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October 22, 2012

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

Attn: Cynthia G. Lynch, Administrator for Trademark Policy & Procedure  
USPTO

Re: Comments on *Amending The First Filing Deadline For  
Affidavits Or Declarations Of Use Or Excusable Nonuse*

Dear Ms. Lynch:

We write on behalf of the American Bar Association, Section of Intellectual Property Law (“ABA IPL Section”), to provide comments in response to the United States Patent and Trademark Office’s *Request For Comments Regarding Amending The First Filing Deadline For Affidavits Or Declarations Of Use Or Excusable Nonuse*, 77 Fed. Reg. 159 (PTO-T-2012-0031, August 16, 2012). The American Bar Association is the largest voluntary professional association in the world, and the Intellectual Property Law Section is the largest intellectual property legal association, with over 25,000 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 ABA IPL Section appreciates the Office’s inquiry regarding a possible change to the time period for filing the initial Section 8 or 71 Affidavit Or Declaration Of Use Or Excusable Nonuse (hereafter “Section 8 or Section 71 Declaration”), and specifically, its invitation for comments and responses to the questions set forth in the *Federal Register* notice.

The ABA IPL Section conducted a survey to obtain information from Section members about their concerns regarding deadwood, the impact of deadwood on clearing marks, and their beliefs regarding the benefits or disadvantages of changing the deadline for submission of the initial Section 8 or Section 71 Declaration. The survey results show a divergence of opinions and suggest that

further study should be conducted before the USPTO proposes a change to the deadline for submission of the initial Section 8 or Section 71 Declaration. References to positions reflected by the survey are included in the responses to the USPTO's questions set forth below. We enclose with this letter a tabulation of the survey results showing all of the survey responses.

### Responses To The USPTO's Questions

*(1) Is "deadwood" on the trademark register a concern of yours, and what impact do you believe it has?*

The presence of deadwood on the register is a matter of concern, but not a matter of significant concern, to the majority of respondents. The majority of respondents reported that they occasionally were unable to clear a mark due to conflicting registrations filed under Section 44 or 66 of the Trademark Act for marks that they believed were not in use for all of the recited goods or services. Only a small percentage reported that it was a frequent occurrence. Similarly, the majority reported that they occasionally were unable to clear a mark due to conflicting use-based registrations for marks that they believed were not in use for all of the recited goods or services, with a small percentage noting that it was a frequent problem.

Some respondents noted that they relied on the ability to file cancellation proceedings to address the deadwood issue, while others noted a concern about the cost or delay caused by that approach. Some respondents felt that a greater concern was the fact that Section 44 or Section 66 registrations could be obtained without showing any evidence of use. Other respondents were more concerned about use-based registrations because i) they make up a greater percentage of the registrations, and ii) the more frequent problems came with respect to registrations that were more than five years old. Others expressed concern about registrations with respect to which use of the mark was shown for one or more of the recited goods or services, but not all of them.

*2) Do you favor or oppose an amendment to shorten the first filing deadline for Affidavits or Declarations of Use or Excusable Nonuse under Sections 8 and 71 as a means of ensuring the accuracy of the trademark register? (Please explain why.)*

The survey responses indicate a divergence of opinions. The ABA IPL Section therefore believes that further study is required before proposing a legislative change to the deadline for submission of the initial Section 8 or Section 71 Declaration.

37% percent of the respondents favored a change to the initial submission deadline, while 25% unconditionally opposed any change. 24% favored a change only if the period for filing a Section 15 Declaration also was changed. Respondents had mixed reactions as to the effectiveness of such a change to address the issue of deadwood, the impact on docketing, and the likelihood of such a change leading to the inadvertent cancellation of registrations for which there was ongoing use of the mark.

While a majority of respondents agreed that moving up the deadline for filing the Section 8 or Section 71 Declaration would improve the accuracy of the register, most thought that it would

not significantly improve such accuracy. Some respondents expressed concern that the proposed change might clear out some “deadwood” but lead to more deadwood registrations during the back end of the ten year period before renewal. Concern also was expressed about the inaccuracy created by cancellation of registrations for marks still in use due to inadvertent failure to file the Section 8 or Section 71 Declaration.

*(3) If you favor shortening the deadline, what time period do you believe would be most appropriate for the first filing deadline?*

Respondents generally believed either that the deadline should remain unchanged or that it should be changed to between the third and fourth year, as suggested in the Notice of Inquiry.

*(4) Are you concerned that an amendment to the first Section 8 and 71 affidavit deadline would foreclose the ability to combine the filing with the filing of an Affidavit or Declaration of Incontestability under Section 15? What impact do you believe separating these filings would have?*

Most respondents had some concern about the fact that the proposed change would foreclose the ability to file a Section 15 Affidavit or Declaration of Incontestability with the Section 8 or Section 71 Declaration. The level of concern varied, but many respondents expressed concern about the increased costs associated with having to docket and make two separate filings.

In terms of impact, a majority of respondents believed that the proposed change would cause fewer respondents to file Section 15 Declarations.

Some respondents suggested that the Section 15 Declaration should be changed if the deadline for the submission of the Section 8 or Section 71 Declaration was changed. Other respondents made clear that shortening the time for obtaining incontestability was undesirable.

### Conclusion

The ABA IPL Section commends the Office for its efforts in seeking to address the issue of deadwood on the Register, but believes that further study is required before any proposal is made for a legislative change regarding the deadline for submission of the initial Section 8 or Section 71 Declaration. The Section also appreciates the opportunity to offer these comments.

Very truly yours,



Joseph M. Potenza  
Section Chair  
American Bar Association  
Section of Intellectual Property Law

**1. Please select one that applies**

#	Answer		Response	%
1	I am employed as in-house counsel for a corporation or other organization		16	11%
2	I work in a law firm		131	87%
3	I work in academia		2	1%
4	I am employed by the government		2	1%
	Total		151	100%

**2. What is the general size of the organization for which you work?**

#	Answer		Response	%
1	1-10 employees		45	30%
2	11-49 employees		24	16%
3	51-100 employees		23	15%
4	101-500 employees		23	15%
5	501-1,000 employees		17	11%
6	Over 1,000 employees		19	13%
	Total		151	100%

**3. Approximately how much of your individual practice is dedicated to trademark clearance, prosecution or maintenance?**

#	Answer		Response	%
1	Less than 25%		49	34%
2	Between 25% and 50%		53	37%
3	Greater than 50%		43	30%
	Total		145	100%

**4. Approximately how much of your firm's or company's practice is dedicated to trademark clearance, prosecution or maintenance?**

#	Answer		Response	%
1	Less than 25%		89	62%
2	Between 25% and 50%		39	27%
3	Greater than 50%		15	10%
	Total		143	100%

**5. Approximately how many trademark applications and registrations does your company presently own, or does your law practice presently handle?**

#	Answer		Response	%
1	1-10		14	10%
2	11-50		18	13%
3	51-100		15	11%
4	100-1000		48	34%
5	Over 1000		47	33%
	Total		142	100%

**6. Which of the following best expresses your view regarding “deadwood,” i.e., the existence of registrations on the trademark register for marks which are not in use in the U.S.?**

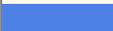
#	Answer		Response	%
1	It is a matter of no concern		3	2%
2	It is a matter of slight concern		27	19%
3	It is a matter of some concern		67	46%
4	It is a matter of significant concern		36	25%
5	It is a matter of very significant concern		12	8%
	Total		145	100%

**7. Which of the following best expresses your view regarding the experience of you and your company or firm with respect to clearing marks?**

#	Answer		Response	%
1	We frequently are unable to clear a proposed mark due to conflicting registrations filed under Section 44 or 66 of the Trademark Act for marks that we believe are not in use in the U.S. or are not in use for all of the goods or services recited in the registration.		13	10%
2	We occasionally are unable to clear a proposed mark due to conflicting registrations filed under Section 44 or 66 of the Trademark Act for marks that we believe are not in use in the U.S. or are not in use for all of the goods or services recited in the registration.		80	59%

3	We rarely are unable to clear a proposed mark due to conflicting registrations filed under Section 44 or 66 of the Trademark Act for marks that we believe are not in use in the U.S. or are not in use for all of the goods or services recited in the registration.		43	32%
	Total		136	100%

**8. Which of the following best expresses your view regarding the experience of you and your company or firm with respect to clearing marks?**

#	Answer		Response	%
1	We frequently are unable to clear a proposed mark due to a conflicting use-based registrations for marks that we believe are not in use in the U.S. or are not in use for all of the goods or services recited in the registration.		12	9%
2	We occasionally are unable to clear a proposed mark due to a conflicting use-based registrations for marks that we believe are not in use in the U.S. or are not in use for all of the goods or services recited in the registration.		92	67%
3	We rarely are unable to clear a proposed mark due to a conflicting use-based		33	24%

	registrations for marks that we believe are not in use in the U.S. or are not in use for all of the goods or services recited in the registration.			
	Total		137	100%

**9. Based on your experience, do you believe that you would be able to clear significantly more marks if registrants were required to file Affidavits or Declarations Of Use or Excusable Nonuse under Sections 8 and 71 of the Trademark Act (“Section 8 or 71 Affidavit”) earlier than between the fifth and sixth year after registration?**

#	Answer		Response	%
1	Yes		62	44%
2	No		37	26%
3	Not sure		43	30%
	Total		142	100%

**10. Based on your experience, do you believe that you would be able to clear significantly more marks if registrants were required to file a Section 8 or 71 Affidavit between the third and fourth year after registration rather than between the fifth and sixth year after registration?**

#	Answer		Response	%
1	Yes		61	43%
2	No		41	29%
3	Not sure		40	28%
	Total		142	100%

## 11. Please provide any additional comment you wish to make on the impact of “deadwood” on the U.S. register.

### Text Response

This is not as big a problem as the USPTO believes it is.

Three years for filing the declarations would also put the US in line with more countries which make registrations subject to cancellation for non-use

This is a great recommendation. Those who use their marks and are serious about protecting them should have no problem with this. Instances of those who seek registration and are confronted with "deadwood" should be reduced, and therefore less resources/cost will be spent cleaning out the deadwood through petitions to cancel.

Clearing the deadwood, where possible, is vital to the function of the US register. I support moving up the Section 8 due date.

If your company operates anywhere outside of the US, the US register is only one piece of the puzzle. And if foreign registrations that are blocking you are removed from the US register, they are likely still blocking you elsewhere internationally anyway.

I cannot say for certain what impact it may have, but I do believe that requiring Section 8 or Section 71 Affidavits earlier than the current required time would "open" up potential registration. I feel in certain situations registrants are merely sitting on marks with little intent to use them and it is too costly to seek to invalidate the mark for whatever applicable reason, e.g. abandonment.

It stands to reason that a requirement for filing the first renewal at an earlier interval would clear the registry of marks that are registered, but not actively used in commerce in the U.S. In lieu of having five to six years to make use of the marks, a three to four-year requirement would certainly weed out the "deadwood" much sooner. The change should not impact those applicants that actively use their marks, as it is simply a change to the calendar reminders to file the renewals at an earlier date. If marks are actually being used, the specimens are readily available for submission and the renewals are a simple process.

Hart to predict the impact on deadwood of moving the declaration of use forward three years, but the elimination of even a modest amount of deadwood would be helpful.

Towergate Software posted some useful data on this issue on their website (<http://towergatesoftware.com/blog/2012/09/06/making-the-case-to-amend-uspto-section-8-deadlines/>). They surveyed all trademark registrations that issued in 2005 to see how many of them were abandoned for failure to file an Affidavit between the 5th and 6th year. As expected, they did find that Section 44 and 66 registrations were more likely to be abandoned than use based registrations (64% and 63% vs. 52%, respectively). However, the data also reveals that the bulk of deadwood on the register results from use-based registrations because more than 10 times as many of them are issued each year. Among all 122,748 registrations issued in 2005, 64,643 (or 53%) of them were abandoned after the 6th year. Use-based registrations accounted for 89% of these deadwood registrations. Sections 44 and 66 registrations accounted for only 8% and 3%, respectively. Therefore, it is clear that deadwood is not merely a problem caused by Section 44 and 66 registrations. Rather, measures to reduce deadwood will only be effective if they address use-based registrations as well. Finally, if more than half of all registered marks are not in use after the 6th year, the current Affidavit requirements occur too late in the registration lifecycle to avoid the build-up of deadwood. These registrations need

to be weeded out years earlier, and the introduction of additional subsequent maintenance requirements might also be beneficial.

along with an earlier date, rules should include requirements that cause registrants to check and verify for all claimed goods/services

Actually, more of the concern is when marks have been renewed under Section 9, and can go another 10 years before another review by Post-Reg. In many cases, \*those\* are the marks that we are finding to be no longer in use, but still protected as incontestable on the Register.

Deadwood is certainly a concern, but I'm not confident that filing affidavits a year earlier would cure the problem. Typically, a mark is being used earlier in its life, and use may trail off after the 5 year mark, so you may catch non-use in the renewal stage. I think the better way to deal with the problem is to require specimens UP FRONT, BEFORE REGISTRATION for every good/service claimed, and AFTER REGISTRATION/AT RENEWAL also. If you don't have the proof, those goods/services get stricken from the app/reg.

Companies should not be able to use the registration process to circumvent the fundamental principle and requirement that marks be in use in the United States. Reducing the amount of time before the section 8 or section 71 affidavit must be filed is a step in the right direction to protecting this principle. It also will make the registry more accurate and provide better guidance to parties conducting trademark searches.

One of our clients sent the following comments regarding removing "deadwood": The notification (Supplementary Information) indicates that "recent research indicates that a significantly higher percentage of businesses fail during the first two years after their establishment than during the three years that follow." This pertains more to "new businesses" which may actually not even have the resources to file trademark applications. In our experience, companies that are more established tend to at least use their mark and maintain the registration for over three years. So the requirement of an Affidavit or Declaration of Use between the 5th and 6th year from the registration date would establish a more accurate trademark registry. We believe it is actually easier for a trademark owner to prove use between the 3-4th year from registration given that this date is closer to the registration date in which an Applicant just gathered specimens to secure the registration. As such, we do not believe that the proposed amendment would significantly reduce "deadwood."

"Deadwood" simply requires clients to either spend tens of thousands of dollars in a cancellation proceeding or wait unnecessarily until the expiration of the sixth year to determine whether a mark is usable and registrable. I do not see the downside to registrants, and the upside to subsequent applicants is significant.

For any significant conflict, the first question is whether the prior mark actually is presently in use; the registration status is relevant to that but not dispositive: abandoned marks may still be in use (e.g., canceled for problems in submitting declarations), and registered marks may not be in use (e.g., use discontinued in the first or second or 7th year after registration). No register can be up to date all the time as to all marks' status; is it worthwhile to impose updating responsibilities on all when only some come into question, and at unpredictable times?

It's not that big a deal.

In overall context, I don't think this is a major problem. For use-based registrations, a Petition to Cancel is available if the mark is abandoned.

Foreign registrants who are used to listing hosts of goods and classes they don't achieve use in commerce in can be problematic, leading to difficult registrations. A shorter filing timeline for Section 8

filings would make most sense on multi-class applications.

Good idea to move the time sooner.

Generally, proving use is not a problem for US registrants, but would be a much greater problem for foreign registrants, who are not used to working in a system based primarily on use, rather than primarily on registration.

This plan makes good sense.

The more deadwood, the more costly the search p[rocess, and yet the less meaningful and reliable the search results.

While I think every practitioner agrees that "deadwood" is a problem; there are certainly adequate mechanisms to deal with such registration, namely, cancellation actions.

I suspect that marks go out of use as a result of a business failure.

I do not think that the "deadwood" issue is a major issue. Further, I think costs/risks associated with changing the system far outweigh the benefits.

The "deadwood" problem derives predominantly from applications based upon foreign registrations. Under these circumstances, registrants are not required to prove use in their home country so the scope of goods in the registrations is far broader than the registrant is typically using the mark. Rather than changing the time for proving use, why not put an obligation that the US will accept a description of goods which (a) is supported by proof of actual use in the US; or (b) is supported by a submission of proof of use in the foreign country.

Applications based on foreign registrations are of a particular problem.

I think it is a great idea, especially in view of the fact that the register is now filing up with dubious marks that are filed by online services which came about as a result of the change in the definition of fraud in In re Bose in 2009. Many of these marks are not in use or the goods/services listed in the record and there is no way to determine that without significant expense.

Most new business or products fail between the third and fifth year. If Section 8 or 71 are required in the third year, many would be kept alive for the remainder of the 10 year period even though the marks wer discontinued in the fourth or fifth year when most business or products fail.

Investigations allow me to clear marks that otherwise might be blocked by "deadwood."

There should be a requirement to file at 3, 6, and 9 years (between 3-4; 6-7; and 9-10) and the Trademark Office should be requested to Cancel the "Deadwood" IMMEDIATELY if no filing has taken place within the Grace Period, which should be reduced to TWO months (from 6). We have had an increasing number of problems with "Dead" Registrations that have NOT yet been Cancelled by the Office. It is costing our Clients a lot of money (and that is NOT money that I feel good taking).

Our TM register should reflect the realities of our domestic marketplace as much as possible and because the market place continually fluctuates the register needs to be brought current at reasonable intervals and three years is a reasonable interval except possibly for pharmaceutical marks. If the period is shortened then the question of what constitutes excusable non-use should also be revisited. Deadwood extends the clearance process and frequently incurs unnecessary investigative expense and encourages "hold ups".

If the renewal period for U.S. registrations remains ten years, there will still be a problem with marks that become abandoned in, for example, year 7. The earlier section 8/71 affidavit addresses some "deadwood", but not all.

The "deadwood" often arises later in the life of a trademark registration than earlier in my view. Perhaps a second "affidavit" should be required?

Would be more expensive. Between 5th and 6th year is good enough.

If you shorten the time, consider adding a requirement that USPTO send a notice regarding the deadline. Although this might inspire a few to use a mark they had almost abandoned, it will also prevent many from accidentally losing rights they are enjoying.

It is a problem and unused marks need to be removed from the Register, but just not one that I experience in my limited trademark practice.

I agree it's a problem, but I'm not sure if shortening the deadline would encourage more filings to preserve (allegedly excusable) nonuse at the 3 or 4 year mark, and whether the excuses at that point would be considered more leniently than after 5 or 6 years - a longer period with fewer excuses may be better.

I think it would do more harm than good. I see more conflict with registrants whose registration have been extinguished inadvertently but are still using the marks.

An earlier Declaration date will depress filings from foreign entities

Deadwood is best dropped from the Register. However, requiring an earlier filing under Section 8/71 will adversely affect filings based on excusable non-use.

While it may be useful to clear off "deadwood" earlier than we now do, that also leaves an exposed longer window where abandonment might occur but for which there is no mechanism in place to clean that deadwood out as well. Not sure I advocate additional filings between renewals, but if they can be simplified and made low cost, that might be useful (e.g., every so many years, a simple submission confirming that the mark is in use or the like without specimens or other proof may be worthwhile and may help clear up a lot of deadwood).

I suspect the downturn in the U.S. economy in the last few years has increased the number of use-based registrations that are no longer in use...but we have to wait several years to find out.

**12. Do you believe that requiring the first Section 8 or Section 71 Affidavit to be filed earlier than between the fifth and sixth year after registration would improve the accuracy of the Trademark Register?**

#	Answer		Response	%
1	Yes, to a significant degree		50	35%
2	Yes, but not to a significant degree		74	52%
3	No		7	5%
4	Not sure		10	7%
	Total		141	100%

**13. Do you believe that requiring the first Section 8 or Section 71 Affidavit to be filed between the third and fourth year after registration rather than between the fifth and sixth year after registration would improve the accuracy of the Trademark Register?**

#	Answer		Response	%
1	Yes, to a significant degree		48	34%
2	Yes, but not to a significant degree		74	53%
3	No		11	8%
4	Not sure		7	5%
	Total		140	100%

**14. Do you believe that requiring the first Section 8 or Section 71 Affidavit to be filed in earlier than between the fifth and sixth year after registration would create problems with respect to management of trademark dockets?**

#	Answer		Response	%
1	Yes, to a significant degree		17	12%
2	Yes, but not to a significant degree		46	33%
3	No		64	46%
4	Not sure		13	9%
	Total		140	100%

**15. Do you believe that requiring the first Section 8 or Section 71 Declaration Of Use to be filed in earlier than between the fifth and sixth year after registration would increase the costs associated with maintaining trademark dockets?**

#	Answer		Response	%
1	Yes, to a significant degree		24	17%
2	Yes, but not to a significant degree		49	35%
3	No		58	42%
4	Not sure		8	6%
	Total		139	100%

**16. Do you believe that requiring the first Section 8 or Section 71 Affidavit to be filed earlier than between the fifth and sixth year after registration would lead to the inadvertent cancellation of**

**registrations that are still in use, or cancellation of registrations for marks that are in use for at least some of the goods or services cited in the registration?**

#	Answer		Response	%
1	Yes, to a significant degree		16	11%
2	Yes, but not to a significant degree		59	42%
3	No		56	40%
4	Not sure		9	6%
	Total		140	100%

**17. Are you concerned that an amendment to the first Section 8 and 71 Affidavit deadline would foreclose the ability to combine the filing of the Section 8 or 71 Affidavit with the filing of a Declaration of Incontestability under Section 15?**

#	Answer		Response	%
1	Yes, I am very concerned		29	21%
2	Yes, I am somewhat concerned		58	42%
3	No		39	28%
4	Not sure		13	9%
	Total		139	100%

**18. Do you believe that separating the deadlines to file a Section 8 or 71 Affidavit and a Section 15 Declaration of Incontestability would lead to fewer registrants filing a Section 15 Declaration?**

#	Answer		Response	%
1	Yes, I believe that significantly fewer registrants would file a Section 15 Declaration		34	24%
2	Yes, I believe that some registrants would not file a Section 15 Declaration		61	44%
3	No		22	16%
4	Not sure		22	16%
	Total		139	100%

**19. Please makes any additional statement you would like to make regarding separating the deadlines for filing a Section 8 or 71 Affidavit and a Section 15 Declaration.**

Text Response

The USPTO should not suggest this to Congress.

Overall, this would increase the cost and burden on our clients, with not much of a significant benefit in return.

This is not a significant issue for me.

separating the filing dates would cause registrants to separately consider requirements for each -- this might reduce inaccuracy in section 15 affidavits

This is sort of interesting. I think it makes sense to combine the 8 and 15, and make people show that they are using the mark for the goods/services claimed AT THE SAME TIME they file the decl of incontestability. If you separate them, I still think that before incontestability is filed, there needs to be some assurance that the goods/services claimed are still in use. Tough problem. I do think if you separate the two, people without knowledgable TM counsel will miss the incontestability filling.

No change should be made to the number of years before a mark can become incontestable. Such a change would be far worse than any benefit form shortening the section 8 or 71 filing time.

One of our clients sent the following comments regarding the additional burdens of "Incontestability" filed separately: Furthermore, the notification mentions that the Section 15 is often filed independently of the Section 8 or 71 affidavits. However, in our experience as a corporate entity, Section 8 & 15 affidavits are often, if not always, filed at the same time. As a company, filing the Section 8 & 15 at the same time does not create additional undue burden. The ability to file the combined Section 8 & 15 declaration is more manageable in time and cost, since users would have no option but to face several filing requirements, namely, trademark application, Statement of Use before registration, 3-4th year Affidavit or Declaration of Use, Section 15 Incontestability, Renewal. The proposed amendment would require an additional deadline in a registrant's docketing system and thus impose an increased burden on registrants to manage an additional deadline. Additionally, while we understand the importance of an accurate trademark registry, there is also a demand for international harmonization of trademark systems. We believe that changing the Affidavit or Declaration of Use requirement to after the third year from registration and removing the ability to file a Section 15 at the same time would further complicate the U.S. trademark system from the trademark systems of most countries and actually regress from the move towards global harmonization of trademark systems.

5-6 years is a good time for conflicts to arise and be disposed of; 3-4 years may well be too early.

I believe there will be slightly greater cost overall to the trademark applicant.

I see it as a cost issue. At present, with a single filing, one need only handle the file for one filing. The proposed early 8/71 filing would add significantly to the cost of maintaining the registration for its initial term.

Seems like a good way for outside counsel to hit me with twice as many fees

Even if the change were to be cost-neutral from an official fee perspective, many registrants would still face higher costs from use of outside counsel. Having said that, shortening the date a registration is eligible for a Section 15 Declaration would be inappropriate - a mark shouldn't be incontestable after

just three years.

The shortened Section 8 deadline and the remaining Section 15 deadline means that dockets will track more dates and registrants face more frequent deadlines for maintenance of the registration. Keeping these filings together would make sense.

I think Section 15 should be changed to conform to any change to Section 8 and 71, as an efficiency step.

none

Three years seems too early for incontestability, but letting it go until the first 10-year renewal seems too long. Leaving the incontestability filing at 5 years while moving the Section 8 or 71 filing forward to 3 years actually enables the attorney to communicate with his client more frequently regarding trademark maintenance, which is a good thing. However, fees should be adjusted to avoid duplication or escalation of costs to trademark owners for the same benefits.

Separating these deadlines could mean increased costs for clients, more opportunities for missed deadlines, and a lot more work for trademark docketing clerks.

I strongly oppose separating the deadlines for the Section 8 or 71 Affidavit and the Section 15 declaration

It should be remembered that there is a duty on the part of the trademark owner (not just the attorneys) and if this is communicated to clients perhaps they would be more vigilant in watching deadlines.

From a docketing standpoint I believe that the earlier date for filing a Section 8 or 71 would be for newly registered marks and not effect those that were registered prior to the effective date of the changes.

There are too many Registrations on the Register for Trademarks that are NOT in use. Whatever can be done to remedy that problem would be a welcome change. This is NOT a full employment act for attorneys.

Doing a 15 with an 8 and 71 probably saves the client some essentially clerical fees. Separating the 15 would result in fewer incontestable registrations. However, the benefits of S.15 have been vastly reduced. If they were strengthened and the timing be made such that the 15 was filed after the first use affidavit, I think you would lend weight to 15 and have more serious use made of it.

It seems to me that 5-6 years is about right because by then many tenuous companies would have failed. I believe 3-4 years may be too early to weed out unused marks.

This staggered filling actually makes more sense. Over past 10-15 years there has been a dramatic increase of filings from mom & pops that collapse within 3-5 years and make only taken use from the start.

This proposal will be viewed by the public as a trademark practitioners' employment act - increasing costs and fees for no benefit to the company.

I believe that the deadlines for Section 8 or 71 Affidavits should be the same as the deadline for filing a Section 15 Declaration.

The costs to trademark owners will be increased. Moreover, trademark owners are likely to blame these increased costs on lobbying by trademark lawyers and trademark law firms who are seeking to increase their revenues.

Incontestability has to be earned, but I don't have a feel for whether three years is enough time to allow the market to discover conflicts. Five is arbitrary, too, so maybe three is enough. Four has more heft to

it.

This would probably be an inconvenience for many small clients (like most of mine) because it would mean more paperwork, and more attorney time, and the cost associated therewith. The actual docketing and notifying is less of an issue than the cost to clients.

To avoid the syndrome of registrants deciding they might as well file a s. 15 at the same time, separating the deadlines seems a good idea.

such action will depress foreign filings

Separating the deadlines would disadvantage smaller entities.

## 20. Do you favor or oppose an amendment to change the first filing deadline for Section 8 or 71 Affidavits to between the third and fourth year after registration rather than between the fifth and sixth year after registration as a means of ensuring the accuracy of the Trademark Register?

#	Answer	Response	%
1	Favor, because the benefits outweigh the costs	52	37%
2	Oppose, because the costs outweigh the benefits	35	25%
3	Favor, but only if the deadline to file the Section 15 Declaration also is changed to match the deadline to file the Section 8 or 71 Affidavit	34	24%
4	Not sure	18	13%
	Total	139	100%

**21. Please provide any additional comment you wish to make regarding changing the first filing deadline for Section 8 or 71 Affidavits to between the third and fourth year after registration rather than between the fifth and sixth year after registration.**

Text Response

The change in filing time periods "may" potentially clear out deadwood registrations from the front end of the 10 year registration period, but extend the ongoing presence of deadwood registrations at the back end of the 10 year registration period.

The change needs to be applied across the board not phased in or docketing will be a nightmare

I highly recommend looking into the data posted by Towergate Software analyzing the rate of registrations that are abandoned after the 6th year.

(<http://towergatesoftware.com/blog/2012/09/06/making-the-case-to-amend-uspto-section-8-deadlines/>)

Keep the fees the same.

I don't think changing the date is the answer, really. The dates can be kept. It's the proof -- at whatever date -- of use of the the mark for the claimed goods and services--all of them--that's key.

I am in favor of changing this deadline, but I do not see it as a significant issue. I do think the impact will primarily be felt by foreign trademark registrants who want to extend their products to the U.S., but will now have less time to do so with a registration unsupported by use. However, this is an advantage over U.S. applicants to begin with and so does not bother me much.

We have a client that opposes shortening of the Affidavit or Declaration of Use requirement since we do not believe changing the Affidavit or Declaration of Use requirement to the 3rd or 4th year from registration would significantly eliminate "deadwood" and additionally, such change would increase burden and cost of Registrants that are already facing budget constraints.

3-4 years is too early. 5-6 years is a better interval because more TMs will fall out of use and therefore be removed from the register. Also, requiring another filing after only 3-4 years will generate ill will by some clients towards trademark lawyers and the USPTO.

The legislation, if it passes, should be phased in so that marks only face the new deadline structure after their next upcoming regular Section 8 filing date. This would create a smoother transition with clients and counsel as they transition their dockets to the new timelines.

none

No additional comment.

I am very concerned that the proposal is being made with out adequate study as to the ultimate impact of this change or the need for it.

Great idea but the Section 15 filing should NOT change - incontestability should not be taken lightly.

There is already a significant issue with clients believing they have a ten year term, yet having to file the affidavit and pay more money at the fifth year.

The severity (if any) of such change could be lessened by adopting a slightly more flexible standard of excusable non-use.

none

It may be more inconvenient for some TM registrants and lawyers, but if it works on getting deadwood out sooner (I'm not sure if it would) then that would be good.

I think this will help with the "deadwood" problem.

Statistic	Value
Total Responses	18

**22. Please provide any additional comment you wish to make regarding addressing the problem of “deadwood” by a means other than changing the first filing deadline for Section 8 or 71 Affidavits.**

Text Response	
Charge more for filing long Identifications of goods and services than shorter ones	
The USPTO should also have the authority to request additional specimens where there is a long list of goods or where the goods, within the same International Class, are very different (such as glasses, microscopes, computer hardware, and computer software - all in IC 9)	
I believe that in Europe (and possibly Canada as well) there is a quick procedure through which a third-party can request that a registrant present evidence of continued use on particular goods. This would be a quicker, cheaper, and more practical mechanism for weeding out deadwood registrations than filing a full-blown cancellation with the TTAB when non-use is suspected.	
a penalty or other undesirable consequence for partially inaccurate affidavits could cause some registrants to more carefully check and verify use and specimens for all claimed goods and services before submitting affidavits	
See earlier comment re Section 9 affidavits.	
How about requiring filing a notice of abandonment of a mark when its use is discontinued without intent to resume, with a penalty for failure to report and ultimate abandonment of the registration?	
One way to fight deadwood is to require a specimen for ALL goods in an application, but that would frankly be a royal pain in the neck for clients and counsel. I would not favor that option.	
none	
There should be a new rule or statute clearly addressing when a Sec 44 or 66 application registered in the US becomes vulnerable to cancellation for non-use. I would favor making that three years from registration.	
Anything that helps clean up the register is generally a good idea.	
Interesting concept with merit. Costs associated with increased maintenance, vigilance and deadlines seem to outweigh benefits. Five/ six year time frame seems like the most reasonable options given the ebbs, flows and cycles of business.	
Consider changing the specimen filing requirements to require more than 1 service/good per class.	
Perhaps allow a challenge of non-use and abandonment before the TTAB, which challenge may first be filed with the TTAB on the day after the third year following the registration issuance date. A finding of non-use and abandonment by the TTAB would result in the TTAB issuing a cancellation of the registration.	
none	

Statistic	Value
Total Responses	14

**23. If you favor shortening the current deadline to file the Section 8 or 71 Affidavit and would select a period other than between the third and fourth year after registration, please state what time period you would propose and why.**

Text Response	
I oppose shortening the deadline	
There should be a 6-month grace period after the 4th year.	
Between 3rd and 4th year seems reasonable as a default merely because it conforms to the statute's presumption of abandonment after three years of non-use. However, I would be willing to support an early or later time period so long as it is supported by persuasive empirical evidence.	
Keep the same time periods to cut the confusion; require specimens for each good and service claimed: before registration; between year 5 and 6; between year 9 and 10, and at every subsequent renewal. THAT will cull the deadwood on the register.	
No, 3-4 years would be good.	
none	
Third year is fine.	
I think 2-3 would be better. The PTO did a study on the timing of new businesses going under and I think that is how they came up with 3-4 years for the proposed renewal. However, I do not think they took into account the time it takes to register a mark. In a 1a situation 2-3 would work, if it was a 1b registration then 3-4 is appropriate.	
between 3-4; 6-7; and 9-10 for Sections 8. The Section 15 could be at the 6-7 and the Section 9 could be at the 9-10.	
No. That really is a good proposal, workable.	
No.	
So long as the time period is different than for s. 15, not sure what time frame would best balance the desire to get rid of deadwood without creating extra pro forma filings.	
na	
There is the obvious compromise of between the fourth and fifth year. That might help match up the Section 8/71 filing with the Section 15 filing.	

Statistic	Value
Total Responses	14