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Via Email [TMFRNotices@uspto.gov]

Commissioner for Trademarks

P.O. Box 1451,

Alexandria, VA 22313-1451

Attention: Jennifer Chicoski, Esq.

Re: NYIPLA Comments in Response to Notice of Proposed Rulemaking
Concerning Changes in Requirements for Affidavits or Declarations of Use,
Continued Use, or Excusable Nonuse in Trademark Cases,
Vol. 81, No. 120, pp. 40589-594

Dear Ms. Chicoski:

The New York Intellectual Property Law Association (“NYIPLA”) welcomes the opportunity to provide comments to the proposed rule concerning changes in Requirements for Affidavits or Declarations of Use, Continued Use or Excusable Nonuse in Trademark Cases.

The NYIPLA is a professional association comprised of over 1,500 lawyers interested in Intellectual Property law who live or work within the jurisdiction of the United States Court of Appeals for the Second Circuit, and members of the judiciary throughout the United States as ex officio Honorary Members. The Association’s mission is to promote the development and administration of intellectual property interests and educate the public and members of the bar on Intellectual Property issues. Its members work both in private practice and government, and in law firms as well as corporations, and they appear before the federal courts and the United States Patent and Trademark Office (“USPTO”). The NYIPLA provides these comments on behalf of its members professionally and individually and not on behalf of their employers.

With respect to the Notice of Proposed Rulemaking, the NYIPLA offers the following comments:

The NYIPLA supports the proposed rule change with a proposed amendment. The proposed rule change serves the important purpose of ensuring that filings to maintain trademark registrations accurately reflect the continued use of the mark with all the identified goods or services stated in the Registration certificate. The NYIPLA further believes that the proposed rule change is also an appropriate response to issues concerning the overbreadth of trademark registrations based upon foreign registrations or Madrid Protocol extensions under Section 71, as explained in the USPTO Notice of Rulemaking.

The NYIPLA proposes a change to the proposed default protocol that the USPTO would take should a trademark registrant fail to respond to an audit request. Under the proposed rule:

[t]he USPTO anticipates issuing an Office action that would specify the goods/services that will require the submission of the additional information, exhibits, affidavits or declarations, and specimens. The trademark owners would be afforded the usual response period to the Office action, that is, a response would be due within six months of the issuance date of the Office action, or before the end of the statutory filing period for the section 8 or section 71 affidavit, whichever is later. 37 CFR 2.163(b), 7.39(a). If the trademark owner responds, but is ultimately unable to provide the requested information, exhibits, affidavits or declarations, and specimens, the USPTO would deem the section 8 or section 71 affidavit unacceptable as to the goods/services to which the requirement pertained and will cancel such goods/services from the registration. ***If no response to the Office action is filed within six months of the issuance date of the Office action, or before the end of the statutory filing period for the section 8 or section 71 affidavit, whichever is later, the USPTO would cancel the entire registration, unless time remains in the grace period under section 8(a)(3) or section 71(a)(3) of the Act.*** 15 U.S.C. 1058(a)(3), 1141k(a)(3); 37 CFR 2.163(c), 7.39(b). If time remains in the grace period, the owner may file a complete new section 8 or section 71 affidavit, with a new fee and grace-period surcharge, 37 CFR 2.161(d)(2), 7.36(b)(3).

“Changes in Requirements for Affidavits or Declarations of Use, Continued Use, or Excusable Nonuse in Trademark Cases; Notice of proposed rulemaking,” 81 Federal Register 120 (22 June 2016), pp. 40589-40593 at 40591 (emphasis added).

The NYIPLA believes that cancelling the entire registration for failure to respond to an Office Action when the record contains at least one proper specimen is an overly harsh sanction. The NYIPLA, therefore, recommends instead that the USPTO only delete those goods or services that are not properly supported by the specimen as initially submitted by the registrant with its continued use affidavit or declaration. This comment, if implemented by the USPTO, will:

- be consistent with other protocols used by the USPTO during the trademark application examination process. As set forth in 37 C.F.R. § 2.65(a)(1):

(a) An application will be abandoned if an applicant fails to respond to an Office action, or to respond completely, within six months from the date of issuance. A timely petition to the Director pursuant to §§ 2.63(a) and (b) and 2.146 or notice of appeal to the Trademark Trial and Appeal Board pursuant to § 2.142, if appropriate, is a response that avoids abandonment (*see* § 2.63(b)(4)).

(1) If all refusals and/or requirements are expressly limited to certain goods and/or services, the application will be abandoned only as to those goods and/or services.

See also TMEP 718.02(a) (“General Rule. Trademark Rule 2.65(a)(1), 37 C.F.R. §2.65(a)(1), provides that if all refusals and/or requirements are expressly limited to certain goods/services, and the applicant fails to respond, or to respond completely, to an Office action, the application will be abandoned only as to those particular goods/services.”) (emphasis added).

- require minimal additional work by the USPTO since the renewal affidavit or declaration will have already been reviewed by the USPTO during the audit process and, thus, the USPTO will have already identified those items actually supported by the specimen as initially submitted by the registrant; and
- further the intended goal of the proposed rule change by ensuring that registrations are properly maintained only for those goods or services for which the trademark is actually being used.

Thank you for giving the NYIPLA the opportunity to provide feedback on the Proposed Rulemaking. We look forward to providing the USPTO with additional feedback in the future.

Respectfully submitted,



Walter E. Hanley
President, New York Intellectual Property Law Association