

Hearing on “Counterfeits and Cluttering: Emerging Threats to the Integrity of the Trademark System and the Impact on American Consumers and Businesses”

Questions for the Record Rep. Henry C. “Hank” Johnson, Jr., Chairman

Mary Boney Denison, Commissioner for Trademarks, U.S. Patent and Trademark Office:

1. Under existing law, what can the USPTO do, if anything, to address an alleged fake specimen of use found in a trademark file after a registration has issued?
2. What is the timeline for implementation of the electronic specimens database? Does the USPTO have adequate financial resources to facilitate implementation?
3. Your written statement refers to incentivizing accuracy in use statements in registrations by charging a “zero fee” for deletions of goods or services for which the mark is not in use. How will the USPTO implement this practice?
4. How does the USPTO balance the competing interests of optimizing pendency and quality of review in examining trademark applications?
5. How is the First Action Pendency performance goal for trademark applications set? Does the USPTO have the authority to alter that performance goal?

Jeanne Fromer, Professor of Law, New York University School of Law:

1. Are you able to estimate how many trademark applications have been filed with fake or likely fake specimens?
2. Are there particular classes of goods or services for which applications containing fake or likely fake specimens appear to be more prevalent?
3. Would the trademark registration system benefit from additional processes to address fake specimens in files for which a trademark registration has already issued?

Peter M. Brody, Partner, Ropes & Gray LLP:

1. Your testimony largely focuses on the benefit of an irreparable harm presumption in cases where likelihood of confusion has been found (or deemed likely), but it also notes that the irreparable harm presumption should apply in Lanham Act cases where the standard is not likelihood of confusion, such as in dilution cases. Why should the presumption also apply in these cases?
2. Have plaintiffs had difficulty proving irreparable harm in courts where the presumption is no longer followed?

Robert Barchiesi, President, International AntiCounterfeiting Coalition:

1. How can e-commerce platforms best keep pace with counterfeiters' changing tactics? Are there enforcement measures that e-commerce platforms can adopt that do not run the risk of being outdated or of being outmaneuvered?
2. Are there any barriers or limitations that prevent e-commerce platforms from adopting technology-based mechanisms that address concerns regarding proper vetting and repeat offenders? What framework would best address those barriers and limitations, if so?

Rebecca Mond, Vice President, Federal Government Affairs, The Toy Association:

1. As you note in your testimony, manufacturers of children's toys must follow stringent safety regulations and undergo testing before appearing on the shelves in brick-and-mortar stores, while counterfeiters using e-commerce platforms get to play by a different set of rules. In what ways could e-commerce platforms best address this loophole, and how should Congress assist in those efforts?

Joseph Cammisso, President, Automotive Anti-Counterfeiting Council, Inc., Mr. Barchiesi, and Ms. Mond:

1. Under the current system, rights owners typically bear the burden of policing individual marketplaces for counterfeits and submitting takedown complaints, which rights holders consider resource-intensive and ineffective at scale. What incentives could Congress provide to meaningfully change this system to one where e-commerce platforms play a larger role in proactively addressing the proliferation of counterfeit goods?
2. Are there changes to the statutory standard for liability in counterfeiting cases that Congress should consider to effectively address the proliferation of counterfeit goods?
3. What specific measures should e-commerce platforms use to better vet sellers and products? Is there a role Congress can play in assisting or incentivizing these efforts?
4. What is a rights holder's recourse when a third-party counterfeit seller cannot be accurately identified, located, or served with a complaint? Who, if anyone, should be liable in these instances?