

October 22, 2012

The Honorable Deborah S. Cohn
Commissioner for Trademarks
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: (TMFRNotices@uspto.gov)

Re: Comments in response to the USPTO's Notice of Inquiry Regarding Adjustment of Fees for Trademark Applications, 77 Fed. Reg. 49426 (August 16, 2012), and Extension of Time, 77 Fed. Reg. 58097 (September 19, 2012)

Dear Commissioner Cohn:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the United States Patent and Trademark Office ("Office") Notice of Inquiry Regarding Adjustment of Fees for Trademark Application, as published in the August 16, 2012 issue of the *Federal Register*, 77 Fed. Reg. 49426 ("Notice"), and Extension of Time as published in the September 19, 2012 issue of the *Federal Register*, 77 Fed. Reg. 58097.

AIPLA is a national bar association with approximately 14,000 members who are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA supports the Office's efforts to use fee incentives to induce applicants to submit all filings and communications electronically with the Office. AIPLA also agrees that it is appropriate for the Office to charge higher fees for paper filings, which take more time and resources to process. AIPLA responds as follows to the specific questions set forth in the Notice:

1. What fee amounts would you consider reasonable for the three existing methods of filing.

While AIPLA agrees with the goal of incentivizing applicants to file everything electronically, there may be situations in which a paper filing is required. Accordingly, AIPLA believes that the additional fees for filing on paper versus using TEAS or TEAS Plus should not exceed the increased cost to the Office for processing paper filings.

The Federal Register Notice states that the cost for processing paper filings is “significantly higher” than for electronic filings, but it does not provide any actual data on that cost differential. Without such data, AIPLA cannot recommend a specific fee increase for paper filings relative to electronic filings. However, any such increase should not exceed the actual difference in handling costs experienced by the Office.

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

See response to (1) above.

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 communications and agree to file all responses and other documents electronically during the prosecution of a trademark application?

AIPLA believes that most of its members file applications and subsequent documents through TEAS, and that those users would have no objection to authorizing email communications and committing to make all future filings electronically through TEAS.

4. If the TEAS Plus fee was reduced and remained the lowest fee, and the discount TEAS option were also offered, would you be more likely to choose TEAS Plus as the lowest fee or select the less burdensome TEAS option?

A further discounted TEAS Plus fee will do little to incentivize users to file through TEAS Plus as opposed to TEAS. Users very often choose to file applications through TEAS over TEAS Plus, because TEAS Plus mandates use of the ID Manual, which often does not contain appropriate or accurate identifications to cover an applicant’s goods/services. As a result, applicants often disregard the ID Manual and prepare a specific identification of goods/services, which then requires them to file through TEAS. Further, applicants are not always certain which or how many classes are covered by their specified identification of goods/services. As a result, any discount offered for TEAS Plus filings over TEAS filings likely will not encourage users to switch to TEAS Plus in such cases.

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?

AIPLA believes that most of its members file applications through TEAS. For those few users that file the initial application on paper, a significantly higher filing fee may discourage such filings. It is perhaps more common for users to file subsequent papers and Office Action responses on paper, and an increased application fee will not have any

impact on those subsequent filings. The Office could consider imposing filing fees for subsequent responses filed on paper to encourage the electronic filing of such documents.

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?

In addition to the above comments, the Office should consider additional incentives for electronic filing through TEAS and TEAS Plus. For example, the Office could consider offering specific, expedited prosecution tracks for those parties choosing to file initial applications and subsequent filings through TEAS and TEAS Plus. The Office may also consider adding a fourth reduced fee option for applicants who commit to filing all papers through TEAS, provided they can opt out of the ID Manual requirement.

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AIPLA appreciates the opportunity to comment on this important Notice. Please contact us if you would like us to provide more details on any issue discussed above.

Sincerely,



William G. Barber
President
American Intellectual Property Law Association