



20 December 2016

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property &
Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, Virginia 22314
Attention: Jennifer Chicoski

Via email: TMFRNotices@uspto.gov

**Re: IPO Comments on “Revival of Abandoned Applications,
Reinstatement of Abandoned Applications and
Cancelled or Expired Registrations, and Petitions to the
Director” 81 Fed. Reg. 74997 (Oct. 28, 2016)**

Dear Director Lee:

Intellectual Property Owners Association (IPO) submits the following comments on the USPTO’s Federal Register notice (Notice) on “Revival of Abandoned Applications, Reinstatement of Abandoned Applications and Cancelled or Expired Registrations, and Petitions to the Director.” 81 Fed. Reg. 74997 (Oct. 28, 2016).

IPO is an international 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 about 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO membership spans 50 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current intellectual property issues; providing information and educational services; and disseminating information to the general public on the importance of intellectual property rights.

IPO appreciates the USPTO allowing stakeholders the opportunity to provide comments on the proposed regulatory changes concerning deadlines for reviving abandoned trademark applications and codifying certain USPTO practices regarding reinstatement of trademark applications and registrations. We understand that the Office proposed the changes to promote the integrity of trademark application and registration information in the electronic records as an accurate reflection of the status of live applications and registrations.

President
Kevin H. Rhodes
3M Innovative Properties Co.

Vice President
Henry Hadad
Bristol-Myers Squibb Co.

Treasurer
Daniel J. Staudt
Siemens

Directors
Scott Barker
Micron Technology, Inc.
Stephen W. Bauer
Medtronic, Inc.
Edward Blocker
Koninklijke Philips N.V.
Amelia Buharin
Intellectual Ventures, LLC
Tina M. Chappell
Intel Corp.
Karen Cochran
Shell International B.V.
John Conway
Sanofi
William J. Coughlin
Ford Global Technologies LLC
Anthony DiBartolomeo
SAP AG
Daniel Enebo
Cargill, Inc.
Barbara A. Fisher
Lockheed Martin
Louis Foreman
Enventys
Scott M. Frank
AT&T
Darryl P. Frickey
Dow Chemical Co.
Gary C. Ganzi
Evoqua Water
Technologies LLC
Krish Gupta
Dell Technologies
Heath Hoglund
Dolby Laboratories
Carl B. Horton
General Electric Co.
Philip S. Johnson
Johnson & Johnson
Thomas R. Kingsbury
Bridgestone Americas
Holding Co.
Charles M. Kinzig
GlaxoSmithKline
William Krovatin
Merck & Co., Inc.
Dan Lang
Cisco Systems, Inc.
Peter Lee
Thermo Fisher Scientific
Allen Lo
Google Inc.
Timothy Loomis
Qualcomm, Inc.
Thomas P. McBride
Monsanto Co.
Elizabeth McCarthy
Avaya, Inc.
Todd Messal
Boston Scientific Co.
Steven W. Miller
Procter & Gamble Co.
Micky Minhas
Microsoft Corp.
Douglas K. Norman
Eli Lilly and Co.
Richard F. Phillips
Exxon Mobil Corp.
Dana Rao
Adobe Systems Inc.
Curtis Rose
Hewlett Packard Enterprise
Matthew Sarboraria
Oracle Corp.
Manny Schecter
IBM, Corp.
Steven Shapiro
Pitney Bowes Inc.
Jessica Sinnott
DuPont
Dennis C. Skarvan
Caterpillar Inc.
Brian R. Suffredini
United Technologies, Corp.
James J. Trussell
BP America, Inc.
Roy Waldron
Pfizer, Inc.
BJ Watrous
Apple Inc.
Stuart Watt
Amgen, Inc.
Steven Wildfeuer
RELX Group
Mike Young
Roche Inc.

General Counsel
Michael D. Nolan
Milbank Tweed

Executive Director
Mark W. Lauroesch

INTELLECTUAL PROPERTY OWNERS ASSOCIATION

We are concerned, however, that one of the proposed changes appears to require registrants to check the USPTO's electronic records every six months. This would unduly burden registrants, particularly those with large portfolios or who have to pay external agents for additional monitoring. Although we do not believe this was the intent, as currently written, the proposed change to Rule 2.146(d)(2)(ii) would have this effect.

For example, proposed Rule 2.146(d)(2)(ii) states that petitions to the Director must be filed no later than "[t]wo months after the date of actual knowledge of the cancellation/ expiration of a registration and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired." Under this proposed rule, registrants will need to check the trademark electronic records every six months to ensure that a petition to the Director is timely filed if a trademark registration becomes abandoned due to USPTO error. In contrast, under existing Rule 2.146(i),¹ the requirement to check the electronic records ends with the receipt of notice that an affidavit or renewal application has been accepted.

We respectfully submit that, once a trademark is registered, the registrant should not need to check the status in electronic records every six months. If a registration goes abandoned due to USPTO error, the registrant should not be precluded from filing a petition to the Director, even if the registrant has not checked the electronic records every six months.

We support the USPTO's efforts to promote the integrity of application and registration information in the trademark electronic records system as an accurate reflection of the status of live applications and registrations. We welcome further dialogue or the opportunity to provide additional information or otherwise assist the Office in its efforts on this important issue.

Sincerely,



Mark W. Lauroesch
Executive Director

¹ Rule 2.146(i) states:

Where a petitioner seeks to reactivate an application or registration that was abandoned, cancelled or expired because documents were lost or mishandled, the Director may deny the petition if the petitioner was not diligent in checking the status of the application or registration. To be considered diligent, a petitioner must:

...

(2) After registration, check the status of the registration every six months from the filing of an affidavit of use or excusable nonuse under section 8 or 71 of the Act, or a renewal application under section 9 of the Act, until the petitioner receives notice that the affidavit or renewal application has been accepted.

(Emphasis added.)