December 5, 2018

The Honorable Hakeem Jeffries  
Member, Committee on the Judiciary  
U.S. House of Representatives  
Washington, D.C. 20515

Re: Request for Comments on Amendments to Section 2(b) of the Lanham Act

Dear Representative Jeffries:

This letter is sent on behalf of the American Bar Association’s (“ABA”) Section of Intellectual Property Law (the “Section”) to express its views on a proposed bill regarding an amendment to Section 2(b) of the Lanham Act, 15 U.S.C. §1052(b).

As you may be aware, the ABA is the legal profession’s leading national voluntary bar organization, with over 400,000 members hailing from each of the fifty states, the District of Columbia, and the U.S. Territories. The Section is the world’s largest organization of intellectual property professionals, with over 17,000 members. The Section’s membership includes lawyers and other legal and policy professionals representing a wide array of business and other interests, and its views reflect a broad consensus regarding the important issues our country faces in developing, improving, and enforcing intellectual property rights for the overall benefit of United States businesspeople and consumers. The views expressed in this letter, however, are those of the Section. They have not been submitted to or approved by the ABA House of Delegates or Board of Governors and should not be construed as views of the Association as a whole.

Currently Section 2(b) of the Lanham Act, 15 U.S.C. §1052(b), prohibits the registration of marks consisting of or comprising a flag, coat of arms, or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof. The Section supports an amendment to this provision to allow for the registration of these marks, with the written consent of the competent authority behind each such designation, assuming the applicant otherwise satisfies the requirements of a trademark registration. Such amendment would also clarify that such marks are entitled to common law trademark rights, to address cases such as *Renna v. County of Union*, 88 F.Supp.3d 310 (D.N.J. 2014), which held that an official insignia un-registrable as a trademark under Section 2(b) also lacked common law trademark rights.
The proposed amendment to allow for the registration of marks comprising or including official insignia, provided the written consent of the competent authority is obtained, is narrowly and reasonably tailored. This amendment will help preserve the integrity of such marks by granting the owner of such marks on the Principal Register numerous rights, including the right to use the (R) symbol, the right to file trademark infringement suits in federal courts, the ability to have their mark cited by the U.S. Patent and Trademark Office against applications for confusingly similar marks, and the ability to register their mark with Customs to bar infringing imports. Moreover, owners of federal trademark registrations are statutorily presumed to have the exclusive right to use the registered mark nationwide, with a priority date based on the registration filing date. Because the owner of the official insignia will be required to provide written consent, the amendment preserves the government authority, permits the government agency to prevent counterfeit uses of its insignia that might harm the public interest and presents little risk.

In addition, the Section recommends that the proposed amendment also include language which codifies certain holdings of the Trademark Trial and Appeal Board that interpret Section 2(b) to permit registration of department or agency insignia which do not connote or suggest national authority, such as the seals, emblems, flags, coats of arms or other official insignia of the various branches of the military, the Department of the Interior, the Department of Defense or the Department of the Treasury, inter alia. See, In re U.S. Dep't of the Interior, 142 USPQ 506, 507 (TTAB 1964); In re Peter S. Herrick, P.A., 91 USPQ2d 1505 (TTAB 2009).

Thus, the Section recommends further refinement to the proposed language which provides for the registration of marks consisting of the flag, coat of arms, or other insignia of the United States, any Departments or Agencies of the United States, any State or municipality, or any foreign nation upon the written consent of the competent authority.

In view of the above, we look forward to the introduction of the amendment and appreciate your consideration of the Section’s view.

Very truly yours,

Mark K. Dickson
Section Chair
ABA Section of Intellectual Property Law