From: David Michaels
To: TM FR Notices
Subject: Comments re Docket No. PTO-T-2018-0021
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Comments about the proposed USPTO Practice Rule

I disagree with a proposed action and I am suggesting an alternative.

Requiring all foreign applicants, registrants, or parties to be represented by a qualified U.S. attorney will not instill greater confidence in the public that U.S. registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper use claims.

While I agree that fraudulent use in commerce claims are a huge problem, there are better ways to ensure that such claims are reliable and subject to audits. I have proposed alternative changes to the trademark application process as detailed below.

Commenter's Qualifications

I have a law degree from a US law school and I have 27 years of experience dealing with US trademark matters. I am currently an entrepreneur and an officer of a few Canadian and US-based startups. I have also been a member of INTA for several years. I operate a trademark search business and a few e-commerce startups. One of my startups won the Global Legal Hackathon 2018 event in Toronto, Canada. We developed a reverse image trademark search app for design marks. I am also the owner of at least two US registered trademarks and I have at least five approved US trademark applications that are pending. Two of my pending applications are in TTAB opposition proceedings.

The burden on Canadian-based Startups and Entrepreneurs

Hiring a US-licensed attorney to file trademark applications for my Canadian based startups would be a significant burden to the startups; it would be a waste of funds for me because I am adept at filing and prosecuting my own applications. And hiring an attorney to handle TTAB opposition proceedings can be cost prohibitive for most startups and small businesses including mine.

Lack of National Treatment

The proposed rule will treat Canadians and Canadian businesses less favorable than US nationals and US businesses because of the added cost of hiring US-licensed attorneys to file and prosecute trademark applications will make it more expensive to establish, acquire, and expand my investments in the USA.

As such, the proposed rule appears to violate Article 1102 of NAFTA on National Treatment:

> 1. Each Party shall accord to investors of another Party treatment no less favorable than that it accords, in like circumstances, to its own investors with respect to the establishment, acquisition, expansion, management, conduct, operation, and sale or other disposition of investments.

In contrast, Canada has updated its Trademarks Act to enable anyone to file and prosecute their own trademark applications. So after June 17, 2019, any US person will be able to directly file their own trademark application in Canada and CIPO will not require the applicant to have or maintain a Canadian address, representative, or trademark agent.

US-Licensed Attorneys Will Usually Not Do Any Due Diligence

Will all US-licensed attorneys be required to do some due diligence to ensure that use claims are valid in all of the trademark applications they file or just the ones they filed on behalf of foreigners? I doubt that they will do either.

Suspect Specimens Filed By US-licensed Attorneys

I have encountered many suspect trademark specimens filed by various US-licensed attorneys that have matured to registrations over the years.

The original specimens submitted in the following two examples are suspect:

In U.S. Registration No. 4227082 for AMKI ORIGINAL SESAME SNAPS, the applicant is represented by a licensed New Jersey attorney. The original specimen filed on August 30, 2012, appears to be a mockup and it has two pieces of paper underneath it to hide the surface. In contrast, the specimen filed on October 16, 2018, is shown in what appears to be a retail setting.

In U.S. Registration No. 4846244 for TINY HINEY, the applicant is represented by a licensed California attorney. The specimen for the lotion is held in a person's hand over an office desk. The TINY HINEY lotion can't be found on Amazon.com or any other part of the internet. The specimen is not shown in a commercial setting and the label doesn't look like it was mass produced.

Alternative Changes To Ensure the Integrity of the U.S. Trademark Register

To combat trademark specimen/SOU fraud, I suggest that the specimen filing includes more details to permit audits of specimens, such as:

An explanation has to how the alleged use of the trademark is "use in commerce" and require applicants to include information to enable stakeholders the ability to audit the claimed use of trademarks on goods:

If the SOU is for the sale of goods, require applicants to attach:

a. Photos of the trademark as it is used on the goods or on the packaging of the goods;

b. Photos of the packaging, from all sides to ensure that the packaging is in compliance with any applicable Federal labeling laws;

c. At least two invoices in the ordinary course of trade showing the full details of the transaction, the source of the transaction (e-commerce, telephone order, etc...), and

d. Proof of shipment and delivery (FedEx, UPS, or other shipping information.)

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