From: Allison S. Ricketts
To: Information Collection
Subject: Information Collection 0651-0009 comment
Date: Monday, February 15, 2021 3:40:49 PM
Attachments: image001.png
image002.png

Thank you for the opportunity to comment.

Trademark owners and their representatives must gather substantial information in order to prepare a trademark application. This includes the applicant's name, legal entity type or citizenship, address, list of goods and services, and supporting evidence such as a specimen of use for each class (if relying on Section 1(a) of the Lanham Act) and copy of a foreign registration (if relying on Section 44 of the Lanham Act). Some applicants also appoint an attorney.

An application can seek registration of a trademark for a single product or service, or may seek registration for many dozens of discrete goods and services. Some applications are based on intent-to-use, which does not require the uploading of specimens or a home country registration so is faster. Given the wide divergence in the nature of applications (basis of application, number of classes, number of goods/services), I do not know how the USPTO has determined that 40-50 minutes is an accurate or average time to prepare an application. It may be, if all the necessary information and data to be uploaded is gathered in advance and then it is simply a matter of copy/pasting data into the form and uploading documents. I do not know if the 40-50 minutes is meant to capture the pre-filing work of gathering all the information needed to complete the application. For attorneys, there is also time spent in forwarding the e-signature link or paper version of the application form to the client and then following up to obtain their signature. If the applicant does not use the e-signature link within two weeks, the link expires and must be re-generated, adding time to the process. Periodic system updates each year also "wipe out" previously prepared forms and then you have to prepare them anew (so far this year, there was a system update on January 2, 2021 to implement the new fees, and another system update on February 13).

However, what I think it is important to know for purpose of this information collection exercise is that new rules implemented by the USPTO in the past 18 months have substantially increased the time necessary to gather all of the information that is required to prepare and file a trademark application, no matter which version of the form is used, how many goods and services there are, or what the basis of the application is. The new rules require the trademark owner or its representative to obtain and supply all of the following information, in addition to the requirements noted above:

- an email address for the trademark applicant owner (implemented February 15, 2020);
- the owner's domicile address (which is interpreted to mean its street address) (implemented August 2019);
- attorney bar information, if an attorney is appointed (state and year of admittance, and number) (implemented August 2019); and
- the URL and date of capture of every website that is submitted as a specimen of use

(implemented February 15, 2020).

Sometimes it is a simple matter to gather all of this information; sometimes it is not. But the additional information definitely means that since August 2019, it has taken longer to prepare and file an application than it did prior to August 2019.

An aspect of the application process that I do not believe is included in the USPTO's estimate is the requirement to prepare and file a petition to waive the requirement that the applicant provide its domicile street address in extraordinary circumstances (usually pertaining to the applicant's personal security concerns). As part of a new rule requiring ex-US domiciliaries to retain US counsel to represent them in their trademark filings, the USPTO changed the definition of "domicile" and now requires not just state and country, but also the applicant's street address. Why this level of specificity is now required, when domicile previously had always been interpreted to mean only state or country of domicile, is unclear. Also not explained is why the domicile street address is necessary at all when the applicant is already represented by an attorney, and thus has satisfied the purpose for which the domicile address is supposedly sought. Applicants that do not want to provide their street address must file a petition to the Director of the USPTO establishing that extraordinary circumstances exist that qualify them for waiver of the rule. For those applicants, this adds quite a bit of additional time and expense to the application process. Moreover, such an applicant must submit a petition for every trademark application they file, rather than having the USPTO issue a blanket waiver of domicile address for an applicant once the USPTO has acknowledged applicant's extraordinary circumstances. In addition to the time to prepare and file the request, the USPTO assesses a fee for each petition.

Regards,

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