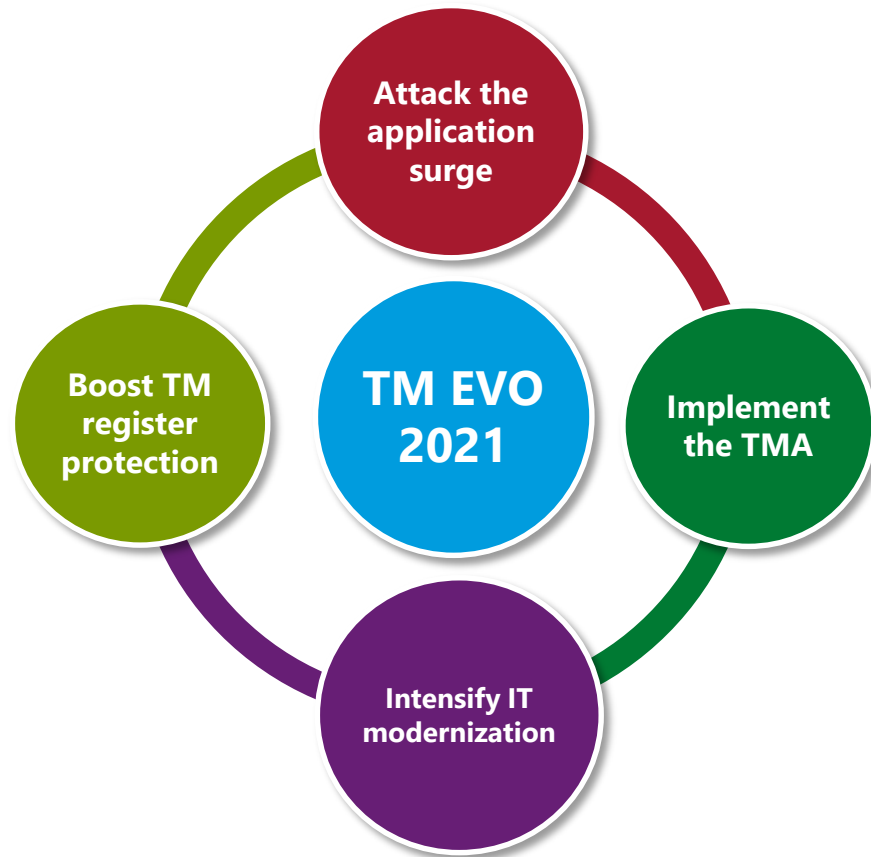


David Gooder
Commissioner for Trademarks

Trademarks FY 2021 priorities

Trademarks FY 2021 priorities



Dan Vavonese

Deputy Commissioner for Trademark Operations

Application filings surge

The surge of 2021

- What's the impact
- What are we doing about it

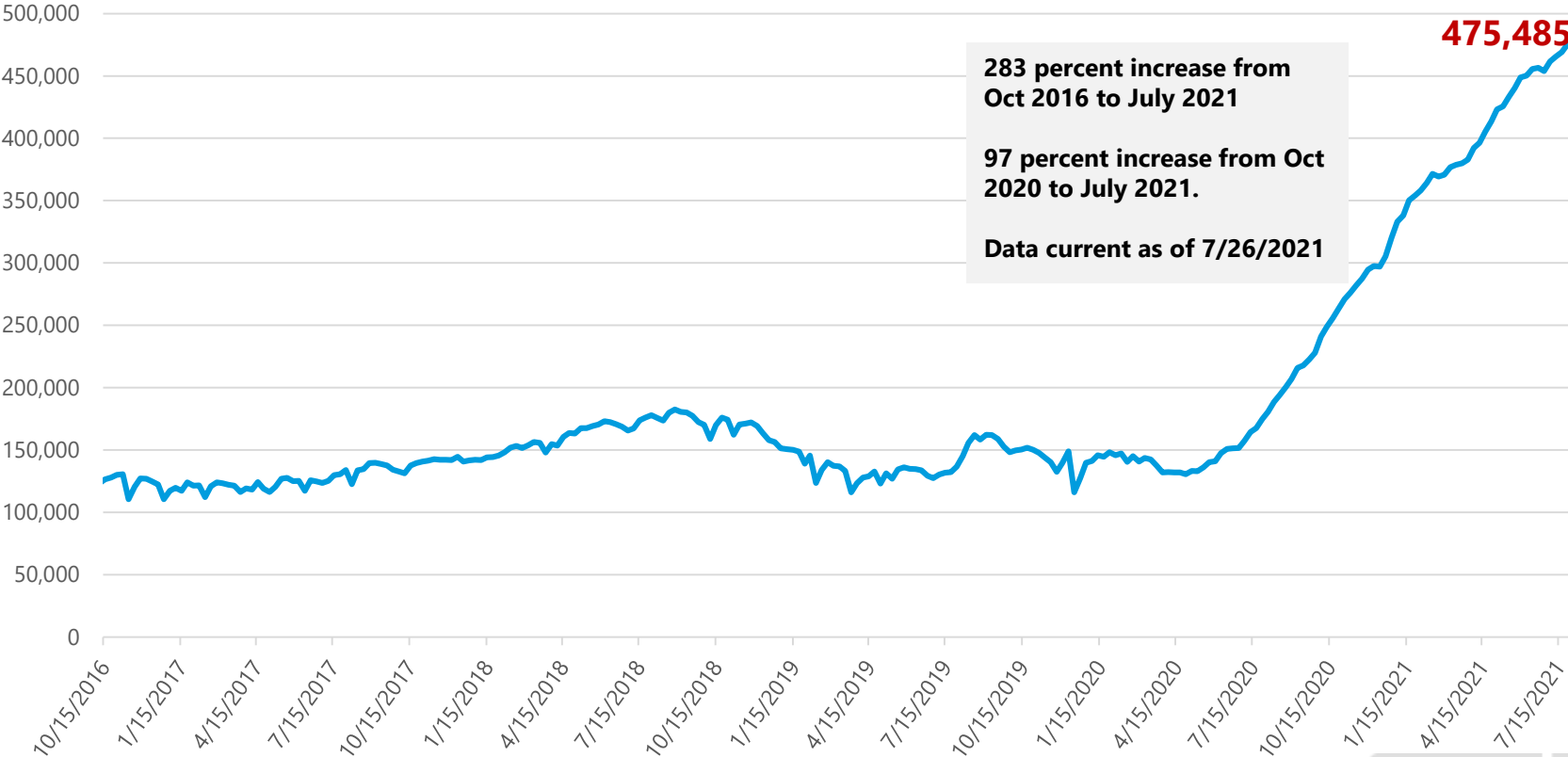


Attack the
application
surge



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Unexamined application inventory (classes)



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
- **First action pendency (target between 2.5 and 4.5 months from filing)**
 - Historically, around 3 months from filing to first action
 - Now taking nearly **6 months**
- **Processing of amendments and responses to office actions**
 - Typically processed within 14 days
 - Back on goal, now taking **around 14 days**




Filings surge: what actions have we taken

- Reorganized workloads among staff
- Hired 47 new examining attorneys
- Upcoming hiring plans
- IT solutions and process improvements
- 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

Attack the application surge

Current Trademark processing wait times		
As of June 2021	Pendency Target	Current Pendency
Pre-Examination Unit		
TEAS	10 days	81 days
MADRID	10 days	0 days
Examination Support Unit (ESU)		
Amendment entry	14 days	68 days
Intent to use		
Extension requests	15 days	7 days
Statement of use	15 days	8 days
Divisional requests	15 days	15 days
Petitions Office		
Letters of protest	60 days	80 days
Post Registration		
Affidavits of Use/Incontestability	30 days	78 days

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Amy Cotton

Deputy Commissioner for Trademark Policy

Trademark Modernization Act: comments in response to Notice of Proposed Rulemaking

Notice of Proposed Rulemaking comments received

- 30 comments
 - Industry associations (10)
 - Law firms (5)
 - Corporations (3)
 - Law school legal clinic (1)
 - Non-profit (1)
 - Individuals (10)

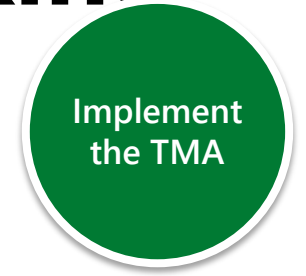


Implement
the TMA



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Notice of Proposed Rulemaking



- Letters of protest
- Flexible response periods
- Nonuse cancellation
- Attorney recognition
- Court orders



Flexible response period options

Implement the TMA

Three month response

*Single **three** month response period, extendable once to full six months*

Two phase examination

Two month response period for formalities, extendable to the full six months

Three month response period for substantive examination, extendable to full six months

Patent model

Two month response period, extendable month by month to full six months



Flexible response period comments



Implement
the TMA

- Twenty three comments
 - Support three month response period
 - Support combination of options one and three
 - No change
 - No change but if anything, three month initial response
 - Delay implementation and ask for more public comments



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Attorney recognition (1 of 2)

Implement
the TMA

2.17(g): recognition for representation continues until revocation or withdrawal

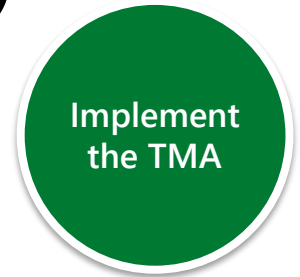
2.17(b) & 2.19(d): fraudulent designation of representative will not be effective

2.19(b): clarifies when an attorney must withdraw and when permitted to withdraw

2.61(c): deletes provision on conflicts of interest, superseded by Rules of Professional Conduct

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Attorney recognition (2 of 2)



- Twelve comments
 - Some support
 - Some oppose
 - Desire for more information about forthcoming phase of login, role-based access controls, to assess the need for rule changes
 - Concerns about removing docketing information from database

Nonuse cancellation (1 of 7)



Implement
the TMA

- Petition requirements and procedures
 - 30 day letter for good faith but incomplete petition
 - Support 30 day letter
 - 30 days to perfect incomplete petition is too long
 - Oppose 30 day letter



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Nonuse cancellation (2 of 7)

Implement
the TMA

- Petition requirements and procedures
 - Allow petitioner to supplement deficient petition with more evidence
 - Allow registrant to submit a response to petition prior to institution
 - Should address confidentiality concerns of registrants

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Nonuse cancellation (3 of 7)

Implement
the TMA

- Petition requirements and procedures
 - Real party in interest
 - Should require
 - Should not require
 - Wait and see if abused
 - Director should retain discretion to ask for real party in interest prior to institution determination

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Nonuse cancellation (4 of 7)

Implement
the TMA

- Petition requirements and procedures
 - Limitation on # petitions filed on a registration
 - Limit number of petitions
 - Limit within a certain time period
 - Don't limit the number of petitions, but "wait and see"
 - Address patterns of abusive filings by denying future requests

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Nonuse cancellation (5 of 7)

Implement
the TMA

- Expungement/Reexamination response period
 - Make consistent with other office action response periods
 - Allow extensions of time
 - Three month response period
 - Three month response period, extendable to six
 - Six month response period

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Nonuse cancellation (6 of 7)



Implement
the TMA

- Filing fee
 - \$600 is appropriate
 - \$600 is too high
 - Charge registrant \$250 per class deletion fee
 - Refund \$200 for default judgments
 - Lower fee for more recent registrations
 - Lower fee for individuals, small businesses, non-profits



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Nonuse cancellation (7 of 7)



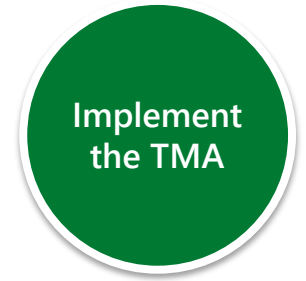
Implement
the TMA

- Audit for failure to respond
 - Oppose audit
 - Impose penalty fee if application is refiled
 - Support audit
 - Evaluate whether to institute Director-initiated proceeding on rest of the registration
 - Wait and see



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Final rule



- Anticipate publication
 - November 2021
 - Rulemaking requires publication 30 days prior to implementation (unless good cause)
 - Implementation for nonuse cancellation is required by December 27, 2021



Amy Cotton

Deputy Commissioner for Trademark Examination Policy

Boost Trademarks register protection

Schemes



- Special task force investigations
 - Violations of US rules of practice, representation rules, and website terms of use
 - Administrative sanctions
 - Attorney misconduct that impacts US applications
 - Refer to Office of Enrollment and Discipline
 - Criminal behavior that impacts or implicates US applications
 - Refer to law enforcement



Taking steps



- Identifying schemes
- Investigating affected applications
- Targeting rule violations where there is evidence of intent to circumvent US rules
- Talking to law enforcement and OED
- Improving website content



Improving website content



- Names of potential scam companies flagged by our customers
- Names of actors and companies that the USPTO is investigating or has sanctioned
- Checklist for how to prevent being scammed and what to do if you believe you are a victim
- TMScams@uspto.gov



Sanctions and discipline



- Commissioner ordered sanctions
 - Final orders for sanctions
 - Xue Chaoxing
 - Dr. Thong Quang Ngo
 - Show cause order
 - Yusha Zhang & Shenzhen Huanyee Intellectual Property Co., Ltd.
 - [Orders issued by the Commissioner for Trademarks-Document Link](#)
- OED discipline
 - Settlement agreement
 - Yiheng Lou, NY attorney
 - [Lou Final Order D2021-04 Redacted.-Document Link](#)



Greg Dodson

Deputy Commissioner for Trademark Administration

IT modernization

Trademark IT update (1 of 3)

- **Electronic registration certificates (eReg Certs) and Blockchain**
 - Development status
 - Adobe HA (high availability) bug fixed July 22, 2021
 - Solidifying communications plan
 - Deployment target
 - February 15, 2022
 - ✓ Timing based on rulemaking and already-scheduled new calendar year deployments
 - Blockchain options to replace ‘hashed’ copies and obviate need for certified copies being reviewed.



Trademark IT update (2 of 3)

- **Identity proofing status**

- Feedback thus far: Usability testing and beta testing
 - Usability testing conducted by customer experience team – utilized cross-section of known users
 - Beta testing accomplished by development team – used TPAC members
- Next cohort for “expanded beta”
 - Using examination policy-vetted users
 - ✓ Testing to run thru August
 - ✓ Feedback will inform enterprise release
- Plan for deployment: October 2021



Trademark IT update (3 of 3)

Product line status



- TRAM retirement acceleration options being developed; six additional development teams added to product line



- Last remaining legacy reporting system has been successfully migrated to the Enterprise Data Warehouse (EDW); all legacy systems assigned have been retired or decommissioned
- One additional AI/ML/RPA development team added in FY22



- Enhanced and re-imagined TM Exam approaching opportunity for launch to volunteer examining attorneys for early adoption and feedback



- Production beta test of ID verification application and integration with TEAS and MyUSPTO
- New pages added to Trademarks landing page on USPTO.gov (ex. "Scam Awareness")



- Established new product development plan on AWS Cloud transition
- Development team established four microservices (workflow router, workflow engine, API, and API gateway) to further improve the cloud infrastructure



- Completed ESTTA *Answer and Counterclaim* and *Petition for Cancellation* forms changes
- Modified backend process to support TMA cancellation based on nonuse



