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**COMMENTS OF THE INTERNATIONAL TRADEMARK ASSOCIATION'S USPTO
SUBCOMMITTEE ON THE NOTICE OF PROPOSED RULEMAKING ENTITLED
"MISCELLANEOUS CHANGES TO TRADEMARK RULES OF PRACTICE"
PUBLISHED IN THE FEDERAL REGISTER ON
JUNE 12, 2008**

On behalf of the International Trademark Association ("INTA"), INTA's U.S. Patent and Trademark Subcommittee hereby submits comments on the United States Patent and Trademark Office's (USPTO) Proposed Rule on "Miscellaneous Changes to Trademark Rules of Practice" (the "Proposed Rules") found at 73 Fed. Reg. 33356-33372 (37 CFR Parts 2, 3, 6 and 7).

We commend the USPTO for its rewording, reorganization, codification and clarification of current trademark prosecution practice in the Proposed Rules. Overall, INTA agrees that the Proposed Rules succeed in clarifying the law. Therefore, our comments focus on areas where further clarity and changes are recommended.

A. SPECIFIC COMMENTS

1. Applications for Registration

Proposed Rule § 2.21(a) - Requirements for receiving a filing date.

Comment: This rule currently applies to applications filed under Section 1 and Section 44. It is not clear whether the USPTO is also seeking to impose this requirement on Section 66(a) applicants. The proposed rule will require that all applications filed in the U.S. must be in English or the Applicant will not be accorded a filing date.

Madrid permits an Applicant to file in one of three languages: Spanish, French, or English. If the Office of Origin designates a particular one of these languages, then the application must be in the specified language. If no language is specified by the Office of Origin, then applicant may select any one of these three languages (Madrid Common Regulations, Rule 6(1)(b)). The International Bureau at WIPO thereafter extends the filing to any countries designated by the Applicant in the language used by the applicant, unless that Office has notified the International Bureau that any such notifications are to be in English, in French or in Spanish (Madrid Common Regulations, Rule 6(2)(iii)). The USPTO should notify the International Bureau, if it has not previously done so, that all communications sent by the International Bureau to the USPTO be in English, regardless of the language of the application.

Proposed Rule § 2.32(a)(3)(iii) - Requirements for a complete application.

Comment: Although consistent with the TMEP and past practice, this requirement imposes an unfair burden of disclosure on domestic applicants because it does not apply to foreign partnerships.

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Proposed Rule § 2.32(a)(3)(iv) - Requirements for a complete application.

Comment: Again, although consistent with the TMEP and past practice, this requirement imposes an unfair burden of disclosure on domestic applicants.

Proposed Rule § 2.32(a)(9) - Requirements for a complete application.

Comment: We note inconsistent treatment requiring translations between non-English wording and non-Latin characters. We ask the USPTO to consider whether the rules should also require an applicant to state whether non-English wording has no direct English meaning (e.g., idiomatic expressions).

Proposed Rule § 2.32(a)(10) - Requirements for a complete application.

Comment: Although this rule is consistent with the long-standing practice of the Office, we note inconsistent treatment requiring translations between non-English wording and non-Latin characters. We ask the USPTO to consider whether the rules should also require an applicant to state whether non-English wording has no direct English meaning (e.g., idiomatic expressions).

Proposed Rule § 2.34(a)(1)(v) - Bases for filing.

Comment: Because TEAS does not provide currently this feature, it should be updated to accommodate the disclosure of the goods/services to which the date of first use applies.

Proposed Rule § 2.56(d)(4) - Specimens.

Comment: INTA commends the USPTO for broadening its support of PDF files.

2. Intent to Use

Proposed Rule § 2.88(b)(1)(ii) - Filing statement of use after notice of allowance.

Comment: Since TEAS does not provide currently this feature, it should be updated to accommodate the disclosure of which goods/services the date of first use applies.

Proposed Rule § 2.89(a)(2) - Extensions of time for filing a statement of use.

Comment: The term “additional time” is undefined. No time period is set forth in the rule or TMEP 1108.02(c).

Proposed Rule § 2.89(b)(2) - Extensions of time for filing a statement of use.

Comment: The term “additional time” is undefined. No time period is set forth in the rule or TMEP 1108.02(c).

3. Assignment Cover Sheet

Proposed Rule § 3.31(a)(8) - Cover sheet content.

Comment: Currently, § 3.31(f) provides that the cover sheet "should" include this information, but the Office proposes to make it mandatory. Please refer to the comment above on domestic partnerships and joint ventures.

4. References to "Paper"

Comment: We raise a concern about substituting "issuance" for "mailing." The proposed word "issuance" is ambiguous because it could refer to either the date an Office Action is written or is mailed. This may be problematic with respect to properly docketing or calendaring Office Actions. Currently, TARR uses either "Non-Final Action Mailed" or "Non-Final Action E-Mailed." If this wording is continued in TARR, we should simply change "mailing" to "mailing and e-mailing." If TARR will list an "issuance" date where it formerly listed "Mailed" or "E-Mailed" then it should provide clear notice as to the 6-month response date. This change would then be acceptable.

The Office proposes to remove the references in § 2.173(c), 2.174, and 2.175(c) to printed copies of amendments and corrections under section 7 of the Act.

Comment: We seek clarification of this proposal. By removing this wording, it appears the USPTO will attach no printed copy of post-registration amendments to printed copies of the registration. How will those amendments be communicated when certified copies of the registration are printed?

B. CONCLUSION

INTA's USPTO Subcommittee appreciates the opportunity to submit its comments on the proposed rule change and looks forward to participating in any further discussions on this issue. Should the USPTO have any questions or comments concerning INTA's response or desire testimony or further information, please contact Michelle Sara King at mking@inta.org or 202-223-0989.