

November 5, 2012

The Honorable Deborah S. Cohn  
Commissioner for Trademarks  
United States Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

Via email: (TMFRNotices@uspto.gov)

**Re: Comments in response to the USPTO's Request for Comments Regarding Amending the First Filing Deadline for Affidavits or Declarations of Use or Excusable Nonuse, 77 Fed. Reg. 49425 (August 16, 2012), and Extension of Comment Period, 77 Fed. Reg. 58097 (September 19, 2012)**

Dear Commissioner Cohn:

The American Intellectual Property Law Association (“AIPLA”) is pleased to have the opportunity to present its views with respect to the United States Patent and Trademark Office (“Office”) proposal to change the time period for filing Section 8 and 71 affidavits of use, as contained in its Request for Comments Regarding Amending the First Filing Deadline for Affidavits or Declarations of Use or Excusable Nonuse, as published in the August 16, 2012 issue of the *Federal Register*, 77 Fed. Reg. 49425 (“Proposal”), and Extension of Comment Period as published in the September 19, 2012 issue of the *Federal Register*, 77 Fed. Reg. 58097.

AIPLA is a national bar association with approximately 14,000 members who are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

**A. Removing Deadwood and Creating A More Accurate Register**

The Office proposes a legislative change to reduce the filing deadline for Affidavits or Declarations of Use or Excusable Nonuse under Sections 8 and 71 of the Trademark Act, from between the fifth and sixth years after the registration date, to between the third and fourth years after the registration date. AIPLA understands that one of the main goals of the Proposal is to remove deadwood from the Federal Register, namely marks that are no longer in use, or marks having overbroad identifications of goods and services.

AIPLA generally supports efforts to remove deadwood from the Federal Register so that it accurately reflects the realities of the marketplace and the true scope of protection as established by proof of actual use of marks in commerce. AIPLA is concerned, however, that the Proposal would require a significant statutory change even though there is no empirical evidence or consensus showing that the Proposal will actually have any meaningful impact.

AIPLA urges the Office to consider gathering and disclosing further historical data concerning Section 8 and 71 filings, including the annual number of registrations that are cancelled for failure to file Section 8 and 71 declarations and the annual number of registrations that are modified or amended through Section 8 and 71 filings. Without such data, it is difficult to determine whether the Proposal will have any meaningful impact on deadwood, beyond mere speculation. If the Office does not have access to such data, it is possible that well-established independent companies may have the ability to gather such information. To facilitate the compilation and review of the data and its implication on the Proposal, AIPLA would be willing to participate in the gathering of further input from the user community.

#### **B. Impact on Registrations Issued Under Sections 44 & 66**

AIPLA understands that the Proposal would apply to all registrations, including those issued under Sections 1, 44, and 66 of the Trademark Act, 15 U.S.C. §§ 1051, 1126, and 1141f. At this time, owners of registrations issued under Sections 44 and 66 are not required to submit proof of use of their mark in interstate commerce until they make the initial Section 8 or 71 affidavit filings, which are due between the fifth and sixth years after the U.S. Registration issues.

AIPLA is concerned that the Proposal may impose an undue burden on international registrants who are not accustomed to submitting proof of use as early as three years after registration issues in order to maintain their rights. It is not uncommon for international-based registrants to need additional time, beyond the first three years after registration, to break into the U.S. market. If the Office shortens the deadline for submitting proof of use of the mark in the U.S., some of these international companies may be placed in the tough position of losing their registration rights, even though they have been taking firm steps to enter the U.S. market.

AIPLA is also concerned that the Proposal may be inconsistent with general U.S. intellectual property harmonization goals, as the proposed change arguably makes maintaining and optimizing a U.S. trademark registration even more onerous than current practice, compared to other offices (i.e., by requiring proof of use earlier and removing the possibility of a combined Section 8 or 71 and 15 filing).

**C. Separate Filing Deadlines for Section 8 & 15 Affidavits**

AIPLA notes that, if implemented, the Proposal will effectively eliminate the “Combined Section 8 and 15” filings, which will likely increase the costs and complexity of handling separate post registration filings. Taking the grace period into account, under the Proposal there would only be a separation of approximately six months between the time a registrant could file its Section 8/71 affidavit and its Section 15 affidavit. This could cause significant confusion among clients and practitioners regarding the need to file a Section 15 affidavit so soon after the mandatory Section 8/71 filing, and at the very least would require significant changes to docketing procedures and software used by many companies and law firms.

AIPLA is concerned that the administrative costs and burdens on registrants and practitioners outweigh the prospective, and unproven, effect on the level of deadwood on the Federal Register. Further, requiring separate filings so close in time will likely have the adverse impact of increasing workload and other burdens on the Office to process the separate maintenance filings.

**D. Cancellation Alternatives Already Exist to Clear Deadwood**

The Office already offers cancellation proceedings as a means to clear deadwood based on claims of abandonment, lack of a bona fide intent to use, and restriction under Section 18. Thus, to the extent that a party believes that a mark is no longer in use or has not commenced use, there is a remedy by way of cancellation. With respect to marks for which the registrant would otherwise not file a Section 8/71 declaration and would abandon, the registrant is likely to default in the cancellation proceeding, resulting in cancellation of the mark. The cost of prosecuting such a cancellation proceeding is relatively modest, and that burden is carried by a party with a personal interest in the mark. In contrast, as noted above, changing the Section 8/71 filing deadline would require regular filing of separate Section 8/71 and 15 declarations for everyone, and would thus impose additional cost and burdens on the entire user community.

**E. Conclusion**

Although AIPLA generally supports the goal of clearing deadwood from the register, it is unclear whether the current Proposal will have any meaningful impact over the current system. Further, the Proposal will likely increase the time and resources registrants expend to handle separate Section 8 and 71 and Section 15 declarations (as opposed to the current option of filing a Combined Section 8/15 declaration), and it may impose an undue burden on international registrants. In sum, AIPLA believes that the Proposal represents a significant statutory change, and it urges the Office to consider further studying the Proposal with well-grounded input from users.

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AIPLA appreciates the opportunity to comment on this important Notice. Please contact us if you would like us to provide more details on any issue discussed above.

Sincerely,

A handwritten signature in black ink, appearing to read "Jeffrey I.D. Lewis". The signature is written in a cursive, flowing style with a large initial "J".

Jeffrey I.D. Lewis  
President  
American Intellectual Property Law Association