

**SUPPORTING STATEMENT**  
**United States Patent and Trademark Office**  
**Proposed Addition to**  
**Post Registration (Trademark Processing)**  
**OMB CONTROL NUMBER 0651-0055**  
**(July 2011)**

**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 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 United States Patent and Trademark Office (USPTO).

Such individuals and businesses may also submit various communications to the USPTO, including requests to correct or amend their registrations. Registered marks remain on the register for ten years and can be renewed, but will be cancelled unless the owner files with the USPTO a declaration attesting to the continued use (or excusable non-use) of the mark in commerce within specific deadlines. Applicants may also surrender a registration and, in limited situations, petition the Director to reinstate a registration that has been cancelled or expired.

This package is being submitted in support of a notice of proposed rulemaking, "Changes in Requirements for Specimens and for Affidavits or Declarations of Continued Use or Excusable Nonuse in Trademark Cases" (RIN 0651-AC49). The USPTO proposes to revise the Trademark Rules of Practice (37 CFR Part 2) and the Rules of Practice for Filings Pursuant to the Madrid Protocol (37 CFR Part 7) to provide for the USPTO to require: (1) any information, exhibits, and affidavits or declarations deemed reasonably necessary to (a) examine an affidavit or declaration of continued use or excusable nonuse in trademark cases, or (b) for the USPTO to assess the accuracy and integrity of the register; and (2) upon request, more than one specimen in connection with a use-based trademark application, an allegation of use, an amendment to a registered mark, or an affidavit or declaration of continued use in trademark cases.

In support of this proposed rulemaking, the USPTO is submitting this information collection to introduce the following new information requirements:

- Response to Office Action for Post-Registration Matters (TEAS Global)
- Response to Office Action for Post-Registration Matters (Paper)

The Trademark Act gives the Director discretion regarding the number of specimens to require, 15 U.S.C. §§ 1051(a)(1) and (d)(1), 1058(b)(1)(C) and 1141k(b)(1)(C). However, the current Trademark Rules of Practice and Madrid Rules mandate the submission of only one specimen per class in connection with use-related filings. See 37 CFR 2.34(a)(1)(iv), 2.56(a), 2.76(b)(2), 2.88(a)(3) and (b), 2.88(b)(2), 2.161(g), and 7.37(g). Similarly, the current rules require only one specimen to be submitted in connection with the amendment to a registered mark. See 37 CFR 2.173(b)(3). In addition, although the current Trademark Rules of Practice allow the USPTO to require additional information or exhibits deemed reasonably necessary to the examination of a pending application (37 CFR 2.61(b)), no counterpart rule exists in the post-registration context to facilitate proper examination of an affidavit or declaration of continued use or excusable nonuse.

To ensure that the USPTO may properly examine amendments, affidavits, or declarations, and the nature and veracity of the use claimed therein, additional specimens or other information or exhibits, such as a photograph of the mark appearing on certain goods, may be needed. Accompanying affidavits or declarations to verify information or exhibits may also be needed. One purpose of the proposed rule is to ensure that the USPTO can require of trademark applicants or registrants any additional specimens or other information, exhibits, and affidavits or declarations necessary to properly examine an applicant's or registrant's claim to be using the mark. Also, the USPTO wishes to ensure its ability to have such requirements as part of a project to assess and improve the accuracy and integrity of the register. Another purpose of the rule is to harmonize the requirements that can be made as part of the examination of use allegations made in post-registration maintenance documents with the requirements currently authorized in the examination of use allegations made prior to registration.

The USPTO estimates that requirements for additional specimens or other evidence of use would issue in a small subset of cases, approximately 3,165. Thus, the impact of the proposed rule would be minimal.

In support of the proposed rule, the USPTO is also proposing to include two new items in the inventory at this time, one of which takes into account a new method of electronic submission of information for which a dedicated Trademark Electronic Application System (TEAS) form is not yet available (i.e., "Global Forms"). The TEAS Global Forms are an interim workaround as the USPTO develops additional specific TEAS forms covering items that are currently collected only in paper. A Global Form will allow the user to submit documents electronically by identifying a document type through a drop-down list, entering text in a free-text box, and attaching files in JPG or PDF format. This allows for electronic filing of documents for which there is not currently a dedicated TEAS form.

Table 1 identifies the statutory and regulatory provisions pursuant to which the USPTO collects the information:

**Table 1: Information Requirements for Proposed Addition to Post Registration (Trademark Processing)**

Requirement	Statute	Rule
Response to Office Action for Post-Registration Matters	15 U.S.C. §§ 1057-1059	37 CFR Part 2, 2.160, 2.161, 2.163, 2.164, 2.168, 2.173, and 2.175

## 2. Needs and Uses

The USPTO uses the information described in this collection to process post-registration submissions. The proposed rule will ensure that the USPTO may properly examine post-registration amendments, affidavits, or declarations, and the nature and veracity of the use claimed therein. There is one electronic 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 also can be accessed at the USPTO Web site. 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 "Privacy Policy Statement" link 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 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.

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 this information collection and its supporting statement comply with all applicable information quality guidelines, i.e., the 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 Post Registration (Trademark Processing)**

Form and Function	Form #	Needs and Uses
Response to Office Action for Post-Registration Matters (TEAS Global) (Ref. B)	TEAS Global Form	<ul style="list-style-type: none"> <li>• Used by the public to respond to an Office action that a post-registration examiner has issued or pay an additional fee related to a post-registration matter.</li> <li>• Used by the USPTO to collect information that the registrant did not supply in the original post-registration maintenance or amendment documents and that the USPTO needs to complete the review of these documents or to run quality assurance projects for the register.</li> </ul>
Response to Office Action for Post-Registration Matters (Paper)	No Form Associated	<ul style="list-style-type: none"> <li>• Used by the public to respond to an Office action that a post-registration examiner has issued or pay an additional fee related to a post-registration matter.</li> <li>• Used by the USPTO to collect information that the registrant did not supply in the original post-registration maintenance or amendment documents and that the USPTO needs to complete the review of these documents or to run quality assurance projects for the register.</li> </ul>

### 3. Use of Information Technology

The USPTO currently offers four IT systems in support of this collection that are accessible through the online Trademark Electronic Business Center (TEBC). The TEBC provides descriptions of the systems, and the systems feature online “help” programs. Thus, the USPTO offers the public a single source for a variety of IT systems useful both for making submissions to the USPTO and for tracking the status of these submissions.

The USPTO provides online electronic forms through the web-accessible Trademark Electronic Application System (TEAS). Once completed, TEAS forms are transmitted to the USPTO 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 or registration 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, 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 printing the signature page of the form, signing it in ink, scanning the signed page, and then transmitting the entire form and scanned signature page to the USPTO.

The USPTO maintains an online image database of the electronic trademark application or registration file wrapper entitled the Trademark Document Retrieval (TDR) system. The USPTO also maintains an online system called 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.

The USPTO provides a web-based record of registered marks, and marks for which applications for registration have been submitted, called the Trademark Electronic Search System (TESS). 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 for the user to choose from four different search tools, is updated daily, and is easy to use.

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. 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.

There is a new method of electronic submission of information for which a dedicated TEAS form is not yet available (i.e., "Global Forms"). The TEAS Global Forms are an interim workaround as the USPTO develops additional specific TEAS forms covering items that are currently collected only in paper. A Global Form will allow the user to submit documents electronically by identifying a document type through a drop-down list, entering text in a free-text box, and attaching files in JPG or PDF format. This method allows for electronic filing of documents for which there is not currently a dedicated TEAS form.

#### **4. Efforts to Identify Duplication**

This collection does not solicit any data already available at the USPTO. The information consists basically of a registrant's response to a requirement for additional specimens or other information, exhibits, and affidavits or declarations necessary to properly examine the registrant's claim to be using the mark. This collection does not create a duplication of effort.

## **5. Minimizing the Burden to Small Entities**

The same information is required from every customer regardless of entity size, 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 in connection with the examination of post registration maintenance documents for which statutory filing deadlines exist. If the information were not collected, the public would not be able to submit a Response to Office Action for Post-Registration Matters. If this information were not collected, the USPTO could not comply with the requirements of the Trademark Act under 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 USPTO will be forwarding a notice of proposed rulemaking, entitled “Changes in Requirements for Specimens and for Affidavits or Declarations of Continued Use or Excusable Nonuse in Trademark Cases” (RIN 0651-AC49), 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. 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.

## **9. Payment or Gifts to Respondents**

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

## 10. Assurance of Confidentiality

Trademark applications and registrations are open to public inspection. The information collected from the registrant 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 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 3,165 responses per year for this proposed addition, with 1,899 of them filed electronically.
- Burden Hour Calculation Factors**  
 The USPTO estimates that it will take the public an average of 20 to 23 minutes (0.335 to 0.383 hours) 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 form.
- Cost Burden Calculation Factors**  
 The professional rate of \$325 per hour used in this submission to calculate respondent cost burden is the median rate for attorneys in private firms as published in the 2009 report of the Committee on Economics of Legal Practice of the American Intellectual Property Law Association. 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 Proposed Addition to Post Registration (Trademark Processing)**

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a) x (b)	Rate (\$/hr) (d)	Total Cost (\$/hr) (e) (c) x (d)
Response to Office Action for Post-Registration Matters (TEAS Global)	0.335	1,899	636	\$325.00	\$206,700.00
Response to Office Action for Post-Registration Matters (Paper)	0.383	1,266	484	\$325.00	\$157,300.00

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a) x (b)	Rate (\$/hr) (d)	Total Cost (\$/hr) (e) (c) x (d)
<b>Total</b>	- - - -	3,165	1,120	- - - -	<b>\$364,000.00</b>

The proposed addition to this information collection, plus the approved burden in the current inventory, will result in the total burden estimates shown below:

Current inventory responses = 127,136  
 Current inventory burden hours = 17,466  
 Current inventory burden hour costs = \$5,414,460

Impact on responses due to the proposed addition = increase of 3,165  
 Impact on burden hours due to the proposed addition = increase of 1,120  
 Impact on burden hour costs due to the proposed addition = increase of \$364,000

Total estimated responses after the proposed addition = 130,301  
 Total estimated burden hours after the proposed addition = 18,586  
 Total estimated burden hour costs after the proposed addition = \$5,778,460

### 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 1,266 submissions are made via first class mail with a postage cost of 44 cents. Therefore, a total estimated mailing cost of \$557 is incurred for this collection.

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

**Table 4: Postage Costs for Proposed Addition to Post Registration (Trademark Processing)**

Item	Responses (yr) (a)	Postage Costs (b)	Total Cost (yr) (a) x (b)
Response to Post-Registration Office Action (Paper)	1,266	\$0.44	\$557.00
<b>Total</b>	<b>1,266</b>	- - - -	<b>\$557.00</b>

In sum, the total annual non-hour cost burden for this proposed addition in the form of postage costs amounts to \$557. When added to the previously approved burden for this collection of \$41,793,757, the total annual (non-hour) costs for this collection would be \$41,794,314.

Currently approved annual (non-hour) costs = \$41,793,757  
 Impact due to the proposed addition = increase of \$557  
 Total estimated annual (non-hour) costs after the proposed addition = \$41,794,314

#### 14. Annual Cost to the Federal Government

The USPTO estimates that it takes a GS-7, step 5 employee between 12 and 15 minutes (0.20 and 0.25 hours) to process the information in this collection. The hourly rate for a GS-7, step 5, is currently \$22.92. When 30% is added to account for a fully-loaded hourly rate (benefits and overhead), the rate per hour for a GS-7, step 5 employee, is \$29.80 (\$22.92 + \$6.88).

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 Proposed Addition to Post Registration (Trademark Processing)**

Item	Hours (a)	Responses (yr) (b)	Burden (hrs/yr) (c) (a) x (b)	Rate (\$/hr) (d)	Total Cost (\$/hr) (e) (c) x (d)
Response to Office Action for Post-Registration Matters (TEAS Global)	0.200	1,899	380	\$29.80	\$11,324.00
Response to Office Action for Post-Registration Matters (Paper)	0.250	1,266	317	\$29.80	\$9,447.00
<b>Total</b>	- - - - -	<b>3,165</b>	<b>697</b>	- - - - -	<b>\$20,771.00</b>

Current government cost burden = \$295,053  
 Impact due to the proposed addition = increase of \$20,771  
 Total estimated government cost burden after the proposed addition = \$315,824

#### 15. Reason for Change in Burden

This information collection is currently approved by OMB with a total of 127,136 responses and 17,466 burden hours per year. Due to the proposed addition, the USPTO estimates that the total annual responses will be 130,301 and the annual burden hours will amount to 18,586, which is an increase of 3,165 responses and 1,120 burden hours from the currently approved burden for this collection. This burden increase is due to a program change resulting from the addition of two new items. There is no change for the remaining items in this collection. **Therefore, this information collection would have a total burden increase of 1,120 hours due to program changes.**

This collection was previously approved with an estimated respondent cost burden of \$5,414,460. The changes in the final rulemaking would increase the cost burden by

\$364,000 due to the addition of two new items, increasing the respondent cost burden to \$5,778,460.

For this proposed addition, the USPTO estimates that the total annual (non-hour) costs will increase by \$557, from \$41,793,757 to \$41,794,314 per year. This increase is due to the addition of postage costs as a result of the proposed rulemaking. **Therefore, this collection has an increase in annual (non-hour) cost burden of \$557 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
- B. Response to Office Action for Post-Registration Matters (TEAS Global Form)