



American Intellectual Property Law Association

October 6, 2023

The Honorable Kathi Vidal
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via the Federal eRulemaking Portal at www.regulations.gov (Docket No. PTO-T-2023-0028)

RE: Changes to Duration of Attorney Recognition

Dear Director Vidal:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to comment on the Office's recent proposal on the changes to the duration of attorney recognition.

AIPLA is a national bar association of approximately 7,000 members, who include 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 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.

General Comments

The proposed changes reference several concerns and issues that could arise from changing the duration of attorney recognition. The request for comment largely seeks suggestions on how the USPTO can address these concerns. AIPLA understands the USPTO solicits feedback on (1) changing the duration of attorney recognition, and (2) implementing the change in duration of attorney recognition, if enacted, including removal of historical attorney information from the record.

While AIPLA understands that the USPTO is revisiting this proposed change after an initial proposal in the Trademark Modernization Act (TMA) published in the Federal Register on May 18, 2021, we observe that there has been a relatively short period of time between the publication of the request for comments and the hearing. We believe that the process could benefit from more deliberate stakeholder discussion and consideration.

AIPLA reserves comments on any potential rule changes that may occur and the implementation of these rule changes. For further information about AIPLA's position regarding the TMA's proposed changes to duration, AIPLA invites the USPTO to refer to its initial letter regarding the TMA¹.

The following are AIPLA's observations on the proposed changes to the duration of representation and how to improve or otherwise streamline the implementation.

1. Do you think the current rule should remain unchanged, or are you in favor of the revisions under consideration?

It is AIPLA's understanding that the revisions under consideration are (1) whether the USPTO should change the duration of recognition for representation to allow recognition as to a pending application or registration to continue until the applicant, registrant, or party to a proceeding revokes the power of attorney or the representative withdraws from representation, and (2) to remove all attorney information from the database for applications and registrations under the previous recognition rule if a recognition-ending event has already occurred.

AIPLA supports the first proposed revision, where the USPTO will change the duration of recognition for representation, so that recognition continues for a pending application or registration until the applicant, registrant, or party to a proceeding revokes the power of attorney or the representative withdraws from representation. In implementing this revision, the Trademark Office's rules regarding duration of attorney recognition will align with the Patent Office's rules.²

With regard to the second proposed revision, removing all attorney information from the record and ceasing communication with all former attorneys of record for applications and registrations under the previous recognition rule, the Request for Comment appropriately refers to many of the concerns held by outside practitioners, including "missing response deadlines when representation continues, if they are removed from the record when recognition ends and will no longer receive correspondence from the USPTO regarding their clients' matters following abandonment or registration."³ This concern is heightened due to the increasing number of misleading solicitations and phishing scams sent to client email addresses, as the new rule would place applicants and registrants at an even higher risk of exploitation by parties seeking to obtain information or payment for deceptive or otherwise disingenuous reasons.

In addition, removing attorney information from the record and ceasing correspondence upon registration or abandonment may cause unpredictability on the Register, where registrations and applications may be inadvertently abandoned or cancelled due to failure to respond to office actions, to submit post-registration filings, and delays in filing Petitions to Revive. This will negatively affect applicants, registrants, and parties seeking to clear potential new marks.

Finally, AIPLA notes that removal of all attorney information from the record will increase the burden on practitioners when filing for reinstatement as attorneys of record. It is common

¹ https://www.aipla.org/docs/default-source/news/aipla-letter-to-uspto-on-trademark-modernization-act-020321-final.pdf?sfvrsn=a7d2f759_2

² See MPEP § 402.05-402.06

³ See Notice of Request for Comment in Fed. Reg. Vol. 88, No. 153, p. 54306 (dated August 10, 2023).

practice for practitioners to have an attorney docket number for each individual application. Under the proposed changes, the attorney will need to re-insert not only their personal details such as name, bar information, and address – but also their individual attorney docket numbers. Since these docket numbers vary based on each individual filing, removal of this information will make it difficult to re-appoint oneself as attorney of record for a client’s portfolio of marks.

AIPLA suggests some potential solutions to these concerns under Point 2 below.

2. Do you have suggestions for handling the transition period during which attorney information is removed from the record whether the current rule is retained or revised?

If the USPTO proceeds with the change in duration of attorney recognition, AIPLA is concerned that removing all former attorney information from the record will create unnecessary problems amongst applicants, practitioners, and other parties.

AIPLA recommends that the USPTO not completely remove former Attorney of Record information from the record until the USPTO can capture and save this information. If this information is captured and saved in USPTO databases, the USPTO can then institute the following procedures to streamline the appointment of Attorney of Record:

- (A) For applications that have already matured into registration, the USPTO should move attorney information to a “historical attorney of record” section and send a courtesy copy to the former attorney of record informing them that this change has occurred. Ideally, the USPTO would provide an optional form within this courtesy copy for the former Attorney to “confirm” that they will remain as Attorney of Record;
- (B) For applications filed before the change in duration has been implemented, but that have not yet reached registration, the USPTO should provide a courtesy copy of the registration to the former Attorney of Record informing them of the revocation upon registration and provide an optional form within the registration notice for the former Attorney to “confirm” that they will remain as Attorney of Record; and
- (C) For new applications filed after the change in duration has been implemented, the TEAS filing form should include a checkbox where the appointed Attorney can request to remain Attorney of Record after the application has matured into registration, unless a formal revocation is filed with the USPTO.

The Request for Comment indicates that the “USPTO has considered requests that attorneys be given the opportunity to opt in to remaining of record” and “the USPTO has neither the staff nor the technological resources to implement an opt-in alternative as to the affected applications and registrations.” AIPLA recognizes that the Office does not have an infinite number of resources to implement “any and all” changes. However, AIPLA requests further explanation regarding (1) the need to remove historical attorney information, (2) why the USPTO cannot retain historical attorney information, and (3) what new technology or forms, if any, are available to streamline the process for re-appointment and/or withdrawal.

Without further information from the USPTO, AIPLA considers the suggestions above to be the reasonable path forward to mitigate confusion and reduce potential negative impact on

outside parties. We therefore ask that the Office fully reconsider whether it will be possible to retain historical attorney information and provide opt-in alternatives.

3. Do you have any suggestions for making withdrawal or re-recognition easier if the rule is revised to continue recognition?

As discussed above, AIPLA submits that (1) creating a new form allowing for easy “restoration” of the former Attorney of Record will make the re-recognition process easier and (2) providing an “opt out of continued recognition” option in TEAS filing forms if the Office chooses to proceed with changing the duration of recognition for representation so recognition continues for a pending application or registration unless revocation or withdrawal is filed with the Office. AIPLA has no current concerns about the current process to file an express withdrawal of representation under TMEP § 607.

Conclusion

AIPLA understands that this Request for Comment is a starting point for how the USPTO will consider implementing a change in duration of representation. AIPLA appreciates that the Office will carefully consider the trademark community’s response to the proposed changes and implementation. In that regard, AIPLA also appreciates the opportunity to provide these comments, and it will be happy to discuss its views on these issues with the Office further. Please do not hesitate to contact me for further information or clarification.

Sincerely,

A handwritten signature in blue ink, appearing to read "B. Batzli".

Brian H. Batzli

President

American Intellectual Property Law Association