



American Intellectual Property Law Association

December 23, 2016

The Honorable Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Via email: TMFRNotices@uspto.gov

*Attention: Jennifer Chicoski
Office of the Deputy Commissioner for Trademark Examination Policy*

Re: Comments on Revival of Abandoned Applications, Reinstatement of Abandoned Applications and Cancelled or Expired Registrations, and Petitions to the Director

Dear Under Secretary Lee:

The American Intellectual Property Law Association (AIPLA) is pleased to present its view in response to the notice of proposed rules for Revival of Abandoned Applications, Reinstatement of Abandoned Applications and Cancelled or Expired Registrations, and Petitions to the Director. 81 Fed. Reg. 209 (October 28, 2016).

AIPLA is a national bar association of approximately 14,000 members who are primarily lawyers 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, 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.

Overall comment about the proposed rules. AIPLA supports the USPTO's proposed rules for Revival of Abandoned Applications, Reinstatement of Abandoned Applications and Cancelled or Expired Registrations, and Petitions to the Director. The proposed rules meet the stated objectives – to provide more detailed procedures regarding the deadlines and requirements for requesting revival, reinstatement, or other action by the Director. AIPLA also understands that the proposed rules are intended to ensure that the public has notice of the deadlines and requirements for making such requests, to facilitate the efficient and consistent processing of such requests, and promote the integrity of application/registration information in the TESS database. Generally, AIPLA finds the proposed revised rules to be clear and reasonable, with two exceptions, as detailed below.

Proposed revised Rule 2.64(b) and Rule 2.146(d)(2)(ii). AIPLA strongly recommends that the USPTO consider revising proposed revised Rules 2.64(b) and 2.146(d)(2)(ii) regarding the now-implied (and previously explicit) requirement of a registrant to check the status of a registration every six months to ensure that the registration was not erroneously cancelled by the USPTO. The revised rules do not make it clear that this requirement is linked to the pendency of a filed affidavit of use or excusable nonuse under Sections 8 or 71 of the Act, or a renewal application under Section 9 of the Act. The comments preceding the proposed revised rules similarly do not clarify the link. AIPLA is concerned that registrants will read the rules as a requirement to check the status of all registrations every six months throughout the ten year period of a registration term to ensure that the USPTO has not erroneously allowed the registrations to expire or be cancelled. This would be unreasonably burdensome and is not the intended outcome of the revised rules.

AIPLA recommends a revision to the proposed revised rules and the comments to clarify that the requirement to check the status of a registration (as compared to an application) every six months is *only* applicable during the time that the registrant is waiting for the USPTO to take action on a filed affidavit of use or excusable nonuse under Sections 8 or 71 of the Act, or a renewal application under Section 9 of the Act. Suggested revisions to the published notice are set forth in red below:

§ 2.64 Reinstatement of applications and registrations abandoned, cancelled, or expired due to Office error.

(b) Request for Reinstatement of Cancelled or Expired Registration. If, during the time that an affidavit of use or excusable non-use under section 8 or 71 of the Act, or a renewal application under section 9 of the Act, is pending, the Office erroneously issues a notice of cancellation/expiration, t[T]he registrant may file a written request to reinstate the [a] registration cancelled or expired due to Office error. There is no fee for the request for reinstatement.

(1) Deadline. The registrant must file the request by not later than:

- (i) Two months after the issue date of the notice of cancellation/expiration; or
- (ii) Two months after the date of actual knowledge of the cancellation/expiration and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired, where the registrant declares under § 2.20 or 28 U.S.C. 1746 that it did not receive the notice of cancellation/expiration or the Office did not issue a notice.

§ 2.146 Petitions to the Director.

(d) Unless a different deadline is specified elsewhere in this chapter, a petition under this section must be filed not later than:

(1) Two months after the issue date of the action, or date of receipt of the filing, from which relief is requested; or

(2) Where the applicant or registrant declares under §2.20 or 28 U.S.C. 1746 that it did not receive the action or no action was issued, the petition must be filed not later than:

(i) Two months of actual knowledge of the abandonment of an application and not later than six months after the date the trademark electronic records system indicates that the application is abandoned in full or in part; or

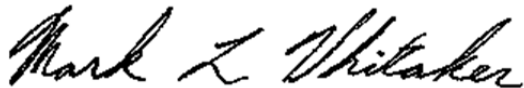
(ii) Two months after the date of actual knowledge of the cancellation/expiration of a registration and not later than six months after the date the trademark electronic records system indicates that the registration is cancelled/expired, where the cancellation/expiration of the registration occurs during the time that an affidavit of use or excusable non-use under Section 8 or 71 of the Act, or a renewal application under Section 9 of the Act, is pending; or

(iii) Two months after the date of actual knowledge of the denial of certification of an international application under §7.13(b) and not later than six months after the trademark electronic records system indicates that certification is denied.

Subject to the comments and recommended revisions discussed herein, AIPLA otherwise agrees with the proposed rules presented by the USPTO and their proposed implementation.

We thank you for allowing AIPLA the opportunity to provide comments on the rules regarding revival of abandoned applications, reinstatement of abandoned applications and cancelled or expired registrations, and petitions to the director. Please let us know if AIPLA can offer any additional comments or input.

Sincerely,



Mark L. Whitaker
President
American Intellectual Property Law Association