



INTELLECTUAL PROPERTY LAW ASSOCIATION OF CHICAGO

July 19, 2021

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Via Online Submission

Robert Lavache
Office of the Deputy Commissioner for Trademark Examination
Policy
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Mr. Lavache:

The Intellectual Property Law Association of Chicago (“IPLAC”) appreciates the opportunity to provide comments to the U.S. Patent and Trademark Office (“USPTO”) in response to the “Changes to Implement Provisions of the Trademark Modernization Act” as originally published on May 17, 2021 in the Federal Register (37 CFR Parts 2 and 7).

Founded in 1884, IPLAC is the country’s first and oldest bar association devoted exclusively to intellectual property matters. Located in Chicago, a principal locus and forum for the nation’s authors, artists, inventors, scholarly pursuits, arts, creativity, research and development, innovation, patenting, and patent litigation, IPLAC is a voluntary bar association with interests in the areas of patents, trademarks, copyrights, and trade secrets and the legal issues they present. Its members include attorneys in private and corporate practices before federal bars throughout the United States, the USPTO and the U.S. Copyright Office. IPLAC offers the following comments and suggestions regarding the proposed changes to the rules of representation of others before the USPTO that may be worthy of consideration:

1. Flexible Response Periods. The Trademark Modernization Act (“TMA”) amended section 12(b) of Lanham Act, 15 U.S.C. 1062(b), allows the USPTO to set response periods by regulation for a time

period between 60 days and 6 months, with the option for extensions to a full 6-month period. IPLAC agrees with the USPTO's proposal of a delayed implementation date of June 27, 2022 in order to allow customers to update their practices and IT systems for these changes.

The USPTO further seeks commentary on two procedures for the flexible response period: (1) a two-phase examination system with each phase having separate shortened, but extendable, response periods; or (2) an initial response period of two months which also allows applicants to file a response in the third, fourth, fifth, or sixth month after issuance of the Office action by submitting an extension request and a fee payment along with the response. IPLAC believes a two-phase examination system will place unnecessary burdens on trademark applicants to consider changes that could otherwise be determined at once. Thus, IPLAC recommends the second proposed procedure: an initial response period of two months, which also allows applicants to file a response or submit an extension request.

2. Attorney Recognition and Withdrawals. The USPTO seeks to implement a role-based access control system to improve USPTO database integrity. The database currently requires *MyUSPTO.gov* accounts to log-in and access filing and response forms. The USPTO proposes additional security measures to access the USPTO's electronic systems, including introducing identity verification requirements, assigning roles to customer accounts (role-based access control), and restricting access to files to exclude actions by unauthorized parties.

While the last attorney of record could submit the TEAS response form if the USPTO retains § 2.17(g) in its current form, the role-based access controls would require the attorney to first request IT permission from the owner to do so. IPLAC agrees with the USPTO that this could result in missed deadlines due to requiring additional time to authenticate documents. As a result, IPLAC questions the efficacy of requiring further authentication and security measures to simply access filing and response forms in order to maintain the integrity of the USPTO database.

In addition, the USPTO seeks to further clarify § 2.19 regarding an attorney's obligations in withdrawing representation. IPLAC believes the proposed changes may be redundant to the USPTO Rules of Professional Conduct that already outlines the duties of an attorney. Specifically, the proposed changes may further place an undue

burden to practitioners and trademark registrants when practitioners may need to withdraw representation at their discretion.

3. Expungement and Reexamination. The TMA created two new ex parte procedures that will allow any third party, or the Director, to challenge a mark that has not been used in commerce in connection with all or some of the goods and services listed on the registration certificate. A registered mark can be effectively cancelled through expungement or reexamination. Overall, IPLAC agrees that the proposed new ex parte procedures may provide an improved system for addressing issues in cited-registrations that often block applications from achieving registration. In particular, IPLAC encourages the USPTO to initiate audits for registrants who fail to respond to expungement or reexamination proceedings. IPLAC believes these audits are likely encourage registrants to be more engaged in responding, and/or further serve to remove goods/services that were never in use or are no longer in use in order to meet the USPTO's policy objectives through these added procedures.

IPLAC thanks the U.S. Patent and Trademark Office for considering these comments and would welcome any further dialogue or opportunity to support U.S. the Patent and Trademark Office.

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