October 24, 2016

Via email to Mary.Denison@uspto.gov

Ms. Mary Boney Denison
Commissioner for Trademarks
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Informal Comments on Proposals to Improve the Accuracy of the United States Trademark Register

Dear Commissioner Denison:

I write on behalf of the American Bar Association Section of Intellectual Property Law (“ABA-IPL Section” or “Section”) to respond to the United States Patent and Trademark Office’s (“USPTO”) invitation for informal comments on its proposals to improve the accuracy of the US trademark register.

Under separate cover, the Section has responded to the Office’s invitation for written comments on the "Changes in Requirements for Affidavits or Declarations of Use, Continued Use, or Excusable Nonuse in Trademark Cases" reported in the Federal Register at 81 Fed. Reg. 22. (PTO-T-2016-0002, June 22, 2016). A copy of those comments is enclosed for your convenient reference.

The American Bar Association is the largest voluntary professional association in the world and the ABA-IPL Section is the largest intellectual property law association with 20,000 members. The views expressed in this letter are those of the Section. These views have not been approved by the House of Delegates or the Board of Governors of the American Bar Association and, accordingly, should not be construed as representing the position of the Association.

The Section supports the USPTO’s goal of assessing and promoting the accuracy and integrity of the trademark register through the use of expungement mechanisms to expunge unused goods and services from trademark registrations. Therefore, the Section generally supports the proposed expungement mechanisms.
The Section commends the USPTO for its consideration of different types of expungement and
non-use proceedings and mechanisms, some of which could potentially be implemented without
statutory changes. Along with the USPTO’s plans to increase the solemnity of the declaration
filed with Section 8 and 71 Declarations, the proposed mechanisms are valuable tools for
efficiently removing unused registrations from the Register.

Trademark Trial and Appeal Board Expungement Proposal

The Section provides the following informal comments and feedback about the USPTO’s
proposal for an expungement proceeding before the Trademark Trial and Appeal Board
(“Board”) that would allow a simplified and accelerated procedure for removing unused
goods and services from trademark registrations. The Section appreciates the USPTO’s
consideration of proposals that would not need statutory changes in order to implement.

The Section is uncertain that the proposed streamlined proceeding will be effective or
widely used for several reasons. First, the enhanced briefing that would likely be required
would increase the time and cost of the proceeding. Second, both parties may provide the
other party and the Board with substantial evidence that had neither been entered into the
record through testimony nor provided pursuant to calculated discovery requests. Third,
in light of the relatively high percentage of default judgments in cancellation
proceedings, trademark owners may be unlikely to spend more time and money on an
expungement proceeding that is just as likely to end in a default judgment.

However, the Section applauds the USPTO’s proposal to expedite the default judgment
procedure to within 60-80 days. Even if the USPTO does not decide to move forward
with the expungement proposal, the Section is interested in ways that the USPTO and
Trademark Trial and Appeal Board can ensure a consistent and predictable timeline for
default judgments.

Trademark Examining Operation Expungement Action Proposal

The Section also provides feedback on the USPTO’s proposed Trademark Examining
Operation (“TMEO”) expungement action that would allow anyone to request
expungement through the TMEO. While the Section has some reservations regarding the
proposed expungement actions, as discussed below, the Section supports the idea of an
expungement action that would provide a streamlined mechanism for removing specific
unused goods and services from registrations. The Section, however, has some concerns
that it believes need to be addressed.

The Section’s biggest concern is the potential for abuse. In particular, the Section notes
that the current proposal does not have a minimal standing requirement for a party
requesting expungement. The Section asks that the USPTO consider additional measures
to prevent a malicious party from abusing the system.

The Section is also concerned that the proposal gives a considerable amount of discretion
and unilateral power to the TMEO to cancel a trademark registration without the benefits
of discovery or other procedures available in a TTAB cancellation proceeding. Further, it
is unclear whether the expungement process would be reviewable by a federal court. The Section asks that the USPTO consider setting clear standards for the proceeding and outline the oversight and internal review it would have over the process. The Section also asks that the USPTO ensure that expungements can be reviewed by a federal court.

The Section also asks the USPTO to consider potential alternatives to the proposed “per-good/service” pricing model, wherein a party requesting expungement would be required to pay a fee for each good/service it requests be expunged. While the Section agrees that the proposed fee structure would likely discourage the filing of arbitrary requests, it may ultimately favor non-U.S. applicants whose registrations registered under Section 44(e) and Section 66(a) often contain long identifications of duplicative and broadly identified goods and services. It may also encourage U.S. applicants to include longer and duplicative identifications of goods and services in their applications as a strategy to increase the costs of a future request for expungement.

The Section would also like to raise concerns about the standard used to determine whether the USPTO will expunge goods and services from a challenged registration. The proposed statutory language in Section 14 (as well as in Section 16 for the new ground for cancellation at the TTAB) use the language of “use sufficient to support registration” (instead of evidence of “use in commerce”). However, Section 1 requires “use in commerce” before registration. Further, “use in commerce” has a statutory definition in Section 45 understood by most trademark practitioners. The Section is concerned that the USPTO seems to be proposing a new standard bereft of a statutory pedigree and absent from the case law. This may create unnecessary uncertainty as to the meaning of “use sufficient to support registration” compared to “use in commerce.”

The ABA-IPL Section commends the Office for its consideration of these issues and appreciates the opportunity to offer these comments.

Very truly yours,

Donna P. Suchy
Section Chair
American Bar Association
Section of Intellectual Property Law

Encl.