



## American Intellectual Property Law Association

July 25, 2018

The Honorable Andrei Iancu  
Under Secretary of Commerce for Intellectual Property and  
Director of U.S. Patent and Trademark Office  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451  
Via email: [TMFRNotices@uspto.gov](mailto:TMFRNotices@uspto.gov)

*Attention: Catherine Cain  
Office of the Deputy Commissioner for Trademark Examination Policy*

**Re: Comments on Changes to the Trademark Rules of Practice to Mandate Electronic Filing (Docket No. PTO-T-2017-0004)**

Dear Under Secretary Iancu:

The American Intellectual Property Law Association (AIPLA) is pleased to present its view in response to the notice of proposed rules for Changes to the Trademark Rules of Practice to Mandate Electronic Filing. 83 Fed. Reg. 104 (May 30, 2018).

AIPLA is a national bar association of approximately 13,500 members who are primarily practitioners 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 stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA supports the Trademark Office's efforts to streamline and increase the end-to-end electronic trademark filing program via the electronic filing mandate. AIPLA recognizes the benefits and efficiencies that electronic filing provides, not the least of which is faster prosecution time for pending trademark applications.

Notwithstanding the many benefits of end-to-end electronic trademark filing, we note some concerns that will result from the electronic filing mandate.

- First, AIPLA requests clarification from the Trademark Office concerning access to certain electronic forms if the TEAS system is unavailable because of a technical problem. Such issues inevitably arise on the eve of a filing deadline, when the user needs to complete the filing before the deadline, but the user is unable to meet the deadline because of a technical problem. What types of proof does the USPTO want to receive from a user whose efforts were thwarted by a technical problem? AIPLA

suggests that the Rules be modified to provide specific examples of documentation the user can provide to satisfy the USPTO's proof requirements to demonstrate that TEAS was unavailable for electronic filing because of a "technical problem". For example, the Rule could enumerate the types of the evidence that would be accepted, e.g.:

- i. Screenshots showing the time and date and the error statement encountered by the user; and/or
  - ii. A declaration under 37 CFR §2.20 signed by the user which indicates the steps undertaken by the user to complete the electronic filing process including an indication of the statements displayed on the screen that led to the unsuccessful electronic filing;
- Second, AIPLA has some concerns about the types of forms available on TEAS to satisfy filing situations beyond the electronic forms that are currently available. It is noted that USPTO's existing electronic forms do not address all situations. As an example, in rare instances where a registration is mistakenly canceled, there is no available TEAS form that allows the user to file maintenance documents after the registration is canceled. Thus, the user must file a petition to revive under 37 C.F.R. § 2.146(a)(2) or § 2.146(a)(4) with the maintenance documents attached, along with the required petition fee. Even if the cancellation was the result of Trademark Office error, the user who complies with the petition requirements has no way of knowing whether the Trademark Office will reinstate the registration, or if the petition fee will be reimbursed in recognition of Trademark Office error.

Several examples include complexities around extension request filings, and the Trademark Office's lack of TEAS forms to address one-off or exceptional situations of the types detailed below.

- In one case, a user encountered an Office Action that was issued after an extension request was filed. Though the user filed a timely Response to the Office Action, the Response was not processed before the deadline for filing the next extension request. As a result, the Trademark Office's online filing system would not allow the extension request form to be accessed or filed.
- In another example, an allowed application was assigned to a third-party, but an extension request was filed by prior counsel in the name of the wrong party (former owner/assignor). When the actual owner tried to timely file the extension request in its own name, the Trademark Office's online filing system would not allow it since an extension request had already been filed.
- Related to the above scenario, when the user filed a Petition to request that the extension be accepted in the correct assignee name, the Petition was still pending when the next extension request came due. The Trademark Office's online filing system would not allow the extension request form to be accessed or filed.
- Lastly, in an example involving a 44(d) basis application, the owner did not yet have its home country registration. A final refusal was issued on grounds of the mark's descriptiveness, and the owner elected to file an Allegation of Use

(AOU) and amend the application to the Supplemental Register. However, the application was filed only on a 44(d) basis, and did not include a 1(b) filing basis. As a result, the Allegation of Use form was not available for purposes of filing the AOU. The owner had to first file a request to add the 1(b) basis and wait for the Examiner to review the case before the filing basis could be added.

The foregoing examples are intended to illustrate the variety of circumstances a user encounters, several of which cannot be resolved through readily accessible forms in the current TEAS system. As a possible remedy, AIPLA suggests that a TEAS “Miscellaneous Form” be made available to allow users the opportunity to provide a written explanation and/or supporting evidence of their particular circumstances. A Miscellaneous Form would enable the user to request specific handling of unusual cases for which no form is available on TEAS. Additionally, a Miscellaneous Form could include a request by the user for the USPTO to waive the petition fee, or to indicate that the user believes that no additional fees are due under the circumstances, with a declaration statement that could be electronically signed by the user, e.g.:

I hereby request that the petition fee be waived, as I believe that no additional fees are due under the circumstances. I understand that the Examining Attorney could still, upon later review, require a fee payment.

Subject to the comments and recommended revisions discussed herein, AIPLA otherwise supports the proposed rules presented by the USPTO and their proposed implementation.

AIPLA appreciates the opportunity to provide comments regarding changes to the Trademark Rules of Practice to mandate electronic filing. Please let us know if AIPLA can offer any additional comments or input.

Sincerely,



Myra H. McCormack  
President  
American Intellectual Property Law Association