IP HORGAN
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Ms. Mary Boney Denison
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Re Changes in Requirements for Affidavits or Declarations of Use, Continued Use, or Excusable Use in Trademark Cases

Dear Commissioner Denison:

On 12 March 1928, engineer Tony Harnischfeger noticed that muddy water was leaking from beneath the giant St Francis Dam. Alarmed, he called water department headquarters in nearby Los Angeles. Dam boss William Mulholland and a crew came out to survey. They made some minor repairs and left. That night the damn collapsed, unleashing billions of gallons of water into the San Francisquito Valley. Over 450 people were swept to their deaths, including Harnischfeger and his family.

We agree that amending the rules to allow the USPTO to require additional proof of use to verify use claims in Section 8 and 71 filings will assist in preserving the accuracy and integrity of the register. But this ignores the real issue: the corruption of the federal register brought about by the implementation of a fundamentally flawed Madrid Protocol.

Many Madrid Protocol applications are filed in the U.S. by parties already using or who genuinely intend to use their marks on the goods and services identified. But the abuse that the system encourages tarnishes all users, both the legitimate and the misusers alike.

Because there is no pre-registration use requirement for Protocol Applications designating the U.S., it is easier for a foreign applicant to get a registration in the U.S. under the Protocol than it is for a U.S. applicant through a direct national filing. The absence of a use requirement motivates many foreign applicants, paying lip-service to bona fide intent to use rules, to claim whatever goods are of interest without any concern for showing use in commerce. So their Protocol registrations can be as wild in terms of the goods and services claimed as the applicants' imaginations. Indeed, there a number of active Protocol Applications and resultant registrations on the U.S. register claiming full class headings, and some claiming all or effectively all 45 classes.[1]

[1] See Reg. No. 3793195 PECUNIA, 3117285 VOLKSWAGEN, and 4081772 BOTSWANA OUR PRIDE, YOUR DESTINATION, among others

The havoc these Madrid registrations wreak is further magnified by their numbers: fully 40% of all Protocol applications filed during 2015 designated the U.S.[2] Madrid applications accounted for over 10% of all applications filed in the U.S. that year.[3] And those Madrid applications averaged over two classes per filing.[4] As noted by the USPTO, live registrations impose a variety of resulting costs and burdens on the public seeking to determine whether a mark is available or not.[5] But, to achieve registration, not one of those 20,000 Madrid applications was required to show any use in commerce.

No doubt the minor repairs made to the St Francis Damn were necessary, but they did not address the real problem. The USPTO's initiative seeking to more thoroughly examine use will no doubt help clear some deadwood from the federal register. However, the real problem is the forest of zombie registrations spawned by the U.S.'s accession to a flawed treaty; one that that works against the interests of legitimate businesses, and against the interests of U.S. consumers. Instead of focusing only on Section 8s and 71s, the U.S. should set its sights on fixing the Protocol.

Very truly yours,

Dermot Horgan

DJH/jkt

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[2] see Statistics under the Madrid System, http://www.wipo.int/madrid/en/statistics/annual_stats.jsp?type=EN&name=2
[3] http://www.uspto.gov/dashboards/trademarks/main.dashxml.
[4] Ibid.
[5] See Federal register Vol 81, No. 120, 40589, p 40590.