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

Via email: 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*

Dear Under Secretary Iancu:

The E-Trademarks Listserv ("the Listserv") is an online community with over one thousand members, most of whom are extremely experienced US trademark practitioners. The Listserv thanks the USPTO for the opportunity to submit comments in response to the Notice of Proposed Rulemaking published May 30, 2018 and entitled *Changes to the Trademark Rules of Practice To Mandate Electronic Filing* (83 FR 24701). In this Notice, the USPTO proposes to mandate electronic filing of trademark applications and submissions associated with trademark applications and registrations, and to require the designation of an email address for receiving USPTO correspondence.

This comment is offered by the nineteen persons subscribed below, all being members of the Listserv. The persons subscribed below have between them filed or prosecuted more than twelve thousand trademark applications in the past decade. These persons have between them paid more than $3.8 million to the USPTO in trademark matters in the past decade. These persons have between them represented more than 5700 applicants and registrants to the USPTO in trademark matters in the past decade.

This comment expresses the views of the signatories thereto but these views should not be imputed to individual clients of the signatories.

Mandated electronic filing. The proposed rule would mandate electronic filing of trademark applications and submissions associated with trademark applications and registrations.

In the Notice, the USPTO puts forth the view that:

> [e]nd-to-end electronic processing of all applications, related correspondence, statutorily required registration maintenance submissions, and other submissions will benefit trademark customers and increase the USPTO's administrative efficiency by facilitating electronic file management, optimizing workflow processes, and reducing processing errors.

Perhaps unsurprisingly, given the name of the listserv, the members of the E-Trademarks Listserv nearly always carry out their correspondence with the USPTO regarding trademarks by means of e-filing. In particular, the persons subscribed below nearly always carry out their correspondence with the USPTO regarding trademarks by means of e-filing. Even the most electronically savvy filers, however, find it necessary from time to time to paper-file an item of trademark-related correspondence at the USPTO.

Given that all members of the trademark community benefit from the use of e-filing (and in particular TEAS) when it is possible to do so, it is natural to consider the causes of the paper filings that happen from time to time and to consider what next step might reduce the number of such filings.

The proposed rule seems assume that the causes for paper filings lie outside of the USPTO and that the appropriate next step is to promulgate rules directed to discretionary decisions to paper-file even when TEAS filing could have been used. For the majority of trademark filers, however, the explanation for a paper filing is not that the the filer is making a discretionary decision to paper-file when a TEAS filing could have been used.

For those who routinely carry out nearly all of their trademark-related correspondence by means of e-filing, the causes for the occasional paper filing are the following problems:

- Sometimes TEAS is broken.
- Sometimes a sub-component of TEAS is broken (such as the credit card processing system).
- Sometimes the appropriate TEAS form is unavailable to the filer with respect to a particular application due to some problem with the status of the application in the USPTO's systems.
- Sometimes there is no TEAS form to address a particular filing need.
- Sometimes the TEAS form intended to address a particular filing need is not adequate to fully address the circumstances of the intended e-filing.

This comment points out that rulemaking is not the way to fix these problems. Said differently, these problems will not get fixed by promulgating a rule that mandates electronic filing.

Nonetheless this comment recognizes that there may be some filers who have traditionally carried out filings on paper, and who have not yet learned how to use TEAS or who make discretionary decisions to paper-file even when TEAS filing could have been used. It is noted that the number of such filings by such filers has decreased dramatically in recent years, partly due to fee setting and partly due to the USPTO's very successful outreach efforts to such filers. One expects that the number of such filers will continue to decrease with time, even in the absence of any rulemaking that would mandate e-filing. Simply carrying out further fee increases for paper filing would likely bring about a further decrease in paper filings by such filers. It is recognized, however, that a rulemaking mandating e-filing might prompt some of the relatively small number of such filers to move to TEAS filing. For this reason, this comment does not object to such a rule change, so long as various protective and corrective measures are carried out by the USPTO. Appropriate protective and corrective measures to be carried out by the USPTO will now be discussed.

Sometimes TEAS is broken. It is recalled that between about December 23 and December 28, 2015, the USPTO incurred a complete outage of all of its externally facing e-commerce systems, including TEAS. During that period of several days, it was impossible for any customer to e-file anything at the USPTO. During the years that have passed since this outage, the USPTO has been repeatedly urged to set up a contingency e-filing server that is geographically distant from the main e-filing server, that is connected to the internet by means of a different connection to the Internet backbone, that receives its electric power from a different source, and that processes credit card payments through a different payment gateway. Were the USPTO to set up such a contingency server for trademark filings, this would greatly reduce the need for paper filings. As of the date of this comment, the USPTO has not set up such a contingency server for trademark e-filing.

Were the failure of December 2015 to have been an isolated incident, that might be the end of the matter. But there have been many other times in the years since that outage, during which TEAS has again been broken. Some TEAS outages have lasted a few minutes, and other TEAS outages have persisted for some hours. During such an outage the filer is sometimes forced to carry out a paper filing instead of a TEAS filing.

This comment reminds the USPTO of the suggestion to set up a contingency e-filing server that is geographically distant from the main e-filing server, that is connected to the Internet by means of a different connection to the Internet backbone, that receives its electrical power from a different source, and that processes credit card payments through a different payment gateway. Such a contingency server would greatly reduce the need for filers to carry out paper filings instead of TEAS filings.

As for a paper filing carried out during a time when TEAS is broken, the Notice proposes that such a paper filing be permitted only in conjunction with a Petition filed by the filer. This comment suggests that such a petition requirement is unneeded and burdensome, for the simple reason that the USPTO as a general matter will already know of instances of its e-filing system being broken. In the rare case where TEAS was broken but somehow the USPTO had been unaware of the outage, the USPTO could respond to a paper filing with a request for a showing by the filer as to the nature and time of the outage. To reiterate, in those cases where the USPTO already knows that TEAS was broken, there should be no need for the filer to file a petition.

The Notice proposes that the availability of a paper-filing option should be limited to filings where the date upon which TEAS was broken happened to be a "deadline day" for a particular application. The suggestion seems to be that if, for a particular application, TEAS is broken on a day that is not the last possible day for the intended filing, then the filer should simply wait (perhaps for one or more days) until TEAS is restored to service, and should carry out the filing on that later date.

This comment objects to any requirement that the filer postpone a filing from day to day until such time as a TEAS outage is repaired. There are many reasons why such a requirement is unreasonable. One reason is that sometimes the filer is not even able to know whether a particular day is a "deadline day", because there may be actions of third parties that are unknown to the filer. A third party might commence use in commerce, or might file a competing intent-to-use trademark application. A third party might file a priority application in a foreign country that would later serve as a priority application with respect to a US application. It is not within the ability of the filer to know whether such events have or have not occurred, and so it is not reasonable to ask the filer to make a decision to wait for one or more days to carry out a filing, for no better reason than that TEAS was broken on a particular day. (Such a decision by a practitioner to wait could potentially lead to loss of substantive rights of the client of the practitioner.)

Yet another reason why it is unreasonable to ask a filer to voluntarily postpone a TEAS filing (due to a TEAS outage) is that the signer, available today for e-signing, might turn out to be unavailable tomorrow, whether due to illness or other unexpected events.

The option to resort to paper filing needs to be available on any day, not only on a "deadline day".

Sometimes a sub-component of TEAS is broken (such as the credit card processing system). Even if the filer is able to start a TEAS filing, sometimes the filer is unable to finish the TEAS filing due to failure of some sub-component of TEAS. In such a circumstance, even though in some sense it might be said that TEAS is nominally "available", from a practical point of view it might nonetheless turn out

that TEAS is not really “available”. One example is the processing of credit card payments, but TEAS relies on a number of additional underlying systems, some of which are not even visible to the filer and so cannot be specifically enumerated in this comment.

Using the example of the credit card processing system, were the USPTO to set up a contingency server that makes use of a different credit card processing system, this would reduce the need for paper filings due to the failure of the USPTO's present credit card processing system.

If a contingency server is not provided by the USPTO, then an alternative of a paper filing needs to be available.

Sometimes the appropriate TEAS form is unavailable to the filer with respect to a particular application due to some problem with the status of the application in the USPTO's systems. When a user attempts to file a particular TEAS form with a particular application, the TEAS system looks up the status of the application in the USPTO systems. If the status of the application in the USPTO's systems is in error (as occasionally happens) then this can lead to TEAS refusing to permit the filer to proceed with the filing via TEAS, because of some business processing rule that is coded into the software of TEAS.

As but one example a registration might be incorrectly listed in the USPTO's systems as canceled or an application might be incorrectly listed in the USPTO's systems as abandoned. This could lead to a situation where a Statement of Use or other post-allowance or post-grant filing cannot be made in TEAS and the only option is a paper filing.

A recent example discussed in the Listserv was an application where an Examiner decided that “plus” status had been lost. The filer needed to pay some particular fee (for example adding a class). But it was impossible to pay the correct fee for the additional class in TEAS because the the status actually listed in the USPTO's systems was still “plus” status. In such a case the filer might find that the only option is to paper-file Form 2038 to pay the correct fee.

With the present rules, in such cases the filer is able to overcome this problem by carrying out a paper filing. But were the proposed rule to be put into effect, a paper filing might not be available to overcome this problem. Any rulemaking that would take away the option of paper filing should be linked to provision of a “none of the above” TEAS form, available for use in the (hopefully rare) times when the status of an application is in error in the USPTO's systems in a way that leads to unavailability of the (nominally “correct”) TEAS form or unavailability of the correct fees or other filing content.

Sometimes there is no TEAS form to address a particular filing need. The USPTO is to be commended for its efforts over the years to add TEAS forms, one by one, to address various needs that present themselves in trademark prosecution. Even with those efforts, and even with the present range of TEAS forms that are available, it sometimes turns out that there is no TEAS form to address a particular filing need. The members of the Listserv, and the undersigned persons, are relatively experienced practitioners and are fully familiar with the various present range of TEAS forms, and are able to identify the appropriate TEAS form when it is needed. It nonetheless occasionally turns out that there simply is no TEAS form to address some particular filing need.

Saying this differently, while the USPTO has gradually developed TEAS forms to address a greater and greater percentage of the things that need to be communicated by filers, the percentage is not yet at

100%.

Any rulemaking that would take away the option of paper filing should be linked to provision of a "none of the above" TEAS form, available for use in such situations.

It will be noted that USPTO personnel can then look at the (hopefully relatively small number of) "none of the above" filings and can identify room for improvement in the existing TEAS forms and can identify possible new TEAS forms.

Sometimes the TEAS form intended to address a particular filing need is not adequate to fully address the circumstances of the intended e-filing. One example is the filing of a notice of express abandonment. For purposes of making a record on behalf of the client, the filer will sometimes find the need to enter a statement indicating why the application is being abandoned. The TEAS form does not, however, permit such a statement, and this puts the filer in the position of having to carry out a paper filing instead of a TEAS filing.

This is but one example, but there are many other situations where the TEAS form, as presently designed, fails to provide a way for the filer to communicate what needs to be communicated. As a general matter, if the USPTO were to promulgate a rule denying the option of paper filing, then every TEAS form should be given a "miscellaneous" section in which free-text comments can be provided.

Mandated provision of email address for the applicant. The proposed rule would require that an email address be revealed to the USPTO *for the applicant*, even if the applicant is represented by counsel. It appears the USPTO does not fully appreciate the high volume of scam email and spam email that is received by anyone who reveals an email address to the USPTO. Every trademark practitioner before the USPTO receives large numbers of scam and spam emails at the email address which the practitioner provides to the USPTO.

The trademark practitioner is, to some extent, able to weed through the scam and spam emails and to avoid falling prey to the scams and potential computer virus infections. An applicant, however, may be less sophisticated and experienced with respect to such scam and spam emails, and is much more likely to succumb to a computer virus or to fall prey to a scam, were the proposed rule to be put into force.

The applicant ought not to be forced to reveal its email address to scammers and spammers through the USPTO's systems.

This comment urges in the strongest terms that so long as *some* email address is provided (for example the email address provided by the practitioner) then there ought to be no requirement that the applicant's own email address be revealed to the USPTO (and thus to the public).

The same comment applies *mutatis mutandis* to the applicant's telephone number. It is commonplace for "boiler room" operations to try to sell deceptive services by means of telephone calls, making use of calls to telephone numbers harvested from sources such as the USPTO's trademark databases.

This comment urges that so long as some telephone number is provided (for example the telephone number provided by the practitioner) then there ought to be no requirement that the applicant's own telephone number be revealed to the USPTO (and thus to the public).

Respectfully submitted,

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