

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 “Changes in Requirements for Signature of Documents, Recognition of Representatives, and Establishing and Changing the Correspondence Address in Trademark Cases”, published at 73 Fed Reg 114, p. 33345.

Procedures for recognizing a representative and changing the representative.

A power of attorney is not required in order for a qualified practitioner to represent a party in proceedings before the Trademark Office. This is acknowledged in the “Overview of Current Practice” section of the proposed rule (p. 33346), which lists three ways in which a qualified practitioner can be recognized as an applicant/registrant’s representative, only one of which requires a signed power of attorney. Nonetheless, the proposed rule would require that in order for the applicant/registrant to change its representative, it must file a signed revocation of power of attorney vis-à-vis the prior representative. (There are two methods by which the existing qualified practitioner can change the records of the PTO to reflect a new qualified practitioner, but this is the only method available to the applicant/registrant.) This requirement applies even if the applicant did not grant a power of attorney to the existing representative. Thus, the rule requires the applicant/registrant to revoke a power of attorney that it did not grant. We urge the PTO not to adopt a requirement that an applicant/registrant must file a revocation of power of attorney in instances when it has not granted a power of attorney in the first place.

Moreover, even though there are three ways in which a representative can be recognized as acting for an applicant when there is no prior-identified qualified practitioner, the new rule requires that a qualified practitioner can be substituted for a prior qualified practitioner only by means of a new signed power of attorney. However, until recently, the USPTO would accept a simple “change of address of correspondence” instruction from a qualified practitioner as sufficient to change the address to which it directed correspondence. It is unclear why this procedure was abandoned. We urge the PTO not to adopt a requirement that requires a signed power of attorney be filed in order for a subsequent qualified practitioner to represent an applicant/registrant. Instead, either the applicant/registrant or the new qualified practitioner should be permitted to sign and file a request for “Change of Address for Correspondence”.

Proposed section 2.18(b)(4) provides that if a qualified practitioner transmits a document on behalf of an applicant/registrant who is not already represented by another qualified practitioner, the Office will “construe” this as including a request to change the correspondence address to that of the practitioner, and will send correspondence to the practitioner. In some instances, applicants/registrants request outside counsel to prepare and file responses to Office action but do not wish the address for correspondence to be

changed to that of counsel. There is no reason for the Office to “construe” such a filing as a request for a change of address for correspondence. If that change is desired, it is simple enough for the applicant/registrant or qualified practitioner to include specific instructions in this regard in the filing. Thus, we urge the PTO not to adopt a rule that would establish a default procedure by which the filing of such a response would be “construed” as including a request for change of correspondence.

Proposed Sec. 2.18(a)(6) would provide that the Office will send correspondence to only one address, which is consistent with current Sec. 2.18(b). However, if correspondence is being sent electronically, there would appear to be no reason why the Office cannot send correspondence to more than one email address. The Trademark Trial and Appeal Board sends correspondence to more than one email address, as requested by the parties who file papers with the TTAB. We urge the PTO to reconsider its position on sending correspondence to only one email address.

Thank you for the opportunity to present comments on the proposed rules.