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New USPTO Rule Makes Trademark Owner Email and Mailing Addresses Publicly Available; Imposes Stricter Rules for Specimens of Use

Effective Feb. 15, the U.S. Patent and Trademark Office (USPTO) implemented a series of rule changes, the biggest of which is the new mandatory requirement for electronic filing for all trademark submissions. Regardless of whether they are represented by counsel, trademark applicants, registrants and parties to a proceeding before the Trademark Trial and Appeal Board (TTAB) will be required to file trademark submissions electronically, provide an email address for receiving USPTO correspondence and provide a postal address to ensure the USPTO can contact them if the email correspondence fails. The USPTO's goal is to have faster processing of applicant/registrant submissions and fewer errors.

Electronic Filing and Email Addresses Required

Under the new rule, when filing a new electronic submission via the USPTO's Trademark Electronic Application System (TEAS), trademark owners will be required to provide an email address separate from that of their U.S. attorney, if an attorney is appointed. By requiring the owner's email address, however, the USPTO is making this information available to the public via the USPTO website, which increases the opportunities for spam and scams as well as the risk of this information being compromised.

In its initial version of the updated examination guide, the USPTO limited acceptable owner email addresses to those that would directly contact the trademark owner, such as a personal email address, an email address created for the purpose of communicating with the USPTO that is personally monitored by the trademark owner (e.g., USPTOcontact@applicantcompany.com), or an in-house counsel's email address for a corporation (or other legal entity) formed to own the trademark. After receiving numerous complaints, the USPTO issued a revised version of the guidelines on Feb. 14, specifying that trademark owners who are represented by an appointed attorney may provide "an email address of their choice in the owner email field of the TEAS forms." The email address cannot be identical to the listed primary correspondence email address of the applicant's or registrant's attorney. Trademark owners not represented by an attorney will need to provide only one email address (an identical email address for the owner and correspondence email address fields). The USPTO examination guide states that for both represented and unrepresented trademark owners, the owner email address can be "a unique email address created specifically for this purpose by the owner or their attorney." Due to the lack of clarity in the examination guide, it is possible that the USPTO again will amend the requirements. In the meantime,

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in order to avoid the associated privacy concerns, we do not recommend submitting a client's personal or business email address.

Applications filed or registrations issued prior to Feb. 15 are grandfathered in and are not subject to these email address requirements, but only up until the point that a new submission (e.g., a specimen of use or a renewal) is filed with the USPTO. At that time, the USPTO will require the applicant or registrant to update the email address of the owner and of the attorney, if one is appointed, in compliance with the new requirements.

Although it is possible for a trademark owner concerned about the impact of publicly available email addresses to file a petition to redact that information, the USPTO will allow redaction only in an extraordinary situation. The USPTO has not defined what is an extraordinary situation.

Mailing Addresses Required

In order to receive a filing date, an applicant must provide an accurate mailing address in addition to an email address when filing a trademark application. The mailing address also will be publicly accessible via the USPTO website, and at present, the USPTO is not accepting post office box or "care of" addresses as the address of an individual or an entity. This requirement has again raised privacy concerns, and the USPTO has not yet released guidelines on how it plans to address these concerns.

New Requirements for Specimen Submissions

Under the new rule, the USPTO also revised the requirements for specimen submissions, clarifying and limiting the scope of acceptable submissions. Notably, a tag or label submitted as a specimen for goods must be clearly affixed to the goods. Further, the tag or label should include informational matter that traditionally appears on a label for those types of goods, such as net weight, volume, UPC bar code, list of contents or ingredients, or other information

about the goods to clearly demonstrate actual use in commerce. The USPTO will continue to accept webpage submissions, but only if they include the URL and the access or print date.

Any submissions not complying with the new requirements implemented on Feb. 15 will be rejected by the USPTO.

We will continue to monitor the new USPTO requirements and advise of any further changes that arise.

Related Professionals

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