The Trademark office

David Gooder
Commissioner for Trademarks
Trademarks updates

- TM Business operations metrics
- TM Business financial performance
- Fee Rule
- Protecting the Integrity of the Trademark Register
- Helping our customers
- Protecting our customers
- New initiatives
TM business operations metrics
Trademarks organization staffing

940 Trademarks employees (7% of USPTO)
623 examining attorneys (67% of Trademarks)
100% of employees have the option to telework during the pandemic
76% of all cases: Filed by applicant with less than 10 applications all-time
Trademark monthly filings vs. S&P 500 monthly average closing price
Trademark application filing levels

FY 2020 projected:
625,000 classes
projected
(7% decrease)

FY 2020 actual:
738,112 classes
approx.
(9.5% increase)
FY20 daily trademark application filings

Actuals compared to revised plan (625,000 classes)
TM Filings - story of two halves

1st-half: first sustained negative growth
2nd-half: unprecedented growth
FY20 Year-Over-Year: monthly growth

FY 2020

October  November  December  January  February  March  April  May  June  July  August  September

3%  -5%  0%  -2%  -2%  -8%  -7%  -1%  3%  30%  64%
Who drove the growth in FY20?

Filers with less than 10 applications all-time; Use and ITU; Individuals; USA and China
FY 2020 USPTO Application Filings from the US, China, and the Rest of the World
# Trademarks performance: pendency

<table>
<thead>
<tr>
<th>FY 2020 Trademarks performance measures</th>
<th>FY 2020 targets</th>
<th>FY2020 results</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>First action pendency</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td>First action pendency from date of filing to the first office action in months</td>
<td>2.5-3.5</td>
<td>3.0</td>
</tr>
<tr>
<td><strong>Disposal pendency</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Disposal pendency from date of filing to issuance of a notice of allowance, registration, or abandonment — excluding suspended and inter partes proceedings</td>
<td>12.0</td>
<td>9.5</td>
</tr>
</tbody>
</table>
FY20 First action pendency vs. 10-year average

![Line chart showing the first action pendency of FY20 compared to the 10-year average. The chart displays the pendency rates for each month from September to September.]
## Trademarks performance: quality

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<th>FY 2020 Trademarks performance measures</th>
<th>FY 2020 targets</th>
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<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 USPTO raises issues and/or refuses marks for registration based on the first office action</td>
<td>95.5%</td>
<td>95.7%</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 USPTO raises issues and/or refuses marks for registration based on the examining attorney’s approval or denial of the application</td>
<td>97.0%</td>
<td>98.1%</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>50.0%</td>
<td>51.0%</td>
</tr>
</tbody>
</table>
Trademarks fee rule
Fee rulemaking

Two-year process:

• TPAC public hearing on September 23, 2019
• Notice of Proposed Rulemaking published in the Federal Register on June 19, 2020
• Comment period ended on August 3, 2020

Notice is posted at uspto.gov at:
Fee rulemaking

Going forward:

• Reviewing comments and considering the economy
  o Adjusting where needed/appropriate
• Internal, DOC and OMB clearance
• Final publication
• Timeframe
Protecting the integrity of the U.S. trademark register
Protecting the Integrity of the TM register

- Recall that use in interstate U.S. commerce is required
  - To obtain and/or maintain U.S. registration
- To protect the integrity of the register
  - Ensure actual use in commerce is proven
    - In filings and renewals
  - Otherwise, register becomes cluttered with “dead wood”
- Three pronged approach
  1. Use of proper specimens
  2. Proof of Use Audit program
  3. U.S. Counsel rule
Protecting the TM register: Specimens

➢ Ensure legally acceptable specimens being used
  • Some applicants trying to submit computer generated, digitally altered and fake specimens
    o Examiners trained to spot and refuse them
    o AI-aided tool in development (ASAP)
  • Examination policy/procedure being revised
    o To protect good faith filers
    o Launching this month

➢ Reporting fake specimens
  • Email us: TMSpecimenProtest@uspto.gov
  • Letters of Protest
Protecting the TM register: Proof of Use Audit program

Why the need?

Overall program stats (Nov 2017–Sept 2020):

- 12,740 first actions issued by examiners on project
- 9,219 responses received
- 4,759 responses deleted goods/services/classes in response to audit
- 987 registrations that have been audited have since been cancelled
Proof of Use Audit program

Deletions in registrations where either a response was filed deleting goods or services or the registration was cancelled (Nov 2017–Sept 2020):

<table>
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<tr>
<th>FILING BASIS</th>
<th>PERCENT OF REGS W/ DELETED GOODS OR SERVICES</th>
</tr>
</thead>
<tbody>
<tr>
<td>1(a)</td>
<td>52%</td>
</tr>
<tr>
<td>1(a) and 44(e)</td>
<td>68%</td>
</tr>
<tr>
<td>44(e)</td>
<td>69%</td>
</tr>
<tr>
<td>66(a)</td>
<td>70%</td>
</tr>
</tbody>
</table>
Protecting the TM register: U.S. Counsel Rule

- Non-U.S. applicants must use a U.S.-licensed attorney
  - To file documents with the USPTO

- Results:
  - Specimen refusals have decreased
  - TM owners report having to oppose fewer applications
Impact of U.S. Counsel rule on digitally altered specimens
Protecting the TM register: U.S. Counsel Rule

However, circumvention schemes are on the rise

- Unauthorized use of attorney information
- Improper signatures/use of credentials
- Mail drops and false domiciles
- False applicants
- Unauthorized changes of correspondence information
Combatting the circumvention schemes

• **PTO initiatives and tools**
  - Developing policies, procedures, and technology solutions
  - Special task force
  - Show cause orders
  - Mandatory log in

• **User tools**
  - MyUSPTO account
  - USPTO app
User tools to monitor application and registration activity

- Tools enable users to search for trademark applications and registrations and monitor activity
- Choose from a variety of status change alerts
- Available in the Apple App Store and Google Play

- **MyUSPTO**
  - Set up an account and log in
  - Provides updates on status changes every 24 hours

- **USPTO app**
  - Does not require a USPTO account
  - Provides updates on status changes in 15 mins or less
Helping our Customers
COVID-19 Stakeholder relief: Fee waivers & extensions

• Petition fee waivers and refunds
  o if the abandonment or cancellation occurred before June 30, 2020, and was a result of the COVID-19 outbreak
    ▪ refunded the $100 Petition to Revive fee in 163 applications
    ▪ refunded or waived the $100 Petition to the Director fee requesting relief under the CARES Act in 272 petitions

• Deadline extensions
  o Pursuant to authority granted under the CARES Act
    ▪ for filings with due dates between March 27, 2020 and May 30, 2020, statutory deadlines were automatically extended until June 1, 2020
  o Petitions to accept a late filing for deadlines after June 1 are being considered on a case-by-case basis
    ▪ 369 petitions received to date
    ▪ Most are for acceptance of a Section 8 or 71 affidavit after the statutory deadline
COVID-19 Stakeholder relief: Priority examination

- On June 15, the USPTO announced a program to advance the initial examination of applications for marks used to identify qualifying COVID-19 medical products and services
  - USPTO will waive petition fee
  - To date, we have received 191 petitions
    - 92 granted, 12 pending
    - 65% published or approved for publication
  - Additional information and FAQs are on the USPTO website at: www.uspto.gov/trademark/laws-regulations/covid-19-petition-prioritize-applications
Protecting our Customers
Protecting customers: TM scams

• Scams proliferating
  o Just like other forms of TM piracy
• USPTO has limited enforcement authority, but...
TM Scams: USPTO actions

- Education and outreach
  - Webpage resources with listing of known solicitation scams
  - Warnings to filers in Office actions and at registration
  - Topic of discussion at events with bar groups and business owners
  - Dedicated mailbox to report solicitations to USPTO: TMScams@uspto.gov

- Interagency cooperation
  - (USPTO, DOJ, USPIS, and FTC)
Trademarks initiatives
New initiatives & guidance

- e-Registration certificate initiative
- Generic.tld Exam Guide
Trademarks Business FY21 Priorities
FY 2021 Priorities

• Keep our employees safe, supported, and engaged
• Ensure our performance continues to meet our pendency and quality objectives
• Drive the key FY21 initiatives that support our customers
  o CARES Act programs continue in effect
  o Fighting challenges to the integrity of the TM register
  o Stabilizing and modernizing public and private TM IT systems
• Ensure our trademark organization has
  o Optimum organizational structure; and
  o Adequate funding...

To achieve these priorities and meet our longer term strategic objectives
Thank you!

David S. Gooder
Commissioner for Trademarks

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