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Milbank, Tweed, Hadley & McCloy, LLP

Executive Director
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September 23, 2011

The Honorable Deborah Cohn
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1450
Attn: Cynthia C. Lynch

Submitted via email: TMFRNotices@uspto.gov

Re: IPO Comments on “Changes in Requirements for Specimens and for Affidavits or Declarations of Continued Use or Excusable Nonuse in Trademark Cases” 76 Fed. Reg. 40839 (July 12, 2011)

Dear Commissioner Cohn:

Intellectual Property Owners Association (IPO) is pleased that the USPTO is addressing the issue of inaccuracies in trademark registrations that may exist due to trademark owners claiming that the mark is in use in commerce on goods and/or services when it is not (hereinafter referred to as “over-claiming”). An IPO representative participated in the April 26, 2010 Roundtable on the topic of “The Future of the Use-Based Register” and its brainstorming session, and other IPO members attended the session.

IPO is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO’s membership includes more than 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as IPO inventor, author, executive, law firm or attorney members.

The Summary of the Proposed Rules states that a purpose of the rule-making is to “determine whether and to what extent a general problem may exist, and consider measures to address it, if necessary.” 76 Fed. Reg. 40839. IPO supports gathering information that is more than anecdotal in nature to determine whether and to what extent a general problem of over-claiming may exist.

However, as currently drafted, the Proposed Rules are much broader than the information gathering objectives of the notice. They would empower the USPTO to immediately require additional evidence of use in all cases. IPO acknowledges that the Supplementary Information includes a statement that the USPTO “currently has no plans to implement such requirements in all cases, and instead is likely to apply the rules in a ‘small subset of cases.’” 76 Fed. Reg. 40840. However, this intention is not reflected in the Proposed Rules. We believe that the goals of determining the extent of the problem and adopting measures to address it can be achieved with less sweeping changes than those contemplated by the Proposed Rules and in a manner that may be

more consistent with the intention to invoke the additional requirements in only a “small subset of cases”. Therefore, while IPO supports the goals that the rule-making exercise seeks to achieve, it does not support the Proposed Rules in their entirety, as discussed below.

Pre-Registration

Existing rules already give the USPTO adequate regulatory authority to require additional information and exhibits to aid proper examination of the application. Rule 2.61(b) provides that “[t]he examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application.” This rule would seem to encompass requirements for additional evidence of use of the mark in connection with more goods and services in the application than the item identified in a single specimen. With appropriate training, it seems likely that the Trademark Examination Operation could deploy this rule in a manner that is designed both to gather relevant information about over-claiming, and to aid in reducing the instance of over-claiming by use-based applicants. In particular, the USPTO would seem to be able to require additional evidence of use of the mark on more goods/services (whether in the form of additional formal specimens of use, or otherwise).

The Proposed Rules would amend Rule 2.61(b) to read “[t]he [Office] may require the applicant to furnish such information and exhibits, and affidavits or declarations, as may be reasonably necessary to the proper examination of the application, or for the Office to assess the accuracy and integrity of the register” (new language underlined). It is not clear why the language about “affidavits and declarations” is included. Does the USPTO believe that it does not presently have sufficient authority to require that information and exhibits requested under this rule be accompanied with an affidavit or declaration? Absent such a determination, this aspect of the proposed rule change seems unnecessary.

With respect to the proposed new language at the end of Rule 2.61(b), to add the words “for the Office to assess the accuracy and integrity of the register,” it is unclear why this would be necessary considering the already-broad authority for the Office to make queries “as may be reasonably necessary to the proper examination of the application.” Does the USPTO intend to undertake such inquiries about the accuracy and integrity of the register outside the framework of the examination of the application? IPO would appreciate clarification of this aspect of the Proposed Rule.

For the reasons outlined above, IPO does not support the changes proposed for the pre-examination rules 2.34, 2.56, 2.61, 2.76, 2.86, or 2.88.

Post-Registration

IPO supports implementation of a “counterpart” rule to 2.61(b) that would apply to post-registration examination of claims of use in commerce in maintenance filings under Sections 8 and Section 71 of the Trademark Act. These maintenance filings mark the first time that owners of some registrations (those that issue under Sections 44 and 66 of the Trademark Act) are required to submit a claim of use of the mark. Such claims should be capable of being examined under a similar standard as that applied to owners of use-based applications.

IPO does not support the proposed changes to rules 2.161(g) and 7.37(g). IPO would support Proposed Rule 2.161(h) and 7.37(h) solely to the extent that they conform to existing rule 2.61(b).

Specimens of Use

Requiring that evidence of use of a mark be submitted as a formal specimen is not necessary to ensure proper examination of claims of use and to assess the possibility of over-claiming. In the experience of IPO members, specimens of use are sometimes subjected to rigorous examination as to their technical sufficiency, despite guidance from the Trademark Trial and Appeal Board that a more liberal standard should be applied. See *In re Big Pig, Inc.*, 81 USPQ2d 1436, 1440 (TTAB 2006), *In re Royal BodyCare, Inc.*, 83 USPQ2d 1564 (TTAB 2007); *In re 1175856 Ontario Ltd.*, 81 USPQ2d 1446 (TTAB 2006); cf. *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856 (TTAB 2007). Goods/services should not necessarily be considered improperly included in a claim of use simply because specimens of use fail to satisfy rigorous formal requirements as to their sufficiency.

Consequences of Failure to Provide Requested Information

The Supplementary Information that accompanies the proposed rules addresses the consequences of failure to file a response to a request for additional information. 76 Fed. Reg. 40840. If a response is filed but fails to include the required specimens or evidence, the USPTO may deem the Section 8 affidavit unacceptable as to the goods/services for which the requirement pertained and delete them from the registration, or in the case of all goods/services, cancel the registration in its entirety. IPO believes that failure to provide the requested information as to only a portion of the goods/services should not result in cancellation of the entire registration.

Registrants may decline to respond to the request for information for reasons other than over-claiming. Gathering information as to some or all of the goods/services may be burdensome and costly. Registrants may conclude that sufficient protection for the mark is provided by limiting the scope of protection to selected goods/services. As noted above, evidence of use may be rejected if it is not considered to qualify as an acceptable specimen. The remainder of the registration should not be vulnerable to

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challenge as to its validity simply because some goods/services are deleted from the registration following such an information inquiry. *Cf. University Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468 (TTAB 2008) and *Zanella Ltd. v. Nordstrom, Inc.*, 90 USPQ2d 1758 (TTAB 2008). The USPTO should also allow registrants to voluntarily request deletion of goods/services as an alternative to responding to the request for information, without such action being deemed an admission that the initial filing improperly over-claimed. Such a position accords with the goal of increasing the accuracy of the register.

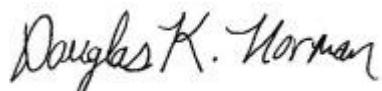
Amendment of Registration under Section 7

IPO does not support the proposed changes to Rule 2.173 which would empower the USPTO to request additional information and specimens of use when an amendment to the registration is sought. A request for amendment of a registration is not accompanied by a claim that the mark is in use on all goods and services in the registration (as is the case with Section 8 or Section 71). Therefore, Section 7 filings do not involve the issue of over-claiming.

In conclusion, while IPO supports addressing the issue of over-claiming, we do not support the Proposed Rules in their entirety. We believe that the goals can be achieved with less sweeping changes than those contemplated by the Proposed Rules and in a manner that may be more consistent with the intention to invoke the additional requirements in only a “small subset of cases”.

IPO thanks the Office for this opportunity and would welcome any further dialog or opportunity to support the Office on this matter.

Sincerely,



Douglas K. Norman
President