October 24, 2016

Via email to sharon.marsh@uspto.gov
Ms. Sharon R. Marsh
Deputy Commissioner for Trademark Examination Policy
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Comments on Reformatted Trademark Declarations

Dear Ms. Marsh:

I write on behalf of the American Bar Association Section of Intellectual Property Law (“ABA- IPL Section” or “Section”) in response to the United States Patent and Trademark Office’s (“Office”) invitations for written comments about the proposed reformatting of the declaration and signature portion of the forms for applications for registration, allegations of use, and post-registration affidavits or declarations of continued use or excusable non-use, posted on uspto-tmep.ideascale.com on July 28, 2016.

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 approximately 20,000 members. The views expressed in this letter are those of the Section alone. 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 Office’s goal of promoting the integrity of the Trademark Register by reformatting the verified statements made in connection with applications, allegations of use and post-registration affidavits, to separate out the clauses to improve readability and to require the signatory to check a box next to each statement in order to validate an electronic submission. The Section agrees that the current formatting of the declaration paragraphs may not promote sufficient reflection by the signatory before he or she signs a document and that the reformatting as proposed may promote, to a small degree, the necessary contemplation of the signatory.
However, the Section is concerned that mere reformatting of the declaration may not be sufficient to significantly improve the accuracy of the Trademark Register. While the proposed reformatting may help to some degree, the statements in the declarations are excerpted from statutory language and remain difficult for applicants to fully understand. The Section suggests that the adoption of simpler language in the declarations would more significantly impact the accuracy of the Register.

Also, the Section is concerned that the USPTO’s proposed changes may only be accessible to users who sign declarations electronically in the TEAS system, and that handwritten signatures on scanned documents uploaded into TEAS may not be required to conform to the proposed format. Accordingly, the goals of the USPTO in reformatting the declarations may only be achieved for the subset of applicants that sign declarations electronically rather than uploading scanned copies of signed declarations. The Section suggests that the USPTO clearly state whether uploaded documents must conform in order to be accepted, cite its legal authority to impose such requirement, and update the TMEP accordingly. The Section recognizes that if the USPTO will not require conformity in uploaded documents, it may at a later date determine to require electronic signatures as part of the set of requirements entitling applicants to reduced official fees, and the Section reserves its comments in relation to such a proposal until it has been made.

**Additional Reformatting Measures**

Additional reformatting measures could more effectively achieve the Office’s goal. For example, the Section recommends that the Office adopt simple headings in bold font next to each of the checkboxes to draw the signatory’s attention to the subject matter addressed in the statement. If headings are adopted, then the Section considers it necessary to include a statement that the headings are for convenience only and shall not control or affect the legal meaning, construction, or interpretation of any portion of the declarations.

The Section also suggests that each statement be accompanied by an explanatory note which might be accessible (i) when the computer mouse hovers over the statement, (ii) via an icon, (iii) an “about this statement” link on which the user could click, or (iv) an associated “help” page on the USPTO website. An explanatory note for each statement may be particularly helpful for pro se applicants that do not have the benefit of legal counsel, but it could also aid correspondents of record in educating their clientele about the solemnity and significance of the language.

**New language in declarations**

The Section also notes that the USPTO’s proposed changes include some language that does not currently appear in the declarations. The language states: “To the best of the signatory’s knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.” The Section understands that such language reiterates what is
required under 37 C.F.R. § 11.18(b). However, the Section considers this newly added language to be unnecessary in view of subsequent statements in the declaration that attest to the truthfulness of the statements. The Section also considers the “evidentiary support” language to be ambiguous, and the Section recommends providing a simple text explanation of what it means to be “evidentiary” for less sophisticated or experienced users as discussed above. Finally, the Section suggests that the USPTO draw attention to the newly included language when publicizing the reformatting initiative.

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