

July 16, 2014

The Honorable Michelle K. Lee  
Deputy Under Secretary of Commerce for Intellectual Property and  
Deputy Director of the United States Patent and Trademark Office  
United States Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

*via Ideascale*

**Re: AIPLA Comments in Response to the USPTO announcement “Share  
Comments/Suggestions on Draft Examination Guide: Service Mark  
Specimens,” June 3, 2014**

Dear Deputy Under Secretary Lee:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the U.S. Patent and Trademark Office’s (USPTO) Draft Examination Guide concerning Service Mark Specimens which was posted to the USPTO website at [http://www.uspto.gov/trademarks/notices/IdeaScale\\_ServiceSpecimens.jsp](http://www.uspto.gov/trademarks/notices/IdeaScale_ServiceSpecimens.jsp). AIPLA supports the USPTO’s attempt to clarify a complex area of service mark practice particularly as it relates to evolving technology-related services.

AIPLA is a national bar association with approximately 15,000 members who are primarily lawyers in private and corporate practice and 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, and unfair competition law. Our members represent both owners and users of intellectual property.

First, AIPLA commends the USPTO for this in-depth examination of service mark specimens as they relate to evolving technology-related services. The USPTO Examining Attorneys, as well as trademark applicants and their representatives, are constantly confronted with new technologies and this Examination Guide will provide useful guidance for the specimens required to support the services rendered using these technologies. The examples given in the Appendix are extremely helpful in clarifying the narrative in the Guide itself.

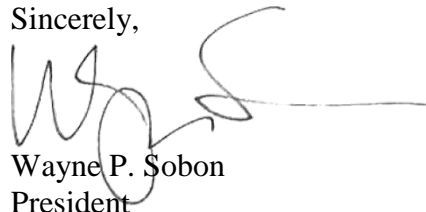
AIPLA has one concern about the Guidelines as drafted. We wonder whether the degree of detail given in the Examination Guide will make Examining Attorneys feel that they are under a greater onus when determining whether a service mark specimen adequately identifies a registrable service. For example, many webpages typically present information and services as basic as possible to avoid users having to drill through many layers of links to get to the service that they are interested in. It is possible that an adequate service mark specimen for an online service provided by the applicant's technology could be rejected based on the draft Guidelines, because the nexus between the mark and the applied-for service is considered too tenuous due to a simplified presentation of the mark at the website. Examining Attorney flexibility and open-mindedness should be emphasized in the examination to avoid extensive responses to justify a specimen that meets the requirements of the Lanham Act but may not have the degree of detail suggested by this Examination Guide.

One other point that AIPLA wishes to bring to the attention of the USPTO concerns a simple house-keeping note. On page 2 of the Examination Guide, in the last paragraph on the page, reference is made to Part II.C. However, there is no Part II.C. Presumably, Part II.B is the intended reference.

\* \* \*

AIPLA appreciates the opportunity to provide comments in response to this announcement. AIPLA looks forward to further dialogue with the USPTO in finding solutions and defining programs to maintain and enhance the USPTO's mission.

Sincerely,

A handwritten signature in black ink, appearing to read 'Wayne P. Sobon', with a long horizontal flourish extending to the right.

Wayne P. Sobon  
President

American Intellectual Property Law Association