

# 67 TRADEMARK ATTORNEYS

March 27, 2021

Via Email [InformationCollection@uspto.gov](mailto:InformationCollection@uspto.gov); [Nicholas A. Fraser@omb.eop.gov](mailto:Nicholas.A.Fraser@omb.eop.gov)

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Kimberly Hardy  
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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313

Re: Comment on Control No. 0651-0009, *Applications for Trademark Registration*, ICR Ref. 202002-0651-002, request for comment at 86 Fed. Reg. 11508 (Feb. 25, 2021)

Dear Mr. Fraser and Ms. Hardy:

We write as 67 trademark attorneys to explain errors and omissions in the PTO's 60-day and 30-day notices, and in the PTO's Feb. 26, 2021 Supporting Statement. Clearance should be denied for a \$50 million collection of information that was not properly promulgated, and limited to giving the PTO time to correct numerous errors. The key facts in this ICR are the following:

- **Procedural omissions as to new burden.** The PTO seeks clearance for two collections of information that total about *\$50 million per year*. These collections were promulgated in 2019 without the estimate-and-comment procedures or OIRA review required by 5 C.F.R. Part 1320. The Supporting Statement is entirely silent on seeking approval for these new collections.
- **Faulty and uncorrected estimates.** In the 60-day notice, the PTO estimated that trademark applications take 40 to 50 minutes each. In contrast, *the PTO's own source* and the comment letters give estimates 4X larger of just *attorney* time, with no estimate for client and paraprofessional time. Notwithstanding all evidence to the contrary, the PTO's 30-day notice and Supporting Statement maintain the faulty estimates, with neither objective support, explanatory rationale, nor response to the public comments.
- **Procedurally faulty submission to OIRA.** An agency is required to "summar[ize] the public comments ... including actions taken by the agency in response to the comments." 5 C.F.R. § 1320.5(a)(1)(iii)(F), and fairly respond to them. The PTO did neither. Several of the PTO's certifications are objectively false. PTO's only response to the 60-day comments is to hide them by neither summarizing them nor including them in its ICR upload.

The PTO disregarded its statutory obligations to estimate "objectively," publish estimates, request comment, or to fairly respond to public comments. This ICR is part of an ongoing pattern: the PTO hides relevant information from OIRA, and avoids legal obligations that govern agency rulemaking. In some cases, the PTO hides its nonfeasance by claiming to already have an OIRA approval, when the public record shows otherwise. These laws matter. They are there to help agencies to ask the right questions—by asking the right questions, agencies avoid adverse unintended consequences and excessive burden. When an agency skips out on asking relevant questions and skips out on legally-required procedures, bad and expensive consequences arise.

The PTO skipped. The bad consequences have landed on the public at a cost of tens of millions of dollars per year. OIRA should narrow the PTO's clearance accordingly.

The signatories are members of several email list groups, organizational blogs, and the like. The signatories taken together filed many tens of thousands of trademark applications at the PTO during the past ten years, and paid many tens of millions of dollars in fees to the PTO in the past ten years. The issues we raise in this letter primarily affect small entities—they are primarily “big guy, little guy” issues, and issues of unwarranted and undisclosed burden.

**I. Issue 1: faulty burden estimates—the very source the PTO relies on recommends estimates 3X larger, and after comment letters, the PTO fails to correct the error**

The 60-day notice and Supporting Statement seek clearance of 40 to 50 minutes for most trademark applications:

**Table 3: Total Hourly Burden for Private Sector Respondents**

Item No.	Item	Estimated Annual Respondents	Estimated Annual Responses (year)	Estimated Time for Response (hours)	Estimated Annual Burden (hour/year)	Rate <sup>1</sup> (\$/hour)	Estimated Annual Respondent Cost Burden
			(a)	(b)	(a) x (b) = (c)	(d)	(c) x (d) = (e)
1	Use-Based Trademark/Service Mark Applications (TEAS Standard)	94,956	94,956	0.75 (45 minutes)	71,217	\$400	\$28,486,800
1	Use-Based Trademark/Service Mark Applications (TEAS Plus)	90,111	90,111	0.83 (50 minutes)	74,792	\$400	\$29,916,800
2	Intent to Use Trademark/Service Mark Application (TEAS Standard)	99,770	99,770	0.67 (40 minutes)	66,846	\$400	\$26,738,400
2	Intent to Use Trademark/Service Mark Application (TEAS Plus)	94,678	94,678	0.75 (45 minutes)	71,009	\$400	\$28,403,600
3	Applications for Registration of Trademark/Service Mark under 37 CFR §44 (TEAS Standard)	13,318	13,318	0.67 (40 minutes)	8,923	\$400	\$3,569,200
3	Applications for Registration of Trademark/Service Mark under 37 CFR §44 (TEAS Plus)	12,638	12,638	0.75 (45 minutes)	9,479	\$400	\$3,791,600
	<b>Totals</b>	<b>405,471</b>	<b>405,471</b>		<b>302,266</b>		<b>\$120,906,400</b>

<sup>1</sup> 2019 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); <https://www.aipla.org/detail/journal-issue/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms which is \$400 per hour.

Remarkably, the PTO cites the *AIPLA Economic Survey* as its source for attorney rate. As shown in Exhibit B, the *AIPLA Economic Survey* also shows an average attorney fee of \$930 for filing a trademark application. At the PTO's assumed rate of \$400/hr, that comes to 2.3 hours, counting only attorney time. The PTO identifies no basis whatsoever for estimating 0.75 to 0.83 hours when *the PTO's own source* suggests 2.3 hours.

When these estimates were published for 60-day comment, a number of comment letters noted that the PTO's estimates are not remotely plausible. The comment letters estimate ordinary course applications take about 120 minutes of *attorney* time. One comment letter notes that occasional outliers, where everything goes wrong, pulls the average up. Further, neither the *AIPLA Economic Survey* nor the comment letters include burden for the client. Clients typically need to spend time in consultation with the attorney, and need to gather information to provide to the attorney. This burden of gathering information may be substantial—the client must go through records that might be decades old to accurately identify a date of first use, or perhaps review sales over a period of time to ensure that the quantum of use meets the legal standard for *bona fide* use.

The PTO's Supporting Statement *entirely ignores* the comment letters, does not adjust the estimates as suggested in the letters, and offers no “objective support” for its 40 and 50 minute estimates.

In the signup sheet for this letter, attorneys offered their estimates for attorney time. The survey instrument and raw data are in Exhibit C. After throwing out the top and bottom, the remainder average to estimates of 3.2 hours of attorney time, and 1.2 hours of client time.

Honest people make honest mistakes. Honest people honestly and gratefully accept correction of their mistakes. OIRA should give the PTO a “do over” opportunity to do so. The PTO should be given a clearance of 120 days, so that the PTO can “consult with the public” to develop objective estimates of burden that include burden on applicants, as well as attorneys, 5 C.F.R. § 1320.8(d)(1)(ii), and then re-run its 60-day and 30-day notices with corrected estimates. We suggest a starting estimate of 3.2 hours of attorney time, and 1.2 hours of client time, at rates for professional staff.

## **II. Issue 2: Terms of clearance should exclude “domicile address” and “attorney bar information” because the PTO omitted multiple procedural requirements**

### **A. History**

Since the PTO first began to collect trademark applications in the 1880s, the PTO has required information about the applicant, the party that uses the trademark. The required information has always been tailored to rational needs of the PTO to process the application, and the rational needs of any member of the public that needs to reach a trademark owner: name, postal address, corporate form, the state of legal jurisdiction over the applicant (trademarks are subject to parallel federal and state law), email address, and the like. For 100 years, all has been well and good.

In the fall of 2019, the PTO added two new collections of information, both without statutorily-required procedure, and with no explanation of rationale for the breadth of information to be collected. The first is a demand that all trademark applicants, including domestic individuals, disclose their home addresses:

- The trademark statute requires a trademark applicant to identify its “domicile.” 15 U.S.C. § 1051(a)(2). For 100 years, the PTO’s definition of “domicile” was the same as the courts’ and everyone else’s: that party’s home state, or occasionally city and state, or foreign country.<sup>1</sup> However, in August 2019, the PTO parachute-dropped a new rule into a final rule without an NPRM.<sup>2</sup> Suddenly, without any opportunity to comment and with only minimal notice, trademark attorneys were required to publicly disclose **address** information for all applicants, including **personal home address** for trademark owners that are domestic individual persons.<sup>3</sup> On email lists among trademark attorneys, the rule was nicknamed the “where you sleep at night” rule.
- In **guidance** issued shortly thereafter, the PTO explained that “domicile address” would not be satisfied by a P.O. Box. The PTO Guidance made no exception for cases where a P.O. Box is the only practical address—RFD addresses, addresses in Caribbean island nations where P.O. Box is the only form of address, and the like. The guidance made no exception for natural persons who have reason to **not** disclose their personal home address, such as those fearing domestic violence.
- At the same time, and with similar lack of rulemaking procedure, the PTO created another rule, 37 C.F.R. § 2.22(a)(19) and § 2.32(a)(2), as amended 84 Fed. Reg. 31498, 31511 (Jul. 2, 2019), to require that attorneys add their attorney bar information to every trademark application and registration. This is required for *all* applicants (even though the discussion in the rule preamble suggests it was intended only to cover foreign applicants). In the NPRM, there’s **not a single word** of rationale, and nothing remotely reminiscent of the requirements specified by 5 C.F.R. § 1320.9, and as proposed, the

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<sup>1</sup> *Gilbert v. David*, 235 U.S. 561, 579 (1915) (“domicile” is either Connecticut or Michigan); *The Venus, Rae, Master*, 12 U.S. 253 (1814) (“domicile” is Great Britain). City is considered in evaluation of “domicile” when a state is divided into multiple judicial districts.

<sup>2</sup> These two collections of information arise primarily in RIN 0651-AD30 and its follow-up guidance, *Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants*, Final rule, 84 Fed. Reg. 31498 (Jul. 2, 2019). The Notice of Proposed Rulemaking, *Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants*, RIN-0651-AD30, 84 Fed. Reg. 4393 (Feb. 15, 2019) proposed to change requirements for *foreign* applicants, but contained no suggestion of any change for *domestic* applicants. In part, these collections of information arise in a contemporaneous but separate rulemaking that likewise claims to be covered by 0651-0009, *Changes to the Trademark Rules of Practice To Mandate Electronic Filing*, final rule, RIN 0651-AD15, 85 Fed. Reg. 37081, 37092 col. 3 (Jul. 31, 2019) (claiming to have an existing clearance under 0651-0009).

<sup>3</sup> 37 C.F.R. § 2.32(a)(2), § 2.189.as amended by 84 Fed. Reg. 31498. *Examination Guide 04-19* (August, 2019) ([https://www.uspto.gov/sites/default/files/documents/Exam%20Guide%2004-19\\_0.pdf](https://www.uspto.gov/sites/default/files/documents/Exam%20Guide%2004-19_0.pdf)), and *Examination Guide 04-19* (September 2019), <https://www.uspto.gov/sites/default/files/documents/Exam%20Guide%2004-19.pdf>

NPRM would have required this information only for *foreign* applicants.<sup>2</sup> While the PTO required this information for every trademark record, the PTO did not update all its forms and electronic filing systems to allow easy addition of the information. Instead, the attorney had to file a separate form to add the information and wait for the electronic record to be updated before the substantive response can be filed, thus doubling the work required for certain tasks.

- Neither the NPRM nor final rule provides burden estimates; neither asks for comment on the four questions specified by 44 U.S.C. § 3506(c)(2)(A) and 5 C.F.R. § 1320.8(d)(1); at no time did the PTO “consult with members of the public” to see if there was a lower-burden solution to the problem of fraudulent foreign applications that the PTO perceived.
- The PTO filed an ICR for clearance of “attorney bar information,” 201912-0651-001,<sup>4</sup> but not for “domicile address.” The “bar information” ICR was filed on Jan. 30, 2020, long after the NPRM and final rule, of February and July 2019. The PTO estimated “attorney bar information” at one minute—because there had been no disclosure or notice in any contemporaneous Federal Register notice, only an obscure “no material or nonsubstantive change” worksheet, the public had no meaningful notice or opportunity to comment on the underestimate (locating the right form, preparing the paper, and uploading it, takes about 8 minutes).

For a time after these rules went into effect, the PTO did not mask the address—trademark attorneys began to get inquiries from clients who were receiving letters from scammers who advertised “services” to trademark owners.

Today, the PTO nominally masks addresses from disclosure on its primary web sites, TESS and TSDR. However, despite requests from trademark attorneys, the PTO declines to assure that home address information is masked in all external-facing systems such as their poorly documented APIs, from FOIA disclosure, or from access by the thousands of PTO employees who have internal access to trademark records.

Many patent and trademark attorneys have had the experience of receiving a phone call from a client, that the client has been contacted by the PTO to approve a substantive action in a patent and trademark application, despite clear regulations to the contrary. 37 C.F.R. § 2.18(a)(2) (“If an attorney is recognized as a representative ... the Office will correspond only with that attorney”); § 1.33(a). It happens regularly—one instance was circulated on the trademark attorney email lists as this letter was in preparation. It is not straightforward to get the PTO to undo an action taken on the approval of the client, even if the client had no informed basis to consent, and the PTO person involved had no authority to ask the question. Any attorney that has had that experience is reluctant to provide the PTO with any opportunity to go around the attorney to the client.

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<sup>4</sup> [https://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=201912-0651-001](https://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=201912-0651-001), justification worksheet at <https://www.reginfo.gov/public/do/DownloadDocument?objectID=98146101>



**B. Procedural omissions in promulgation**

As proposed in the NPRM,<sup>2</sup> the PTO proposed two things: (a) to require that *foreign* applicants designate a U.S. attorney, and (b) those *foreign* parties must disclose their address, which could be a mailing address. The requirement to disclose for *domestic* applicants, and to disclose *domicile* address popped into the final rule, with no advance notice, and no opportunity for public comment. We also note that the time between proposed and final rule was less than five months—we surmise that this was a rush rule, and that therefore the skipping of procedure was entirely intentional, for reasons not explained in the proposed or final rule notice.

1. A Notice of Proposed Rulemaking is required when the rule adds any burden cognizable under the Paperwork Reduction Act, or modifies any “collection of information” *whether or not* the “collection of information” is embodied in a regulation.<sup>5</sup> The following requirements apply:

- (a) the Notice must present (or be accompanied by) the PTO’s burden estimates, and permit a 30- or 60-day comment period for the burden estimates under the Paperwork Reduction Act.<sup>6</sup> Neither of the NPRMs has any estimates whatsoever, let alone estimates for *domestic* applicants, or estimates of *domicile* address. Neither of the NPRMs asks the four questions required by § 3506(c)(2)(A).
- (b) No later than the NPRM, the PTO was required make a submission to OIRA with certain certifications, showings, and objective support.<sup>7</sup> OIRA’s web site shows that the PTO made none of the required filings at the relevant time.<sup>8,9</sup>

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<sup>5</sup> 5 C.F.R. § 1320.11 covers rules in notices of proposed rulemaking, § 1320.12 covers final rules, and § 1320.10 covers collections of information other than those in proposed or final rules.

<sup>6</sup> 44 U.S.C. § 3506(c)(2)(B) and 5 C.F.R. § 1320.8(d)(1). Notice of the rule and the agency’s estimates must be provided to OIRA and published in the Federal Register no later than the Notice of Proposed Rulemaking or other notice of the rule, then the agency must allow 30 days for comments, and then OIRA has up to 60 days to approve or disapprove. 5 C.F.R. § 1320.11(b), (c) and (h) (collections of information in proposed rules and final notices); 5 C.F.R. § 1320.12 (current rules); 5 C.F.R. § 1320.10(a) and (b) (collections of information not in proposed or final rules).

<sup>7</sup> 44 U.S.C. § 3507(d)(1) (requirement to submit); 5 C.F.R. § 1320.9 (required content of the submission); 44 U.S.C. § 3506(c)(2)(A)(iv); § 3506(c)(3); and 5 C.F.R. § 1320.5(d)(1) (“To obtain OMB approval of a collection of information, an agency shall demonstrate that it has taken every reasonable step to ensure that the proposed collection of information: (i) Is the least burdensome necessary for the proper performance of the agency’s functions...”); § 1320.9(d).

<sup>8</sup> <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0009> ; <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0050> ; <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0054> ; <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0055> ; <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0056> ; <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0061>. The PTO eventually “got around” to one of the two required ICRs, a year late and at a time unrelated to other rulemaking notices, as noted in footnote 4.

(c) The NPRM claims that the PTO had pre-approval, 84 Fed. Reg. 4402, col. 2:

*et seq.*). The collection of information involved in this rule has been reviewed and previously approved by OMB under control numbers 0651-0009, 0651-0050, 0651-0051, 0651-0054, 0651-0055, 0651-0056, and 0651-0061. We

In contrast, no relevant filings near the relevant times are visible at the relevant pages on OIRA's web site, let alone approvals.<sup>8,9</sup>

- (d) A number of the PTO's recent NPRM and final rule notices have had similar statements of "previous approval" with a long list of control numbers, when actual approval is readily ascertainable in none of them, because none even have a relevant filing in the relevant time window. After OIRA makes appropriate inquiry with relevant PTO personnel, OIRA may infer that PTO is intentionally playing "seven card monte" or hide-the-peanut with the public and with OIRA, in an effort to hide an omission.
- (e) An NPRM must request comment on the four questions specified by 44 U.S.C. § 3506(c)(2)(A) and 5 C.F.R. § 1320.8(d)(1). The NPRM did not do so, for either the "domicile address" or "attorney bar information" collections.
2. If the information collections of a rule are "substantially modified" at any time between the Notice of Proposed Rulemaking and publication as a final rule, the PTO must resubmit the rule to OIRA and seek notice-and-comment for another pass at step 1, at least 60 days before publication of the final rule.<sup>10</sup> Here, the PTO changed the scope of the "domicile address" collection (foreign applicants only in the NPRM, all applicants in the final rule), and the consequential duty (merely requiring a U.S. representative in the NPRM, disclosure of "domicile address" in the final rule), but did not make the required additional filing or request the required notice and comment.<sup>8,9</sup>
  3. On or before the date of publication of the Federal Register notice of a final rule, the PTO must submit the rule to OIRA for another round of review under the Paperwork Reduction Act, with a 30-day public comment period.<sup>11</sup> The PTO did not do so.

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<sup>9</sup> In <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0051>, the PTO made a filing in February 2019, which purports to reduce burden for administrative reasons. The relevant ICR concedes that it is "Not associated with rulemaking" and the Supporting Statement discloses nothing of relevance to either the February 2019 NPRM or the July final rule.

<sup>10</sup> 44 U.S.C. § 3507(d)(4)(D) and 5 C.F.R. § 1320.11(h)(2).

<sup>11</sup> 5 C.F.R. § 1320.11(h).

4. In the RIN 0651-AD30 Final rule notice, the PTO claims that all burden is “previously approved.” 84 Fed. Reg. 31509, col. 3. In the RIN 0651-AD15 Final Rule notice, the PTO makes two claims, 84 Fed. Reg. at 37092, col. 3:

*et seq.*). The collection of information involved in this rule has been reviewed and previously approved by OMB under control numbers 0651–0009, 0651–0050, 0651–0051, 0651–0054, 0651–0055, 0651–0056, and 0651–0061. This rulemaking has an overall change on the public burdens within these approved collections including a reduction of 862 in burden hours and a reduction of \$5,175 in cost burdens.

If the PTO’s claims of “previously approved” are true, the approvals are not visible at [reginfo.gov](http://reginfo.gov).

- (a) By its own admission to OIRA, this “reduction in cost burden” was “not associated with rulemaking,” *not* as a result of “this rulemaking.”<sup>9</sup>
- (b) At the time of this final rule notice (July 2019), the PTO has never *sought* clearance for the “attorney bar information,” and to this day has never sought clearance for “domicile address” collections of information, let alone obtained “previous approval.”<sup>8,9</sup> The PTO’s ICR requesting clearance for “attorney bar information” was in January 2020.<sup>12</sup>
- (c) Because the PTO designated ICR 201912-0651-001 “not associated with rulemaking” and “No material or nonsubstantive change to a currently approved collection,” and the 60-day notice (85 Fed. Reg. 82456) made no mention of “attorney bar information” or any other new collection of information, the public had no meaningful opportunity for comment.
5. In this ICR 202002-0651-002,<sup>13</sup> the PTO “clicks the boxes” to make certain certifications:
- (a) The PTO certifies that “the proposed collection of information ... is necessary for the proper performance of agency functions.” But the trademark system has worked without “domicile information” and “attorney bar information” for 140 years; the PTO made no showing of “necessary” commensurate with the scope of the rule. This issue was raised in the public comment letters in the PTO’s post-issuance 60-day notice (see Exhibit D); the PTO’s Supporting Statement neither disagrees nor explains nor attempts to correct the error. The PTO’s only reaction is to hide the public comment letters by not including them in this ICR and not summarizing them in the Supporting Statement.
- (b) The PTO certifies that “the proposed collection of information ... [is] implement[ed] [to] be consistent and compatible with current reporting and recordkeeping practices” and “

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<sup>12</sup> [https://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=201912-0651-001](https://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=201912-0651-001), justification worksheet at <https://www.reginfo.gov/public/do/DownloadDocument?objectID=98146101>

<sup>13</sup> [https://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=201912-0651-001#section0\\_anchor](https://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=201912-0651-001#section0_anchor)



makes appropriate use of information technology.” But a good share of the excess burden we explain above arises because the PTO has not fully updated its electronic filing systems to make these collections easy.

- (c) The PTO certifies that “the proposed collection of information ... reduces burden on small entities.” The greatest harm from disclosure of domicile address information falls on individual applicants. Giant corporations’ addresses are well known. In contrast, some small entities, for example, individuals fearing domestic violence but trying to run a small business, have well-founded fear of disclosing this information. The public has raised this concern on every occasion on which the PTO sought comment, and in petitions for rulemaking—the PTO offers no contrary explanation.
  - (d) The PTO certifies that “the proposed collection of information ... developed by an office that has planned and allocated resources for the efficient and effective management and use of the information to be collected.” The PTO nowhere indicates that it will make actual practical utility of the “domicile address” information, and states no use for any but a small fraction of the attorney bar information it collects.
6. In this Supporting Statement, there is no mention of either “domicile address” or “attorney bar information.” *Not a word* on either one.

### **C. Public efforts to seek correction, and PTO inaction**

The Software Freedom Conservancy, a 501(c)(3) nonprofit, filed a petition for rulemaking on September 18, 2019. The petition is attached hereto as Exhibit A. The PTO has taken *no action* on this petition in *eighteen months*. OIRA may infer that PTO is intentionally evading a legal obligation to decide the petition.

This Petition for Rulemaking, by a credible and experienced trademark attorney, estimates that the “domicile address information” and “attorney bar information” collections of information create *\$50 million* of burden, burden that has never been promulgated by proper rulemaking procedure, has never been cleared by OIRA, and for which clearance is not requested in this Supporting Statement.

### **D. The public comment letters in response to the 60-day notice—neglect or coverup?**

The public filed at least nine comment letters through regulations.gov during the 60-day comment period, and an unknown number more via email. The PTO has not made these letters public—for example, they are nowhere visible on the PTO’s web site, and were excluded from the PTO’s ICR upload. They are not summarized in the Supporting Statement, as required by 5 C.F.R. § 1320.5(a)(1)(iii)(F). The PTO offers no “actions taken by the agency in response to the comments.” The letters that we are aware of are attached as Exhibit D. Several of them commented on these two collections of information; there may be more, but the PTO ceased positing information collection comment letters on its own web site earlier this year. The Supporting Statement’s only acknowledgement is “Several comments were received. USPTO appreciates these comments and is working on responding to them.” The PTO complies with neither the letter nor the spirit of the law.

**E. This ICR is procedurally incomplete, and the Supporting Statement plays “hide the ball”—terms of clearance should exclude “domicile address” and domestic “attorney bar information”**

The PTO estimates burden of these two collections of information at essentially zero—at the very least, the Supporting Statement acknowledges no additional burden. Knowledgeable commenters estimate burden at over \$50 million (see Exhibit A). The PTO offers no support for its estimate, and it is simply not credible.

Second, both of these collections of information were invalidly promulgated. In its NPRM and final rule notices,<sup>2</sup> the PTO omitted the procedural requirements of the Administrative Procedure Act, Paperwork Reduction Act, Regulatory Flexibility Act, Executive Order 12866, 13771, or 13891. The errors are summarized in § II.B, and laid out in greater detail in Exhibit A. The PTO offers no corrective remedy.

Third, the Administrative Conference of the United States issued [recommendations](#) in August 2019 (that is, eighteen months ago):

1. An agency should not use an interpretive rule to create a standard independent of the statute or legislative rule it interprets. That is, noncompliance with an interpretive rule should not form an independent basis for action in matters that determine the rights and obligations of any member of the public.

4. An agency should prominently state, in the text of an interpretive rule or elsewhere, that the rule expresses the agency’s current interpretation of the law but that a member of the public will, upon proper request, be accorded a fair opportunity to seek modification, rescission, or waiver of the rule.

The PTO’s treatment of its guidance as *binding* conflicts with these recommendations. In the last year, the PTO has issued a dozen guidance documents to which it attaches binding effect, some may be expected to have a billion dollars a year in economic effect;<sup>14</sup> the PTO observes no procedure. This ICR is merely one symptom of a pervasive problem. OIRA may infer that the PTO lacks capacity to know right from wrong in issuing and enforcing guidance, or lacks capacity to conform its conduct to the requirements of law.

### III. Conclusion

OIRA should give a 120-day approval, with terms of clearance as follows:

- Clearance should be granted for only those collections of information that PTO specifically requests and for which the PTO observed information collection procedure in its rulemaking. Terms of clearance should limit the PTO to collecting the same

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<sup>14</sup> For example, *Treatment of Statements of the Applicant in the Challenged Patent in Inter Partes Reviews under § 311*, (Aug. 18, 2020) [https://www.uspto.gov/sites/default/files/documents/signed\\_aapa\\_guidance\\_memo.pdf](https://www.uspto.gov/sites/default/files/documents/signed_aapa_guidance_memo.pdf); *Approach to Indefiniteness under 35 U.S.C. § 112 in AIA Post-Grant Proceedings*, (Jan. 6, 2021) <https://www.uspto.gov/sites/default/files/documents/IndefinitenessMemo.pdf>

information approved in 2017 (the rules were stable from 2017 until June 2019),<sup>15</sup> and should exclude PTO's collection of domicile address information.

- The clearance for “attorney bar information” should be revoked. 5 C.F.R. § 1320.16(c). The relevant NPRM and final rule failed to request comment as required by 44 U.S.C. § 3506(c)(2)(A) and 5 C.F.R. § 1320.8(d)(1), and the PTO has never identified “practical utility” for any but a fraction of the total collection of information. The ICR was filed six months distant from the NPRM and final rule, and characterized as “No material or nonsubstantive change to a currently approved collection,” effectively denying the public any meaningful opportunity for comment.<sup>12</sup> The one-minute estimate in the Supporting Statement was not developed in consultation with the public, the PTO offers no objective support, and the one-minute estimate is not plausible.
- OIRA should grant a 120-day clearance, with instructions to the PTO to republish objective estimates that align with the public comments. The PTO's estimates in the Supporting Statement, 0.75 to 0.83 hours, are not remotely plausible. As a starting point for corrected estimates, we suggest 3.2 hours of attorney time, and 1.2 hours of client time.
- OIRA should direct that the “domicile address” and “attorney bar information” collections of information may be repromulgated, but will not be cleared until the PTO observes the procedures of 5 C.F.R. Part 1320. That will require the PTO to start with a proper Notice of Proposed Rulemaking that observes all information collection requirements, starting with “objective estimates” and a contemporaneous filing with OIRA. As a fortunate coincidence, Congress recently enacted the Trademark Modernization Act,<sup>16</sup> which requires the PTO to conduct a rulemaking to address many of the same problems for foreign-origin applications as the “domicile address” and “attorney bar information” collections seek to address. The PTO is to conclude rulemaking by December 2021—the timing couldn't be better for OIRA to refuse clearance for improperly-promulgated collections of information, because the PTO is obligated to act imminently, and has an opportunity to replace them with more precisely-targeted regulations and collections of information. In the mean time, this ICR should be cleared only as to the rules as they stood in June 2019.
- Until the PTO acts on Software Freedom Conservancy's Petition for Rulemaking in Exhibit A, OIRA lacks sound information to decide clearance for the “domicile address” and “attorney bar information” collections of information in 0651-0009, -0054, and -0056. The issues largely overlap. All three ICRs now pending should be given only

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<sup>15</sup> OIRA has approved with terms of clearance that back-date to an earlier version of regulations, e.g., [https://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=200809-0651-003](https://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=200809-0651-003) even after a revision has been published as a final rule. The PTO would have to publish a Federal Register notice analogous to *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Delay of Effective and Applicability Dates*, 73 Fed. Reg. 74972 (Dec. 10, 2008).

<sup>16</sup> Trademark Modernization Act of 2020, Pub. L. 116-260, §§ 221-228, 134 Stat. 1182, 2201-05 (Dec. 27, 2020) as part of the Consolidated Appropriations Act of Dec. 27, 2020.

month-to-month clearance until the PTO decides that petition, and offers the public a proper notice and comment period on any collections of information that remain.

- Pursuant to § 1320.16(b), OIRA should require the PTO to demonstrate that its information collection personnel are “sufficiently independent of program responsibility to evaluate fairly whether proposed collections of information should be approved,” and are able to “review process that demonstrates the prompt, efficient, and effective performance of collection of information review responsibilities.”

**Point of contact.** A single point of contact can refer specific issues to specific authors of various sections of this letter. Please route any questions or further inquiries to David Boundy, [DavidBoundyEsq@gmail.com](mailto:DavidBoundyEsq@gmail.com), (646) 472-9737.

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Attachments:

Exhibit A Software Freedom Conservancy, *Petition for Rulemaking under 5 U.S.C. § 553(e) to Limit the Use of Rule 2.189 and to Initiate Rulemaking under 5 U.S.C. § 553(b)-(d)* (Sep 18, 2019) (PDF pages 16-31)

Exhibit B Page from the 2019 *AIPLA Economic Survey* (PDF pages 32-33)

Exhibit C Raw data of estimates from the public (PDF pages 34-35)

Exhibit D Comment letters in response to 60-day notice, from  
<https://www.regulations.gov/document/PTO-T-2020-0069-0001/comment> (PDF pages 36-51)

## **Exhibit A**

**Software Freedom Conservancy, *Petition for Rulemaking under 5 U.S.C. § 553(e) to Limit the Use of Rule 2.189 and to Initiate Rulemaking under 5 U.S.C. § 553(b)-(d)* (Sep 18, 2019)**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
PETITION FOR RULEMAKING UNDER 5 U.S.C. § 553(e)  
TO LIMIT THE USE OF RULE 2.189  
AND  
TO INITIATE RULEMAKING UNDER 5 U.S.C. § 553(b)-(d)

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## I. INTRODUCTION

This is a Petition for rulemaking pursuant to 5 U.S.C. § 555(e) asking that the United States Patent and Trademark Office (the “USPTO”) temporarily suspend implementation of newly-promulgated Rules 2.2(o), 2.2(p), and 2.189 to the extent they require providing physical address information from applicants. These rules were added to the Trademark Rules of Practice without proper rulemaking procedure. As currently implemented, the USPTO is putting the personal safety of many trademark applicants and registrants at significant risk and unnecessarily creating obstacles for many applicants in a way that disadvantages poorer and more vulnerable applicants. Further, the USPTO failed to comply with various other statutory requirements such that the rules were issued without observance of procedure required by law, and enforcement is contrary to law.<sup>1</sup> The USPTO should refrain from enforcing these rules until there has been a lawful rulemaking process that provides the public with the opportunity to comment on the appropriate scope of the rules and that demonstrates that the USPTO adheres to the rule of law.

This petition is submitted by the Software Freedom Conservancy, Inc., a 501(c)(3) not-for-profit organization incorporated in New York. Software Freedom Conservancy helps promote, improve, develop, and defend Free and Open Source Software (FOSS) in pursuit of ethical technology. As part of its charitable mission, it provides a supportive community and financial support for the development of technical skills by those who face systematic bias or discrimination, such as many women, transgendered individuals, and African and native Americans, groups that are significantly and disproportionately impacted by the new rules and their implementation. It also represents the interests

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1 5 U.S.C. § 706(2)(A) and (D).

of people who make new software for the purpose of taking control of critical technology that may otherwise be exploitative or against the public interest.

## II. SUMMARY OF THE RECENT RULEMAKING PROCESS

On February 15, 2019, the USPTO published a Notice of Proposed Rulemaking (NPRM).<sup>2</sup> The stated reason for the rule was to require that applicants, registrants, or parties to a proceeding who are not domiciled in the United States be represented by a U.S. attorney in good standing.<sup>3</sup> The rationale for the new rule was to “(1) instill greater confidence in the public that U.S. registrations that issue to foreign applicants are not subject to invalidation ... and (2) enable the USPTO to more effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters.”<sup>4</sup> The NPRM did not mention any purpose that related to U.S. citizens or U.S. domiciled applicants or registrants.

The NPRM only mentioned the amendment of six existing rules: 37 C.F.R. §§ 2.2, 2.11, 2.17, 2.22, 2.32 and 11.15.<sup>5</sup> It did not propose adding any rules.<sup>6</sup> None of the descriptions of the proposed changes suggest that the rulemaking would make any change to the USPTO’s past practices with respect to U.S. citizens or U.S. domiciled applicants or registrants.<sup>7</sup>

The USPTO received 38 comments on the NPRM.<sup>8</sup> None of those comments addressed the potential impact of requiring domicile information from represented applicants/registrants or U.S. applicants/registrants, presumably because there was nothing in the NPRM suggesting that the rule changes would have any effect on these parties.

The Final Rule notice promulgated by the USPTO included an altogether new rule, one that had not been in the NPRM:<sup>9</sup>

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2 U.S. Patent and Trademark Office, Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, Notice of Proposed Rulemaking, 84 Fed. Reg. 4,393 (Feb. 15, 2019) [hereinafter “NPRM”].

3 NPRM at 4,393, col. 3.

4 NPRM at 4,394, col. 2; *see also* NPRM at 4,400, col. 1.

5 *Id.* at 4,399, col. 1-2.

6 *Id.* at 4,402-03.

7 *Id.* at 4,399. *See, e.g.*, the description of the most substantial change, to Rule 2.22, which mentions only affecting foreign applicants and registrants: “The USPTO proposes to amend § 2.11 to change the title to ‘Requirement for representation,’ to delete the first sentence, to include the remaining sentence in new § 2.11(a) and to add § 2.11(b)–(e), which set out the requirements regarding representation of applicants, registrants, or parties to a proceeding whose domicile or principal place of business is not located within the U.S. or its territories.”

8 Comments on Proposed Rulemaking to Require Foreign-Domiciled Trademark Applicants and Registrants to Use a U.S.-Licensed Attorney, USPTO, <https://www.uspto.gov/trademark/trademark-updates-and-announcements/comments-proposed-rulemaking-require-foreign-domiciled> (last visited Aug. 9, 2019).

9 U.S. Patent and Trademark Office, *Requirements of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, Final Rule*, 84 Fed. Reg. 31,498, 31,511 (July 2, 2019) [hereinafter “Final Rule”].



■ 7. Add § 2.189 to read as follows:

**§ 2.189 Requirement to provide domicile address.**

An applicant or registrant must provide and keep current the address of its domicile, as defined in § 2.2(o).

The NPRM expressly concedes that this is an altogether new rule that was needed because the then-current rules did not allow for the collection of this information:<sup>10</sup>

Further, to authorize the USPTO to require an applicant or registrant to provide and maintain a current domicile address, the USPTO codifies a new regulatory section at 37 CFR 2.189.

As proposed in the NPRM, the Final Rule notice also adds entirely new §§ 2.2(o) and (p) to define “domicile” and “principal place of business” as follows:

■ 2. Amend § 2.2 by adding paragraphs (o) and (p) to read as follows:

**§ 2.2 Definitions.**

\* \* \* \* \*

(o) The term *domicile* as used in this part means the permanent legal place of residence of a natural person or the principal place of business of a juristic entity.

(p) The term *principal place of business* as used in this part means the location of a juristic entity's headquarters where the entity's senior executives or officers ordinarily direct and control the entity's activities and is usually the center from where other locations are controlled.

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There was no “general statement of the basis and purpose” given for the addition of new rule 2.189, as required by 5 U.S.C. § 553(c). The only statement about the addition was “The USPTO adds § 2.189 to require applicants and registrants to provide and keep current their domicile addresses.”<sup>12</sup>

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10 Final Rule at 31,500 col. 3; Final Rule at 31,506, col.3.

11 *Id.* at 31,510, col. 1.

12 *Id.* at 31,506, col. 3.

The USPTO also stated that in “many” applications the address information was not legitimate, incomplete or inaccurate, but did not further quantify the frequency beyond “many.”<sup>13</sup>

Prior to this rulemaking, the USPTO accepted a mailing address as the domicile.<sup>14</sup> There was no suggestion in the NPRM that this would change. Because there was no mention that this practice would change, there also was no discussion in the NPRM or the Final Rule about what impact this change might have on applicants.

The USPTO has also published its Examination Guide 4-19,<sup>15</sup> twice. The Revised Exam Guide explains how the USPTO will be implementing the new rules. The USPTO is now requiring a street address for *every* applicant/registrant, not just foreign applicants.<sup>16</sup> The USPTO will not allow a U.S. applicant/registrant to use a post office box, “care of” address, or “other similar variation” as an address for an application or registration.<sup>17</sup> Disclosing a street address is required whether or not the applicant/registrant is already represented by counsel.<sup>18</sup>

The Revised Exam Guide states that the USPTO can further ask for documentation showing that the address is applicant's or registrant's address of residence (for an individual) or business headquarters (for a juristic entity).<sup>19</sup> The USPTO has been implementing this guidance by asking for information such as rental agreements, insurance policies, and utilities bills.<sup>20</sup>

The USPTO is not clear about which addresses will be acceptable and which will not be. The USPTO refers only a “post-office box” but does not state whether it means a box at a United States Post Office or a box at the UPS Store, which has a street address but also boxes for receiving postal mail. The USPTO has not stated whether a “care of” or “other similar variation” includes the addresses of Regus or WeWork, co-working spaces commonly used by start ups as their headquarters.

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13 *Id.* at 31,500, col. 1.

14 *See, e.g.*, Trademark Manual of Examining Procedure § 803.05 (Oct. 2018) (“The written application must specify the applicant’s mailing address. 37 C.F.R. §2.32(a)(4). Addresses should include the United States Postal Service ZIP code or its equivalent for addresses outside the United States. The applicant’s address may consist of a post office box.”)

15 *Examination Guide 4-19 Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants*, (Aug. 2019) (no longer available); *Examination Guide 4-19 (Revised) Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants*, <https://www.uspto.gov/sites/default/files/documents/Exam%20Guide%2004-19.pdf> (Sep. 2019) [hereinafter “Revised Exam Guide”].

16 Revised Exam Guide at I (“All applications must include the applicant’s domicile address.”)

17 *Id.* at I.A.

18 *Id.*

19 *Id.*

20 *Id.* at I.A.2, *see also, e.g.*, Application Ser. No. 88/437,575, Aug. 16, 2019 Office Action, <http://tsdr.uspto.gov/documentviewer?caseId=sn88437575&docId=OOA20190816164919#docIndex=0&page=1>.

The Revised Exam Guide added a new provision not found in the original Exam Guide, which is a mechanism that will allow an applicant to seek a waiver of the publication of their street address.<sup>21</sup> First, this mechanism sets up a class system, where those who have suffered hardship in their lives must now pronounce it publicly in a trademark application. Further, a waiver will be granted only in an “extraordinary” situation and the USPTO does not provide any information about what it might consider “extraordinary.”<sup>22</sup> If a person has moved away from a jurisdiction where the person has a restraining order, will the person no longer be allowed to keep their residential address private? Is being moderately well-known or famous in a niche field “extraordinary”? Is the voluntary practice of never publishing one’s home address “extraordinary”? Working with regimented governmental agencies is already challenging, but there can be little in life more distressing than knowing that your very life may be at risk but you cannot convince a governmental agency that your situation is one that meets their definition of “extraordinary.”

### **III. REQUIRING PRIVATE INFORMATION FROM APPLICANTS/REGISTRANTS CAUSES MORE HARM THAN GOOD**

The USPTO’s desired outcome for the rulemaking—reduction in questionable applications, which it states are statistically more likely to be from a foreign entity—is laudable. However, the sole purpose given for the rulemaking was to identify *foreign* applicants and impose a duty on them to be represented by U.S. counsel. If an applicant or registrant already has a U.S. attorney (or hires an attorney after being advised of the requirement), then the USPTO does not need any domicile information to ascertain whether an applicant or registrant is foreign and therefore required to have an attorney – the applicant already has one. Rules 2.2(o), 2.2(p) and 2.193 as promulgated and implemented are therefore not rationally related to the purpose given in the NPRM and Final Rule notice.

Further, requiring physical address information puts many individuals at significant risk of personal harm. Unfortunately some individuals have to go to great lengths to hide their residential address because they have stalkers, dangerous former partners, or simply have stated unpopular public opinions for which they received colorable threats to their physical well being.<sup>23</sup> The risk is so well-known that many states have Address Confidentiality Programs to protect the whereabouts of survivors of violence, abuse and stalking.<sup>24</sup> A requirement that victims must disclose their residential information in a publicly accessible database puts these individuals at great risk.

Take for example a mother of small children who recently successfully ended an abusive relationship. She elects to start a home business so she can earn income as the sole support of her family. As a new small business owner she wants to register the trademark for her business but this small step, a symbol of a new beginning and the tangible ownership of an important business asset, is

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21 *Id.* at I.A.4.

22 *Id.*

23 See, e.g., Stephen Totilo, *Bomb Threat Targeted Anita Sarkeesian, Gaming Awards Last March*, <https://kotaku.com/bomb-threat-targeted-anita-sarkeesian-gaming-awards-la-1636032301> (Sep. 17, 2014).

24 National Center for Victims of Crime, Stalking Resource Center, *Address Confidentiality Program*, <https://victimsofcrime.org/our-programs/past-programs/stalking-resource-center/help-for-victims/address-confidentiality-programs> (last visited Aug. 1, 2019).

foreclosed to her because filing an application will reveal to her abuser where she and her children sleep.

The concern is not limited to individuals or sole proprietorships. Increasingly, businesses are operated virtually without any physical office.<sup>25</sup> However, the rulemaking defined “domicile” as “where the entity’s senior executives or officers ordinarily direct and control the entity’s activities and is usually the center from where other locations are controlled.”<sup>26</sup> Where a business is operated virtually, the entity’s activities are most likely controlled from a residential address, subjecting the individuals to the same risk as individual applicants and sole proprietorships. This risk of harm is true for both U.S. and foreign applicants.

The promise of technology is that it can give anyone opportunities from anywhere. However, the new rules and their implementation may altogether prevent registration by those financially disadvantaged. The poorer the individuals involved in the enterprise are, the less likely they will be able to afford business offices for their new business. Additionally, charities increasingly make the most of their lean resources by forgoing rent on a physical space. What if the applicant lives in a homeless shelter? What if one is living with a sister? Mortgages, rental agreements, insurance policies and utility company bills may be issued in one person’s name, meaning that other occupants of the residence cannot prove they reside there. The applicant will not be able to register their trademark because they cannot satisfy the USPTO’s requirements for proof of domicile.

This also has profound impact for organizations that may have a substantial interest in keeping their location private. For example, shelters for women who are victims of domestic and other violence must weigh the risks carefully as to whether they disclose their location or not.<sup>27</sup>

There are more mundane reasons for using a post office box, “care of” address, or “similar variation.” Businesses may use a post office box so they can control who handles incoming mail, so they won’t lose important mail when their physical location changes, or to ensure that the mail remains in a secure location until it is retrieved. A person may travel a lot and use a mail forwarding service so that they receive their mail in a timely manner at a temporary address. Because of these new rules, the USPTO may well be mailing Registration Certificates that will never reach their intended recipient because they were mailed to an address where someone does not actually receive mail. Children (who can also be trademark applicants) may use a “care of” address of their parents or other adult. The Commissioner of Trademarks’ address is a post office box. The above-mentioned Address Confidentiality Program laws often use a post office box as a substitute address for documents as important as driver’s licenses and voter registration, so that a victim can avoid disclosing their home address to their abuser.<sup>28</sup>

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25 2018 Global State of Remote Work, OwlLabs, <https://www.owllabs.com/state-of-remote-work> (last visited Sep. 9, 2019) (stating that 16% of all companies globally are now fully remote).

26 Final Rule at 31,510, col. 1.

27 Pam Belluck, *Shelters for Women Disclosing Their Locations, in Spite of Risk*, N.Y. Times, <https://www.nytimes.com/1997/08/10/us/shelters-for-women-disclosing-their-locations-in-spite-of-risk.html> (Aug. 10, 1997).

28 See, e.g., Alex Padilla California Secretary of State, About Safe at Home, <https://www.sos.ca.gov/registries/safe-home/about-safeathome/> (last visited Sep. 2, 2019) (stating that California provides a free post office box); Address Confidentiality Program, New York Department of State, <https://www.dos.ny.gov/ACP/> (last visited Aug. 9, 2019) (stating that the participant’s legal documents will have a substitute address of a post office box in Albany, New York); Ken Paxton Attorney General of Texas, Ad-

The new rules and their implementation have a significant impact on privacy in general. There are multiple web sites that aggregate personal data, making it easier than ever to find out information about where people live, whether they have a mortgage and how much, and a whole host of other information.<sup>29</sup> These websites are becoming more established and easier to search. Every day new ways to collect detailed personal information about people are created which, when cross-referenced with public records of people's addresses, make it trivial to de-anonymize data when the subject had no intention or knowledge that such personal information would be made public.<sup>30</sup> For people with more common names, tying an applicant's address to a business name and brand will give an attacker the last piece of the puzzle. Any governmental collection and publication of this kind of identifying personal information must anticipate this use.

The rest of the world has recognized that an individual's right to privacy has become of paramount concern in today's society. The European Union leads the world in promulgating laws for the protection of personal information.<sup>31</sup> California recently followed suit.<sup>32</sup> As far back as 2012 the Federal Trade Commission recommended giving consumers the ability to make decisions about their data.<sup>33</sup> However, the USPTO has taken a dramatic step in the opposite direction without any examination or explanation why it must expose the most private of information, where one sleeps, to the public at large.

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dress Confidentiality Program, <https://www.texasattorneygeneral.gov/crime-victims/services-crime-victims/address-confidentiality-program> (last visited Sep. 2, 2019) (stating that Texas provides a post office box address).

29 See, e.g., Kate Cox, *It's Creepy, But Not Illegal, For This Website To Provide All Your Public Info To Anyone*, Consumer Reports, <https://www.consumerreports.org/consumerist/its-creepy-but-not-illegal-for-this-website-to-provide-all-your-public-info-to-anyone/> (May 4, 2018); portlandmaps.com (providing aggregated information on addresses in Portland, Oregon).

30 See, e.g., Paul Ohm, *Broken Promises of Privacy: Responding to the Surprising Failure of Anonymization*, 57 UCLA L. Rev. 1701 (2010) (describing how deanonymized data can be reidentified); Daniel Kondor, Behrooz Hashemian, Yves-Alexandre de Montjoye, and Carlo Ratti, *Towards Matching User Mobility Traces in Large-Scale Datasets*, IEEE Xplore, <https://ieeexplore.ieee.org/document/8470173/authors#authors> (Sep. 24, 2018); Jennifer Valentino DeVries, Natasha Singer, Micheal H. Keller and Aaron Krolik, *Your Apps Know Where You Were Last Night, and They're Not Keeping It Secret*, N.Y. Times, <https://www.nytimes.com/interactive/2018/12/10/business/location-data-privacy-apps.html> (Dec. 10, 2018).

31 Regulation (EU) 2016/679, of the European Parliament and the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC (General Data Protection Regulation), 2016 O.J. (L 119) 1 at arts. 22, 13, 14, 15

32 California Consumer Privacy Act of 2018, Cal. Civ. Code § 1798.100 et seq.

33 Federal Trade Commission, *Protecting Consumer Privacy in an Era of Rapid Change: Recommendations For Businesses and Policymakers*, <https://www.ftc.gov/sites/default/files/documents/reports/federal-trade-commission-report-protecting-consumer-privacy-era-rapid-change-recommendations/120326privacyreport.pdf> (March 2012).



#### **IV. THE FINAL RULE IS UNENFORCEABLE FOR MULTIPLE FAILURES TO OBSERVE RULEMAKING LAW**

##### **A. Violation of the Administrative Procedure Act: the New Rules and Their Implementation Are Arbitrary, Capricious and Not in Accordance With Law**

Agency actions may not be “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.” 5 U.S.C. § 706(2)(A). An agency rule will be arbitrary and capricious if the agency has, *inter alia*, entirely failed to consider an important aspect of the problem or offered an explanation for its decision that runs counter to the evidence before the agency, or is so implausible that it could not be ascribed to a difference in view or the product of agency expertise.<sup>34</sup>

A requirement that every applicant provide a street address is arbitrary and capricious. The Trademark Act states that a trademark application “shall include specification of the applicant’s domicile and citizenship ....”<sup>35</sup> The trademark application forms include fields for domicile and citizenship and prior to this rulemaking a mailing address was all that was needed to satisfy this requirement.<sup>36</sup> Never before has registration required a street address or evidentiary proof of domicile. The proof is in the fact that the USPTO had to create a new rule in order to collect the information.<sup>37</sup> The sufficiency of a mailing address likely was because any more information is irrelevant to registration: foreign applicants, with foreign addresses, may register trademarks in the United States. With respect to U.S. applicants and registrants, whether or not they can afford to rent an office or where they reside is not an indicator of their legitimacy or any indication of their intent. The requirement that applicants and registrants provide street addresses therefore can have nothing to do with registrability.

Further, any address, whether street address or post office box, has no relationship whatsoever to whether an applicant or registrant has retained a lawyer. Where any party is already represented, no further information is required for the USPTO’s purpose for the rulemaking to have been met. It is therefore arbitrary and capricious to require information from any represented applicant, whether U.S. or foreign.

Before promulgating a rule an agency must have examined the relevant data and articulated a satisfactory explanation for its action, including a rational connection between the facts found and the choice made.<sup>38</sup> One scours the NPRM and the Final Rules for any data on whether or how the absence of street addresses is related to the problem to be solved by the rulemaking. There is also no explanation how requiring a street address, rather than a post office box, “‘care of’ address or other similar variation” will reduce the number of fraudulent or inaccurate claims in a trademark application, whether the applicant is U.S. or foreign. All kinds of addresses are equally susceptible to falsification, or to having

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34 Motor Vehicle Mfrs. Ass’n of U.S., Inc. v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43 (1983).

35 Trademark Act of 1946 (as amended) § 1, 15 U.S.C. 1051(a)(2) (2012).

36 See, e.g., Trademark Manual of Examining Procedure § 803.05 (Oct. 2018) (“The written application must specify the applicant’s mailing address. 37 C.F.R. §2.32(a)(4). Addresses should include the United States Postal Service ZIP code or its equivalent for addresses outside the United States. The applicant’s address may consist of a post office box.”)

37 Final Rule 31,500, col. 3 (“Further, to authorize the USPTO to require an applicant or registrant to provide and maintain a current domicile address, the USPTO codifies a new regulatory section at 37 CFR 2.189.”)

38 Nat’l Fuel Gas Supply Corp. v. F.E.R.C., 468 F.3d 831, 839 (D.C. Cir. 2006).

occupants at a residential address willingly serve as a mail drop. Quite possibly nothing will be accomplished by requiring street addresses except to put applicants and registrants at greater risk due to the exposure of their personal information.

The USPTO may be trying to find a solution to a problem that does not have a solution: every address used legitimately by a person or company can also be used illegitimately. However, at its least harmful the new requirement removes the opportunity to protect one's personal information from disclosure, a requirement that is against the weight of international law, state law and the U.S. government's own guidance. At its most harmful, it creates a significant risk of bodily harm.

The balance of the potential harm to applicants and the potential benefit to the trademark registration system risk is undoubtedly open to debate, but the USPTO's rulemaking process failed to invite comment on, consider, or weigh *any* countervailing reasons why it would be inadvisable to require a street address. The USPTO therefore has not properly promulgated the new rules.

**B. Violation of the Administrative Procedure Act: the New Rules and Their Implementation Are Not a “Logical Outgrowth” of the Regulations Proposed in the NPRM**

If a final rule is not a “logical outgrowth” of the rule as proposed, then the change requires a new round of notice and comment.<sup>39</sup> The fact that the rule change is in response to the public comments does not excuse the agency from this requirement.<sup>40</sup>

There is no logical antecedent in the NPRM for Rule 2.189 in the Final Rule. The NPRM stated expressly that the purpose was “to require applicants, registrants, or parties to a proceeding *whose domicile or principal place of business is not located within the United States (U.S.) or its territories ... to be represented by an attorney ...*”<sup>41</sup> There was no mention or suggestion whatsoever in the NPRM that there would be any impact on *U.S. domestic* applicants or registrants. It was therefore unforeseeable from the NPRM that the USPTO would add in the Final Rules a new, very broad rule allowing the USPTO to seek evidence of a U.S. applicant's residence at all and further that, contrary to its past practices, a post office box or “care of” address would no longer be acceptable.

The NPRM was also specifically limited to the purpose of ensuring that foreign applicants were represented by counsel. It was therefore unforeseeable from the NPRM that a represented applicant or registrant would be asked for documentation of their domicile information, to be denied a registration if it fails to comply.

For these reasons, this rule is not a “natural outgrowth” of the rulemaking process and therefore the rule was improperly promulgated and is unenforceable.

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39 *Mid Continent Nail Corp v U.S.*, 846 F.3d 1364, 1373–74 (Fed. Cir. 2017).

40 *Id.*

41 NPRM at 4,393, col. 3 (emphasis added).

**C. Violation of the Paperwork Reduction Act: the Rules Add Substantial Burden, But the USPTO Stated That No New Burden Exists**

The Paperwork Reduction Act (PRA)<sup>42</sup> and implementing regulations<sup>43</sup> promulgated by the Office of Information and Regulatory Affairs (OIRA) within the Office of Management and Budget (OMB) protect the public from burdensome regulations that involve any activity involving “collection of information” or submission of paperwork by or on behalf of an agency. The Act requires “Agencies ... to minimize the burden on the public to the extent practicable.”<sup>44</sup> It requires agencies to do several specific analyses, including asking the public for specific feedback, before promulgating any new rule of general applicability that requires submission of paperwork. In the context of the USPTO, the Paperwork Reduction Act covers essentially all USPTO rulemaking and essentially all papers that must be filed.

The NPRM and Final Rule notice concede that burdens cognizable under the Paperwork Reduction Act are altered or added. For example, the Final Rule notice states:

*P. Paperwork Reduction Act: This rulemaking involves information collection requirements that are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.). The collection of information involved in this rule has been reviewed and previously approved by OMB under control numbers 0651-0009, 0651-0050, 0651-0051, 0651-0054, 0651-0055, 0651-0056, and 0651-0061. We estimate that 41,000 applications will have an additional burden of 5 minutes due to this rulemaking, adding in 3,000 burden hours across all trademark collections.*

The USPTO’s statement that “The collection of information involved in this rule has been reviewed and previously approved by OMB” is inaccurate. Review of the relevant Paperwork Reduction Act pages at the web site for the Office of Management and Budget show that the USPTO did not file anything relating to this rulemaking and its new information collection burden as it was required to do.<sup>45</sup> The USPTO must have known that the statement was inaccurate – the Final Rule notice states that “41,000 applications will have an additional burden of 5 minute due to this rulemaking, adding in 3,000 burden

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42 44 U.S.C. §§ 3501–3520.

43 5 C.F.R. Part 1320, especially §§ 1320.5, 1320.8, 1320.9, and 1320.11.

44 *Dole v. United Steelworkers of America*, 494 U.S. 26, 32 (1990), citing 44 U.S.C. § 3507(a)(1).

45 See Office of Information and Regulatory Affairs, *OMB Control Number History*, [https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0009, -0050, -0051, -0054, -0055, -0056, and -0061](https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0009,-0050,-0051,-0054,-0055,-0056,-0061) (last visited Sep. 1, 2019) (showing that none of the cited control numbers reflect any filing during the relevant time periods for relevant information collections, let alone approval of 37 C.F.R. § 2.189).

hours across all trademark collections.<sup>46</sup> However, the USPTO made not a single filing with OMB to update the paperwork burden.<sup>47</sup>

The statistics the USPTO relied on for its claim that there was no substantial burden also conveniently told only part of the story. The Final Rule notice claimed that only 41,000 applications would have a 5-minute burden for a total of 6000 hours. The USPTO did not explain which 41,000 it was referring to, but, given that there were over 870,000 applications pending at the time the USPTO culled its data,<sup>48</sup> it is presumably the number of foreign pro se applications. First, the USPTO's calculation fails as a matter of arithmetic ( $41,000 \times 5 / 60 = 3416.67$  hours). It also fails to include all the other applications, U.S. and foreign, that would be affected. Specifically it did not include:

- Data on the cost for attorneys to add their bar number, state of licensure, and a statement of good standing in most pending applications.<sup>49</sup> This requirement may involve filing a document that would have previously been unnecessary.<sup>50</sup> Assuming only half of the pending applications required this update by a separate paper, the total cost would be  $870,000 \text{ applications} / 2 \times 20 \text{ minutes per paper} = 145,000 \text{ hours}$ , at \$36.2 million.
- Data on the number of applicants that use post office box "care of" or "similar variation" addresses who will now receive an Office Action requiring different address information.<sup>51</sup> Assuming 10% of applications receive an Office Action requiring a response with updated address information, the total cost would be  $870,000 \text{ applications} / 10 \times 20 \text{ minutes per paper} = 29,000 \text{ hours}$ , at \$7.2 million.
- Data on the cost for applicants and attorneys to provide documentation proving their domicile.<sup>52</sup> Assuming 5% of applications receive an Office Action requiring proof of domicile, the total cost would be  $870,000 \text{ applications} / 20 \times 30 \text{ minutes per paper} = 21,750 \text{ hours}$ , at \$5.4 million.

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46 Final Rule at 31,500.

47 See Office of Information and Regulatory Affairs, *OMB Control Number History*, <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0009,-0050,-0051,-0054,-0055,-0056,-0061> (last visited Sep. 1, 2019) (showing that none of the cited control numbers have been updated since 2018 or earlier).

48 USPTO Data Visualization Center Trademarks Dashboard, <https://www.uspto.gov/dashboards/trademarks/main.dashxml> (last visited Sep. 9 2019).

49 Revised Exam Guide at II ("The requirement for bar information is not tied to the domicile of the applicant and is required of all attorneys representing applicants at the USPTO, except as discussed above in Section I.B.1.")

50 Revised Exam Guide at I.A.2.a (describing how applicant who must respond to an Office Action must first file a TEAS Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative form and then submit a response to the Office Action).

51 Revised Exam Guide at I.A (describing requirement to provide street address).

52 Revised Exam Guide at I.A.2 (describing requirement to submit proof to the USPTO during trademark examination).

- Data on the cost of asking for a waiver of the requirement to make a domicile public.<sup>53</sup> Assuming 1% of applications ask for a waiver, the total cost would be 870,000 applications / 100 x 30 minutes per paper = 4,350, at \$1.1 million.

Therefore a rational estimate of the costs the USPTO failed to consider is a total of almost \$50,000,000.

The USPTO further underestimated the number of foreign applicants who would be affected and therefore the cost of compliance. If, as the USPTO claims, there are foreign applicants using post office boxes and “care of” address, these individuals have not been counted in the USPTO’s summary of foreign applications.<sup>54</sup>

These are burdens the USPTO did not include in its reporting on the Paperwork Reduction Act.

Likewise, the NPRM and Final Rule notice fail to observe the procedural requirements under the Paperwork Reduction Act and its implementing regulations, *e.g.*, 44 U.S.C. §§ 3506 and 3507; 5 C.F.R. § 1320.5(d), § 1320.8(d)(1). For example, § 1320.8(d) requires an agency to ask four specific questions in its NPRM, and provide the public with 60 days to comment on any new regulation that demands paperwork. The USPTO did neither.

Because the USPTO never sought Paperwork Reduction Act clearance from OMB, OMB never issued a valid control number. Without a valid OMB control number for the information it proposes to collect as a result of the revised rules, the USPTO has no authority to enforce the rules (or any other paperwork to be collected under this Final Rule).<sup>55</sup>

The PTO’s failure to make a good faith estimate of burden, and to instead incorrectly state that there is none, both invalidates the PTO’s legal authority to enforce the rule, 44 U.S.C. § 3512, and is deeply troubling as a matter of respect for the rule of law. The USPTO’s best alternative for correction today is to issue a “never mind” notice in the Federal Register, analogous to the notice the USPTO ran in 2008 to suspend enforcement of the patent appeal rules,<sup>56</sup> and start over again with a rulemaking that complies with the requirements of the law.

#### **D. Violation of the Regulatory Flexibility Act**

The Regulatory Flexibility Act (RFA)<sup>57</sup> protects small businesses from excessively burdensome regulation. In addition, Executive Order 13,272<sup>58</sup> requires agencies to assess the impact that their

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53 Revised Exam Guide at I.A.4.

54 Final Rule at 31,501, col. 3, 31,502 col. 1 (stating that the statistics given are for those listing a domicile or address outside the United States).

55 44 U.S.C. § 3512; 5 C.F.R. § 1320.6.

56 U.S. Patent and Trademark Office, *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Delay of Effective and Applicability Dates, Final Rule; Delay of Effective and Applicability Dates*, 73 Fed. Reg. 74972 (Dec. 10, 2008).

57 5 U.S.C. §§ 601–612.

58 Executive Order 13282 (2002) (available at <https://www.sba.gov/advocacy/executive-order-13272-august-13-2002>).



proposed regulations will have on small entities. The RFA and Executive Order 13,272 are administered by the Small Business Administration, Office of Advocacy.<sup>59</sup>

Courts have generally held that the RFA applies broadly to all direct economic “impacts” on small businesses, not just Paperwork burdens.<sup>60</sup> The RFA does not require agencies to minimize economic impacts, but only to fairly evaluate and account for them – the legislative history expresses the hope that if agencies are forced to account for the effects of regulation, they will seek to avoid promulgating poorly-tailored and excessively-burdensome regulations on small entities. Executive Order 13,272 fills that gap, and directs agencies to minimize impacts.

The NPRM and Final Rule both say “The costs to comply with the requirement proposed herein would be borne by foreign applicants, registrants, and parties. The [proposed requirement/rule] would not impact individuals or large or small entities with a domicile or principal place of business within the U.S.”<sup>61</sup> That is simply not true; many U.S. domiciled applicants will have to provide different address information, some will have to provide actual evidence of domicile, and all U.S. domiciled applicants will have to absorb the cost of their attorney adding bar information.

The Final Rule also says the USPTO only estimated costs for representation “for pro se applicants and registrants with a domicile outside the U.S. or its territories.”<sup>62</sup> The USPTO therefore did not include in its estimate those costs also borne by U.S. domiciled applicants and registrants described above. Taking only the matter of foreign applicants with U.S. addresses, the USPTO stated that there were 50,742 “foreign trademark filings” in 2017.<sup>63</sup> If we assume that a modest 15% of these applications are U.S. residents even though of foreign citizenship,<sup>64</sup> and that the average cost per response to provide proof of domicile is also a modest \$200, the PTO’s Regulation Flexibility Analysis estimate is low by \$1,500,000 per year for this single requirement alone. The agency’s cost estimate is therefore a significant underestimation of the costs to be borne by small businesses.

Finally, the USPTO neglected to consider impact on a large class of small entities: the lawyers. Most trademark attorneys work for small entity law firms. This regulation imposes significant new costs

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59 Small Business Administration Office of Advocacy, <http://www.sba.gov/advo/> (last visited Sep. 10, 2019).

60 *American Federation of Labor v. Chertoff*, 552 F.Supp.2d 999, 1012 (N.D. Cal. 2007) (Regulatory Flexibility Act (RFA) analysis must consider economic impacts on small employers); *Home Builders’ Ass’n of Northern Cal. v. U.S. Fish & Wildlife Service*, 268 F.Supp.2d 1197, 1234 (E.D. Cal. 2003) (remanding rule because agency failed to analyze economic impact on small homebuilders of protecting snake habitat); *Harlan Land Co. v. U.S. Dep’t of Agriculture*, 186 F.Supp.2d 1076, 1097 (E.D. Cal. 2001) (rule vacated because agency’s investigation of the possible effects of introduction of agricultural pests on small farmers on was flawed); *Southern Offshore Fishing Ass’n v. Daley*, 55 F.Supp.2d 1336, 1338 (M.D. Fla. 1999) (regulatory flexibility analysis must consider economic costs to fishermen of replacing boats), *vacated by settlement*, *Southern Offshore Fishing Ass’n v. Mineta*, 2000 WL 33171005, 2000 U.S. Dist. Lexis 20496 (M.D. Fla. Dec. 7, 2000).

61 NPRM at 4,401; Final Rule at 31,508, col. 2.

62 Final Rule at 31,508.

63 Final Rule at 31,500.

64 This estimate is based on the number of applications in 2018 where the word “corporation” or “individual” was adjacent to the word “China” in the owner field and how many of those applications also had the name of a U.S. state in the owner field.

on small firm lawyers, costs that may not be recoverable (for example, under fixed fee arrangements). It also creates substantial new malpractice liability.

#### **E. Violation of Executive Order 13771**

The Final Rule notice reads as follows:

*E. Executive Order 13771 (Reducing Regulation and Controlling Regulatory Costs): This rule is not subject to the requirements of Executive Order 13771 (Jan. 30, 2017) because it is expected to result in no more than *de minimis* costs to citizens and residents of the United States.*

This representation is counterfactual or unlawful in several respects:

- The Final Rule notice adds a new regulation, 37 C.F.R. § 2.189, without repealing two others. The Executive Order 13771 section of the Final Rule notice does not inform OMB or the Department of Commerce that the PTO is not in compliance with the President’s regulatory budget concept.
- The representation of costs is false. The rule imposes significant, undisclosed costs as explained in IV.C and IV.D.
- Likewise, Executive Order 13771 requires an agency to consider *all* costs—there is no carveout in the Executive Order or OMB’s implementing guidance that empowers agencies to consider only effect on “citizens and residents of the United States.” Agencies do not have authority to effectively exempt themselves from laws by rewriting them.

#### **V. REQUEST FOR RULEMAKING**

The USPTO has authority to decide this Petition under at least 5 U.S.C. § 553(e) of the Administrative Procedure Act (“APA”), which provides that “[e]ach agency shall give an interested person the right to petition for the issuance, amendment, or repeal of a rule.” The Petitioner asks the USPTO to do so here.

The Petitioner firmly supports the USPTO’s goal of reducing the number of fraudulent or inaccurate registrations. However, the creation of the new rules 2.2(o) , 2.2(p) and 2.189 and their implementation in the Revised Exam Guide are beyond the USPTO’s statutory authority, and each was procedurally defective. Further, the failure of the USPTO to limit the rule to only the situation where a foreign applicant is unrepresented is arbitrary and capricious and in excess of statutory jurisdiction.

And all of these unnecessary and unlawful requirements come at great cost to applicants. By requiring residential addresses, victims of abuse and stalking are placed at significant risk of harm, small business is being disadvantaged, and ordinary businesses will have to adjust their mail handling practices. The USPTO has failed to consider these important aspects of the problem in its rulemaking and the rulemaking was therefore unlawful.

## VI. CONCLUSION

The Federal Register notices leave no doubt that the USPTO did not consider the possibility that it would create so many problems when it added what perhaps to the USPTO seemed like a modest requirement. But that is what the rulemaking process is for, an opportunity to learn from those who might be affected and ensure that there is an appropriate balance of the problem to be solved against the interests of those affected by it. It is a step that was missed because the USPTO did not follow statutory instructions for amending its rules. The Petitioner therefore respectfully asks that the USPTO temporarily suspend implementation of newly-promulgated Rule Rules 2.2(o), Rule 2.2(p) and 2.189, and the Revised Exam Guide § 4-19 to the extent it requires providing physical address information, and to undertake a new notice and rulemaking process to add more appropriately constrained rules.

The Petitioner hopes for the courtesy of a response in 30 days.

Respectfully submitted,

SOFTWARE FREEDOM CONSERVANCY, INC.

Date: September 18, 2019

By: 

Pamela S. Chestek  
Chestek Legal  
P.O. Box 2492  
Raleigh, NC 27602  
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## **Exhibit B**

**Page from the 2019 *AIPLA Economic Survey***

## EXHIBIT B

### Trademark Clearance Search, Analysis, and Opinion by Location (Q41a)

	Total	Location													
		Boston CMSA	NYC CMSA	Phila CMSA	Wash, DC CMSA	Other East	Metro South- east	Other South- east	Chicago CMSA	Minne- St. Paul PMSA	Other Central	Texas	L.A. CMSA	S.F. CMSA	Other West
Number of Respondents	265	10	28	11	20	15	14	16	23	7	54	12	10	7	38
Mean (Average)	\$1,515	\$3,280	\$1,408	\$1,568	\$1,021	\$1,287	\$1,279	\$1,217	\$1,658	\$1,279	\$1,235	\$1,667	\$2,550	\$1,607	\$1,691
10th Percentile 10%	\$500	\$750	\$485	\$1,000	\$253	\$450	\$353	\$305	\$580	ISO	\$425	\$545	\$1,710	ISO	\$495
First Quartile 25%	\$750	\$938	\$800	\$1,200	\$500	\$600	\$675	\$705	\$1,000	\$800	\$713	\$725	\$2,513	\$1,000	\$575
Median (Midpoint)	\$1,200	\$2,000	\$1,500	\$1,500	\$725	\$1,200	\$1,200	\$1,100	\$1,500	\$1,400	\$1,000	\$1,200	\$2,750	\$1,400	\$1,200
Third Quartile 75%	\$2,000	\$5,625	\$1,800	\$2,000	\$1,649	\$2,000	\$2,000	\$1,763	\$2,000	\$1,500	\$1,575	\$2,375	\$2,750	\$2,500	\$2,500
90th Percentile 90%	\$2,750	\$7,500	\$2,410	\$2,400	\$2,000	\$2,600	\$2,325	\$2,150	\$3,000	ISO	\$2,500	\$4,325	\$2,750	ISO	\$3,000

### Trademark Registration Application (Preparation and Filing) by Location (Q41b)

	Total	Location													
		Boston CMSA	NYC CMSA	Phila CMSA	Wash, DC CMSA	Other East	Metro South- east	Other South- east	Chicago CMSA	Minne- St. Paul PMSA	Other Central	Texas	L.A. CMSA	S.E. CMSA	Other West
Number of respondents	320	8	31	11	27	16	15	17	26	8	69	19	14	10	49
Mean (Average)	\$930	\$1,294	\$826	\$988	\$874	\$913	\$1,039	\$804	\$1,131	\$688	\$749	\$1,331	\$1,027	\$943	\$840
10th Percentile	\$500	ISO	\$520	\$710	\$380	\$570	\$484	\$480	\$570	ISO	\$450	\$600	\$788	\$420	\$550
First Quartile	\$650	\$775	\$650	\$750	\$500	\$700	\$725	\$638	\$694	\$525	\$550	\$1,000	\$1,000	\$619	\$600
Median (Midpoint)	\$800	\$1,000	\$750	\$985	\$700	\$775	\$800	\$850	\$850	\$713	\$700	\$1,250	\$1,000	\$950	\$850
Third Quartile	\$1,000	\$1,500	\$1,000	\$1,200	\$1,500	\$1,144	\$1,000	\$1,050	\$1,050	\$831	\$838	\$1,500	\$1,200	\$1,025	\$1,000
90th Percentile	\$1,485	ISO	\$1,167	\$1,440	\$1,500	\$1,493	\$2,400	\$1,520	\$1,230	ISO	\$1,200	\$2,100	\$1,200	\$1,910	\$1,275

**Trademark Prosecution (Total, including amendments and interviews but not appeals) by Location (Q41c)**

	Location														
	Total	Boston CMSA	NYC CMSA	Phila CMSA	Wash, DC CMSA	Other East	Metro South- east	Other South- east	Chicago CMSA	Minne- sota CMSA	Other Central	Texas	LA CMSA	S.F. CMSA	Other West
Number of Respondents	249	8	26	11	21	12	13	17	19	6	54	11	10	4	37
Mean (Average)	\$1,423	\$2,725	\$1,115	\$2,264	\$1,310	\$1,100	\$1,614	\$1,046	\$1,784	\$1,500	\$1,211	\$1,305	\$1,770	\$1,938	\$1,382
10th Percentile 10%	\$400	ISO	\$379	\$1,120	\$304	\$145	\$288	\$300	\$500	ISO	\$433	\$360	\$810	ISO	\$370
First Quartile 25%	\$750	\$675	\$500	\$2,000	\$500	\$750	\$900	\$413	\$1,000	\$625	\$688	\$1,000	\$1,725	\$1,063	\$600
Median (Midpoint)	\$1,200	\$3,000	\$1,000	\$2,300	\$1,000	\$1,200	\$1,500	\$1,000	\$1,500	\$1,750	\$1,138	\$1,200	\$2,000	\$2,000	\$1,200
Third Quartile 75%	\$2,000	\$4,625	\$1,500	\$2,500	\$2,000	\$1,500	\$2,000	\$1,748	\$2,500	\$2,125	\$1,500	\$2,000	\$2,000	\$2,750	\$2,000
90th Percentile 90%	\$2,500	ISO	\$2,545	\$3,400	\$2,500	\$1,850	\$3,600	\$2,040	\$3,000	ISO	\$2,000	\$2,000	\$2,000	ISO	\$2,420

# **Exhibit C**

**Raw data of estimates from the public**

average time to prepare and file a TM application -- information gathering, counseling, choosing, preparing, filing, record retention (in the average, include the outliers on days when everything goes wrong)	your estimate for client time (counseling, searching old records, reviewing the doc, record retention)
3 hours	
2-2.5 hrs	
3.0 hours	
3.0 hr	
4 hours	
3 hours	
7 hrs (av due to new SB cl's)	
4.5 hours	
3.5 hours	
3 hours	
3 hours	1.5 hours
2.5 hrs	
3 hrs	
3 hrs.	
3 hrs	
3.5 hours	
3 hours	
3 hours	
3.5 hours	
4 -5 hours	
4 hours	1.5 hours
3 hours	1 hour
3 hours	
3.5 hours	1 hour
3.5 hours	1 hour
3 hours	1.5 hours
2.5 hours	1 hour
3 hours	1 hour
3 hours	1 hour
2.5 hrs	i hr
2-3 hrs	1-2 hours
2-3 hrs	1-2 hrs



## **Exhibit D**

**Comment letters in response to 60-day notice,  
from  
[https://www.regulations.gov/document/PTO-T-  
2020-0069-0001/comment](https://www.regulations.gov/document/PTO-T-2020-0069-0001/comment)**

## COMMENTS:

I. This comment responds to the Paperwork Reduction Act (PRA) required inquiry with respect to the burden attendant to the initial filing of a Trademark Application (the “Burden”) with the USPTO (or “Agency”).

My understanding that the Agency has estimated the Burden to be well under an hour. I believe that to be an absolute, bare minimum applicable only to a tiny fraction of trademark owners such as described below. As such, it is simply disingenuous for the Agency to promulgate such miniscule number.

(A) 1. As counsel to small businesses that may have only one of a handful of marks, I find that 8-12 hours is a realistic estimate of the total Burden to file an initial mark. Why? One first has to explain various standards applicable to the filing: e.g., what constitutes Tm usage, specimen requirements, etc. This takes significant time, often with multiple communications “back-and-forth.” Moreover, the averments in the required Declaration often need explanation as does the spectre of the “fine or imprisonment” penalty clause. With all that done, the Application must be prepared and the Applicants signature procured.

2. As indicated, the Burden for interactions above for a client’s first mark can be 8-12 hours. The this writer considers filing a client’s initial mark to be a hybrid of marketing loss-leader and pro bono. Subsequent marks stand to be perhaps half that for an attentive client.

3. Note that the actual filling in and filing of an Application can itself run close to an hour including proof-reading, double-checking specimens, etc. But that has to be perhaps doubled by amortizing the time wasted dealing with the too-frequent TEAS and TEAS+ systems problems.

(B) Likely large consumer companies with significant Tm portfolios may do better since counsel (inhouse or otherwise) may be more familiar with the client’s products, business practices, etc. Likewise some clients may have staff to better chose specimens. In an exceptionally well-run operation perhaps an occasional Application has a one-hour Burden, but again, considering TEAS system glitches. Still, less than two hours start to finish seems rare.

(C) To all the foregoing one must add the overhead of studying Agency rules, of petitioning for a Domicile Address exception, and like overhead which for low volume filers adds at least another hour to the Burden of an Application.

(D) Conclusion: My generous estimate across all filers puts the average Burden of six (6) hours.

## II. Domicile Address requirement.

This suffers from two infirmities:

(A) It’s unjustified. The nominal explanation is for cases such as counsel of record disappearing or failing to cooperate, so the Agency must contact the

Applicant directly and email fails. This is such a rare occurrence that the invasion of privacy and Burden on the whole body of trademark applicants is simply without justification (or if somehow justified, the Agency has failed to document it).

(B) The Agency suddenly sprang the Domicile requirement on all applicants without proper Notice and Comment.

III. Attorney Bar requirement. Likewise promulgated w/out Notice & Comment

In lighFor the foregoing,

\*\* Trademark Application should be figured as at least six (6) hours

\*\* Domicile and Attorney Bar requirements should be stricken from the Application .

Respectfully submitted,

Michael M Krieger, member, State Bar of California



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16 February 2021

Kimberly Hardy  
Office of the Chief Administrative Officer  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Re: Notice of Information Collection No. 0651-0009 (Applications for Trademark Registration)

Dear Ms. Hardy:

I am an attorney with 18 years of experience in the practice of trademark law. My practice consists largely of assisting clients in preparing and prosecuting trademark applications and trademark maintenance documents. I am thankful for the opportunity to provide information on submissions required by the regulations at 37 CFR part 2 for initial applications regarding the registration of trademarks and service marks.

The Patent and Trademark Office estimates that the average time spent preparing a trademark or service mark application is between 40 and 50 minutes. This estimate is low. At best these estimates might cover the time to physically complete and file the application, but not the time spent in collecting and analyzing all the information necessary to prepare the application, especially for a "complete" application using TEAS-Plus. These estimates do not include everything that comprises the definition of "burden." See the definition of "burden" at <https://www.law.cornell.edu/cfr/text/5/1320.3#b>.

As an attorney, one of my primary duties is to help clients in procuring a trademark registration that accurately reflects how they use their marks in an efficient and cost-effective manner. To accomplish this goal, I need to interview clients about their marks and the goods and services on which they use, or intend to use, the mark. I also need to find out their goals, develop a budget, describe the application process, and counsel them on potential risks and benefits for registering a particular mark. Additionally, I need to collect information that is required to comply with the Lanham Act and the PTO's regulations. Finally, as an attorney, I have a duty to ensure that the information I submit is true and accurate.

All of this requires my time and my client's time. Moreover, most clients would prefer to avoid an office action due to incomplete application. So this tends to require intensive information collection to prepare an application. In particular, I need to determine that the proposed does not run afoul of Section 2 of the Lanham Act and to counsel a client if such a

potential exists. I need to assist the client in developing an identification of goods and services that reflects the client's use and complies with the requirement that the identification is sufficiently definite. If the mark is based on use, I need to collect the dates of first use and review the specimens to ensure that they comply with the requirements of the Lanham Act and PTO regulations and guidance. Additionally, the client will need to disclose any translation and transliteration of the mark, any geographic significance, or significance in the trade or industry and provide a description of the mark.

Moreover, the PTO has recently added additional information requirements concerning an applicant's domicile and an attorney's bar information for an application to ensure compliance with the requirement that foreign applicants have a U.S.-licensed attorney and to provide an electronic means to contact the applicant.

In light of these requirements, I estimate the average time to prepare an application is closer to 100 to 120 minutes than 40 to 50 minutes.

I would like to note that the PTO seems to assume that acquiring an applicant's email address, its domicile address, and an attorney's bar information is frictionless and costless. This is incorrect. Most applicants do not initially provide an email address or distinguish between its physical domicile address and its mailing address. So application requests often come with this information omitted. So additional time is needed to follow up with the client and frequently to explain why the PTO requires this information.

Individual applicants do not understand why they need to disclose the place where they sleep when they already have an attorney or have disclosed the physical address of their place of business. After all the purpose of the rule is to ensure that a foreign applicant is not trying to avoid the U.S.-counsel rule by claiming a U.S. post office box or mail drop as its address. However, that purpose is not served when an individual applicant discloses its physical place of business or is already represented by a U.S. attorney.

Meanwhile, collecting an attorney's bar information also adds to some time to completing an application without any clear benefit. In most states, an attorney's name, bar number, and date of admittance are a matter of public record and are often available online. So it is a simple matter for a foreign applicant to fake representation by finding an attorney from an online bar directory and enter the information in an application without the attorney's knowledge. In fact, this has already happened, and so far the PTO's response has been merely to ask an applicant find a U.S. attorney.

In any case, the PTO's estimates for preparing and application fails to capture the time and the attendant costs of obtaining and providing information about where a client sleeps and an attorney's bar information.

Ultimately, the PTO has significantly underestimated the time for collecting information necessary to prepare an application. It continues to do so even as it has increased the information necessary to file an application. As a result, it has significantly underestimated the costs of its new requirements for disclosing where an applicant sleeps and the attorney's bar information. If

these costs were considered, it is doubtful the limited usefulness of the physical address for an individual applicant and the attorney bar information are justified by their costs.

Best wishes,

A handwritten signature in blue ink that reads "Robert S. Pierce". The signature is fluid and cursive, with a long horizontal stroke at the end.

Robert S. Pierce  
JACOBSON HOLMAN PLLC  
Direct Line: 202-628-4268  
[\[rpierce@jhip.com\]](mailto:rpierce@jhip.com)

RSP

Supplementing a comment submitted yesterday (tracking number kl7-295j-ck5k), additional comments on the TEAS system needed to be provided.

First, the TEAS application form should be revised to provide additional characters for entering an applicant's address. The address fields are inadequate to provide full address details for many non-US addresses, including a limitation of 40 characters for the city name.

Second, there is no need for a warning message regarding the applicant's telephone number. This information is not required, and it should be up to the applicant or its counsel to choose to make this information public for scammers to abuse.

Third, with the all-to-frequent TEAS instability (it crashed on two browsers today), the save form option should appear on each page, allowing an applicant to save work being entered and not have to repeat work, which repetition increases the time involved in filing an application.

Fourth, if there are issues in the TEAS system, the USPTO should promptly post a notice on the TEAS form page, as well as specific filing type pages, so that applicants do not waste time in having to deal with system crashes, at least for non-urgent filings.

Fifth, the TEAS response to Office Action form should allow for an applicant to provide Section 44(e) registration information for multiple classes, rather than requiring the same information to be entered for each individual class, thereby increasing the amount of time an applicant has to spend on responding to office actions.



Comments on 88 FR 82456, Document Number: 2020-27904

The estimated times stated in the Notice are far below the actual amount of time involved, and accordingly, the costs to the public are higher.

I consider myself an experienced trademark attorney and have filed close to 1000 trademark applications in under 30 years of practice. I have been using the TEAS system since it was introduced by the USPTO, and have filed hundreds of applications using TEAS Plus and TEAS Standard (or regular TEAS as it was known prior to the recent changes).

The time estimates for filing new trademark applications using TEAS Plus or TEAS Standard do not accurately take in to account the true amount of time involved, and therefore understate the burden to applicants. The Notice identifies that the time estimate should cover gathering information, preparing documents, and submitting the information to the USPTO. The Notice also separates respondents by “Private Sector” and “Individuals or Households” (referred to as individuals herein).

Gathering information has different time requirements for private sector businesses than for individuals. For businesses that may have filed one or more trademark applications, such businesses may have a basic understanding of the information needed for a trademark application. However, for businesses new to trademark filings, the time involved in learning what is required may be the same as for individuals. Further, it may be faster for trademark filers to work with experienced trademark counsel, rather than to spend time learning about the trademark system from reading through pages on the USPTO web site, or third party materials. The time saved by using experienced trademark counsel is offset by the cost of using counsel for the filings.

The Notice identified 45 minutes as an estimated time for a use based TEAS Standard application, and 50 minutes for a TEAS Plus application based on use, with intent to use applications being five minutes less. These estimates are inaccurate when the steps involved in a trademark application are considered, as set out below with average amounts of time involved:

- 1) Identifying the trademark – taking into consideration whether the trademark may be rejected based on existing marks, or on grounds of descriptiveness, and educating the applicant about these risks – 15 minutes
- 2) Identifying the proposed goods and/or services – determining whether the proposed goods and services may exist in the ID manual, and therefore allowing for a TEAS Plus filing – 20 minutes on average, due to the poor interface of the ID manual
- 3) Identifying the applicant – considering whether an individual or corporate entity should be the applicant, and confirming the details of the applicant, and whether there are reasons for concealing the physical address of an applicant for safety concerns – 20 minutes (not including the formation of a new corporate entity)
- 4) For applications based on use – reviewing potential specimens of use, and making sure that the specimens will not be refused based on the standards set by the USPTO, which are often abused by USPTO personnel – 15 minutes
- 5) Obtaining a signed declaration in advance of filing the application, including preparing

a document for signature, or ensuring that the applicant or a representative of the applicant will be able to electronically sign the application when it is submitted – 15 minutes

6) Filing the application, through payment –

- a) filling out the TEAS Standard form for average listing of goods and/or services – 15 minutes;
- b) filling out the TEAS Plus form for average listing of goods and/or services – 30 minutes;
- c) filling out the TEAS Plus form for a lengthy listing of goods and/or services – 50 minutes

7) Review of the application filing receipt and reporting the filing to the client – 15 minutes

Total times based on the above:

- A) Use based TEAS Standard – 100 minutes
- B) Use based TEAS Plus (average) – 115 minutes
- C) Use based TEAS Plus (lengthy) – 135 minutes
- D) Intent to use TEAS Standard – 85 minutes
- E) Intent to use TEAS Plus (average) – 100 minutes
- F) Intent to use TEAS Plus (lengthy) - 120 minutes

The TEAS Plus system shifts the costs of an application to the applicant more than the savings of the \$100 filing fee, primarily due to the difficulty of using the selection of the goods and services. For all of the changes made to the TEAS system over the past few years, that component has remained unchanged, despite the USPTO's apparent desire to have applicants use TEAS Plus.

The increased scrutiny of specimens by the USPTO has increased the costs of an application. Often, applicants prepare professional quality photographs of products for display on a web site, where the background of the photograph is plain white. The USPTO staff regularly object to such photographs as mockups, ignoring the commercial reality of how the photographs are used, and as such, applicants are encouraged to take additional photographs, in poor quality, just to avoid specimen refusals. This increases the costs for use based applications.

The time estimate for communicating with the client (foreign or domestic) and preparing a trademark application is too low. Private lawyers dealing with clients who are questioning about what is and should they file a trademark, plus the cost, spend more time to file an application than set forth.

I am a trademark attorney and have been in practice for nine years. The USPTO's estimated time per response, which ranges from 40 to 50 minutes, seems low in my experience. It likely takes me about that amount of time to complete and file an application, but the actual burden—which must account not only for time spent filling out the form, but also time spent collecting and analyzing the information required to prepare it—is realistically closer to two hours on average, depending on an application's complexity and filing basis.

Before I begin an application, I first must compile a significant amount of information. The process requires gathering material from clients about their business, including, but not limited to, determining ownership of the application, claims of priority, and/or related properties; judging whether the mark requires a translation or has particular meaning in the relevant industry; for design marks, preparing an adequate drawing of the mark; determining whether the mark is famous or has acquired secondary meaning (1(a) only); determining how the mark is or will be used and marketed in commerce and through which trade channels; identifying the relevant classes of goods and/or services (g/s); selecting or drafting adequate descriptions of the g/s; confirming commercial use of the mark (1(a) only); and selecting and preparing a sufficient specimen of use (1(a) only).

Two collections of information should be disapproved. The public estimates burden at \$50 million. The December 18 notice in the Federal Register does not disclose this new burden, does not book it in the estimates, and does not offer any disagreement with the public's burden estimate. The Office offers no objective support for its estimate of zero.

First, in 2019, the Trademark Office issued guidance that requires disclosure of a trademark applicant's "domicile address." For many trademark owners, this means putting personal address information into the public record. Gathering of information, and updating existing files, are substantial burden. Further, for trademark owners that are individuals, disclosure of personal information places them at personal risk.

Second, in 2019, Trademark Office promulgated a final rule that requires disclosure of attorney bar information. But the Office didn't update its forms and filing practices or information technology to make this easy. Attorneys are forced to go through some rather baroque contortions to comply.

The Office's non-observance of law is shocking. In both cases, the Trademark Office evaded the public comment requirements of the Administrative Procedure Act and under the Paperwork Reduction Act. Instead, both collections of information were promulgated either as guidance with no regulatory support, or dropped into a final rule without notice and comment. The PTO never asked the four questions required by 44 U.S.C. § 3506(c)(2)(A) and 5 C.F.R. § 1320.8(d)(1) to allow the public to offer alternative means to the Trademark Office's end, nor to correct the Trademark Office's misestimate of burden. A petition for rulemaking that estimates burden at \$50 million was filed over a year ago; the Trademark Office has taken no action.

Several of the Office's certifications in this ICR are false. This information is not "necessary;" the trademark system has worked without these two bits of information for a century. The information lacks "practical utility"—the Office uses it in only a tiny minority of cases. Both increase burden on small entity applicants and small entity law firms. The Office gave no apparent consideration to "nature and extent of confidentiality"—email lists among trademark attorneys have noted scams that seem to be driven by the Office's mishandling of this information. Implementation is inconsistent with current reporting and recordkeeping—this information was not required in the past, and the PTO's forms and IT infrastructure were not restructured to make this easy. The Trademark Office does not "make appropriate use of information technology" to reduce burden.

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Please state explicitly in your filings to OMB that these two collections of information are dropped, and issue a Federal Register notice stating that they have been rescinded.

# CAMBRIDGE TECHNOLOGY LAW LLC

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December 22, 2020

Via Email InformationCollection@uspto.gov

Kimberly Hardy  
Office of the Chief Administrative Officer  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Re: Comment Request, *Applications for Trademark Registration*, 0651-0009, and *Substantive Submissions Made During Prosecution of the Trademark Application*, 0651-0054, and *Trademark Submissions Regarding Correspondence and Regarding Attorney Representation*, 0651-0056, 85 Fed. Reg. 60973 (Sep. 29, 2020), 67522 (Oct. 23, 2020), 76540 (Nov. 30, 2020), and 82456 (Dec 18, 2020)

Dear Ms. Hardy:

Several collections of information should be removed from these three information collection requests before they are submitted to OMB for review. The public estimates burden to be over \$50 million per year. Further, the public estimates that one collection of information endangers the personal safety of applicants. The price of a human life is generally regarded as too large to be quantified for information collection purposes. Further, the PTO estimated burden at zero, and therefore did not consider the burden on the public of changing rules midstream in trademark applications, or in making personal residence information public. These two collections of information cannot be cost-benefit justified.

Further, the PTO acted unlawfully in promulgating these two collections of information, and this triennial review is a good time to prune them:

The two collections of information at issue are:

- Any rule that calls for submission of an applicant's "domicile address," including 37 C.F.R. § 2.32(a)(2) and § 2.189, and *Examination Guide 04-19* (August, 2019) ([https://www.uspto.gov/sites/default/files/documents/Exam%20Guide%2004-19\\_0.pdf](https://www.uspto.gov/sites/default/files/documents/Exam%20Guide%2004-19_0.pdf)), and *Examination Guide 04-19* (September 2019), <https://www.uspto.gov/sites/default/files/documents/Exam%20Guide%2004-19.pdf>.
- Any rule that calls for submission of an attorney's "bar information," including 37 C.F.R. § 2.32(a)(4) and the two *Examination Guides*.



Re: Comment Request, *Applications for Trademark Registration, 0651-0009, and Substantive Submissions Made During Prosecution of the Trademark Application, 0651-0054, and Trademark Submissions Regarding Correspondence and Regarding Attorney Representation, 0651-0056, 85 Fed. Reg. 60973 (Sep. 29, 2020), 67522 (Oct. 23, 2020), 76540 (Nov. 30, 2020), and 82456 (Dec 18, 2020)*

First, the burden of the “domicile address” and “attorney bar information” rules are explained in a petition for rulemaking that has been pending for over a year, attached hereto as Exhibit A. The PTO failed to recognize, and therefore consider, the substantial paperwork burden created by the requirement that attorneys include bar information. A place to provide the bar information was not included on every form. Therefore, as implemented, for some actions attorneys have to file a separate document for the sole purpose of providing bar information before they can file the document for the action being sought. As an example, if an attorney is withdrawing from the case, the attorney has to file a separate “Change Address or Representation” form to provide the (soon to be irrelevant) attorney’s bar information so that the attorney can next file the separate Request for Withdrawal as Attorney of Record form.

Second, the PTO estimates burden at zero. Knowledgeable commenters estimate burden at over \$50 million (see Exhibit A). The PTO offers no support for its estimate, and it’s obviously wrong.

Second, both of these rules were invalidly promulgated, in violation of the Administrative Procedure Act, Paperwork Reduction Act, Regulatory Flexibility Act, and several executive orders. The errors are explained in Exhibit A.

Third, the President issued Executive Order 13891 in August 2019, and the Department of Commerce issued its implementing regulation, 15 C.F.R. § 29.2(a). Both prohibit the PTO from treating guidance as mandatory or binding against the public. To the extent that either of these collections of information is not supported by a current regulation, it’s not currently lawfully enforceable, and should be removed from the PTO’s *Examination Guides* and from these three information collection requests.

Fourth, the Administrative Conference of the United States issued [recommendations](#) in August 2019 (that is, over a year ago):

1. An agency should not use an interpretive rule to create a standard independent of the statute or legislative rule it interprets. That is, noncompliance with an interpretive rule should not form an independent basis for action in matters that determine the rights and obligations of any member of the public.
4. An agency should prominently state, in the text of an interpretive rule or elsewhere, that the rule expresses the agency’s current interpretation of the law but that a member of the public will, upon proper request, be accorded a fair opportunity to seek modification, rescission, or waiver of the rule.

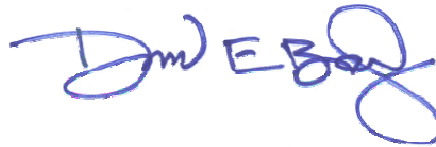
The PTO’s guidance conflicts with these recommendations.

A year after Executive Order 13891, a year after the ACUS recommendations, and three months after Commerce’s regulations, there’s no apparent effort by the PTO to implement any of the three. For example, a google search “13891 site:uspto.gov” gives zero relevant hits.

Re: Comment Request, *Applications for Trademark Registration, 0651-0009, and Substantive Submissions Made During Prosecution of the Trademark Application, 0651-0054, and Trademark Submissions Regarding Correspondence and Regarding Attorney Representation, 0651-0056, 85 Fed. Reg. 60973 (Sep. 29, 2020), 67522 (Oct. 23, 2020), 76540 (Nov. 30, 2020), and 82456 (Dec 18, 2020)*

The “domicile address” and “attorney bar information” collections of information should be removed from the PTO’s guidance documents and from these two information collection requests.

Very truly yours,

A handwritten signature in blue ink, appearing to read "Dm EBO", with a large loop at the end.

Attachments:

Exhibit A Software Freedom Conservancy, *Petition for Rulemaking under 5 U.S.C. § 553(e) to Limit the Use of Rule 2.189 and to Initiate Rulemaking under 5 U.S.C. § 553(b)-(d)* (Sept. 18, 2019)