

Operational News and Updates

Mary Boney Denison

Commissioner for Trademarks

October 31, 2017

UNITED STATES
PATENT AND TRADEMARK OFFICE



Organization and Statistics

October 31, 2017

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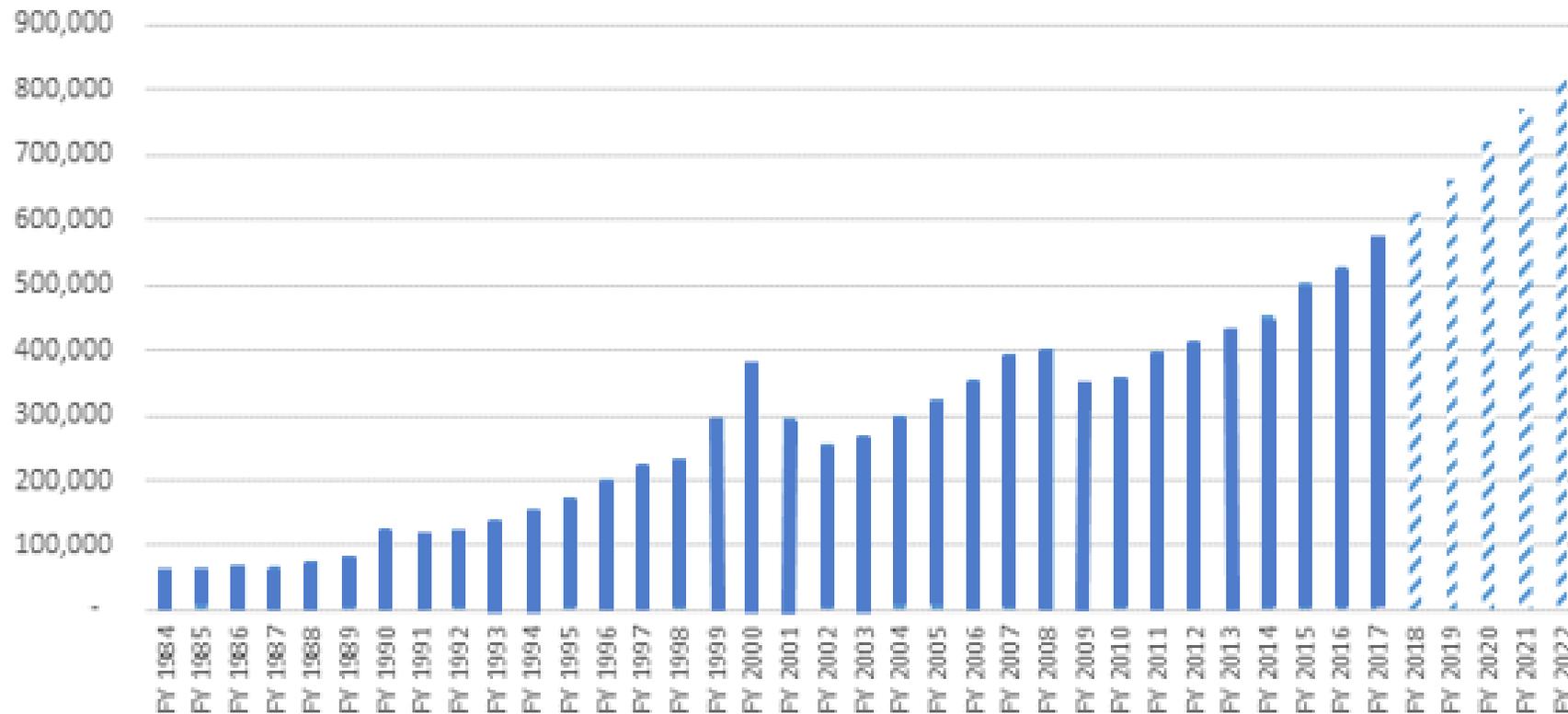
Trademark Organization Staffing

- 834 Trademark employees
(7% of USPTO)
- 548 examining attorneys
(66% of Trademarks)
- 68% of examining attorneys
telework full time
- Announcement for new examining attorneys closed:
Interviews will be conducted soon
- Planning to hire ~50-65 this Fiscal Year

New Application Filings

- FY16: 530,270 classes filed FY17: 594,107 classes filed
- FY17 up 12% compared to FY16.

Applications for Registration - Classes



Trademark Performance: Pendency

FY 2017 Trademark Performance Measures	FY 2017 Targets	FY 2017 Results
First Action Pendency First action pendency from date of filing to first office action in months.	2.5 – 3.5	2.7
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	9.5

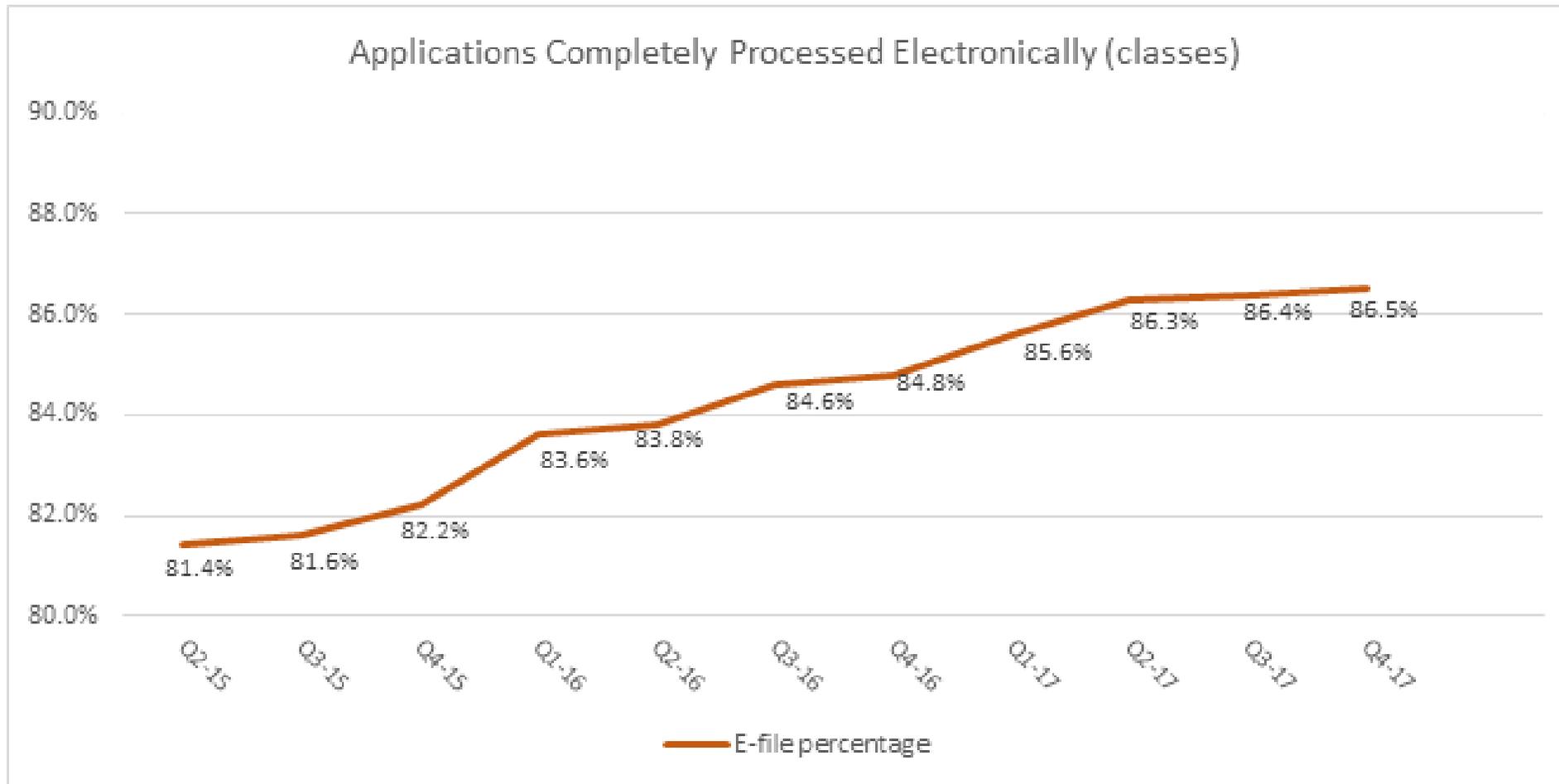
Trademark Performance: Quality

<i>FY 2017</i> <i>Trademark Performance Measures</i>	FY 2017 Targets	FY 2017 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%	97.3%
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%	98.3%
Exceptional Office Action Measure indicating the comprehensive quality of the first Office action search, evidence, writing and decision making.	42.0%	45.0%

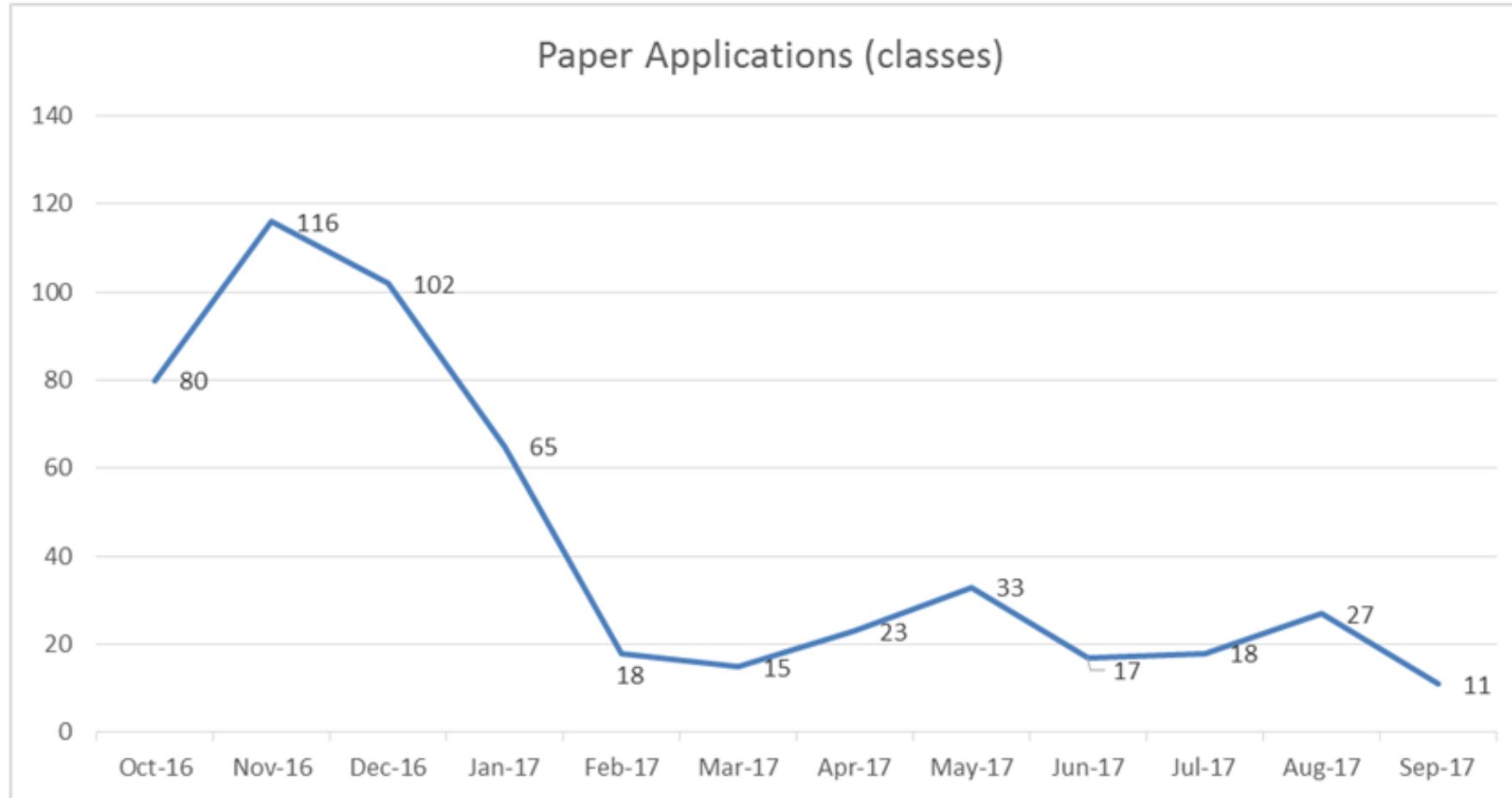
E-Government Statistic

- 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 fall of 2018**

E-Government



Fee Change Effect on Paper Applications



Fees: No Longer Accepting Cash Payments

- Effective tomorrow, November 1, 2017, the Office will no longer accept payment for fees in cash. We will continue to accept payment by deposit account, credit card, EFT, and check at the cashier's window, and through U.S. mail and TEAS.

Trademark IT News

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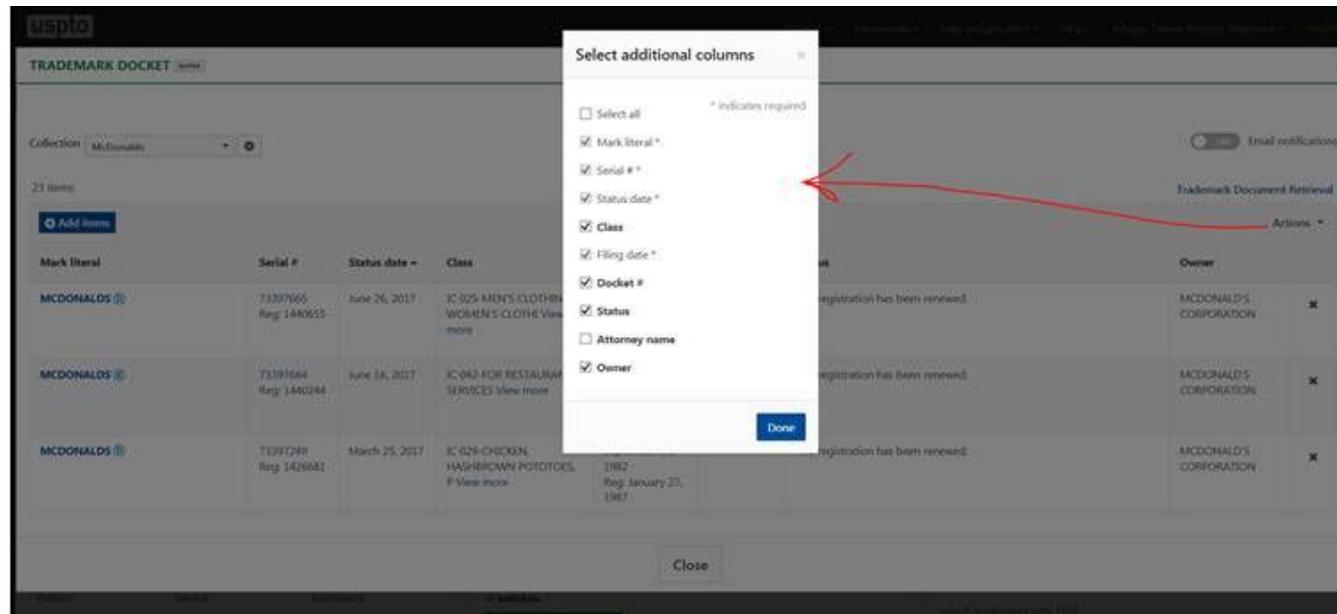


My.USPTO.gov

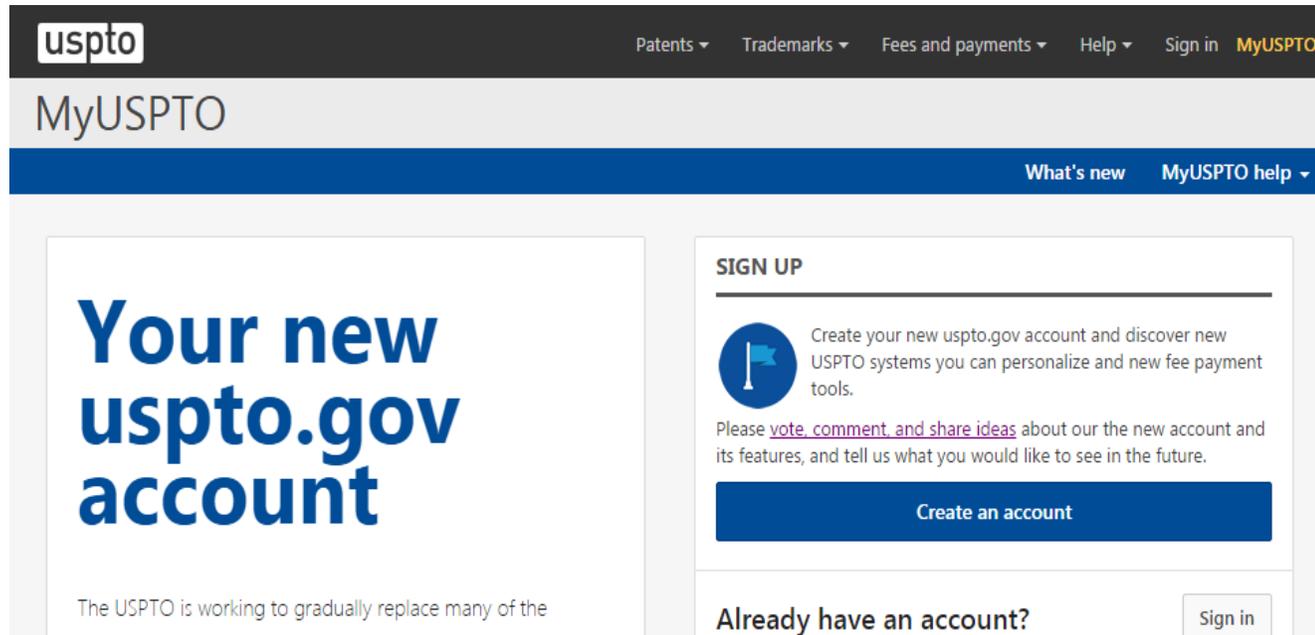
- **Trademark Docket**
 - Stores and monitors up to 1,000 applications and registrations
 - Sends e-mail notification of status changes
- **Trademark OG Watch**
 - Stores searches
 - Sends email notification when there are new hits on saved TMOG searches
- **EZ File**
 - Working on a simple application for ITU word marks using TEAS RF.
- **Form Finder**

My.USPTO.gov Update cont.

- Latest enhancement to note: custom column feature, which allows users to decide what data fields are displayed in their full screen view of the Trademark docket



The uspto.gov user account



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', and 'Sign in MyUSPTO'. Below this is a light gray header with 'MyUSPTO' and a blue bar with 'What's new' and 'MyUSPTO help'. The main content area is split into two columns. The left column features a large blue heading 'Your new uspto.gov account' and a sub-heading 'The USPTO is working to gradually replace many of the'. The right column is titled 'SIGN UP' and contains a blue flag icon, a paragraph of text: 'Create your new uspto.gov account and discover new USPTO systems you can personalize and new fee payment tools. Please [vote, comment, and share ideas](#) about our the new account and its features, and tell us what you would like to see in the future.', a blue 'Create an account' button, and a 'Sign in' button. Below the sign-up section is a link 'Already have an account?'.

<https://account.uspto.gov>

- Users **register once** to set up a profile and establish the account credentials (login/password)
- Users can then **sign-in** using the credentials, and **access all USPTO systems** that have adopted the **uspto.gov user accounts**
 - MyUSPTO, Financial Manager, Patent Maintenance Fee storefront have already adopted the uspto.gov user accounts
 - Many more USPTO systems are moving to **adopt** the uspto.gov user accounts. Stay tuned!

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 dark blue bar contains 'What's new' and 'MyUSPTO help'. A dropdown menu is open from the 'MyUSPTO help' link, showing options: 'Feedback' (highlighted in yellow and circled in blue), 'FAQs', and 'Tutorial'. The main content area features three panels: 'USPTO FEES BETA' with sub-sections for Patent, PCT, Trademark, and General; 'TRADEMARK APPLICATION DOCKET ALPHA' with a 'Create a new collection' button; and 'TRADEMARK POST-REGISTRATION DOCKET ALPHA' with a 'Create a new collection' button.

Trademark App

Open Source Code on Github

- Source code for a mobile application for trademarks
- Receive a push notification anytime the status of a trademark application changes
- Try it and let us know what you think
- See: <https://github.com/USPTO/TrademarkStatusApp>



Trademark Rules of Practice

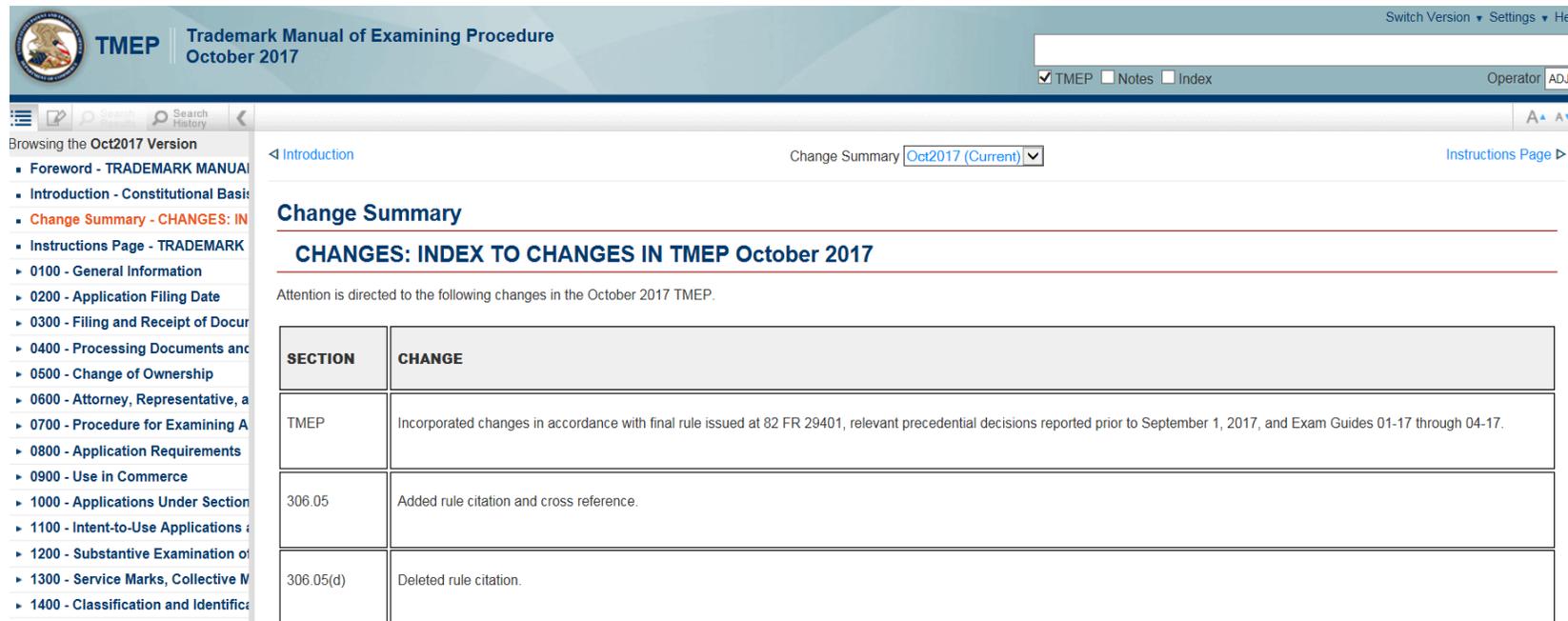
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TMEP Update

- October 2017 update has been posted. An index to changes is included



The screenshot shows the TMEP website interface. The header includes the USPTO logo, the title 'TMEP Trademark Manual of Examining Procedure October 2017', and navigation links for 'Switch Version', 'Settings', and 'Help'. Below the header, there is a search bar and a dropdown menu for 'Change Summary' set to 'Oct2017 (Current)'. The main content area is titled 'Change Summary' and 'CHANGES: INDEX TO CHANGES IN TMEP October 2017'. A note states: 'Attention is directed to the following changes in the October 2017 TMEP.' Below this is a table with two columns: 'SECTION' and 'CHANGE'.

SECTION	CHANGE
TMEP	Incorporated changes in accordance with final rule issued at 82 FR 29401, relevant precedential decisions reported prior to September 1, 2017, and Exam Guides 01-17 through 04-17.
306.05	Added rule citation and cross reference.
306.05(d)	Deleted rule citation.

ID Manual Update

- The contents of the entire manual and search results can now be downloaded in Excel[®], HTML or XML
- Users can also customize the content when downloading
- On January 1, 2018 the eleventh edition of the Nice Classification, version 2018 (Nice 11-2018 or NCL 11-2018) will go into effect. The USPTO ID Manual will reflect those changes on January 1, 2018.

Screenshot of ID Manual

The screenshot shows the USPTO ID Manual search results for the term "legal services". The page displays a table of 124 records. A dialog box titled "Download search results (124 records)" is open, allowing the user to choose a format and columns to export. The dialog box has two dropdown menus for "Format:" and "Columns to export:". The "Format:" dropdown is set to "Excel". The "Columns to export:" dropdown is set to "HTML". The dialog box also has checkboxes for selecting specific columns: Term ID, Class, Description, Status, Effective Date, Type, Notes, TMS, and NCL Version. The "Download" button is highlighted in blue.

Term ID	Class	Description	Status	Effective Date	Type	Notes	TMS	NCL Version
045-2552	045	Legal services	M	01/01/2007	SERVICES	Transferred from Class 42 based on the 9th edition of the More >	T	09-2007
045-2551	045	Legal research	M	01/01/2007	SERVICES	Transferred from Class 42 pursuant to 9th edition of the N More >	T	09-2007
045-2580	045	Legal advisory services			SERVICES			10-2015
045-974	045	On-site legal services			SERVICES			09-2007
045-1124	045	Trademark monitoring legal services			SERVICES		T	10-2012
045-1079	045	Legal consultation services			SERVICES			09-2007
045-2361	045	Pro bono legal services			SERVICES	On 07-26-2012, this 04-02-1991 entry was modified by inser More >		10-2014
045-1193	045	Legal document preparation services			SERVICES			10-2013
045-2547	045	Mediation legal services			SERVICES	Legal document preparation refers to personalized services More >		10-2013
045-2644	045	Legal support services			SERVICES	Transferred from Class 42 pursuant to the 9th edition of t More >	T	09-2007
045-2578	045	Legal information services			SERVICES		T	11-2017
045-782	045	Patent licensing legal services			SERVICES		T	10-2015
045-726	045	Cartoon character licensing legal services			SERVICES	Transferred from Class 41 pursuant to 9th edition of Nice More >	T	09-2007
045-2537	045	Legal services, namely, process serving			SERVICES	Transferred from Class 35 pursuant to 9th edition of Nice More >		09-2007
042-1782	042	Electronic legal discovery consulting services			SERVICES	Transferred from Class 42 based on the 9th edition of the More >		09-2007
045-2648	045	Licensing of trademarks legal services			SERVICES	On 5-5-2011, this 9-11-2008 ID was deleted because it is b More >		09-2007
041-1905	041	Videotaping legal depositions			SERVICES		T	11-2017
045-1028	045	Legal services, namely, service of actual legal notice			SERVICES	These services were transferred to Class 41 due to the res More >		08-2002
045-2533	045	Legal services and legal consultation for medical imaging centers			SERVICES			09-2007
045-796	045	Legal services, namely, trademark maintenance services			SERVICES	Transferred from Class 42 based on the 9th edition of the More >		09-2007
045-783	045	Legal services, namely, providing legal consultation in the area of health issues by a legal nurse			SERVICES			09-2007
045-730	045	Licensing of computer software legal services			SERVICES			09-2007
045-729	045	Licensing of intellectual property legal services			SERVICES			09-2007
035-2511	035	Business administration of pre-paid legal services			SERVICES	Transferred from Class 35 pursuant to 9th edition of Nice More >	T	09-2007
035-420	035	Providing legal docket management services for others			SERVICES	Transferred from Class 42 pursuant to 9th edition of Nice More >	T	09-2007
036-159	036	Underwriting insurance for pre-paid legal services			SERVICES			10-2013
045-2647	045	Licensing of registered designs legal services			SERVICES			07-1997
045-2646	045	Licensing of patent applications legal services			SERVICES			07-1997
045-1207	045	Legal consultation in the field of taxation	A	01/12/2017	SERVICES		T	11-2017
045-795	045	Legal services, namely, trademark searching and clearance services	A	10/24/2013	SERVICES	Legal consultation services are classified in Class 45 reg More >		10-2013
045-910	045	Online news reporting and expert legal commentary services in the field of legal news	A	06/21/2007	SERVICES			09-2007
045-909	045	News reporting and expert legal commentary services in the field of legal news	A	11/27/2008	SERVICES			09-2007
045-1002	045	Licensing of software for management of intellectual property legal services	A	11/27/2008	SERVICES			09-2007
045-797	045	Legal services, namely, preparation of applications for trademark registration	A	01/14/2010	SERVICES			09-2007
045-732	045	Licensing of advertising slogans and cartoon characters legal services	A	06/21/2007	SERVICES			09-2007
045-731	045	Licensing of architectural drawings to others legal services	M	01/01/2007	SERVICES	Transferred from Class 35 pursuant to 9th edition of Nice More >		09-2007
045-2546	045	Consulting services concerning legal matters in the medical field	M	01/01/2007	SERVICES	Transferred from Class 35 pursuant to 9th edition of Nice More >		09-2007
045-2550	045	Legal document preparation and research services for attorneys	M	01/01/2007	SERVICES	Transferred from Class 42 based on the 9th edition of the More >		09-2007
035-2580	035	Business administration of employee benefit plans concerning legal services	D	11/28/2013	SERVICES	Transferred from Class 42 based on the 9th edition of the More >		10-2013
045-1047	045	Providing information in the field of intellectual property legal services	A	10/07/2010	SERVICES	On 11-28-2013, this 02-07-2013 entry was deleted and repla More >		10-2013
045-2661	045	Providing legal services to disadvantaged persons through public advocacy programs	A	09/28/2017	SERVICES			11-2017
045-2643	045	Legal services relating to the exploitation of broadcasting rights	A	01/12/2017	SERVICES		T	11-2017
045-2643	045	Legal services relative to the exploitation of film copyright	A	01/12/2017	SERVICES		T	11-2017

Mandatory E-filing

- Plan to make use of TEAS mandatory for all trademark filings
- Notice of proposed rulemaking planned for early 2018
- Implementation likely late 2018

Regulatory Reform

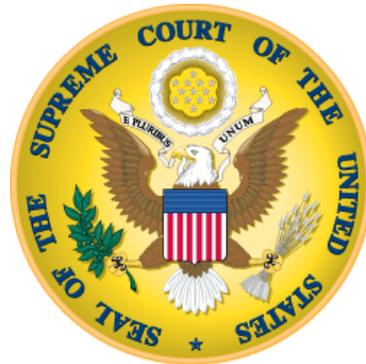
- USPTO Working Group on Regulatory Reform
- See: <https://www.uspto.gov/about-us/working-group-regulatory-reform.html>
- Suggestions to improve, revise, and streamline USPTO regulations: RegulatoryReformGroup@uspto.gov
- Proposed removal of interferences-hasn't been used in over 40 years; NPRM published on October 18, comments are due by November 17.

Recent Examination Guides

- Exam Guide 1, Post Matal v. Tam re: Disparagement Clause of Section 2(a)
- Exam Guide 2, Merely Informational Matter
- Exam Guide 3, Petitions/Reinstatement Rule
- Exam Guide 4, Surname Combined with Wording

Section 2(a)

- Guidance sent out in June after Tam; “The Slants” published August 29.
- Will await *Brunetti* Decision regarding scandalous marks; oral argument last August
- *Blackhorse* allowed to proceed based on Tam decision



Initiatives

October 31, 2017

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Decluttering of Federal Register

Suggested Methods of Improvement from Post-Registration Pilot Program

- **Increase Readability of Declaration**
- **Continue Random Audits of Registrations**
- **Expedited Cancellation Procedures**

Random Audit Program

- All single-class registrations with four or more goods/services in the class and multiple-class registrations in which at least two classes have two or more goods/services in each class are potentially subject to audit.
- Office actions will identify any deficiencies in the underlying affidavit or declaration and will also require “proof of use” for two additional goods/services for each class.

Random Audit Program

No Response or Untimely Response to Office action

- If a timely response is not filed to an Office action, after the expiration of the statutory filing period, **the registration will be cancelled in its entirety.**
- If a timely response is not filed to an Office action, but time remains in the statutory filing period, the registration owner has the option to file **a new maintenance filing, along with all new filing fees.**
- Note that any new filings will also be reviewed for compliance with both statutory and audit requirements, since the registration remains subject to the audit.

Expedited Cancellation Proceedings

- Request for Comments published. See 82 Fed. Reg. 22517; public roundtable held 9/25/17
- Four options initially considered; we are moving forward on two options that do not require a statutory change
- TTAB Streamlined Cancellation Proceedings
 - 1) Abandonment
 - 2) No use as of §1(a) filing date or no use as of the filing date of an AAU/SOU for §1(b)

Fraudulent Solicitations

Raising awareness of schemes to defraud trademark owners:

- Providing general warning in “Trademarks” section of the USPTO website with a **dedicated web page and video** warning people about non-USPTO solicitations. The “Patents” section of the USPTO website has **a similar warning**, which cross-links to the Trademarks section warning page
- 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
- Cooperating with DOJ on criminal prosecutions
- Participating in an informal interagency working group on combatting fraudulent solicitations
- Hosted a roundtable with TPAC on July 26 with numerous bar groups and other government agencies (FTC, DOJ, USPIS, SBA, CBP)

Initiatives to Improve Customer Experience

- Hired Chief Customer Experience Administrator and two plain language writers
- Implementing Deloitte Recommendations such as:
Improving website, making searching more understandable, making ID selection process easier to use and simplifying the filing process
- My.uspto.gov
 - (1) Simplified ITU application form
 - (2) Form finder

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 of 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**

Image Searching

- Members of our Information Technology Staff will be going to Japan next week to discuss the latest developments in Image Searching Technology

TM5 on Bad Faith TM Filings

- TM5 partners – USPTO, SAIC, EUIPO, JPO, and KIPO – continue to make efforts to minimize bad faith trademark filings by:
 - (a) exchanging best practices and
 - (b) working with each other to provide more transparent information to users on how the largest trademark offices combat bad faith trademark filings.
- Most recent seminars: Tokyo, March 2016 and Kunshan City, October 2016 and Barcelona, May 2017
- JPO presented their report at the mid-year meeting in Barcelona in May.
- Attending Annual Meeting in Alicante, Spain at the end of the month.

Common Status Descriptors

STATUS
DOCUMENTS ?
Download
Print Preview

Generated on: This page was generated by TSDR on 2016-05-18 15:27:11 EDT

Mark: POPVOX

US Serial Number: 85123456	Application Filing Date: Sep. 05, 2010
US Registration Number: 4168554	Registration Date: Jul. 03, 2012
Register: Principal	
Mark Type: Service Mark	
TM5 Common Status Descriptor:	LIVE/REGISTRATION/Issued and Active The trademark application has been registered with the Office.
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.	
Status Date: Jul. 03, 2012	
Publication Date: Aug. 16, 2011	Notice of Allowance Date: Oct. 11, 2011

- ▲ [Mark Information](#) ▼ Expand All
- ▲ [Goods and Services](#)
- ▲ [Basis Information \(Case Level\)](#)
- ▲ [Current Owner\(s\) Information](#)
- ▲ [Attorney/Correspondence Information](#)
- ▲ [Prosecution History](#)
- ▲ [TM Staff and Location Information](#)
- ▲ [Assignment Abstract Of Title Information - Click to Load](#)
- ▲ [Proceedings - Click to Load](#)

Common Status Descriptors (CSD) icons



1. LIVE/APPLICATION/Awaiting Examination - The trademark application has been accepted by the Office (has met the minimum filing requirements) and has not yet been assigned to an examiner.
2. LIVE/APPLICATION/Under Examination - The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.
3. LIVE/APPLICATION/Appeal of Refusal Pending - An appeal of the Office's final refusal to register a pending trademark application is currently pending.
4. LIVE/APPLICATION/Published for Opposition - A pending trademark application has been examined by the Office and has been published in a way that provides an opportunity for the public to oppose its registration.
5. LIVE/APPLICATION/Opposition Pending - The pending trademark application has been examined by the Office and was published for opposition, at which time one or more oppositions were filed but they have not yet been decided.
6. LIVE/REGISTRATION/Issued and Active - The trademark application has been registered with the Office.
7. LIVE/REGISTRATION/Cancelled/Invalidated - The trademark application was registered, but subsequently it was cancelled or invalidated and removed from the registry.
8. LIVE/REGISTRATION/Refused/Dismissed or Invalidated - This trademark application was refused, dismissed, or invalidated by the Office and this application is no longer active.
9. LIVE/REGISTRATION/Withdrawn/Abandoned - The owner of the trademark application withdrew (e.g. abandoned) the application and the application is no longer active.
10. DEAD/REGISTRATION/Expired - The trademark application registered, but subsequently removed from the registry when the registration was not successfully maintained.
11. DEAD/REGISTRATION/Surrendered - The trademark application was registered, but subsequently voluntarily removed from the registry by action of the owner.
12. DEAD/REGISTRATION/Other - For the situation where the status is uncertain, unknown, or other than those previously identified.
13. DEAD/REGISTRATION/Other - For the situation where the status is uncertain, unknown, or other than those previously identified.
14. DEAD/REGISTRATION/Other - For the situation where the status is uncertain, unknown, or other than those previously identified.
15. DEAD/REGISTRATION/Other - For the situation where the status is uncertain, unknown, or other than those previously identified.

China

October 31, 2017

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Focus on China

- Unauthorized Practice of Law
- Influx of Chinese Filings
- Specimen Issues
- Counterfeiting
- Bad Faith Filings



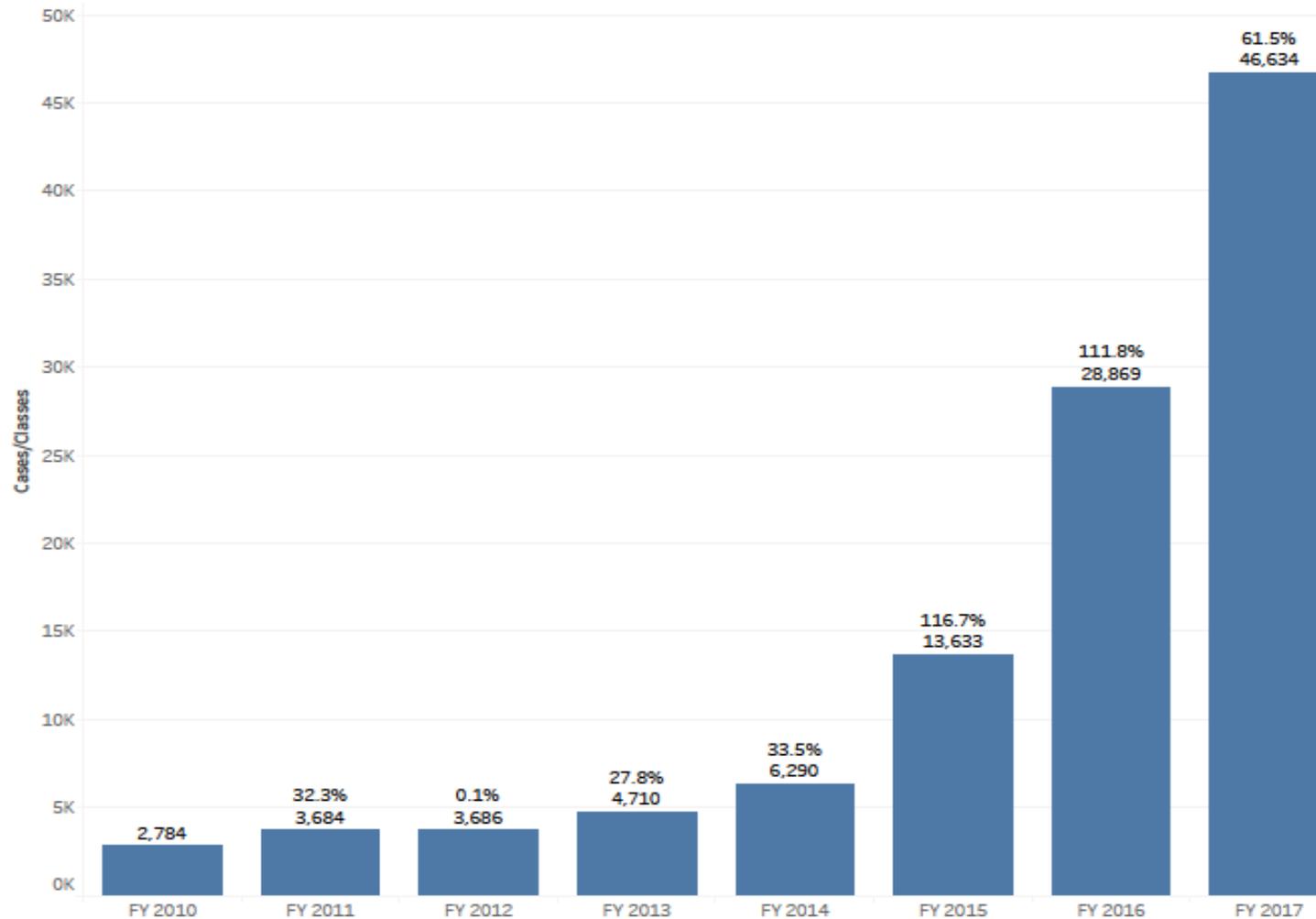
Unauthorized Practice of Law

- Concerned with applications handled by foreign attorneys.
- Not permitted under our rules unless permission granted by Office of Enrollment and Discipline (OED); only Canadian attorneys/agents currently permitted
- *TMEP § 602.03, TMEP § 608*
- Foreign Attorney or Agent may receive correspondence, but cannot file on applicant's behalf.
- Trademarks and OED investigate infractions.
- Send Orders to Show Cause and possible exclusion order based on response.
- Conferred with SAIC in China on this issue and also providing information on our website.

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

Chart showing Influx of Chinese Filings



Specimen Issues

- Mocked-up or fake specimens are increasing
- Much more sophisticated as well
- Applicants pasting their marks on products or services of others to show use in commerce
- We are aware and are doing our best to refuse the fraudulent specimens

Mock-Ups and Digitally Altered Specimens

- Fake specimens present several issues:
 - Basis to refuse registration because does not show the mark as used in commerce
 - Basis for finding fraud on the Office
 - Can subject a practitioner to discipline by OED
 - May impact validity of any registration that issues and subject it to cancellation

Thank You!

Mary Boney Denison

Commissioner for Trademarks

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