

AIPLA

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

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February 2, 2004

Ms. Anne Chasser
Commissioner for Trademarks
United States Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202-3513

Attn: Mary Hannon

Re: Notice of Proposed Rulemaking
Proposed Changes for Amendment and Correction of Trademark Registrations
68 Federal Register 70482 (December 18, 2003)

Dear Commissioner Chasser:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to present its views on the Changes in the Requirements for Amendment and Correction of Trademark Registrations proposed by the United States Patent and Trademark Office.

AIPLA is a national bar association with more than 15,000 members engaged 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.

AIPLA *supports* the proposed amendments to 37 CFR §§ 2.172 through 2.176 to the extent those amendments would eliminate the requirement that a Section 7 request for amendment or correction of a trademark registration be accompanied by the original certificate of registration or, if the original is lost or destroyed, by a certified copy of the original, and that a Section 7 application for surrender of a trademark registration for cancellation be accompanied by the original certificate of registration if it is not lost or destroyed. These requirements are clearly unnecessary, as the primary record of a trademark registration resides with the USPTO and is controlling over paper registration copies held by registrants. Such copies are not required by the USPTO in order to correct or cancel a registration.

However, we *oppose* the proposed amendments to the extent they would add a requirement that a request for correction of a mistake in a registration be filed within one year of the date of registration, regardless of whether the mistake was the fault of the registrant or the USPTO. This proposed new requirement could needlessly create hardships for registrants who must have their registrations accurately reflect such critical data as the name, address, legal entity status and domicile country of the owner of the registration; the spelling or depiction of the mark; the recitation of goods and services; the basis for the registration; the registration or application number; the registration numbers of other registrations that the registrant owns; the serial numbers of foreign applications or registrations claimed under the Paris Convention; and the dates of first use, filing, Paris Convention priority and issuance. Errors in this critical information may not be discovered until well after the proposed one-year anniversary date deadline has passed.¹

The following are among the serious problems for registrants that can result from inaccurate registration information:

- Problems in establishing an accurate and complete chain of title
- Problems in attempting to use the registration to support an application to register the mark in another country under the Paris Convention
- Problems in attempting to use the registration to support a request for extension of protection of the mark to another country under the Madrid Protocol
- Problems in utilizing the registration to support or defend litigation
- Problems in utilizing the registration to support a recordal of the registrant's rights with the United States Customs Service to prevent the importation of counterfeit goods

The USPTO's rationale for the proposed rule is that inaccurate information about existing registrations can be "harmful to examining attorneys and third parties who search Office records." With all due respect, while it would be better for USPTO records to accurately reflect registrants' rights from the beginning, this reason is far outweighed by the considerations noted above. The proposed new policy could condemn registrants with a registration containing erroneous information arising from a clerical error within the USPTO that could result in a deprivation of a material and valuable property right. The notion that registrants or their attorneys should diligently check registrations for accuracy at the time of issuance, while laudable, does not outweigh the unfairness and potential harm to registrants. The law (and a customer service-oriented government agency) should

¹ It should be noted that, at times, the USPTO has experienced significant delays between the time a registration issues and the time the certificate is mailed to the registrant. Also, certificates have been known to be delayed or lost in the mail. In addition, it is also possible that the USPTO's electronic database may not be updated on a timely basis to reflect that a mark has registered. Thus, the registrant may have considerably less than a full year to review the certificate and request a correction.

always seek to avoid a forfeiture of material rights. Moreover, in some cases, such as where there is an assignment of a registration after the one-year anniversary, the (new) registrant cannot rationally be held accountable for a failure to verify the accuracy of a registration within one year if there is no conceivable way for the (new) registrant to have known that such an error occurred.

We greatly appreciate the opportunity to provide our comments, and would be pleased to answer any questions our comments might raise.

Sincerely,

A handwritten signature in black ink that reads "Michael Kirk". The signature is written in a cursive style with a large, sweeping initial "M".

Michael Kirk
Executive Director
AIPLA