

OVERVIEW OF THE TRADEMARK EXAMINING OPERATION

by Craig Morris, Manager
Trademark Business Process Reengineering
U.S. Patent and Trademark Office
2900 Crystal Drive
Arlington, VA 22202

The Trademark
Examining
Operation
(TMEO) is
crucial to

accomplishing the mission of the United States Patent and Trademark Office (USPTO), administering trademark laws that assist businesses in protecting their investments, promoting goods and services, and safeguarding consumers against deception in the marketplace. Trademarks, as intellectual property, have financial and practical value for both the trademark owner and the consumer. One indicator of the value assigned to the registration system is the fact that the number of applications filed continues to grow each year. In fiscal year 1998, approximately 193,000 applications were filed. In fiscal year 1999, approximately 240,000 applications were filed.

The TMEO supports the mission and strategic themes of the Department of Commerce by improving intellectual property systems in the United States and abroad through its administration of the trademark statute and participation in international agreements to promote U.S. competitiveness in the global marketplace. It also provides effective management of our nation's assets to ensure sustainable economic opportunities.

The Commerce Clause of the Constitution establishes the basis for the government to regulate commerce with foreign nations and among the states, thereby establishing the authority under which trademark statutes are enacted and the USPTO administers the trademark registration system. The intent of the statute is to protect registered marks used in commerce from interference by the states and from unfair competition in U.S. and foreign marketplaces.

The TMEO maintains a register of more than 900,000 trademarks, providing businesses and consumers with notice of marks that are in active use. Although federal registration of trademarks is not required, registration does:

- ◆ Provide notice to others of marks in use in commerce in the U.S.
- ◆ Provide access to the federal courts
- ◆ Provide *prima facie* evidence of ownership
- ◆ Provide access to anti-counterfeiting statutes
- ◆ Permit enforcement of rights
- ◆ Provide a basis for foreign filing

THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS)

BACKGROUND

In order to meet the growing demands placed on the TMEO by dramatic increases in filing levels, the USPTO has used business process reengineering principles to change its way of doing business. One outcome has been the development of the Trademark Electronic Application System (TEAS). In the early 1980s, the then Commissioner of Patents and Trademarks proposed a far-reaching goal for the USPTO to become a paperless office. Since that time, the USPTO has been able to automate many of its systems. However, it was not until November 1997 that the USPTO was able to make a truly major step towards the achievement of the goal of a paperless office with the introduction of TEAS. This progress was due, in large measure, to recent acceptance of the Internet as a method of business communication.

The USPTO first began TEAS as a pilot program, with approximately fifty participants selected to test the concept of operations for online filing. Although the overall number of applications filed was not high over a ten-month period (approximately 350 applications), the USPTO was satisfied that electronic filing was, indeed, viable. Thus, on October 1, 1998, the TEAS site was opened to the general public. Since that time, the USPTO has received over 23,000 electronically-filed applications. Today anyone with access to the Internet, whether an attorney in a law firm, an in-house attorney in a corporation, or an individual *pro se* applicant, can file a trademark application directly online, through <http://www.uspto.gov/teas/index.html>.

The TEAS site actually is divided into two components, e-TEAS and PrinTEAS. Both allow you to fill out an application form and check it for completeness over the Internet. Using e-TEAS you can then submit the application directly to the USPTO over the Internet, paying by credit card or through an existing USPTO deposit account. On the other hand, through

PrinTEAS you can print out the completed application for mailing to the USPTO, paying by check, money order or through an existing USPTO deposit account.

TEAS gives step-by-step instructions for completing a trademark or service mark application form properly—the site features “links” to help information at the bottom of the form, which can be accessed for any particular section. It also provides access to a wide variety of information about USPTO procedures and practices. Although the different sections of the forms may appear straightforward and easy to fill out, the USPTO strongly encourages applicants to read the HELP instructions very carefully for EACH section PRIOR to actually completing it. Failure to follow this advice may cause sections of the form to be completed incorrectly, jeopardizing legal rights.

There are some basic technical requirements for using the system: 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). The e-TEAS system utilizes frames, JavaScript, and the file upload feature supported by these browser versions. Also, Internet Explorer on the Macintosh platform will NOT permit a proper image attachment, if an image is required for the particular application. PrinTEAS, on the other hand, works best if you use either Netscape Navigator (Version 3.0 or most recent) or Microsoft Internet Explorer (Version 4.0 or most recent).

The web site server is open 24 hours a day, 7 days a week, 365 days a year and issues a filing date for the date in question up until midnight, Eastern Standard Time (U.S.). If an application is filed after midnight, the filing date is the next regular business day. However, an e-TEAS filing *could* be made on a day that the USPTO is closed (e.g., Saturday), and the USPTO will accord a filing date for that day (rather than the next regular business day). Please note, however, that there is a brief period, from 12:01 a.m. until 6 a.m. Monday, when credit card transactions cannot be processed, so an e-TEAS application could not be fully submitted to the USPTO during that period.

THE FORM WIZARD AND APPLICATION

Both the e-TEAS and PrinTEAS sites begin with a “Form Wizard.” This is a series of “Yes” and “No” questions that you should answer to create the proper application form. That is, by using the “Form Wizard,” you are able to pull up an application form that ONLY contains sections relevant to a particular filing. For example, if the applicant is a *pro se* applicant, by answering “No” to the question asking “Is an attorney filing this application,” the form that will be pulled up after answering all questions on the “Form Wizard” and clicking the NEXT button will NOT include an Attorney

Information section. However, if a “complete” form is needed, there is an option to select “Standard Form,” which includes ALL possible sections.

Once the form comes up, entries are simply made in the appropriate boxes. There are five (5) fields that are delineated with a red asterisk. These are the “mandatory” fields that must be completed, under the terms of the Trademark Law Treaty Implementation Act of 1998 (TLTIA), to receive a filing date. Although the other fields are optional, in terms of receiving a filing date, the USPTO encourages you to complete ALL fields for which you have the necessary information, to avoid later delays in the prosecution of the application.

When the form is completed, there is a Validate Form button. This validation function will permit the USPTO to check whether information has been entered in particular fields. It is not, however, in any way checking the validity of the information entered, nor is it performing any sort of search to see whether the mark is registrable. These functions are performed by the assigned examining attorney in the normal course of prosecution of the application. If one of the five (5) mandatory fields has not been completed, an “error” screen will come up indicating what information must still be entered for the application to be submitted. On the other hand, if the piece of information that is missing is in an optional field, a “warning” screen will come up. This screen will indicate what information has not been entered, but then will provide the option of either submitting the application as is or going back to enter any missing data.

SIGNATURE OPTIONS

Many attorneys are concerned about obtaining the signature of their client on the application when the client is located in another city. This was handled by making the application “portable,” which means that it can be filled out by the applicant’s attorney, e-mailed to the applicant for signature, and then returned to the attorney for filing at the USPTO. The signature that is used is any combination of alpha-numeric characters placed between two forward slash symbols (/). For example, /john smith/ or /js/ or /s123/ would all be acceptable signatures. This is totally at the discretion of the signatory and does NOT require any sort of approval by the USPTO.

However, it should also be noted that TLTIA eliminates the specification of the appropriate person to sign on behalf of an applicant, which arguably made the signature requirement less cumbersome after October 30, 1999. Under TLTIA, the appropriate person to sign the form is:

1. a person with legal authority to bind the applicant; or
2. a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or
3. an attorney who has an actual or implied written or verbal power of attorney from the applicant.

If there are joint or multiple applicants, or if it is corporate policy to have two or more officers sign the application for one applicant, each must sign and provide the relevant information.

IMAGE ATTACHMENT

Another major concern is how to apply electronically for a mark that is in a stylized format and/or an application that is filed based on Section 1(a), actual use in commerce, for which you want to submit the specimen (sample) of how the mark is being used, e.g., a tag or label for goods or an advertisement for services. For either of these, you must attach an image file in the GIF or JPG file format. These are the only two formats that the USPTO currently will accept. This requires that you “scan” or take a digital photograph of the specimen. If you cannot do so, then you could use the PrinTEAS option and mail the printed application to the USPTO.

Please note that due to technical limitations within the browsers now available, and to simplify the process and prevent possible errors, where you are filing an application with 1) a mark image file (in JPG or GIF format, to show the mark in a stylized manner or a design); and/or 2) a specimen image file (in JPG or GIF format, to show the mark as actually used in commerce), neither of these image files will be available for viewing or printing an application that was previously downloaded and saved. Either or both of these image files will need to be re-attached to the application before final submission to the USPTO.

VALIDATION

Once the application is properly validated, you may check the information entered on the form, in one of two formats. You can either use the icon for the “scannable format,” which would show all of the information entered converted into a data tag format (e.g., <NAME> John Jones). You could also use the “Input” format, which presents the data in a table or chart format, which some users find easier to read. You can also check the drawing page, which will show the mark for which registration is being sought (either words alone or a stylized presentation and/or design element, based on the attached GIF or JPG that was attached). The specimen image file can also be viewed

to ensure that it has “loaded” properly. You should print out each of these pages for your records by using the print function within your browser.

If you discover any errors, you would use the Go Back to Modify button to re-enter the proper information. Upon re-entry, the application must be re-validated. It is critical that the information be checked completely before submission, because once you submit an application, either electronically or through the mail, the USPTO will not cancel the filing or refund your fee, unless the application fails to satisfy minimum filing requirements. The fee is a processing fee, which is not refunded even if the USPTO cannot issue a registration after a substantive review.

After a successful validation, you may save the file to your choice of drive and directory, using the Download Portable Form button at the bottom of the Validation Screen and the SAVE function within your browser. Once you have saved an application in this manner, you can then use it as you would any other file, i.e., opening it again for additional review and/or attaching it to an e-mail message to transfer it to another person and/or location. The portable form could also be used to save out a template if you plan on doing multiple filings.

If you transfer the file to another person via an e-mail message, the recipient of the message can (as long as the recipient has a compatible web browser) simply save the attachment to a local drive and directory and then open it from within his or her web browser for review (and “signature” if that person is the appropriate person to sign on behalf of the applicant).

The recipient can then make changes to the application and/or sign it (if that person is the appropriate person to sign on behalf of the applicant) and save the changes and/or signature using the same “Download Portable Form” button and SAVE functions used originally to save the application. Once an application has been signed and saved in this manner, it can then be returned to the applicant’s attorney via e-mail for actual filing with the USPTO. Each time a new party accesses the form, it must be re-validated in order to reach the page that will allow either the save function or the Pay/Submit function.

PAYMENT

If you are ready to submit the application, you would click on the Pay/Submit button. If you are paying by credit card, this will bring up a screen asking standard questions regarding the credit card payment (card number, expiration date). The USPTO accepts MasterCard, Visa, American Express, and Discover. Once all of the required information is entered, the application is submitted to the USPTO. If paying

through an existing UPSTO deposit account, hitting the Pay/Submit button will immediately submit the application to the USPTO.

Upon successful receipt of an electronically-filed application by the USPTO, within the same session you will see a screen that says "SUCCESS! We have received your application and assigned serial number _____." If you do not see this screen, the USPTO did NOT receive the application. You will also receive a separate e-mail confirmation within 24 hours that will include the same serial number, as well as a summary of the information entered in the application (although if the mark consists of stylized wording and/or a design, this will not be bounced back, nor would any specimen image—this is why you should print out a hard copy of these pages, as accessed through the icons on the validation page, before actual submission).

CORRECTING ERRORS

If you determine after submitting your application that you made an error in the information you entered, DO NOT request via e-mail that we correct your filing. The application is considered officially filed as submitted and the TEAS staff cannot make any changes. This is why you must carefully review the information before hitting the Pay/Submit button. To attempt to correct an error discovered after submission, you must send a hard copy (not electronic) preliminary amendment to the following address:

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202

There is no set "form." On a piece of paper, you would use the heading of the MARK and the SERIAL NUMBER, followed by the caption PRELIMINARY AMENDMENT, and then the request (i.e., please change X to Y). Please note that the examining attorney will determine whether the requested changes are acceptable (for example, if you made a major error in your mark, and want the mark changed to something else, this most likely would NOT be acceptable). Also, you should wait one month before submitting the request, in order to allow the case file to get to the proper office (so that your paper could be properly matched with the file).

Once received by the USPTO, a paper copy of the electronic filing is generated (since, at this time, the bulk of work in the USPTO is still done in a paper format). Assuming that, upon review of the filing by the Pre-Examination section, all minimum filing requirements have been satisfied, the user will receive an official paper filing receipt via regular U.S. mail approximately 40-50 days after submission of the applica-

tion. If, on the other hand, the minimum filing requirements have not been satisfied, the USPTO will return all papers to the applicant and refund the filing fee. This is not the scenario when minimum filing requirements have been satisfied; once examined by the examining attorney, papers are not returned and fees are not refunded, even if the examining attorney determines that the mark cannot be registered.

For general trademark information, please telephone the Trademark Assistance Center at 703-308-9000. For automated status information on an application that has an assigned serial number, please telephone 703-305-8747, or check the USPTO status server at <http://tarr.uspto.gov/>. Please note that the Trademark Application and Registration Retrieval System (TARR) site will, in addition to providing current status information, list the current owner of the mark, the goods and/or services, and the full prosecution history of the application or registration. You may wish to perform a search to see if there is a federal registration or pending application for a similar mark used on related goods and/or services. Please see <http://www.uspto.gov/tmdb/index.html>.

If you need help in resolving glitches or need answers to technical questions, you can send an e-mail to PrinTEAS@uspto.gov. Please include your telephone number, so someone can contact you directly, if necessary. However, please do NOT use this e-mail for general questions (again, please call the Trademark Assistance Center at 703-308-9000). The front page of the TEAS site also includes links to Frequently Asked Questions about Trademarks and a "Bug Report" to alert the USPTO of any technical problems.

ADVANTAGES OF ELECTRONIC FILING

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

- a dramatic increase in the speed with which applications can be filed;
- the ability to receive a filing date up until midnight Eastern Standard Time, rather than an earlier time (often 5 p.m.) — which is the case using the U.S. Postal Service Express Mail certificate procedure;
- substantial savings on Express Mail postage, fax charges or courier delivery costs, because electronic applications are created, reviewed, and filed electronically using the Internet; and
- more efficient review of the applications because they are in a standard format recommended by the USPTO.

Because electronic applications can be prepared and passed around via e-mail almost instantaneously, the speed for filing can increase dramatically. For

example, a large multinational corporation based in Europe that has used the system extensively has cut the average time to file an application from five to seven working days to less than two. In the past, they drafted applications on a word processor in the United States, e-mailed them to Europe to be printed out, signed, and faxed or mailed them back to their U.S. office to be filed at the USPTO. Their e-TEAS applications are filled out by counsel in the U.S., sent via Internet e-mail to Europe, signed electronically, and returned to counsel in the U.S. for immediate filing. In one urgent situation, an application was drafted in the U.S., sent via e-mail to Europe, signed, returned, and filed at the Trademark Office, all in just 32 minutes.

The extended operating hours of the e-TEAS system also offer substantial benefits. Because six-month Paris Convention priority deadlines are statutory, being able to file so quickly and getting the benefit of up to seven extra hours before a filing date passes may be crucial. Using the paper system, a filing date may be lost if the application is not filed at the USPTO by 5 p.m. Eastern Standard Time, or at least mailed via Express Mail by the time the post office closes. Using e-TEAS enables you to file until midnight, providing applicants on the East Coast an extra seven hours and those on the West Coast an extra four hours for filing.

Finally, cost savings may be substantial. A company or law firm that files a large number of applications each year can essentially cut the out-of-pocket postage

and/or fax expenses for filing an application from \$15-20 down to nothing, simply by using e-TEAS and the Internet. For example, it may cost \$3-4 in long distance charges to fax an application to a client for review and signature and have it faxed back. It then costs \$10.95 to use Express Mail to forward the application to the USPTO. Filing via e-TEAS costs nothing. The application is created electronically, sent via e-mail to the client for review and signature, returned via e-mail and filed electronically. Savings could be substantial over the course of filing hundreds of applications.

THE FUTURE

While the TMEO probably will always have to be prepared to accept paper documents, the TMEO believes it is well on the way to at least having the capabilities of becoming a "paperless" office. The introduction of the TEAS filing site for basic applications has clearly established the viability of electronic filing. Expectations are that, within a year, electronic filing could amount to at least 25% of all applications filed. Moreover, by April 2000, the USPTO plans to expand the TEAS site to include ALL forms (e.g., Section 8 and Section 9 filings, extension requests, and Allegations of Use). Also, future plans include the ability to prosecute fully all filings electronically, not only to submit the original filing, but also to respond electronically to any actions from the attorney or paralegal. The TMEO will continue to "push the envelope" - but it won't be a paper one!