

SF-83 SUPPORTING STATEMENT
PAPERWORK REDUCTION ACT – OMB CONTROL NUMBER 0651-0050
Proposed Addition to
ELECTRONIC RESPONSE TO OFFICE ACTION AND
PRELIMINARY AMENDMENT FORMS

A. JUSTIFICATION

1. Necessity of Information Collection

This collection of information is required by the Trademark Act, 15 U.S.C. § 1051 et seq., which provides for the Federal registration of trademarks, service marks, collective trademarks and service marks, collective membership marks, and certification marks. Individuals and businesses that use such marks, or intend to use such marks, in interstate commerce, may file an application to register their marks with the United States Patent and Trademark Office (USPTO). In some cases, the USPTO issues Office Actions to applicants requesting additional information that is required before the issuance of a registration. Also, the USPTO may determine that the mark may not be entitled to registration, pursuant to one or more provisions of the Act. In such cases, the USPTO may issue Office Actions advising applicants of the refusal to register the mark. Applicants reply to these Office Actions by providing the required information and/or by putting forth legal arguments as to why the refusal of registration should be withdrawn.

This package is being submitted in support of a notice of proposed rulemaking, “Changes in the Requirements for Filing Requests for Reconsideration of Final Office Actions in Trademark Cases” (RIN 0651-AC05) (Attachment A). The USPTO proposes to amend 37 CFR 2.64 to require a request for reconsideration of an examining attorney’s final refusal or requirement to be filed through the Trademark Electronic Application System (TEAS) within three months of the mailing date of the final action.

The USPTO proposes the amendment of 37 CFR 2.64 to streamline and promote efficiency in the process once a final action has issued in an application for trademark registration. By setting a three-month period in which to file a request for reconsideration of the final action, and by requiring that the request be filed through TEAS, the proposed amendment would facilitate the likely disposition of an applicant’s request for reconsideration prior to the six-month deadline for filing an appeal to the Trademark Trial and Appeal Board (TTAB) or petition to the Director on the same final action. This may eliminate the need for some appeals or petitions, and reduces the need for remands and transfers of applications on appeal.

A request for reconsideration of a final action does not extend the time for filing an appeal or petitioning the Director on that action. Under the current version of the rule, wherein the applicant may file a request for reconsideration at any time between the final action and the six-month deadline for appealing or petitioning, many applicants

simultaneously seek reconsideration and file an appeal. Because the examining attorney loses jurisdiction over the application upon the filing of an appeal to the TTAB, this simultaneous pursuit of reconsideration and appeal often necessitates a remand by the TTAB to the examining attorney for a decision on the request for reconsideration. If the request is denied, then the case is transferred back to the TTAB. If the request is granted, and the examining attorney reconsiders the final action, the appeal or petition may become moot. The need for these remands and transfers contributes to the burden on the applicant and the USPTO, and prolongs the pendency of the case.

In order to eliminate some appeals and petitions and reduce the need for these remands and transfers, the proposed rule provides that a request for reconsideration must be filed within three months of the final action, while the six-month period for appeal or petition remains unchanged. Normally, the examining attorney will reply to the request for reconsideration before the end of the six-month period to appeal or petition. To facilitate the prompt consideration by the examining attorney, the proposed rule further provides that the request must be filed through TEAS, which expedites the examining attorney’s notice of and access to the request.

The proposed earlier deadline and mandatory TEAS filing facilitate the likely disposition of the request for reconsideration prior to the deadline to petition or appeal. A grant of reconsideration within this timeframe will obviate the need for an applicant to file an appeal or petition, thus also saving the applicant the filing fee for an appeal or petition. A denial of reconsideration within this timeframe will obviate the need for a case on appeal to be remanded and transferred between the TTAB and the examining attorney. Under either scenario, the timeframe in the proposed rule promotes more efficient and prompt handling of the case, and achieves benefits both for the applicant and the USPTO.

Table 1 identifies the statutory and regulatory provisions that require the USPTO to collect the information:

Table 1: Information Requirements for Request for Reconsideration after Final Action

| Requirement | Statute | Rule |
|--|------------------|---|
| Request for Reconsideration after Final Action | 15 U.S.C. § 1051 | 37 CFR Part 2, 2.61(b), 2.62, 2.71, 2.72, 2.74 and 2.75 |

2. Needs and Uses

The proposed earlier deadline and mandatory TEAS filing facilitate the likely disposition of the request for reconsideration prior to the deadline to petition or appeal. A grant of reconsideration within this timeframe will obviate the need for an applicant to file an appeal or petition, thus also saving the applicant the filing fee for an appeal or petition. A denial of reconsideration within this timeframe will obviate the need for a case on appeal to be remanded and transferred between the TTAB and the examining attorney. Under either scenario, the timeframe in the proposed rule promotes more efficient and

prompt handling of the case, and achieves benefits both for the applicant and the USPTO. There is one form associated with this rulemaking.

The information in this collection is a matter of public record and is used by the public for a variety of private business purposes related to establishing and enforcing trademark rights. The information is available at USPTO facilities and can also be accessed at the USPTO’s website. Additionally, the USPTO provides the information to other entities, including Patent and Trademark Depository Libraries (PTDLs). The PTDLs maintain the information for use by the public.

Apart from the substantive components and burden statements, the TEAS forms also include a link to the USPTO’s Web Privacy Policy. This link, “Privacy Policy Statement” is located above the PRA Burden Statement found at the end of the “Wizard” and at the end of the forms themselves. The Web Privacy Policy Statement explains how the USPTO handles any personal information collected from the public through the website, and how it handles e-mails. Additionally, the statement also explains what information is collected through the USPTO’s Kids Pages, and whether and why the USPTO uses cookies to collect information. A copy of the USPTO’s Web Privacy Policy Statement is provided in this submission (Attachment B).

The Information Quality Guidelines from Section 515 of Public Law 106-554, Treasury and General Government Appropriations Act for Fiscal Year 2001, apply to this information collection and comply with all applicable information quality guidelines, *i.e.*, OMB and specific operating unit guidelines.

This proposed collection of information will result in information that will be collected, maintained, and used in a way consistent with all applicable OMB and USPTO Information Quality Guidelines. (See Attachment C, the *USPTO Information Quality Guidelines*.)

Table 2 lists the information identified in this collection and explains how this information is used by the public and by the USPTO:

Table 2: Needs and Uses of Information Collected for Request for Reconsideration after Final Action

| Form and Function | Form # | Needs and Uses |
|--|---------------|---|
| Request for Reconsideration after Final Action (Attachment D) | PTO Form 1930 | <ul style="list-style-type: none"> • Used by the public to request reconsideration of an examining attorney’s final refusal or requirement within three months of the mailing date of the final action. • Used by the USPTO to streamline and promote efficiency in the process once a final action has issued in an application for trademark registration. • Used by the USPTO to eliminate the need for some appeals or petitions, and reduce the need for remands and transfers of applications on appeal. |

3. Use of Information Technology

TEAS provides a useful service for all trademark filers. TEAS forms are completed on-line and transmitted to the USPTO electronically, via the Internet. The TEAS forms include “help” instructions, as well as a “Form Wizard” that tailors the form to the particular characteristics of the application and the mark in question, based on responses provided by the user to questions posed by the “Wizard.” The forms filed are received within seconds after transmission, and a confirmation of filing is immediately issued via e-mail to the user.

Users do not affix digital signatures to the TEAS forms. Instead, these forms are signed using a combination of alphanumeric characters that the user selects and types between two forward slashes. TEAS forms can be signed in this manner directly onto the form, or the text form of the application can be e-mailed to a second party who can then electronically sign the application. The forms can also be signed by hand by printing the signature page of the form, signing it in pen and ink, scanning the signed page, and then transmitting the entire form, including the scanned signature page, to the USPTO.

In addition to providing a system that allows the electronic transmission of trademark submissions, the USPTO also provides the public with on-line access to various trademark records. One such on-line product is the Trademark Electronic Search System (TESS), a web-based record of registered marks and marks for which applications for registration have been submitted. TESS can be used by potential applicants for trademark registration to assist in the determination of whether or not a particular mark may be available. The data in TESS is identical to the data reviewed by examining attorneys at the USPTO in their determination of whether marks for which registration is sought are confusingly similar to marks in existing registrations or to marks in pending applications for registration. TESS allows the user to choose from four different search tools, is updated daily, and is easy to use.

Another on-line record system provided by the USPTO is the Trademark Application and Registration Retrieval (TARR) system. TARR provides users with information regarding the status of trademark applications and registrations. The data in the TARR system is updated daily.

These systems are all accessible through the Trademark Electronic Business Center (TEBC), which in turn is accessed through the USPTO website. Thus, the USPTO offers a single source that provides a variety of systems useful both for making submissions to the USPTO and for tracking the status of these submissions. The TEBC also provides on-line descriptions of these systems, and the systems feature on-line “help” programs.

The USPTO also maintains an on-line image database called Trademark Document Retrieval (TDR). TDR features images of each of the documents that make up the “electronic file wrapper” of particular trademark applications or registrations. Currently,

images of virtually all pending trademark applications are present in TDR, and TDR also features images of many trademark registration files. Over time, the USPTO will upload images of the files of all live trademark registrations into TDR. The public accesses TDR by clicking on a link, entitled "View Full Files," that appears on the USPTO home page.

The Trademark Reporting and Monitoring (TRAM) System is also maintained by the USPTO. This system is an internal USPTO database only and provides support to all facets of Trademark operations. TRAM supports Trademark operations from the receipt of a new application in the USPTO, through processing and examination of the application, and into the post-registration activities required to maintain registered trademarks. Bibliographic data in TRAM for pending applications and active registrations is updated on a real time basis. The TRAM System maintains current location and status information on applications and registrations, enabling the USPTO to promptly determine the status of any file and to locate files. Data is received in an electronic format that permits expedited transfer to TRAM, thereby reducing processing steps and improving the reliability and quality of the data that is transferred.

Please note that electronic forms can only be submitted via TEAS; filers may not e-mail their own forms to the USPTO. Additionally, filers who submit drawings of marks that are not "standard character" drawings must attach digitized images of these drawings to their submissions.

4. Efforts to Identify Duplication

This collection does not solicit any data already available at the USPTO. In a request for reconsideration, the information consists basically of arguments made by the applicant about why registration should not be refused. This collection does not create a duplication of effort.

5. Minimizing the Burden to Small Entities

Since registration of a trademark/service mark is a voluntary activity on the part of the public, the USPTO has not collected data to determine if the collection of information impacts small businesses or other small entities.

The request for reconsideration is the applicant's response to a substantive refusal to register, perhaps where registration has been refused because the mark in the application is confusingly similar to a previously registered mark. Additionally, applicants may voluntarily provide that information, or other information of their choosing. The USPTO believes that the submission of the information provided places no undue burden on small businesses or other small entities.

6. Consequences of Less Frequent Collection

Less frequent collection of this information is not possible, since the information is collected in response to a USPTO final office action. The request for reconsideration is the applicant's response to a substantive refusal to register; arguments made by the applicant about why registration should not be refused. It is not a required response. The applicant can file an appeal instead of a request for reconsideration.

7. Special Circumstances in the Conduct of Information Collection

There are no special circumstances associated with this collection of information.

8. Consultation Outside the Agency

The USPTO will be forwarding a notice of proposed rulemaking, entitled "Changes in the Requirements for Filing Requests for Reconsideration of Final Office Actions in Trademark Cases" (RIN 0651-AC05), to the *Federal Register* for publication.

Large and well-organized bar associations frequently communicate their views to the USPTO. Also, the Trademark Public Advisory Committee (T-PAC) was created by the American Inventors Protection Act of 1999 to advise the Director of the USPTO on the agency's operations, including its goals, performance, budget, and user fees. The T-PAC includes nine voting members who are appointed by and serve at the pleasure of the Secretary of Commerce. The statute also provides non-voting membership on the Committee for the agency's three recognized unions. Members include inventors, lawyers, corporate executives, entrepreneurs, and academicians with significant experience in management, finance, science, technology, labor relations, and intellectual property issues. The members of the T-PAC reflect the broad array of USPTO's stakeholders and embrace the USPTO's e-government initiative. This diversity of interests is an effective tool in helping the USPTO nurture and protect the intellectual property that is the underpinning of America's strong economy.

9. Payment or Gifts to Respondents

This information collection does not involve a payment or gift to any respondent.

10. Assurance of Confidentiality

The initial application for registration of a trademark is open to public inspection. The information collected from the applicant in response to Office Actions is available for inspection by the public. Confidentiality is not required in the processing of this information.

11. Justification for Sensitive Questions

None of the required information is considered to be of a sensitive nature.

12. Estimate of Hour and Cost Burden to Respondents

Table 3 calculates the anticipated burden hours and costs of this information collection to the public, based on the following factors:

- Respondent Calculation Factors**
 The USPTO estimates that it will receive approximately 33,500 requests for reconsideration annually.
- Burden Hour Calculation Factors**
 The USPTO estimates that it will take the public 10 minutes (0.17 hours) to complete this information, depending on the nature of the particular information being provided. This includes time to gather the necessary information, create the document, and submit the completed request.
- Cost Burden Calculation Factors**
 The professional rate of \$304 per hour used in this submission to calculate the respondent cost burden is the median rate for associate attorneys in private firms as published in the 2005 report of the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA). This report summarized the results of a survey with data on hourly billing rates. This is a fully loaded hourly rate.

Table 3: Burden Hour/Burden Cost to Respondents for Request for Reconsideration after Final Action

| Item | Hours (a) | Responses (yr) (b) | Burden (hrs/yr) (c) (a) x (b) | Rate (\$/hr) (d) | Total Cost (\$/hr) (e) (c) x (d) |
|--|--------------|--------------------------|--|------------------------|---|
| Request for Reconsideration after Final Action | 0.17 | 33,500 | 5,695 | \$304.00 | \$1,731,280.00 |
| Total | - - - - | 33,500 | 5,695 | - - - - | \$1,731,280.00 |

The proposed addition to this information collection, plus the currently approved totals, will result in the total estimates shown below:

Current inventory responses = 117,400
 Current inventory burden hours = 19,958
 Current inventory burden hour costs = \$5,707,988

Response impact due to the proposed rulemaking = increase of 33,500
 Burden hour impact due to the proposed rulemaking = increase of 5,695
 Burden hour costs impact due to the proposed rulemaking = increase of \$1,731,280

Total estimated responses after the proposed rulemaking = 150,900
 Total estimated burden hours after the proposed rulemaking = 25,653
 Total estimated burden hour costs after the proposed rulemaking = \$7,439,268

13. Total Annualized Cost Burden

There are no maintenance or record keeping costs associated with this information collection. There are no filing fees or postage costs associated with a Response to Office Action. However, filing fees that were incurred but not paid when another document was submitted may be provided together with the Request for Reconsideration. The USPTO calculates these fees as part of another collection.

14. Annual Cost to the Federal Government

The USPTO estimates that it takes a GS-7, step 5 employee 4 minutes (0.07 hours) to process a request for reconsideration after final action. The hourly rate for a GS-7, step 5 is currently \$20.44. When 30% is added to account for a fully loaded hourly rate (benefits and overhead), the cost per hour is \$20.44 + \$6.13, for a rate of \$26.57.

Table 4 calculates the processing hours and costs of this information collection to the Federal Government:

Table 4: Burden Hour/Burden Cost to the Federal Government for Request for Reconsideration after Final Action

| Item | Hours (a) | Responses (yr) (b) | Burden (hrs/yr) (c) (a) x (b) | Rate (\$/hr) (d) | Total Cost (\$/hr) (e) (c) x (d) |
|--|--------------|--------------------------|--|------------------------|---|
| Request for Reconsideration after Final Action | 0.07 | 33,500 | 2,345 | \$26.57 | \$62,307.00 |
| Total | - - - - | 33,500 | 2,345 | - - - - | \$62,307.00 |

15. Reason for Change in Burden

This information collection is currently approved by OMB with a total of 117,400 responses and 19,958 burden hours per year. Based on the changes included in the attached notice of proposed rulemaking, “Changes in the Requirements for Filing Requests for Reconsideration of Final Office Actions in Trademark Cases” (RIN 0651-AC05), the USPTO estimates that the annual responses will amount to 150,900 and the annual burden hours will be 25,653, which is an increase of 33,500 responses and 5,695 burden hours from the currently approved burden for this collection. This burden increase is due to a program change resulting from the addition of a new form. There is no change for the remaining items in this collection. **Therefore, this information collection would have a total burden increase of 5,695 hours due to a program change.**

This collection was previously approved with an estimated respondent cost burden of \$5,707,988. The changes in the proposed rulemaking would increase the cost burden by \$1,731,280 due to the addition of one new form, increasing the respondent cost burden to \$7,439,268.

Currently, there are no annualized (non-hour) costs attributed to this collection, and none are being reported as a result of this notice of proposed rulemaking. **Therefore, there is no change in the \$0 in annualized (non-hour) cost burden associated with this collection.**

16. Project Schedule

There is no plan to publish this information for statistical use.

17. Display of Expiration Date of OMB Approval

The forms in this information collection will display the OMB Control Number and the date on which OMB's approval of this information collection expires.

18. Exception to the Certificate Statement

No exceptions to the certificate statement are included in this collection of information.

B. COLLECTIONS OF INFORMATION EMPLOYING STATISTICAL METHODS

This collection of information does not employ statistical methods.

LIST OF ATTACHMENTS

- A. "Changes in the Requirements for Filing Requests for Reconsideration of Final Office Actions in Trademark Cases" (RIN 0651-AC05)
- B. USPTO Web Privacy Policy
- C. USPTO Information Quality Guidelines
- D. PTO Form 1930 Request for Reconsideration after Final Action