

SUPPORTING STATEMENT
United States Patent and Trademark Office
Trademark Petitions
OMB CONTROL NUMBER 0651-00xx

A. JUSTIFICATION

1. Necessity of Information Collection

The United States Patent and Trademark Office (USPTO) administers the Trademark Act, 15 U.S.C. § 1051 et seq., which provides for the registration of trademarks, service marks, collective trademarks and collective service marks, collective membership marks, and certification marks. Individuals and businesses that use or intend to use such marks in commerce may file an application to register their marks with the USPTO. Individuals and businesses may also submit various communications to the USPTO, including letters of protest and requests to make special.

A letter of protest is an informal procedure whereby third parties who object to the registration of a mark in a pending application may submit evidence relevant to the registrability of the mark to the attention of the USPTO. A letter of protest should include an explanation of which application is being protested and relevant evidence to support the protest.

A request to make special may be submitted where an applicant's prior registration for the same mark on the same goods and/or services was cancelled due to the inadvertent failure to file a post registration maintenance document and should include an explanation of why special action is appropriate.

The USPTO is proposing to include these two items in the inventory at this time because of a new method of submission in a "global format" that would standardize some formatting involving the electronic collection of this information. Both of these items are covered under 15 U.S.C. § 1051.

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

Table 1: Information Requirements for Trademark Petitions

| Requirement | Statute | Rule |
|-------------------------|------------------|--------------|
| Letter of Protest | 15 U.S.C. § 1051 | 37 CFR 2.146 |
| Request to Make Special | 15 U.S.C. § 1051 | 37 CFR 2.146 |

2. Needs and Uses

The USPTO uses the information described in this collection to process letters of protest and requests to make special. The information is used by the public for a variety of private business purposes related to establishing and enforcing trademark rights. Information relating to the registration of a trademark is made publicly available by the USPTO. The release of information in a letter of protest is controlled and may be available upon request only.

The Information Quality Guidelines set forth in 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.

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 Trademark Petitions

| Form and Function | Form # | Needs and Uses |
|------------------------------|--------------------|---|
| TEAS Letter of Protest | No Form Associated | <ul style="list-style-type: none"> Used by the public to electronically submit an objection regarding a pending application. Used by the USPTO to decide whether the protest should be granted. |
| Letter of Protest | No Form Associated | <ul style="list-style-type: none"> Used by the public to submit an objection regarding a pending application. Used by the USPTO to decide whether the protest should be granted. |
| TEAS Request to Make Special | No Form Associated | <ul style="list-style-type: none"> Used by applicants to electronically submit a request that an application be examined expeditiously in those cases where a formal petition is not required. Used by the USPTO to act upon a request to make special. |
| Request to Make Special | No Form Associated | <ul style="list-style-type: none"> Used by applicants to submit a request that an application be examined expeditiously in those cases where a formal petition is not required. Used by the USPTO to act upon a request to make special. |

3. Use of Information Technology

The USPTO provides electronic forms for filing many submissions through the Trademark Electronic Application System (TEAS), which is accessible via the USPTO web site. The forms filed are received within seconds after transmission, and a confirmation of filing is immediately sent to the user by e-mail.

Electronic forms do not currently exist for all possible types of trademark submissions to the USPTO. Filers may not email their own forms to the USPTO. In order to provide filers with many of the benefits of electronic filing for a submission where a true electronic form does not currently exist within TEAS, the USPTO is creating a new type of submission in a “global format.” This new method of submission will allow the user to identify the type of document being filed by selecting from a drop-down list and then uploading a document in either the JPG or PDF format containing the matter being filed. Using this approach will provide the same benefits of a “regular” TEAS filing, namely, electronic confirmation of receipt at the USPTO; entry of the appropriate prosecution history label in the Trademark Reporting and Monitoring (TRAM) database (viewable externally in the Trademark Application and Registration Retrieval (TARR) system); upload for viewing in the Trademark Document Retrieval (TDR) system; and automatic routing to the proper work unit. However, such filings will not result in the automated upload of data into the USPTO databases, which is one of the primary benefits of true electronic filing, i.e., an actual TEAS form relies on tagged data elements that permit direct upload of data absent manual intervention, thereby avoiding data entry errors. If a specific TEAS form is developed and placed in production, then that option would be removed entirely from the pull-down list of the global form, and only true electronic filing would then be possible for that form.

The USPTO maintains an online database called Trademark Document Retrieval (TDR), which features images of each document that make up the “electronic file wrapper” of a particular trademark application or registration. 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. Another online record system provided by the USPTO is the Trademark Application and Registration Retrieval (TARR) system, which provides users with information regarding the status of trademark applications and registrations. The data in the TARR system is updated daily.

In addition to providing a system that allows the electronic transmission of trademark submissions, the USPTO also provides the public with online access to various trademark records. One such online 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. Potential applicants for trademark registration can use TESS to assist in the determination of whether a particular mark may be available. The data in TESS is identical to the data reviewed by examining attorneys at the USPTO when determining 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 for the user to choose from four different search tools, is updated daily, and is easy to use.

These systems are all accessible through the Trademark Electronic Business Center (TEBC) on the USPTO web site. The TEBC provides descriptions of the systems, and the systems feature online “help” programs. Thus, the USPTO offers a single source for a variety of systems useful both for making submissions to the USPTO and for tracking the status of these submissions.

4. Efforts to Identify Duplication

This information is collected only when letters of protest and requests to make special are submitted to the USPTO. This collection does not solicit any data already available at the USPTO. This collection does not create a duplication of effort.

5. Minimizing the Burden to Small Entities

The USPTO believes that the submission of the information provided places no undue burden on small business or other small entities. The same information is required from every customer and is not available from any other source.

6. Consequences of Less Frequent Collection

This information collection could not be conducted less frequently, since the information is collected only when voluntarily submitted by the public. If the information were not collected, the public would not be able to submit letters of protest or requests to make special and the USPTO could not comply with the requirements of the Trademark Act 15 U.S.C. § 1051 and 37 CFR Part 2.

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 60-Day Notice was published in the *Federal Register* on May 18, 2009 (74 Fed Reg. 23168). The public comment period ended on July 17, 2009. No public comments were received.

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. 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 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. Additional feedback solicited through the USPTO-monitored mailbox of TEAS@uspto.gov helped the USPTO determine that its customers were very interested in the "global format"

approach to help bridge the gap where true electronic forms have yet to be developed. Again, the global format, while not quite as beneficial to the USPTO as a true TEAS form, will nonetheless provide many advantages to both the applicant and the USPTO.

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 trademark applications and registrations are open to public inspection. Confidentiality is not required in the processing of this information.

The USPTO Web Privacy Policy Statement explains how the USPTO handles any personal information collected from the public through the web site, 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.

11. Justification for Sensitive Questions

None of the required information in this collection 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 953 responses per year for this collection, with 477 of them filed electronically.
- **Burden Hour Calculation Factors**
The USPTO estimates that it will take the public an average of 30 minutes (0.50 hours) to one hour to complete the collections of information described in this submission, depending on the nature of the information. This includes time to gather the necessary information, create the documents, and mail the completed paper request. The time estimates shown for the electronic forms in this collection are based on the average amount of time needed to complete and electronically file the associated information.
- **Cost Burden Calculation Factors**
The professional rate of \$310 per hour used in this submission to calculate respondent cost burden is the median rate for associate attorneys in private firms as published in the 2007 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.

The USPTO expects that the information in this collection will primarily be prepared by attorneys, although some submissions may be prepared by *pro se* registrants.

Table 3: Burden Hour/Burden Cost to Respondents for Trademark Petitions

| Item | Hours (a) | Responses (yr) (b) | Burden (hrs/yr) (c) (a) x (b) | Rate (\$/hr) (d) | Total Cost (\$/hr) (e) (c) x (d) |
|------------------------------|-----------|--------------------|----------------------------------|------------------|-------------------------------------|
| TEAS Letter of Protest | 0.83 | 463 | 384 | \$310.00 | \$119,040.00 |
| Letter of Protest | 1.00 | 462 | 462 | \$310.00 | \$143,220.00 |
| TEAS Request to Make Special | 0.50 | 14 | 7 | \$310.00 | \$2,170.00 |
| Request to Make Special | 0.67 | 14 | 9 | \$310.00 | \$2,790.00 |
| Total | - - - - | 953 | 862 | - - - - | \$267,220.00 |

13. Total Annualized Non-hour Cost Burden

There are no capital start-up, maintenance, or record keeping costs, nor are there filing fees. There is, however, non-hour cost burden in the way of postage costs.

Applicants and registrants incur postage costs when submitting non-electronic information to the USPTO by mail through the United States Postal Service. The USPTO estimates that 476 submissions are made via first class mail. First class postage is 44 cents. Therefore, a total estimated mailing cost of \$209 is incurred for this collection.

Table 4 calculates the postage costs for this collection of information:

Table 4: Postage Costs for Trademark Petitions

| Item | Responses (yr) (a) | Postage Costs (b) | Total Cost (yr) (a) x (b) |
|------------------------------|--------------------|-------------------|---------------------------|
| TEAS Letter of Protest | 463 | \$0.00 | \$0.00 |
| Letter of Protest | 462 | \$0.44 | \$203.00 |
| TEAS Request to Make Special | 14 | \$0.00 | \$0.00 |
| Request to Make Special | 14 | \$0.44 | \$6.00 |
| Total | 953 | - - - - | \$209.00 |

In sum, the total annual non-hour cost burden for this collection in the form of postage costs is \$209.

14. Annual Cost to the Federal Government

The USPTO estimates that it takes a GS-14, step 5, 20 minutes (0.33 hours) to process the Letter of Protest and a GS-12, step 5, 20 minutes (0.33 hours) to process the Request to Make Special whether they are submitted on paper or in TEAS.

The hourly rate for a GS-14, step 5 is currently \$55.78. When 30% is added to account for a fully loaded hourly rate (benefits and overhead), the cost per hour is \$72.51 (\$55.78 + \$16.73).

The hourly rate for a GS-12 step 5 is currently \$39.70. When 30% is added to account for a fully loaded hourly rate (benefits and overhead), the cost per hour is \$51.61 (\$39.70 + \$11.91).

Table 5 calculates the processing hours and costs of this information collection to the Federal Government:

Table 5: Burden Hour/Burden Cost to the Federal Government for Trademark Petitions

| Item | Hours (a) | Responses (yr) (b) | Burden (hrs/yr) (c) (a) x (b) | Rate (\$/hr) (d) | Total Cost (\$/hr) (e) (c) x (d) |
|------------------------------|--------------|--------------------------|--|------------------------|---|
| TEAS Letter of Protest | 0.33 | 463 | 153 | \$72.51 | \$11,094.00 |
| Letter of Protest | 0.33 | 462 | 152 | \$72.51 | \$11,022.00 |
| TEAS Request to Make Special | 0.33 | 14 | 5 | \$51.61 | \$258.00 |
| Request to Make Special | 0.33 | 14 | 5 | \$51.61 | \$258.00 |
| Total | - - - - - | 953 | 315 | - - - - - | \$22,632.00 |

15. Reason for Change in Burden

The USPTO is requesting that OMB add this new information collection to the agency's information collection inventory. The USPTO is submitting this new information collection request as a result of a program change due to a new method of submission in a "global format" that will standardize some formatting involving the electronic collection of this information.

The USPTO estimates that it will receive 953 responses from this collection annually and that the associated burden will be 862 hours per year. **Therefore, an additional 862 burden hours per year will be added to the USPTO's current information collection inventory as a program change.**

There is non-hour cost burden in the form of postage costs associated with this information collection, which amounts to \$209 per year. **Therefore, an additional \$209 per year in the way of non-hour cost burden will be added to the USPTO's current information collection inventory as a program change.**

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

This collection of information does not include any exceptions to the certificate statement.

B. COLLECTIONS OF INFORMATION EMPLOYING STATISTICAL METHODS

This collection of information does not employ statistical methods.

REFERENCES

- A. USPTO Information Quality Guidelines