



United States Patent and Trademark Office

Office of the Commissioner for Trademarks

February 28, 2020

Dear Trademark Practitioners,

Thank you all for your letter regarding the United States Patent and Trademark Office (USPTO) final rule on Mandatory Electronic Filing and the requirement to provide the owner's email address. As you are aware, on February 14, 2020, the USPTO clarified its guidance concerning implementation of the rule to make clear that trademark owners who are represented by counsel may provide an email address of their choice in the owner email field of trademark filings, so long as the owner is able to receive emails the USPTO sends to the address if representation ends. I believe this clarification addresses the primary concerns expressed in your letter, but I wanted to provide some further background on the USPTO's collection and publication of information concerning trademark filings and the rulemaking process that culminated in the Mandatory Electronic Filing rule.

The federal trademark register provides the public with notice of trademark rights. To facilitate the notice function of the register, the USPTO's rules have always required that information about pending applications, including the name and address of the applicant, be made available to the public. We make sure to communicate to prospective applicants, not only in our rules and guidance documents, but also on a dedicated webpage, that we make information and documents concerning trademark filings publicly available. The United States also has treaty obligations to forward applicant contact information to the World Intellectual Property Organization (WIPO) when an international application under the Protocol to the Madrid System for the International Registration of Marks is filed with the USPTO as the office of origin where that information is published in the International Register.

The USPTO recognizes that publicly available trademark owner information can create openings for bad actors to take advantage of the USPTO and our customers. That is why the USPTO has been omitting owner email addresses in the TSDR status tab, a frequently mined data field, for a few years. That practice continues with the new rule in effect.

The recent Mandatory Electronic Filing rulemaking provided the opportunity for the USPTO to again consider (with the public's input) how best to balance the USPTO's role as a public registry of trademark rights against a trademark owner's privacy concerns. Mandating end-to-end electronic communications for all applicants and registrants appears to be an unprecedented undertaking among global trademark offices. A mandatory electronic filing environment requires 100% electronic communications. To accomplish this and achieve the efficiencies and

accuracy that such an environment creates, the USPTO must collect an email address at the time of filing where the owner can and will receive electronic mail in the event that the owner is unrepresented or becomes unrepresented at some point. The USPTO will not mail correspondence to a postal address when we do not have a valid email address for the owner.

The rule does not distinguish between owners who are represented and those who are not because owners who are represented will need to know whether a filing or response is due if representation ends. Many owners have previously relied on their representative's contact information to receive communications from the USPTO. However, the USPTO has experienced that once representation ends, the lawyer or law firm does not wish to be an intermediary for communications between the USPTO and a former client. Also, if the lawyer withdraws from representing the owner or is disciplined and no longer authorized to represent the owner, the USPTO needs to be able to send communications to the owner at a valid email address where the owner will be able to receive and review them. If representation ends without a valid owner email address, the owner will no longer receive communications from the USPTO and runs the risk that their application or registration will abandon or expire.

We understand that practitioners have questions about what email address may be provided for the owner. In direct response to public feedback received prior to implementation of the Mandatory Electronic Filing rule (including your letter), the USPTO clarified its guidance to make clear that trademark owners who are represented by counsel may decide, with their attorney, what email address is appropriate for the purpose described above and may provide an email address of their choice in the trademark owner email field of trademark filings. The rule anticipates that the owner's email address be for the owner to receive USPTO communications and it can be an address created specifically for receiving USPTO communications. For represented trademark owners, the USPTO will accept any email address, foreign or domestic, which permits the owner to receive USPTO email after representation ends. The USPTO generally will not inquire as to the validity of an owner's email address unless, for example, it is identical to the email address of the owner's attorney or the same address is used across multiple individual owners to engage in the unauthorized practice of law. To reduce unwanted communications from parties other than the USPTO, the owner may consider including filters that only allow receipt of email from uspto.gov accounts.

In addition to the legal framework leading to the Mandatory Electronic Filing rule, it is also worth noting that the owner email address requirement was part of a rulemaking process that began more than 18 months ago, and involved significant public input and outreach. The process began on May 30, 2018, when the USPTO published a notice of proposed rulemaking (NPRM) proposing certain changes to USPTO trademark regulations that would (1) mandate electronic filing of trademark applications and submissions associated with trademark applications and

registrations and (2) require the designation of email addresses for applicants and (if relevant) their representatives.

The NPRM explained that, in connection with the proposed requirement for electronic filing, the USPTO also proposed to require email addresses for applicants, registrants, parties to a proceeding, and (where relevant) qualified practitioners representing the applicants in order to ensure that the Office could communicate electronically with trademark owners and their representatives. The USPTO provided a 60-day comment period for this proposed rule in order to provide the public sufficient time to consider the proposed changes and provide comment to the Office.

Following the public comment period and careful consideration of the public feedback, the USPTO published a final rule on July 31, 2019, implementing changes to the regulations to mandate electronic filing in most instances, requiring that applicants and registrants provide a valid email address for themselves and any appointed practitioner for receipt of correspondence from the USPTO. At the time of such publication, the rule was set to become effective on October 5, 2019.

Prior to October 5th, in response to feedback from the public seeking additional time to comply with the rule's requirements and the essential need for additional IT upgrades at the USPTO, the Office delayed the effective date of the rule, first to December 21, 2019, and then to February 15, 2020.

Prior to the effective date of the rule, the USPTO undertook diligent efforts to inform the public about the new requirements to file electronically and to provide a valid email address for themselves and any appointed practitioner for receipt of correspondence. For example, on December 10, 2019, the USPTO conducted a webinar concerning this rule, which included a question-and-answer session. Various educational materials concerning implementation of the rule were also made available on a page on USPTO's website concerning Mandatory Electronic Filing.

In the week prior to implementation of the rule, the USPTO received feedback from some members of the public (including your letter), expressing concerns that the email addresses required under the rule (as first proposed in May 2018) may cause some applicants and registrants to make public email addresses they wish to keep private. In particular, concerns were expressed that the collection of email address of applicants and registrants, and their inclusion in the public trademark files (consistent with the generally public nature of trademark documents) might create the risk of those parties receiving emails containing fraudulent solicitations or spam. In response to those concerns, as described above, the USPTO clarified its guidance to make clear that trademark owners who are represented by counsel may provide an email address of their choice in the "trademark owner" email field of trademark filings, but

consistent with the final rule, the address must be one where the owner will receive USPTO communications when representation ends. The USPTO continues to assess its electronic systems and procedures to determine where improvements may be needed to address concerns raised by the public and our stakeholders, including with respect to owner email addresses.

We hope this response addresses the concerns raised in your letter and helps explain why the USPTO proposed the requirements for mandatory electronic filing and then implemented them. We appreciate your feedback, and always welcome input from stakeholders as we consider potential improvements to USPTO's trademark procedures.

Sincerely,


Meryl Hershkowitz

Acting Commissioner for Trademarks
United States Patent and Trademark Office