Trademarks FY 2021 priorities
Trademarks FY 2021 priorities

- Attack the application surge
- Implement the TMA
- Boost TM register protection
- TM EVO 2021
- Intensify IT modernization
Trademarks filings surge 2021

Dan Vavonese
Deputy Commissioner for Trademark Operations
The surge of 2021

• How big a surge
• What’s causing it
• What’s the impact
• What are we doing about it
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

• 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

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

View Current Trademark processing wait times
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 face 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
• Docket number PTO-T-2021-0008
• Deadline for formal comments: July 19, 2021
Boosting register protection: investigation and sanction process

Amy Cotton
Deputy Commissioner for Trademark Policy
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
IT modernization

Greg Dodson
Deputy Commissioner for Trademark Administration
Trademark IT update

• “New Ways of Working”
  o Product teams firmly established and development efforts ongoing
  o “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
Trademark IT update

• “New Ways of Working”
  o “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