

[over one hundred] TRADEMARK PRACTITIONERS

By Federal Express 777733384068

Meryl Hershkowitz
Acting Commissioner for Trademarks
USPTO
600 Dulany Street
Alexandria, VA 22314

February 11, 2020

Dear Acting Commissioner Hershkowitz:

This letter is prompted by Examination Guide 1-20 entitled *Mandatory Electronic Filing and Specimen Requirements* which the Trademark Office published on February 6, 2020. As set forth in the Examination Guide, the Trademark Office plans to require each trademark applicant and each trademark registrant to establish and provide to the Trademark Office an email address that is “personally monitored” by the applicant or by the registrant, even when the applicant or registrant is represented by an attorney, and plans to publish such email addresses. The Guide, published on February 6, purports to take effect a mere nine days later on February 15, 2020.

Many of the signers of this letter are members of the e-Trademarks Listserv (see https://oppedahl-lists.com/mailman/listinfo/e-trademarks_oppedahl-lists.com), an online community of trademark practitioners. The signers of this letter have between them filed and/or prosecuted to registration [a number bigger than 87,000] trademark applications at the USPTO in the past ten years and have [a number bigger than sixty million dollars] in fees to the USPTO in the past ten years. Our goals in this letter are to help your office to more fully appreciate the great risks and harms that these plans will cause to applicants and registrants, to ask your office to take interim steps to reduce those risks and harms in the near term, and to amend these plans in the longer term to further reduce the risks and harms.

Some of the signers also question whether the changes set forth in the Examination Guide go beyond the final rules set forth at 84 FR 37081 and thus fail to comply with the Administrative

Procedure Act, and question whether the provisions of the Examination Guide comply with other applicable statutes and rules. This letter will not, however, attempt to address such issues, but is instead limited to the goals mentioned in the previous paragraph.

Here are the main points that follow:

- we hope to summarize salient aspects of what we understand to be the Office's stated plans for forced collection and publication of applicant email addresses;
- we hope to assist the Office in more fully appreciating the profound risks and harms that will predictably flow from those stated plans;
- we urge that nine days is an inadequate amount of time to permit meaningful dialogue between the Office and its practitioner community on this extremely important issue;
- we urge that the Office as an interim measure mask the applicant email addresses from public view and harvesting; and
- we point out that there are in fact very few fact patterns or events that would justify such invasive collection and publication of applicant email addresses.

The plans. The Guide will require each trademark applicant and each trademark registrant to establish and provide to the Trademark Office an email address that is "personally monitored" by the applicant or by the registrant, even when the applicant or registrant is represented by an attorney. As set forth in the Guide, the applicant or registrant is not permitted to filter the email through the applicant's or registrant's US counsel or foreign law firm, but is required to receive the email in an unfiltered and "directly accessed" way. As set forth in the Guide, this email address must be provided to the Trademark Office on the day that a trademark application is filed. As set forth in the Guide, the Trademark Office will publish this email address in a way that is readily available to all members of the public, capable of being harvested electronically in an automated way by data miners and scammers and spammers and spearfishers.

If one's business model were the harvesting of email addresses from government databases, so that one could sell or exploit the resulting mailing lists, it is impossible to think of anything more attractive than the opportunity to do data mining in a government system where the users are explicitly required to reveal the following:

- personal email addresses
- email addresses created for the purpose of communicating with the government in which a trademark owner promises to personally monitor the email address
- in-house counsel's email addresses
- corporate officer's individual email addresses
- partnership partner's individual email addresses
- holding company officer's individual email addresses

- juristic entity owner's email address where a trademark owner promises to personally monitor the email address

Such a government database would be an irresistible target for every scammer and spammer and spearphisher in the world. It would be a treasure trove. It is sad to say that this treasure trove is not merely some hypothetical or made-up possibility. The seven bullet points above were simply copied and pasted from the Examination Guide.

The signers of this letter wonder whether the Office fully appreciates that for many a trademark applicant, one of the chief reasons why the applicant hires an attorney in the first place is specifically to have a layer of protection against such email attacks and risks.

Regrettably, in the Examination Guide, the Trademark Office pays only lip service to protection of the interests of the applicant or registrant, listing only two supposed mechanisms of possible protection.

The first supposed mechanism of protection is that of the two places in TSDR where such information is revealed to the public (the "status" tab and the "documents" tab), the Office would omit the information only from the former. The latter, however, would according to the Guide remain fully available for data mining and harvesting. This is absolutely unacceptable. Unsaid is whether there may be other public-facing databases or APIs in which the information would also be available to data miners.

The second supposed mechanism of protection is that "a petition may be filed to redact the email address in the TSDR documents tab in an extraordinary situation. See TMEP §1708." Not one word of explanation is offered as to what standard would be applied by the Office in deciding whether or not the situation is "extraordinary". Unsaid is that such a petition requires paying \$100. It also appears that the sequence of events contemplated by the Office is that the applicant would be forced to reveal his or her personal email address and have it be published by the Office, and only later (if and when the petition is granted) would the email address be redacted. This is absolutely unacceptable. Related to this is that the TEAS petition form cannot be completed and filed until such time as a newly filed trademark application has been fully loaded into other Trademark Office systems, a process that takes several days. This means that it is impossible to file the redaction petition concurrently; it can only be filed some days after the filing of the trademark application itself. Given that we understand the TEAS application form will refuse to permit filing until the applicant email field has been filled, this appears to mean that the email address would already have been published and made available to data miners by the time the Office would have made it possible to file the redaction petition. This, too, is unacceptable.

For some categories of applicant, the stated plans of the Office will mean that every application will need to have a redaction petition filed. On a practical level, this would simply add \$100 to the cost of every trademark application for such applicants.

Other public-facing databases and APIs. The Examination Guide mentions only TSDR as a way in which data miners might harvest applicant personal email addresses from the filings

taking place after February 15, 2020. Any commitment by the Office to protect applicant private email addresses would, however, need to cover any and all public-facing databases and APIs that contain trademark data. One example is the *Trademark Image Search* API dated November 15, 2018. It seems to us that the guidance offered in the Examination Guide, namely the filing of “a petition ... to redact the email address in the TSDR documents tab”, would be a trap for the unwary and that in fact the well-crafted petition would need to request such relief as well in all other public-facing databases and APIs containing trademark information.

What does “third-party email addresses” mean? At page 8 of the Guide, this sentence appears:

Third-party email addresses can no longer be used as the primary email address for trademark correspondence.

Nowhere does the Guide say what “third-party email addresses” means. Experienced practitioners have tried to make sense of this sentence, arriving at any of several possible meanings. One possible meaning is that as of February 15, 2020, maybe the Office will not permit use of email addresses such as name@gmail.com or name@aol.com or name@yahoo.com. If so, then this change would have a profound and harmful effect on small businesses and individual applicants, many of whom do not have personal Internet domain names.

It is also not clear whether this sentence is setting forth a business process rule to be enforced by the Office staff during an examination process after filing, or is providing advance warning of a validation that the TEAS form will carry out before permitting the filer to move forward to a subsequent screen, or is purporting to establish a condition for a grant of a filing date.

Nine days is not enough. Nine days is not enough time for meaningful dialogue between the Office and the trademark filing community on such a serious matter as the collection and publication of applicant personal email addresses.

It is recalled that the Final Rule was published July 31, 2019. Nothing in that Final Rule, however, said that an applicant that had retained an attorney would be required to provide a personal email address to the Office, nor did anything in the Final Rule say that such a personal email address would be published. The scheduled effective date of the Final Rule was October 5, 2019. The effective date was then postponed to December 21, 2019. The Office gave an “educational purposes only” slide presentation on December 10, 2019 describing what might happen on December 21, 2019 including an applicant email address requirement, but nothing was said about such email addresses being published nor were requirements stated about what could or could not be used for such an email address. In any event before the scheduled December 21, 2019 launch date, the Office postponed the effective date yet again, so it was not clear whether or not the provisions of the December 10, 2019 slide presentation would still apply. The first time that the Office said anything about requirements about what could or could not be used for an applicant email address, and that such an email address would be published, was in the Examination Guide released late in the day on February 6, 2020. The proposed effective date of February 15, 2020 must be postponed to permit meaningful dialogue.

Masking. At an absolute minimum, and as an interim protective measure until longer-term corrective measures are taken regarding these plans of the Office, it is absolutely necessary that the Office mask the email addresses of applicants in all public-facing databases including but not limited to TSDR.

It should be very nearly cost-free and quick for the Office to provide such masking. It will be recalled the Trademark Office already masks IP addresses and attorney bar information.

Here is an example of IP address masking. As can be seen, the TEAS system replaces the characters of the applicant’s IP address with repetitions of the letter “X”.

Declaration Signature

Signature: /Heather Hodovance/ Date: 01/01/2020
 Signatory's Name: Heather Hodovance
 Signatory's Position: President
 Payment Sale Number: 88745468
 Payment Accounting Date: 01/02/2020
 Serial Number: 88745468
 Internet Transmission Date: Thu Jan 02 20:25:19 EST 2020
 TEAS Stamp: USPTO/BAS-XX.XX.XXX.XX-20200102202519465
 677-88745468-700326073da5177c06d234e52c1
 8b60e919431ce89633a347a8b7db2b1b43c04f25
 -CC-25187689-20191231140147165875

Here is an example of masking of attorney bar information.

The signers of this letter do not mean to suggest that with such masking, it would be otherwise acceptable for the Trademark Office to force trademark applicants to reveal their personal email addresses. But at least as

ATTORNEY INFORMATION	
NAME	Nyall Engfield
ATTORNEY DOCKET NUMBER	T-0322-LTX
ATTORNEY BAR MEMBERSHIP NUMBER	XXX
YEAR OF ADMISSION	XXXX
U.S. STATE/ COMMONWEALTH/ TERRITORY	XX
STREET	16950 Via de Santa Fe, 5060-107
CITY	Rancho Santa Fe
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	92067

an interim protective measure until the Trademark Office discontinues such forced revelation of personal email addresses, the masking requested here would likely be a great help toward reducing the risks and harms visited upon applicants.

The bigger and longer-term question. We turn now to the bigger and longer-term question which is what the supposedly enormous problem is for which invasive collection and publication of applicant personal email addresses is supposedly the solution. What the Office seems to have failed to do is any effort to balance needs and harms.

So far as harms are concerned, it is very predictable that the plans as set forth by the Trademark Office will expose hundreds of thousands of trademark applicants per year to great risk of harm due to the unlimited harvesting of their email addresses. If some profound benefit were to accrue

to the Trademark Office that somehow justified this great harm, one hopes that this benefit would be evident from the Examination Guide. Such is not, however, the case.

What exactly are the situations where supposedly there is a burning need for the Trademark Office to have collected an email address from the applicant even at a time when the applicant is known to be represented by an attorney? The Examination Guide enumerates at page 7 three conceivable events in which it would supposedly have been helpful to have collected an applicant email address in advance:

1. The party files a revocation of attorney;
2. the designated attorney is suspended or excluded from practicing in trademark matters;
or
3. recognition as the designated representative ends pursuant to 37 CFR § 2.17(g).

These three events differ greatly from one to the next in terms of how often they arise, in terms of whether there is or is not some alternative way for the Office to get in touch with the applicant when the event happens, and in terms of the extent to which the event even represents a problem for which a solution is needed. Because the three events differ so greatly, they deserve at least a brief individual discussion. The third event actually expands into seven distinct sub-events which we will number 3-1 through 3-7, each of which needs a bit of individual discussion.

1. *The party files a revocation of a power of attorney.* In a case where an applicant or registrant was heretofore represented by an attorney, of course this means that heretofore the Office directed its outgoing correspondence to the email address of the attorney. At such time as the applicant goes to the TEAS system to file a revocation at the Trademark Office, we appreciate that this means the Office needs to know what email address to use henceforth for outgoing correspondence.

Surely it is not lost on the Office that *the TEAS form itself* can be used as the way to learn from the applicant what email address the Office should use henceforth. It should also not be lost on the Office that in many cases, the event is not merely a revocation of a power of attorney but is also a grant of a new power of attorney. In such cases, not only did it not matter before what the email address of the applicant was prior to the revocation, but it also will not matter henceforth what the email address of the applicant is after the new power of attorney takes effect. What matters is the email address of the new attorney. If a new attorney is not taking over representation, the applicant can provide its direct email address at the time it files the revocation and becomes a *pro se* applicant/registrant.

2. *The designated attorney is suspended or excluded from practicing in trademark matters.* Such suspensions and exclusions happen very rarely – only at most a few dozen times per year, but we acknowledge that we cannot claim to know the Office’s expectations for how often this might occur in the future. On the other side of the balance, the predictable harms and risks caused by publishing the personal email addresses of trademark applicants happen hundreds of thousands of times per year. It is not reasonable to impose profound risks and harms upon the

entire corpus of trademark applicants every year, just to save a little bit of work for Office personnel when the Office needs to get in touch with a handful of applicants in the handful of suspensions and exclusions that happen per year.

Regardless of whether such a suspension or exclusion were to happen rarely or more frequently, it should be recognized that if, as mentioned above, the Office were to mask the applicant's email address in the TSDR system, then when a suspension or exclusion occurs, the Office personnel could look at the (unmasked) original record to obtain the applicant's email address to take further action.

3. Recognition as the designated representative ends pursuant to 37 CFR § 2.17(g). What we are talking about here are several distinct events, each of which needs its own distinct analysis, as follows.

3-1. The Office considers recognition as to a pending application to end when the mark registers. Marks register hundreds of thousands of times per year. What exactly is the problem, relating to a registered mark, for which a forced collection and publication of the applicant's email address is the solution? The Examination Guide does not explain. For the signers of this letter, the only legitimate need that the signers can think of is that the applicant might wish its email address to be among the several email addresses to which the Office might send a courtesy reminder at renewal time, five years hence, and, as discussed below, in connection with the filing of a cancellation petition. If so, then let this be voluntary on the part of the applicant, not required.

3-2. The Office considers recognition as to a pending application to end when ownership changes. Some common sense needs to be applied to this fact pattern. If ownership has changed, then this means that somehow the Office learned that ownership changed. Someone somewhere communicated something (electronically) to the Trademark Office that somehow tipped off the Office that the ownership has changed. This tells the Office that the (former) attorney is no longer the attorney.

But, importantly, this also means that the email address that the Office extracted from the (previous) applicant is no longer the email address of the applicant. It does not help at all that the Office collected that email address because it is an email address of an entity that is (by definition) no longer connected with the pending application.

When ownership changes, yes it is acknowledged that the Office may well feel the need to have some confidence that it can get in touch with the new owner. But no amount of having previously extracted an email address from the old owner will be of any help with this need. Instead, the burden is on the Office to figure out how to obtain a fresh email address from whoever it is that communicated the event of the ownership change to the Office.

3-3. The Office considers recognition as to a pending application to end when the application is abandoned. If an application is abandoned, then there is no more need for the Office to send

out communications. So this event is not an event for which it was important that the Office previously extracted an email address from the applicant.

3-4. The Office considers recognition obtained after registration to end when the mark is cancelled or expired. If a registration is cancelled or expired, then there is no more need for the Office to send out communications. So this event is not an event for which it was important that the Office previously extracted an email address from the registrant.

3-5. The Office considers recognition obtained after registration to end when ownership changes. Just as with an ownership change for a pending application, it is important to apply common sense to this fact pattern. If ownership of a registration has changed, then this means that somehow *the Office learned that ownership of the registration changed*. Someone somewhere communicated something (electronically) to the Trademark Office that somehow tipped off the Office that the ownership of the registration has changed. This tells the Office that the attorney is no longer the attorney.

But, importantly, this also means that the email address that the Office extracted from the (previous) registrant is no longer the email address of the registrant. It does not help at all that the Office collected that email address because it is an email address of an entity that is (by definition) no longer connected with the registration.

When ownership changes, yes it is acknowledged that the Office may well feel the need to have some confidence that it can get in touch with the new owner. But no amount of having previously extracted an email address from the old owner will be of any help with this need. Instead, the burden is on the Office to figure out how to obtain a fresh email address from whoever it is that communicated the event of the ownership change to the Office.

3-6. If a practitioner was recognized as the representative in connection with [a renewal], recognition is deemed to end upon acceptance of the [renewal] filing. Registrations get renewed hundreds of thousands of times per year. What exactly is the problem, relating to a successful renewal, for which a forced collection and publication of the registrant's email address is the solution? The Examination Guide does not explain. For the signers of this letter, the only legitimate need that the signers can think of is that the registrant might wish its email address to be among the several email addresses to which the Office might send a courtesy reminder at the next renewal time, perhaps four years hence or ten years hence, and, as discussed below, in connection with the filing of a cancellation petition. If so, then let this be voluntary on the part of the registrant, not required.

3-7. If a practitioner was recognized as the representative in connection with [a renewal], recognition is deemed to end upon final rejection of the [renewal] filing. If a renewal filing is finally rejected, then there is no more need for the Office to send out communications. So this event is not an event for which it was important that the Office previously extracted an email address from the registrant.

Petitions to cancel. From the above discussion it will be appreciated that the Examination Guide does not actually enumerate any fact pattern or event in which some benefit to the Office can be identified that somehow justifies the enormous risks and harms to the corpus of applicants that will predictably flow from the planned collection and publication of applicant personal email addresses. Having said this, it seems to us there is one event which, although never mentioned in the Examination Guide, might benefit from some thought regarding collection of email addresses, namely the filing of a Petition to Cancel at the Trademark Trial and Appeal Board. Every time a new cancellation proceeding gets filed, it falls upon Board personnel to try to figure out how to effect service. This requires what may be charitably characterized as a “treasure hunt” through the TSDR records, collecting such email addresses may be found there, in case one or another of the email addresses may succeed in reaching the real party in interest. At least two comments may be made about this.

First, to the extent that the Office imposes newer and stronger requirements that applicants and registrants reveal personal email addresses to the Office, we acknowledge that this has the possibility of making the “treasure hunt” more rewarding for Board personnel, and has the possibility of reducing how often the commencement of a cancellation proceeding becomes needlessly complicated due to difficulties in effecting service. Having said this, there is no reason why such personal email addresses need to be published in TSDR or in any other public-facing databases. And the plain fact is, this could still be left as a voluntary matter for the individual registrant as to whether the registrant does or does not wish to reveal a personal email address so as to improve the chances of being notified about the filing of a cancellation petition.

Applying common sense. At page 7 of the Guide, the following sentence appears:

If the email transmission fails for any reason, the USPTO will not attempt to contact the correspondent by any other means.

It seems to us that this policy has a risk of appearing to be a bit mean-spirited. Common sense tells us that from time to time an email address will have changed, or will have stopped working temporarily, or will have stopped working permanently, or will turn out to have been mistyped at the time of filing, or will for some other reason not serve to permit the Office to get in touch with the applicant. This may be an applicant that is completely innocent of any wrongdoing but merely has the misfortune to have been represented by an attorney that just got suspended or excluded from practice. Thus no matter how demanding the Office chooses to be about forcing applicants to reveal email addresses, it is just a fact of life that from time to time the Office will still on rare occasion have to resort to such a desperate measure as writing a letter to the applicant, or picking up the telephone and placing a telephone call to the applicant. On even a more rare occasion, the Office might have to look up the applicant in a search engine to find the applicant’s new contact information. No amount of invasive data collection by the Office will eliminate completely the fact that every now and then the Office will need to use some other communications channel to reach an applicant.

That sentence also ignores that the Trademark Office actually does use “other means” in nearly every trademark application, namely when it mails out a physical original trademark registration certificate or a Certificate of Correction. No matter how much the Office tries to shift to email communications and away from paper communications, there is be the need to mail out physical registration certificates and physical Certificates of Correction. As such, the Office has no choice but to recognize that the “mailing address” field in its databases means something now and will always mean something. In the interests of justice, the Office might on rare occasions feel the need to mail a letter, for example, to the same mailing address that the Office would use to mail a registration certificate of a Certificate of Correction.

Summarizing. We hope that we have helped the Office to appreciate several things:

- the Office’s stated plans regarding collection and publication of applicant private email addresses will very predictably cause great risks and harms to the entire corpus of trademark applicants;
- as an interim measure applicant email addresses absolutely must be masked from public view and harvesting not only in TSDR but also in all other public-facing databases and APIs; and
- there are in fact very few fact patterns or events that would justify such invasive collection and publication of applicant email addresses.

We thank you for your consideration and cooperation.

Respectfully,

[signature block to be inserted, at this point over one hundred names]