May 21, 2014

Via electronic mail
tmfrnotices@uspto.gov

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Attn: Cynthia Lynch, Administrator for Trademark Policy and Procedure

Re: Comments on Proposed Changes in Requirements for Collective Trademarks and Service Marks, Collective Membership Marks, and Certification Marks.

Dear Ms. Lynch:

We write on behalf of the American Bar Association Section of Intellectual Property Law (the “Section”) to provide comments in response to the United States Patent and Trademark Office’s (the “Office”) invitation for public comment on the proposed Changes in Requirements for Collective Trademarks and Service Marks, Collective Membership Marks, and Certification Marks (the “Request for Comments”). The American Bar Association is the largest voluntary professional association in the world and the Intellectual Property Law Section is the largest intellectual property association with over 24,000 members. The views expressed in this letter are those of the Section. These comments have not been approved by the ABA House of Delegates or Board of Governors and should not be considered as views of the American Bar Association.

The Office proposes to amend the rules related to collective trademarks, collective service marks, and collective membership marks (together “Collective Marks”), and certification marks (“Certification Marks”) to clarify application requirements, allegations of use requirements, multiple-class application requirements, and registration maintenance requirements for such marks. These proposed rule changes will codify current Office practice set forth in the Trademark Manual of Examining Procedure (the “TMEP”) and precedential case law. These changes also will permit the Office to provide the public with more detailed guidance regarding registering and maintaining registrations for Collective Marks and Certification Marks. Further, these proposed changes are designed to promote the efficient and consistent processing of such marks.
The Section appreciates the Office’s inquiry to stakeholders on whether changes should be made to the Trademark Rules of Practice and the Rules of Practice in filing requirements for Collective Marks and Certification Marks. For ease of reference, a summary of all proposed rule changes has been included in the attached Appendix A.

The Section understands, as the Request for Comments states, that most of the rule changes proposed by the Office are intended simply to codify existing practice, to clarify the application and registration filing and maintenance process, as well as to harmonize the filing and registration procedures for Collective Marks and Certification Marks with those required for other trademarks and service marks. As such, the proposed changes appear to be reasonable and the Section is generally in favor of the amendments. However, the Section would like to take this opportunity to provide some additional comments on specific proposed sections.

Potential Burden Imposed by Proposed Rule §2.34: Bases for Filing an Application.

The Office states that the proposed changes would not create a significant burden on small business applicants or existing registration owners. According to the Office, these changes would create consistency, and streamline the rules by consolidating text and incorporating headings. Further, by codifying existing Office practice, as set forth in the TMEP, the rules pertaining to Collective Marks and Certification Marks would be harmonized with those rules relating to other trademarks. The proposed changes are intended to simplify the application and registration process, and to provide applicants and registrations with more detailed guidance on the process, especially with respect to Collective Marks and Certification Marks.

Overall, that goal seems to be accomplished. The Section, however, has identified one potentially ambiguous revised provision. Section § 2.34 (Bases for filing a trademark or service mark application) provides in part that,

(a) An application for a trademark or service mark must include one or more of the following five filing bases:

(i) Use in commerce under section 1(a) of the Act. The requirements for an application under section 1(a) of the Act are:

   (i) The applicant’s verified statement that the mark is in use in commerce. If the verified statement is not filed with the initial application, the verified statement must also allege that the mark has been in use as of the application filing date;

   *   *   *   *   *

   (iii) The date of the applicant’s first use of the mark in commerce;

   (iv) One specimen showing how the applicant uses the mark in commerce; and . . .

While this proposed rule, on one hand, seems to suggest that if the verified statement is not filed along with the initial application, when the verified statement is filed, it must state that the mark has been in use as of the application date. An argument can also be made that this proposed change requires declarants to affirm that the mark is in use both at the time of filing and that it has been in continuous use since that time up to the date that the verified statement is filed. Assuming that the Office did not intend the
latter interpretation, the Section recommends that the language should be amended to state that "the verified statement must also allege that the mark was in use in commerce as of the application filing date”. The same comments would seemingly apply to further sub-sections relating to applications filed under 1(b) or 44 of the Act (i.e. Sections 2.34(a)(2) and 2.34(a)(3)(i) respectively).

**Conclusion**

The Section commends the Office for its consideration of these issues and appreciates the opportunity to offer comment.

Very truly yours,

Robert O. Lindefjeld  
Section Chair  
American Bar Association  
Section of Intellectual Property Law
Appendix A

Summary of Proposed Rule Changes:

- The Office proposes to revise the rules in parts 2 and 7 of title 37 of the Code of Federal Regulations in the following ways (not including typographical reference changes):
  
  - § 2.2: Definitions.
  - § 2.20: Declarations in lieu of oaths.
  - § 2.32 Requirements for a complete trademark or service mark application.
  - § 2.33 Verified statement for a trademark or service mark.
  - § 2.34: Bases for filing a trademark or service mark application
  - § 2.41: Proof of distinctiveness under section 2(f).
  - § 2.42: Concurrent use.
  - § 2.44 Requirements for a complete collective mark application.
  - § 2.45 Requirements for a complete certification mark application; restriction on certification mark application
  - § 2.56: Specimens.
  - § 2.59: Filing substitute specimen(s)
  - § 2.71: Amendment to correct informalities.
  - § 2.74: Form and signature of amendment.
  - § 2.76: Amendment to allege use.
  - § 2.86: Multiple-class applications.
  - § 2.88 Statement of use after notice of allowance.
  - § 2.89: Extensions of time for filing a statement of use.
  - § 2.146: Petitions to the Director.
  - § 2.161: Requirements for a complete affidavit or declaration of continued use or excusable nonuse.
  - § 2.167 Affidavit or declaration under section 15.
  - § 2.173: Amendment of registration.
  - § 2.175: Correction of mistake by owner.
  - § 2.183: Requirements for a complete renewal application.
  - § 2.193: Trademark correspondence and signature requirements.
  - § 7.1: Definitions of terms as used in this part.
  - § 7.37: Requirements for a complete affidavit or declaration of use in commerce or excusable nonuse.