



VIA EMAIL ONLY <via Federal eRulemaking Portal at <http://www.regulations.gov> >
cc: TMFRNotices@uspto.gov

Ms. Jennifer Chicoski
Commissioner for Trademarks
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451
TMFRNotices@uspto.gov

Re: Changes in Requirements for Affidavits or Declarations of Use, Continued Use, or Excusable Nonuse in Trademark Cases

Dear Ms. Chicoski:

Microsoft Corporation (“Microsoft”) welcomes this opportunity to provide its comments to the United States Patent & Trademark Office (“USPTO”) on the proposed changes in Requirements for Affidavits or Declarations of Use, Continued Use or Excusable Nonuse in Trademark Cases (“Proposed Changes”).¹ While Microsoft supports the stated goals set forth in the Proposed Changes and the proposed audit program (“Proposed Audit”) in principle, Microsoft is concerned that (a) the amendments proposed by the USPTO are both vague and unnecessarily broad to meet those goals, and (b) insufficient details are provided with respect to the implementation of the Proposed Audit to comprehensively assess the program, its impact or likely effectiveness.

Microsoft is a worldwide leader in the IT industry and its mission is to enable people and businesses throughout the world to realize their full potential. Since the company was founded in 1975, it has worked to achieve this mission by creating technology that transforms the way people work, play, and communicate. Microsoft is also an owner and champion of intellectual property rights. It maintains sizable trademark and domain name portfolios and takes pride in the worldwide recognition of many of its trademarks. Microsoft’s trademark portfolio is truly global in nature. In the United States alone, Microsoft has over 800 trademark applications and registrations as of the date of this letter.

With respect to the Proposed Changes, Microsoft has the following comments:

Microsoft supports the stated goals of the Proposed Changes, *i.e.* “verify[ing] the accuracy of claims that a trademark is in use in connection with the goods/services listed in the

¹ Federal Register Vol. 81, No. 120 (“Federal Register”), pp. 40589-594.

Microsoft supports the stated goals of the Proposed Changes, *i.e.* “verify[ing] the accuracy of claims that a trademark is in use in connection with the goods/services listed in the registration.”² Encouraging accuracy in the identification of goods and services for which use or continued use is claimed furthers the underlying purpose of 37 C.F.R. §§2.161 and 7.37 “to remove from the register those registrations that have become deadwood.”³ Moreover, a more accurate registry will benefit the public insofar as the removal of deadwood will enable individuals and companies to more accurately evaluate the availability of trademarks and discourage frivolous disputes based on trademarks that have been abandoned with respect to some or all of the goods and/or services listed on an active registration. Microsoft further believes that the random audit as described in the Proposed Changes (“Proposed Audit”) is, in principle, an acceptable approach to accomplishing these goals. In particular, Microsoft supports the implementation of the Proposed Audit based on the approach taken in the post registration proof-of-use pilot program (“Pilot Program”), whereby registrants selected at random were required to (a) produce proof of current use equivalent to additional specimens for one or two specific goods/services listed in the registration⁴; and (b) submit a statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20, that the proof of use “was in use in commerce during the relevant period for filing the 6-year Section [8/71].”

Microsoft is concerned, however, that the proposed amendments to 37 C.F.R. §§2.161 and 7.37 are vague and unnecessarily open ended, and also that the Proposed Audit is insufficiently described in the Proposed Changes to properly assess the likely impact and effectiveness of the program towards meeting the stated goals. Microsoft therefore recommends the following modifications to the Proposed Changes:

I. Suggested Revisions to Proposed Amendments

The USPTO has proposed amending paragraph (h) of 37 C.F.R. §§2.161 and 7.37 , respectively, as follows:

(h) The Office may require the owner to furnish such information, exhibits, affidavits or declarations, and such additional specimens as may be reasonably necessary to the proper examination of the affidavit or declaration under section [8/71] of the Act or for the Office to assess and promote the accuracy and integrity of the register.

As background, the USPTO initially added the following language to 37 C.F.R. §§2.161 and 7.37 prior to the launch of the Pilot Program in 2012 (“2012 Amendments”):

(g) ... When requested by the Office, additional specimens must be provided.

² Federal Register, p. 40590.

³ T.M.E.P. §§ 1604.11, 1613.11, *citing See Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (C.C.P.A. 1969).

⁴ Quoting from an example Post Registration Office Action issued during the Pilot Program: “To demonstrate acceptable proof of use for goods, the owner must submit photographs that show the mark on the actual goods or packaging, or photographs of displays associated with the actual goods at their point of sale. Acceptable proof of use for services includes signs, photographs, brochures, website printouts or advertisements that show the mark used in the actual sale or advertising of the services.”

(h) The Office may require the owner to furnish such information, exhibits, affidavits or declarations, and such additional specimens: (1) As may be reasonably necessary to the proper examination of the affidavit or declaration under section 8 of the Act; or (2) For the Office to assess the accuracy and integrity of the register. (3) The provisions of paragraph (h)(2) of this section will no longer be applied after June 21, 2014.

The USPTO described these provisions as “corollaries to Sec. 2.61(b), which currently allows the USPTO to require additional information or exhibits in connection with the examination of a pending application”⁵ (emphasis added). Pursuant to paragraph (h)(3), the language in paragraph (h)(2) was removed after the expiration of the Pilot Program in 2014, whereas the other provisions added in the 2012 Amendments remained.

Microsoft is concerned that the current language of 37 C.F.R. §§2.161 and 7.37, specifically with respect to the remaining provisions included in the 2012 Amendments, is vague with respect to the “additional proof of use” the USPTO may request under the Proposed Audit. Whereas the type of “additional proof of use” required under the Pilot Program was the equivalent of a specimen already required with a Section 8/71 declaration, the current language of 37 C.F.R. §§2.161 and 7.37 potentially contemplates the request for additional “information [and] exhibits” comparable to requests made by examining attorneys during the examination of applications.⁶ Such requests for information or exhibits beyond “proof of use” comparable to a specimen suitable for a Section 8/71 declaration of use potentially conflicts with the guideline set forth in the T.M.E.P. that “[t]he propriety of the original registration [shall] not [be] re-examined in connection with the affidavit or declaration under §8 / §71.”⁷ Re-examination of a registration beyond requesting “additional proof of use” has at least the potential to undermine the legal presumption of a registration’s validity and the registrant’s ownership of the mark therein per 15 U.S.C. §§1057(b) and 1115(a). At the very least, requiring registrants to provide “information [or] exhibits” beyond proof of use comparable to additional specimens may impose an undue burden beyond that imposed under the Pilot Program or contemplated under the Proposed Changes.

Microsoft therefore proposes the following amendments to paragraph (h) of 37 C.F.R. §§2.161 and 7.37 to conform with goals set forth in the Proposed Changes as well as the model provided by the Pilot Program:

(h) The Office may require the owner to furnish (1) such information, exhibits, affidavits or declarations, and such additional specimens as may be reasonably necessary to the proper examination of the affidavit or declaration under section [8/71] of the Act; and/or (2) such additional specimens, and supporting affidavits or declarations, reasonably necessary to verify the accuracy of claims that a trademark is in use in commerce on or in connection with the goods/services identified in the registration.

Microsoft believes these amendments further the USPTO’s stated goals while addressing the vagueness and uncertain scope of the provisions introduced by the 2012 Amendments.

⁵ Federal Register Volume 77, Number 99 (Tuesday, May 22, 2012), p. 30201.

⁶ See *id.*, pp. 30200-201.

⁷ TMEP §§1604.15, 1613.15.

The Proposed Changes provide limited details on the implementation of the Proposed Audit, making it difficult for the public to properly assess the likely impact and effectiveness of the program. For example, as discussed above, it is unclear whether the USPTO will require “additional proof of use” that is comparable to a specimen as described in 37 C.F.R. §2.56, or additional “information [or] exhibits” comparable to materials sometimes required by examining attorneys during the examination stage. The Proposed Changes also provide few details on the process for selecting registrants to audit, or the timing of the issuance of Office Actions under the Proposed Audit.

Microsoft therefore respectfully requests that the USPTO release additional details for the implementation of the Proposed Audit in the form of proposed amendments to the T.M.E.P. for public comment. Ideally, the proposed amendments will set forth in detail the specific means by which registrations will be selected at random, the “additional proof of use” to be required (to be consistent with the suggested amendment regulatory language above), and the timing for the registrant to respond and establish proof of use (*e.g.* whether the proof of use must have been in use by registrant within the statutory period to file the Section 8/71 declaration of use, even if the Office Action issues after the statutory period has passed). Furthermore, Microsoft recommends that the proposed amendments guide the examining attorney to conform the review of the “additional proof of use” to the guidelines currently set forth in TMEP §§1604.15 and 1613.15, expressly prohibiting the “re-examin[ation]” of the underlying registration.

Should the USPTO release such draft amendments to the T.M.E.P., Microsoft reserves the right to submit additional comments upon review thereof.

Thank you for your consideration. If you have any questions or wish to discuss any of the points raised herein, please feel free to contact me at elenagri@microsoft.com.

Respectfully submitted,



Elena Grimme

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Microsoft Corporation