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April 29, 2008

Commissioner for Trademarks
P.O. Box 1451 Alexandria, VA 22313 – 1451
Attention: Mary Hannon
Emailed to: TMMailingRules@uspto.gov

RE: Comments on Proposed Rule entitled Changes in Rules Regarding Filing Trademark Correspondence by Express Mail or Under a Certificate of Mailing or Transmission
Walker Digital Management, LLC hereby submits comments on Notice of Proposed Rulemaking, Federal Register Vol. 73, No. 41, February 29, 2008, in particular regarding the proposed amendments to 37 C.F.R. parts 2 and 7.

General Comment:

The proposed changes to rule 2.197 seem overly aggressive concerning promoting the electronic filing of documents. While it is readily ascertainable why the Trademark Office desires to encourage electronic filing, the Trademark Office provides no reason to discontinue or discourage the practice of filing certain documents in a paper format. It seems unnecessarily restrictive to discontinue a practice that has worked for many years just to force people to use a newer style of submission. Before concluding our submission, we offer an alternative approach that may be more palatable to the Trademark Office and its customers.

Specific Objection to Eliminating the Express Mail Provisions for Responses to Examining Attorneys' Office Actions:

The unique nature of each response to an Office Action precludes cookie cutter electronic submission options and, accordingly, provides a reason to continue to allow responses to Examining Attorneys' Office Actions to be submitted under the current Express Mail or Certificate of Transmission standards.

In our experience, Office Actions raise myriad types of issues, each of which may require a different approach in preparing a response. Frequently, an Applicant may be required to submit evidence from disparate sources to rebut a prima facie showing made by the Office Action. While great strides have been made in allowing submission of jpegs and pdfs of various pieces of evidence, there are times when the volume of such evidence precludes easy electronic submission. For example, when proving that a prior registration is dilute and therefore entitled to little protection under the DuPont test, an Applicant may submit large quantities of photographs, advertisements, registrations, and the like to show that the mark is used by many parties. Likewise, survey evidence can be rather voluminous with numerous exhibits when showing that there is no actual confusion and little likelihood of confusion between an Applicant's proposed mark and a registered mark. These sorts of documents do not lend themselves to electronic submission.

In a preemptive response to the charge that such paper submissions may still be submitted, albeit at an earlier time so as to insure a timely submission, we offer the following counterpoint. In many instances, the evidence that is poorly suited for electronic submission is gathered throughout the six month period for reply and submitted on or immediately prior to the six month date. Attorneys wrestle with their clients trying to get the client to submit materials to the attorney in a timely fashion, but

even the best client may wait until the last minute to provide documents or other evidence. Reformatting late submissions from clients into a format suitable for electronic submission to meet a deadline rather than mailing the submission and relying on a certificate of mailing will impose additional costs on Applicants. This burden does not seem justified in light of the stated goals set forth in the Notice of Proposed Rulemaking. Furthermore, the proposed rule puts an Applicant that chooses to file via paper at a relative disadvantage compared to an electronically filing Applicant. That is, the Applicant that relies on paper is effectively deprived of several days in which the response need be submitted. Since both Applicants have paid the same fee, both Applicants should be entitled to the same service. This bifurcated treatment is not warranted merely to promote electronic filing.

Alternate Solutions to Incent Electronic Submission

Rather than just denigrate the proposed rule, we provide at least one suggested alternative in hopes that it is recognized that retaining some version of the current rule is possible, while still promoting the stated goals set forth in the Notice of Proposed Rulemaking. Specifically, revised fees could be imposed that discriminate against paper submissions, but still allow practitioners to rely on the certificate of mailing. The revised fees could be implemented in one of two equivalent ways. Electronic submissions may receive a discount for any fees associated with the submission. Alternatively, and more practically since not every submission has a fee, paper submissions that choose to rely on a certificate of mailing could be charged a fee or surcharge. While obviously we would prefer that the surcharge be modest such that there was no huge expense for our client, the surcharge could readily be sized to incent the desired electronic filings. We note that the Trademark Office already offers discounted filing fees for new applications.

Conclusion

We recognize that the number of submissions which would be heavily affected by this rule change may be small, but respectfully submit that the disproportionate impact the rule change would have on responses that are impractical to file electronically justifies preserving some form of the current rule so that practitioners can continue to rely on certificates of mailing to insure timely filings. Preserving some form of the current rule for responses to Office Actions is further justified for that small number of submissions because there is nothing which specifically necessitates the new rule completely replacing the current rule. Having some form of bifurcated rule allowing for electronic submissions and paper submissions with certificates of mailing will still increase efficiency and improve quality and integrity of data within the automated systems for all those cases in which an electronic submission was received. We believe that the vast majority of the filings will be electronic and the goals will be achieved, but preserving some form of the current rule for responses to Office Actions will help avoid passing an undue burden on to some clients in some situations.

Respectfully submitted,

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on behalf of Walker Digital Management, LLC