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DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO-T-2023-0028]

Changes to Duration of Attorney Recognition; Notice of Public Listening Session and Request for Comments

AGENCY: United States Patent and Trademark Office, U.S. Department of Commerce.

ACTION: Notice of public listening session; request for comments.

SUMMARY: The United States Patent and Trademark Office (USPTO or Office) seeks public comments on changes to the trademark rule regarding the duration of attorney recognition. In addition, the USPTO is announcing a public listening session on September 26, 2023, titled "Changes to Duration of Attorney Recognition," to offer further opportunity for the public to provide input on this topic.

DATES: The public listening session will take place on September 26, 2023, from 2-3:30 p.m. ET. Anyone wishing to present oral testimony at the hearing, either in person or virtually, must submit a written request for an opportunity to do so no later than September 15, 2023. Persons seeking to attend, either in person or virtually, but not to speak at the event must register by September 18, 2023. Seating is limited for in-person attendance. The USPTO will accept written comments until October 6, 2023.

ADDRESSES:

Public Listening Session

The public listening session will take place in person in the Clara Barton Auditorium at the USPTO, 600 Dulany Street, Alexandria, VA 22314. The session will also be available via live feed for those wishing to attend remotely. Registration is required for both in-person and virtual attendance. Information on registration is available on the USPTO's

website at www.uspto.gov/about-us/events/trademark-public-listening-session-changes-duration-attorney-recognition.

Request for Comments

For reasons of Government efficiency, commenters must submit their comments through the Federal eRulemaking Portal at www.regulations.gov. To submit comments via the portal, enter docket number PTO-T-2023-0028 on the homepage and click "search." The site will provide a search results page listing all documents associated with this docket. Find a reference to this request for comments and click on the "Comment" icon, complete the required fields, and enter or attach your comments. Attachments to electronic comments will be accepted in ADOBE® portable document format (PDF) or MICROSOFT WORD® format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

Visit the Federal eRulemaking Portal for additional instructions on providing comments via the portal. If electronic submission of comments is not feasible due to a lack of access to a computer and/or the internet, please contact the USPTO using the contact information below for special instructions regarding how to submit comments by mail or by hand delivery.

FOR FURTHER INFORMATION CONTACT: Catherine Cain, Office of the Deputy Commissioner for Trademark Examination Policy, at 571-272-8946 or TMPolicy@uspto.gov.

SUPPLEMENTARY INFORMATION:

I. Background

Under the Trademark Rules of Practice, the USPTO will recognize an attorney qualified under 37 CFR 11.14 as an applicant's or registrant's representative if that attorney files a power of attorney, signs a document on behalf of an applicant or registrant who is not already represented, or is otherwise identified in a document submitted on behalf of an applicant or registrant who is not already represented. 37 CFR 2.17(b). Once an attorney is recognized, the USPTO will correspond only with that attorney until recognition ends. 37 CFR 2.18(a)(2). Recognition as to a pending application ends when the mark registers, when ownership changes, or when the application is abandoned. 37 CFR 2.17(g)(1). Recognition as to a registration ends when the registration is canceled or expired, when ownership changes, or upon acceptance or final rejection of a post registration maintenance filing. 37 CFR 2.17(g)(2). The USPTO does not inquire into any engagement agreement between the attorney and the applicant or registrant to determine whether representation continues after the events that trigger the end of recognition under § 2.17(g). Therefore, following such an event, the trademark rules dictate that the USPTO correspond only with the applicant or registrant. 37 CFR 2.18(a). However, past customer feedback indicated that, in most cases, even after the occurrence of an event listed in the current § 2.17(g), 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, except in connection with petitions to cancel filed with the Trademark Trial and Appeal Board, which are served on the registrant.

For several years, some outside practitioners have expressed concern that the current recognition rule, when read in conjunction with the correspondence rule, is problematic for practitioners whose recognition before the Office ends even though their representation of the applicant or registrant continues based on engagement agreements. These practitioners are concerned about missing response deadlines when representation

continues, if they are removed from the record when recognition ends and will no longer receive correspondence from the USPTO regarding their clients' matters following abandonment or registration. Many of these practitioners have instructed their clients to disregard anything sent directly to them about their trademark application or registration to avoid having the clients subjected to a misleading solicitation, which is a growing problem for the USPTO and its customers. If their clients disregard all communications, including USPTO correspondence sent to them pursuant to § 2.18(a), and the practitioner is no longer receiving correspondence from the USPTO, deadlines for taking action would likely be missed. This group would like the USPTO to presume that representation, and therefore recognition, continues until the attorney withdraws or is revoked so that they, and not their clients, will continue to receive correspondence from the USPTO.

Other practitioners have expressed that they did not have any concerns with the current recognition rule because they do not wish to be subject to continuing legal and ethical obligations to the client after a listed event occurs. The current rule works to their advantage because they have no obligation to file a withdrawal form with the USPTO if recognition ends automatically. However, these practitioners have expressed concern as to whether there is an ethical obligation to contact their former clients about correspondence sent to them as a courtesy by the USPTO. As noted above, the USPTO continues to list all practitioners as the attorney of record and to send correspondence to them, even after recognition ended under the rule, because of the concerns over missed response deadlines.

In response to practitioner requests, the USPTO sends the courtesy email reminder that goes out in advance of the due date for a post registration maintenance document to both the owner and the last attorney of record (who is no longer recognized under the current

rule and should not receive correspondence). The USPTO implemented this courtesy practice by sending the email reminders to both the applicant/registrant and the attorney as well as the notice of registration, the notice of abandonment, and the notice that an expungement or reexamination petition had been filed against the registration.

However, the practice has caused confusion among practitioners and has created some uncertainty for the USPTO in implementing its regulations. Sending email reminders and notices to attorneys who are no longer recognized under § 2.17(g) constitutes an unofficial waiver of § 2.18(a), which governs the parties with whom the USPTO will correspond in trademark matters. Moreover, despite the obligation under § 2.18(c) to maintain current and accurate correspondence addresses, the USPTO cannot be certain that the correspondence information in its records is still accurate, particularly regarding post registration reminders and notices that are sent 5-10 years or more after registration.

II. Trademark Modernization Act Notice of Proposed Rulemaking

In a notice of proposed rulemaking (NPRM) to implement provisions of the Trademark Modernization Act (TMA), published in the **Federal Register** on May 18, 2021, the USPTO proposed to revise 37 CFR 2.17(g) (86 FR 26862). The suggested revisions indicated that, for purposes of an application or registration, recognition of a qualified attorney as the applicant's or registrant's representative would continue until the owner revoked the appointment or the attorney withdrew from representation, even when there was a change of ownership. Therefore, owners and/or attorneys would be required to proactively file an appropriate revocation or withdrawal document under 37 CFR 2.19 before a new attorney could be recognized. The amendment was proposed to address the issues discussed above.

As noted in the final rule published on November 17, 2021, the USPTO received mixed comments regarding the proposed revisions to § 2.17(g) (86 FR 64300). While several

commenters were generally in favor of ongoing attorney recognition, others preferred the current practice, citing burdens associated with the new rules.

The USPTO also proposed to remove the name of any attorney whose recognition had ended under existing § 2.17(g) from the current attorney-of-record field in the USPTO's database, along with the attorney's bar information and any docketing information. However, the attorney's correspondence information, including any correspondence email address, would be retained so the USPTO could continue to send relevant correspondence and notices to both the formerly recognized attorney and the owner. Most commenters were opposed to removing the attorney information during the transition period, stating that this would cause unnecessary burdens to reappear in records.

Based on the public comments to the TMA NPRM, the USPTO determined that additional time was needed to address the concerns expressed. Therefore, the changes proposed in the TMA NPRM were not included in the TMA final rule. The USPTO now seeks additional input on whether § 2.17(g): (1) should be amended as discussed below, or (2) should not be amended, and all attorney information be removed when recognition ends following a listed event in § 2.17(g).

III. Changes to Duration of Recognition for Representation

The USPTO now seeks additional feedback regarding possible changes to the provisions addressing the duration of recognition for representation in § 2.17(g). The changes under consideration would allow recognition as to a pending application or registration to continue until the applicant, registrant, or party to a proceeding revokes the power of attorney or the representative withdraws from representation.

As noted above, such a rule change would require an attorney who no longer represents an applicant to affirmatively withdraw or be revoked for recognition to end. Shifting the

burden to the attorney to withdraw, or to the owner to file a revocation, would give the USPTO greater assurance that it is communicating with the correct party. If stakeholders support the rule change, there are at least two challenges to address:

(1) How to make withdrawal easier

(2) How to implement the transition in the USPTO database

Although withdrawal is relatively easy, it is worth exploring whether the USPTO can make it even easier. In addition, the USPTO must ensure that if an attorney is deceased, it can efficiently remove that practitioner from its records. Moreover, the process must be consistent with the Rules of Professional Conduct, which dictate the terms of withdrawal.

The other area of concern is the transition of the USPTO's electronic records from recognition for a set duration to continued recognition following any rule change. Two categories of attorneys would be immediately affected by any rule change: (1) attorneys who are recognized at the time the rule goes into effect, and (2) attorneys whose information remains in the record but who are not currently recognized by virtue of the previous recognition rule. The revisions under consideration would have limited effect on the first set of attorneys because their existing recognition would continue. There would be some impact on attorneys whose representation does not continue past a certain event or date and who no longer wish to be recognized by the Office as the attorney of record because they would have to proactively withdraw to avoid any ambiguity.

The attorneys in the second group for whom recognition has ended under the current rule, even though their information remains of record, cannot be retroactively recognized by implementation of the revisions under consideration even if they prefer recognition to continue. *See Bowen v. Georgetown Univ. Hosp.*, 488 U.S. 204, 208, 109 S. Ct. 468, 471-472, 102 L. Ed. 2d 493, 500 (1988). On the date the USPTO recognized these attorneys, the current rule was in effect, and they had no notice that recognition would continue

beyond the events listed in § 2.17(g). To avoid this retroactive effect, the USPTO proposed in the TMA NPRM that all attorney information would be removed from the database if a recognition-ending event had already occurred. To be recognized again, these attorneys would need to: (1) reappear by filing a document, and (2) reenter bar and docket information. Some public comments filed in response to this proposal demonstrated a concern with this approach because of the burden this would place on trademark owners and attorneys. However, removal of attorney information comports with the current recognition rule and the attorneys subject to it.

The USPTO is now considering deleting all attorney information, after a listed event, from the records of all applications filed or registrations issued prior to the date of implementation of a change to § 2.17(g) stating that recognition continues until there is a revocation or withdrawal of the recognized attorney of record. The USPTO has considered requests that attorneys be given the opportunity to opt in to remaining of record in such situations. However, the USPTO has neither the staff nor the technological resources to implement an opt-in alternative as to the affected applications and registrations. In addition, such a provision would not reconcile inaccuracies in older records.

IV. Retaining the Current Provisions on Recognition for Representation

If the USPTO does not amend § 2.17(g) to allow continued recognition until there is a revocation or withdrawal of the recognized attorney of record, the USPTO would not continue the courtesy practice of sending notices or reminders to the listed attorney in addition to the applicant or registrant. Pursuant to the plain language of § 2.17(g) that recognition ends when a listed event occurs, all attorney information would be removed when such an event occurs or if it has already occurred. Thus, correspondence and relevant notices would no longer be sent to both the formerly recognized attorney and the

owner. Following § 2.18(a), correspondence and notices would be sent to the applicant or registrant or to a newly recognized attorney. This option would also require a transition period during which attorney information would be removed for attorneys whose information remains in the record but who are not currently recognized by virtue of the rule.

V. Listening Session and Questions for Comments

The USPTO is holding a listening session on September 26, 2023, and is requesting public comments on the questions listed below. The USPTO will use a portion of the listening session to provide an overview of the changes under consideration. An agenda will be available approximately five days before the listening session on the USPTO website at www.uspto.gov/about-us/events/trademark-public-listening-session-changes-duration-attorney-recognition, which is the same link for registration.

The USPTO poses the following questions for public comment. These questions are not meant to be exhaustive. We encourage interested stakeholders to address these and/or other related issues and to submit research and data that inform and support their comments on these topics. Commenters are welcome to respond to any or all of the questions, and are encouraged to indicate which questions their comments address.

1. Do you think the current rule should remain unchanged, or are you in favor of the revisions under consideration?
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?
3. Do you have any suggestions for making withdrawal or re-recognition easier if the rule is revised to continue recognition?

Anyone wishing to participate as a speaker, either in person or virtually, must submit a request in writing no later than September 15, 2023. Requests to participate as a speaker must be submitted to TMPolicy@uspto.gov and must include:

1. The name of the person desiring to participate;
2. The organization(s) that person represents, if any; and
3. The person's contact information (address, telephone number, and email).

Speaking slots are limited; the USPTO will give preference to speakers wishing to address one of the questions raised in this request for comments. Speakers will be announced a few days prior to the public listening session. The USPTO will inform each speaker in advance of their assigned time slot. If the USPTO receives more requests to speak than time allows and is unable to assign a time slot as requested, the agency will invite the requestor to submit written comments. Time slots will be at least three minutes and may be longer, depending on the number of speakers registered. A panel of USPTO personnel may reserve time to ask questions of particular speakers after the delivery of a speaker's remarks.

The public listening session will be physically accessible to people with disabilities. Individuals requiring accommodation, such as sign language interpretation or other ancillary aids, should communicate their needs to the individuals listed under the **FOR FURTHER INFORMATION CONTACT** section of this notice at least seven business days prior to the session.

Katherine K. Vidal,
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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