

IP Alert: USPTO Implements Masking of Email Addresses of Trademark Owners Who Are Represented by Outside Counsel

April 28, 2020

The USPTO issued a "Trademark Alert" on April 24, indicating that it is now masking trademark owners' direct email addresses from being viewed on its public website. However, the masking applies only to the "owner" email address field in the online forms. The "correspondence" email address field will still be public. Therefore, while trademark owners who are represented by outside U.S. counsel (who use their law firm email addresses in the publicly accessible "correspondence" field) will benefit from this development, unrepresented owners, who must provide "correspondence" email addresses that can be viewed by the public, are still subject to potential abuse by bad actors.

Background

As we reported in a previous IP Alert, in January 2020, the USPTO released Trademark Examination Guide 1-20, with an effective date of February 15. The Exam Guide implemented mandatory electronic filing and a number of other noteworthy changes. A controversy immediately arose from a requirement that trademark owners provide and maintain a direct email address that is different from that of their named attorney or other correspondent. The fact that this email address would be publicly accessible on the USPTO's online Trademark Status and Document Retrieval (TSDR) "Documents" tab raised serious concerns that this exposed represented trademark owners to the increased risk of receiving spam, phishing and other fraudulent emails.

In an attempt to address the concerns, on February 14, 2020, the USPTO released a revised Exam Guide which eased some of strict rules surrounding the nature of the direct email address requirement. For example, the original requirements that the owner email address be one that is regularly accessed and reviewed by the trademark owner, and that it not be the email address of foreign counsel, were deleted. Trademark owners represented by outside counsel can provide "an email address of their choice" in the owner field of the electronic forms. This could be a general company email address such as "info@acmeco.com," or it could be any other address, including one that is created specifically for USPTO trademark filings, so long as it is not identical to the listed primary correspondence email address of the attorney.



As for owners who are not represented by outside counsel, it has always been the case that their direct "correspondent" email addresses were available to the public. The new USPTO policy announced last Friday does not change that.

In order to comply with USPTO requirements, Lathrop GPM's Trademark Team requests that trademark clients provide an email address to use with filings. If you would prefer an alternative, or would like more information, please let us know.

For more information, please contact Sheldon Klein or your regular Lathrop GPM contact.