

Rulemaking

U.S. counsel requirement

- New proposed rule would require foreign-domiciled trademark applicants and registrants to be represented by a U.S.-licensed attorney to file trademark documents with the USPTO
- Proposed rule would:
 - Ensure that we can effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters
 - Provide greater confidence to foreign applicants and the public that registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims
 - Aid our efforts to improve accuracy of the U.S. Trademark Register
- Notice of proposed rulemaking published February 15, comments were due March 18
- www.uspto.gov/trademark/laws-regulations/uspto-proposes-requiring-foreign-domiciled-trademark-applicants-and

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Rulemaking

U.S. counsel requirement – impact on U.S. licensed attorneys

- Will be required to enter bar membership information and confirm active member in good standing
- Owner address will be required
- Beware foreign solicitations – persons located internationally offering to pay to use your bar information to circumvent the rule

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Section 2(a)

- The *Brunetti* decision issued on December 15, 2017, held the immoral or scandalous provision of Section 2(a) unconstitutional. The U.S. Court of Appeals for the Federal Circuit (CAFC) ruled that “Fuct”, while vulgar, was protected speech under the First Amendment.
- The Supreme Court granted certiorari on January 4, 2019; argument is expected this month.



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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
- 2018 Farm Bill and corresponding amendments to CSA remove hemp as a controlled substance



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Legislation

Trademark issues that may be discussed in the 116th Congress (2019-2020) include:

- Industry Proposal on injunctive relief (*to create a presumption of irreparable harm in trademark infringement cases*)
- Consolidation of TTAB appeals at the Federal Circuit
- Rep. Jeffries bill on State Seals and Insignia
- USPTO Technical amendments



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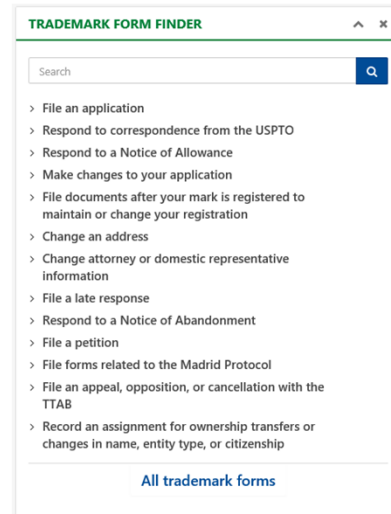
Initiatives for our customers



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My.USPTO.gov

- Trademark docket
 - Share collections in docket with other MyUSPTO users.
- Trademark form finder widget
 - Widget identifies forms using plain language rather than current form names
 - Includes a search box to search the form names
- Next widget: Trademark Electronic Application System (TEAS) Plus Short Form
 - Initial scope: intent-to-use (ITU) word marks, TEAS Plus fee basis
 - Status: currently testing with small set of users. Hope to roll out later in 2019



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Post Registration Amendments to IDs Due to Technology Evolution

- Since September 1, 2015, ^ petitions have been filed.
- ^ amendments currently appear on the USPTO webpage at <http://www.uspto.gov/trademark/trademark-updates-and-announcements/proposed-amendments-identifications-goods-and-services>



Pilot Commenced September 1, 2015



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Efforts to declutter

1) Proof of use audit program (2012)

- The USPTO began a pilot program in 2012 and made it permanent in 2017, giving the Office the authority to cancel audited registrations with unsubstantiated use claims or to delete unsupported goods and services

2) Excluded unauthorized foreign practitioners (2015)

- The Commissioner has excluded specific foreign practitioners from appearing before the Office

3) Proof of actual use in examination (2016)

- Examiners have been trained about the issues posed by mocked-up and fake specimens and to use the 37 CFR §2.61(b) request for information authority to request proof of actual use when refusing registration because the specimen does not show use of the mark in commerce

4) Improved readability of declaration (2017)

- The declaration was reformatted to make it more readable and to make the signatory acknowledge the required statements in them by checking a box next to each one, thereby increasing the likelihood that the signer would read the declaration and appreciate the significance of swearing to use for each and every good or service listed

5) Expedited cancellation pilot for non-use or abandonment claims (2018)

- Implemented TTAB pilot program for cases raising non-use or abandonment claims to identify the types of procedures needed to accelerate disposition of those claims; considering whether to make permanent

6) Issued U.S. Counsel rulemaking (February 15, 2019)

- The USPTO issued rulemaking to require all foreign domiciled trademark applicants and registrants to be represented before the USPTO by a lawyer licensed

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Decluttering initiative: Proof-of-use audit program

- Permanent program launched November 1, 2017
- As of February 28, 2,818 first office actions have been sent.
- The program improves the integrity of the Trademark Register.
 - Allows us to cancel audited registrations with unsubstantiated use claims or remove unsupported goods and services from others
- Your registration may be audited if you meet both requirements:
 - You filed a Section 8 or 71 declaration of use.
 - Your registration includes at least one class with four or more goods or services, or at least two classes with two or more goods or services.
- If audited, we will require submission of proof of use for additional goods/services in registration to ensure that register accurately reflects marks that are in use in the United States for all goods/services identified in registrations
- www.uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program

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Proof-of-use audit program results so far

November 2017 – February 28, 2018

- 2,818 first actions issued by examining attorneys on project
- 2,020 responses received
- 50.8 percent of registrations with response deleted at least some goods or services
- 79 percent of respondents represented by an attorney
- 21 percent of respondents pro se



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Specimen issues

- Mocked-up or fake specimens are increasing.
- Issues are much more sophisticated.
- Applicants are pasting their marks on products or services of others to show use in commerce.
- We are doing our best to refuse the fraudulent specimens.
- We are starting an internal pilot program using digital forensic services to help us.



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Mock-ups and digitally altered specimens

- Fake specimens present several issues:
 - Fail to show mark as used in commerce
 - Fraud on the USPTO
 - Discipline by the Office of Enrollment and Discipline (OED)
 - Impact on validity of registration



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Specimen protest pilot program



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Specimen protest pilot program

- New streamlined process for public to report improper specimens
- Email submissions should include either:
 - Objective evidence of third-party use of images identical to the specimen of record
 - Registration or serial numbers showing identical specimens bearing different marks
- Additional submission guidelines and details on the process appear on our website under “Recent postings.”
- Specimens mailbox email address: TMSpecimenProtest@uspto.gov



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International



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