

USPTO's register protection program

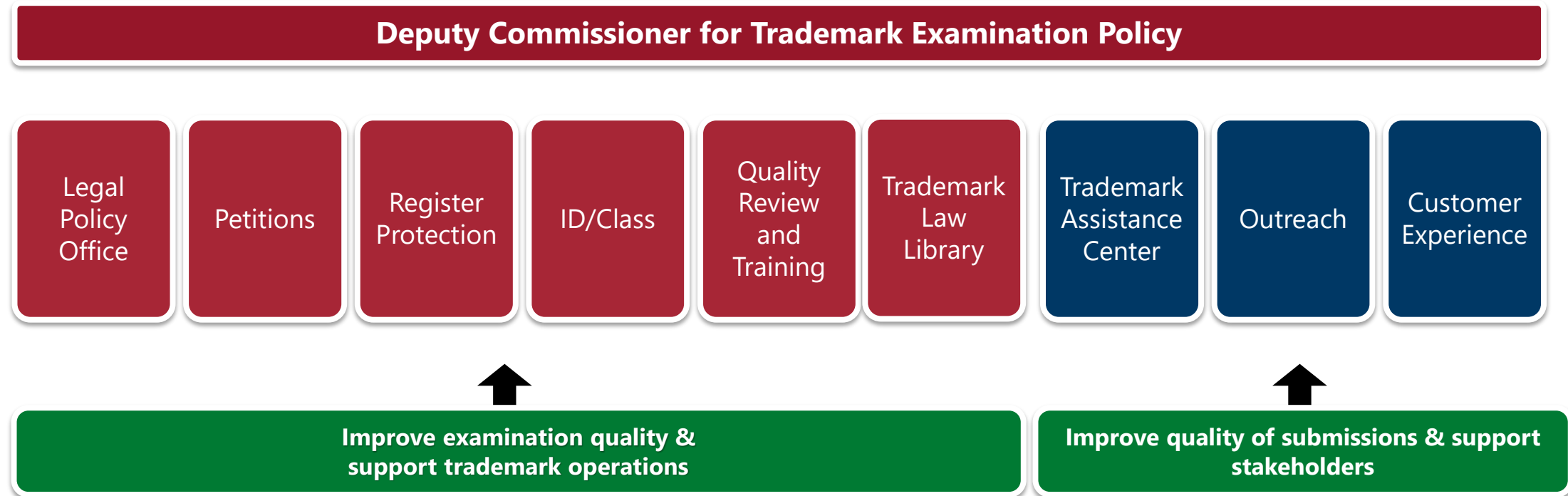
Montia Pressey, Director for Trademark Register Protection

United States Patent and Trademark Office

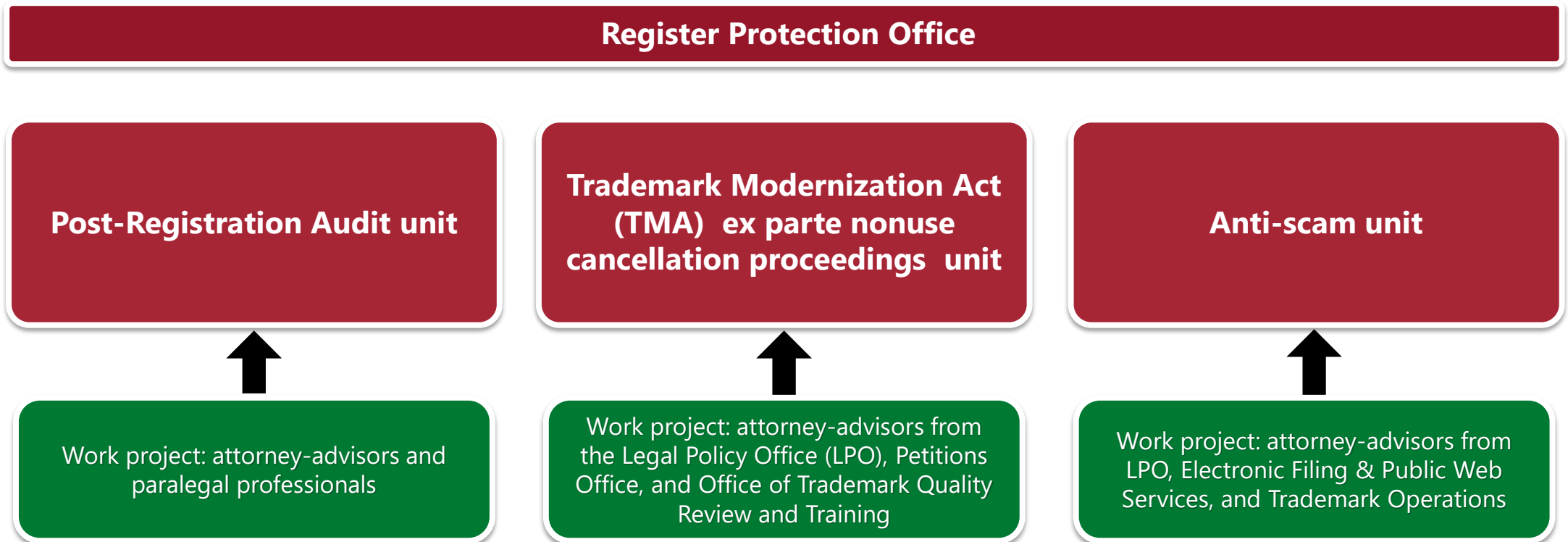


UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Examination policy structure



Register Protection Office



Scam types

Scam type 1

- Scammers mislead customers to pay inflated fees for fake or unnecessary services

Scam type 2

- Scammers impersonate the USPTO

Scam type 3

- Scammers hijack applications and registrations

Scam type 4

- Scammers hijack or rent attorney credentials

Register protection program

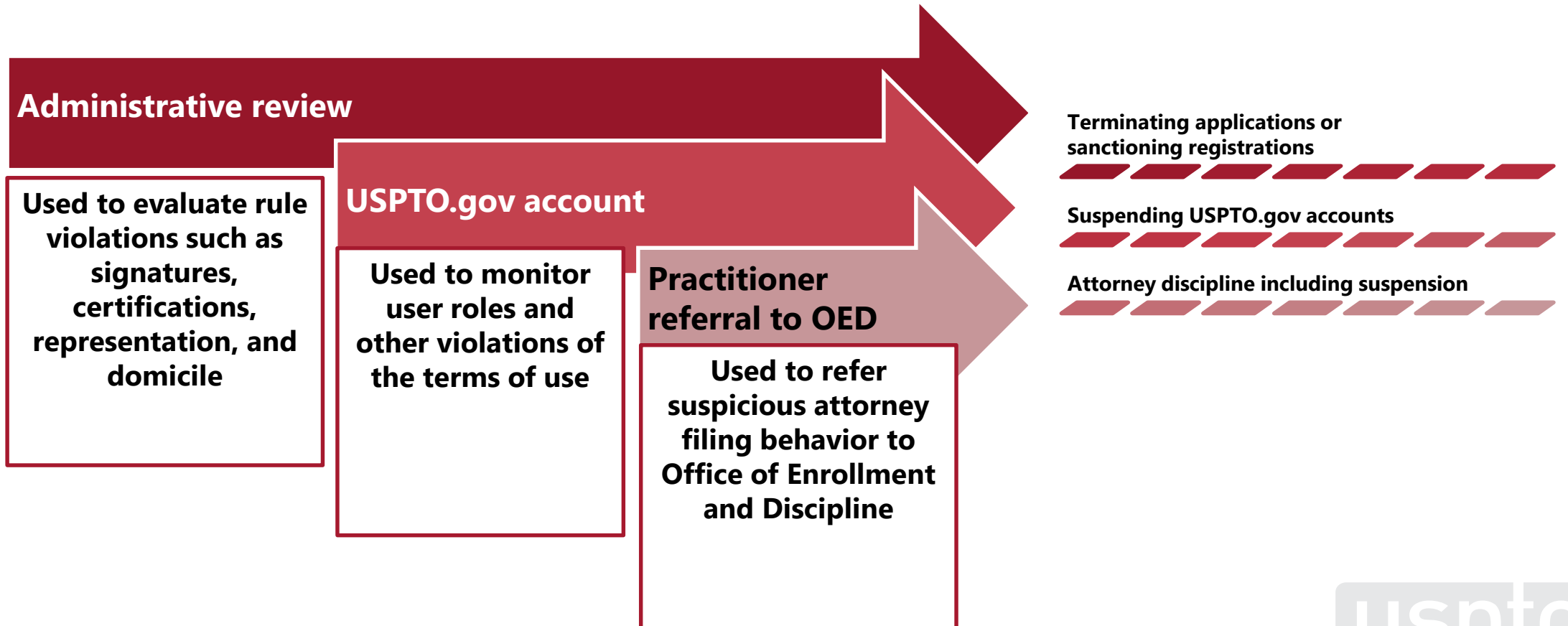
Internal tools

- **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



USPTO rules and terms of use

Representation

- Do you have authority to represent the applicant or registrant under 37 CFR §11.5?

Application or filing preparer

- Do you have authority to prepare the filing under 37 CFR §11.5?

Authorized signatory

- Do you have authority to sign a submission under 37 CFR §2.193? (signatures are non-delegable)

Validate, certify, and transmit

- Can you make the necessary certifications under 37 CR §11.18(b)?

US counsel rule - domicile

- Did you provide an unacceptable domicile address to circumvent 37 CFR §2.11?

TM verified account agreement

- Does your filing activity match your user role?



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

Jerome Eady

- **Show cause order** – clone scheme
- 70 applications (1/17/2023)

ASIN

- **Show cause order** – Unauthorized practice of law (UPL), signatures, specimens
- 426 applications; 4957 registrations (12/13/2023)

Sellergrowth

- **Show cause order** – UPL, signatures, specimens
- 61 applications and 13,009 registrations (9/7/2022)

Haiyi

- **Show cause order** – UPL, signatures, specimens
- 1299 applications and 950 registrations (8/25/22)

Abtach

- **Final order for sanctions** – UPL, signatures, specimens
- 5458 applications and 70 registrations (11/3/21)

Huanyee

- **Final order for sanctions** – UPL, signatures, specimens
- 12,565 applications and 3227 registrations (6/8/21)

Xue Chaoxing

- **Final order for sanctions** – clone scheme
- 11 applications (5/6/21)

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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

Trademark Decisions and Proceedings

Expungement/Reexamination Proceedings | Administrative Orders and Sanctions | Precedential Director Decisions | TTAB Reading Room | Open Data | Help

Search administrative orders and sanctions metadata/attributes and document text

Filter by

Date range

Party name(s)

Document type

Sponsored account suspension order

Show-cause

Administrative order

Sanctions

Administrative Orders and Sanctions

685 Results found Page updated: Mar 14, 2023, 3:32:37 PM EST

	Name <input type="button" value="↑↓"/>	Date <input type="button" value="↑↓"/>	Document type <input type="button" value="↑↓"/>
+	In re Jerome Eady, Jr.	02/16/2023	Sanctions
+	In re Jerome Eady, Jr.	01/17/2023	Show-cause
+	In re Asin Enter. Mgmt. Consulting Ltd. Co.	12/12/2022	Show-cause
+	In re Adam Klein	12/09/2022	Administrative order
+	In the matter of USPTO.gov Accounts Sponsored by Grace ...	09/16/2022	Sponsored account suspension order
+	In the matter of USPTO.gov Accounts Sponsored by Julian ...	09/16/2022	Sponsored account suspension order
+	In re Shenzhen Seller Growth Network Tech, Ltd., et al.	09/07/2022	Show-cause
+	In re Shenzhen Haiyi Enter. Mgmt. Co., Ltd., Haiyi Ente ...	08/25/2022	Show-cause
+	In re Quanzhou Rishang Imp. and Exp. Co., Ltd.	08/16/2022	Sanctions
+	In re Ningbo Xiye Elec. Commerce Co., Ltd.	08/16/2022	Sanctions
+	In re Mingze Sui	08/16/2022	Sanctions
+	In re Liang ChunShi	08/16/2022	Sanctions
+	In re Jin Jing	08/16/2022	Sanctions

TM decisions - Expungements (uspto.gov)



Protect against scams

- > What to do if scammed
- > Understanding filing firms
- > Administrative orders process
- > Watch out for counterfeit goods



Maintain your registration

- > How do I renew my trademark?
- > What happens if my trademark registration is audited?



Laws and rules

- > Trademark Modernization Act
- > Rule making
- > Examination guides

Impacted by the Abtatch investigation
Abtatch, 360 Digital Marketing, and Retrocube investigated for suspicious filings.
Check to see if your trademark application may be impacted.

Search (TESS)
Select (ID Manual)
Forms (TEAS)
Status (TSDR)

NEW TOOL

Trademark Decisions and Proceedings search tool

IP IDENTIFIER

Learn the type of intellectual property you have and how to protect it.

EVENT SERIES

USPTO ONLINE EVENT

Trademark Basics Boot Camp



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

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

TMA petition numbers

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



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

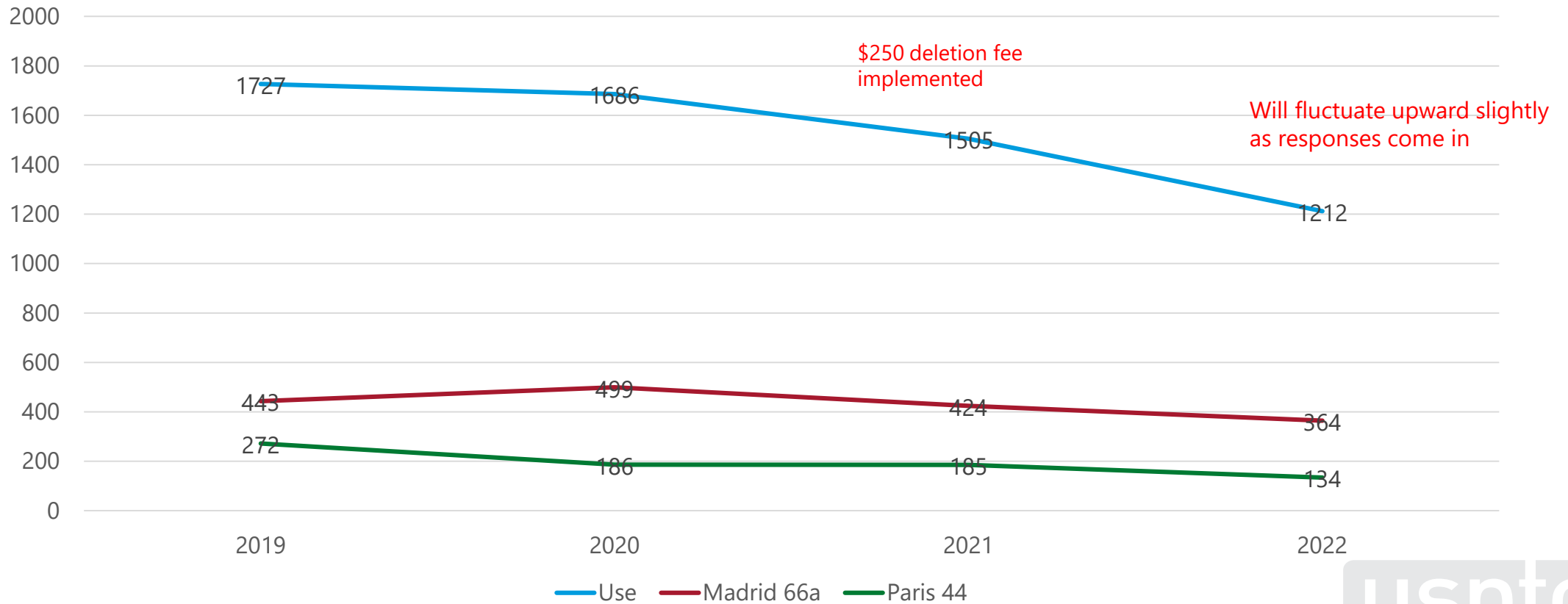
Any time registrant is required by the audit examiners to provide proof of use or by the Post-Registration examiners to provide specimens of use and cannot, registrant must pay a \$250 per deletion fee

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



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, TMAAlerts, 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 TMAAlerts

Trademark Alert

To protect the trademark community against fraud, the USPTO 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

- > Spoofing phone numbers
- > Foreign filing firms improperly soliciting U.S.-licensed attorneys
- > Applications terminated because of Abtch Ltd.
- > Criminal conviction in trademark solicitation scam



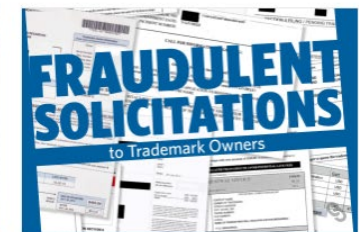
VIDEO

Protect yourself against trademark fraud



DIRECTOR'S BLOG

USPTO's comprehensive strategy to fight trademark fraud



DIRECTOR'S BLOG

USPTO fights trademark scams

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

