

From: [Brad Heisler](#)
To: [TM FR Notices](#)
Subject: Comment on Proposed USPTO Trademark Fee Increases
Date: Monday, September 30, 2019 8:35:03 PM

Dear Director Iancu and Members of the Trademark Public Advisory Committee (TPAC):

Thank you for clearly setting out the proposed new trademark fees and for your clear focus on the goals of maintaining the integrity of the Register, aligning fees with the associated administrative burdens, and addressing recent changes in filing behavior. I believe the fee increases largely conform to these goals.

In one instance, I do not think the proposed fee increases meet the stated goals very well, and so am taking this opportunity to comment. In particular, it is proposed that the fee to file a Petition to Cancel with the TTAB be raised from \$400 to \$600. In my trademark practice, I often assist clients in filing new trademark applications and registration is refused under Trademark act Section 2(d) based on a prior mark which does not appear to be in use any longer. While it may be possible in some cases to wait to see if a Section 8 or 9 filing is made, or to contact the owner of the cited mark to inquire as to an express abandonment, it is often much more desirable to file a Petition to Cancel the mark. In a large percentage of such cases where this is done, a default judgment results.

Such "likely to default" Petitions to Cancel serve the goal of maintaining/enhancing the integrity of the register, by more quickly removing abandoned registrations than the Section 8/9 system. Also, such Petitions to Cancel are highly likely to present a low burden upon the TTAB, because the instituted case is dismissed within a few months and without involving members of the Board, but rather only administrative personnel at the TTAB.

Certainly when a Petition to Cancel matures into a fully contested inter parties case, the Petition to Cancel fee is likely currently too low. However, it seems to me both unfair and defeating the goals of the fee increase to burden all Petitions to Cancel with this fee increase. As the Trademark Office is proposing a variety of new fees in this round of fee adjustments, I would recommend a new fee to be paid upon filing of the Brief near the end of a contested Petition to Cancel. This fee would be larger to reflect the burden that such a contested case places upon the members of the Board (similar to how an Inter Partes Review (IPR) has a large fee (and a second large fee when a case is "instituted") in patent cases at the PTAB). The Petition to Cancel fee could be kept the same (or even reduced somewhat) so that trademark applicants would be more likely to use such "likely to default" Petitions to Cancel as a method to maintain/enhance the integrity of the Register, by more quickly and efficiently removing abandoned registrations.

As an alternative to a second fee due upon filing the Brief, a second fee could be due by the Petitioner in a Petition to Cancel, after the Answer is filed and before the discovery conference. Such an early second fee due by the Petitioner would be an early opportunity for the Petitioner to drop a contested case if the Petitioner is not "serious enough" about the Petition to pay the second fee. I have had one case where after we answered the Petition to Cancel the Petitioner became highly disinterested in prosecuting the case vigorously. Such cases can hang around and burden everyone unnecessarily, until a voluntary dismissal is filed. An early second fee due by a Petitioner would ensure that an adequate fee is raised to match the burdens faced by the TTAB and support the filing of very useful "likely to default"

Petitions to Cancel at a still reasonably small filing fee.

Thanks for your consideration.

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