

Operational News and Updates

Mary Boney Denison
Commissioner for Trademarks

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Continuing Resolution

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Organization and Statistics

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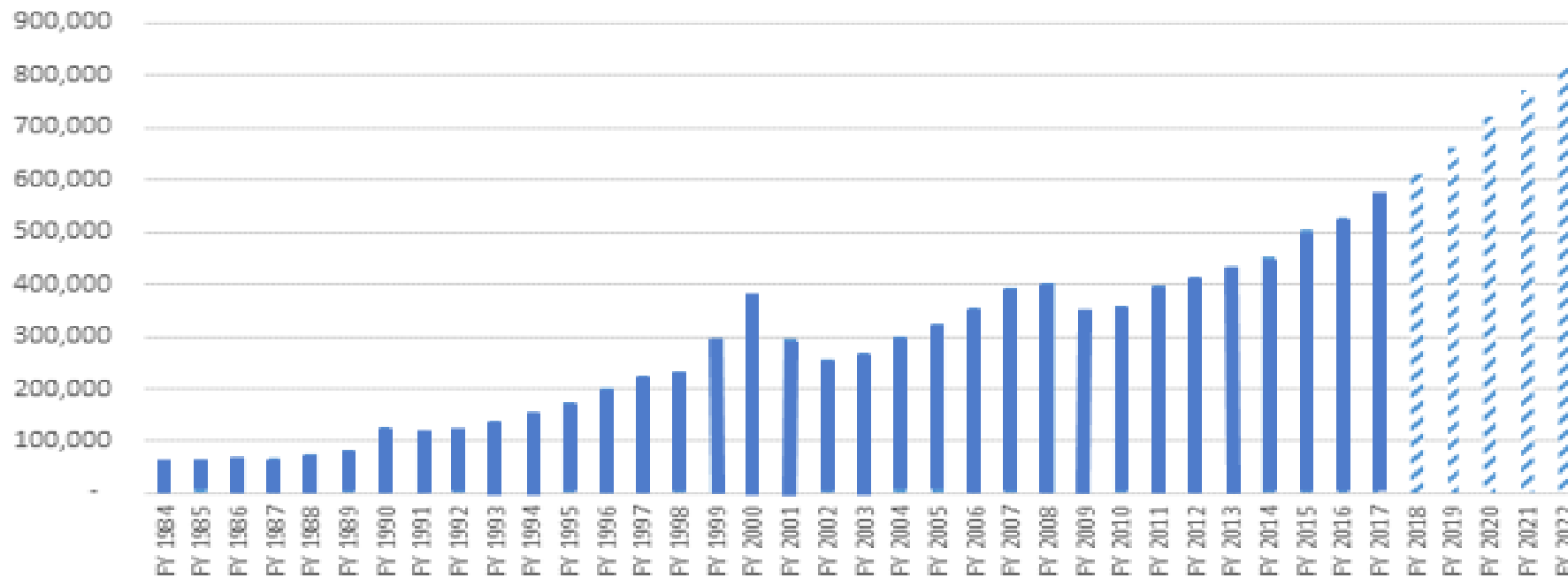
Trademark Organization Staffing

- 854 Trademark employees (7% of USPTO)
- 561 examining attorneys (66% of Trademarks)
- 77% of examining attorneys telework full time
- Hiring ~60 new examining attorneys this fiscal year

New Application Filings

- FY16: 530,270 classes filed FY17: 594,107 classes filed
- FY18 up 17.2% compared to FY17. Expecting 646,000 classes this year

Applications for Registration - Classes



Trademark Performance: Pendency

<i>FY 2018 Trademark Performance Measures</i>	FY 2018 Targets	FY 2018 January Results
First Action Pendency First action pendency from date of filing to first office action in months.	2.5 – 3.5	3.0
Disposal Pendency Disposal pendency from date of filing to issuance of a notice of allowance, registration, or abandonment – excluding suspended and inter partes proceedings.	12.0	9.3

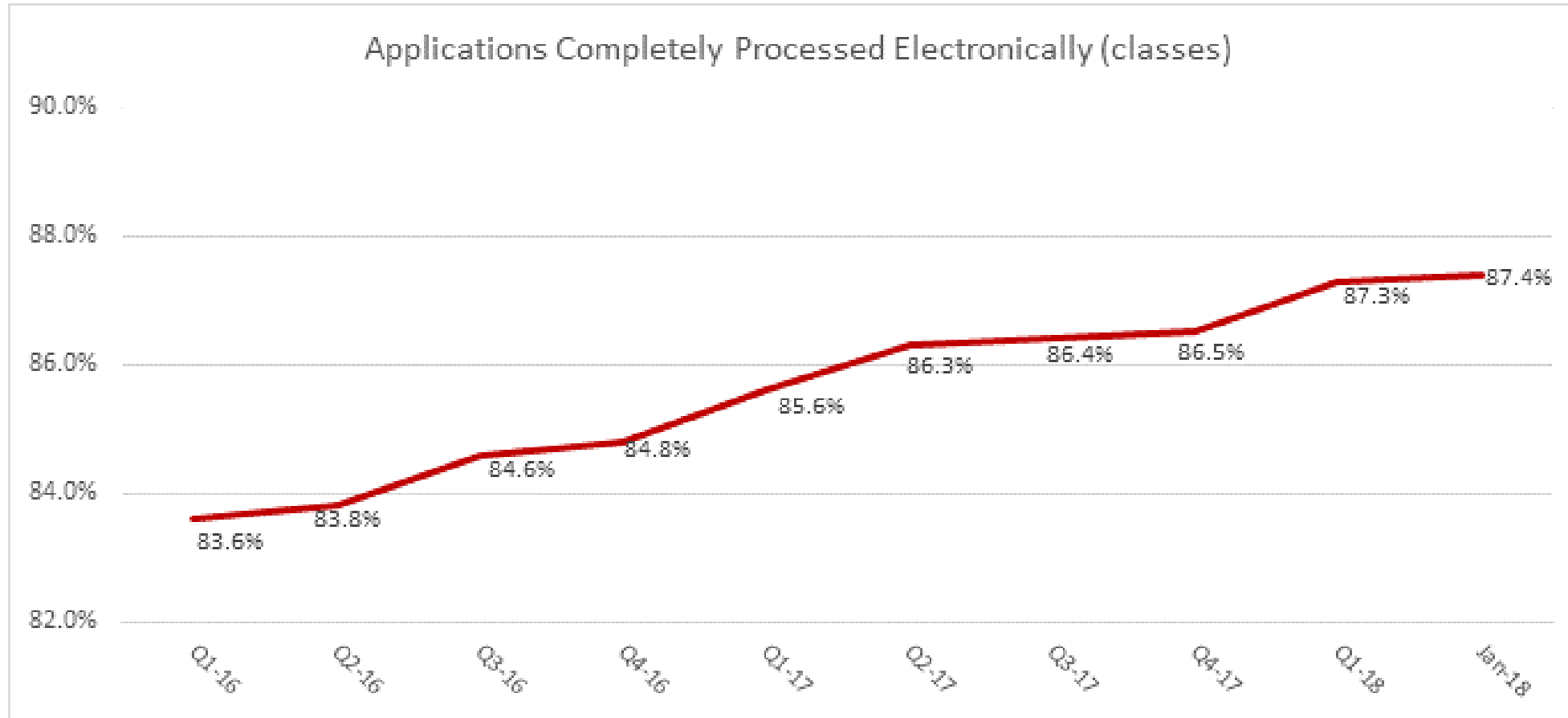
Trademark Performance: Quality

<i>FY 2018</i> <i>Trademark Performance Measures</i>	FY 2018 Targets	FY 2018 January Results
First Action Compliance In-process review evaluation of the statutory bases for which the Office raises issues and or refuses marks for registration based on the first office action.	95.5%	97.3%
Final Action Compliance In-process review evaluation of the statutory bases for which the Office raises issues and or refuses marks for registration based on the examiner's approval or denial of the application.	97.0%	97.5%
Exceptional Office Action Measure indicating the comprehensive quality of the first Office action search, evidence, writing and decision making.	45.0%	45.0%

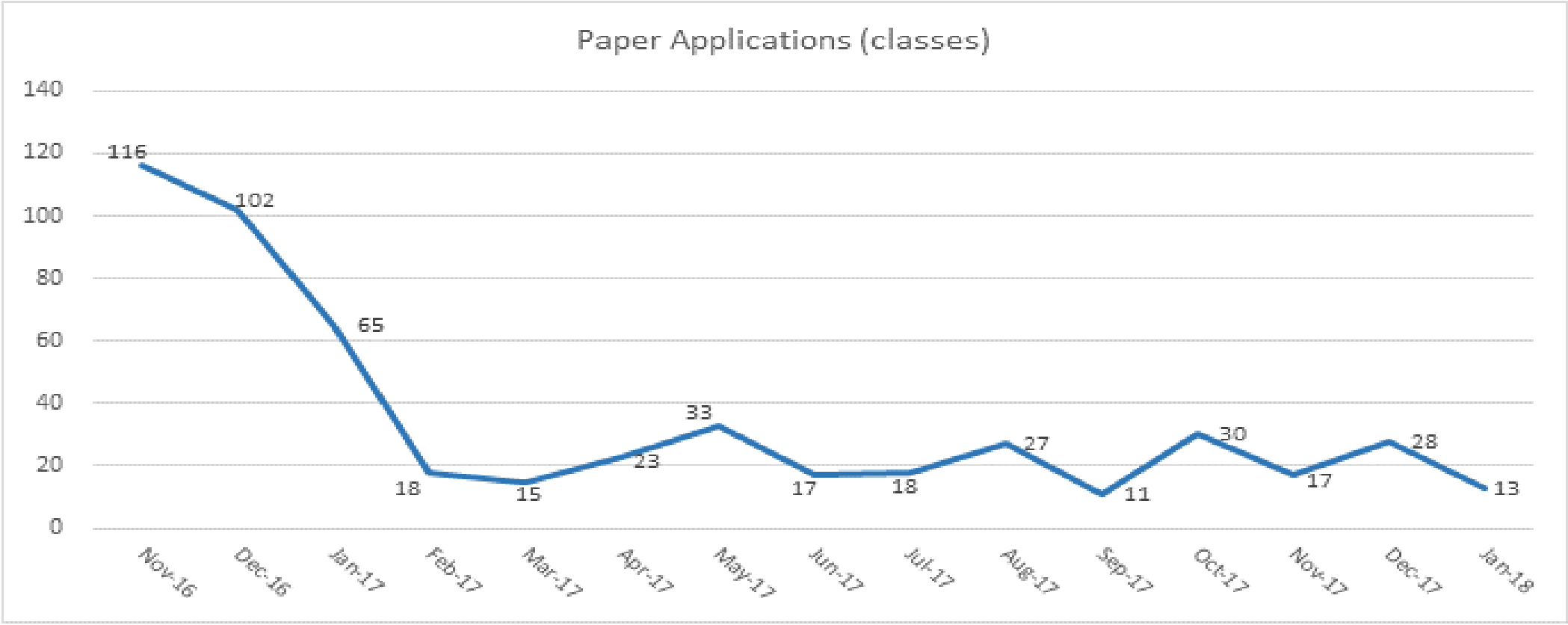
E-Government Statistic

- Original goal was to have all applications submitted electronically;
Currently at the 99.9% range
- Goal shifted from application to two-way electronic communication throughout the entire registration process
- Continue to encourage end-to-end electronic processing by users
- **Planning for mandatory electronic filing by fall of 2018**

E-Government



Fee Change Effect on Paper Applications



Trademark IT News

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MyUSPTO

- **Trademark Docket**

- Stores and monitors up to 1,000 applications and registrations
- Sends e-mail notification of status changes

- **Trademark OG Watch**

- Stores searches
- Sends email notification when there are new hits on saved TMOG searches

- **EZ File**

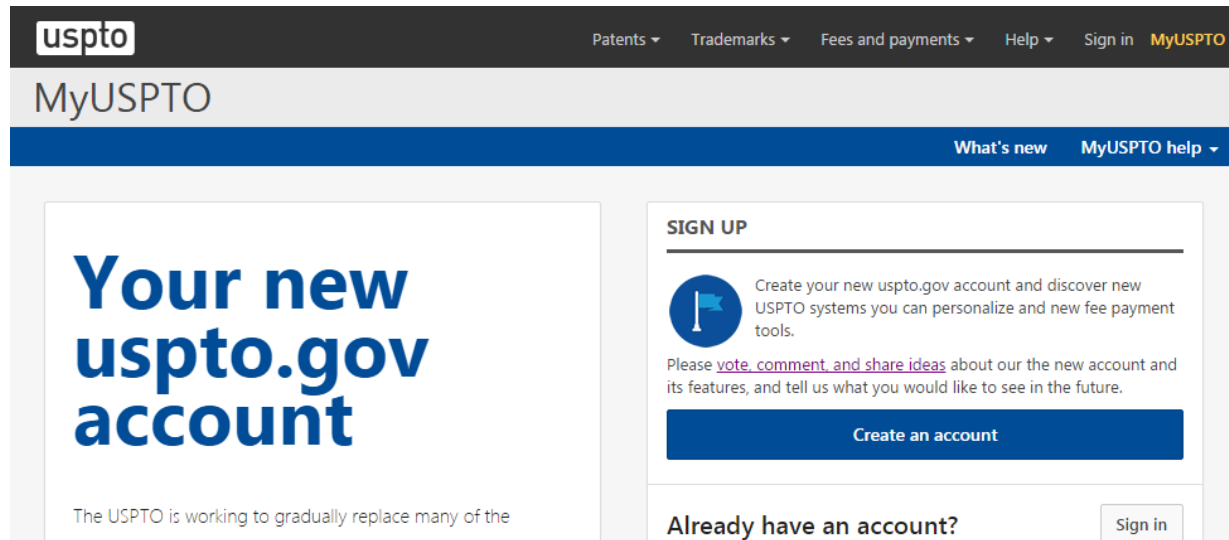
- Working on a simple application for ITU word marks using TEAS RF.

- **Form Finder**

MyUSPTO Usage

- As of 2/1/18, there were **72,413** external (public) users who had registered for MyUSPTO accounts
- As of 2/2/18, there were **3766** public users using the TM Docket actively. This has been growing steadily at a rate of 50-60 per week.
- Of the 3766 users, **2047 (54%)** are subscribed to the status change email alerts.
- There were **779** users using the TMOG widget.

The uspto.gov user account



- Users **register once** to set up a profile and establish the account credentials (login/password)
- Users can then **sign-in** using the credentials, and access all USPTO systems that have adopted the uspto.gov user accounts
 - MyUSPTO, Financial Manager, Patent Maintenance Fee storefront have already adopted the uspto.gov user accounts
 - Many more USPTO systems are moving to **adopt** the uspto.gov user accounts. Stay tuned!

<https://account.uspto.gov>

Please provide your feedback online

The screenshot shows the MyUSPTO website interface. At the top, there is a navigation bar with the 'uspto' logo on the left and links for 'Patents', 'Trademarks', 'Fees and payments', 'Help', 'Ramesh Pai', and 'MyUSPTO' on the right. Below this is a header area with 'MyUSPTO BETA' on the left and 'What's new' and 'MyUSPTO help' on the right. A blue bar contains a '+' icon and a dropdown menu with 'Feedback' (highlighted in yellow and circled in blue), 'FAQs', and 'Tutorial'. The main content area is divided into three panels: 'USPTO FEES BETA' with sub-sections for Patent, PCT, Trademark, and General; 'TRADEMARK APPLICATION DOCKET ALPHA' with a 'Create a new collection' button; and 'TRADEMARK POST-REGISTRATION DOCKET ALPHA' with a 'Create a new collection' button.

Trademark App Open Source Code on Github

- Source code for a mobile application for trademarks
- Receive a push notification anytime the status of a trademark application changes
- Try it and let us know what you think
- See: <https://github.com/USPTO/TrademarkStatusApp>



Trademark Rules of Practice

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ID Manual Update

- On January 1, 2018 the eleventh edition of the Nice Classification, version 2018 (Nice 11-2018 or NCL 11-2018) went into effect. The USPTO ID Manual reflects those changes.
- Document highlighting the changes published on recent postings page at: <https://www.uspto.gov/trademark/trademark-updates-and-announcements/recent-postings>
- Training for the examination corps occurred on January 23, 2018
- Note that you can download the entire manual

Screenshot of ID Manual



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Trademark ID Manual

[Download Entire Manual](#)

A large blue arrow points downwards from the top right of the search bar area towards the 'Download Entire Manual' link.



ID Master List

Mandatory E-filing

- Plan to make use of TEAS mandatory for all trademark filings
- Notice of proposed rulemaking planned for early 2018
- Implementation likely late 2018

Regulatory Reform

- USPTO Working Group on Regulatory Reform
- See: <https://www.uspto.gov/about-us/working-group-regulatory-reform.html>
- Suggestions to improve, revise, and streamline USPTO regulations: RegulatoryReformGroup@uspto.gov
- Proposed removal of interferences-hasn't been used in over 40 years; NPRM published on October 18, comment period closed on November 17.

Section 2(a)

- *Brunetti* Decision Issued on December 15, 2017 holding the immoral or scandalous provision of Section 2(a) unconstitutional. The U.S. Court of Appeals for the Federal Circuit ruled that “Fuct”, while vulgar, was protected speech under the First Amendment. Awaiting guidance from the Office of the Solicitor. Decision regarding possible rehearing *en banc* is pending.

Initiatives

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Decluttering of Federal Register

Suggested Methods of Improvement from Post-Registration Pilot Program

- **Increase Readability of Declaration**
- **Continue Random Audits of Registrations**
- **Expedited Cancellation Procedures**

Random Audits

- USPTO will require submission of information, exhibits, affidavits or declarations, and such additional specimens to ensure that register accurately reflects marks are in use in United States for all goods/services identified in registrations in random pull of cases
- Final rule published Federal Register on January 19, 2017. Effective date March 21, 2017
- Launched November 1!
- As of January 20, 2018: 825 First Actions have been sent.

Expedited Cancellation Proceedings

- Responsive to stakeholder requests for faster, less expensive option to clear deadwood
- May establish a streamlined version of cancellation proceeding for grounds of abandonment and, for § 1 registrations, no use as of relevant date
- Could be implemented by rule changes; no need for legislation
- Existing legal standards for abandonment and nonuse would apply

Fraudulent Solicitations

Raising awareness of schemes to defraud trademark owners:

- Providing general warning in “Trademarks” section of the USPTO website with a **dedicated web page and video** warning people about non-USPTO solicitations. The “Patents” section of the USPTO website has **a similar warning**, which cross-links to the Trademarks section warning page
- Warning individual applicants and registrants at key stages of the trademark prosecution process: (1) in trademark application filing receipt (2) cover email for trademark office actions and (3) with each paper trademark registration on bright orange sheet of paper
- Cooperating with DOJ on criminal prosecutions
- Participating in an informal interagency working group on combatting fraudulent solicitations
- Hosted a roundtable with TPAC on July 26 with numerous bar groups and other government agencies (FTC, DOJ, USPIIS, SBA, CBP)

Initiatives to Improve Customer Experience

- We have a **five-year customer experience strategic plan** to ensure we provide consistent, clear, and intuitive services to our customers.
- FY 2018 focus areas include:
 - Implement **four customer touchpoint surveys** to collect feedback persistently. This will help inform our strategic decisions. The customer touchpoint surveys will cover the following topics:
 - Trademark Assistance Center
 - TEAS
 - Website content
 - Application prosecution
 - **Dramatically improve our website** so customers can find, understand, and use the information they need. This includes information on trademark searching, online filing, and trademark basics.
- [My.uspto.gov](https://my.uspto.gov): Email alerts for certain changes to prosecution history (April)

Vision: To be a global leader in customer experience by providing consistent, clear, and intuitive services to trademark customers.

Mission	Goals	Objectives
Enhance customer experience to benefit customers and employees.	Bring customers to the center of all we do. (Culture change)	<ul style="list-style-type: none"> Evaluate and expand CX incentives for employees Share the voice of our customers across the business unit Harness employee experience and ideas to improve CX Integrate CX components into all employee learning and development Enable employees to co-create with our customers
	Make every customer touchpoint consistent, clear, and intuitive. (Effective customer communication)	<ul style="list-style-type: none"> Manage customer expectations w/ educational materials and process information Enable desired customer behavior with information that is easy to find, understand, and use Simplify navigating and using forms/systems during filing and prosecution Enable enhanced communication and collaboration during prosecution
	Work together to amplify impact on customer experience efforts. (Teamwork)	<ul style="list-style-type: none"> Build a CX infrastructure Create "one voice" for all customer content Enable cross-functional employee teams to address challenges Understand the end-to-end customer experience to make it seamless
	Measure and track customer metrics, engagement, and insights. (Data and tools)	<ul style="list-style-type: none"> Standardize data capture across customer touchpoints Solicit and act on customer sentiment data Use metrics to drive decision making at all levels (from program to executive)
	Partner to provide services outside core capabilities. (Strategic partnerships)	<ul style="list-style-type: none"> Leverage outside partnerships to amplify education and outreach impact Partner to address novice customers' needs for legal resources, including pro bono and reduced-fee opportunities. Leverage partnerships to provide services when internal resources are constrained

International

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TM5

- Comprised of the 5 largest trademark offices:
 - European Union Intellectual Property Office (EUIPO),
 - Japan Patent Office (JPO),
 - Korean Intellectual Property Office (KIPO),
 - Trademark Office of the State Administration for Industry and Commerce of the People's Republic of China (SAIC), and
 - United States Patent and Trademark Office (USPTO)
- Focuses on exchange of information and collaboration and harmonization projects regarding trademark matters to benefit users
- Projects include, among others:
 - Minimizing Bad Faith Filings
 - Common Status Descriptors
 - ID List
 - Indexing of Non-Traditional Marks
 - Image Searching

TM5 Calendar 2018

- **TM5 Joint Workshop** on Examination of Non-Traditional Marks, including Proving Acquired Distinctiveness, at the INTA Annual Meeting in Seattle on **Monday, May 21 at 1:15pm**
 - The TM5 Partners will discuss examination issues surrounding non-traditional marks and proving acquired distinctiveness
- **TM5 Midterm User Session** at INTA Annual Meeting in Seattle on **Sunday, May 20 at 9:00am**
- 2018 TM5 Midterm Meeting in South Korea in June (user session at INTA Annual Meeting)
- 2018 **TM5 Annual Meeting** in South Korea (likely Seoul), **November 1-2**

2017 TM5 Annual Meeting

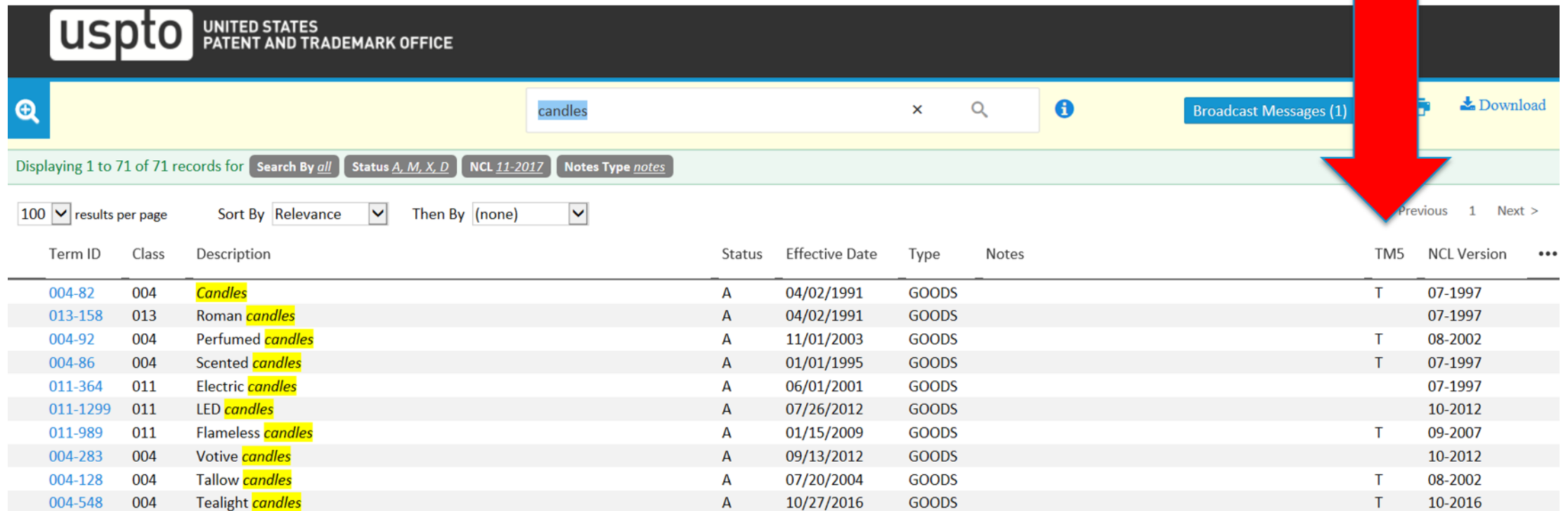
- At the 2018 TM5 Annual Meeting in Alicante on November 30, the Partners agreed to 3 new projects:
 - Fraudulent Solicitations/Misleading Invoices (co-led by USPTO and EUIPO)
 - Quality Management (co-led by JPO and EUIPO)
 - Priority Rights Documents (led by EUIPO)
- Agreed to invite Indonesia, Thailand, Cambodia, Vietnam, Australia, Singapore, New Zealand, Mexico, Norway, Switzerland, Israel, Jordan, Saudi Arabia to join the USPTO-led Common Status Descriptors Project
- Agreed to future revisions of the TM5 web site to keep it more current and more user friendly
- Agreed to new Bad Faith Report including cases from non-TM5 countries and with participation of INTA
- KIPO established as 2018 TM5 Secretariat
- Full day user session included summary of Annual Meeting, presentations on Quality Management and Bad Faith Trademark Filings, and table topic discussions on Fraudulent Solicitations, Bad Faith Filings and Quality Management

TM5 ID List



- TM5 ID List Search Tool posted on the TM5 website, <http://tmfive.org/>
- As of February 5, 2017, the TM5 ID List contained **18,208** pre-approved terms that are acceptable to all Partner Offices
- At the 2017 TM5 Annual Meeting, the Partners agreed to invite Argentina, Paraguay and Saudi Arabia to join the ID List

Example from ID Manual



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Search: candles

Displaying 1 to 71 of 71 records for Search By all Status A, M, X, D NCL 11-2017 Notes Type notes

100 results per page Sort By Relevance Then By (none)

Term ID	Class	Description	Status	Effective Date	Type	Notes	TM5	NCL Version	...
004-82	004	Candles	A	04/02/1991	GOODS		T	07-1997	
013-158	013	Roman candles	A	04/02/1991	GOODS			07-1997	
004-92	004	Perfumed candles	A	11/01/2003	GOODS		T	08-2002	
004-86	004	Scented candles	A	01/01/1995	GOODS		T	07-1997	
011-364	011	Electric candles	A	06/01/2001	GOODS			07-1997	
011-1299	011	LED candles	A	07/26/2012	GOODS			10-2012	
011-989	011	Flameless candles	A	01/15/2009	GOODS		T	09-2007	
004-283	004	Votive candles	A	09/13/2012	GOODS			10-2012	
004-128	004	Tallow candles	A	07/20/2004	GOODS		T	08-2002	
004-548	004	Tealight candles	A	10/27/2016	GOODS		T	10-2016	

Madrid Protocol

- Effective November 1, 2017, applicants may add a description of the mark to the international application, even if the description does not appear in the basic application or registration
- The description of the mark in the basic application or registration must also be submitted if required by the country of origin
- http://www.wipo.int/edocs/mdocs/govbody/en/mm_a_49/mm_a_49_3.pdf

China

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Focus on China

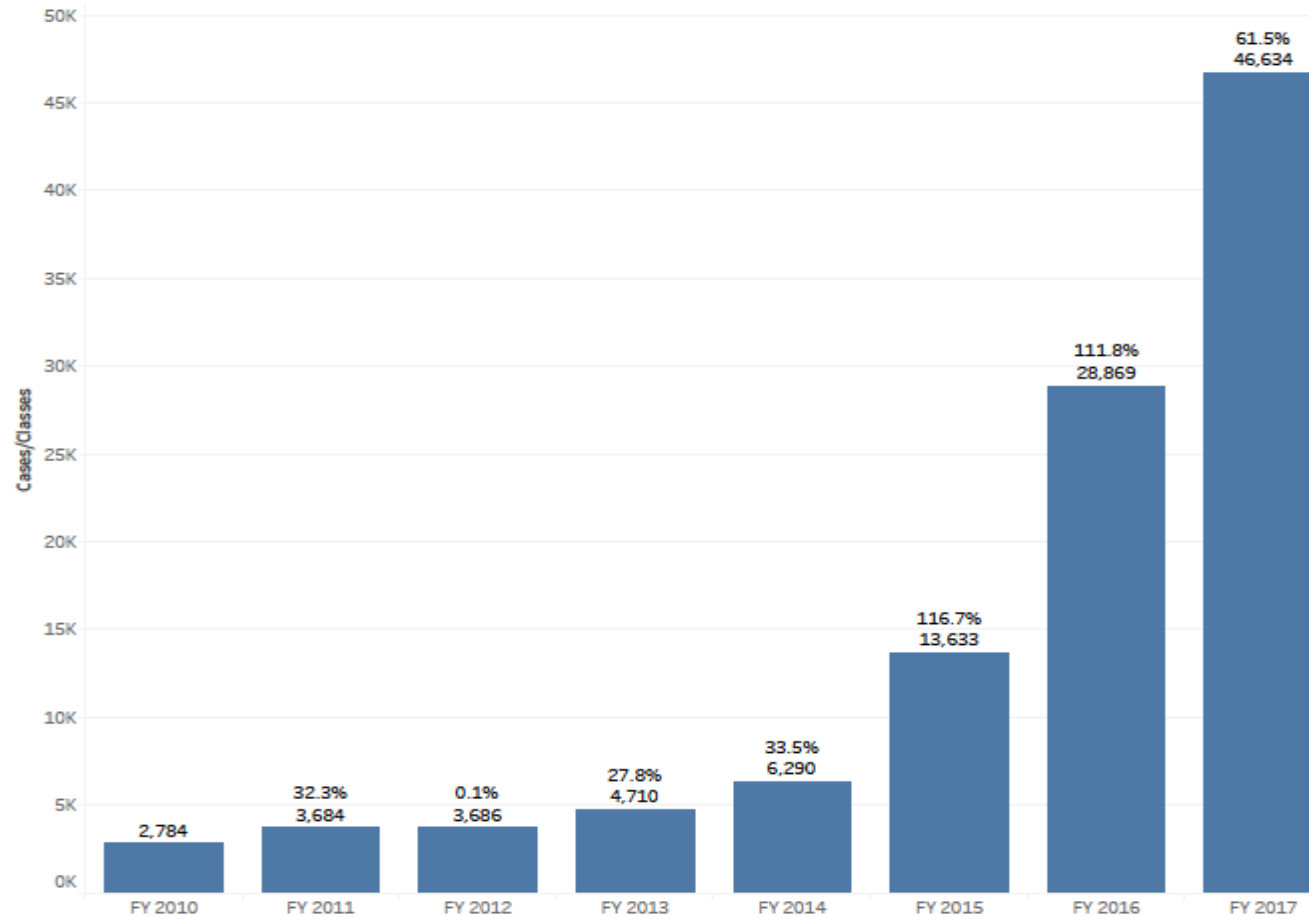
- Influx of Chinese Filings
- Specimen Issues
- Counterfeiting
- Bad Faith Filings



Influx of Chinese Filings

- Recent trends showing a great increase in filings from China.
- Possibility that local governments within China are encouraging filings in the U.S.
- Concern over the legitimacy of these applications and subsequent registrations

Chart showing Influx of Chinese Filings



Specimen Issues

- Mocked-up or fake specimens are increasing
- Much more sophisticated as well
- Applicants pasting their marks on products or services of others to show use in commerce
- We are aware and are doing our best to refuse the fraudulent specimens

Mock-Ups and Digitally Altered Specimens

- Fake specimens present several issues:
 - Basis to refuse registration because does not show the mark as used in commerce
 - Basis for finding fraud on the Office
 - Can subject a practitioner to discipline by OED
 - May impact validity of any registration that issues and subject it to cancellation

Thank You!

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Commissioner for Trademarks

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