

Date: April 29, 2008  
To: Commissioner of Trademarks  
From: Fross Zelnick Lehrman & Zissu, P.C.  
Submitted Via: [TMMailingrules@uspto.gov](mailto:TMMailingrules@uspto.gov)

Attn: Mary Hannon

**Re: Notice of Proposed Rule and Request for Comments Concerning Certificate of Mail Procedures Reported at 11079 Federal Register, Vol. 73, No. 41 (February 29, 2008)**

These are the comments of Fross Zelnick Lehrman & Zissu, P.C., a New York-based law firm that practices extensively in the field of trademark law and before the USPTO, concerning the proposed new rules to amend Trademark Rules 2.197 and 2.198 to exclude certain specified filings in trademark applications for which corresponding electronic forms are available in TEAS from Express Mail, certificate of mailing and certificate of facsimile transmittal filing procedures. *See* 11079 Federal Register, Vol. 73, No. 41 (February 29, 2008) (copy attached).

These procedures (hereafter referred to collectively as “Certificate of Mail Procedures”) credit the filing of certain trademark documents as of the date of deposit with the U.S. Postal Service or of fax transmission to the USPTO. Certificate of Mail Procedures apply to numerous time-sensitive trademark filings, including responses to examining attorney office actions, statements of use, amendments to allege use, requests for reconsideration, requests for extension of time to file a statement of use, requests for reinstatement, petitions to revive, Section 8 affidavits, and many other necessary filings submitted in trademark applications and registrations. Used and relied upon extensively by applicants, registrants and practitioners for decades, the Certificate of Mail Procedures provide a highly reliable, efficient and convenient means of ensuring timely filing to meet outstanding deadlines.

We strongly oppose the proposed rules. They are unnecessary and have no apparent or even claimed benefit for applicants, registrants and practitioners. Instead of a step forward to embrace developing technologies, this change would be a step backward which coerces reliance on TEAS, which is not yet as flexible as paper filings.

The proposed rules provide no explanation or description of why the USPTO feels this drastic step is necessary or why the Certificate of Mail Procedures cannot be maintained along with TEAS filings. Indeed, the patent side is unaffected by this proposed rule change and will continue to accept paper filings, and the USPTO will continue to handle a very large volume of mail and fax correspondence. Clearly, there are no benefits to filers in removing procedures that guarantee filing date certainty in paper filings, especially where TEAS is not adequate or the best option to meet filing needs and ensure accuracy in the USPTO’s databases.

The proposed rules, therefore, are unnecessary and represent a solution in search of a problem. Removing mechanisms to provide filing date certainty for paper filings will unduly burden and inconvenience filers by taking away a valuable customer service. Making the Certificate of Mail Procedures unavailable simply in order to promote on-line filing is misplaced.

Instead of considering the customer service benefit afforded by Certificate of Mail Procedures, the USPTO instead states they are “no longer necessary” as TEAS offers a better alternative. We submit that this determination is best left to those who utilize the TEAS system, namely applicants, registrants and practitioners. Where possible, this firm has increasingly sought to file trademark correspondence with the USPTO on-line through TEAS and will continue doing so. In some instances, TEAS does provide a better alternative to filing on paper. However, as a large-volume filer, we routinely encounter numerous circumstances in which TEAS does not offer a better alternative to filing on paper. Examples of these circumstances are set forth below. In some cases, TEAS cannot be made to fit a particular type of filing, even though a “form” is available. Thus, we strongly disagree with the USPTO’s contention that the Certificate of Mail Procedures are no longer necessary.

We have documented numerous instances where TEAS forms proved inadequate. These include:

- 1) The inability to file a divisional request through TEAS where called for in a statement of use or allegation of use filing;
- 2) Not being able to print out uploaded versions of evidence, specimens or other attachments being submitted through TEAS.
- 3) When deleting the ITU portion of a dual-basis class following issuance of the Notice of Allowance, the TEAS form still calculates the extension fee due for that class.
- 4) Deleting one class from an application and adding two classes requires two fees to be paid, rather than applying the fee paid for the deleted class to the new class.
- 5) Forms only provide room for one “additional statement”; multiple statements in this field cannot be separated, such as by hard returns. In addition, these statements are frequently overlooked.
- 6) PDF's for specimens often do not upload correctly.
- 7) Reviving an application abandoned during the post-Notice of Allowance stage requires that both a Petition to Revive and a Request for an Extension of Time to file Statement of Use be filed simultaneously. These are two different documents making two different types of statements. However, the TEAS form provides a space for only one individual to sign both forms, even though it may be more appropriate for a

practitioner to sign the petition to revive, but the applicant to sign the extension request with its accompanying declaration of a continuing bona fide intent.

8) Sometimes having more than one Internet browser window open with more than one TEAS form in process at the same time causes data from one form to migrate to the other. This poses a severe limitation for a high volume law practice like ours.

9) Filing a response through TEAS to a priority action issued after a final action is not possible.

10) In order to delete classes/goods in Section 8 filings, the registrant must check a box saying that the mark is not in use, when this may not be the case.

11) Joint applicants in application/registration generate two signature fields and require both fields to be completed, even though only one signature is required (as with a renewal).

12) Substitute drawings of marks are better filed on paper since digitization distorts them and resolution discrepancies create "color" tints where no color exists.

13) Some information entered into TEAS does not show up when form is forwarded to applicant for signature, e.g., selection of the box that mark is in standard characters.

14) It is not possible to allege both use and excusable non-use in the alternative in a Section 8 TEAS form.

15) Long addresses for applicants can be too long for the address field in TEAS. Moreover, international addresses that do not conform to U.S. formats are often truncated or presented improperly. (At this time, the USPTO's suggested workaround is to submit the proper and complete address on paper).

16) Changing basis to add 44(e) and delete 1(b) is not possible through TEAS where the application is not suspended or suspended on different grounds (need to request removal from suspension).

17) When some goods are filed on the basis of use in commerce and other goods are filed on the basis of 44(d) or (e), the TEAS filing causes the USPTO frequently to misstate the goods under the appropriate basis.

Perhaps the majority of filings submitted through TEAS do not encounter these types of problems. But the proposed rules are directed to making TEAS not just the preponderant filing method, but *the exclusive* method of filing with filing date certainty. Any shortcomings of the TEAS system like those described above would compel filers, having no other recourse, to give up filing date certainty and rely on the vagaries of the

U.S. Postal Service, or, where a deadline is looming, arrange for a Washington firm to hand-carry the filing to the PTO.

It is clear from the above that the proposed rules would adversely impact large-volume filers, such as our firm, as well as large-volume corporate filers, who frequently encounter difficult and complex filing issues that do not fit readily into the TEAS forms. In other words, the proposed rules would needlessly inconvenience the USPTO's largest customers. Moreover, the resulting pressure on the USPTO to promptly and continually update the TEAS forms and system will be far greater where *TEAS is intended to be the only filing media providing filing date certainty.*

The proposed rules also discriminate against non-Washington-based filers, who do not have the option to hand-deliver documents in order to receive a same-day filing stamp.

A back-up system of paper filing certainty such as the Certificate of Mail Procedures provide an additional level of customer service that ensures filing date certainty where paper filings prove necessary or more efficient. Customer satisfaction and USPTO efficiency are both enhanced by maintaining Certificate of Mail Procedures alongside TEAS filing availability.

At the very least, giving up the certainty and flexibility afforded by the paper filing Certificate of Mailing Procedures removes a valuable back-up filing procedure that can be employed when on-line systems are down, or otherwise malfunction (whether this occurs on the server or user ends).

The Notice's proposal that paper filing via the Certificate of Mailing Procedures would be permitted when TEAS is down, if evidenced by TEAS service announcements, error messages, and help desk correspondence, is an inadequate and incomplete measure. This type of limited "fallback" position is insufficient because (1) problems other than those producing this type of "excuse" can prevent a successful TEAS filing (such as problems with uploading PDF attachments), and (2) user problems with accessing the system (such as temporary lack of access to the Internet, loss of electricity, or internal computer network problems) can render TEAS just as unavailable as if the system was down, but would not qualify for this exception. In addition, it wastes time if, for example, someone in our firm reports that the system is down; everyone having a filing would still have to go through the time-consuming entry process to get to the end and have the "error" statement issue to secure the date for a paper filing.

The explanation accompanying the proposed rule change states that situations where TEAS is unavailable due to technical problems are "rare." Rarity of system outages is a relative concept. Our firm would not characterize their frequency as "rare." Over a three-month span, between September and November of 2007, we encountered interruptions in service on at least six occasions. With respect to interruptions that are not for scheduled maintenance, the outages usually do not last for more than a few hours at a time, but they are persistent. Since there is no consistent procedure for notifying

people who attempted a filing during the outage period that the system is back up, users must simply keep re-trying the filing. This causes problems in a busy practice like ours, where assistants working for numerous attorneys have numerous documents to prepare and file every day.

For all these reasons, we urge the USPTO to withdraw the proposed rule change.

Our firm appreciates the opportunity afforded to comment on the above-referenced rule change proposal.