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March 20, 2019

Hon. Mary Boney Denison
Commissioner for Trademarks
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Request for Comments Concerning Requirement of U.S. Licensed
Attorney for Foreign Trademark Applicants and Registrants

Dear Commissioner Denison:

I write on behalf of the American Bar Association Section of Intellectual Property Law (the "Section") in response to the United States Patent and Trademark Office's (the "Office's") request for comments concerning *Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants*, published at 84 Fed. Reg. 4393 (PTO-T-2018-0021, February 15, 2019) (the "Notice"). The views expressed herein are presented on behalf of the Section of Intellectual Property Law. They have not been approved by the House of Delegates or the Board of Governors of the American Bar Association and, accordingly, should not be construed as representing the position of the Association.

The Section strongly supports the Office's goal of protecting the integrity of the trademark register and agrees that the Office should be able to enforce foreign applicant and registrant compliance with Office requirements effectively. To that end, the Section generally supports the Office's revisions of parts 2 and 11 of title 37 of the Code of Federal Regulations to require foreign applicants and registrants to be represented by U.S. licensed attorneys.

In support of the Office's goal, the Section has several recommendations and questions for the Office and therefore respectfully submits the following comments.

EFFECTIVENESS OF PROPOSED RULE IN FURTHERING THE OFFICE'S STATED GOALS

As stated above, the Section strongly supports the Office's goal of protecting the integrity of the trademark register. The Section also believes in the value and importance of legal representation in trademark matters before the Office. The

drafting and prosecution of a trademark application require many legal decisions that could drastically change the scope and validity of a resulting registration. The same is true for both maintenance filings and proceedings before the Trademark Trial and Appeal Board. Accordingly, the Section believes all applicants should consider hiring effective counsel before or in lieu of applying for a trademark application *pro se*.

The Section recognizes that the proposed rule may substantially reduce the number of foreign applications filed with doctored and fraudulent specimens and also reduce the incentive and ease in which unauthorized foreign companies and individuals provide improper representation to foreign applicants, thereby reducing the unauthorized practice of law before the Office. The potential drawback however is that the proposed rule may have the effect of increasing costs for legitimate foreign applicants, including those who might otherwise have filed *pro se*.

Notably, U.S. licensed attorneys are not required to independently verify the validity of specimens submitted by their clients when prosecuting a trademark application and may rely on the sworn statements and specimens provided by their clients. Further, unlike the Patent Bar, the Office does not require prerequisites before any licensed U.S. attorney may represent foreign and domestic clients in trademark matters before the Office.

TIMING OF REPRESENTATION

The Notice states that, under the proposed rule, foreign applicants will be permitted to obtain a priority date before being required to seek a licensed U.S. attorney. The Notice also seeks comment on the timing of the proposed rule's new requirements.

As an initial matter, the Section asks that the Office consider further whether to allow foreign applicants to obtain a priority date prior to their representation by a licensed U.S. attorney.

As a basis for the proposed rule, the Notice cites "international considerations" but does not state what those considerations are. The Section is concerned that the proposed rule allowing foreign applicants to secure a priority date without being represented by a licensed U.S. attorney will create an administrative burden on the Office to examine filings for non-compliance as well as a burden on other applicants and registrants who must monitor and analyze marks in applications that otherwise were not in compliance with U.S. regulations.

37 C.F.R. §2.21 already provides several grounds for denying a filing date to an applicant, including an improper "name and address for correspondence." The Section asks the Office to consider whether, in light of international considerations, the Office would further its goals of reducing fraud by amending section 2.21 to include the requirement for foreign applicants to be represented by a licensed U.S. attorney. If this requirement might interfere with the U.S.'s obligations under various intellectual property treaties and agreements, the Section believes that the Office should make the

Office's analysis of these treaty considerations available for stakeholders to review and comment.

The Notice seeks specific comments on whether the Office Action refusing an unrepresented foreign applicant's application should be issued before substantive examination or after such. If the Office implements the proposed rule as stated in the Notice, the Section recommends that the Office issue the refusal before the substantive examination of the application to reduce the burden on the Office's examining attorneys.

The Section asks for clarification on how the Office will analyze these refusals under the Office's public data reporting of the pendency times for first actions for trademark examinations. Pendency has been an important metric for the Office's efficiency, and the public reporting of these numbers is a valuable data point for trademark applicants and practitioners. Accordingly, the Section asks that the Office consider the integrity of this data in connection with the procedures of the proposed rule.

AMENDMENTS TO FORMS TO PROMOTE COMPLIANCE

If the Office implements the proposed rule as stated in the Notice, the Section recommends that the Office amend its forms to reference the new requirement in several different languages. The Section believes that this will help increase the likelihood that foreign applicants and registrants who are not in compliance with the proposed rule will seek U.S. counsel before applying for a trademark or submitting maintenance filings with the Office and may help reduce the administrative burden on the Office's staff. The Section believes that this additional notice may help further the Office's goal of protecting the integrity of the register.

Further, if the Office implements the proposed rule change to § 2.32(a)(4), the Section recommends that the Office revise the application form to include a section for the attorney's bar license information.

SPECIAL RULES FOR MADRID PROTOCOL APPLICANTS

The Notice seeks specific comments on whether to allow applications filed by unrepresented foreign applicants based on extensions of the Madrid Protocol under § 66(a) of the Lanham Act to proceed to publication and registration if such applications meet all other statutory requirements and would otherwise not be issued an Office Action.

The Section does not have specific comments regarding the exception at this time, but generally recommends that any exceptions to the proposed rule be limited and carefully implemented to maintain the Office's goals stated in the Notice.

FOREIGN AUTHORIZED ATTORNEYS

The Notice proposes amending § 11.14 to clarify that only registered and active foreign attorneys or agents who are in good standing before the trademark office of the country in

which the attorney or agent resides and practices may be recognized for the limited purpose of representing parties located in such country, provided the trademark office of such country and the Office have reached an official understanding to allow substantially reciprocal privileges.

The proposed rule would also require that in any trademark matter where an authorized foreign attorney or agent is representing a party, that a qualified U.S. attorney must also be appointed as the representative with whom the Office will communicate and conduct business.

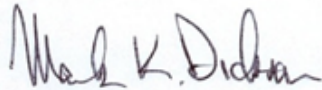
The Section supports this proposed rule change.

The Section also supports the Office's proposal to seek more reciprocal agreements with other countries. However, the Section seeks additional information on how the Office identifies, negotiates and implements these reciprocal agreements, particularly in relation to differences in the roles and licensing of attorneys in other jurisdictions.

CONCLUSION

The ABA-IPL Section commends the Office for its consideration of these issues and appreciates the opportunity to offer these comments.

Very truly yours,

A handwritten signature in black ink, appearing to read "Mark K. Dickson". The signature is written in a cursive style with a large initial "M".

Mark K. Dickson
Chair, ABA Section of Intellectual Property Law