TM Examination Policy Updates

Amy Cotton
November 2-4, 2022
Caution: Scam alert

• Don't be fooled by offers and notices from private companies; some are scams

• To confirm whether the notice is legitimate, call or email the Trademark Assistance Center

• For more information, check out our webpages:
  – Caution: Scam alert
  – Ten things you can do to protect your trademark application or registration
Amy P Cotton, Deputy Commissioner for Trademark Examination Policy

Update on TMA nonuse cancellation
Nonuse cancellation options

- Nonuse cancellation options to remove blocking registrations

- Maintenance filings
  - Wait and see

- TTAB petition to cancel
  - Nonuse
  - Abandonment
  - Expungement
  - Fraud

- TMA petitions to the Director
  - Expungement
  - Reexamination
Nonuse cancellation

- Trademark Modernization Act (TMA) proceedings before the Director

- 181 petitions received
- 96 expungement
- 85 reexamination
- 34 thirty-day letters
- 81 notices of institution
- 42 notices of non-institution
- 12 Director-initiated proceedings
- 31 Terminations

Expungement and reexamination petitions received

The Trademark Modernization Act created two new mechanisms, ex parte expungement and reexamination proceedings, to challenge registrations for nonuse. On December 21, 2021, the United States Patent and Trademark Office (USPTO) received the first petition for expungement. Below are the registrations in which either a petition for expungement or reexamination was submitted.

<table>
<thead>
<tr>
<th>Registration number</th>
<th>Trademark</th>
<th>Type of petition</th>
<th>Filing date</th>
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</thead>
<tbody>
<tr>
<td>5310589</td>
<td>RFIVER &amp; Design</td>
<td>Reexamination</td>
<td>10/16/2022</td>
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<tr>
<td>5813982</td>
<td>ALL GOOD THINGS</td>
<td>Reexamination</td>
<td>10/14/2022</td>
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<td>5937786</td>
<td>FALDAI</td>
<td>Reexamination</td>
<td>10/12/2022</td>
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<td>6146776</td>
<td>CAPSULE LETTERS</td>
<td>Reexamination</td>
<td>10/12/2022</td>
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<td>2697642</td>
<td>THE ST. JAMES'S CLUB</td>
<td>Expungement</td>
<td>10/11/2022</td>
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<td>1080718</td>
<td>WILLIAMSBURG</td>
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<td>682566</td>
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<td>Expungement</td>
<td>10/5/2022</td>
</tr>
</tbody>
</table>
Petitioners

• Trademark Modernization Act (TMA) petition before the Director
• Institution determination

Do this!

• Provide an index of evidence
• Provide domicile address; petitioner may be a law firm whereby the law firm address is the domicile
• Provide more than one bad specimen as evidence, so that we can institute on the whole class/registration
• Provide evidence of specimen farms or multiple suspicious assignments of registrations by the same attorney
• Provide relevant industry specific search evidence
• Provide relevant website screen shots if relying on website evidence, not just URL
• Label all exhibits as they appear in the Index and make sure the URL/date accessed is on the website evidence
• Pursue reexamination for 1(a); expungement is harder to establish

Not that!

• Don’t try to use these proceedings to narrow the registrant’s ID
• Don’t provide foreign language evidence without a translation
• Don’t provide testimony in petition without documentary evidence to substantiate it
• Don’t provide only hitlists of online sources
• Don’t challenge “hooded sweatshirts for babies, children” but then not challenge “hooded sweatshirts”
### Registrants do this, not that!

**Do this!**
- Provide proof of use, i.e., sales, but not di minimus sales
- Establish use in interstate commerce; transport is ok but needs to meet the case law definition

**Not that!**
- Don’t provide only the original specimens to prove use
- Don’t provide only invoices to show use
- Don’t provide foreign language evidence without a translation
- Don’t provide testimony in response without documentary evidence to substantiate it
- Don’t provide evidence of use dated after the petition was filed
Amy P Cotton, Deputy Commissioner for Trademark Examination Policy

Update on administrative sanctions program
Sanctions and account violations

- Administrative sanctions program

Possible sanctions:
- Terminating applications
- Suspending USPTO.gov account
- Precluding from appearing before the USPTO
Account agreement violations

• We are seeing violations of the TM verified account agreement by attorneys sponsoring foreign agents.

• This can result in:
  • Suspension of sponsored accounts
  • Referral of sponsoring attorney to Office of Enrollment and Discipline
  • Referral of attorney’s filings for administrative review by Register Protection Office

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Foreign filing firms improperly soliciting U.S.-licensed attorneys

Foreign individuals and companies are trying to scam the United States Patent and Trademark Office (USPTO) by improperly using U.S.-licensed attorneys’ names and bar credentials in trademark submissions or having U.S.-licensed attorneys sponsor USPTO.gov legal support staff accounts for people who are not the attorney’s support staff. Individuals or companies involved in these scams will either:

• Pay U.S.-licensed attorneys to use their name and bar registration details in trademark filings. The attorney has minimal, if any, participation in the application process.
• Pay U.S.-licensed attorneys to sponsor and verify legal support staff USPTO.gov accounts. The attorney does not employ or supervise the sponsored individual.
• Use U.S.-licensed attorney information without the U.S.-licensed attorney’s knowledge or permission. The attorney hasn’t authorized the use of their information.

Trademark filing firms engage in these scams to get around the USPTO’s requirement for foreign-domiciled filers to use a U.S.-licensed attorney and mandatory identity verification for USPTO.gov accounts.

Examples of foreign filing firms offering to pay U.S.-licensed attorneys

In both of the examples below, the U.S.-licensed attorney would have little to no involvement in the application process. This violates the USPTO’s rules, contributes to invalid filings, and harms the integrity of the trademark register.

Foreign law firm asking to use a U.S.-licensed attorney’s credentials