



**Etienne Sanz de Acedo**  
*Chief Executive Officer*

655 Third Avenue, 10th Floor, New York, NY 10017-5646, USA  
t: +1-212-642-1776 | f: +1-212-768-7796  
inta.org | esanzdeacedo@inta.org

October 5, 2016

The Honorable Robert W. Goodlatte  
Chairman  
Committee on the Judiciary  
U.S. House of Representatives  
2138 Rayburn House Office Building  
Washington, DC 20515

The Honorable John Conyers, Jr.  
Ranking Minority Member  
Committee on the Judiciary  
U.S. House of Representatives  
B-336 Rayburn House Office Building  
Washington, DC 20515

Dear Chairman Goodlatte and Ranking Minority Member Conyers:

The International Trademark Association (INTA) opposes the recently revived proposal of the House Office of Law Revision Counsel (OLRC) to re-codify the Trademark Act of 1946 (the Lanham Act) into positive law. INTA objected a decade ago to a parallel proposal and continues to believe that the negative implications and burdens of re-codification far outweigh any intended benefits. Accordingly, we respectfully urge the Committee on the Judiciary not to take this initiative further.

The OLRC proposes removing the Lanham Act from Title 15 of the U.S. Code, rewriting the statute, and placing the law into Title 35, which contains the Patent Act. According to the OLRC, the bill would "remove ambiguities, contradictions, and other imperfections" in the Lanham Act and modernize obsolete language, a process that is intended to be purely technical.<sup>1</sup> The OLRC would renumber and reorganize the basic framework of the Lanham Act to make its structure consistent with that of the Patent Act.

In 2006, the OLRC proposed a very similar re-codification of federal trademark law into positive law. Based on a detailed analysis of that substantial re-write, INTA disagreed with the OLRC's characterization of its changes as "purely technical." INTA was also concerned about the financial burdens and long-term confusion that codification would cause. The 2006 bill was ultimately pulled from consideration.

INTA remains confident that re-codification of the Lanham Act into positive law is a solution without a problem. There is no compelling reason to undertake this project, and there are several compelling reasons to abandon it.

The OLRC's position is that the Lanham Act, as non-positive law, is merely prima facie evidence of what the law is. INTA is unaware of any instance, however, in which the nature of the federal trademark statute was called into question because it was not "positive law." There is no genuine suggestion that there were transcription errors when duly-enacted trademark laws were incorporated into Title 15. In fact, we are unaware of any other organizations or people sharing the OLRC's concern that the federal trademark law is somehow not authoritative. Courts have had no difficulty accepting the statutory language in Title 15,

---

<sup>1</sup> The OLRC's explanation of the draft bill appears at <http://uscode.house.gov/codification/t35/exp.pdf>.

and far from clamoring for re-codification, the trademark bar strongly opposes it now, just as it did a decade ago.

Moreover, the proposed changes to the statutory language are quite problematic. Words matter, especially words in a statute. What the OLRC characterizes as mere elimination of inconsistent, redundant and obsolete terms instead could substantively alter the statute in ways that would have a palpable impact on trademark law. For the public and trademark owners needing access to the courts, the changes will introduce uncertainty as to their rights and available remedies, as well as courts' interpretation of the new statute.

INTA would object to re-codification of the Lanham Act even if the language of the bill were amended to track the current language more closely. The re-codification consequences that the OLRC dismisses as inconveniences are in fact quite onerous. If passed, the bill would disrupt well-established trademark law practice in the United States. It is not simply a matter of a few practitioners having to learn some new section numbers during a brief transition period. Decades of rulings issued under the current statutory scheme would only be comprehensible, even to experts, with the help of a lengthy guide, and this confusion will continue for years to come. A practitioner new to trademark law in 2030, say, would still find statutory citations and quotations in pre-re-codification decisions and academic articles befuddling. Commonly-used shorthand references to "Section 2(a) refusals" and "Section 8 affidavits" in legal opinions would be rendered nonsensical.

Moving the law to another title and renumbering and reorganizing its provisions will also stymie state and federal court judges and the Trademark Trial and Appeal Board writing legal opinions in trademark matters. All tribunals will be required to continually reference and rely upon pre-re-codification cases and decisions. Practitioners will have to educate courts for years in pre-re-codification and post-re-codification language and renumbering. This exercise provides absolutely no substantive benefit to the trademark litigation or prosecution process.

Finally, the inconveniences dismissed by the OLRC will have real financial consequences, not only to practitioners who need to keep track of current law but also to the United States Patent and Trademark Office, which would have to update all of its content, from its many online forms to the Trademark Manual of Examining Procedure and the Trademark Trial and Appeal Board Manual of Procedure. Requiring such revisions would needlessly draw on the USPTO's human and financial resources and likely sideline other important Office initiatives.

In the end, INTA sees no practical benefit to re-codification and has not identified any pressing issue that needs to be addressed. Although we understand the appeal of having a complete set of positive law in the United States, those who work closely with the Lanham Act every day as practitioners and trademark owners oppose this drastic transformation. INTA's U.S. Legislation Subcommittee intends to soon complete a close reading of the 2016 bill, similar to that done in 2006, to examine the changes in detail and determine their significance. We will then provide an updated analysis.

INTA appreciates your time and willingness to consider our position. We welcome any questions that you or your staff may have on this issue.

Sincerely,



Etienne Sanz de Acedo  
Chief Executive Officer