



**COMMENTS OF THE INTERNATIONAL TRADEMARK ASSOCIATION'S  
 USPTO SUBCOMMITTEE ON THE USPTO'S NOTICE OF  
 PROPOSED RULEMAKING DATED FEBRUARY 29, 2008**

The USPTO Subcommittee hereby responds on behalf of the International Trademark Association ("INTA") to the United States Patent and Trademark Office's ("USPTO") February 29, 2008 Notice of Proposed Rulemaking entitled "Changes in Rules Regarding Filing Trademark Correspondence by Express Mail or Under a Certificate of Mailing or Transmission."

**A. The Proposal**

The USPTO proposes that the express mail and certificate of mailing or transmission procedures no longer apply to documents for which specific Trademark Electronic Application Systems ("TEAS") forms are available. Specifically, the USPTO proposes to amend the Trademark Rules of Practice to provide that certificate of mailing or transmission procedures and/or express mail no longer apply to the following forms set forth in the chart below for clarity and ease in reading:

FORM	PROPOSED EXCLUSION FROM EXPRESS MAIL	PROPOSED EXCLUSION FROM CERTIFICATE OF MAILING/TRANSMISSION
(1) preliminary amendments	Yes	Yes
(2) office action responses	Yes	Yes
(3) requests for reconsideration after final action	Yes	Yes
(4) responses to suspension inquiries or letters of suspension	Yes	Yes
(5) petitions to revive abandoned applications under 37 C.F.R. 2.66	Yes	Yes
(6) requests for express abandonment	Yes	Yes
(7) section 15 declarations/affidavits	Yes	Yes

(8) requests for amendment under Section 7(e)	Yes	Yes
(9) requests for correction of applicant's mistakes under section 7(h)	Yes	Yes
(10) certain Madrid correspondence	Yes	Does not currently apply.
(11) appointments or revocations of attorney or domestic representatives	Yes	Yes
(12) notices of withdrawal of attorney	Yes	Yes
(13) requests to change or correct addresses	Does not currently apply.	Yes
(14) international applications	Yes	Does not currently apply.
(15) applications for registrations of marks	Does not currently apply.	Does not currently apply.
(16) amendments to allege use	Does not currently apply.	Yes
(17) statements of use	Does not currently apply.	Yes
(18) requests for extensions of time to file statements of use	Does not currently apply.	Yes
(19) Affidavits or declarations of use under Section 8	Does not currently apply.	Yes
(20) Renewal applications under section 9	Does not currently apply.	Yes

## **B. INTA'S Response**

INTA supports the USPTO's ongoing goal of increasing electronic filings. INTA agrees that the proposed rule change will promote increased electronic filing and will therefore likely improve the quality and integrity of critical data in the Office's automated systems.

INTA supports the proposed rule change affecting all the proposed forms except for large filings and special form drawings which still face technological challenges under the current TEAS system. For those categories of filings, INTA has concerns that the proposed rule change will reduce trademark practitioners' and *pro se* Applicants' filing flexibility by increasing the filer's financial burden and/or effectively shortening the deadlines for non-Washington, D.C. applicants/ attorneys. An undesirable adverse effect of this rule may also be the inhibition of evidentiary submissions accompanying office action responses or requests for reconsideration. The Subcommittee requests that the new rules address and offer solutions for these potentially adverse effects on applicants/attorneys.

### **(1) The Technological Limitations of TEAS Unduly Burden Applicants**

The new rules place an undue burden on applicants and their attorneys as they relate to:

- (a) filings that contain supporting evidence or multiple attachments such as office action responses and/or requests for reconsideration and
- (b) amendments to special form drawings.

The current limitations of TEAS do not permit the system to accept any document exceeding three megabytes. This technological limitation makes it difficult to attach large documents, multiple pages or special form drawings.

While one can overcome the three megabyte limitation by dividing attachments into three megabit or less groups, such an exercise can take a significant amount of time resulting in increased legal fees and/or costs for the applicant. Furthermore, it is not currently possible to insert images within the text of an argument such as side-by-side comparison of marks. Whether technologically or time prohibitive, in these situations, applicants/attorneys find it preferable to file these documents on paper. The proposed rulemaking effectively forces applicants with large filings who do not reside in the Washington, D.C. area to file (a) a week or two early if using the US Postal Service; (b) at least a day early if they are willing to incur the cost of an overnight courier to ensure timely delivery; or (c) to utilize the certificate of facsimile provision under 37 C.F.R. §2.195(c) which will likely result in a significant increase in faxes received by the USPTO.

### **(2) Elimination of These Mailing Options Would Result in a Disparate Impact on Non-Washington, D.C. Area Applicants/Practitioners**

In addition to the purpose stated in the Notice, a beneficial effect of the certificate of mailing provision is to equalize applicants/attorneys who work throughout the country and those in the Washington, DC area by affording filing dates to correspondence when placed in

the U.S. Mail rather than by actual receipt at the USPTO. In short, the nearest U.S. mailbox has long been the equivalent of the front door of the USPTO to applicants/attorneys in areas outside of Washington, D.C. By eliminating the certificate of mailing/express mail procedure as an option when electronic filing is not preferable, non-Washington area applicants/attorneys will experience a disparate impact compared to applicants/attorneys in the Washington, D.C. area. For applicants/attorneys outside of Washington, D.C., the elimination of a certificate of mailing procedure effectively shortens the response time to an office action by at least one week and possibly two weeks or requires the added expense of using a courier service.

### **(3) Recommendations**

Before implementing the proposed rule changes, INTA recommends the USPTO consider the following:

- Increasing size of attachments to TEAS forms from three megabytes to a higher number to allow for bulky documents to be attached as one document or explore other means to submit large attachments to the USPTO server such as how the USPTO issues Office Actions;
- Increasing the size of special form drawings or explore other means to submit large special form drawings to the USPTO server;
- Allowing continued use of express mail/certificate of mailing for office action responses, requests for reconsideration and special form drawings; and
- Clarifying that 37 C.F.R. §2.195(c) will remain available to applicants/attorneys who wish to use it.

Implementing the above recommendations will address the major issues resulting from eliminating the express mail/certificate of mailing procedures.

### **C. Conclusion**

INTA's USPTO Subcommittee appreciates the opportunity to submit its comments on the proposed rule change with regard to changes in rules regarding filing trademark correspondence by express mail or under a certificate of mailing or transmission, and looks forward to participating in any further discussion on this issue. Should the USPTO have any questions or comments concerning INTA's response or desire testimony or further information, please contact Michelle Sara King at [mking@inta.org](mailto:mking@inta.org) or 202-223-0989.