

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Trademark Operations Update

Mary Boney Denison
Commissioner for Trademarks

Thursday, July 26, 2018

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Organization and Statistics

Thursday, July 26, 2018

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Trademark Organization Staffing

- 892 Trademark employees (7% of USPTO)
- 581 examining attorneys (66% of Trademarks)
- 77% of examining attorneys telework full time
- Hired 61 new examining attorneys this fiscal year; hiring ~100 next year

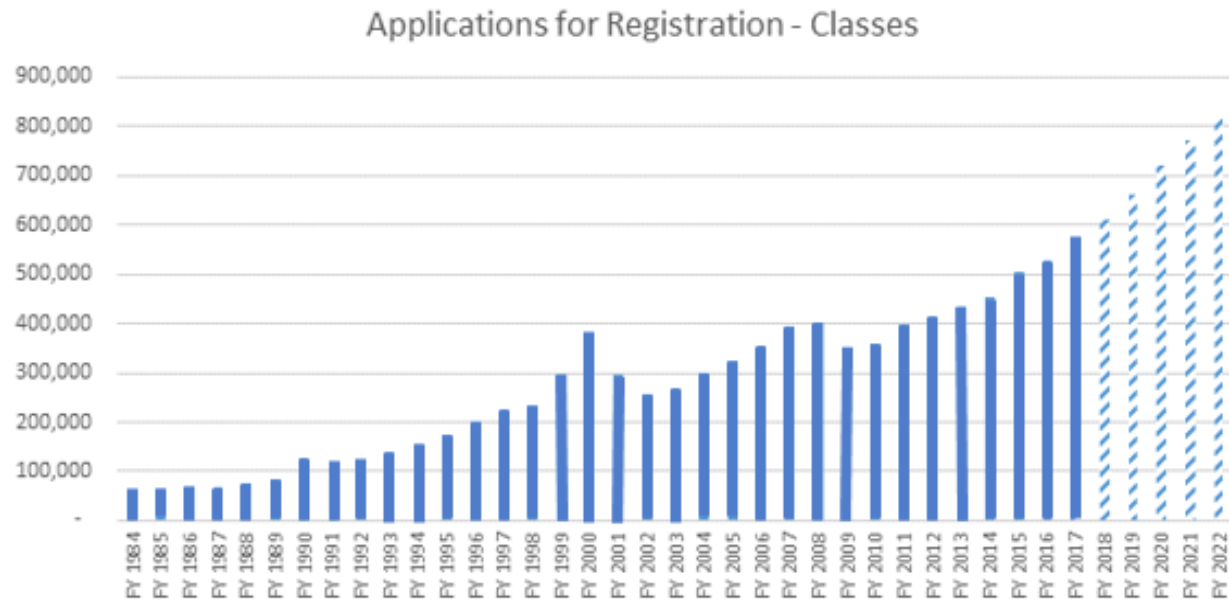
New Application Filings

FY16: 530,270 classes filed

FY17: 594,107 classes filed

FY18: up 10.4% compared to FY17

Expecting 646,000 classes this year



Trademark Performance: Pendency

<i>FY 2018</i> <i>Trademark Performance Measures</i>	FY 2018 Targets	FY 2018 June Results
First Action Pendency First action pendency from date of filing to first office action in months.	2.5 – 3.5	3.1
Disposal Pendency Disposal pendency from date of filing to issuance of a notice of allowance, registration, or abandonment – excluding suspended and <i>inter partes</i> proceedings.	12.0	9.7

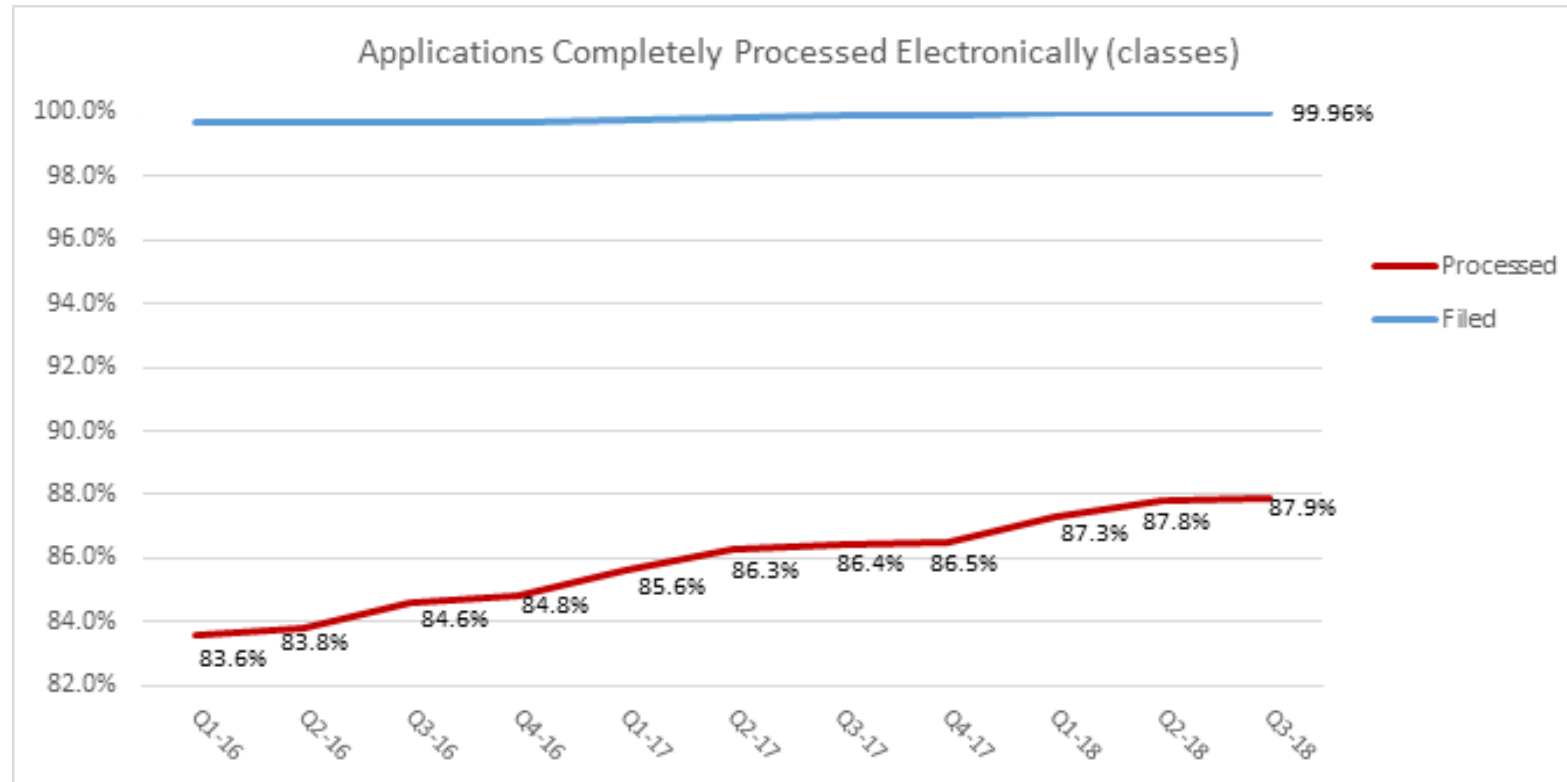
Trademark Performance: Quality

<i>FY 2018 Trademark Performance Measures</i>	FY 2018 Targets	FY 2018 June Results
First Action Compliance In-process review evaluation of the statutory bases for which the Office raises issues and or refuses marks for registration based on the first office action.	95.5%	96.8%
Final Action Compliance In-process review evaluation of the statutory bases for which the Office raises issues and or refuses marks for registration based on the examiner's approval or denial of the application.	97.0%	98.1%
Exceptional Office Action Measure indicating the comprehensive quality of the first Office action search, evidence, writing and decision making.	45.0%	45.2%

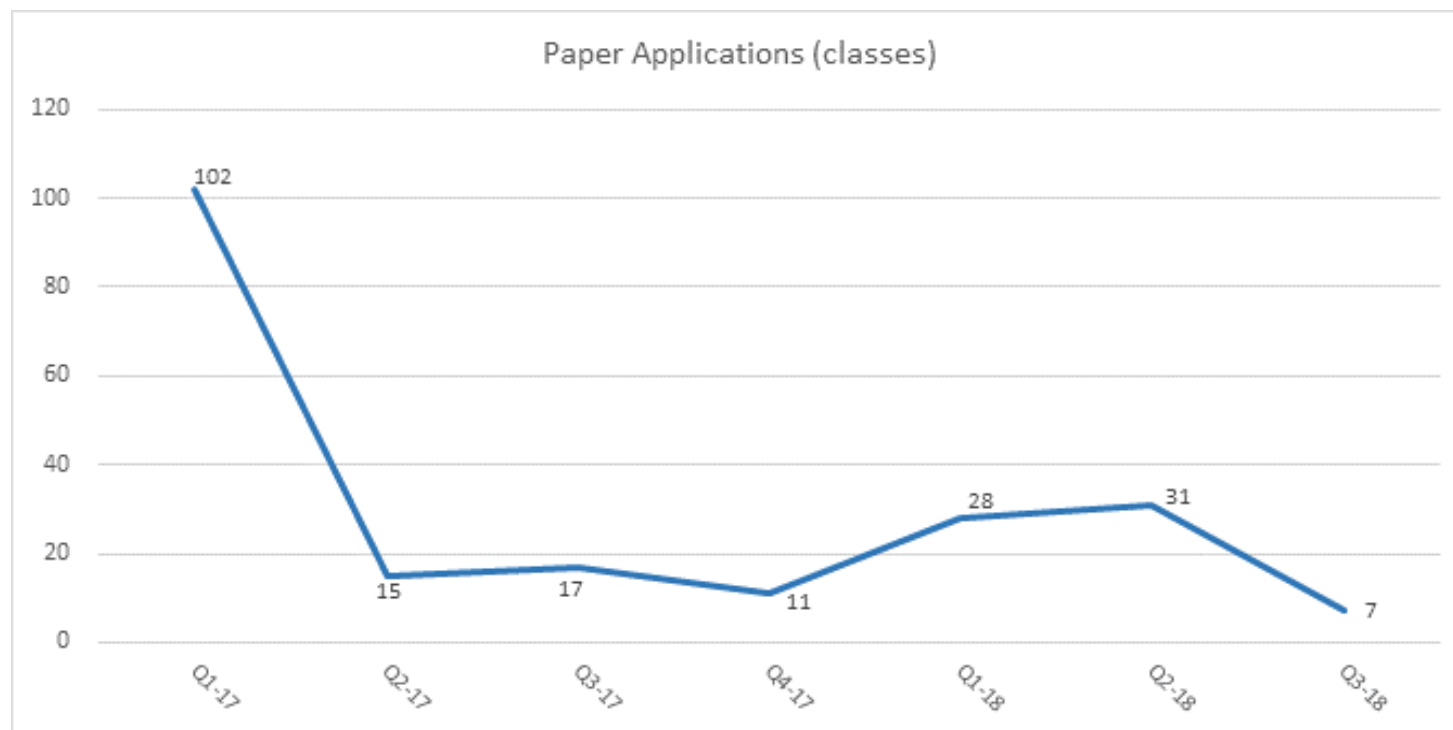
E-Government Statistic

- Original goal was to have all applications submitted electronically;
Currently at the 99.9% range
- Goal shifted from application to two-way electronic communication throughout the entire registration process
- Continue to encourage end-to-end electronic processing by users
- **Planning for mandatory electronic filing by early 2019**

E-government



Fee Change Effect on Paper Applications



Trademark IT News

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IT Improvements



- ✓ TEAS now emails both new and previous correspondent when correspondence address of record is changed
- ✓ Text in owner sections of forms reformatted and clarified to help prevent accidental misuse of these fields

ID Manual Update

Enhancements deployed in April 2018 include 4 new features:

- **See all your results on a single page.**
No need to click through multiple pages – up to 500 results on a single page.
- **Use navigation buttons to see results from previous searches.**
Easily view all your results from a series of searches.
- **Target your search to descriptions only, not notes.**
The default setting will search the description field only.
- **Automatically search alternate spellings for some terms.**
Save time by searching for two common spellings at once, e.g. color and colour.

See our [ID Manual enhancements webpage](#) for tips on using these new features.

My.USPTO.gov

- **Trademark Docket**
 - Stores and monitors up to 1,000 applications and registrations per grouping (“collection”)
 - List due dates and quick links to corresponding forms for registered marks
 - Sends e-mail notification of status changes
 - Will send e-mail notification of certain prosecution history entries
- **Trademark OG Watch**
 - Stores searches
 - Sends email notification when there are new hits on saved TMOG searches

Sign up at my.uspto.gov, and please provide feedback and suggestions.



My.USPTO.gov

- Trademark Docket
 - **New:** Share collections in dockets with other MyUSPTO users (May release)
- **Coming later this summer: Trademark Form Finder widget**
 - Tool identifies forms using plain language rather than current form names
 - Includes a search box to search the form names
- **Next widget: Simple File**
 - Initial scope: ITU word marks, TEAS PLUS fees basis
 - Status: testing design with small set of public users

A screenshot of the Trademark Form Finder widget. The title bar reads "TRADEMARK FORM FINDER" with a search icon and a close button. Below the title bar is a search box with the placeholder text "Search" and a search icon. A list of form categories follows, each preceded by a right-pointing chevron: "File an application", "Respond to correspondence from the USPTO", "Respond to a Notice of Allowance", "Make changes to your application", "File documents after your mark is registered to maintain or change your registration", "Change an address", "Change attorney or domestic representative information", "File a late response", "Respond to a Notice of Abandonment", "File a petition", "File forms related to the Madrid Protocol", "File an appeal, opposition, or cancellation with the TTAB", and "Record an assignment for ownership transfers or changes in name, entity type, or citizenship". At the bottom of the widget is a button labeled "All trademark forms".

Please provide your feedback online

The screenshot shows the MyUSPTO website interface. At the top, there is a dark navigation bar with the 'uspto' logo on the left and links for 'Patents', 'Trademarks', 'Fees and payments', 'Help', 'Ramesh Pai', and 'MyUSPTO' on the right. Below this is a light gray header with 'MyUSPTO' and a 'BETA' badge. A blue navigation bar contains 'What's new' and 'MyUSPTO help'. A dropdown menu is open under 'MyUSPTO help', showing 'Feedback' (highlighted in yellow and circled in blue), 'FAQs', and 'Tutorial'. The main content area features three panels: 'USPTO FEES' (with sub-tabs for Patent, PCT, Trademark, and General), 'TRADEMARK APPLICATION DOCKET' (ALPHA), and 'TRADEMARK POST-REGISTRATION DOCKET' (ALPHA). Each docket panel includes a description and a 'Create a new collection' button.

Trademark Rules of Practice

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Rulemaking

Mandatory Electronic Filing

- As of midyear FY18, ~99% of TM applications are filed electronically but ~88% are processed electronically from beginning to end
- New rule will make use of TEAS mandatory for all trademark filings
- Notice of proposed rulemaking published May 30 – comments due by July 30
- Implementation likely early 2019

Rulemaking

U.S. Counsel Requirement

- New rule will require foreign trademark applicants and registrants to be represented by a U.S. licensed attorney to file trademark documents with the USPTO
- New requirement will:
 - ensure that the USPTO can effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters;
 - provide greater confidence to foreign applicants and the public that registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims; and
 - aid USPTO efforts to improve accuracy of the U.S. Trademark Register
- Notice of proposed rulemaking planned for early 2019

Section 2(a)

- *Brunetti* Decision Issued on December 15, 2017 holding the immoral or scandalous provision of Section 2(a) unconstitutional. The U.S. Court of Appeals for the Federal Circuit ruled that “Fuct”, while vulgar, was protected speech under the First Amendment.
 - Petition for rehearing denied on April 19. An extension to file a petition for cert has been granted. DOJ now has until August 10 to decide whether to petition for cert. Office of the Solicitor conferring with DOJ to consider petitioning for cert.

Initiatives

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Decluttering Initiative: Proof of Use Audit Program

- Launched November 1, 2017!
- As of June 13, 2018: 2,401 first actions have been sent.
- Program improves integrity of the trademark register by allowing us to cancel audited registrations with unsubstantiated use claims or remove unsupported goods and services from others
- Your registration may be audited if you meet both requirements:
 1. You filed a Section 8 or 71 declaration of use
 2. Your registration includes at least one class with four or more goods or services or at least two classes with two or more goods or services in at least two classes.
- If audited, USPTO will require submission of proof of use for additional goods/services in registration to ensure that register accurately reflects marks are in use in United States for all goods/services identified in registrations.



Proof of Use Audit Program

Results So Far:

November 2017 – July 11, 2018

- 2,401 First Actions issued by Examining Attorneys on project
- 945 responses received
- 44% of registrations with response deleted at least some goods or services
- 79% of respondents represented by an attorney
- 21% of respondents pro se

Misleading Solicitations

- Raising awareness of schemes to defraud trademark owners:
 - **Warning** individual applicants and registrants **at key stages** of the trademark prosecution process:
 - (1) in trademark application filing receipt
 - (2) cover email for trademark office actions and
 - (3) with each paper trademark registration on bright orange sheet of paper
 - Participating in an informal interagency working group on combatting fraudulent solicitations
 - Hosted a roundtable with TPAC on July 26, 2017 with numerous bar groups and other government agencies (FTC, DOJ, USPIIS, SBA, CBP)
 - Working with DOJ on criminal prosecutions
 - In 2017, two men pled guilty to stealing \$1.66 million from U.S. trademark applicants and registrants; third man convicted
 - This year we have sent 2 lawyers to DOJ to work on criminal prosecutions

Initiatives to Improve Customer Experience

- We have a **five-year customer experience strategic plan** to ensure we provide consistent, clear, and intuitive services to our customers.
- FY 2018 focus areas include:
 - Implement **four customer touchpoint surveys on:**
 - Trademark Assistance Center
 - TEAS
 - Website content
 - Application prosecution

Initiatives to Improve Customer Experience

Dramatically improve our website so customers can find, understand, and use the information they need. This includes information on trademark searching, online filing, and trademark basics.

- Improved TESS guidance

We are working on several webpages with enhanced guidance for TESS users. The first two webpages were published this month:

- [“Get ready to search – classification and design search codes”](#) gives users background about how classification and design search codes help with a TESS search, as well as guidance for looking up the classes and design search codes that apply to a given mark.
- [“Using the Trademark Electronic Search System”](#) helps users choose the best search option (Basic, Structured, or Free Form) and directs users to a set of general instructions for using the interface.

Initiatives to Improve Customer Experience

Website Improvements Continued:

- Other new and improved webpages
 - [“Why hire a private trademark attorney”](#) replaced “Using private legal services.” The revised page more clearly explains the benefits of hiring an attorney and stresses the legal implications of filing an application.
 - [“Timelines for trademark application and post-registration”](#) were updated for accuracy and plain language.
 - [“Decisions on Trademark Petitions to the Director”](#) is a new page that features petition decisions dating from 2013. The page is updated monthly with decisions involving new or complex legal issues or unusual factual situations. You can also see a monthly list of all petition decisions by serial number.

Specimen Issues

- Mocked-up or fake specimens are increasing
- Much more sophisticated
- Applicants pasting their marks on products or services of others to show use in commerce
- We are doing our best to refuse the fraudulent specimens
- We are researching digital forensic services to help us.

Mock-Ups and Digitally Altered Specimens

- Fake specimens present several issues:
 - Fail to show mark as used in commerce?
 - Fraud on the Office?
 - Discipline by OED?
 - Impact on validity of registration?

Specimen Protest Pilot Program



Specimen Protest Pilot Program

- New streamlined process for public to report improper specimens.
- Email submissions should include either:
 - Objective evidence of 3rd party use of images identical to the specimen of record; or
 - Registration or serial numbers showing identical specimens bearing different marks
- Additional submission guidelines and details on the process appear on our website under Recent Postings
- Specimens mailbox email address:
TMSpecimenProtest@uspto.gov.

2018 National Trademark Exposition

July 27-28, 2018

Special guest **Kareem Abdul-Jabbar** will be our keynote on Friday, July 27!



Exhibitors selected:

1000 Cranes, LLC	Girl Scouts Nation's Capital	Safeway Inc.
Alexei Novitzky (DBA Looshes Labs LLC)	Idaho Potato Commission	Segway Inc.
American Intellectual Property Law Association, Inc.	International Trademark Association, Inc. (the Unreal Campaign)	Tenneco Automotive Operating Company Inc.
Bradley Graham and Lissa Muscatine (DBA Politics and Prose, Inc.)	National Aeronautics & Space Administration (NASA)	The National Institute on Deafness and Other Communication Disorders (The National Institutes of Health)
DC Rollergirls	National Council of Young Men's Christian Associations of the United States of America (YMCA)	U.S. Chamber of Commerce
National Park Service (United States Department of the Interior)	Under Armour, Inc.	Edible IP, LLC (FKA Edible Arrangements, LLC)
Rebecca Klemm Charitable Foundation (NumbersAlive!)		



2018 National Trademark Exposition Schedule



Friday, July 27

10:15-11:15 a.m.

Who Owns You After You Die - Inside the Estates of Deceased Celebrities (CLE)

12:15-1 p.m.

Opening Ceremony

1-1:30 p.m.

How Celebrities Build and Maintain Their Brands – Kareem Abdul-Jabbar

2-2:30 p.m.

Counterfeits and Con Artists: The Real Dangers and Costs of Fake Goods

3-3:30 p.m.

Trademark Teasers

4-4:30 p.m.

Trademark Trivia

Saturday, July 28

12-12:30 p.m.

Telling the Story of Business Growth in America

1-1:30 p.m.

Trademark Teasers

2-2:30 p.m.

Counterfeits and Con Artists: The Real Dangers and Costs of Fake Goods

3-3:30 p.m.

Marks and Mascots, How Businesses Build and Sustain Brand Identity – What's in a Brand

*Children's activities, including scavenger hunts, interactive games, and trademark design workshops, will be offered both days.



International

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TM5

- Comprised of the 5 largest trademark offices:
 - European Union Intellectual Property Office (EUIPO),
 - Japan Patent Office (JPO),
 - Korean Intellectual Property Office (KIPO),
 - Trademark Office of the State Administration for Industry and Commerce of the People's Republic of China (SAIC), and
 - United States Patent and Trademark Office (USPTO)
- Focuses on exchange of information and collaboration and harmonization projects regarding trademark matters to benefit users
- Projects include, among others:
 - Minimizing Bad Faith Filings
 - Common Status Descriptors
 - ID List
 - Indexing of Non-Traditional Marks
 - Image Searching

2017 TM5 Annual Meeting

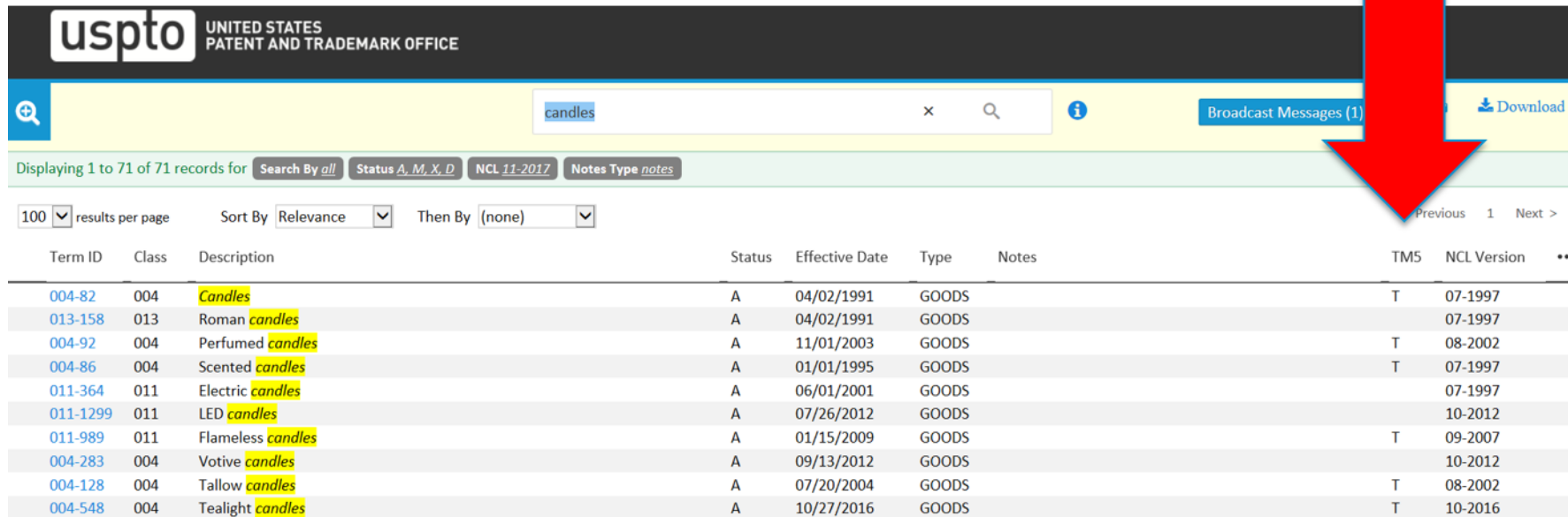
- At the 2017 TM5 Annual Meeting in Alicante on November 30, the Partners agreed to 3 new projects:
 - Fraudulent Solicitations/Misleading Invoices (co-led by USPTO and EUIPO)
 - Quality Management (co-led by JPO and EUIPO)
 - Priority Rights Documents (led by EUIPO)
- Agreed to invite Indonesia, Thailand, Cambodia, Vietnam, Australia, Singapore, New Zealand, Mexico, Norway, Switzerland, Israel, Jordan, Saudi Arabia to join the USPTO-led Common Status Descriptors Project
- Agreed to future revisions of the TM5 web site to keep it more current and more user friendly
- Agreed to new Bad Faith Report including cases from non-TM5 countries and with participation of INTA
- KIPO established as 2018 TM5 Secretariat
- Full day user session included summary of Annual Meeting, presentations on Quality Management and Bad Faith Trademark Filings, and table topic discussions on Fraudulent Solicitations, Bad Faith Filings and Quality Management
- 2018 **TM5 Annual Meeting** in Seoul, South Korea, **November 1-2**

TM5 ID List



- TM5 ID List Search Tool posted on the TM5 website, <http://tmfive.org/>
- As of July 5, 2018, the TM5 ID List contained **18,610** pre-approved terms that are acceptable to all Partner Offices
- At the 2017 TM5 Annual Meeting, the Partners agreed to invite Argentina, Paraguay and Saudi Arabia to join the ID List

Example from ID Manual



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Search: candles

Displaying 1 to 71 of 71 records for Search By all Status A, M, X, D NCL 11-2017 Notes Type notes

100 results per page Sort By Relevance Then By (none)

Term ID	Class	Description	Status	Effective Date	Type	Notes	TM5	NCL Version	...
004-82	004	Candles	A	04/02/1991	GOODS		T	07-1997	
013-158	013	Roman candles	A	04/02/1991	GOODS			07-1997	
004-92	004	Perfumed candles	A	11/01/2003	GOODS		T	08-2002	
004-86	004	Scented candles	A	01/01/1995	GOODS		T	07-1997	
011-364	011	Electric candles	A	06/01/2001	GOODS			07-1997	
011-1299	011	LED candles	A	07/26/2012	GOODS			10-2012	
011-989	011	Flameless candles	A	01/15/2009	GOODS		T	09-2007	
004-283	004	Votive candles	A	09/13/2012	GOODS			10-2012	
004-128	004	Tallow candles	A	07/20/2004	GOODS		T	08-2002	
004-548	004	Tealight candles	A	10/27/2016	GOODS		T	10-2016	

Madrid Protocol

- Effective November 1, 2017, applicants may add a description of the mark to the international application, even if the description does not appear in the basic application or registration
- The description of the mark in the basic application or registration must also be submitted if required by the country of origin
- http://www.wipo.int/edocs/mdocs/govbody/en/mm_a_49/mm_a_49_3.pdf

China

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Focus on China

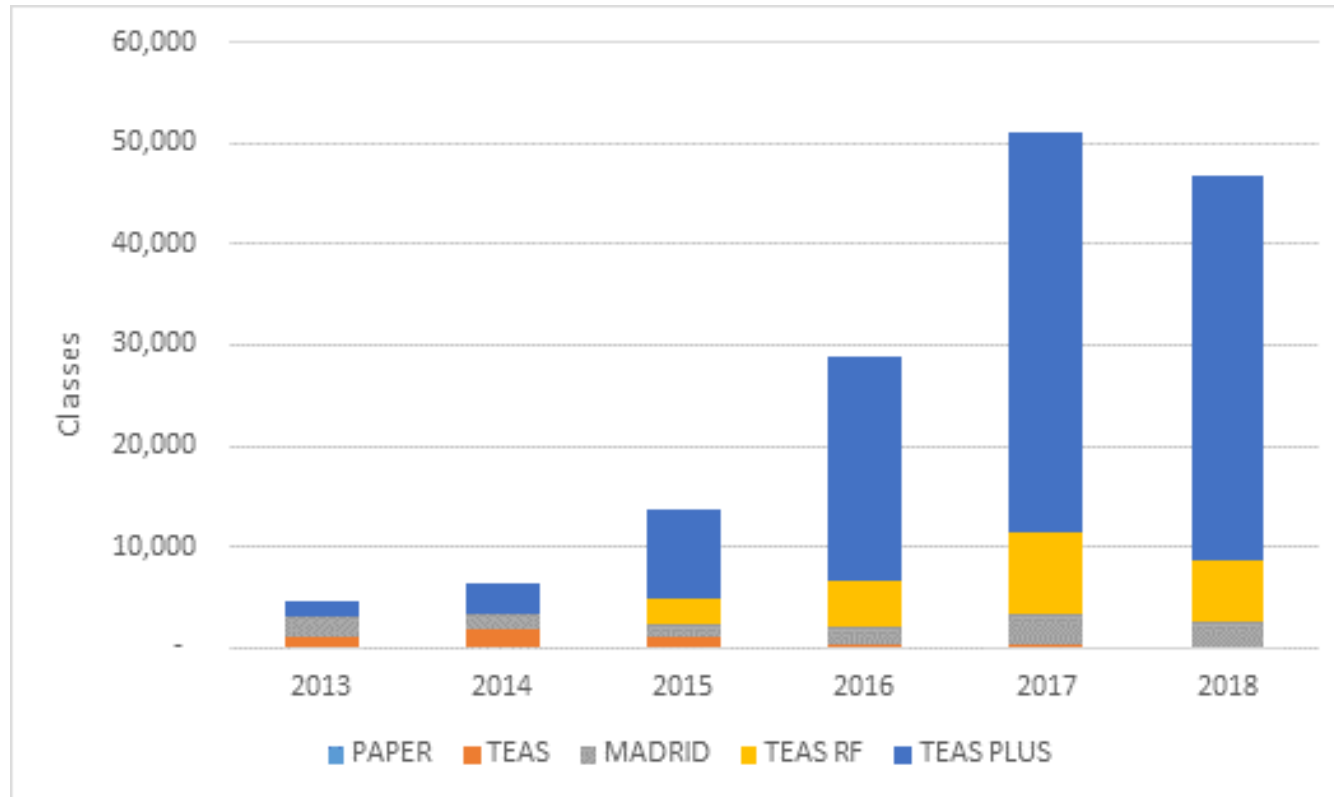
- Influx of Chinese Filings
- Specimen Issues
- Counterfeiting
- Bad Faith Filings

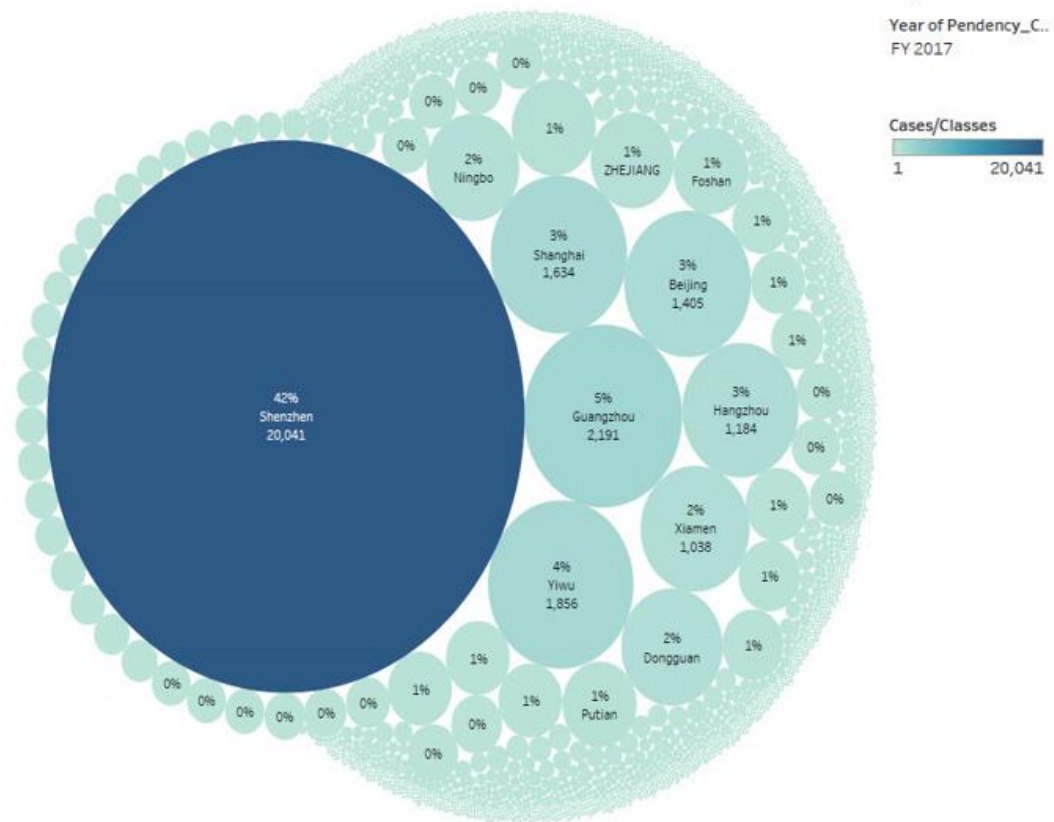


Influx of Chinese Filings

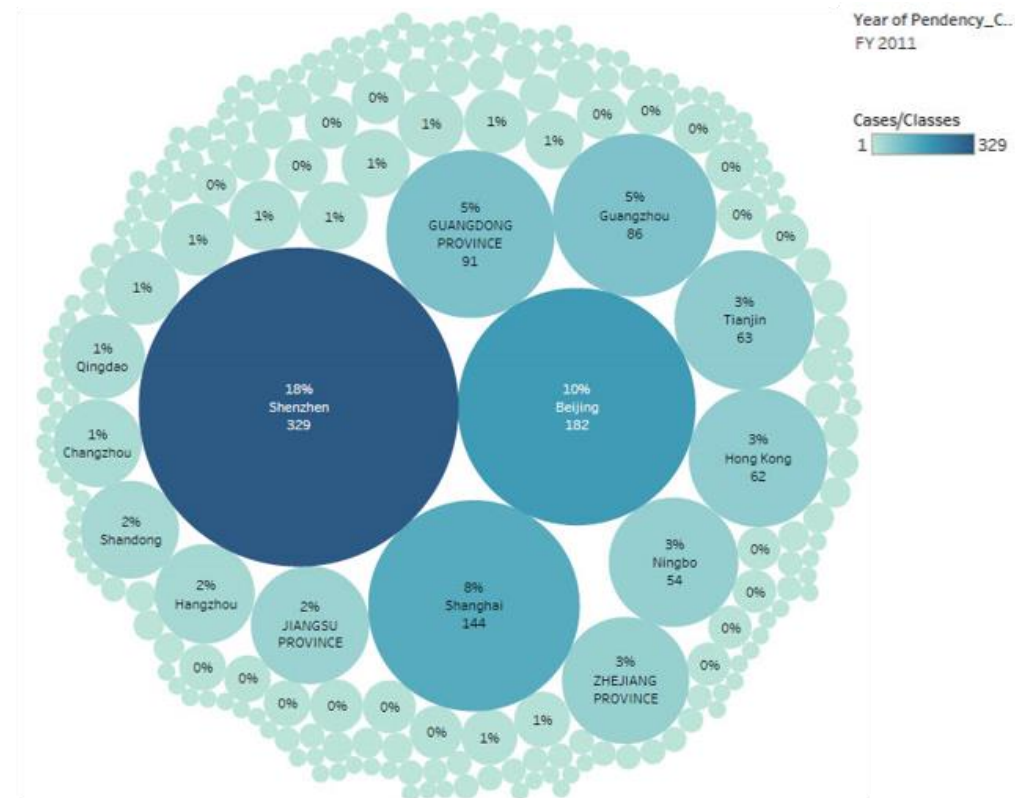
- Recent trends showing a great increase in filings from China.
- Possibility that local governments within China are encouraging filings in the U.S.
- Concern over the legitimacy of these applications and subsequent registrations

U.S. Filings by Chinese Applicants

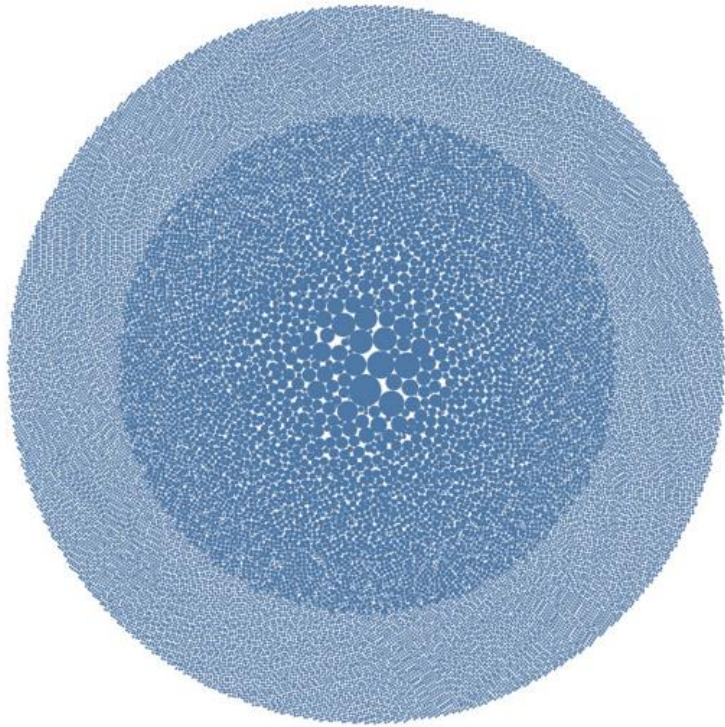




FY2017



FY2011



Cases/Classes
From 1

Filing Basis

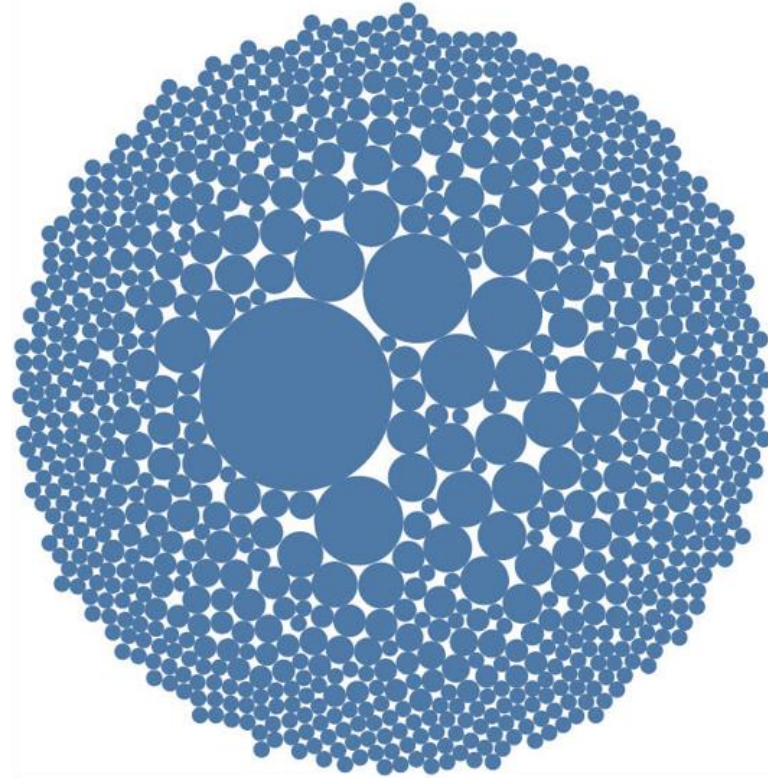
- Null
- 44D
- 44E
- 66A
- ITU
- NO BASIS
- USE

Fiscal Year
FY 2017

Show history

Switch Case Class
Class

FY2017



Cases/Classes
From 1

Filing Basis

- Null
- 44D
- 44E
- 66A
- ITU
- NO BASIS
- USE

Fiscal Year
FY 2011

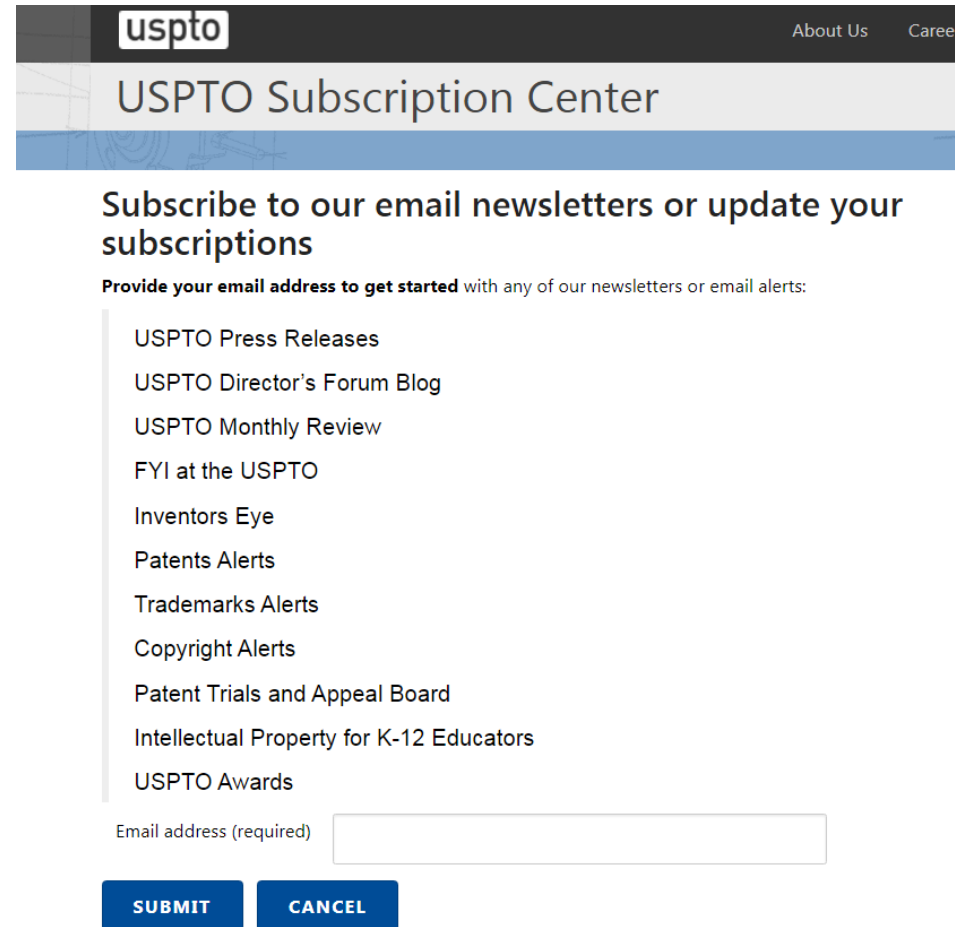
Show history

Switch Case Class
Class

FY2011

Stay Informed

Sign up to receive updates and announcements on upcoming Trademark system changes, events and roundtables, rules changes, and other Trademarks Operations matters



The screenshot shows the USPTO Subscription Center page. At the top, there is a dark header with the 'uspto' logo on the left and 'About Us' and 'Careers' links on the right. Below the header is a light gray banner with the text 'USPTO Subscription Center'. Underneath is a blue horizontal bar. The main content area has a heading 'Subscribe to our email newsletters or update your subscriptions' followed by a sub-heading 'Provide your email address to get started with any of our newsletters or email alerts:'. A list of newsletter options is provided, including USPTO Press Releases, USPTO Director's Forum Blog, USPTO Monthly Review, FYI at the USPTO, Inventors Eye, Patents Alerts, Trademarks Alerts, Copyright Alerts, Patent Trials and Appeal Board, Intellectual Property for K-12 Educators, and USPTO Awards. Below the list is an input field for the email address, labeled 'Email address (required)'. At the bottom of the form are two buttons: 'SUBMIT' and 'CANCEL'.

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- Inventors Eye
- Patents Alerts
- Trademarks Alerts
- Copyright Alerts
- Patent Trials and Appeal Board
- Intellectual Property for K-12 Educators
- USPTO Awards

Email address (required)

SUBMIT **CANCEL**



Feedback

- We want to hear from you!
- E-mail TMFeedback@uspto.gov for general suggestions
- Other Trademarks contact information can be found on our website at:
<https://www.uspto.gov/trademark/contact-trademarks/other-trademark-contact-information>

Thank You!

Mary Boney Denison

Commissioner for Trademarks

Mary.Denison@uspto.gov

