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DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 2

[Docket No. PTO–T–2017–0004]

RIN 0651–AD15

Changes to the Trademark Rules of Practice to Mandate Electronic Filing; Correction

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Final rule; correction.

SUMMARY: The United States Patent and Trademark Office published in the Federal Register on July 31, 2019 (delayed on October 2, 2019), a final rule amending its regulations to mandate electronic filing of trademark applications and all submissions associated with trademark applications and registrations, and to require the designation of an email address for receiving USPTO correspondence, with limited exceptions. This rulemaking clarifies the mandatory electronic filing regulation addressing the requirements for receiving a filing date, by amending it to remove the word “domicile.” This rulemaking also clarifies the mandatory electronic filing regulation addressing the requirements for a TEAS Plus application.

DATES: This correction is effective on December 21, 2019.

FOR FURTHER INFORMATION CONTACT: Catherine Cain, Office of the Deputy Commissioner for Trademark Examination Policy, TMFRNotices@uspto.gov, (571) 272–8946.

SUPPLEMENTARY INFORMATION: On July 31, 2019 (84 FR 37081), the United States Patent and Trademark Office (USPTO) published in the Federal Register a final rule amending the Rules of Practice in Trademark Cases and the Rules of Practice in Filings Pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks to mandate electronic filing of trademark applications based on section 1 and/or section 44 of the Trademark Act (Act), 15 U.S.C. 1051, 1126, and all submissions associated with trademark applications and registrations, and to require the designation of an email address for receiving USPTO correspondence, with limited exceptions (Mandatory Electronic Filing Rule). The effective date of the July 31, 2019, rule was delayed until December 21, 2019 (84 FR 52363, October 2, 2019). In § 2.21, the Mandatory Electronic Filing Rule addressing the requirements for receiving a filing date were amended to require the “domicile address” of each applicant. Prior to the July 31, 2019, Mandatory Electronic Filing Rule, the regulations at § 2.21(a) required “[t]he name of the applicant” and “[a] name and address for correspondence.” 37 CFR 2.21(a)(1), (2). In the May 30, 2018 notice of proposed rulemaking, the USPTO proposed to amend § 2.21(a)(1) to require “[t]he name, postal address, and email address of each applicant” to receive a filing date and made a conforming amendment to § 2.32(a)(2) to require the same information for a complete application. In the July 31, 2019, final rule, the USPTO replaced the word “postal” with “domicile” in amended § 2.21(a)(1) and amended § 2.32(a)(2) to reconcile the final rule with the provisions of another final rule entitled “Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants” (84 FR 31498, July 2, 2019) (U.S. Counsel rule) that required provision of domicile addresses. The USPTO has determined that substituting the wording “domicile address” for “postal address” in the July 31, 2019, final rule might result in the unintended consequence of the loss of a filing date for some applicants who

provide an address that is later determined not to be their domicile address. Therefore, the USPTO has determined that the better practice is to retain the existing requirement for an “address” as a filing-date requirement. The requirement for a “domicile address” remains a requirement for a complete application in amended § 2.32(a)(2). Thus, this rulemaking amends § 2.21(a)(1) in the July 31, 2019, final rule to remove the word “domicile.”

In addition, in light of the amendment made to § 2.21(a)(1), the USPTO makes a conforming change to § 2.22(a)(1) in the July 31, 2019, final rule to reinsert the requirement for a domicile address. In the U.S. Counsel rule, the USPTO added the requirement for the applicant’s domicile address to the regulation addressing the requirements for a TEAS Plus application. 37 CFR 2.22(a)(1). Subsequently, in the July 31, 2019, Mandatory Electronic Filing Rule, the USPTO removed this requirement from § 2.22(a)(1) as duplicative because the domicile requirement added to § 2.21(a)(1) also applied to TEAS Plus applications. The amendment made to § 2.21(a)(1) in this rulemaking removes the requirement for a domicile address from § 2.21(a)(1), as discussed above, and requires the USPTO to reinsert it back in § 2.22(a)(1) so that it will continue to apply to TEAS Plus applications as a requirement for receiving a reduced filing fee.

Rulemaking Requirements

Administrative Procedure Act: The changes in this rulemaking involve rules of agency practice and procedure, and/or interpretive rules. *See Perez v. Mortg. Bankers Ass’n*, 135 S. Ct. 1199, 1204 (2015) (Interpretive rules “advise the public of the agency’s construction of the statutes and rules which it administers.” (citation and internal quotation marks omitted)); *Nat’l Org. of Veterans’ Advocates v. Sec’y of Veterans Affairs*, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (Rule that clarifies interpretation of a statute is interpretive.); *Bachow Commc’ns Inc. v. FCC*, 237 F.3d 683, 690

(D.C. Cir. 2001) (Rules governing an application process are procedural under the Administrative Procedure Act.); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (Rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims.).

Accordingly, prior notice and opportunity for public comment for the changes in this rulemaking are not required pursuant to 5 U.S.C. 553(b) or (c), or any other law. *See Perez*, 135 S. Ct. at 1206 (Notice-and-comment procedures are required neither when an agency “issue[s] an initial interpretive rule” nor “when it amends or repeals that interpretive rule.”); *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice” (quoting 5 U.S.C. 553(b)(A))).

In addition, good cause exists under 5 U.S.C. 553(b)(B) and (d)(3) to issue this rule without prior notice and opportunity for comment and the 30-day delay in effectiveness, as it would be impracticable and contrary to the public interest. This action amends § 2.21(a)(1) to avoid a possible unintended consequence (i.e., possible loss of a filing date for some applicants who provide an address that is later determined not to be their domicile address) that might result from substituting the wording “domicile address” for “postal address” in the July 31, 2019 final rule. Therefore, the USPTO has determined that the better practice is to retain the existing requirement for an “address” as a filing-date requirement. The requirement for a “domicile address” remains a requirement for a complete application in amended § 2.32(a)(2). Delay of this correction to allow for prior notice and opportunity for comment would result in the implementation of a requirement that may result in a loss of a filing date for some applicants as

well as confusion among applicants regarding the requirements for a filing date. In addition, because the July 31, 2019 final rule is not effective until December 21, 2019, no party has been negatively impacted or affected by this rulemaking, which is being published prior to that effective date. Therefore, the USPTO waives the requirement for prior notice and opportunity for comment, and implements this correction on the effective date of this rule.

Corrections

In FR Doc. 2019–16259 appearing on page 37081 in the *Federal Register* of Wednesday, July 31, 2019, delayed at 84 FR 52363, October 2, 2019, the following corrections are made:

§ 2.21 [Corrected]

1. On page 37093, in the third column, in §2.21, in paragraph (a)(1), “The name, domicile address, and email address of each applicant;” is corrected to read “The name, address, and email address of each applicant;”
2. On page 37094, in the first and second columns, in §2.22, paragraphs (a)(1) through (19) are redesignated as paragraphs (a)(2) through (20) and new paragraph (a)(1) is added to read as follows:

§ 2.22 Requirements for a TEAS Plus application.

(a) * * *

(1) The applicant’s name and domicile address;

* * * * *

Dated: December 9, 2019

Andrei Iancu,

Under Secretary of Commerce for Intellectual Property and

Director of the United States Patent and Trademark Office

[FR Doc. 2019-26899 Filed: 12/12/2019 8:45 am; Publication Date: 12/13/2019]