PIPLA TRADEMARK PROGRAM

FEBRUARY 22, 2017

FOLLOW UP TO SELECT TRADEMARK QUESTIONS

Thank you to all who attended the Trademark Program on February 22 at Dechert LLP in Philadelphia. As result of the lively discussion on numerous topics, there were questions that the panel did not have an opportunity to respond to. The United States Patent & Trademark Office has put together the following document to respond to some of those question.

**Assignments**

There have been no changes to the Trademark Assignment Rules in the past few years. However, there have been enhancements to the Electronic Trademark Assignment System (ETAS) and to the manner in which the Assignment Recordation Branch (Assignment Branch) reviews assignments. These include: a cursory review of the cover sheet and underlying document to ensure there are no typographical errors, and if there are, the filer may fix the error before recording the document to avoid the filer having to file a corrective assignment; the ability to identify the order in which the filer would like assignments with the same execution date to appear in the Assignment Historical database record; an update to the list of entity types available for assignors and assignees that matches the entity types found with the Trademark Electronic Application System (TEAS); and the addition of new conveyance types on the ETAS cover sheet.

Notification of these enhancements was sent to the public through a Trademark Alert, was highlighted in an INTA article, and was posted on the USPTO website. If there are future enhancements to ETAS, the USPTO will notify customers of these enhancements by posting them on the ETAS home page, sending a Trademark Alert and summarizing the changes in a notice posted on the USPTO website.

**Letters of Protest (LOPs)**

In FY 2016, Trademarks received a total of 2,258 LOPs, and assigned and worked on 2,179. Of the 1,863 LOPs handled at the pre-publication stage, 74.40% were granted, and in approximately 53% of those granted, the examining attorney issued an Office Action. (Note: Some of these LOPs accepted or acted on in FY 2016 may include a carry-over from FY 2015.) Of the 316 LOPs handled at the post-publication stage, 5.37% were granted.

Note that when an LOP is filed pre-publication, it is granted when the submitted evidence is relevant and supports any reasonable ground for refusal appropriate in ex parte examination; the examining attorney is not required to issue any refusal as a result of the grant, the evidence is merely brought to his/her attention. It is in the examining attorney’s discretion whether to issue a refusal upon seeing the submitted evidence. However, if an LOP is filed post-publication, it is granted only when the evidence establishes a clear error would occur if the refusal were not issued; the examining attorney is required to issue the refusal.

**Madrid Protocol Tips**

*Filing Date of the 66(a) application and when the USPTO is notified by the IB (International Bureau)*: If a request for extension of protection of an international registration to the United States is made in an international application, the filing date of the §66(a) application is the international registration date.  The international registration date is determined as follows: If the IB receives an international application within two months of the date of receipt in an Office of Origin, the date of the international registration is the date of receipt in the Office of Origin.  If the IB does not receive the international application within two months of the date of receipt in the Office of Origin, the date of the international registration is the date of receipt in the IB.  If a request for extension of protection to the United States is made in a subsequent designation, the filing date of the §66(a) application is the date on which the subsequent designation was recorded by the IB. Due to the processing of international applications/subsequent designations at the Office of Origin and at the IB, often times the designation to the United States has a filing date that is more than three months old.  Until the USPTO receives the designation to the US it will not appear in TESS.

*Corrections to the listing of goods/services*: If the USPTO receives a notification of correction from the IB as it pertains to good/services, the USPTO generally has to accept and process the correction. The majority of the corrections to the listing of goods/services will include goods/services that are outside scope of what was originally received by the USPTO. In these cases, the additional goods/services must be examined, and depending on the outcome of examination re-publication may be necessary. Additionally, marks in pending applications with a later effective filing date may receive a Section 2(d) refusal for likelihood of confusion based on these newly added goods/services.

*Role of USPTO as Office of Origin and the IB as it pertains to the listing of goods/services*: The USPTO is responsible for certifying international applications and forwarding them to the IB. If the information contained in an international application corresponds to the information in the basic application or basic registration, the USPTO will certify the international application. If an International application is unacceptable the IB will notify both the applicant and the USPTO of the "irregularity.” Note that if the IB determines that the identification of goods/services is too vague or is incomprehensible or linguistically incorrect for purposes of classification, it will notify both the applicant and the USPTO.  Generally, the IB recommends amended wording.  Sometimes the IB will recommend wording that is outside scope of the goods/services in the basic application and/or registration.

Since the listing of goods/services in the international application cannot be broader than what is in the basic mark(s), any response regarding the identification of goods/services must be sent through the USPTO to determine if the response is still within scope of the listing of goods/services in the basic mark(s).  An MPU (Madrid Processing Unit) trademark specialist will review the applicant’s response to ensure that the goods/services identified in the response are within the scope of the identification in the basic application and/or registration at the time the response is filed.  If an amendment to the goods/services in the basic application and/or registration has been entered into the Trademark database since the date the international application was submitted to the USPTO, the goods/services in the response to the IB notice must be within the scope of the amended goods/services.  If the goods/services in the response exceed the scope of the goods/services in the basic application and/or registration as amended, the trademark specialist will notify the applicant that the proposed amendment to the goods/services does not conform to the goods/services as identified in the basic application and/or registration and that the response will not be forwarded to the IB.  If there is time remaining in the IB response period, the applicant may submit a corrected response.  If the goods/services in the corrected response do not exceed the scope of the goods/services in the basic application or registration as amended, and the IB response period has not expired, the MPU will forward the response to the IB.

The applicant’s response to the IB’s notice should separately address each irregularity pertaining to the identification of goods/services, specifying which goods/services are to be deleted or amended, and providing any explanation or arguments deemed necessary. To avoid any misunderstanding by the examiners at the IB, the response should also include a separate final listing of the goods/services as it will appear in the international registration. If the applicant omits any goods/services from the final listing that were previously included in the identification of goods/services, the IB may remove such goods/services from the international registration.

*Maintenance Requirements of the International Registration and the 66(a) registration*: The term of an international registration is ten years from the date of the international registration. Renewal of international registrations must be made directly with the IB. There is a renewal form, form MM11, on the IB website at <http://www.wipo.int/madrid/en/> as well as an electronic form.   Once renewed the IB will notify the USPTO.  The USPTO will not process a request to renew an international registration nor forward it to the IB.

In addition to renewing the international registration that includes an extension of protection to the United States at the IB, the owner of a registered extension of protection must also periodically file at the USPTO an  affidavit or declaration of use in commerce or excusable nonuse under §71 of the Trademark Act. The purpose of the §71 affidavit or declaration is to remove marks that are no longer being used in commerce from the USPTO register.  The requirements are equivalent to the affidavit or declaration of use in commerce or excusable nonuse under §8 of the Trademark Act.

**Website Enhancements**

The Trademarks team at the USPTO launched an initiative to improve our website with your needs in mind. We recently hired a customer experience administrator and two plain language writers to make information on the website more accessible for all of our customers—from first-time filers to experienced trademark attorneys. Website analytics and your direct feedback will guide our efforts. In the coming months, we will analyze website usability surveys submitted by intellectual property professionals and our most experienced website users. Now is the perfect time to email your suggestions for improvement to [TMFeedback@uspto.gov](mailto:TMFeedback@uspto.gov).

The USPTO also recently launched a new tool to improve how you manage your intellectual property portfolio. With one single sign on, you can now track your trademark applications and registrations, receive alerts when they are updated, and get other news from the USPTO. [MyUSPTO](https://my.uspto.gov/?utm_source=directorsforum&utm_campaign=uxd-myusptosoftlaunchjan2017&utm_medium=text&utm_content=firstlink) is your personalized homepage and gateway to all your USPTO business needs, and there is no cost to sign up and use the site. MyUSPTO allows you to save USPTO webpages as bookmarks, so you won’t need to save them separately in your own browser. Additionally, you can learn about current news, upcoming events, and connect with our Facebook and Twitter accounts on the MyUSPTO homepage. The site uses “widgets,” which are small applications that display snippets of important information; aka shortcuts to larger USPTO applications and affiliated sites. The entire site is fully customizable so you can add as little or as much as you prefer. Let us know your suggestions on how we can further improve the site through our [MyUSPTO feedback forum on IdeaScale](http://usptoglobalsignon.ideascale.com/" \o "http://usptoglobalsignon.ideascale.com/). You can also visit our [“What’s New” page](https://www.uspto.gov/blog/systemsupdates/category/MyUSPTO?utm_source=systemsupdates&utm_campaign=uxd-myusptosystemsupdates&utm_medium=webpagelink) to find out about future updates and improvements.

**INTA**

Please note that Commissioner Denison and Chief Judge Rogers will host a USPTO Users’ Session on at INTA in Barcelona, on Sunday, May 21 at 3:00 pm.

**Feedback / Practice Tips / Trademark Alerts**

We always welcome and encourage suggestions and feedback; please email [tmfeedback@uspto.gov](mailto:tmfeedback@uspto.gov) to let us know your thoughts.

For trademarks practice tips, please visit <https://www.uspto.gov/trademark/guides-manuals-resources/practice-tips>.

To sign up for alerts, you can enter your email address and then set your preferences for alert types at <https://public.govdelivery.com/accounts/USPTO/subscriber/new>.