

**AMERICAN BAR ASSOCIATION**

**Section of Intellectual Property Law**

321 N. Clark Street  
Chicago, IL 60654-7598  
(312) 988-6254

E-mail: [iplaw@americanbar.org](mailto:iplaw@americanbar.org)  
[www.americanbar.org/iplaw](http://www.americanbar.org/iplaw)

**CHAIR**

Mark K. Dickson  
*San Mateo, CA*

**CHAIR-ELECT**

George W. Jordan III  
*Houston, TX*

**VICE-CHAIR**

June Besek  
*New York, NY*

**SECRETARY**

Adriana S. Luedke  
*Bethesda, MD*

**FINANCIAL OFFICER**

Willard Jones II  
*Bethlehem, PA*

**REVENUE OFFICER**

Jonathan Hudis  
*Washington, DC*

**CLE OFFICER**

David Postolski  
*Summit, NJ*

**MEMBERSHIP OFFICER**

Thad Chaloehtiarana  
*Chicago, IL*

**PUBLICATIONS OFFICER**

Stephen E. Gillen  
*Cincinnati, OH*

**SECTION DELEGATES TO  
THE HOUSE OF DELEGATES**

Susan B. Montgomery (2019)  
*Boston, MA*

Joseph M. Potenza (2020)  
*Washington, DC*

William L. LaFuze (2021)  
*Houston, TX*

**IMMEDIATE PAST CHAIR**

Scott F. Partridge  
*Houston, TX*

**COUNCIL MEMBERS**

Scott M. Alter (2019)

Janet Fries (2019)

Barbara J. Gislason (2019)

Heath W. Hoglund (2019)

Elizabeth Chien-Hale (2020)

Sharon A. Israel (2020)

Chris Katopis (2020)

Christina N. Scelsi (2020)

James R. Davis II (2021)

Jonathan R. Sick (2021)

Joshua L. Simmons (2021)

Francine D. Ward (2021)

Steven P. Caltrider (2022)

Thad Chaloehtiarana (2022)

Christina D. Frangiosa (2022)

Mary E. Rasenberger (2022)

**Young Lawyer Council Member**

Jameson Ma (2019)

**SECTION STAFF**

Michael G. Winkler  
*Director*

Carey Farley  
*Programming / Events*

Amy Mandel  
*Communications / Publications*

Kira M. Alvarez  
*Legislative Consultant*  
*Washington, DC*  
[kira.alvarez@americanbar.org](mailto:kira.alvarez@americanbar.org)

August 20, 2018

Hon. Mary Boney Denison  
Commissioner for Trademarks  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

Re: Request for Comments Concerning Changes to the Trademark  
Rules of Practice to Mandate Electronic Filing

Dear Commissioner Denison:

I write on behalf of the American Bar Association Section of Intellectual Property Law (the “ABA-IPL Section” or “Section”) in response to the United States Patent and Trademark Office’s (USPTO) request for comments concerning *Changes to the Trademark Rules of Practice to Mandate Electronic Filing* (“Trademark Rules”), published at 83 Fed. Reg. 24701 (PTO-T-2017-0004, May 30, 2018) (the “Notice”). The views expressed herein are presented on behalf of the Section of Intellectual Property Law. They have not been approved by the House of Delegates or the Board of Governors of the American Bar Association and, accordingly, should not be construed as representing the position of the Association.

The Section supports the Office’s goal of improving administrative efficiency in the trademark prosecution procedure and maintaining the accuracy of the Federal Register by reducing processing errors. To that end, the Section generally supports the Office’s revisions of parts 2 and 7 of title 37 of the Code of Federal Regulations to require all new trademark application filings based on section 1 and/or section 44 of the Trademark Act (Act), 15 U.S.C. 1051, 1126, and submissions concerning applications or registrations, to be submitted electronically through the (USPTO) Trademark Electronic Application System (TEAS). The Section though has concerns about a few proposed revisions and therefore respectfully submits the following comments.

## **I. Limited Exception for TEAS Outages**

If adopted, the revised Trademark Rules will permit limited exceptions to the electronic filing requirement, including when TEAS is unavailable on the date of the deadline for a submission. A filer invoking this exception would be required to submit a Petition to the Director of the USPTO (“Director”) to accept a paper submission.

The Notice states that the USPTO intends to continue to waive fees and non-statutory deadlines for such Petitions to the Director, where the USPTO’s systems prevent electronic filing for an extended period. The Section seeks clarity on this exception and recommends that the USPTO expand this exception to allow paper submissions in instances where the submitter attempts an electronic submission before the date of a deadline, but where TEAS is unavailable because of a technical problem. The USPTO generally encourages early submissions to allow time for submitting relevant documents by mail in the event of an unexpected technical problem. However, the first exception does not take into consideration a situation where an applicant or registrant attempts to make an early, timely filing, but is unable to do so because of technical issues with TEAS. In other words, the applicant or registrant should not be required to wait until the day of a deadline to be eligible for the exception.

The Section also recommends extending this exception for TEAS outages to known outages. In this way, paper submissions would be allowed for both types of outage circumstances—unexpected or known—where TEAS is unavailable. The USPTO should consider waiving the requirement for a Petition to the Director in the case of known TEAS outages.

## **II. Mandatory Applicant E-mail**

The Notice proposes to amend § 2.21(a) to require the postal and e-mail addresses for each applicant, and if the applicant is represented by a practitioner, to require the postal and e-mail addresses for the practitioner. This is a change from the current practice, where TEAS-RF and TEAS-PLUS applications require only a practitioner’s e-mail address for an applicant represented by counsel.

The Section is concerned that the additional requirement for an applicant’s e-mail address is unnecessary and will lead to an increase in spam and fraudulent electronic mail to applicants. We understand that the USPTO is actively working to reduce fraudulent mailings sent to trademark applicants by third parties who harvest this information from the USPTO’s public database. The Section is concerned that if the new rule is adopted applicants represented by counsel will be subjected to the same e-mail solicitations, fraud, and spam received by their non-represented counterparts. Therefore, the Section recommends that the USPTO reconsider this requirement.

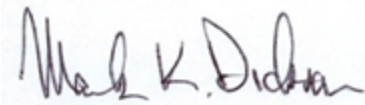
The Section also appreciates and acknowledges that parties have a duty to maintain a current and accurate correspondence address, including an e-mail address. However, provided an attorney or qualified practitioner’s e-mail address is on file with the USPTO,

this should be sufficient to allow the USPTO to communicate electronically with the applicant or registrant.

The Section would be concerned if the USPTO does “not attempt to contact the correspondent by other means” when an email transmission fails. Email addresses frequently change as companies adopt new domain names and as staff turns over. Further, technical issues due to hardware malfunction, software bugs, or malicious cyber-attacks increase the chances for electronic communication to be disrupted. Therefore, the Section strongly encourages the USPTO to continue its practice of attempting to contact the correspondent by other means if the address of record is undeliverable, including physical correspondence by mail. TMEP §§ 403, 717.01 (Oct. 2017).

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

Very truly yours,

A handwritten signature in blue ink that reads "Mark K. Dickson". The signature is written in a cursive, slightly slanted style.

Mark K. Dickson  
Chair, ABA Section of Intellectual Property Law