VIA ELECTRONIC MAIL (tmfrnotices@uspto.gov)

June 18, 2014

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

Attn: Cynthia G. Lynch
Administrator for Trademark Policy & Procedure
USPTO

Re: Comments on Proposed Reduction of Fees for Trademark Applications and Renewals

Dear Ms. Lynch:

We write on behalf of the American Bar Association Section of Intellectual Property Law (the “Section”) to provide comments in response to the United States Patent and Trademark Office’s (the “Office”) invitation for public comment on the proposed Reduction of Fees for Trademark Applications and Renewals (the “Request for Comments”). The American Bar Association is the largest voluntary professional association in the world and the Intellectual Property Law Section is the largest intellectual property association with over 25,000 members. The views expressed in this letter are those of the Section. These comments have not been approved by the ABA House of Delegates or Board of Governors and should not be considered as views of the American Bar Association.

In order to both improve the alignment of Office costs with revenues and increase efficiency by incentivizing electronic communications, the Office proposes to reduce the filing fees for trademark, certification mark, collective membership mark, and collective trademark applications for registration on the Principal or Supplemental Register that are filed using the Trademark Electronic Application System (“TEAS”) if applicants authorize email communication and file electronically throughout the application process. The Office also proposes to reduce the filing fees for TEAS Plus applications for registration and TEAS applications for renewal of a registration.
The Section appreciates the Office’s inquiry to stakeholders on whether reductions to the fees for trademark and service mark applications and renewals should be made. (For ease of reference, a summary of all proposed rule changes has been included in the attached Appendix A.) The proposed reductions in fees appear to be reasonable and the Section is generally in favor of the amendments. However, the Section would like to take this opportunity to provide some additional comments on specific proposed sections, as well as the proposed changes as a whole.

A. Clarification of Requirements for Electronic Communications with the Office for TEAS RF Applications.

In order to increase efficiency in terms of processing and prosecuting new applications for trademarks, service marks, collective marks, and certification marks, the Section recognizes that the Office is attempting to create additional incentives to encourage applicants to file new applications via TEAS, the Office’s online, electronic filing system. Specifically, the Office proposes to create a new level of filing called TEAS RF (TEAS Reduced Fee). An applicant who files via TEAS RF would be required to file both its application and all subsequent prosecution documents identified in Section 2.23 online via the TEAS system. Under this new filing system, Applicants would enjoy a reduction in their application filing fees.

The Section favors this proposal. However, the Section recommends that the Office confirm that informal communications with the Examining Attorney, including telephone and email communications will not violate the requirement of an “electronic communication” for purposes of retaining TEAS RF status.

B. Reduction of Fees for Applications Filed Under Section 66

The Section also notes that there is no proposed reduction in the fee for filing an application under Section 66 of the Act. In view of the reductions in fees for trademark and service mark applications filed via TEAS or TEAS Plus, the Section wishes to confirm that there was no intent to decrease these fees, as well. In addition, the Section notes that the primary motivation in reducing filing fees is to incentivize electronic filing. Since applications filed under Section 66 are already made electronically, the Section recognizes that the Office may not see any need to change the current fee schedule. The Section encourages the Office to consider how the fee reduction could alter the incentives of foreign applicants to seek U.S. registration via national applications versus through the Madrid System. The Section also notes that although the data that becomes the equivalent of an application under Section 66 is not submitted by applicants directly, the Office’s goals of increasing efficiency through electronic correspondence can be achieved with Section 66 applications by requiring that a Section 66 applicant use TEAS to respond to provisional refusals and to engage in other subsequent prosecution. The Section also considers that Section 66 requests for extensions of protection encounter a number of inefficiencies arising
from the data transfer from WIPO to the Office. The Section recommends that such inefficiencies be addressed by the Office whether as part of this proposed rule or in a separate request for comment.

Conclusion

The Section commends the Office for its consideration of these issues and appreciates the opportunity to offer comment.

Very truly yours,

[Signature]

Robert O. Lindefjeld
Section Chair
American Bar Association
Section of Intellectual Property Law
Appendix A

Summary of Proposed Rule Changes:

- The Office proposes to revise the rules in part 2 of title 37 of the Code of Federal Regulations in the following ways (not including typographical reference changes):
  - § 2.6: Trademark fees.
  - § 2.22: Requirements for a TEAS Plus application.
  - § 2.23: Requirements for a TEAS RF application.