



**INTELLECTUAL PROPERTY LAW
ASSOCIATION OF CHICAGO**

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October 15, 2012

VIA EMAIL

TMFRNotices@uspto.gov

Attn: Cynthia C. Lynch
Office of the Deputy Commissioner
for Trademark Examination Policy
P.O. Box 1451
Alexandria, VA 22313-1451

**Re: Comments on Amending First Filing Deadline for Affidavits or
Declarations of Use or Excusable Nonuse**

Dear Ms. Lynch:

I am the President of the Intellectual Property Law Association of Chicago (IPLAC), one of the largest intellectual property law associations in the United States. Established in 1884, IPLAC is the nation's oldest bar association focused on patent and trademark law. The Association's founding members declared their original purpose to include "aiding reforms in the administration of the Patent Office," and "discussing such other matters hereafter to arise as may be of common interest . . ." Today, one such common interest is the improvement of the trademark system.

The purpose of this submission is to provide IPLAC's comments on the points raised in the "Request for Comments Regarding Amending First Filing Deadline for Affidavits or Declarations of Use or Excusable Nonuse," 159 F.R. 49425-49426 (August 16, 2012) ("the Notice"). These comments were drafted by our Trademark and Anti-Counterfeiting Committee, taking into consideration both the views of those who prosecute trademark applications and those who litigate issues related to registered trademarks, and reviewed and

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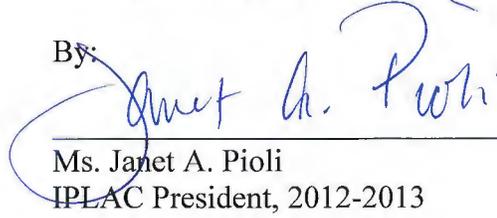
approved by the IPLAC Board of Managers – its governing board. This submission is being filed on or before the deadline of October 15, 2012.

The Office is respectfully requested to give consideration to the attached comments prepared by the Intellectual Property Law Association of Chicago.

Sincerely,

Intellectual Property Law Association of Chicago

By:



Ms. Janet A. Pioli
IPLAC President, 2012-2013

Attachment (3 pages)

1) Is “deadwood” on the trademark register a concern of yours, and what impact do you believe it has?

Comment: Yes, “deadwood” on the trademark register is a concern of ours. Often new trademark applications are rejected based on a likelihood of confusion under Section 2(d) with registrations listing similar goods/services that are no longer being sold or offered for sale under the cited mark. In addition, an application may be rejected based on a likelihood of confusion with an application filed under the Madrid Protocol or based on Section 44. Applications filed under the Madrid Protocol and Section 44 often include an extensive listing of goods and/or services, as is the practice in many foreign jurisdictions with treaty ties to the U.S. Because there is no requirement to show use until before the end of the sixth year in such registrations, it is unclear which, if any, goods/services are actually sold or offered for sale in association with these mark(s).

Such lack of use or proof of use presents a challenge to an applicant faced with a Section 2(d) rejection. To overcome the rejection, the applicant can attempt to argue around the rejection, which can lead to the unnecessary narrowing of the mark or the inclusion of unnecessary admissions regarding the strength of elements of the mark or the mark in general. In addition, such arguments are often fruitless and can result in a final rejection forcing the applicant to initiate a cancellation proceeding, and/or attempt to contact the owner of the cited mark(s) so as to take steps to secure the registration. Particularly for small businesses or individual applicants with limited resources, these options often prove to be too costly and burdensome to pursue. This often results in a decision to abandon the application.

Accordingly, eliminating deadwood would reduce the time and expense associated with Section 2(d) refusals based on marks that were never, or are no longer, being used with the goods/services listed in the cited registration.

2) Do you favor or oppose an amendment to shorten the first filing deadline for Affidavits or Declarations of Use or Excusable Nonuse under Sections 8 and 71 as a means of ensuring the accuracy of the trademark register? (Please explain why)

Comment: We are in favor of shortening the deadline. However, while there is merit to shortening the first filing deadline, we do not see it as a cure-all. Although the Trademark Office

indicates that a majority of businesses (or products) fail before their third year,¹ many can fail after their fourth year and prior to their sixth year. Thus, some deadwood that would be cleared under the current system would remain until expiration of the renewal period (i.e. an additional 4 to 5 1/2 years). However, on balance, we believe that the large number of applications being filed for goods which will *never* be used (i.e. Section 66 applications) will be cleared much faster and much less expensively than if a cancellation action based on fraud or non-use is required.

Second, as explained in more detail below in response to Question No. 4, shortening the first filing deadline for the Section 8 and 71 Declaration could result in added costs to the owner of a registration as well as the possibility of a missed opportunity for the earliest possible Section 15 filing and/or meaningless Section 15 filings.

It is also our recommendation that if the first filing deadline is shortened, that all registrations obtained before the date such change goes into effect be grandfathered under the current law, thereby retaining the first filing deadline between the fifth and sixth years.

3) If you favor shortening the deadline, what time period do you believe would be most appropriate for the first filing deadline?

Comment: Section 45 of the Lanham Act, 15 U.S.C. § 1127, provides “[n]on-use [of a mark] for 3 consecutive years shall be prima facie evidence of abandonment.” The proposed Section 8 filing period would begin to run at the same time the presumption of abandonment arises. The change to section 8 of the Lanham Act would thus comport more closely with Section 45 than currently. We believe this is appropriate.

4) Are you concerned that an amendment to the first Section 8 and 71 affidavit deadline would foreclose the ability to combine the filing with the filing of an Affidavit or Declaration of Incontestability under Section 15? What impact do you believe separating these filings would have?

Comment: We do have this concern. The filing of a combined Section 8 (or Section 71) and 15 Declaration is desirable because it can save registrants time and money. This is particularly true when registrations are handled by outside attorneys. By eliminating the combined declaration, an attorney will need to contact his client at least twice as often regarding

¹ See Request for Comments Regarding Amending the First Filing Deadline for Affidavits or Declarations of Use or Excusable Nonuse, 77 Fed. Reg. 49,425 (Aug. 16, 2012).

the maintenance and incontestability of the registration and then make the necessary separate filings. This will require more of the attorney's attention and time thereby resulting in increased costs to the registrant. In addition, eliminating the combined declarations may result in a failure, or a significant delay, on the part of the registrant in filing the Section 15 Declaration. In addition, we have a concern regarding the integrity of the Section 15 filing. Presently Sections 8 and 71 require the submission of a specimen showing use of the mark in commerce at the time of filing; Section 15 does not impose such a requirement. Under the current system, Section 15 Declarations are generally filed in combination with a Section 8 or 71 Declaration. Therefore, a specimen is coincidentally provided. However, if the Section 8 (or 71) and Section 15 Declarations are separated, a specimen will no longer accompany the Section 15 filings, thus no actual substantiation of any type of use (other than the signed declaration of registrant) will be available. We understand that the Trademark Office does not "accept" Section 15 affidavits, nor determine whether the mark for which a Section 15 declaration is filed actually is incontestable. *See* TMEP § 1605.

However, we recommend, if the Section 8 (or 71) and Section 15 Declaration timing is changed, that a current specimen of use be required with the Section 15 filing. We also recommend that the specimen be examined. This will ensure a more meaningful Section 15 filing because the applicant will perforce take more time and effort to prepare it.