

**International Trademark Association Comments on
Changes in Requirements for Specimens and for Affidavits or Declarations
of Continued Use or Excusable Nonuse in Trademark Cases**

Notice of Proposed Rulemaking:
PTO-T-2010-0073--*Federal Register* Vol. 76, No. 133 on July 12, 2011

The International Trademark Association (INTA) appreciates the opportunity to provide comments to the proposed rules regarding the USPTO's efforts to ensure the accuracy of the trademark register by requiring additional specimens, information, exhibits and declarations in a limited number of cases. The USPTO Subcommittee of INTA's Trademark Office Practices Committee, in consultation with other relevant INTA committees, prepared these comments.

INTA supports the USPTO's efforts to ensure the accuracy of the trademark register because that practice assists in clearing new marks and protecting existing ones. Currently whether filing a new use-based application or maintaining a registration, the USPTO requires only one acceptable specimen per class, which then serves to indicate that the mark is in use with all goods/services in that class. By requiring additional specimens or additional information, even in limited cases, the USPTO should establish a more accurate trademark register but as set forth below in our comments on the specific issues identified in the notice, INTA believes that the USPTO may share with stakeholders the criteria and standards which will be used to determine when additional specimens or information would be requested. Additionally, the USPTO should explain the potential scope of those information requests and explain how the USPTO will monitor these requests and their scope to ensure uniform implementation and minimize time and cost burdens for applicants/registrants and the USPTO.

(1) Whether the collection of information is necessary for the proper performance of the functions of the agency.

INTA agrees that collecting information regarding the accuracy of the applications and registrations on the trademark register is a necessary and proper performance of the USPTO's functions. In particular, the trademark register now contains many applications and registrations with wide ranging descriptions of goods and services. From ensuring efficient and accurate examination of both applications and registrations to aiding practitioners and brand owners in selecting new marks, an up to date register reflecting marks that are actually in use would benefit everyone.

Gathering that information should aid in accurately clearing marks and prosecuting applications, but the USPTO should ensure that the information is gathered consistently and without singling out any particular classes of applications/registrations (e.g., focusing only on Madrid registrations) or mark owners (e.g., focusing only on foreign mark owners).

(2) The accuracy of the agency's estimate of the burden.

The USPTO estimates the additional burden to comply with the requests for specimens or additional information to be approximately one hour. INTA agrees that the time to actually submit an acceptable specimen will likely be approximately one hour, but that the time involved in making the request to the client and reviewing the client's responses will be substantially greater.

Both the USPTO and the registrant/applicant have some control over the amount of time to comply with the request. At the outset, the USPTO can control the burden by requiring only one extra specimen or minimal additional information. (Conversely, to the extent that the USPTO requires specimens for each good/service in a particular class, the time to respond will likely be significantly greater.) Additionally, to the extent that the USPTO requires declarations to support any additional specimens submitted, complying with the request will likely take additional time.

For mark owners and their counsel, the time to comply with the additional requirements will turn on a few factors, the first being the location of the ultimate client. For instance, when working with foreign entities, U.S. counsel will often convey the message to a foreign associate, who in turn conveys the request to the ultimate client. From there, the client will turn to the appropriate business unit to locate specimens and the chain will work in reverse. A similar path would apply to U.S. clients with requests passed along to the marketing department. In either case, but particularly with foreign entities, counsel will have to explain the legal standard for acceptable specimens and will then have to review the specimens found before submitting them to the USPTO.

In general, the longer the description of goods/services, the more difficult it will be to acquire additional specimens, and particularly if the USPTO requires additional specimens for more than one of the goods/services in the description. Sometimes, longer lists of goods indicate a highly diversified company which could mean that different goods/services identified in the application/registration are manufactured in different areas (including different countries or business units) or by third party licensees. If the USPTO requires more than one additional specimen for those long lists of goods/services, the burden on trademark owners and outside counsel will intensify.

Closely related is the question of whether the USPTO will require those additional specimens to be supported with declarations or affidavits. Locating people with the requisite knowledge to declare under oath that a particular mark has been in use in commerce with particular goods/services can be very time consuming, particularly when working with large companies with multiple offices. If the USPTO requires a declaration in support of each additional specimen or evidence, counsel may need to contact many different people and explain the requirements to them, thus greatly increasing the compliance time.

Finally, if the USPTO begins to routinely require multiple specimens, the time required to comply will likely increase. Mark owners may submit many specimens with the expectation that at least a few will be acceptable. This would increase the time that it takes to prepare the filings

but would also increase the amount of time that individual examining attorneys or post-registration paralegals devote to their review.

(3) Ways to enhance the quality, utility, and clarity of the information to be collected.

To enhance the quality of the information that will be collected, the USPTO should develop and publicize the requirements as early as possible. Additionally, because the prosecution process can vary greatly from post-registration practice, ensuring that post-registration employees receive training in the new standard will ensure that better information is received.

Publicizing the nature of specimens or additional information that will be required to support requests for information will assist practitioners in establishing guidelines and in properly responding. One example would be loosening the restrictions on catalog submissions so that if a mark owner received a request for additional specimens to demonstrate that a mark was in use with various items of clothing, the request could be satisfied simply by providing a catalog rather than providing a specific specimen for each particular good listed in the description.

The USPTO should also clarify whether requests for additional information will apply to entire classes of goods/services or specific goods/services within each class.

Intertwined with submitting the specimens is whether a declaration will be required to support the additional specimens or information and the form that declaration will ultimately take. For instance, acquired distinctiveness declarations have very specific language attesting strictly to the particular mark. If declarations will be required to support additional specimens under the new rule, having a uniform format would help to ensure higher quality submissions.

Practitioners also recognize that examining attorneys review application specimens while paralegals review post-registration specimens. Ensuring uniform levels of inquiry for specimens during prosecution and post-registration and publicizing them in either Exam Guides or the TMEP would further the stated goal of an accurate trademark registry.

At least at the outset of the implementation of the new rule, having a particular contact person (or dedicated “specimens mailbox”) for issues that arise would ensure that practitioners and USPTO employees receive consistent guidance.¹ Closely related, the USPTO should share any statistics that are kept on the success of the new rule – for instance, the length of descriptions that are routinely queried, the percentage of registrations/applications that are queried, and statistics that suggest that “deadwood” on the register is an issue to be addressed.

¹ One technique to assist with uniform treatment would be having trademark examining attorneys perform work projects or details to assist in training the post-registration paralegals.

(4) Ways to minimize the burden of the collection of information to respondents.

The primary function in determining the burden on respondents will be the nature of the response itself. For instance, if the USPTO requires every individual good/service to be supported with both a specimen and a declaration supporting that use, then the burden will be quite high.

One way to minimize the time would be to request additional specimens or information without a supporting declaration if the specimen initially submitted is acceptable. For instance, if a registrant makes a Section 8 and 15 filing for a registration with goods X, Y, and Z and the post-registration specialist determines that the specimen is acceptable for X but not Y and Z, then the request could be for merely an additional specimen but without a requirement for a declaration supporting that specimen.

Conclusion

INTA shares the USPTO's goal of maintaining an accurate trademark register and understands the challenges related to achieving that goal. INTA appreciates that the USPTO has provided an opportunity for the stakeholder community to comment on this proposed rule. In conclusion, if the USPTO requires additional specimens or information, the USPTO should communicate with stakeholders the criteria and standards that will be used to determine when additional specimens or information will be requested. Further, the USPTO should develop a process to monitor these requests to ensure uniform implementation and to evaluate whether "deadwood" on the register is an issue.