

David Gooder  
Commissioner for Trademarks

# Trademarks FY 2021 priorities

# Trademarks FY 2021 priorities



Dan Vavonese

Deputy Commissioner for Trademark Operations

# **Trademarks filings surge 2021**

# The surge of 2021

- How big a surge
- What's causing it
- What's the impact
- What are we doing about it



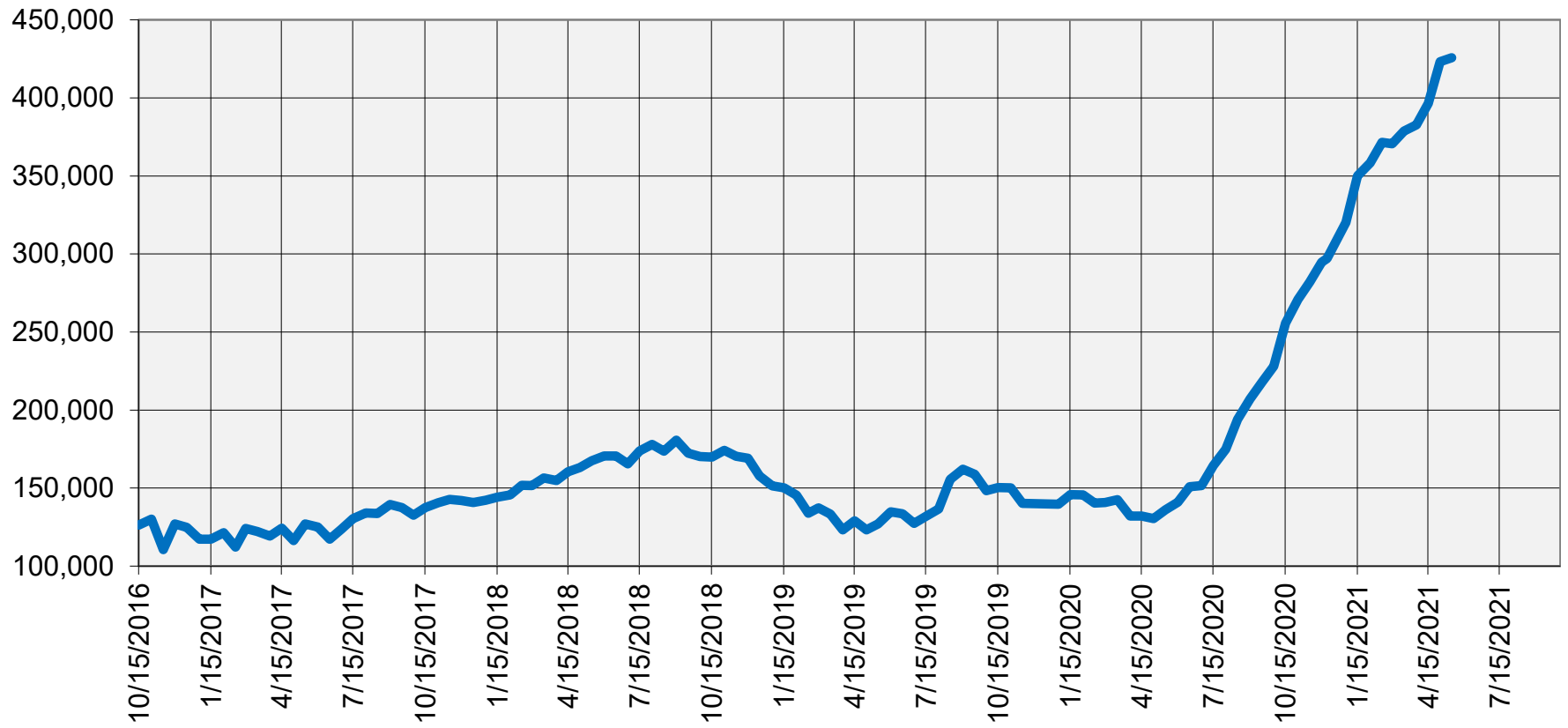
Attack the  
application  
surge



uspto

# Unexamined application inventory (classes)

**425,673**



# Impact of the surge: processing backlogs


- **New applications uploaded into Trademark Status and Document Retrieval and Trademark Electronic Search System**
  - Typically processed within one week
  - Takes longer if manual entry is required; contact [TEAS@uspto.gov](mailto:TEAS@uspto.gov)
- **First action pendency (target between 2.5 and 4.5 months from filing)**
  - Historically, around 3 months from filing to first action
  - Now taking slightly over **5 months**
- **Processing of amendments and responses to office actions**
  - Typically processed within 14 days
  - Now taking **slightly over 95 days**



# Filings surge: what actions have we taken

- Reorganized workloads among staff
- Hired 47 new examining attorneys
  - Started in April
- IT solutions and process improvements – translations and bots to automate some administrative tasks
- Notices on our external sites
- Monthly pendency metrics launched – TM Dashboard
  - Provides regular check processing timeframes

# Pendency metrics: up-to-date processing wait times on TM Dashboard

 [View Current Trademark processing wait times](#)

## Current Trademark processing wait times

As of March 2021	Pendency Target	Current Pendency
<b>Pre-Examination Unit</b>		
TEAS	10 days	74 days
MADRID	10 days	1 days
<b>Examination Support Unit (ESU)</b>		
Amendment entry	14 days	96 days
<b>Intent to use</b>		
Extension requests	15 days	12 days
Statement of use	15 days	16 days
Divisional requests	15 days	13 days
<b>Petitions Office</b>		
Letters of protest	60 days	58 days
<b>Post Registration</b>		
Affidavits of Use/Incontestability	30 days	66 days
Renewals	33 days	66 days
Amendments/Corrections	30 days	21 days
<b>Assignment</b>		
ETAS	2 days	4 days
FAX	10 days	6 days
Paper	14 days	6 days





Amy Cotton

Deputy Commissioner for Trademark Examination Policy

# Trademark Modernization Act

# Notice of proposed rulemaking (NPRM)

- Contains draft rules on:
  - Letters of protest
  - Response times for office actions
  - New ex parte nonuse proceedings
  - Attorney recognition for representation
  - Court orders concerning registrations

**Flexible response period**

# Flexible response period rule

- Options:
  1. Three-month response period with one extension
  2. Two-phase examination
  3. Patent model

# **Nonuse cancellation mechanisms**

# Nonuse cancellation mechanisms

- New proceedings available
  - Expungement
    - Also a new claim at the Trademark Trial and Appeal Board (TTAB)
  - Reexamination

# Nonuse cancellation mechanisms

- Filing a petition
  - \$600 per class
  - USPTO.gov account
  - Petitioner's name, domicile address, and email address
  - Verified statement
  - Documentary evidence of nonuse



# Nonuse cancellation mechanisms

- Reasonable investigation sources
  - State and federal trademark records
    - Other regulatory filings
  - Websites or print sources
    - Controlled by registrant
    - Where relevant goods/services likely offered for sale
    - Where reviews or discussion of relevant goods/services are likely
  - Registrant's marketplace activities
    - Including attempts to purchase
  - Litigation or administrative proceeding records





# Nonuse cancellation mechanisms

- **Prima facie case**
  - Director decides whether prima facie case is made
  - If prima facie case is made, Director must institute proceedings
  - Director's decision to institute is final and non-reviewable
- **Institution**
  - Office action issues with two-month response period

# Nonuse cancellation mechanisms

- Registrant's response
  - Acceptable response options
    - Documentary evidence of use
    - Verified statement and evidence of excusable nonuse
      - Applies only to Section 44 or 66 registrants in an expungement proceeding
    - Deletion of goods or services
  - If acceptable, proceedings terminate

# Nonuse cancellation mechanisms

- Registrant's response
  - Non-response
    - Failure to respond results in **immediate** cancellation in whole or in part
  - Unacceptable response
    - Final action issues, continuing requirements, with two-month response period

# Nonuse cancellation mechanisms

- Response to final action
  - Request reconsideration
  - Appeal to TTAB

# Nonuse cancellation mechanisms

- Estoppel
  - Goods and services for which use in commerce has already been established may not be subject to further proceedings

# **Attorney recognition for representation**

# Recognition for representation

- Recognition for representation continues until revocation or withdrawal
  - Owners and attorneys must proactively file revocation or withdrawal documents

# NPRM comments

- Send formal comments to [www.regulations.gov](http://www.regulations.gov)
- Docket number PTO-T-2021-0008
- <https://www.federalregister.gov/public-inspection/2021-10116/changes-to-implement-provisions-of-the-trademark-modernization-act>
- Deadline for formal comments: July 19, 2021



Amy Cotton

Deputy Commissioner for Trademark Policy

# **Boosting register protection: investigation and sanction process**

# Schemes

- False use claims
- U.S. counsel circumvention
- Unauthorized practice of law
- Trafficking in applications or registrations
- Scam solicitations

# Sanctions

- Criminal provisions
  - Law enforcement
- USPTO Rules of Professional Conduct
  - Office of Enrollment and Discipline (OED)
- USPTO Rules of Practice & website Terms of Use
  - Authority of the Commissioner for Trademarks

# Commissioner for Trademarks

- Authority to:
  - manage and direct all aspects of the activities of the USPTO that affect the administration of trademark operations
  - impose sanctions on parties who file submissions in trademark matters in violation of
    - USPTO Rules of Practice
    - USPTO website Terms of Use

# Investigation trigger

- Detecting fraudulent submissions
  - Examining attorneys
  - USPTO data analytics
  - Law enforcement
  - Media reports
  - Customers

# Investigation process

- Investigating fraudulent submissions
  - Identify affected applications
  - Collect evidence and establish rule violations
  - Two options:
    - Direct examining attorneys to issue appropriate refusals or requests for information
    - Issue show cause order

# Sanctions

- Issuing final order for sanctions
  - Sanctions include:
    - Striking submission
    - Terminating the proceeding
    - Precluding parties from submitting documents
    - Referring practitioners to OED
    - Terminating USPTO.gov accounts

# Referral for additional sanctions

- **OED**
  - Refer representatives to OED for investigation and possible discipline
- **Law enforcement**
  - Refer to the Department of Commerce's Office of the Inspector General and other law-enforcement agencies



# Orders issued

- Recent orders for sanctions
  - Xue Chaoxing
  - Dr. Thong Quang Ngo
  - <https://www.uspto.gov/trademarks/trademark-updates-and-announcements/orders-issued-commissioner-trademarks>

Greg Dodson

Deputy Commissioner for Trademark Administration

# IT modernization

# Trademark IT update

- **“New Ways of Working”**

- Product teams firmly established and development efforts ongoing
- “Center” highlights
  - External:
    - ✓ Numerous components have seen stability releases since last meeting
    - ✓ TEAS deployed features for testing of identity verification capability
    - ✓ TSDR work enhancing cybersecurity completed; ended temporary restriction on document bundle API
  - Examination:
    - ✓ FAST 2 stabilization is complete and FAST 1 stabilization will be deployed May 21
    - ✓ NG-Exam enhancement continues; DevSecOps pipeline has been built out allowing for much quicker and easier deployment of future enhancements. New screen capture functionality has been deployed.
  - International:
    - ✓ Establishing cloud services to support microservices development
    - ✓ High customer satisfaction from Madrid business managers, business users, and the international bureau



Intensify IT  
modernization



uspto

# Trademark IT update

- **“New Ways of Working”**

- “Center” highlights

- TTAB:

- ✓ Completed a two-year project for the stabilization of TTAB legacy systems
- ✓ Begun work on a new TTAB Center and an integrated Notice of Opposition form
- ✓ Begun work on implementing the TMA new ground for cancellation

- Data and Analytics

- ✓ Three legacy systems, out of four, have been retired and decommissioned
- ✓ Reduced total number of legacy reports from nearly 400 to approximately 100; migrating to EDW SAP platform
- ✓ Deployed Form Paragraph search application to support analysis by Legal Policy office

- Content Management

- ✓ Developing a modernized TRM database to eventually replace the TM mainframe database; workflow and business rules breakdown is currently underway
- ✓ MyUSPTO has been using TRM database to generate queries from its webpage via microservices technology
- ✓ Cloud-based solutions for TM databases are in the evaluation stage



# Trademark IT update

- **Robotic process automation**

- **Auto suspension**

- Modifies the business logic in TRADEUPS
- Allows for automatic entry and processing of a greater number of amendments and responsive documents

- **Trademark Assistance Center**

- Automates FAQ responses to minimize the human interaction in up-front interaction

- **Pseudo marks**

- Automates significant portions of the workflow
  - ✓ “Flags” misaligned serial numbers; suggests (and auto-populates) pseudo marks when required
  - ✓ Reduces workload on Examination Support Unit

