

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Introduction & Welcome by TPAC Chair

Bill Barber

Chair, Trademark Public Advisory Committee

UNITED STATES
PATENT AND TRADEMARK OFFICE



Opening Remarks

Laura Peter

Deputy Under Secretary and Deputy
Director

UNITED STATES
PATENT AND TRADEMARK OFFICE



Operational news and updates

Commissioner for Trademarks

Mary Boney Denison

November 1, 2019

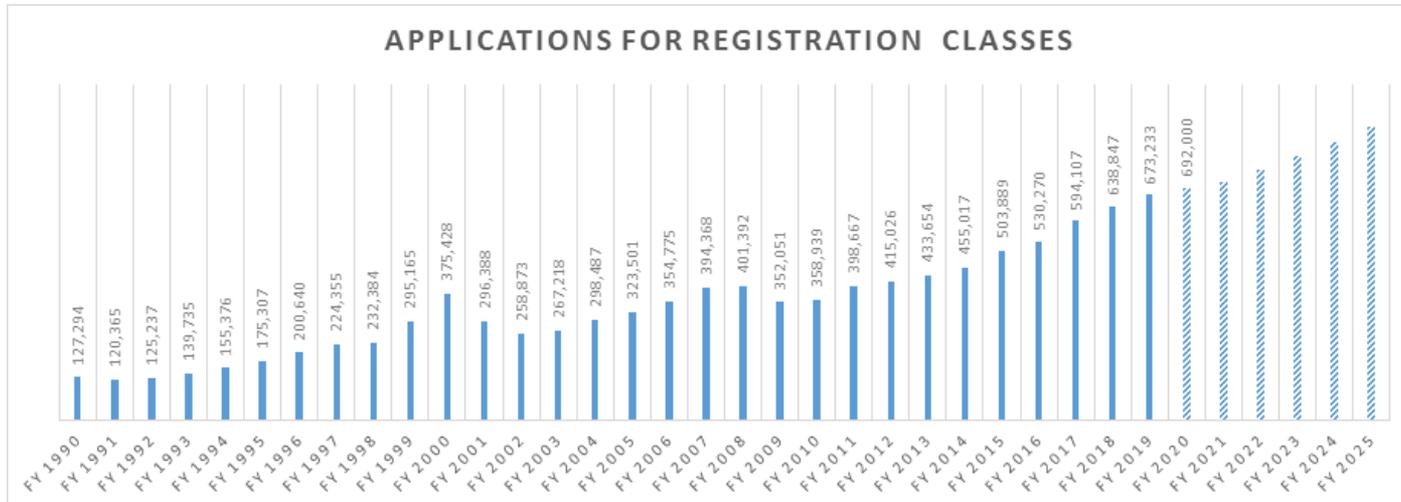
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UNITED STATES
PATENT AND TRADEMARK OFFICE



New application filing projections

- FY 2016: 530,270 classes filed
- FY 2017: 594,107 classes filed
- FY 2018: 638,847 classes filed
- FY 2019: 673,233 classes filed (5.4% increase from FY 2018)



Trademarks organization staffing

- 944 Trademarks employees (7% of USPTO)
- 627 examining attorneys (67% of Trademarks)
- 83% of examining attorneys telework
- FY 2018: hired 61 new examining attorneys
- FY 2019: hired 83 new examining attorneys
- FY 2020: planning to hire 40-50 new examining attorneys

Trademarks performance: Pendency

FY 2019 Trademarks performance measures	FY 2019 targets	FY 2019 September results
First action pendency First action pendency from date of filing to the first office action in months	2.5 – 3.5	2.6
Disposal pendency Disposal pendency from date of filing to issuance of a notice of allowance, registration, or abandonment – excluding suspended and <i>inter partes</i> proceedings.	12.0	9.3

Trademarks performance: Quality

FY 2019 Trademarks performance measures	FY 2019 targets	FY 2019 September results
First action compliance In-process review evaluation of the statutory bases for which the USPTO raises issues and/or refuses marks for registration based on the first office action	95.5%	96.4%
Final action compliance In-process review evaluation of the statutory bases for which the USPTO raises issues and/or refuses marks for registration based on the examining attorney's approval or denial of the application	97.0%	97.4%
Exceptional office action Measure indicating the comprehensive quality of the first office action search, evidence, writing, and decision making	46.0%	54.5%

Law and policy

Rulemaking: U.S. counsel requirement

- Requires foreign-domiciled trademark applicants, registrants, and parties before the Trademark Trial and Appeal Board to be represented by a U.S.-licensed attorney to file trademark documents with the USPTO
 - Made effective August 3
 - Examination Guide 4-19 issued in September

Rulemaking: U.S. counsel requirement

- Benefits of new rule
 - Ensure effective use of available mechanisms to enforce foreign applicant and registrant compliance with statutory and regulatory requirements
 - Increase confidence that registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims
 - Aid our efforts to improve accuracy of the U.S. trademark register
- Impact on U.S.- licensed attorneys
 - Will be required to enter bar membership information and confirm active member in good standing
 - Owner address required (can be hidden)
 - Beware of foreign solicitations – persons located internationally offering to pay to use your bar information to circumvent the rule



Rulemaking: Mandatory electronic filing

- Implementation scheduled for December 21
- Mandatory use of TEAS for all trademark filings with the USPTO except in cases of:
 - International agreements requiring acceptance of paper submissions from certain countries
 - Specimens for scent, flavor, or other non-traditional marks
 - Postal service interruptions or emergencies
- Petition process for requesting acceptance of paper submissions under limited circumstances
- www.uspto.gov/trademark/laws-regulations/mandatory-electronic-filing



Initiatives

Improper behavior

Submitting fake or altered specimens

Submitting false claims of use in U.S. commerce

Using unauthorized practitioners

Making unauthorized address changes

Misleading solicitations

Trying to circumvent U.S. counsel rule

Forged Signatures

Addressing improper behavior

- **Proof of use audit program**
 - The USPTO began a pilot program in 2012 and made it permanent in 2017, giving the USPTO the authority to cancel audited registrations with unsubstantiated use claims or to delete unsupported goods and services
- **Excluded unauthorized foreign practitioners**
 - The commissioner has excluded specific foreign practitioners from appearing before the USPTO
- **Proof of actual use in examination**
 - Updated examination guidance to require examiners to refuse mocked-up and fake specimens and to use the 37 CFR §2.61(b) request for information authority to request evidence of use in commerce



Addressing improper behavior

- Improved readability of declaration
 - The declaration was reformatted to make it more readable and to make the signer acknowledge the required statements by checking a box next to each one, thereby increasing the likelihood that the signer will read the declaration and appreciate the significance of swearing to use for each and every good or service listed
- Expedited cancellation pilot for non-use or abandonment claims
 - Implemented TTAB pilot program for cases raising non-use or abandonment claims to identify the types of procedures needed to accelerate disposition of those claims; considering whether to make permanent
- Issued U.S. counsel final rulemaking
 - Requires foreign-domiciled trademark applicants, registrants and parties before the Trademark Trial and Appeal Board to be represented by a U.S.-licensed attorney to file trademark documents with the USPTO. Made effective August 3. Examination Guide 4-19 issued in September

Addressing improper behavior

- Specimen database
 - Developing specimen database to enable examining attorneys to see highly similar specimens used by multiple applicants. Expected by the second quarter of FY 2020
- Login
 - To prevent unauthorized changes, USPTO will be implementing a login system requirement for all filings in three phases. First phase rolled out on October 26

Addressing improper behavior

- **Suspicious addresses**
 - Some foreign-domiciled applicants are providing U.S. addresses to establish U.S. domicile and circumvent the requirement for U.S. counsel. The addresses are typically associated with “mail drops” or are virtual office mailing addresses; others are simply residential mailing addresses used by numerous parties
 - We are developing processes for identifying these addresses so that we may flag relevant applications and other submissions before they are assigned for examination
- **Improperly signed submissions**
 - We have identified applications that include the name, information, and signatures of U.S. attorneys who did not sign or otherwise consent to be designated in applications
 - We have also identified what appear to be fictitious attorney names in some records
 - If an attorney’s information and/or signature has been misused, we work with the attorney to correct the record. Improper signatures and attorney designations will be handled through the examination process or, when appropriate, through the issuance of show-cause orders to the relevant parties

Special task force

- Developed in response to the significant increase in unauthorized and improper activities in connection with trademark filings
- Goals include:
 - Developing and implementing policies, procedures, and technology solutions to effectively address fake/altered specimens, false claims, unauthorized TEAS submissions, and other efforts to circumvent the rules of practice in trademark cases
- Continue to monitor and analyze suspicious specimen filing activities

Unauthorized changes

- Unauthorized parties have filed forms through TEAS making changes to trademark records
- This affects a very small number of total applications and registrations
- The USPTO intercepts the vast majority of unauthorized changes
- We created a webpage where customers can get information on steps to take if impacted (search “unauthorized changes” on www.uspto.gov)
- MyUSPTO login was required for TEAS forms starting on October 26

The screenshot shows the USPTO website's navigation bar with links for Patents, Trademarks, IP Policy, and Learning and Resources. The main content area is titled "Unauthorized changes to your file" and contains the following text:

Unauthorized changes have been made to a number of active trademark applications and registrations. These changes may be part of a scheme to register the marks of others on third-party "brand registries." Unauthorized parties have filed forms through our Trademark Electronic Application System (TEAS) to make these changes. Although these instances affect a small percentage of total applications and registrations, we want to make sure our customers are aware of the problem as we work to resolve it.

You may receive an email message from the USPTO notifying you of a requested change to your application or registration. For example, when we receive a request to change the primary email correspondence address of record, we may send this email alert to the **patent** primary email correspondence address to alert the applicant, registrant, or attorney of the change.

Please note that this automated email message alert is generated immediately after the electronic form requesting to change the primary correspondence email address is submitted. However, it may take up to 72 hours after we receive the request before the change is actually processed or the filing becomes available for viewing through the Trademark Status and Document Retrieval (TSDR) system.

If you received an email alert message and were not expecting it, you should take the following steps:

1. **Confirm the change was not authorized.** Review the new primary email address in the message to determine if you recognize it. If the address belongs to somebody else within your organization or belongs to a law firm with which you have a current or past relationship, it is possible the change was unexpected but still authorized.
 - If you have recently hired an attorney, revoked an attorney, or changed attorneys, a change of correspondence alert will usually result when we are notified of the change.
 - If the change was unexpected, but you recognize the party who requested the change, please consider whether communication with the other party will resolve the issue before reporting it to us.
2. **If the change still appears to be unauthorized, report it to us by forwarding the original "alert" email message to TEAS@uspto.gov with the following information:**
 - Your name and your direct telephone number
 - The application serial number(s) and/or registration number(s) affected by the allegedly unauthorized change
 - The date and time of the alert message
 - A brief explanation of your relationship to the named applicant or registrant of record
 - Any other information you believe may be pertinent to your particular situation.
3. **Once you contact us, we will likely advise you to file one or more of the following:**
 - [Change of Correspondence Address, Revocation](#)
 - [Appointment and/or Change of Correspondence Address of Attorney/Domestic Representative](#)
 - [Request for Withdrawal as Attorney/Law Firm of Attorney/Law Firm](#)
 - [Other TEAS correspondence forms](#) as may be appropriate under the circumstances.

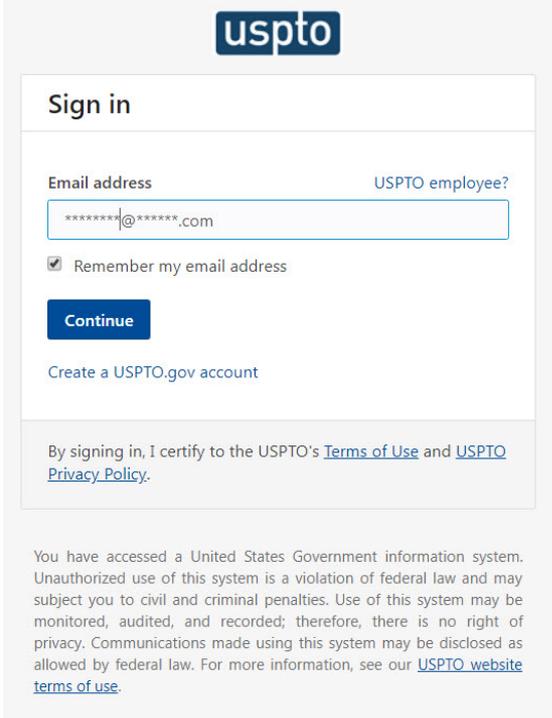


Action plan

- Short-term solutions
 - Assigned full-time staff to monitor this issue and contact affected customers
 - Created a [webpage](#) (search “unauthorized changes” on www.uspto.gov)
- Long-term solutions
 - TEAS log in with authentication and authorization (customized COTS product)
 - Phase 1 Mandatory Login implemented on October 26

Phase 1: fall 2019

- Use an existing uspto.gov account or sign up for a new one at my.uspto.gov
- Log in through my.uspto.gov or click on the TEAS form you want to use and you will be prompted to log in
- Once logged in, file as usual through TEAS
- Mandatory login implemented on October 26



The screenshot shows the USPTO sign-in interface. At the top is the 'uspto' logo. Below it is a 'Sign in' section with an 'Email address' field containing a masked email address '*****@*****.com'. To the right of the field is a checkbox labeled 'USPTO employee?'. Below the field is a checked checkbox labeled 'Remember my email address'. A blue 'Continue' button is positioned below the checkbox. Underneath the button is a link that says 'Create a USPTO.gov account'. At the bottom of the sign-in section, there is a disclaimer: 'By signing in, I certify to the USPTO's [Terms of Use](#) and [USPTO Privacy Policy](#).' Below the sign-in section is a larger block of text: 'You have accessed a United States Government information system. Unauthorized use of this system is a violation of federal law and may subject you to civil and criminal penalties. Use of this system may be monitored, audited, and recorded; therefore, there is no right of privacy. Communications made using this system may be disclosed as allowed by federal law. For more information, see our [USPTO website terms of use](#).'



Phase 1: fall 2019

- MyUSPTO has four ways to provide two-step authentication:
 - Email
 - A six-digit code will be sent to the primary email address associated with your uspto.gov account by default. If the code is not used within 20 minutes, it will no longer be active and a new code will need to be requested
 - Authentication app
 - A six-digit code will be generated by an authenticator app
 - In order to be used, the application will need to be installed and configured on your device
 - Phone call
 - A six-digit code will be generated and a phone call made to the verified number on your account. You must verify and enable the number through your account page
 - Text message
 - Text messaging became an option on October 26



Phase 2: Q2 FY 2020

- Current and new uspto.gov account holders will verify their identity
- Identity proofing prevents “impostor” accounts

Phase 3: summer 2020

- Customers will be able to create roles and delegate authority to other accounts
 - Attorneys may authorize multiple staff accounts to access and edit filings
 - Customers may restrict any unauthorized users from making changes to an application or registration

Specimen protest pilot program

- Streamlined process for public to report improper specimens
- Email submissions should include either:
 - Objective evidence of third-party use of images identical to the specimen of record
 - Registration or serial numbers showing identical specimens bearing different marks
- Effective immediately, to align with new Exam Guide 3-19 on examining digitally created or altered and mockup specimens, protests will be granted when any specimen of record raises concerns about actual use in commerce.
- Additional submission guidelines and details on the process are on our website under “Recent postings”
- Send submissions to TMSpecimenProtest@uspto.gov



Decluttering initiative: proof-of-use audit program

- Permanent program launched November 1, 2017
- The program improves the integrity of the trademark register
 - Allows us to cancel audited registrations with unsubstantiated use claims or remove unsupported goods and services from others
- Your registration may be audited if you meet both requirements:
 - You filed a Section 8 or 71 declaration of use
 - Your registration includes at least one class with four or more goods or services, or at least two classes with two or more goods or services.
- If audited, we will require submission of proof of use for additional goods/services in registration to ensure that register accurately reflects marks that are in use in the United States for all goods/services identified in registrations
- uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program

Proof-of-use audit program results so far

November 2017 – October 1, 2019

- 7,613 first actions issued by examiners on project
- 3,723 responses received
- 48.6 percent of registrations with response deleted at least some goods or services
- 62 percent of registrations either filed a response deleting goods or services, or were cancelled
- 79 percent of respondents represented by an attorney
- 21 percent of respondents pro se



Misleading solicitations

- **Collaboration: Working with stakeholders to find solutions**
 - Informal interagency working group on combatting fraudulent solicitations
 - 2017 roundtable with TPAC and numerous bar groups and government agencies
 - TM5 project co-led by the European Union Intellectual Property Office (EUIPO) and the USPTO
- **Education: Warning applicants and registrants at key stages**
 - Warnings on application filing receipts, office action cover emails, and paper notices mailed with each trademark registrations
 - Examples of notices and video explanation on our webpage “Caution: Misleading notices”
- **Prosecution: Working with Department of Justice (DOJ) on criminal prosecutions**
 - 2017: Two men pled guilty to stealing \$1.66 million from U.S. trademark applicants and registrants; third man was convicted
 - 2018: We sent two attorneys to work with DOJ and USPIA on criminal investigations and possible prosecutions
 - 2019: We extended the USPTO’s attorneys’ work with DOJ/USPIA for another year



Efforts to enhance customer experience

- **Bringing the customer to the center of all we do**
 - Asked customers to sign up to provide feedback as we make CX improvements. Will continually build this customer list to gather perspectives across all customer segments
 - Incorporated customer experience briefings into new employee onboarding
- **Measure and track customer metrics, engagement, and insights**
 - Established the first-ever persistent, long-term survey to measure customer sentiment on application prosecution of office actions
 - Built partnership between customer experience and business intelligence teams to leverage both operational data and customer data sets. This will enrich the data we have and help us see measureable results of our customer experience efforts over time

Efforts to enhance customer experience

- **Make every customer touchpoint consistent, clear, and intuitive**
 - Added two website communication strategists and two plain language writers this year. With their specialized expertise, we are providing information that is easy to find, understand, and use
 - Operated a plain language working group whose membership includes writers and attorneys. Conducted business unit-wide training, developed policy, and are incorporating plain language principles into all of our customer-facing communications. This year, offered in-person plain language training to the entire workforce
- **Work together to amplify impact on customer experience efforts**
 - Drove a customer-centric culture beyond our business unit and across the USPTO. We provided customer experience briefings to OCIO and OCFO at all hands meetings
 - Established a strong relationship with the Patents customer experience office as it stood up this year. Collaborated to ensure that overlapping areas of customer experience infrastructure are aligned

Redesigned TM landing page

The screenshot displays the USPTO website's Trademark landing page. At the top, the USPTO logo and 'UNITED STATES PATENT AND TRADEMARK OFFICE' are on the left, and navigation links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO' are on the right. A search bar is positioned in the center of the top navigation. Below this is a secondary navigation bar with tabs for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', along with a 'Find It Fast' button. A yellow banner below the navigation provides information about logging into the Trademark Electronic Application System (TEAS) and TEAS International (TEASi) as of October 26, 2019. The main content area is organized into a 2x3 grid of topic cards, each with an icon and a list of links: 'Trademark basics' (TM icon), 'Search trademarks' (magnifying glass icon), 'Apply for a trademark' (ID Manual icon), 'Protect trademarks' (person icon), 'Maintain your registration' (refresh icon), and 'Laws and rules' (scales icon). At the bottom, a blue navigation bar contains icons for 'Search (TESS)', 'Select (ID Manual)', 'Forms (TEAS)', and 'Status (TSDR)'. Below this bar are three preview cards: 'Your new uspto.gov account', a photo of a woman using a smartphone, and a 'Sign in' form with fields for email address and a 'Remember my email address' checkbox.

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About Us Jobs Contact Us MyUSPTO

Search uspto.gov

Patents Trademarks IP Policy Learning and Resources Find It Fast

To access the Trademark Electronic Application System (TEAS) and TEAS International (TEASi), you need to log in to a USPTO.gov account with two-step authentication as of October 26, 2019. Learn more on the [Log in to TEAS and TEASi page](#).

TM
Trademark basics

- > Do I need a U.S.-licensed attorney?
- > Trademark fee information
- > Timeline to process an application
- > Free resources in your state

🔍
Search trademarks

- > Develop a search strategy
- > How to use the Trademark Electronic Search System (TESS)

📄
Apply for a trademark

- > How do I apply using the Trademark Electronic Application System (TEAS)?
- > Respond to an office action
- > Select goods & services in ID Manual

👤
Protect trademarks

- > Protect your trademark rights
- > I suspect a scam or misleading notice. What should I do?
- > Watch out for counterfeit goods

🔄
Maintain your registration

- > How do I renew my trademark?
- > What happens if my trademark registration is audited?

⚖️
Laws and rules

- > Mandatory electronic filing rule
- > U.S.-licensed attorney rule
- > Trademark Manual of Examination Procedure (TMEP)

Search (TESS) Select (ID Manual) Forms (TEAS) Status (TSDR)

Your new uspto.gov account

Sign in

Email address uspto employee?

Remember my email address

Continue



My.USPTO.gov

- Trademark docket
 - Share collections in dockets with other MyUSPTO users
- Trademark form finder widget
 - Widget identifies forms using plain language rather than current form names
 - Includes a search box to search the form names
- Next widget: Trademark Electronic Application System (TEAS) plus short form
 - Initial scope: intent-to-use (ITU) word marks, TEAS plus fee basis
 - Status: Testing ongoing using production data; release to the public Q1 FY 2020



TRADEMARK FORM FINDER

- > File an application
- > Respond to correspondence from the USPTO
- > Respond to a Notice of Allowance
- > Make changes to your application
- > File documents after your mark is registered to maintain or change your registration
- > Change an address
- > Change attorney or domestic representative information
- > File a late response
- > Respond to a Notice of Abandonment
- > File a petition
- > File forms related to the Madrid Protocol
- > File an appeal, opposition, or cancellation with the TTAB
- > Record an assignment for ownership transfers or changes in name, entity type, or citizenship

[All trademark forms](#)



Apple



Google

USPTO TM Status App

- Available on Apple App Store and Google Play
- Search application and registration numbers
- Notifications of selected status changes
- Reflects updated status changes within minutes
- Share, bookmark, or create notebooks for saving information
- No account necessary



International

TM5

- Comprised of the 5 largest trademark offices:
 - China National Intellectual Property Administration (CNIPA)
 - European Union Intellectual Property Office (EUIPO)
 - Japan Patent Office (JPO)
 - Korean Intellectual Property Office (KIPO)
 - USPTO
- Focuses on exchange of information and collaboration and harmonization projects regarding trademark matters to benefit users
- Projects include, among others:
 - Combatting bad faith filings
 - Common status descriptors
 - ID list
 - Non-traditional marks
 - Image searching
 - Anti-counterfeiting
 - Misleading (fraudulent) solicitations



IP attachés around the world



Feedback

- We want to hear from you!
- Email TMFeedback@uspto.gov for general suggestions
- Other Trademarks contact information can be found on our website at:
 - uspto.gov/trademark/contact-trademarks/other-trademark-contact-information



Thank you!

Mary Boney Denison

Commissioner for
Trademarks

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www.uspto.gov

Office of Policy and International Affairs update

Shira Perlmutter

November 1, 2019

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Updates

- Presidential memorandum on combatting trafficking in counterfeit and pirated goods
 - Interagency Report submitted to White House on October 30
 - 89 comments received in response to Federal Register Notice
- Developments in China on bad faith applications
 - New trademark law, Nov. 1, 2019
 - New final measures, Dec. 1, 2019
- World Intellectual Property Organization (WIPO)
 - Standing Committee on Trademarks, Industrial Designs and Geographical Indications (SCT)

Trademark Public Advisory Committee Quarterly Meeting

Legislative/Governmental Affairs Update

Branden Ritchie

Kim Alton

Office of Government Affairs and Oversight

October 31, 2019

UNITED STATES
PATENT AND TRADEMARK OFFICE



The 116th Congress



- USPTO-related hearings
 - Senate Judiciary Committee's Subcommittee on Intellectual Property, "Promoting the Useful Arts: How can Congress prevent the issuance of poor quality patents?" (October 30, 2019)

Legislative activity

116th Congress

Hot issues in Congress related to trademarks

- Trademark filings with inaccurate / fraudulent use claims
 - Roundtable on October 22, 2019
 - Draft legislation
- Irreparable harm
- Anti-counterfeiting efforts by the U.S. government
- Trademark Licensing Protection Act of 2019 (S. 2439/H.R. 4164) (Franchisor / franchisee relationship)
- FLAG Act
- *Brunetti* update

USPTO is aggressively monitoring these efforts



Legislative activity

116th Congress

Federal Budget FY2020: Operating under a Continuing Resolution (CR) until November 21 for FY2020 (P.L. 116-37)

- Appropriations bills provide \$3.45 billion for the Patent and Trademark Office (H.R. 3055/S. 2584)
- CR currently provides FY2019 levels

USPTO's legislative priorities

- Trademark legislative package
- Continuity of service issues
- IP attachés



THANK YOU



Branden Ritchie

Director

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USPTO budget update

Sean Mildrew

November 1, 2019

UNITED STATES
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Agenda

- FY 2019 summary
- FY 2020 status
- FY 2021 budget
- Fee setting

FY 2019 summary

- USPTO collected \$343.9M in Trademark fees in FY 2019
- Fee collections are \$4.1M in excess of the FY 2019 spending authority. The fees have been deposited in the Patent and Trademark Fee Reserve Fund (PTFRF)

	Trademarks
Total USPTO Fee Collections	\$345,219,285
<i>Actual Fee Collections</i>	\$343,901,439
<i>Adjustment to Revenue (Year-End Timing Differences)</i>	1,317,846
Appropriated Fee Level (Spending Authority)	\$341,150,475
Resources in Excess of Current Spending Authority (PTFRF)	\$4,068,810

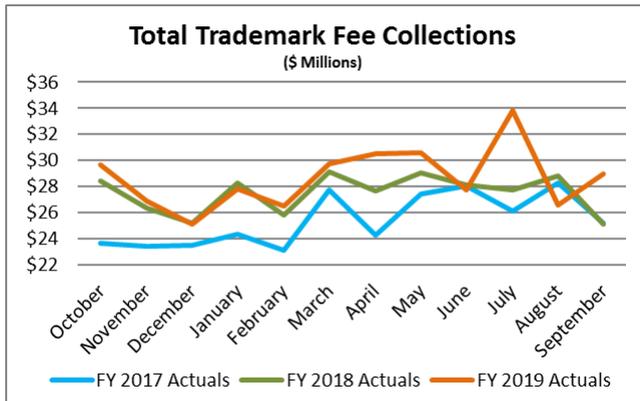
FY 2019 summary, cont.

- Based on the appropriated fee level, FY 2019 ended the year with a \$126.6M Trademark operating reserve level

	Trademarks
Appropriated Fee Level (Spending Authority)	\$341,150,475
Actual Prior Year Operating Reserve	135,295,784
Actual Other Income	4,829,924
OIG Transfer	-149,104
<i>Total End-of-Year Available Income</i>	<i>481,127,079</i>
<i>Total End-of-Year Spending</i>	<i>354,517,994</i>
EOY Operating Reserve	126,609,085
<i>Resources in Excess of Current Spending Authority (PTFRF)</i>	<i>4,068,810</i>
EOY Operating Reserve including funds deposited in the PTFRF	\$130,677,895

FY 2019 summary: fees

- Trademark fee collections were
 - 0.8% above the FY 2019 appropriated level of \$341.1M
 - 1.0%, or \$3.3M, above the FY 2019 planned collection amount of \$340.6M
 - 4.5% greater than total collections in FY 2018



Trademark fee levels *(dollars in thousands)*

FY 2019				
Appropriated Level (October 2018)	Planned Collections (Updated June 2019)	Actual Collections (September 30, 2019)	Increase of Actuals over Appropriated	Increase of Actuals over Plan
\$341,150	\$340,635	\$343,901	0.8%	1.0%

Total Trademarks collections *(dollars in thousands)*

FY 2017	FY 2018		FY 2019	
Actual	Actual	Increase	Actual	Increase
\$305,033	\$328,976	7.9%	\$343,902	4.5%



FY 2020 status

- The current Continuing Resolution (CR) is through November 21, 2019
 - The USPTO is held to an adjusted spending level calculated off of \$3.37B (plus carryover and other income)

FY 2021 budget

- USPTO submitted its FY 2021 OMB Budget on September 9, 2019
- The FY 2021 President's Budget will be released and available to the public in February 2020
 - TPAC will receive a draft copy of the budget to review in advance of the submission

Fee setting

- The comment period on the proposed Trademark fee proposals closed on September 30, 2019
- USPTO will begin the process of drafting a notice of proposed rulemaking (NPRM) to set and adjust trademark-related fees with the benefit of the TPAC Fee Setting Report
- The Agency expects to have the NPRM published in the Federal Register for public comments in spring 2020



Thank you!

Sean Mildrew

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www.uspto.gov

Trademark Trial and Appeal Board Update – FY2019 Report

TTAB Chief Judge Gerard Rogers
November 1, 2019

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FY 2019 TTAB incoming filings	FY 2018 EOY results	FY 2019 actual, target or projected	FY 2019 EOY results	Variance
TYPE OF FILING				
Notices of Appeal	3,223		3,333	+3.4%
Extensions of Time to Oppose	19,208		20,502	+6.7%
Notices of Opposition	6,496		6,955	+7.1%
Petitions to Cancel	2,253		2,426	+7.7%

Trends in new filings

Type of filing	FY16 (% +/- FY15)	FY17 (% +/- FY16)	FY18 (% +/- FY17)	By Quarters in FY19	FY19 (% +/- FY18)
Appeals	3,121 (+4.3%)	3,158 (+1.2%)	3,223 (+2%)	866; 747; 871; 849	3,333 (+3.4%)
Extensions of time to oppose	19,055 (+11.2%)	18,490 (-3%)	19,208 (+3.9%)	4,672; 4,673; 5,564; 5,593	20,502 (+6.7%)
Oppositions	5,881 (+11.2%)	6,156 (+4.7%)	6,496 (+5.5%)	1,599; 1,632; 1,780; 1,944	6,955 (+7.1%)
Cancellations	1,848 (+4.8%)	2,101 (+13.7%)	2,253 (+7.2%)	565; 599; 609; 653	2,426 (+7.7%)

Cumulative 3 year increases

- Ex Parte Appeals Up 6.8%
- Extensions to Oppose Up 7.6%
- Oppositions Up 18.3%
- Petitions to Cancel Up 31.3%

Trends – cases ready for decision

Final decisions on merits appeals and trial cases	FY16 (% +/- FY15)	FY17 (% +/- FY16)	FY18 (% +/- FY17)	By Quarters in FY19	FY19 (% +/- FY18)
Maturing to RFD (ready for decision) (appeals/trials)	687 (+11.3%) (529/158)	679 (-1.2 %) (517/162)	650 (-4.3%) (473/177)	191; 185; 201; 167 (128/63); (126/59); (132/69); (128/39)	744 (+14.5%) (514/230) (8.7%/29.9%)
Awaiting decision at end of period (appeals/trials)	83 (-25.9%) (56/27)	93 (+12%) (65/28)	130 (+39.8%) (74/56)	197; 213; 267; 206 (131/66); (129/84); (158/109); (123/83)	206 (+58.5%) (123/83)

A trial case heavy docket

- Appeals maturing to RFD Up 8.7%
- Trials maturing to RFD Up 29.9%
- Appeals decided Up 1.6%
- Trials decided Up 41%
- Inventory split (123/83) 40.3 trials%

FY 2019 TTAB performance measures	FY 2018 EOY results	FY 2019 Actual, Target or Projected	FY 2019 EOY results	Variance
<p>PENDENCY – Contested motions</p> <p>(1) Measured from ready-for decision until mailing; average of orders on contested motions, excluding precedents, issued during reporting period</p> <p>(2) Age of single oldest contested motion ready for decision at end of reporting period</p>	<p>9.4 weeks</p> <p>11.9 weeks</p>	<p>(targets)</p> <p>8-9 weeks (avg.)</p> <p>12 weeks or less</p>	<p>11.5 weeks</p> <p>20.1 weeks</p>	<p>above target</p> <p>above goal</p>
<p>INVENTORY – Contested motions ready for decision</p> <p>The number of cases with contested motions in which briefing was completed, becoming ready for decision, as of the end of the reporting period</p>	<p>165</p>	<p>Cases with motions 150-190 (target)</p>	<p>242</p>	<p>above target range</p>

FY 2019 TTAB performance measures	FY 2018 EOY results	FY 2019 actual, target or projected	FY 2019 EOY results	Variance
<p>PENDENCY – Final decisions (cancellations, oppositions, ex parte appeals) Measured from ready for decision date until mailing for final decisions, excluding precedents, in appeals and trial cases during reporting period</p>	8.6 weeks	10-12 weeks (target)	13.4 weeks	above target range
<p>INVENTORY – Cases ready for final decision The number of pending appeals and trial cases in which briefing was completed, or in which briefing and arguments were completed, thus becoming ready for decision on the merits, as of the end of the reporting period</p>	Ex parte appeals 74 Oppositions 33 Cancellations 21 Concurrent Use 2 <u>Total:</u> 130	Total case inventory 130-170 (target)	Ex parte appeals 123 Oppositions 57 Cancellations 24 Concurrent Use 2 <u>Total:</u> 206	above target range

Trends – Time to decision

Final decisions on merits appeals and trial cases	FY16 (% +/- FY15)	FY17 (% +/- FY16)	FY18 (% +/- FY17)	FY19 (% +/- FY18)
Average Pendency of Appeals, RFD to mailing (excluding precedents, possible precedents)	8.8 weeks (-5.4%)	7.0 weeks (-20.5%)	8.3 weeks (+18.6%)	12.7 weeks (+53%)
Average Pendency of Trials, RFD to mailing (excluding precedents, possible precedents)	10.8 weeks (-3.6%)	10.4 weeks (-3.7%)	9.5 weeks (-8.7%)	15.3 weeks (+61%)

FY 2019 TTAB performance measures	FY 2018 EOY results	FY 2019 actual, target or projected	FY 2019 EOY results	Variance
<p>TOTAL PENDENCY Average total pendency, commencement to completion, excluding precedents</p> <p>Appeals (441 decided FY18; 448 in FY19 - flat)</p> <p>Trial cases (144 decided FY18; 203 in FY19 +41%)</p> <p>ACR trial cases (19 decided FY18; 27 decided in FY19)</p>	<p>35.8 weeks</p> <p>140.3 weeks</p> <p>106.3 weeks</p>		<p>40.5 weeks</p> <p>160.6 weeks</p> <p>126.2 weeks</p>	<p>+13.1%</p> <p>+14.5%</p> <p>+18.7%</p>

FY 2019 TTAB staffing	FY 2018 EOY results	FY 2019 actual, target or projected	As of October 1, 2019	Variance
JUDGES and ATTORNEYS				
Administrative Trademark Judges	22	(actuals) 24	23	Increases planned
Interlocutory Attorneys	17/1	14/2	14/1	

Help is on the Way

- Brought on Deputy Chief Judge in June 2019
- Judges to be hired in Q1 and perhaps again in FY2020
- Interlocutory Attorneys to be hired
- Trademark Examining Attorney on work project
- Trademark Examining Attorney IA detail resumed
- P/T law student intern; F/T law student extern
- Investigating law clerks

Possible goals for FY2020

- Two ATJ goals for finals: 10-12 weeks for appeals; 12-15 weeks for trials
- Two Attorney goals for motions: 8-10 weeks for non-dispositive; 10-12 weeks for dispositive
- Age of motions at end of each quarter: no non-dispositive older than 12 weeks; no dispositive older than 15 weeks

Accomplishments

- ATJs issued 11.3% more final decisions in FY2019
- Inventory of cases RFD down 25% from May
- Five new Interlocutory Attorneys for FY2019 ramping up production
- Issued 38 precedential decisions/orders
- Revised TBMP on schedule



Continuing interest in ACR

- Speed can be realized (though it is not a given)
- Imagine efficiencies ... and agree to them!
- Mutual informal exchanges of documents
- Limitations on discovery
- Broader use of Notices of Reliance
- Summary judgment-style trial
- Stipulations re: facts and authenticity of evidence
- Remember your burden(s) of proof

Another Notable Trend

- Default rates are high in cancellation cases and growing
- 44% in all cancellation cases
- 49% when the case includes abandonment or nonuse claim
- 55% for cases with only nonuse claims
- 60% for cases with only abandonment claims

Cancellation pilot program

- Uncontroversial cases result in default or early settlement.
- For cases involving asserted claims of ongoing use, petitioner wants to investigate or question the claimed use via discovery.
- Discovery is almost always desired when primary issue is excusable nonuse/intent to resume use.
- Pilot to continue through Q1 or Q2.

Input - Standard Protective Order

- Comment period closed June 30, 2019
- Comments mixed on in-house access to AEO material and tiers of confidentiality
- No changes on these major issues.

SPO potential changes

- Entering SPO in record/case history
- Access issues; pro se parties
- Address ambiguity in Sections 3, 5 re: disclosure to experts/consultants
- Presumptive protection for documents made available for inspection

Trademark IT update to TPAC

Rob Harris

Trademark portfolio manager

November 1, 2019

UNITED STATES
PATENT AND TRADEMARK OFFICE



Activity since last TPAC

- U.S. Counsel rule changes became effective August 3
- TEAS login capability was implemented October 26
- Number of Trademark Electronic Application System (TEAS) Plus Short Form Beta testers and submissions has increased
- System updates to support Mandatory Electronic Filing (MEF) changes are in progress (effective December 21)

Activity since last TPAC

- Artificial intelligence solutions for specimen search and image search capabilities are being tested
- Stabilization of trademark and TTAB systems continue including improvements to the Trademark Status and Document Retrieval (TSDR) system
- All trademark and TTAB systems were upgraded to be compatible with Win10; new laptops were deployed to all Trademark and TTAB employees
- Started three Trademark Agile Pilot teams focused on refining the team structure and processes to be used for future efforts

Priorities for Future Success



1. Stabilization

- Reduce risk of future system outages in infrastructure and legacy systems
- 25 systems and applications initially targeted based on risk and business criticality
- Systems Integrator (SI) vendor to upgrade 15 systems; in-house teams will upgrade remaining 10



2. Modernization

- Improve agility, performance, and stability of Patent and Trademark systems
- Develop and integrate a portfolio of new features to address business needs and increased demand
- Drive savings and speed to market through data management, automation and artificial intelligence



3. Governance

- Optimize speed, quality and cost-effectiveness of IT delivery through operating model refinements
- Launch Agile at a large scale, starting with small pilot teams, eventually spanning across OCIO
- Redefine Software Development Life Cycle (SDLC), planning and governance, and IT acquisition processes

