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October 22, 2012

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Attn: Cynthia G. Lynch, Administrator for Trademark Policy & Procedure
U.S. Patent and Trademark Office

Re: Comments on *Adjustment of Fees for Trademark Applications*

Dear Ms. Lynch:

We write on behalf of the American Bar Association Section of Intellectual Property Law (“ABA IPL Section” or “Section”) to provide comments in response to the United States Patent and Trademark Office’s (the “Office”) invitation for public comment on the *Notice of Inquiry re: Adjustment of Fees for Trademark Applications*, 77 Fed. Reg. 159 (PTO-T-2012-0029, August 16, 2012). The American Bar Association is the largest voluntary professional association in the world and the ABA IPL Section is the largest intellectual property law association with over 25,000 members. The views expressed in this letter are those of the Section. These comments have not been approved by the ABA House of Delegates or Board of Governors and should not be considered as views of the American Bar Association.

The Section appreciates the Office’s inquiry regarding possible changes to trademark application filing fees, and specifically, its invitation for comments in response to the questions set forth in the *Federal Register* notice.

The Section supports the Office’s goal of increasing the use of electronic filing and electronic communications for reasons previously identified by the Office, *i.e.*, faster processing, a reduction of processing costs to the Office, and increased data accuracy. The Section commends the Office for the strides made to provide forms enabling applicants and their counsel to use electronic filing and the changes made to address concerns about electronic filing, such as the ability to provide multiple email addresses.

In connection with its response to the Notice Of Inquiry, the ABA IPL Section conducted a survey to obtain information from its members about i) their current practices in filing and prosecuting trademark applications, ii) the likely impact of changing trademark application fees in the manner referenced in the Notice of Inquiry, and iii) beliefs about the appropriate differences in fees based on the use of electronic versus paper filings or communications. The following are some highlights from the survey results:

- 90% of the respondents file applications electronically.
- The majority of respondents use regular TEAS applications exclusively or primarily rather than TEAS Plus applications.
- For most respondents, the selection of a regular TEAS application over a TEAS Plus application is driven by considerations other than the requirement of electronic communications.
- The most frequent reasons given for the selection of regular TEAS applications over TEAS Plus applications are the requirement to use an identification from the Acceptable Identification of Goods and Services Manual and the requirement that the application be complete.
- 86% of respondents who file regular TEAS applications authorize communication by email.
- 77% of respondents who file regular TEAS applications also file subsequent documents electronically.
- Respondents who generally file subsequent documents electronically, but sometimes file documents by paper, indicated that they generally use paper in those instances where there was not a TEAS form that worked or because of the size of a specimen or supporting evidence.
- A majority of those respondents who do not always use authorize email communications when filing a TEAS application indicated that they would be more likely to do so if they received a discounted fee.

References to positions reflected by the survey are included in the responses to the Office's questions set forth below. We enclose with this letter a tabulation of the survey results showing all of the survey responses.

In general, the ABA IPL Section agrees that the Office should offer a price differential between paper and electronic applications, given the difference in cost to the Office to process paper applications and the goal of encouraging electronic filings. The Section also is in agreement with discounted filing fees for applicants who agree to complete electronic correspondence.

Responses To The Office's Questions

(1) Given the objective to increase end-to-end electronic processing of trademark applications, the significantly higher cost of processing paper applications, and the ability of the USPTO to offer some fee reductions, what fee amounts would you consider reasonable for the three existing methods of filing?

The Committee believes that the Office should continue to offer lower fees for those who file applications electronically, as opposed to filing paper applications, and that the Office should offer a discounted fee for applicants using regular TEAS applications who agree to authorize email communication and submit subsequent documents electronically.

With respect to specific fee amounts, the survey produced a broad spectrum of suggestions of specific fee amounts for paper, regular TEAS, and TEAS Plus applications, as shown in the attached survey results. The majority of respondents suggested a \$100 difference between paper and regular TEAS applications.

2) How much of a discount do you consider appropriate for the proposed TEAS application fee discount if the applicant authorizes email communication and agrees to file all responses and other documents electronically during the prosecution of the application?

The Section commends the Office's proposal to offer a discounted fee for applicants who file regular TEAS applications and agree to authorize email communication and submit subsequent documents electronically. The survey results indicate that such a discount would likely lead to an increased use of electronic communications. The Section invites the Office to review the survey results attached for the specific responses received, but notes that the survey results indicate that an appropriate discount would be \$50 - \$100 per class.

As explained above, the survey responses indicate that for many filers, the reason that they have used paper filings or fax rather than the TEAS system was that they had particular filings for which they could not use a TEAS form or were submitting a specimen or other evidence which the TEAS system did not accommodate. The responses recognize that situations where this is true have been reduced with the addition of forms and enhancements to TEAS. The Section recommends, however, that the Office attempt to address the remaining instances where it is not possible to use the TEAS system. For example, one respondent reported being unable use the TEAS system for the appointment of a Domestic Representative because the Revocation and Appointment of Agent/Domestic Representative form on TEAS auto-fills the Correspondent/Lawyer name in the space for Domestic Representative and does not allow the filer to change the auto-filled name.

(3) If you generally file trademark applications using TEAS, but not TEAS Plus, how much of a proposed discount would motivate you to authorize email communication and agree to file all

responses and other documents electronically during the prosecution of a trademark application?

The survey results indicate that the discount that is likely to motivate filers who use regular TEAS applications to authorize email communication and agree to file all responses and other documents electronically during the prosecution of a trademark application varies depending on the filer. However, as indicated above, it appears that that a discount of \$50 - \$100 per class is likely to motivate a significant percentage of those who do not already authorize email communications to do so.

(4) If the TEAS Plus fee were reduced and remained the lowest fee, and the discount TEAS option were also offered, what would be the impact on the TEAS Plus filing level – i.e. would you be more likely to choose TEAS Plus at the lowest fee, or to select the discount TEAS option with its less burdensome requirements?

The Section does not believe that the price difference between TEAS and TEAS Plus is or will be the deciding factor, or even a motivating factor, for the majority of applicants to choose TEAS Plus over the TEAS method.

The decision to use TEAS is often motivated by the inconvenient and often insurmountable requirements of the TEAS Plus application, regardless of the price differential. As indicated above, the survey indicates that the primary reason applicants choose to use a regular TEAS application is the limitation imposed by TEAS Plus to use a description of goods or services found in the Acceptable Identification of Goods and Services Manual, followed by the requirement that the application be complete at filing, e.g., that it be signed by the applicant.

As a result, applicants are likely to continue to predominantly or exclusively use a regular TEAS application or a discounted TEAS application rather than a TEAS Plus application even if the TEAS Plus application has the lowest fee.

(5) The cost of processing paper filed applications is substantially higher than electronically filed applications. If you generally file paper trademark applications, would you continue to do so even if the paper application fee were to increase, and why?

As indicated above, only four of the 164 survey respondents always or primarily use paper applications. These respondents provided no reason for that decision. Only one of the four indicated that an increase in price would change this decision. 14 other respondents indicated that they use primarily electronic and some paper applications or a mix of the two. They indicated that the choice was driven by habit, client preference, or for easier review or revision. Four of these respondents indicated that their practice would change if there were a higher fee for paper applications. One respondent who files electronically indicated that when he/she previously was doing work at a low income clinic associated with a law school, the clinic had to

use paper applications because payments had to be made in a way that was not accommodated by the TEAS system.

(6) What advantages and disadvantages do you see in a fee structure that includes the TEAS application fee discount and a significantly higher fee for paper-filed applications?

The Section foresees several advantages to a fee structure that encourages electronic filing and communications, in addition to the potential cost savings for applicants. This fee structure will likely encourage more electronic correspondence, which in turn will mean faster, more efficient and less costly processing. Quicker processing of an application benefits not just the particular applicant, but also those searching the registry, as it will provide for a more accurate and up-to-date record. The tiered fee structure also better reflects the costs that the Office incurs in processing the different types of applications.

At the same time, the fee structure should not prevent persons who do not have the ability to file and communicate electronically, e.g., because they need to pay using a method payment different from that offered through TEAS, from being able to apply to register their marks because the fees for paper applications make filing cost-prohibitive.

Conclusion

The ABA IPL Section commends the Office for its consideration of these issues and appreciates the opportunity to offer these comments.





Very truly yours,



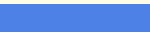





Joseph M. Potenza
Section Chair
American Bar Association
Section of Intellectual Property Law

Enclosure

1. Please select one that applies:

#	Answer		Response	%
1	I am employed as in-house counsel for a corporation or other organization		26	14%
2	I work in a law firm		148	82%
3	I work in academia		3	2%
4	I am employed by the government		3	2%
	Total		180	100%

2. What is the general size of the organization for which you work?

#	Answer		Response	%
1	1-10 employees		58	32%
2	11-49 employees		36	20%
3	51-100 employees		27	15%
4	101-500 employees		24	13%
5	501-1000 employees		16	9%
6	Over 1000 employees		18	10%
	Total		179	100%

3. Approximately how much of your individual practice is dedicated to trademark prosecution?

#	Answer		Response	%
1	Less than 25%		81	46%
2	Between 25% and 50%		60	34%
3	Greater than 50%		36	20%
	Total		177	100%

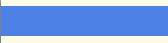

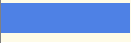


4. Approximately how much of your firm's or company's practice is dedicated to trademark prosecution?

#	Answer		Response	%
1	Less than 25%		120	69%
2	Between 25% and 50%		42	24%
3	Greater than 50%		12	7%
	Total		174	100%

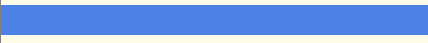




5. Approximately how many trademark applications do you typically file in the United States Patent And Trademark Office ("USPTO") in a year?

#	Answer		Response	%
1	1-10		56	33%
2	11-50		81	48%
3	100-300		17	10%
4	More than 300		2	1%
5	Not applicable - not part of my practice		12	7%
	Total		168	100%

6. Approximately how many trademark applications do your company or law firm typically file in the USPTO in a year?

#	Answer		Response	%
1	1-25		56	35%
2	26-100		45	28%
3	101-500		43	27%
4	501-1000		10	6%
5	More than 1000		5	3%
	Total		159	100%

7. Which of the following best describes your practice with respect to the trademark applications you file or have filed?

#	Answer		Response	%
1	Always file electronically		147	90%
2	Always file paper applications		3	2%
3	File primarily electronic applications and some paper applications		11	7%
4	File primarily paper applications and some electronic applications		1	1%
5	File both electronic and paper applications		2	1%
	Total		164	100%

8. If the applications you file include paper applications, briefly state the reason(s) that cause you to file a paper application rather than an electronic application.

9. What reason(s) have others given you for their decision to file a paper application rather than an electronic application.

Text Response
n/a
In my firm, I am the only one filing trademarks.
Old habits, use of forms the lawyer is used to using
None. I didn't know anyone really filed on paper anymore.
Have not heard from others on this point.
No reason to use paper at all. I use TEAS only if the pre-specified goods and services descriptions do not fairly apply, or if the client has so many specified goods that the added (current) \$50 bump is worthwhile to pay, so as to let the examiner work out the proper descriptions....
None
They are older attorneys that feel more comfortable doing it that way.
Not aware of anyone who still files paper applications.
A particular client's habit.
Comfort level with using the same forms that they (the individual lawyer) has developed over the years to conform with USPTO rules. They prefer to use the forms they are used to seeing, rather than having uncertainty about whether the electronic version gets received. They are comfortable with email communications with clients, but not with online submissions through the USPTO's website.
I don't know anyone who files paper
The only time I have met someone not filing electronically was when I worked with a low-income business/IP law clinic associated with a law school. The clinic did not have anyway to process the charges on a card, and it was against the clinic's policies to allow an attorney (or student for that matter) to use the client's card for any reason. As a result, the clinic had not choice but to file by paper. It was a nightmare!
I haven't heard of anyone filing a paper application since at least 2004.
None
None.
none; it's purely archaic.
Distrust of USPTO system; greater sense of control and certainty.
none, other than specimen limitations
None
N/A

They have internal processes that can't accomodate e-filing
Resistance to change; more time to meet deadlines with postmark due to time difference.
Unsure of the procedures used for e-filings
I don't know anyone who files on paper.
n/aPa
unfamiliarity with electronic filing system comfort with paper filings
One hospital client was a hold out until very recently. They said they wanted their officers to sign on paper so they knew what they were signing.
n/a
The attorneys in my office file trademark applications electronically.
again primarily long standing protocol
none
Easier to fix errors; easier to have other attorneys and staff review it first.
n/a
they are old timers
Habit, easier for the partner to review before filing.
firms in the DC area like to hand-carry them in and get a physically stamped receipt where papers need signatures, some like to send the original
Specimen problems with in use applications
Long time practice.
None.
State has no means for electronic filing
I don't know any who do
I do not know anyone who still files paper applications.
NA
Haven't heard any
Habit, lack of comfort using electronic filing, client preference.
none
Same as above.
more efficient, cheaper for client in legal fees.
none
None
None.
None
None
none

Some people are not comfortable filing electronically.

None. Our firm always files electronically

New fillers

None received

10. The current fee structure for filing trademark applications is \$375 per class if filing by a paper application, \$325 per class if filing electronically using TEAS, and \$275 per class if filing electronically using TEAS Plus. Given the USPTO's objective to increase end-to-end electronic processing and the ability of the USPTO to offer some discounts, what fee amounts would you consider reasonable for filing an application (i) by paper, (ii) filing electronically using TEAS, and (iii) filing electronically using TEAS Plus.

Text Response
\$400 \$300 \$200
Paper: \$400; TEAS: \$300; TEAS Plus: \$275
I would say raise the paper fee to \$475 and drop the electronic fee to \$175 / \$225
(i) \$400; (ii) \$375; (iii) \$250. I think a significant difference in filing fees will encourage people to consider filing electronically using TEAS Plus.
\$500 paper \$350 TEAS \$300 TEAS Plus
\$375 per class if filing by paper application, \$325 per class if filing electronically using TEAS, and \$275 per class if filing electronically using TEAS Plus
Paper - \$500 TEAS - \$300 TEAS Plus - \$300
(i) by paper - \$500; (ii) filing electronically using TEAS - \$250; (iii) filing electronically using TEAS Plus - \$200
(i) 450 (ii) 325 (iii) 275
Paper applications: \$425 - \$375 per class TEAS: \$325 - \$275 per class TEAS Plus: \$275 - \$200 per class current variable -- or increase to \$400 or \$425 for paper
\$450; \$350; \$250.
\$400 paper \$300 TEAS get rid of TEAS Plus
I don't think that TEAS Plus should be discounted any further. TEAS Plus is a burden for most applications because of the ID issues. The USPTO could give other incentives for using TEAS Plus, such as priority in review (i.e. faster processing), instead of a reduced fee. I am OK with a paper filing fee that is more than the electronic filing fee.
I think a \$50 discount for both electronic filings is reasonable. I don't think the paper filing fee needs to change.
Paper - \$450 TEAS - \$300 TEAS PLUS - \$250
In my experience, the difference in filing fees between paper, TEAS and TEAS Plus hasn't been the principal driver of the transition away from paper filings. Though the fee difference might have motivated some, there are significant non-monetary benefits to electronic filing that are most responsible for its adoption. Similarly, I don't believe that the fee difference between TEAS and TEAS

Plus is very effective. Instead, having different fees for TEAS and TEAS Plus complicates accounting, which actually provides an incentive to avoid TEAS Plus entirely in order to keep fees uniform. Therefore, I would propose that the PTO set a uniform fee for TEAS and TEAS Plus, and instead implement additional nonmonetary advantages for TEAS Plus applications. For example, fast track review of TEAS Plus applications would be a valuable benefit if all other things were equal.

(i) \$350 (ii) \$300 and (iii) \$200.

\$450 paper, \$300 TEAS, \$250 TEAS Plus

(1) 500; (2) 250; (3) 250.

Lower them all by \$50.

(i) by paper - \$400 or \$425. They take longer to process within the firm, too. (ii) filing electronically using TEAS - \$300 (III) filing electronically using TEAS PLUS - \$250

Paper \$750 per class TEAS \$250 per class TEAS Plus \$225 per class

\$350 paper \$300 TEAS \$275 TEAS Plus

\$400 for paper filings. \$300 for eFilings

\$400 by paper \$300 TEAS \$250 TEAS Plus Problem here is, what may serve as an incentive for those at the bottom of the ladder to file electronically will probably make no difference to those at the top. Problem with fee-based incentives is always that--those at the top don't care, those at the bottom are suddenly overburdened by the same law that is supposed to secure to them some kind of economic benefit or security.

i) \$375 ii) \$275 iii) \$225

\$400 paper, same prices for TEAS and TEAS Plus

paper - \$400 electronic using TEAS - \$300 TeasPlus - \$250

Paper \$500 TEAS \$300 TEAS+ \$250

No view.

(i) \$300 (ii) \$250 (iii) \$150

Paper--keep the same, \$375 no matter what; TEAS--\$275; TEAS Plus--\$200. In my experience, tho, PTO fees are seldom the reason private-practice clients decline to file a trademark application--or at least do it correctly. The sticking point for cost-conscious clients is always the cost of a comprehensive clearance search, but that's not a PTO problem. So, I don't see the fee structure at the PTO having a big impact on filing practices.

I think the current fees are fair, but would, of course, welcome a reduction in e-filing fees.

\$400; \$300; \$300

(i): \$500 (ii): \$250 (iii): \$200

Current fees are OK

current fees are reasonable

Filing by paper - double the cost of filing by TEAS Filing by TEAS \$275 or \$300 Drop TEAS Plus since there is usually an office action which then increases the cost.

E-filing using TEAS Plus \$200; E-Filing using TEAS \$250; Paper - \$300

1. \$400 2. \$300 3. \$250

(i) \$400, (ii) \$300, (iii) \$250.

A more substantial discount seems it would be reasonable for using TEAS. TEAS Plus, however, can be problematic as the USPTO does not regularly update or keep current the list of "Acceptable Identification of Goods and Services" and many of our desired marks do not properly fit into the listed goods (especially software products)

\$75 - \$100 reduction for each; i.e.\$375 per class for paper, \$275 - \$300 for TEAS, \$175 - \$225 for TEAS Plus

(i) \$450 (ii) \$250 (iii) \$200

(i) \$525 (ii) \$275 (iii) \$225

Paper - \$500; TEAS - \$250; TEAS Plus - \$200

\$425 for paper, \$300 for TEAS, and \$250 for TEAS PLUS. Although, keep in mind, this could result in an overall reduction in filing fee income, if the program is successful in eliminating paper filings.

\$400; \$300; \$250

All filings: \$200

The filing fee is not what dictates whether I file electronically using TEAS or TEAS Plus, so I have no objection to the current fee ratio.

current fees

1. \$400 2. \$225 3. \$225

(i) \$400, (ii) \$225, (iii) \$175

estimate paper \$500; TEAS \$250; TEAS PLUS \$200

(1) \$450, (ii) \$325, (iii) \$275

I think the current fees are best, unless \$375 per class is not enough to recover the extra costs of paper filing (in which case the \$375 fee should be increased, but not by much)

For start-up clients fees of \$250 to \$300; So, keep paper at \$375; TEAS reduce to \$275 TEAS plus to \$225

The TEAS Plus G & S descriptions are hard to use so I'd just give one discount for electronic filing.

(i) \$425 (ii) \$200 (iii) \$200

(i) 500 (ii) 300 (iii) 200

I think the current fee structure is reasonable. My main suggestion would be to ease the guidelines for filing TEAS Plus applications. 95% of the time, we meet all the qualifications except for the ID of goods/services. If we were permitted to use free-form ID's instead of the standard listing from the Acceptable Goods/Services Manual, we would most likely file TEAS Plus applications the majority of the time.

I don't see a need for lowering fees - they are not unreasonable and the PTO needs the funds.

i) \$400; ii) \$310; iii) \$260

375 for paper 300 for TEAS 250 for TEAS PLUS

paper, \$450/class; TEAS electronic \$300/class; TEAS Plus \$200/class (seems like they have a secondary goal to encourage TEAS Plus in particular)

No increase in any applications

Fees should stay "as is". A fee increase is a burden on our clients, particularly small companies, start-ups

(i) \$425 (ii) \$275 (iii) 225

Paper should not be penalized

Paper: \$375/class TEAS: \$325/class TEASPlus: \$250/class

I think the current fee structure is reasonable.

\$100 differential

(1) 375 (ii) 300 (iii) 250

(i) \$500 per class (ii) \$275 per class (iii) \$200 per class

I thin the two TEAS fees are reasonable, but would increase the paper filing fee to \$400.

(i) by paper: 400\$ (ii) filing electronically using TEAS: 300\$ (iii) filing electronically using TEAS Plus: 250\$

NA

Because I do not file paper applications, I do not care how high those go. I would like to see regular TEAS and TEAS Plus application fees be lowered. Start-ups sometimes balk at the cost, especially if they should file in multiple ICs. I would especially like to see the cost for additional classes be lower, e.g., \$300 for first class with regular TEAS and \$100 for each additional class for the same mark within the same application.

I'm not sure that a \$50 or \$100 discount is enough to be a large incentive; but a larger discount risks becoming more of a penalty to paper filers. So current discount scheme seems reasonable.

i)\$500 ii)\$250 iii)\$175

(i)425 (ii)325 (iii)275

It depends. What percentage of applications result in Office Actions? What percentage go directly to Notice of Publication or Notice of Allowance?

(i) \$400 (ii) \$250 (iii) \$200

\$425 \$300 \$300

(i) \$475 (ii) \$300 (iii) \$250

(i) \$400; (ii) \$300 (iii) \$250

(I) \$400, (ii) \$350, (iii) \$300

The same.

\$500 \$300 \$250

the same as it currently is

\$375 for paper; \$250 for TEAS and \$200 for TEAS Plus

I wish TEAS and TEAS plus were free....

\$450 for paper \$250 for TEAS-Plus \$275 for TEAS The problem with using a substantially higher filing fee (currently \$50 more) for filing a TEAS application than for filing a TEAS Plus application is that the Patent and Trademark Office stubbornly refuses to add descriptions to the ID Manual upon request when there are similar, but not correct, preapproved applications already in the Manual. On several occasions we have asked the PTO to add descriptions that would correctly identify our clients' goods or services and the ID Suggest people have refused to do so because there are SIMILAR descriptions

already in the ID Manual. They say that the Manual exists as a GUIDELINE and that if there are existing descriptions from which we can create correct ones, it is unnecessary to add more descriptions to the Manual. Assuming that the purpose for the Manual and the TEAS Plus application is to eliminate work by the examining attorneys and make the application process smoother and more efficient, the refusal to add to the Manual descriptions that are correct is ridiculous--and is nothing more than a way for the PTO to generate the higher filing fees that a TEAS application requires. If an existing description does not completely fit an applicant's goods or services, the PTO should make the application process easier by adding to the Manual a proper description that DOES fit as long as that description satisfies the PTO's requirements. Hence my recommendation that the differential between the TEAS and TEAS Plus filing fees be reduced, if it is kept at all.

Current fees are fine

the same fees as they now charge

I can't speak to that. I don't know the actual costs incurred by the Trademark Office over the life of an application.

They already seem reasonable, although if paper handling is too costly for the PTO, rather than spreading that cost onto the e-based systems, raising fees on paper filing would be more appropriate.

Current fees.

\$400 paper, \$250 TEAS, \$200 TEAS Plus

My clients seem to find the current electronic filing fees reasonable.

11. Would an increase in the filing fee for paper applications increase the likelihood that you would file an electronic application?

#	Answer		Response	%
1	No		36	23%
2	Yes		30	19%
3	Yes, but only if the fee was increased by \$50		1	1%
4	Yes, but only if the fee was increased by \$100		1	1%
5	Not applicable, because I don't file paper applications		91	57%
	Total		159	100%

12. What do you believe should be the price differential between paper and regular TEAS applications?

#	Answer		Response	%
1	No difference		13	8%
2	\$50, as it is now		30	19%
3	\$100		65	42%
4	\$150		15	10%
5	More than \$150		32	21%
	Total		155	100%

13. If the applications you file or have filed include electronic applications, which of the following most accurately describes your practice with respect to electronic applications?

#	Answer		Response	%
1	Always file TEAS Plus applications		13	9%
2	Always file regular TEAS applications		41	29%
3	File mostly TEAS Plus applications and some regular TEAS applications		39	28%
4	File mostly regular TEAS applications and some TEAS Plus applications		34	24%
5	File both TEAS Plus and regular TEAS applications		14	10%
	Total		141	100%




14. With respect to the TEAS applications (as opposed to TEAS Plus applications) you file, which of the following best describes your practice with respect to authorizing the Trademark Office to communicate with you via e-mail?

#	Answer		Response	%
1	Always authorize communications via email		121	86%
2	Never authorize communications via email		9	6%
3	Authorize communications via email in most applications		10	7%
4	Authorize communications via email in some, but less than half, of the applications		1	1%
	Total		141	100%

15. With respect to the regular TEAS applications (as opposed to TEAS Plus applications) you file, which of the following best describes your practice with respect to subsequent documents you file in connection with the prosecution of the application?

#	Answer		Response	%
1	Always file subsequent documents electronically		108	77%
2	Never file subsequent documents electronically		1	1%
3	Generally file subsequent documents electronically		29	21%
4	Generally file subsequent documents by mail		3	2%
	Total		141	100%

16. To the extent that you file subsequent documents by mail rather than electronically in some circumstances, what is the reason for your choice?

#	Answer		Response	%
1	Prefer filing by mail to filing electronically		7	16%
2	Filing includes materials that cannot be accommodated by TEAS		27	61%
3	Need to make a filing for which there is not an appropriate TEAS form		10	23%
	Total		44	100%

17. If applicable, briefly describe the kinds of documents you found necessary to file by mail rather than electronically.

Text Response
n/a
An Office Action Response containing a large volume of supporting evidence.
Catalog of a size too large to be accommodated by TEAS
None
none
N/A
AAU filing fees or additional class filings fees paid by check from client directly to USPTO so we don't need to involve the firm's accounting or trust account.
none
Exhibits
Can't think of a specific example, because I've submitted in paper format only rarely over the past 10 years, but know that I've done it only because I had to.
bulky specimens and documents supporting argument
N/A
When there was an electronic error with a Request to Divide
None.
None. No reason whatsoever to use mail.
N/A
mostly the size of the files; number of pages
none
If we file paper documents, the documents are mainly TTAB documents because the system is controlled by events and/or calendaring to a certain extent and, if you need to file a document in which the time has passed the system will not accept it or if a certain event occurred, then a party is sometimes precluded from filing the document. As a precaution, we send in paper documents to assure it is not rejected by the TTAB. In regards to TM prosecution, we rarely file paper documents unless the foregoing occurs.
When PTO erroneously marked an application as abandoned, request to correct the record was faxed.
N/A
Copies of foreign registrations
Rarely - when a form is not available on TEAS, or once when TEAS was having technical problems and we had a deadline.
can't recall
N/A
n/a

Responses to office actions that involve more than a brief argument, exhibits, and additional documents, such as an allegation of use submitted with a response.
haven't filed by mail in years
Small number of filings for which there is still no electronic form. This happens less and less.
n/a
hard to recall specifics now
none
certified priority documents
n/a
N/A - we file all documents electronically
NA
trade show brochures that didn't reproduce well
Specimens
Do not file by mail
N/A
art, colors
Complicated illustrations where file size might cause problems electronically or if had problems converting file formats.
Certain use in commerce specimens
There's a problem with the Revocation and Appointment of Agent/Domestic Representative electronic form. The form auto-fills the Correspondent/Lawyer name in the space provided for us to name the Domestic Representative. The form will not allow us to change the auto-filled name. I work for a law firm of OED Recognized Canadian lawyers who are often named as the lawyer/correspondent. We typically appoint a US Domestic Rep when filing US applications. Since some of the trademark registrations for which our firm is responsible did not have a Domestic Rep appointed, we recently attempted to use the on-line form for this purpose and discovered the problem with the form. We contacted a USPTO representative to question if there was a way around this and were told we would have to mail our submissions to the USPTO for this purpose.
Responses, divisionals, etc. with marks including diacritical symbols
Have done it, can't recall the specifics.
products brochures books video commercials






18. If you could obtain a discounted filing fee by authorizing communication by email and agreeing to make subsequent filings electronically, without also being required to meet the other conditions of a TEAS Plus application, would you follow that course more often than you do now?

#	Answer		Response	%
1	Not applicable, I already follow that course for all applications		70	45%
2	No		12	8%
3	Yes		58	38%
4	Yes, but only if the savings were at least \$50		8	5%
5	Yes, but only if the savings were at least \$100		6	4%
	Total		154	100%

19. What discount do you believe parties filing regular TEAS applications should get from the regular filing fee for agreeing to authorize email communications and to file all responses electronically?

#	Answer		Response	%
1	No discount		24	16%
2	\$25 - \$50		52	34%
3	\$51 - \$100		51	34%
4	\$101 - \$150		11	7%
5	More than \$150		14	9%
	Total		152	100%

20. To the extent you file applications using TEAS but not TEAS Plus, which of the following best describes the primary reason for that decision.

#	Answer		Response	%
1	I do not want to be restricted to using a description of goods or services identified in the Acceptable Identification of Goods and Services Manual		124	83%
2	I do not want to be limited to communicating with the USPTO electronically		7	5%
3	I do not want to pay the entire fee at the time I file the application		4	3%
4	I do not want to be restricted to filing an application that is complete when filed		6	4%
5	Other		8	5%
	Total		149	100%

21. To the extent you file applications using TEAS but not TEAS Plus, which of the following – other than the primary reason identified in response to the prior question – best describes the reason for that decision.

#	Answer	Response	%
1	Requirement to use description of goods or services from the Manual	50	56%
2	Requirement that communications be done electronically	7	8%
3	Requirement that entire fee be paid with the filing of the application	5	6%
4	Requirement that the application be complete	20	22%
5	Other	7	8%
	Total	89	100%

Statistic	Value
Min Value	1
Max Value	5
Mean	2.18
Variance	2.22
Standard Deviation	1.49
Total Responses	89

22. What are the advantages or disadvantages of a fee structure that (i) discounts the regular TEAS application fee for parties who agree to electronic communication and (ii) imposes a significantly-higher fee for paper applications?

Text Response

Advantage: More people filing electronically and agreeing to electronic communication; Disadvantages: None

Advantages: less cost; Disadvantages: inability to use own form.

Since many of us are already doing this without the discount it would be an advantage to be able to pass that discount on to the client. The disadvantage would be that depending on how deep the discount, it may encourage more filings of applications on a 1(b) basis by applicants without a bona fide intent to use the mark.

Increased use in electronic communications benefits both applicants and those searching the database. Disadvantage would be if the significantly-higher fee prevented some people from being able to file an application because they did not have the ability to file electronically; without knowing who files paper applications there is no way to know if this in fact really would be a concern.

Advantages - brings the fees more in line with the efforts required for examining attorneys to review and respond to electronic apps v. paper apps; lower fee may encourage more filings Disadvantages - may discourage those who for some reason need to file via paper or have no access to electronic communications

none

I think there are a lot of applicants who would agree to electronic communications only in conjunction with the regular TEAS application, but are reluctant to file TEAS Plus applications due to the requirements that (1) they use a description consistent with the Acceptable Identification Manual of Goods and Services and (2) the application be complete when filed. If the PTO offered a discount for TEAS Plus applicants who agree to electronic communications, I suspect the PTO would see a very significant increase in such applicants. I do not file paper applications, and am not aware of any relatively seasoned trademark attorneys who file paper applications. I therefore do not see any significant disadvantages to increasing the paper application filing fee.

either might influence behavior -- increasing fee to discourage certain behavior may be more effective??? -- should be behavioral studies in analogous situations comparing different impact/effectiveness of raising fee to discourage vs. lowering fee to encourage

Saves work at the TM Office!

Isn't that obvious? The only problem is if TEAS is down and there is a deadline.

I think people who need to file paper applications for whatever reason could feel (and very well be) disenfranchised - however, if the reality is that it costs the PTO more money to process the paper applications, electronic filers should not have to pay for that.

I believe this would be a highly advantageous approach, provided that the discounted fee for TEAS (with electronic communication) was the same as TEAS Plus fee. One of the other reasons not to use TEAS Plus is the additional complexity in accounting for the different fee levels and the time required by the

occasional case when we have to go back to the client to obtain another \$50 to convert from TEAS Plus back to TEAS. If electronic communication is really what the PTO wants to incentivize, then have one fee for electronic communication and another for paper/non-electronic. Use non-monetary incentives to encourage users to take the additional step of filing under TEAS Plus.

encouraging people to file electronically; lessens paper waste

Advantage; provides incentive for electronic filing and electronic communications.

You'll get more electronic filings. No disadvantage.

Will encourage clients or other lawyers in our practice to adopt the electronic filing method, which is faster and easier to use for updating our client files. Some of our colleagues are very slow to adopt new technology.

Requiring electronic communication not acceptable to most paralegals, who want to make sure that they see all correspondence that comes in.

I had no idea that anyone didn't authorize electronic communication and file electronically.

Efficiency!

The only advantage is benefit to USPTO to push less paper. A volume discount for electronic filings for applications and other documents/responses should be applied.

I think it is a fantastic idea and have always found the fee structure at the Trademark Office to be fair and reasonable. I don't see how altering the fee structure will reduce paper filings, but it might. The difference would have to be a clear penalty pricing structure (\$150 difference or more), however.

No opinion.

n/a

The big disadvantage would be for voluminous 2(f) filings, but these are relatively rare.

none that i can see. NOTE ON ID MANUAL: I ALWAYS TRY TO USE THE ID MANUAL BUT SOME GOODS AND SERVICES DO NOT SEEM TO HAVE ACCURATE IDENTIFICATIONS FOR SOME PRODUCTS, ESPECIALLY NEWLY INVENTED PRODUCTS.

Encourages electronic filing. Paper applications should only be allowed for individuals not law firms or attorneys since there may be individuals who are not computer savvy.

more parties will file electronically if the fee is lower and sole proprietors or individuals can afford to file TM applications if the fees are reduced

no disadvantages, as long as you are using the TEAS system

Faster processing of e-filed cases.

advantage: Efficiency and lower cost. disadvantage: reduced flexibility in the form of the presentation.

n/a

A disadvantage of electronic communication is the expectation of immediate response, which a reduced fee will not solve. The issue isn't with filing electronically, it is with subsequent communication. Clients need time to provide instructions.

might allow for same fee for TEAS and TEAS PLUS which removes the penalty for using own description of goods

Don't understand the question.

Improves efficiency, decreases handling cost.

Regarding (i), the fee advantage is a lower fee, but we also prefer electronic communication because we can handle and file it more efficiently in our office. Regarding (ii), This has no advantages or disadvantage for us, as we never file on paper. For the public at large, particularly infrequent and pro se filers that may be unaware of or unwilling or unable to use the electronic systems, a disadvantage is that a higher fee is charged to many applicants who have less money to invest in trademark filing, although a good argument can be made on general principles that many of these paper filers should be charged less than standard rates.

Not fair to those who are hindered in their use of electronic communications.

I think it's advantageous to create a tiered fee structure to encourage electronic filings/communications to speed the process along, as long as the PTO provides forms for all of the potential filings one might need to make. But if the PTO cannot do that, I don't think filers should be penalized just because the PTO hasn't created the appropriate form yet. Also, I think it's appropriate to charge users who don't file electronically (assuming there is an appropriate form for what they need to file/submit) whatever the additional cost is to the PTO to process the paper filings. Since I don't know what that amount is, I can't answer appropriately the questions about the size of the additional fee that would be acceptable.

increased electronic filings, greater efficiencies will result

Honestly, I never saw this as much as a discounted fee as I did a penalty for filing paper applications. I am not particularly affected by this practice because I don't file paper applications and I agree they are more labor-intensive on the PTO end. However, if I am filing electronically through regular TEAS and reducing the PTO's processing time (e.g., the PTO no longer needs to input details from my newly-filed application - I essentially enter the information when I file the application), then I believe it is reasonable that the cost savings be passed on to me and my clients. The primary disadvantage I have seen for TEAS Plus applications is that applicants are required to use the standard goods/services manual. This can be a problem when the desired ID isn't in the book yet applicants feel pressured (either by budget constraints or other issues) to file a TEAS Plus application to get the lower fee, but they sacrifice coverage with an ID that doesn't really describe their products or services accurately. I would remove the ID requirement because I think it places undue pressure to file a substandard application to get the lowest fee possible.

I think a higher cost for paper application is appropriate but the current TEAS and TEAS Plus fees are fine. Why not just up the paper fee. This will benefit the PTO and trademark practitioners because it is probably only the pro se applicants who do paper - I don't know any attorneys who do. The office spends a lot more time on pro se filings and a higher fee is completely justified. It might also induce more pro se applicants to engage attorney which is a win for the office, the attorney, and the applicant since they will benefit from the assistance of an attorney.

Risk of losing the communication from the PTO.

Advantages: aligns fee revenues with costs of processing (assuming paper applications cost significantly more to process) Disadvantages: None noted.

The advantage is that it encourages electronic filing, which allows fast filing and confirmation as well as streamlines communication between the applicant and the USPTO.

If I get faster processing time, electronic is better. Easy access to electronically filed documents. It has to be more economic for the USPTO, which I am in favor of.

Discounting the fee when agreeing to electronic communication is disadvantageous because it will not change usage and will reduce fees to the USPTO. My underlying assumption is that those who use TEAS

generally authorize email communication already. The advantage to imposing a significantly higher fee for paper applications is both to discourage its use and to cover more of the actual internal costs involved in handling physical applications.

NA

As per previous comment, if discount too large it becomes more of a penalty to paper filers, which I see as not good (not in the public interest).

increased efficiency; possible improved accuracy since data is as-entered versus having to be manually entered.

PTO profitability

USPTO is the gatekeeper. It is one thing to defray the cost of processing an application (electronic or paper), but it is another thing to regulate conduct (mandatory electronic filing or economic disincentives to paper filing).

For those that are paper filing submissions in the USPTO, a significant difference between the fees charged for electronic filing as opposed to those charged for paper filing might be the incentive needed to prompt them to use (or at least explore the possibility of using) the electronic forms. A disadvantage would be that which I've noted previously (i.e. problems with the on-line forms). There's no fee for submitting the aforementioned appointment documents so we're not penalized for our paper submission. Situations in which paper filing is necessary due to problems with the on-line forms will likely prompt complaints if higher fees are also payable.

obviously you discourage the use of paper

paperless is its own advantage

Is this a trick question? The advantage is that those who file electronically pay less. The disadvantage of those who file paper applications pay more.

Obviously it encourages electronic filing. That said, it seems to me to be a question of who pays for the paper. If the PTO keeps a paper file, it has to print the application and accompanying specimens. I always print copies of the electronic documents for my paper file as a back-up.

For me, there are no advantages, only disadvantages. I file an application based on what is most effective for the client, and not the fee. So, an increase in fees will only increase costs, and cannot cause me to otherwise file electronically.

I see no disadvantages.

No disadvantages.

Advantages - encourages online communication, cuts down on paper. Faster than snail mail.

I think most practitioners are using electronic applications and communications as part of a best practices. I think many individuals and small businesses may have a difficult time submitting electronic applications because they may not have access to a scanner, for example. The fee structure could be structured such that such individuals and businesses weren't penalized.

More efficient, quicker processing by using email is a definite advantage to me, and thus my clients.

Statistic	Value
Total Responses	62