



AIPPI • JAPAN

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International Association for the Protection of Intellectual Property of Japan

September 12, 2011

The Honorable Commissioner for Trademarks
U.S. Patent and Trademark Office
United State Department of Commerce
P.O.Box 1451
Alexandria, VA 22313-1451, USA
Attention: Ms. Cynthia C. Lynch
E-mail: TMFRNotices@uspto.gov

Re: Comments on the proposed "Changes in Requirements for Specimens and for Affidavits or Declarations of Continued Use or Excusable Non-use in Trademark Cases"

Dear Ms. Commissioner:

The Japanese Group of AIPPI (AIPPI Japan) appreciates the opportunity to offer comments in response to the Notice of the U.S. Patent and Trademark Office (PTO) regarding the "Changes in Requirements for Specimens and for Affidavits or Declarations of Continued Use or Excusable Non-use in Trademark Cases".

AIPPI Japan is the local group in Japan of AIPPI, The International Association for the Protection of Intellectual Property, which has more than 8,000 members worldwide. The Japanese group was founded in 1956 and currently has about 1,100 members (approximately 900 individuals and 200 corporate members). It is the largest national/regional group of AIPPI. Its members include patent attorneys, lawyers and other patent practitioners in private and corporate practice, and in the academic community. AIPPI Japan represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

AIPPI Japan as a user organization deeply appreciates every effort made by the PTO to improve the US trademark system.

Proposed changes in requirements for Specimens and for Affidavits or Declarations

Under the current Trademark Rule, one specimen of use for the mark per class

is enough to register the trademark and keep the trademark registration alive. However, according to the proposed change of Trademark Rule, the PTO may require additional specimens of use per class.

AIPPI Japan has formed a special committee and studied the proposed changes, and the committee wishes to submit for consideration the following comments.

Concerns

With respect to Intent to Use Application, under the current Trademark Rule, it is necessary to submit one specimen of use per class: (1) on allowance of registration; (2) 5 to 6 years from the registration date; and (3) 10 years from the registration date. This is a good system for reducing the number of non-used registered trademarks from the trademark register. However, the burden on trademark owners under such a system is great.

Proposed changes permit the PTO to require additional specimens of use per class. This change will create additional burdens to trademark owners if the examiners' discretion is broad.

Thus, AIPPI Japan requests a provision in the Trademark Rules or TMEP that the PTO can require additional specimens of use on special occasions, e.g., where identification includes a large number of, or significant disparity in, goods/services.

Furthermore, AIPPI Japan requests a provision in the Trademark Rules or TMEP that standard for requirement of additional specimens of use for house marks should be relaxed as compared with the product marks because house marks will be used for a large number of goods or services.

Very truly, yours,

for 
Yoshio Kumakura
President
The Japanese Group of AIPPI