

Nineteen Hundred and Twenty-two

NYIPLA

The New York Intellectual Property Law Association®

BOARD OF DIRECTORS

OFFICERS

PRESIDENT

Annemarie Hassett
1.212.998.6595
annemarie.hassett@nyu.edu

PRESIDENT-ELECT

Matthew B. McFarlane
1.212.328.1175
matt@groutprojects.com

1st VICE PRESIDENT

Peter G. Thurlow
1.212.413.2832
pthurlow@polsinelli.com

2nd VICE PRESIDENT

Kathleen E. McCarthy
1.212.556.2345
kmcCarthy@kslaw.com

TREASURER

Robert J. Rando
1.516.799.9800
rrando@randolawfirm.com

SECRETARY

Heather Schneider
1. 212.728.8685
hschneider@willkie.com

MEMBERS

Mark H. Bloomberg
Frank A. DeLucia Jr.
Faith S. Hochberg
Robert M. Isackson
William J. McCabe
Douglas R. Nemecek
Colman B. Ragan
Irena Royzman
Marian Underweiser

IMMEDIATE PAST PRESIDENT

Walter E. Hanley
1.212.908.6263
walterhanley@andrewskurthkenyon.com

NYIPLA EXECUTIVE OFFICE

2125 Center Avenue, Suite 406
Fort Lee, NJ 07024-5874
Tel: 1.201.461.6603
Fax: 1.201.461.6635
E-Mail: admin@nyipla.org
Website: www.nyipla.org

August 11, 2017

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria VA 22313-1451

Attn: Cynthia Lynch, Administrative Trademark Judge

Re: NYIPLA Comments
“Improving the Accuracy of the Trademark Register: Request for Comments on Possible Streamlined Version of Cancellation Proceedings on Grounds of Abandonment and Nonuse”
Docket No. PTO-T-2017-0012
82 FR 22517-22519 (May 16, 2017).

Dear Administrative Trademark Judge Lynch:

The New York Intellectual Property Law Association (“NYIPLA”) welcomes the opportunity to provide its comments to the proposed “Streamlined Proceedings” outlined in the Federal Register Notice cited above.

The NYIPLA is a professional association comprised of over 1000 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 NYIPLA’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”), including the Trademark Trial and Appeal Board (“TTAB”). The NYIPLA provides these comments on behalf of its members professionally and individually and not on behalf of their employers.

In response to the request for comments, the NYIPLA offers the following.

The NYIPLA does not believe that the proposed rule change is a necessary or appropriate response to the issue concerning marks registered on the Principal Register that are not in use. Rather than creating a new protocol and procedure for cancellation proceedings, the NYIPLA believes that the USPTO could better address the issue by focusing its resources on ensuring that the existing procedures are utilized and expeditiously initiated by the USPTO and TTAB staff.

In particular, the NYIPLA believes that cancellation proceedings can already be resolved within the 170-day time frame suggested by the proposed rule. In the experience of our members, many cancellation proceedings are resolved by default judgments because the respondent is not using the mark at issue. However, unnecessary delays may occur either when the TTAB does not expeditiously enter the notice of default after the respondent has not timely filed an answer, or, when the notice of default is entered, the TTAB does not expeditiously enter the default judgment after the respondent has not timely shown cause. In our members’ experience, default judgments can take months to issue, often times requiring repeated calls to the TTAB paralegal and/or interlocutory attorney. Thus, it is our position that if the TTAB procedures that are already in place were followed in a more timely manner, cancellation proceedings could be resolved in a much quicker time frame than 170-days.

The NYIPLA further believes that the procedure set forth in the proposed rule change is redundant of the Accelerated Case Resolution (“ACR”) procedure already in place. If a respondent appears to defend the cancellation, parties wishing to use an expedited procedure can elect to proceed on an ACR schedule rather than a full cancellation proceeding. We note that the ACR procedure is generally not elected in *ex parte* proceedings, which calls into question whether another Streamlined Proceeding is needed and whether such a proceeding is likely to be utilized.

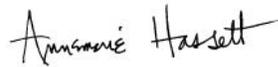
Moreover, the NYIPLA encourages the USPTO to consider additional instructions and training for its staff, to allow them to take a closer look at specimens to ascertain whether the specimens reflect genuine use or are doctored or specifically created solely for use to support an application or registration. The burden to closely inspect specimens is better considered by the USPTO, rather than stakeholders. Moreover, the USPTO could improve the process by providing greater attention to cancelling registrations when the registrants have not timely filed Section 8 / Section 9 declarations. In our members’ experience, the USPTO does not cancel these registrations for a significant period of time after the grace period has expired, which we believe contributes to the excess of marks on the Principal Register that are not in use.

If the TTAB nevertheless decides to move forward with further consideration of a Streamlined Proceeding, the NYIPLA provides the following comments:

- The NYIPLA is concerned with the requirement to plead the grounds with “particularity” and the requirement that the petition “would be required to be supported by the proof upon which the petitioner relies to establish both standing and the claim of abandonment and/or nonuse.” The NYIPLA notes that it may be difficult to meet the particularity requirements because the petitioner is trying to prove a negative, i.e., non-use, and to prove the registrant’s intent – which is uniquely within the registrant’s knowledge.
- The provisions for limited discovery do not appear to be balanced: the respondent can ask for discovery on standing but there is no language providing the petitioner with the opportunity to request discovery.
- The NYIPLA further suggests providing that: (1) the petitioner can make its initial showing based on (a) a current Internet search for the mark and the relevant goods and services and (b) a search of the registrant’s website if registrant has one; and (2) the respondent must have documentary evidence, created before the commencement of the proceeding, that reflects intent to resume use in order to overcome the presumption.
- The NYIPLA disagrees with footnote 2 contained in the proposal, which rejects the need for any mechanism for the respondent to convert the Streamlined Proceeding to a full proceeding. A respondent should be allowed the option to convert the Streamlined Proceeding to a full proceeding rather than only the opportunity to answer with evidence rebutting the submissions by the petitioner. For example, the respondent may want to depose the investigator that procured the facts upon which the petitioner’s assertion of abandonment is based.

Thank you for giving the NYIPLA the opportunity to provide comments on the proposed Streamlined Proceedings.

Respectfully submitted,



Annemarie Hassett, President

New York Intellectual Property Law Association