USPTO’s register protection program

Montia Pressey, Director for Trademark Register Protection
United States Patent and Trademark Office
Examination policy structure

Deputy Commissioner for Trademark Examination Policy

Legal Policy Office  Petitions  Register Protection  ID/Class  Quality Review and Training  Trademark Law Library  Trademark Assistance Center  Outreach  Customer Experience

Improve examination quality & support trademark operations  Improve quality of submissions & support stakeholders
Register Protection Office

Post-Registration Audit unit
Work project: attorney-advisors and paralegal professionals

Trademark Modernization Act (TMA) ex parte nonuse cancellation proceedings unit
Work project: attorney-advisors from the Legal Policy Office (LPO), Petitions Office, and Office of Trademark Quality Review and Training

Anti-scam unit
Work project: attorney-advisors from LPO, Electronic Filing & Public Web Services, and Trademark Operations
## Scam types

<table>
<thead>
<tr>
<th>Scam type 1</th>
<th>• Scammers mislead customers to pay inflated fees for fake or unnecessary services</th>
</tr>
</thead>
<tbody>
<tr>
<td>Scam type 2</td>
<td>• Scammers impersonate the USPTO</td>
</tr>
<tr>
<td>Scam type 3</td>
<td>• Scammers hijack applications and registrations</td>
</tr>
<tr>
<td>Scam type 4</td>
<td>• Scammers hijack or rent attorney credentials</td>
</tr>
</tbody>
</table>
Register protection program

**Internal tools**

- Administrative sanctions program
- Director-initiated expungement/reexamination
- Post-registration audit & maintenance filing deletion fee
- Scam awareness

**External tools**

- Petitions to cancel at the TTAB
- Petitions for expungement/reexamination
- Letters of protest
- Petitions to the Director
- TMscams@uspto.gov
Administrative sanctions program

Administrative review
- Used to evaluate rule violations such as signatures, certifications, representation, and domicile

USPTO.gov account
- Used to monitor user roles and other violations of the terms of use

Practitioner referral to OED
- Used to refer suspicious attorney filing behavior to Office of Enrollment and Discipline

Terminating applications or sanctioning registrations
- Suspending USPTO.gov accounts
- Attorney discipline including suspension
<table>
<thead>
<tr>
<th>Authorization Type</th>
<th>Authority Required</th>
</tr>
</thead>
<tbody>
<tr>
<td>Representation</td>
<td>Do you have authority to represent the applicant or registrant under 37 CFR §11.5?</td>
</tr>
<tr>
<td>Application or filing preparer</td>
<td>Do you have authority to prepare the filing under 37 CFR §11.5?</td>
</tr>
<tr>
<td>Authorized signatory</td>
<td>Do you have authority to sign a submission under 37 CFR §2.193? (Signatures non-delegable)</td>
</tr>
<tr>
<td>Validate, certify, and transmit</td>
<td>Can you make the necessary certifications under 37 CFR §11.18(b)?</td>
</tr>
<tr>
<td>US counsel rule - domicile</td>
<td>Did you provide an unacceptable domicile address to circumvent 37 CFR §2.11?</td>
</tr>
<tr>
<td>TM verified account agreement</td>
<td>Does your filing activity match your user role?</td>
</tr>
</tbody>
</table>
Verified account agreement

**Owner**
- A person who is an individual and the owner of the mark
- A person who can legally bind the owner to any obligation and/or agreement whatsoever, e.g., a corporate officer
- A person who is directly employed by a juristic entity owner*

**US-licensed attorney**
- An active member in good standing of the bar of the highest court of any U.S. state, commonwealth or territory, or the District of Columbia

**Canadian attorney or agent**
- A practitioner reciprocally recognized by the USPTO's Office of Enrollment and Discipline (OED) to represent persons located in Canada before the USPTO in trademark matters

**Attorney support staff**
- U.S.-licensed attorneys and Canadian attorneys/agents may sponsor individuals with USPTO.gov accounts in a support staff role
# Significant sanctions orders

<table>
<thead>
<tr>
<th>Name</th>
<th>Description</th>
<th>Details</th>
</tr>
</thead>
<tbody>
<tr>
<td>Jerome Eady</td>
<td>Show cause order – clone scheme</td>
<td>70 applications (1/17/2023)</td>
</tr>
<tr>
<td>ASIN</td>
<td>Show cause order – Unauthorized practice of law (UPL), signatures, specimens</td>
<td>426 applications; 4957 registrations (12/13/2023)</td>
</tr>
<tr>
<td>Sellergrowth</td>
<td>Show cause order – UPL, signatures, specimens</td>
<td>61 applications and 13,009 registrations (9/7/2022)</td>
</tr>
<tr>
<td>Haiyi</td>
<td>Show cause order – UPL, signatures, specimens</td>
<td>1299 applications and 950 registrations (8/25/22)</td>
</tr>
<tr>
<td>Abtach</td>
<td>Final order for sanctions – UPL, signatures, specimens</td>
<td>5458 applications and 70 registrations (11/3/21)</td>
</tr>
<tr>
<td>Huanyee</td>
<td>Final order for sanctions – UPL, signatures, specimens</td>
<td>12,565 applications and 3227 registrations (6/8/21)</td>
</tr>
<tr>
<td>Xue Chaoxing</td>
<td>Final order for sanctions – clone scheme</td>
<td>11 applications (5/6/21)</td>
</tr>
</tbody>
</table>
Sanctions takeaways

• By the numbers:
  – 154 orders for sanctions terminating nearly 19,000 invalidly filed applications and sanctioning 3,500 invalid registrations
  – 5 USPTO.gov account suspensions
  – 34 individuals referred to OED for investigation and possible discipline
  – 12 settlement agreements with attorneys regarding violations of the USPTO’s Rules of Professional Conduct related to the US counsel rule
Decisions and proceedings tool

TM decisions - Expungements (uspto.gov)
Nonuse cancellation: Expungement and reexamination

**Third party petitions – proceedings before the Director**

- Third party petition requesting either expungement (never been used) or reexamination (no use by relevant date)
- Must include nonuse evidence establishing prima facie case
- $400 per class
  - “anonymous”

**Director-initiated proceedings**

- Director can institute proceedings for expungement or reexamination based on her own initiative without a petition
- Must present nonuse evidence establishing a prima facie case

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Challenged goods or services cancelled if registrant does not establish use or excusable nonuse (44/66 only)
### TMA petition numbers

<table>
<thead>
<tr>
<th>Type of proceeding</th>
<th>Petitions Filed</th>
<th>Instituted proceedings</th>
<th>Non-Institutions</th>
<th>Terminated Proceedings</th>
<th>No Cancellation</th>
<th>Cancellation</th>
<th># goods or services cancelled</th>
</tr>
</thead>
<tbody>
<tr>
<td>Expungement</td>
<td>146 54 YTD</td>
<td>65</td>
<td>42</td>
<td>47</td>
<td>2</td>
<td>45</td>
<td>397 out of 414</td>
</tr>
<tr>
<td>Reexamination</td>
<td>141 67 YTD</td>
<td>67</td>
<td>37</td>
<td>38</td>
<td>6</td>
<td>32</td>
<td>470 out of 492</td>
</tr>
<tr>
<td>Total</td>
<td>287 121 YTD</td>
<td>132</td>
<td>79</td>
<td>85</td>
<td>8</td>
<td>77</td>
<td>867 out of 906 challenged</td>
</tr>
</tbody>
</table>

December 2021 – April 17, 2023
TMA takeaways

• By the numbers:
  – 47 Director initiated proceedings
    • Cancelled 370 goods or services out of 370 challenged
  – 287 total petitions filed; 127 institutions + 79 non-institutions + 85 terminated proceedings
    • Cancelled 867 goods or services out of 906 challenged
Post-registration audit & deletion fee

Post-registration Audit
- 5000 registrations audited per year
- Examiner queries 2 additional goods or services and requests proof of use
- Registrant must provide proof of use to avoid deletion

Maintenance filing deletion fee
- Any time registrant is required by the audit examiners to provide proof of use or by the Post-Registration examiners to provide specimens of use and cannot, registrant must pay a $250 per deletion fee

Failure to pay deletion fee results in cancellation of the entire registration.
Downward trend in deletion rates in use-based registrations

Audit deletion rates by filing basis

$250 deletion fee implemented
Will fluctuate upward slightly as responses come in

Use
Madrid 66a
Paris 44

2019 2020 2021 2022

1727 1686 1505 1212
443 499 424 364
272 186 185 134
0 400 600 800 1000 1200 1400 1600 1800 2000
Audit takeaways

• By the numbers:
  – Downward trend in Section 1(a) deletion rates following 2021 deletion fee
    • But 44/66 stubbornly consistent
  – More Section 8 and 71 declarations filed with narrowed identifications of goods and services, resulting in a smaller pool of registrations eligible for audit
Scam awareness

Communications

Using webpage resources, TMAlerts, and social media posts to alert customers and protect against scams

Visit Protect against scams webpage at www.uspto.gov/trademarks/protect

Visit our subscription center at www.uspto.gov/subscribe to subscribe to TMAlerts

Trademark Alert

To protect the trademark community against fraud, starts mandatory ID verification August 6

Protect against scams

Prevent scams
- 10 things you can do
- Understanding filing firms
- Common scams
- USPTO register integrity
- U.S. Customs and Border Protection services

Response to scams
- What to do if scammed
- Administrative sanctions process
- Suspended application
- Orders issued by the Commissioner for Trademarks

Latest scams
- Spoofer phone numbers
- Foreign filing firms improperly soliciting U.S.-licensed attorneys
- Applications terminated because of Abtech Ltd.
- Criminal conviction in trademark solicitation scam

- TERMINATE
- VIDEO
- Protect yourself against trademark fraud
- USPTO's comprehensive strategy to fight trademark fraud
- USPTO fights trademark scams

Beware: Scammers have recently begun impersonating USPTO employees by using real employee names and spoofing USPTO phone numbers. Learn more about this scam and what to do if you get a call: bit.ly/3Y6nVPQ
Some external tools

Letters of Protest
Evidence of nonuse, digitally altered specimen, or “improper submission” that is relevant to a refusal will be forwarded to an examining attorney for consideration
264 LOPs filed with this type of evidence through Q2FY23 (156 considered; 108 not considered)

Petitions to the Director
Used to draw our attention to suspicious or unauthorized filings
18 petitions raising unauthorized filings filed through Q2FY23

TMScams@uspto.gov
Used to monitor reports of new scams
425 emails received through Q2FY23