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September 13, 2011

The Honorable David Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Cynthia C. Lynch, Commissioner for Trademarks
Administrator for Trademark Policy & Procedure, USPTO

Re: Comments on *Proposed Rule, 76 FR 40839*
Changes in Requirements for Specimens and for Affidavits or
Declarations of Continued Use or Excusable Nonuse in
Trademark Cases

Dear Under Secretary Kappos:

We are writing on behalf of the American Bar Association Section of Intellectual Property Law (the "Section") to provide comments in response to the United States Patent and Trademark Office's (the "Office") invitation for public comment on the *Proposed Rule re: Changes in Requirements for Specimens and for Affidavits or Declarations of Continued Use or Excusable Nonuse in Trademark Cases, 76 Fed. Reg. 40839 (PTO-T-2010-0073, July 12, 2011)*. These comments have not been approved by the American Bar Association's House of Delegates or Board of Governors and should not be considered to be views of the American Bar Association.

The Section appreciates the Office's request for comment from stakeholders on whether and to what extent the Office should amend and revise the Trademark Rules of Practice, and the Rules of Practice for Filings Pursuant to the Madrid Protocol, in order to allow for the collection of additional affidavits, declarations, exhibits, statements of use, and other evidence and information related to allegations of use of a mark, continued use, excusable nonuse, and/or amendments to a registered mark (the "Proposed Rules").

In general, the Section supports the Office's goal to improve the accuracy of the trademark registry, and appreciates the presumed benefit to the public of records that more precisely reflect the marks used in commerce and the goods and services actually associated with those marks. However, the Section cannot endorse the Office's Proposed Rules as currently set forth due to, among other things, the lack of clarity around (i) whether registrants will face additional fees and surcharges for supplemental filings when required by an Examining Attorney; and (ii) the criteria specifying exactly when an Examining Attorney might request additional specimens or evidence. Furthermore, the Section is concerned that as a consequence, the only way a registrant might mitigate these concerns is to preemptively submit additional specimens, needlessly burdening both the registrant and the Office.

The Section's first concern stems from the significant differences, especially in regard to timing, between the initial application process and post-registration filings. During the application process, for example, an Examining Attorney can request additional specimens through an initial Office Action, followed by a final refusal if the applicant does not submit new or additional specimens by the given deadline, and the applicant has opportunities to seek reconsideration or to appeal the Examining Attorney's decision. Importantly, all of these exchanges occur before any mark is placed on the register and none of the responses or refusals carry additional filing fees.

However, post-registration filings generally do not involve the same back-and-forth exchanges between the registrant and the Office, and a post-registration filing is either complete as submitted, or deficient for reasons the registrant typically should have known at the time of submission. Accordingly, the deadline for a registrant to address deficient filings is pegged to the original filing deadline, and a deficiency charge is imposed if the correction is made beyond this period. The Proposed Rules are problematic because, as written, it is not clear whether a response to an Examining Attorney's request for additional evidence must be completed according to this same timeline or if an extension would be given. The registrant may have to pay a deficiency surcharge for a deficiency that did not exist until the Examining Attorney's discretionary request, as the Proposed Rules allow an Examining Attorney to request additional evidence for reasons that the registrant could never have predicted.

The Section's second concern regards the lack of specific criteria or guidelines to signal when a registrant might expect a request for additional evidence or specimens. The vague and discretionary nature of the Proposed Rules hampers their effectiveness as a means to maintain the accuracy and integrity of the register. For example, a third party checking a registration that lacks multiple specimens to

support its renewal would have no way of knowing the reason why the Examining Attorney had not requested more specimens. This would lead to increased confusion among those checking the register and in fact be detrimental to the Office's purported goal.

The Section's final concern is that the lack of clarity as to when an Examining Attorney will request additional samples leaves registrants with only one viable option – to “err on the side of caution,” and present additional specimens even in cases when only one would have been sufficient. This practice will needlessly overburden the Office as Examining Attorney's will need to coordinate how the additional (but unnecessary) specimens relate to goods and services described in the registration. This lack of clarity will increase the burden on both registrants (in needlessly making additional filings) and the Office in what is currently a fairly routine submission.

Conclusion

The Section commends the Office for its thought and effort in attempting to improve the accuracy of the registry and appreciates the opportunity to offer comment, but cannot endorse the rules as currently proposed.

Very truly yours,



Robert A. Armitage
Section Chair
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Section of Intellectual Property Law