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**COMMENTS OF THE INTERNATIONAL TRADEMARK ASSOCIATION'S USPTO
SUBCOMMITTEE ON THE NOTICE OF PROPOSED RULEMAKING ENTITLED
"CHANGES IN REQUIREMENTS FOR SIGNATURE OF DOCUMENTS,
RECOGNITION OF REPRESENTATIVES, AND ESTABLISHING AND CHANGING
THE CORRESPONDENCE ADDRESS IN TRADEMARK CASES"
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 "Changes in Requirements for Signature of Documents, Recognition of Representatives, and Establishing and Changing the Correspondence Address in Trademark Cases" (the "Proposed Rules") found at 73 Fed. Reg. 33345-33356 (37 CFR Part 2).

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 the specific areas where further clarity and changes are recommended.

A. GENERAL COMMENTS

We note the terms "registrant," "owner", "owner of a mark" and "owner of the registration" are used interchangeably throughout the proposed rules. *See e.g.* §§2.19(a), 2.163(b), 2.167 and 2.193(e)(6). For clarification, we suggest the USPTO indicate the definition of these terms such as "owner" indicating the "owner in fact", the "owner of record", etc. and to be consistent throughout to avoid any possible confusion.

B. SPECIFIC COMMENTS

(1) Proposed Rule – 2.17(c) – "Recognition for representation. Requirements for powers of attorney."

Comment: This proposed rule only addresses individual applicants and the USPTO may want to address applications from unrepresented joint applicants.

(2) Proposed Rule - §2.18 (a)(7) – "Correspondence, with whom held. Establishing the correspondence address."

Comment: The USPTO may want to emphasize that when practitioners change law firms, the filing of a change of correspondence address does not revoke any prior powers of attorney or associate powers of attorney. We recommend the rule provide for practitioners to file a revocation/power of attorney when changing firms to ensure practitioners from the previous firm will not still be authorized to represent the client. Further, the choice of counsel is determined by

the applicant and we recommend that the rule provides for approval by the applicant of the change in the power of attorney. The revocation will also automatically update the correspondence address. Further, this places the burden on the practitioner.

(3) Proposed Rule – §2.18 (b)(4) – “Correspondence, with whom held. Changing the correspondence address.”

Comment: We understand this rule to mean the correspondence address of a practitioner filing a document will only be recognized if the USPTO has not otherwise recognized a qualified practitioner at the time the document is filed.

(4) Proposed Rule – § 2.19(a)(1) “Revocation or withdrawal of attorney. Revocation.”

Comment: The proposed rule only addresses the situation of the individual applicant and the USPTO may want to address the situation of unrepresented joint applicants.

(5) Proposed Rule – § 2.19(a)(3) “Revocation or withdrawal of attorney. Revocation.”

Comment: The USPTO may want to emphasize that when practitioners change law firms, the filing of a change of correspondence address does not revoke any prior powers of attorney or associate powers of attorney. The USPTO may want to add this information to the TMEP. We suggest the process ask practitioners to file a revocation/power of attorney when changing firms to ensure practitioners from the previous firm are not still authorized to represent the client. The revocation will also automatically update the correspondence address.

(6) Proposed Rule - § 2.193(a) – “Trademark correspondence and signature requirements. Signature required.”

Comment: We disagree with the proposed change and definition of electronic signatures. Since the attorneys assume liability and responsibility for the signing forms, it is common legal practice for attorneys to authorize others to sign on their behalf. To assist with this proposed change, we request the forms be portable for signature to allow for easier compliance with this rule, including assignment cover sheets and TTAB filings.

(7) Proposed Rule - § 2.193(e)(2)(ii) - “Trademark correspondence and signature requirements. Responses, amendments to applications, requests for express abandonment, requests for reconsideration of final actions, notices of change of address, requests to divide and petitions under §2.146.”

Comment: This provision creates an additional burden if the document is being composed and sent through TEAS or ESTTA or if examiner’s amendments need to be cleared with each applicant, etc. However, we understand the percentage of unrepresented joint applicants is small

and the office intends to avoid the situation where one unrepresented joint applicant speaks for the other(s) without authorization.

- (8) Proposed Rule - § 2.193(e)(3) - “ Trademark correspondence and signature requirements. Proper person to sign. Powers of attorney and revocations of powers of attorney.”**

Comment: Under current practice, when an application is filed by an attorney, the online power of attorney form can be signed by the filing attorney. The proposed rule would require a change in the online form. If the proposed rule is not intended to apply in the initial filing stage, but only to subsequent designations, this distinction should be made clear in the proposed rule.

- (9) Proposed Rule - § 2.193(e)(6) - “ Trademark correspondence and signature requirements. Proper person to sign. Requests for correction, amendment or surrender of registrations.”**

Comment: This proposed rule creates an additional burden for unrepresented joint applicants. However, we understand the percentage of unrepresented joint applicants is small and the office intends to avoid the situation where one unrepresented joint applicant speaks for the other(s) without authorization.

- (10) Proposed Rule - § 2.193(e)(8) - “Trademark correspondence and signature requirements. Proper person to sign. Cover Letters.”**

Comment: This proposed rule pertains to trademark paper filings. However, when filing TTAB documents through ESTTA, the electronic filing cover sheet must be signed by a person with authority. If not, the filing may be rejected if the attached documents are unsigned by an authorized person.

C. 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.