



**AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION**  
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April 29, 2008

Lynne G. Beresford  
Commissioner for Trademarks,  
P.O. Box 1451  
Alexandria, VA 22313-1451

Attn : Mary Hannon

Re: Comments on Proposed Rule: “Changes in Rules Regarding Filing Trademark Correspondence by Express Mail or Under a Certificate of Mailing or Transmission” 73 Federal Register 11079 (February 29, 2008)

Dear Commissioner Beresford:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments regarding the U.S. Patent and Trademark Office (PTO) proposed changes to restrict the use of certificates of mailing for specified documents for which an electronic form is available in the Trademark Electronic Application System (“TEAS”).

AIPLA is a national bar association whose more than 17,000 members 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.

## **INTRODUCTION**

The proposed changes to the rules would amend 37 CFR 2.197 and 37 CFR 2.198 to make the "Certificate of Mailing", "Certificate of Express Mailing" and "Certificate of Facsimile Transmission" procedure inapplicable for certain specified documents for which a Trademark Electronic Application System (“TEAS”) form is available.

The certificate of mailing, certificate of transmission, and Express mail procedures (hereinafter, all referred to as “Cert. of Mailing”) were created to respond to public concern about the loss of filing dates due to mail delays or loss of documents within the Office. Notice at 11080. The Cert. of Mailing procedure provides that correspondence is considered to be timely filed even if received after the due date, if the correspondence was: (1) deposited with the USPS as first class mail or transmitted to the PTO by facsimile transmission on or before the due date; and (2)

accompanied by a certificate attesting to the date of deposit or transmission. A corresponding provision provides a similar procedure for correspondence deposited with the United States Postal Service as "Express Mail." Trademark Rules 2.197-98.

The Notice states that the Cert. of Mailing procedures “are no longer necessary because electronic filing provides a better alternative” and lists the following advantages of electronic filing:

- electronic filing is available 24/7
- electronic filing assures filers that the Office actually received the document submitted by providing users with a “Success” page and an email confirming receipt,
- documents filed electronically are unlikely to be lost or misplaced within the Office,
- electronic filing reduces data entry errors resulting in an improvement in quality and accuracy of information available to the public in Office databases,
- electronic filing permits faster processing, reduces pendency, and enables the Office to provide a higher level of customer service,
- electronic filing provides a level of consistency, accuracy and predictability that a paper-based process cannot.

Notice at 11080.

The Notice states that, in the “rare situations” when TEAS is unavailable, “mechanisms are in place to obtain a filing date as of the date of the attempted filing”, observing that the filer may provide evidence that filing was attempted through TEAS but TEAS was unavailable due to technical problems. Computer screen printouts showing receipt of an error message or a copy of an e-mail from the TEAS Help Desk stating that TEAS was unavailable are cited as appropriate evidence. Notice at 11080.

The proposed rule would apply to the following filings:

- Applications for the registration of marks
- Amendments to allege use under section 1(c) of the Act<sup>1</sup>
- Statements of use under section 1(d) of the Act
- Requests for extension of time to file a statement of use under section 1(d) of the Act
- Preliminary amendments
- Responses to examining attorneys' Office actions
- Requests for reconsideration after final action
- Responses to suspension inquiries or letters of suspension
- Petitions to revive abandoned applications under §2.66
- Requests for express abandonment of applications
- Affidavits or declarations of use under section 8 of the Act

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<sup>1</sup> The Notice states that the Express Mail filing procedure was removed from the Amendments to Allege Use, Statements of Use, and Requests for Extensions of Time to file a Statement of Use form in 2002. While true, these filings can still rely on the certificate of mailing procedure. The explanation provided is therefore misleading insofar as it implies that filing through TEAS is already mandated for these filings in order to confirm filing date certainty.

- Renewal applications under section 9 of the Act
- Affidavits or declarations of incontestability under section 15 of the Act
- Requests for amendment of registrations under section 7(e) of the Act
- Requests for correction of applicants' mistakes under section 7(h) of the Act
- Appointments or revocations of attorney or domestic representative
- Notices of withdrawal of attorney
- Requests to change or correct addresses

## **GENERAL COMMENTS**

Generally speaking, AIPLA agrees with the benefits of electronic filing cited in the Notice. Many applicants, registrants and practitioners use the USPTO's TEAS system for electronic filings. However, the fact that electronic filing has many benefits does not mean that the Cert. of Mailing procedure is no longer necessary. For the reasons explained below, we believe it is premature at this time to restrict the use of the Cert. of Mailing procedure as proposed.

Applicants, registrants and practitioners who regularly use TEAS still find occasion when they must rely on paper filings. There are two reasons: (1) it is not always able to use a TEAS form to make a necessary filing because it is inadequate or inefficient for the purpose, or because it requires the input of inaccurate or incorrect information in order to get the form to "work"; and, (2) users experience technical difficulties with the TEAS system, whether resulting from problems on the Office's side or their side. Thus, the fact that a form is available on TEAS does not necessarily mean that electronic filing provides a better alternative. Eliminating the valuable back-up procedure afforded by the Cert. of Mailing procedure for paper filings would require applicants to: (a) use TEAS even when it is not appropriate for the filing, and then engage in post-filing faxes or telephone conversations with the relevant individuals at the PTO to explain or "fix" the filing; (b) file paper documents earlier, and then check the PTO online status system to ensure that the document was received by the USPTO before the deadline; or, (c) engage Washington-based firms to hand-deliver documents to ensure that they are timely received by the USPTO.

## **SPECIFIC COMMENTS**

### TEAS Is Not Reliably Available

The Notice states that TEAS is unavailable due to technical problems in "rare situations." It is the experience of AIPLA members that the system's unavailability, at least during regular business hours in the United States, is far more frequent than the use of the word "rare" would imply.

Members occasionally experience delayed receipt of confirmations, sometimes as much as a day late. There have been occasions when unannounced maintenance downtime has affected the ability to file, but with no corresponding explanation as to why the system was down to use as evidence. These occurrences, and the contemplated need for TEAS Help Desk messages to serve as evidence of the system's unavailability, raise questions as to whether the USPTO Help Desk is equipped to handle a significant increase in inquiry traffic, especially where the rule changes now may make substantive rights dependent on action taken by the Help Desk.

Before adopting the proposed rule change, the Office should provide additional means for demonstrating that TEAS was not available than the two types of evidence cited in the Notice: a computer screen printout showing receipt of a ‘Fatal Error—Access Denied’ error message, or a copy of an email message from the TEAS Help Desk stating that the TEAS forms were temporarily unavailable.”

#### Proposed Changes Do Not Address Non-TEAS Related System Failures/Malfunctions

The proposed rule does not provide any exception for non-TEAS-form-related technical malfunctions, or customer computer or Internet problems. An applicant, registrant or practitioner who experiences an Internet accessibility problem or internal network failure, or even a loss of electricity for a significant period of time<sup>2</sup>, is just as unable to use the TEAS forms as if the TEAS forms were not available, but the Notice contemplates no relief or recourse in such situations. Further, difficulties have been experienced uploading especially large attachments for no apparent or obvious reason. Again, before the proposed rule change is adopted, it should address such situations and provide a practical means for users to submit evidence demonstrating why the paper filing was necessary.

#### TEAS Forms Are Not Always Adequate To Handle Common Contingencies

U.S. trademark registration practice involves complex procedures and governing rules. TEAS forms do not and perhaps cannot cover every contingency or eventuality that can be presented in a filing. The Office should be lauded for being responsive to user feedback about ways in which TEAS forms are deficient. Unfortunately, though, efforts to revise the TEAS forms to address every filing eventuality have made them increasingly complex and difficult to navigate. Changes and “improvements” frequently introduce new glitches or unexpected consequences.

Existing forms lack sufficient flexibility to encompass all permissible changes and amendments, or to properly characterize these. The following examples are illustrative:

- Deleting goods from an application upon filing a Statement of Use, or at the time of filing a Section 8 Declaration of use, requires the applicant or registrant to check a box stating that the goods “are not in use”, when this may not be the case. (That is, the mark could be in use for these goods, but for other reasons, the applicant/registrant opts not to include the goods in the filing.)
- When deleting one class and adding two other classes, the fee for only one additional class is required, but the system will not allow the form to “validate” unless the fees for two classes are paid.
- When seeking to divide an application during the Notice of Allowance period, the Request to Divide must be filed simultaneously with the Statement of Use,

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<sup>2</sup> While the USPTO has a procedure for excusing late filings made through the United States Postal Service due to natural disasters and similar emergencies (see [http://www.uspto.gov/emergencyalerts/index\\_emergency.html](http://www.uspto.gov/emergencyalerts/index_emergency.html)), it does not usually make those determinations or post those notices on the day that the emergency occurs, leaving filers unsure as to whether their situation will qualify. See, e.g., Northeast power outage of August 14, 2003 (notice posted on August 19, 2003): <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/uspsoutage.htm>.

but there is no TEAS form for filing the Request to Divide. Thus, the practical effect is that most practitioners opt to submit both forms, as well as the accompanying and requisite Extension Request, on paper.

- The address field in the application form is only 40 characters long. This is insufficient for some addresses, especially those of some foreign applicants.

Retaining the Certificate of Mailing procedures until these deficiencies are addressed would ensure that filers have an effective means to submit accurate information.

#### TEAS Not Amenable To Certain Filings

Office action responses frequently include evidence, specimens, and other graphical materials which can be quite extensive. These bulky filings are often difficult to accomplish through TEAS, or end up distorted or lacking in visual clarity. Moreover, TEAS does not permit printouts of the materials that filers load onto the USPTO system, and preview windows can be distorted and not permit adequate review. These resolution and display problems are often not detected until a further objection or refusal from the examining attorney is received. Paper filing allows the filer to control the display, format and organization of filings, ensuring that they are clearer, more complete, and less subject to distortion by digitization or other intervening electronic media. Again, we ask that the possibility of utilizing paper submissions not be eliminated until these difficulties of using TEAS are corrected.

#### Inadequate Justification

The justification for the proposed rule fails to explain why the USPTO needs to eliminate the Cert. of Mailing procedure at this time. The stated goals of the proposed rules, e.g., increased efficiency and streamlined processing, are well-known and existing advantages of TEAS filings. However, the benefits of TEAS are not an adequate justification for eliminating the Cert. of Mailing procedure while there remain valid reasons for using such procedures that even regular TEAS filers occasionally utilize. While eliminating the Cert. of Mailing procedure may benefit the Office, it would not serve the legitimate needs of trademark applicants and registrants.

#### Other Incentives For On-Line Filing Should Be Considered.

AIPLA recognizes that processing paper filings can be more costly than processing electronic filings. We would suggest exploring other means to incentivize on-line filing short of eliminating mail and fax certification procedures. For example, eliminating the deficiencies of using TEAS noted above would be helpful. Once these problems are addressed, consideration might be given to imposing a reasonable additional fee to reflect the added costs of processing paper submissions, as is presently done with newly filed applications.

#### Mechanisms To Obtain a Filing Date When TEAS Unavailable

Although the comments accompanying the proposed rule change state that a mechanism is in place to obtain a filing date when TEAS is unavailable, the sections of the Trademark Manual of Examining Procedure (“TMEP”) cited do not provide such a mechanism. Cited TMEP Section

1711 relates to instances where an “application is denied a filing date”, and does not relate to deadlines that arise after the application is filed. The other cited sections, TMEP Sections 1712.01-02, deal with reinstatement of abandoned applications or cancelled registrations that resulted from Office error. These sections do not identify unavailability of TEAS or error in TEAS transmission as a ground for reinstatement. We would urge that appropriate revisions be made to the TMEP to better reflect the comments.

## CONCLUSION

AIPLA appreciates the opportunity afforded to comment on the above referenced rule change proposal. We would be pleased to work with the Office to devise solutions to the problems identified.

Sincerely,

A handwritten signature in black ink that reads "Michael K. Kirk". The signature is written in a cursive, flowing style.

Michael K. Kirk  
Executive Director  
AIPLA