



AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION
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April 16, 2007

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

Attention: Cynthia C. Lynch

Re: Comments on Proposed Rule: “Changes to
Request for Reconsideration After Final Action”
72 Federal Register 6984 (February 14, 2007)

Dear Commissioner Beresford:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments on the rule and practice changes proposed by the United States Patent and Trademark Office (PTO) in the subject Notice.

AIPLA is a national bar association whose more than 17,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. 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. Our members represent both owners and users of intellectual property. We are pleased to provide comments on the subject notice.

The PTO proposes to change the rules of practice to require that applicants file a Request for Reconsideration of an examining attorney’s final refusal through the Trademark Electronic Application System (TEAS) within three months of the mailing date of the final action.

The stated purpose of the proposed rule change is to achieve the following goals:

- (1) streamline and promote efficiency in the process once a final action has issued;
- (2) eliminate the practice of filing a Request for Reconsideration simultaneously with a Notice of Appeal, thus reducing the number of remands and transfers that contribute to the burdens on applicants and the PTO and prolong the pendency of the case; and,
- (3) facilitate the likely disposition of applicant’s Request for Reconsideration prior to the six-month deadline for filing the Notice of Appeal with the Trademark Trial and Appeal Board.

AIPLA supports the stated goals, but does not believe that the proposed rule will achieve these goals unless a corresponding obligation is placed on examining attorneys to review Requests for Reconsideration prior to the six-month appeal deadline. Therefore, AIPLA cannot support the proposed rule change in its current form.

Filing through TEAS

AIPLA generally supports the PTO’s proposed rule 2.64(b)(1) to require that “the request must be filed through TEAS.” AIPLA agrees that, in most cases, this practice will promote efficiency.

However, AIPLA encourages the PTO to permit applicants to file documents and evidence on paper, CD-Rom, video tape, and/or DVD in certain circumstances, when the request for reconsideration is accompanied by lengthy documentary evidence, large exhibits, and/or video tape and DVD images. The proposed rule does not contemplate these types of filings, nor does the current TEAS and Electronic

System for Trademark Trials and Appeals (ESTTA) systems support them. Although TEAS now permits documents to be filed in PDF format, many practitioners still have difficulty in meeting the Office's technical requirements for attaching documents in this format, especially when the documents and exhibits are quite large. Moreover, an applicant should be permitted to submit video tape and DVD images, large, bulky evidence, and the like in support of a request for reconsideration, if necessary. Accordingly, AIPLA encourages the PTO to amend the proposed rule to accommodate these types of filings and exhibits along the lines set forth in 37 CFR §§ 2.56, 2.126 and TBMP § 106.03.

Three-Month Deadline to File Request for Reconsideration

AIPLA does not support the imposition on applicants of a three-month deadline to file a Request for Reconsideration after issuance of a final refusal absent a corresponding requirement imposed on the examining attorney to review and reply to the Request for Reconsideration prior to the end of the six-month period. Not only does the proposed rule impose no corresponding deadline on the examining attorney, it would even delete the current "aspirational statement" that states that "normally" the examining attorney will act on the request for Reconsideration before the expiration of the six-month period if the request for reconsideration is filed within the first three months. Without placing a corresponding obligation on the examining attorney to review the Request for Reconsideration before the expiration of the six month appeal period, the proposed rule change is unlikely to achieve its goals.

Burden on the Applicant and PTO Resulting from File Transfers

AIPLA acknowledges that the transfer of physical files has been an administrative burden in the past. However, the PTO and TTAB now have an electronic-based case management system and the transfer of cases can now largely be performed electronically. Thus, the burden of tracking, transferring and remanding cases within the office should be substantially reduced because, with the exception of video tape and DVD images and large and bulky evidence, the files no longer need to be physically moved and jurisdiction can be transferred efficiently and effectively through electronic case management.

Efficiency Considerations Should Not Trump Consideration of All Evidence

The three-month deadline for filing a Request for Reconsideration should not preclude applicants from submitting important evidence developed after the three-month deadline, as this would frustrate the stated purpose of increasing efficiency and reducing pendency. An example is when the applicant enters into a consent agreement with the owner of a cited prior registration. It is well settled that the TTAB will generally suspend an appeal and remand a refused application to the examining attorney, no matter how late the stage of the appeal, so that the examining attorney may consider the consent. See TBMP § 1207.02 (2d ed. rev. March 2004). The TTAB policy providing for suspension of an appeal and remand to allow for consideration of a consent agreement even late in the course of an appeal is an acknowledgement, as the TBMP states, that this type of evidence may be "inherently difficult and time-consuming to obtain and may be highly persuasive of registrability," and may only become available for filing late in the course of an appeal. Id. It would be inefficient for the proposed rule to operate in such a way that applicants would be prevented from submitting additional evidence during the six-month period, and would instead be forced to institute an appeal and then file a request for remand in order for the evidence to be considered.

We appreciate the opportunity to provide comments and would be pleased to answer any questions you might have regarding our comments.

Sincerely,



Michael K. Kirk
Executive Director
AIPLA