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Via electronic mail
TMFRNotices@uspto.gov

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

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

Re: *Comments on Proposed Rule Amending the Trademark
Rules of Practice and the Rules of Practice in Filings
Pursuant to the Protocol Relating to the Madrid Agreement
Concerning the International Registration of Marks.*

Dear Ms. Lynch:

We write 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 Amending the Trademark Rules of Practice and the Rules of Practice in Filings Pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (the "Request for Comments"). The views expressed herein are presented on behalf of the Section of Intellectual Property Law. They have not been approved by the House of Delegates or the Board of Governors of the American Bar Association and, accordingly, should not be construed as representing the position of the Association.

The Section appreciates the Office's inquiry to stakeholders on whether changes should be made to the Trademark Rules of Practice and the Rules of Practice in Filings Pursuant to the Protocol Relating to the Madrid Agreement (the "Request for Comments"). As summarized in the Request for Comments, the Office proposes to amend the stated rules to benefit the public by providing greater clarity as to certain requirements relating to representation before the Office, applications for registration, examination procedures, amendment of applications, publication and post publication procedures, appeals, petitions, post registration practice, correspondence in trademark cases, classification of goods, services, and procedures under the Madrid Protocol. For ease of reference, a summary of all proposed rule changes has been included in the attached Appendix A.

The Section understands, as the Request for Comments states, that most of the rule changes proposed by the Office are intended to codify existing practice. Many of the changes are meant to be consistent with existing TMEP sections, particularly the changes made to Part 2. Other minor changes are meant to be consistent with headings (e.g. the change to §6.1(5)). Finally, the changes in Part 7 are meant to conform to the Madrid Protocol. To the extent the proposed changes are consistent with the Office’s stated purpose, they appear to be reasonable and the Section generally favors them. However, the Section would like to take this opportunity to provide some additional comments.

Practical Changes.

The Section agrees that several proposed rule changes are justified for practical reasons. Some of the changes are intended to “streamline” the application process and make it more efficient. In particular, the Section approves of the following such changes:

- §2.22(a)(19), providing that if a TEAS Plus applicant owns one or more registrations for the same mark shown in the application, and the last listed owner of the prior registration(s) differs from the owner of the application, the application must include a claim of ownership for the prior registration(s) in order to be entitled to the reduced filing fee.
- §2.38(b), remove application requirement to indicate related companies’ use.
- §2.62(c), responses must be submitted through TEAS, fax, mail, by hand. No emails.

Changes Relating to Examination of Applications.

The proposed rule changes in §2.63 are intended to clarify the purpose of the rule, the requirements for responding to initial Office Actions, when an applicant can request reconsideration of a final action, when an appeal can be filed, and the consequences of not filing a timely appeal. The Section believes that the proposed rule changes make these rules more consistent with existing practice. To that end, the Section approves the rules, and in particular the following:

- §2.63, modifies the title from “Reexamination” to “Action after response,” to incorporate a discussion of reexamination, the filing of petitions, appeals, and abandonments.
- § 2.63(a), clarifies that after submission, the examining attorney will review all statutory refusal(s) and/or requirement(s) in light of the response.
- §2.63(a)(1), adds that applicant may respond after a non-final action that maintains any requirement(s) or substantive refusal(s) to the examiner’s action.
- §2.63(a)(2), according to (a)(1), applicant files a petition to the Director if appropriate for petition. If denied, applicant has 6 months from Office action that repeated the requirements or 30 days from the date of the decision on the petition to comply with repeated requirements.
- §2.63(b)(1), adds that applicant may respond to a final action by filing an appeal.

- §2.63(b)(2), adds that the applicant may respond to a final action that withdraws all substantive refusals, but maintains any requirement(s) either by filing an appeal or filing a petition to the Director.
- §2.63(b)(3), adds that applicant can file a request for reconsideration of the final action prior to the expiration of the time for filing an appeal or a petition to the Director.
- §2.63(b)(4), adds that the filing of a request for reconsideration that does not result in the withdrawal of all refusals and requirements, without the filing of a timely appeal or petition, will result in abandonment of the application for incomplete response.
- §2.63(c), adds that if a petition to the Director is denied, the applicant will have six months from the date of issuance or 30 days from the date of decision to comply with the requirements and that a requirement subject to petition may not be subject of an appeal.
- §2.63(d), adds that if an amendment is filed during the six-month response period after issuance of a final action, the examining attorney will examine the amendment, but the filing of the amendment does not stay or extend the time for filing an appeal.

The Section believes that any opportunity to make the rules of practice more consistent, as applied to all applicants, and thus more equitable, is appreciated.

Changes Relating to Applicants' Responses to Office Actions.

Some of the proposed rule changes appear to reaffirm and further clarify the applicant's requirement to timely respond to Office Actions and requests for Statements of Use. Missing those deadlines renders applications abandoned. The Section approves, in particular, the following:

- §2.65(a), if the applicant fails to respond or respond completely within six months to an office action, it is abandoned.
- §2.65(a)(1), adds that if applicant fails to timely respond, but all refusals or requirements are expressly limited to certain goods or services, the application is abandoned only to those goods and services.
- §2.65(a)(2), adds that an applicant may be granted 30 days, or to the end of the response period stated in the action, whichever is longer, to provide information omitted from a response before the examining attorney considers the issue of abandonment.
- §2.65(b) clarifies that an application will be abandoned if an applicant expressly abandons the application.
- §2.65(c), adds if the applicant fails to file a timely Statement of Use, then the application is considered abandoned.

While §2.65(a)(2) may lengthen the process by an additional 30-day period, the Section believes this modified rule brings these rules into alignment with TMEP rules of practice, as they apply to U.S. applicants, and ultimately makes the process more efficient. The Section also approves proposed §2.77(b), which provides that amendments not listed in §2.77(a) may be entered in the application in the time period between issuance of the notice of allowance and submission of a Statement of Use only with the express permission of the Director, after consideration on petition

under §2.146. Any extension of time that is not reasonable causes an undue burden on the system, requiring added time for re-review of an application. The Section approves the requirement of express permission to make such an amendment.

Changes Relating to Abandonment and Withdrawal.

The Office proposes to revise §2.68(a) to indicate that a request for abandonment or withdrawal may not subsequently be withdrawn. This is consistent with the TMEP, and we agree with its intended purpose to provide applicants, registration owners, and the public assurance of the accuracy of the status of applications or registrations after filings are received by the Office.

Changes Relating to Post-Registration.

The Section approves the rule changes regarding post-registration, such as §2.172, which requires that a surrender for cancellation may not subsequently be withdrawn. We find this consistent with existing practice. The Section also agrees with the proposed revision to §2.185(a) to indicate that deficiencies in renewal applications may be corrected after notification from the Office. This is also consistent with existing practice.

Changes Relating to Madrid Protocol.

The Office proposes to revise §7.11(a)(3)(ii) which would clarify that if a mark includes a color claim, an international application filed on paper requires both color and black-and-white reproductions, but an electronically-filed application requires only a color reproduction. The Section agrees with this proposed rule because it is consistent with existing practice, as the WIPO paper application form requires the applicant to submit both black-and-white and color reproductions of the mark, while TEAS requires only that the applicant submit a color reproduction of the mark.

The Office proposes to revise §7.23(a)(5) to require that a request to record an assignment of an international registration submitted through the Office must include a statement that, after making a good faith effort, the assignee could not obtain the assignor's signature for the request to record the assignment. This proposed rule is meant to ensure that an assignee make a good-faith effort to obtain the assignor's signature, before invoking this rule and requesting the Office to forward the assignment document to WIPO. The Section approves this proposed revision, because it places the burden of due diligence on the assignee, where it belongs, therefore making the process more efficient.

The Office proposes to revise §7.23(a)(6) to indicate that a request to record an assignment of an international registration, submitted through the Office, must include an indication that the assignment applies to the designation to the U.S. or an international registration that was originally based on a U.S. application or registration. The Section approves this proposed rule change, because this revision is intended to ensure that an assignee of an international registration based on a U.S. registration or application is treated the same as an assignee of a designation to the U.S. Under current practice, the owner of the international registration based on a U.S. registration or application must file a petition to waive this subsection of the rule.

Conclusion.

In conclusion, the Section supports the goals of increasing clarity and streamlining the application process. Further we feel that these proposed rules do not create unnecessary burdens on applicants. To that end, the Section of Intellectual Property of the American Bar Association commends the Office for its consideration of these issues and appreciates the opportunity to offer comments, and we approve the proposed changes *Amending the Trademark Rules of Practice and the Rules of Practice in Filings Pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*.

Very truly yours,



Robert O. Lindefjeld
Section Chair
American Bar Association
Section of Intellectual Property Law

Enclosure

Appendix A

Summary of Proposed Rule Changes:

- The Office proposes to revise the rules in parts 2, 6, and 7 of title 37 of the Code of Federal Regulations in the following ways (not including typographical reference changes):
 - § 2.17(d)(1), remove reference to the number of power of attorneys that can be filed via TEAS
 - § 2.22(a)(19), providing that if a TEAS Plus applicant owns one or more registrations for the same mark shown in the application, and the last listed owner of the prior registration(s) differs from the owner of the application, the application must include a claim of ownership for the prior registration(s) in order to be entitled to the reduced filing fee.
 - § 2.36, indicating that an applicant is only required to claim ownership of prior registrations for the same or similar marks if the owner listed in the application differs from the owner last listed in the Office's database for such prior registrations
 - § 2.38(b), remove application requirement to indicate related companies' use.
 - § 2.62(c), responses must be submitted through TEAS, fax, mail, by hand. No emails.
 - § 2.63(a), clarifying that after submission, the examining attorney will review all stat. refusal(s) and/or requirement(s) in light of the response.
 - § 2.63(a)(1), adding that applicant may respond after a non-final action that maintains any requirement(s) or substantive refusal(s) to the examiner's action.
 - § 2.63(a)(2), according to (a)(1), applicant files a petition to the Director if appropriate for petition. If denied, applicant has 6 months from Office action that repeated the requirements or 30 days from the date of the decision on the petition to comply with repeated requirements.
 - § 2.63(b), clarifying examining attorney can make final a refusal or requirement upon review of a response or request for reconsideration.
 - § 2.63(b)(1), adding that applicant may respond to a final action by filing an appeal.
 - § 2.63(b)(2), adding that the applicant may respond to a final action that withdraws all substantive refusals, but maintains any requirement(s) either by filing an appeal or filing a petition to the Director.
 - § 2.63(b)(3), adding that applicant can file a request for reconsideration of the final action prior to the expiration of the time for filing an appeal or a petition to the Director.
 - § 2.63(b)(4), adding that the filing of a request for reconsideration that does not result in the withdrawal of all refusals and requirements, without the filing of a timely appeal or petition, will result in abandonment of the application for incomplete response.
 - § 2.63(c), adding that if a petition to the Director is denied, the application will have 6 months from the date of issuance or 30 days from the date of decisions to

- comply with the requirements and that a requirement subject to petition may not be subject of an appeal.
- § 2.63(d), adding that if an amendment is filed during the six-month response period after issuance of a final action, the examining attorney will examine the amendment, but the filing of the amendment does not stay or extend the time for filing an appeal.
 - Remove and reserve § 2.64 and incorporate updated final action procedures into proposed revised §2.63.
 - § 2.65(a), if the applicant fails to respond or respond completely within 6 months to an office action, it is abandoned.
 - § 2.65(a)(1), adding that if applicant fails to timely respond, but all refusals or requirements are expressly limited to certain goods or services, the application is abandoned only to those goods and services.
 - § 2.65(a)(2), adding that an applicant may be granted 30 days to provide information omitted from a response before it is considered abandoned.
 - § 2.65(b), applicant expressly abandons the application, and then it is abandoned.
 - § 2.65(c), if the applicant fails to file a timely statement of use under § 2.88 or 2.89, then it is considered abandoned.
 - § 2.68(a), a request for abandonment or withdrawal may not subsequently be withdrawn.
 - § 2.77(b), only with the express permission of the Director, amendments not listed in §2.77(a) may be entered in the application in the time period between issuance of the notice of allowance and submission of a statement of use.
 - § 2.81(b), removing the list of items that will be included on the notice of allowance.
 - § 2.84(b), between the time from a published mark for opposition and before certification of a mark, the application may be amended if it is not before the TTAB.
 - § 2.145(a), adding registrants who have filed an affidavit or declaration and are dissatisfied with a decision of the Director to the list of parties eligible of the Director to the list of parties eligible to appeal to the federal circuit.
 - § 2.172, surrender for cancellation may not subsequently be withdrawn.
 - § 2.185(a), indicating that deficiencies in renewal applications may be corrected after notification from the Office.
 - § 2.198(a)(1), adding § 2.198(a)(1)(viii) to include affidavits in the list of documents excluded from the Office’s Express Mail procedure.
 - § 6.1(5), adding “or veterinary” to the entry “dietetic food and substances adapted for medical use.”
 - § 7.11(a)(3)(ii), if the mark includes a color claim, an International application filed on paper requires both color and black and white reproductions, but an electronically filed application just needs a color reproduction.
 - § 7.23(a)(5), requiring that a request to record an international application submitted through the office includes a statement that, after a good faith effort, assignee could not obtain the assignor’s signature.

- § 7.23(a)(6), adding that a request to record an assignment of an international registration through the Office must include an indication that the assignment applies to the United States.
- § 7.24 (b)(5)(ii), requiring that a request, through the Office, to record a restriction or the release of a restriction as a result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal must include a statement indicating that, after making a good faith effort, the signature of the holder of the international registration could not be obtained.
- § 7.24(b)(7), indicating that a request to record a restriction, or the release of a restriction must include an indication that it applies to the United States.
- § 7.31, requiring that a request to the United States into a US Application specify the goods and/or services to be transformed.