



United States Patent and Trademark Office

Office of the Commissioner for Trademarks

February 28, 2020

Barbara A. Fiacco
President
American Intellectual Property Law Association

Dear President Fiacco:

Thank you to you and your colleagues at AIPLA 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. The Mandatory Electronic Filing rule requires trademark owners to provide their email address at filing so that the USPTO can be assured that we are able to communicate electronically with 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 and when representation ends. Many represented 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 often 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 must be able to send communications to the owner at a valid email address where the owner will be able to receive and review them.

In direct response to public feedback received prior to implementation of the Mandatory Electronic Filing rule, 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. It can be an address created specifically for receiving USPTO communications, and could even include filters that only allow receipt of email from uspto.gov accounts. 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.

With regard to post registration communications, the USPTO's use of the attorney email is not limited to reminders for filing Section 8 or Section 71 affidavits. The USPTO will continue to send all communications regarding post registration submissions to the attorney correspondence email of record until that address is removed from the database. However, note that for post registration proceedings at the Trademark Trial and Appeal Board, an attorney email address that dates back to the application, to the filing of an assignment, or a registration maintenance document, will only be used if the owner cannot be reached. In such cases, the attorney email may be used by the USPTO to ask for current contact information for the trademark owner.

We hope this response addresses the concerns raised in your letter. We appreciate your feedback and always welcome input from stakeholders as we consider potential improvements to USPTO's trademark procedures.

Sincerely,

A handwritten signature in black ink, appearing to read "Meryl Hershkowitz", with a stylized flourish extending to the right.

Meryl Hershkowitz

Acting Commissioner for Trademarks
United States Patent and Trademark Office