



American Intellectual Property Law Association

February 26, 2020

The Honorable Meryl Hershkowitz
Acting Commissioner for Trademarks
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via Email: TMpolicy@uspto.gov

RE: Urgent Request for Clarification - Updated Examination Guide for Mandatory Electronic Filing of Trademark Applications issued on February 14, 2020

Dear Commissioner Hershkowitz:

The American Intellectual Law Association (AIPLA) has reviewed and discussed the revised Examination Guide issued by the USPTO on February 14, 2020, which relates to the mandatory electronic filing rule for trademark applications. AIPLA appreciates the revisions made in this Examination Guide and the guidance that the document provides. However, the revised guidance regarding the submission of an acceptable email address for a trademark owner who is represented by counsel is subject to various interpretations, leading to significant uncertainty for our members.

Founded in 1897, AIPLA is a national bar association of approximately 12,000 members engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA urgently requests that the USPTO provide responses to the following questions as soon as possible:

- (1) In connection with this requirement, if a trademark owner does not want to provide a company or personal email address to satisfy this requirement, can the owner choose to provide an email address of the owner's attorney or the attorney's law firm, as long as this email address is not identical to the primary correspondence email address of the owner's attorney?
- (2) If the answer to Question (1) above is "yes," can the same provided attorney or law firm email address be used to satisfy this requirement by different trademark owners? In other

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words, if a law firm sets up a single email address for the sole purpose of receiving emails from the USPTO on behalf of any of a multiplicity of clients who choose to use this email address as their email address, is this acceptable?

(3) If the answers to Questions (1) and (2) above are “yes,” is it acceptable for emails sent to either law firm-provided email address to be received in a single inbox?

(4) If a trademark owner who is represented by a non-U.S. representative such as a non-U.S. trademark firm (which, in turn, communicates with U.S. counsel) does not want to provide a company or personal email address to satisfy the owner email address requirement, can the trademark owner choose to provide its non-U.S. representative’s email address as the trademark owner’s email address?

(5) If a U.S. attorney receives last-day instructions from a client to file a new U.S. application, based on a last-day priority deadline or some other business circumstance calling for a same-day filing date, but cannot confirm (in that same day) the client’s email of choice for the application, please confirm that designating any valid client email address for correspondence is acceptable and all that is needed to receive a filing date and comply with the rule.

(6) The revised Examination Guide states that “even after registration, although the power of attorney has ended, the USPTO will not remove the attorney’s information and will continue to include the attorney email for courtesy reminders to file a Section 8 or Section 71 affidavit...” Why is inclusion of the attorney email limited to reminders for filing a Section 8 or Section 71 affidavit? Can the USPTO include the attorney email for copies of any post-registration notice for which the attorney email address remains of record?

A prompt response to these questions is critical to our members, as many are waiting (to the extent possible) for the Office’s response in order to proceed with filings.

We thank you for the opportunity to pose these questions. AIPLA supports the USPTO’s efforts to improve the IP system, and looks forward to an opportunity to further discuss this important subject.

Sincerely,



Barbara A. Fiacco
President

American Intellectual Property Law Association