

United States Trademark Update

Description

A periodic newsletter for our international friends and colleagues regarding changes in U.S. trademark law and practice of current interest.

USPTO To Increase Filing Fees

Effective on 14 January 2017, the USPTO will increase a number of filing fees. The fee increases are primarily directed to paper filings, to encourage electronic filing.

- The good news is that most fees for new applications filed electronically will not increase. One exception is for TEAS filings, for which the filing fee will increase from \$325 to \$500 per international class. This fee increase applies to both U.S. and foreign filers as well as to applications submitted under the Madrid Protocol as requests for extension of protection to the U.S. The filing fee for TEAS RF and TEAS PLUS filings will remain at \$275 and \$225 per international class, respectively.
- In addition, the filing fees for requests for extension of time to file a statement of use for Section 1(b) applications will be reduced from \$150 to \$125 per class.
- Fees for filing so called Section 8 and Section 71 Declarations will also increase from \$100 to \$125 per class. These are the filings required between the 5th and 6th year following registration, and with every renewal application, to evidence that the trademark still is in use in the United States.
- Some fees are changing at the Trademark Trial and Appeal Board, also. The filing fees for a Petition to Cancel or for a Notice of Opposition will increase from \$300 to \$400 per class. The filing fee for an ex parte appeal to the Trademark Trial and Appeal Board filed electronically will increase from \$100 to \$200. New rules will also apply to requests for extension of time to file a notice of opposition. Under the new structure: (1) an initial 30-day extension may be requested for no fee; (2) a subsequent 60-day extension may be requested for a fee of \$100 for electronic filings OR single 90-day extension may be requested for a fee of \$100 for electronic filings; and (3) a final 60-day extension may be requested for a fee of \$200 for electronic filings (and also requires the written consent of the applicant or its representative or extraordinary circumstances).

Based on these changes, we recommend the following filing strategies for U.S. trademark applications whenever possible:

- Foreign applicants should use the TEAS RF option for filing, as it has fewer requirements than the TEAS PLUS option and is less likely to cause a problem for ongoing prosecution.
- Applicants should delay filing Request for Extension of Time for Filing a Statement of Use until after 14 January 2017.
- Requests for an Extension of Time to File a Notice of Opposition, as well as Notices of Opposition and Petitions to Cancel, should be filed prior to 14 January 2017 in order to avoid the higher filing fees.
- Section 8 or Section 71 Declarations should be filed prior to 14 January 2017 in order to avoid the higher filing fees.

Trademark Trial and Appeal Board Procedural Rules Updated

The Trademark Trial and Appeal Board procedural rules will be revised effective 14 January 2017. The principal reasons for the changes are due to changes in technology and changes in the U.S. Federal Rules of Civil Procedure since 2007, when the last major set of rule changes at the TTAB took effect.

Under the new rules, all filings must be made electronically. The new rules also promote discovery limitations, and in some instances allow parties to take testimony by written affidavit or declaration, with the option of oral cross-examination.

Board Continues to Require Documentary Evidence of Bona Fide Intent to Use Marks

Many applicants apply to register trademarks in the United States based on a “bona fide intent to use” the mark. In recent decisions, the Board has continued its long standing practice of approving oppositions to applications where the applicant has no documentary evidence of its bona fide intent to use the mark. The Board has consistently held that neither the filing of an application based on an intent-to-use the mark, nor a trademark availability search, is sufficient to establish a bona fide intent.

We recommend that the applicant, or its attorneys, retain documentary evidence of business plans, marketing or promotional activities, research and development, consumer testing, financing efforts, or any other documents to substantiate the applicant’s claim of a bona fide intent to use the mark as of the filing date of the application.

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