



October 6, 2023

The Honorable Kathi Vidal
Under Secretary of Commerce for Intellectual Property
and Director, U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Submitted via: https://www.regulations.gov (Docket Number PTO-T-2023-0028)

Re: Comments Regarding USPTO Proposed Changes to Duration of Attorney Recognition

Dear Director Vidal:

Intellectual Property Owners Association (IPO) appreciates the opportunity to provide comments in response to the USPTO's request on "Changes to Duration of Attorney Recognition; Notice of Public Listening Session and Request for Comments" at 88 Fed. Reg. 54305 (Aug. 10, 2023).

IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers, and individuals in all industries and fields of technology that own, or are interested in, intellectual property (IP) rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; supporting and advocating for diversity, equity, and inclusion in IP and innovation; and disseminating information to the public on the importance of IP rights.

IPO's vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. The Board of Directors has adopted a strategic objective to foster diverse engagement in the innovation ecosystem and to integrate diversity, equity, and inclusion in all its work to complement IPO's mission of promoting high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

In response to the May 2021 notice of proposed rulemaking to implement provisions of the Trademark Modernization Act, IPO supported the USPTO's effort to clarify the rules related to attorney recognition. Clear attorney recognition rules should help improve secure access to USPTO databases and records and may also assist with tracking and combatting misleading solicitations sent to applicants and registrants. In those comments, IPO also expressed interest in retaining docketing information in application and registration records should attorney recognition rules change.

As a preliminary matter, the USPTO's current regulations concerning the end of USPTO attorney recognition are inconsistent with practices of trademark owners and trademark practitioners concerning the end of attorney representation. The request for comments states:

For several years, some outside practitioners have expressed concern that the current recognition rule, when read in conjunction with the correspondence rule, is

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problematic for practitioners whose recognition before the Office ends even though their representation of the applicant or registrant continues based on engagement agreements.

88 Fed. Reg. at 54306. In these instances, practitioners believe that they may miss response deadlines if they no longer receive USPTO correspondence regarding their clients' matters.

Further, current regulations concerning the end of attorney recognition may be problematic for some trademark owners and their counsel. As a result, the USPTO sends courtesy correspondence to attorneys of record:

[P]ast customer feedback indicated that, in most cases, even after the occurrence of an event listed in the current §2.17(g) [concerning the end of attorney recognition by USPTO], representation continued, and the attorney should be the only recipient of the trademark registration certificate, maintenance and renewal reminders, and any other correspondence. For this reason, the USPTO currently sends, as a courtesy, correspondence to the attorney of record.

Id.

Stakeholder information about events that typically end attorney representation would be helpful to the USPTO so that changes to the applicable regulations reflect the existing practices of trademark owners and their counsel. Although the USPTO has not requested this information, IPO's comments provide some information in this regard.

With respect to the questions raised by the USPTO, IPO submits the following comments:

1. Do you think the current rule should remain unchanged, or are you in favor of the revisions under consideration?

As noted in IPO's 2021 comments, IPO supports the attorney recognition changes proposed by the USPTO. That is, for purposes of an application or registration, recognition of a qualified attorney should continue until the owner revokes the appointment or the attorney withdraws from representation. This change would be less disruptive to IPO members than the proposed alternative—no amendment to § 2.17(g) and no courtesy copies provided to outside counsel.

Existing regulations regarding the commencement of attorney recognition for applications and registrations appear consistent with the practices of IPO members regarding attorney representation.

In addition, consistent with the current regulations, attorney representation for a particular trademark application or registration often ends with a change in ownership. The USPTO's proposed amendment to attorney recognition rules will require the affirmative filing of either revocation of attorney or withdrawal from representation forms, which means the preparation and filing of additional paperwork by IPO members.

2. Do you have suggestions for handling the transition period during which attorney information is removed from the record whether the current rule is retained or revised?

As mentioned in IPO's 2021 comments, we do not support removing docketing information from the USPTO's database. Retaining docketing information is important for applicants, registrants, and attorneys to efficiently track and manage USPTO communications, filings, and fee payments. The task of re-entering docket information for each application and registration would be time-consuming, especially for attorneys handling larger trademark portfolios for multiple parties. Retaining docketing information in the database will allow attorneys, applicants, and registrants to continue efficiently managing trademark applications and registrations during the period of transition to new attorney recognition procedures and will help facilitate the process of re-recognition for attorneys whose clients wish that they be re-recognized.

Removal of attorney information from the record when the attorney continues to represent the trademark owner could have adverse impacts on the trademark owner. For example, a potentially adverse party might be unable to identify or contact the trademark owner's counsel in case of a dispute. Therefore, before attorney information is removed from the record, IPO requests adequate notice to trademark owners and counsel of the potential removal of counsel information and an opportunity to file a power of attorney prior to the removal date, particularly in the case of (a) issued registrations where no post-registration maintenance filings have been submitted and (b) pending applications and registrations where a change in ownership has been recorded.


3. **Do you have any suggestions for making withdrawal or re-recognition easier if the rule is revised to continue recognition?**

As noted above, consistent with current USPTO attorney recognition regulations, attorney representation often ends when there is a change in ownership of a trademark application or registration. IPO suggests that, at the time of recordation of a change of ownership, the new applicant or registrant be given an opportunity to revoke the prior representation and/or appoint a new attorney. If the new applicant or registrant does not appoint an attorney at the time of recordation, IPO suggests that the USPTO provide a courtesy notice to the new applicant or registrant and existing attorney of record advising that, unless a withdrawal or new power of attorney form is filed, attorney recognition will continue.

Conclusion

Thank you for considering these comments. We welcome further dialogue with the USPTO on this issue.

Best regards,



Karen Cochran
President