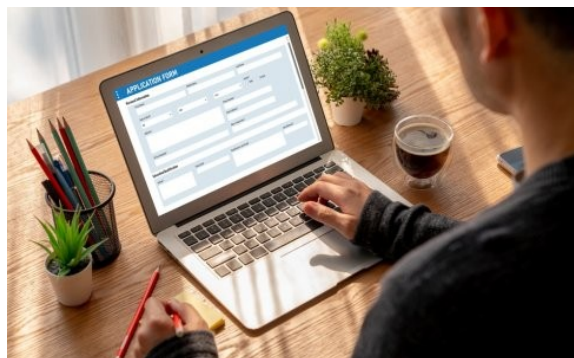


Navigating the USPTO's New Trademark Fees

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It's finally here. After months of warnings, announcements, and uneasiness about their application, the U.S. Patent and Trademark Office implemented a number of trademark-related fee changes in January 2025. These fee changes, though, are more than just fee increases. Many of the new fee changes will require new filing practices and strategies to keep Trademark Office fees to a minimum, especially for filings by foreign applicants.

Make Sure Your Application Has All Required Information

In the past, it was possible to file an application without all of the required information. For example, an application could be filed without a signature and the signature submitted later. While this is still possible, applications filed without the required information will now be subject to an "insufficient information fee" of \$100 per class.

In some instances, these fees will be incurred at the time of filing (the electronic filing form is supposed to indicate what omissions will incur this fee), and in some instances, they will be incurred during the examination. For example, if an application is for the name of a living individual and is filed without written consent, or if the application is for a mark that is a foreign word and is filed without a translation, the application will incur an insufficient information fee during prosecution.

Further, the insufficient information fee will be charged to new classes that are added to an application during prosecution if the application was filed with insufficient information.

The Trademark Office does permit pre-examination amendments. The Trademark Office has advised, however, that using a pre-examination amendment to supplement an application with information omitted from the application at filing will wind up incurring the insufficient information fee during prosecution, eliminating a tool that was often used when an application needed to be filed in a hurry.

These changes will put a premium on evaluating an application before it is filed to make sure that some effort is made to address all necessary requirements (e.g., a description of the mark, a transliteration, a color claim, applicant's name, address, and domicile; etc.)

Use the ID Manual

Applications with listings of goods and services taken from the Trademark Office's ID Manual (available here: <https://idm-tmng.uspto.gov/id-master-list-public.html>) are now charged a lower filing fee (\$350) than those with listings not taken from the ID Manual (\$550). Thus, using the ID Manual where possible is beneficial. In order to be entitled to the lower fee, each item in the listing for a particular class must be taken from the ID Manual. If one item in the listing is not from the ID Manual, then the higher fee will be charged.

Further, the Trademark Office has explained that if any text is entered in what it calls the “free-form text” box in an application, the higher fee will be charged, even if some or all of the listings are taken from the ID Manual.

Using descriptions from the ID Manual is not necessarily a guarantee that an applicant will be able to avoid the higher filing fee. Some descriptions in the ID Manual require applicants to fill in certain information. Guidance from the Trademark Office indicates that if a good faith attempt to fill in that information is made, the applicant will not be charged the additional fee during examination (use of a description such as “Printed educational materials in the field of specify subject matter” would not be considered a good faith attempt). In those situations, it will be up to the examining attorneys to determine if a good-faith attempt has been made. That will be a subjective determination, and it seems fair to expect the Trademark Office to take its familiar position that one examining attorney is not bound by the acts of another when determining what constitutes good faith.

The Trademark Office has also indicated that if a party uses, in good faith, descriptions from the ID Manual and then is required to amend those descriptions, the additional fee will not be charged. Moreover, if an applicant files an application with a description from the ID Manual and then amends to a specification that is not in the ID Manual, the application will not incur the additional charge.

One issue with the ID Manual is that it does not list every good or service (this can be a particular issue with new products, technology, etc.). One option for resolving this issue is to ask that a particular description be added to the ID Manual. This can be done by sending an email to tmidsuggest@uspto.gov with the following information:

- the name of the party submitting the proposed identification;
- an email address for correspondence relating to the proposed identification; and
- the proposed identification, which should be concise and no more than 25 words. Depending on how long it takes the Trademark Office to add descriptions to the ID Manual, that may not be a practical option (the Trademark Office’s website suggests that reviews will take 1 to 2 business days, and that accepted updates will be made in the next weekly update, but whether that time frame is accurate remains to be seen).

Trademark Office guidance indicates that the insufficient information fee will not apply to issues with descriptions of goods or services.

Keep Specifications Short

One goal of the Trademark Office is to cut down on lengthy descriptions of goods and services. Thus, the Trademark Office has implemented a new fee of \$200 per class where a specification entered as free-form text is in excess of 1,000 characters (the fee does not apply to specifications derived entirely from the ID Manual). The fee applies for each group of characters over 1,000, so a specification over 1,000 characters would incur a fee of \$200 and a specification over 2,000 characters would incur a fee of \$400.

According to the Trademark Office, this fee will only be applied at the time an application is filed and will not be assessed during examination.

Consider Filing Multiple Applications Instead of Multiclass Applications

While a multiclass application may seem like it would be less expensive, under the Trademark Office’s new rules, it could actually be more expensive. For example, any insufficient information fees will be assessed against each class in an application.

Further, if an application has two classes, and the description of goods or services for one is taken from the ID Manual and the other is entered as free-form text, both classes will be charged the additional fee due to the use of the free-form text feature.

Additionally, if an application is filed using the free-form text option and a new class is added during examination, the fee for that class will be the higher fee, even if the description of the goods or services in that class is taken from the ID Manual. While

it can be difficult to predict whether additional classes will have to be added during prosecution, filing a single class application rather than a multiclass application can reduce the likelihood that the higher fee will be incurred.

File Through the Madrid Protocol, If You Can

Applications filed through the Madrid Protocol are not subject to the new fees discussed above, making that an attractive means of filing in the United States. Use of the Madrid Protocol already had benefits not afforded to direct filings in the U.S.; applicants who file through the Madrid Protocol have six months in which to respond to any Office Actions that may be issued, rather than the three-month response period for applicants who file directly in the U.S., and this will continue to be the case.

Applications filed directly in the U.S. will be subject to the Trademark Office's new fees, even if those applications are filed based on foreign applications or registrations or claim priority to a foreign application or registration. Anyone considering filing directly in the U.S. based on a foreign application or registration would be well served to match the goods or services description in their home filing to those in the Trademark Office's ID Manual, if possible, in order to avoid additional fees. If the application is based on a foreign application or registration that has already been filed, consider paring down lengthy specifications to avoid surcharges.

A Note on Pending Applications

Applications filed before January 18, 2025, will not be subject to any of the new fees if filed as TEAS Standard applications. Applications filed before January 18 as TEAS Plus applications (at the lower filing fee) may incur the insufficient information fee, if appropriate.

Conclusion

The Trademark Office's fee changes have ushered in a brave new world of trademark practice in the United States. Only time will tell if these changes will accomplish the Trademark Office's goals. At this point there are some means of avoiding the imposition of the Trademark Office's new fees (particularly with some planning), and it is likely that the new fees will cause filers from outside of the U.S. to increase their use of the Madrid Protocol. In the end, though, the new fees and procedures reinforce the importance of working with skilled counsel to secure registration of a mark in as efficient a manner as possible.