ABA-IPL Trademark Day: Behind the Scenes at the USPTO

Wednesday, September 13, 2017 USPTO Campus
Alexandria, VA
# 5th Annual ABA-IPL Trademark Day:
Behind the Scenes at the USPTO

## TABLE OF CONTENTS

| Program Agenda | ........................................................................................................................................... [i] |


**Trademarks Update** .......................................................... [01]
*Mary Boney Denison, Commissioner for Trademarks, USPTO*

**Back to Basics: A Look Inside the Life Of a Trademark Application and Tips for Navigating The Trademark Application Process** ........................................ [29]
*Kevin Peska, Managing Attorney, Office of Trademark Quality Review & Training, USPTO*

**Offices of Legal Policy, Liaison and Petitions, and Trademark Classification** ................. [47]
*Jennifer Chicoski, Administrator for Trademark Examination Policy & Procedure, USPTO*

**Tour of TEAS and the USPTO Website** ........................................ [73]
*Tanya Amos, Trademark Legal Administrator, Office of the Deputy Commissioner of Trademark Administration, USPTO*

**Post Registration: Random Audit Overview, When to Use the Technology Evolution Pilot, and Tips on Filing Declarations Of Incontestability and Excusable Nonuse** ................. [113]
*Montia Pressey, Staff Attorney, Office of the Deputy Commissioner for Trademark Policy, USPTO*

## Part II - Trademark Examination Process: “A Day in the Life of a Trademark Examining Attorney”

**A Day in the Life of an Examining Attorney** ................................ [142]
*Steven Berk, Trademarks Chief of Staff, USPTO*

## Part III - Trademark Trial and Appeal Board Overview

**Trademark Trial and Appeal Board - Inter partes proceedings** ................................ [169]
*Elizabeth Dunn and Christian English, TTAB Interlocutory Attorneys, USPTO*
5th Annual ABA-IPL Trademark Day:  
Behind the Scenes at the USPTO

Wednesday, September 13, 2017  
8:30 am – 4:00 pm  
USPTO Headquarters, Alexandria, VA

AGENDA

8:30 am – 8:50 am  
Registration & Coffee

8:50 am – 9:00 am  
Welcome: Jonathan Hudis, ABA-IPL Section Secretary

9:00 am – 10:30 am  
   A. Introduction  
      Introductory remarks, general information about the Trademark Office including filings, structure overview, etc.  
      Speaker: Commissioner for Trademarks, Mary Boney Denison

   B. Back to Basics:  
      Start the day learning about the life of a U.S. trademark application. Then hear from the experts on filing tips and best practices to help your client’s application proceed more quickly through the prosecution process — relevant to beginning and seasoned practitioners alike.  
      Speaker: Kevin Peska, Managing Attorney, Office of Trademark Quality

   C. Examination Policy Office  
      Learn how to stay abreast of rule changes, TMEP revisions, exam guides, and other trademark policy guidance that may affect your trademark prosecution practice. Learn how to avoid common pitfalls in the process and how the Petitions Office helps resolve certain problems in the process. Hear about current cooperative initiatives and developments regarding international classification of goods and services.  
      Speakers: Jennifer Chicoski, Administrator for Trademark Policy and Procedures

   D. TEAS  
      Get the most recent updates on the Trademark Electronic Application System and the Trademarks website. Learn filing tips, familiarize yourself with the various forms available, discover enhancements to the USPTO website, and what may work best for you and your client.  
      Speaker: Tanya Amos, Office of the Deputy Commissioner of Trademark Administration
10:30 am – 10:45 am Coffee Break

10:45 am – 11:15 am E. Post-Registration: Random Audit Program Overview, Declarations of Incontestability and More
Learn about the implementation of the permanent random audit program and how the program will work. Hear what you always wanted to know about post-registration practice before the Office, including filing Declarations of Incontestability and “excusable nonuse” claims in Declarations or Affidavits of Use, and how the Technology Evolution Pilot can help with maintaining registrations where “evolving technology” has changed the manner or medium by which registered goods/services are now offered to consumers.

Speaker: Montia Givens Pressey, Staff Attorney, Office of the Deputy Commissioner for Trademark Policy

11:15 am-12:00 pm II. Trademark Examination Process: “A Day in the Life of a Trademark Examining Attorney”
A. Trademark Examining Attorney Life
Learn the ins and outs of what it is like to be an examining attorney, see the various software systems examining attorneys use (especially the FAST system for handling applications), and gain insight as to workload and quality review.

Speaker: Steven R. Berk, Trademarks Chief of Staff

12:00 pm – 1:00 pm Networking Lunch

1:00 pm – 2:15 pm III. Trademark Trial and Appeal Board Overview
A. Introduction
Introductory remarks, Board overview, and general information about TTAB, including filings, structure overview, etc.

Speaker: Hon. Gerard F. Rogers, Chief Administrative Trademark Judge

B. Inter Parties
Board attorney panelists – pleading matters handled, settlement, discovery and phone conferences – what to do to request and prepare, orders issued after, management of discovery in cancellation and opposition proceedings, etc.

Speaker: Elizabeth Dunn and Christen English, Trademark Trial and Appeal Board Interlocutory Attorneys

C. Ex Parte Appeals
Hear tips and advice from judges on strategies in prosecution in anticipation of appeal—interlocutory issues, remands, reconsideration, examining attorney’s review on reconsideration or remand, and Requests for Reconsideration, etc.
2:15 pm – 2:30 pm  
**Coffee Break**

2:30 pm – 4:00 pm  
**IV. TTAB Inter Partes Hearing**  
*Hokie Objective Onomastics Society LLC v. Virginia Polytechnic Institute and State University*, Proceeding No. 91207895  
**Speakers:** Counsel for Applicant and Counsel for Opposer

V. Questions
Trademark Organization Staffing

- 836 Trademark employees (7% of USPTO)
- 555 examining attorneys (66% of Trademarks)
- 77% of examining attorneys telework full time
- Examining Attorney hiring completed for the fiscal year
New Application Filings

- FY 2016: 530,270 classes filed
- Projecting **570,000** fee paid classes this fiscal year. This is an increase of 7.5% over the previous fiscal year.
# Trademark Performance: Pendency

<table>
<thead>
<tr>
<th>FY 2017 Trademark Performance Measures</th>
<th>FY 2017 Targets</th>
<th>FY 2017 June Results</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>First Action Pendency</strong>&lt;br&gt;First action pendency from date of filing to first office action in months.</td>
<td>2.5 – 3.5</td>
<td>2.5</td>
</tr>
<tr>
<td><strong>Disposal Pendency</strong>&lt;br&gt;Disposal pendency from date of filing to issuance of a notice of allowance, registration, or abandonment – <em>excluding</em> suspended and <em>inter partes</em> proceedings.</td>
<td>12.0</td>
<td>10.1</td>
</tr>
</tbody>
</table>
## Trademark Performance: Quality

<table>
<thead>
<tr>
<th>FY 2017 Trademark Performance Measures</th>
<th>FY 2017 Targets</th>
<th>FY 2017 June Results</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>First Action Compliance</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td>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.</td>
<td>95.5%</td>
<td>97.3%</td>
</tr>
<tr>
<td><strong>Final Action Compliance</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td>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.</td>
<td>97.0%</td>
<td>98.2%</td>
</tr>
<tr>
<td><strong>Exceptional Office Action</strong></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Measure indicating the comprehensive quality of the first Office action search, evidence, writing and decision making.</td>
<td>42.0%</td>
<td>45.9%</td>
</tr>
</tbody>
</table>
E-Government Statistic

- Original goal was to have all applications submitted electronically; Currently at the 99.7% 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
- Mandatory electronic filing on the horizon for the next Fiscal Year.
E-Government

Applications Completely Processed Electronically (classes)

- Q2-15: 81.4%
- Q3-15: 81.6%
- Q4-15: 82.2%
- Q1-16: 83.6%
- Q2-16: 85.8%
- Q3-16: 84.6%
- Q4-16: 84.8%
- Q1-17: 85.6%
- Q2-17: 86.3%
- Q3-17: 86.4%

Actual
Fee Change Effect on Paper Applications

![Graph showing the effect of fee change on paper applications from October 2016 to June 2017. The graph indicates a peak in December 2016 with 116 applications, followed by a decline to a low in April 2017 with 15 applications, and a slight increase in May 2017 with 33 applications, ending with 17 applications in June 2017.](image-url)
C. My.USPTO.gov Update

• Recent Enhancements
  – Notification by email when there are new hits on the saved TMOG watches
  – Merging of docket to track both applications and registrations
  – Increased docket size to track status of up to 1,000 applications/registrations. (Can already create as many dockets or “collections” as needed)
  – In addition to serial and registration numbers, user can now search trademarks by mark literal, owner name and attorney name.
  – Sign up at my.uspto.gov, and please provide feedback and suggestions.
The uspto.gov user account

- 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!

https://account.uspto.gov
Please provide your feedback online
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
Post Registration Amendments to IDs Due to Technology Evolution

Pilot Commenced September 1, 2015
View full announcement at www.uspto.gov/sites/default/files/documents/Technology_Evolution_Pilot_Program.docx
Post Registration Amendments to IDs Due to Technology Evolution

- In response to user feedback, we developed a method for users to petition our office to make technology changes due to evolution.
- Since September 1, 2015, 125 petitions have been filed. Of the 125 petitions received, 50 have been granted, 23 have been dismissed, and 29 have recently published for public comment but no decision has issued. 2 petitions have been denied.
Marijuana-related Trademarks

- 21 U.S.C. §§801-971 (The Controlled Substances Act (“CSA”))
- Regardless of state law, the federal law provides no exception for marijuana
- See TMEP §907 and §1205
- We will refuse drug paraphernalia under the CSA as well
- Review is done on a case-by-case basis
Marijuana-related Trademarks (cont.)

• When the sale or transportation of any product for which registration of a trademark is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application.

• Use of a mark in commerce must be lawful use to be the basis for federal registration of the mark. Under 37 C.F.R. §2.69, the USPTO may inquire about compliance with federal laws.
Integrity of Federal Register

Suggested Methods of Improvement from Post-Registration Pilot Program

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

**Former Declaration Format**

**Revised Declaration Format**
Random Audits

• USPTO will require submission of information, exhibits, affidavits or declarations, and such additional specimens to ensure that register accurately reflects marks are in use in United States for all goods/services identified in registrations in random pull of cases.

• Final rule in Federal Register on January 19, 2017. Now in effect on March 21, 2017, not February 17 as originally published.

• Rollout expected Fall 2017.
Expedited Cancellation Proceedings

• Request for Comments published. See 82 Fed. Reg. 22517; open until August 14, 2017
• 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)
International
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
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.
# Common Status Descriptors

![Status Information]

**Mark Information**
- 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

**Mark Information**
- US Serial Number: 85123456
- Application Filing Date: Sep 06, 2010
- US Registration Number: 4168654
- Registration Date: Jul 03, 2012
- Register: Principal
- Mark Type: Service Mark
- TMS Common Status Descriptor: LIVE/REGISTRATION Issued and Active
  - The trademark application has been registered with the Office.
- Status Date: Jul 03, 2012
- Publication Date: Aug 16, 2011
- Notice of Allowance Date: Oct 11, 2011

**Common Status Descriptors (CSD) icons**

1. ![Folder](image1)
2. ![Envelope](image2)
3. ![Certificate](image3)
4. ![Folder](image4)
5. ![No Action](image5)
6. ![Certificate](image6)
7. ![Folder](image7)
8. ![No Action](image8)
9. ![Certificate](image9)
10. ![Folder](image10)
11. ![No Action](image11)
12. ![Certificate](image12)
13. ![Folder](image13)
14. ![No Action](image14)
15. ![Certificate](image15)

---

6. ![Folder](image1)
7. ![Envelope](image2)
8. ![Certificate](image3)
9. ![Folder](image4)
10. ![No Action](image5)
11. ![Certificate](image6)
12. ![Folder](image7)
13. ![No Action](image8)
14. ![Certificate](image9)
15. ![Folder](image10)
16. ![No Action](image11)
17. ![Certificate](image12)
18. ![Folder](image13)
19. ![No Action](image14)
20. ![Certificate](image15)

---

**Future Status Descriptors**

- Mark Information
- 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
Outreach and Customer Experience
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 its trademark application filing receipt (2) its cover email for trademark office actions and (3) with each paper trademark registration on a 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 invited.
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

BACK TO BASICS

A Look Inside The Life Of A Trademark Application And Tips For Navigating The Trademark Application Process

Kevin Peska, Managing Attorney
Office of Trademark Quality Review & Training
A LOOK INSIDE USPTO’s TRADEMARK EXAMINING OPERATIONS
Who will examine the applications?

555 examining attorneys and 45 supervisors (managers & senior attorneys) in 25 Law Offices

LAW OFFICE STRUCTURE

Most Law Offices Comprised of:
One Managing Attorney
One Senior Attorney
Approximately 23 Examining Attorneys
Examination Process at the USPTO – continued

3. If **Allowed**, publication in the *Official Gazette* and Notice of Allowance (if intent-to-use).

4. If finally **Refused**, appeal to the Trademark Trial and Appeal Board (TTAB)

5. If **Refusal is affirmed:**
   
   A) Appeal to a U.S. District Court *de novo*: or
   
   B) Appeal to the United States Court of Appeals for the Federal Circuit (CAFC) on the administrative record.
Examination Process at the USPTO – continued.

6. After Publication, **Opposition period**. Both parties (Opposer and Applicant) have right to appeal the TTAB decision.

7. If no Opposition, **Registration** issues.

8. **Cancellation proceeding** available to cancel a registration. Both parties (Petitioner and Registrant) have right to appeal the TTAB decision.
Trademark Registration Timeline*

Examination: 2.5 months from filing to examination.

Registration: 9.9 months after filing.

*Figures are approximate, and based on May FY17 performance.
Some Tips For Navigating The Trademark Application Process
TIP # 1
Be Mindful of Common Refusals

- Likelihood of Confusion – conduct a “clearance” search
- Merely Descriptive – search for industry meaning; look at applicant’s website.
- Ornamentation
- Geographic
- Surname
- 2(a) Deceptive
TIP # 2
DRAFTING ACCEPTABLE IDENTIFICATIONS

Problem: Indefinite IDs.

Tips:

• Use common commercial name - be as specific as possible, non-technical, and understandable.

  – Online at https://tmidm.uspto.gov/id-master-list-public.html

• Request that an item be added to the ID Manual by sending an email to: TMIDSuggest@uspto.gov

Note: Make sure the ID is definite...and accurate! (Reflects the actual goods/services.)
TIP # 3
Descriptions of Marks

Problem: The description of the mark is incomplete/unacceptable

Tips:

1. Make sure all descriptions are concise, but also accurate and complete.
   - Description should describe all significant aspects of the mark, including both literal elements and design elements.

2. Make sure all colors are claimed and included in mark description, if applicable.

Example:

When a mark includes words & designs, be sure the description includes the wording, e.g. “the wording DANGER! in a stylized font, appears below the design of a ringing alarm” (not merely "the mark is the design of a ringing alarm")
TIP # 4
Include Known Information

Problem: Application is missing required information

Tip: Provide as much information as possible in the original filing to speed up the process

For example:
- Consent for names or portraits of living individuals.
- Translations and Transliterations.
- Filing Date & Serial Number of Foreign Applications (44(d) priority claims).
- Obvious Disclaimers.
TIP # 5
Specimens

• Does the Drawing match the Specimen.
• Does the Specimen show actual use on stated services.
• Avoid mock-ups or printer’s proofs.
• For ITU’s, consider filing extensions of time rather than submitting specimens that may be refused.
TIP # 6
Responding to Office Actions

**Problem:** Unpersuasive responses

**Tips:**

• **Argue Your Interpretation of the Evidence**
  – The Office action will include evidence to support a refusal or requirement.
  – Provide your own evidence to support your interpretation or analysis of the situation.
  – Explain any problems with the examining attorney’s evidence and/or analysis.

• **Educate the Examining Attorney About Your Field/Industry**
  – Explain the field or marketplace for your goods/services when arguing against any refusals or requirements.
  – If possible, submit brochures, printouts of webpages, catalogs, documentation, and any other evidence explaining how your industry or field works.

• **Avoid Conclusory or Broad Arguments Without Evidence to Support Them**
  – Make specific, fact-based points about why the examining attorney should withdraw the refusal.
  – Include any helpful evidence that supports your argument.
TIP # 7
TRY NOT TO WAIT UNTIL THE LAST MINUTE

Problem: Accidental abandonment

Tips:

• Know the deadlines.

• There are no extensions available for filing a response
  ➢ If you miss your deadline and your application abandons, you may be able to revive it, but you must file a petition with a petition filing fee to do so.

• Partial Abandonment: Failure to respond to Office Action may result in abandonment of some goods and/or services, with application going forward to publication.
TIP # 8
Email or Call Examining Attorneys with Questions or to Resolve Easy Issues

Problem: Not using email or phone

Tips:
• Leave clear messages that include your name, phone number and serial number.

• Please return phone calls promptly.

• For easily resolved issues, such as disclaimers and amending goods/services, consider calling or e-mailing to do an Examiner’s Amendment.
Tip: TEAS Nuts and Bolts videos

- A how-to video series that provides information about each page of the TEAS application form.
- Each video shows how the form is used and provides examples.
Trademark Tools & Links

- **Search trademark database**
  Search database for trademark registrations and applications by mark, owner, or serial/registration number with Trademark Electronic Search System (TESS)
  TESS

- **Apply online**
  File forms for the trademark application, maintenance and other trademark processes with Trademark Electronic Application System (TEAS)
  TEAS

- **Check Status & View Documents**
  Check the status of an application and view and download application and registration records using Trademark Status and Document Retrieval (TSDR)
  TSDR

---

**Trademark Trial and Appeal Board (TTAB)**
The TTAB is an administrative board that hears and decides adversary proceedings between two parties, namely, oppositions and cancellations. The TTAB also handles interference and concurrent use proceedings, as well as appeals of final refusals issued by USPTO Trademark Examining Attorneys.
ESTTA TTABVUE

**Trademark Assignments: Change & Search Ownership**
During the examination of a pending trademark application as well as after a trademark has registered, the owner of a trademark may change for various reasons
ETAS AOTW

**Trademark Application and Post-Registration Process Timelines**
The timelines provide an overview of the process steps and time frames for filing a trademark application with a particular filing basis and for maintaining a trademark
Apply online

First timer? Get basic information before filing to avoid mistakes that cost you time, money, and potentially your legal rights.

To apply for a trademark or servicemark, **select your form from the table heading below.** Once you select the form, you will be directed to our Trademark Electronic Application System (TEAS) where you can being filing your application.

**Need more help** deciding which form to use or how to fill it out? **Watch the TEAS Nuts and Bolts video.**

<table>
<thead>
<tr>
<th>Trademark application forms (select one to start) ---</th>
<th>TEAS Plus form</th>
<th>TEAS Reduced Fee form</th>
<th>TEAS Regular form</th>
</tr>
</thead>
<tbody>
<tr>
<td>Filing fee per class of goods/services</td>
<td>$225</td>
<td>$275</td>
<td>$400</td>
</tr>
<tr>
<td>E-mail address required for USPTO application-related correspondence?</td>
<td>Yes</td>
<td>Yes</td>
<td>No</td>
</tr>
<tr>
<td>Additional submissions, like responses to Office actions, must be filed online?</td>
<td>Yes</td>
<td>Yes</td>
<td>No</td>
</tr>
<tr>
<td>Goods/services listing must be selected from the USPTO Trademark Identification (ID) Manual?</td>
<td>Yes</td>
<td>No</td>
<td>No</td>
</tr>
<tr>
<td>Full Filing fee paid upfront (per class for all classes listed on the application)?</td>
<td>Yes</td>
<td>No</td>
<td>No</td>
</tr>
<tr>
<td>Certain statements regarding the mark be provided in the application</td>
<td>Yes -</td>
<td>No</td>
<td>No</td>
</tr>
</tbody>
</table>
Topics Covered

• Legal Policy Office
  – Responsibilities
  – Current work

• Liaison and Petitions Office
  – Responsibilities
  – Petitions and Reinstatement rule of July 8, 2017

• Trademark Classification
  – International cooperation
TRADEMARK LEGAL POLICY
Legal Policy Office Staff

• TMEP Editor
• Form Paragraphs Editor
• Six staff attorneys
• One administrative information specialist
Legal Policy Office
Responsibilities

• Rulemaking
• Review or drafting of legislative updates
• Consultation on trademark treaties & litigation issues
• Federal Register, Official Gazette and other notices
Legal Policy Office Responsibilities

- Trademark Manual of Examining Procedure
- Examination Guides
- Examination policy development
- Subject matter expertise
- Website content
- Office action citation and support
What’s New in Legal Policy?

• TMEDP October Update is in progress
  – Typically twice a year
  – “Extra” updates when warranted
    For example, January 2017 – fee changes

• Summer 2017 Rulemaking – Petitions and Reinstatement rule package – July 8, 2017
Examples of Recently Issued Policy Guidance

- Examination Guide on disparaging and scandalous/immoral examination practices post *Matal v. Tam* U.S. Supreme Court decision – June 2017
- Examination Guide on Merely Informational Matter – July 2017, which includes:
  - General information about goods/services
  - Common phrases in widespread use
  - Religious quotations and citation
- Examination Notes to Examining Attorneys
  - Use of Notes to the File
  - Notation of basis in goods and services
Other Policy Office Work

• Regulatory Reform Working Group
• Notice of Proposed Rule-Making on mandatory electronic filing
LEGAL LIAISON AND PETITIONS
Liaison and Petitions Office Staff

• 11 staff attorneys
• Paralegal supervisor
• Five paralegals
• One legal assistant
Liaison and Petitions Office
Staff Attorneys

• Customer service
  – Advanced problem resolution

• Subject matter experts
  – Attorney advisors to Trademark Services
    • Intent to Use
    • Post Registration
    • Madrid Processing Unit

• Electronic filing and public web services
Staff Attorney Responsibilities

• Petitions to the Director to
  – waive rules or exercise supervisory authority;
  – review procedural issues in examination;
  – review Post Registration decisions
  – Over 1,400 in FY 2016
• Letters of Protest - over 2,250 in FY 2016
• Education and outreach
• Congressional inquiries and trademark-related correspondence to the Director or Commissioner
Petitions Office Paralegal Responsibilities

• Petitions to revive abandoned applications
• Requests for reinstatement for USPTO error
• Petitions to make applications special, to restore application filing dates, and to application change filing basis
• Post publication amendments – over 2,300 in Fiscal Year 2016
Petitions Office “Other” Responsibilities

• Article 6ter of the Paris Convention
• Native American Tribal Insignia Act
• Fastener Quality Act (FQA)
• Freedom of Information Act (FOIA) requests
• Office of Enrollment and Discipline (OED)
  – practitioners barred from practice before USPTO
  – unauthorized practice of law issues in trademark cases
Petitions and Reinstatement Rule

- July 8, 2017 – revised existing petition Rules 2.66 and 2.146 and added new Rule 2.64 to cover reinstatements;
- Harmonizes the requirements for timeliness and due diligence
  - 2 months from issuance of notice of abandonment or cancellation, or
  - If notice not received, within 2 months of knowledge of abandonment/cancellation and no more than 6 months from date Office records are updated to show abandonment/cancellation
- Allows only one petition to revive for failure to receive a particular Office action
What Can We Do for You?

• **TMTMEP@uspto.gov** – policy input and suggestions

• Subscribe to TM Alerts at uspto.gov – find out the latest

• Collaboration Website – follow the link from the TMEP page on uspto.gov

• Petitions Office – 571-272-8950
TRADEMARK CLASSIFICATION
Trademark Classification Policy and Practice Office Staff

- Administrator
- Eight staff attorneys
- Work Project Examining Attorneys on rotation
Duties of the Office

• Develop and implement classification policy consistent with the Nice Agreement;

• Create, maintain and improve identification and classification resources for internal and external customers;

• Provide internal and external customer service and training on identification and classification issues;

• Conduct tasks in accordance with international cooperation projects (example – TM5 ID List Project).
Duties of the Office

• Maintain the U.S. ID Manual
  – Weekly updates to add new entries from public suggestions, examining attorney suggestions, TM5 entries, and other sources.
  – Modifications and clarifications as necessary.

• Review the Official Gazette for Compliance with USPTO Classification Policy & ID Requirements
  – ID/Class review only; substantive review is the purview of law office managers and senior attorneys.
Internal and External Customer Service

• Provide guidance and advice to the law offices, Trademark Trial and Appeal Board, Post Registration and other USPTO business units on complex classification issues;

• Review and respond to suggestions made by the public to the TMIDSUGGEST@uspto.gov mailbox; add U.S. ID Manual entries as appropriate on a weekly basis;

• Answer procedural questions relating to classification and identification policy posed by external customers.
Trademark Identification (Goods and Services) Manual Suggestions

The Acceptable Identification of Goods and Services Manual (ID Manual) includes a wide range of entries, and the USPTO frequently updates the ID Manual to add more entries. Nevertheless, at times, the ID Manual may not include identifications or recitations that describe recently developed goods or services.

To enhance the usefulness of the ID Manual, the USPTO will consider suggestions from the public for identifications or recitations to add to the ID Manual. We are particularly interested in descriptions of new technologies (goods or services) for inclusion in the ID Manual.

A party should not suggest an identification or recitation that has been included in an application for registration and was rejected by an Examining Attorney. Please do not submit overly specific descriptions that would not be useful to a variety of applicants. Also, please do not request pre-approval of descriptions before filing or legal advice on crafting acceptable descriptions or other matters.

A party wishing to suggest an addition to the ID Manual should submit the following, via e-mail, to tmidsuggest@uspto.gov:

- A clear description of the identification or recitation
- A statement indicating how the identification or recitation relates to the goods or services
- A description of the technology or service
- Any other relevant information

Submit suggestions in a concise and clear manner. The USPTO will review and evaluate all suggestions and consider appropriate changes to the ID Manual.
TM5 Trademark ID List Project

• Review and propose entries for the Expanded Trilateral Partners’ ID List Project (aka TM5)
  – European Union Intellectual Property Office (EUIPO)
  – Korean Intellectual Property Office (KIPO)
  – China’s State Administration for Industry & Commerce (SAIC)

• Participant/observer nations
  – Mexico, Philippines, Russia, Singapore, Chile, Colombia
Meeting of Technical Experts

• Annual meeting of the TM5 partners
• Continued work on revising and expanding the list of acceptable terms
• Coordinate with WIPO and the Madrid Goods and Services (MGS) database
Recent Developments

• Over 200 items from Nice Classification Alphabetical List added from NCL-11-2017
• Collaborative review of 300 terms in Class 42 – identified over 100 terms that are acceptable to all 5 partners
• Agreement to review further classes
• Re-analysis of 85 TM5 entries not currently accepted by WIPO
Tour of TEAS and the USPTO Website

Tanya Amos
Office of the Deputy Commissioner for Trademark Administration
September 2017
Welcome to TEAS

The Trademark Electronic Application System (TEAS) - USPTO’s online filing system for trademark prosecution.

You can submit forms and pay fees online using 53 TEAS forms
Commonly used forms

- Initial Application forms
- Response forms
- Intent-to-Use (ITU) forms
- Correspondence and Power of Attorney forms
- Registration Maintenance/Renewal forms
TEAS Tip 1: Watch the TEAS Nuts & Bolts videos

How-to video series for the initial application forms
TEAS Tip 2: Subscribe to Trademark Alert emails

- Keep current with developments in Trademarks by subscribing to alert emails

Trademark Alert

File your portable and e-signature forms by 7:59 a.m. Saturday, April 29, 2017

What
Trademark Electronic Application System (TEAS) and Trademark Electronic Application System International (TEASI) will be unavailable due to system maintenance.

When
Saturday, April 29, 2017, from 8 a.m. until 4 p.m. ET

What you should do
File all “portable” forms and “e-signature” forms by 7:59 a.m. ET on Saturday, April 29. If you don’t file these forms by that time, you will have to start the process again with the new forms. We apologize for any inconvenience.
TEAS Tip 3: Preview a PDF version before filing

TEAS PLUS

File a TEAS Plus Application. [< This is a direct link to the electronic form.]

The TEAS Plus application has the lowest filing fee, at $225 per class of goods and/or services in the application, and you must meet certain additional requirements beyond the minimum filing requirements specified in the TEAS Regular description below. Select this option only if you agree to:

- **File a “Complete” Application:** Almost all the fields in this form are mandatory. For a complete list of TEAS Plus requirements, see [TMEP 8819](#).
- **Use the ID Manual:** You must be able to select an entry or entries from the USPTO’s [Acceptable Identification of Goods and Services Manual](#) (ID Manual) that accurately describe your goods/services. If you do not find a listing that accurately identifies your goods/services in the ID Manual, you may request that an identification be added by e-mailing [TMIDSUGGEST@uspto.gov](mailto:TMIDSUGGEST@uspto.gov); however, you could not file immediately. For more information on this process, click [here](#).
- **Pay Fees for All Classes:** You must pay the fees for all classes at the time of filing.
- **File Electronically:** You must file certain relevant application-related submissions, such as a response to Office action, through TEAS.
- **Authorize E-mail Communication:** You must provide a valid e-mail address and authorize the USPTO to send e-mail correspondence concerning the application.

**NOTE:** If you fail to meet the TEAS Plus requirements, the USPTO will require you to pay an additional fee of $50 per class.

Preview TEAS Plus application form [PDF] prior to accessing the electronic version through the link above. Do **not** attempt to file the PDF version because it is for informational purposes only and **not** for submitting application information. To prepare and file the electronic form, you must click on “File a TEAS Plus Application” at the top of this section.
Filing a trademark application

• Three different initial application forms with different requirements and different fees per class

• Choose carefully!
<table>
<thead>
<tr>
<th></th>
<th>TEAS PLUS</th>
<th>TEAS RF (reduced fee)</th>
<th>TEAS REGULAR</th>
</tr>
</thead>
<tbody>
<tr>
<td>Filing Fee</td>
<td>$225</td>
<td>$275</td>
<td>$400</td>
</tr>
<tr>
<td>Email Authorization Required?</td>
<td>YES</td>
<td>YES</td>
<td>NO</td>
</tr>
<tr>
<td>Must Subsequent Filings be Electronic?</td>
<td>YES</td>
<td>YES</td>
<td>NO</td>
</tr>
<tr>
<td>Must ID be Selected from ID Manual?</td>
<td>YES</td>
<td>NO</td>
<td>NO</td>
</tr>
<tr>
<td>Must Certain Statements be Included in Application? (e.g. translation, color claim)</td>
<td>YES</td>
<td>NO</td>
<td>NO</td>
</tr>
</tbody>
</table>
TEAS Tip 4: Consider adding secondary email addresses

• Designate one primary email address for correspondence; and

• Up to four secondary email addresses in the “Correspondence Information” section

<table>
<thead>
<tr>
<th>Primary Email Address</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Secondary Email Address(es)</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
</tr>
</tbody>
</table>

Enter up to 4 addresses, separated by either a semicolon or a comma.

Only one e-mail address may be used for correspondence, in accordance with Office policy. The applicant must keep this address current in the Office’s records.
TEAS Tip 5: Use Change of Address forms to update email after filing

- Use the Change of Correspondence Address form (https://teas.uspto.gov/ccr/cca) to update correspondence address information.

- Use the Change of Owner Address form (https://teas.uspto.gov/ccr/coa/) to update owner address information.

- Note: Changing the owner’s address will not change the correspondence address unless the owner and correspondence addresses are identical.
TEAS Tip 6: Look for important form notices
# TEAS Tip 7: Use TEAS resources

<table>
<thead>
<tr>
<th><strong>Teas practice tips</strong></th>
<th>Tips for using online forms</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>System outages</strong></td>
<td>Notices of system problems and/or planned outages. (subscribe to the RSS feed to get updated automatically downloaded to your computer.)</td>
</tr>
<tr>
<td><strong>Filing during a TEAS outage</strong></td>
<td>Alternative methods for filing during an outage.</td>
</tr>
</tbody>
</table>

**Links:**
- [System outages](http://www.uspto.gov/blog/ebiz/)
- [Filing during a TEAS outage](https://www.uspto.gov/trademarks-application-process/filing-online/filing-documents-during-outage)
TEAS – July 2017 improvements

1. New wizard questions and language changes related to the rule on revivals, reinstatements, and petitions to the director

2. Simplified filing receipt language & success screens

3. New mark drawing validation

4. Enhanced ID Manual validation feature

5. Telephone number standardization
Overview of final petitions rule

• Provides specific deadlines for filing petitions to revive an abandoned trademark application, requests for reinstatement, and petitions regarding other matters

• Provides new rules for reinstating applications and registrations

• Limits your ability to claim in a petition that you did not receive a particular office action or notice of allowance to one time only

• Requires you to specify whether you are filing a notice of appeal when filing a petition to revive an application that abandoned because you did not respond to a final office action.
Simplified filing receipts for all forms

- Embedded hyperlinks instead of URLs
- Improved readability, including increased line spacing and removing all caps
- Described next steps in the application or registration process
Filing receipts

Before

Trademark Electronic Application System (TEAS) filing receipt

1. YOUR MARK: Pineapplie (Standard Character, mark.jsp) The literal element of the mark consists of Pineapplie. The mark consists of standard characters, without claim to any particular font, style, size, or color.

2. YOUR SERIAL NUMBER: We have received your U.S. Trademark Application and assigned serial number ‘87001130’ to your submission. A summary of your application data is provided at the bottom of this message and serves as your official filing receipt. Please keep a copy of this information for your records. All correspondence concerning the application should reference your assigned serial number. Please read all of the important information below. Not every mark is registrable with the USPTO and we do not refund the application filing fee(s) if a registration does not ultimately issue.

3. RECEIVING E-MAIL COMMUNICATIONS/FILE DOCUMENTS ON-LINE: Because you have authorized receipt of correspondence by e-mail, please make sure that your server will accept USPTO e-mail and not treat it as SPAM. If you must submit correspondence to us, please use the Trademark Electronic Application System (TEAS) forms, available at http://www.uspto.gov/trademarks/teas/index.jsp. Applicants who filed their application online using the lower fee TEAS RF application must (1) continue to submit certain documents online using TEAS, including responses to Office actions (see http://www.uspto.gov/trademarks/teas/teasbecca.jsp) for a complete list of these documents; (2) accept correspondence from the USPTO via e-mail throughout the examination process; and (3) maintain a valid e-mail address. TEAS RF applicants who do not meet these three requirements must submit an additional processing fee of $60 per international class of goods and services. However, in certain situations, an examiner’s amendment by telephone will not incur this additional fee.

4. KEEP YOUR ADDRESS CURRENT IN USPTO RECORDS: We do not extend filing deadlines due to a failure to receive USPTO mailings/e-mailings. You must update the correspondence and/or owner’s address if a postal address and/or e-mail address changes, using the form(s) available at http://www.uspto.gov/trademarks/teas/correspondence.jsp.

5. WARNING ABOUT UNSOLICITED COMMUNICATIONS: You may receive trademark-related communications from private companies not associated with the USPTO. These communications frequently display customer-specific information, including your USPTO serial number or registration number and owner name, and request fees for trademark-related services, such as monitoring, listings in international publications, and document filing. None of the companies offering these services are affiliated with the USPTO or any other federal agency. Official correspondence will be from the “United States Patent and Trademark Office” in Alexandria, VA, and if by e-mail, specifically from the domain “uspto.gov.” Please consult the “Warning” page on the Trademarks section of the USPTO’s website for further information about unsolicited communications and to view representative examples of them. For general information on filing and maintenance requirements for trademark applications and registrations, including fees required by law, please consult www.uspto.gov, contact the Trademark Assistance Center at usaic.gov or phone 1-800-786-9999.

6. LEGAL EXAMINATION PROCESS: Your application is now pending examination. In approximately 3 months, your application will be assigned to a USPTO examining attorney for review. The application cannot mature into a registration unless all legal requirements are met, and many applications never satisfy those requirements and therefore never register. The overall process can take up to 18 months.

7. CHECK STATUS AND REVIEW DOCUMENTS OR YOUR APPLICATION MAY BE UNINTENTIONALLY ABANDONED: You must check the status and review all documents associated with your application at least every 3–4 months using Trademark Status and Document Retrieval (TSDR), available at http://tsdr.uspto.gov/.

After

Filing Receipt for Trademark/Service Mark Application for Registration on the Principal Register and Next Steps in the Application Process

Thank you for submitting your trademark application to the U.S. Patent and Trademark Office (USPTO). This filing receipt confirms your mark and serial number, describes next steps in the application process, and includes the information submitted as your application. Please read this receipt carefully and keep a copy of your records.

For an overview of important things to know after filing your application, visit our website to read the After You File page and watch video number 7, “After You File.”

1. Your mark: The mark in your application is [insert mark information here].

2. Your serial number: Your application was assigned serial number #######. You must refer to your serial number on all communications about your application.

3. What happens next: legal examination. Your mark will not be registered automatically. In approximately three months, your application will be assigned to a USPTO examining attorney for review. The attorney will determine if your application meets all applicable legal requirements, and if it doesn’t you will be notified in an email with a link to the official Office action (official letter from the USPTO). Visit our website for an explanation of application process timelines.

4. Keep your current address current in USPTO records. We do not extend filing deadlines if you do not receive USPTO mail or e-mail. If your postal address or email address changes, you must update the correspondence or owner’s address using the address forms on our website.

5. Check your application status in our database every three to four months. To be sure that you don’t miss an important email from us, and to avoid the possible abandonment of your application, check your application status and review your documents in our database, Trademark Status and Document Retrieval (TSDR), every three to four months.

6. Warning about private companies offering trademark-related services. Private companies may send you communications that resemble official USPTO communications. These private companies are not associated with the USPTO. All official correspondence will be from the “United States Patent and Trademark Office” in Alexandria, Virginia, and from emails with the domain “uspto.gov.” If you are unsure about whether the correspondence is from us, check your records in our database, TSDR. Visit our website for more information on trademark-related communications that may resemble official USPTO communications.

7. Questions? Please visit our website, email us, or call us at 1-800-786-9999 and select option 1.

8. Application data: If you find an error in the data below, visit the After You File page on our website for information on correcting errors.

The information submitted in the application appears below:

(No table appears here with application data)

The following declaration and/or statement(s) were signed and submitted with the application:

[Insert declaration here]
New success screens

Success screens on all forms will provide next steps to filers.

Submission Successful: Trademark/Service Mark Application, Principal Register

Success! View/Save E-Receipt as PDF file

We received your application and assigned it serial number 87453477. Click on the button above to open and save a PDF version of your filing. This PDF will serve as your official confirmation copy.

We will also email a filing receipt and important next steps of the application process to tanya.amos@uspto.gov. For electronically submitted applications, we do not mail paper filing receipts.

What's next?

In approximately three months, your application will be assigned to a USPTO examining attorney for review. Visit our website for an explanation of application process timelines.

To be sure that you don't miss an important email from the USPTO and to avoid the possible abandonment of your application, you should check your application status and review your documents in our database, Trademark Status and Document Retrieval (TSDR) every three to four months.

Thank you,

The TEAS Support Team
Mark drawing validation

- TEAS is improving the validation process for ensuring that all uploaded images are good quality.
- TEAS will automatically convert CYMK color format to RGB and let you know that it was converted.
- TEAS will automatically check images to ensure that dots per inch (DPI) in the image are set to 300 DPI so they don’t cause problems with USPTO systems.
ID Manual validation feature

• The TEAS Plus form will validate IDs when the Pay/Submit button is clicked.

• This new service ensures that IDs in TEAS Plus comply with the current ID Manual, which is updated weekly.

• If the system identifies goods or services that appear no longer valid, the user will see an error message and check box.
Error message:
Your goods and/or services contain one or more items that are no longer valid entries in the Trademark ID Manual. In certain limited situations these may still be acceptable IDs, but in many cases they will not be acceptable for TEAS Plus. You may continue with your submission by checking the box below, but you are responsible for ensuring that all of your goods and/or services match entries in the appropriate class in the ID Manual. If any do not, this application may be removed from TEAS Plus and you may have to submit clarifying language and/or additional fees.

New check box:
By checking the box, applicant acknowledges that proceeding with this Identification of Goods and/or Services may result in the application’s removal from TEAS Plus and a requirement for clarifying language and/or additional fees.
Telephone number standardization

• TEAS is changing the way it stores telephone numbers to make them easier to read.

• All 10-digit U.S. telephone numbers will now include hyphens to separate the area code from the local exchange and local number as follows: XXX-XXX-XXXX. A separate field exists to capture telephone extensions.

• Users from other countries will have a drop-down list to find their country codes.
USPTO website improvements

• New initiative to improve our website
• Hired a customer experience administrator and two plain language writers to make information on the website more accessible
Our vision

Web content that meets the needs of all customers

Our process

• Customer-focused improvements
• Data and customer feedback guide our efforts
Quick Links

• Quick Links Menu connects you to the most heavily used tools for searching, filing, checking status, reviewing manuals
Trademark Assistance Center

Promoting our customer service center

Easy access from the Trademarks landing page
After you file webpage

Answering questions about what to expect

We want to hear from you
We are improving our webpages, filing receipts, and other communications based on your feedback. Was this page helpful? Let us know using the buttons at the bottom of the page.

After you file

After you submit an online form, read this page for important information on:

- Your duty to check application and registration status
- Correcting filing errors
- Requirements for electronic correspondence for TEAS RF and TEAS Plus applicants

Your duty to check application and registration status

After you submit an online form to the United States Patent and Trademark Office (USPTO), it’s your responsibility to check the status of your application or registration in our database, Trademark Status and Document Retrieval (TSDR). Through this database, you can see where you are in the application or post-registration process and you can review documents stored in your application or registration record.

NOTE: Four to five days after you submit an online form, check the documents tab in TSRD. If your documents do not appear in TSRD after four to five days, please email TrademarkAssistanceCenter@uspto.gov.

- Visit our website for information about when and how to check your status in TSRD.
- Check your status and view your documents now in TSRD.

Correcting filing errors

Not all filing errors are correctable—read this before you submit any forms to correct an error

Review your filing receipt carefully. If you find an error in your filing receipt immediately after submitting your receipt, visit Trademark Application Center to PTO-TEAS (option A) to cancel.
Design search codes

Clarifying a complex step in the process

A design search code is a six-digit number that helps the public and examining attorneys search the USPTO database for marks with similar designs. Understanding design search codes will help you conduct a more effective search before you file your application.

Links to additional USPTO webpages featuring information on conducting searches and design coding are at the end of this page.

Why does the USPTO use design search codes?

When examining your trademark application, we must determine whether a consumer is likely to confuse your mark with a registered mark or a mark in a previously filed application. To make that determination, examining attorneys and the public must be able to thoroughly and efficiently search the expansive USPTO database for marks that are similar to yours.

To focus the search, we assign a numerical design search code to each design element of your mark when we receive your application. A design element can be any component of your mark that is not a word, such as a depiction of a star or flower.

If your mark resembles another mark too closely in sound, appearance, or meaning, we will issue you a likelihood-of-confusion refusal.

Examples

If a mark contains an image of an elephant, that mark is assigned design search code 03.03.01. Searching for marks with the design code 03.03.01 would retrieve all federal trademark applications and registrations containing images of elephants, even if the mark included other design elements, such as the house in the mark shown below.
Guidance for foreign applicants

Addressing common missteps of foreign applicants and registrants

Guidance for foreign applicants and registrants

Use a qualified attorney to represent you
Consider the benefits of using a private trademark attorney
Choose a filing basis
Use your mark on all goods and services
Provide a specimen
Submit verified statements
Know who may sign applications and submissions
Check the status of your application or registration and viewing documents
Maintain your trademark registration

Use a qualified attorney to represent you

As a foreign applicant, you may represent yourself before the U.S. Patent and Trademark Office (USPTO), but we strongly recommend that you hire a qualified attorney who is experienced in trademark matters. All attorneys who represent applicants before the USPTO must be:

- Licensed in the United States
- Authorized to practice before the USPTO.

We do not permit non-attorneys or foreign attorneys to represent applicants before the USPTO with the exception of specifically authorized Canadian attorneys and agents.

If a foreign attorney or another unauthorized individual attempts to represent you directly, your application may be delayed or abandoned and the validity of your registration will be at risk.

Foreign attorneys and non-attorneys may not perform any of the following actions for anyone else:

- Consult or advise applicants or registrants concerning filing a trademark application, application-related issues, or matters involving the registration of a trademark.
- Accept compensation for legal services rendered in connection with the registration of a trademark.
- Represent applicants or registrants before the USPTO.

Consultation with an attorney regarding trademark registration issues is strongly recommended as it can help ensure the success of your application.
Rockin’ the Trademark

- http://www.uspto.gov/trademark/laws-regulations/rockin-trademark
- Questions and answers that apply to bands and other musical artists
On April 8th, the USPTO deployed a new maintenance tab for registered trademarks in TSDR. The tab will not appear if the mark is not registered.
If Mark Registered <5 Years, System Will Display 3 Dates

§8 (6 year) Affidavit of Continuing Use Due Dates:

- Earliest date §8 can be filed: Dec. 15, 2020
- Latest date §8 can be filed without paying additional fee: Dec. 15, 2021
- Latest date §8 can be filed by paying an additional fee: Jun. 15, 2022
MyUSPTO

Personalized homepage for managing IP portfolios

Access it at: https://MY.uspto.gov
Widgets & personalization

Widgets provide specific capabilities

Several functional widgets are available in the widget library. More are coming!

Widgets can be added, moved around on the page, deleted and re-added if needed
The uspto.gov user account

Users register once to set up a profile and account credentials (login/password)

Users then sign in and access all USPTO systems that have adopted the uspto.gov user accounts.

So far:
- MyUSPTO
- Financial Manager
- Patent Maintenance Fee storefront

Many more USPTO systems are moving to adopt the uspto.gov user accounts.

Stay tuned!

https://account.uspto.gov
Spotlight: TM Docket widgets

1. Track TM applications or registrations in one or more named “Collections”

2. Add/delete items from collections at any time

3. See status changes

4. Subscribe/unsubscribe to email updates
Spotlight: TM Official Gazette widget

1. Save search queries (“Watch”) in one or more named “Collections”

2. Add/delete watches from collections at any time

2. See search results of a search on the newest version of the OG
Spotlight: Favorites widget

1. Get to bookmarked USPTO pages and systems with one click

2. Add/delete more bookmarks as needed

FAVORITES

- File patents with EFS-Web
- Patent Full Text Search
- Search trademarks with TESS
- File trademarks with TEAS
- Fees
- Assignment Search
- Manual of Trademark Examining Procedures
- Patent Interview Request Form
- File TTAB documents (ESTTA)
- View a board proceeding (TTABVUE)
- Trademark Trial and Appeal Board Manual of Procedure (TBMP)

Name
Anderson inc - PRIVATE PAIR

URL
PAIR.USPTO.GOV

Cancel
Save
Please provide your feedback online

Thank you!
## Important contact information

| Technical difficulties with TEAS online forms | Email [TEAS@uspto.gov](mailto:TEAS@uspto.gov) M-F 8am-8pm ET |
| General trademark questions | Call or email the Trademark Assistance Center (TAC) M-F 8:30am- 8pm ET |
|  | 1-800-786-9199 [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) |
Comments, Questions, Suggestions?

For general suggestions for improving the USPTO website, please email TMFeedback@uspto.gov
Post Registration: Random Audit Overview, When to Use the Technology Evolution Pilot, and Tips on Filing Declarations Of Incontestability and Excusable Nonuse

Montia Pressey

Staff Attorney
Office of the Deputy Commissioner for Trademark Policy
Random Audit Program

• July 2012, pilot launched to assess the accuracy and integrity of the Trademark Register as to actual use of marks with goods/services listed in maintenance filings submitted to the USPTO.

• Under the pilot, 500 trademark registrations with 6-year Section 8 or Section 71 declaration of use filings were randomly selected for additional “proof of use.”

• 51% (253) of registrations unable to verify previously claimed use
  • 35% deleted goods/services queried under the pilot
  • 16% failed to respond to pilot Office actions and were cancelled
Random Audit Program

• Pilot ended but the final results supported need for ongoing measures to encourage registration owners to file accurate declarations of use.

• New Rules, Effective March 21, 2017:
  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 subject to audit.
Random Audit Program

• 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.

• “Proof of use”

  • For goods - photographs showing the mark on actual goods or packaging, or photographs of displays associated with the goods at the point of sale.

  • For services – signs, photographs, brochures, website printouts, or advertisements showing the mark used in the actual sale/advertising of services.
Random Audit Program

Evaluating Responses to Initial Office actions

• If a response provides acceptable proof of use for queried items, or deletes the queried items and the specimens of record also qualify as proof of use for any remaining goods/services, a notice of acceptance will issue without further inquiry.

• Still Under Discussion: If a response deletes any items queried for proof of use or no acceptable proof of use for queried items is provided, and additional goods/services remain in the registration without acceptable proof of use, the Office is considering requiring proof of use for all remaining items in the second Office action.
Random Audit Program

Evaluating Responses to Second Office actions

• **Still Under Discussion**: If a registration owner responds to the second Office action by deleting some of the queried goods/services or providing unacceptable proof of use, a *third and final Office action* would then be issued advising that any goods/services for which acceptable proof of use was not provided will be deleted from the registration.

• Option to file a Petition to the Director under 2.146 would also be provided, in the event the owner disagrees with the refusal to accept the filing as to all goods/services.
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.
Technology Evolution Pilot

• On petition, the Office is allowing limited amendments to IDs in registered marks outside the scope of current rules

• Petitioners must declare that the amendments are necessary because “evolving technology” has changed the manner/medium by which content is offered for sale/provided to consumers
Technology Evolution Pilot

• The content or subject matter of the goods/services must be the same.

• Existing goods/services for which petitioner is unable to show use must be replaced in the registration with the “evolved” goods/services.

• Permitted only where: (1) petitioner is unable to show use of the mark with the goods/services in original form and, absent an amendment, (2) petitioner would lose protection of the registration in relation to the underlying content or subject matter of the original goods/services.
Technology Evolution Pilot

• Requires a Petition to the Director under 2.146 and a Section 7 Request to amend the ID (filed together using the TEAS Petition Form)

• $100 petition fee (petitions under the pilot must be filed via TEAS) and $100 Section 7 Request fee

• Supporting specimen

• New Dedicated Webpage on USPTO website - Amending your registration’s goods/services when technology evolves:

https://www.uspto.gov/trademarks-maintaining-trademark-registration/amending-your-registration-s-goodsservices-when
Technology Evolution Pilot

• Additional Considerations

  • In Madrid registrations, (1) the scope of the amended goods/services cannot be beyond the scope of the original ID in the underlying international registration, and (2) the classification of goods/services cannot be changed.

  • If a mark has incontestable status, that status will not be transferred to the amended goods/services and no new incontestability filing permitted for 5 years after the approval of the ID amendment.

  • Filing a request under the pilot program does not toll any required maintenance filing deadlines. Be sure to timely file any required filings, identifying the evolved goods/services, since the original goods/services are no longer in use.
Technology Evolution Pilot

EXAMPLES

• Acceptable:
  
  o “Phonograph records featuring music” in International Class 9 to “Musical sound recordings” in International Class 9

  o “Telephone banking services” in International Class 36 to “On-line banking services” in International Class 36
Technology Evolution Pilot

• Unacceptable

“Downloadable software for use as a spreadsheet in the field of accounting” in International Class 9 to “Providing on-line non-downloadable software for use as a spreadsheet in the field of business management” in International Class 42

NOTE: This amendment would not be allowed because the subject matter of the spreadsheet software has changed from accounting to business management.
Section 8 Declaration/Affidavit of Excusable Nonuse

Filing Tips

• Submit a complete nonuse claim in the initial filing.

• Use the “Miscellaneous Field” in the TEAS form to provide information supporting each required element.

• Be sure that the “special circumstances” are accurate and support all relevant goods/services.
Section 8 Declaration/Affidavit of Excusable Nonuse

Required Information for Nonuse claims

The owner is claiming excusable nonuse under Trademark Act Section 8. 15 U.S.C. §1058. A proper claim of excusable nonuse must include all of the following information:

(1) the date of last use of the mark;
(2) details explaining the special circumstances* excusing nonuse;
(3) the steps being taken to resume use; and
(4) the approximate date when use is expected to resume.

37 C.F.R. §2.161(f)(2); TMEP §1604.11.

*When nonuse claims are denied, most often it is because the facts do not support that nonuse is due to “special circumstances.”
Section 8 Declaration/Affidavit of Excusable Nonuse

Filing Tips (cont’d)

- Example: A claim that the mark is not in use because the owner is awaiting FDA approval where the goods include “mobile phones” and “light bulbs” would not be accepted.

- It is possible to include nonuse and use claims in the same declaration/affidavit. Both claims must be complete.

- A use filing cannot be “amended” to a nonuse filing, and vice versa. A new filing must be submitted within the relevant statutory period. See TMEP Section 1604.11
Section 8 Declaration/Affidavit of Excusable Nonuse

Examples: “Special Circumstances?”

• Retooling of plant or equipment?
  ☐ Yes, but excusable only if the facts demonstrate that plant or equipment is \textit{essential} to production of goods and \textit{no alternate equipment available}.

• Physical impairment of the Owner?
  ☐ Only if the facts demonstrate that the business is a “one person operation” that could not continue without owner’s presence.
Section 8 Declaration/Affidavit of Excusable Nonuse

Examples: “Special Circumstances?”

- Awaiting review and approval by FDA for registration covering drugs?
  - Yes, but facts must provide details about the review process and the current status of the goods in that process and the expected date of approval, if available. Moreover, the goods should be drugs or other medical products directly connected to drugs. Must be clear that nonuse use is solely attributable to FDA review process.
Section 8 Declaration/Affidavit of Excusable Nonuse

Examples: “Special Circumstances?”

• Pursuing new licensee or distributor, negotiations with distributors or licensees?
  ■ No. Typical business activities.

• Re-design of product line?
  ■ Generally no (but maybe if re-design required due to a change in government regulations).
Section 15 Declaration/Affidavit of Incontestability

• Section 15 provides a procedure by which exclusive use of a trademark can become “incontestable.” Not available for registrations on the Supplemental Register.

• Incontestability protects registration from certain challenges, e.g., *descriptiveness* (of goods/services), primarily merely surname, and primarily geographic descriptiveness.

• Incontestability *does not* protect against all challenges, e.g., *genericness*, *functionality*, *abandonment*, *fraud on the USPTO*, and *false suggestion of a connection* can be raised at any time.
Section 15 Declaration/Affidavit of Incontestability

• Filing Tip: Before filing a Section 8/71 Declaration/Affidavit of Use and a Section 15 Declaration/Affidavit of Incontestability consider whether the identification of goods/services covered by the registration is accurate. Has the “medium” (method) by which the same content is provided under the registration changed due to evolved technology?

• Yes? Consider pursuing an ID amendment under the “technology evolution” pilot program.
Section 15 Declaration/Affidavit of Incontestability

- Wait to file a Section 15 as to the goods/services you want to amend under the pilot because incontestability cannot be applied to them. In addition, no new incontestability filing will be permitted for 5 years following the approval date of the ID amendment.

- General consideration for all required maintenance filings: Be sure that the listing of goods/services in the registration accurately reflects current use of the mark. Limit the incontestability claim and/or delete goods/services from the registration as necessary.
Section 15 Declaration/Affidavit of Incontestability

• Post Registration Review of Section 15 Filings
  • Execution Date must be no earlier than five years from the date of registration.

• Chain of Title must be clear to the party that filed.

1. Prior to filing, ensure that appropriate documents are recorded with Assignment Recordation Services.

2. If there is no time to record before filing, use the “Miscellaneous Field” of the TEAS Section 15 Declaration form to explain and clarify any discrepancies between the owner information in the filing and in the Trademark Database.
Section 15 Declaration/Affidavit of Incontestability

• Post Registration Review of Section 15 Filings
  
  • No final decision adverse to owner’s claim of ownership of the mark or right to register/keep the registration.

  • No pending proceeding involving these rights before the USPTO or a court.

• The Office reviews:
  1. Trademark Database for Notice of Suit information listing the registration owner as the defendant

  2. TTABvue for any proceedings challenging the validity of the registration (including in as a counterclaim in oppositions)
Section 15 Declaration/Affidavit of Incontestability

• Prior to Filing a Section 15 Declaration/Affidavit:

  • Check TTABVUE and the Trademark Database to confirm there are no notices of suit or pending/final decisions that might preclude acknowledgement of the filing.

  • If the information in USPTO records is incomplete (e.g., federal challenge dismissed with prejudice), provide supporting documents with initial Section 15 filing.

  • No refund of fee if Section 15 filing is refused.

  • If Section 15 declaration/affidavit is filed in error, file a Petition to the Director under 2.146, along with the $100 fee (if filed via TEAS) or $200 (if filed via paper), requesting that it be abandoned.
On January 27, 2015, USPTO began sending email reminders of maintenance filing deadlines for:

- Declarations/Affidavits of use/nonuse (§§8 and 71)
- Renewals (§9, non-Madrid registrations only)
- Electronic forms available on the USPTO website

To be eligible to receive email reminders registration owners must:

- Provide a valid email address;
- Authorize email communication; and
- Own a “live” registration on the scheduled issuance date.
Courtesy E-mail Reminders!

• Look for the “.gov” ending in the sender’s email address to ensure it is an official USPTO notice.
<table>
<thead>
<tr>
<th>Filing Type</th>
<th>Old TEAS</th>
<th>New TEAS</th>
<th>Old Paper</th>
<th>New Paper</th>
</tr>
</thead>
<tbody>
<tr>
<td>Section 8</td>
<td>$100</td>
<td>$125</td>
<td>$100</td>
<td>$225</td>
</tr>
<tr>
<td>Section 9</td>
<td>$300</td>
<td>$300</td>
<td>$400</td>
<td>$500</td>
</tr>
<tr>
<td>Sections 8/9</td>
<td>$400</td>
<td>$425</td>
<td>$500</td>
<td>$725</td>
</tr>
<tr>
<td>Additional fee for filing Section 8 during grace period, per class</td>
<td>$100</td>
<td>$100</td>
<td>$100</td>
<td>$200</td>
</tr>
<tr>
<td>Correcting a deficiency in a Section 8 affidavit</td>
<td>$100</td>
<td>$100</td>
<td>$100</td>
<td>$200</td>
</tr>
<tr>
<td>Additional fee for filing Section 9 during grace period, per class</td>
<td>$100</td>
<td>$100</td>
<td>$100</td>
<td>$200</td>
</tr>
<tr>
<td>Section 15</td>
<td>$200</td>
<td>$200</td>
<td>$200</td>
<td>$300</td>
</tr>
<tr>
<td>Section 8/15</td>
<td>$300</td>
<td>$325</td>
<td>$300</td>
<td>$525</td>
</tr>
<tr>
<td>Section 71</td>
<td>$100</td>
<td>$125</td>
<td>$100</td>
<td>$225</td>
</tr>
<tr>
<td>Sections 71/15</td>
<td>$300</td>
<td>$325</td>
<td>$300</td>
<td>$525</td>
</tr>
<tr>
<td>Additional fee for filing Section 71 during grace period, per class</td>
<td>$100</td>
<td>$100</td>
<td>$100</td>
<td>$200</td>
</tr>
<tr>
<td>Section 12(c)</td>
<td>$100</td>
<td>$100</td>
<td>$100</td>
<td>$200</td>
</tr>
<tr>
<td>Issuing new certificate of registration</td>
<td>$100</td>
<td>$100</td>
<td>$100</td>
<td>$200</td>
</tr>
<tr>
<td>Certificate of correction, registrant's error</td>
<td>$100</td>
<td>$100</td>
<td>$100</td>
<td>$200</td>
</tr>
<tr>
<td>Filing disclaimer to registration</td>
<td>$100</td>
<td>$100</td>
<td>$100</td>
<td>$200</td>
</tr>
<tr>
<td>Filing amendment to registration</td>
<td>$100</td>
<td>$100</td>
<td>$100</td>
<td>$200</td>
</tr>
</tbody>
</table>
New Post Registration Filing Fees (Effective January 14, 2017)

- Link to USPTO Fee Schedule:
  
A Day in the Life of an Examining Attorney
Steven Berk
Trademarks Chief of Staff
September 13, 2017
Trademark Performance Measures

• Pendency Goals
  – 2.5 to 3.5 months to first action
  – 12 months to disposal
  – 2015: translates to 967,400 first actions plus disposal actions
  – 2016: translates to 1,061,055 first actions plus disposal actions
  – 2017: estimated 1,121,500 first actions plus disposal actions
  – 2018: estimated 1,187,000 first actions plus disposal actions

• Quality Goals
  – 95.5% compliance on first actions
  – 97.0% compliance on final actions
  – 42.0% “exceptional” Office actions

• E-Government
  – 86.4% of applications are processed entirely electronically
Trademark Organization Staffing

• 836 Trademark employees (7% of USPTO)
• 555 examining attorneys (66% of Trademarks)
  – All applications for registration are examined by an attorney
• Trademark organization is steadily growing and very few employees are leaving
  – Hiring approximately 50? new examining attorneys in FY18
  – Average about 10 examiners promoted to new positions each year
  – Average about 5 examiners leaving the USPTO each year
Trademark Work at Home

• Telework programs in all Trademark organization work units

• 88% of Trademark employees are eligible to participate

• 77% of examining attorneys telework full time (“hoteling”), most in the local area

• As a business strategy, telework increases job satisfaction and employee retention

• $34 million in agency real estate costs in FY16 were avoided because of “hoteling”

• Examining Attorney work is measured through quality review and number of applications processed. On line tools allow for real time monitoring.
TEAPP

• 18% of examining attorneys participate in the Telework Enhancement Act Pilot Program (TEAPP), allowing telework full time outside the local area (currently in 31 different states, 109 employees), with change in duty station, and waiver of employee’s right to reimbursement for four trips back to campus

• Congressional authority for TEAPP expires in December, 2017; working with Gov’t Affairs to hopefully extend or make permanent
Law Office Structure

• The Examination Corps is divided into 25 separate law offices typically comprising 20-25 attorneys in each law office. We are piloting a few of these offices with a virtual Managing Attorney. (Law Offices 102, 118, 119, 124)

• A Managing Attorney and Senior Supervisory Attorney lead each office.

• Unlike Patents, the examining attorneys do not specialize in particular areas of goods and services.

• Piloting new Law Office 120, 121, 122, 123, and 125 with all new examining attorneys
Training New Examining Attorneys

- Newly hired attorneys: 4-6 weeks of intensive training
- Mentor assigned
- The mentoring period continues for approximately 2 years
- The new examining attorney’s authority increases until full signatory authority is given at the end of the 2-year period.
- Exploring New Training Methods
Primary Mission: Trademark Examination

• Trademark registration is a legal determination made under the authority of:
  – Article 1, Section 8 of the Constitution (Commerce Clause)
  – Trademark Act of 1946 as amended (Title 15 of the United States Code)
  – Code of Federal Regulations, Title 37
  – International Treaties
  – Federal case law

• Legal review by examining attorneys:
  Our attorneys review, research and search for conflicts for every trademark application to make a legal decision as to allowance for registration.
The Job of the Examining Attorney

• Getting the File: FAST
• Searching: X-search
• Database changes: TRADEUPS/TRAM
• Procedural Issues
• Substantive Issues
• Issuing Office Actions
  – Internal Deadlines
  – Production
  – Docket Management
Obtaining a File

• The examining attorney requests a file using our FAST electronic docketing system.

  ![FAST logo]

• Copending applications (applications that have the same owner, filed at or near the same time) are also sent to the examining attorney to maintain consistency.
Obtaining a File (cont.)
Searching

- The USPTO maintains a database of federally registered marks and pending TM applications only (not State Regs, Common Law, Domain Names)
- The examining attorney conducts a search using software known as X-search to determine registrability of the applied for mark. Words and designs are searched using this application.
- Applicants may conduct their own search online using the **TESS** (Trademark Electronic Search System) free of charge
Issuing Office Actions

• Examining Attorney will address any procedural/substantive issues identified in review.
• This can be done by office action, examiner’s amendment (phone call/informal e-mail), priority action.
• The office strongly encourages phone resolution.
• All responses should be electronic, using our forms.
Issuing Office Actions (cont.)

• The applicant or its attorney can submit written arguments as to why the refusal or requirement should be withdrawn.

• If the examining attorney is not convinced by those arguments and repeats the refusal or requirement, an appeal can be taken to the Trademark Trial and Appeal Board.
FAST Action Manager
Grounds for Refusal

• Some possible grounds for refusal:
  – Likelihood of Confusion
  – Merely Descriptive
  – Geographic
  – Surname
  – Failure to Function
Approval for Publication

- If the mark is approved for publication, and, if after publication, no one opposes the issuance of a registration, a registration will issue.
  - If the application was based on an intent to use the mark, the applicant must submit a statement of use before a registration is issued.
  - If an opposition was filed, it is considered by the Trademark Trial and Appeal Board.
Deadlines

• Examining attorneys are given seven (7) days to take initial action on a new case.
• The applicants are given six (6) months to respond to any requirement or refusal addressed in a priority action or office action.
• If the applicant does not respond within this time period, the file is deemed abandoned.
• Once the applicant responds, the examining attorney has 21 days to take appropriate action upon receipt by the examining attorney.
Production

• Depending on experience, the examining attorneys are required to produce a certain number of Office Actions in a specified period.

• Examining attorneys receive credit for the first action taken and the final disposal of the case.
Docket Management

- Each examining attorney has an online docket where cases are sent for review.
- Applications are divided into separate categories, namely suspension, SOU, abandonment, TTAB, and response to office action.
# Reports

## Total Balanced Disposals

<table>
<thead>
<tr>
<th>Current Period</th>
<th>FY To Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>57.00</td>
<td>1,165.00</td>
</tr>
<tr>
<td>66A First Actions</td>
<td>9.00</td>
</tr>
</tbody>
</table>

## Total Action Points

<table>
<thead>
<tr>
<th>Current Period</th>
<th>FY To Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>50.00</td>
<td>1,203.50</td>
</tr>
</tbody>
</table>

## Total Examining Hours

<table>
<thead>
<tr>
<th>Current Period</th>
<th>FY To Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>0.00</td>
<td>804.20</td>
</tr>
</tbody>
</table>

## Action Points Per Hour

<table>
<thead>
<tr>
<th>Current Period</th>
<th>FY To Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>0.00</td>
<td>1.50</td>
</tr>
</tbody>
</table>

## Admission Action Codes

<table>
<thead>
<tr>
<th>Serial Number</th>
<th>MARK</th>
<th>Action Number</th>
<th>Active Classes</th>
<th>Total BDS</th>
<th>Correction</th>
<th>Action Type</th>
<th>Action Date</th>
<th>Action Time</th>
<th>Tran Code</th>
<th>Total Points</th>
</tr>
</thead>
<tbody>
<tr>
<td>2</td>
<td>0.0</td>
<td>1.0</td>
<td>1.0</td>
<td>1.0</td>
<td>Abandonment-Failure To Respond</td>
<td>2017/02/09</td>
<td>06:57:11</td>
<td>6323</td>
<td>1.0</td>
<td></td>
</tr>
<tr>
<td>8</td>
<td>0.0</td>
<td>1.0</td>
<td>1.0</td>
<td>1.0</td>
<td>Abandonment-After Final Refusal</td>
<td>2017/02/08</td>
<td>07:26:04</td>
<td>6323</td>
<td>0.0</td>
<td></td>
</tr>
<tr>
<td>4</td>
<td>0.0</td>
<td>1.0</td>
<td>1.0</td>
<td>1.0</td>
<td>Abandonment-Failure To Respond</td>
<td>2017/02/08</td>
<td>07:26:35</td>
<td>6323</td>
<td>1.0</td>
<td></td>
</tr>
<tr>
<td>5</td>
<td>0.0</td>
<td>1.0</td>
<td>0.0</td>
<td>0.0</td>
<td>Non-Final Action - Initial Exam</td>
<td>2017/02/07</td>
<td>08:52:02</td>
<td>6325</td>
<td>0.0</td>
<td></td>
</tr>
</tbody>
</table>
Awards Eligibility

- Outstanding in Production/Pendency
- At least fully successful in all other critical elements
- $\frac{1}{2}$ award amount if commendable in production/pendency, and full successful in all other critical elements
- 3% for outstanding in quality
- Examiners may earn up to $5K per quarter in production bonuses (when in effect)
Trademark Trial and Appeal Board - *Inter partes* proceedings

Elizabeth Dunn and Christen English
TTAB Interlocutory Attorneys
September 13, 2017
Overview

1. Slides
   • Differences between TTAB proceedings and trademark prosecution
   • Introduction to *inter partes* proceedings
   • Electronic filing tips for practitioners new to *inter partes* proceedings

2. Written materials
   • “Advanced Practice Tips from the TTAB”
Every trademark applicant has the potential to become involved in a TTAB inter partes proceeding

Examination may be followed by an opposition
• In FY16, more than 5,000 applicants became defendants in TTAB opposition proceedings

Registration may be followed by a cancellation
• In FY16, more than 1,500 former applicants, aka current registrants, became defendants in TTAB cancellations
TTAB inter partes proceedings

• Part of the registration process BUT

• more similar to civil actions in district court than to examination.
EX PARTE V. INTER PARTES PRACTICE: key differences

• *less ability to consult with USPTO

• other side must consent to amend or abandon application or registration

• shorter deadlines

• more formal evidence required

• *limited electronic filing options (last section)
Communication with USPTO during Examination

- Examining Attorneys help the applicant obtain the registration, and have the burden of supporting any refusal of registration with evidence.

- Examining Attorneys may offer suggestions on how to modify the application to gain approval.
Communication with USPTO during Litigation

• Interlocutory Attorneys (and other TTAB staff) apply procedural rules to ensure fairness for both parties, and do not address the merits of the case.

• Interlocutory Attorneys (and other TTAB staff) must avoid ex parte communications which could be construed as legal counsel (what a party should file) and advisory opinions (how the TTAB will rule on a filing)
Governing Statutes and Relevant Rules

• Examination
  ➢ U.S. Trademark Act (Lanham Act), 15 U.S.C., et seq.; and
  ➢ Trademark Rules of Practice, 37 C.F.R. Part 2

• Inter Partes Proceedings
  ➢ U.S. Trademark Act (Lanham Act), 15 U.S.C., et seq.; and
  ➢ Trademark Rules of Practice, 37 C.F.R. Part 2

  PLUS

  ➢ Federal Rules of Civil Procedure
  ➢ Federal Rules of Evidence
Source of Information on Board procedures:

Trademark Trial and Appeal Board Manual of Procedure (TBMP)

- Like TMEP
- Searchable
- Detailed
- Includes legal case cites
- Available from USPTO.GOV

*not binding as case law or rules, but practical guidelines
Case Management at the Board

1. Consent motions and uncontested matters
   • addressed automatically by ESTTA
   • order by paralegal staff

2. Complicated uncontested matters and contested motions
   • order by interlocutory attorneys

3. Dispositive contested motions, trial evidence and briefs
   • opinion by panel of judges
Scope of TTAB Inter Partes Proceedings

- The Board’s jurisdiction is limited to determining only the right to register

- Remedies: Refuse Registration or Cancel Registration (in some instances, Modify Registration)

- The Board cannot award damages, costs or fees. Nor can the Board issue injunctions.
Stages in a TTAB *Inter Partes* Proceeding

Five stages of opposition and cancellation proceedings:

1. Pleadings
2. Disclosure and discovery
3. Trial
4. Briefing and, if requested, oral hearing;
5. Final decision
Pleadings

- Complaint (notice of opposition or petition to cancel) = “short and plain” statement of legal theory of the case

  - Allegations made in ESTTA coversheet v. Allegations asserted in body of complaint
  - Bald, conclusory allegations not sufficient
  - May make pleaded registrations of record
Pleadings

• Service of Complaint and Institution of Proceeding
  
  ➢ Board will effect service of complaint on defendant
  
  ➢ Board will issue institution order setting dates for proceeding, including time to file answer to complaint
Pleadings

- Answer = “short and plain” statement of defenses to pleaded claims(s)
  - Answer should correspond to numbered paragraphs in complaint
  - With respect to each paragraph: (1) admit; (2) deny; or (3) state without knowledge to admit or deny, which functions as a denial;
  - Matters admitted do not have to be proven
  - Should not include arguments on the merits
  - Affirmative defenses – must be pleaded with particularity
  - Counterclaim(s) - May be compulsory; fee(s) required
Settlement

- Most Board cases settle

- Motions to extend or suspend for settlement
  - Suspending/extending before answer v. after answer
  - Reporting requirement
Trial Strategy

PLAN AHEAD...

• Parties should focus early on what evidence they need to establish each required element of each pleaded claim or defense, and how to obtain and submit that evidence.

• Pleadings determine scope of discovery, so over-pleading likely to expand costs
Discovery Conference

• Both parties are responsible for scheduling conference.

• Required to discuss subjects set forth in Fed. R. Civ. P. 26(f) and the Board’s institution order.

• Discuss whether the parties are willing to explore possible settlement

• Should discuss possibility of ACR or reaching evidentiary and/or factual stipulations that will streamline the case
Discovery Conference, Cont.

• Board participation in discovery conference

  ➢ May be requested by phone or through ESTTA

  ➢ Particularly helpful when your adversary is appearing *pro se*, when the claims or defenses have not been adequately pleaded, or if the case is one that may become unnecessarily contentious

  ➢ Board may strike insufficient claims and defenses – usually will allow time to replead
Initial Disclosures

• Timing
  ➢ Must be made no later than 30 days after the opening of discovery
  ➢ May not serve discovery until have served initial disclosures

• Served on opposing party; not filed with the Board

• Content
  ➢ Identify potential witnesses and the subject(s) about which each witness is knowledgeable; and
  ➢ Either identify by category and location the documents that you may rely on at trial or produce the documents you may rely on at trial
Discovery

• Discovery = the parties’ opportunity to investigate facts relevant to claims and defenses

➤ Written discovery requests, limited to 75 each:
  o Interrogatories
  o Requests for Production of Documents
  o Requests for Admission

➤ Depositions
  o Limited to 10
  o Fed. R. Civ. P. 30(b)(6) deposition available
Serving Discovery Requests

• Timing
  ➢ Must be served early enough in proceeding so that responses are due during discovery
  ➢ Serve discovery early so have sufficient time for follow-up discovery

• Request only what is *truly* relevant

• Must be proportional to the needs of the case

• Section 414 of the TBMP sets out numerous examples of the types of information/documents generally discoverable in Board proceedings
Responding to Discovery Requests

- 30 day response period

- Objections
  - Must be stated with particularity
  - No objections based on confidentiality – standard protective order automatically in place to govern confidential information

- Privilege Log – necessary if asserting privilege

- Duty to supplement discovery responses
Discovery Disputes

• Parties have a duty to cooperate to resolve discovery disputes

• Board will not entertain motion to compel absent a showing that movant made a good faith effort to resolve dispute prior to seeking Board intervention
Motions Practice

- Range of motions may be filed in Board proceedings

- Response period
  - Twenty days
  - Exception: thirty day period to respond to motion for summary judgment
  - Deadline for reply brief may not be extended, even upon consent
Motions Practice, Cont.

• Suspension
  ➢ Automatic for potentially dispositive motions
  ➢ Will suspend for motions to compel
  ➢ May suspend for other motions

• Motion may be granted as conceded if not opposed
Pretrial Disclosures

• Due 15 days prior to opening of each testimony period

• Served on opposing party, not filed with the Board

• Content
  ➢ Disclosure of witnesses who may testify or statement that have no plans to submit witness testimony
  ➢ Need not disclose documents that may rely on at trial
Trial = Testimony Periods

• Timing

➢ Each party has a thirty-day testimony period

➢ Plaintiff has a fifteen-day rebuttal testimony period
Trial Evidence

- Evidence Automatically of Record
  - Application or registration *subject* to proceeding
  - Pleased registration(s) *not* automatically of record absent counterclaim(s) to cancel

- Testimony
  - Affidavit or declaration subject to optional live cross-examination
  - Testimony deposition
Trial Evidence

• Notices of Reliance – admissible materials include:

  ➢ pleaded registrations

  ➢ printed publications and official records

  ➢ Internet materials

  ➢ adversary’s answers to interrogatories

  ➢ adversary’s admissions to requests for admission
Objections to Trial Evidence

• No motions *in limine*

• Procedural objections must be raised promptly or may be deemed waived

• Substantive objections, *e.g.* hearsay or relevancy, may be raised in final briefs or separate appendix; will not be decided prior to final decision
Final Briefs

- 55 page limit for main briefs; 25 page limit for reply briefs

- Must include alphabetical index of cited cases, included in page limit

- Should discuss pertinent facts in view of relevant statutory authority and case law

- Cite relevant record evidence by its location in TTABVUE, the Board’s electronic docketing system, e.g. 10 TTABVUE 15-16.

- Do not reattach evidence of record to brief
Oral Hearing

• Optional – will be scheduled by the Board on request of one or both parties

• Each party is allotted 30 minutes; plaintiff may reserve time for rebuttal

• Judges will have read briefs, but generally will not have reviewed the record so may have questions about the record
TTAB Electronic Filing Tips

• What ESTTA does
  ➢ proves TTAB receipt of filings
  ➢ provides docket access (except to confidential papers)

• What ESTTA does not do
  ➢ provide forms*
  ➢ prevent error
  ➢ suggest action
  ➢ supply language

* exception: extensions of time to oppose and consent motions
ESTTA Summary

- “Requests for extension of time” and “consent motions”
  - most similar to TEAS

- “File a New Proceeding”
  - only a template

- “File documents in a Board proceeding”
  - load your own documents only
Sample TEAS forms used in ex parte examination

Initial Application Form

- TEAS Plus Application
- TEAS RF Application [This is a direct link to the combined TEAS RF/TEAS Regular electronic form. The TEAS RF filing option will be pre-selected in wizard question 1.]
- TEAS Regular Application [This is a direct link to the combined TEAS RF/TEAS Regular electronic form. To file a TEAS Regular form, you must select the TEAS Regular filing option in wizard question 1.]
- Trademark/Servicemark Application, Supplemental Register
- Certification Mark Application, Principal Register
- Collective Membership Mark Application, Principal Register
- Collective Trademark/Servicemark Application, Principal Register

Correspondence and Attorney/Domestic Representative Forms

- Change of Correspondence Address Form
- Change of Owner’s Address Form
- Change of Domestic Representative’s Address
- Withdrawal of Attorney
- Replacement of Attorney of Record with Another Already-Appointed Attorney
- Revocation of Attorney/Domestic Representative and/or Appointment of Attorney/Domestic Representative
- Request to Withdraw as Domestic Representative

Response Forms

- Response to Office Action Form
- Request for Reconsideration after Final Office Action Form
- Response to Suspension Inquiry or Letter of Suspension
- Substitute Trademark/Servicemark Application, Principal Register
- Substitute Certification Mark, Principal Register
- Substitute Collective Membership Mark, Principal Register
- Substitute Collective Trademark/Servicemark, Principal Register
- Response to Intent-to-Use (ITU) Office action
- Response to Post-Registration Office action
- Response to Petition to Revive Deficiency Letter
- Response to Petition to Director Inquiry Letter

Intent-to-Use (ITU) Forms

- Statement of Use/Amendment to Allege Use for Intent-to-Use Application
- Request for Extension of Time to File a Statement of Use
- Respond to an Intent-to-Use Unit Office action

Madrid Protocol Forms

- Application for International Registration
- Subsequent Designation
- Response to a Notice of Irregularity
- Replacement Request
- Transformation Request
- Declaration of Use and Excusable Nonuse under Section 71
- Combined Declaration of Use & Incontestability under Sections 71 & 15
- Petition to Director to Review Denial of Certification of International Application
Please choose one of the following options to start filing a form for

- **Request for Extension of Time to File an Opposition**
  File a request for extension of time to file a notice of opposition.
  Enter the serial number of the application to which the filing applies: ______________ Start
  Fees are required for certain requests for extension that can be filed using this form.

- **File a New Proceeding**
  Use these options to file a new opposition, cancellation or appeal from a final refusal to register. Choose your filing and enter the serial number of the application to be opposed, the registration number of the registration to be cancelled, or the serial number of the application to be appealed.
  Type of filing: ______________ Start

  Notice of Opposition
  Petition for Cancellation
  Appeal of Refusal to Register

- **File Documents in a Board Proceeding**
  Use these options to file documents (motions, briefs, etc.) in an already existing opposition, cancellation, concurrent use, or appeal proceeding. Choose a filing option and enter the opposition number (91xxxxxx), cancellation number (92xxxxxx), concurrent use number (94xxxxxx), or application serial number to which your filing applies.
  Type of filing: ______________ Start

  Most filings do not require a fee.
Please choose one of the following options to start filing a form for

- **Request for Extension of Time to File an Opposition**
  File a request for extension of time to file a notice of opposition.
  Enter the serial number of the application to which the filing applies: [Start]
  Fees are required for certain requests for extension that can be filed using this form.

- **File a New Proceeding**
  Use these options to file a new opposition, cancellation or appeal from a final refusal to register. Choose your filing and enter the serial number of the application to be opposed, the registration number of the registration to be cancelled, or the serial number of the application to be appealed.
  **Type of filing:** [Start]
  There is a filing fee associated with these forms.

- **File Documents in a Board Proceeding**
  Use these options to file documents (motions, briefs, etc.) in an already existing opposition, cancellation, concurrent use, or appeal proceeding. Choose a filing option and enter the opposition number (91xxxxxx), cancellation number (92xxxxxx), concurrent use number (94xxxxxx), or application serial number to which your filing applies.
  **Type of filing:** [Start]

Most filings do not require filing fees.
List of Consent Motions

Electronic System for Trademark Trials and Appeals

Consent Motions

Use these forms to file the following consent motions in cancellation or opposition proceedings:

1. Motion to extend the time to answer
2. Motion to extend the current discovery or testimony period
3. Motion to suspend for settlement negotiations
4. Motion to suspend in view of civil litigation

- In order to use these forms, you must have the explicit consent of all other parties to the proceeding for the suspension or extension you are requesting. If you do not have consent, you may file your motion using ESTTA's "File documents in a Board proceeding." "Opposition, cancellation or concurrent use(general filings)" option.

- Because the Board may issue an order on this motion electronically, you also must supply an email address for both yourself and the opposing party to which the order may be sent.

I have secured the consent of all parties  Cancel  Save Session
ESTTA Consent Motion Tips

• Consent must be explicit

• Granted automatically without Board review, so do not include motion or request for action

• If you file wrong dates, re-file with correct dates (and if ESTTA consent motion won’t allow, upload paper as general filing)

• Serve a copy on adverse party, even a signed stipulation (service does not happen automatically)
Checking Status of a Board Proceeding

Welcome TTAVUE, the Trademark Trial and Appeal Board Inquiry System.

Using TTAVUE, you can view a TTAB proceeding file by entering the proceeding number, or search for proceedings by application number, registration number, mark, party, correspondent.

View TTAB Proceeding File:
Note: extensions of time to oppose may be found under the application serial number.

**Proceeding Status:**
- Pending
- Terminated
- All

**Proceeding Number:**
9-digit Board proceeding number digits only

**Application or Registration Number:**

Find proceedings with the following criteria:
Enter applicable search terms below. Results will contain all specified terms. For example, if KALAKA is entered in the 'mark' field and 'Jones' is entered in the 'party' field, the search results will include only proceedings in which the mark contains the word KALAKA and one of the parties contains the word Jones.

**All these words anywhere in a record:**
Search proceeding number, application or registration number, parties, marks

- **Mark:** contains all words
- **Party:** contains all words
- **Other Party:** contains all words
- **Correspondent:** contains all words

[Search button]
**Opposition**

**Number:** 91122892  
**Status:** Terminated  
**General Contact Number:** 571-272-6500  
**Interlocutory Attorney:** ANNE LINNEHAN VOGLER  
**Paralegal Name:** MILLENNIAL CANZANI

---

**Defendant**

**Name:** AMERICAN BAR ASSOCIATION  
**Correspondence:** DEBRA J. STANAK  
SIDNEY & AUSTIN  
ONE FIRST NATIONAL PLAZA  
CHICAGO, IL 60603  
UNITED STATES

**Serial #:** 7556779  
**Application Status:** Cancelled - Section 8  
**Mark:** WOMEN RAINMAKERS

---

**Plaintiff**

**Name:** RAINMAKER MARKETING, INC.  
**Correspondence:** SUZAN PERKS CLIVE  
OLIVE & OLIVE P.A.  
300 MEMORIAL ST., P.O. BOX 2049  
DURHAM, NC 27702  
UNITED STATES

**Serial #:** 75847799  
**Application Status:** Cancelled - Section 8  
**Mark:** RAINMAKER MARKETING

---

**Prosecution History**

<table>
<thead>
<tr>
<th>#</th>
<th>Date</th>
<th>History Text</th>
<th>Due Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>15</td>
<td>05/08/2006</td>
<td>TERMINATED</td>
<td></td>
</tr>
<tr>
<td>14</td>
<td>06/08/2006</td>
<td>BO'S DECISION; DISMISSED W/ PREJUDICE</td>
<td></td>
</tr>
<tr>
<td>13</td>
<td>03/07/2006</td>
<td>RESPONSE DUE 30 DAYS (DUE DATE)</td>
<td></td>
</tr>
<tr>
<td>12</td>
<td>04/28/2006</td>
<td>PROCEEDINGS RESUMED</td>
<td></td>
</tr>
<tr>
<td>11</td>
<td>05/20/2003</td>
<td>DEF'S RSPY RE M TO DISMISS + RSPY TO PG M TO REOPEN</td>
<td></td>
</tr>
<tr>
<td>10</td>
<td>06/08/2003</td>
<td>PL'S RSPY TO M TO DISMISS + PS M TO REOPEN</td>
<td></td>
</tr>
<tr>
<td>9</td>
<td>05/13/2003</td>
<td>SUSPENDED PENDING DSSP OF OUTSTANDING MOT</td>
<td></td>
</tr>
<tr>
<td>8</td>
<td>04/10/2003</td>
<td>PS'S MOTION TO DISMISS - TN RULE132(A)</td>
<td></td>
</tr>
<tr>
<td>7</td>
<td>01/06/2003</td>
<td>PROCS RESUMED DATES RESET</td>
<td></td>
</tr>
<tr>
<td>6</td>
<td>05/01/2002</td>
<td>SUSPENDED</td>
<td></td>
</tr>
<tr>
<td>5</td>
<td>02/01/2002</td>
<td>PS'S MOT FOR EXTR. OF TIME W/ CONSENT</td>
<td></td>
</tr>
<tr>
<td>4</td>
<td>06/22/2001</td>
<td>ANSWER</td>
<td></td>
</tr>
<tr>
<td>3</td>
<td>05/16/2001</td>
<td>PENDING, INSTITUTED</td>
<td></td>
</tr>
<tr>
<td>2</td>
<td>06/16/2001</td>
<td>NOTICE AND TRIAL DATES SENT; ANSWER DUE</td>
<td></td>
</tr>
<tr>
<td>1</td>
<td>05/09/2001</td>
<td>FILED AND FEE</td>
<td>06/29/2001</td>
</tr>
</tbody>
</table>

Results as of 07/21/2017 09:10 AM