

August 11, 2008

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These are the comments of Fross Zelnick Lehrman & Zissu, P.C., a New York based law firm that practices extensively in the field of trademark law and before the USPTO, on the proposed rules entitled "Miscellaneous Changes to Trademark Rules of Practice", published in the Federal Register on Thursday, June 12, 2008 at 73 Fed Reg 114, p. 33356.

Further clarification of the proposed changes to Rules 2.85(d) and 2.85(f) is respectfully requested. These proposed changes are summarized as follows:

(d) Section 66(a) applications and registered extensions of protection. In an application under section 66(a) of the Act or registered extension of protection, the classification cannot be changed from the classification assigned by the International Bureau of the World Intellectual Property Organization, unless the International Bureau corrects the classification. Classes cannot be added, and goods or services cannot be transferred from one class to another

(f) Classification schedules shall not limit or extend the applicant's rights, except that in a section 66(a) application, the scope of the identification of goods or services for purposes of permissible amendments (see § 2.71(a)) is limited by the class, pursuant to § 2.85(d).

At present, the Office follows a practice of refusing to permit Madrid Protocol applicants to amend goods/services that are deemed insufficiently specific by the Office's standards if the more specific item that the applicant seeks to identify is classified by the US in a class other than the class in which the unacceptable good/service was classified by the International Bureau. The justification for this practice is that "the classification cannot be changed from the classification assigned by the International Bureau of WIPO unless the IB corrects the classification."

The proposed rule changes could be interpreted as being intended to institutionalize this practice.

If that is the case, then we urge the USPTO to reconsider its position. Among other things, this reasoning does not take into account the fact that in some instances when this rule is applied, the applicant is seeking to identify a good/service that was not the subject of classification by the IB. For example, the IB may have classified "nutritional aids" in

the extension of protection international class 30, but since the US requires that “nutritional aids” be identified more specifically, the applicant may then seek to amend “nutritional aids” to the more specific term “nutritional supplements”. “Nutritional supplements” has not been the subject of classification by the IB in this extension of protection. But because “nutritional supplements” are classified by the US in international Class 5, the amendment is refused.

This practice, however, works a complete forfeiture of rights to U.S. Madrid extension applicants as to those goods or services deleted. The potential hardship this practice works on U.S. Madrid applicants, and the chilling effect of the resulting disparate handling of U.S. extension applications on successful implementation of the Madrid Protocol, should be readily apparent. To the extent that institutionalizing this rule is the purpose of the proposed amendment to Rules 2.85(d) and 2.85(f), we oppose it.

Such hardship and effects also are seemingly avoidable. In keeping its present practice and proposing these rule changes, the USPTO is probably concerned about the integrity of its trademark records and the ability of these to support substantial reliance on class based searching by the public. This is a sound concern. But other and less drastic administrative measures may also address this concern and do not require U.S. Madrid applicants to risk losing their substantive rights.

For instance, the USPTO could consider implementing a "pseudo classification" system. This system would function in a manner analogous to how alternative meanings or pronunciations of marks are included in a "pseudo mark" line for searching purposes. Such a system would allow trademark records with goods or services "misclassified" by the IB to be accessible on-line by searches of all relevant classifications, including those the USPTO regards as the "correct" international classes. Thus, U.S. Madrid applicants could amend goods and services classifications the same way non-Madrid filers presently do, and retain the full scope of protection afforded by registration.

Insofar as examining attorneys already examine goods and services identifications, and determine certain goods or services in Madrid Protocol extension applications are "misclassified" or that amendment would be limited by their IB classification issues, there would be little additional administrative burden in recording the correct classifications and updating the search databases accordingly. A "pseudo classification" system would even address situations where an acceptable good or service is misclassified by the IB. Currently, and even under the proposed rule, the U.S. must accept any acceptably definite terms in a Madrid extension application in the class provided by the IB.

However, the proposed rule changes could also be interpreted to mean that the USPTO will permit the amendment to be made even if it results in a registration issuing with the good/service in the “wrong” class under the US classification system. Following the example given above, the Office could decide to permit the applicant to identify nutritional supplements in Class 30, even though this deviates from the usual US system.

We would support this interpretation of the proposed rule change. In fact, this result is already occurring in some instances. For example, if the International Bureau initially classified “nutritional supplements” in Class 30, then the USPTO will accept this classification, since the goods are identified sufficiently specific under US practice. Therefore, since there already are discrepancies to the US system of classification that must be accepted pursuant to the terms of the Madrid Protocol, a fairer result is to permit applicants in all cases to obtain protection for the goods/services they seek to protect in the US by means of the Madrid Protocol extension despite discrepancies in classification between the IB and the US.

Thank you for the opportunity to comment on the proposed rules.