

July 19, 2021

**INTA’S COMMENTS ON PROPOSED CHANGES TO IMPLEMENT PROVISIONS OF THE
TRADEMARK MODERNIZATION ACT OF 2020**

Introduction

The United States Patent and Trademark Office (USPTO) published its notice of proposed rulemaking (NPRM) proposing to amend the rules of practice in trademark cases to implement provisions of the Trademark Modernization Act of 2020 (TMA) on May 18, 2021. The International Trademark Association (INTA) appreciates the opportunity to provide comments regarding the proposed rules.

INTA is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association’s global trademark resources, policy development, education and training, and international network. Founded in 1878, INTA, a not-for-profit organization, is headquartered in New York City, with offices in Brussels, Santiago, Shanghai, Singapore, and Washington, D.C., and a representative in New Delhi. For more information, visit inta.org.

The main section numbers and headings referenced below correspond to the main sections and headings in the NPRM.

I. Ex Parte Expungement and Reexamination Proceedings

A. Proposed Rules

In Section I of the NPRM, the USPTO proposes a number of new rules to implement new procedures for expungement and reexamination, as well as amendments to existing rules to accommodate these new procedures. In general, INTA supports these proposed rule changes and believes that they are consistent with both the letter and spirit of the TMA.

1. Response Period for Reexamination and Expungement Proceedings

The main exception to this general support relates to the proposed two-month deadline for a registrant to respond to an action in an expungement or reexamination proceeding. INTA respectfully submits that the proposed deadlines for responding to the initial Office action in a reexamination or expungement proceeding under proposed § 2.93(b)(1) and for filing a request for reconsideration or appeal to the TTAB under proposed § 2.93(c)(3)(ii) and § 2.94 should be three months instead of the proposed two months.

The notices to registrants of a reexamination or expungement proceeding will be denominated as Office actions. Having a three-month deadline for all responses to Office actions (except for

applications pursuant to the Madrid Protocol) will provide simplicity and consistency for applicants, registrants and practitioners. This consistency should also make building the necessary USPTO IT systems and third-party trademark software docketing to accommodate these responses more streamlined and straightforward. Also, drawing on the experience of our members in the context of the post-registration audits, INTA believes that two months is an extremely aggressive timeline for obtaining the necessary proof of use to respond in a reexamination or expungement proceeding, especially for foreign registrants. A three-month response to petitions in these proceedings provides clarity and consistency to practitioners and trademark owners while still serving the goal of expeditiously removing unused trademarks from the register.

INTA is also concerned that one of the USPTO's underlying assumptions in proposing the two-month deadline is inaccurate. Specifically, INTA understands that the two-month deadline is partly based on the assumption that registrants should already have easy access to adequate proof of use for every good and service listed in the registration. INTA respectfully disagrees and believes almost all registrants will have difficulty gathering sufficient proof of use to adequately respond within two months. In the case of Section 1(a) registrants, the USPTO rules only require one specimen per class, so there has been very little incentive for applicants or their counsel to identify and retain evidence of use for all goods and services when applications or Statements of Use are filed. As noted above, INTA's brand owners and practitioners have consistently experienced difficulty in obtaining comparable evidence of use in the context of post-registration audits. This is especially true for industrial goods, machinery, and other types of goods that are advertised and sold business-to-business, rather than to general consumers. Owners of Section 44 and 66 registrations that are the subject of expungement proceedings are even less likely to have adequate proof of use readily available because they would never have had to identify and submit specimens prior to registration.

Identifying the right kind of evidence will be especially challenging in the context of reexamination given that use must be established during a specific time period. For example, if a reexamination proceeding is initiated close to the statutory five-year deadline, it is entirely possible that a registrant who submitted its application based on 1(a) will need to gather evidence of use from seven or eight years in the past to show that the mark was in use as of the application date. Even the most organized trademark owners will very likely need more than two months to gather evidence of use in that situation and to prepare a response. Small businesses and individuals will surely face even greater challenges in such circumstances.

Ultimately, relying on the experience of its brand owner and U.S. trademark practitioner members, INTA respectfully disagrees that two months is an adequate amount of time for registrants to gather sufficient evidence of use and respond to an expungement or reexamination proceeding. INTA is concerned that the short deadline will encourage registrants to file placeholder responses while they spend extra time gathering better evidence of use before finally submitting a stronger request for reconsideration. This outcome may prolong the pendency of contested expungement and reexamination proceedings. Therefore, INTA recommends a three-month deadline for responding to expungement and reexamination proceedings, which will encourage more complete initial responses and will be consistent with the proposed deadlines for Office actions under § 2.62.

2. Filing Fee

The USPTO has proposed a filing fee of \$600 per class of goods or services for a petition for expungement or reexamination. INTA supports this proposed filing fee. INTA notes that this fee is the

same as the filing fee for filing a notice of opposition against a pending application or a petition for cancellation of an existing registration. This fee should be high enough to discourage bad faith petitioners from instituting these proceedings without making the proceedings completely out of reach for individuals or smaller businesses.

B. *Requests for Comments*

There are several items in this section on which the USPTO has specifically requested comment.

1. Limitations on the Number of Petitions

The TMA gives discretion to the Director to establish by rule a limit on the number of petitions for expungement or reexamination that can be filed against a registration. The USPTO proposes not to set any limits at this time, based on the assumption that the existing safeguards in the statute and proposed regulations will provide sufficient protection to registrants from potential misuse of the proceedings. If it turns out that the existing safeguards do not adequately protect registrants from misuse of the proceedings, the USPTO may establish limits on the number of petitions that may be filed against a registration in the future.

INTA supports this approach, and expects that the Report on Decluttering Initiatives provided for in Section 7 of the TMA will inform the USPTO on whether such additional safeguards might be needed after some experience with these proceedings.

2. Identification of Real Party in Interest

Although the USPTO does not anticipate requiring real-party-in-interest information from the petitioner in an ex parte expungement or reexamination proceeding, the USPTO is seeking comments on whether and when the Director should require a petitioner to identify the name of the real party in interest on whose behalf the petition is filed.

INTA supports the USPTO's proposal not to require a petition to identify the name of the real party in interest. This position is consistent with the language of the TMA to allow "any person" to file a petition to request institution of an expungement or reexamination proceeding. This proposal is also consistent with the fact that these proceedings are only between the USPTO and the registrant after institution, so that the identity of the party seeking the proceeding becomes irrelevant for purposes of the proceeding itself.

As with the limitations on the number of petitions, INTA suggests that the USPTO may find, following the Report on Decluttering Initiatives, that this additional safeguard is needed.

3. 30-Day Period to Resolve Deficiencies in a Substantially Complete Response

The USPTO is considering whether proposed § 2.93 should provide that, when a timely response by the registrant is a bona fide attempt to advance the proceeding and is a substantially complete response to the Office action, but consideration of some matter or compliance with a requirement has been omitted, the registrant may be granted thirty days, or to the end of the response period set forth in the Office action to which the substantially complete response was submitted, whichever is longer, to resolve the issue before the question of terminating the proceeding is considered.

INTA does not believe such a provision is necessary under the proposed rules. Proposed § 2.93(c) provides that if a registrant's timely response fails to rebut the prima facie case of nonuse or fully comply with all outstanding requirements, the USPTO will issue a final action identifying any outstanding issues with an option for the registrant to request reconsideration by providing any deficient information. INTA believes that this procedure should provide adequate protection for registrants in the event that an otherwise substantially complete response is deficient in some manner.

4. Subsequent Selection for Audit

The USPTO is considering whether it should take additional action when a registrant's failure to respond in an expungement or reexamination proceeding leads to cancellation of some of the goods and/or services in the registration. Specifically, the USPTO is considering whether, in these cases, the registration should also be selected for audit under 37 C.F.R. § 2.161(b) or § 7.37(b) if a registration maintenance filing is pending or, if one is not pending, when the next maintenance filing is submitted. As under current practice, if selected for audit, the registrant would be required to substantiate use for some or all of the remaining goods and/or services recited in the registration.

INTA supports this proposed additional action of selecting registrations for audit in the event that a registrant's failure to respond in an expungement or reexamination proceeding leads to cancellation of some of the goods and/or services in the registration. Such subsequent action is consistent with the stated objectives of the House Report for the TMA, and also appears to be an efficient way to identify deadwood registrations that may no longer be in use for other portions of their goods and/or services that were not addressed in the expungement or reexamination proceeding.

In summary, INTA supports the USPTO's proposed amendments to the rules and its proposed procedures for handling expungement and reexamination proceedings as outlined in the NPRM, except that INTA respectfully requests that the deadline for responding to an Office action after institution of an expungement or reexamination proceeding should be three months instead of two months.

II. New Nonuse Ground for Cancellation Before the TTAB

In Section II of the NPRM, the USPTO proposes to amend § 2.111(b) to specify the time for filing a petition under the new ground for cancellation under Section 14 on the basis that a mark has never been used in commerce and distinguish the timing of when such a claim may be filed from the timing of other nonuse claims.

INTA supports this proposed rule change.

III. Flexible Response Periods

A. Proposed Rule

In Section III of the NPRM, the USPTO proposes to amend § 2.62 to set a response period of three months for responses to Office actions in applications under Sections 1 and/or 44. Applicants may request a single three-month extension of the deadline upon payment of the proposed extension fee of \$125 for an extension filed through TEAS and \$225 for an extension filed on paper. This three-month

deadline with a single three-month extension would also apply to responses to Office actions in connection with post-registration review of maintenance and renewal filings. However, applications filed under Section 66(a) pursuant to the Madrid Protocol will still have a six-month deadline for responses to Office actions.

INTA supports these proposed rule changes. The three-month period will be adequate for many responses to Office actions and will allow applications to proceed more quickly to publication or abandonment. The single three-month extension provides a simple and straightforward way for applicants who need more time to obtain the full six-month period to respond. This proposed process should be relatively easy to understand and should be relatively straightforward to implement from a docketing standpoint.

INTA also supports and appreciates the USPTO's proposal to maintain the current six-month response period for Section 66(a) applications pursuant to the Madrid Protocol. The additional time required for WIPO to notify applicants of the Office action and for those applicants or their foreign counsel to locate, hire and communicate instructions to U.S. counsel would make a three-month response deadline extremely difficult to meet.

INTA believes the proposed extension fee of \$125/\$225 for the extension of time to respond to an Office action strikes a reasonable balance between the desire to encourage applicants to respond during the initial three-month response period and the need to keep extension requests reasonably accessible to those applicants who need additional time. We point out that this single extension fee for the response to Office action is comparable to a single request for extension of time to file a statement of use in a single class, which seems in line for this kind of fee. While some stakeholders have advocated for a no-fee extension, INTA believes that the modest fee proposed in the NPRM is necessary to incentivize responses by the initial three-month deadline.

The USPTO has proposed to delay implementation of these particular changes until June 27, 2022. INTA supports and appreciates this proposed timing, which will give both the USPTO and third-party trademark docketing software vendors time to make the necessary changes to their IT systems to accommodate the new deadlines and forms.

Finally, INTA believes that the proposed rule is equitable and adequately takes into account the impact on small and medium-sized enterprises (SMEs). To the extent that SMEs file applications pro se and need to retain counsel to respond to the Office action, INTA believes that three months is an adequate amount of time to at least retain counsel. If SMEs and their newly appointed counsel need additional time to analyze and respond to the Office action, the \$125/\$225 proposed fee for a three-month extension is reasonable and does not greatly increase the overall cost of prosecuting an application to registration.

B. Alternative Procedures

The USPTO has requested comments related to two alternative proposals for handling flexible response periods and extensions.

1. Two-Phase Examination

This alternative proposal provides for a possible initial review of application formalities with a two-month response period to address any formalities, extendable in two-month increments to the full six-month response period. That initial phase would be followed by a review of substantive refusals with a three-month response deadline, extendable for an additional three-month period.

INTA opposes this proposal for a variety of reasons. First, it would significantly extend the potential pendency of applications, with the time for responding to Office actions potentially reaching more than one year from the issuance of the initial formalities Office action. In addition, both applicants and their counsel appreciate understanding all of the potential hurdles facing an application in a single Office action in order to properly assess the strategy for response. Any time spent responding to a formalities Office action is wasted if the application later faces insurmountable substantive hurdles. This extra expenditure of time and resources for both examiners and applicants appears to defeat the stated purpose for the changes of reducing pendency and clearing away applications that will ultimately be abandoned in a shorter amount of time. This proposal also significantly complicates the docketing systems and calculation of applicable deadlines, with a much greater likelihood of error in calculating the deadlines, distinguishing between a two-month deadline and a three-month deadline, along with differing extension periods.

2. Patent Model of Increasing Extension Fees for Longer Extensions

The second alternative proposal is to set the initial period for responding to an Office action at two months, but allow applicants to file a response at various times after issuance of the Office action by submitting progressively higher extension fees, such as \$50 for the third month, \$75 for the fourth month, \$125 for the fifth month and \$150 for the sixth month.

INTA also opposes this alternative for a variety of reasons. It would be a docketing nightmare for applicants and practitioners. Unlike in a patent context in which the applicant pays the appropriate fee whenever the response is filed, on the trademark side, the application will be abandoned if no response or extension is filed by the applicable deadline. If an applicant believes it only needs one additional month to respond and so files a request for extension of time to respond with a \$50 fee, but then needs another month, does the applicant file an additional extension with a \$75 fee, or only the \$25 difference? This approach seems extremely confusing and could end up being much more costly to applicants than the initial proposal above. In particular, it would be especially confusing for pro se applicants, who are more prone to misunderstand the extension procedure and miss a deadline. This proposal would also require much more complicated programming of the USPTO IT systems to accommodate the differing deadlines and extensions, as well as the numerous additional forms that would be required to accommodate the various extension options.

In summary, INTA supports the proposed rule changes in Section III of the NPRM establishing an initial three-month period to respond to an Office action with an available three-month extension of the deadline upon payment of the proposed fee for applications under Sections 1 and 44 of the Act, while maintaining the six-month deadline for responses to Office actions in applications under Section 66(a). INTA opposes both alternative frameworks for flexible response periods on which the USPTO seeks comment.

IV. Letters of Protest

Section IV of the NPRM provides express statutory authority to support the USPTO's current processes regarding letters of protest, which offers third parties the opportunity to submit evidence relevant to a basis of refusal that may be added to a pending application's record for the examining attorney's consideration.

The USPTO added § 2.149 promulgating letter of protest procedures and instituting a \$50 filing fee in a final rule published in the Federal Register on November 17, 2020. The TMA and the proposed rule changes discussed in this section of the NPRM impose a deadline of two months for the Director of the USPTO to act on a filed letter of protest and determine whether evidence provided in a letter should be included in the application record. Section IV additionally confirms that the Director's decision on a letter's relevance is final and non-reviewable, and shall not prejudice any party's right to raise any issue or rely on any evidence in any other proceeding.

INTA supports the effort to provide express statutory authority for the Letter of Protest procedure.

However, INTA believes the requirement for the Director to act on a submitted letter within two months is not optimal. As the USPTO has, until very recently, sought to maintain application pendency at three months, INTA believes a two-month period for decisions would be too long and could result in an examining attorney acting on an application before receiving the relevant evidence in a letter of protest. The TMA added 15 U.S.C. § 1051(f), which provides that the Director shall determine whether evidence should be included in the record of the application "*within two months.*" (emphasis added) INTA recommends consideration of a one-month or six-week limit for Director decisions on letters of protest.

V. Suspension of Proceedings

INTA has no comments regarding the proposed changes in this Section of the NPRM.

VI. Attorney Recognition Until Revocation Or Withdrawal

A. Proposed Rule Changes

In Section VI of the NPRM, the USPTO proposes adding new subsection § 2.17(b)(4) to render recognition of a practitioner ineffective when they have been "mistakenly, falsely, or fraudulently designated as a representative for an applicant, registrant, or party to a proceeding without the practitioner's prior authorization or knowledge." INTA supports this proposed amendment to § 2.17(b), as well as the conforming amendment in § 2.19(d) concerning revocation and withdrawal.

The USPTO also proposes changing the current provision regarding attorney recognition under § 2.17(g) as well as the related rule governing correspondence in § 2.18. While some of the proposed changes are meant to address communications related to the new expungement and reexamination procedures, the proposal also includes additional, potentially confusing stopgap measures intended to provide a transition to the USPTO's planned role-based access system. To the extent grounded in anticipation of a future role-based access system, INTA believes that these proposed rule changes are premature until the details of the proposed new system are released; meanwhile, specific changes to the rules should be made to reflect current practices of the Office for attorney recognition and correspondence.

Under the current rules, attorney recognition automatically terminates when ownership changes, when the application process terminates, or, in the case of an issued registration, when the registration is cancelled or expired or upon acceptance or rejection of a filing made under Section 7, 8, 9, 12(c), 15, or 71.

Under the proposed changes to § 2.17(g), attorney recognition would continue until (1) the owner revokes the appointment or (2) the attorney withdraws from representation. The USPTO is trying to resolve an inconsistency between the current application of § 2.17(g) and the terms of § 2.18(a). The latter rule requires the USPTO (with a few exceptions) to correspond with the applicant's or registrant's attorney if one is recognized, and otherwise to send correspondence to the applicant, registrant, or party to the proceeding. The USPTO explains that it currently treats representation as continuing in numerous circumstances, sending correspondence to the attorney of record, including the trademark registration certificate, renewal reminders, and notices of abandonment, even though attorney recognition has been terminated under the terms of current § 2.17(g). As discussed below, INTA believes that the current practice is desirable, but does not believe that the significant changes to the system of recognition are necessary to maintain such practice.

B. *INTA's Opposition to the Proposed Rule Changes*

INTA opposes this proposal because the proposed rule will place significant burdens on counsel, applicants, and registrants. INTA agrees with the USPTO that the needs of applicants and registrants are well-served when the USPTO sends correspondence such as registration certificates and notices of abandonment to the recognized attorney of record, because these communications can be expected to lead to further communications between counsel and their client. Indeed, in the case of a notice of abandonment, an applicant may choose to file a petition to revive an application and can be expected to employ the same counsel of record. Assuming (as the USPTO appears to acknowledge) that such communications are desirable and beneficial, it would be simpler merely to change existing rules to conform to current practice.

The USPTO apparently believes that it is beneficial for formerly recognized counsel to receive courtesy reminders and notices of petitions to cancel. While INTA agrees that this can be beneficial to the interests of registrants, INTA disagrees that changes to the recognition rules to extend recognition in perpetuity are the best way to ensure that such reminders can continue. Notably, the USPTO instituted a requirement that a single e-mail address for the owner be included with each application file, together with a requirement that the e-mail address be maintained with current information. If the USPTO nevertheless believes that sending reminders and notices to formerly recognized attorneys is desirable, the existing rules regarding correspondence in § 2.18 could be amended to permit such reminders and notices to be sent to the formerly recognized counsel.

Indeed, events may hinder communications between the recognized attorney and the owner several years after the issuance of a registration or a maintenance filing. A registrant may change their address without informing the attorney of record, go out of business, assign a registration to another owner, or change counsel altogether. A registrant may choose to retain different counsel for purposes of a post-registration filing. Maintaining once-recognized counsel in perpetuity until the owner formally

revokes the appointment imposes a burden on the owner, who may not be aware of how to revoke the appointment without the involvement of new counsel. The new counsel would then presumably assist in the process of revoking the prior counsel in any event. The only other means of terminating recognition is withdrawal of counsel, which is an undesirable alternative as discussed below.

The proposed rule conflates the issues of recognition and representation, by requiring an attorney to terminate *representation* (a potentially uncomfortable step for counsel or client or both shortly after registration issues, and potentially impossible several years after registration) in order to terminate *recognition* with respect to an issued registration. Such a rule would impose a significant (if not impossible) burden on the original counsel who would need to comply with the detailed requirements for withdrawal of representation in order for recognition to be terminated. It is conceivable that counsel would be unable to withdraw under § 2.19 if efforts to contact the registrant are unsuccessful, due to the notices required by the rule. Thus, under the proposed rule an attorney of record would be considered by the USPTO as representing a registrant despite any agreements regarding representation between that registrant and their counsel. Accordingly, the proposed rule would create adverse implications for the attorney-client relationship that the current rule does not impose.

The current USPTO practices embody a familiar and practical approach to the issue of recognition and representation. If recognition ends after the end of a filing process, ongoing representation will not be presumed. The present workable system under which counsel (same or new) is recognized as the attorney of record by signing a submission to the USPTO on behalf of the applicant or registrant, or by being named as the attorney in a submission filed on behalf of the applicant, should not be disturbed. INTA favors maintaining the current practices by changing the rules to reflect those practices specifically, without imposing additional filing requirements on owners or withdrawal requirements on counsel. The provision regarding change of ownership should be changed to reflect the recordation of an assignment documenting such change.

The USPTO also suggests that the proposed rule change is necessary to facilitate a “forthcoming identity verification process.” The USPTO explains that without the proposed rule change, “while the last attorney of record could submit the TEAS form to file a maintenance document, the role-based access controls would require the attorney to first request IT permission from the owner to do so. This could result in missed deadlines.” INTA believes that the proposed rule changes are premature until such time as the USPTO can provide the details of its proposed new system, so that the ramifications (which are likely to be significant) can be considered. The disadvantages of maintaining recognition of counsel in perpetuity outweigh the risk of a missed deadline attributable to future compliance issues with a new and presently unknown system, especially given the availability of grace periods for a maintenance document filing.

As an additional justification, the USPTO claims that misleading solicitations are likely to be intercepted more effectively by trademark attorneys than by an “unrepresented applicant or registrant.” In reality, INTA’s experience is that many solicitations are directed by mail to the mailing address of record for the owner, as opposed to the address of the attorney of record. Moreover, the USPTO currently requires that the owner keep an active e-mail address on record with an application file. INTA believes that the proposed rule changes will not alleviate scam solicitations, in that scammers

have shown creativity in obtaining information from USPTO databases and directing communications to registrants instead of their counsel. In short, so long as application and ownership information is publicly available, scammers will have opportunities to perpetrate scams on applicants and registrants.

Lastly, the USPTO states that as an interim measure, it would remove the name of any attorney whose recognition has already ended under existing § 2.17(g) from the current attorney-of-record field in the USPTO's database, yet would retain the attorney's correspondence information, including any correspondence email address, so that relevant correspondence and notices can continue to be sent to both the formerly recognized attorney and the owner. These actions by the USPTO would be unnecessary if changes were merely made to the rules to reflect current practice.

C. *INTA's Proposed Alternative Rule Changes*

Accordingly, INTA proposes changes to § 2.17(g) and § 2.18 that would reflect and align with current practice and also the forthcoming expungement and reexamination proceedings:

§ 2.17 Recognition for representation.

* * *

(g) Duration of recognition.

(1) The Office considers recognition as to a pending application to end (i) when the registration certificate is transmitted to the attorney of record, (ii) when ownership changes as documented by a recorded assignment, (iii) two months after the date on which a notice of abandonment is transmitted to the attorney of record, unless a petition to revive is timely filed, in which case the Office considers recognition to end on the date on which a denial of the petition is transmitted to the attorney of record; or (iv) upon withdrawal of the attorney granted by the Office pursuant to § 2.19(b) or (c).

(2) The Office considers recognition obtained after registration to end when the mark is cancelled or expired; when ownership changes as documented by a recorded assignment; or upon withdrawal of the attorney granted by the Office pursuant to § 2.19(b) or (c). If a practitioner was recognized as the representative in connection with an affidavit under section 8, 12(c), 15, or 71 of the Act, renewal application under section 9 of the Act, or request for amendment or correction under section 7 of the Act, recognition is deemed to end upon the transmittal to the attorney of record of the acceptance or final rejection of the filing.

§ 2.18 Correspondence, with whom held.

(a) Establishing the correspondent. The Office will send correspondence as follows:

(1) If an attorney is not recognized as a representative pursuant to § 2.17(b)(1), the Office will send correspondence to the applicant, registrant, or party to the proceeding.

(2) If an attorney is recognized as a representative pursuant to § 2.17(b)(1), the Office will correspond only with that attorney until recognition of the attorney has ended pursuant to § 2.17(g). Thereafter, the Office may send courtesy reminders for maintenance of a registration to the domestic representative, if any has been appointed; to the attorney, if any, listed as correspondent on the

records of the Office; and to the registrant. Service of a cancellation petition and notices of institution of expungement or reexamination proceedings will be sent by the Office to the domestic representative, if any has been appointed; to the attorney, if any, listed as correspondent on the records of the Office; and to the registrant. A request to change the correspondence address does not revoke a power of attorney. Except for service of a cancellation petition and notices of institution of expungement or reexamination proceedings, and courtesy reminders for maintenance of a registration, the Office will not correspond directly with the applicant, registrant, or a party to a proceeding, or with another attorney from a different firm, unless:

- (i) The applicant or registrant files a revocation of the power of attorney under § 2.19(a) and/or a new power of attorney that meets the requirements of § 2.17(c);
- (ii) The attorney has been suspended or excluded from practicing in trademark matters before the USPTO; or
- (iii) Recognition of the attorney has ended pursuant to § 2.17(g).

(b) Ex parte matters. Only one correspondence address may be designated in an ex parte matter.

(c) Maintaining and changing the correspondence addresses. The applicant, registrant, or party to a proceeding must maintain current and accurate correspondence addresses, as required by § 2.23, for itself and its attorney, if one is designated. If any of these addresses change, a request to change the address, signed in accordance with § 2.193(e)(9), must be promptly filed.

(d) Post registration filings under sections 7, 8, 9, 12(c), 15, and 71 of the Act. Even if there is no new power of attorney or written request to change the correspondence address, the Office will change the correspondence address upon the examination of an affidavit under section 8, 12(c), 15, or 71 of the Act, renewal application under section 9 of the Act, or request for amendment or correction under section 7 of the Act, if a new address is provided, in accordance with paragraph (a) of this section.

In summary, INTA respectfully requests that the USPTO consider the proposed rule changes provided in these comments to conform the rules to current practice and take into consideration the new expungement and reexamination proceedings without substantively requiring the recognition of attorneys in perpetuity. INTA believes the proposed amendment in the NPRM will create confusion and cause an undue burden on applicants and registrants as well as their attorneys. INTA hopes that once the details of the anticipated role-based access control system become available, there will be a future opportunity to consider any additional changes to the attorney recognition rules that may be appropriate.

VII. Court Orders Concerning Registrations

In Section VII of the NPRM, the USPTO proposes to “codify the USPTO’s longstanding procedures concerning action on court orders cancelling or affecting a registration under section 37, 15 U.S.C. 1119, that are currently set forth in § 1610 of the Trademark Manual of Examining Procedure. The USPTO requires submission of a certified copy of the order and normally does not act on such orders until the case is finally determined.” The NPRM further states that “[t]he USPTO proposes to add § 2.177 to address procedures concerning action on court orders cancelling or affecting a registration under section 37 of the Act.”

INTA respectfully requests that proposed § 2.177 be changed so as not to reflect that a party must provide the certified copy. The requirement that a party obtain the certified copy and submit it to the USPTO adds an unnecessary burden on litigant parties. The statute, 15 U.S.C. §1119, refers to the “certification by the Court to the Director.” and §1610 of the TMEP consistently reflects this. This procedure has worked for years as handled directly by courts, and there seems to be no reason to require a party to first obtain a certified copy from a court and then send it on (by mail) to the Director.

Further, the proposed rule is vague in referring only to “a party,” and does not identify which party to litigation is responsible or specify the resulting penalty for failure to provide the certified copy. While the interested party may choose to attend to this process itself, it should not be mandated to do so. However, INTA has no objection to requiring a court party to a TTAB action to submit an order to the TTAB, but only where it is a party to the TTAB action.

In summary, INTA supports allowing the current system for court submission of court orders to remain in place, and not adding the burden on a party. INTA has no objection to adding the obligation burden on a party who is a litigant in both the court and a TTAB proceeding involving the mark to provide a copy of the order to the TTAB.

Conclusion

We hope that these comments are helpful, and we welcome the opportunity to discuss them in greater detail, if helpful. For any questions or follow-up, please contact Jenny McDowell, INTA’s Director of Government Relations, at jmcdowell@inta.org.