



American Intellectual Property Law Association

July 31, 2020

The Honorable David Gooder
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
Attention: Catherine Cain
Via email: TMFRNotices@uspto.gov

RE: Fee Setting: AIPLA Comments on Proposed Rulemaking for the Proposed Trademark Fee Schedule

Dear Commissioner Gooder:

The American Intellectual Property Law Association (AIPLA) is pleased to offer comments in response to the Notice of the U.S. Patent and Trademark Office (USPTO) proposed rulemaking for “Trademark Fee Adjustment.” Written comments were requested in a Federal Register Notice dated June 19, 2020, Vol. 85, No. 119.

AIPLA is a national bar association of approximately 8,500 members that include trademark attorneys and trademark owners, as well as other IP professionals engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that allow all trademark stakeholders to protect their marks in an efficient, reasonable, and cost-effective manner.

AIPLA appreciates the Trademark Office’s efforts to take into consideration the comments previously submitted by AIPLA and other stakeholders regarding new trademark fees. AIPLA understands the needs of the Office to generate additional revenue from its users in order to facilitate effective operations. For this reason, our comments are limited to a small number of proposed fees.

Our comments below are divided into three sections. The first includes AIPLA’s comments on trademark prosecution and maintenance fees; the second includes comments on Trademark Trial and Appeal Board (“TTAB”) fees; and the third addresses miscellaneous fees.

1. Trademark Prosecution and Maintenance Fees.

AIPLA has ongoing concerns regarding the justification for, and implementation of, certain trademark prosecution or maintenance fees and asks the Office to reevaluate the fees for each of the following:

a. New \$400 Fee for filing a Request for Reconsideration of a Refusal of an Application if filed within the final three months of the six-month time period for response. By imposing a substantial \$400 fee on applicants who do not respond within the first three months of the response period, the Office effectively shortens the statutorily-prescribed time period of six months to three months. AIPLA does not support this fee on applicants who avail themselves of the entire response period, and does not understand how the imposition of this fee relates to costs associated with processing these responses at this point during the response period. Presumably, the same effort is expended by the Office whether it considers a Request for Reconsideration in the first three months of the response period, or the last three months. Finally, this proposed fee would require practitioners to keep track of two separate deadlines for a Request for Reconsideration. This imposes additional complexities and costs. AIPLA strongly urges the Office to reconsider this fee in its entirety.

b. New \$250 fee per class if goods or services in the class are deleted from the registration following a random audit or following a post-registration Office Action. While AIPLA supports the Office's goal of discouraging post-registration filers from including goods or services in Section 8 and 71 filings for which the mark is not used, AIPLA believes that \$250 per class is too high because it penalizes the many legitimate brand owners who act in good faith. AIPLA is of the opinion that the \$100 per class fee previously associated with a Section 7 Petition to amend goods or services is a more appropriate per class fee for deleting goods or services from the registration following a random audit or following a post-registration Office Action. A \$100 per class fee, coupled with the \$100 per class increase in filing fee for a Section 8 filing, should sufficiently discourage questionable filings.

2. Trademark Trial and Appeal Board Fees

AIPLA limits its comments to the proposed increase in Trademark Trial and Appeal Board fees to those associated with filing a Notice of Opposition or Petition for Cancellation:

a. \$600 per class fee for filing a Notice of Opposition or Petition for Cancellation. AIPLA believes this fee is excessive and will disadvantage smaller parties because it will discourage these filings. Also, while AIPLA appreciates the Office's offer to refund \$200 of the fee in certain limited circumstances involving default judgments, AIPLA believes that the refund proposal raises a number of issues and concerns, including:

(1) Is the \$200 refund issued per class or per filing (even if the filing involves multiple classes)? If the \$200 refund is per filing, this is not adequate to reimburse the filer for the additional fees incurred per class in the event of a filing that results in a default judgment.

(2) Why is the refund discretionary with the Board?

(3) Why is the refund applicable to cancellation actions based solely on abandonment or nonuse and that result in a default judgment? AIPLA believes that any ground for cancellation that results in a default judgment should qualify for the refund because less work is needed by the Board in these circumstances.

(4) Why is a refund applicable to cancellation actions only? While AIPLA acknowledges that default judgments are rare in Opposition proceedings, there appears to be no legitimate justification for not issuing a refund that results in a default judgment in an Opposition proceeding since less work is needed by the Board in these circumstances.

(5) Will the issuance of a refund require action on the part of the filer? Will the filer be required to have a deposit account in order for a refund to issue?

In view of these concerns, AIPLA strongly urges the Office to reconsider any increase, or to substantially reduce the increase, in fees for filing a Notice of Opposition or Petition for Cancellation. If this is not possible, AIPLA believes that any proposed refund should be per class and should be applicable to any cancellation action or opposition that results in a default judgment, regardless of the grounds asserted in the Notice of Opposition or Petition for Cancellation.

4. Miscellaneous Fees

AIPLA provides a further comment regarding the following miscellaneous fee:

Revised Fee of \$50 fee for Letters of Protest. While some members of AIPLA continue to oppose any fee for Letters of Protest because of the valuable public service that some Letters of Protest provide the Office, AIPLA believes that, on balance, a \$50 filing fee is appropriate for the Office to recoup some of the cost associated with the timely handling of Letters of Protest it receives.

Conclusion

Although the recent Notice of proposed rulemaking for “Trademark Fee Adjustment” includes many increased or new fees, AIPLA limits its comments to a handful of fees for which its members had the most significant remarks or concerns. AIPLA supports the Office’s continuing efforts to improve the trademark system and appreciates the opportunity to make these comments. We thank you in advance for considering these views and look forward to further dialogue on these matters.

Sincerely,



Barbara A. Fiacco
President
American Intellectual Property Law Association