



American Intellectual Property Law Association

October 8, 2020

The Honorable David Gooder
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
Attention: Catherine Cain
Via email: TMFRNotices@uspto.gov

**RE: AIPLA Comments on Revised Trademark Examination Guide 3-19
Examination of Specimens in Commerce: Digitally Created/Altered or
Mockup Specimens**

Dear Commissioner Gooder:

The American Intellectual Property Law Association (AIPLA) is pleased to offer comments on the revised Trademark Examination Guide 3-19 Examination of Specimens for Use in Commerce: Digitally Created/Altered or Mockup Specimens.

AIPLA is a national bar association of approximately 8,500 members that include trademark attorneys and trademark owners, as well as other IP professionals 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 allow all trademark stakeholders to protect their marks in an efficient, reasonable, and cost-effective manner.

AIPLA appreciates the Trademark Office's efforts to address the issue of fraudulent trademark specimens that incorporate digital alterations, thereby creating the false impression of use of a trademark in the marketplace. We also appreciate the Office's transparency in providing clarity as to how the USPTO and Examiners will address fraudulent specimens.

While AIPLA further recognizes the need for the USPTO to focus its attention on the authenticity of submitted specimens and whether they show marks as actually used in commerce as required by the Trademark Act, AIPLA has the following suggestions and comments on the revised Examination Guide.

Section III. IDENTIFYING DIGITALLY CREATED/ALTERED AND MOCKUP SPECIMENS

Section III identifies characteristics of specimens that may indicate a digitally created, altered or mockup specimen. AIPLA supports the USPTO's listed characteristics as possible indicia of fraudulent specimens, but questions the appropriateness of the final item on this list, which reads:

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A webpage for an online marketplace, submitted as a display associated with the goods, includes indicia indicating that the mark is not in use in U.S. commerce or was not in use on the dates of use indicated in the application (e.g., language, currency, price, first available date, ship-to destination)

While this item may raise a question of actual use in commerce, this does not mean the web page is not legitimate. In other words, while such a web page may not be an acceptable specimen, the characteristic listed in the Examination Guide does not establish that it is a fraudulent specimen. In particular, a website in a foreign language may be more indicative of U.S. trademark owners marketing their goods and services to expatriates and immigrants in the U.S., rather than an indicia of a fraudulent specimen.

The revised Examination Guide contains a sentence below the list of characteristics that specifically refers to specimens not showing use of the mark in commerce. AIPLA believes that the characteristic discussed above is an example of a specimen potentially falling into this category and therefore suggests that the characteristic be moved here.

Section IV. GENERAL EXAMINATION CONSIDERATIONS FOR DIGITALLY CREATED/ALTERED OR MOCKUP SPECIMENS

AIPLA welcomes the deletion of reference to “white backgrounds” in the paragraph heading and text. While a mockup specimen may appear on a white background, such a display is, by itself, insufficient evidence of a digital creation or alteration. Many trademark owners choose to display their goods on a white or light background for aesthetic reasons.

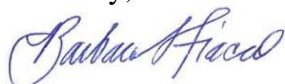
In view of this change, AIPLA suggests that the Office allow applicants to resolve any outstanding Office action refusals, based solely on this issue, by phone or email communication.

Section VI. GATHERING EVIDENCE

AIPLA supports Examining attorneys’ reliance on Office records to support a finding that specimens are digitally altered, created or mockups. AIPLA requests that Examiners download and attach any such evidence to an Office action to enable an applicant to review the Examiner’s evidence for a refusal. Examiners are required to do this for extrinsic evidence, and therefore, all evidence used as a basis for refusal would be handled consistently.

AIPLA thanks the Office for considering these views and looks forward to continued discussion. Please let us know if AIPLA may offer any additional input.

Sincerely,



Barbara A. Fiocco

President

American Intellectual Property Law Association