

# AIPLA

---

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION  
2001 JEFFERSON DAVIS HIGHWAY ■ SUITE 203 ■ ARLINGTON, Virginia 22202

May 26, 2003

Ms. Anne Chasser  
Commissioner for Trademarks  
United States Patent and Trademark Office  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Attn: Cheryl L. Black

Re: AIPLA Response to the USPTO's Notice of Proposed Rulemaking for Trademark- Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. Reg. 15119 (March 28, 2003)

Dear Commissioner Chasser:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to present its views on the USPTO's Notice of Proposed Rulemaking for Trademark- Related Filings under the Madrid Protocol Implementation Act. We will be pleased to expand on these comments during the public hearing to be held by the USPTO on May 30, 2003.

The AIPLA is a national bar association of more than 14,000 members engaged in private and corporate practice, in government service, and in the academic community. The AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

AIPLA commends the USPTO for doing an excellent job in drafting rules that are by and large a sensible, efficient and coherent means for implementing the Madrid Protocol ("Madrid" or "the Protocol") and the Madrid Protocol Implementation Act ("MPIA"), and for improving current rules in other areas. We hope these comments will serve as a constructive contribution to that effort.

At page 15127 of the Federal Register Notice, there are assertions and time estimates regarding the extent of the public reporting burden for collection of information

pertaining to the rules. AIPLA questions the time estimates, which appear to seriously underestimate time and resources required to engage in the listed activities and to proceed electronically in general. For example, the estimates include time periods such as two minutes to request that the Office replace a U.S. registration with a subsequently registered extension of protection to the U.S.; five minutes for a request that the Office transform a canceled extension of protection into an application for registration under Sections 1 or 44 of the Act; and fourteen minutes for an affidavit of continued use or excusable nonuse under Section 71. The time estimates purportedly “include the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed and completing and reviewing the collection of information.” At least two assumptions appear to be made, namely that the person signing the document is the one filing it and that the specimens have already been scanned on the system required by the USPTO. For law firms in particular, as well as for many corporations filing directly, these assumptions should not be made and therefore the time periods should be increased considerably. If the Office will explain the basis for these time estimates, AIPLA would be pleased to work with the Office to devise more accurate estimates.

AIPLA applauds the USPTO for not seeking to impose a surcharge for non-Madrid applications and other papers that are not filed electronically. We also urge the USPTO to continue to actively seek legislation to amend the grace periods for post-registration declarations of use for International Registrations ("IR") Certificates of Extension of Protection ("CEP") to conform with current law regarding all other U.S. registrations.

It appears that one may use a U.S. concurrent use application or registration as a basic application or registration under the Protocol. Conceivably, one may therefore base an IR and extensions of protection to other countries on a U.S. application or registration that has only a very limited geographic scope in this country. AIPLA would be interested to know whether the USPTO believes this is an accurate understanding of the MPIA and whether the USPTO has considered the possible implications of this.

#### COMMENTS ON SPECIFIC PROPOSED CHANGES TO THE RULES

**Rule 2.19(a):** Prior to the word "notification" at the beginning of the fifth line (in the pdf. version of the Federal Register notice), insert "written" to be consistent with Rule 2.18 and to require proper evidence of revocation of power of attorney.

**Rule 2.33(e):** Rule 2.33 contains the requirement that a trademark application must always include a signed verified statement. Current subsections (b)(1) and (2) set forth the allegations that are required in the verified statement under current Sections 1(a), 1(b) and 44 of the Lanham Act. We do not understand why proposed new subsection (e) does not similarly set forth the requirements of the contents of the verified statement under Section 66(a) of the Lanham Act, namely, that it be “a declaration of bona fide intention to use the mark in commerce,” and we suggest that language to this effect be included.

We also note that Rule 2.33(e) does not require that a copy of the verified statement be submitted to the USPTO by either the applicant requesting extension of protection to the United States or by the International Bureau (“IB”). We are concerned that this could conceivably work a hardship on opposers or cancellation petitioners in connection with these applications or resulting registrations. Proof of the existence of a signed verified statement, and the identity of the person signing the statement, are issues that can be relevant in such proceedings. While a copy of the statement can, presumably, be obtained by the opposer or petitioner from the IB, this could cause delay and undue expense. We request that the USPTO consider requiring the IB to transmit a copy of the signed verified statement to the USPTO at the time the request for extension of protection is submitted.

**Rule 2.35(b)(2):** The proposed rule does not change the former requirement that, after publication, in order to add or substitute a basis in an application that is not the subject of an inter partes proceeding before the TTAB, one must petition the Director to obtain permission. AIPLA proposes that the requirement to have the express permission of the Director for such amendments be eliminated. Currently, such petitions are routinely granted if the request complies with the rules. Trademark Examining Attorneys are equipped to handle such requests on their own. Requiring a petition to the Director needlessly delays the process and increases the Director's workload. We do not propose at this time to eliminate the need for republication of the application, but we do suggest that this requirement be studied and that consideration be given as to whether it should be required in all instances.

**Rule 2.52(a):** The requirement of subsection (1) to affirmatively state that a mark is in standard characters and that no claim is made to any particular font style in order for a drawing to qualify as a standard character drawing seems unnecessary and redundant, and should be deleted. The condition set forth in subsection (5) that “The mark includes common punctuation or diacritical marks” is vague and should be clarified, or examples should be provided.

**Rule 2.52(b)(1):** AIPLA is concerned about the possibility of confusion and uncertainty arising from the requirement to name the color and describe where it appears on the mark when color is claimed as a feature of the mark since color will be plainly depicted in the drawing. Recognizing that the naming of the color is a requirement for Section 66 applications under the Protocol, we recommend that this requirement be optional for applications under Sections 1 or 44. Additionally, we would appreciate an explanation of the basis for requiring, in all cases, a description of where the color appears on the mark.

If there is a perceived conflict between the claimed color as depicted in the drawing and as described by the applicant, whether it is an application under Sections 1, 44, or 66, the applicant should be asked for clarification.

The USPTO's comments on this rule indicate that the USPTO will now accept drawings with gray tones and will treat them as black and white drawings (unless the color gray is claimed). This is a welcome change, but it is unclear how this will be depicted in the Official Gazette (will the mark be published with the gray tone or will the gray be converted to black or white?) and what the legal effect will be. The actual rule is silent on this. The USPTO should clearly indicate the policy and the effect thereof.

**Rule 2.54(c):** The Office is requested to state the consequences of someone inadvertently excluding the caption "Drawing Page" from the top of the drawing page.

**Rule 2.66 and Rule 2.146(i):** We strongly oppose the deletion of current subsection (a)(2) of Rule 2.66, which allows a petition to revive an abandoned application within two months of the time applicant receives actual knowledge of the abandonment, if the applicant checked the status of the application every 12 months. Likewise, we oppose shortening the due diligence requirement to six months via proposed Rule 2.146(i). We are aware of many instances where non-receipt of an office action or a notice of abandonment is not the fault of the applicant. Additionally, given the current state of pendency at the Office, these requirements unfairly shift the burden to applicants. A review of the status reports provided in the Trademark Official Gazette of April 8, 2003 confirms that it generally takes more than six months before the Office acts on responses to office actions. There are also new cases that date back to March and April of 2002 that have not yet been acted upon.

Recognizing the problems the current policy may create under the Protocol's strict deadlines, we would support a rules change that requires a stricter due diligence standard with respect to requests for extension of protection under Section 66(a). We offer to work with the Office to develop an acceptable framework within the rules for this change.

**Rules 2.101:** AIPLA believes that if an opposer to an application based on Section 66(a) submits a fee sufficient to pay for one person to oppose one class via the Electronic System for Trademark Trials and Appeals (ESTAA), the opposition should be accepted, just as it would be accepted if it were filed on paper in the case of an opposition to an application under Sections 1 or 44 under proposed Rule 2.101(d)(3). Also, the rules should be clarified to provide that the opposer will be notified of any fee deficiency and given a reasonable period of time to submit the additional fees. A forfeiture of opposers' rights should be avoided whenever possible. This comment is also applicable to Rule 2.111.

**Rule 2.102(c):** We oppose the limitations for all cases to no more than two requests for extension of time to oppose, totaling 120 days from the publication date. First, there should be no limit with regard to Section 1 and Section 44 published applications. The Office should continue current practice, which results in the majority of potential oppositions being settled before they are even filed. There is no statutory or treaty requirement to change current practice. This also avoids the potential prejudicial effect of having to dismiss an already-filed opposition. The Office's proposals for these

rules, as well as others, illustrate that it is quite feasible for the Office and the Trademark Trial and Appeal Board to have disparate requirements for Protocol and non-Protocol applications.

Second, with regard to opposing Section 66(a) applications, Article 5 of the Protocol and Section 68 of the MPIA provide that the Office need not inform the IB of an opposition until seven months after the publication of a mark, or within one month after the opposition period expires, whichever occurs first. Since the Office will be notifying the IB of the opposition electronically, one month is certainly sufficient time. Therefore, the maximum time subsequent to publication of a mark under Section 66(a) that should be allowed for filing an opposition is six months, in order to preserve as much flexibility as possible for the parties to attempt to settle the matter before the opposition is instituted. Parenthetically, it is noted that, even under the USPTO's current proposal, the Office would still have only one month within which to notify the IB of the opposition, under the above-cited treaty and statutory provisions.

**Rules 2.105 and 2.113:** There is a discrepancy between the second and third sentences of Rule 2.105, which identify to whom the TTAB will mail the notification of opposition. The list in the second sentence (mailing of a copy of the notification to opposer) specifically refers to the definitions of "attorney" and "authorized representative" in Section 10 of the rules. However, the list in the third sentence (relating to mailing the notification and opposition to the applicant) does not reference the Section 10 definitions of "attorney" and "authorized representative." Is it intended that an "authorized representative" in the third sentence include, for example, the authorized representative designated in an IR (in cases where the application being opposed is a request for extension of protection), which could include a foreign agent or attorney for the IR holder? It seems that the rule requires clarification. Rule 2.113(a) contains a similar discrepancy, and seems inconsistent with Rules 2.18(a) and (c) regarding the need to send notification to an attorney or a domestic representative, respectively, if one has been appointed.

AIPLA is concerned about how the USPTO will deal with the problem of timely notification of oppositions and cancellations to foreign applicants and registrants where there is no U.S.-based attorney or domestic representative appointed, in view of potential delays in mail service to and in foreign countries.

**Rule 2.126(a)(4):** We believe the rule should allow a paper submission to be bound or fastened together if its contents can be easily separated. We understand the need to separate paper submissions for electronic scanning, but we have concerns based on the experience of some of our members that, in some cases, submissions are unclipped and then not replaced in the file in their original order.

**Rule 7.6(a):** Some of the acts by the Office for which fees of \$100 per class are proposed seem to be largely ministerial in nature, involving nothing more than

transmitting to the IB filings submitted electronically by applicants. This should require only a minimal expenditure of time and resources by the Office. AIPLA would like to understand the basis for these fees in terms of the associated burden on the Office and in comparison with fees charged by and associated burdens on other national trademark offices that have been operating under the Protocol for some time.

**Rule 7.11(a)(2):** We are concerned that the requirement to include the address of the international applicant and that it be identical to the address as it appears on the basic application or basic registration may lead to unnecessary rejection of the international application if the international applicant has not made sure that the records in the USPTO Assignment Branch are up to date. We also note that there are instances where an applicant or a registrant files or records change of address papers with the Office but they are not properly associated with the files and/or recorded. Since this is not required by the Protocol, the Common Regulations, or the MPIA, it should be deleted.

**Rule 7.13(b):** AIPLA believes that the Office should advise international applicants within a specific time frame when an international application is deficient and is not being forwarded to the IB and the reasons for the deficiency. Further, international applicants should be allowed a reasonable amount of time to correct the deficiency and still have their corrected international application forwarded to the IB without being forced to forfeit their \$100 transmittal fee and possibly lose a Paris Convention priority date.

**Rule 7.14(d):** We understand that the Office requires some lead time to submit a response or payment of fees by the applicant to the IB before the IB's deadline. However, since the IB's deadlines are typically as short as two months, and in view of the fact that these submissions will be made electronically by the applicant to the Office and then by the Office to IB, it seems unnecessary and burdensome on applicants to require that these submissions be made a full month prior to the IB's deadline. A lead time of seven (7) days prior to the IB deadline should be more than sufficient.

**Rules 7.23(d) and 7.24(d):** AIPLA believes that the Office should establish a time frame within which it will advise holders of IRs when a request to record an assignment with the IB through the Office is deficient and is not being forwarded to the IB. Also, applicants should be allowed a reasonable amount of time to correct the deficiency and still have their corrected request forwarded to the IB without being forced to forfeit their \$100 transmittal fee.

**Rule 7.28(b):** We note that the rule allows the holder of an identical U.S. registration to file a request to note replacement even before the certificate for an extension of protection (CEP) has issued. We are concerned about potential confusion as to the effect of such a filing at this stage, and would appreciate clarification from the Office as to the purpose of allowing the early filing.

We greatly appreciate the opportunity to provide our comments on the notice of proposed rulemaking for the implementation of the MPIA. We would be pleased to

answer any questions our comments might raise and look forward to presenting the most significant points at the hearing on May 30<sup>th</sup>.

Sincerely,

A handwritten signature in black ink that reads "Michael Kirk". The signature is written in a cursive style with a large, sweeping initial "M".

Michael Kirk  
Executive Director  
AIPLA