Operational News and Updates

Mary Boney Denison
Commissioner for Trademarks
Organization and Statistics
Trademark Organization Staffing

• 834 Trademark employees  
  (7% of USPTO)
• 548 examining attorneys  
  (66% of Trademarks)
• 68% of examining attorneys telework full time
• Announcement for new examining attorneys closed: Interviews will be conducted soon
• Planning to hire ~50-65 this Fiscal Year
New Application Filings

- FY16: 530,270 classes filed  FY17: 594,107 classes filed
- FY17 up 12% compared to FY16.
## Trademark Performance: Pendency

<table>
<thead>
<tr>
<th>FY 2017 Trademark Performance Measures</th>
<th>FY 2017 Targets</th>
<th>FY 2017 Results</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>First Action Pendency</strong>&lt;br&gt;First action pendency from date of filing to first office action in months.</td>
<td>2.5 – 3.5</td>
<td>2.7</td>
</tr>
<tr>
<td><strong>Disposal Pendency</strong>&lt;br&gt;Disposal pendency from date of filing to issuance of a notice of allowance, registration, or abandonment – <strong>excluding</strong> suspended and <em>inter partes</em> proceedings.</td>
<td>12.0</td>
<td>9.5</td>
</tr>
</tbody>
</table>
# Trademark Performance: Quality

<table>
<thead>
<tr>
<th>FY 2017 Trademark Performance Measures</th>
<th>FY 2017 Targets</th>
<th>FY 2017 Results</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>First Action Compliance</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td>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.</td>
<td>95.5%</td>
<td>97.3%</td>
</tr>
<tr>
<td><strong>Final Action Compliance</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td>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.</td>
<td>97.0%</td>
<td>98.3%</td>
</tr>
<tr>
<td><strong>Exceptional Office Action</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Measure indicating the comprehensive quality of the first Office action search, evidence, writing and decision making.</td>
<td>42.0%</td>
<td>45.0%</td>
</tr>
</tbody>
</table>
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

Applications Completely Processed Electronically (classes)

- Q2-15: 81.4%
- Q3-15: 81.6%
- Q4-15: 82.2%
- Q2-16: 83.6%
- Q3-16: 83.8%
- Q2-16: 84.6%
- Q3-16: 84.8%
- Q4-16: 85.6%
- Q1-17: 86.3%
- Q2-17: 86.4%
- Q3-17: 86.5%
- Q4-17: [Value not provided]
Fee Change Effect on Paper Applications

Paper Applications (classes)

- October 2016: 80
- November 2016: 116
- December 2016: 102
- January 2017: 65
- February 2017: 18
- March 2017: 15
- April 2017: 23
- May 2017: 33
- June 2017: 17
- July 2017: 18
- August 2017: 27
- September 2017: 11
• Effective tomorrow, November 1, 2017, the Office will no longer accept payment for fees in cash. We will continue to accept payment by deposit account, credit card, EFT, and check at the cashier’s window, and through U.S. mail and TEAS.
My.USPTO.gov

• **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**
My.USPTO.gov Update cont.

• Latest enhancement to note: custom column feature, which allows users to decide what data fields are displayed in their full screen view of the Trademark docket.
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
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
October 2017 update has been posted. An index to changes is included
ID Manual Update

• The contents of the entire manual and search results can now be downloaded in Excel®, HTML or XML
• Users can also customize the content when downloading
• On January 1, 2018 the eleventh edition of the Nice Classification, version 2018 (Nice 11-2018 or NCL 11-2018) will go into effect. The USPTO ID Manual will reflect those changes on January 1, 2018.
Screenshot of ID Manual
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, comments are due by November 17.
Recent Examination Guides

- Exam Guide 1, Post Matal v. Tam re: Disparagement Clause of Section 2(a)

- Exam Guide 2, Merely Informational Matter

- Exam Guide 3, Petitions/Reinstatement Rule

- Exam Guide 4, Surname Combined with Wording
Section 2(a)

• Guidance sent out in June after Tam; “The Slants” published August 29.

• Will await Brunetti Decision regarding scandalous marks; oral argument last August

• Blackhorse allowed to proceed based on Tam decision
Initiatives
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 Audit Program

• All single-class registrations with four or more goods/services in the class and multiple-class registrations in which at least two classes have two or more goods/services in each class are potentially subject to audit.

• Office actions will identify any deficiencies in the underlying affidavit or declaration and will also require “proof of use” for two additional goods/services for each class.
Random Audit Program

No Response or Untimely Response to Office action

- If a timely response is not filed to an Office action, after the expiration of the statutory filing period, the registration will be cancelled in its entirety.

- If a timely response is not filed to an Office action, but time remains in the statutory filing period, the registration owner has the option to file a new maintenance filing, along with all new filing fees.

- Note that any new filings will also be reviewed for compliance with both statutory and audit requirements, since the registration remains subject to the audit.
Expedited Cancellation Proceedings

• Request for Comments published. See 82 Fed. Reg. 22517; public roundtable held 9/25/17

• Four options initially considered; we are moving forward on two options that do not require a statutory change

• TTAB Streamlined Cancellation Proceedings
  – 1) Abandonment
  – 2) No use as of §1(a) filing date or no use as of the filing date of an AAU/SOU for §1(b)
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, USPIS, SBA, CBP).
Initiatives to Improve Customer Experience

• Hired Chief Customer Experience Administrator and two plain language writers
• Implementing Deloitte Recommendations such as: Improving website, making searching more understandable, making ID selection process easier to use and simplifying the filing process
• My.uspto.gov
  (1) Simplified ITU application form
  (2) Form finder
International
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 of 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
Image Searching

- Members of our Information Technology Staff will be going to Japan next week to discuss the latest developments in Image Searching Technology
TM5 on Bad Faith TM Filings

• TM5 partners – USPTO, SAIC, EUIPO, JPO, and KIPO – continue to make efforts to minimize bad faith trademark filings by:
  (a) exchanging best practices and
  (b) working with each other to provide more transparent information to users on how the largest trademark offices combat bad faith trademark filings.
• Most recent seminars: Tokyo, March 2016 and Kunshan City, October 2016 and Barcelona, May 2017
• JPO presented their report at the mid-year meeting in Barcelona in May.
• Attending Annual Meeting in Alicante, Spain at the end of the month.
Common Status Descriptors

Mark: POPVOX

US Serial Number: 8512406
US Registration Number: 4166054
Register: Principal
Mark Type: Service Mark
TMIS Common Status Descriptor: LIVE/REGISTRATION Issued and Active

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.
Status Date: Jul 03, 2012
Publication Date: Aug 10, 2011
Notice of Allowance Date: Oct 11, 2011

- Mark Information
- Goods and Services
- Basis Information (Case Level)
- Current Owner(s) Information
- Attorney/Correspondence Information
- Prosecution History
- TM Staff and Location Information
- Assignment Abstract Of Title Information - Click to Load
- Proceedings - Click to Load
China
Focus on China

• Unauthorized Practice of Law
• Influx of Chinese Filings
• Specimen Issues
• Counterfeiting
• Bad Faith Filings
Unauthorized Practice of Law

• Concerned with applications handled by foreign attorneys.
• Not permitted under our rules unless permission granted by Office of Enrollment and Discipline (OED); only Canadian attorneys/agents currently permitted
• TMEP § 602.03, TMEP § 608
• Foreign Attorney or Agent may receive correspondence, but cannot file on applicant’s behalf.
• Trademarks and OED investigate infractions.
• Send Orders to Show Cause and possible exclusion order based on response.
• Conferred with SAIC in China on this issue and also providing information on our website.
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 are 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!

Mary Boney Denison
Commissioner for Trademarks

Mary.Denison@uspto.gov