

Trademark Electronic Application System (TEAS)



Tanya Amos
TEAS Administrator

*Patent and Trademark Office Day
March 25, 2014*



Commonly used **FORMS** that can be submitted electronically:

NOW

- Initial Application
- Response
- Intent-To-Use (ITU)
- Post-Approval/Publication
- Correspondence
- Registration
- Maintenance/Renewal

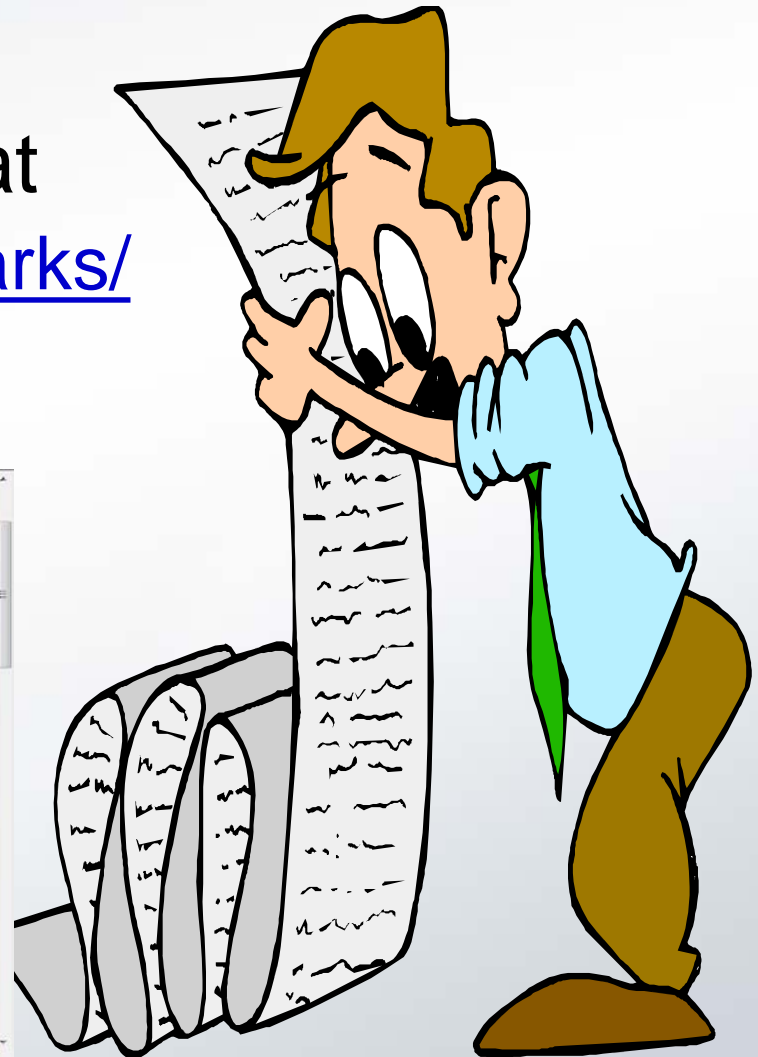
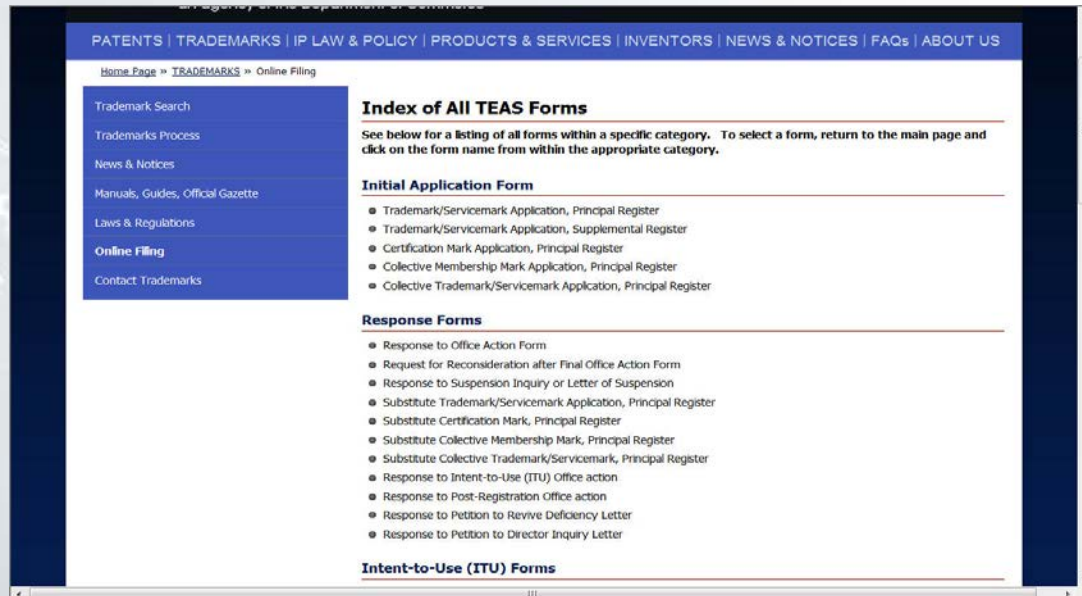
A computer monitor is shown on the right side of the slide. The screen displays the URL for the USPTO Trademark Electronic Application System (TEAS) in white text on a blue background.

<http://www.uspto.gov/trademarks/teas/index.jsp>



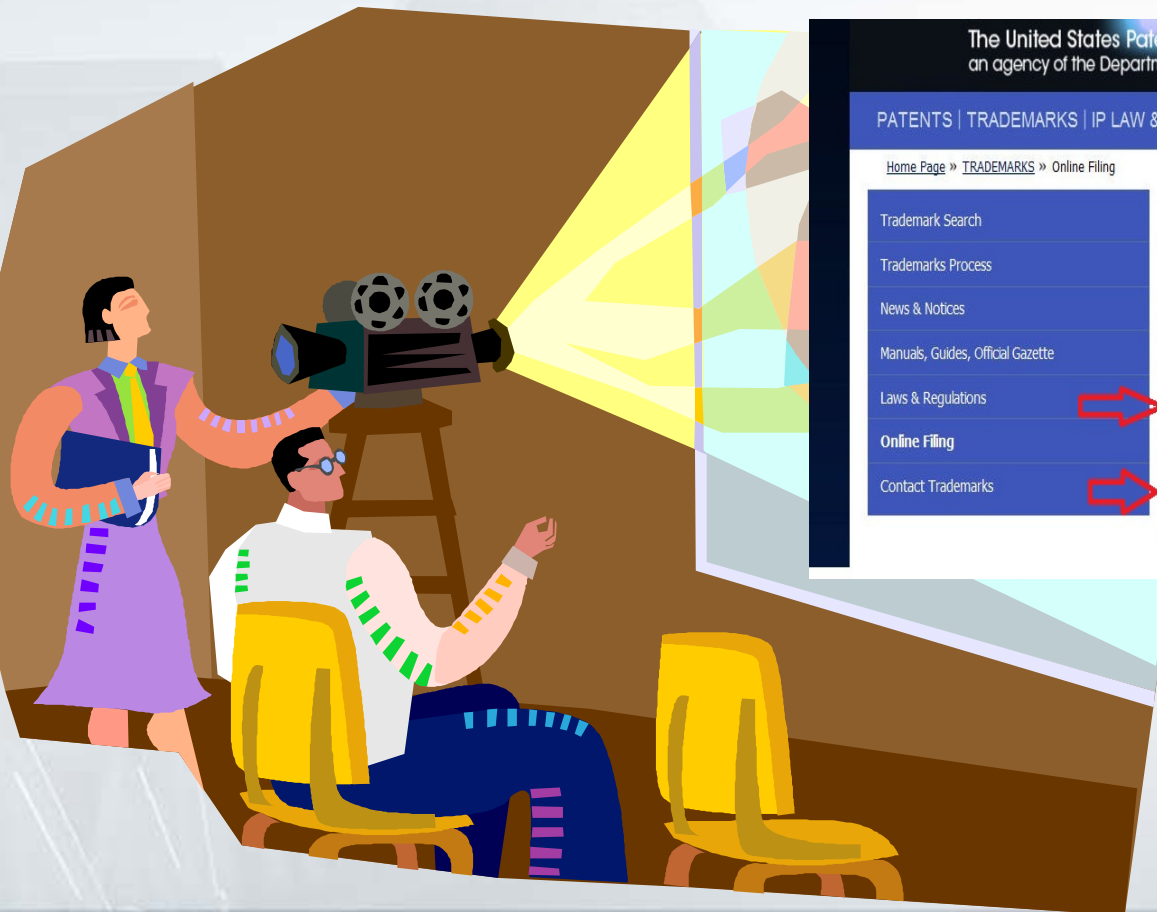
Index of TEAS Forms

Find a **complete list** at
<http://www.uspto.gov/trademarks/teas/forms-index.jsp>.





Preview a PDF version* *prior to filing*



The United States Patent and Trademark Office
an agency of the Department of Commerce

PATENTS | TRADEMARKS | IP LAW & POLICY | PRODUCTS & SERVICES | INVENTORS | NEWS & NOTICES | FAQs | ABOUT US

Home Page » [TRADEMARKS](#) » Online Filing

Trademark Search	
Trademarks Process	
News & Notices	
Manuals, Guides, Official Gazette	
Laws & Regulations	
Online Filing	
Contact Trademarks	

Initial Application Forms

1. [Trademark/Service mark Application, Principal Register](#) [< This is the **direct link** to the electronic form.]

Use this form to file an initial application to register on the Principal Register a TRADEMARK for "goods" and/or a SERVICEMARK for "providing services" (this form is appropriate for either and you will not actually specify the "type" of mark when filing). Clicking on the link above will take you to a page offering the two versions of this form, namely, TEAS Plus and regular TEAS.

[Preview TEAS Plus application form \[PDF\]](#) prior to accessing the electronic version through the numbered link, above. **Do not attempt to file the PDF version because it is for viewing purposes only and not the entrance of any information. To prepare and file the electronic form, you must click on the form title that follows 1. at the top of this section.**

[Preview regular TEAS application form \[PDF\]](#) prior to accessing the electronic version through the numbered link, above. **Do not attempt to file the PDF version because it is for viewing purposes only and not the entrance of any information. To prepare and file the electronic form, you must click on the form title that follows 1. at the top of this section.**

***But *don't* try to
file the PDF
version!**



Initial Application

TEAS Plus Form

- \$275 per class (lower fee)
- stricter requirements, including
 - file complete application
 - select from ID Manual
 - pay for all classes at filing
 - file certain documents via TEAS
 - receive USPTO correspondence by e-mail

“Regular” TEAS Form

- \$325 per class (higher fee)
- less strict requirements





Initial Application

NOTE: For an instructional video on goods and services and the importance of making the proper selection, [click here](#).

Watch Embedded Instructional Videos:

Selecting the proper mark type

Goods/Services

Searching





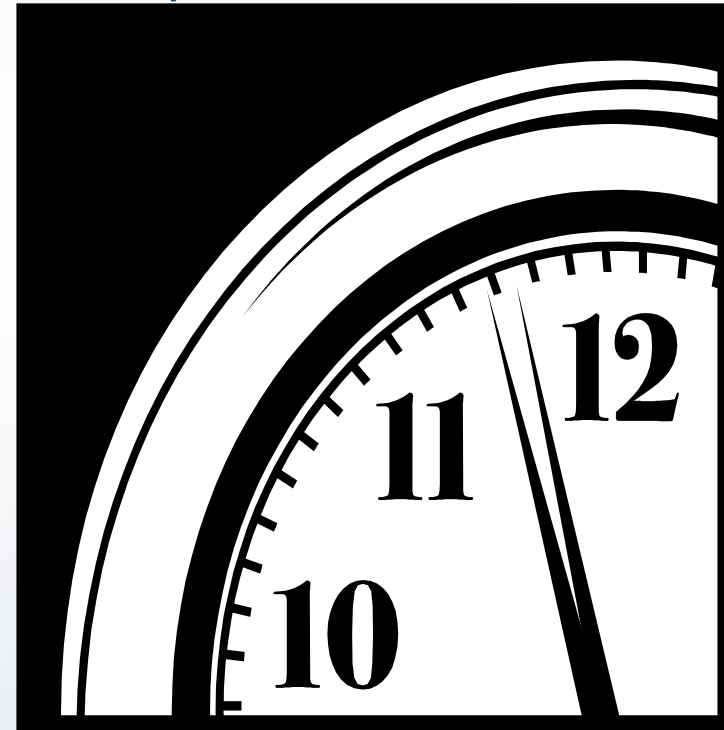
Response Forms

(Most are generated by answering specific initial form wizard questions)



Must arrive on the USPTO server prior to **Midnight, Eastern Time**, of the last day of the response period

(unless the last day falls on a Saturday, Sunday, or holiday)





Response Forms

Practice Tips page:

http://www.uspto.gov/trademarks/notices/practice_tips.jsp



**How to
overcome
specimen and
ornamental refusals.**

**Step-by-step
TEAS instructions**



Response Forms

Instructions for responding via TEAS are on many USPTO communications.

USPTO TSDR Document Viewer 

[Download PDF](#)

Case Id
85417238

Document Description
Offc Action Outgoing

Mail/Create Date
Dec. 27, 2011

[Previous](#)

1 of 2

[Next](#)

To: Tracey Palumbo (michael@fattlegal.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85417238 - TANYA TATE - N/A
Sent: 12/27/2011 4:36:43 PM
Sent As: ECOM103@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85417238

MARK: TANYA TATE

CORRESPONDENT ADDRESS:
MICHAEL W. FATTOROSI
LAW OFFICES OF MICHAEL W. FATTOROSI
5850 CANOGA AVE FL 4
WOODLAND HILLS, CA 91367-6554



CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp





ITU Forms

Statement of Use – *if*

you filed based on Section 1(b) and
are now using the mark in commerce

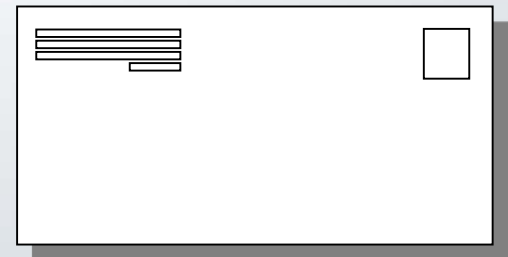
Extension Request – *if*

you need additional time
to begin using the mark in commerce



Response to ITU form – *to*

respond to ITU Office action





Post-Approval Forms

View TEAS practice tips on



http://www.uspto.gov/trademarks/basics/MoreInfo_SOU_EXT.jsp

Dividing applications

Deleting and amending filing bases

Filing amendments
after the NOA issues



Correspondence Form

(To Change Correspondence Address)

- Submit **300** serial/registration **numbers** at a time
- Displays **mark, attorney** of record, **current correspondent** information
- Automatically **uploads** data into record
- Up to **four secondary e-mail addresses** permitted for duplicate copies of correspondence





Request for Withdrawal as Attorney of Record Form

- Use to **request withdrawal** as attorney of record and/or **update of USPTO's database** after power of attorney ends
- Submit **300** serial/registration **numbers** at a time
- Future correspondence sent to address specified in the form
- The form must be **signed by the attorney requesting the withdrawal** or update of the USPTO's database



Replacement of Attorney of Record with Another Already-Appointed Attorney Form

- Use to **replace current primary attorney** with another attorney named in a previously submitted power of attorney or listed in the record as an appointed attorney
- Submit **single** serial/registration **number**
- **Change of Correspondence Address** form must also be filed to update correspondence address
- The form must be **signed by the previously appointed attorney** who is replacing the currently recognized attorney of record



Revocation of Attorney and/or Appointment of Attorney/Domestic Representative Form

- Submit **300** serial/registration **numbers** at a time
- Future correspondence sent to address specified in form
- Form must be **signed** by the **individual applicant/registrant** or by a **person authorized to legally bind** a juristic applicant/registrant
- Current attorney may sign if using the form to appoint other associate attorneys or remove an associate attorney previously designated



Required Post Registration Forms

Section 8 Affidavit of Use

(Section 71 Affidavit of Use for Madrid registrations)

Due:

- (1) **between the 5th and 6th year** after registration date
(six-month grace period available, for *add'l fee*) *and*
- (2) **between the 9th and 10th anniversaries of registration**
and each successive 10-year period after
(six-month grace period available, for *add'l fee*)





Required Post Registration Forms

Section 8 Affidavit of Use

(Section 71 Affidavit of Use for Madrid registrations)

Affidavit states that

mark is **still in use** in commerce
on the goods and services
recited in the registration

Specimen (one per class) and **fee** required (**\$100 per class**)



Required Post Registration Forms

Section 9 Renewal

- Registration must be renewed **between the 9th and 10th** anniversaries of registration and **each successive 10-year period after**
- Renewal simply states that registrant **wishes to renew** its existing registration
- Appropriate **fee** required (**\$400 per class**)
- Must be filed **with Section 8** Affidavit or registration will be cancelled
- *Madrid registrations are not renewed with USPTO;* renewals of international registrations filed directly with IB



Optional Post Registration Forms

Section 7 request for *amendment or correction*

- file **anytime** to request correction of an immaterial error in registration certificate caused by the owner or the USPTO



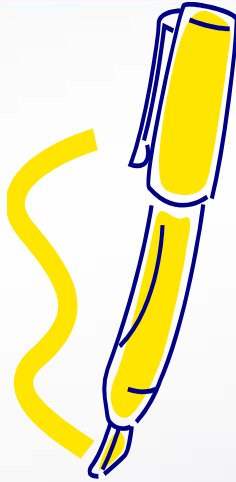
Section 15 declaration of *incontestability*

- file **after 5 years** or more of continuous use for trademarks on the Principal Register



Highlights of Recent Improvements

- “ID Assistance” Tool – optional tool in regular TEAS form to help applicants enter acceptable IDs.
- Request for Withdrawal of Attorney – now allows users to request an update of USPTO’s database after power of attorney ends

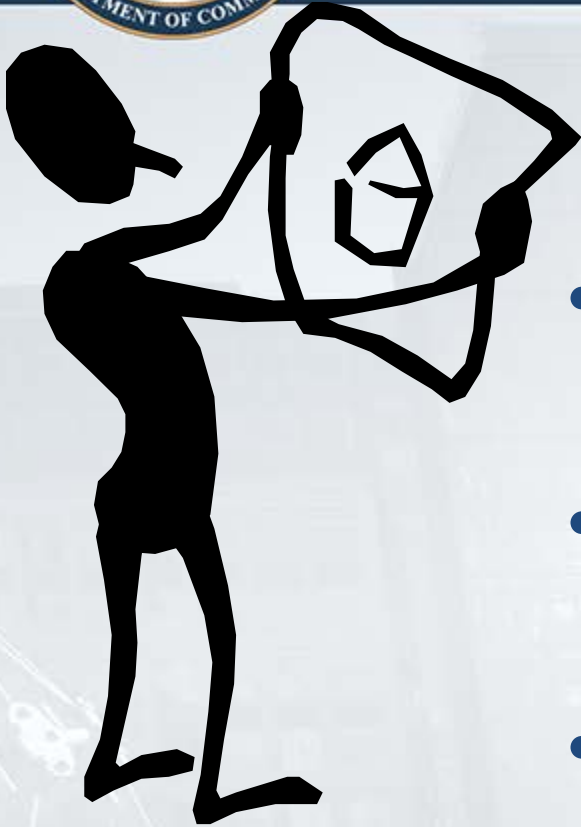


See more information on the USPTO’s website at

- <http://www.uspto.gov/trademarks/teas/enhancements.jsp>



Future Enhancements



- New **miscellaneous statement sections** for Extension Request form and Petition to Revive form
- Creation of a **text box** for posting important notices at the top of each form
- **Conversion** of global **Letter of Protest** form into a specific TEAS form
- Expansion of the ability to **upload sound/motion/multimedia** files



Resources for New Filers

Trademark Basics:

<http://www.uspto.gov/trademarks/basics/index.jsp>.

First time filers should go to the Trademark Basics page before opening the application form to review important information on topics such as hiring an attorney, mark selection, identifying goods/services, and searching your mark.

Trademark Information Network (TMIN):

<http://www.uspto.gov/trademarks/process/TMIN.jsp>.

Broadcast-style video “Before You File” provides an overview of the most important issues you should be aware of when filing.

Trademark Frequently Asked Questions:

<http://www.uspto.gov/faq/trademarks.jsp>.

Lists questions and answers to commonly asked trademark questions.

Trademark Registration Timelines:

http://www.uspto.gov/trademarks/process/tm_timeline.jsp.

Timelines provide an overview of the process steps and time frames for filing an application.



TEAS Web Resources

TEAS FAQs:

http://www.uspto.gov/trademarks/teas/teas_faq.jsp

provides answers to commonly asked TEAS questions.

Electronic Filing Tips:

http://www.uspto.gov/trademarks/teas/e_filing_tips.jsp

identifies best practices for filing electronically via TEAS.

System Outages:

<http://www.uspto.gov/blog/ebiz/>

provides notices of system problems and/or planned outages.

Subscribe to Trademark Alert Emails:

<http://enews.uspto.gov/lists/?p=subscribe&id=1>

provides updates on system changes, events, roundtables, rules changes.

Filing During a TEAS Outage:

http://www.uspto.gov/trademarks/teas/TEAS_outage.jsp

specifies alternative methods for filing during an outage.



Suggestions and Questions

To submit suggestions for improving the system, ask for help in resolving TEAS glitches, or request answers to technical questions, email us at

TEAS@uspto.gov.



Tips on Navigating the Examination Process



Steven R. Berk
Trademarks Chief of Staff
March 25, 2014



Trademark Staff

- Trademark employees are a dedicated group that are there to register trademarks, while protecting the rights of those who have already registered; Most examining attorneys have over three years experience
- Production-Based Work Schedule; Credit given for first action taken and final disposal of application



Training New Examining Attorneys

- Newly hired attorneys: 7-8 weeks of intensive training
- Mentor assigned
- The mentoring period continues for approximately two years
- The new examining attorney's authority increases until full signatory authority is given at the end of the 2-year period.





Law Office Structure

- The Examination Corps is divided into 19 separate law offices. Most offices comprise 20-25 attorneys in each. We are piloting 2 of these offices with a virtual Managing Attorney containing about 14 attorneys each
- A Managing Attorney and Senior Supervisory Attorney traditionally lead each office
- Unlike Patents, the examining attorneys do not specialize in particular areas of goods and services



Before Filing an Application: IDs

- Draft an Acceptable Identification: See <http://tess2.uspto.gov/netahtml/tidm.html>
- Do not use proprietary names or trademarks
- Make it understandable
- Use English
- Meet the Manual's standards
- Do not use Class Headings
- Make sure it is classifiable in only one class
- TMEP § 1402.01(a)



Before Filing an Application: Search

- Conduct your own search using our Trademark Electronic Search System (TESS)
<http://tess2.uspto.gov/bin/gate.exe?f=tess&state=4804:lin8g4.1.1>





What to Include in an Application

- Minimum Filing Requirements to receive a filing date - Trademark Rule CFR 2.21 (TMEP Section § 202)
- Name of Applicant
- Address of applicant or filing correspondent
- Drawing of the Mark (Standard Character or Special Form)
- Identification of Goods/Recitation of Services
- **Filing Fee - one class (\$325 per class through TEAS, \$275 per class through TEAS Plus, and \$375 per class if by paper)**



Recommended Inclusions

- A clear black and white drawing or a clear color drawing with a statement claiming color
- Statement regarding Standard Character drawing
- Claim of ownership of other related Registrations
- Appropriate Disclaimers
- Fees for all classes: Check ID Manual
- Clear specimens; explanation if necessary
- Consent for names or portraits of living individuals
- Translations and Transliterations
- Descriptions of Marks
- Filing Date and Serial No. of Foreign Registration
- */Signed Declaration/*



Internal Deadlines

- Examining attorneys are given 7 days to take initial action on a new case
- If the applicant does not respond, the file within this period, the file is deemed abandoned
- Once the applicant responds, the examining attorney has 21 days to take appropriate action





Issuing Office Actions

- Examining Attorney will address procedural or 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





Communications

- Each examining attorney has a performance plan that requires a certain percentage of phone actions to occur
- Remember that e-mails will become part of the public record; TMEP § 709.04
- Remember to leave detailed messages and suggest a day and time to return a call



During the Examination Process

- Know your deadlines!
- Do not wait until the last minute to get questions answered; you have 6 months to respond to an Office Action
- If unintentionally abandoned, file a revival petition within 60 days of the abandonment date along with \$100 fee and a statement that the abandonment was unintentional. If Office Action not received, ask for another. If received, you must submit your response along with the petition.

THANK YOU!



steven.berk@uspto.gov

Office of Trademark Classification Policy & Practice



Jennifer Chicoski
Administrator



Office of Trademark Classification Policy & Practice of the Office of the Deputy Commissioner for Trademark examination Policy

a.k.a. “ID/Class”



Duties of the Unit

- Develop and implement classification policy consistent with the *Nice Agreement*;
- Create, maintain and improve identification and classification resources for internal and external customers, including the *Acceptable Identification of Goods and Services Manual* (U.S. ID Manual);



Duties of the Unit, Cont.

- Provide internal and external customer service and training on identification and classification issues;
- Conduct tasks in accordance with bi-lateral and multi-lateral international cooperation projects.

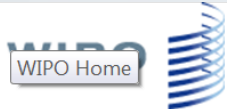


International Duties

- **Prepare annual proposals and review submissions for the *Nice Agreement's* Committee of Experts**
 - Procedure change – now on an annual cycle of updates to Nice Editions
 - Proposals due end of October
 - Comments to other countries' proposals due end of December
 - Replies to Comments of other countries due end of January
 - Annual meeting in April in Geneva, Switzerland



Nice Electronic Forum



RESOURCES

WORLD INTELLECTUAL PROPERTY ORGANIZATION

Français

Login

Contact us

NIVILO E-Forum

Nice, Vienna and Locarno Classifications

Help

[NCL Home Page](#)
[VCL Home Page](#)
[LOC Home Page](#)

List of Projects

A - ACTIVE

Any Type

Any Rapporteur

Project:

Search in:

Any Field

Redesigned nef V 1.1
last modified: 2012-12-13

Projects (19)

Project	Subject	CL	Rap.	Next Action	Deadline	Update
CE999	Proposals for modifications to NCL		IB	Proposals-CE24	31-Oct-13	17-Dec-12
DV011	OHIM Proposal for VCL improvement		EM	The Action is not set		17-Oct-12
LO110	Report of the 11th session of the CE-Locarno Union		IB	The Action is not set		08-Nov-12
NC013	NCL (10-2013)		IB	The Action is not set		05-Sep-12
NI001	Proposals DE - Nice CE23		DE	The Action is not set		21-Jan-13
NI002	Proposals IL - Nice CE23		IL	The Action is not set		30-Jan-13
NI003	Proposals MX - Nice CE23		MX	The Action is not set		04-Jan-13
NI004	Proposals GB - Nice CE23		GB	The Action is not set		04-Jan-13
NI005	Proposals CN - Nice CE23		CN	The Action is not set		29-Jan-13
NI006	Proposals US - Nice CE23		US	The Action is not set		31-Jan-13
NI007	Proposals FR - Nice CE23		FR	The Action is not set		31-Jan-13
NI008	Proposals JP - Nice CE23		JP	The Action is not set		31-Jan-13
NI009	Proposals RU - Nice CE23		RU	The Action is not set		31-Jan-13
NI010	Proposals CH - Nice CE23		CH	The Action is not set		04-Jan-13
NI011	Proposals ES - Nice CE23		ES	The Action is not set		04-Jan-13
NI012	Proposals NL - Nice CE23		NL	The Action is not set		04-Jan-13
NI013	Proposals IB - Nice CE23		IB	The Action is not set		05-Feb-13
NP011	New Publication Platform for the Nice Classification		IB	The Action is not set		24-Aug-11
NS011	Versión oficial en español de NCL10		IB	The Action is not set		20-Apr-12



TM5 Trademark ID List Project

- **Review and propose entries for the Expanded Trilateral Partners' ID List Project (aka TM5)**
 - Japanese Patent Office (JPO)
 - Office for the Harmonization for the Internal Market (OHIM)
 - Korean Intellectual Property Office (KIPO)
 - Participant/visitor nations
 - Mexico, Philippines, Russia, Singapore



TM5 Trademark ID List Project

TRILATERAL TRADEMARK IDENTIFICATION

Navigation Menu

- [View Approved Items](#)
- [View Rejected Items](#)
- [View Removed Items](#)
- [View Unreleased Items](#)
- [Submit Proposed Item](#)
- [Create Custom Query](#)
- [Logout](#)

[Trilateral User Guide](#)

Page Information

Click on a column heading to sort the data by that column.

Inbox (349)

Click on column headings to sort data.

☐ View Visitor Nation Submissions

Status	Days Left ▲	Item ID	Item	Class	Date Released ▲	New/Resubmittal	Submitted By	Comments	USPTO	OHIM	JPO	KOREA	MEXICO	PHI
	11	52823	rolled, drawn or extruded semi-finished articles of magnesium	006	27 November 2012	New	JPO		Pending	Accept	Accept	Accept	Pending	Pen
	11	52824	rolled, drawn or extruded semi-finished articles of magnesium's alloys	006	27 November 2012	New	JPO	1	Pending	Reject	Accept	Accept	Pending	Pen

Hit No.	Class	Description	Status	Effective Date	Type	Note	Trilateral
	042	Medical laboratory services	A	03 Jul 08	S	N	T
2	042	Non-medical, ultrasound imaging services	A	09 Sep 10	S	N	T
3	044	Medical assistance services	A	01 Jul 06	S	N	T



Domestic Duties

- **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.
 - Answer procedural questions relating to classification and identification policy posed by external customers.
 - Review and respond to suggestions made by the public to the TMIDSUGGEST@uspto.gov mailbox.



TM ID Suggest mailbox

uspto.GOV

The United States Patent and Trademark Office
an agency of the Department of Commerce

search for patents | search for trademarks

Search our site



PATENTS | TRADEMARKS | IP LAW & POLICY | PRODUCTS & SERVICES | INVENTORS | NEWS & NOTICES | FAQs | ABOUT US

[Home Page](#) » [TRADEMARKS](#) » Manuals, Guides, Official Gazette

Trademark Search

Trademarks Process

News & Notices

Manuals, Guides, Official Gazette

Laws & Regulations

Online Filing

Contact Trademarks

Trademark Identification (Goods and Services) Manual Suggestions

TMIDSUGGEST Mailbox

The Acceptable Identification of Goods and Services Manual (ID Manual) includes a wide range of entries, and the USPTO frequently updates the 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 now consider suggestions from the public for identifications or recitations to add to 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**.

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

- (1) The **name of the party** submitting the proposed identification of goods or recitation of services;
- (2) An **e-mail address** for correspondence pertaining to the proposed identification of goods or recitation of services; and
- (3) The **proposed identification of goods or recitation of services**. The proposed identification of goods or recitation of services should be concise and should not exceed twenty-five words (**25 word limit**). To ensure timely and efficient processing of suggested additions to the ID Manual, e-mail submissions should contain no more than three individual proposals.



Domestic Duties, cont.

- **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**
 - Review identifications and class only; substantive review is the purview of law office managers and senior attorneys.



USPTO Trademark ID Manual

U.S. Acceptable Identification of Goods and Services Manual (ID Manual)

[Reflects Nice Agreement 10th Ed., 2014 Version]

The ID Manual contains a listing of acceptable identifications of goods and services. Any entry you choose must accurately describe your goods and/or services. Failure to list the goods and/or services accurately with which you are using or intend to use your mark could prevent you from registering your mark.

Need more information on how to identify your goods or services? Watch the Trademark Information "how-to" video on "[Goods and Services](#)." Or need more information on how use in commerce and intent to use differ? Watch the "[Filing Basis](#)" video.

Please see below for updated Quick Tips or click on "Searching the ID Manual" for detailed information on searching and use of the ID Manual features.

Please click on the "Guidance for Users" link below for information about the ID Manual's features, general identification and classification notices, and for guidance on identifying and/or classifying specific goods and services. For information about USPTO policy on identification and classification of goods and services, please also consult [Chapter 1400](#) of the Trademark Manual of Examining Procedure (TMEP).

[Searching the ID Manual](#) | [Guidance for Users](#) | [Browse Entire Content](#) | [To suggest additions to the Trademark ID Manual click here.](#)

Search Manual

Choose Field Basic Fields

Enter Search Terms

(If choosing a field other than "Basic Fields," all status checkboxes must be unchecked.)

Return results with status: ☒ A - Added ☒ M - Modified ☒ X - Examples ☐ D - Deleted

[Click here](#) for more information about ID Manual entry statuses and using the status checkboxes.

Submit Query

Reset



USPTO Trademark ID Manual

Quick Tips:

- **How to enter a search:**

Enter search term(s) in the search box. The default setting "Basic Fields" will search the basic table fields (IC, GS, ED, DE, ST and TL). Press "Submit Query" to execute the search. The "Reset" button will delete contents of the search box and return to the "Basic Fields" selection.

- **Statuses:**

Searches conducted **using the "Basic Fields" search field** may be further refined by checking the appropriate checkboxes to return entries with a particular status. Entries with a status of A, M, and X are active entries that are generally acceptable as written.

- The letter "A" is used to indicate that the entry was Added to the ID Manual.
- The letter "M" is used to indicate an entry which has been Modified since originally added to the ID Manual.
- The letter "X" indicates an entry that is an Example of an acceptable identification of goods or services; the Example entries often include more detail than is required for an acceptable identification. Example entries may also include minor grammatical differences from an "A" entry, such as pluralization of an "A" entry (e.g., beer ("A") and beers ("X")).
- The letter "D" indicates an entry that has been Deleted from the ID Manual as of the indicated effective date.

The status checkboxes will default to select the active entries (entries with A, M, and X statuses) as retrieved entries. To include a particular status in the search results, check the box(es) next to the desired status. Multiple boxes may be checked. To exclude a particular status from the search results, uncheck box next to that status.

- **Choose Field:**

To search individual fields, select a field code from the pull down options. For example, to search the Note field, choose "Note" from the "Choose Field" pull down options and any term entered in the search box will be searched only in the Notes field. CAUTION: The status checkboxes cannot be used if a specific field is selected other than "Basic Fields" search field. For further information, see [How to Use the Choose Field Search Options](#).

- **Refine Search:**

Use the "Refine Search" box located at the top of the results page to add terms to the original search. This search box may be used to execute new searches. To execute a new search, delete the contents of the search box, enter the new text to search and press "Submit Query" to execute the new search. The search will default to "Basic Fields".

- **Boolean Search Operators:**

- AND (e.g., automobile and repair; "016" and paint)
The search results will include only identifications containing both terms.
- OR (e.g., cloth or fabric)
The search results will include identifications containing either term, as well as those containing both terms.
CAUTION: When conducting searches in the "Basic Fields" search field, a search using the Boolean Operator OR must be surrounded by parentheses if less than all of the status checkboxes are selected. For further information, see [How to Filter Search Results Using the Checkboxes](#).



Guidance For Users

uspto.GOV

The United States Patent and Trademark Office
an agency of the Department of Commerce

[search for patents](#) | [search for trademarks](#)

Search our site



[PATENTS](#) | [TRADEMARKS](#) | [IP LAW & POLICY](#) | [PRODUCTS & SERVICES](#) | [INVENTORS](#) | [NEWS & NOTICES](#) | [FAQs](#) | [ABOUT US](#)

[Home Page](#) » [TRADEMARKS](#) » [Manuals, Guides, Official Gazette](#)

[Trademark Search](#)

[Trademarks Process](#)

[News & Notices](#)

[Manuals, Guides, Official Gazette](#)

[Laws & Regulations](#)

[Online Filing](#)

[Contact Trademarks](#)

GUIDANCE FOR USERS

This page contains information regarding ID Manual features, classification and identification practice, and tips relating to specific goods and services. Click on the links below to browse content in each category.

- [ID MANUAL FEATURES](#)
- [GENERAL NOTICES](#)
- [GUIDANCE ON IDENTIFYING AND/OR CLASSIFYING SPECIFIC GOODS AND SERVICES](#)
- [ARCHIVED NOTICES](#)

ID MANUAL FEATURES

Spotlight on TM5 – the “T” Entries

The USPTO works together with its international partners, the Japanese Patent Office (“JPO”), the European Trademark Office (“OHIM,” the Office of Harmonization in the Internal Market), and the Korean Intellectual Property Office (“KIPO”), to establish and maintain a list of identifications of goods or services which are acceptable to all offices. This collective effort is known as the “TM5” Trademark Identifications and Classifications Project (formerly known as “Trilateral”). The mutually agreed upon identifications are included in ID Manual and are designated by the letter “T” in the “TM5” column of the hit list. For further information about “T” entries, see [TMEP §1402.04](#).

Entry Status

Each entry in the ID Manual is given a particular letter to indicate the status of the entry. Entries with a status of “A” (Added), “M” (Modified), or “X” (Example) are active entries which are acceptable in the class specified.

Highlights



[DATOS En Español](#)





Searching the TM ID Manual

uspto.GOV

The United States Patent and Trademark Office
an agency of the Department of Commerce

search for patents | search for trademarks

Search our site



PATENTS | TRADEMARKS | IP LAW & POLICY | PRODUCTS & SERVICES | INVENTORS | NEWS & NOTICES | FAQs | ABOUT US

[Home Page](#) » [TRADEMARKS](#) » Manuals, Guides, Official Gazette

Trademark Search

Trademarks Process

News & Notices

Manuals, Guides, Official Gazette

Laws & Regulations

Online Filing

Contact Trademarks

Highlights



[DATOS En Español](#)



SEARCHING THE TRADEMARK ID MANUAL

To perform the broadest search of the ID Manual, enter the desired search term in the "Enter Search Terms" box on the ID Manual Main Page. The "Choose Field" box defaults to the "Basic Fields" search option, which searches across several fields of data simultaneously.

For more detailed information about searching, click on the links below to view help on a specific topic.

- [EXPLANATION OF ID MANUAL MAIN PAGE FEATURES](#)
- [EXPLANATION OF SEARCH FIELDS](#)
- [HOW TO FILTER SEARCH RESULTS](#)
- [FILTERING SEARCH RESULTS USING THE CHECKBOXES](#)
- [FILTERING SEARCH RESULTS USING THE CHOOSE FIELD SEARCH OPTIONS](#)
- [HOW TO USE BOOLEAN OPERATORS TO CONDUCT A SEARCH](#)
- [HOW TO USE TRUNCATION TO CONDUCT A SEARCH](#)
- [EXPLANATION OF "SUBMIT QUERY" AND "RESET" BUTTONS](#)
- [EXPLANATION OF "REFINE SEARCH" BOX AND "RETURN TO TOP TO REFINE SEARCH" LINK](#)
- [EXPLANATION OF SEARCH RESULTS HIT LIST AND COLUMN HEADINGS](#)
- [COPYING, PRINTING, AND EXPORTING USING INTERNET EXPLORER®](#)
- [GLOSSARY](#)

EXPLANATION OF ID MANUAL MAIN PAGE FEATURES

The ID Manual is available on the USPTO's website. Upon arriving at the specific ID Manual web page, the ID Manual will load and display the "Main Page" which includes the "Search Area" where a search may be conducted.



Recent ID/Class Projects

- Implementation of Nice Classification, 10th edition, 2014 version on January 1, 2014
- Advanced ID Crafting Bootcamp training for Trademark Examining Attorneys
- Kickoff of IT development project for Next Generation Identification Database system



Noteworthy Changes of NCL-10-2014

- Electronic data storage – Class 42
 - Transferred from Class 39
- Search engine optimization - Class 35
 - Transferred from Class 42
- Providing on-line videos, not downloadable – Class 41 *regardless of subject matter*
 - Previously classified by subject matter
- Embalming services – Class 45
 - Transferred from Class 40



Continuing ID/Class Initiatives

- Industry Input
 - User groups are forming teams of industry-specific “experts” to assist USPTO in drafting U.S. ID Manual entries relevant to the marketplace.
- WIPO’s Madrid Goods and Services (MGS) Manager
 - USPTO is reviewing thousands of entries to vote “yes” or “no” so Madrid filers (and anyone using GSM) will know in advance if we accept language or not; over 40,000 entries in GSM



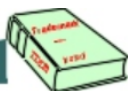
Recent IT Enhancements

- Improvements to ID Manual
 - “X” status (for “Example” entries)
 - Status checkboxes - allow filtering of results by status (“Added,” “Modified,” “Deleted,” “Example”)
 - More & Better Notes to new and existing entries



“X” status for “Example” entries

Trademark ID Manual



Refine Search:

Return results with status: ☐ A - Added ☐ M - Modified ☒ X - Examples ☐ D - Deleted

[Click here](#) for more information about Manual entry statuses and using the status checkboxes.

Submit Query

Documents: 1 - 1131 of 1131

Hit No.	Class	Description	Status	Effective Date	Type	Note	TM5
1	001	Antioxidants and proteins used in the manufacture of cosmetics, beverages, food products and food supplements	X	09 Aug 07	G	Y	
2	001	Chemical additives for asphalt	X	22 Aug 13	G	N	
3	001	Chemical preparations, namely, {indicate type of product, e.g., sprays, gels, powders, etc.} for use in preventing odors, mold and mildew from building up on outdoor furniture, carpets and cushions	X	24 Mar 11	G	Y	
4	001	Cryopreservation kits for use in scientific research consisting primarily of sperm freezing medium, in vitro fertilization medium, sperm freezing canister, cans for holding straws filled with semen, and mixing tubes	X	07 Jul 11	G	Y	
5	001	Immunohistochemistry detection kits consisting of mouse secondary reagents, DAB chromogens, DAB buffers, peroxidase blocking reagent, and hematoxylin, for anatomic pathology purposes in the medical diagnostics industry	X	03 Sep 09	G	Y	
6	001	Kit comprising of regeneration solution, serum samples and sensor chips for scientific use	X	18 Oct 07	G	Y	
7	001	Kit comprising polymer based composition, tape and plastic coating for forming handles moldable to the individual's hand	X	27 Sep 07	G	Y	
8	001	Kit containing pre-packed columns, chemicals, pre-made buffer concentrates, syringes and instructional manual	X	17 Aug 06	G	Y	



Recent Enhancements, Cont.

- Optional “ID Assistance” tool added to regular TEAS application form
 - For use when manually entering or pasting in a listing of goods/services
 - Compares inputted terms with U.S. ID Manual
 - Provides results page that can be printed and tool can be re-run again and again



You should review the [USPTO Goods/Services ID Manual](#) (ID Manual) before entering items below. You are not required to use an entry from the ID Manual; however, if your entry is not from the ID Manual, you must describe your goods and/or services in specific, clear, and concise terms.

ID ASSISTANCE (optional feature):

Before continuing to the next screen, you may want to use the ID Assistance tool, which may result in more efficient processing of your application. This tool compares your proposed identification (ID) of goods/services with the ID Manual's list of acceptable entries. Once you have reviewed the results, you can then revise your entry to follow the acceptable language from the ID Manual, if the language from the ID Manual is accurate for your goods and/or services.

ID Assistance Instructions:

(1) After entering your goods and/or services in the text box by following the above instructions, select one of the four buttons below to specify how this tool should search the wording (i.e., by semicolons, commas, both, or neither) for comparison with the ID Manual wording;

(2) Click "Analyze."

Note: For accurate results, use only characters from the English alphabet. Do not enter the following: special characters such as accent marks; punctuation other than hyphens, commas, or semicolons; or more than 4,000 characters. For additional information, please see the [detailed instructions](#).

- Semicolon: Searches all wording separated by a semicolon as a single clause. Commas will be ignored.
- Comma: Searches all wording separated by a comma as a single clause. Semicolons will be ignored.
- Both: Searches all wording separated by a comma or a semicolon as a clause.
- None: Searches all wording as a single clause. Commas and semicolons will be ignored. (This is rarely appropriate.)

Analyze



ID Assistance Results Page

Identification (ID) Assistance Result

Wed Mar 05 18:11:51 EST 2014



The TEAS ID Assistance Tool has returned the "ID results list" below, by comparing your proposed list of goods and/or services against entries in the [USPTO's Acceptable Identification of Goods and Services Manual](#) (the "ID Manual"). You may print this page for future reference. The [key](#) to understanding your results appears directly below the "ID Results List".

ID Results List

Class	ID	ID Manual Result
014	rings	OK
025	hats	OK
025	sweatshirts	OK
016	pencils	OK
	computer software	Possible Match

ID Assistance: Key to "ID Results List"

- **OK:** The proposed wording is identical to a listing in the ID Manual and the International Class of that listing is displayed.
- **Possible Match:** The proposed wording may require further clarification because, as entered, it does not exactly match any entry in the ID Manual. Click the hyperlinked search term to open a browser window containing a listing of all entries from the ID Manual that incorporate the wording in question.
- **No Entry:** The proposed ID, in its entirety, does not appear in any entries in the ID Manual.



Did you know?

- The U.S. ID Manual can be searched using the same search rules as TESS?
 - E.g. truncation – BRS search engine dollar sign - \$ - allows for an unlimited number of characters; **flo\$** will retrieve flower, flowers, floor, flow, etc.
- Text in square brackets (e.g. jerseys [clothing]) is informational or instructional and is NOT a required part of an identification.



Did you know?

- Text in parentheses IS part of the identification
 - May indicate non-English term for the entry; e.g., Korean-style dumplings (mandu)
 - May indicate a recognized acronym for the entry; e.g., Hard disk drives (HDD)
- The percentage of applications filed through TEAS Plus that are approved for publication on first action is 35.2%.
 - Regular TEAS = 18.1%; paper filings = 10.1%



THANK YOU!

State of the USPTO

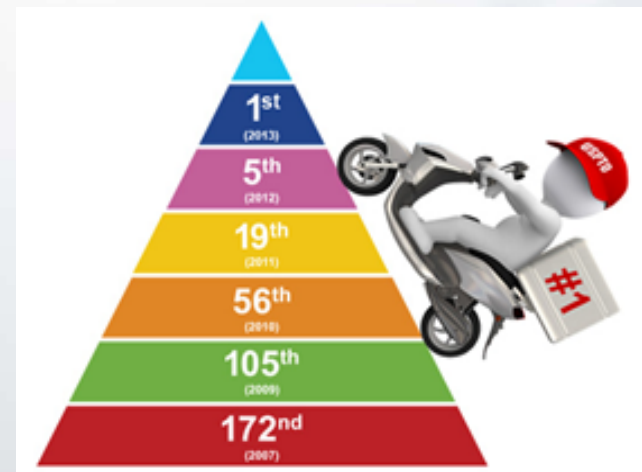


Deborah Cohn
Commissioner for Trademarks
March 25, 2014



Best Places To Work® Rankings

- In 2013 USPTO was #1 out of 300 sub-agencies
- Rankings are a tool for agency leaders to understand health of organization and highlight areas for improvement



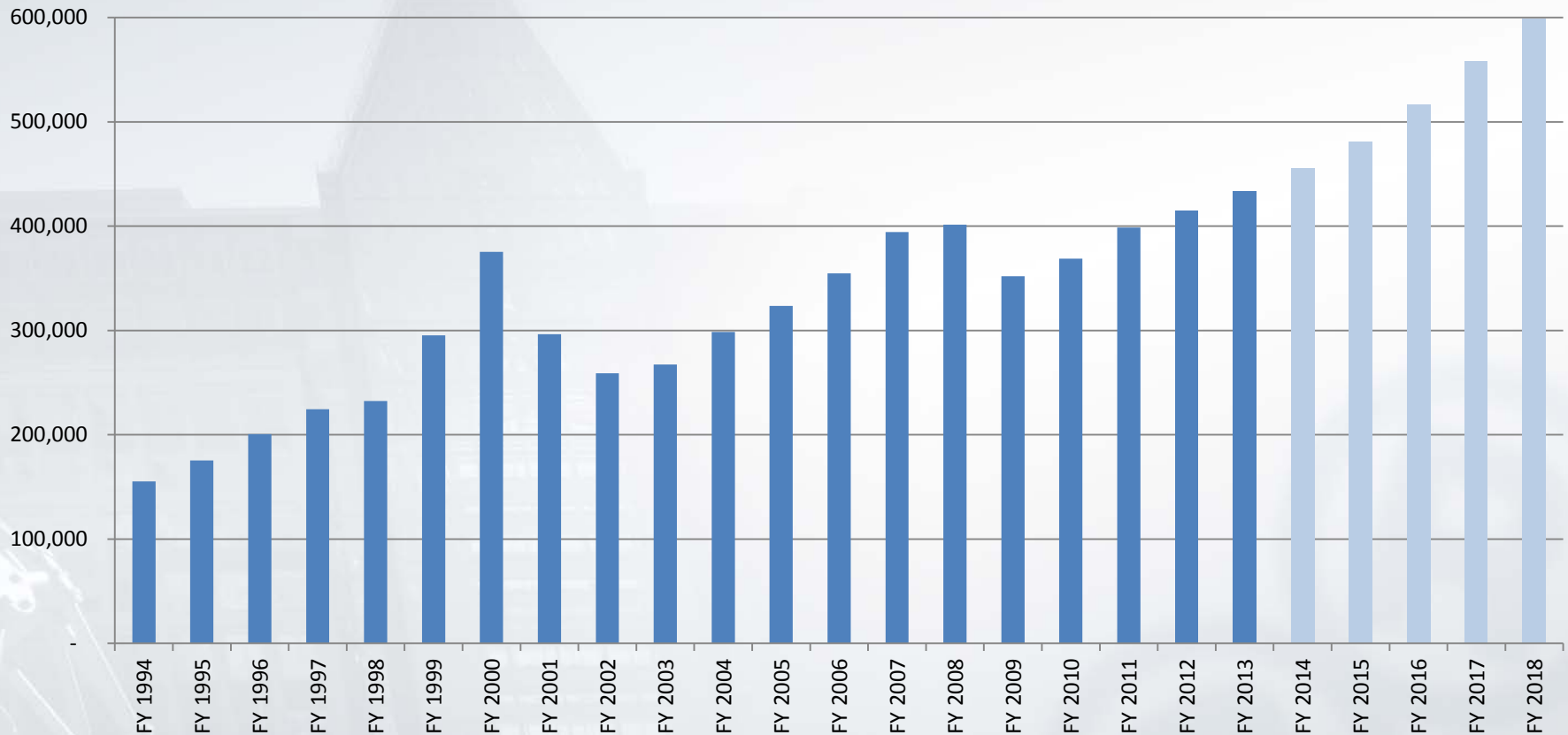


Trademark Staffing

- 691 total Trademark employees
- 421 examining attorneys
- Almost 85% of examining attorneys telework full time
- Examining attorneys are located in 29 different states
- Hiring 30 examining attorneys this year



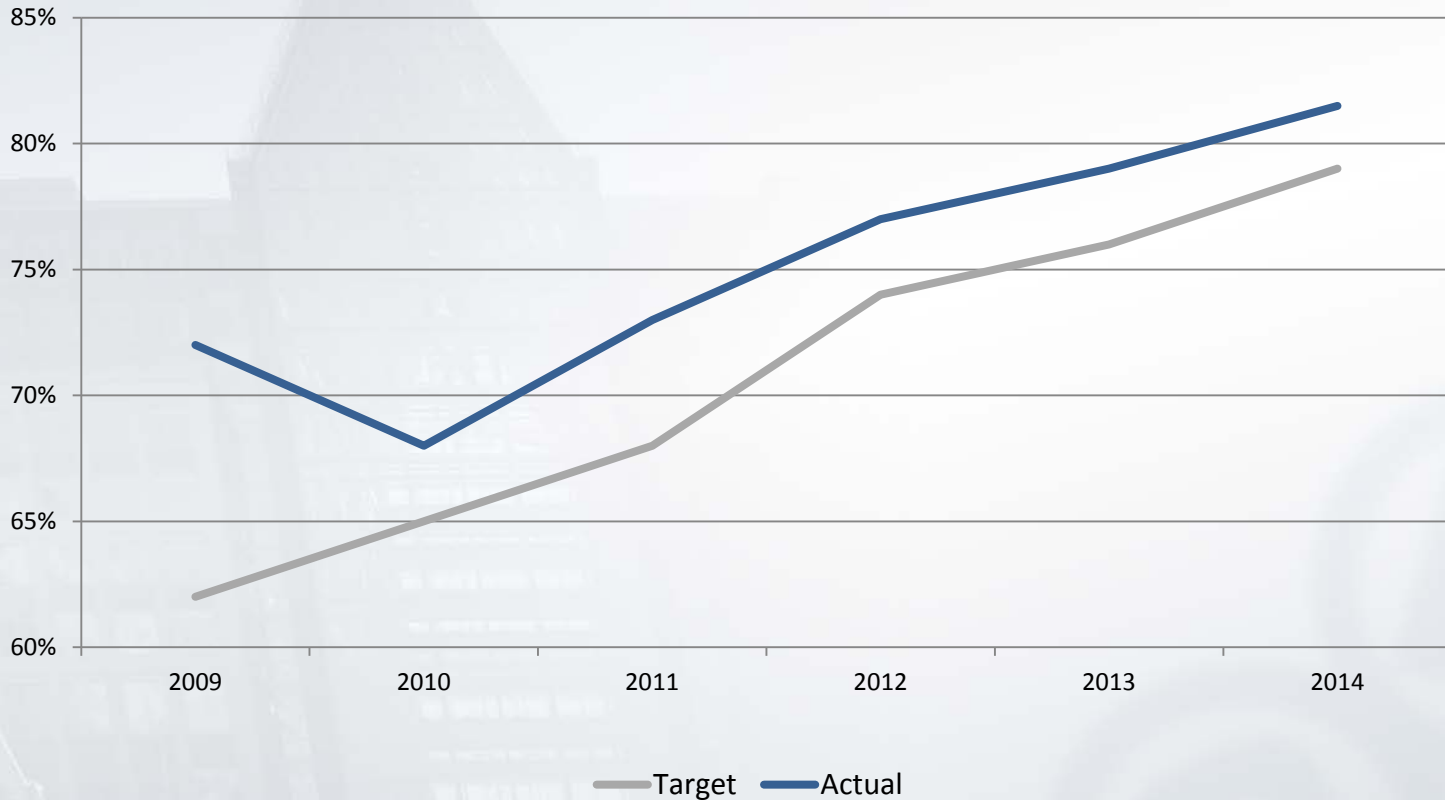
New Application Filing Levels



- FY 2013: 433,654 classes
- FY 2014: 455,000 classes projected – 5% increase



Performance Results: E-Government





Trademark Performance: Pendency

<i>FY 2014 Trademark Performance Measures</i>	<i>FY 2014 Targets</i>	<i>FY 2014 January Results</i>
First Action Pendency First action pendency from date of filing to first office action in months.	2.5 – 3.5	3.0
Disposal Pendency Disposal pendency from date of filing to issuance of a notice of allowance, registration, or abandonment – excluding suspended and <i>inter partes</i> proceedings.	12.0	10.0



Trademark Performance: Quality

<i>FY 2014 Trademark Performance Measures</i>	FY 2014 Targets	FY 2014 January Results
First Action Compliance In-process review evaluation of the statutory bases for which the Office raises issues and or refuses marks for registration based on the first office action.	95.5%	96.0%
Final Action Compliance In-process review evaluation of the statutory bases for which the Office raises issues and or refuses marks for registration based on the examiner's approval or denial of the application.	97.0%	97.3%
Exceptional Office Action Measure indicating the comprehensive quality of the first Office action search, evidence, writing and decision making.	28.0%	41.3%

Upcoming Events



- Roundtables
- TM Expo



Roundtable on Technology Changes in Identifications

- Previous Request for Comments on amending registrations to reflect evolving technology in goods and services
- April 11, 2014: USPTO roundtable to discuss user views on possible impacts and advisability of policy changes to allow updates



INTA/USPTO Roundtables

- INTA/USPTO Roundtables throughout U.S.
- Trademark professionals discuss current topics of interest, exchange practice tips, and raise important issues to USPTO leadership
- Planning events in Silicon Valley, Dallas, Indianapolis, and other areas in 2014



TM Expo Returns

TM Expo: October 17-18, 2014





USPTO Communications

tmfeedback@uspto.gov – for
miscellaneous suggestions
and/or comments



E-mail News and Updates

- Would you like to be notified of happenings at the USPTO?
- See our subscription center where you can sign up for Trademarks Alerts and various other updates. www.uspto.gov/subscribe



United States Patent and Trademark Office
An Agency of the Department of Commerce

subscriptioncenter

Welcome to the USPTO Subscription Center. Sign up here to receive the latest news and updates from the USPTO conveniently via e-mail.

Subscribe to one or more news updates by entering your e-mail address.

E-mail

Confirm your e-mail address

Preferred format for e-mails:

☐ Text ☒ HTML

Please select the newsletters or updates you would like to receive:



Thank You

Questions?

Deborah S. Cohn

Commissioner for Trademarks

Debbie.Cohn@uspto.gov

The New gTLD Launch IPO Education Foundation PTO Day

March 25, 2014



Amy Cotton, Senior Counsel for Trademarks
Office of Policy and International Affairs
USPTO



Topics

- 1) Update on the new gTLD rollout
- 2) Overview of the NEW RPMs for new gTLDs (rights protection mechanisms)
- 3) GAC advice implementation
 - Any late-breaking news from ICANN/Singapore Meeting (March 22-28, 2014)



Status of the gTLD applications

- Total Applications Received for new gTLDs: 1,930
 - 1,775 have passed evaluation
 - 4 applications were not approved
 - 140 applications have been withdrawn
 - 11 continue in evaluation



Next Steps for gTLD Applications

- Contracting and Delegation:
 - Of those that have passed evaluation, ICANN has invited 1,083 applications to begin contracting:
 - 283 contracts have been signed and, of these:
 - 221 new gTLDs have passed Pre-Delegation Testing
 - 150 new gTLDs have been delegated!



First 10 strings to be delegated

06 November 2013	.LIGHTING	John McCook, LLC
06 November 2013	.SINGLES	Fern Madison, LLC
06 November 2013	.VOYAGE	Ruby House, LLC
06 November 2013	.GURU	Pioneer Cypress, LLC
06 November 2013	.HOLDINGS	John Madison, LLC
06 November 2013	.EQUIPMENT	Corn Station, LLC
23 October 2013	xn--ngbc5azd) – Arabic for "web/network"	International Domain Registry Pty. Ltd.
23 October 2013	онлайн (xn--80asehdb) – Russian for "online"	CORE Association
23 October 2013	сайт (xn--80aswg) – Russian for "site"	CORE Association
23 October 2013	游戏 (xn--unup4y) – Chinese for "game(s)"	Spring Fields, LLC



Basic IP Protection in (new) gTLDs: RPMs or Rights Protection Mechanisms

- “Thick” WHOIS (domain name registration record)
- Trademark Clearinghouse
 - For use in Sunrise
 - For use in Trademark Claims
- Uniform Rapid Suspension System (URS)
- Uniform Domain Name Dispute Resolution Policy (UDRP)



Trademark Clearinghouse

- Centralized database of verified data of registered (court-validated or statute/treaty-protected) trademarks
 - TM data deposited at one centralized source rather than with each new gTLD Registry (which will retrieve data from TMCH).
 - Facilitates use of the Sunrise service and Trademark Claims service

www.trademark-clearinghouse.com



RPMs, continued

- Sunrise Registration Period
 - period during which TM owners can purchase domain names, before the general public (*with a 30 days notice period **before** Sunrise begins*)
- Trademark Claims Notice (90 days)
 - Provides notice to prospective DNS registrant of a potential conflict between the domain name and existing trademark
 - Also provides notice to the TM owner if the domain name is registered following the registrant's claim of non-infringement



Uniform Rapid Suspension: URS

- Quicker and cheaper alternative to the UDRP
 - Approximately between the \$300-500 range (cheaper than the \$1,000-plus associated with the UDRP)
 - Decision in favor of IBM handed down **within 7 days** of filing the complaint cf. 2 months for UDRP)
- Intended for clear cut cases of trademark abuse
- Only remedy available is the suspension of the domain name



gTLDs: The Uniform Domain Name Dispute Resolution Policy (UDRP)

- The Uniform Domain Name Dispute Resolution Policy (UDRP) was targeted to discourage and resolve abusive registration of trademarks as domain names in gTLDs.
- Three-prong test:
 - *Domain identical or confusingly similar to mark;*
 - *Respondent has no right or legitimate interest in domain name; and*
 - *Respondent has registered and used domain name in bad faith.*
- Information about the UDRP may be found at:
<http://www.icann.org/udrp> and at
<http://www.wipo.int/amc/en/domains/>



GAC Advice

- Governmental Advisory Committee (GAC) – representing government interests within ICANN
 - Provided early warnings to certain strings
 - Which basically halted these applications
 - Provided advice to ICANN Board in the form of additional safeguard recommendations applicable to all new gTLDs and certain specific strings
 - Category 1 Safeguards designed to offer protection for strings related to regulated sectors
 - To be added to Specification in new Registry Agreement
 - Category 2 Safeguards designed to offer nondiscriminatory and transparency measures for strings representing generic terms but with exclusive access.
 - Awaiting further review



Looking into the future

- New gTLDs: What's Next?
 - RPMs operational
 - Continue delegation of new gTLDs
- New horizons:
 - Changes to ACPA?
 - Increased second-level protection? A new Internet?
 - Another round of new gTLDs?



ICANN: The Roll-out of New gTLDs

ICANN New gTLD Program --

<http://newgtlds.icann.org/en/>

About the Program --

<http://newgtlds.icann.org/en/about/program>

ICANN Fact Sheet on new gTLDs --

<http://archive.icann.org/en/topics/new-gtlds/gtld-facts-31jul11-en.pdf>

Right holders Fact Sheet –

<http://archive.icann.org/en/topics/new-gtlds/rights-holders-with-insert-02sep11-en.pdf>



THANK YOU!

The **World Leader** in Digital Brand Services



DIGITAL BRAND SERVICES
CORPORATION SERVICE COMPANY™



DIGITAL BRAND SERVICES
CORPORATION SERVICE COMPANY®

Update on gTLD Rollout



DIGITAL BRAND SERVICES
CORPORATION SERVICE COMPANY®

Sara Freixa

Digital Brand Consultant
CSC Digital Brand Services

Today's Agenda

What are New gTLDs?

**Trademark Clearinghouse
(TMCH)**

**Domain Protected Marks
Lists (DPML)**

Dispute Resolution

Q & A



ICANN – The Internet Corporation for Assigned Names and Numbers is the policy body governing domain names and IP addresses.

TMCH – The trademark clearinghouse is a global database of verified trademarks that may be eligible for registration as a domain name during a sunrise period.

Sunrise – A priority period that every new gTLD must offer to trademark owners before making registrations available to the general public.

DPML – A registry-specific rights protection mechanism that allows trademark holders to prevent cybersquatting by blocking trademark names.

Before New gTLDs

A word cloud of existing top-level domains (TLDs) is centered on the slide. The words are of various sizes and colors, including shades of green, orange, yellow, and purple. The domains shown are: tel, pro, edu, cat, com, asiacoop, name, jobs, biz, travel, gov, org, museum, mobi, aero, net, int, info, and xxx. The word "pro" is the largest and most prominent, followed by "tel", "edu", "cat", "com", "name", "jobs", "biz", "travel", "gov", "org", "museum", "mobi", "aero", "net", "int", "info", and "xxx".





Complexity in New gTLDs

1,930 APPLICATIONS SUBMITTED

1,400+ UNIQUE STRINGS

CLOSED APPLICATIONS

650 +/- OPEN, RESTRICTED, COMMUNITY



NO ACTION REQUIRED
(TMCH)

RISK

REGISTRATIONS

BLOCK

MONITOR

Central repository for trademark holders

- **1,3, or 5 year terms available**

Key benefits

- Mandatory for participation in sunrise periods for open new gTLDs
- Trademark Claims Notices when third parties register exact matches of registered marks
- Allows participation in other Rights Protection Mechanisms (RPMs)



Applied for over 300 generic new gTLDs

- Expected to operate over 200
- 5 year term on DPML





Rightside DPML

Rightside

Interest in 100+ new gTLDs

Minimum one year term on block

TMCH registration required



.gives



.republican



.democrat



.social



.ninja

DPML is a block, not an active domain name

- Can override a block at a later date
- Prevents cybersquatting at a fraction of the cost of defensive registrations
- Requires a TMCH record





Building Your New gTLD Strategy

1



Determine the right trademarks to file with the Trademark Clearinghouse.

2



Narrow the field of potential New gTLDs that will have the greatest impact on your business.

3



Prepare cost effective, data driven registration and blocking strategies for the sunrise and land rush (.brand included).

4



Achieve digital optimization in the new Internet landscape.

UDRP

- Domain transferred to Complainant
- Takes around 3 months
- Panelist fees start at \$1,400
- Historical method of Dispute Resolution

URS

- Domain not transferred to Complainant
- Can take as little as 6 days
- Panelist fees: \$375
- New for New gTLD Program
- First cases have been filed (and won)



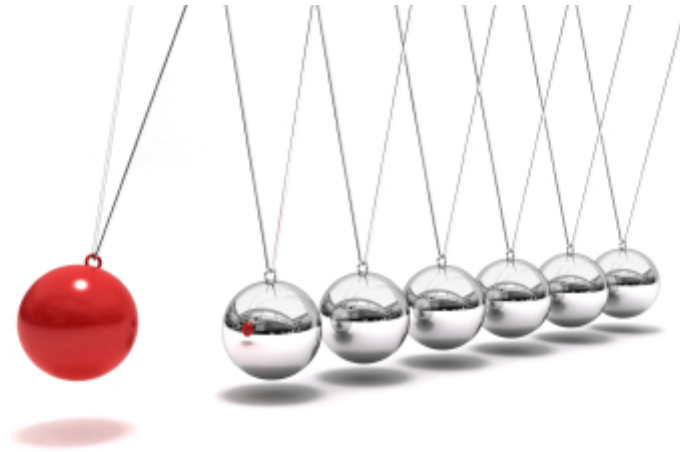


Requirements for Disputes

Need to prove three things:

- 1. The Complainant has an identical or confusingly similar trademark to the domain**
- 2. The Respondent (Current owner of the domain) has no legitimate interest in the domain**
- 3. The Respondent (Current owner of the domain) registered and is using the domain in bad faith**

Questions?



Examination of Applications for gTLD Marks for Domain Name Registry Operator and Registrar Services

2014



Cynthia Lynch
Administrator
Trademark Policy and Procedure
U.S. Patent and Trademark Office



Background on USPTO Policy

TMEP has provided, in part, that for a mark composed solely of a TLD for domain name-related services:

[R]egistration generally must be refused under Trademark Act §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127, on the ground that the TLD would not be perceived as a mark.

TMEP 1215.02(d).



Background on USPTO Policy

- Premise of old policy -- gTLDs as mere abbreviations of the class of intended users of the gTLD or subject matter of the domain space
- Limited number of gTLDs lent itself to a more absolute policy



Changing Landscape – New .BRAND gTLDs

- New gTLDs may be comprised of existing registered marks that are already strong source identifiers in other fields of use
- For those types of gTLDs, the consumer perception of them as source indicators may carry over to these new services



USPTO Exam Guide

- Draft posted for comment in August 2013 through USPTO.gov collaboration tool
- Comments from INTA, AIPLA, various companies, trademark lawyers, and other members of the public



Requirements for Registration

New policy – allow for registration in certain limited circumstances

- Perception of the gTLD as a source identifier
- Currently valid agreement with ICANN for the gTLD identified by the mark
- Services will be primarily for the benefit of others



Source Identifier

- Prior registration(s) of the same mark for goods or services in the same field of use as the domain-name registry operator and registrar services
- Additional proof that the gTLD will be perceived as a mark



ICANN Agreement

- Potential consumer deception based on belief that the applicant's domain-name registry operator and registrar services feature the gTLD in the proposed mark
- Must submit evidence of ICANN agreement
- Must amend the ID to indicate that the gTLD in the mark will be a feature of the services



Service for the Benefit of Others

- Information requirement by examining attorney
- Operating a gTLD registry that is only available for use by the applicant's employees or for the applicant's marketing initiatives alone generally would not qualify as a service
- Use by the applicant's affiliated distributors typically would



Other Issues

- Section 2(e)(1) descriptiveness -- *In re theDot Commc'n Network LLC*, 101 USPQ2d 1062 (TTAB 2011) (affirming descriptiveness of .MUSIC)
- Section 2(d) – interesting issues with relatedness of goods/services



Questions?

Petitions to the Director



Montia Pressey

Attorney Advisor

Office of the Deputy Commissioner for
Trademark Examination Policy

Patent and Trademark Office Day

March 25, 2014



Petitions to the Director: Procedural questions in *ex parte* examination

- ***In re Faucher Industries Inc.*, 107 USPQ2d 1355 (TTAB 2013)**
 - *Ex parte* case involving refusal of registration due to an unacceptable identification of goods
 - Board noted the Director had more flexibility in providing a remedy within scope of her “supervisory authority” for non-substantive matters during prosecution of an application
 - Ability to address identification/classification of goods/services
 - Ability to reopen examination pursuant to 37 C.F.R. §2.142(g)
 - Authority to waive rules in accordance with 37 C.F.R. §2.148.



Petitions to the Director: Procedural questions in *ex parte* examination

- ***In re P.T. Polysindo Permute*, 109 USPQ2d 1256 (TTAB 2013)**
 - Director exercised supervisory authority under 37 C.F.R. §2.146(a)(3) and reversed examining attorney's holding of abandonment
 - Finding no clear error in abandoning applications for failure to file complete responses due to the lack of supporting declarations for the substitute specimens
 - But concluding applicant demonstrated substantial compliance and a bona fide attempt to advance examination by submitting otherwise acceptable specimens and providing the required declarations on petition



Petitions Office Staff

- Six staff attorneys
- Paralegal supervisor
- Five paralegals
- One legal assistant



Petitions Office Paralegal Responsibilities Include:

- Petitions to revive abandoned applications
- Requests for reinstatement (for USPTO error)
- Petitions to make special, restore application filing dates
- Post publication amendments



Petitions Office Attorney Responsibilities Include:

- Petitions to the Director to waive rules or exercise supervisory authority; review procedural issues in examination; review interlocutory orders in TTAB proceedings; review Post Registration decisions; etc.
- Letters of Protest
- Customer service, including Congressional inquiries & trademark-related correspondence to the Director or Commissioner



Types of Petitions

- Petitions to revive abandoned applications under Trademark Rule 2.66
 - Abandonment due to “unintentional delay” by applicant
 - Handled by the paralegals in the Office of the Commissioner for Trademarks
- Petitions to the Director under Trademark Rule 2.146
 - Handled by both the paralegals and staff attorneys



Petitions to Revive

- A Petition to Revive may be filed when an applicant was **unintentionally delayed** in filing a response to an Office action or an SOU or extension request. 37 C.F.R. §2.66.
- Routinely granted but must be timely and meet all requirements of Rule 2.66.
 - To be timely it must be filed within two months of the mailing date of the Notice of Abandonment.
- Fee: \$100 per application



Reinstatement

- Applications abandoned due to **Office error**
- Available in place of formal petition to revive
- Requires direct evidence that Office error caused abandonment. Acceptable evidence includes:
 - TEAS receipt proving that a timely response was submitted;
 - Copy of response with a timely Certificate of Mailing;
 - Copy of return receipt postcard date-stamped by the USPTO; or
 - Other proof of receipt in the USPTO, such as a cancelled check.
- No fee needed



Petitions under 2.146

- Under 37 C.F.R. §2.146(b), questions of substance during the *ex parte* prosecution of applications are not appropriate subject matter for petitions
- Procedural *ex parte* matters and Board orders in *inter partes* matters concerning issues of procedure that do not put an end to litigation before the Board are petitionable.



Petitions under 2.146

- Questions of substance are considered on petition when reviewing the action of the Post Registration staff
- Explanation of circumstances; and
- Supporting declaration under 37 C.F.R. 2.20, or affidavit
- Fee: \$100 per application or registration



Types of 2.146 Petitions

- Petitions to Reverse an Examining Attorney's Holding of Abandonment for failure to file a complete response to an Office action.
 - Generally granted only if there was a clear error or abuse of discretion on the part of the examining attorney
- Petitions to Restore Jurisdiction to the Examining Attorney to consider an amendment to the application.
 - Usually filed after the NOA issues and the applicant wants to make an amendment before filing the SOU



Types of 2.146 Petitions

- Petitions to Restore an Application Filing Date.
- Petitions to Make Special.
- Petitions to Review the Refusal of the Madrid Processing Unit to certify an application for international registration.
- Petitions to Waive Trademark Rule 2.77 to allow consideration of an amendment other than an amendment to delete goods between NOA and SOU



Types of 2.146 Petitions

- Petitions to Review the Action of the Post Registration Staff due to rejection of an affidavit of use or excusable nonuse, a renewal application, or a proposed amendment or correction.
- Petitions to Amend Basis Post Publication required by Trademark Rule 2.35(b)(2).
- Petitions to Reverse a Non-Final Decision of the Trademark Trial and Appeal Board.



Petition Statistics FY2013

Nature of petition	2009	2010	2011	2012	2013
Actions on trademark petitions, total	24,747	21,852	23,133	21,036	22,268
Filing date restorations	20	13	6	19	8
Inadvertently issued registrations	134	116	78	81	118
Letters of Protest	1,011	1,003	1,213	1,490	1,595
Madrid Petitions	21	28	46	43	61
Make special	94	225	170	302	244
Reinstatements	851	563	547	354	319
Revive (reviewed on paper)	2,526	1,096	1,276	698	324
Revive (granted electronically)	18,67	17,686	18,802	16,913	18,165
Waive fees/refunds	18	18	5	18	7
Miscellaneous Petitions to the Director	1,008	971	840	967	1,223
Board Matters	11	16	9	15	25
Post Registration Matters	86	117	141	136	179



TEAS Petition Forms

Petition Forms - Microsoft Internet Explorer provided by USPTO

http://www.uspto.gov/trademarks/teas/petition_forms.jsp

File Edit View Favorites Tools Help

★ Favorites ⚡ Petition Forms

About USPTO Patents **Trademarks** IP Law & Policy Products & Services Careers Inventors News & Notices eBusiness/Alerts FAQs For Kids

Home Page » Trademarks » TEAS

Trademarks Process
News & Notices
Manuals, Guides, Official Gazette
Laws & Regulations
Contact Trademarks
TEAS

Petition Forms

1. Petition To Revive Abandoned Application - Failure To Respond Timely To Office Action

Use this form to file a petition to revive an abandoned application and request that the USPTO return the application to active ("pending") status. The United States Patent and Trademark Office (USPTO) "abandons" a trademark application whenever the USPTO does not receive a timely-filed response to an examining attorney's office action. "Abandoned" means that the application is no longer pending, and, therefore, cannot mature into a registration.

You may file a petition to revive only if the applicant's delay in responding to the office action was unintentional. 37 C.F.R. §2.66. You must file the petition to revive no later than two (2) months from the mailing date of the notice of abandonment.

If you never received the notice of abandonment, and you have been diligent in prosecuting the application, you may file a petition within two (2) months from the date you became aware of the abandonment. To be considered diligent, you must have checked the status of the application every six (6) months from the filing date of the application. 37 C.F.R. §2.66(a) and 2.146(I).

2. Petition To Revive Abandoned Application - Failure To File Timely Statement Of Use Or Extension Request

Use this form to file a petition to revive an abandoned application and request that the USPTO return the application to active ("pending") status. The United States Patent and Trademark Office (USPTO) "abandons" a trademark application whenever the USPTO does not receive a timely-filed Statement of Use (SOU) or Request for an Extension of Time to File a Statement of Use (Extension Request), in response to a Notice of Allowance. 37 C.F.R. §2.65. "Abandoned" means that the application is no longer pending, and, therefore, cannot mature into a registration.

You may petition to revive only if the delay in filing an SOU or Extension Request was unintentional. 37 C.F.R. §2.66. You must file the petition to revive no later than two (2) months from the mailing date of the notice of abandonment.

If you never received the notice of abandonment, and you have been diligent in prosecuting the application, you may file a petition within two (2) months from the date you became aware of the abandonment. To be considered diligent, you must have checked the status of the application every six (6) months from the filing date of the application. 37 C.F.R. §2.66(a) and 2.146(I).

3. Petition to the Director under Trademark Rule 2.146

Use this form to file a petition to the Director specifically pursuant to Trademark Rule 2.146. The petition must include a statement of the relevant facts and be accompanied by any relevant evidence as well as the required fee (\$100). When Facts are to be proved, the petitioner must submit proof in the form of an affidavit or declaration under 37 C.F.R. §2.20. See [TMEP §1702](#) for general information about when a 2.146 petition is appropriate, and [TMEP §1705 et seq.](#)

4:35 PM Local intranet 105%



Questions?

- Petitions paralegals and staff attorneys available at 571-272-8950
- Monday- Friday 9:00-5:00 p.m. EST

ASSIGNMENTS



Dawn Sanok
Attorney Advisor
Office of the Commissioner for
Trademarks



The Assignment Recordation Branch

- Not part of Trademark Operations per se--Supports both patents and trademarks.
- The Assignment Recordation Branch does not examine the substance of documents submitted for recording.
 - As long there is a completed cover sheet, fee and supporting document, the Assignment Recordation Branch will record it!
 - THE USPTO encourages electronic recordation through ETAS. Assignments filed electronically are recorded within 1-2 business days.
 - The USPTO determines the effect of the assignment when an *assignee* attempts to take an action in connection with an application or registration, e.g. when an assignee files a Statement of Use or Section 8 affidavit.



Ownership Updates

- Just because an assignment is recorded does not mean that the ownership records in the Trademark database i.e. TESS, TSDR will be updated with the new owner information
- There are situations when there will be an automatic update of ownership information and others in which it will not update. See TMEP Section 504.01.



Automatic Updates to TSDR - after November 3, 2003

- TSDR will automatically update with new owner information only when certain transfers are filed:
 - Assignment of entire interest
 - Merger
 - Nunc pro tunc assignment or
 - Name change

and

- The execution date of the document being recorded is later than the execution date of any other recorded document;
- Not recorded during a “blackout period”; and
- The maximum number of changes of ownership has not yet been reached (9 transfers prepublication and 9 after publication)



Black out period – No automatic updates

- (a) For §1(a) and §44 applications:
 - Between approval for publication and issuance of registration

- (b) For §1(b) applications:
 - Between approval for publication and issuance of notice of allowance; *and*
 - Between approval of the SOU and issuance of registration



No Automatic Assignment

- How to change the Trademark database
 - Applications:
 - The applicant should send a written request to the Office if they want the registration to issue in the new owner's name. See **TMEP 505.01**
 - Can use TEAS forms: Voluntary Amendment form (pre pub) or Post-Approval/Publication/Post-Notice of Allowance (NOA) Amendment form (after publication)
 - Registrations:
 - Post Registration does not enter new ownership information unless the new owner files a Section 7 request or if the request is made along with the filing of a Post Registration maintenance document. **TMEP Section 505.02.**



Locating assignment information

- TSDR now has a direct link to the Assignment database so you can easily see everything recorded against any property. Here you will also be able to see the most current ownership information.
- NOTE:
 - Even if an assignment is recorded that should automatically update ownership information (based on the criteria), it may take a week or so for the update to occur.
 - Similarly, even after recordation, it may take a week or so for the actual cover sheet and supporting document to be viewable.



Correcting Assignment Records

- Once a document is recorded with the Assignment Recordation Branch, the Assignment Branch will not remove the document from the record. See TMEP §503.06(e)
 - Typographical errors made by the USPTO will be corrected promptly and without charge upon written request directed to the Assignment Recordation Branch.
 - For any other error, the party recording the document is responsible for filing the documents and paying the recordation fees necessary to correct the error, using the procedures set forth in TMEP §503.06(a)- §503.06(d).
 - But note: If you know there was an error in your filing and the assignment has not been recorded you may be able to contact the Assignment Branch immediately to have the assignment paperwork not recorded—call 571-272-3350 from 8:30 a.m. – 5:00 p.m. EST.



An incorrect recordation against another's property

- In the situation in which another has recorded something against your client's property:
 - *See* <http://www.uspto.gov/trademarks/process/assign.jsp>
- Contact the third party and ask that they file a corrective assignment.
 - If this is not possible you have two choices:
 - File your own paperwork with the Assignment Branch explaining ownership, or
 - Send e-mail to TMFeedback if the error in the previous filing is an obvious typographical error



Automatic update caused ownership information error

- Applications or Registrations
 - Send a written request to the Office of the Commissioner for Trademarks
 - Can be faxed 571-273-8950 or can send an email to TMFeedback
 - If there was not a proper chain of title to the party currently listed as owner, we will put the records back to the last listed owner with proper title. See TMEP 504.03



Madrid Application Assignments

- The Assignment Branch will NOT record any assignments for “Madrid applications”—79 series/66(a) based applications. 15 USC §1141a.
- The World Intellectual Property Organization (WIPO) handles Madrid assignments. WIPO sends the information electronically to the USPTO and the Assignment Branch automatically uploads these “transfers” or “assignments” into its database.
 - The Madrid Processing Unit (MPU) updates ownership information.



Upcoming Enhancements to ETAS

- Ability to identify the order in which multiple assignments recorded the same day should appear in the Assignment database.
- The ability to file a “Merger and Change of Name” with one cover sheet, fee, and supporting document.
- The addition of new conveyance types that will allow for automatic update of ownership information.



Information on Assignments

- All enhancements and information on assignments can be found on our web site:
 - **News & Notices**- “Recent postings” will be updated when the enhancements to ETAS are implemented.
 - General information can be found on the Assignment page under Trademark Basics.



QUESTIONS

- Questions?

THANK YOU!



Dawn-marie.sanok@uspto.gov
571-272-9577

LETTERS OF PROTEST



Karen Strzyz

Attorney Advisor

Office of the Deputy Commissioner for
Trademark Examination Policy



BASICS

- Letters of Protest are not created by the Trademark Act or Regulations
- Bring facts relevant to the registrability of the mark to the attention of the Office
- Intent is to achieve this without causing unnecessary delay in the examination process or compromising the objectivity of the ex parte examination process
- See *In re BPJ Enterprises, Ltd.*, 7 USPQ2d 1375 (Comm'r Pats. 1988)



Standard for Pre-Pub Letter of Protest

- Letter of Protest is granted where evidence is relevant and supports any reasonable ground for refusal appropriate in ex parte examination
 - Examining attorney not required to issue refusal as a result of the grant
 - See TMEP §1715



Standard for Post-Pub Letter of Protest

- Granted only where evidence establishes a ***clear error*** on the part of the USPTO in not issuing the refusal
 - Examining attorney is required to issue the refusal



PROCEDURE

- Letter of Protest docketed in Commissioner's office
- Reviewed in order of receipt
- Turn around time approximately 30-45 days from filing



PROCEDURE

- Filed before publication
 - If granted
 - record updated to show Letter of Protest accepted
 - Examining attorney notified
 - If no refusal being issued, prosecution history updated "Letter of Protest Evidence Reviewed"
 - If denied
 - No evidence in file or prosecution history of existence of Letter of Protest



PROCEDURE

- Filed after publication
 - Must be filed within 30 days of publication (rare circumstances allow later filing if grounds did not exist before)
 - See *In re Pohn*, 3 USPQ2d 1700 (ComrPats 1987) and *In re BPJ Enterprises*, 7 USPQ2d 1375 (ComrPats 1988)
 - Time to file opposition not extended



PROCEDURE

- Letter filed after publication
 - If granted
 - record updated to show Letter of Protest accepted
 - Jurisdiction restored to Examining Attorney to issue a refusal
 - If denied
 - No evidence in file or prosecution history of existence of Letter of Protest



DISMISSAL

- Letter of Protest dismissed if:
 - Untimely
 - Issue raised by Examining Attorney and does not add useful evidence
 - May be granted if refusal is made and Protestor provides extensive evidence that the Examining Attorney may not have been able to obtain



SUBJECT MATTER

- Must relate to an issue that can be prosecuted to its legal conclusion by the Examining Attorney in the course of *ex parte* examination
 - fraud, prior use, actual evidence of confusion not relevant
- Should not be a substitute of protestor's judgment
- Usually relate to likelihood of confusion or descriptive/generic issues



PENDING LITIGATION

- Must involve a federally registered mark or prior pending application of the protestor
- Must be specifically identified
- Copy of the relevant pleadings must be enclosed
- Protestor must allege that there is a likelihood of confusion between this mark and the mark in the application that is the subject of the letter of protest



PENDING LITIGATION

- Remedy requested is cancellation, abandonment, or amendment of the protested application
- If granted
 - Copies of the relevant pleadings are placed in the record.



Request Copy Of Letter of Protest

- Any party can request a copy of a Letter of Protest
- If Letter of Protest materials are determined to be potential FOIA exemptions, request will be forward to USPTO Office of General Counsel



Recourse after a Denial

- Institute opposition proceeding at appropriate time
- No request for reconsideration of denial of Letter of Protest
- May file a petition to the Commissioner for review of the decision in the Letter of Protest under 37 CFR §2.146(a)(3)
 - Standard of review is clear error or abuse of discretion
 - No new evidence may be submitted with petition



STATISTICAL INFORMATION

	FY 2007	FY 2008	FY 2009*	FY 2010	FY 2011	FY 2012	FY 2013	FY 2014 Oct- Feb
Letters of Protest Filed	719	876	1011	1003	1238	1479	1518	671
Letters of Protest Granted	154	160	407	645	753	922	985	458

Fiscal Year – October 1 through September 30

*** November 2008 - standard of review changed for Letters of Protest filed before publication from “clear error” to “relevance”**



STATISTICAL INFORMATION

Pre-Publication			
	Filed	Accepted	Action taken by EA
FY 2013	1292	970 (75%)	388 (40%)
FY 2014 Oct-Feb	563	447 (79%)	191 (43%)



STATISTICAL INFORMATION

Post-Publication		
	Filed	Accepted
FY 2013	226	15 (6.5%)
FY 2014 Oct-Feb	108	11 (10%)



TIPS FOR FILING

- Always file online
 - Petition form #10
- Provide correspondence address
- Clearly identify refusal and/or requirement
- Do NOT send LOP twice
- Submit objective evidence relative to examination
 - Arguments will not be forwarded



TIPS FOR FILING

- Evidence in excess of 75 pages
 - Must include index
 - Do not identify protestor in index
- Submit registration or application numbers of protestor's application(s)/registration(s)
 - Copies of the registration certificates or printouts from USPTO database not needed
- Multiple registration/application serial nos.
 - Submit chart with no., mark and relevant goods/services



TIPS FOR FILING

- Prosecution history of protested application not necessary
- If the g/s are not identical objective third party evidence should be included
 - Post Pub – if no evidence is submitted it will be denied
- Website listings are not sufficient
 - Actual evidence is required



TIPS FOR FILING

- Third party registrations to show relatedness of g/s must be submitted
 - A listing of the registrations is not sufficient
- Separate letters of protest are required for multiple applications
- Evidence of fraud, prior use, actual evidence of confusion should not be included



QUESTIONS

- Further information on letters of protest can be found in Section 1715 of the *Trademark Manual of Examining Procedure* (TMEP).

THANK YOU!



karen.strzyz@uspto.gov
571-272-9419