to the trademark area because it is a
6 different department. It is actually the CIO area.

7 But I'm happy to report that we are going
8 to have improvements. I'm going to ask Wes to speak to
9 those issues. Oh, you can't? MR. GEWEHR:
10 Not on this one.

11 MS. CHASSER: Oh, I'm sorry, that was the CIO
12 area.

13 First of all, you can file your assignments
14 electronically now and as I understand when TIS comes
15 in on November 1, is that correct, who can speak to the
16 TIS implementation?

17 MR. SUSSMAN: On November 2nd, we plan on
18 running the two systems that Anne referred to the
19 assignment system and our tram system talk to each
20 other, have a little translator in there.

21 We're going to automatically update our

1 records with the assignment records so there won't be
2 any problems that we've been experiencing.

3 Now, whether or not our chain of title is
4 broken or anything is still a question. That would be
5 an examination issue just like it is now. The last
6 assignment would automatically be put into tram, if
7 it's correct everything should be fine.

8 MS. BERESFORD: Let me just add one thing to
9 that and that's the brief codes. Those of you who have
10 filed assignments you have it on the cover sheet the
11 choices as to what you are filing.

12 Our plan is to only update from the database
13 those things that actually change ownership assignment,
14 merger, et cetera.

15 If you have checked other on that form, it
16 will not automatically update the ownership field
17 because we don't know whether ownership has changed or
18 not.

19 If you have filed a security interest, it is
20 not going to update the ownership field because
21 although security has been filed the owner remains the

1 same. You have to be aware of what is going on and
2 what you have done with your assignment records in the
3 past.

4 We have also suggested assignments that they
5 need to add a new brief code which is security interest
6 released. So that when you have security and
7 (inaudible) you can say that accurately as opposed to
8 checking other on the box. We're trying to decrease
9 the number of things from other for more accurate
10 information.

11 Finally, the assignment records are
12 available, chain of title is now available my
13 understanding is on the web site.

14 If you have some questions about who owns --
15 who actually owns the assignment records you can now go
16 to the web site and see.

17 MR. SUSSMAN: No. Not yet.

18 MS. BERESFORD: It's not? I thought it was
19 already up. Sorry, about that CIO knows more about
20 this than I do. Thank you, Wes.

21 It is going to be available soon. Coming

1 soon to the web site near you.

2 MR. ALEXANDER: I'm going to exercise the
3 prerogative of the Chair so we get on with the non
4 public session. We're going to reconvene the public
5 session at 2 o'clock.

6 We are going to have a 50 minute lunch and
7 budget discussion.

8 (Thereupon, a lunch recess was taken.)

9 MR. ALEXANDER: Ladies and gentlemen, we're
10 going to go back on the record and continue from this
11 morning.

12 We're going to interrupt the process because
13 Lynn Beresford has to be back at INTA with about 250
14 people before 3 o'clock. So we will take her afternoon
15 session when she returns.

16 In the mean time, let's try to finish up some
17 of the things we were talking about this morning, the
18 scam notices were the last thing that was being
19 discussed.

20 My understanding from Anne is the department
21 of commerce is sending out letters.

1 MS. CHASSER: Cease and desist letters from
2 the office of general counsel. When the notices come
3 to our office we ask our users to send a copy -- if
4 they send a letter directly to the trademark office and
5 we forward them over to our office of general counsel,
6 who then sends it to the Department of Commerce and the
7 Department of Commerce sends cease and desist letter is
8 that correct Jim?

9 MR. TOUPIN: Yes.

10 MR. ALEXANDER: One of the problems with some
11 of those organizations, by the way, is they put a
12 disclaimer on it indicating they have no connection
13 with the US government and that become as first
14 amendment issue.

15 Because we had tried to refer them to the --
16 on the fair business practice act to various state
17 attorney generals. And that was the problem that we
18 ran into with some of them.

19 But some of them are clearly so misleading
20 that even if there is a disclosure it's not effective,
21 you can stop it.

1 Lynn, are you ready? We were going to go
2 ahead and move on to Madrid and then pick up. I mean
3 move on to the morning agenda after Madrid.

4 MS. BERESFORD: I thought -- what one would
5 you like me to do? Do you want a presentation?

6 MR. ALEXANDER: Okay.

7 MS. BERESFORD: I'm not clear what you wanted
8 from me.

9 MR. ALEXANDER: I think we had agreed that
10 there were not going to be general presentations.

11 But it may be appropriate to take about five
12 minutes and update us as to any problems we are unaware
13 of that have developed since our last meeting, if any.

14 Otherwise, it will be open for questions and
15 we may be through very quickly I don't know.

16 MR. MOYER: Plus, I would be interested in
17 the reaction to some of some of the comments that have
18 been filed on Madrid. If you are able to talk on
19 those in a general way.

20 MS. BERESFORD: Sure. Where we are is our 60
21 day comment period closed. I was really surprised with

1 the very low number of comments we received, less than
2 a dozen. There was pretty much
3 agreement among bar groups that commented on issues
4 that they saw with the proposed rules and there were
5 areas where we expected to see disagreement.

6 Certainly, the two biggest hot buttons were
7 the TTAB period for opposition, filing notice of
8 opposition and the petition area where we had proposed
9 not having the one year due diligence period for the
10 filing of 2.66 petitions and lessening the due
11 diligence period to six months for 2.146 petitions to
12 the commissioner.

13 Various folks weighed in as to why they
14 thought that was all really a bad idea and I can't
15 speak for TTAB reaction and what they are speaking
16 about in their response, we are looking and rethinking
17 our position as to whether we need to eliminate due
18 diligence from 2.66, whether we can shorten it to six
19 months, whether we should just leave it the way it is.

20
21 There are arguments on all sides of the coin.

1 Internally we're having discussions about that.

2 In addition, as we go through the process of
3 creating electronic forms and figuring out how the
4 system is going to work, issues come up that impact on
5 the rules. And we see things in rules that we didn't
6 see when we wrote them.

7 So a variety of issues have arisen in the
8 context of our ongoing meetings that we have to
9 implement the protocol.

10 So there will be some rule rewriting for
11 minor stuff based on the comments that have come in
12 during that process.

13 On the whole, however, in general, the rules
14 are pretty much accepted as they are. We haven't had
15 anyone go whoopsie, you missed this huge area and
16 surprise you need to do something about it.

17 There have been disagreements with particular
18 areas. Again, we'll talk a little bit about those, and
19 we are looking at those areas and trying to figure out
20 what to do about it.

21 MR. ANDERSON: Overall, nothing that would

1 take you off the time table that was previously --

2 MS. BERESFORD: No, the plan is to have final
3 rules out before the end of August, is my time period
4 that I'm hoping, that I think we'll meet that
5 requirement with not too much of a problem.

6 The idea being that if we get them in place
7 by the end of August, practitioners will have two
8 months to look at them before the system opens for
9 business. I think that's plenty of time.

10 But we would like minimum, of course, 30 days
11 before, but I would like to have about two months in
12 advance if at all possible.

13 MS. KANE: Those minor changes that are
14 required because of the electronic filing, can you give
15 us some examples.

16 MS. BERESFORD: Sure, the kinds of things
17 we're seeing are in transformation we're thinking about
18 rewording the rules slightly to conform with the
19 electronic form. One of the changes we see
20 is we have required in the rules that to the address be
21 consistent between the basic application registration

1 and the international application. We're going to
2 change that.

3 Just really kind of minor stuff.

4 MR. ALEXANDER: Do you regard the changes of
5 the period of opposition and the changes in the one
6 year -- particularly the one year to the six months, do
7 you regard that as a Madrid driven?

8 Do you regard the latter of Madrid driven or
9 just a --

10 MS. BERESFORD: It's partly Madrid driven
11 because one of the things we know about the Madrid
12 system is that it's unforgiving time wise.

13 There is no petition that you haven't met your
14 three-month deadline -- if you haven't met it whatever
15 consequences flow from not meeting it that's what
16 happens and there isn't any change there.

17 One of the things we wanted to do was to make
18 our system more responsive to that.

19 Now, there is as I said, there are arguments
20 on all sides of this issue. There is a very good
21 argument that goes why change the US system for a very

1 small portion of filings under Madrid.

2 On the other hand, there is the argument of
3 perhaps the US system doesn't work as well as it could
4 because we have these very long periods of uncertainty
5 caused by our one year long due diligence standard.

6 And we're re looking at that as part of how we
7 look at how US practice and how the US office
8 functions.

9 MR. ALEXANDER: I know I'm arguing the case,
10 but the one year as opposed to the six months seems to
11 be backed by AIPLA and by INTA and by the ABA, and I
12 think Vito Giordano separately submitted something.

13 That delay arises only, normally, only if the
14 US patent and trademark office has lost application, or
15 failed, or the mail was not delivered.

16 You have to show good cause. You just can't
17 open it for any reason. You have to show you never
18 received it.

19 Isn't that correct?

20 MS. BERESFORD: Normally that would be the
21 circumstances.

1 MR. ALEXANDER: So, normally it is not the
2 applicant's fault. The application has filed an
3 application, may have planned a whole marketing
4 program, and gone national with it, and they loose the
5 date of priority.

6 And our office as far back as I can remember
7 has had a suspense system to check if something hasn't
8 been received within six months we're now at what, 5.3
9 months or 5.8 months before you can even expect a
10 response. What you're saying is that you
11 have to check to see what happened in six months and
12 nothing may have happened.

13 So you put a malpractice imposition in every
14 law firm in the country that doesn't check in six
15 months and they are checking before you may even have
16 responded. That seems to be irrational.

17 MS. BERESFORD: We're certainly taking that
18 into consideration, Miles.

19 MS. KANE: I agree, Miles.

20 MR. ALEXANDER: I think maybe the TPAC ought to weigh
21 in on it. It strikes me as such a clear issue in terms

1 of the structure and the integrity of the trademark
2 system.

3 I have been an expert witness in the case in
4 which a lawyer was held liable for very substantial
5 amounts of money for failing to do due diligence after
6 a year. And a lot of law firms, a lot of
7 the smaller applicants that are not large law firms and
8 corporations would not know to do due diligence. It
9 seems like it is a trap for the unwary.

10 After you year you wonder what happened, but
11 if your response is almost six months why would someone
12 inquire when it is not unusual to take longer than
13 that.

14 MS. BERESFORD: I'm not sure about it being a
15 trap for the unwary, Miles. If you don't know about
16 due diligence it doesn't matter what the standard is.

17 MR. ALEXANDER: It is irrational to check on
18 something when you don't expect it to be sent yet.

19 I mean, if you have a moving backlog, which
20 is right at close to the six months now, which means
21 why would a rational person check to see if they

1 receive something if at the most it is 60 days behind
2 the average?

3 And many examiners are not responding until
4 long after six months, because that's the average.
5 Isn't it?

6 MS. BERESFORD: I think you are mixing apples
7 and oranges here.

8 MR. ANDERSON: If you are talking about new
9 cases --

10 MR. ALEXANDER: You don't have to do on new
11 case I understand but --

12 What is the response time for the second
13 response?

14 MR. ANDERSON: After the applicant sends in a
15 response and even if they do it at the 180 days, six
16 months, when it gets to an examiner's desk, they have
17 21 days to turn the case around.

18 MR. ALEXANDER: So, you are saying you only
19 have a 21 day response?

20 MR. ANDERSON: Right. The examining attorney
21 except in some circumstances, will normally have 21

1 days to respond to the applicant's response to the
2 office action.

3 MR. ALEXANDER: If I file
4 an application and I get no response for 9 months.

5 MR. ANDERSON: Is it a new application?

6 MR. ALEXANDER: New application, I file a new
7 application, I receive no response for 9 months --

8 MR. ANDERSON: If you file a new application
9 and don't get a filing receipt from the office, then
10 you should check on it.

11 MR. ALEXANDER: No, you get a filing receipt.

12 You get a filing receipt and you wait and then you
13 don't receive anything for six months. Do you have no
14 due diligence obligation during that period of time?

15 MS. MARSH: During that time the
16 examiner could have sent out an office action.

17 If you are ignoring it, nine months go by you
18 could have abandoned --

19 MR. ALEXANDER: That's my point. What if you
20 receive a refiling receipt and you don't do anything
21 for six months and a response has been sent one month
after the filing received.

1 MR. ANDERSON: The scenario you have on the
2 table would actually apply if we were two months
3 pendency in first action. If we were at two months
4 pendency and you don't hear anything for nine months
5 and then check on it, due diligence is still going to
6 stick.

7 MR. ALEXANDER: My point is if I
8 apply and I don't expect to receive anything for six
9 months, and, in fact, something has been sent out and I
10 haven't received it, haven't I lost my -- haven't I
11 abandoned my application?

12 I applied January first, filing receipt
13 instantaneously on elect --

14 MR. ANDERSON: I'm actually a little confused
15 by the point you are trying to make. Because first you
16 were saying first action pendency is at 5.8 months and
17 I don't do anything.

18 If first action pendency is at 5.8 months how
19 long after that are you going to wait to check on an
20 office action?

21 MR. ALEXANDER; That's the issue. Do you
22 have only four months -- do you have only 5.8 months,

1 you only have 2/10ths of a month to check under your
2 theory after you expect to receive it.

3 MS. KANE: And isn't pendency an average so
4 that some could be after the six month period.

5 I just have to share Miles's view here, you
6 are not really thinking, oh my God, the sky is falling
7 because it has been six months since I've heard.

8 You might be starting to think it if it has
9 been close to a year. That might trigger some bells
10 and yes, you should have a system no matter whether six
11 months or a year. I'm thinking that it is a little
12 harsh to have 6 month system under these circumstances.

13 MR. ANDERSON: I would interject at this
14 point, most of the petitions -- I haven't seen one on a
15 new case in a long time. By and large we're talking
16 about action subsequent to a new case.

17 MS. BERESFORD: We're also talking about a
18 tiny, tiny number of issues where due diligence is --

19 MR. ALEXANDER: They are most likely not
20 going to be Madrid, because somebody is concerned about
21 Madrid is more likely to be looking at it closely than

1 somebody who is not.

2 We're supposed to represent large user and
3 the small user community. I regard this as a real trap
4 for the small user who files two applications a year or
5 one application ever.

6 And I don't see the benefit, I don't see the
7 benefit to the office.

8 MR. PRICE: Griff Price speaking, I certainly
9 agree, I think this is a very important point.

10 It is a point on which all three of the
11 associations which responded to the proposed rules
12 commented on and highlighted as one of the most
13 significant changes that they took issue with and it
14 seems for me that the six month period does, in fact,
15 represent a serious trap for the unwary.

16 MR. ALEXANDER: You look very puzzled. Why
17 are you --

18 MS. BERESFORD: I'm concerned about that
19 serious trap for the unwary language. If you know about
20 due diligence, if you know what the rule is, then you
21 know what the rule is.

1 If you don't know what the rule is, which you
2 deposited, most small filers won't, then it's a trap,
3 of course you don't know what the rule is. You don't
4 know when you have to do anything.

5 MR. ALEXANDER: Well, the fallacy of that is
6 that the average person after not having heard for a
7 year would be wondering what happened.

8 The average person when they are told don't
9 expect to hear anything for six months would not expect
10 to lose their application if they haven't heard
11 something in six months.

12 It is a common sense theory that what if you
13 had to do due diligence in 30 days and you made that
14 the rule. People would regard that as bizarre. Why
15 would they be aware of it unless they were
16 sophisticated.

17 MS. BERESFORD: I take your point. I
18 understand -- I'm not sure I understand the trap for
19 the unwary argument, but I take your point that you
20 don't like the change for exactly the same reason that
21 the bar association raised the issue. I note that.

1 We are looking again, we are looking at all
2 the comments and considering the options, and
3 considering, again, what our goals are here.

4 And whether or not one of them is to shorten
5 this period or not, what the benefits or the detriments
6 of doing that. We take all our comments seriously and
7 consider them.

8 MR. STIMSON: I raise that we take a formal
9 position on it.

10 MR. ALEXANDER: So do I. I want to find out
11 what the benefits are in your mind that outweigh the
12 detriments.

13 What are the benefits?

14 MS. BERESFORD: Of a shortened period?

15 MR. ALEXANDER: Yeah, the six month period.

16 MS. BERESFORD: When you talk about a one
17 year due diligence period or a six month due diligence
18 period, what you are really talking about is often an
19 18 month period where something is not in the system
20 because people get -- figure something out.

21 It abandons, they don't get the abandonment notice.

1 They have a year after that to do something, they file
2 something at the last minute. Then the process starts
3 up to get their petition going and to decide whether or
4 not to reinstate the application or whatever.

5 So it is a much longer than one year period
6 by the time you are finished with the process.

7 And for anyone who has filed in the interim
8 thinking that a particular application is dead, they
9 have the happy surprise of having this application come
10 back to life and again, we're talking about a very
11 small number of applications.

12 We're talking about a process that we
13 proposed. We hear loud and clear what the bar groups
14 and others think but we're in discussion about it.
15 Truly, we haven't taken a position on what the final
16 rule will be.

17 MR. ALEXANDER: That is a very reasonable
18 argument if third party is --

19 MS. KANE: I think a third party who sees
20 that the application has been abandoned, you're talking
21 about sophisticated third parties they know that

1 doesn't mean it is not in use.

2 They are not just going to rely on that and
3 say, oh my God, I filed and thought I had the thing or
4 at least as an argument they should be looking out
5 there in the marketplace.

6 MS. BERESFORD: The sophisticated applicant
7 will -- or applicant's representative will know that.
8 The unwary of course, will --

9 MR. ALEXANDER: Can't go both ways.

10 MS. BERESFORD: -- be trapped, but whatever.

11 As I said at the beginning of this discussion there
12 are arguments on all sides of this issue. We take very
13 seriously our public comment.

14 I, in my personal view, is we run this office
15 for the benefit of trademark owners not for our
16 benefit. We're very concerned and very attuned to what
17 our parties and others tell us.

18 MR. ALEXANDER: How long does it take for
19 notice of abandonment take to go out? And why wouldn't
20 it be automatic in an electronic system?

21 Something six months, no response, six months

1 and one day you send out electronic abandonment why
2 would not that be something in the future that happens?

3 MS. BERESFORD: I actually think they go out
4 a littler earlier than six months.

5 MR. ALEXANDER: No, I meant you don't get a
6 response for six months --

7 MR. ANDERSON: Since we still primarily have
8 paper files, we normally wait two months after the six
9 month period to be sure that all the paper has been
10 processed in and so forth.

11 When we get to full electronic file wrapper
12 and when we get to 80 percent or more of applicants
13 responding electronically to the office, I would guess
14 you absolutely correct, that we could get closer to six
15 months and one day to send out an abandonment notice.

16 But we're not close to 80 percent electronic
17 response to office actions yet.

18 MR. ALEXANDER: I don't want to beat a dead
19 horse. I think the group would like to vote. I would
20 accept a motion.

21 If there is any motion from the TPAC on

1 whether or not to change from a year to six months.

2 MR. STIMSON: I move that we support a one
3 year period.

4 MS. KANE: Second.

5 MR. ALEXANDER: Thank you for the discussion.

6

7 MR. PRICE: I'm sorry, I didn't hear that.

8 MR. ALEXANDER: The motion was for leaving it
9 at one year, Griff.

10 MR. MULLER: Can we incorporate the actual
11 rules you are referring to because there are all kinds
12 of time lines with (inaudible). I think if we are
13 going to have a motion we ought to at least have a
14 motion as to what we are moving for.

15 MR. ALEXANDER: I think it is 2.146 I. The
16 rule is -- the motion is to leave
17 2.146 I as is, one year rather than six months.

18 Any further discussion? All in favor? All
19 opposed?

20 Unanimous recommendation from TPAC. I think
21 the next one was the period of time for extensions, the

1 filing notice of opposition. Is that correct?

2 JUDGE SAMS: I can speak to that. We are
3 considering the comments that were made both at the
4 public hearing and in writing. I guess I would say
5 we're not wed to the original proposal.

6 Although we haven't made any final decisions
7 about what the final rule would look like.

8 There were some comments about having a two
9 track system depending on whether you were opposing a
10 Madrid application or non Madrid application.

11 We haven't come down definitely on that
12 either, although I think we're a little less favoring
13 having a having a two track system. I think, I
14 believe, only one group wanted to have a two track
15 system.

16 MR. ALEXANDER: I think, as I understand the
17 issue is to give the TTAB more time for processing a
18 notice of opposition against Madrid protocol
19 application. Right?

JUDGE SAMS: We
20 obviously want to make sure we have enough time to
21 process so we don't have to issue a registration where

1 there has been an extension or an opposition for that
2 matter. It is to make sure we have enough time.

3 But we may be able to extend it further than
4 we had proposed. We may not need that much time. We
5 may not have that much time anyway.

6 MR. ALEXANDER: And the proposal is 120 days
7 maximum extension?

8 JUDGE SAMS: Yes.

9 MR. ALEXANDER: The INTA proposes to permit
10 extension for 180 days, the original 30, plus 150
11 rather than 120. Does TPAC wish to weigh in or not,
12 that's the question.

13 MS. LOTT: Can I ask a question? The
14 extension of time, the limitation of two extensions,
15 that's not two 120 day extensions. That's two 60 day?

16 MR. ALEXANDER: Well, The INTA indicated
17 extensions could be requested for 36 or 90 days, but
18 anything for more than 30 days requires good cause.

19 You still get 30 days automatic in addition
20 to the 30 days that you get. The first 60 days is
21 without cause. Anything after that is with cause.

1 That cause is not a very demanding

2 JUDGE SAMS: The original proposal allowed basically
3 two extensions it can be of varying lengths depending
4 how you end up filing it.

5 Whether we retain two extensions but extend
6 the period for which you can file a second extension,
7 we haven't decided.

8 MS. LOTT: The proposal is regardless of how
9 many extensions, the total -- you can't go out further
10 than 120 days?

11 JUDGE SAMS: That's right, at least as it was
12 originally proposed.

13 MR. ALEXANDER: Judge, do you think this
14 would increase the number of oppositions filed over
15 what normally would be the case because people don't
16 have the choice of getting a further extension and it
17 increases your work load, or do you think the benefits
18 outweigh that?

19 JUDGE SAMS: I think the benefits outweigh.
20 You can tell me whether you think more oppositions will
21 be filed. I tend not to think so, but maybe you can

1 tell me if you think so.

2 MR. ALEXANDER: Lawyers never procrastinate.

3 MS. KANE: I have a tendency to think that
4 more time is better in terms of being able to decide
5 you are not going to oppose, being able to contact
6 people if they are abroad, or whoever they may be.

7 I know you can say lawyers procrastinate, but
8 I really think that the benefits of board proceedings
9 in general, versus litigation is that you on a less
10 rigorous time table in general, it does provide
11 sufficient time for people to fully explore settlement
12 and that that's a good thing that we should continue to
13 support.

14 MR. ALEXANDER: Even their proposal is four
15 months.

16 MS. KANE: How does your proposal compare
17 with what we have got now?

18 That is what I'm trying to figure out now.

19 JUDGE SAMS: What we have now is an almost
20 unlimited period of time for extension. We do cut it
21 off after a year if there is no indication that a

1 settlement is imminent.

2 So, there are any number of extension
3 proceedings that are going on for a year or more.

4 MS. KANE: The theory for cutting it off is
5 because you have to?

6 MR. ANDERSON: Madrid.

7 JUDGE SAMS: We have no choice with Madrid.
8 It's a Madrid application.

9 MS. KANE: So what is the most you could get
10 under Madrid?

11 JUDGE SAMS: We have to let Madrid, let the
12 international bureau know within one month after to
13 the termination of the opposition period, and we define
14 the opposition period as the original period plus any
15 extension or seven months, which ever is sooner.

16 MS. KANE: So you can get seven months on
17 Madrid.

18 JUDGE SAMS: We have to have time to get it
19 to the international bureau.

20 MS. KANE: But still, you are getting more
21 than are you getting under your proposal.

193

1 Am I right?

2 JUDGE SAMS: It is possible to have more,
3 which is why some of the organizations have recommended
4 we extend it out to the full six months basically.

5 MS. KANE: That would be my feeling.

6 JUDGE SAMS: We can't do it as do today,
7 which you can extend years or more. MS.

8 KANE: I would certainly give at least the maximum you
9 could get under Madrid (inaudible) make it shorter.

10 MR. ALEXANDER: No, no they would
11 give -- if you had 120 days, it would give the TTAB
12 more time under Madrid than just the 30 days. Because
13 the maximum was seven months -- actually that's not
14 true.

15 JUDGE SAMS: That's not true. It is 30 days
16 after the termination.

17 MR. ALEXANDER: So it doesn't help you with
18 Madrid at all, if you adopted 180 days you still have
19 30 days.

20 JUDGE SAMS: That's correct.

21 MR. MOYER: The question is how much time are

1 we saying we want to be able to extend oppositions out.
2 Under the Madrid application you basically have six
3 months max. We can't change that.

4 MR. ALEXANDER: There is really no reason
5 under Madrid, per se to not have the 180 days, as I
6 understand it.

7 It is using Madrid as an excuse to shorten
8 the period that we now have. Is that reasonably
9 accurate?

10 Madrid is not motivating anything less than a
11 six months -- six months puts you in the same position
12 with Madrid as if you had four months or three months.
13 TTAB still only has 30 days.

14 JUDGE SAMS: That is correct.

15 MR. ALEXANDER: There is no reason from a
16 Madrid standpoint to have it any shorter than the 180
17 days, as I understand it.

18 JUDGE SAMS: That's fair, yes.

19 MR. ALEXANDER: What is the motivation to take it
20 from ad infinitum to less than 180 days? It is not
21 Madrid that is causing it.

1 JUDGE SAMS: The original proposal, I have to
2 confess, were a little confused about the operation of
3 Madrid and weren't sure about whether or not we could
4 have that extra time.

5 And I think there is also a predilection
6 sometimes we have at the board that extension periods
7 go on too long.

8 MR. ALEXANDER: It is sort of accidental that
9 it turned out to be the 120 days. It was a
10 misinterpretation of Madrid.

11 JUDGE SAMS: I think that's fair, right.

12 MR. ALEXANDER: I would suggest a motion we
13 go to 180 days if there is no reason not to.

14 MS. KANE: Second.

15 MR. ALEXANDER: I need a motion. I can't
16 make it.

17 MS. KANE: I make a motion that we go after
18 the 180 days.

19 MS. LOTT: Second.

20 MR. ALEXANDER: Any further discussion? All
21 those in favor?

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1 MR. PRICE: Aye.

2 MR. ALEXANDER: Unanimous again. You have
3 our recommendation to join with the others.

4 MR. STIMSON: I have a general question. Is
5 there any role that WIPO has in approving the rule
6 making?

7 Do they review it to see fits consistent with
8 Madrid, and if so when do they weigh in?

9 MS. BERESFORD: They have already looked at
10 our proposals we had them here a month or so ago. We
11 had their legal expert go through the rules and make
12 suggestions to us, so they have. We're in contact
13 with them basically, on a daily basis with issues.

14 MR. STIMSON: So if there are revisions
15 based on the comments they would then review them
16 again. Is that correct?

MS. BERESFORD:
17 It would depend on the revisions there. You have to
18 remember that the Madrid system really has at least,
19 three or four different players in it.

20 There are certain parts of the rules -- most
21 over the rules deal only with how applicants and

1 trademark owners act with the USPTO.

2 A lot of the common regulations, which deal
3 with how applicants and offices deal with WIPO, then
4 that's a separate set of regulations. And we did not
5 want to replicate any of that you in our rules if
6 possible.

7 So only small portions of our rules actually
8 have anything to do with what happens with WIPO. If we
9 change those courses we would, in fact, let them know
10 or talk about it.

11 A lot of what we have in our rules is more
12 between applicant and trademark owners and USPTO. We
13 have them, we talk to them constantly. We want to make
14 sure that all these systems mesh.

15 MR. ALEXANDER: There was another suggestion
16 because of the difference in the section eight time
17 period.

18 MS. BERESFORD: Section 71.

19 MR. ALEXANDER: Right, would you go over that
20 with us?

21 MS. BERESFORD: The Madrid legislation was

1 written back in '94 before we made the changes to the
2 post registration practice with the trademark law
3 office treaty where we harmonized to the section 8 and
4 9 period.

5 So the old legislation, the old time periods,
6 the pre TLT time period of what is in section 71 of
7 Madrid.

8 To file your affidavit continuing use you
9 have six months before the end of the fifth year
10 period, tenth year period, 20 year period, et cetera.
11 And three months after.

12 So the old section 8 period -- I'm not sure
13 many of you remember them -- apply to those affidavits
14 used to have to be filed to keep your request for
15 extension protection alive.

16 Prior to the legislation being passed we sent
17 revisions of that section down to the Hill but somehow
18 they never got into the legislation.

19 We will continue to try to get technical
20 amendments to that section. It will be 2009 or later
21 before anyone has to actually file an affidavit of use

1 under section 71 and hope we'll have those sections
2 harmonized by then.

3 In the meantime those of you who have
4 docketing systems will have to take that into
5 consideration.

6 MR. ALEXANDER: The PTO is in accord with the
7 recommendation that they be harmonized?

8 MS. BERESFORD: Absolutely. We try to do
9 that before the legislation passed.

10 MR. ALEXANDER: How do you feel about the
11 standard characters in terms of word marks.

12 MS. BERESFORD: The standard characters we're
13 going to a more international standard. And when we
14 publish the final rule we'll publish a character set
15 with the final rule which has 270 some characters in
16 it, capitals and smalls, tilde, and other kinds of
17 things included with letters in there to expand.

18 Anything in that character set can be filed
19 and claimed as a standard character drawing.

20 MR. ALEXANDER: So that would be consistent
21 with Madrid, do you think?

200

1 MS. BERESFORD: That would be all across the
2 board for all our filings, national filings and
3 international application files.

4 MS. KANE: What is -- in your hand out there
5 is something about a stricter standard, imposing a
6 stricter standard than the requirements under the
7 current rule.

8 MS. BERESFORD: In what context?

9 MS. KANE: Standard character type drawings -
10 - the bottom of the page.

11 MS. BERESFORD: I don't know why we would say
12 we're imposing a stricter standard.

13 MS. KANE: I don't think you were saying it.

14

15 MR. ALEXANDER: I think it was the INTA.

16 MS. BERESFORD: I think you have to say you
17 are filing a standard character drawing. You have to
18 tell us --

19 MS. KANE: Why is that a stricter standard
20 than currently because you don't have to say it
21 apparently?

1 MS. BERESFORD: You don't. You file a type
2 drawing. We're going to allow more things to be filed.

3 So, we want to know who actually the applicants or
4 applicant's representative thinks the drawing is
5 standard character and lines.

6 MR. ALEXANDER: What happens is you file a
7 word mark and your -- you just type in the word mark
8 and you type it in. Does it make any difference what
9 font it's typed in on if you don't say it is standard?

10 Are you only get to font you type it in on if
11 --

12 MS. BERESFORD: If you want to claim standard
13 characters on this drawing rule you have to say you are
14 claiming standard character marks.

15 MR. ALEXANDER: Otherwise you only get the
16 font that you've typed it in?

17 MS. BERESFORD: Otherwise you will either get
18 an office action saying, gee this looks like a standard
19 character mark, are you really claiming special form.
20 The examiner might wonder and ask you. You can avoid
21 the problem by telling us it's a standard character

1 mark.

2 And if you don't, if you come back and say if
3 you are asked and you say, no this is not a standard
4 character mark then you are claiming it in the font you
5 are showing it. MR. ALEXANDER: If you are
6 not asked, they can just treat it as a narrower than a
7 standard --

8 MS. BERESFORD: If you are not asked and
9 don't have the claim in there it will be treated as a
10 special form drawing, as it is called now. If not it's
11 a standard character filing.

12 So we ask you, we require if you're claiming
13 standard character drawing, if you're claiming the mark
14 in all fonts, in all timesteps just the words, you
15 tell us that. You give us the information about that
16 legal claim.

17 MR. ALEXANDER: Is that called for any place
18 in the application or do you just have to know it?

19 MS. BERESFORD: It is called for in the
20 electronic application, yes. In the new electronic
21 application form there will be something to express

1 that.

2 MR. MULLER: When did you say the electronic
3 applications would be available for review, the
4 electronic forms?

5 MS. MARSH: We don't even have them yet.
6 We're going to get them any day now for us to review.

7 The electronic forms have not been available
8 for review up until now the contractor is, I'm told, on
9 the verge of handing over the copies of forms and then
10 we can review them.

11 MS. KANE: If you file a paper application
12 and you are not claiming Madrid, obviously, and you
13 don't say anything about standard character, are you
14 going to lose your claim that it is a standard
15 character form?

16 MS. BERESFORD: The rule says if you are
17 claiming standard character -- the proposed rule says
18 if you are claiming standard character you have to say
19 that. Otherwise, alternatively you are
20 not filing standard characters.

21 MS. KANE: People should be alerted to that.

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MR. ALEXANDER: What was the INTA recommendation to that, do you recall?

MS. BERESFORD: The INTA recommendation was that if you don't say anything and it looks like a standard character mark, treat it like a standard character mark.

MR. ALEXANDER: That's what I thought. The INTA is sort of what we do now. Right?

MS. BERESFORD: Right.

MR. ALEXANDER: Anybody on TPAC want to take a position on this?

MR. STIMSON: All I can say is, I just wrote down to tell my legal assistant we better be careful because this is a change. I think, when we just type something in, we expect we're claiming standard character. If that's going to change I want to be careful we don't make mistakes.

MR. ALEXANDER: What are the benefits of the change?

MS. KANE: Talk about trap for the unwary.

1 MS. BERESFORD: We do put in it the rules.
2 Those people who actually read the rules would know
3 that they have to make this claim --

4 MR. ALEXANDER: Do you want to make a guess
5 at how many people read the rules?

6 MS. BERESFORD: I have been involved in this
7 for many, many years, so I know that it is a very low
8 number. However, we can't run our system based on
9 nobody reading the rules. That's why we put them out
10 there.

11 MR. ALEXANDER: What about people who read
12 the rules in the past and now, they know. What is the
13 benefit of not -- what is the benefit of changing, I
14 guess, is my question.

15 MS. BERESFORD: This is an examination. By
16 saying if you don't claim it but it might be standard
17 characters, you essentially force the examiner to ask
18 the question, because it is one or the other.

19 We broadened what we will accept as standard
20 form character, we're going to take caps and smalls and
21 all kinds of other things.

1 But in order to simplify the examination
2 process, we have asked we suggest in the rule -- we
3 don't suggest, we demand in the rule that if you are
4 going to file a standard form character that you are
5 making that claim, that you make it expressly.

6 MR. ALEXANDER: The same is true in the
7 reverse though.

8 MR. NICHOLSON: Are you changing the default?
9 People have been practicing for a number of years know
10 the default to be the other way.

11 MR. ALEXANDER: Everybody practicing now
12 thinks it defaults into block letters. You are
13 changing the rule and I'm trying to find out why.

14 MS. BERESFORD: We are accepting more kinds
15 of things as standard characters. There is going to be
16 more variety in what comes in that can be standard
17 characters.

18 MR. ANDERSON: Part of the
19 reason we're changing the rule is because we're joining
20 Madrid. Under Madrid, there is no such thing as a mark
21 typed in all capital letters giving you broad rights.

21 Under Madrid, you must claim standard

1 characters to get -- to have a broad right claim for
2 your trademark.

3 And when you look at the international
4 gazette, you will see standard character claims for
5 marks that currently in the US we would consider to be
6 special form. The don't -- the US, may be
7 the only country in the world who does all caps giving
8 you broad protection for the mark.

9 So we're simply moving toward the standard
10 the rest of the world has. One, because of Madrid and
11 secondly, because as was indicated this morning by
12 Anne, we're involved in a trilateral discussion with
13 JPO, the European community trademark office and the
14 PTO.

15 Again, to try to standardize on a filing
16 system. So it would be much easier to file under these
17 three offices. To move toward any kind of
18 harmonization, we have to adjust our own thinking about
19 what we do also.

20 Just as final comment, the downfall in a
21 sense of all cap marks came when the first PC came on

1 line. As an examiner who started a long time ago in
2 the office, and the only thing that people had to send
3 in an application was a typewriter, all cap marks were
4 common.

5 There was no such thing as all of these
6 mysterious fonts that you can pull up on your PC. When
7 PC's started to come in we started to get drawings that
8 by any standard would have been special form. And we
9 would publish them in special form.

10 Low and behold, the guy writes in I asked for
11 a special form mark. I wanted standard character, or
12 typewritten mark. I wanted a broad claim. This has
13 been a bugaboo for us ever since the first PC came on
14 line and had more than one font on it.

15 MR. ALEXANDER: Amazingly enough, you have
16 convinced me to show flexibility.

17 MR. PRICE: Is it possible to check the box
18 on the electronic application form in such way so that
19 the applicant is focused on the fact that they have to
20 make an election if they wish to make the broader
21 claim?

1 MR. ANDERSON: Yes, there will be a check box
2 on the electronic form for standard characters.

3 MR. ALEXANDER: That's one of the reasons I
4 buy in, you are warning people on the form that they
5 should make an election. Secondly, it is
6 harmonization. And third, if you have it in a font in
7 the US, that's going to give you block letter
8 protection anyway as a practical matter.

9 I side with the office for what it is worth.

10 MS. LOTT: May I add one comment to that, in
11 the check box may I suggest it be an either or. That
12 you have to check one.

13 MR. ANDERSON: You will have to check one or
14 the other.

15 MS. LOTT: Oh, then it is done. Then you
16 have let people know.

17 MR. NICHOLSON: If you haven't, you get an
18 office action. Correct?

19 MR. ANDERSON: Yes. I think, in some cases
20 an examiner might look at what an applicant did
21 particularly on paper applications and say -- in

1 particular those people who stick with all caps and
2 then they don't have an indication of standard
3 characters. The examiner is likely to ask, did you
4 mean to submit a typewritten mark.

5 I can't imagine that filer is going to give
6 up the notion of all caps easily. MS.

7 BERESFORD: Just because everybody is accustomed --

8 MR. ANDERSON: Everybody is accustomed to all
9 caps for a typewritten mark in a broad claim. The bar
10 doesn't give up on things easily. We'll probably be
11 getting well into the 21st century.

12 MR. ALEXANDER: If you bring a lawsuit on you
13 are going to be covered just as the times an as if it
14 were not a standard? MR. ANDERSON: Correct.

15 MR. ALEXANDER: Any further questions on
16 Madrid?

17 MR. MOYER: Do you have any idea when you are
18 going issue a final rule?

19 MS. BERESFORD: My plan is to issue before
20 the end of August, if at all possible. I would like to
21 have at least two months before the system comes up for

1 people to see. MR. MOYER: You will have your
2 hotly ready for all questions? You will get a lot of
3 questions once people see that this is it.

4 MS. BERESFORD: Right. Again, most of the comments the
5 dealt with time periods, which you know, they are
6 either six months, or a year, or nothing, or four
7 months, or whatever.

8 There won't be questions about that. The
9 basic rules there have not been comments on. What you
10 are seeing in the basic rules except for the time
11 period issues, is what is going to be in the final rule
12 because we haven't gotten comments on it.

13 We haven't gotten comments on what we're
14 doing with standard characters, for instance, except
15 the one comment INTA raised. We haven't
16 gotten comments about our application filing
17 requirement for the international applications, except
18 for the address issue. You are pretty much seeing the
19 final rule except for the time period issues that we
20 are struggling to reorder.

21 MR. ALEXANDER: That's a real compliment to

1 you. You can't improve on perfection.

2 MS. LOTT: One question for Bob, you said
3 one thing I didn't understand. If you are submitting a
4 mark for standard character, don't you submit the
5 drawing then in solid caps?

6 MR. ANDERSON: Well actually, when Madrid
7 kicks in, you will have the have the option of
8 submitting -- of typing the drawing, you can use upper
9 case, lower case, upper case and lower case. Or you
10 can capture as an image and send it as an image and
11 indicate it is standard characters.

12 You will have two options. One, just typing
13 the mark in and saying standard characters. Or second,
14 scanning it in, attaching it as an image and indicating
15 standard characters.

16 MR. ALEXANDER: So you could put the
17 Coca-Cola script in and claim standard characters and
18 you would have it as if it were block letters. Is that
19 what you are saying?

20 MS. LOTT: When you were saying the bar is
21 not going to give up the idea of sending in solid cast

1 drawings --

2 MR. ANDERSON: We are only talking about were
3 that segment of the bar that is totally familiar with
4 office practice is probably going to submit all caps
5 for a long period of time after this rule goes in,
6 simply because that's what their staffs are used to.

7 MR. ALEXANDER: Until death do us part.

8 MS. BERESFORD: We are also adding a lot of
9 punctuation in standard characters too for folks who
10 have been unable to file a standard character drawing
11 because there is some kind of punctuation in it, it
12 will now be able to file with the standard character
13 claim.

14 MR. ALEXANDER: So hyphen won't hurt you.

15 MS. BERESFORD: Right. Hyphen won't hurt
16 you.

17 MR. RADER: First off, I still have a hard
18 time getting the mental image out of my head seeing Bob
19 at his desk using a typewriter and examining, but I
20 guess that has been a number of years.

21 More up to speed I couldn't help but notice

1 in particular, the ABA comments one of the things
2 they are suggested is that revived applications be
3 handled by examining attorneys and also noting that if
4 there is a substitute or additional basis, after
5 publication it be handled by an examining attorney.

6 One of these need to be noted in making that
7 first comment is that it was a perfunctory and the
8 commissioner's office shouldn't be burdened with that
9 administrative burden. Of course, the implication
10 there is somebody has to be burdened with it.

11 One, we obviously, would like to be a party
12 not burdened with it. Two, if you don't see eye to eye
13 with us on that, obviously at the very at least, we
14 want what ever time is available to handle revivals.

15 Finally, before you comment, or in view of
16 the things that have occurred today, including a
17 motion, which seems to be where the TPAC seems to have
18 indicated that we are trying to lessen the
19 administrative burden on the examiners, I know that
20 pendency is going up, I would like to assume TPAC's
21 flavor and I'm only speaking for myself, that they

1 would perhaps prefer the examining attorney not assume
2 the administrative burden.

3 That's just my assumption.

4 MS. BERESFORD: The issue of changing basis
5 after publication and certain revivals, et cetera,
6 although it looks simple from those who are not in the
7 office, when you talk about changing basis after
8 publication, you talk about a serious amount of
9 exception processing done by our computer folks.

10 It is not something that we would essentially
11 want our examining attorneys to do. It is exception
12 processing. Remember 99 percent of the files that are
13 published for opposition ITU go right -- we want them
14 to stay in that ITU track.

15 To change the basis to a 44 registration base
16 or some other basis -- well, 44 registration basis is -
17 - takes a lot of exception processing. It is not the
18 kind of thing you put on examining attorneys.

19 I know that bar sees this as just simply,
20 pass this work over to the examiners but it is actually
21 a whole lot more complex process than that.

1 So I don't see us doing that -- making that
2 particular change.

3 MR. FRIEDMAN: A follow up question. Have
4 you figured out yet what training some of the office
5 examining attorneys will need to handle Madrid
6 publications?

7 MS. BERESFORD: If you have read the
8 legislation, you know that one of the things the
9 legislation says is that the request for extension of
10 protection have to be exactly like regularly filed
11 national application.

12 The only difference would be will they have a
13 different basis, a 66 A basis which they will already
14 have been examined as to classification by the
15 international bureau.

16 In essence, the basis has already been
17 examined too, because it doesn't get to us unless it
18 has a valid 66 A basis. In terms of training we will
19 be doing on the Madrid protocol. We will be talking
20 about how it operates, et cetera.

21 I just put this in the context of the

1 legislation. We have to examine these applications
2 just like regularly filed national application.

3 MR. STIMSON: I have a general comment.
4 We're talking a lot about the details of
5 implementation. We shouldn't lose sight of the sense
6 of wonder we should have that we are talking about
7 final rules for implementation Madrid protocol after
8 all these years.

9 Some of us know very well what was involved
10 in getting this passed. I think it is just amazing to
11 be sitting here talking about the final months before
12 we implement. We all ought to be very thankful that
13 this day has come.

14 MR. PRICE: Point well taken.

15 MS. KANE: I think we covered everything but
16 the first item, by first item I mean, verified
17 statement under section 66.
18 Somebody had a concern there about the wording for the
19 bona fide intent to use.

20 MS. BERESFORD: There was a comment in the
21 rules regarding the bona fide intent to use statement

1 that the actual statement was spelled out in the rules
2 for the other basis. It is not spelled out in that
3 particular section of the rules. We will do that.

4 MR. ALEXANDER: Anything else?

5 Lynn, thank you very much.

6 PUBLIC: Can members of the public ask
7 questions now?

8 MR. ALEXANDER: Certainly, I'm sorry. Is
9 there anybody else who is not from patent and
10 trademark?

11 PUBLIC: I work at the patent and trademark
12 office, but I'm an individual examining attorney
13 speaking for myself.

14 MR. ALEXANDER: One of the things that hasn't
15 been talked about very much is certain portions of
16 proposed new 2.65.

17 One of the things that greatly concerns
18 almost all applicants and attorneys that practice a lot
19 whether inside the office or not is acceptable
20 identification of goods and services.

21 What this new proposal would do is that an

1 application will be deemed abandoned unless a refusal
2 requirement is expressly limited to only certain goods
3 and/or services.

4 You can picture if you have just one class
5 application say in class 9, and the examining attorney
6 makes a refusal or requirement as to certain goods but
7 not all, the examining attorney is going to be in a
8 position of either approving for all, abandoning for
9 all, or approving for some, and abandoning for others.

10 And there are a lot of applications some of
11 them have multiple classes. This would be a really
12 time consuming job. Some applications where there is
13 only even only one class where this would be a really
14 time consuming job.

15 My first question on this is, is this new
16 proposed 2.65 going to apply to only 66 applications
17 under section 66 or to all applications from
18 applications from A, 1 B, 44 and 66?

19 How are we going to be able to --how are
20 people on the outside, how are examining attorneys on
21 the inside going to be able to determine if their

1 application is going to be abandoned or approved for
2 certain goods and services?

3 This to me is a major kind of thing and I
4 haven't heard anybody or read any comments about it.

5 MS. BERESFORD: I don't believe we received
6 any comments on this particular rule?

7 I think the reason we didn't receive any
8 comments on this particular rule is it is extremely
9 trademark owner friendly, essentially.

10 Our practice now is if we send out an office
11 action you have a five class application and we say you
12 have a problem with this class and you don't respond we
13 abandon all five classes.

14 Under this new proposed rule if you didn't
15 respond, you would be abandoned as to that one class
16 but would go forward, assuming there were no issues
17 with the other classes, you would go forward to
18 registration in those four classes.

19 I think the reason we heard nothing about it
20 is because, again, it is very trademark owner friendly.

21 The rule is written. It applies to all applications

1 whether 66 A based or other bases.

2 If you feel it is absolutely required you
3 simply put A basis (inaudible) application under the
4 terms of the protocol if you are not refused as to
5 particular goods or services, you go onto registration.

6
7 Your rights don't lapse unless you are
8 refused to those goods and services. Again, there is
9 controversy in the rule writing group about this
10 particular rule, but in terms of what was said in the
11 comments we got no adverse comments to this particular
12 rule.

13 PUBLIC: How will this work?

14 Say it's a class 16 application and it is
15 before the recent decision overturning the (inaudible),
16 you have the name of the team as a proposed mark, and
17 you have books and publications about the team, and
18 then you have calendars, and then you have just paper
19 and printed goods. And then you have another 30 single
20 space line ID. How would that work?

21 MS. BERESFORD: I think the rule is pretty

1 explicit. It says unless you -- it says you have to
2 expressly say in the refusal that it's refused as to
3 certain goods or services.

4 Does that answer your question?

5 PUBLIC: As to refusal, but as to accepting the ID,
6 the long ID. How is one going to pick out what is the
7 acceptable what is the unacceptable part.

8 MS. MARSH: I think we are still looking into
9 a number of different ways that could be administered.

10 There are a number of ideas being considered so that
11 examiners can quickly and easily identify these
12 applications.

13 We don't know the specifics yet.

14 PUBLIC: Thanks.

15 MR. ALEXANDER: I think we need to move on,
16 unless there is something that is really driving us at
17 this point, to get through the agenda.

18 Lynn, thank you very much.

19 I'm going to take two items outside the
20 normal agenda because we have at least one person
21 leaving early. There has been a request for

1 quality and work force issues.

2 MS. KANE: I think we had agreed at our last
3 meeting, consensus was that examiners would like the
4 idea of examiners continuing to focus on their own
5 special classes.

6 It was more efficient in terms of their
7 background and it would also probably have slightly
8 related to the related applications issue. I see that
9 the PTO has decided to separate out the application. I
10 gather it is on a kind of a random, just sign them as
11 they come in?

12 MS. CHASSER Under the FAST system it is the
13 most senior application is then passed onto the next
14 examining attorney who is requesting new file.

15 MS. KANE: So, regardless of the background
16 of the attorney, he will be handling any number of
17 different cases?

18 MS. CHASSER: I'm going to ask Bob and the
19 law office managers to chime in.

20 For a number of years the examining attorneys
21 have been examining all classes and services. And

1 about 50 percent of all of our applications are from
2 service class. We ran a pilot in our E commerce law
3 offices. How long was that pilot?

4 MS. COHN: Over two years.

5 MS. CHASSER: Over two years where the
6 examiners who were examining E filed applications
7 examined all classes.

8 In our evaluation of the quality coming out
9 of those offices, it was no different than the quality
10 in all the other offices.

11 So there wasn't. From our point of view, a
12 case made that it made sense to retain specialization
13 by separating out the offices -- Debbie.

14 MS. COHN: Just to comment on the quality end
15 when we looked at the statistics for the office of
16 quality review for, I guess, fiscal year '02, two of
17 the three E commerce law offices were in the highest
18 range for quality among all the law offices. The other
19 one was somewhere in the middle. It
20 really was no -- it didn't seem to be any effect
21 judging by the office of quality review, on the quality

1 of examination coming from those offices that are
2 handling all points.

3 MR. NICHOLSON: Can I ask a question first?
4 I got the impression from Howard's comments this
5 morning that the examining corps is against, by in
6 large, being required to review all classes.

7 I have never been an examining attorney, but
8 it seems to me if I was one, I would actual prefer to
9 have broader range of experience in examining various
10 types of goods and services from various industries.
11 It would make my job more interesting.

12 I'm wondering if that's something that has
13 been factored in in terms of the survey. I haven't had
14 a chance to focus on the survey. What is the sense
15 among the examining corps in terms of their preferences
16 on this issue?

17 MR. FRIEDMAN: Here is the sense and here is
18 the solution. It's a very easy solution. It is
19 consistent frankly, with what everyone has just said,
20 except for one slight fact was left out.

21 When we set up the E commerce offices, we

1 specifically gave them a reduction in production of 10
2 percent.

3 One of the reasons we gave them a reduction
4 in production was because they were doing all goods.

5 If we're trying to marry the office's
6 interest FAST and TIS, and for convenience purposes
7 handling all files, with your interest and our interest
8 in quality, and in pendency, and in customer service,
9 the best way to do that everyone has already
10 volunteered from the office to talk about what occurred
11 in the E commerce office.

12 The easy solution is one that has already
13 occurred and that is give everybody the same reduction
14 in production in doing all goods that people in the E
15 commerce offices have had.

16 That would, hopefully, compensate for the
17 additional time people take or people would need to do
18 whatever research they feel they need to in order to
19 get up to speed in trade channels and how goods are and
20 aren't related and stay abreast of the change in
21 technology.

1 I would submit that's the reason primarily,
2 why people in the three law offices quality did not
3 suffer. Because they were given more time.

4 That is the solution, I think.

5 MR. ALEXANDER: Let me ask you because it is
6 generally thought to be the case in the legal
7 profession that you get a better product by
8 specializing, that the specialist knows more about the
9 field, can deal with the problem more rapidly and with
10 less research and less time.

11 Your proposition that you need 10 percent
12 more time sort of supports the fact that it maybe a
13 less efficient way to do it. Though more interesting
14 for the examiners as you say. I started law practice
15 doing everything from slip down cases to murders.

16 Rest assured, I didn't do them as well as you
17 do something if you specialize in the area.

18 What you are saying Howard, as I understand
19 that it is a 10 percent time hit on the public if you
20 do that as far as office efficiency.

21 Is that a fair statement?

1 MR. FRIEDMAN: This is what I'm saying, so
2 I'm real clear about this. What I'm trying to do is
3 marry our interest in being compensated with the
4 office's interest in having everybody do all goods.
5 I'm trying to about the realistic.

6 MR. ANDERSON: That was not my question.

7 MR. FRIEDMAN: But to answer your question
8 what we support and what I continue to support, is what
9 is in our November 2000 annual report, 2003, which is
10 that we endorse the development and continued use of
11 expertise within the trademark examining corps.

12 The TPAC also endorses consultation by
13 trademark attorneys with those having expertise in
14 specific classes where appropriate and where
15 productivity credit is given to both parties for this
16 consultation. TPAC is not in favor of
17 concentrated training directed to the objectives of
18 having all attorneys equally qualified to handle all
19 goods. You become a better attorney, you examine
20 better, you get the better work product.

21 MR. ALEXANDER: Not necessarily a better

1 attorney. You become more efficient.

2 MR. FRIEDMAN: You become a more efficient
3 attorney, maybe a more effective attorney when people
4 who have been doing computer goods continue to do
5 computer goods. And people who have done publications
6 continue to do publications.

7 That's the long and short of it.

8 MR. ANDERSON: We have a minor dilemma here, 12 or so
9 years ago when the office first created GS-14
10 attorneys, back then they called them lead attorneys,
11 the office of personnel management and the office of
12 human relations at the Department of Commerce came over
13 and did an audit.

14 We were told in no uncertain terms that the
15 position description we had at the time did not support
16 GS-14.

17 So the director at that time, myself Jeff
18 Samuels, and a few other people in the agency went into
19 negotiations with the Department of Commerce and the
20 office of personnel management in an attempt to keep
21 GS-14 attorneys in the office.

1 Major aspect of being a GS-14 is to be an
2 expert in all classes. As Howard pointed out this
3 morning, about 95 percent of our current attorneys are
4 GS-14s, and we expect them to be experts in all classes
5 to retain their grade.

6 The progression is that at the lower level
7 when they first started in the office, they are not --
8 they do not have to have an expertise in all classes.

9 As they move up the food chain, so to speak,
10 towards the senior grade of GS-14, they do have to meet
11 the requirements of the position description to be in
12 that position.

13 In theory, all of the GS-14s, the 95 percent
14 of our work force now have been qualified for that
15 position under an arrangement through NTBU management.

16 MR. ALEXANDER: Bob, let's say it
17 was 15 percent GS-14 and 50 percent GS-13 or 12 in the
18 office.

19 Would you still have people accepting all
20 applications or would you only have the GS-14 accepting
21 them?

1 MR. ANDERSON: We would bring people in and
2 they would not be specialized as they started. As they
3 moved up their career latter, they would move into
4 being a generalist of all classes.

5 MR. ALEXANDER: Isn't it just the opposite?
6 Wouldn't they start out being specialists and then move
7 up to generalists.

8 MR. ANDERSON: Yes, they would be specialist
9 at the bottom and then move in to all classes as they
10 moved up the career ladder.

11 MR. ALEXANDER: Let me suggest using a
12 baseball analogy, it is great to have a player who is
13 an all-star first baseman. Maybe you ought to get more
14 money if you can also catch and do other things in a
15 bind. Maybe that's the standard GS-14 ought to have to
16 be able to do everything even though you are not able
17 to do everything as well as a specialist.

18 I'm not sure. They are not going to take
19 GS-14s away from that standard now are they if you
20 specialize or might they?

MR. ANDERSON:
21 The only thing I can tell you Miles, is about 12 years

1 ago when Jeff Samuels was the assistant commissioner
2 for trademarks the Department of Commerce and OPM were
3 going to downgrade our attorneys because they did not
4 believe that the work they were doing supported the
5 grade that they had.

6 We went through about a six to 9 month
7 process arguing the opposite case. And the agreement
8 at the end was on a gradation of position descriptions
9 that had a gradual increase in responsibility as you
10 went up the ladder.

11 You started as a GS-9 or 11, and then you go
12 to a 12, 13 and 14. When you get to the 14, you are
13 supposed to be an expert in all classes.

14 MR. ALEXANDER: Can't you keep that fiction
15 up by somebody spending 30 percent of their time in a
16 specialty and 70 percent of their time as a generalist
17 because most applications are going to be general
18 applications.

19 If you are in nuclear physics it is just
20 beyond the pale of reality to believe that everybody
21 without some sort of degree in that area is going to be

1 as competent.

2 MR. ANDERSON: If we were examining patents
3 in nuclear physics, and computer science, and other
4 areas, absolutely we would have specialists.

5 But at the end of the day you are dealing
6 with an identification of goods and services that set
7 the applicants and the trademark owners rights and
8 generally speaking, they are required to use
9 understandable language.

10 Now occasionally, ID's come in and they do
11 contain some technical terms. By and large if you take
12 a look at the OG, you are going to see that people 98
13 percent of the time are using language that can
14 generally understood by someone -- in particular I
15 would think somebody that has 17 or so years of
16 education.

17 MR. ALEXANDER: Jerry Swan, when he was a
18 litigator, used to say anybody could learn trademark
19 law in three days, when he became a trademark lawyer he
20 changed his mind.

21 MR. ANDERSON: I would agree. I don't tend

1 to think that the classification and writing ID's is
2 the rough part of the job. The rough part of the job
3 is likelihood of confusion and is the mark descriptive
4 and other aspects of the examination.

5 MR. ALEXANDER: You really have to understand
6 the channels of the trade, and computer, and other
7 areas that are not necessarily in general knowledge to
8 the very sophisticated trademark lawyer and there are
9 other areas where that is true.

10 The more you are into that area, the more you
11 see the conflicts in that area, the better able you are
12 to understand the likelihood of confusion at least in
13 my opinion.

14 MR. ANDERSON: I would agree with that. The
15 trademark trial and appeal board is fairly well defined
16 for exparty and interparties examination purposes.

17 As the case moves through the office what
18 they will look at channels of trade. The difficult
19 part of channels and trade comes in in a true contest
20 between two parties when you start to introduce
21 external evidence.

1 For exparty decisions, it is fairly
2 straightforward. And the type of evidence that the
3 examiner puts into the case is fairly well established
4 under corps precedent.

5 MS. KANE: When you are evaluating a
6 likelihood of confusion, possible rejection and you
7 have to look at the goods and the application, if there
8 is not particular limit to trade channels you are
9 supposed to presume they are distributed in the
10 ordinary channels.

11 You need to have some basic knowledge it
12 seems to me, about the ordinary channels. There is
13 also in different areas -- take banks for example, you
14 have to have experience in examining banking
15 applications to bank names.

16 You are going get a pretty good idea that
17 there are a lot of national banks around. I know you
18 are going to learn that eventually, but it seems to me
19 you could have some kind of compromise of getting
20 benefit the benefit of someone who has experience in a
21 certain area and yet to use the consulting method and

1 still keep up your G-14.

2 MR. FRIEDMAN: A few things I would suggest,
3 and Bob and I are on different pages here, a lot of
4 things have last changed in the last 12 years. Having
5 lived and breathed this issue and related issues for a
6 little while now.

7 One, there was a study that came out a few
8 years ago by that NAPA, National Academy of Public
9 Administration. That office specifically commissioned
10 they were really sort of the first once to come out and
11 say it looks like based on the work you do -- that was
12 14s not doing all goods.

13 Based on the work you are doing as a 13, it
14 looks like there is justification to allow for a
15 "working grade" 14 in the bargaining unit.

16 So that of course happened a few years ago
17 within the 12 year time frame.

18 Two, we're a PBO now. I just have a hard
19 time believing as a PBO based on specific legislation,
20 that OPM or somebody else is going to come knocking
21 down the door worried about losing a grade 14.

1 Obviously, in my position I would be concerned about
2 that but I don't have a high level of concern.

3 Three, generally when we negotiate GS-14 a
4 few years ago, to get a working grade 14, it was
5 because of increasing of duties which was not
6 necessarily tied in just to doing all goods but doing
7 harder cases. Maybe A B 200, special marks.

8 There were reasons other than doing all goods
9 that would cause people to be a 14. Four, it
10 sounds like if I was to follow some of the office's
11 logic we would have been in trouble for a number of
12 years. We had 14 for a number of years. Myself
13 include, examining not all goods but in my case foods
14 in other people's cases, we have five or six attorneys
15 here some of who are 14 specializing, specializing in
16 food, publications, computers, pharmaceutical.

17 I didn't see anyone knocking down the door
18 then. I still don't expect them to come knocking down
19 the door later.

20 Six, as I recall from the position
21 description and I haven't looked at it in a long time,

1 so I apologize.

2 The two criteria I remember is whether your
3 work is reviewed and our work really isn't reviewed
4 before we send out something for registration and
5 publication. And then just generally the type of
6 cases you handle.

7 While the standards there are sort of old and
8 are outdated they talk about 25 percent of applications
9 are filed by applicants that have a million dollars in
10 sales or something along that lines, as opposed to all
11 being in publications or all being in computers.

12 I would submit, again, reasonable minds can
13 differ, but I have given you some reasons why I
14 believe, at least the union's concern about losing its
15 GS-14 may not be as high -- it would not be a reason we
16 would stand in the way of looking to specialize.

17 MR. MOYER: I have a question. I think maybe
18 you wanted to address it.

19 When the E commerce offices went to all
20 classes, they were given a 10 percent, I guess, waiver
21 on productivity. Did that continue for all time or --

1 I can see having to ramp up when suddenly you have to
2 do all classes.

3 I would think at some point after you have
4 done a couple of banking cases, I don't want to
5 belittle this, we are going to develop some good
6 expertise in other areas. I'm just
7 wondering if that kind of forgiveness on the time it
8 takes to ramp up would need to continue to.

9 What I'm hearing is a bit of what they call
10 in the big company float of the work, I can see the
11 benefit of this.

12 If there is a huge number of applications
13 coming into computers right now and have you people
14 sitting across the hall working on toys or something,
15 and if toys are way down and computers are way up, why
16 doesn't it make sense to have those go out so that the
17 work load is more evenly distributed.

18 That's my only question.

19 MS. COHN: Those were precisely some of the
20 problems we were facing in past years.

21 Just to point out as point indicated, all of

1 the law offices have been handling all services for
2 some time now probably for around 12 years since we
3 moved to the south tower building.

4 In addition in about 1997, all the examining
5 attorneys were trained to handle class 9, which
6 includes computers and other electronic products, for
7 precisely the thing you said. We were being flooded
8 with class 9 applications and we needed other people to
9 handle them.

10 Regarding the -- so when we put the E
11 commerce pilot in place, what we were doing was taking
12 people who had already had the expertise in services
13 class 9, and whatever other classes that they had
14 handled and adding to that other goods classes.

15 In terms of the production results, though,
16 it is true that we gave it 10 percent -- we agreed on a
17 10 percent adjustment. It was not only to handle all
18 classes, in fact, it was really to get some of these E
19 commerce initiatives off the ground and to allow people
20 the opportunity to learn them and ramp up and do some
21 of this electronic processing.

1 So the handling all classes was perhaps a
2 small part of it, but it was not the major focus of the
3 adjustment that was given to the E commerce offices.

4 The results of the fiscal years which we had
5 the E commerce pilot was that the production for those
6 offices was as high as production in other offices.

7 Examining attorneys in fiscal year '01, I
8 believe, that was if first year of the production
9 incentive bonus, and just as many reason able to attain
10 that in E commerce offices.

11 That measured the absolute number of action
12 points that an examining attorney produced, not their
13 rate per hour necessarily, even though that was part of
14 the qualification.

15 Really the way people get the award under
16 that system is the number of action points that are
17 produced. E commerce law offices were in no different
18 situation than the other law offices.

19 MS. LOTT: What is the pay scale at the GS-14
20 level? What are we talking about? MS.

21 COHN: Including I think it is about 80 something, 85

1 or 90.

2 MS. CHASSER: To begin. There are 10 steps,
3 correct?

4 PUBLIC: It's not 85 to begin. It is 82.

5 MR. FRIEDMAN: I think it is in the lower 80s
6 to begin. Someone like, for example, GS-14 step 4, I
7 think it is \$89,000 area probably going up to, I guess,
8 \$95,000 or so.

9 MS. COHN: That would be the basic pay
10 without the production bonus.

11 MR. ALEXANDER: 14 step 10 is 103,000.

12 MR. MULLER: If you assume you are going to
13 adopt this examination where there is not going to be
14 specialization, what is the rationale for continuing
15 with the law offices the way we have them?

16 Why do we need lawyer offices?

17 MR. ANDERSON: That's actually a question
18 that's being looked as we move towards November 2nd.

19 With 110 people working at home and with the
20 notion that when you come to the office you reserve
21 office space, with plans that once we get the trademark

1 at home truly stabilized and on a very solid basis we
2 will probably have additional people working at home.

3 The plans are in the future to have -- to go
4 to 150 if possible. We're in discussions with CIO
5 about that now. That would mean more people working at
6 home than are working in the office.

7 I assume everybody is familiar with the
8 concept of virtual workplace. In some sense we have
9 that already. We are kind of stuck with the tradition
10 of law offices because that's what everyone is used to.

11
12 I'm not sure that the concept of law office -
13 - in a public advisory meeting five years from now I
14 seriously doubt that the organization will be talking
15 about law offices.

16 MR. ALEXANDER: If you were without respect
17 to GS-14, without respect to anything other than how to
18 put out the best work product in the shortest period of
19 time, would you have specialization or not have
20 specialization in the trademark office?

21 MR. ANDERSON: I would not have

1 specialization. What I would do is encourage and to
2 continue to work with us bring in specialists in areas
3 to train our examiners on channels of trade so forth.

4 We had over the past couple years at least a
5 couple of those meetings and they have been well
6 received. Also, making more and more information
7 available to examiners electronically.

8 As you saw this morning with FAST, we do try
9 to identify web sites that would provide information
10 very quickly to examiners for review.

11 And then finally, keeping them up with
12 precedents from the trademark trial and appeal board,
13 which generally speaking defines what an examiner has
14 to put on the table for channels of trade and so forth.

15 MR. ALEXANDER: I throw this out for what
16 it's worth. On the other side of where the TPAC has
17 been, there is a great argument for litigators not
18 specializing, because you transfer knowledge that is
19 gained in one industry and litigation in another
20 industry.

21 If you only litigate in one area. You may

1 become so narrow that you don't cross-fertilize ideas
2 any more to take a different approach.

3 It is not a -- I tend toward specialization
4 but I also see the benefits of not specializing. The
5 issue, I guess, that Siegrun raises is do we reaffirm
6 our earlier position as read by Howard, at the TPAC
7 meeting where we favor specialization and also favor
8 consultation.

9 Do we change that, do we leave it as is, or
10 do we just say the jury is out on it?

11 We don't have to take any action now we're on
12 the record as to where we stand unless we want to
13 change that.

14 MS. KANE: One thing I would liked to say is
15 I think a lot of the considerations that have been
16 mentioned here today were not before us when we took
17 our position. So I think it is a new ball game, so to
18 speak.

19 MR. ALEXANDER: I take it Howard,
20 that there is consultation, that examiners that get
21 something in very complex area and they know somebody
else has had something in that area do call up and ask

1 their colleagues about it as we do in a law firm.

2 MR. FRIEDMAN: You do and do it as part of
3 your examination time.

4 Even if we draw that to what is in here, I
5 don't know why at least that piece of the puzzle
6 wouldn't be applicable whether we stayed the same or
7 changed, which was language to the effect if you are
8 consulting with somebody, you would get credit.

9 That shouldn't change whether are you
10 specializing or not.

11 MR. ALEXANDER: There is another argument.
12 We expect that as part of our job in a law firm. If I
13 call somebody up and I have a tax problem and I call my
14 partner up I have saved the client a lot of time by
15 getting an expert answer from him or her.

16 But if they have a trademark problem they do
17 the same both of us are more productive and save time
18 so, it is not necessarily additional time. Sometimes
19 you actually save yourself time by cross-consulting by
20 both getting out a product a lot quicker without having
21 to dig in yourself.

1 I say that not because I don't think time is
2 involved. But I think it works both ways.

3 MR. FRIEDMAN: I would suggest on just about
4 any circumstance that that would be in the examiner's
5 best interest.

6 The problem is it is not helpful and
7 productive to pick up a file, call somebody, wait to
8 hear from them and pickup another file when you have a
9 system where you have to get something out every 50
10 minutes. It is every time you pick up a
11 file you have to get reacquainted, even if it takes
12 three or four minutes it is additional time that eats
13 into how quickly you have to work into the file.

14 MR. ALEXANDER: Unless what your colleague
15 tells you on the phone saves you two hours of work.
16 Then you get it out that much quicker. That's the
17 issue.

18 Let me ask whether the TPAC want to indicate
19 that we plan on observing how this works and reaching a
20 conclusion as to whether or not we continue our current
21 position on specialization or not, depending upon

1 observations of future generations of TPAC members.

2 MS. KANE: Can I ask another question,
3 please?

4 This business of getting out so many actions
5 as you call them per day, are you -- what is your
6 requirement?

7 MR. ALEXANDER: 1.3 an hour?

8 MR. FRIEDMAN: GS-14 orders you to spell your
9 success level. You know it pretty well now, 1.3 an
10 hour, GS-13 it is 1.2.

11 MS. KANE: Now, you really get judged by the
12 hour or is it at the end of the day if you have done
13 five or -- that's what I want to know or at the end of
14 the week?

15 MS. CHASSER: I'll let Ron and Debbie speak
16 to that how the performance is measured.

17 MR. WILLIAMS: I believe that they use that
18 rate of 1.3 per hour. They get credit for various
19 types of points they get a full point for first action.
20 They get a full point when it goes -- published.

21 If it goes abandoned they get a full point.

1 When they get a SOU that's approved they get a half a
2 point. A lot of these points -- abandonments you do
3 nothing. The case comes back and the guy didn't
4 respond in six months was abandoned, you get a point.

5 In about 18 to 20 have applications
6 abandoned.

7 MS. KANE: Are you measuring this on a daily
8 basis?

9 MR. WILLIAMS: On a yearly basis.

10 MR. ALEXANDER: On a one year basis.

11 MR. FRIEDMAN: I would suggest it is not on a
12 yearly basis to the extent you fall below 90 percent of
13 your goal, you are probably going to put on a
14 performance improvement plan.

15 MS. CHASSER: That is correct.

16 MR. FRIEDMAN: I would suggest on a weekly or
17 biweekly basis, according to current practice. You
18 fall below 90 percent of your goal you are going to be
19 in trouble.

20 The other thing is since Ron had talked about
21 -- Miles, quickly indulge three.

1 Since Ron talked about points what has always been the
2 case and what is clearly on the rise in the past year,
3 is the number of second actions we do when we find
4 people file -- not you but others file and we have to
5 do work for which we get no credit.

6 Just like there were files for which there
7 were and get credit there are also an increasing number
8 of files that we work on -- there are a couple of
9 alumni here so you probably know to some degree what
10 I'm talking about -- where you don't get credit.

11 Finally, two points, if you do a second and you
12 get a response back and it raises a new issue, we have
13 to respond. We don't get a point for that.

14 MR. ALEXANDER: Let me interrupt for a
15 minute. I think we are getting pretty far afield of
16 where our agenda is.

17 MR. STIMSON: I wanted to speak to the
18 comment or suggestion you made. As a specialist, I
19 think I see a lot of value in specializing in a certain
20 area.

21 I have also heard some very persuasive

1 arguments from the trademark office as to why they are
2 doing what they are doing.

3 In balance I haven't heard enough here that I
4 would feel that the TPAC ought to take a position
5 telling the trademark office to do differently. I
6 think its something where reasonable minds can differ.

7
8 I were I think there is good arguments on
9 both sides. I certainly would not support a position
10 now where we were basically recommending that the
11 trademarks office use specialists.

12 MR. ALEXANDER: Do we have a motion to that
13 effect?

14 MR. STIMSON: I'm saying we should not make a
15 motion now. What we do with our previous motion maybe
16 the way to do that is, as you said, wait and see and
17 look at this. I'm not sure I would rescind
18 that. I think in terms of a new motion now saying we
19 oppose the requirement that people be generalists, I
20 would not be in favor.

21 MR. ALEXANDER: I was saying a motion that we

1 keep an open mind to the development of it. But
2 perhaps that's what I needed. Any dissent as to what
3 David said?

MR. FRIEDMAN: As a tag line
4 if you are working on files that generally you have
5 less expertise in, and therefore as a general rule from
6 our perspective it will take you longer to work on, is
7 there a correlary to that if we're all going to be
8 handling all files you be given more time to work on
9 them?

10 Going back to something Debbie said, I
11 would agree 100 percent that one of the reasons there
12 was a production adjustment in E commerce offices is
13 not only because you were working on all goods, but
14 because there was also going to be implemented and you
15 were going to have to get used to all the E government
16 initiatives.

17 One of the things that hasn't occurred as we
18 go through all these E government initiatives now, is
19 there isn't any production adjustment for those people
20 in the offices who haven't previously been in E
21 commerce offices.

1 Here are you working on all goods, no break
2 for E commerce initiatives that you are getting used
3 to, though all of our attorneys are struggling.

4 MR. STIMSON: As we have done in the past, I
5 would leave issues like production adjustments between
6 the union and the office would not take a position.

7 MR. ALEXANDER: I just don't think TPAC could
8 get into compensation issues. We have heard arguments
9 indicating it is just as productive doing a wide
10 variety of things and we have heard that it is not as
11 productive. I don't think that's for us to resolve.

12 MS. LOTT: Although if I heard Howard
13 correctly when you read the last annual report, or our
14 last report, I think, it said something about our
15 recommending appropriate time recognition or something
16 like that, which is consistent with what Howard is
17 saying and what we have said today. Is that
18 correct, am I recalling that correctly?

19 MR. FRIEDMAN: Well, just with
20 specialization, if you are doing cases that you are not
21 normally specializing in, everyone would get credit,

1 the person who is asking the question, as well as the
2 person who is answering the question.

3 The point I was making before is that I would
4 think that would apply whether they we are specializing
5 or not.

6 MR. MOYER: My suggestion, since time is
7 moving on, there are various committees set up. This
8 might logically fall under the E office committee. It
9 is an ongoing issue to be monitored and considered and
10 TPAC will want to weigh in on this after it hears more
11 about the pros and cons of generalism versus
12 specialization.

13 MR. MULLER: I hope we don't get involved in
14 negotiation between union and the office. I really
15 don't want us to go there. I think we have
16 to try to figure out if this issue really is a nexus in
17 increased pendency, first action. If it is, then it's
18 something we should be involved in.

19 Otherwise, I think it is up to the office to
20 tell us what they think is the way to run the office.
21 Let them run it with the lowest pendency we can get.

1 MR. PRICE: Let me ask before responding is
2 there a motion on the table? MR.

3 ALEXANDER: No, there really isn't.

4 The conversation is just going to go on
5 record indicating the general view of the group that it
6 is wait and see without a motion.

7 MR. PRICE: It would seem to me that it's
8 appropriate for the key office committee to make itself
9 aware of how it goes with generalization versus
10 specialization and to incorporate that in its annual
11 report.

12 MR. ALEXANDER: I think that's an excellent
13 idea.

14 MR. MOYER: Griff, you earned your money.

15 MR. ALEXANDER: There is another item I want
16 to take up before we start running out of time. Over
17 the next couple of hours let me move up to the agenda
18 the selection of an acting chair and committee for
19 2003, annual TPAC report.

20 We have three board members going off and the
21 chair going off. I think you need an acting chair and

1 I think you need a committee to take charge of it
2 though I expect, as we did last year, everybody on the
3 TPAC to contribute for the annual report through
4 subcommittees and assignments.

5 I would open the floor for nominations for an
6 active chair and then we can talk about selection of
7 committee members who will be the driving force of the
8 annual report which will be on you before you know it.

9 I had suggested earlier that Kim take a role
10 in this. I think for a couple reasons.

11 MS. LOTT: I nominate Kim Muller.

12 MR. ALEXANDER: Any other nominations? Any
13 other volunteers? Any further discussion?

14 All those in favor? Opposed?

15 Unanimous.

16 May I suggest that Kim give some thought to
17 selecting the members of the committee based upon their
18 subcommittee roles since they are only five other
19 people involved rather than trying to do this as a
20 group.

21 Does that seem fair? He can talk to each

1 separately and find out what you are inclinations are.

2

3 MR. MULLER: I will do that just be aware
4 that I communicate a lot by e-mail, as you know miles.

5 MR. ALEXANDER: Yes.

6 MR. MULLER: I will probably be communicating
7 a lot with you by e-mail also. I would hope the office
8 could give us three more people, three more pens to
9 write with before August, hopefully.

10 And I would also like the office to tell us
11 whether or not the three people that are going off can
12 participate for their time that they were here in the
13 annual report in November. If that's permissible even
14 though they are not on TPAC anymore?

15 MS. CHASSER: We don't have general counsel
16 here, but I would assume that you could certainly ask
17 questions and they could respond by e-mail.

18 MR. MULLER: Can they help write the report?

19 MS. CHASSER: You mean as special government
20 people?

21 MR. MULLER: No, just from there

1 participation here.

2 MS. KANE: As friends.

3 MR. ALEXANDER: I think the theory is nobody
4 has joined this group for the money. Why don't we get
5 a ruling from counsel on that.

6 MS. CHASSER: Sure.

7 Again, I want to reiterate the commitment to
8 try to get the new members on board so there won't be
9 such a large lapse on the full committee. It is
10 underway.

11 Siegrun, you started to ask about where we
12 were. I think we received four or five nominations for
13 those positions. They are currently being vetted and
14 then will be sent to the secretary of commerce.

15 I think, within the next couple of weeks and
16 then when the letters go out, we're hoping will be out
17 around the time of the end of the term, which is, I
18 think, the middle of July.

19 MS. KANE: I'm assuming that the
20 subcommittees for the people who are still here remain
21 the same.

260

1 MR. MULLER: Yes, that's correct.

2 MR. ALEXANDER: The next item on the agenda
3 was TPAC committee work.

4 I just want to read into the record from the
5 last meeting from page 146 - 147 of the transcript.

6 Siegrun Kane is going to serve on the TTAB
7 committee and deal with appellate questions that have
8 been raised. Leslie in her absence has been assigned
9 to the TTAB hope committee and to any other committees
10 we need anybody on.

11 Jon you are going to deal with quality
12 control. Griff you are going to deal with E office.
13 David Moyer, Madrid. Kim you wanted to deal with
14 quality control as well?

15 MR. MULLER: With Jon, yes, that's right.

16 MR. ALEXANDER: I think that will give you a
17 refresher.

18 The two areas we had not covered completely
19 from this morning or ad nauseam, I guess, would be the
20 word would be work force issues and pendency.

21 Why don't we go to pendency. Anne, could you

1 just brief us on --

2 MR. CHASSER: When we met last, gosh, I don't
3 know when it was, August, and there was a lot of
4 discussion about where we were going to be in terms of
5 right sizing the work force, we indicated that about
6 250 examiners were the number that we needed in order
7 to reach our three-month pendency goal for trademarks.

8 We had a number of assumptions that we placed
9 in that model, one of which was that we would institute
10 our production award system shortly in the beginning of
11 the fiscal year that we would enter the fiscal year
12 with a very small backlog of cases, that our examiners
13 would spend 80 percent of their time on examination.

14 You all heard about the 1.3 and so on and so
15 forth, amount of work done for the level of our
16 examining the attorneys.

17 What we have found through this year is that
18 a number of our examiners have been working -- last
19 June we made a concerted the effort to clean out the
20 back end of the process and we worked on that last
21 June.

1 So last fiscal year our examiners were
2 working only about 25 percent of their time on first
3 action, which resulted in sort of a backlog of first
4 actions.

5 This year through the first half of the year
6 we have not seen a tremendous increase in the ratio
7 between first actions and amended work.

8 We have seen a pickup in March as the back
9 end of the process is clearing up. And our goal is to
10 try to get our system working in the way that it works
11 best rather than focusing completely on first actions
12 or back end pendency, where our examiners would spend
13 about 55 to 60 percent of their time on first action
14 and then the balance of their time in subsequent work.

15 Our current pendency is I think 5.8 or 5.7
16 months as of the end of May. And again, that's because
17 as Howard mentioned that our examiners are working on
18 many fewer first actions than first actions coming in.

19 We believe that as the other work dries up
20 in the system, that the examiners will begin to focus
21 on first action because there is not that much other

1 work to work on at this point.

2 That will drive down the first action
3 pendency. We want to look at the end of the year,
4 which is a September date. In our calculations, we
5 should end fiscal year somewhere in the three-month
6 range now.

7 Again, in government work three-month
8 pendency is anywhere from 3.0 months to 3.9 months and
9 we believe that we will be within that range.

10 I don't know if Debbie or Ron have anything
11 you would like to add to that or Bob?

12 MR. WILLIAMS: We're hoping.

13 MS. CHASSER: That's not very encouraging,
14 Ron. I think you might want to talk about from a
15 management perspective how this, you know, in terms of
16 the control of the work and what influences the
17 managers have with regard to working or influencing
18 what kind of work is done by examiners

19 MR. ALEXANDER: Or you can plead the 5th if you want.

20 MR. WILLIAMS: Actually, many cases is as
21 small (inaudible) sometimes. So we anticipate that as

1 the indicated examiners will begin to work more first
2 actions. There is just not that many amended cases in
3 the queue.

4 The first six months of the year they are
5 working off to the docket, their own dockets plus the
6 dockets of the examining attorneys that have left.

7 So that has kept them very busy through the
8 end of February and March. Now we are anticipating
9 that in March the first actions went up.

10 We hope that they will continue to go up
11 during the remainder of to the fiscal year, because it
12 is just not that much amended work coming in the door
13 for them to keep processing.

14 They have to turn the cases over every six
15 months. Like Anne, said we're trying to get up to 80
16 percent of the time they are actually in the office.

17 We're -- having more senior work force a lot
18 of them have more leave. They can take more leave. We
19 have a very beneficial comp time program where they can
20 hours to days and take them next week, or next month,
21 or whenever they feel like it?

1 We anticipate, we hope, at least I hope very,
2 very strongly that we will -- that pendency will start
3 going down. I think it has.

4 In the month of May we actually transferred a
5 lot of -- we had cases that were five and a -- any case
6 that was over five and a half months or over, we were
7 trying to get assigned and get it processed out so we
8 could get rid of old cases. I
9 anticipated pendency to go up in May for that. Now
10 that we have fewer cases over 5.6 months, we should,
11 hopefully, see a decline in June in terms of first
12 action pendency, because there will be fewer cases over
13 the 5.8.

14 MR. ALEXANDER: Is the office move going to
15 have any substantial impact in terms of times taken
16 away from processing?

17 MR. WILLIAMS: No, actually on average, I
18 think the average amount of time we lost per examiner
19 was four hours for the moves.

20 MR. ALEXANDER: I'm talking about the future
21 move to Carlisle.

1 MR. WILLIAMS: Oh, the Carlisle move, it
2 absolutely will have an impact. That will be fiscal
3 year '05.

4 MR. ALEXANDER: That's the budget we're
5 talking about though.

6 MR. WILLIAMS: It will have an impact. I
7 can't tell you exactly how much impact that will have.
8 Certainly, we're going to lose some time.

9 Fortunately because patents -- we have
10 already moved and have a couple organizations there,
11 the IP stuff, the technology piece hopefully will have
12 been worked out.

13 Those bugs and all the cranks in the system
14 in should have been worked out before we actually move.
15 Our process substantially different.

16 We're in the process now of scanning
17 everything that comes in the door. We're in the
18 process of scanning on demand all of our current
19 pending applications. Right now we're scanning
20 everything that comes into our office.

21 When the paper comes in, to match with the

1 file we scan it so that file becomes into our
2 particular under system -- we anticipate November to
3 have all 12 law offices -- everything that is coming in
4 scanned in particulars so that by the time we move in
5 2004, most of our current applications will be in
6 particulars and there will be less of a problem when we
7 begin to move.

8 MR. NICHOLSON: Related to that point right
9 there, you mentioned this morning the process of
10 scanning back files.

11 Is that process scheduled to be completed
12 before the move to Carlisle?

13 MS. CHASSER: I don't know.

14 MR. ANDERSON: Yes. By the time we move to
15 Carlisle, all pending applications will be in
16 electronic formats.

17 Ron mentioned scanning on demand, which we're
18 running as a pilot right now to work out any problems.

19 It is being reviewed on a monthly basis.

20 It took a while to get two law offices
21 running smoothly. But what kicks off a scan is you

1 file a response to an office action. We then go pull
2 the file that would be matched to that response. We
3 scan to the entire file into the system including the
4 response to the office action. Any paper that comes
5 from outside the office that affects any pending file
6 wrapper that does not exist electronically means that
7 file wrapper gets scanned into particulars.

8 By November, we hope to have a good portion
9 of the existing pending file wrappers in the system.
10 But what we don't have -- the system will be working
11 smoothly enough by then that it won't be a big problem
12 getting additional stuff in.

13 As Ron indicated we have four law offices now
14 we're doing this with. We'll be adding a couple more
15 in the very near future. So half the law offices will
16 be getting all their files scanned in.

17 I would have to guess by September all 12
18 offices will be on that system. So any office action
19 response, any paper that comes in that affects the
20 file, the file gets scanned in the system. That's the
21 entire file wrapper, the specimens, the whole --

1 MR. ALEXANDER: Any other comments?

2 MR. FRIEDMAN: Historically, having gone through this
3 in past years, don't files typically go up as the year
4 goes on at least in the third quarter?

5 MR. ANDERSON: They normally go up in the
6 third quarter. Then they start dropping through the
7 fourth quarter and the first quarter of the next fiscal
8 year.

9 MR. FRIEDMAN: We learned last two years that
10 it seems like filings more or less have some loose
11 correlary to NASDQ. Unfortunately for
12 most that's been going up of late. Do you have any
13 idea what impact that may have on --

14 MR. ALEXANDER: Loose correlated to what?

15 MR. FRIEDMAN: To NASDQ.

16 MR. ANDERSON: You know, the guy who runs
17 internet did publish the thing that said there was a
18 strong correlation between the NASDQ and trademark
19 filings, that did kick off a certain amount of interest
20 in the trademark industry and among economists in the
21 office.

1 It has been looked at fairly carefully. What
2 was found there was a very strong correlation between
3 the NASDQ and the filings in the international class 9
4 35 and 42, which are essentially, where internet
5 services and goods related to the computer industry are
6 found.

7 Our big drop off now when filings started to
8 go down we're in classes 35 42, well service classes
9 had become almost 52 percent of our filings at one
10 point. Now they are back down to more normal levels.

11 So, a lots of the loss in filings has been in
12 the service industry which would suggest that the
13 service industry starts to pick up again maybe they
14 will.

15 Given the consolidation that is going on in
16 the internet world, I seriously doubt we're going to
17 see another internet boom in files because start-ups
18 are not the way of the industry right now.

19 The other correlation that has been found on
20 filings tends to be corporate profit. This is outside
21 of to the so-called internet industry.

1 There is a correlation between corporate
2 profit and filings in the office when you look at it in
3 hindsight. However, it is very difficult to project
4 corporate profit.

5 In point of fact, if you look at corporate
6 profit right now, it does not go well for filings,
7 generally speaking. The market fluctuations are being
8 caused by companies downgrading their profit forecasts
9 right now.

10 So I don't know. The only thing that I have
11 seen any general agreement on among economists and
12 other people is that that was a very cute thing the guy
13 at the internet did when he found correlation between
14 trademark filings in the chart and the NASDAQ, but it
15 certainly hasn't helped.

16 Of course the other factor is if anybody can
17 predict where the NASDAQ is going, good luck.

18 MR. FRIEDMAN: The only thing I would add is
19 that when we were chiming in over the past few months
20 as to what we wanted on the agenda or what the focus
21 should be, there were a number of people who had

1 suggested looking at what the priority of TPAC is
2 relative to pendency, relative to quality.

3 Whether they are attached to each strategic
4 plan initiatives or other things that have been
5 discussed today and that TPAC would want to look at how
6 important pendency is if pendency or working off cases
7 at a certain level is going to sacrifice quality.

8 Perhaps the quality was more important that
9 that's in line with what Deputy Director Dudas and
10 Director Rogan had suggested. To the extent we were
11 advocating we push pendency to sacrifice quality was
12 not something, I think, most people were interested in.

13 So, I guess I just throw that out in case
14 there needs to be a sense gotten from the TPAC as to
15 what is most important to them.

16 MR. ALEXANDER: I think most of the TPAC
17 members have been involved in the trademark area,
18 pendency was a lot worse than it is now.

19 So 5.3 or 5.8, doesn't make us shudder and
20 probably for those of us that are even older before ITU
21 and constructive use dates were determined by

1 application dates it was a much more serious problem.

2 Because you had no priority until
3 registration or use.

4 Speaking for myself, I'm not hung up on
5 pendency as I would have been pre ITU dates or during
6 other times. And therefore quality takes priority by a
7 large amount over pendency from personal standpoint.

8 I don't know how others feel about it.

9 MR. MULLER: Isn't that what the office has
10 told us in the past? Quality is the most important
11 thing they do and pendency is important but not as
12 important as quality.

13 Am I right?

14 MR. ALEXANDER: I believe so.

15 MR. FRIEDMAN: It is what they made very clear at the
16 August 2002, meeting by Bob and Deputy Director Dudas
17 and Secretary Rogan, one of the reasons I put it out
18 there and I'm glad to hear what TPAC has to say is it
19 confirms what -- I have always been under the
20 impression is that I know that the office on the other
21 hand as important as quality is, is very concerned

1 about pendency and is making a push when it comes to
2 pendency. Perhaps now that they have
3 heard to some degree from the customers that they are
4 reaffirming what is most important is quality, there
5 can be a renewed or additional focus on quality,
6 whether it is training, or examination time, or other
7 things that lead to a better quality product instead of
8 having so much concern about lowering pendency.

9 MR. ALEXANDER: The two are not mutually
10 exclusively, obviously.

11 Speaking for myself quality is first priority
12 as long pendency is reasonable. I don't know if
13 anybody feels any different.

14 MR. NICHOLSON: Another law firm perspective,
15 I agree. I don't think clients of our firm certainly
16 have a problem with four to six month to first action
17 pendency at all that is quite reasonable.

18 MR. ALEXANDER: We're really blessed by them
19 being used to watching patents.

20 MR. MULLER: I don't think the TPAC has ever
21 wavered on this issue. I don't know why we're even

1 discussing it. The office has been consistent, we've
2 been consistent quality is the most important thing.

3 MS. CHASSER: I think the reason we have been
4 focussing, if I can chime in, is that we have goals
5 that we established with the appropriators.

6 And while customers say that quality is job
7 one, when we go up to Capitol Hill they are looking at
8 the amount of time it takes to deliver our products and
9 services.

10 So, when we establish our budget and you
11 heard in the closed session how we develop our budget
12 two years ahead of time those are the markers we always
13 give. What will our quality be, what will our
14 timeliness be, and what are the markers for E
15 government.

16 If we're not able to deliver on the agency
17 goals in those three areas, when the next funding cycle
18 comes around, you get a bad mark. And that means we
19 can't support you at the level that we supported you
20 before because you didn't achieve the goals that you
21 said you would achieve under the appropriated funds

1 that we granted.

2 It really is I mean it is our responsibility
3 really to put everything in balance. As I said our
4 stated goal is three months and there is -- now that
5 pendency has been rising this last year, we are making
6 a concerted effort at the end of the year to drive
7 towards our stated goal of three-month pendency by the
8 end of the year.

9 That's why we're seeing an additional focus
10 in the second half of the year.

11 MR. ALEXANDER: That's certainly in keeping
12 with the administration's goal in finding weapons of
13 mass destruction.

14 Let's go onto work force issues. I think we
15 have talked about this a good bit, Howard distributed a
16 survey that is not a -- I don't think has been seen by
17 others before today.

18 I'm not sure it is appropriate to get into it
19 today without having the office have time to take a
20 look at it and balance it by any comments they have.
21 But I thank Howard for sharing it with us.

1 MR. FRIEDMAN: Just to be clear this is an
2 abridged version. There is a much more -- we're
3 looking at all the results. We wanted to get something
4 to the TPAC today. There are a number of other
5 questions that were asked which generated a number of
6 other answers.

7 We of course would welcome providing all the
8 survey results and all the survey questions to TPAC, as
9 well as the office so they can review that.

10 MR. ALEXANDER: I think that it would be very
11 useful to see the complete survey and the survey
12 questions before we dealt with it.

13 We're still obviously dealing in a very
14 difficult time after the RIF that -- and we understand
15 the psychological aspects of that as well.

16 I think it may be premature to address it at
17 this meeting is all I'm saying.

18 MS. KANE:
19 Could I ask a question about it?

20 I notice the statement I don't know what page
21 it is, but it is toward the end, it's a footnote,
footnote one. That during the past year changes have

1 been made to the TMBP and it was previously available
2 in paper and there is a searchable on line tool and
3 now, it is non searchable on line test.

4 And then at the end there was a general
5 criticism about the TMEP. I'm wondering how you know,
6 for those of us in the public who would like to know,
7 what changes were made in the TMEP without having some
8 guideline.

9 That's the kind of thing I think the public
10 would be interested in. If there is some change in
11 practice or some change in policy, how do you know?

12 MS. CHASSER: The TMEP was put on line
13 electronically this year or last year Sharon?

14 MS. MARSH: Last year you had it on line.

15 MS. CHASSER: 2002.

16 MS. MARSH: The new updates are on the web.
17 For each update there is a list of sections that have
18 been changed.

19 MS. KANE: For the entire year would there be
20 an update? In other words every change for the year
21 would be in one spot?

1 MS. MARSH: Well if I update. There have
2 been two updates, two lists of changes. Two different
3 documents.

4 MS. LOTT: Isn't that in the index? When you
5 go to TMEP on line, you scroll down the index at the
6 end it says --

7 MS. KANE: Have amendments been made to the
8 text as well or only in to the appendices. Do you know
9 what I mean?

10 MS. MARSH: In the body you see the changes.

11 MS. LOTT: Can I follow up on that? What
12 does it mean it was originally searchable and now, not?
13 Has there been a difference in the change of the
14 format of the TMEP on line?

15 MS. MARSH: We previously were using software
16 called (inaudible) it was searchable. When we put it
17 on line, it is tied to the first gov search engine.
18 And it is searchable, it is just not searchable in a
19 way that is ideal.

20 I think we have it on our to do list to put a
21 different search engine on there but this year with

1 Madrid and TIS, it is not on the top of the priority
2 list.

3 I will say anybody who has worked at the
4 office for a few years is quite familiar with the TMEP,
5 and generally should have a good idea of what you are
6 looking for. Where it is in the TMEP, individual
7 chapters are searchable with a very basic search.

8 MR. MULLER: Wasn't this a drop down in the
9 presentation this morning that Chris showed us. TMEP
10 was on there and you clicked on it and it would open
11 the TMEP?

12 MS. MARSH: Yes.

13 MR. MULLER: So, you can't search that once
14 you click on it, you just have to scroll through the
15 whole thing?

16 MR. FRIEDMAN: No, when you click onto it you
17 use the first gov search engine, you actually do a
18 search of all of the chapter. Once you have identified
19 the chapter you can do an individual word search
20 through that chapter.

21 MR. ALEXANDER: But if you had a single word

1 that you wanted to find used any place in it you would
2 have to go chapter by chapter?

3 MR. FRIEDMAN: That is the crux of the
4 problem.

5 MR. ALEXANDER: How many chapters are there?
6

7 MS. MARSH: Eighteen.

8 MR. FRIEDMAN: Keep in mind, that of itself
9 would be a problem if we were comparing one electronic
10 TMEP to another. Keep in mind that when we went
11 electronic you don't have paper copies and people
12 really -- think about all the office actions you get
13 and how many TMEP sections you site in it because
14 people refer you to form paragraphs of the TMEP
15 directly. That's the bible. That's what we all use.

16 MR. ALEXANDER: You say you don't have paper
17 copies.

18 MR. FRIEDMAN: We don't have paper copies of
19 the TMEP.

20 MR. ALEXANDER: Don't you have to just press
21 a button to get one.

1 MR. FRIEDMAN: You mean print the whole
2 thing? You do and then every time updates come out you
3 do that. One of the problems there -- it sounds like
4 it is not a problem.

5 The office is free to disagree. Lots of
6 times we find out about changes after they are already
7 implemented, which doesn't help you, clearly doesn't
8 help us. We're spending time examining.

9 Trying not to spend too much time printing
10 out updates of the TMEP, and focussing back on the
11 searchable part. You've hit it, Miles, especially as
12 it keeps changing if you have to take this step, and
13 this step, and this step to search a word to figure out
14 how you want to treat a particular procedural or
15 substantive issue, you would be doing that very often,
16 that's what five or six examiners here are doing. It
17 adds up.

18 MR. ALEXANDER: Nobody else has put it on
19 line? Couldn't the office agree, I mean, private law
20 firms pay a lot of money to have things like that
21 conveniently on line. Wouldn't West, or somebody be

1 happy to do so.

2 MR. SUSSMAN: I put it on line myself. I
3 have a different search engine. I don't know that it's
4 really any better but some people like it.

5 I get probably between 30 and 75 hits a day
6 to my version of the TMEP. Probably 50 are those are
7 from the USPT and other 25 are from law firms and
8 corporations.

9 MS. KANE: What do you mean your version?

10 MR. SUSSMAN: It is the same version. I put
11 it up on the web site when it first came out in --
12 before the office did. I put it on in Microsoft word -
13 -

14 MR. ALEXANDER: Why don't you give everybody
15 your URL.

16 MS. SUSSMAN: WWW.SUSSMANS.NET/REF, R-E-F,
17 for reference.

18 MS. CHASSER: Just for you information when
19 Chris, was showing you the FAST demonstration, he said
20 that's the most popular one. So, we actually have it
21 on the examiners desktops the so they can click onto

1 that too. That is a searchable.

2 MS. KANE: Can you check by section number if
3 you just want to check or do you have to go chapter by
4 chapter.

5 MR. SUSSMAN: You can do it either way. You
6 can search by chapter or the entire TMEP for words.

7 MS. KANE: I thought you couldn't, or is this
8 your version that you can? I thought you had to go
9 chapter by chapter.

10 MR. ANDERSON: He has a different search
11 engine.

12 MR. DONINGER: You have to remember that Ron
13 does this and answers only to Ron. Whereas when we put
14 something up we have to go through the CIO stuff and it
15 takes a little bit longer and more people involved.

16 MR. ALEXANDER: It's amazing what you can do
17 if you don't go through the bureaucracy, isn't it?

18 MR. SUSSMAN: Another thing that people do I
19 know, is use the office's TMEP but they use Google's
20 search engine. Because you can limit a Google will
21 search to a specific domain name. What they will do is

1 search term and just limit the domain to USPTO dot gov.

2

3 You will be using Google as your search
4 engine, it's a far better search engine.

5 MR. ALEXANDER: Howard, does that solve your
6 problem?

7 MR. FRIEDMAN: They had never heard of it.
8 In all seriousness, Miles, the answer is no, but one of
9 the problems is having -- and TMEP is just one small
10 part of the training.

11 That's the reason there is a resounding no,
12 it doesn't obviously solve our problems. Obviously it
13 makes it a little more palatable.

14 MR. ALEXANDER: I didn't mean all your
15 problems. I meant the TMEP problem.

16 MR. FRIEDMAN: I couldn't solve all my
17 problems if I tried. But one of the interesting things
18 is it was clear from looking at the reaction of
19 attorneys who examine in this room when Ron talked
20 about Google, was that was the first they ever heard of
21 it.

1 And the point being, even if you have an
2 engine and it is improved and Ron has improved it and
3 you can do better through Google, clearly if the two
4 gentleman over here, if evidence given the bar unit,
5 not to suggest they do, that was clearly the first they
6 had heard of that.

7 That's the kind of thing that doesn't get
8 communicated to the bargaining unit. That's the kind
9 of thing that would help.

10 MR. ALEXANDER: I'm glad we met today.

11 MR. FRIEDMAN: The two of them are probably
12 too.

13 MR. ALEXANDER: Moving on to the --

14 MR. SANDELIN: Just a comment on the survey
15 which I think is extremely valuable but it's just on
16 accuracy basis, when you show the percentages you might
17 want to consider saying percentage of respondents.

18 If I understand this correctly about 60 percent
19 -- the views of about 60 percent of the force are not
20 represented, just so people aren't misguided.

21 MR. ALEXANDER: Any other comments or

1 thoughts with respect to work force issues?

2 I'm about to go onto the 3 to 5.

3 MR. FRIEDMAN: Just real quick, just under
4 strategic plans work force issues, the specific page
5 strategic plan title work force issues that says that
6 information is confidential and there isn't anything
7 really on those pages, is that something that
8 eventually is going to be discussed with the TPAC
9 group?

10 MS. CHASSER: I understand it, there are a
11 number of issues that involve labor management
12 negotiation. And so that's why the issues are not
13 presented for the public yet because those issues have
14 not been resolved.

15 MR. ANDERSON: The reason it is not on the
16 web site -- there is information in there that affects
17 labor relations.

18 We're not at liberty to discuss in open
19 forum.

20 MR. ALEXANDER: That has not been something
21 that has been given to TPAC?

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1 MR. ANDERSON: I don't know.

2 I had one in there also --

3 MR. ANDERSON: The work force issues that are
4 not in the strategic plan are all related to patents.
5 The only thing that trademarks had in there is still in
6 there.

7 So there is nothing missing from an NTU 245
8 standpoint.

9 MR. ALEXANDER: Before we get down to the
10 last section of the agenda, is there any other issues
11 that we have not discussed that anybody in the TPAC
12 would like to discuss?

13 MR. MOYER: I would like to ask just one
14 question it kind of goes back to work force issues. I
15 heard Howard allude to changes that were made without
16 enough input from examining attorneys.

17 I'm just wondering as a matter of process
18 when management makes decisions, I assume you go to
19 examining attorneys, a small corps perhaps, and say
20 we're thinking about this. What should we be thinking
21 about.

1 And the only reason I raise that is, I think,
2 when change occurs to the extent that people that the
3 change affects have some opportunity to input on the
4 change, it goes down or it gets embraced more readily.

5 And I just -- we don't want to spend a lot of
6 time on that I think that's fairly well know. I sort
7 of sense that there has been some changes that have
8 gone on that perhaps the impact on the examining
9 attorneys has not been fully considered through their
10 eyes.

11 Maybe it has been. But it is just something
12 that has been sort of bothering me all day.

13 MS. CHASSER: I think you are probably right
14 in terms of two different points of view. I think you
15 can appreciate that since we're in an union, management
16 kind of relationship we have to be very careful to dot
17 the I's and cross the T's and do everything within the
18 guidelines that are set forth in the contract. And
19 we're very sensitive to that.

20 We did through a partnership negotiate an E
21 commerce agreement with our union, which involves all

1 of the changes that we are undertaking in our
2 transformation to a model E government.

3 There might be some disagreements about what
4 was included and what was not. That may be what you
5 are sensing today.

6 I don't know. Bob, did you want anything
7 else?

8 MR. ANDERSON: I think that's fair.

9 MS. CHASSER: It is a matter of publication.

10 MS. COHN: Can I just point out that during
11 the E commerce pilot program, we did have a working
12 group, a labor management working group set up with
13 examining attorney representatives and management
14 representatives that worked out some of these issues.

15 MS. CHASSER: One thing we talked a lot about
16 work force issues and the difficulty of change within
17 an organization. We're going to put it on the table
18 that this organization is changing. There is no doubt
19 about it.

20 Those of you who were in the office, I guess
21 quite a few years ago, but even if you worked in the

1 office two years ago and you came back today, it was a
2 very, very different environment than it was today.

3 Change is always difficult, and change is
4 always stressful, but what I would like to just share
5 with you is what are some of the benefits of working
6 within this office.

7 I happen to think that this is a great place
8 to work even though you have heard to the contrary
9 today. I thought it might be interesting to share with
10 the TPAC just what the benefits are, especially, from
11 our examining corps.

12 We talked a little bit about the corps being
13 -- the majority of the corps being GS-14. We have a
14 small percentage that is GS-13.

15 We talked a little bit about reintroducing
16 our productivity incentive bonus. Under that, under
17 our production incentive program it allows examining
18 attorneys who do have out standing production to earn
19 up to \$20,000 a year in awards. That would be -- it is
20 measured every six months. You have the ability to
21 earn \$10,000 twice a year for outstanding production.

1 It is based purely on production
2 with an element of quality and customer service
3 standards that have to be in there as well. We also
4 have a quality award which is earned on a yearly basis.

5 That can add as much as 3 percent of the salary for
6 outstanding quality.

7 If you combine these awards along with the
8 base salary of a GS-14, a GS-14 examining attorney can
9 earn as much as about \$129,000 - \$268,000 dollars a
10 year.

11 MR. ALEXANDER: It's a rough estimate?

12 MS. CHASSER: What is interesting to note
13 about that in our government structure if you are a
14 senior executive and the scope of your responsibility
15 as a senior executive the base salary for senior
16 executive is \$115,000 and then there is a pay
17 compression where the maximum you can eastern is
18 \$125,000 a year.

19 About 53 percent of our examining attorneys
20 earned a mid year production award at the ends of March
21 this year. Now, we reintroduced our production award

1 at the end of January.

2 Many folks said that was too late in the year
3 in order to manage your dockets so that you could
4 maximize the production award.

5 In spite of that 53 percent earned a midyear
6 production award. Out of that 53 percent, about 13 1/2
7 earned the maximum of \$10,000.

8 Now, this along with a flexible work schedule
9 under our increased flexible work program examining
10 attorneys have an option of working any hours between
11 5:30 a.m. and 10 p.m., both on the weekdays and
12 weekends.

13 They have to complete 80 hours of work within
14 a two week period. But literally, they can structure
15 their day anyway they want. There is no sign in sign
16 out. It is sort of at their own discretion.

17 There is very little supervise and this there is no
18 supervisory approval to work whatever hours you want to
19 work. It is really -- you have the ability to adapt
20 to your own life-style and your own -- your person life
21 in terms of when it is you get the job done as long as

1 between the hours of 5:30 in the morning and 10:00
2 o'clock at night.

3 We talked a little built about telecommuting.

4 We have 42 percent of our examining attorneys are
5 working from home.

6 That's their primary workplace is at home. This is an
7 enormously popular program.

8 We're hoping to expand it to eventually to --
9 Bob said 150. That allows our examining attorneys to
10 make life-style choices that perhaps they otherwise
11 would not be able to if you had to be in a certain
12 place from 9 to 6 every day or you had to get the job
13 done in a particular time.

14 Our examining attorneys can also elect to
15 work part-time and that's anywhere between 16 and 32
16 hours a week.

17 We talked a little earlier about compensatory
18 time. This is a recent addition within the last two or
19 three years. This was based on a negotiation with our
20 unions.

21 This really does add to -- it further adds

1 to the completely flexible work schedule because our
2 employees have the ability to work compensatory time at
3 their direction, which can later be used in lieu of
4 vacation or leave.

5 In other words, we have actually had
6 examining attorneys that have used compensatory time
7 and then you chunk that compensatory time along with
8 your annual leave, and you could be out of the office
9 for a month at a time. Take a month off.

10 So there is an awful lot of flexibility in
11 terms of shifting your time for personal reasons and to
12 use for vacation.

13 We do have paid the overtime. And we have
14 reinstated the overtime now you have heard in other
15 meetings that it is at a lower GS rating. So it is at
16 a GS step 10 versus a GS-13.

17 But it allows examining attorneys who want to
18 earn additional money to put a few more hours into
19 examining and overtime. And all of this overtime then
20 does count towards the production bonus as well. It is
21 almost a double dipping, if you will.

1 I think that -- in addition, of course we
2 have a very liberal maternity and paternity leave
3 policy where you can take up to six months on maternity
4 or paternity leave.

5 In addition, we have the family medical leave
6 act where employees can use up to 12 weeks more during
7 the first year after a birth for maternity or paternity
8 purposes.

9 In spite of the fact that there is a lot of
10 stresses in the job, there is a lot of flexibilities.

11 I think it is a heck of a good job to have.
12 I think that as a matter of fact, we probably have more
13 flexibilities for our examiners both on the patent and
14 trademark side, than any other federal agency,
15 certainly within Washington, D.C..

16 And I think that's what some of our folks
17 have found out as they have gone to other agencies to
18 look for positions.

19 I really wanted to put that on the record so
20 you could get a sense of what this true work
21 environment is here within is office.

1 I don't know if you have any other questions.

2 MS. LOTT: I do, obviously, a lot of work has
3 gone into this and thought has gone into this. Do you
4 know of any other work environment in the private,
5 public or private sector that offers these kind of
6 different programs or this kind of flexibility?

7 MR. ANDERSON: Partner in a law firm.

8 MS. CHASSER: Let me ask you this, what did
9 you have to do to get there?

10 MS. LOTT: Is there something you are looking
11 to for comparison in coming up with these things?

12 MS. CHASSER: The reason I wanted to point
13 this out is recently I spoke to the company that helped
14 our examiners with out placement to see how -- just to
15 sort of get a debriefing about what worked and what
16 didn't work.

17 What the gentleman who is the head of the
18 company said to me that that was the biggest surprise.

19 First of all when he realized what the benefits were
20 that our employees had, second of all, that many of our
21 examiners that left were -- this was their first or

1 second job out of college, and they were shocked to
2 find out that other agencies in private industries the
3 didn't have similar kinds of flexibilities within the
4 job.

5 So I think we come to expect this as the
6 norm. but in reality it is quite the opposite. This is
7 not the norm in terms of a workplace environment and
8 what the opportunities and flexibilities are within the
9 workplace.

10 MR. STIMSON: Do you have any idea in your
11 discussions with the out placing people or otherwise
12 that in terms of the examiners who were laid off how
13 many of those have found new positions.

14 MS. CHASSER: I did. I don't have the exact
15 number.

16 I can tell you what the experience was. He
17 found the examiners who were willing to move beyond --
18 who were able to move beyond the beltway had a very
19 high rate of success.

20 Many of the examiners, of course, were limited
21 to stay in this geographic area because of family and

1 other jobs and so forth.

2 But those that were willing to look at the
3 skills that they have learned through this job and the
4 critical thinking, evaluation of regulations and they
5 were able to transition that into other more
6 generalists kinds of positions, legal positions had a
7 much higher success of finding other jobs than those
8 that were wedded to staying in intellectual properties
9 and specifically trademarks.

10 MR. STIMSON: What were the numbers when you
11 say higher.

12 MS. CHASSER: The percentage for those that
13 moved out of the Washington, D.C. area was about 90
14 percent he said, found jobs. He said those that stayed
15 within the Washington D.C. area that were very wedded
16 to staying in IP was considerably less, about 50
17 percent.

18 But we were actually very lucky. A number of
19 our examiners who went over to Veterans' Affairs, to
20 transportation safety, and I'm sure there are still a
21 number that have not found positions.

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1 A good percentage have found positions. Some
2 have found very interesting positions too.

3 MR. MOYER: How many examining attorneys have
4 left since September of 2002? Would it be like 9 or
5 something?

6 MR. ANDERSON: I thought it's like two or
7 three.

8 MS. CHASSER: Yeah.

9 MR. ALEXANDER: The last item on the agenda
10 is 21st century strategic plan discussion.

11 I think we have discussed fees and
12 specialization, examiner specialization. Certification
13 and second set of eyes were on it, I'm trying to go
14 look back at the schedule of trademark related actions
15 from a prior meetings and dates which certain things
16 were supposed to happen.

17 Bob Anderson is here with us to answer any
18 questions and perhaps to indicate to us how the
19 strategic plan is proceeding.

20 Did you want to say anything first and give
21 us a feel for it?

301

1 MR. ANDERSON: From a strategic plan
2 standpoint the primary focus has been on implementation
3 of the trademark information system and Madrid.

4 Madrid, which was a late comer to the table
5 has created more work than we otherwise would have
6 anticipated. I think we would have been further along
7 on the strategic plan in general had Madrid not come to
8 the table at the same time.

9 We have undertaken a fairly good number of
10 quality initiatives. Did you get the briefing while I
11 was out?

12 The quality has probably had the most
13 development of anything that set forth in the strategic
14 plan. We have focused on it, we're expanding the
15 quality office.

16 We developed some standards for looking at
17 files. And I assume they also mention that we are
18 working on an on line training mechanism that has been
19 used a couple of times on a pilot basis.

20 In particular, we are developing more
21 training programs under that on line initiative. And

1 eventually when Brian's group identifies problems, we
2 will then develop training programs specifically to
3 address those problems.

4 Right now we're work on some broad areas,
5 likelihood of confusion and a couple of areas like
6 them. We talked about using the program for other
7 things that come along in a more routine basis
8 including classification.

9 One of the major conversations here has been
10 having everyone do all classes. Are there some
11 problems.

12 We have started some discussion about
13 developing an on line training the program that focuses
14 on the international classification system in
15 particular. But would give examiners a broader
16 overview of how things are supposed to be managed in
17 the classification structure.

18 Another thing that Anne mentioned this
19 morning and this is again a focus on quality is to get
20 the three major offices moved toward standardizing
21 identifications of goods and services. So an ID in one

1 office would be good in all three offices.

2 I think as we get those things going, quality
3 will have better statistics on quality and things will
4 get moving a little better in the quality agreement.

5 The things that are listed in your examiner
6 certification, second set of eyes, quite frankly, we
7 have not done much yet with because we haven't had
8 time.

9 Second set of eyes as is indicated in the
10 current strategic plan will be initiated as a pilot in
11 conjunction with three tier examination and only on the
12 first tier, the \$275 filing.

13 If we value with second sets of eyes, we
14 would expand it. I'm not so sure that many people
15 think we'll see a lot of value with it. So it may be
16 one of those pilot programs that just kind of quietly
17 disappears.

18 We are going to try it however, as a pilot.
19 If we see value as patents have seen in the business
20 method process areas then we may expand it depending on
21 how resource intensive it is.

1 There does have to be a pay off in terms of
2 resource. If you eat up too much resource doing second
3 set of eyes you really have to start to question value
4 of it.

5 Examiner certification is tied in with our on
6 line training program. I think this has been
7 emphasized before, I will emphasize it again. The goal
8 of the certification program is to ensure that people
9 get adequate training.

10 The one thing that an examiner will have to
11 do if they are asked by their manager to go through a
12 training course because they appear to have a
13 deficiency in the area, is they must pass the test.

14 When I say they must pass the test, it
15 doesn't mean if they fail it they are out the door, it
16 means they have to go through the training program
17 again until such point as they can pass the test.

18 This is not meant to be a program to get rid
19 of people, to take examiners out of the corps. This is
20 meant to be a program to improve the skills of
21 examiners and in particular when they are having

1 problems in a particular area of examination.

2 MR. ALEXANDER: Bob, how does the office get
3 rid of somebody who they regard as not competent? Not
4 just examiners, anybody.

5 MR. ANDERSON: We're under what is called
6 title five and there are two types of actions that can
7 be taken. One, based on performance and the other
8 based on conduct.

9 There is fairly clear lines between the two.

10 Generally speaking a performance based action will
11 always be based on the performance appraisal plan under
12 which the employee works.

13 Conduct based actions are just what is
14 implied. The employee's conduct does not meet the
15 standards set by the federal government. This can
16 range from anything employees not showing up for work.

17 Quite commonly, conduct based actions that I
18 handle are employees who just don't have quite enough
19 time off so they just decide today I'm not coming to
20 work. They don't ask their managers and then the next
21 day they decide not to come to work either.

1 After a while, they are AWOL. When you get an AWOL
2 commonly the agency will take a conduct based action.

3 We also have employees who get in fights.
4 Some conduct based actions I've had over the past 15
5 years or so, drunk on the job, consuming alcohol in the
6 workplace, two or three fight situations where one
7 employee goes after another including with staplers and
8 other implements at hand.

9 A lot of AWOL actions, interestingly, under
10 and AWOL action what you commonly do is suspend the
11 employee to try to get him to be better, but there is
12 also a thing this in the federal sector call the
13 Douglas factors and it's a progressive punishment
14 arrangement.

15 The first thing you get might be a letter of
16 reprimand, then you get a three day suspension, and
17 then maybe a two week suspension, and then you are
18 recommended for termination.

19 I have signed terminations for employees who
20 simply cannot come to work on a routine basis.

21 One conduct based action that has occurred in

1 the examining corps is what we call mortgaging. An
2 examiner taking credit for work that they have not
3 completed. And we will take the conduct based action
4 for mortgaging.

5 Generally speaking, I don't actually recall
6 any other conduct based actions in NTU 245 members
7 other than for mortgaging. I think that's been it.

8 MR. FRIEDMAN: Other than, I guess a few
9 years ago maybe dealing with things related to
10 pornography.

11 MR. ANDERSON: Oh, yeah. The government has
12 this thing you know they don't like you to look up
13 pornography on the internet.

14 In particular, when some people were spending
15 virtually their entire workday at it, we thought maybe
16 occasionally they should take a break and do a little
17 real work.

18 There were a couple of -- I don't think
19 anybody lost their job or at least in trademarks nobody
20 lost their job. I think at most it was a suspension or
21 letter of reprimand, stuff like that.

1 MR. ALEXANDER: Sounds like a drug free
2 environment.

3 MR. ANDERSON: But those are the two ways or
4 the two methods that the government has of dealing with
5 employees who aren't performing to standard.
6 Performance based action but it is strictly driven by
7 the performance appraisal plan.

8 I think I have only seen -- actually I
9 haven't ever seen an instance because where the
10 employee does not follow what is considered to be a
11 reasonable direction from a manager, that's a conduct
12 based action not performance.

13 But that's how it divides out. Now it is a
14 very -- anyone who has been reading the papers lately,
15 as you know, the current administration is taking a
16 look at the subserver system.

17 They would like to take a look at some of the
18 protections in the system and make it a little more
19 efficient in terms of dealing with employees who aren't
20 meeting standard.

21 That's been on the table before quite a

1 number of times even during my career in the federal
2 government. I would have to guess it is not going to
3 go real far or at least not real fast, real far.

4 There are a number of protections built into
5 the system for the employee. There are third party
6 appeals and further, the contracts for both NTU 243 and
7 NTU 245 which we have in trademarks, we have
8 protections built-in by contract language.

9 It is managers have to build a very good case
10 to take a performance or conduct action on an employee
11 to be successful at it.

12 MR. ALEXANDER: There has been no
13 reconsideration of having the second set of eyes be at
14 a random basis rather than the fast track?

15 MR. ANDERSON: Not right now. We would like
16 to keep it in a fairly confined environment. We're
17 assuming that like most things, the three tier
18 examination would get off to a slow start and gradually
19 pick up. But we would like to keep it in
20 a management circumstance.

21 MR. ALEXANDER: I had heard from the fee

1 basis with the fast track fees going down and the paper
2 going up, that there is the expectation that the
3 overall user fees will go down as opposed to having
4 remained as it was. Is that an accurate estimate?

5 MR. ANDERSON: If there is a very high level
6 of -- if filings under the fast track fee structure are
7 at the levels that we have projected for the 2005
8 budget our total fee collections are likely to be less
9 than they would if the fee stays at \$335 per
10 application.

11 Now, the one caveat here is we have not
12 included any fees that we would collect from the Madrid
13 protocol in that calculation yet. But our overall fee
14 collections under our current fee structure would drop
15 as opposed to increase.

16 The only thing that would throw that off
17 track would be in the number of paper filings in \$325
18 and electronic filings was at a higher level than we
19 projected.

20 MR. ALEXANDER: I mentioned
21 that because I know that AIPLA and TPAC both opposed
any increase in the fees without elimination of

1 diversion.

2 MR. ANDERSON: Right.

3 MR. ALEXANDER: And one of to the reasons was
4 we didn't want an increase in fees without diversion.
5 Nobody ever tried to present that to the TPAC as not an
6 increase in fees.

7 I think probably you would have been better
8 advised to say the overall fees that we're proposing
9 are lower than they would have been before. And you
10 might have gotten a different reaction. I throw that
11 out if that ever happens again.

12 MR. ANDERSON: It was mentioned. I don't
13 know if it was ever mentioned at TPAC, it was mentioned
14 in other quorums. The primary focus has been on patent
15 fees. And the increased patent fees would result in a
16 substantial increase for the agency.

17 I think most of the controversy about
18 diversion at this point is focused on the potential
19 income that the faculties would generate.

20 MR. ALEXANDER: We probably would have
21 supported the patent group then.

1 There was a digital capture of pending paper
2 file inventory with a November 2nd, target date.

3 MR. ANDERSON: That was the thing that I
4 talked about earlier, the scanning on demand. We
5 saddled on a technique for doing it about three or four
6 months ago. We started testing it the first of May, we
7 had a review at the end of May.

8 Roughly in mid -- a couple days ago we added
9 another two law offices to the scanning on demand.
10 There will be another review at the end of June. At
11 that point, the way things are going now we'll probably
12 just let the manager of that project add law offices as
13 to the contractor can pick it out.

14 The scanning is being done by a contractor
15 not by government employees.

16 MR. ALEXANDER: We saw fast track this
17 morning. That's due to be finished before your
18 November 2, deadline. Right? MR.

19 ANDERSON: You saw FAST this morning. There is a
20 difference between the environment that we will
21 implement on November 2nd, and the environment you saw

1 this morning.

2 The FAST application you saw this morning was
3 specifically programmed using legacy systems that we
4 have in place. So you recall when Chris was talking
5 about it, he said the examiner will no longer have to
6 go on the case to get credit.

7 Essentially, the examiner hits a button and
8 the credit is entered into tram which is our current
9 administrative processing system just as if the
10 examiner had wanded the case.

11 We have adopted a product called Bizflow that
12 is currently being developed, and in fact, most of the
13 structure for the examination is completed and now,
14 they are working on the details of it.

15 The Bizflow desktop will look just like the
16 desktop you saw this morning. There will be tabs
17 across the top. Examiners by clicking a tab will
18 access various resources, such as excerpts and so
19 forth, but the underlying structure is a true work flow
20 product.

21 At that point, we start to move the

1 administrative part of our environment off of the tram
2 system. Tram becomes only a database for bibliographic
3 data we store on applications.

4 All of the other information on examiner
5 production and so forth will come or be derived from
6 the Bizflow application.

7 It is a true work flow product where FAST is
8 not -- it is a work flow product but it is Jerry
9 rigged, I guess, is the description that best fits it.

10 TIS November 2nd, is work flow in its purest
11 form.

12 MR. ALEXANDER: I know you just talked about
13 certification. Your original schedule pilot project
14 was to be finished by October of this year. What is
15 the deadline now?

16 MR. ANDERSON: It is still October. As I
17 said, certification is tied the to our on line
18 training. And we have put up a couple of preliminary
19 courses with testing at the end of it.

20 The only real difference is when we put the
21 certification structure in place, if an examiner is

1 identified as having a problem with making
2 determinations in likelihood of confusion they will be
3 required to take the likelihood of confusion course and
4 then take the test at the end of it.

5 If they don't get it right they will be asked
6 to take the course again and go through again.

7 We do not want to have a punitive system. We
8 want to have a system that will help examiners be more
9 successful. Quite frankly, some of the issues that
10 Howard has been talking about if you get better at
11 making decisions, your whole job goes better.

12 The more knowledge you have about what you are doing,
13 the better that knowledge is going to help you to
14 manage your work better, and to make decisions faster,
15 and to get stuff on the way.

16 And that is the goal of our certification
17 program. Not to tie it to promotions, not to tie it to
18 keeping your job or anything like that.

19 The goal is a little bit like continuing
20 legal education in the bar. You need to be able to
21 pass the course to stay in the bar. Only here all you

1 need to do is pass the course if you want to stop
2 taking it.

3 MR. ALEXANDER: Does anybody have any other
4 questions of any type?

5 MR. STIMSON: I have a question on the
6 strategic plan. Is there going to be a new version
7 coming out? If so, when and if so, when will TPAC have
8 a chance to comment on the early thinking of that?

9 MR. ANDERSON: As far as I know there is not
10 a new version coming out. I'm thankful for that
11 because when they do a new version it ends up being a
12 huge project that tends to absorb an enormous amount of
13 time. I'm not aware of anybody even
14 thinking of a new version. I believe that the
15 publication that recently occurred establishes the
16 goals of the agency and it establishes the how patents
17 and trademarks are going get to those goals.

18 Unless there is something that throws it off
19 track like insufficient funding or something like that,
20 that's where we're headed.

21 MR. STIMSON: My Understanding, maybe I

1 misremember was that it was going to be an annual
2 exercise.

3 MR. ANDERSON: It is annual in the sense that
4 it's tied to our budget, but the version that is up now
5 is our 2004 budget version.

6 As we get into the 2005 budget process the
7 strategic plan will be reviewed in terms of the
8 requests that people put on the table. But at this
9 point, the requests that people put on the table are
10 supposed to match the strategic plan.

11 And unless somebody walks in and says they
12 there is just not enough money to do this and we don't
13 see any way of getting that money, I would guess the
14 strategic plan is pretty much going to be what see.

15 Or if the administration changes direction.
16 But on the primary patent and trademark goals, those I
17 don't believe will change. They are both E government
18 quality and pendency.

19 MR. STIMSON: If there are going to be
20 changes I would urge, as I have in the past, urge that
21 TPAC be a part of that at an early stage.

1 MR. FRIEDMAN: One of the things that the
2 strategic thing talks about that we haven't talked
3 about today but sort of conflicts with our discussion
4 on everyone doing all goods is the whole issue of
5 paralegals and language in the strategic plan about
6 doing market sectors.

7 So explain how examining by market sectors
8 doesn't conflict --

9 MR. ANDERSON: I will address the market
10 sectors first, in this version -- the original
11 strategic plan when was published, in the trademark
12 section on examination alternatives were listed.

13 Then the agency said and we have decided to
14 adopt three tier examination. Market sectors were
15 listed as one of the alternatives, but it was not
16 adopted.

17 So the area of that document where it talks
18 about contracting out examination, other things,
19 essentially you can take your red pen and mark through
20 every one of those. Go to the next section
21 where it says and the agency decided, et cetera, and

1 that's what we're doing.

2 We are not going to market sector
3 examination. We are going to use the 3 tier
4 examination structure.

5 Now to the second question, paralegals. We
6 have had substantial feedback from both private bar and
7 internal people about the use of paralegals in the
8 examining corps. We are taking another look at how to
9 structure that.

10 I want everyone to clearly note I did not say
11 that we are not going to use paralegals. What I said
12 was we are taking another look at how to structure
13 that.

14 The one thing that has come across loud and
15 clear from both the private sector and from examiners
16 internally is when the new file comes in, they would
17 prefer that one person handle the file all the way
18 through to publication and registration or the issuance
19 of the NOA.

20 We're looking at that. We're looking at
21 alternatives to structuring the way we had originally

1 talked about. We do plan on moving to the use of
2 paralegals in the examining corps, but we won't
3 necessarily be using them as it was originally set up
4 in the strategic plan, ie. sharing examination of a
5 single file between two people.

6 MS. KANE: Could you give us some examples if
7 you have any of what you think you would be using
8 paralegals for?

9 MR. ANDERSON: An example might go like this.
10 First exam, I mean since ITU we have decided divided
11 examination into two parts.

12 First exam every case that comes in whether
13 it is IPU section 44 are used based. And in the future
14 international files goes to an examiner.

15 They do the examination they have exchanges
16 with the applicant if they make a refusal then approve
17 it for publication or the application abandons, and
18 after publication, the examiner loses jurisdiction of
19 the case.

20 The case is published for opposition and then
21 either a NOA issues or a certificate of registration

1 issues on 44 end use cases.

2 On about 65 percent of our filings are now IP
3 driven, quite a large number of those ban and a certain
4 number get statements of use on them. We could use
5 paralegals to examine statement of use, in other words
6 take the statement of use examination out of the
7 examiners job description.

8 If the paralegal saw a substantive legal
9 issue in the statement of use then it would go back to
10 the examiner who handled the case if they still happen
11 to be in the agency.

12 We would train our paralegals exactly the way
13 we currently train examiners. So they would be able to
14 spot issues, so to speak, but the bulk of the SOU cases
15 go straight to registration after the SOU is filed.

16 Another use for paralegals would be, and this
17 is something of an irritant to examiners as I
18 understand it, section 44 cases and cases that are
19 suspended pending action at the trademark trial and
20 appeal board, every six months the examiner has to go
21 out and do a suspension query on the file, and when

1 they finally get something they match it with the file
2 and goes back into examination.

3 Paralegals could do that work. Paralegal
4 already do post registration work. There is a number
5 of things that could be on the table for paralegals,
6 and I believe the job would be post registration work
7 is already done by paralegals. It's a supportive
8 position.

9 The suspended -- managing the suspended case
10 docket I'm not sure where that would fall we haven't
11 done an evaluation. It is something that a paralegal
12 could easily handle. A paralegal knows whether it is a
13 foreign certificate or not.

14 They would know if the case has been
15 terminated to trademark trial appeal board, et cetera
16 and then put it back into examination.

17 At the back end of the system filing of the
18 SOU the, the bulk of them are ready to go straight to
19 registration after the SOU is filed.

20 Would it affect the examiners job, yes,
21 absolutely would affect it.

1 But those are some alternatives to having
2 this concept of case comes in, paralegal looks at it,
3 if there is substantive legal then it goes to an
4 examiner.

5 This would just put every case in the hands
6 of the examiner at the front end of the system. There
7 would be virtually no change except for those files
8 that get suspended because trademark trial and appeal
9 board stuff or section 44 things.

10 MR. NICHOLSON: One anecdotal comment about
11 the use of the paralegals at the TTAB. I think you
12 might want to think about what you are actually doing.

13 In some cases what you might be doing is shifting
14 work.

15 In other words, it is very common if you put
16 in for a 60 day extension of time to have a paralegal
17 notice come back saying they are suspending the
18 proceeding if the word settlement happens to be in your
19 request for and extension of time.

20 And you may only want 60 days, otherwise you
21 will (inaudible).

1 But it seems to me that the paralegals are
2 trained to -- if they see the word settlement talks
3 they suspend the proceeding. That doesn't really help.

4
5 A lot of times what ends up happening is we
6 didn't file a motion to lift the suspension. You are
7 shift dating, basically the problem.

8 I'm not sure the paralegal function in that
9 particular instance is necessarily helping the
10 situation.

11 MR. ANDERSON: At the trademark conference we
12 will try to set up a program that benefit the
13 operations.

14 And we do want to try to address some of the
15 concerns that both NTU 245 has and that external
16 applicants and trademarks owners have had about moving
17 to a paralegal program, concerns about loss of
18 examination continuity and so forth.

19 As I said, this is not an alternative plan at
20 this point. I was asked for some ideas. These are
21 some ideas we have been kicking around.

1 There has been absolutely no clearance of
2 this at any level of the agency at this point, but we
3 are looking at some alternatives to what we originally
4 had on the table. In response to the concerns that
5 have been expressed by this committee and by bar
6 groups.

7 But we are committed to moving to
8 incorporating more paralegals into our examination.
9 Into trademark operations, I guess is a better way of
10 stating it.

11 MS. KANE: What is the paralegal pay
12 structure?

13 MR. ANDERSON: They can go up to a GS-11.
14 Which is where we start an examining attorney. That is
15 a starting salary for an examining attorney.

16 It is about -- probably, mid 40's or so right
17 now.

18 MS. KANE: And what do they start at? They
19 would start at the same --

20 MR. ANDERSON: Oh, no they would start at a
21 GS-9 normally, I believe. It might go 7, 9, 11, or 9,

1 11. I'm not for sure on that.

2 MR. FRIEDMAN: I know it was mentioned in Dr.
3 Rogan's letter in July of 2002 as GS-7.

4 MS. KANE: What's that payment?

5 MR. ANDERSON: GS-7 is probably starting
6 around \$30,000 I think.

7 MR. ALEXANDER: How many paralegals are you
8 thinking of?

9 MR. ANDERSON: We haven't gotten that far.
10 It would depend on what duties are assigned. It really
11 will be driven by what the paralegals are doing and the
12 volumes of work that exist.

13 MR. ALEXANDER: If the system we saw this
14 morning when the screen first came up it had all the
15 information about the application, description of
16 goods, ITU, is that all done electronically or does
17 somebody have to type that in?

18 MR. ANDERSON: No, it is done electronically.

19 I should add the screens you saw this morning, again,
20 because of the press to get this done by November 2nd,
21 because of Madrid, and to get it done by the end of

1 this fiscal year because we were so close to things,
2 there are several things that will be added to that
3 environment after November 2nd. They are
4 already on the table. We had to put priorities on
5 things, some things are not in there that we are
6 planning for the future.

7 MR. ALEXANDER: WWW.SUSSMAN will be in there?

8 MS. LOTT: It is already there.

9 MR. ANDERSON: One of the things we were
10 planning and is still on the table is to have an
11 electronic system do a preliminary search of the
12 incoming applications. We are essentially, dead on
13 sights.

14 It would compare marks and tell the examiner
15 here is a mark that exactly matches this applicant's
16 mark.

17 Then the examiner would make an evaluation
18 based on that whether it is a true dead on sight or
19 whether is a variations on the goods and services, or
20 it's owned by the same parties, stuff like that.

21 MR. ALEXANDER: Preprogrammed search?

1 MR. ANDERSON: Yes, here would be a
2 preprogram search that we plan on adding sometime after
3 November 2nd. I don't know whether it will be in
4 release two or three, but it would give the examiner a
5 heads up about potential sights.

6 MR. ALEXANDER: Would that be a PTO search,
7 search of PTO records automatically done or what?

8 MR. ANDERSON: Yes, it would be an automatic
9 search of USPTO office.

10 MR. ALEXANDER: Same mark, same class, or the
11 same phonetic marks and class?

12 MR. ANDERSON: Probably be the same mark
13 only.

14 MR. ALEXANDER: If you had a mark that was
15 very common, you might get 30 sights.

16 MR. ANDERSON: Yes, that's why we have
17 examiners. They will make the evaluation of the output
18 of the system. This is just to give the examiner a
19 heads up about dead on-sight.

20 MS. KANE: Then will the examiner decide
21 whether or not to do a fuller search?

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1 MR. ANDERSON: Yes, absolutely.

2 MS. KANE: And sometimes decide not to do it,
3 maybe?

4 MR. ANDERSON: No. The examiner would have
5 to do a search if there were a dead on sight the
6 examiner would probably end up citing that and
7 forgetting about it.

8 MR. ALEXANDER: Helps your 1.3.

9 Anything else by anyone? Other items?

10 MR. STIMSON: We are at general discussion?

11 MR. ALEXANDER: We are at general discussion.

12 MR. STIMSON: I have some remarks if its
13 appropriate now, this is my final meeting as a member
14 of the TPAC.

15 MR. ALEXANDER: Well, perhaps.

16 MR. STIMSON: I wanted to express appreciation
17 for the opportunity to serve on the TPAC. It has been
18 a very good three years. It has been a pleasure
19 working with everybody on here.

20 I think the staff, Tracy Bell, was just
21 wonderful in terms of supporting our meetings.

1 David Sams, the work I did on the
2 subcommittee on the TTAB, David and his group were
3 totally supportive and cooperative in our TTAB
4 Subcommittee.

5 Anne Chasser was always very responsive to
6 whatever we needed -- and in a very difficult position
7 she had was excellent to work with.

8 Miles Alexander as to the Chair. I have
9 worked with Miles before on numerous things. This was
10 just an unprecedented pleasure and honor to have worked
11 under your chairship of this committee. I'm just
12 amazed at the dedication and the work you did. It was
13 a real pleasure.

14 I'm very proud of the work we did over the
15 last three years. I think we showed loyalty to of our
16 mandate to representing trademark owners and showing
17 independence in representing trademark owners.

18 I think that's reflected in the annual
19 reports we put out that really identified some
20 important issues. I think it made a real contribution
21 to the trademark bar.

1 It has also been a frustrating three years in
2 many ways. I wish we had accomplished more. I don't
3 feel that we lived up to our full potential.

4 I think that is partly because it was new a
5 idea, a new committee. I think as the committee moves
6 forward and builds on the last three years, hopefully,
7 they can build on some of the things we learned from
8 that.

9 I got the feeling that often although the PTO
10 was very supportive of us, they were also
11 understandably a little bit leery about having a group
12 looking over their shoulders and giving other opinions,
13 and sometimes viewed us as a potential hindrance rather
14 than what I think we are, a real allie in a way to help
15 them do their job.

16 Suggestions for the future, I think meetings
17 like this where we do have time to discuss big issues
18 and have that opportunity have been very helpful. I
19 think this has been one on the best meetings we have
20 had.

21 It is very helpful to get materials ahead of

1 time so we have had a chance to review them rather than
2 have them wait here in the book. I think to the extent
3 we can concentrate on big issues rather than getting
4 lost in the weeds, I think that's the best use of our
5 time.

6 Finally, I think, the opportunity is to set
7 our own agenda as we see our responsibility of
8 representing trademark owners have been very helpful
9 rather than to have the agenda set forth and listen to
10 presentations.

11 All and all, it has been a wonderful three
12 years and I'm very grateful for opportunity I have had
13 to serve on TPAC. I will see all of you in
14 the future, but I will certainly miss being fellow
15 government employees.

16 MR. ALEXANDER: David, thank you, you are
17 eloquent as always.

18 MR. NICHOLSON: Let me very briefly echo
19 those comments. I'm also rotation off and it has been
20 a wonderful experience.

21 I have gained an great insight into how the

1 PTO works, gained an appreciation, I think, for the
2 dedication of a lot of people that before being on
3 TPAC, I hardly knew what they did or who they were.

4 I'm really impressed by the way this
5 organization is run. I especially want to thank Miles,
6 for his leadership. This has been a new committee that
7 no one really knew how it would be run and what its
8 mandate was originally.

9 I think it has been lead in an extremely
10 effective manner. Thank you, Miles.

11 MR.ALEXANDER: Thank you. Just a couple
12 comments. First, I have never had an opportunity to
13 see the USPTO up close it is a group of very dedicated
14 people. We were able to appreciate that by watching
15 everyone. It was a very difficult time for the USPTO
16 with the RIF. I was impressed by the civility of both
17 management and labor.

18 Howard, I particularly thank you for
19 conducting yourself in the manner that was always
20 constructive in supporting your union as your
21 colleagues did, and never as an obstructionist in

1 connection with the TPAC meetings. Certainly we found
2 you a great source of information.

3 Anne, as our leader has always been a person
4 behind the scenes that has provided us with whatever we
5 have asked for. I have never felt that somebody was
6 hiding the ball from us. And I'm sure other people
7 dealing with different aspects of the office may have
8 felt that way.

9 But I don't think this group has ever felt
10 that way. I pay tribute to Bob and others who is the
11 quintessential government servant, who we could ask no
12 more from and gives much more than anybody has a right
13 to expect.

14 And to all of you that have shared your
15 expertise with us and dealt with an Octogenarian
16 curmudgeon with a warped sense of humor with tolerance.

17 I appreciate that. That being said, I
18 truly appreciate the privilege of having worked with
19 you. I thank you all, with that unless --

20 MS. CHASSER: I have something to say.

21 I just want to -- you know, Miles is a man of

1 many awards and recognitions for his illustrious career
2 in trademarks and the law. We have a very small token
3 of our appreciation. After you open it I'm going to
4 tell you why we selected this small token.

5 MR. ALEXANDER: I hope it is not X rated
6 videos.

7 MR. PRICE: Could you tell me what it is?

8 MS. CHASSER: I wanted to present Miles with
9 a memento of his term here as chairman of the TPAC. I
10 was wandering through our gift shop, our very
11 impressive gift shop for those of you who have not been
12 down there, there is a whole bunch of interesting
13 things down there. I came across this gift that Miles
14 is opening.

15 I have been in Miles office and his office is
16 mostly pictures of his family. So I wanted to give you
17 something you will put on your bookshelf along with
18 pictures of your family.

19 MR. ALEXANDER: I have picture of you in my
20 massage chair which is --

21 MS. CHASSER: So this is a (inaudible) and

1 the reason there are many similarities, I thought.

2 MR. ALEXANDER: A Republican statue for
3 Atlanta, Georgia.

4 MS. CHASSER: And you know, Abraham Lincoln
5 was the only President that actually has a patent
6 issued in his name for a shale, a voting device. He
7 received a patent for it.

8 Also I think there is a number of
9 similarities and connections between Abraham Lincoln
10 and our esteemed Chair, Miles Alexander.

11 You all know that Miles has been a pioneer in
12 a alternative dispute resolution and mediation, and
13 intellectual property cases, and Lincoln was a big
14 believer in avoiding litigation.

15 I just happen to be reading his famous notes
16 of a law lecture just the other night before I went to
17 sleep.

18 Lincoln did say that you should discourage
19 litigation and persuade your neighbors to compromise
20 whenever possible, and to point out to them how the
21 nominal winner is often the loser because of expensive

1 costs, expenses and a waste of time, and that as a
2 peacemaker the lawyer has a superior opportunity of
3 being a good man and that should be business enough.

4 Lincoln also, while he was a proponent of
5 mediation and avoiding litigation was a great litigator
6 as you all know. He was one of America's famous
7 litigators, and Miles likewise is well-known for his
8 expert litigation skills, representing a number of the
9 Fortune 100 companies, I'm sure, in trademarks
10 disputes. Also, miles started his career as

11 a judge advocate in the Air Force way back, huh?

12 MR. ALEXANDER: 1955.

13 MS. CHASSER: And Lincoln was the presiding
14 Judge in the civil war court-martials. He is famous
15 for his ground breaking work in the field of military
16 justice.

17 I think the thing that captures the essence
18 of you, Miles, and also something that Lincoln is
19 quoted as saying is that the leading role for a lawyer
20 as for every man of every calling is diligence.

21 Leave nothing until tomorrow that could be

1 done today. I think that aptly describes your
2 leadership of the TPAC, leaving no stone unplanned much
3 to my chagrin at times, I might add, but I think your
4 leadership, your diligent leadership of the TPAC and
5 the immense hard work and dedication you have certainly
6 left nothing for tomorrow, although I'm sure we'll find
7 more stones unplanned.

8 So on behalf of the USPTO and on behalf of
9 everyone in the trademark operation, we want to thank
10 you for serving as the inaugural chair of the trademark
11 public advisory committee. Thank you very much.

12 MR. ALEXANDER: Thank you so much, everybody.

13 I have served as general counsel under David, and Kim,
14 and Anne, all who were president of the INTA. I will
15 close on the record with a quintessential Alexanderism.

16 Anne, I'm going to find you something to
17 do that is better than reading Lincoln before going to
18 bed.

19
20 - - -

21 [Whereupon, at 5:30 p.m., the

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meeting concluded.]

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FRANCES M. FREEMAN

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