Trademark Examination Policy update

Amy Cotton
Deputy Commissioner for Trademark Examination Policy
Register protection journey

- Post-registration audit • 2017
- Special task force • 2019
- Account login • 2019
- Sanctions ordered • 2021
- ID verification • 2022

- Updating specimen guidance • 2019-2020
- U.S. counsel rule • 2019
- Post-registration deletion fee • 2021
- Trademark Modernization Act • 2021
Mandatory account login

- **2019**
  - Account required to access all electronic forms

- **2022**
  - Identity verification
  - User roles

- **2022-2023**
  - Role-based access controls

- Terminate accounts for violations of terms of use
ID verification is role-based

Trademark customers choose a role prior to verifying their identity

- **Attorneys** and **owners** verify their identity with one of the ID verification options
- **Attorney support staff** are verified by their sponsoring attorney

**Trademark roles**

- Trademark owner
- U.S.-licensed attorney
- Canadian attorney or agent
- Attorney support staff
Petition-initiated proceedings

- $400 per class
- Uspto.gov account
- Petitioner’s name, domicile address, email address
- Verified statement
- Documentary evidence of nonuse
U.S. counsel rule

Foreign domiciliary must be represented by U.S.-licensed attorney

Domicile address required

Unacceptable addresses
- Automated queries for P.O. boxes and commercial mail-receiving agencies

Attorney misconduct
- Special Task Force investigations
- Referral to Office of Enrollment and Discipline
Holding attorneys accountable

- Office of Enrollment and Discipline settlement agreements
  - Yiheng Lou
    - NY-licensed attorney contracted with Chinese IP firm (5/12/2021)
  - Devasena Reddy
    - CA-licensed attorney contracted with Indian TM filing firm (9/9/2021)
  - Bennet David
    - Patent attorney and MA-licensed attorney contracted with Chinese IP firm (9/24/2021)
  - Di Li
    - CA-licensed attorney contracted with Chinese firm that consults with online retailers (10/7/2021)
  - Tony Hom
    - NY-licensed attorney contracted with several different Chinese firms (12/17/2021)
  - Elizabeth Yang
    - CA-licensed attorney contracted with Chinese firm serving online retailers (12/17/2021)
  - https://foiadocuments.uspto.gov/oed/
Administrative sanctions process

1. Special Task Force investigation
2. Show cause order
3. Party’s response
4. Order for sanctions
5. Imposing sanctions
Sanctions

- Striking submission
- Terminating the proceeding
- Precluding parties from submitting documents
- Referring practitioners to the Office of Enrollment and Discipline
- Blocking uspto.gov accounts
## Recent administrative orders

<table>
<thead>
<tr>
<th>Type of order</th>
<th>Proceeding name</th>
<th>Serial number(s)</th>
<th>Date</th>
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<tr>
<td>Sanctions</td>
<td>In re Abtach Ltd., 360 Marketing LLC, and Retrocube LLC</td>
<td>PDF</td>
<td>1/25/2022</td>
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<td>5/6/2021</td>
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</tbody>
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- **5500 applications and registrations**
- **15,000 applications and registrations**
Trademark Modernization Act

- **Letter of protest**
  - Codifies existing practice
  - $50 fee

- **Flexible response period**
  - Shorten response periods to 3 months with one extension to full six months

- **Nonuse cancellation**
  - Expungement
  - Reexamination

- **Clear deadwood and move applications through more quickly**
TMA implementation timeline

- **TMA signed into law**
  - December 2020

- **Notice of proposed rulemaking published**
  - May 18, 2021

- **Public comment period closed**
  - July 19, 2021

- **Nonuse cancellation tools implemented**
  - December 18, 2021

- **USPTO public roundtable**
  - March 1, 2021

- **USPTO public roundtables**
  - July 1 and 14, 2021

- **Final rule issued**
  - November 17, 2021

- **Flexible response periods implemented**
  - December 1, 2022
Thank you!

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