

Via Email

December 20, 2012

Tracey Denning  
U.S. Customs and Border Protection  
Office of Regulations and Rulings  
799 9th Street NW., 5th Floor  
Washington, DC. 20229-1177  
Email: tracey.denning@dhs.gov

**Re: INTA SUBMISSION ON THE REQUEST FOR PUBLIC COMMENT REGARDING REGULATIONS  
RELATING TO RECORDATION AND ENFORCEMENT OF TRADEMARKS AND COPYRIGHTS**

Dear Ms. Denning:

On behalf of the International Trademark Association (INTA), I welcome the opportunity to respond to the request of the U.S. Customs and Border Protection (CBP) for comments to the regulations relating to recordation and enforcement of trademarks.

INTA is a membership association of more than 6,000 trademark owners and professionals from more than 190 countries. The organization is dedicated to the support and advancement of trademarks and related intellectual property (IP) as elements of fair and effective national and international commerce.

INTA recognizes that customs officials are the gatekeepers of their country's streams of international commerce and are the first line of defense in keeping foreign-born counterfeits from the public. Counterfeiting is an international problem that affects all types of products from luxury goods to consumer goods, medicines, and electronics. Counterfeit products infiltrate legitimate markets and supply chains, harming economies worldwide, posing threats to health and safety of the public, and compromising international security. Recent reports estimate that the impact of counterfeit and pirated goods is as much as \$650 billion per year. For these reasons, INTA strongly believes that the development of new tools and concepts to enforce measures against counterfeiting are critically important. We thank you for the opportunity to give our comments on the need for continuing the recordation of trademarks with Customs.

INTA applauds CBP's current efforts to develop a process and method to distinguish between high and low risk shipments, which would help to make CBP's intellectual property rights (IPR) targeting system more efficient and effective. INTA believes that the current recordal system is an integral part of this process. However, to streamline the recordation process and to alleviate any confusion among trademark owners, INTA recommends the following:

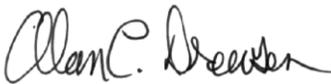
- The recordation system should be linked with the trademark registration system so that trademarks newly registered at the U.S. Patent and Trademark Office can immediately be recorded at CBP with the proper fees paid by rights holders that opt to record. This would also help to increase the number of rights holders' recordations with Customs while reducing the administrative burden on trademark owners.
- Electronic renewal of trademark rights in customs recordation databases should be made available. While initial recordation of registered trademarks via CBP's online website is convenient and fast, the renewal process is inefficient. In order to renew the recordation, the

trademark owner must mail a physical request to the Chief of the IP Rights & Restricted Merchandise Branch. We recommend that in the interest of saving time for all parties and cutting down on unnecessary paperwork and expense, CBP allow renewal of these same trademark recordation rights via its existing online portal.

- A form should be developed for those trademark owners seeking *Lever*-rule protection with regard to parallel imports pursuant to the federal regulations. Currently, the *Lever*-rule process is not fully understood by trademark owners, and there is no guidance for applicants on the CBP website. As a result, trademark owners often erroneously believe that recording their trademarks with CBP in the usual fashion gives them protection against parallel imports, when in reality it does not. Making the process for obtaining *Lever*-rule protection more transparent would significantly benefit trademark owners and reduce confusion as it relates to the recordation process.

INTA hopes that these comments on the CBP's consultation on the regulations relating to recordation and enforcement of trademarks help to improve the process. INTA would be pleased to answer any questions that the CBP may have and is available to discuss our recommendations in more detail. Please do not hesitate to contact either of the following INTA representatives David E. Warr (Director, Government Relations/Washington Representative; [dwarr@inta.org](mailto:dwarr@inta.org); +1(202)261-6572) or Candice Li, External Relations Manager for Anticounterfeiting ([cli@inta.org](mailto:cli@inta.org); +1(212)642-1739) if we can be of assistance.

Sincerely,



Alan C. Drewsen  
Executive Director