

JUSTIFICATION FOR NONMATERIAL/NONSUBSTANTIVE CHANGE
United States Patent and Trademark Office
Substantive Submissions Made During Prosecution of the Trademark Application
OMB Control Number 0651-0054
2020

Background

The United States Patent and Trademark Office (USPTO) is submitting this request to increase the annual responses associated with information collection 0651-0054 (Substantive Submissions Made During Prosecution of the Trademark Application) in conjunction with rulemaking RIN 0651-AD30 (Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants) and RIN 0651-AD15 (Changes to the Trademark Rules of Practice to Mandate Electronic Filing).

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 providing additional information needed to process a request to delete a particular filing basis from an application or to divide an application identifying multiple goods and/or services into two or more separate applications.

In support of RIN 0651-AD30, (Requirement of US Licensed Attorney for Foreign Trademark Applicants and Registrants) USPTO is increasing the estimated number of Petitions to the Director under Trademark Rule 2.146 to account for the submission of petitions requesting that the applicant's or registrant's domicile address be withheld from public view. Such petitions are made under the general petition provision at 37 CFR 2.146(a)(5). Overall, the USPTO estimates 100 additional petitions could be filed annually. Each petition is estimated to take 25 minutes to complete and filing requires a \$100 filing fee. This changes adds 100 respondents, 41 burden hours, and \$10,000 in non-hourly costs to the information collection.

In support of RIN 0651-AD15 (Changes to the Trademark Rules of Practice to Mandate Electronic Filing), the USPTO is proposing changes to account for a shift in respondents away from paper submissions and towards electronic submissions. The number of trademark applicants is expected to remain at its current level as it assumed that those who would have filed on paper will instead submit electronically. This request does, however, add in a new item (Petition to the Director under Trademark Rule 2.147) to account for individuals requesting acceptance of paper submissions. This new petition is estimated to add 60 respondents to the information collection. This petition is estimated to take 30 minutes to complete, if filed on paper, or 25 minutes to complete, if filed electronically. The fee for filing a petition on paper is \$200 and \$100 for filing electronically. These changes would increase the hourly burdens by 28. The cost burden estimates also change as the reduction of \$4,422, since fewer paper submissions will require postage costs, is offset by the addition of \$9,000 in filing fees.

Overall, these changes will add 160 respondents to the information collection, add 65 burden hours, and increase the non-hourly cost burden by \$14,578. Additionally the hourly cost burden estimate for this information collection is increasing by \$28,470 (65 hours X \$438 hourly rate).

Changes in Respondents

IC #	Item	Current Annual Responses	Increases in Responses	Proposed Annual Responses
1	Trademark/Service Mark Allegation of Use (Amendment to Allege Use/Statement of Use) (Paper)	27	-14	13
1	Trademark/Service Mark Allegation of Use (Amendment to Allege Use/Statement of Use) (TEAS)	109,086	14	109,100
2	Request for Extension of Time to File a Statement of Use (Paper)	59	-30	29
2	Request for Extension of Time to File a Statement of Use (TEAS)	234,906	30	234,936
10	Petition to the Director Under Trademark Rule 2.146 (TEAS Global)	750	100	850
12	Petition to the Director Under Trademark Rule 2.147 (Paper)	0	30	30
12	Petition to the Director Under Trademark Rule 2.147 (TEAS)	0	30	30
Total		344,828	160	344,988

Changes in Burden Hours

IC #	Item	Current Annual Time Burden (hours)	Increases in Time Burden (hours)	Proposed Annual Time Burden (hours)
1	Trademark/Service Mark Allegation of Use (Amendment to Allege Use/Statement of Use) (Paper)	14	-7	7
1	Trademark/Service Mark Allegation of Use (Amendment to Allege Use/Statement of Use) (TEAS)	45,453	5	45,458
2	Request for Extension of Time to File a Statement of Use (Paper)	15	-8	7
2	Request for Extension of Time to File a Statement of Use (TEAS)	46,981	6	46,987
10	Petition to the Director Under Trademark Rule 2.146 (TEAS Global)	313	41	354
12	Petition to the Director Under Trademark Rule 2.147 (Paper)	0	15	15

12	Petition to the Director Under Trademark Rule 2.147 (TEAS)	0	13	13
Total		92,776	65	92,841

Changes to Non-hourly Cost Burdens

	IC Item	Current Cost	Changes in Cost	Proposed Cost
1	Trademark/ Service Mark Allegation of Use (Amendment to Allege Use/Statement of Use) (Paper)	\$5,413	-\$2,807	\$2,606
1	Trademark/ Service Mark Allegation of Use (Amendment to Allege Use/Statement of Use) (TEAS)	\$10,908,600	\$1,400	\$10,910,000
2	Request for Extension of Time to File a Statement of Use (Paper)	\$13,304	-\$6,765	\$6,539
2	Request for Extension of Time to File a Statement of Use (TEAS)	\$29,363,250	\$3,750	\$29,367,000
10	Petition to the Director Under Trademark Rule 2.146 (TEAS Global)	\$75,000	\$10,000	\$85,000
12	Petition to the Director Under Trademark Rule 2.147 (Paper)	\$0	\$6,000	\$6,000
12	Petition to the Director Under Trademark Rule 2.147 (TEAS)	\$0	\$3,000	\$3,000
	Total	\$40,365,567	\$14,578	\$\$40,380,145

Changes in Burden

Burden Type	Currently Approved	Proposed Changes	New Estimate
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Annual Respondent	374,972	160	375,132
Annual hourly burden	101,401	65	101,466
Hourly Cost Burden	\$44,413,360	\$28,470	\$44,441,830
Annual (non-hourly) cost burden	\$42,650,869	\$14,578	\$42,665,447

0651-0054's revised total burden is as follows:

- 375,132 annual respondents
- 101,466 in annual hourly burden
- \$44,441,830 in hourly cost burden
- \$42,665,447 in annual (non-hourly) cost burden