Examination Policy updates

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Deputy Commissioner for Trademark Examination Policy

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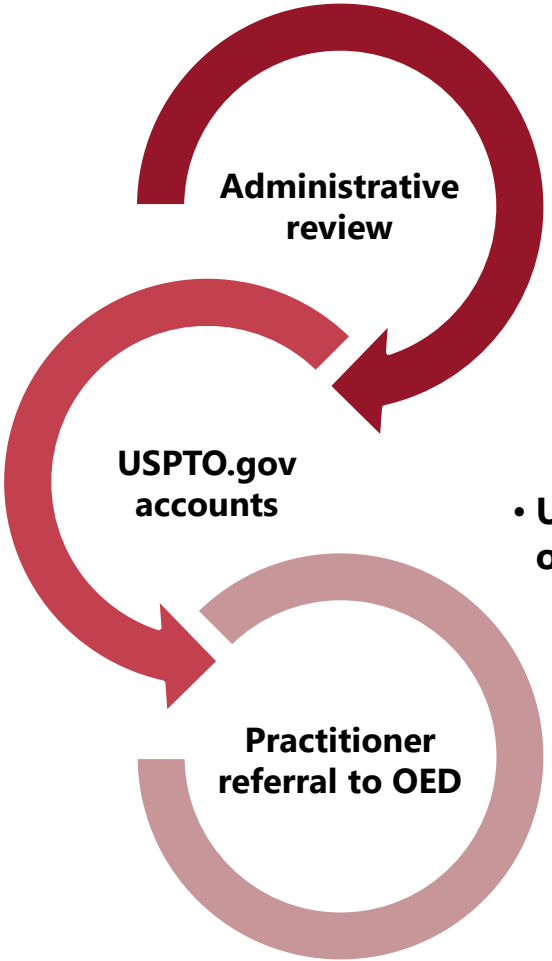
Trademark Examination Policy

Register protection updates:

sanctions and expungement/reexamination

Administrative sanctions program



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

- Used to monitor user roles and other violations of the terms of use

- Used to refer suspicious attorney filing behavior to Office of Enrollment and Discipline (OED)

Sanctions program numbers

Calendar year	Number of show cause orders (SCO)	Number of final orders (OFS)	Terminated applications in OFS	Sanctioned registrations in OFS	USPTO.gov accounts suspended (ID verification 8/6/22)	Individuals referred to OED
2019	68	1	2	0	n/a	10
2020	534	0	0	0	n/a	5
2021	3	3	12,576	3227	345	15
2022	6	36	5,885	70	18	20
2023	2	268	573	0	44	4
Total	**613**	**308**	**19,036**	**3,297**	**407**	**51**

Attorney discipline (a)

Tony Hom	• NY/NJ-licensed attorney contracted with several different Chinese firms (agreement: 12/17/2021)
Elizabeth Yang	• CA-licensed attorney contracted with Chinese entity, Sellergrowth (agreement: 12/17/2021) **CA State Bar suspension**
Yi Wan	• NY-licensed attorney contracted with several Chinese entities, including Shenmahui IP and Huanyee IP (agreement: 4/14/2022) (reinstated)
Jonathan Morton	• FL/NY licensed patent attorney contracted with Chinese firms (agreement: 4/20/22**) FL State bar suspension**
Yiheng Lou	• NY-licensed attorney contracted with Dingji IP Co. (agreement: 5/12/2021) **NY State Bar suspension**
Devasena Reddy	• CA-licensed attorney contracted with Indian entities, KA Partners, KAnalysis, KA Filing (agreement: 9/9/2021) **CA State Bar public reproval**

Attorney discipline (b)

Bennett David	• Patent attorney/MA-licensed attorney contracted with Chinese IP firm (agreement: 9/24/2021) **MA State Bar public reprimand**
Di Li	• CA-licensed attorney contracted with Chinese entity, Sellergrowth (agreement: 10/7/2021) **CA State Bar suspension**
Kathy Hao	• WA/CA licensed attorney contracted with Chinese entities, Sellergrowth, Shenmate, and Xingyue (agreement: 4/27/2022) **WA State Bar suspension**
Weibo Zhang	• NY licensed attorney contracted with Chinese entities, Sellergrowth, Xinyi International IP, etc. (agreement: 7/11/22) (reinstated)
Zhihua "Josh" Han	• Patent attorney/WA-licensed attorney contracted with Jinhua, Xing, and One Stop (agreement: 1/6/2023) **WA State Bar suspension**
Daoyou Tim Liu	• TX/CA-licensed attorney, fraudulent signatures (Final decision following default before ALJ: 8/9/2022) **TX State Bar suspension**

Attorney discipline (c)

Kevin Gallagher	• NY/PA-licensed attorney contracted with Tony Hom, Wuzhou Puhua IP Group (excluded on consent from USPTO practice: 6/16/2023)
Jifeng Song	• Patent/IL-licensed attorney contracted with Sellergrowth, Chinese filing firm (agreement: 5/1/2023) (reinstated)

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Sanctions takeaways

- By the numbers:
  - 308 orders for sanctions terminating over 19,000 invalidly filed applications and sanctioning 3200 invalid registrations
  - 407 USPTO.gov account suspensions
  - 51 individuals referred to OED for investigation and possible discipline
  - 14 settlement agreements with attorneys regarding violations of the USPTO's Rules of Professional Conduct related to the US counsel rule

Trademark Modernization Act (TMA) nonuse cancellation: expungement and reexamination

- Third party petition requesting institution of either expungement (never been used) or reexamination (no use by relevant date) proceedings

- Director can institute proceedings for expungement or reexamination based on her own initiative without a petition

TMA Petition numbers

December 2021 – July 28 2023

Type of proceeding	Petitions Filed	Instituted proceedings	Non-Institutions	Terminated Proceedings	No Cancellation	Cancellation	# goods or services cancelled
Expungement	170 total 55 YTD	87	57	59	3	45	515 out of 520
Reexamination	180 total 72 YTD	91	66	54	7	45	1635 out of 1645
Total	**350 total 127 YTD**	**178**	**122**	**113**	**10**	**90**	**2150 out of challenged 2165**

- *Are petitions meeting the evidentiary burden?*
  - Institution rate is 59%
- *Are the proceedings worth it for petitioners?*
  - Cancellation rate for instituted proceedings is 90%

TMA Director-instituted numbers

December 2021 – July 28 2023

Type of proceeding	Institutions	Terminated proceedings	No Cancellation	Full or partial cancellation	# goods or services cancelled
Director initiated expungement	11	4	0	3	52 out of 52
Director initiated reexamination	141	39	0	34	578 out of 578
Total	**152**	**43**	**0**	**37**	**630 out of 630**

Are these proceedings effective at eliminating deadwood?

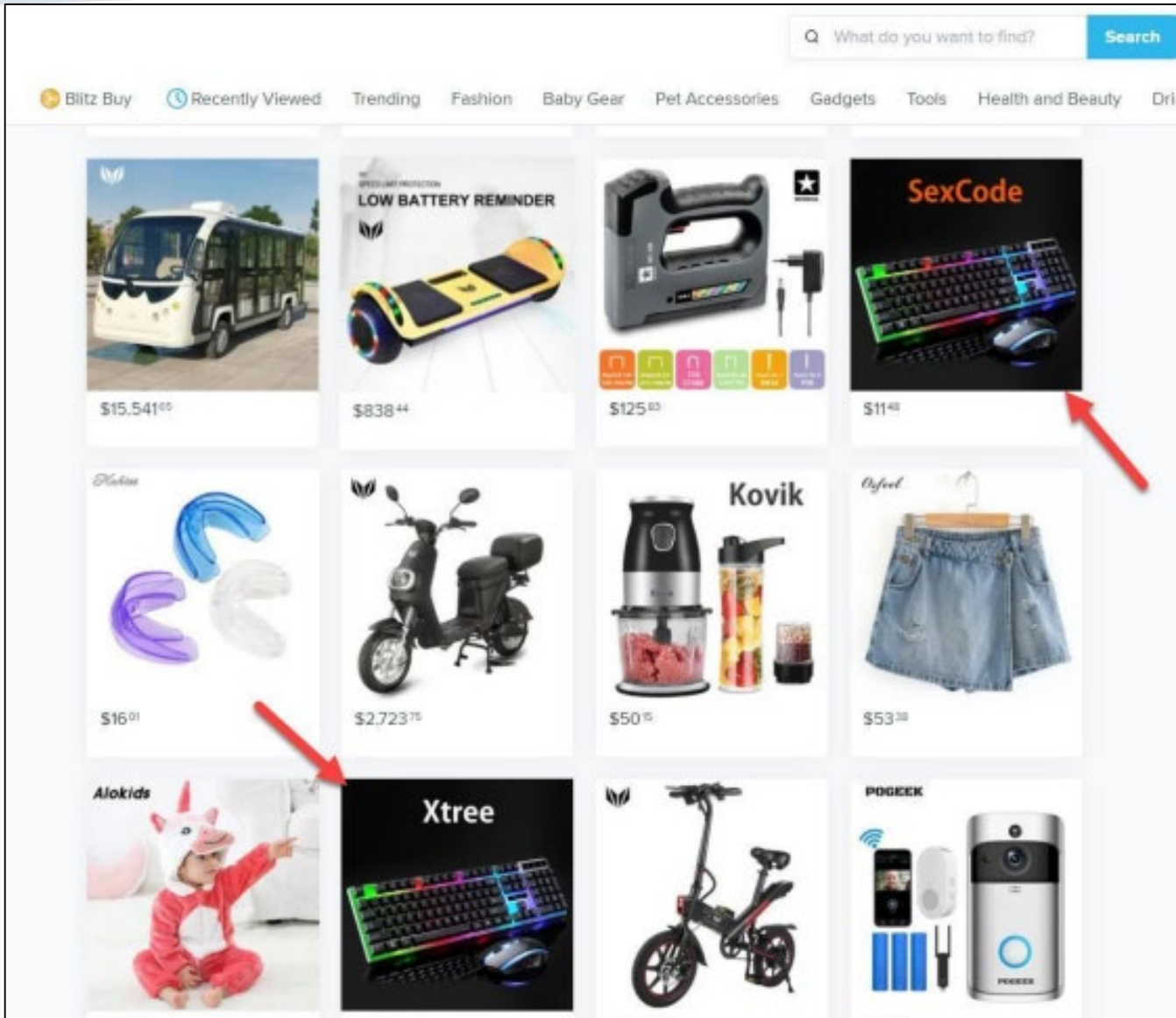
- Director-initiated cancellation rate: 100%
- Director + petition proceeding cancellations = 2780 out of 2795 goods/services cancelled

Specimen farm (a)

Atypical features

QSeel's Red1985 storefront has a large variety of unrelated products

The listings may include the identical product image, but a different mark



Specimen farm (b)

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Trademark Decisions and Proceedings

Expungement/Reexamination Proceedings | Administrative Orders and Sanctions | Precedential Director Decisions

TTAB Reading Room | Open Data | Help

Names

Proceeding type

Director initiated

- [x] Director-initiated 67

Apply

Document type

- [x] Notice of institution / office action issued - expungement 5
- [x] Notice of institution / office action issued - reexamination 60
- [x] Paper mailed - expungement 2

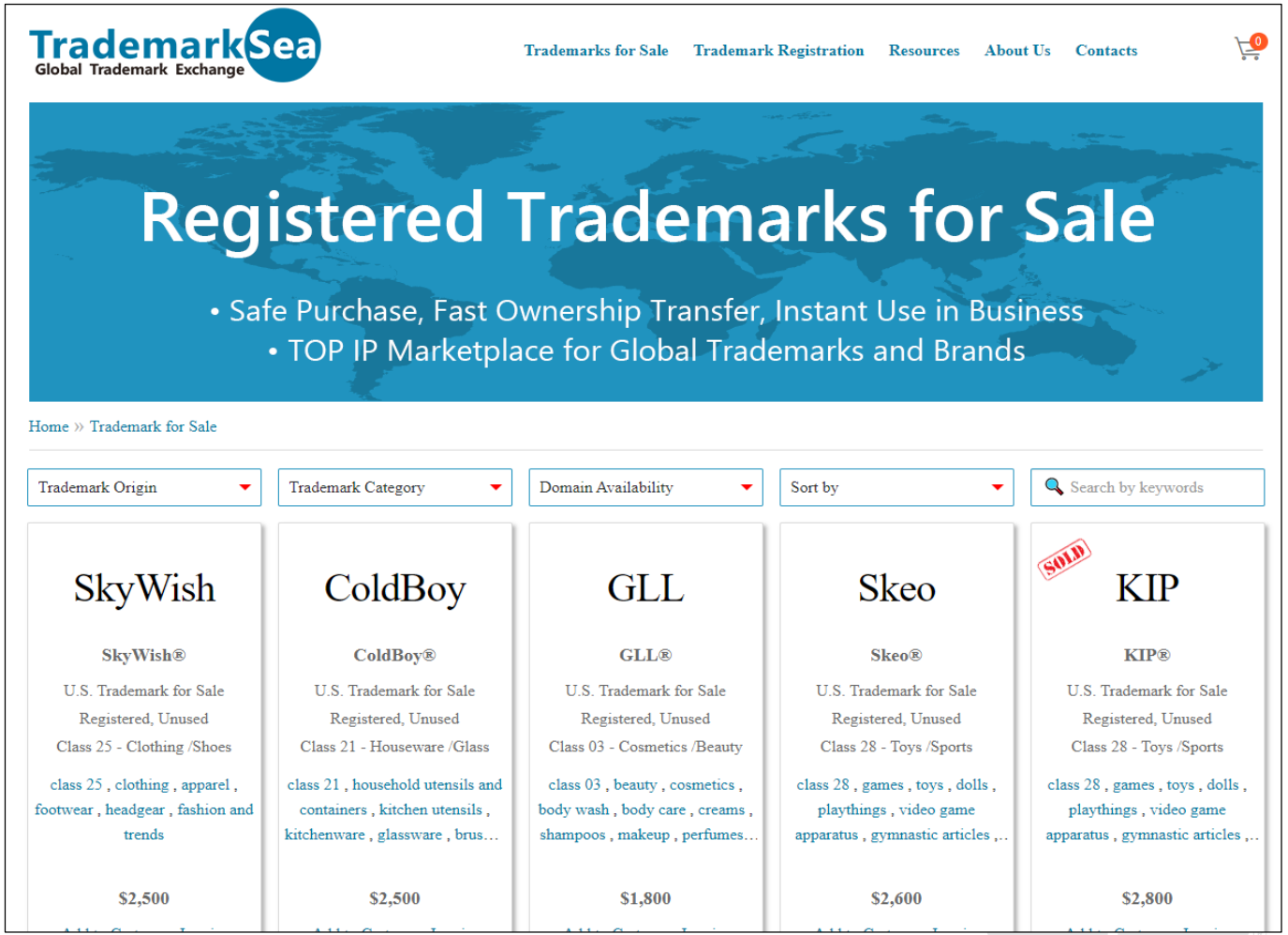
Apply

Precedential/Non-Precedential

+	Trademark	Registration number	Registrant name	Date	Proceeding type	Document type
+	Xtree	6437670	QSEEL INC	04/28/2023	Reexamination	Notice of institution / office action issued - reexamination
+		6493436	QSEEL INC	04/28/2023	Reexamination	Notice of institution / office action issued - reexamination
+	Zbro	6327197	QSEEL INC	04/28/2023	Reexamination	Notice of institution / office action issued - reexamination
+		6493442	QSEEL INC	04/28/2023	Reexamination	Notice of institution / office action issued - reexamination
+		6704822	QSEEL INC	04/28/2023	Reexamination	Notice of institution / office action issued - reexamination
+	Mecaco	6388006	QSEEL INC	04/28/2023	Reexamination	Notice of institution / office action issued - reexamination
+	ZOROSE	6707350	QSEEL INC	04/27/2023	Reexamination	Notice of institution / office action issued - reexamination
+	Roska	6355619	QSEEL INC	04/26/2023	Reexamination	Notice of institution / office action issued - reexamination
+	Fitik	6354789	QSEEL INC	04/26/2023	Reexamination	Notice of institution / office action issued - reexamination
+	Jobik	6354799	QSEEL INC	04/26/2023	Reexamination	Notice of institution / office action issued - reexamination
+	Kovik	6355664	QSEEL INC	04/26/2023	Reexamination	Notice of institution / office action issued - reexamination
+	Cetika	6355563	QSEEL INC	04/26/2023	Reexamination	Notice of institution / office action issued - reexamination
+	POGEEK	6977314	QSEEL INC	04/25/2023	Reexamination	Notice of institution / office action issued - reexamination
+	Fitik	6355665	QSEEL INC	04/25/2023	Reexamination	Notice of institution / office action issued - reexamination
+	OSPA	6355734	QSEEL INC	04/25/2023	Reexamination	Notice of institution / office action issued - reexamination

Trademark auction sites

Trademarksea.com has at least 5000 registrations listed for sale



Scam awareness

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Protect against trademark scams

- Protect your trademark
- Understanding filing firms
- Common scams
- USPTO register integrity
- What to do if scammed
- Administrative sanctions
- Suspended application
- Non-attorneys precluded
- Decisions and Proceedings search tool
- Caution online auctions
- **Challenge invalid specimens**

Third parties can challenge applications or registrations with invalid specimens from e-commerce specimen farm websites

Some filing firms are creating e-commerce websites solely for the purpose of creating specimens to attempt to meet the USPTO's application specimen requirement. We call these websites "specimen farms," because they're made up of webpages created to display hundreds of products with various trademarks that appear to be for sale. Here's what they are doing.

The filing firms apply to register a trademark (frequently made up of nonsensical wording) for a standard set of consumer goods, such as eyeglasses, clothing, toys, electronics, or hand tools—all types of goods that are typically mass-produced. They then create an authentic looking e-commerce site where each trademark gets its own product listing, along with a picture of the goods with the trademark digitally superimposed. The listings may look legitimate when viewed in isolation, or they can look hastily created (e.g., they may include typos, pictures of other retailers' goods with the trademark digitally applied to those goods, or descriptions of goods that do not match the pictures).

The filing firms submit the product listings to the USPTO as specimens of a trademark's use in commerce in order to obtain registration. Such specimens, however, do not support registration, because they do not show a bona fide use of the trademark in the ordinary course of trade, which is a requirement of our law.

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Home > Trademarks > Protect > Use extreme caution if buying registered trademarks from online auctions

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Protect against trademark scams

- Protect your trademark
- Understanding filing firms
- Common scams
- USPTO register integrity
- What to do if scammed
- Administrative sanctions
- Suspended application
- Non-attorneys precluded
- Decisions and Proceedings search tool
- **Caution online auctions**
- Challenge invalid specimens
- Spoofing phone numbers
- Foreign filing firms

Use extreme caution if buying registered trademarks from online auctions

Internet trademark auctions are virtual marketplaces where people attempt to sell registered trademarks from around the world. Many of these auction websites attempt to sell U.S. trademark registrations. While some of these marketplaces may be legitimate, some are known to sell invalid registrations. **The USPTO is not affiliated in any way with online auctions.**

A registration can be invalid for many reasons. If you buy an invalid registration, you have likely not acquired any actual rights to the trademark.

A trademark cannot be transferred without the goodwill associated with its use

The value of a trademark relates to the goodwill associated with it. Goodwill is the reputation of the company and product or service that consumers associate with the trademark. A trademark registration itself has no inherent value apart from the consumer recognition associated with the trademark's use in commerce for particular goods or services.

A U.S. trademark registration must be sold with its associated goodwill to transfer any rights in the trademark. This requirement helps protect consumers from potential deception by ensuring that the buyer provides goods or services of similar quality and nature as the previous owner.

If you're interested in buying a U.S. trademark registration, consider: Is there any goodwill to actually transfer and does the sale transaction actually transfer that trademark's goodwill to me?

TMA takeaways

- By the numbers:
  - 350 total petitions filed
    - 178 institutions + 122 non-institutions (59% *institution rate*)
    - Cancelled 2150 goods or services out of 2165 challenged
  - 152 Director initiated proceedings
    - Cancelled 630 goods or services out of 630 challenged

Trademark Examination Policy

Communications and marketing

New filing receipt

Filing Receipt for Trademark/Service Mark Application for Registration
on the Principal Register
and Next Steps in the Application Process

Thank you for submitting your trademark application to the U.S. Patent and Trademark Office (USPTO)! You have started the legal process to federally register your mark.

This filing receipt confirms that you successfully submitted your application, whic
reviewed to see if it qualifies for registration. Registration is not *automatic or gu*
will see your mark, the serial number assigned to your application, and a descript
next in the application process. Carefully review this information to make sure it
know what to expect. We also highly recommend keeping a copy for your record

Please pay attention to the section below regarding scams and read the Protec on our website. Also, we encourage you to take advantage of the resources we h
for first-time applicants, startups, and women entrepreneurs.

Watch out for scams
Recognizing common signs of a scam can help you avoid costly mistakes. Scammers pretend to be from the USPTO, often state there's some sort of problem with your application, pressure you to act immediately, and tell you to pay some sort of fee or provide personal information. Some will even call you and use names, numbers, and locations of real USPTO employees to try to steal your money or personal information. USPTO employees will never ask you for your personal or payment information over the phone.

If you receive a notification about paying to publish your trademark in a directory, avoid doing so. Trademark directory listings aren't necessary. They're unofficial and not associated with the USPTO.

All official communications will be from the "United States Patent and Trademark Office" in
om emails with the domain "uspto.gov." If you're unsure about
is from us, call or email the Trademark Assistance Center or check
ase, TSDR. Any official communications we send you will be uploaded
isit protect against scams on our website.

Resources for new applicants
We have many resources available for small business owners, first-time applicants, and entrepreneurs taking the first step to protect their trademark. Read the welcome letter from our leaders for details.

Kathi

Kathi Vidal
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

Derrick Brent
Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office

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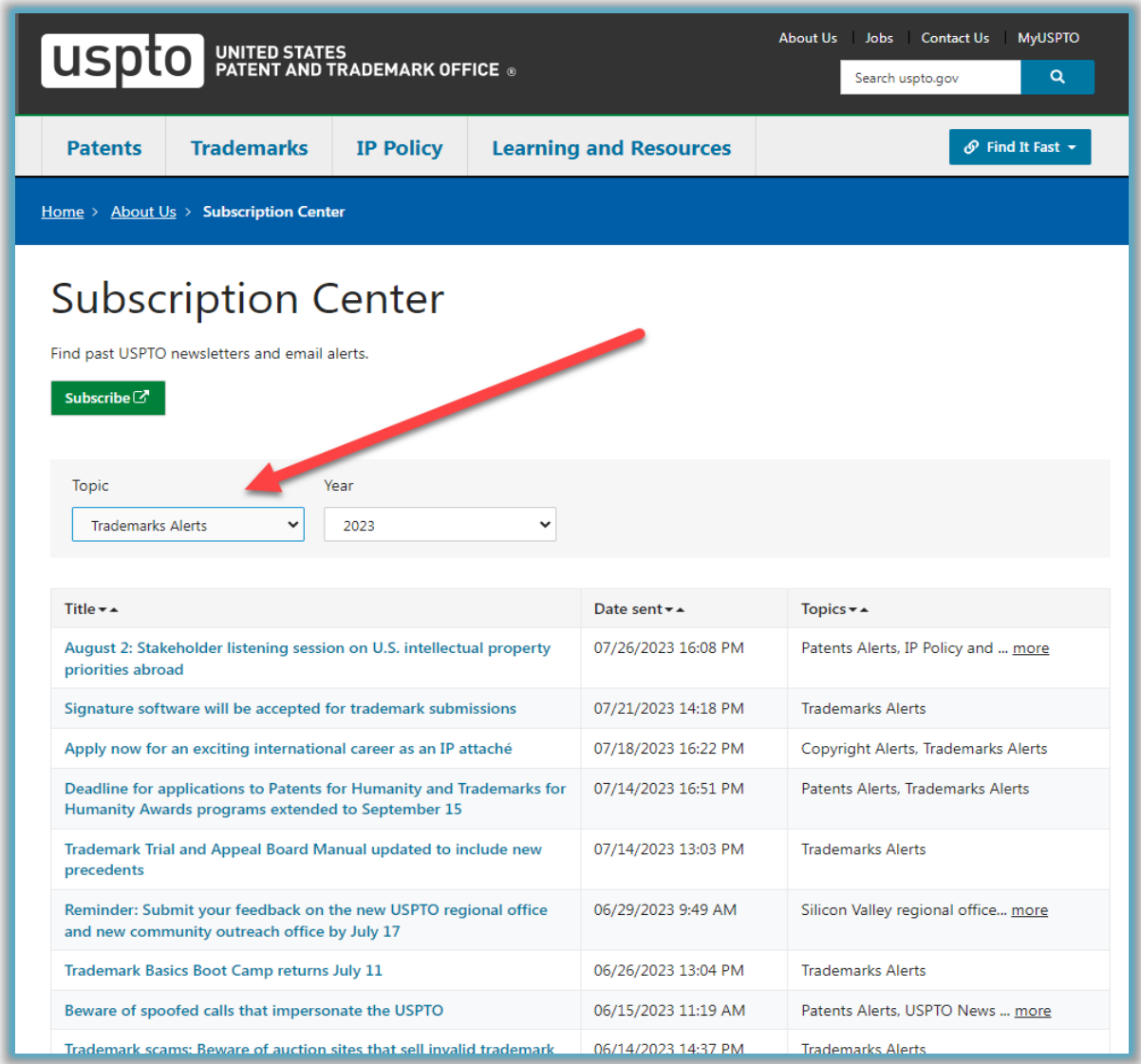

Trademark Examination Policy

Guidance and notices

Guidance and notices

- New software signed documents exam guide
- Upcoming domicile address exam guide
- Upcoming Federal Register Notices
  - Attorney recognition public roundtable: 9/26/23
  - ID verification for attorney sponsored accounts

TM exam guides

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Trademark examination guides

Examination guides issued after the publication of the Trademark Manual of Examining Procedure (TMEP) (July 2022), or any issued before publication but not incorporated into the TMEP, are listed below. Generally, examination guides issued before publication of the July 2022 TMEP have been incorporated into the TMEP.

- Exam Guide 2-23 Electronic Trademark Submissions Signed Using Document-signing Software and Compliance with 37 C.F.R. section 2.193
- Exam Guide 1-23 Examination for Compliance with Section 2(c) while Constitutionality of Section 2(c) as Applied to Marks that are Critical of Government Officials or Public Figures Remains in Question
- Exam Guide 2-22 Change in Office Action Response Periods for Section 1 and/or Section 44 Application
- Exam Guide 1-22 Clarification of Examination Evidentiary Standard for Marks Refused as Generic
  Exam Guide 1-19 Examination of Marks for Cannabis and Cannabis-Related Goods and Services after Enactment of the 2018 Farm Bill
- Exam Guide 1-11 (Section 2(a) Deceptiveness for Class 5 Goods)

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