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PIERCE LAW

FRANKLIN PIERCE LAW CENTER

ELECTRONIC TRADEMARK REGISTRATION PRACTICE

What Every Trademark Lawyer Needs To Know

Pierce Law, Rich Room

October 4, 2002
1:00 – 5:00 p.m.

Co-sponsored by:

Pierce Law
2 White Street
Concord, NH 03301

and

Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206

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CONFERENCE AGENDA

1:00 – 1:05 p.m.	**John D. Hutson, Dean and President, Pierce Law** *Introduction*
1:05 – 2:05 p.m.	**Anne H. Chasser, Commissioner for Trademarks, USPTO** *USPTO Strategic Plan and the Benefits of the Trademark Operation's e-Government Initiatives*
2:05 – 3:05 p.m.	**Craig K. Morris, TEAS Project Manager, USPTO** *Live Internet Demonstration of Trademark Electronic Application System (TEAS)*
3:05 – 3:15 p.m.	**Break for Refreshments**
3:15 – 4:30 p.m.	**Michael A. Albert, Partner, Wolf, Greenfield & Sacks, P.C.** **Carole A. Boelitz, Associate, Wolf, Greenfield & Sacks, P.C.** *Electronic Filing: Practical Filing Issues, Litigation Issues, and 4 Tier Examination* *Recent Developments in 1st Circuit Trademark Law*
4:30 – 5:00 p.m.	*Question and Answer Session*

Speaker Biographies

Anne H. Chasser

As Commissioner for Trademarks, Ms. Chasser, serves as Chief Operating Officer of the USPTO. She is responsible for oversight of the examination and registration of trademarks, proposing policy and programmatic changes in the trademark system, advocating increased protection for the trademark rights of U.S. citizens throughout the world. One of her top priorities as Commissioner is to transform the Trademark Office into a model e-Government operation which will improve the efficiency and effectiveness of the Trademark Examining Operation. Immediately prior to joining the PTO, Commissioner Chasser served as President of the International Trademark Association and was the Director of Trademarks and Licensing Services at the Ohio State University (OSU), where she established OSU's Trademark Licensing Program. Ms. Chasser has been involved in collegiate licensing since the late 1970's and was a founder of the Association of Collegiate Licensing Administrators, an association of 300 U.S. and international collegiate trademark administrators, licensees and affiliated organizations. She served as its President in 1990.

Craig K. Morris

Mr. Morris joined the Trademark Operation of the USPTO in 1983, and he currently serves as the Project Manager for TEAS, the Trademark Electronic Application System. In 1998, Mr. Morris received a Department of Commerce Silver Medal Award, recognizing his contributions in the design, development and implementation of the web-based trademark application form. He also spearheaded efforts through which the USPTO received national recognition for TEAS, namely as a semi-finalist in the *2000 Innovations in American Government Awards Competition*, sponsored by the Ford Foundation and the John F. Kennedy School of Government at Harvard University; a *2000 Government Technology Leadership Award*, celebrating successful U.S. government initiatives; and the *2001 Quality Cup Finalist Award* winner, presented by *USAToday* and the Rochester Institute of Technology.

Michael A. Albert

Mr. Albert is a shareholder of Wolf, Greenfield & Sacks and is a member of the Massachusetts Bar and the Boston Patent Law Association, where he serves as Co-Chair of the Committee on Trademarks and Unfair Competition. His practice focuses on the representation of clients in trademark, copyright, patent and trade secret litigation. Mr. Albert has trial experience in both state and federal courts and has tried cases before the U.S. Court of Appeals for the First Circuit and the Massachusetts Supreme Judicial Court. He recently co-authored an article entitled "Trade Libel: Theory and Practice Under the Common Law, the Lanham Act, and the First Amendment" appearing in The Trademark Reporter, a publication of the International Trademark Association (INTA). He is also a member of the External Affairs Committee of INTA and has drafted trademark legislation for the Association which is being introduced in Massachusetts.

Carole A. Boelitz

An associate with Wolf, Greenfield & Sacks, Ms. Boelitz is admitted to practice before the Massachusetts Bar and the USPTO. Additionally, she is a member of the Boston Bar Association and the Boston Patent Law Association. Ms. Boelitz specializes in intellectual property law, specifically, in the areas of software and mechanical patent prosecution, trademark and copyright law.

USPTO Strategic Plan and the Benefits of the Trademark Operation's e-Government Initiatives

UNITED STATES PATENT AND TRADEMARK OFFICE

USPTO Strategic Plan and the Benefits of the Trademark Operation's e-Government Initiatives



UNITED STATES
PATENT AND
TRADEMARK OFFICE

Our Vision:

To move the Trademark Operation from the 18th to the 21st Century

USPTO Strategic Plan

Developed to respond to the 2002 House and Senate Committee Reports – Patent and Trademark Office Authorization Act of 2002.

Trademark GOALS:

- **Address the 21st century economy by becoming a more market-based, agile organization, adopting a single business approach for serving our customers;**

- **On October 1, 2003, transform the workplace by implementing total electronic workflow, to eliminate labor intensive paper processing and provide access to trademark information electronically;**

USPTO Strategic Plan

Trademark GOALS (*continued*):

- **By 2004, deliver a fully electronic trademark process for use by the USPTO and the public (searching, examining, communicating, publishing, and disseminating trademark registrations);**

- **Enhance trademark quality, through workforce and process improvements; and**

- **Reduce trademark pendency and processing times, through focused examination with electronic filing and processing of applications – reduce trademark pendency to 2 months to first action and 12 months to disposal/registration.**

How USPTO Plans to Reach Goals

- In FY 2004, Trademark Information System (TIS) will be introduced, as the centerpiece of e-Government initiatives:
  - Electronic files - paperless examination.
  - Electronic workflow, from beginning to end of process.
  - Streamlined, consistent process for customers.
  - "Event" focused processing.

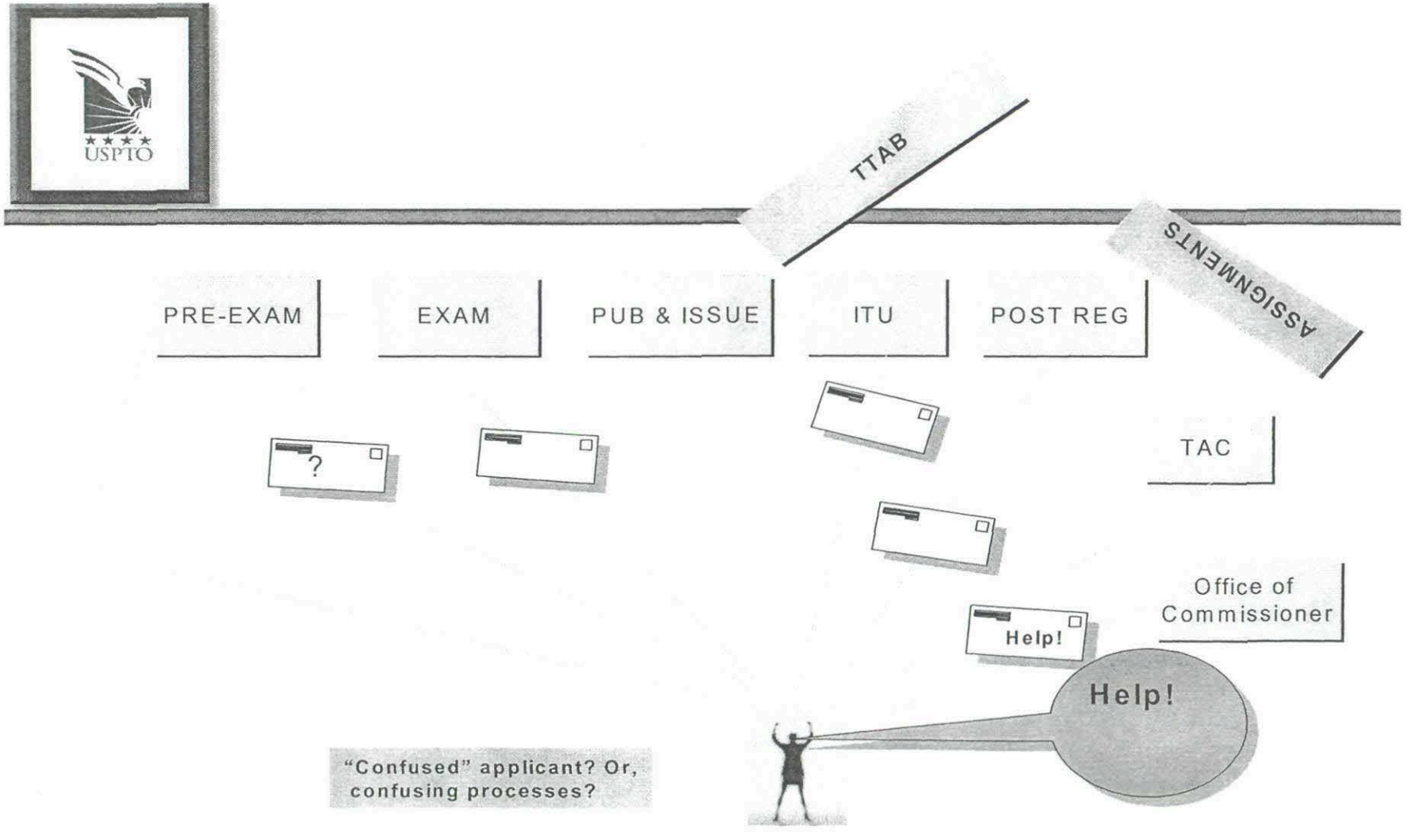
TIS – The Focus Shifts

- Currently, examination processes are specialized by function and skills, and require moving paper files from system to system and person to person to complete examination.

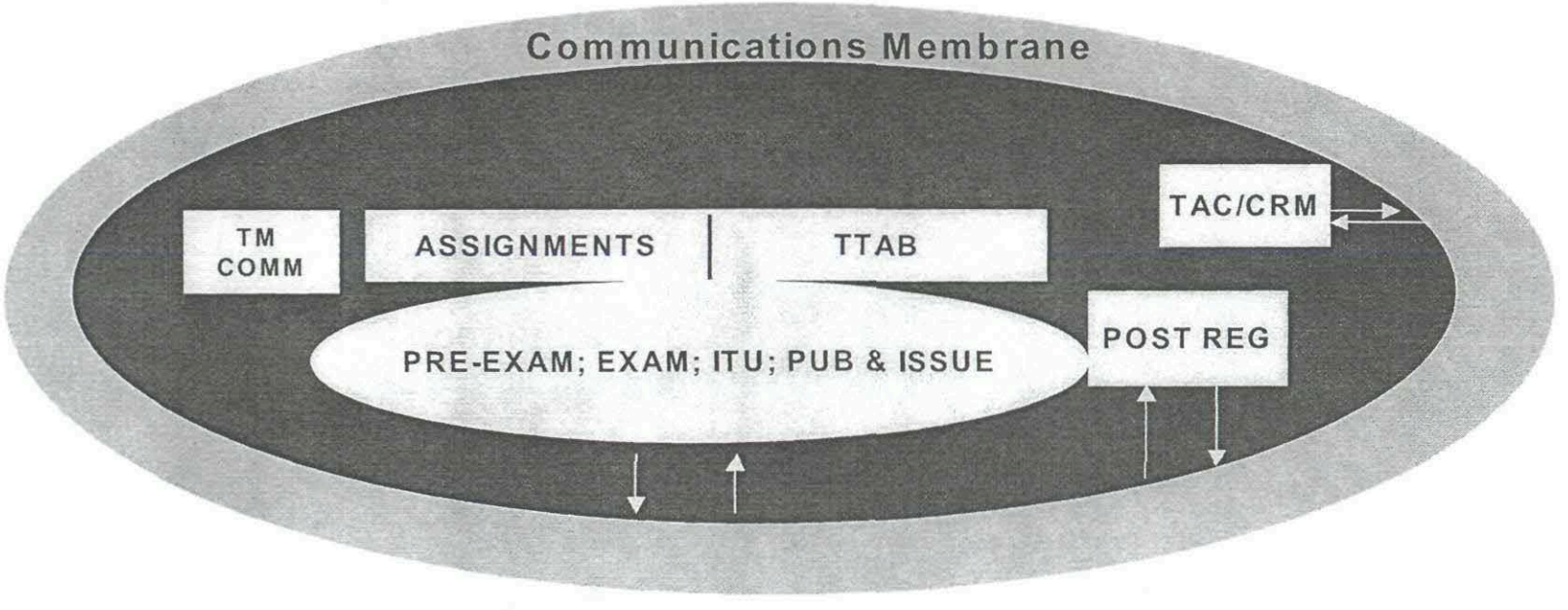
- TIS will focus on examination "events," integrating systems, people, and process in a way that makes sense for the examination event being handled;

  i.e.,a stationary e-file can be worked on by multiple people and move through the process by computer automatically.

Current Process



Proposed Process





The Future Application:

TIS will allow examination directly from electronic record.

TIS demo

New Application | Pre-Search Report | Sec. 2(d) Search | Evidence | Office Action | References



Word Mark	NASCAR RACERS
Goods and Services	IC 025. US 022 039. G & S: warm up suits; jogging suits; sweat suits, sweat pants and sweat shirts; bodysuits, leotards, tights, leg warmers, leggings, singlets, wet suits, ski suits, ski pants, ski bibs, ski jackets, swimwear, bathing suits, beach and bathing cover -ups, suits, slacks, jeans, shorts, sweat shorts, gym shorts, tops, coats, sport coats, shirts, sport shirts, T-shirts, knit shirts, polo shirts, pullovers, sweaters, tank tops, blazers, jumpsuits, playsuits, jackets, overcoats, parkas, wind resistant jackets, leather jackets, skirts, dresses, footwear, boots, slippers, athletic footwear, basketball shoes, casual footwear, sandals, head wear, hats, caps, visors, hoods, berets, head bands, bands, wrist bands, ear muffs, neckwear, neckties, neckerchiefs, scarves, bandannas, sleepwear, robes, pajamas, nightshirts, rainwear, mittens, galoshes, loungewear, underwear, briefs, underpants, boxer shorts, cloth diapers, undershirts, suspenders, hosiery, socks, masquerade and Halloween costumes and aprons
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	260302 260317 261113 261121
Serial	



The central module of TIS is the Trademark Electronic Application System

www.uspto.gov/teas

TEAS Development Timeline

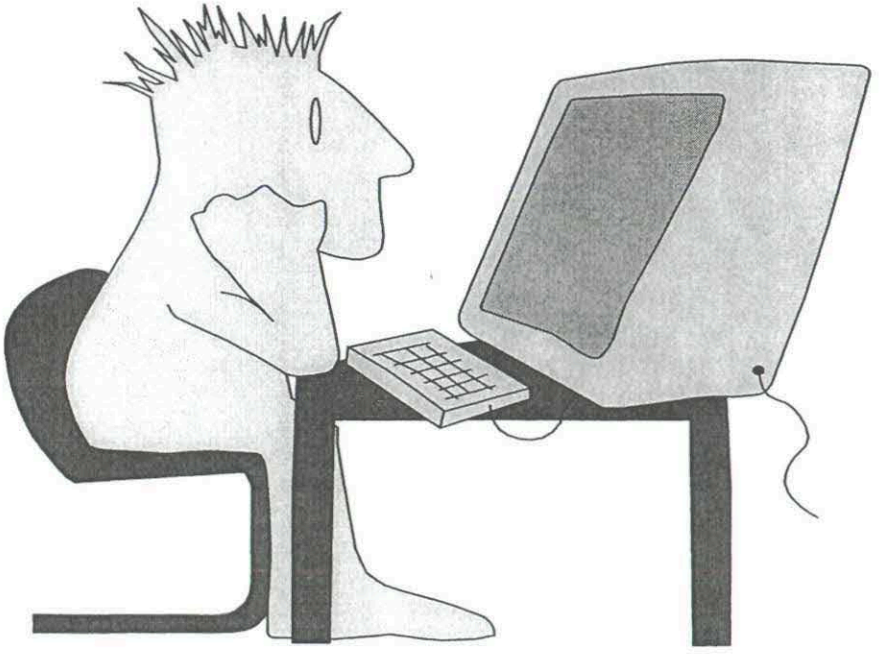
- 1995: Trademark Concept of Operations envisions electronic filing and processing, with goal of eventual "paperless office."
- October 1, 1998: TEAS opens worldwide, at *www.uspto.gov/teas*
- Since October 1, 1998, USPTO has received more than 180,000 electronically-filed applications (about 40% of overall new trademark application filings).

Our Goals for e-Filing

- **50% of all *new* applications filed electronically by September 30, 2002.**
- **80% of *all* applications (new applications, ITU filings, Post Registration filings) filed electronically by September 30, 2003.**
- **80% of *all* communications completed electronically by September 30, 2004.**

Reason to move to e-Filing

TO HELP OUR CUSTOMERS, by improving customer service and quality.



How TEAS Benefits Our Customers

Advantages of electronic filing cf. paper filing:

- Easy access to forms and other USPTO information.
- Preliminary "Form Wizard" to produce form sections.
- Comprehensive on-line help.
- Portable form feature (save work/create templates).
- Pay fees with 3 different payment options: credit card, deposit account (both in real time), and electronic funds transfer.

How TEAS Benefits Our Customers

Advantages of electronic filing (e-mail)

- Transmit application directly on-line.
- File virtually 24/7: gives filing date when USPTO is closed, *i.e.*, Saturdays, Sundays and Holidays.
- Immediate filing receipt and serial number via e-mail.
- Increase of speed in application filing, processing, & review (Goal: first action by 2 months, disposal in 12 months).

How TEAS Benefits Our Customers

Advantages of electronic filing (cont.)

- More accurate filing receipt information, since applicant-supplied information uploaded directly.

- Saving money on mail postage and fax charges and/or courier delivery costs.

- Elimination of "lost or missing" papers, making petitions to revive unnecessary.

- Automatic confirmation in TRAM/TARR of receipt of all submissions, helping to avoid abandonment.

ГЕАS MYTHS



TEAS Myths

#1 Signature methods are too cumbersome and burdensome.

#2 Payment methods are limited and/or problematic.

#3 You cannot easily prepare many filings for the same client.

#4 Electronic documents cannot be saved for later modification.

TEAS Myths

#5 The .gif and .jpeg image formats required by the USPTO are difficult formats.

#6 You may not know if the USPTO received the electronic filing, particularly if the e-mail acknowledgement is not returned.

#7 Electronic filings will not be properly docketed at the law firm, because receipts are sent to the preparer; also, TEAS filings cannot be associated with a specific attorney docket number.

TEAS Myths

#8 Computer printout looks "unprofessional."

#9 TEAS corrupts drawing and specimen images.

#10 You cannot "play around" on TEAS without fear of filing a non-refundable application.

To Encourage e-Filing

- Amended Filing Date Rules
  - A *Final Rule* was published May 23,2002 in the Federal Register that eliminated the date of deposit in Express Mail to set a filing date for trademark documents. Rule took effect on June 24,2002.
  - Filing date for all trademark documents is now the date of receipt in the USPTO (except for Preliminary Amendment and Response to Office Action, for which TEAS forms are relatively new). NOTE: Rule 1.8 was NOT changed in any way.

To Encourage e-Filing

- Differential Filing Fees
  - On May 17, 2002, the USPTO published a *proposed* rule to set a new, higher fee for filing using paper.
  - Fees will be $50 higher per class, when using paper, *if* a specifically-designated electronic form is available (currently, exceptions for Change of Correspondence Address, Preliminary Amendment, and Response to Office Action forms).
  - For example, under current fees:
    - $325 per class for electronically-filed applications
    - $375 per class for paper-filed applications

- **Electronic communication**
  - Data fields added in TRAM for external e-mail addresses.
  - Central e-mail boxes established for internal offices (ecom112@uspto.gov, *e.g.*).
  - Where authorized by applicant, all communications (including office actions) could be handled electronically.

- **E-Commerce Law Offices**
  - TEAS applications go to these offices.
  - Handle *all* classes of goods and services.
  - Pre-examination, examination and post- examination activities are located in the law office.

Post-Examination

- **TIPS**

OG published from a Post Script file sent to GPO



MARKS PUBLISHED FOR OPPOSITION

SECTION 1. INTERNATIONAL CLASSIFICATION

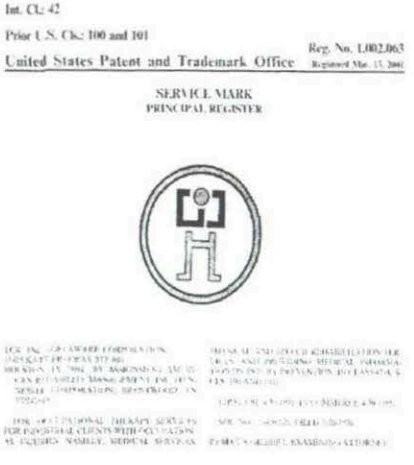
Application in more than one class

INTERNETRAVEL

CLASS 39—TRANSPORTATION AND STORAGE

CLASS 16—PAPER GOODS AND PRINTED MATTER

CLASS 42—MISCELLANEOUS SERVICES



Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 1,002,063

SERVICE MARK
PRINCIPAL REGISTER

A PDF TMOG is available at www.uspto.gov (5 rotating issues).

We're all in this together-
the key to success!



Live Internet Demonstration of Trademark Electronic Application System (TEAS)

Trademark Electronic Application System (TEAS)
(TEAS) http://www.uspto.gov/teas

BACKGROUND INFORMATION

To handle trademark applications both accurately and cost-effectively, and to respond more fully to customer requests for a technologically-advanced trademark filing system, the United States Patent and Trademark Office (USPTO) developed TEAS—the Trademark Electronic Application System. TEAS is an on-line, interactive electronic application that allows an applicant to fill out a trademark form and check it for completeness over the Internet, and then submit the completed application directly to the USPTO.

TEAS began as a pilot program on November 30, 1997, with approximately fifty customers. The first application was filed very shortly after the electronic filing site opened, for a stylized design composed of triangular shapes, used in connection with "legal services." Following a successful ten-month pilot period, on October 1, 1998, the USPTO opened TEAS worldwide, at **http://www.uspto.gov/teas**. The USPTO thus became one of the first national intellectual property offices in the world to offer an electronic filing system for trademarks. Not only did the Trademark Operation step onto the information highway, it raced out in front, soon becoming one of the leaders in the U.S. government arena in the area of electronic commerce.

Why use TEAS?

Electronic filing has many advantages over filing over paper via mail or express delivery services, including:

- a dramatic increase in the speed with which applications can be filed;
- the ability to file virtually 24 hours a day, seven days a week, making it possible to receive a filing date on the days the USPTO is officially closed;
- almost instantaneous provision of a filing receipt and serial number for an initial application via email;
- almost instantaneous provision of email confirmation of receipt of all other forms;
- access to a "portable" form for saving work and creating templates;
- saving a great deal of money on mail postage and fax charges and/or courier delivery costs, because electronic applications are created, reviewed and filed electronically using the Internet;
- more accurate filing receipt information because it is transferred directly from the database containing the information entered by the applicant and does not have to be re-entered manually at the USPTO;
- more efficient review of applications because they are in a standard format recommended by the USPTO; and
- faster review of applications by an examining attorney or a paralegal.

What can be filed through TEAS?
Forms currently available through TEAS:

- Trademark/Service Mark Application, Principal Register
- Allegation of Use (Amendment to Allege Use/Statement of Use), for Intent-to-Use Application
- Request for Extension of Time to file a Statement of Use
- Combined Declaration of Use & Incontestability under Sections 8 & 15
- Declaration of Use of a Mark under Section 8
- Combined Declaration of Use in Commerce/Application for Renewal of Registration of Mark under Sections 8 & 9
- Declaration of Incontestability of a Mark under Section 15
- Change of Correspondence Address
- Response to Office Action
- Preliminary Amendment
- Collective Membership Mark
- Collective Trademark/Service mark
- Certification Mark
- Trademark/Service Mark Application, Supplemental Register

Under Development:

- Request to Divide

When is TEAS available?
TEAS is available 24 hours a day, seven days a week, for issuance of filing dates when the USPTO is officially closed. However, because TEAS will ***not*** permit payments from 12 a.m. to 4 a.m. on Sundays, applications cannot be transmitted during that period (although an application could be completed and saved using the download portable form feature available once an application has been successfully validated, for resumption of the payment piece at a later time).

How is payment made in TEAS?
Payment can be made by credit card through a secure related site (via MasterCard, Visa, American Express or Discover), for processing in "real time," *i.e.*, an application cannot be transmitted absent the verification of a valid credit card and expiration date.

Or, payment can be made through an already-existing USPTO deposit account, which will also be processed in real time; *i.e.*, an application cannot be transmitted absent the verification of sufficient funds within the deposit account. Requirements for doing a deposit account payment are the six-digit deposit account number, and a four-digit access code (which is the same as your existing deposit account password, which your firm should already know). However, if necessary, please call 703-305-4631 for this information. You must be on the USPTO authorized user's list for the deposit account.

Finally, payment can be done through the Electronic Funds Transfer (EFT) payment method, which allows you to send the USPTO a payment over the Internet as easily as writing a check. In general, the Automated Clearing House performs EFT transactions through the Federal Reserve System. The EFT payment method can only to be used by customers with U.S. affiliated bank accounts (those banks who are a member of the American Banking Association (ABA) network).

To pay through EFT, all you will need is a check (not deposit slip). You must be authorized to sign checks on this account to use this payment method.

In order to use the USPTO's EFT payment mechanism, you must establish a UserID and Password. To create a UserID and Password, click "Pay by EFT" on the screen that appears after clicking on the PAY/SUBMIT button at the bottom of the Validation Page (which comes up after you have completed the application and successfully validated the form). Then, click on "Create User Account." Once you have entered the "EFT User Profile" page, you will be asked for various pieces of information, most of which appears on the check itself. After entering this information, you will have a UserID and Password that you may use to perform EFT transactions within TEAS, or any other USPTO website offering this payment option.

What are the technical requirements to use TEAS?
e-TEAS works only if you use either NETSCAPE NAVIGATOR (Version 3.0 or most recent) or MICROSOFT INTERNET EXPLORER (Version 4.0 or most recent). e-TEAS utilizes frames, JavaScript, and the file upload feature supported by these browser versions. Note: Internet Explorer on the Macintosh platform will ***not*** permit a proper image attachment. You must use Internet Explorer version 5 or Netscape in order to use the payment server with the Macintosh platform. Images created on a Macintosh using Adobe Photoshop or Illustrator must be properly saved with appended file extensions .gif or .jpg for use on a Windows system. We cannot open image files that are not properly saved prior to attachment. Also, Internet Explorer that sits behind a Microsoft Proxy Server will NOT connect properly. However, if you upgrade Internet Explorer to 5.01 or higher the site will work properly.

Is there TEAS HELP?
TEAS gives step-by-step instructions for completing a form properly. It also provides access to a wide variety of information about USPTO procedures and practice. While the different sections of the forms may appear straightforward and easy to fill out, applicants are strongly advised to read the HELP instructions very carefully for *each* section ***prior*** to completion. Failure to follow this advice may cause incorrect completion of the form, thereby potentially jeopardizing legal rights.

Within the form itself, there are hyperlinks to all of the field names. Simply by "double-clicking" on the name for any particular field, HELP information will appear at the bottom of the screen, giving information for proper completion of that section. There are also direct links within the form to other useful information, *e.g.*, to the *USPTO Goods/ Services Manual.*

If help is required to resolve glitches or to receive answers to technical questions, an email can be sent to PrinTEAS@uspto.gov. A telephone number should be included, so that the USPTO staff may provide direct assistance, if necessary. A "Bug" Report may also be used, available from the front page of the TEAS site. The front page of the TEAS site also has links to "Frequently Asked Questions about Trademarks" (general trademark questions) and to more specific "TEAS Policy and Technical Hints."

Can a template for multiple filings from the same client be created in TEAS?
At the bottom left of the very front page of the TEAS site, there is an icon for "Downloadable Blank Initial Application form." (This is **not** the same as the "Download Portable Form" button that is accessed on the Validation Page after successful validation of the application). The "Downloadable Blank Initial Application form" is intended for experienced practitioners to create "templates" for future use, where multiple filings will be submitted for the same client, for example. The "Downloadable Blank Initial Application form" does not contain a validation function, meaning that as much or as little information as desired may be entered, and then the form may be saved for later use.

However, this feature may require creation of multiple templates; *e.g.*, one form may be saved for intent-to-use applications; a second for use-based applications; a third for multi-class applications, etc. The initial Form Wizard will dictate the creation of the proper form. Once within a particular saved template, it is not possible to change the basic structure of that template; *e.g.*, a single-class application cannot be changed to accommodate a multi-class filing—an entirely new template would be required, meaning that a new process of creating a form through the Form Wizard must be started.

Currently, only the initial application has the "Downloadable Blank" form feature; unfortunately, none of the other TEAS forms can be saved in this manner at this time. However, to make multiple filings even easier, the USPTO is in the process of developing a means of using XML (extensible markup language) in the various TEAS forms, so that relevant data (*e.g.*, addresses, phone numbers, firm names, etc.) can be imported into the various forms quickly and easily.

THE ELECTRONIC FILING PROCESS

What is the starting point for using a TEAS form?
All forms are structured through a beginning "Form Wizard." This is a series of YES and NO questions, the answers to which will tailor a form for the specific needs of the applicant; *i.e.*, after the applicant answers all of the questions within the Form Wizard, and then clicks on the NEXT button, a form will pull up that only has sections that the applicant needs, as specified through the Wizard questions. However, if the applicant wants a form containing *all* possible sections, a "Standard Form" may be accessed from the top of the Form Wizard, thereby by-passing the Wizard entirely. However, in some instances, *e.g.*, to create a form that will permit filing of a multi-class application, the initial Form Wizard **must** be used.

Can TEAS process images?
To file an initial application for a stylized or design mark, the applicant must be able to attach either a black-and-white GIF or JPG image file (the only two formats currently accepted; however, the USPTO is exploring expansion to accept other formats, *e.g.*, TIFF). Where a specimen (sample) of actual use in commerce is required, the applicant must be able to attach a scanned image or digital photograph in the GIF or JPG format. Unlike the image file for a drawing, the specimen image file *may* be in color (and, in fact, *must* be in color if color is being claimed as a feature of the mark).

How will the form be signed?
The application will not be "signed" in the sense of a traditional paper document. To verify the contents of the application, the signatory must enter *any* combination of alpha/numeric characters that has been specifically adopted to serve the function of the signature, preceded and followed by the forward slash (/) symbol. No "pre-approval" from the USPTO of the "electronic signature" is required. Acceptable "signatures" could include: /john doe/; /jd/; and /123-4567/. The application may still be verified to check for missing information or errors even if the signature and date signed fields are left blank, however, because a signature is not required for filing date purposes.

The ***proper*** signatory must be the one physically to enter the alpha-numeric combination. While the attorney may "sign" the application on his or her *own* behalf, the attorney should *not* be entering any signature on behalf of another party, regardless if given explicit approval to perform this function by the client, for example.

To simplify the signature process, the USPTO has introduced two enhancements (accessible through a question on the initial Form Wizard, which asks "Will someone else be signing the application"?) Under the first method, the client is able to access the form for signing directly from a hyperlink included in an email generated upon completion of the form by the attorney—no "downloading" of a portable form is required. The client will only be viewing a "text form, " one that is in a narrative, paragraph-type format that only permits entry of the signature and date, and *not* the manipulation of any other data.

The second method has been developed to accommodate clients who cannot even access Internet email. Here, the attorney will complete the TEAS application, and then print out the "Text" form. This can then be mailed or faxed to the client for a traditional pen-and-ink signature. Once the signed application is returned, the attorney can scan the document to create an image file of the declaration and signature, for affixation within the original electronic version of the application. The complete application may then be validated and filed electronically.

NOTE: Although not desirable from the standpoint of efficiency of processing at the USPTO, an initial TEAS application *may* be filed electronically absent *any* signature. A follow-up declaration with a traditional pen-and-ink signature may then be submitted, either as a preliminary amendment or in response to an Office Action. However, it is critical to make clear at the time of filing the signed declaration that this submission is only to complete an application for which a serial number has already been assigned, and "to verify all facts set forth in the original application." If, instead, the signed declaration is submitted along with a hard copy of the original application, the Pre-Examination section may believe this is an entirely new submission, and as such, assign a new serial number (rather than simply associating the signed declaration with an already-existing file).

What is the TEAS validation function?
After completing an application, there is a validation function at the end of the form. Successful validation brings up a Validation Page for continuation of the application submission process. The application process cannot continue, however, if no entry has been made for one of the mandatory fields (*i.e.*, those data elements required to receive a filing date, and so designated on

the form with a red asterisk)— an "error" screen will pop up. The initial form can then be re-accessed for entry of the information.

For fields that are not considered mandatory, but for which an entry *should* be made, a "warning" screen will pop up. If an entry was not made simply due to oversight, the form can be re-accessed for entry of the information. However, if the piece of information is not known at this time and it is more critical to receive a filing date than to wait for that data, the "warning" can be by-passed and the application therefore filed.

NOTE: The validation function in no way checks the content of the entry for accuracy or completeness; rather, the system only confirms that at least one "character" has been entered in each of the mandatory fields. The Pre-Examination section, and then later, the examining attorney, will determine the sufficiency and correctness of the entries.

Can work be double-checked before submission?
Successful validation of an application will bring up the Validation Page. This does ***not*** mean the application has been submitted, only that all mandatory fields have been entered. From this point, there are icons for viewing the application data in various formats:

- **Text form**: this presents the application data in a narrative, paragraph-type format;
- **Input**: this presents the data in a simple "table" format (*i.e.*, field name on the left, data on the right, with no "boilerplate" text);
- **Drawing:** the mark will appear in the middle of the page, either as typed words, or as the image previously attached. If the image does not look correct here (clear black-and-white, and no greater than 4x4 inches when printed), the image file should be amended, and the new image re-attached within the form;
- **Specimen** *(only appears for a use-based application)*: the specimen image (which may be in color, and no greater than 8½x11 inches when printed) should be viewable. If the image does not look correct here, the image file should be amended, and the new image re-attached within the form;

  NOTE: Portable forms do *not* save image attachments, requiring drawing and/or specimen image files to be re-attached to the application before final submission to the USPTO.
- **XML format**: this shows all of the data as associated with tagged data fields (which permits the USPTO to upload the information directly into our databases and avoid manual data entry errors), along with all standard "boilerplate" language.

Information accessed from any of these icons may be saved for your records simply by using the print function within the standard browser. If any of the information being viewed is incorrect, the page should be closed, in order to return to the Validation Page; clicking on the "Go Back to Modify" button at the bottom of the Validation Page permits return to the form itself, allowing any corrections to be made. If a change is, in fact, made to the form, re-validation (through the Validate Form button) is then required. The process may then be resumed at the Validation Page.

Can the electronic form be saved?
After successful validation, and upon reaching the Validation Page, a "Download Portable Form" button at the bottom of the page will allow the form to be saved to a local drive. The saved form may be pulled up for continued work at a later time, or forwarded to another party, either for review or signature.

How is receipt of the application confirmed?
The USPTO no longer mails paper filing receipts for electronically submitted applications. After proper completion of all mandatory application fields, and payment of the application filing fee is verified, a screen comes up that says SUCCESS! We have received your application and assigned serial number _____. Within 24 hours, an email acknowledgment, containing both the assigned serial number and a complete summary of all data (but for any images), will also be sent (The Validation Page contains an entry field to specify the address to which the USPTO should email the acknowledgment; *e.g.*, this could be a "docketing" address specifically established to track application filings).

Can an electronic filing be stopped after successful transmission?
If the application has arrived on the USPTO server, and a SUCCESS screen has been generated with a serial number, then the application is considered officially filed. Once an application is filed, we do not cancel the filing or refund the fee, unless the application fails to satisfy minimum filing requirements. The fee is a processing fee, which the USPTO does not refund even if no registration ultimately issues after substantive review by the examining attorney. A "warning" to this effect is on the Validation Page, and a box must be "checked" to acknowledge that this statement has been read and understood.

TEAS TECHNICAL INFORMATION

Eastern Time Controls filing date. All forms filed via e-TEAS are stamped Eastern Time when received on the USPTO server in Arlington, Virginia. The time stamp is applied at the moment the payment process is completed and the Success screen is displayed. The time stamp applied by the e-TEAS server is the official time the USPTO received the application or form; the time the transmission was begun is not a factor considered when assigning the filing date. The official filing date and time can be found at the bottom of the e-mail confirmation.

Filing Fee and Refund Policy.
The filing fee is $325.00 per class of goods and/or services (*i.e.*, an application may only have one mark, but may cover multiple classes; *e.g.*, an application with two classes would be for both computer software in Class 9 and t-shirts in Class 25, making the filing fee $650.00). Although only one mark is permissible per application, a mark may consist of several elements that are joined to form a composite whole (*e.g.*, words plus a design). You do not have to have already used your mark before filing an application. However, if the mark has not already been used in interstate commerce at the time of filing, but instead the application is based on an "intent-to-use" the mark in interstate commerce in the future, an additional fee of $100.00 per class will be required when the "Allegation of Use" form is submitted (whereas a "use-based" application does not require this additional fee). Also, the filing fee is a processing fee for the application.

This fee is NOT returned even if ultimately the USPTO does not issue a registration after our substantive review. You should take all necessary steps to ensure the mark is registrable before filing the application.

Image files must be in GIF or JPG format. To file an initial application for a stylized or design mark, you must be able to attach either a black-and-white GIF or JPG image file, the only two formats currently accepted. Where a specimen (sample) of actual use in commerce is required, you must be able to attach a scanned image or digital photograph in the GIF or JPG format (although submission of a specimen is not a requirement to receive a filing date for an initial application).

- **Mark Images.** If you are using, or intend to use, your mark with a stylized appearance or design that you want to protect, you must attach a GIF or JPG image file of your mark. Click on the 'Browse' button on the form to select from your local drive the GIF or JPG image file-these are the only image file formats you can use. Mark image attachments should be submitted in bi-tonal (black and white) format; color images are not recommended for Mark drawings. Although the USPTO will accept a color image, we will convert any image that is not a 1-bit image (i.e., black and white) to 1-bit before the application can proceed to registration; however, mark images submitted in a color format may not convert properly to black-and-white images.

  If color is an important feature of your mark that you wish to protect, use the description of the mark field (under the Additional Statement section) to explain where the color(s) appear in the mark (e.g., "The mark consists of a bird with a blue body, a red head, and a yellow beak."). NOTE: If you do not see the Additional Statement section on the form, it is because you answered "No" on the Form Wizard to the question "Do you need to enter an additional statement?" Unfortunately, you would need to create a new form, going back to the Form Wizard and answering that question "Yes."

- **Specimen Images.** For a Specimen Image File, you would attach a GIF or JPG file showing an image of the mark as used in commerce on or in connection with any item listed in the description of goods and/or services. To attach the specimen(s), click on the browse button to select the GIF or JPG image file that is stored on the applicant's local drive and that contains the specimen(s). This is not simply the same as the image of your actual mark by itself that was attached in the Mark Information section. Instead, for the specimen, you must show how you are actually using the mark in commerce. We do accept specimen images in color.

  For example, for goods, acceptable specimens would consist of scanned or digitally photographed tags, labels, instruction manuals, or containers that show the mark on the goods or packaging. Invoices, announcements, order forms, bills of lading, leaflets, brochures, publicity releases and other printed advertising material generally are not acceptable specimens for goods. Examples of acceptable service mark specimens are signs, photographs, brochures or advertisements that show the mark used in the sale or advertising of the services. If the goods and/or services are classified in more than one

international class, one specimen must be provided showing the mark used on or in connection with at least one item from each of these classes.

Please note the following:

1) Mark images should not include the trademark, service mark or registration symbols (TM, SM, ®). These symbols should only appear on specimens.

2) TEAS cannot accept animated GIF files.

3) Mark images should be submitted with as little white space around the design as possible. The mark images should be pure black-and-white with no gray areas.

4) The mark image size used on registration certificates is approximately 4" x 4". The mark image size used in the Official Gazette is approximately 2" x 2". Images are scaled to fit these sizes.

5) The acceptable specimen image size is 8 1/2 " X 11". The specimen images are scaled to fit 7" X 7" on internal USPTO databases.

6) You must be able to open and print the images from your browser. If you cannot view and print the images from your browser, we will not be able to open the image file. The mark image must print no larger than 4" X 4". The specimen image must print no larger than 8 1/2" X 11".

7) If you cannot validate the form after attaching an image file, please try validating the form without the image attached; if successful, try re-saving the image using PowerPoint. Copy the image onto a blank slide and use the "file type" save as feature to re-save the image as a JPG or GIF file. PowerPoint will ask if you want the save to apply to all of the slides. Answer "Yes". Then try attaching and validating with this new image file attached. You should also try this approach if the form drops your image file during the validation process. If you cannot validate with the image attached or it is dropped during the validation process, then we are not recognizing the image as a valid JPG or GIF image file.

8) After validation, you should be able to view your image from the validation page. If you cannot view your images they are not properly attached. If you can view them, but they appear large, this is not a problem as long as you were able to view and print them (as described at number 6, *above*). If the images do print larger than desired, use your image software's zoom feature to reduce the size of the image and re-save. If this does not work, use your Printscreen feature to cut-and-paste the re-sized image onto a blank slide and re-save it as a JPG or GIF file, in the correct size.

9) The image file should be scanned at a minimum of 300 DPI; however, 600 DPI will provide a clearer image.

10) Images created on a Macintosh using Adobe Photoshop or Illustrator must be properly saved with appended file extensions .gif or .jpg for use on a Windows system. We cannot open image files that are not properly saved prior to attachment.

11) Internet Explorer on the Macintosh platform will NOT permit proper image attachment. You must use Netscape or a PC.

12) Images that are no larger than 600 pixels either horizontally or vertically when submitted reproduce better than images with higher or lower pixel counts.

13) Adobe Photoshop/Illustrator users must ensure that images are saved with the RGB color scheme. The USPTO cannot accept the CYMK color scheme. If you can open your image with your browser, then it is saved in the RGB color scheme.

14) Do NOT zip your image files or add any additional compression. Both GIF and JPG files are already compressed.

Three payment options available. After November 13, 2001, three options (credit card, automated deposit account (New!), and Electronic Funds Transfer (New!)) will now appear after clicking on the PAY/SUBMIT button, which is available on the bottom of the Validation Page after completing and validating the application form. You will NOT specify a payment option in the Form Wizard or within the form itself. For more information about these payment options, please see http://e-TEAS.uspto.gov/payment.htm.

Availability. e-TEAS is available 24 hours a day, seven days a week, for issuance of filing dates when the USPTO is officially closed. However, because e-TEAS will not permit payment processing from 12 a.m. to 4 a.m. on Sundays, you cannot transmit an application during that period (although you can complete an application and save it using the download portable form feature available once you successfully validate the application, to resume the payment piece at a later time).

Browser requirements. e-TEAS works only if you use either NETSCAPE NAVIGATOR (Version 3.0 or most recent) or MICROSOFT INTERNET EXPLORER (Version 4.0 or most recent). e-TEAS utilizes frames, JavaScript, and the file upload feature supported by these browser versions. Note: Internet Explorer on the Macintosh platform will ***not*** permit a proper image attachment. You must use Internet Explorer version 5 or Netscape in order to use the payment server with the Macintosh platform. Images created on a Macintosh using Adobe Photoshop or Illustrator must be properly saved with appended file extensions .gif or .jpg for use on a Windows system. We cannot open image files that are not properly saved prior to attachment. Also, Internet Explorer that sits behind a Microsoft Proxy Server will NOT connect properly. However, if you upgrade Internet Explorer to 5.01 or higher the site will work properly.

PrinTEAS option. For information on completing an application on-line, to be printed out and mailed to the USPTO, paying by check or money order or through a USPTO deposit account, please see PrinTEAS, available at http://www3.uspto.gov/teas/PrinTEASforms.htm.

Additional Help. To use TEAS successfully, please follow the steps outlined below. For additional general trademark information, please telephone the Trademark Assistance Center, at 703-308-9000, or e-mail your question to TrademarkAssistanceCenter@uspto.gov. If you need help in resolving glitches or need answers to technical questions, you can email us at PrinTEAS@uspto.gov. Please include your telephone number, so we can talk to you directly, if necessary.

STEP-BY-STEP INSTRUCTIONS FOR FILING ELECTRONICALLY

STEP 1: Determine (1) what mark you want to register, and the form thereof (i.e., either words only or stylized wording and/or design; and (2) the goods to which the mark is (or will be) applied, or the services in connection with which the mark is (or will be) used. For assistance with the goods and/or services, check the USPTO Goods/Services Manual.

NOTE: The filing fee for the initial trademark/servicemark is $325 per class of goods or services listed, and at least $325 must accompany the application in order for a filing date to be assigned.

STEP 2: Use the Trademark Electronic Application System (TESS) to search the USPTO database, to determine whether a confusingly similar mark is already registered, or whether a pending application for a confusingly similar mark has been filed, for related goods and/or services.

WARNING: After searching the USPTO database, even if you think the results are "O.K.," do not assume that your mark can be registered at the USPTO. After you file an application, the USPTO must do its own search and other review, and might refuse to register your mark. For a complete list of possible substantive grounds of refusal and a detailed explanation of each, see Chapter 1200, Trademark Manual of Examining Procedure (TMEP). The USPTO cannot provide preliminary legal advice as to whether we will register a particular mark; filing an application is the only way to obtain a decision on whether the USPTO will refuse or grant registration.

STEP 3: Based on your search results from TESS (STEP 2), check the status of any potentially conflicting application or registration through the Trademark Application and Registration Retrieval (TARR) system, at http://tarr.uspto.gov.

STEP 4: In light of all of the information above, re-assess whether it makes sense to seek registration. Please be aware that once you file your application, we do not cancel the filing or refund the fee, unless the application fails to satisfy minimum filing requirements. The fee is a processing fee, which the USPTO does not refund, even if no registration ultimately issues after the substantive review by the examining attorney.

STEP 5: If the mark you wish to register consists of stylized wording or a design, then first create a GIF or JPG image file of the mark, and save onto your local drive. e-TEAS cannot be used for filing a stylized or design mark if no GIF or JPG image file exists. Similarly, if you will be filing the application based on actual use in commerce (i.e., you have already sold goods or rendered services under this specific mark), create a GIF or JPG image file of the "specimen" of use, i.e., either scan or digitally photograph a sample of how the mark actually appears; e.g., a tag or label for goods or an advertisement for services. (However, because submission of a specimen is not required at the time of filing, lack of an image file for the specimen will not preclude filing an initial application through e-TEAS).
NOTE: You do not have to create a special electronic file for a "word only" (*i.e.*, not stylized or design) mark, or for an "intent-to-use" application (*i.e.*, where you have not yet sold goods or

rendered services under this specific mark, but you have a bona fide intention to use the mark at some point in the future.

STEP 6: Access the front page of the TEAS site. As necessary, click on the links to the Frequently Asked Questions about Trademarks and the TEAS Technical and Policy Hints.

STEP 7: Click on the designated link to access the list of available e-TEAS forms.

NOTE: The following steps presume that the e-TEAS option, for filing directly over the Internet, was selected, and that the filing will be for an initial, basic trademark and/or servicemark application. However, most steps are similar for completing the other types of forms.

STEP 8: Click on the link for "New Mark", and then select "Trademark/Servicemark Application, Principal Register."

STEP 9: Answer the series of YES and NO questions on the first page of the Form Wizard. When finished, click on the NEXT button at the bottom of the page, to pull up a form tailored to the specific requirements for this particular filing.

NOTE: To receive HELP at any point in the application process, simply click on any of the field names the appropriate HELP section will then be displayed at the bottom of your screen.

STEP 10: Enter information in the appropriate fields in the form. You must enter information in all of the fields containing a red asterisk, as these fields are considered mandatory to receive an application filing date. However, you are encouraged to enter all available information at this time, since failure to do so, although not preventing filing, may delay approval of the application and require later submission of the information to the assigned examining attorney.

STEP 11: If you are the proper signatory of the application, you will "sign" the completed application by entering any combination of alpha/numeric characters that has been specifically adopted to serve the function of the signature, preceded and followed by the forward slash (/) symbol. Acceptable "signatures" could include: /john doe/; /jd/; or /123-4567/. No "pre-approval" from the USPTO of the "electronic signature" is required, nor must the "electronic signature" even be consistent from one filing to the next.
If you are not the proper signatory, proceed to the Validate Form function, at STEP 12. The application may still be verified to check for missing information or errors even if the signature and date signed fields are left blank. STEP 19 will permit you, if appropriate, to send the application to another party for signature.

NOTE: If you indicated through the Form Wizard that someone else would be signing the application, either through the "eSignature" method or through the attachment of an image file of a handwritten pen-and-ink signature, you will not be following the steps outlined at STEP 19. Instead, follow the directions within the special form that pulls up as a result of the information provided within the Form Wizard.

STEP 12: Upon completing the application, click on the "Validate Form" button at the end of the form. If you did not enter information for a mandatory field, an "error" screen will pop up. You must then re-access the initial form to enter the required information. You can continue the application process only by eliminating all error messages. Clicking the "Reset Form" button will totally clear all entries in the form.

For fields that are not considered mandatory, but for which an entry should be made, a "warning" screen will pop up. If an entry was not made simply due to oversight, you can again re-access the form to enter information by clicking on "Go Back." However, you can by-pass a "warning" and continue the application submission process by clicking on the "Continue" button, if the piece of information is not known at this time and it is more critical to receive a filing date than to wait for that data.

NOTE: The validation function in no way checks the content of the entry for accuracy or completeness; rather, the system only confirms that at least one "character" has been entered in each of the mandatory fields. The Pre-Examination section, and then later, the examining attorney, will determine the sufficiency and correctness of the entries.

STEP 13: Before submitting the application, double-check your work by clicking on the icons within the Validation Page (to view the application data in various formats):

Input: this presents the data in a simple "table" format (i.e., field name on the left, data on the right, with no "boilerplate" text).

Drawing: the mark will appear in the middle of the page, either as typed words, or as the image previously attached. You should print out this page to ensure that the resulting image is correct, i.e., the entire mark is visible, in clear black-and-white (no gray tones), and not greater than 4x4 inches. (Because of different monitor settings, it is not always possible to determine this simply by viewing the image on-line. We are concerned only with how the image actually "prints out"). If you determine that the image is not acceptable, then you must create a new image file, re-attach the file within the form, and repeat the steps outlined above.

Specimen (only appears for a use-based application): the specimen image (which, unlike the drawing image, may be in color) should be viewable. You should print out this page to ensure that the entire specimen has been captured. (Because of different monitor settings, it is not always possible to determine this simply by viewing the image on-line. We are concerned only with how the image actually "prints out"). If you determine that the image is not acceptable, then you must create a new image file, re-attach the file within the form, and repeat the steps outlined above.

NOTE: Portable forms do not save image attachments; therefore, you must re-attach the drawing and/or specimen image file to the application before final submission to the USPTO.

Scannable format: this shows all of the data as associated with tagged data fields, which permits the USPTO to upload the information directly into our databases and avoid manual data entry errors.

Textform: this presents the application data in a narrative, paragraph-type format.

STEP 14: Print the information accessed from any of these icons for your records simply by using the print function within the standard browser.

STEP 15: If any of the information being viewed is incorrect, you should close the page, to return to the main Validation Page. Then, click on the "Go Back to Modify" button at the bottom of the Validation Page, to return to the original application form. You can then correct any errors. Because a change has been made to the form, you must re-validate the application, again using the Validate Form button. At this point, you may resume the process at the Validation Page.

STEP 16: Enter the address to which the USPTO should email the acknowledgment; e.g., either a personal email address or a "docketing" email address specifically established to track application filings. (The USPTO no longer mails paper filing receipts for electronically submitted applications).

STEP 17: Re-enter the email address, to ensure delivery of the acknowledgment. (An inconsistent entry will result in a pop-up box asking for another entry of the address).

STEP 18: Read and check the box within the "Important Notice" section at the bottom of the Validation Page. This confirms an understanding that once an application is filed, we will not cancel the filing or refund the fee, unless the application fails to satisfy minimum filing requirements. The fee is a processing fee, which we do not refund even if we cannot issue a registration after our substantive review.

STEP 19: To save the electronic file to a local drive (either to pull up to continue work at a later time, or to forward to another party, either for review or signature), click on the "Download Portable Form" button at the bottom of the Validation Page.

NOTE: Each time you view the Portable Form, you must re-validate and save the form prior to forwarding. The GIF or JPG image files do not save with the portable form, and must always be re-attached prior to final submission to the USPTO.

STEP 20: Clicking on the PAY/SUBMIT button will bring up a screen to enter the appropriate payment information. After properly entering the information, submission can be completed to the USPTO. Shortly after successful transmission, a screen comes up that says "SUCCESS! We have received your application and assigned serial number _____." Again, within 24 hours, an email acknowledgment, containing both the assigned serial number and a complete summary of all data (but for any images), will also be sent to the email address provided at STEP 16. For your records, print out copies of the SUCCESS screen and the email acknowledgment.

STEP 21: If after successful filing an error is discovered, follow the steps outlined in the email acknowledgment for submission of a "preliminary amendment."

STEP 22: Follow the status of the prosecution of the application through the Trademark Application and Registration Retrieval (TARR) system, or call 703-305-8747 (Monday-Friday,

6:30 a.m. to 12 midnight, EST). However, do NOT attempt to check status until at least 25 days after submission, to allow sufficient time for our databases to be updated.

Contact Us. For general trademark information, please telephone the Trademark Assistance Center, at 703-308-9000, or e-mail your question to TrademarkAssistanceCenter@uspto.gov. If you need help in resolving glitches or need answers to technical questions, you can e-mail us at PrinTEAS@uspto.gov. Please include your telephone number, so we can talk to you directly, if necessary.

Use of E-Mail and Facsimile Transmission. You may e-mail or "fax" correspondence related to trademark applications that have previously been filed with the Office to either the e-mail addresses or facsimile numbers listed below. However, first please use TARR (http://tarr.uspto.gov/) to determine the location of your application. Do not send correspondence on the same topic to multiple locations. If you have a question about where you should send your correspondence, please contact the Trademark Assistance Center. Whether your correspondence is sent by e-mail or facsimile transmission, we will send back a confirmation that the Office has received the communication.

Any communications regarding pending applications sent via e-mail to the law office addresses listed below must

(1) be in English;
(2) include the entire response as e-mail text, ***not*** as an attachment;
(3) list the serial number in the "Subject" line; and
(4) include any specimens or evidence in jpg or gif format only.

For security and compatibility reasons, the Office will ***not*** accept communications that include any attachments, other than those in jpg or gif format. Thus, no attachments in WordPerfect®, Word, Adobe® PDF or any other format EXCEPT jpg or gif can be accepted.

Additionally, all such communications sent via e-mail should (1) be signed electronically (using the same format accepted for electronically-filed applications, namely, the signatory must enter any combination of alpha/numeric characters that has been specifically adopted to serve the function of the signature, preceded and followed by the forward slash (/) symbol. Acceptable "signatures" could include: /john doe/; /jd/; and /123-4567/. (See 64 FR 33056, 33062 (June 21, 1999))); and (2) address every issue raised. Failure to comply with these additional requirements will result in delays in prosecuting your application.

Please note that the law office e-mail addresses listed below are for *formally* responding to Office Actions and/or submitting preliminary amendments. Your cooperation in not using these addresses for anything other than official responses is appreciated. If you wish to send something other than a preliminary amendment/correction and/or response, such as a question or comment, please send your message to TrademarkAssistanceCenter@uspto.gov. Thank you.

Submissions That Are Not Acceptable Via E-Mail Or Facsimile. The Office does not accept submission of any of the following via e-mail or facsimile:

Trademark/Servicemark Application
Statement of Use/Amendment to Allege Use for Intent-to-Use Application

Request for Extension of Time to File a Statement of Use
Declaration of Use of a Mark under Section 8
Combined declaration of use application for renewal of registration of mark under Sections 8 & 9
Declaration of Incontestability of a Mark under Section 15
Requests to Divide and application
Any document containing credit card information for the purposes of paying fees
Any e-mail communication with attachments EXCEPT those in jpg or gif format

Certificate Of E-Mail And Facsimile Transmission. Under 37 C.F.R. §1.8, e-mail and facsimile correspondence will be considered to be timely filed, even if received after the due date, if the correspondence is: (1) transmitted to the Office by e-mail or facsimile on or before the due date; and (2) accompanied by a certificate attesting to the date of transmission. 64 Fed. Reg. 33056, 33063 (June 21, 1999). See TMEP §§306.05 et seq. regarding the certificate of transmission procedure under 37 C.F.R. §1.8.

The following wording is suggested for the certificate of transmission:
I hereby certify that this correspondence is being transmitted by [electronic mail or facsimile] to the United States Patent and Trademark Office on the date shown below.
(Typed or Printed Name of Person Signing Certificate)
(Signature)

[Please note that if this is part of the actual electronic message and not a previously signed document that has been attached as a jpg or gif file, it must also be signed electronically using the same format accepted for electronically filed applications - the signatory must enter any combination of alpha/numeric characters that has been specifically adopted to serve the function of the signature, preceded and followed by the forward slash (/) symbol. Acceptable "signatures" could include: /john doe/; /jd/; and /123-4567/. (See 64 FR 33056, 33062 (June 21, 1999)))

(Date)

E-Mail Addresses, Phone and Fax Numbers at the Trademark Office

Law Office	Phone	Fax	E-Mail
101	(703) 308-9101	(703) 746-8101	ecom101@uspto.gov
102	(703) 308-9102	(703) 746-8102	ecom102@uspto.gov
103	(703) 308-9103	(703) 746-8103	ecom103@uspto.gov
104	(703) 308-9104	(703) 746-8104	ecom104@uspto.gov
105	(703) 308-9105	(703) 872-9825	ecom105@uspto.gov
106	(703) 308-9106	(703) 746-8106	ecom106@uspto.gov
107	(703) 308-9107	(703) 746-8107	ecom107@uspto.gov
108	(703) 308-9108	(703) 746-8108	ecom108@uspto.gov
109	(703) 308-9109	(703) 746-8109	ecom109@uspto.gov
110	(703) 308-9110	(703) 746-8110	ecom110@uspto.gov
111	(703) 308-9111	(703) 746-8111	ecom111@uspto.gov
112	(703) 308-9112	(703) 746-8110	ecom112@uspto.gov
113	(703) 308-9113	(703) 746-8113	ecom113@uspto.gov

114	(703) 308-9114	(703) 746-8114	ecom114@uspto.gov
115	(703) 308-9115	(703) 872-9875	ecom115@uspto.gov
116	(703) 306-7900	(703) 746-8116	ecom116@uspto.gov
TAC	(703) 308-9000	(703) 746-3600	TrademarkAssistanceCenter@uspto.gov
Pre-Exam	(703) 308-9401	(703) 308-9096	TMPreExam@uspto.gov
Intent to Use (ITU)	(703) 308-9550	(703) 746-3400	TMITU@uspto.gov
Publication & Issue	(703) 308-9401	(703) 746-3300	TMPubIssue@uspto.gov
Post Registration	(703) 308-9500	(703) 746-3200	TMPostRegistration@uspto.gov
Petitions	(703) 308-8900	(703) 746-3000	TMPetitions@uspto.gov
Commissioner	(703) 308-8900	(703) 746-3000	
TTAB	(703) 308-9300	(703) 308-9333	
TM Library	(703) 308-7200	(703) 305-1907	
Status Line	(703) 305-8747		
PTO Copy Sales	(703) 305-8716	(703) 308-7048	
Assignments	(703) 308-9723	(703) 308-7124	

RULE CHANGE: Section 1.10 amended, effective June 24, 2002

Previously, filers had to rely on 1.10 ("Express Mail") to receive an effective filing date for new applications. However, 1.10 was amended (effective June 24, 2002) to eliminate this option for new applications, as well as the other forms specified in the rule: 1) amendment to allege use; 2) statement of use; 3) request for extension to file a statement of use; 4) Section 8; 5) Section 9; and 6) requests to change correspondence address. The rule does NOT reference either responses to office actions or preliminary amendments, so 1.10 CAN still be used for those documents (they were not included because the electronic forms for those two are relatively new). At some time in the future, the rule may be amended to also eliminate 1.10 for both the response form and the preliminary amendment form. However, please also note that through pure oversight, Section 15 was not listed. We will issue a new rule in the future, to correct this oversight, and perhaps add other forms to the list.

The provisions of Section 1.8 were NOT being changed at all. Section 1.8 establishes an effective filing date as the date of deposit of a document with the U.S. Postal Service as first class mail. This is a totally different procedure than using the "Express Mail" procedure provided for in Section 1.10. However, 1.8 provisions apply to ALL documents EXCEPT the initial application.

The practical effect for most filings is minimal in terms of getting an "effective" filing date (i.e., when the document actually arrives at the USPTO is irrelevant, because we are giving the date of deposit as the assigned filing date), because the 1.8 option could still be used. BUT, this is a critical change for new applications, because to receive today's filing date, you must either 1) file electronically; 2) Fax the application to someone in the Arlington, VA area, for hand delivery to the USPTO; or 3) prepare the application one day in advance, and use an overnight courier service for delivery to the USPTO. The most serious area of concern here is for a new application based on a Section 44(d) priority claim. You will NOT be able to wait until the last day of the 6-month period and then get a "timely" filing under 1.10.

FRANKLIN PIERCE
LAW CENTER LIBRARY
CONCORD, N. H.

TOP TEN MYTHS ABOUT TRADEMARK ELECTRONIC FILING

Myth 1: ***Signature methods are too cumbersome and burdensome.*** Although the signature method originally was cumbersome, we have since introduced two new methods to simplify this process. Under the first new method, the client can access the form for signing directly from a hyperlink included in an email generated upon completion of the form by the attorney—no "downloading" of any portable form is required. The client will see a "text form," a narrative, paragraph-style format that only permits entry of the signature and date, and ***not*** the manipulation of any other data. The client will not have to see either the original application form used by the preparer of the application, or any sort of form with incomprehensible data tag elements.

The second method accommodates clients who cannot even access Internet email. Here, the attorney will complete the TEAS application, and then print out the "Text" form. This paper copy can then be mailed or faxed to the client for a traditional pen-and-ink signature. Once the signed application is returned, the attorney can scan the document to create an image file of the signed declaration, to attach within the original electronic version of the application. The complete application can then be validated and filed electronically.

It is important to also remember that, although not desirable from the standpoint of efficiency of USPTO processing, an initial TEAS application ***may*** be filed electronically without ***any*** signature. A follow-up declaration with a traditional pen-and-ink signature may then be submitted, either as a preliminary amendment or in response to an Office Action. However, it is critical to make clear at the time of filing the signed declaration that this submission is only to complete an application for which a serial number has already been assigned, and "to verify all facts set forth in the original application." If, instead, the signed declaration is submitted along with a hard copy of the original application, the Pre-Examination section may believe this is an entirely new submission, and as such, assign a new serial number (rather than simply associating the signed declaration with the electronically-filed application).

Myth 2: ***Payment methods are limited and/or problematic.*** Actually, payment can now be made by one of three (3) different methods, one of which should suit your needs. First, payment can be made via a credit card through a secure site that accepts MasterCard, Visa, American Express or Discover, for "real time" processing, meaning that an application cannot be transmitted absent verification of valid credit card information.

Second, payment can be made through an already-existing USPTO deposit account, which since November 12, 2001 will be processed in real time, so that an application cannot be transmitted absent USPTO verification that there are sufficient funds within the deposit account.

Third, payment can be done through the Electronic Funds Transfer payment method, which allows you to send the USPTO a payment over the Internet as easily as writing a check, by entering a bank account number and a bank transit routing number.

Also, with recent upgrades to the USPTO finance system, payment by any of these means should result in more information appearing on your statements, so that you should be able to associate

a payment with a specific filing. However, although the USPTO will pass the accounting detail including serial number to all banking institutions, not all banking institutions in turn provide this level of detail back to their customers.

Myth 3: ***There is no easy way to do many filings for the same client.*** It is, in fact, possible to create a template for multiple filings from the same client in TEAS. At the bottom left of the very front page of the TEAS site, there is a special icon for "Downloadable Blank Initial Application form." Through this special form, you can enter as little or as much information as desired, and then save it for later use. Currently, only the initial application has this feature, but plans are to add it to all TEAS forms in the future.

However, to make multiple filings even easier, the USPTO has converted its forms to use XML coding language, so that standard data can be imported into the various forms quickly and easily. This should help address one of the primary criticisms of TEAS, namely that in-house templates are currently more efficient.

Myth 4: ***Electronic documents cannot be saved for later modification.*** In TEAS, once you complete any application, you can save that application to your computer's local drive, as you would save any other document. The only difference is that the application will automatically be saved in a certain format, known as XML.

Saving the application simply requires clicking on the Download Portable Form button on the bottom of the TEAS Validation Page, accessed after you successfully complete the application by entering all fields required to receive an application filing date. Once saved, you can modify the application at any time prior to submission, simply by pulling the file up from your local drive—in the same manner that you would pull up a regular Word document to enter changes.

Myth 5: ***GIF and JPEG image formats required by the USPTO are difficult formats.*** First, it is important to note that in many cases, no special equipment, beyond the proper versions of either Netscape or Internet Explorer is required to use TEAS. That is, unless a special form drawing or specimen must be attached, no scanner or digital camera is required. Moreover, because a specimen is ***not*** required to receive a filing date, even a use-based initial application could be submitted through TEAS. A traditional hard-copy specimen submitted could then be filed in the regular course of prosecution of the application, or as a preliminary amendment.

As to gif and jpeg images, both of these are standard image formats widely used in the computer and graphic design industry, and can easily be created using inexpensive entry level computer peripherals that create or scan images, namely scanners and digital cameras. Even so, the USPTO is now exploring how to accommodate files in other formats, such as TIFF.

We are also considering the option of having the USPTO create, for a fee, an acceptable gif or jpeg image file for the applicant, based on a paper or faxed submission. This would obviate the need for special equipment, and would also improve the quality of the drawings and/or specimens for TEAS filings.

Myth 6: ***The user may not know if the USPTO received the electronic filing, particularly if the e-mail acknowledgement is not returned.*** We do recognize that many filers have come to count on the stamped postcard from a paper-based filing. But, TEAS really does provide the assurance that you need that the filing was successful. The e-mail acknowledgement is simply a follow-up courtesy that the USPTO provides. Within the actual filing session, a screen appears within seconds of completion of the filing process. It says "Success! We have received your application and assigned the following serial number." You can print out this screen for your records. If you do **not** see this Success screen, then the filing did **not** go through. Again, this should occur within seconds of completion of the process, so there should never be any doubt about whether the USPTO received a particular filing.

Myth 7: ***Electronic filings will not be properly docketed at the law firm, because the filing receipt will be sent to the email address of the person who prepared the application; and also that TEAS filings cannot be associated with a specific attorney docket number.*** In reality, on the Validation page you can specify ***any*** address to which you would like the e-mail acknowledgement to be directed. This ***can*** be the same address as that of the preparer of the application, or it could be a specially-created docketing address that will go somewhere else in the firm. Also, the form itself does provide, within the Attorney Information Section, a specific field for the entry of your own attorney docket or reference number.

Myth 8: ***The computer printouts look "unprofessional."*** To address previous criticism that the TEAS output was not "professional" looking, a new format was introduced for viewing the information, known as the "Text" form. This can be accessed from an icon on the Validation Page, upon successful validation of the first part of the application. Because the "Text" form presents the application data in a narrative, paragraph-style format, it is more user-friendly and analogous to what a law firm might prepare.

Also, as referenced earlier, the USPTO has converted all of the TEAS data from an HTML format to XML format, which will be a more universally-recognized format. The XML format will allow customers to communicate with us through documents that have whatever "look" the firm chooses, as long as the underlying XML tagging structure coincides with USPTO requirements.

Myth 9: ***Drawings are being corrupted by TEAS, leading to rejections by the examining attorneys.*** Our experience has been that, upon reviewing the drawings that are the basis of these corruption claims, we have found that, in reality, the drawings as originally prepared did ***not***, in fact, comply with our drawing standards. Instead, the originals included gray tones, rather than clean black-and-white images.

Because we are now preparing our ***Official Gazette*** internally, it is imperative that submitted drawings comply completely with our drawing rules. Again, that means that all marks must consist of crisp blank-and-white images, with no gray tones.

Myth 10: ***The applicant cannot simply "play around" on TEAS without fear of filing an application***. Actually, we encourage you to get on-line and explore TEAS, as this is the only way you will become comfortable with electronic filing. Up until you hit the final button

whereby you would authorize payment for the filing, you can simply close your browser at any time in the process, thereby stopping the application. Also, we suggest that in trying out the system, you simply enter an "X" in the data entry fields. This will still allow the application to validate, but will reduce the amount of information you must enter. Also, under the absolute worse case scenario, even if you file this application, you would later receive a fee refund, since you did not enter any "real" information to warrant granting of a filing date.

Electronic Filing: Practical Filing Issues, Litigation Issues, and 4 Tier Examination

ELECTRONIC TRADEMARK REGISTRATION PRACTICE: WHAT EVERY TRADEMARK LAWYER NEEDS TO KNOW

Presented by Michael Albert and Carole A. Boelitz

October 4, 2002

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PRACTICAL FILING ISSUES

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PRACTICAL FILING ISSUES

- Signatures
- Specimens
- Verification of Electronic Application
- Correction of Mistakes
- Certificate of Mailing

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SIGNATURES

- **The attorney may sign the verification of the application (37 C.F.R. Sec. 2.33(a))**
  - **Will attorney then be a fact witness for the statements within the verification?**
  - **37 C.F.R. § 10.18: "any statement made therein on information and belief are believed to be true"**
- **The applicant may sign**
  - **Electronic signature may be cumbersome with only 72 hours allowed**
  - **Scanned signature may have issue of authenticity as to what document actually signed.**
    - Did applicant sign IDENTICAL document as that e-filed?

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SPECIMENS

- **Must be in .gif or .jpg format.**
- **Some applicants would like to submit .pdf and website address**
- **Formats allow ONE page of specimens**
- **Specimens document must exist at time use Form Wizard to create the application**

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VERIFICATION OF ELECTRONIC APPLICATION

- **What is the formal procedure to verify e-filing if not receive automatic "Success" screen or e-mail?**
- **Examine possibility of returning fees for duplicate application**
- **What is the formal procedure if e-filing (ETEAS) is down?**

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CORRECTION OF MISTAKES

Form Wizard sets up:

- **type of application 1(a) 1(b), 44(d) and 44(e)**
- **number of classes**
- **number of signatories**
- **whether attorney or applicant is signing**
- **e-signature or scanned signature**

Thus, if any of these must be changed, a whole new application must be created.

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Certificate of Mailing

- **New § 1.10 - Express Mail receive date of deposit UNLESS available on E-TEAS:**
  - **TM application - No § 1.8 available**
  - **Amendment to Allege Use/Statement of Use**
  - **EOT for Amendment to Allege Use**
  - **§ 8**
  - **§ 9**
  - **Correction of Address**

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LITIGATION ISSUES

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LITIGATION ISSUES

- Date of Filing
- File Maintenance
- Signature Requirement
- Domestic Representative
- Copy of Foreign Registration
- Elimination of Specimens

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DATE OF FILING

- **Paper - Date of Receipt by PTO - New 37 C.F.R. 1.8**
- **E-File - Date of Receipt by PTO (Immediate in most cases) - 37 C.F.R. 1.6(a)(4)**

E-Filing will also intrinsically have a time of filing, due to electronic transmission. Will this time of filing have any weight in the (unlikely) event of confusing marks being filed on the same date?

- prefer e-filing since 'earlier date of submission?

- prefer paper filing since actually mailed at earlier date than filed?

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FILE MAINTENANCE

The U.S.P.T.O will maintain electronic file wrappers for all pending and issued trademark registrations (TIS). (Strategic Plan, Part 1 Agility e-government 1)

- **The USPTO is not yet compliant with Government Information Security Reform Act (Strategic Plan, Part 1 Agility e-government 4)**
- **How will we be able to determine if an e-file wrapper becomes corrupted (software bug, hacker or catastrophic event)?**
- **How will we re-create a lost or corrupted file wrapper - what are the requirements of proof of evidence of corruption?**

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SIGNATURE REQUIREMENT

- **How will we be able to tell what document the signatory verified if only scan and submit signature?**
- **The Strategic Plan suggests removing the signature requirement. (Strategic Plan, Part 2c Legislation/Rules 1k)**
  - **Who is then verifying statement of Intent to Use or Dates of Use?**

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DOMESTIC REPRESENTATIVE

The Strategic Plan suggests eliminating requirement for domestic representative. (Strategic Plan, Part 2c Legislation/Rules 1k)

- **Currently in H.R. 615 Intellectual Property Technical Amendments Act of 2001**
  - **Foreign applicant would then accept service by through Commissioner**
  - **Commissioner will publish a notice in OG for at least 4 consecutive weeks - 37 C.F.R. § 10.135**
  - **Time to answer will be at least 30 days from 4th publication**

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COPY OF FOREIGN REGISTRATION

The Strategic Plan suggests eliminating requirement for certified copies of foreign registration. (Strategic Plan, Part 2c Legislation/Rules 1k)

- **What is the point of Certification?**
- **Will number of cancellation proceedings increase or will it increase burden of evidence if litigation?**

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ELIMINATION OF SPECIMENS

The Strategic Plan suggests eliminating examination of specimens. (Strategic Plan, Part 2c Legislation/Rules 1k)

- **Revised Strategic Plan withdraws this issue - Examiner will still examine specimens for consistency with drawings, consistency with each other, and use meeting requirements of Trademark Act**
- **PTO still need to review specimens for use of mark as shown in application and for functionality as a mark, ornamentation, descriptiveness, etc.**
- **Will Registrant or Attorney be required to provide specimens on demand in litigation?**

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4 TIER EXAMINATION
(Strategic Plan, and Part 3 Pendency 1 & 2)
Part 2c Legislation/Rules 1k

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4 TIER EXAMINATION

(1) Applicant: Complete, E-File application, fees at filing (least expensive), goods and services must conform to Manual of Goods and Services, search from a certified searching service, 30 day mandatory electronic response

PTO: priority review (1st action within 1 month and registration within 9 months), examined out of order, "second set of eyes" review.

(2) Applicant: Complete, E-File application, fees at filing (next least expensive), goods and services must conform to Manual of Goods and Services, 30 mandatory electronic response.

PTO: Expedited review (1st action within 2 months and registration within 12 months), examined out of order, "second set of eyes' review

(3) Applicant: Minimum E-filing application (next most expensive).

PTO: Review in order filed, no guarantee of 1st action of registration time limit.

(4) Applicant: Paper filing application, most expensive fees + $50 surcharge for paper filing.

PTO: Review in order filed, no guarantee of 1st action of registration time limit.

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4 TIER EXAMINATION

	TIER			
	1	2	3	4
File Form	Complete Electronic	Complete Electronic	Electronic	Paper
Fees	$ (at time file)	$$ (at time file)	$$$	$$$$
Conform to Manual of G&S at time file	✓	✓		
Applicant provides Certified Search from CSS at time file	✓			
Applicant has 30 days to respond	✓	✓		
Applicant must respond electronically	✓	✓		
Priority Review (1st Action within 1 month and issue within 9 months)	✓			
Expedited Review (1st Action within 2 months and *issue within 12 months*))		✓		
Examiner Out of Order	✓	✓		
Second Set of Eyes Review	✓	✓		

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CERTIFIED SEARCH

- **Revised Strategic Plan withdraws 3rd party certification. Current proposal for USPTO standard X-search pre-search. Examiner has discretion to supplement with further full X-search.**

- **Who will be certified?**
- **Cut off at 300 hits.**
- **Only receive $50 reduction in fees if submit certified search.**
- **Forum shopping for certified searcher with 'good' applicant results?**
- **Will applicants with large accounts be able to skew results based upon maintenance of account with searcher?**
- **Amount of deference to certified search in litigation?**

(Strategic Plan, Part 2 b Quality 6)

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EXAMINATION WITH TIERED SYSTEM

- **There will be no examination out of order.**
  - **All applications will be entered into TIS on first-in-first-out basis. If conflict, senior application will be examined first.**
  - **Will be implemented on small scale at first**
- **Second Set of Eyes review will not require us to persuade two Examining Attorneys.**
  - **Second attorney only on initial review.**
- **Why should Tiers 1 and 2 receive 'better' review?**
  - **Will it receive more deference from court?**

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FEES

- **Tiered fees do not seem justified by amount of work or benefit received.**

- **Strategic Plan suggests eliminating the provision that the Director may raise trademark fees only yearly, and only in response to fluctuations in the consumer price index.**
  - **Currently withdrawn from Revised Strategic Plan**

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TIME TO RESPOND

- **30 day response time within Tier 1.**
  - **What are the consequences if miss that date?**
    - Revert to statutory period
    - Lose expedited status
    - Penalty fee
- **Revised Strategic Plan - decrease 6 month statutory period in current telecommunication world**

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MANUAL OF GOODS AND SERVICES

- **Mandatory Compliance within Tiers 1 and 2.**
- **What if goods or services are new?**
  - **Planned update by October, 2003**
  - **PTO will work with Bar to add cutting edge goods and services**
- **Undefined terms within Manual right now, i.e., "downloadable in Class 9 v. non-downloadable in Class 41"**

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IMPLEMENTATION

- **Draft/submit legislation changes in FY 2002**
- **Draft/publish CFR and TMEP changes in FY 2002**
- **Fully implement by October 1, 2003**
- **Revised Strategic Plan - places TIS implementation first and most other projects will depend on full TIS implementation**

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