**International Trademark Association Comments in Response to:**

**Notice of Proposed Rulemaking Regarding Trademark Fee Adjustment**

PTO-T-2016-0005 – Federal Register Vol. 81, No. 103 on May 27, 2016

The International Trademark Association (INTA) appreciates the opportunity to provide additional comments (beyond those made in November, 2015) in response to the proposal of the United States Patent and Trademark Office (USPTO) to revise the trademark fee schedule. The USPTO Subcommittee of INTA’s Trademark Office Practices Committee prepared the following comments.

**Comments**

INTA again commends the USPTO’s efforts to ensure adequate funding for its operations and reserves. Further, INTA supports the USPTO’s efforts to allocate costs fairly and encourage applicants to use electronic communications in all phases of the application process. According to the USPTO’s data, the fees currently charged for filing on paper do not, in most cases, cover its costs of processing paper filings. It is appropriate to discontinue, or at least reduce, the subsidies that paper filers currently enjoy.

However, situations in which electronic filing is not possible remain (for example, submission of evidence or specimens in video format, or when the USPTO’s electronic system is down) and stakeholders should not be penalized for failing to file electronically in those situations. For this reason, INTA supports the USPTO’s proposal to retain the option to file on paper and encourages the USPTO to consider adopting a mechanism to request a waiver of the fee surcharge for filing on paper under such circumstances.

Specifically, when the ability to make a timely electronic filing through TEAS is unavailable because the system is offline or otherwise not functioning properly, individual filers, practitioners, and their clients are already financially penalized and inconvenienced because of the additional work created by having to prepare and submit a paper filing. In this situation, the payment of additional paper-filing fees and the need for filing a Petition to the Director for reimbursement of such additional fees causes significant additional hardship. Accordingly, INTA proposes that the increased fees for paper filing be waived without the need for filing a separate Petition to the Director any time the TEAS system is offline or otherwise unavailable at the location of the filer, either (a) for a period of at least two hours between the hours of 9:00 am and 5:00 pm, or (b) after 4:00 pm for any length of time.

In addition, INTA appreciates the reasoning behind the USPTO’s proposal for a tiered fee structure for filing requests for extensions of time to oppose published trademark applications. However, INTA respectfully asserts that the currently proposed fee structure may actually incentivize potential opposers to file *more* initial 30 day requests for an extension followed by a request for an additional 60 day extension of time when they would have otherwise simply filed a single initial request for a 90 day extension of time with cause. In other words, the proposal could create more piecemeal requests for extensions thereby adding to the USPTO’s processing costs. INTA proposes that any *initial* request(s) for extension(s) of time to oppose (up to 90 days) be free and that any *subsequent* request for an extension of time to oppose (for good cause or with consent) incur a fee of $100 for an electronic filing and $200 for a paper filing.

**Conclusion**

In conclusion, INTA supports the USPTO’s goal of amending trademark fees to encourage increased end-to-end electronic communication, more closely reflect the USPTO’s actual processing costs and ensure the integrity of the register, but with the two proposed modifications outlined above. INTA looks forward to discussing this important proposal further with the USPTO and invites the USPTO to contact Deborah Cohn, Senior Director of Government Relations, at dcohn@inta.org with any questions about this submission.