



Via Electronic Mail
TEASPLUS.comments@uspto.gov

April 21, 2005

Commissioner for Trademarks
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Attention: Cheryl L. Black

Re: "TEAS Plus"

The International Trademark Association takes this opportunity to offer its response to the April 7, 2005 notice of proposed rule making concerning the 19 requirements to receive a reduced fee of \$275 for filing a trademark application through the Trademark Electronic Application System. According to the NPRM, the reduced fee option will be referred to as "TEAS Plus"; it is being enacted pursuant to the USPTO's 21st Century Strategic Plan and in accordance with the Consolidated Appropriations Act, 2005, Public Law 108-447. INTA supports the efforts of the USPTO to encourage greater use of the TEAS system and believes the reduced fee will help achieve that goal. Our comments, which were prepared by the association's USPTO Subcommittee, are as follows:

Eligible Marks. The preamble of the enumerated requirements indicates that the procedure is available only to marks filed on the Principal Register; it is not available for marks filed on the Supplemental Register, or for collective or certification marks, or for Madrid extensions. We note that TEAS forms are available for marks filed on the Supplemental Register, and for collective and certification marks, so the rationale for excluding these filings is unclear. Due to these limitations, the availability of a reduced fee for only Principal Register TEAS applications could encourage some applicants to file initially on the Principal Register and later amend to the Supplemental Register to take advantage of the lower filing fees, thereby creating additional work and expense for both the applicants and the USPTO. We therefore encourage the USPTO to offer TEAS Plus forms for marks filed on the Supplemental Register and for collective and certification marks.

Electronic Correspondence. Requirement 6 provides that all correspondence between the USPTO and the applicant or the applicant's attorney be by e-mail. We are in agreement with this requirement; however, practitioners have noted that the USPTO does not consistently process electronically filed change of e-mail address forms, thereby causing correspondence to go astray. We request that this issue be addressed so that a change of law firms handling the case, or even attorneys within a firm (usually caused by a departing attorney), be promptly recognized in the official record so that correspondence via e-mail can continue uninterrupted.

ID Manual. Requirement 8 provides that all goods and services be identified by using the USPTO Acceptable Identification of Goods and Services Manual. This requirement is problematic for goods or services for which the ID Manual contains brackets or blank spaces, requiring the applicant to provide specific information – *e.g.*, “Computer software for {specify the function of the software, *e.g.*, use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use} that may be downloaded from a global computer network” or “Books {indicate subject matter}”. Presumably, the applicant will be deemed to be in compliance with Requirement 8 if the specific fields or bracketed information is supplied; the form should allow for input as to the specifics in the categories where required. We also note that some cutting-edge goods or services may not be in the ID Manual. It is our expectation that proposals by applicants to supplement the ID Manual as to these goods or services will be acted upon promptly so as to enable applicants to take advantage of the TEAS Plus filing.

Drawings. Requirement 12 states that a drawing of the mark must meet the requirements of 37 CFR §§ 2.51 and 2.52. We note that many applicants use drawings with gray shading, which is intended to show shading rather than the color gray. The USPTO’s current regulations, however, require only a black-and-white drawing and do not permit the use of shading. This requirement is out of step with most other countries, and it places an additional burden on applicants to produce a special form drawing. The preparation of a black-and-white drawing typically costs in the range of \$200, and takes a week to prepare. We have previously raised this issue with USPTO officials, and note that the agency has expressed a willingness to address this issue. We do not see any prejudice to applicants by allowing drawings to show gray, with the understanding that the gray shows shading (typically caused by the use of different colors, when color is not claimed as a feature of the mark), and request that the USPTO implement a change to the drawing rules to facilitate compliance with the requirements for TEAS Plus applications.

Response Time. Compliance with the TEAS Plus rules also requires that all office actions be responded to completely within two months of the mailing date, except for final refusals. *See* Requirement 19. We note that the original strategic plan provided that first actions would issue on an expedited basis, provided that the “perfect” application was filed, and a response to the office action was filed in two months. The current proposal, however, makes no mention of the expedited handling for TEAS Plus filings. Absent such a benefit, we see no justification for imposing a two-month response deadline on TEAS Plus filers. This time limit does not appear to have any bearing on the cost to the USPTO to examine the application, or on the ease or ability of the USPTO to correspond with the applicant. Therefore, unless and until the USPTO is in a position to deliver a corresponding benefit (*i.e.*, faster processing time or shorter pendency) in exchange for requiring a faster response time to office actions, we see no basis for such a requirement and recommend that the original six-month response deadline be retained.

Formats. In addition to the 19 enumerated requirements, the rules require that all documents be submitted electronically throughout the process. We note the cumbersome and time-consuming process of attaching multiple-page documents, because the only format permitted by the USPTO is .jpg, a format that requires each page to be separately scanned and attached. We understand that the USPTO is considering permitting other formats such as .pdf, and we encourage the USPTO to implement this change as soon as possible, to facilitate the most efficient and extensive use of the TEAS system.

Assignment of Serial Number and Filing Date. Finally, we note that the USPTO proposes to revise current § 2.23 of the rules, which deals with the assignment of a serial number to applications and informing the applicant of both the serial number and filing date. These issues do not directly relate to the proposed TEAS Plus filing option, and the agency's reasons for changing this section are therefore unclear. The USPTO states that it intends to continue its practice relating to the assignment of serial numbers and the notification of applicants, but the USPTO prefers to relegate this current rule to the TMEP, calling it "administrative information." Because the assignment of a serial number and filing date are of substantive importance in many situations, INTA does not regard this as mere "administrative information," and we encourage the USPTO to retain current § 2.23. Trademark owners frequently need information relating to the filing date and serial number for purposes of priority filings in foreign jurisdictions, for transactions involving trademark collateral and for establishing the relative seniority of trademark rights in disputes. We therefore disfavor any change that would relegate the agency's practices in relation to assigning a serial number and filing date and to notifying applicants to a resource, such as the TMEP, that is not subject to public notice and comment before being changed in the future.

Thank you for the opportunity to submit comments with respect to TEAS Plus. Should the USPTO have any questions or comments concerning the INTA response, please contact INTA External Relations Manager Michael Heltzer at (212) 642-1741.

Sincerely

A handwritten signature in black ink, appearing to read "Anne Gundelfinger", with a long horizontal flourish extending to the right.

Anne Gundelfinger
President