

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Welcome! The TPAC public meeting will start at 1:00 p.m. ET

Please send all questions via email to  
[TPAC@uspto.gov](mailto:TPAC@uspto.gov)

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Introduction and welcome by TPAC Chair

Chris Kelly

Chair, Trademark Public Advisory Committee

March 12, 2021

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# Swearing in of new members and Opening remarks

Drew Hirshfeld

Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and the Director of the United States Patent and Trademark Office

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# Welcome new TPAC members

- **David J. Cho**

- Assistant Vice President Senior Legal Counsel - Trademarks and Copyrights at AT&T Inc.

- **Tracy L. Deutmeyer**

- Shareholder with the firm of Fredrikson & Byron, P.A.

- **Jomarie B. Fredericks**

- Deputy General Counsel and Chief Intellectual Property and Brand Counsel at Rotary International and the Rotary Foundation



# Trademark Office performance

David Gooder

Commissioner for Trademarks

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# Agenda

- Trademark Office update
  - TM Business operations metrics
  - TM Business financial performance
  - TM FY21 priorities
- OCIO update
- OGA update
- OPIA
- TTAB

# TM business performance



# Trademark Office leadership – New faces

- **Dan Vavonese**

- Deputy Commissioner for Trademark Operations

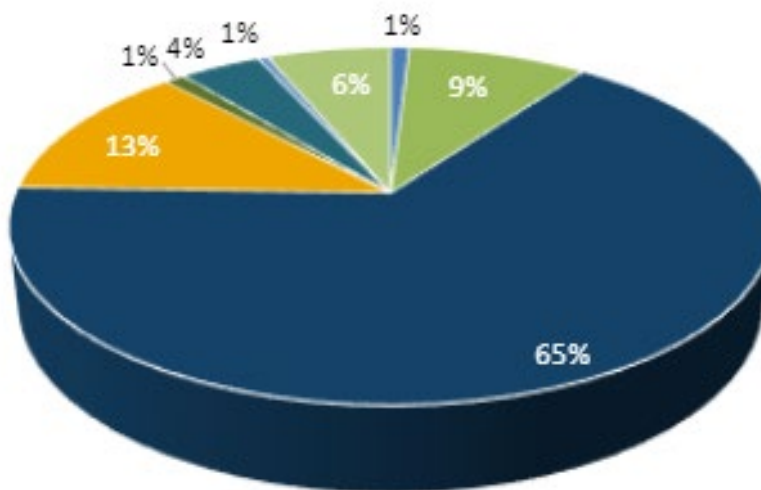
- **Amy Cotton**

- Deputy Commissioner for Trademark Examination Policy



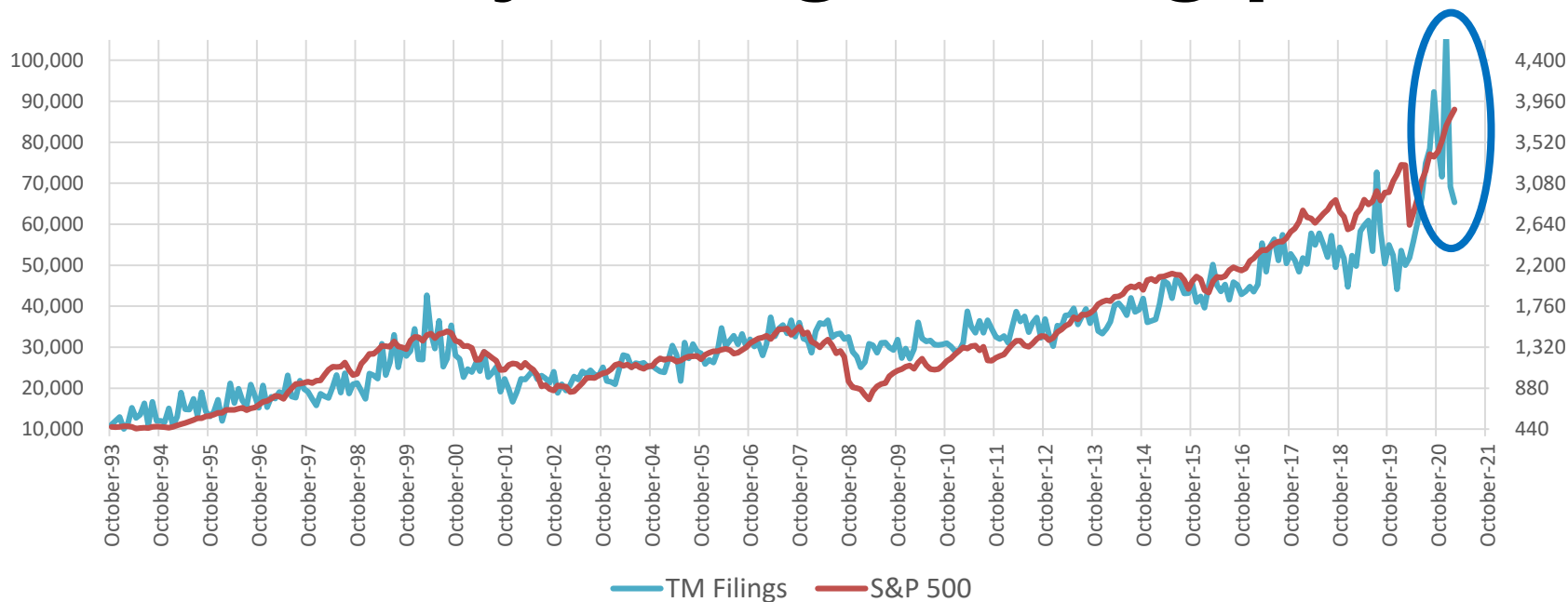
# Trademarks Office staffing

- 962 Trademarks employees (7% of USPTO)
- 639 examining attorneys (65% of Trademarks)
- 100% of employees have the option to telework during the pandemic



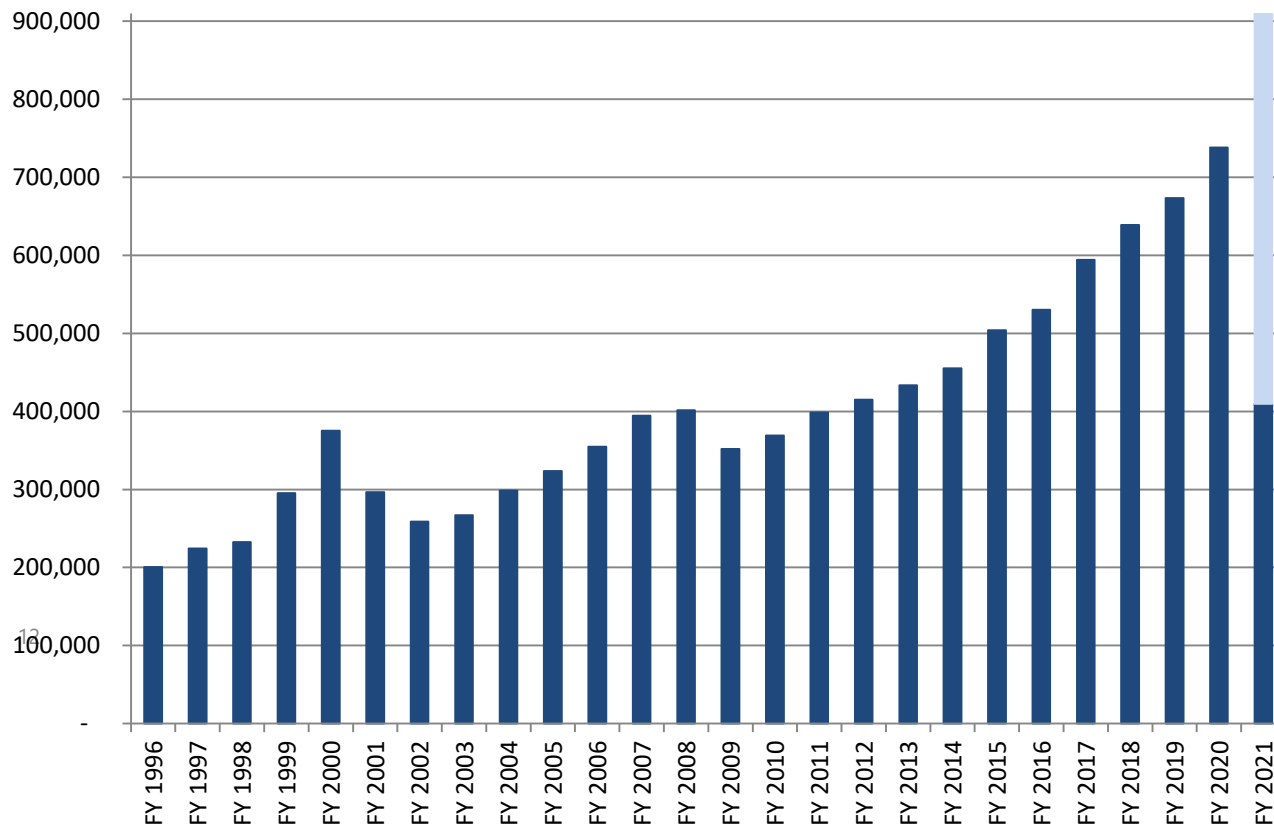


# Trademark monthly filings vs. S&P 500 monthly average closing price





# Trademark application filing levels



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

**FY 2021 year to date:**  
416,708 classes

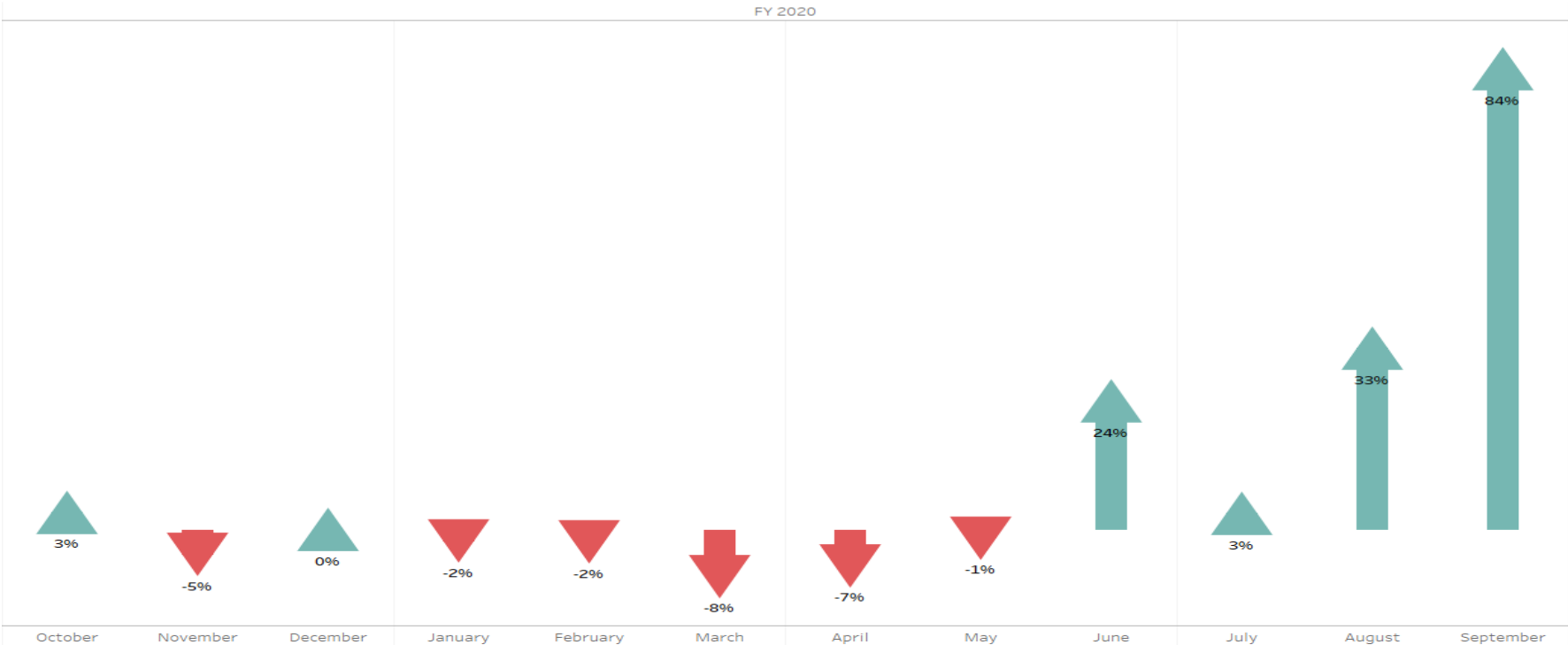


# FY20 TM filings – A tale of two halves

1st-half: first sustained negative growth we've seen since Great Recession

2nd-half: unprecedented growth

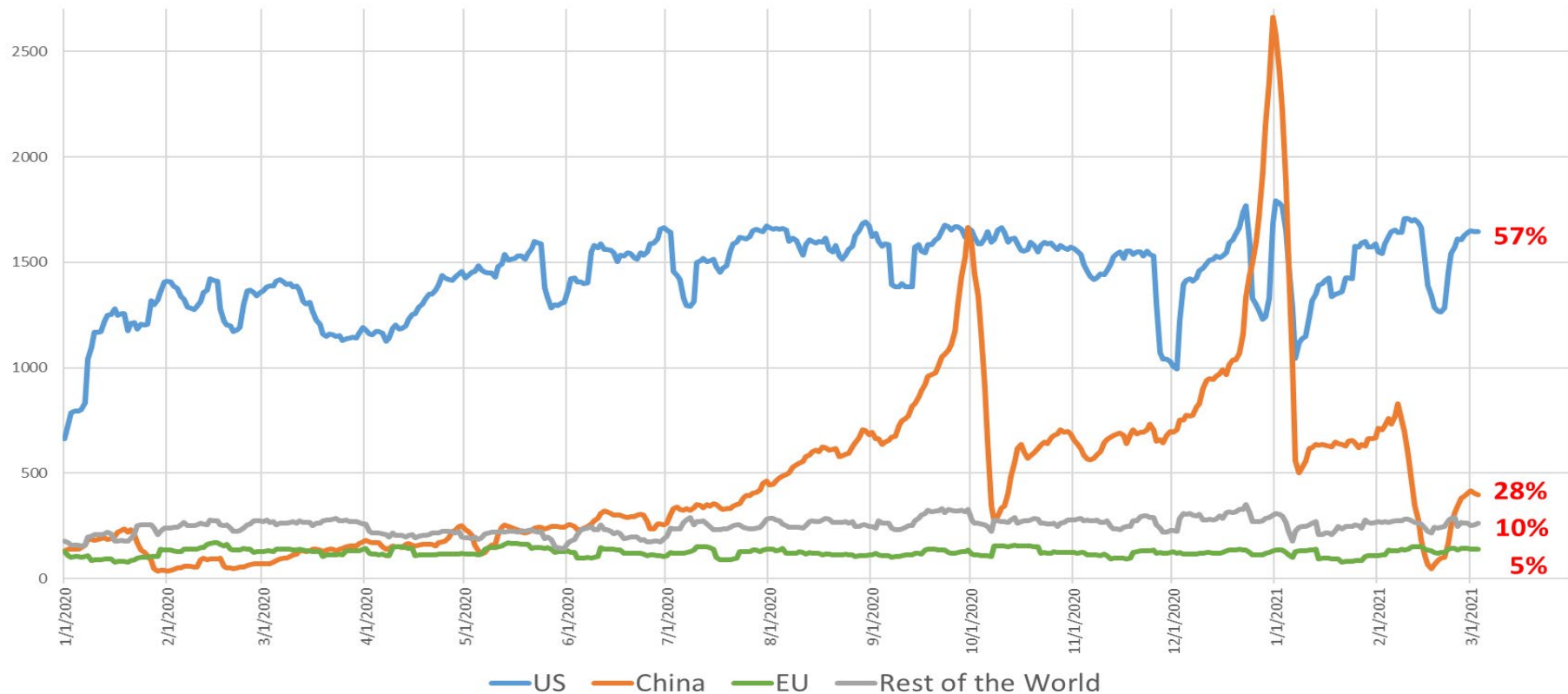
FY20 Year-Over-Year: Monthly Growth





# FY21 Daily trademark application filings

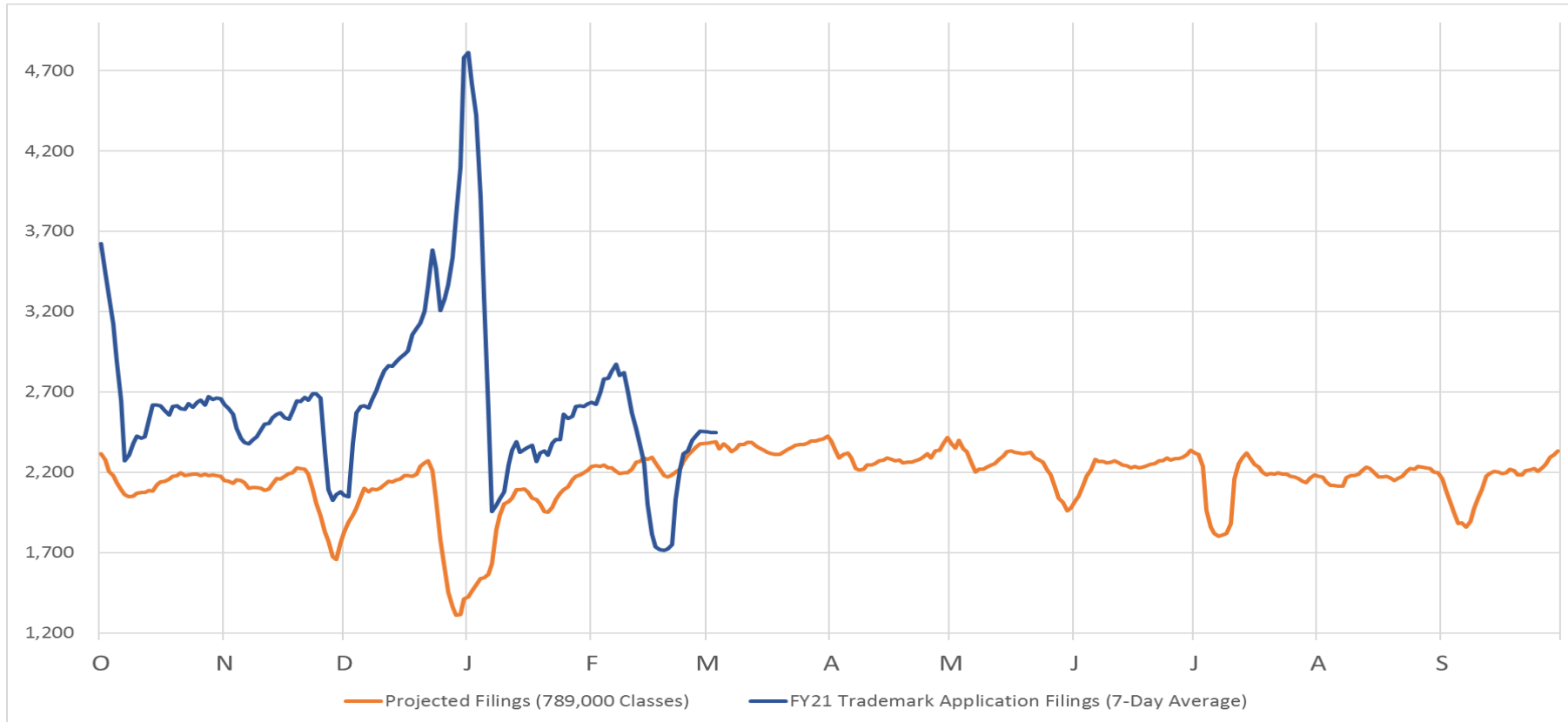
Actuals compared to plan (789,000 classes)





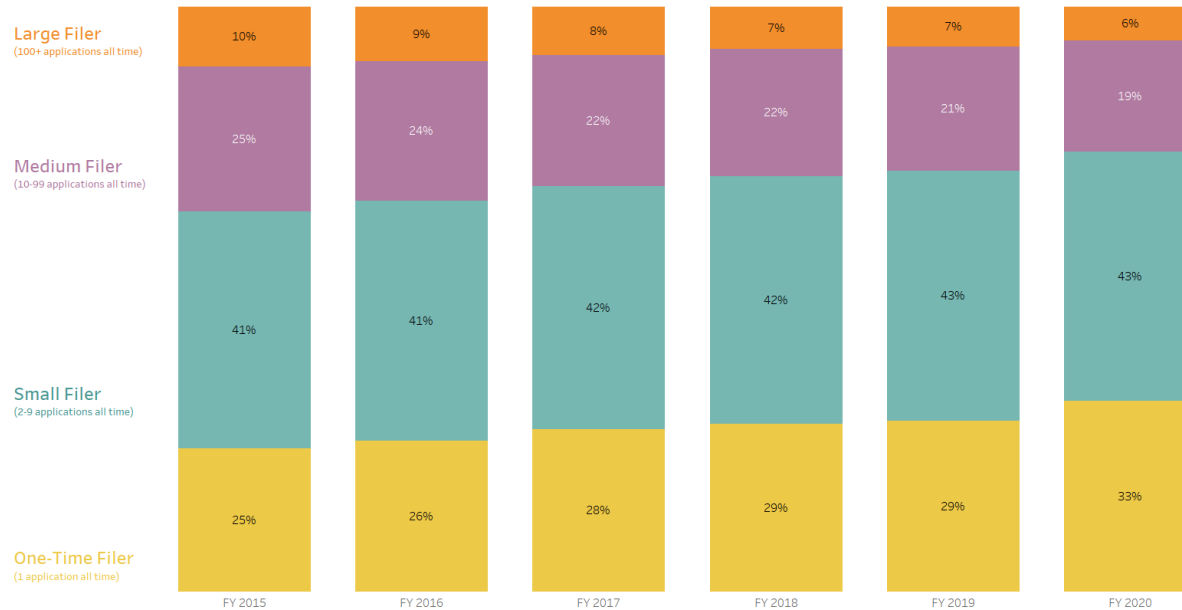
# FY21 Daily trademark application filings

Actuals compared to plan (789,000 classes)



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

Filer Type: Filings (Cases) by Fiscal Year

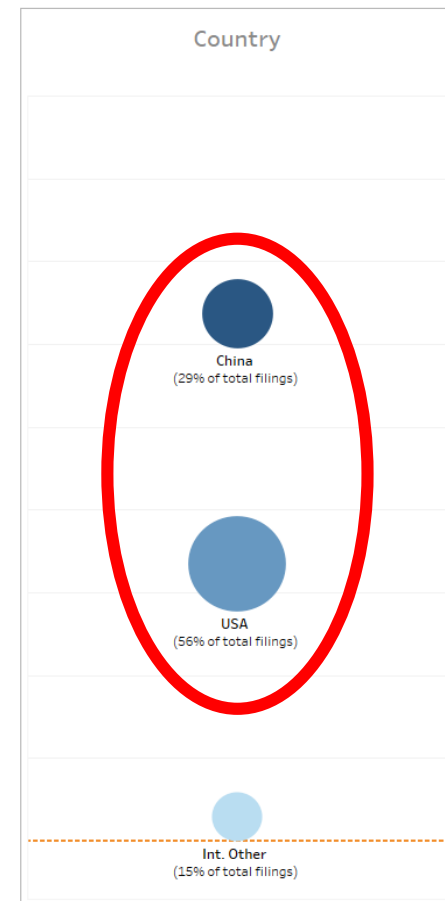
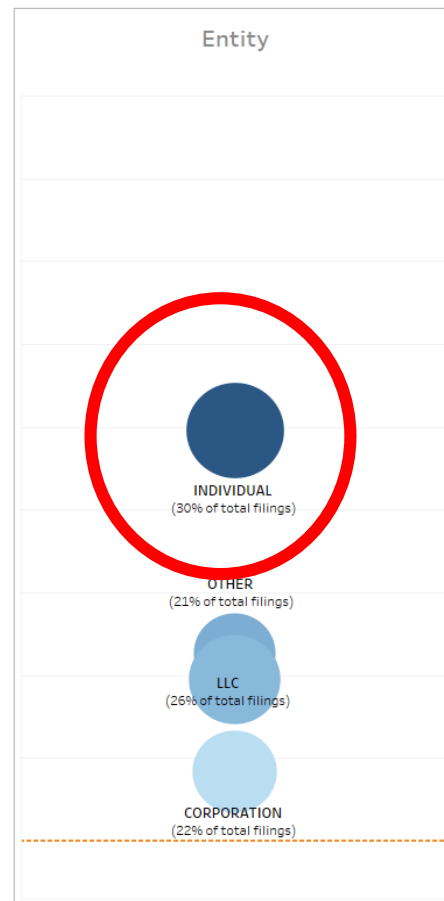
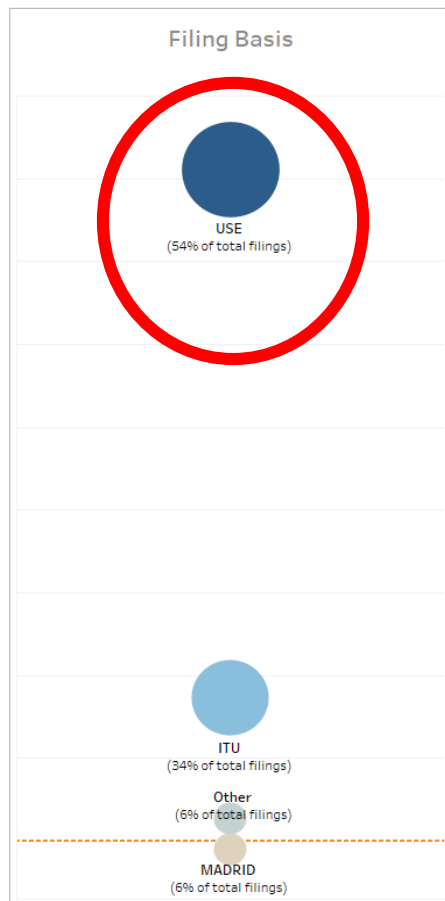
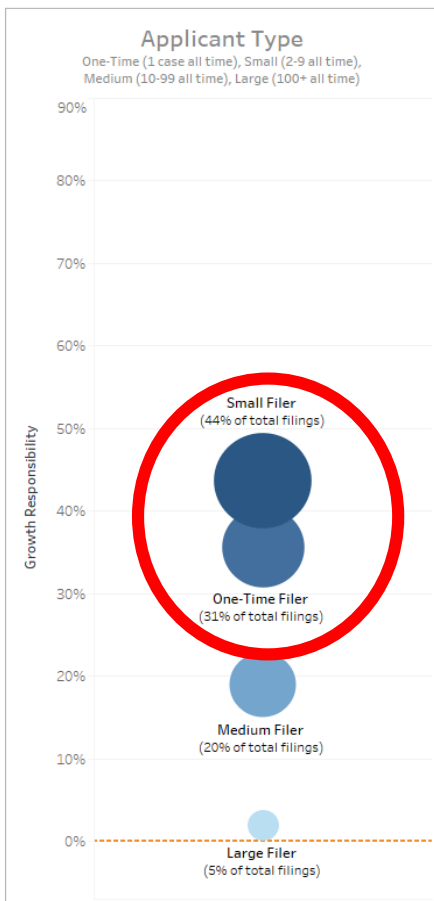






# Who is driving the surge

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



# Trademarks performance: quality

FY 2020 Trademarks performance measures	FY 2021 targets	FY 2021 Results*
<b>First action compliance</b> 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	<b>95.5%</b>	<b>95.8%</b>
<b>Final action compliance</b> 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	<b>97.0%</b>	<b>98.8%</b>
<b>Exceptional office action</b> Measure indicating the comprehensive quality of the first office action search, evidence, writing, and decision making	<b>50.0%</b>	<b>52.3%</b>

\*through Mar 4, 2021





David Gooder  
Commissioner for Trademarks

# Trademarks business FY21 priorities



# Trademarks Priorities

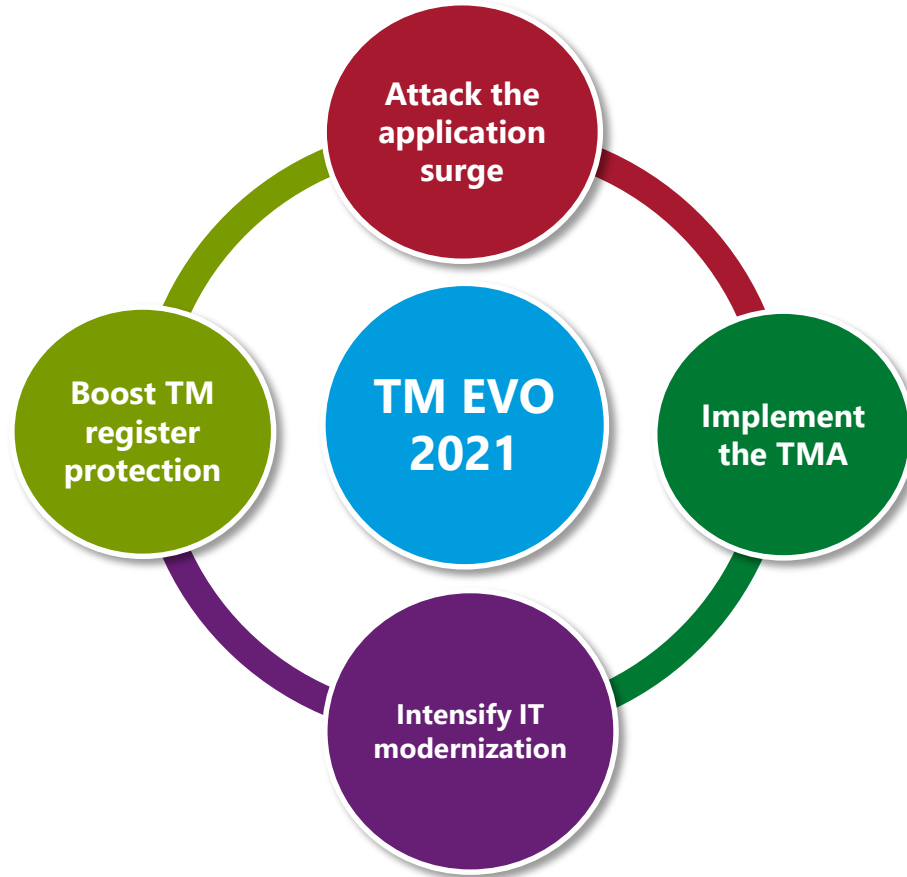
## FY2021





# Trademarks Priorities

FY2021



Dan Vavonese

Deputy Commissioner for Trademark Operations

# Trademarks filings surge 2021

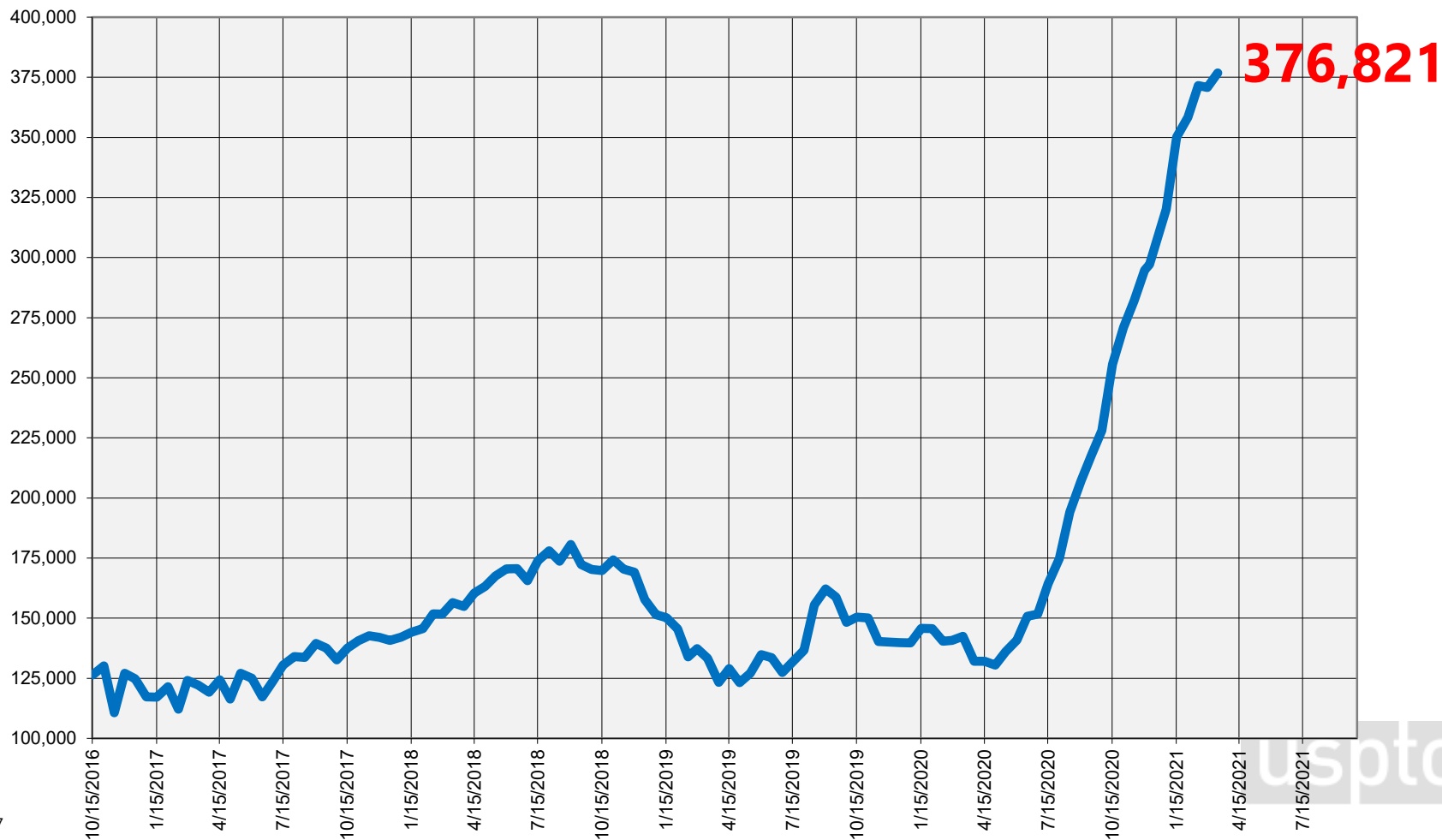


# The surge of 2021

- How big a surge
- What's causing it
- What's the impact
- What are we doing about it

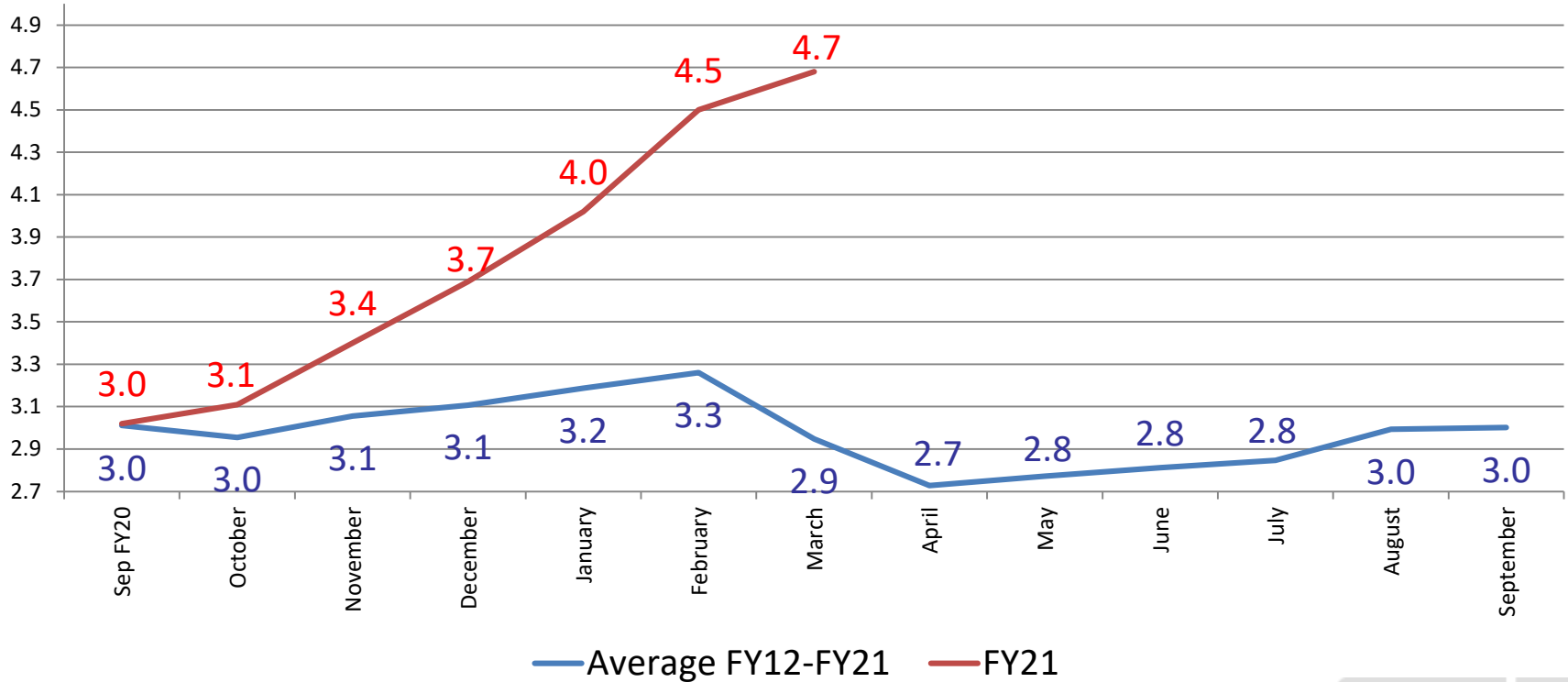


# Unexamined Application Inventory (Classes)





# FY21 First action pendency vs. 10-year average



# Trademarks performance: Pendency

FY 2021 Trademarks performance measures	FY 2021 Targets*	FY 2021 Actual	Feb 2021
<b>First action pendency</b> First action pendency from date of filing to the first office action in months	<b>2.5 – 4.5</b>	<b>3.8</b>	<b>4.5</b>
<b>Disposal pendency</b> Disposal pendency from date of filing to issuance of a notice of allowance, registration, or abandonment – <b>excluding</b> suspended and <i>inter partes</i> proceedings.	<b>12.0</b>	<b>9.7</b>	<b>9.8</b>

\*pendency target adjusted from 2.5 – 3.5 to 2.5 – 4.5 in October 2020



# What is causing the surge

- Growth of on-line sales
  - And registration as a requirement to join brand registry programs
- Chinese government subsidies
  - Notably in Guangdong province
- Anticipation of USPTO fee increase in FY21
- Chinese/US law firms/lawyers
  - Marketing filings directly to Chinese SMEs



# Impact of the surge: Processing backlogs

- **New applications uploaded into TSDR and TESS systems**
  - Typically processed within one week
  - In rare situations, it is taking longer; contact TEAS team directly at [TEAS@uspto.gov](mailto:TEAS@uspto.gov)
- **First action pendency (target between 2.5 and 4.5 months from filing)**
  - Historically, around 3 months from filing to first action
  - Now taking between 4 and 5 months
- **Processing of amendments and responses to office actions**
  - Typically processed within 14 days
  - Now taking approximately 90 days or more





# Filings surge: What actions we are taking

- Reorganized workloads among staff
- Hiring 50 examining attorneys
  - April start
- IT solutions and process improvements
- Notices on our external sites
- Launching monthly pendency metrics
  - Will provide regular updates
  - Users can check processing timeframes





# Pendency metrics: Processing wait times

Backlog/Processing Delays (as of Feb 2021)	Pendency Target	Current Pendency
<b>Pre-Examination Unit</b>		
TEAS	10 days	60 days
MADRID	10 days	2 days
<b>Examination Support Unit (ESU)</b>		
Amendment entry	14 days	102 days
<b>Intent to use</b>		
Extension requests	15 days	12 days
Statement of use	15 days	16 days
Divisional requests	15 days	11 days
<b>Petitions Office</b>		
Letters of protest	60 days	58 days
<b>Post Registration</b>		
Affidavits of Use/incontestability	30 days	66 days
Renewals	30 days	66 days
Amendments/Corrections	30 days	21 days

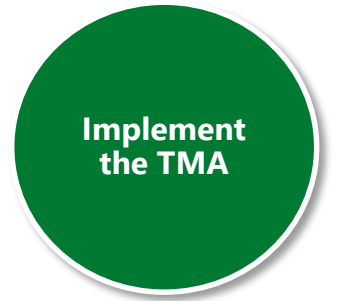
Amy Cotton

Deputy Commissioner for Trademark Examination Policy

# **Implementation of the Trademark Modernization Act 2020**



# Register protection



- Trademark Modernization Act (TMA) provides us with updated tools
  - Letters of protest
  - Flexible response period
  - New nonuse cancellation mechanisms







# Letters of protest

- Third parties may submit for consideration for inclusion in the record evidence relevant to a ground for refusal of registration.
  - Two-month deadline
  - \$50 per submission



# Flexible response period

- Increase examination efficiency.
  - Authority to shorten six-month response period, but not less than 60 days
  - Extensions available up to full six months
  - Fee for extensions



# Nonuse cancellation mechanisms

- New proceedings available
  - Expungement
    - Targets trademarks that have never been used in commerce.
      - Also available as a new claim at the Trademark Trial and Appeal Board (TTAB).
  - Reexamination
    - Targets trademarks that were not in use on or before the “relevant date.”



# Nonuse cancellation mechanisms

- Petition/request requirements:
  - Identify registration
  - Identify each good or service challenged
  - Include verified statement regarding reasonable search conducted
  - Include supporting evidence
  - Pay fee



# Nonuse cancellation mechanisms

- Who may initiate?
  - Any person
  - The Director
- What may be challenged?
  - Expungement: Sections 1, 44, or 66
  - Reexamination: Section 1



# Nonuse cancellation mechanisms

- When may they be filed?
  - Expungement: between 3-10 years after registration
  - Reexamination: between 0-5 years after registration
- What are the available remedies?
  - Cancellation in whole or in part



# Nonuse cancellation mechanisms

- What is the appeal process?
  - From the Director to the TTAB and then to the Court of Appeals for the Federal Circuit
- What prevents abuse of the process?
  - Estoppel as to the same goods or services



# Nonuse cancellation mechanisms

- Rules
  - Must include:
    - What constitutes reasonable investigation
    - What constitutes acceptable types of evidence
  - May include:
    - Response and extension times
    - Limits on timing and number of petitions
    - Relationship to other proceedings





# TMA implementation

- Notice of Proposed Rulemaking
  - Spring, 2021
- Deadline for implementation
  - December 27, 2021



# USPTO resources and feedback

- USPTO external site
  - <https://www.uspto.gov/trademarks/laws/2020-modernization-act>
- USPTO feedback
  - Send input to [TMFeedback@uspto.gov](mailto:TMFeedback@uspto.gov)



David Gooder and Amy Cotton

# **Boosting register protection**



# Register protection: Integrity + Accuracy



- Why does accuracy matter?
  - Trademark register is meant to be a reliable reflection of marks in use in commerce
  - Inaccurate or improper use claims:
    - Could result in loss of registration
    - Contribute to a cluttered trademark register
    - Diminish the register's utility to business and public





# Register protection

- Why does register integrity matter?
  - Obtaining registration by improper means gives bad actors an unfair advantage over competitors
  - Challenging improperly granted registrations is costly for businesses
  - Scams aimed at USPTO harms customers and erodes trust





# “Bad behavior”

## **Sloppy behavior**

- Overclaiming
- Improper specimens
- Improper appointment of attorneys
- Unauthorized practice of law

## **Sleazy behavior**

- False domicile
- Fake names
- Unauthorized change of correspondence address
- Credit card charge backs
- Scams/solicitations



# Register protection

- Battle bad behavior

- Special task force
  - Fighting the suspicious activities and scams
- LEA cooperation
- Education + Outreach
- Database login

- Improve accuracy

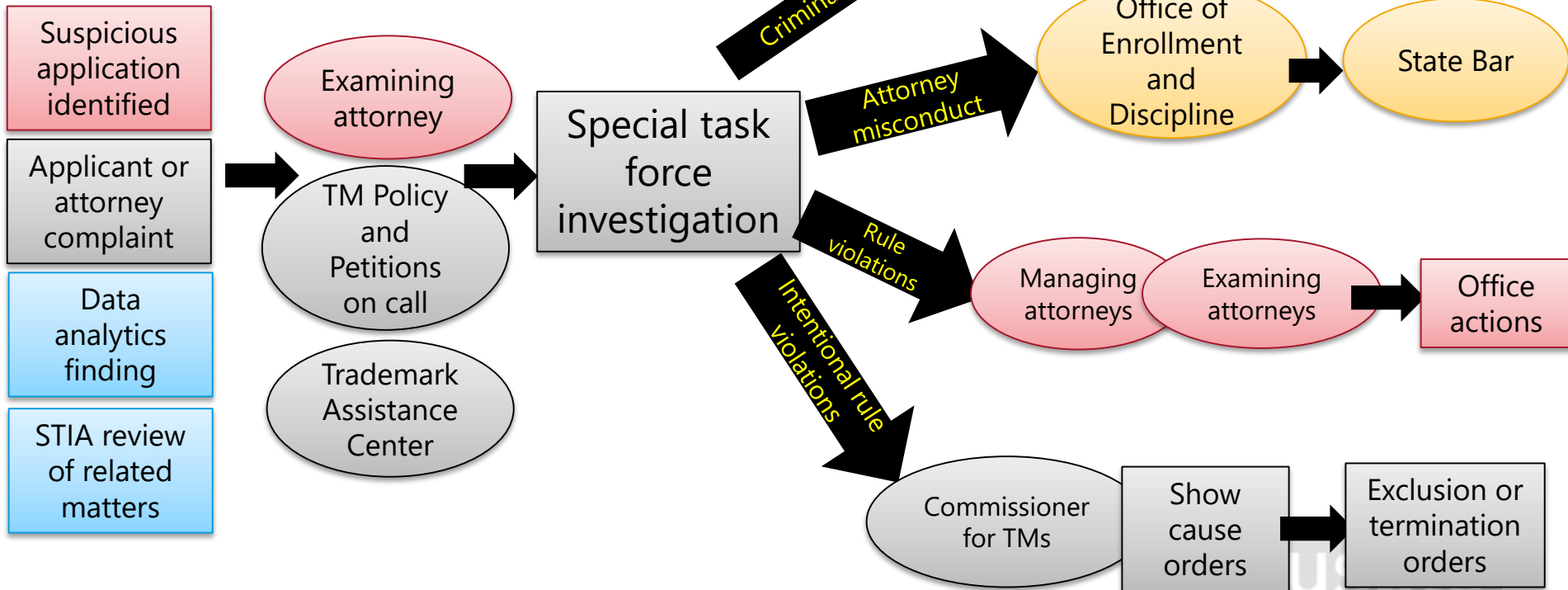
- U.S. counsel rule
- Specimen refusals
- Post-registration audit
- TMA

# Current TM register protection team

- Primary Trademarks Team:
  - Leader: Former examiner + policy experience
  - Supporting attorneys and analysts
- Plus
  - OGC
  - OED
  - CIO
  - OCCO



# Current TM BP workflow





# Law enforcement agency cooperation

- Interagency cooperation
  - USPTO, DOJ, USPIS, and FTC
- Cooperation w/non-US law enforcement
- Noteworthy actions
  - [United States v. Suhorukovs, No. 6:20-cr-00210-DCC \(D.S.C.\)](#)



# Education + Outreach

- Webpage resources
  - Listing of known solicitation scams
- Warnings to filers
  - in Office actions and at registration
- Topic of discussion
  - Blogs, bar groups, and brand owners
- Dedicated mailbox
  - to report solicitations: [TMScams@uspto.gov](mailto:TMScams@uspto.gov)



# Additional resources

## New filers:

- USPTO Trademark Basics Boot camp
- [USPTO.gov/trademarks/basics](https://USPTO.gov/trademarks/basics)
  - Video series
- Law School Clinic program


## Experienced filers:

- Advanced practitioner seminars
  - March 30: Specimens of Use



# 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

Greg Dodson

Deputy Commissioner for Trademark Administration

# IT modernization

# Trademark “Future IT” Update



- **Vendors selected**

- Alliant 2 contract vehicle let late December 2020
- Four highly-qualified IT firms chosen
  - Accenture Federal Services (Accenture)
  - Booz Allen Hamilton (Booz Allen or BAH)
  - General Dynamics Information Technology (GDIT)
  - REI Systems (REI)

- **“New Ways of Working”**

- Focused Trademark organization (Group Director for Information Technology)
- Dedicated<sup>2</sup>, educated, and empowered, professionals
  - Lead Product Owners, Product Owners, Tech Leads, SME’s, etc.
- Agile, *DevSecOps*, industry/government best practices, failing isn’t failure

# Trademark “Future IT” Update

- **Six business-focused “centers” to build-out the enterprise**
  - Trademark Center (external tools and applications; TEAS, TESS, etc.)
  - Trademark Exam Center (FAST 1 & 2, XSearch, petitions, etc.)
  - Trial and Appeal Board Center (ESTTA, TTABIS, etc.)
  - Trademark International Center (Madrid, WIPO/IB, etc.)
  - Trademark Data and Analytics Center (TQRS, Reports, AI/ML/RPA, etc.)
  - Trademark Content Management Services (TRAM/TRM, admin consoles, etc.)





# Trademark AI/ML/RPA Efforts

- **ASAP**
  - Automated Specimen Analysis Product
  - Customized commercial image search software
  - Scans targets of interest or filter incoming filings against millions of prior-filed specimens
  - In limited use with the STIA
- **Image Search and ID/Goods & Services**
  - Two RFI efforts in work:
    - Internally-developed applications; code/app “improved” under IAISS contract
    - Externally-developed applications; in late stages of acquisition timeline
- **Chatbots, Robots and Cobots**

