

January 12, 2011

The Honorable Deborah Cohn
Commissioner for Trademarks
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

AIPLA Comments on the *Bose* Roundtable Suggestions to Improve the Accuracy of Identifications of Goods and Services in Trademark Applications and Registrations at the USPTO

Dear Commissioner Cohn:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments regarding the United States Patent and Trademark Office's ("USPTO") *Bose* Roundtable Suggestions to Improve the Accuracy of Identifications of Goods and Services in Trademark Applications and Registrations at the USPTO.

AIPLA is a national bar association with approximately 16,000 members who are primarily lawyers and other patent practitioners 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. Our members represent both owners and users of intellectual property.

The USPTO requested comments regarding the below list of 18 suggestions to improve the accuracy of goods and services identifications in trademark applications and registrations at the USPTO. These suggestions were the result of a roundtable hosted by the USPTO and George Washington University Law School on April 26, 2010.

AIPLA has considered the list of 18 suggestions, as well as the USPTO's comments, and the USPTO's general assessment of each suggestion's potential effectiveness to increase the accuracy of goods and services identifications in U.S. trademark filings, and how accurately such identifications reflect actual use or intent-to-use, following the decision of the Court of Appeals for the Federal Circuit in *In re Bose Corp.*, 580 F.3d 1240, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009).

As a general comment, AIPLA fully supports the USPTO's efforts to improve and create new measures to ensure the accuracy of identifications of goods and services in trademark applications and registrations. More specifically, AIPLA believes that suggestions 11 and 12 may be the most feasible and effective measures for improving the accuracy of goods and services identifications.

Suggestion 11 is to make a "[c]hange in the electronic form to require a separate averment of use or *bona fide* intent-to-use for each item of goods and services in the application." Such a change in the electronic form will require users of the USPTO's Trademark Electronic Application System ("TEAS") to specifically focus on and be more cognizant of each item of goods or services in each class for a particular mark at the time a registration is renewed or a statement of use is filed. The obligation of requiring a separate averment of use or *bona fide* intent-to-use for each item of a goods or services description will also serve to deter TEAS users from simply renewing all items in a goods or services identification without truly contemplating or investigating exactly whether the mark is still used in connection with such items. Although such a change in the electronic form will require additional time and effort from TEAS users, and may not cover extensions of protection under the Madrid Protocol, the significant benefit of keeping trademark applications and registrations more accurate for the majority of other applicants may outweigh any drawback of implementing such a change.

AIPLA also recommends that suggestion 12 be given further consideration by the USPTO. This suggestion is to "[c]reate a truncated non-use expungement procedure (analogous to the Canadian expungement proceedings under Section 45 of the Trade-marks Act)." AIPLA considers this suggestion especially important because it would allow a mechanism by which trademark owners and practitioners may "self-police" the register. For example, a junior user may be blocked in a particular class by a prior registrant. Instead of going through the lengthy process of filing a partial cancellation action before the Trademark Trial and Appeal Board, the junior user could use the expungement procedure to expeditiously resolve the issue. A truncated non-use expungement procedure would also ensure that those who are truly using a mark for specific goods and services are rewarded with registration rights, and would provide an incentive for trademark owners and practitioners to maintain accurate goods and services identifications.

Further, AIPLA recommends that the USPTO consider suggestions 11 and 12 jointly and not in the alternative. This is because suggestion 11 would likely require less time to implement, thus providing a quick solution. However, a mere change to the electronic form cannot stand alone because it does not provide a fool-proof method for ensuring the accuracy of goods and services identification. Consequently, suggestion 12, while requiring legislative and regulatory changes, would provide a long-term comprehensive solution for trademark owners and practitioners. In order to further explore the practicality of creating a truncated expungement procedure in the United States, AIPLA could work with the USPTO in creating a task force comprised of trademark owners and practitioners from the United States and Canada that are familiar with the Canadian expungement procedure as well as USPTO procedures since several of AIPLA's members would satisfy this criteria.

While AIPLA believes suggestions 11 and 12 would be the most useful and effective measure for improving the accuracy of goods and services identifications, other comments with respect to the rest of the suggestions follow below in *italics*.

During Examination Prior to Registration

1. Current Office practice is to require one specimen for each overall class of goods and/or services recited in an application for registration under Section 1(a) of the Trademark Act (use in commerce), or at the time of submission of an Allegation of Use. Examples of acceptable specimens include a photo of goods bearing the mark, tag, label, or container for the goods, or an advertisement for services. The following suggestions are changes to the current practice:

A. Suggestion: Request a specimen for **each** item of goods and/or services in the identification.

USPTO assessment: Moderately effective

B. Suggestion: Request a specimen for **each** item of goods and/or services in the identification, and require that the specimen be a photo of the goods showing the mark used directly therewith or an actual advertisement for the services.

USPTO assessment: Moderately effective

C. Suggestion: Request a photo specimen for each item of goods and/or services, but do so on a random basis.

USPTO assessment: Minimally effective

USPTO comment: All of these suggestions may be possible under the current law. Requiring a specimen for each item of goods and/or services will only affect applicants who initially file a use-based application or who file an Allegation of Use for an intent-to-use-based application. It will not affect applicants who file based on a foreign registration under Section 44 or Madrid Protocol applicants under Section 66(a). Therefore, each of these suggestions will require more work primarily for domestic applicants.

AIPLA comment: AIPLA is concerned that suggestions 1(a)-(c) may be overly burdensome for many domestic applicants, particularly those who may use a mark on hundreds or even thousands of different goods. In addition, such requirements will not be effective against applicants who file based on a foreign registration under Section 44 or Madrid Protocol applicants under Section 66(a). This will also increase the examination time per application, and thus be counter-effective as to pendency timing and backlogs at the USPTO.

2. Suggestion: Increase the solemnity of the declaration. For example, require the applicant to check a box stating that he understands the seriousness of the oath, or take some other extra step to confirm his understanding of the oath or declaration.

USPTO assessment: Moderately effective

USPTO comment: This suggestion would require changes in the electronic forms.

AIPLA comment: AIPLA agrees that a mere change in the solemnity of the declaration will only be moderately effective as many applicants may not pay attention to such nuances, and thus this measure will not increase the accuracy of applications or registrations.

3. Suggestion: Revise the forms to add pop-up warnings about the ramifications of untruthful statements or about the seriousness of the oath.

USPTO assessment: Moderately effective

USPTO comment: This suggestion would require changes in the electronic forms.

AIPLA comment: AIPLA agrees that pop-up warnings will only be moderately effective as many applicants may choose to ignore such warnings and there is no way to ensure that all pop-up warnings are viewed because applicants may have filters or pop-up blockers on their computers.

4. Suggestion: Provide the USPTO's Office of Enrollment and Discipline more enforcement powers against attorneys who act unethically in matters before the Office.

USPTO assessment: Minimally effective

USPTO comment: This suggestion would likely require legislative and regulatory changes, and it would not address the behavior of clients or *pro se* applicants.

AIPLA comment: AIPLA agrees that enforcement actions against attorneys acting unethically in matters before the USPTO will not address the behavior of clients or pro se applicants, nor will such actions be effective in increasing the accuracy of issued registrations—which is the primary goal.

5. Suggestion: Add fees for identifications that exceed a certain number of words or characters.

USPTO assessment: Counter-effective

USPTO comment: Changes in the initial application fees would require legislative and regulatory changes. Furthermore, adding fees for identifications that exceed a certain number of words or characters may drive applicants to “wordsmith” identifications rather than supply accurate identifications, possibly leading to less accuracy.

AIPLA comment: AIPLA agrees that adding fees based on a word or character count could possibly lead to less accuracy and increase prosecution and examination issues, which will lead to increased pendency times and backlogs at the USPTO.

6. Suggestion: Provide a partial refund of the application fee for withdrawal of goods and/or services that are not in use during the application phase.

USPTO assessment: Counter-effective

USPTO comment: This suggestion may discourage accuracy by encouraging the filing of multiple-item identifications in order to receive a refund. Moreover, to the extent examination as to those goods and/or services already occurred, a refund may not be appropriate.

AIPLA comment: AIPLA agrees that costs are incurred at the time of examination, thus providing partial refunds as an incentive to withdraw certain goods or services may create a resource deficit at the USPTO, and will likely increase pendency times and backlogs at the USPTO.

7. Suggestion: For applications filed based on a statement of *bona fide* intent-to-use (Sections 1(b), 44(d), 44(e), and 66(a)), require some proof of *bona fide* intent-to-use.

USPTO assessment: Moderately effective

USPTO comment: Regulatory changes and extensive training of examining attorneys may be necessary to implement this type of change.

AIPLA comment: Establishing guidelines and regulations for proof of a bona fide intent-to-use is a task that may be effective, but will require a great deal of resources. Such measures may also counter-act the purpose of intent-to-use applications, and are likely increase pendency times and backlogs at the USPTO.

8. Suggestion: Require proof of a continued *bona fide* intention to use the mark in commerce needed before granting extensions of time to file a statement of use.

USPTO assessment: Moderately effective

USPTO comment: Regulatory changes and extensive training of ITU staff may be necessary to implement this type of change.

AIPLA comment: Same as for suggestion 7.

9. Suggestion: Require the division of large classes into separate applications.

USPTO assessment: Counter-effective

USPTO comment: Regulatory and USPTO electronic systems changes would be necessary to implement this suggestion. There may also be implications for our treaty obligations. Furthermore, this approach may simply shift the “problem” from one application to many applications.

AIPLA comment: AIPLA agrees that dividing large classes into separate applications may simply shift problematic goods or services identifications to multiple applications, thereby creating a potential backlog at the USPTO.

10. Suggestion: Create a "best practices" checklist for practitioners; i.e., a form that practitioners would send to clients requiring that the clients specifically “sign off” on each item of goods and/or services in the proposed identification.

USPTO assessment: Minimally effective

USPTO comment: Use of the suggested form would be purely voluntary.

AIPLA comment: A “best practices” checklist could potentially increase the accuracy of identifications. However, the impact of the creation of a voluntary form, the details of which would have to be filled out manually by a practitioner to have the desired impact, may not justify the effort to create and promulgate the form, particularly where practitioners likely already have at least some process for getting confirmation from the client up to and including having the client make the averment. AIPLA feels that, for the direction this approach seems to be targeting of a more thorough advance sign-off on the goods and services, suggestion 11 would be more likely to deliver a more significant impact to the practice.

11. Suggestion: Change the electronic form to require a separate averment of use or *bona fide* intent-to-use for each item of goods and services in the application.

USPTO assessment: Moderately effective

USPTO comment: This suggestion would require a change in the electronic forms and would, in some cases, require additional time and effort to fill out the form. Because extensions of protection under the Madrid Protocol are submitted through the International Bureau, this probably could not be applied to Madrid-based applications.

AIPLA comment: Changing the electronic form to require a separate averment of use for each item of goods or services may not cover extensions of protection under the Madrid Protocol, but could be highly useful for the majority of other applications. AIPLA supports this suggestion for the reasons detailed on pgs. 1–3 of this letter.

Post Registration

12. Suggestion: Create a truncated non-use expungement procedure (analogous to the Canadian expungement proceedings under Section 45 of the Trade-marks Act). For example, a party that believes a registrant is not using its mark on the goods and/or services in its registration could file a request with the USPTO to require that the registrant prove use of its mark for all listed goods and/or services. The USPTO would request that the registrant submit a declaration/affidavit and specimens of use for all listed goods and/or services. If the registrant complies, that ends the procedure. Otherwise, any goods or services for which the registrant has not provided a specimen and supporting declaration/affidavit would be deleted from the registration.

USPTO assessment: Moderately effective

USPTO comment: Creating this procedure would require legislative and regulatory changes.

AIPLA comment: AIPLA recommends examining the possibility of a truncated non-use expungement procedure more thoroughly to assess the feasibility of implementing such a procedure in the United States. AIPLA also supports this suggestion for the reasons detailed on pgs. 1–3 of this letter.

13. Suggestion: Require specimens for every item of goods and/or services listed in the registration when the first Section 8 declaration is filed.

USPTO assessment: Moderately effective

USPTO comment: Regulatory changes may be necessary to implement this suggestion.

AIPLA Comment: Requiring specimens for every item of goods at the time the first Section 8 declaration is filed may be extremely cumbersome for many trademark owners and practitioners. AIPLA does not support this suggestion as it would likely delay post-registration examination, increase backlogs at the USPTO, and place an undue burden on trademark owners.

14. Suggestion: Require specimens for every item of goods and/or services listed in the registration when the first Section 8 declaration is filed, and mandate that the specimen must be a photo showing use of the mark in conjunction with the claimed goods and/or an advertisement for the services.

USPTO assessment: Highly effective

USPTO comment: Regulatory changes may be necessary to implement this suggestion.

AIPLA Comment: Requiring specimens for every item of goods at the time the first Section 8 declaration is filed may be extremely cumbersome for many trademark owners and practitioners. Additionally, a photo showing use of the mark on claimed goods may not always be practicable. AIPLA does not support this suggestion as it would likely delay post-registration examination, increase backlogs at the USPTO, and place an undue burden on trademark owners.

15. Suggestion: Require statements accompanying Section 8 declarations to detail steps taken to verify use.

USPTO assessment: Moderately effective

USPTO comment: Regulatory changes may be necessary to implement this suggestion.

AIPLA Comment: AIPLA agrees that this measure may not be very effective, and additionally steps to verify use may be hard to regulate, handle appeals, etc. Further, such a requirement could invade the attorney-client privilege in some circumstances.

16. Suggestion: Conduct random audits of Section 8 filings. If proof of actual use of the mark cannot be supplied for all the listed goods and/or services in the registration, then the practitioner would be reported to the USPTO's Office of Enrollment and Discipline.

USPTO assessment: Minimally effective

USPTO comment: Regulatory changes may be necessary to implement this suggestion. It would not address the behavior of clients (i.e., the trademark owner) or *pro se* registrants.

AIPLA Comment: AIPLA agrees that this measure would be minimally effective and may result in inconsistent treatment of filings.

17. Suggestion: Provide more information to the trademark bar about the option of filing a Section 7 for the purpose of voluntarily deleting goods and/or services from a registration for which the mark is no longer being used. Also, raise general awareness of the obligation to update registrations when appropriate.

USPTO assessment: Minimally effective

USPTO comment: Such an educational campaign could be undertaken by the USPTO or the outside bar.

AIPLA Comment: AIPLA agrees that an educational campaign may be useful but will not fully deter current problems.

18. Suggestion: Raise awareness of Section 18 of the Trademark Act and the ability of the TTAB to limit identifications of goods and services.

USPTO assessment: Minimally effective

USPTO comment: Such an educational campaign could be undertaken by the USPTO or the outside bar.

AIPLA Comment: AIPLA agrees that this measure may only be minimally effective (same comment as for suggestion 17).

AIPLA appreciates the opportunity to provide these comments on the *Bose* Roundtable Suggestions. We would be pleased to answer any questions that our comments may raise and look forward to participation in the continuing development of USPTO trademark practice.

Sincerely



Q. Todd Dickinson
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AIPLA