



August 1, 2017

Joseph Matal
Performing the Functions and Duties of
Under Secretary of Commerce for Intellectual Property and
Director of the U.S. Patent and Trademark Office
United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
ATTN: Cynthia Lynch

Via email: TTABFRNotices@uspto.gov

Re: Comments to Improving the Accuracy of the Trademark Register: Request for Comments on Possible Streamlined Version of Cancellation Proceedings on Grounds of Abandonment and Nonuse, 82 Fed. Reg. 22517 (May 16, 2017), Docket No. PTO-T-2017-0012

Dear Mr. Matal,

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to provide comments to the USPTO's Possible Streamlined Version of Cancellation Proceedings on Grounds of Abandonment and Nonuse.

AIPLA is a national bar association of approximately 13,500 members who are primarily practitioners engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA commends the Office on its efforts to look for ways to improve the accuracy of the Trademark Register and to eliminate from the Register those marks that are not in use and should no longer be entitled to registration status. AIPLA's specific comments and suggestions in response to the Office's request are as follows:

1. Overall comment about the proposed Streamlined Cancellation Proceedings. AIPLA is generally in favor of the Office's Possible Streamlined Version of Cancellation Proceedings on Grounds of Abandonment and Nonuse ("Streamlined Proceedings") and believes the Streamlined Proceedings will meet the stated objective of improving the accuracy of the U.S.

Trademark register by eliminating registrations for marks that are not in use. However, additional safeguards are necessary to sufficiently protect the rights of registrants.

2. Safeguards at initial filing of a petition. A major concern raised by AIPLA members is that the Streamlined Proceedings potentially place a significant burden on a registrant in terms of both time and expense. It is unclear whether the proposed version of the Streamlined Proceedings does enough to deter actions brought for improper purposes, such as inhibiting legitimate competition. Although the Streamlined Proceedings would be particularly effective in default scenarios, AIPLA believes that additional safeguards should be considered in connection with other scenarios. In particular, there are concerns that a registrant may face repeated Streamlined Proceedings. The USPTO should consider implementing a rule that limits successive petitions against a specific registration, even if the subsequent petitioner is unrelated to the petitioner in the previous Streamlined Proceeding. This might be accomplished by prohibiting the filing of a petition against a registration within a proscribed period of time after such registration has been the subject of a prior petition. Exceptions to this prohibition could be granted on a motion for good cause explaining the change in circumstances since the previous proceeding was concluded.

Other concerns have been raised by AIPLA members about the method by which the petition will be served on the registrant. It should be made clear that a streamlined cancellation petition will be served by the Trademark Trial and Appeal Board ("TTAB" or "Board") in the same manner as a full cancellation petition.

One safeguard to consider is requiring an oath or declaration by the petitioner or its counsel regarding the steps taken to find evidence of use prior to filing the petition.

3. Weight of the burden placed on the registrant. There are also concerns about the significant burden being placed on a registrant by the Streamlined Proceeding. The Federal Register notice is unclear as to the amount and type of evidence that a petitioner must provide, or which the registrant must submit to rebut the charge of abandonment or non-use. In the case of a registrant, this evidence could range from evidence of use for each good and/or service identified in the registration to a declaration affirming that the mark is in use and providing some supporting facts. Although each case must necessarily be decided on its own facts, AIPLA believes that further guidance on the nature of evidence and burden of proof required in the Streamlined Proceedings is needed. In addition to requesting specific guidance from the USPTO regarding this issue, AIPLA believes that the potentially significant burden to the registrant of submitting large quantities of evidence in a short time period should not be shifted to the registrant in the absence of significant "evidence" of non-use from the petitioner. While recognizing the difficulty of proving a negative and that, ultimately, the evidence of use is in the registrant's possession, a bare assertion of abandonment or nonuse should not result in the cancellation of a registration that carries a presumption of validity, and registrants should receive the benefit of the presumption.

4. Excusable Nonuse. AIPLA suggests that any proposed rules to enact the Streamlined Proceedings take into account and address the issue of excusable nonuse, which could be raised as a defense by the registrant. The availability of the Board's standard protective order,

which might be especially important when a registrant claims excusable nonuse, should be explicitly addressed.

5. Questions about preclusion effects, ability to re-litigate, and consistency. AIPLA members also expressed concerns about the preclusive effect that might be given to the result in a Streamlined Proceeding and questioned under what circumstances a petitioner might be able to re-litigate similar issues in a later full cancellation. A question was also raised about what actions the TTAB might take to ensure that the review of evidence of use by the Board in the Streamlined Proceedings remains consistent, such as perhaps assigning dedicated personnel to handle these cases.

AIPLA looks forward to working with the Office as this possible program develops and thanks the Office for considering AIPLA's suggestions.

Sincerely,

A handwritten signature in black ink that reads "Mark L. Whitaker". The signature is written in a cursive, slightly slanted style.

Mark L. Whitaker
President
American Intellectual Property Law Association