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Trademark
Association

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American Intellectual Property Law Association



Intellectual
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April 26, 2019

The Hon. Mary Boney Denison
Commissioner for Trademarks
Office of the Commissioner for Trademarks
United States Patent and Trademark Office
600 Dulany Street
Madison East Building
Alexandria, VA 22313

Re: Proposal to Eliminate the Restriction on Additional Extensions of Time Following the Filing of a Statement of Use After the Notice of Allowance Has Issued

Dear Commissioner Denison:

We, the undersigned associations, who represent trademark owners and the trademark bar, urge the United States Patent & Trademark Office to revise the Rules of Practice and the Trademark Manual of Examining Procedure (37 C.F.R. §§ 2.88(f) and 2.89(e)(1)) so that the filing of a Statement of Use (SOU) would not limit an applicant to a single six-month “insurance” extension request if, in fact, time remains in the three-year term following the issuance of the Notice of Allowance (NOA) for additional six-month extension requests, as permitted by Section 1(d) of the statute.¹ This change would allow an applicant filing an intent-to-use (ITU) application the opportunity to meet the use and SOU requirements within the statutory time period.

The current ITU application prohibition against filing additional extension requests after submission of an SOU beyond the one “insurance” extension request works an injustice on applicants who file an SOU early within the three-year term. It does so by preventing them from thereafter utilizing the full three years to meet the statutory SOU requirements should the Office find some defect in the SOU or specimen (or in a subsequent SOU or specimen). We are thankful that the USPTO is contemplating a change that would fairly restore these applicants to the same status they would have had they not yet filed an SOU.

For example, this prohibition works a severe hardship against applicants who have maintained applications for years, declaring their bona fide intent to use their marks and incurring USPTO fees for the applications (and possibly for some extensions), if their specimens are deemed technically deficient. These applicants have devoted expense and resources to put the trademark in use on the related goods and/or services and to file specimens of use – and should not be adversely affected by a shortened time period to gain acceptance of their specimens. There have been many reported cases of specimen refusals, including some involving emerging technologies and newly developed trademark displays that do not fit the standard guidelines. There also have been many cases where the applicant believes it has submitted a specimen complying with USPTO guidelines but the trademark examining attorney disagrees based on his or her subjective determination. When alternative specimens are not available within the time remaining in the single insurance extension, as is often the case when use of a mark is first made, the applicants

¹ Currently, the Rules of Practice and the TMEP state that the statement of use (SOU) once filed by an intent-to-use applicant cannot be withdrawn and only one extension request within six months of filing the SOU, commonly known as an “insurance extension,” can be filed.

have no additional time to correct their use and are thus forced to abandon their applications and re-file (with the risk of intervening applications and marks or other issues) or file appeals.

Even when the refusals of SOUs are justified, applicants should have the right to withdraw their submitted SOUs, and enjoy the full term of three years after the NOA (as stipulated in the trademark law and regulations) to file an acceptable SOU if they continue to maintain a bona fide intent to use their marks and file timely extension requests supported, where required by the statute, by a statement of good cause. This change would fairly restore these applicants to the same status they would have had had they not yet filed SOUs – and allow them to maintain their applications by continuing to file extensions (with appropriate USPTO fees) within the statutory period, as might be needed, until they are able to file acceptable SOUs and specimens.

This letter is to follow up on our telephone conference with you and Deputy Commissioner Sharon Marsh on 7 August 2018 to discuss the issue and to explain the necessity and importance of these changes to stakeholders. Members from the undersigned associations agree the above proposal provides the best opportunity, via rulemaking, to address the current unfairness to applicants. It is the preferred way to allow applicants to take full advantage of the three-year period by filing up to five six-month extension requests following the issuance of the Notice of Allowance.

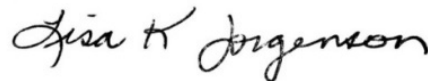
We hope that this letter serves to underscore the importance of eliminating the one “insurance extension” restriction, while at the same time affording ITU applicants the opportunity, if needed, to use the full three-year statutory period following issuance of the NOA to reach agreement with the USPTO on an acceptable specimen. We further hope that the USPTO will consider appropriate changes to the relevant Rules of Practice and the TMEP to effectuate this new practice and that you are able to move forward with the same at your earliest opportunity. We are available to assist the USPTO in any way possible, including providing additional information as you deem appropriate.

Thank you for considering our request.

Sincerely,



Etienne Sanz de Acedo
Chief Executive Officer
International Trademark Assn



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Intellectual Property Owners Assn