

TRADEMARK LAW

A Trademark Two-fer: Trademark Office Metrics; Take-Aways and Tips for Trademark Practitioners

Navigating USPTO Practices and Procedures

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The Patent and Trademark Office in the United States has been around in one incarnation or another since July 4, 1836. For most of that time, the office was situated in Washington, D.C.

At present, the United States Patent and Trademark Office (“USPTO”) is headquartered in the James Madison Building on USPTO’s spacious campus consisting of eleven buildings in a city-like development surrounded by ground floor retail and high-rise residential buildings in Alexandria, Virginia. Additionally, there are also USPTO satellite offices in Detroit and Silicon Valley. The USPTO occupies several interconnected buildings in Alexandria, Virginia. The office employs more than 13,000 people -- including engineers, scientists, attorneys, analysts, computer specialists -- all dedicated to protecting U.S. intellectual property rights.

The current Director (since April 13, 2022) of USPTO is Kathi Vidal, formerly an Engineer and Intellectual Property lawyer, who concurrently serves as Under Secretary of Commerce for Intellectual Property (since April 19, 2022). She also was a former Law Clerk to the Hon. Alvin A. Schall, an appellate judge sitting on the Court of Appeals for the Federal Circuit. David S. Gooder is the Commissioner for Trademarks.

The legal predicate authorizing trademark law is the Commerce Clause in of Article I of the U.S. Constitution, which gives Congress to regulate trade.

The Congress shall have Power To lay and collect Taxes, Duties, Imposts and Excises, to pay the Debts and provide for the common Defence and general Welfare of the United States; but all Duties, Imposts and Excises shall be uniform throughout the United States;

To borrow Money on the credit of the United States; To regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes...”¹ (emphasis added)

A trademark is a word, name, symbol, device, or any combination thereof, that is used in trade with goods to indicate the source of the goods and to distinguish

them from the goods of others. A service mark is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product. The terms “trademark” and “mark” are commonly used to refer to both trademarks and service marks. Trademark rights can prevent others from using a confusingly similar mark, but not from making the same goods or from selling the same goods or services under a clearly different mark. Trademarks that are used in interstate or foreign commerce may be registered with the USPTO. The registration procedure for trademarks and general information concerning trademarks can be found at Trademark Basics (www.USPTO.gov)

In the U.S., trademarks are granted for a term of ten (10 years). They are thereafter subject to renewal, ad infinitum.

The USPTO examines applications for trademark registration, which can be filed under five different filing bases: use in commerce, intent to use, foreign application, foreign registration, or international registration. If approved, the trademarks are registered on either the Principal Register or the Supplemental Register, depending upon whether the mark meets the appropriate distinctiveness criteria. This federal system governs goods and services distributed via interstate commerce and operates alongside state level trademark registration systems.

Trademark applications have grown substantially in recent years, jumping from 296,490 new applications in 2000,² to 345,000 new applications in 2014, to 458,103 new applications in 2018.

Recent growth has been driven partially by growing numbers of trademark applications originating in China; trademark applications from China have grown more than 12-fold since 2013, and in 2017, one in every nine trademark applications reviewed by the U.S. Trademark Office originated in China.³

In 2020, trademark applications marked the sharpest declines and inclines in American history. During the spring, COVID-19 lockdowns led to reduced filings, which then increased in July 2020 to exceed the previous year. August 2020 was subsequently the highest month of trademark filings in the history of the U.S. Patent and Trademark Office.

The following historical USPTO figures were derived straight from the horse’s mouth, namely, the USPTO’s various Performance and Accountability Reports for FY2007 through FY 2022 (archived at www.USPTO.gov).

Back in 2007, there were 8,913 USPTO employees. Of those, 404 were Trademark Examining Attorneys (a/k/a Trademark Examiners). In total, there were

394,368 trademark filings.

By 2010, there were 9,507 USPTO employees. Of those, 378 were Trademark Examiners. The number of total trademark filings was 368,939.

By 2015, there were 12,667 USPTO employees. Of those, there were 456 Trademark Examiners. The number of total trademark filings was 503,889.

By the end of FY 2018, there were 12,579 employees, of which 579 were Trademark Examiners.

By 2020, there were 12,928 USPTO employees. Of those, 622 were Examiners. The number of total trademark filings was 738,112.

In 2021, there were 12,963 USPTO employees. Of those, 662 were Trademark Examiners. In all, there were 943,928 trademark filings.

More recently, in 2022, there were 13,103 USPTO employees. Of those, there were 718 Trademark Examiners. In total, there were 787,798 trademark filings.

The USPTO Trademark Examiners are reasonably compensated. As of December 10, 2023, the average annual pay for a Trademark Examiner in the United States is \$61,362 a year. Depending upon tenure, experience, skill level, and location, the range is from \$68,000 to \$107,000. The estimated total median pay for an Examiner (GS-12) at US Patent and Trademark Office is \$85,506 per year.

Trademark applicants encounter refusals from the United States Patent and Trademark Office (“USPTO”) based on a myriad of issues. Section 2(d) likelihood of confusion refusals and Section 2(e)(1) mere descriptiveness refusals or disclaimer requirements based on descriptiveness are commonly issued by the USPTO.

The Board consistently reminds us, for better or for worse, that each case must be decided on its own merits. But for those trying to read the tea leaves, it’s hard to discount the seemingly uphill battle of an appeal. The affirmance rates for the Examiners seem to be in the high 80% to low 90% range. Therefore, the Board’s affirmance rates, along with the pertinent facts of each case, should strongly be considered when deciding to file an appeal. Subsequent appeals are directed to the Federal Circuit, or a civil action in U.S. District may also be brought.

The publicly available data provided by the USPTO tells us quite a bit that can be useful to trademark practitioners. ⁴ The following statistics have been culled from that public information published by USPTO.

USPTO Inventory, Unexamined New Applications

Q4 (2023): 526,160
Compare with:
Q4 (2021): 333,100

Fiscal Year Application Filings

2023: 737,018
2022: 787,795
2021: 943,928
2020: 738,112

Application Filing Basis

Q4: 2023
Use: 40%
I/T/U: 45%
Compare with:
Q1: 2021
Use: 55%
I/T/U: 35%

Types of Applications

TEAS Plus: 381,747
TEAS Std: 285,513
Madrid: 69,758

First Action Pendency

Q4 (2023) First Action Pendency: 8.5 months
Compare with:
Q1 (2021) First Action Pendency: 4 months

Total Pendency of Applications:

Q4 Total Pendency: 14.6 months
Compare with:
Q1 2021 Total Pendency: 9.8 months

Pendency Including Suspended and Inter Partes Proceedings at TTAB

Q4 (2023): 15.9 months
Compare with:
Q1 (2012): 11.4 months

First Action Quality (Error Free Decisions)

Q4 (2021): 94%
Q4 (2023) 98.6%

Percentage of Applications Approved Upon First Action

Q4 (2023)
TEAS Plus: 40.5 %
TEAS Standard: 12.9 %
Madrid: 2.4 %
Paper: 34.2 %

Total Pendency by Filing Method (Months)

Q4 (2023)
TEAS Plus: 13.8 months
Teas Std: 15.5 months
Madrid: 15.7 months

Paper: 37.5 months

USPTO's Initial Processing of Statements of Use Submitted

Q4 (2023): 9 days
Compare with:
Q1 (2021): 15 days

USPTO Post-Renewal Pendency

Q4 (2023): 155 days
Compare with:
Q1 (2021): 48 days
Final Action Quality
Q4 (2023): 98.6%
Compare with:
Q (2021): 99%

Active Registrations

Q4 (2023): 3,151,009
Compare with:
Q1 (2021): More than 2.5 million

NEW REGISTRATIONS BY FY

2023: 414,043
2022: 453,588
2021: 434,810
2020: 400,298

USPTO Inventory, Pending Applications

Q4 (2023): 1,364,577
Compare with:
Q1 (2021): 1,036,765

Take-Aways and Tips for Trademark Practitioners Navigating USPTO Practices and Procedures

- Learn or confirm what kind of IP you are dealing with in the IP Identifier (Basic and Advanced). Coming soon! "Tips for managing your IP Assets." ⁵
- Review USPTO's "Online Trademark tools."
- ⁶For an overview on trademark basics, understanding the application process, preparing to file an application, filing an application moving through the application process, and keeping a registration alive, check out the Registration Toolkit. ⁷
- File TEAS PLUS Applications whenever possible.
- Do not file paper Applications.
- File I/T/U Applications whenever possible.
- Take advantage of USPTO's Practice Tips page ⁸
- Subscribe to receive Trademark Alert Emails from USPTO ⁹
- To access the proper place to conduct a trademark

search, refer to the USPTO's "Search our trademark database" page. ¹⁰

- For more information about applying for a trademark online, consult USPTO's "Apply online" website page. ¹¹
- Conduct (or commission) a proper search for trademark conflicts.
- Utilize the USPTO's trademark database which contains the records of all active and inactive trademark applications and registrations. ¹²
- Avoid applying for registration of merely descriptive marks.
- Avoid applying for registration of generic marks.
- Avoid applying for registration of commonly used phrases.
- Do not apply for registration of a mark which includes a living person's name unless you have their binding written consent.
- Do not apply for a mark that consists merely of a surname.
- File and submit your trademark applications and other application-related, and maintenance form (Statement of Use, Sections 8 and 15 Declarations, Sections 8 & 9 Declarations, etc.) through the Trademark Electronic Application System "TEAS". ¹³
- Check and view documents by virtue of the Trademark Status and Document Retrieval System ("TSDR"). ¹⁴
- For a searchable listing of the proper articulation of goods and services, refer to the Acceptable Identifications of Goods and Services Manual (a/k/a "Trademark ID Manual"). ¹⁵
- In order to search the trademark database for designs, use the Trademark Design Search Code Manual, wherein all figurative designs are assigned numerical codes for searching purposes. ¹⁶
- Your go-to resource for all the procedures and guidelines used by and referred to by the Trademark Examiners is The Trademark Manual of Examining Procedure ("TMEP"). ¹⁷
- Submit proper specimens (the correct type for goods or services, as appropriate) and that show use of the mark in commerce.
- Identify the proper party as the trademark proprietor.
- Correctly identify the goods or services involved.
- If expedited processing is necessary, think about a Petition to Make Special.
- Apply for the "genus" of goods unless you really need to start identifying "species" of goods within the genus.
- Do not combine multiple classes in applications.

- Do not file hybrid use/intent to use applications.
- For discussion of typical issues raised by Trademark Examiners in initial Office Actions, see USPTO's "Common problems in applications" page.¹⁸
- Take advantage, where applicable of TTAB Ex Partes Appeals.¹⁹
- Where applicable, take advantage of USPTO Inter Partes Opposition procedures.²⁰
- Where applicable, take advantage of USPTO Inter Partes Cancellation procedures.²¹
- Where necessary or desirable, take advantage of the optional three (3) month extensions (for a fee) to respond to an Office Action.
- For tips on responding to Examining Attorneys' decisions, refer to "Responding to Office Actions."²²
- When necessary or desirable, contact the Examining Attorney on an application file.
- When the Examining Attorney cannot be reached, or is not responsive, contact the Examining Attorney's Supervisor.
- After a preliminary approval by the Examiner, a mark is published in the USPTO's Trademark Official Gazette ("TMOG"), a weekly publication used to, among things, commence the mark's opposition period.²³
- It is possible, under certain circumstances, to revive an abandoned application.²⁴
- Rather than an ex parte appeal, file another Application.
- To order certified copies of documents from USPTO, refer to the Certified Copy Center.²⁵
- Regarding Letters of Protest, see USPTO's "Letter of protest practice tip" page.²⁶
- For general questions or technical assistance, contact the Trademark Assistance Center ("TAC")²⁷
- For all of your USPTO Contact Needs, check out the USPTO's Contact Trademarks page²⁸
- For information about the Trademark Trial and Appeal Board ("TTAB"), review the main website page for the TTAB.²⁹
- Research public information about trademark-related decisions and proceedings issued by or conducted under the authority of the Commissioner for Trademarks or the Director of the USPTO (i.e., Expungement/Reexamination Proceedings, Administrative Orders and Sanctions, and Precedential Director Decisions) in the Trademark Decisions and Proceedings search tool.³⁰

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of the Florida and New York Bars, has been practicing law for 43 years, and is rated AV Pre-Excellence® by Martindale Hubbell.® Attorney Cohen served as Judicial Law Clerk to the Honorable Harold J. Raby, United States Magistrate Judge for the Southern District of New York (1982-85). Ira also is a proud Member of the FBA's National Sections and Divisions Council, Secretary of the ADR Section of the FBA, Chair Emeritus of the FBA's Intellectual Property Law Section, Sustaining Member of the Federal Bar Association, Lifetime Fellow of the Foundation of FBA, FBA Moot Court Judge, Member of FBA Judicial Intern Academy, and an FBA Mentor. Ira can be reached at icohen@ictrade-marksandcopyrights.com

Endnotes

- ¹"The United States Constitution". The U.S. National Archives. January 2014. Retrieved Dec. 25, 2023.
- ²USPTO Annual Report FY2000, www.USPTO.gov Retrieved Dec. 24, 2023.
- ³Gershman, Jacob (2018-05-05). "Flood of Trademark Applications from China Alarms U.S. Officials". *Wall Street Journal*. ISSN 0099-9660. Retrieved 2019-01-14.
- ⁴See, generally, the USPTO Dashboard at www.uspto.gov/dashboard/trademarks for more recent and current information about USPTO's processing of U.S. trademark applications.
- ⁵<https://ipidentifier.uspto.gov/#/identifier/welcome>
- ⁶<https://www.uspto.gov/trademarks/basics/online-tools>
- ⁷<chrome-extension://efaidnbmnnnibpcajpcglclefindmkaj/https://www.uspto.gov/sites/default/files/documents/TM-Registration-Toolkit>
- ⁸<https://www.uspto.gov/trademarks/guides-manuals-resources/practice-tips>
- ⁹<https://www.uspto.gov/trademarks/trademark-updates-and-announcements/subscribing-trademark-alert-emails>
- ¹⁰<https://www.uspto.gov/trademarks/search>
- ¹¹<https://www.uspto.gov/trademarks/apply>
- ¹²<https://www.uspto.gov/trademarks/basics/online-tools>
- ¹³<https://www.uspto.gov/trademarks/apply>
- ¹⁴<https://tsdr.uspto.gov/>
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- ¹⁸<https://www.uspto.gov/trademarks/basics/common-problems>
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- ²⁰<https://www.uspto.gov/trademarks/trademark-trial-and-appeal-board/about-ttab>
- ²¹<https://www.uspto.gov/trademarks/trademark-trial-and-appeal-board/about-ttab>

In summary, the digital landscape is moving at a rapid pace. The evolving terrain of copyright law thus presents both challenges and opportunities. The need to adapt to technological advancements, while preserving the rights of creators, is paramount. Landmark cases have set new precedents that will shape future copyright law interpretations. Policymakers, legal professionals, and the creative industry are urged to collaborate in developing laws and policies that reflect the current digital environment. Finding a balance between copyright protection and public access is key. It is imperative that the future of copyright law continue to evolve with technology, necessitating ongoing dialogue and adjustment to ensure that it serves both creators, and the public, effectively.

Devin A. Albert is a J.D. Candidate (2024) at the Charleston School of Law, aspiring to serve the South Florida region upon his graduation in the spring. Having family in the South Florida area and being an avid fan of the Inter Miami Soccer team, he feels a strong connection to the vibrant community. Devin has experience working with a

variety of law firms, both large and small, providing assistance to businesses and creators at all stages of development and creation. Previously, Devin worked on the legal team for the beloved South Florida-based food chain, BurgerFi. Having grown up in a family of small business owners, creatives, and investors, Devin is deeply committed to empowering the risk-takers and visionaries of our communities. He is eagerly looking forward to applying his talents in the South Florida region.

Sources and Further Reading

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(Deadline, 2019) <https://deadline.com/2019/07/password-sharing-piracy-will-cost-streaming-companies-12-5b-by-2024-report-1202647160/>

(OpenAI, 2024) <https://openai.com/blog/openai-and-journalism>

Andy Warhol Foundation v. Lynn Goldsmith, (2023), web, https://www.supremecourt.gov/opinions/22pdf/f/21-869_87ad.pdf

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²²<https://www.uspto.gov/trademarks/maintain/responding-office-actions>

²³https://eog-tmng.uspto.gov/#issues=2023-12-26&pubReason=OPPOSITION&limit=20&orderBy=SERIAL_NR&view=review&subview=title

²⁴<https://www.uspto.gov/trademarks/trademark-trial-and-appeal-board/about-ttab> <https://www.uspto.gov/trademarks/apply/reviving-abandoned-application>

²⁵<https://certifiedcopycenter.uspto.gov/>

²⁶<https://www.uspto.gov/trademarks/trademark-updates-and-announcements/letter-protest-practice-tip>

²⁷<https://www.uspto.gov/learning-and-resources/support-centers/trademark-assistance-center>

²⁸<https://www.uspto.gov/trademarks/contact-trademarks>

²⁹<https://www.uspto.gov/trademarks/ttab>

³⁰<https://developer.uspto.gov/tm-decisions/search/ex-pungement>