

Nineteen Hundred and Twenty-two

# NYIPLA

The New York Intellectual Property Law Association®

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March 18, 2019

**Via Email** [TMFRNotices@uspto.gov]  
Commissioner for Trademarks  
P.O. Box 1451,  
Alexandria, VA 22313-1451  
Attention: Catherine Cain, Esq.

Re: NYIPLA Comments in Response to Notice of Proposed Rulemaking Concerning Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, 84 Fed. Reg., No. 32, pp. 4393-4404 (Docket No. PTO-T-2018-0021)

Dear Ms. Cain:

The New York Intellectual Property Law Association (“NYIPLA”) welcomes the opportunity to provide comments to the Notice of Proposed Rulemaking (“NPRM”) for a possible Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants. 84 Fed. Reg., No. 32, pp. 4393-4404 (Docket No. PTO-T-2018-0021).

The NYIPLA is a professional membership association comprised of approximately 1,000 lawyers interested in Intellectual Property law who live or work within the New York City metropolitan area. The Association’s mission is to promote the development and administration of intellectual property interests and educate the public and members of the bar on Intellectual Property issues. Its members work both in private practice and government, and in law firms as well as corporations, and they appear before the federal courts and the United States Patent and Trademark Office (“USPTO”). The NYIPLA provides these comments on behalf of its members professionally and individually and not on behalf of their employers.

With respect to the Notice of Proposed Rulemaking, the NYIPLA offers the following comments:

### **NYIPLA Supports the Proposed Rule**

The NYIPLA supports the proposed rule requiring applicants, registrants or parties to proceedings in the USPTO whose domicile or principal place of business is not located within the United States or its territories (hereinafter “foreign filers”) to be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the U.S. (including the District of Columbia and any Commonwealth or territory of the U.S.). The NYIPLA notes and concurs with the concerns expressed by the USPTO in the NPRM that (a) there is an increasing problem of foreign trademark applicants, who are purportedly acting *pro se*, filing inaccurate and possibly fraudulent submissions in violation of the Trademark Act and the USPTO’s rules, (b) the proposed new requirement

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will help to curtail and deter such practices, and (c) there will be resulting benefits to public, including legitimate trademark filers based both in the U.S. and abroad, due to the improved accuracy and integrity of the U.S. Trademark Register and a decrease in the burdens and disadvantages encountered by legitimate filers as the consequence of such improper practices.

In particular, the NYIPLA notes the USPTO's advice and statistics provided in the NPRM indicating that there has been a marked increase in recent years in the frequency with which foreign-based, purportedly *pro se* trademark filings have included inaccurate and possibly fraudulent claims of use of the subject mark in United States commerce, often supported by specimens of such use that have been mocked-up or digitally altered, tending to indicate that the mark may not actually be in use. As the USPTO also notes in the NPRM, the presently existing mechanisms and sanctions available to the USPTO and other U.S. authorities have not proven adequate by themselves to curb such practices, given that the possibility of sanctions for making false declarations and/or practicing law without a license are not as effective against foreign filers and foreign-based representatives of such filers as they are with respect to U.S.-based parties.

The NYIPLA agrees that the proposed new requirement should be effective in curtailing and deterring the increasingly frequent practice by some foreign filers of making false or inaccurate claims in their U.S. trademark filings. This is because, under the proposed new rule, submissions to the USPTO would be made by practitioners subject to disciplinary jurisdiction at both the federal and state levels, making it less likely that the filings will contain inaccurate statements or be signed or averred to by unauthorized parties.

The benefits to the public resulting from this change will essentially be two-fold: (1) the U.S. Trademark Register, which the public relies upon when considering the possible adoption of new marks, will more accurately reflect those prior marks which were actually in use and/or entitled to registration; and (2) legitimate trademark filers, including those based both in the U.S. and abroad, will face less of a burden and disadvantage as a consequence of inaccurate filings. At present, based on the experience of the members of the NYIPLA, we concur with the USPTO that the burdens and disadvantages presently faced by legitimate filers and prospective filers are substantial. These include additional costs associated with investigating the actual use of a mark to assess possible conflicts, changing business plans in order to avoid an apparent conflict, and/or the need to bring proceedings in the USPTO or the courts to prevent the issuance of or cancel such improperly supported prior registrations. These burdens and disadvantages will be alleviated because the new requirement will, as noted above, reduce the frequency of inaccurate and/or fraudulent applications and resulting registrations of trademarks in the U.S.

### **NYIPLA Does Not Agree with the Suggested Exception Relating to Madrid-Based Filings**

The NPRM includes and invites comment on a possible exception to the new requirement for applications filed pursuant to Section 66(a) of the Trademark Act (15 U.S.C. 1141f(a)), which are in the nature of requests to extend the protection of International Registrations under the Madrid Protocol to the United States and which are initially filed with the International Bureau ("IB") of the World Intellectual Property Organization (hereinafter "Madrid Applications"). In particular, the NPRM suggests waiving the new requirement with respect to those Madrid Applications that, when they are submitted, are already in order to be approved for publication upon first examination in the USPTO.

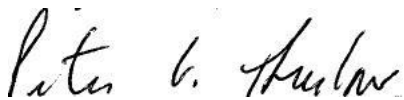
However, the NYIPLA suggests that Madrid applications be treated like other applications under the new rule, i.e. they should receive an Office Action stating that U.S. counsel must be appointed before the USPTO proceeds to full review and reminding the applicant that a *bona fide* intention to use the mark is required even for applications based on foreign filings. This NYIPLA believes that the early involvement with U.S. counsel in connection with the latter category of Madrid applications would be a reasonable measure to help ensure accurate compliance with the requirement, applicable to all Madrid applications seeking extension into the United States, of a *bona fide* intention to use the mark in US commerce in connection with the goods or services identified in the application. The failure of many applicants, including Madrid-based filers, to accurately comply with this requirement, and to instead file applications including voluminous lists of goods or services in multiple classes that are not fully supported by such a *bona fide* intention, has proven to be an additional cause of inaccuracy in the U.S. Trademark Register, posing related burdens and disadvantages to legitimate filers.

### **NYIPLA Supports the Option Of Deferring Substantive Examination Until the Applicant Complies With New Requirement**

The NPRM also requests comments on two different possible approaches for enforcing the new requirement. In one approach, where an application has been filed in violation of the new requirement, the USPTO would conduct a full examination and then issue an Office Action including the new requirement along with any other refusals or objections that may be applicable. In the alternative approach, the USPTO would conserve its resources with regard to the non-complying application by issuing an initial Office Action that only requires the appointment of U.S. counsel and which states that full examination is being deferred until this requirement is complied with. NYIPLA generally supports the latter proposal, which avoids the need for the USPTO to expend additional resources in situations where it may often prove unnecessary, i.e. in cases where the non-complying foreign filer opts to abandon the application instead of complying with the requirement.

Thank you for giving the NYIPLA the opportunity to provide feedback on the Proposed Rulemaking. We look forward to providing the USPTO with additional feedback in the future.

Respectfully submitted,



Peter G. Thurlow  
President, New York Intellectual Property Law Association