

IP Alert: New USPTO Requirements Mandate a Valid Direct Owner Email Address; Privacy Concerns Raised

February 12, 2020

Also: Paper filings disallowed and trademark specimen requirements revised

The U.S. Patent and Trademark Office (USPTO) has released Trademark Examination Guide 1-20, which goes into effect on February 15. The Exam Guide implements the Office's final rule, published July 31, 2019, concerning mandatory electronic filing at the USPTO and other noteworthy changes. One change mandated by the new rule which is likely to have a significant impact on trademark owners, especially foreign companies, is 37 CFR §2.23(b), which states: Applicants, registrants, and parties to a proceeding must provide and maintain a valid email address for correspondence."

As of February 15, 2020, all formal correspondence concerning a trademark application or registration must be filed electronically via TEAS, the trademark electronic filing system, except in limited circumstances. The process for informal communications between practitioners and the USPTO remains unchanged. Unless one of the narrow exceptions for paper filing applies, paper submissions will not be processed. Should TEAS be unavailable on the date of filing deadline, the requirement to file electronically will be waived and filings via facsimile will be accepted without a petition or petition fee. There are other exceptions to the electronic filing rule that may be accepted by the USPTO upon filing a petition to the Director.

Notably, in order to receive a filing date, new applications filed on or after February 15, 2020 must include a direct email address for the applicant. If the applicant is represented by an attorney, the application must still also include the name, postal address, and email address of the attorney. In addition, applicants, registrants, and parties to a proceeding must maintain a valid email address that connects to a mailbox to which they have direct access and regularly review. Even if there is an appointed attorney, a separate email address for the applicant, registrant or party is required so that the USPTO can contact them if the representation ends.

Examples of acceptable applicant email addresses include: a personal email address, an email address created for the purpose of communication with the USPTO, a corporate email address, or in-house counsel's email address. Email addresses that cannot be used to directly contact the applicant or registrant include: an email address of US or foreign outside counsel, a designated email address to which all messages sent are automatically deleted and are never stored or reviewed (a "black hole email address"), or any other email address to which the applicant or registrant does not have direct access for monitoring.



The new email address requirement is likely to cause confusion for trademark owners who are not properly counseled. It also raises privacy concerns. While the email address of the applicant/registrant/party will not appear in the USPTO's Trademark Status and Document Retrieval (TSDR) "Status" tab, it will be viewable in the filed document in the TSDR "Documents" tab. It may not take long for email marketers and bad actors (e.g., perpetrators of confusing and fraudulent trademark notices and solicitations) to scrape and utilize these email addresses to directly contact owners who are represented by counsel. Such an outcome would run counter to the USPTO's and the Federal Trade Commission's longstanding efforts to combat this manner of fraud.

It does not appear to be necessary to affirmatively insert the registrant's email address into existing U.S. registrations that are not due for a maintenance or Declaration of Use filing. While this may be a technical violation of the rule to "maintain a valid email address for correspondence," the USPTO should have no interest in enforcing the rule to this degree. However, the registrant's email address will need to be provided for any new filings in association with the maintenance of existing U.S. registrations. Further, after registration, although the power of attorney has ended, the USPTO will not remove the attorney's information and will continue to send courtesy reminders for maintenance filings to only the attorney of record and/or the appointed domestic representative, until a change of correspondence or revocation and new power of attorney is submitted.

Madrid Protocol Extensions of Protection (EOP) technically should have the applicant's email address inserted into the USPTO record after the EOP is transmitted, but it appears this will not be enforced. The EOP without the applicant's email address will not be denied a filing date. If the EOP is approved by the USPTO with no Office Action, it does not appear the applicant's email address will be need to be provided. However, if the applicant needs to file any subsequent document to perfect the application and obtain a registration (e.g., a response to an Office Action), the email address of the applicant will need to be provided. For foreign applicants/registrants, it is recommended to also appoint a U.S. attorney as the domestic representative and, hence, correspondent, for applications and registrations.

Finally, the Exam Guide imposes new requirements for certain types of trademark specimens associated with use-in-commerce filings.

For more information, please contact a member of the Trademark team at Lathrop GPM.