

The Trademark office

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Commissioner for Trademarks

UNITED STATES
PATENT AND TRADEMARK OFFICE



Trademarks updates

- TM Business operations metrics
- TM Business financial performance
- Fee Rule
- Protecting the Integrity of the Trademark Register
- Helping our customers
- Protecting our customers
- New initiatives

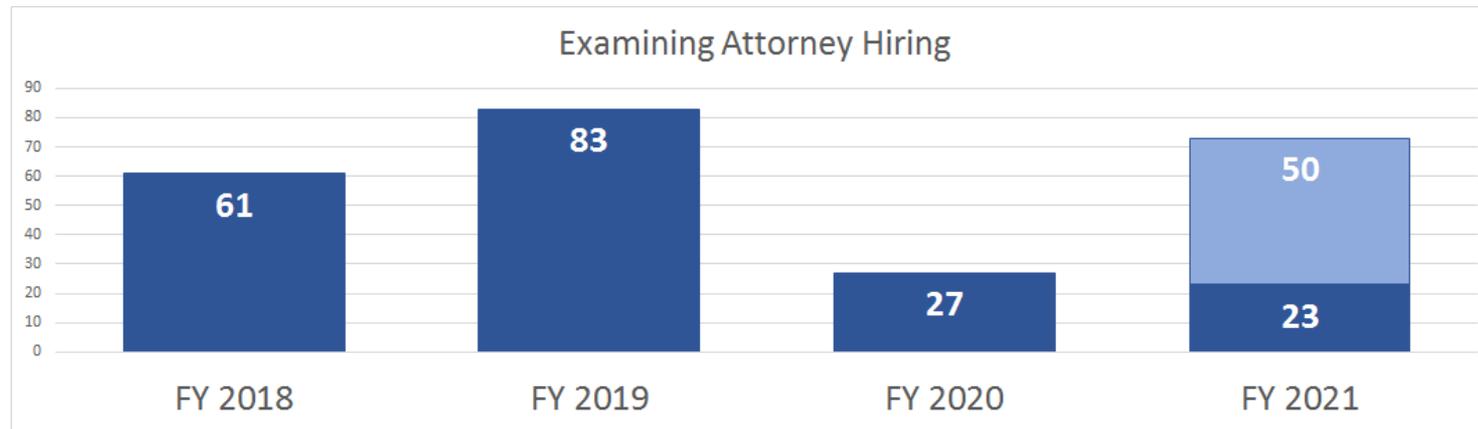
TM business operations metrics

Trademarks organization staffing

940 Trademarks employees (7% of USPTO)

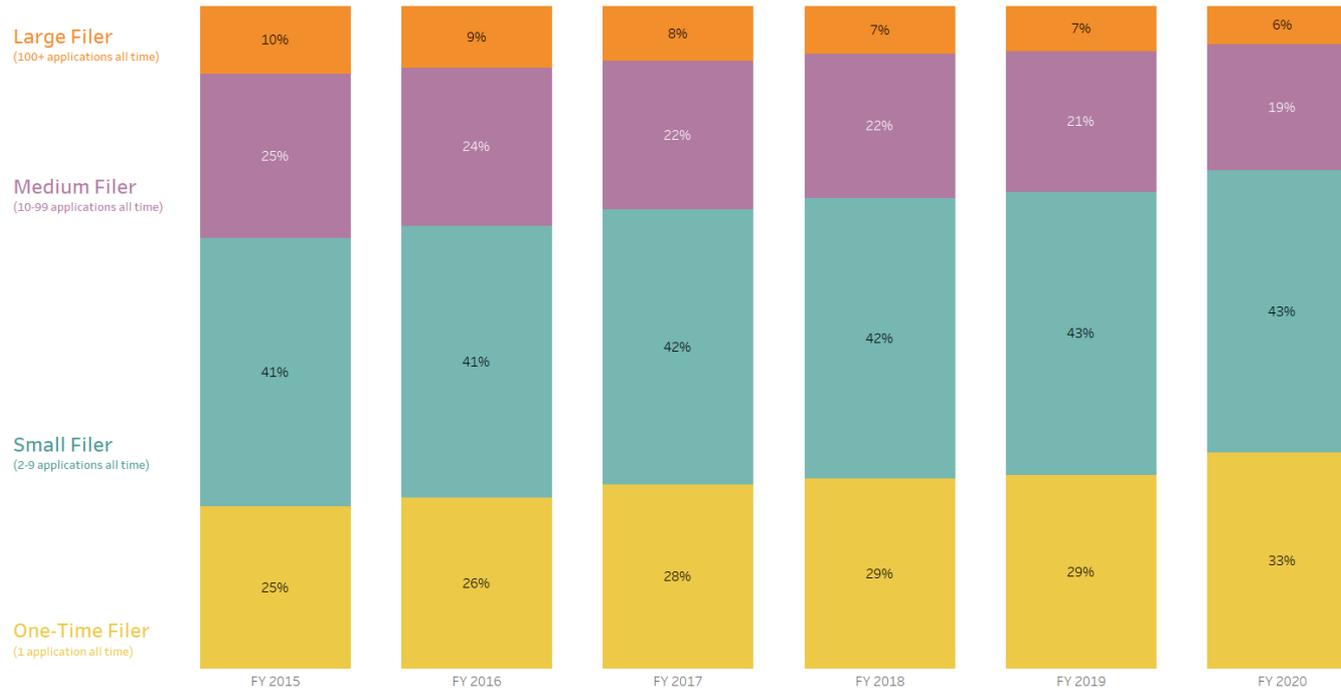
623 examining attorneys (67% of Trademarks)

100% of employees have the option to telework during the pandemic

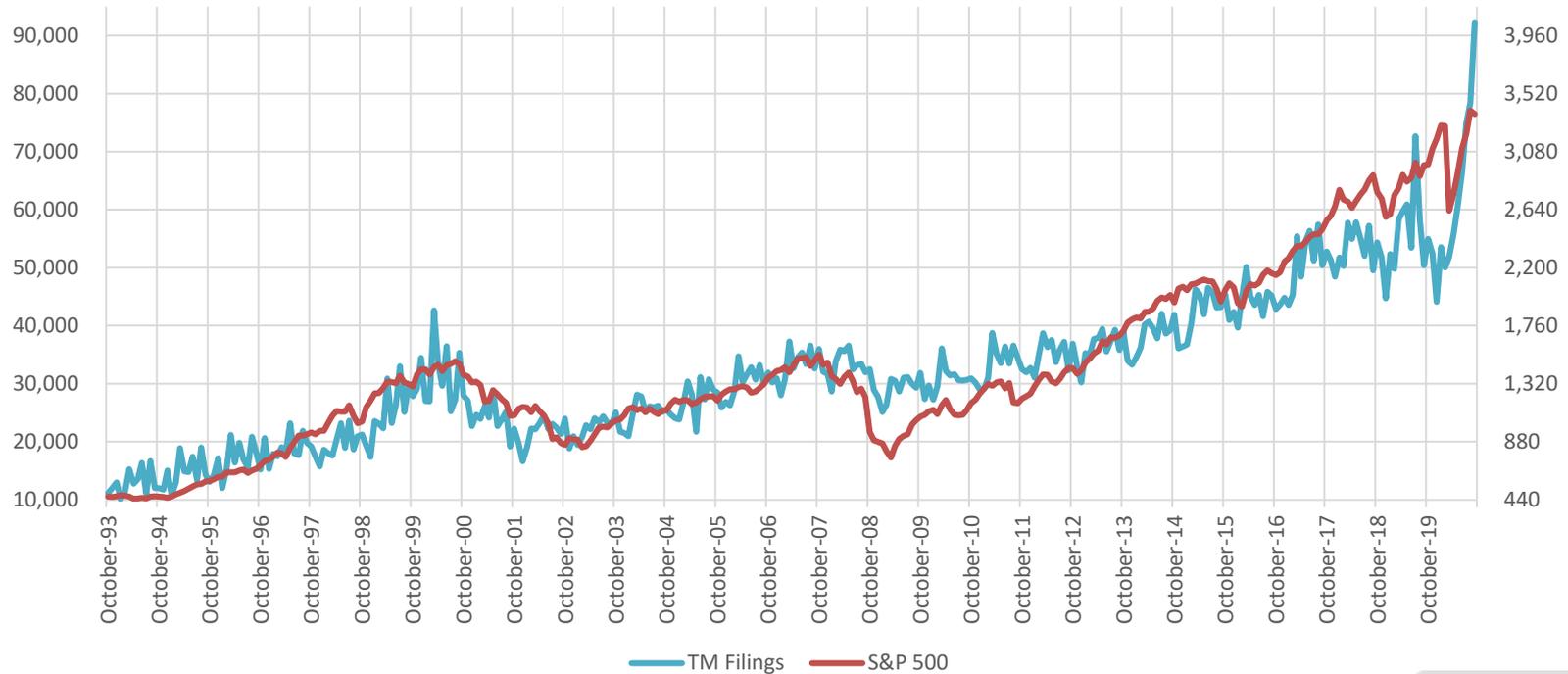


76% of all cases: Filed by applicant with less than 10 applications all-time

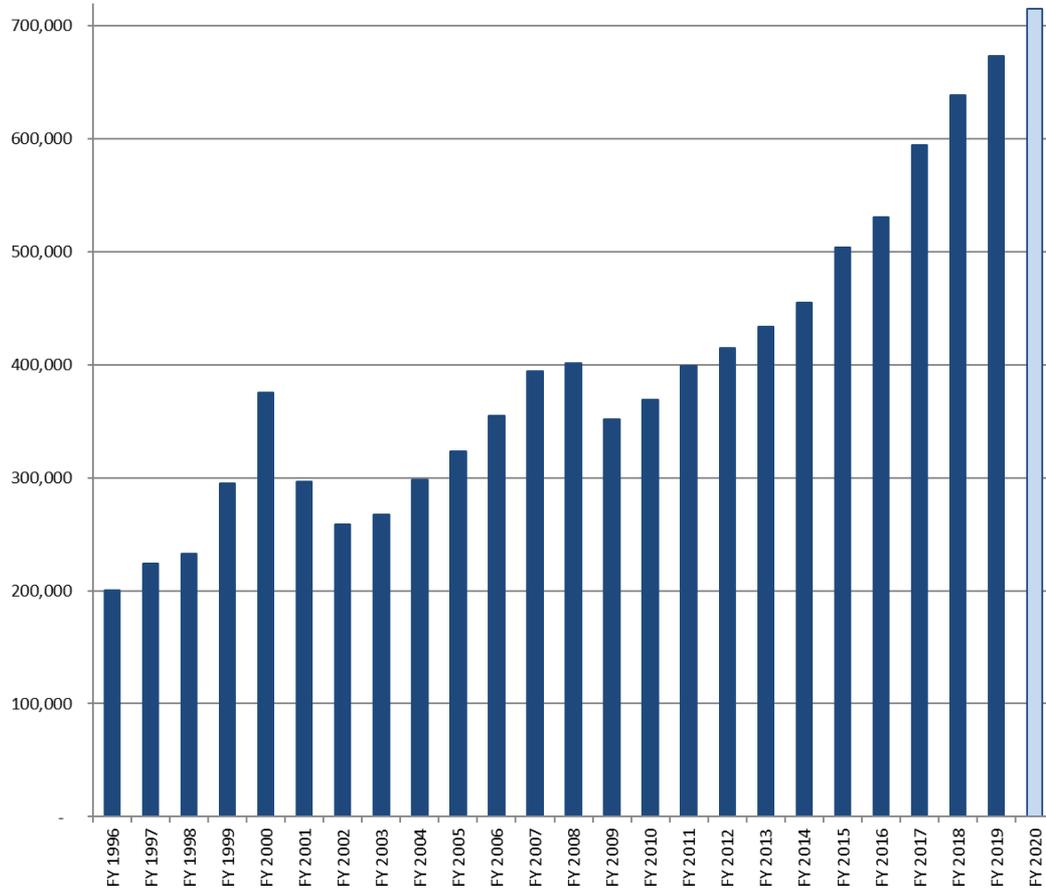
Filer Type: Filings (Cases) by Fiscal Year



Trademark monthly filings vs. S&P 500 monthly average closing price



Trademark application filing levels



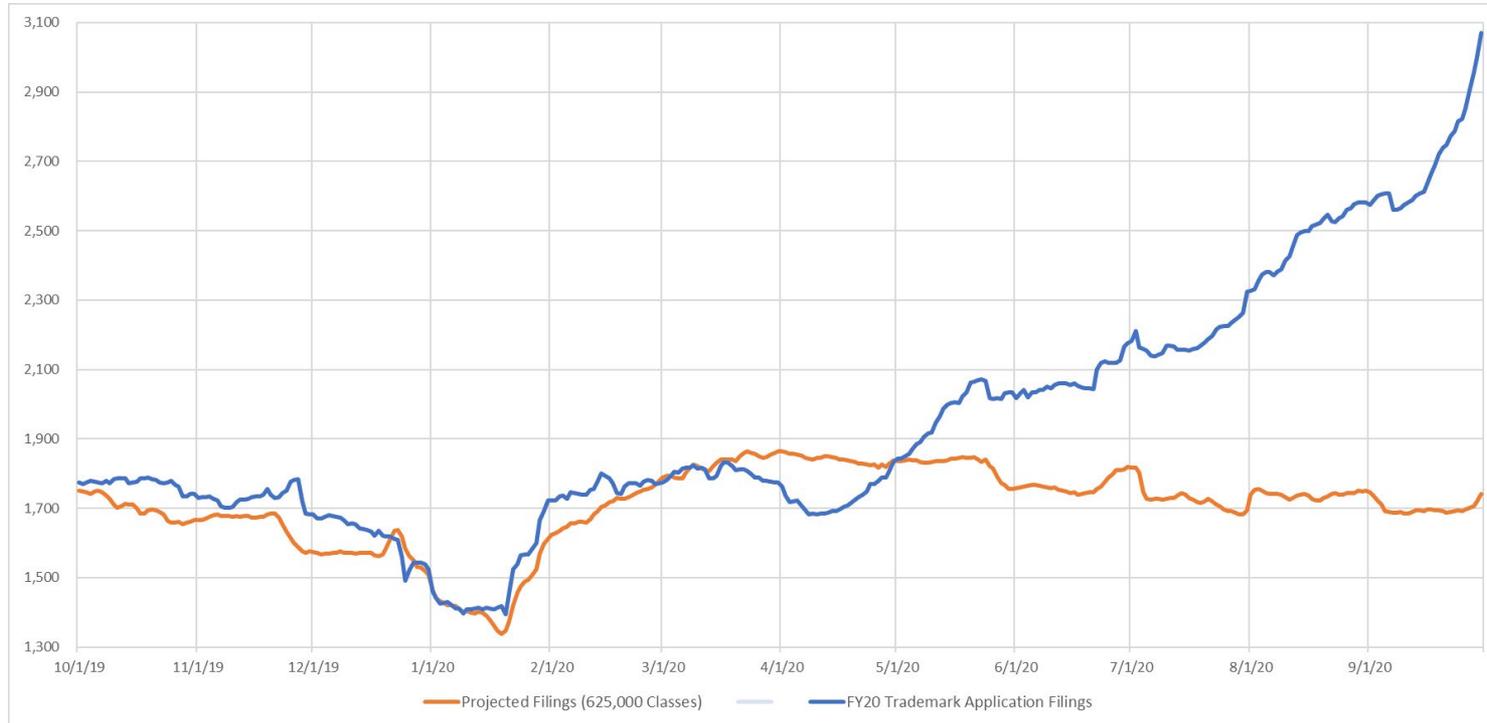
FY 2020 projected:
625,000 classes
projected
(7% decrease)

FY 2020 actual:
738,112 classes
approx.
(9.5% increase)



FY20 daily trademark application filings

Actuals compared to revised plan (625,000 classes)



TM Filings - story of two halves

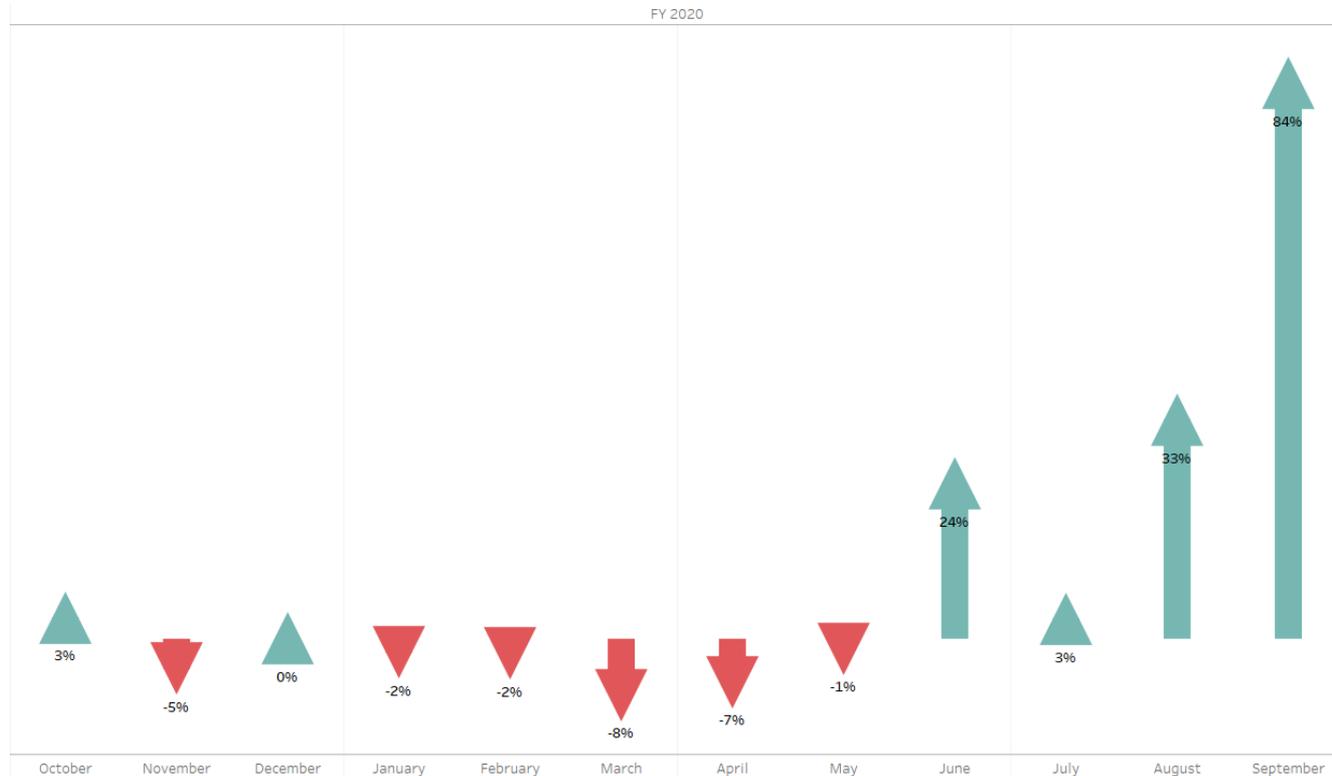
1st-half: first sustained negative growth

2nd-half: unprecedented growth

Year-Over-Year: Quarterly Growth

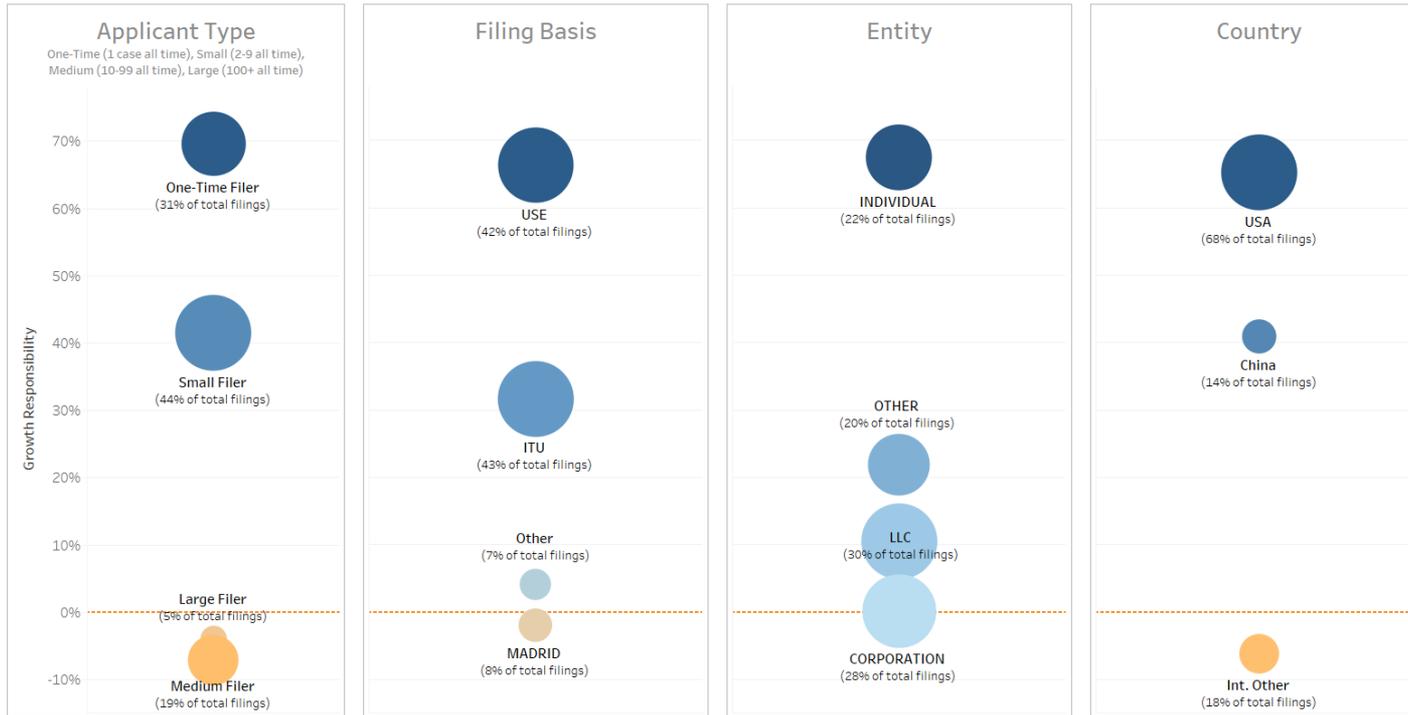


FY20 Year-Over-Year: monthly growth

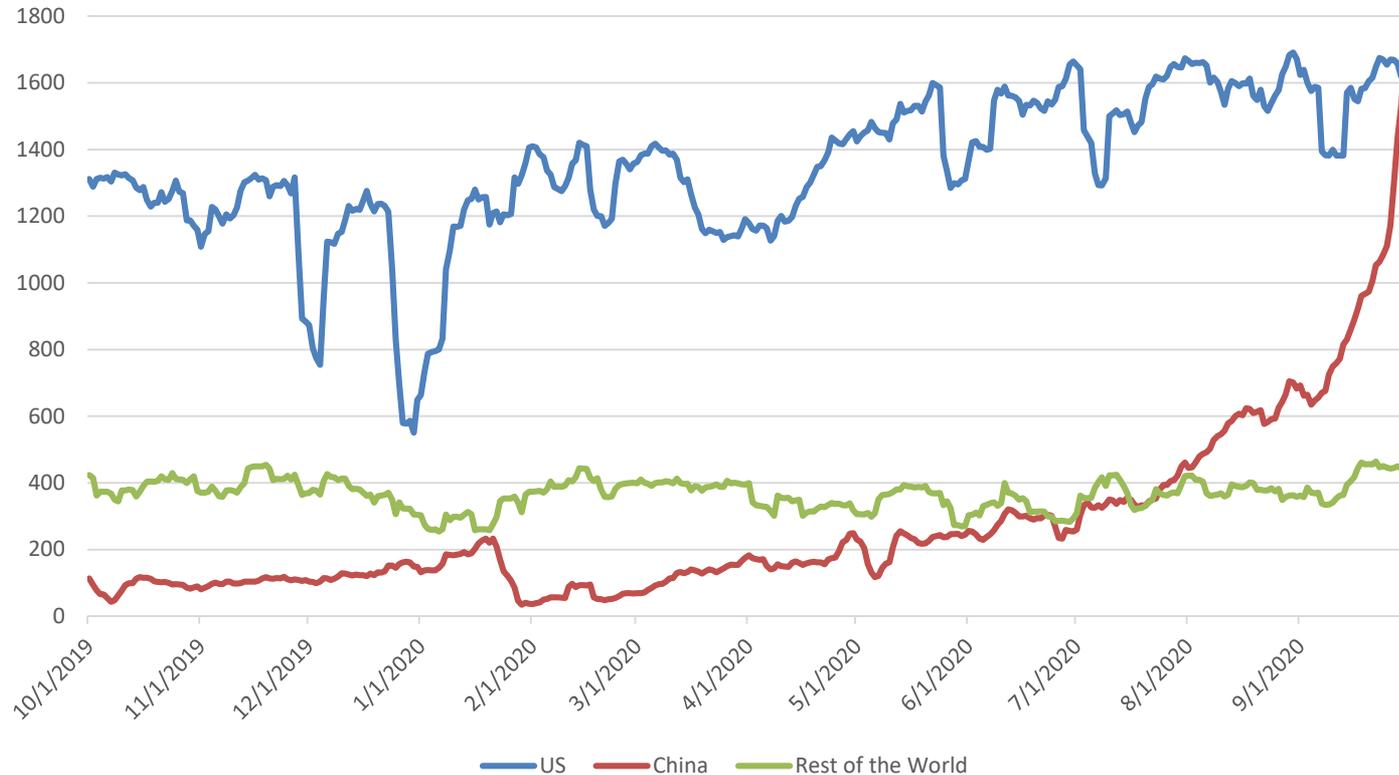


Who drove the growth in FY20?

Filers with less than 10 applications all-time; Use and ITU; Individuals; USA and China



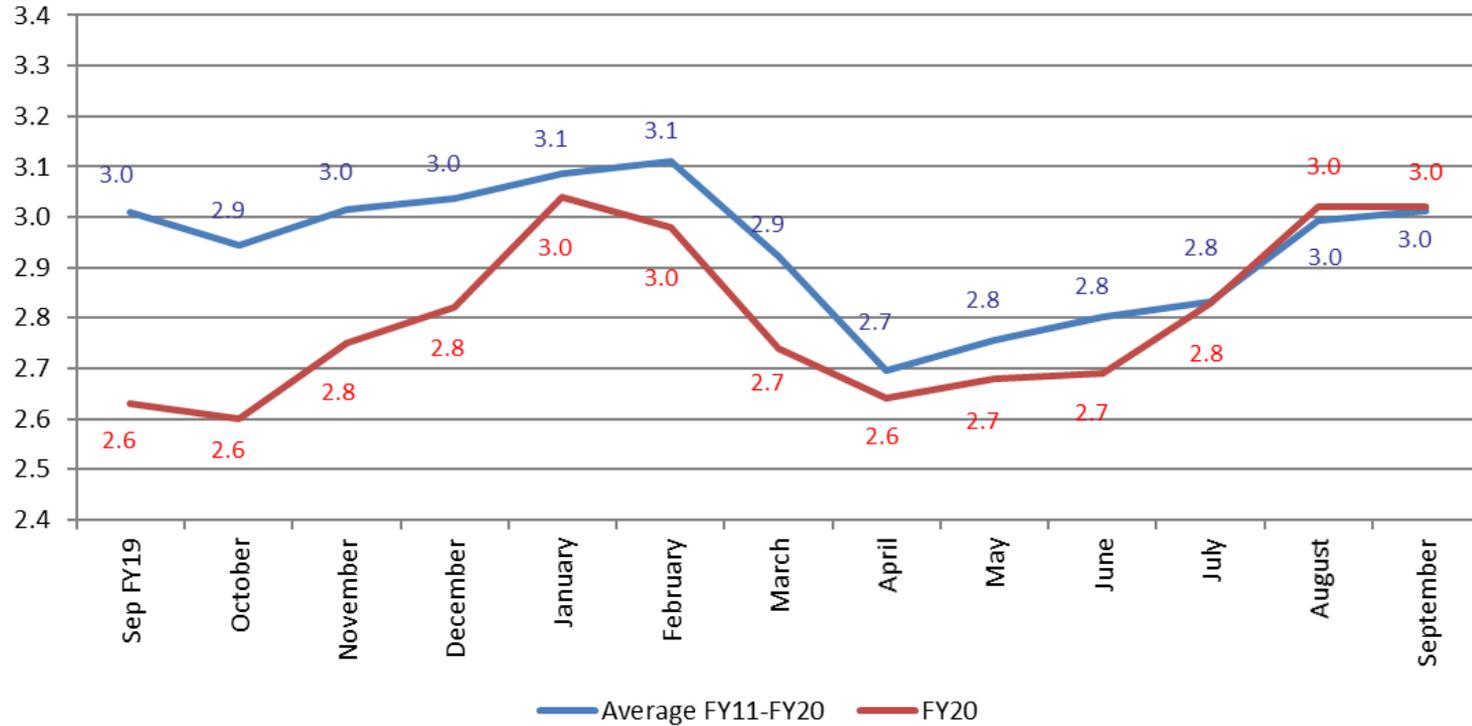
FY 2020 USPTO Application Filings from the US, China, and the Rest of the World



Trademarks performance: pendency

FY 2020 Trademarks performance measures	FY 2020 targets	FY2020 results
First action pendency First action pendency from date of filing to the first office action in months	2.5-3.5	3.0
Disposal pendency Disposal pendency from date of filing to issuance of a notice of allowance, registration, or abandonment — excluding suspended and inter partes proceedings	12.0	9.5

FY20 First action pendency vs. 10-year average



Trademarks performance: quality

FY 2020 Trademarks performance measures	FY 2020 targets	FY 2020 results
First action compliance In-process review evaluation of the statutory bases for which the USPTO raises issues and/or refuses marks for registration based on the first office action	95.5%	95.7%
Final action compliance In-process review evaluation of the statutory bases for which the USPTO raises issues and/or refuses marks for registration based on the examining attorney'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	50.0%	51.0%

Trademarks fee rule

Fee rulemaking

Two-year process:

- TPAC public hearing on September 23, 2019
- Notice of Proposed Rulemaking published in the Federal Register on June 19, 2020
- Comment period ended on August 3, 2020

Notice is posted at [uspto.gov](https://www.uspto.gov) at:

<https://www.uspto.gov/about-us/performance-and-planning/fee-setting-and-adjusting#tmfee-info>

Fee rulemaking

Going forward:

- Reviewing comments and considering the economy
 - Adjusting where needed/appropriate
- Internal, DOC and OMB clearance
- Final publication
- Timeframe

Protecting the integrity of the U.S. trademark register

Protecting the Integrity of the TM register

- Recall that use in interstate U.S. commerce is required
 - To obtain and/or maintain U.S. registration
- To protect the integrity of the register
 - Ensure actual use in commerce is proven
 - In filings and renewals
 - Otherwise, register becomes cluttered with “dead wood”
- Three pronged approach
 1. Use of proper specimens
 2. Proof of Use Audit program
 3. U.S. Counsel rule

Protecting the TM register: Specimens

- Ensure legally acceptable specimens being used
 - Some applicants trying to submit computer generated, digitally altered and fake specimens
 - Examiners trained to spot and refuse them
 - AI-aided tool in development (ASAP)
 - Examination policy/procedure being revised
 - To protect good faith filers
 - Launching this month
- Reporting fake specimens
 - Email us: TMSpecimenProtest@uspto.gov
 - Letters of Protest

Protecting the TM register: Proof of Use Audit program

Why the need?

Overall program stats (Nov 2017–Sept 2020):

- 12,740 first actions issued by examiners on project
- 9,219 responses received
- 4,759 responses deleted goods/services/classes in response to audit
- 987 registrations that have been audited have since been cancelled

Proof of Use Audit program

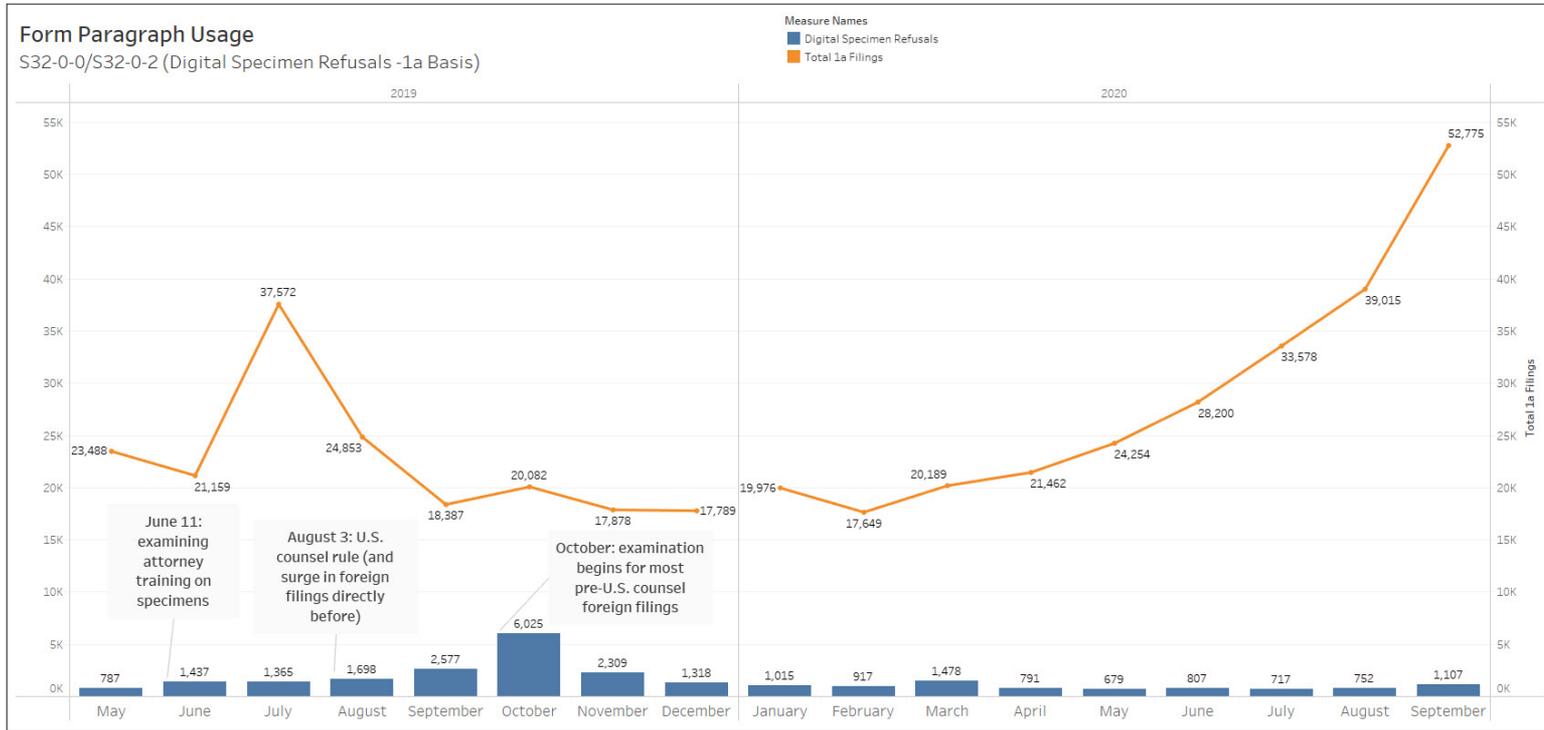
Deletions in registrations where either a response was filed deleting goods or services or the registration was cancelled (Nov 2017–Sept 2020):

FILING BASIS	PERCENT OF REGS W/ DELETED GOODS OR SERVICES
1(a)	52%
1(a) and 44(e)	68%
44(e)	69%
66(a)	70%

Protecting the TM register: U.S. Counsel Rule

- Non-U.S. applicants must use a U.S.-licensed attorney
 - To file documents with the USPTO
- Results:
 - Specimen refusals have decreased
 - TM owners report having to oppose fewer applications

Impact of U.S. Counsel rule on digitally altered specimens



Protecting the TM register: U.S. Counsel Rule

However, circumvention schemes are on the rise

- Unauthorized use of attorney information
- Improper signatures/use of credentials
- Mail drops and false domiciles
- False applicants
- Unauthorized changes of correspondence information

Combating the circumvention schemes

- PTO initiatives and tools
 - Developing policies, procedures, and technology solutions
 - Special task force
 - Show cause orders
 - Mandatory log in
- User tools
 - MyUSPTO account
 - USPTO app

User tools to monitor application and registration activity

- Tools enable users to search for trademark applications and registrations and monitor activity
- Choose from a variety of status change alerts
- Available in the Apple App Store and Google Play

- **MyUSPTO**
 - Set up an account and log in
 - Provides updates on status changes every 24 hours
- **USPTO app** 
 - Does not require a USPTO account
 - Provides updates on status changes in 15 mins or less

Helping our Customers

COVID-19 Stakeholder relief: Fee waivers & extensions

- Petition fee waivers and refunds
 - if the abandonment or cancellation occurred before June 30, 2020, *and* was a result of the COVID-19 outbreak
 - refunded the \$100 Petition to Revive fee in **163** applications
 - refunded or waived the \$100 Petition to the Director fee requesting relief under the CARES Act in **272** petitions
- Deadline extensions
 - Pursuant to authority granted under the CARES Act
 - for filings with due dates between March 27, 2020 and May 30, 2020, statutory deadlines were automatically extended until June 1, 2020
 - Petitions to accept a late filing for deadlines after June 1 are being considered on a case-by-case basis
 - 369 petitions received to date
 - Most are for acceptance of a Section 8 or 71 affidavit after the statutory deadline

COVID-19 Stakeholder relief: Priority examination

- On June 15, the USPTO announced a program to advance the initial examination of applications for marks used to identify qualifying COVID-19 medical products and services
 - USPTO will waive petition fee
 - To date, we have received 191 petitions
 - 92 granted, 12 pending
 - 65% published or approved for publication
 - Additional information and FAQs are on the USPTO website at: www.uspto.gov/trademark/laws-regulations/covid-19-petition-prioritize-applications



Protecting our Customers

Protecting customers: TM scams

- Scams proliferating
 - Just like other forms of TM piracy
- USPTO has limited enforcement authority, but...

TM Scams: USPTO actions

➤ Education and outreach

- Webpage resources with listing of known solicitation scams
- Warnings to filers in Office actions and at registration
- Topic of discussion at events with bar groups and business owners
- Dedicated mailbox to report solicitations to USPTO:
TMScams@uspto.gov

➤ Interagency cooperation

- (USPTO, DOJ, USPIA, and FTC)
- [*United States v. Suhorukovs*, No. 6:20-cr-00210-DCC \(D.S.C.\)](#)

Trademarks initiatives

New initiatives & guidance

- e-Registration certificate initiative
- Generic.tld Exam Guide

Trademarks Business FY21 Priorities

FY 2021 Priorities

- Keep our employees safe, supported, and engaged
- Ensure our performance continues to meet our pendency and quality objectives
- Drive the key FY21 initiatives that support our customers
 - CARES Act programs continue in effect
 - Fighting challenges to the integrity of the TM register
 - Stabilizing and modernizing public and private TM IT systems
- Ensure our trademark organization has
 - Optimum organizational structure; and
 - Adequate funding...

To achieve these priorities and meet our longer term strategic objectives





Thank you!

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Commissioner for Trademarks

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