

Via electronic mail to TMRFNotices@uspto.gov

**International Trademark Association (INTA) Comments on Notice of
Inquiry Regarding Adjustment of Fees for Trademark Applications**

Notice of Inquiry:

PTO-T-2012-0029 – *Federal Register* Vol. 77, No. 159 on August 16, 2012

The International Trademark Association (INTA) appreciates the opportunity to provide comments on the USPTO’s Notice of Inquiry regarding the adjustment of fees for trademark applications. INTA supports the USPTO’s efforts to minimize paper filings, including measures to encourage applicants to use electronic communications in all phases of the application process. The USPTO Subcommittee of INTA’s Trademark Office Practices Committee prepared the following comments, in consultation with other relevant INTA committees.

The comments below follow the questions posed in the Notice of Inquiry:

(1) What fee amounts would you consider reasonable for the three existing methods of filing?

INTA believes that the fee for each type of filing should reflect the USPTO’s cost of processing that filing. INTA defers to the USPTO to determine the exact fee for each filing, as the USPTO is in a better position to know its costs for processing each type of application, but INTA agrees that it is appropriate to charge higher fees for paper filings.

Since the ease of electronic filing is, by itself, enough to encourage most applicants who can file electronically to do so, it is possible that those applicants who still file on paper do so for a compelling reason. If this is true, it would be ineffective, if not unfair, to penalize paper filers with substantially higher fees. In this regard, INTA supports the USPTO’s continuing outreach efforts to identify and address the reasons why certain applicants still file on paper.

(2) How much of a discount would be appropriate for TEAS filers who authorize email communication and agree to file all documents electronically?

INTA supports a discounted fee for TEAS filers who agree to communicate exclusively through electronic communications with the USPTO. An appropriate fee for such filers might be midway between the fees for regular TEAS and TEAS Plus. In this case, the

fee for TEAS guaranteed electronic communication would be \$300 under the current fee structure.

(3) How much of a discount would motivate TEAS filers to authorize email communication and agree to file all documents electronically?

Although INTA supports a discounted fee for TEAS filers who agree to communicate exclusively through electronic communications with the USPTO, we question whether a substantial discount would be needed to motivate TEAS filers to do so. A discount of \$25 from the current regular TEAS filing fee might be sufficient.

INTA also questions whether the USPTO's current practice of attempting to resolve many simple issues by telephone would be affected. In other words, would Examiners be prohibited from resolving their questions by means of a telephone call with TEAS filers who agree to communicate exclusively through electronic communications? A telephone discussion with the Examiner is often a fast and cost-effective means of dealing with issues in an application and it would be an unfortunate consequence if applicants who chose the TEAS guaranteed electronic communication option lost the ability to communicate by telephone with Examiners.

(4) If the TEAS Plus fee were reduced and the discount TEAS option were also offered, would you be more likely to choose TEAS Plus?

INTA believes that a reduction in the TEAS Plus fee would not be likely to cause applicants to choose TEAS Plus. Most applicants who file by TEAS rather than TEAS Plus, we believe, do so because they wish to avoid certain aspects of TEAS Plus. For example, applicants may need to submit identifications of goods and services not found in the Acceptable Identifications of Goods and Services Manual to accurately identify their clients' goods and services. Also, the requirement to search for and select all relevant goods/services and separately assign a basis to each, and where applicable, attach a separate specimen, makes the TEAS Plus application more time-consuming and cumbersome than regular TEAS. Revisions to the ID Manual to include more up-to-date recitations and to make it more easily navigable would help to address these concerns. Nonetheless, under the current circumstances, a reduction in the TEAS Plus filing fee would not be sufficient to overcome these perceived hurdles.

(5) If you generally file paper trademark applications, would you continue to do so even if the paper application fee were to increase, and why?

INTA is unable to respond to this question as none of those consulted on the various committees file applications on paper.

(6) What advantages and disadvantages do you see in a fee structure that includes the TEAS application discount and a significantly higher fee for paper-filed applications?

For the most part, INTA sees only advantages in a fee structure that encourages end-to-end electronic prosecution, reduces paper filings and more closely reflects the USPTO's actual costs of processing each type of filing. However, care should be taken not to create additional barriers for pro se applicants who are less likely to be familiar with the electronic application process or to have easy access to reliable means of electronic communication. INTA supports the USPTO's continuing efforts to increase pro se accessibility through information and training efforts such as its Basic Facts About Trademarks website and the Trademark Information Network series. Finally, if there remain any circumstances which cannot be addressed by electronic communications, INTA recommends that the USPTO allow applicants to file on paper without penalty until such time as the USPTO develops an electronic means of communication to address those circumstances.

In conclusion, INTA supports the USPTO's movement towards entire end-to-end electronic processing of applications. INTA suggests that education and outreach continue to inform applicants about the electronic processing and to encourage this process. INTA looks forward to further discussions about fee setting and INTA is happy to assist with the USPTO's outreach efforts to identify the remaining issues that lead applicants to file on paper.