

Fifty-Four Trademark Practitioners

By Priority Mail Express 9470103699300060163863

David S. Gooder, Commissioner for Trademarks
USPTO
P O Box 1451
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August 7, 2021

Dear Commissioner Gooder:

This letter asks that the USPTO improve its trademark e-commerce systems to comport with USPTO's recently expanded requirements regarding applicant addresses.

This letter comes to you from fifty-four trademark practitioners. Most of the signers of this letter are members of the e-Trademarks listserv, a community of over 1200 trademark practitioners. The signers of this letter have individually or through their law firms or corporations collectively paid over fifty-six million dollars to the USPTO in the past ten years. The signers of this letter, individually or through their law firms or corporations, have over sixty thousand US trademark applications and registrations under management.

By way of background, USPTO's trademark e-commerce systems provide only a very limited number of characters and fields for mailing addresses, and provide only a very limited number of characters for the attorney docket number. The fields are:

- internal address – limited to 40 characters
- mailing address – limited to 40 characters
- city – limited to 22 characters
- docket number – limited to 12 characters.

The systems do not provide any field for a region or state or province in any non-US location. The systems provide only two fields for the mailing address – the “internal address” field and the “mailing address” field.

These limitations may have been adequate (although only just barely so) many decades ago when by far the majority of applicants were located in the US and had relatively simple and short mailing addresses. We imagine that these limitations may have been selected by the USPTO at an early time when computer storage devices were very expensive. We also imagine that these limitations may have arisen in part from innate storage-size limits in legacy computer media such as punch cards.

Now in 2021, these limits are completely inadequate for the needs of most trademark applicants. Many of the signers of this letter represent clients located outside of the US, having mailing addresses with line counts and character counts that absolutely cannot be squeezed into the existing fields in the USPTO systems. Exacerbating this inadequacy in the USPTO systems is the USPTO's recent focus on demanding that applicants reveal “where they sleep at night”, that is, demanding that the applicant

provide not merely a postal address but instead the applicant's "domicile address". (In other words part of this problem is of the USPTO's own making.) There are many countries around the world where a mailing address cannot be squeezed into these fields, and there are even more countries around the world where the "domicile address" requires more lines of text and more characters than a mere mailing address.

Further exacerbating this is USPTO's recently imposed requirement that US counsel be retained in cases where the applicant is located outside the US. In many cases the US counsel need to be able to insert not only the docket number of US counsel but also the docket number of the instructing counsel who are located outside of the US and who have entrusted the application to US counsel. In some other cases the US counsel need to be able to insert not only the docket number of US counsel but also the client's docket number. Invariably the total character count far exceeds the legacy 12-character limit.

Other branches of the USPTO provide reasonable numbers of fields and reasonable character counts. Other trademark offices likewise provide reasonable numbers of fields and reasonable character counts.

Docket number field. In USPTO's Palm system (and thus in EFS-Web and in Patentcenter) the filer is permitted to insert as many as 25 characters in the docket number field. WIPO's ePCT system likewise permits 25 characters.

By comparison the USPTO trademark office systems limit the character count to a mere 12 characters.

Address fields. As a second example in USPTO's Palm system (and thus in EFS-Web and in Patentcenter) each of the address line fields permits fifty (50) characters. In contrast USPTO's trademark systems support only 40 characters per line. Palm permits forty characters in the "city" field while the in USPTO trademark systems only 22 characters are permitted. WIPO's Madrid system permits an applicant to have as many as three lines of mailing address. USPTO's trademark systems support only two lines. This leads to bad truncation problems when a Madrid application designates the US. It is commonplace for a line of the mailing address to get lost in such a designation, and it is commonplace for a mailing address to be rendered useless due to truncation.

As mentioned above, USPTO's recent insistence that non-US applicants provide their domicile addresses is impossible to comply with given the small number of address fields and the small character count in each address field.

In the decades that have passed since USPTO first selected these small field counts and small character counts, the cost of computer data storage has plummeted. Storage cost is no longer a legitimate reason to place such small caps on the field count and on the character count.

Another reason why USPTO might have tended long ago to choose small field counts and small character counts is that in legacy times, every character in a trademark application had to be hand-keyed by USPTO personnel, imposing time and money costs to the USPTO. In 2021, however, the USPTO need not carry out such hand-keying, because applicants are required to file electronically, meaning that if the amount of keying to carry out is large, that burden (to the extent that it is a burden) falls only on the filer and not on the USPTO. The information provided by the filer is in computer-readable form and it auto-loads into USPTO's systems.

We ask that the address and docket number fields in the USPTO trademark systems be resized as follows:

- at least three street address fields
- each street address field accommodating at least fifty characters
- a free-text field for non-US provinces and regions
- a city field accommodating at least 30 characters
- a docket number field of at least 25 characters.

In addition we ask that all fields be provided and sized to receive the entirety of the address and docket number information provided by WIPO in the communication of US designations from international trademark applications, if that exceeds the resizing character and line counts just mentioned. We appreciate that this may require more fields and bigger character counts than itemized in the previous five bullet points.

We thank you for your attention to this request and we look forward to favorable action by the USPTO.

Signed,

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