

May 5, 2005

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
P.O. Box 1451
Alexandria, Virginia 22313-1451

Attn: Cheryl L. Black

Comments on Notice of Proposed Rule Making: "Requirements to Receive a Reduced Fee for Filing an Application through the Trademark Electronic Application System" 70 Federal Register 17636 (April 7, 2005)

Dear Mr. Under Secretary:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments regarding the proposed rules directed to the circumstances under which applicants may pay a reduced fee for filing trademark or service mark applications through the Trademark Electronic Application System (TEAS), as published at 70 Fed. Reg. 17636 (April 7, 2005).

AIPLA is a national bar association whose more than 16,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA 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. Our members represent both owners and users of intellectual property.

The United States Patent and Trademark Office (USPTO) has proposed rule changes to permit an applicant to pay a reduced fee, under certain circumstances, for filing applications through the TEAS. The changes are proposed in accordance with requirements of the Consolidated Appropriations Act, 2005, Public Law 108-447, enacted on December 8, 2004.

We commend the USPTO for continuing to enhance its electronic systems to better serve trademark owners and their representatives and for this initiative to pass along to applicants some of the cost savings generated by electronic filing and processing of applications. Our comments below are intended as constructive contributions to this initiative. These comments seek clarification of how the proposed rules would be applied in specific situations. They also seek to draw attention to areas in which modifications to the proposed rules will enable and encourage greater participation in the proposed electronic filing program.

As we understand the proposed rules, an applicant meeting all of the specified requirements would pay a reduced fee of \$275 instead of the usual \$325 fee for filing an electronic application through the TEAS. Applications to which the reduced fee would apply would be referred to as “TEAS Plus” applications. With this understanding, we offer the following specific comments on a rule-by-rule basis:

Rule 2.22: Rule 2.22 lists the specific categories of information that an applicant must provide at the time of filing to qualify for a reduced filing fee under TEAS Plus. To reduce the risk that an applicant would unwittingly omit required information, AIPLA proposes that the TEAS electronically flag missing information at the time of filing (before a filer reaches the payment screen), and that the applicant be given the opportunity to return to the application form to enter the additional information needed to qualify for a reduced filing fee under Rule 2.6(iii) or, if the filer chooses, to proceed without qualifying for a reduced filing fee under Rule 2.6(ii).

Rule 2.22(a)(8): Rule 2.22(a)(8) requires TEAS Plus applicants to correctly classify goods and/or services from the Office’s *Acceptable Identification of Goods and Services Manual*. AIPLA suggests that the USPTO both clarify and modify this rule.

First, several identification statements in the Office’s Manual are open-ended, such as “computer software for (specify the function of the programs, e.g., use in database management, use as a spreadsheet, word processing, etc. and if software is content- or field-specific, the content or field of use) in Class 9.” AIPLA understands that TEAS Plus filers will be permitted to use such open-ended identifications and to complete the parenthetical information in a free-text field, but it is not clear whether filers will be required to pay a \$50 per class surcharge if the Examining Attorney later requires that the parenthetical information be amended or narrowed. This should be clarified.

Second, AIPLA proposes that this rule be amended to permit filers to use identification statements that are correctly classified and identified under Office Practice, but that are not in the USPTO’s Manual. If a definition is not in the manual but is otherwise acceptable, the filer should qualify for the reduced filing fee. AIPLA thus urges that reversion to the higher electronic filing fee occur only when the USPTO is required to issue an office action objecting to the identification of goods or services as being indefinite.

Third, if a TEAS Plus filer is later required to add a class to its application, or to amend the goods or services in only a single class of a multi-class application, the rules should make it clear whether the \$50 surcharge will be required and, if so, should apply it only to the newly added or amended class.

Rule 2.22(a)(11): Rule 2.22(a)(11) requires TEAS Plus applicants to sign their application at the time of filing. AIPLA urges the USPTO withdraw the applicant’s signature as a filing requirement for TEAS Plus status. It is often difficult to obtain signatures for some applicants, putting them at a disadvantage regarding either priority or filing fees. Because the USPTO does not assign newly filed applications to Examining Attorneys until five to six

months after filing, permitting a TEAS Plus applicant to provide a signature by pre-examination amendment within a short time period after filing (for example, 2-3 months) would not adversely affect USPTO operations or detract from the utility of the TEAS Plus application.

Rule 2.23(a)(1)(i): Rule 2.23(a)(1)(i) requires TEAS Plus filers to file office action responses and certain other documents through the TEAS. The TEAS, however, does not accommodate all of the types of communications that a filer might need to make. For example, a filer cannot submit a television or radio commercial as a specimen through the TEAS. This proposed rule should be revised such that a filer will not lose TEAS Plus status for a filing made outside of the TEAS if the TEAS fails to provide an electronic method to make that filing.

Rules 2.23(a)(2) and 2.62: Rules 2.23(a)(2) and 2.62 require TEAS Plus filers to respond to office actions within two months of the office action mailing date. AIPLA believes that this deadline is too short (and thus the penalty too harsh) for a filer who can comply with all formality requirements but must respond to an office action that raises a substantive registrability or likelihood of confusion objection. Setting a different office action response deadline for TEAS Plus applications also complicates record-keeping for applicants, with no apparent cost-savings for the USPTO. Problems with this two month response deadline are exacerbated by the fact that the TEAS does not recognize that a filing deadline falling on a weekend or holiday automatically extends to the next business day. This deficiency poses a potential trap for applicants attempting to comply with such a short deadline. This problem with the TEAS should be repaired and the USPTO should allow papers to be filed outside of the TEAS in cases where the TEAS is not available for use.

Rule 2.23(a)(3): Rule 2.23(a)(3) provides that “in addition to the filing requirements under 2.22(a), the applicant must receive communications from the Office by electronic mail.” AIPLA requests clarification on how this differs from the Rule 2.22(6) requirement that the applicant must authorize the Office to send correspondence concerning the application by e-mail. Does this additional rule mean that a filer will lose its TEAS Plus status (and face a \$50 per class surcharge) if the USPTO’s email communication capability is interrupted because of a technical problem or because the email address provided at the time of filing has changed or been replaced?

Rules 2.22(a)(13, 14) and 2.53: Together, Rules 2.22(a)(13), 2.22(a)(14) and Rule 2.53 require TEAS Plus applicants filing for marks in standard characters to include only characters in the USPTO standard character set. This proposal does not account for the inability of the TEAS to recognize 90 of the 272 standard characters in the standard character box on the TEAS form, as the rule forbids a filer from attaching a digitized image if its mark is a standard character mark. If the USPTO intends to permit filers to use all 272 standard characters in a standard character mark application, it must either enable the TEAS to recognize all of those characters or permit such filers to attach a digitized image of the mark in standard characters.

Finally, the USPTO should clarify the method by which the extra \$50 filing fee will be charged and collected when one of the many circumstances triggering the need to pay that fee arises.

We appreciate the opportunity to provide comments on the proposed rules and are available to assist the PTO in further developing patent practice and procedures.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael K. Kirk". The signature is written in a cursive style with a prominent initial "M".

Michael K. Kirk
Executive Director