ONE HUNDRED ELEVEN TRADEMARK APPLICANTS AND PRACTITIONERS

By USPS 9405503699300260225228

David S. Gooder
Commissioner for Trademarks
U.S. Patent and Trademark Office
P O Box 1451
Alexandria, VA 22313

May 27, 2022

Dear Commissioner Gooder:

We write to you as trademark applicants, as trademark practitioners, and as concerned members of society, to ask that you cease your requirement (dating from July 2, 2019) that trademark applicants divulge to your Office where they sleep at night. Although this "where you sleep at night" requirement has been a matter of concern to many of us for many reasons ever since it was imposed in 2019, a recent event prompts us to be even more concerned, and it is the recent event that triggers this letter.

Many of the signers of this letter are members of the e-Trademarks Listserv, an online community of over one thousand trademark practitioners. The signers of this letter, either directly or through their firms or corporations, have more than **one hundred thousand** US trademark applications and registrations under management. The signers of this letter, either directly or through their firms or corporations, have between them paid more than **two hundred million dollars** in fees to the USPTO in the past ten years. Some of the signers of this letter are among the one hundred ninety-nine trademark practitioners who signed a letter dated February 11, 2020 to your predecessor, Acting Director Meryl Hershkowitz, which letter is mentioned below.

The recent event triggering this letter is that three days ago, your Office published the private email addresses of 20837 trademark applicants. This came despite your Office having assured the Trademark Public Advisory Committee on April 21, 2020 that you would:

> mask the [applicant] email address field in TEAS and TEASi documents viewable in TSDR. This includes submissions viewable in the documents tab, all application programming interfaces (APIs), and PDF downloads.

Just as your Office promised to protect the privacy of the email addresses of trademark applicants, your Office has also offered assurances that the "where you sleep at night" addresses which trademark applicants reveal to your Office will likewise be protected. Giving your Office the benefit of the doubt, we imagine that the publication of the private email addresses of 20837 trademark applicants by your office three days ago (on May 24, 2022) was inadvertent, perhaps due to some oversight or mistake by a computer programmer. We are, however, gravely

concerned that it is only a matter of time before some similar oversight or mistake will lead to a similar publication of the "where you sleep at night" addresses of trademark applicants.

If there were actually some good and important reason why your Office needs to force some trademark applicants to reveal their "where you sleep at night" addresses, then your Office and the trademark community could engage in some dialogue about which applicants ought to be forced to do this, and about how and where the information would be stored, who would have access to the information, and where the information would routinely get transmitted. But your Office has never articulated a good or important reason for such a requirement, nor has your Office offered meaningful assurances as to the ways that such information might or might not get protected against, for example, FOIA requests or access by USPTO personnel or USPTO contractor personnel.

Some background will help to communicate how this issue appears to us. As a point of reference, your Office justifies its inquisitiveness into "where you sleep at night" by a strained interpretation of the statutory term "domicile". On the patent side of the USPTO, the statutory term "domicile" gets interpreted no more invasively than to require an inventor to reveal the city and state where the inventor resides. The USPTO has never required an inventor to reveal "where he or she sleeps at night". Each inventor is required to provide an address where the inventor can receive postal mail, but the mailing address is not linked to the "domicile" address. One of us (Carl Oppedahl) is a named inventor on nine granted US patents, and has never had to reveal to the USPTO where he sleeps at night as a precondition to obtaining patent protection in any of the nine underlying patent applications.

Turning from the patent side of the USPTO to the trademark side, what must be recognized is that during the first hundred years that the USPTO had a trademark application process, the Trademark Office interpreted the statutory term "domicile" no more invasively than did the Patent Office. The Trademark Office required little more than disclosure of the applicant's citizenship and a postal address. It was only after some ten decades of receiving and examining trademark applications, and granting trademark registrations, that seemingly "out of the blue" the Acting Commissioner for Trademarks arrived at an interpretation of the statutory term "domicile" that somehow supposedly called for revelation by the trademark applicant of the place where the trademark applicant sleeps at night, with specificity all the way down to the exact street address. Something happened in the summer of 2019 that prompted the Acting Commissioner for Trademarks to interpret the statutory term "domicile" very differently than it had been interpreted during the previous century of trademark examination.

To the limited extent that some policy justification was offered for this striking inquiry into the private life of the trademark applicant, the Acting Commissioner explained in 2019 the supposed policy justification as follows:

- There were in recent times a large number of trademark filings of questionable veracity and quality ("suspect filings") being filed by *pro se* filers.
- Most of the suspect filings were originating from outside of the United States.

- The Acting Commissioner felt (or at least hoped) that if only the suspect filings could be forced to be represented-by-US-counsel filings rather than *pro se* filings, this would reduce or eliminate the suspect filings.
- The Acting Commissioner had previously imposed a requirement that any applicant residing outside the US had to be represented by US counsel.
- The Acting Commissioner suspected that at least some of the filers of suspect filings had been using post office boxes or "in care of" addresses in the US as a way to circumvent the requirement of having to hire US counsel.
- The Acting Commissioner had in mind that requiring applicants to reveal "where they sleep at night" might smoke out some or most of the filers of suspect filings who were trying to avoid having to hire US counsel, and would force them to hire US counsel, and assumed that this would reduce or eliminate the suspect filings.

Even the most cursory consideration of this explanation prompts the realization that in those trademark applications that were filed in the first place by US counsel, there would be no need whatsoever to pry into the "where you sleep at night" circumstances of a trademark applicant. Likewise even a moment's reflection reveals that even if a trademark application had not initially been filed by US counsel, the instant that US counsel is retained, any need to pry into the "where you sleep at night" circumstances of a trademark applicant disappears. In either case, the goal of forcing the applicant to carry on through the application process by means of representation by US counsel, rather than *pro se*, has been achieved. From that moment forward, it ceases to be relevant whether the applicant is or is not located in the US, and in particular it ceases to be relevant where the applicant sleeps at night.

One cannot escape the suspicion that the newly strained interpretation of the statutory term "domicile" that happened so suddenly in the summer of 2019 might have had some political connection. The USPTO is part of the Department of Commerce, as is the Census Bureau. An Executive Order dated July 11, 2019 signed by the then-president of the US said in part:

> Nevertheless, we shall ensure that accurate citizenship data is compiled in connection with the census by other means. To achieve that goal, I have determined that it is imperative that all executive departments and agencies (agencies) provide the Department the maximum assistance permissible, consistent with law, in determining the number of citizens and non-citizens in the country, including by providing any access that the Department may request to administrative records that may be useful in accomplishing that objective.

To this day, the USPTO has not said whether it has provided the "sleep at night" addresses of trademark applicants (along with their citizenships, a piece of information also required in the TEAS trademark application forms) to the Commerce Department pursuant to this Executive order. (This Executive Order was revoked on January 20, 2021.)

The Acting Commissioner's requirement that the applicant reveal where he or she sleeps at night is not an idle concern. An applicant might for example be a victim of domestic violence, or the target of a stalker. The applicant might be a highly visible person concerned about the risk of a child or other family member being kidnapped. There are many reasons why an applicant might

value his or her privacy and might very much wish to hold back from revealing to the Office where he or she sleeps at night.

Those who can afford it can try to protect against such risks by filing a petition. Actor Robert De Niro filed such a petition in US trademark application number 85713838, and the Acting Director granted that petition, permitting Mr. De Niro to reveal his address with no more specificity than the city and state where he lives. But the office has not routinely granted all such petitions, and has denied some such petitions on various grounds.

For an applicant that is a legal person, the Office's strained interpretation of the statutory term "domicile" is such that the information demanded by the Office (termed "domicile address") is the revelation of the place where "the entity's senior executives or officers ordinarily direct and control the entity's activities and is usually the center from where other locations are controlled". It will be appreciated that for many small startup businesses, there may be only one or two senior executives or officers, and the place where these things happen is extremely likely to be someone's home. In other words, for many small startup businesses, when the Office demands to know the domicile address of the legal entity, this works out to be the same thing as demanding to know where some natural person sleeps at night.

More than two years have passed since the Office commenced this "where you sleep at night" disclosure requirement. Has it worked? Has it reduced or eliminated the suspect filings? So far as any external observer can see, the success rate for this line of attack is somewhere in the range of "very little" or "none". The examination and processing backlogs at the USPTO are, if anything, more severe now in 2022 than they were in 2019. The numbers of filings from the places outside of the US that the Acting Commissioner hoped to influence have, if anything, increased. All or nearly all such non-US filers have long since apparently worked out economical and efficient ways to obtain representation by US counsel.

During these past two years, a non-negligible portion of the working day of Examining Attorneys at the Trademark Office has, so far as an external observer can see, been needlessly spent on having to research things like whether the mailing address of an applicant (that is already represented by US counsel) happens to be a UPS Store or some other kind of mail drop, so as to assemble evidence for an Office Action to force the applicant to reveal his or her "where you sleep at night" address. It seems to the external observer that an Examining Attorney could much better spend such time on other aspects of the examination process that might actually serve the policy goals of the trademark system (identifying faked specimens of use, to give one example, or carrying out ever-better-quality searches of Office databases).

We acknowledge that the Office has established the "check box" in the relevant TEAS forms, by which an applicant can provide a postal mailing address that is distinct from the applicant's "sleep at night" address, and we acknowledge that in the USPTO systems, when the "check box" is used, the "sleep at night" address is then kept from public view in TSDR. We are aware that the Office has put forth the view that this "check box" feature supposedly fully addresses any privacy concerns on the part of trademark applicants regarding the requirement that applicants reveal their "sleep at night" addresses. With all respect, this view of the Office is completely in error, for several reasons.

A ***first reason*** that this view of the Office is in error is that the Office has never committed to any protection of the "sleep at night" information beyond the mere masking it from public view in TSDR. What would happen if, for example, someone were to file a FOIA request and if the documents responsive to the request were to include the "sleep at night" information of a trademark applicant (or perhaps all trademark applicants)? Would Office personnel check to see whether the soon-to-be-released document happens to contain a "sleep at night" address? Would Office personnel even notice? If Office personnel did notice this, would they first check with the applicant to see whether the applicant has any objection to having his or her "sleep at night" address revealed? The Office has never addressed any of these questions or committed to any particular way of handling such concerns.

A ***second reason*** that this view is in error is that the Office has never said that the "sleep at night" information is not routinely communicated outside of the USPTO. All of the relevant TEAS forms, for example, carry disclaimers that the filer or applicant "has no right to privacy". Given the conspicuous absence of any assurance on this point from the USPTO, one has no choice but to assume the worst, namely that such information does sometimes get communicated, or perhaps even routinely gets communicated, outside of the USPTO, for example to other government agencies.

A ***third reason*** that this view is in error is that the Office has never said what, if any, internal procedures or protections are in place to shield the "sleep at night" information from view by the many USPTO employees and USPTO contractor employees.

But the ***fourth reason*** that this view is in error is the vivid reminder that nobody is perfect. Nobody, no matter how hard they try, ever succeeds at avoiding errors and mistakes when they administer computer systems. It is part of life. We see a reminder of this in the Office's publication, three days ago, of the supposedly "masked" and private email addresses of 20837 trademark applicants. The Office promised the Trademark Public Advisory Committee on April 21, 2020 that the Office would

> mask the [applicant] email address field in TEAS and TEASi documents viewable in TSDR. This includes submissions viewable in the documents tab, all application programming interfaces (APIs), and PDF downloads.

The Office failed at this promise three days ago.

It should be appreciated that the harm that actually flowed from the Office's mistake on May 24, 2022 was less bad than it might have been, due to a letter very much like this letter. A bit of explanation is called for.

When the Acting Commissioner for Trademarks first promulgated Examination Guide 1-20 on February 6, 2020, the guide contemplated that the email address that the trademark applicant would be required to reveal in the TEAS application form would be an email address that is "personally monitored" and "directly accessed" by the applicant. The planned effective date for this requirement was in a TEAS software release a mere nine days later at 12:01 AM on

Saturday, February 15, 2020. Had this requirement by the Acting Commissioner gone into effect as planned, then the Office's publication on May 24, 2022 of 20837 applicant email addresses would have been a publication of 20837 email addresses each of which is "personally monitored" and "directly accessed" by the applicant. These 20837 email addresses would have been a spearphisher's dream.

What actually happened, however, is that *One Hundred Ninety-Nine Trademark Practitioners* wrote a letter dated February 11, 2020 to the Acting Commissioner for Trademarks, urging her not to proceed with this plan. Three days later, at 4:32 PM on Friday, February 14, 2020, the Acting Commissioner relented. She modified the TEAS software so that it was only required that the email address provided by the applicant be different from the email address provided by the attorney (if any). Gone was any requirement that the email address be "personally monitored" by the applicant or "directly accessed" by the applicant.

On a practical level, this probably means that some fraction of the 20837 applicant email addresses that the Office published on May 24, 2022 were not very harmful email addresses to have published. Yes, many of the email addresses that got published on May 24 surely were the actual personal email addresses of applicants, and surely their publication by the Office has already caused harm and will continue to cause harm. But at least some of the email addresses that got published on May 24 may have been less harmful email addresses, due to the influence of the *One Hundred Ninety-Nine Trademark Practitioners*.

Hopefully the present Commissioner for Trademarks can listen to the signers of this letter, just as the Acting Commissioner for Trademarks listened to the signers of the letter dated February 11, 2020 from the *One Hundred Ninety-Nine Trademark Practitioners*.

We return to the "ask" of this letter. If the Office failed at its promise to manage its computer systems competently so as to protect the private email addresses of 20837 trademark applicants, we fear that it is only a matter of time until the Office will fail at its promise to manage its computer systems competently so as to protect the "sleep at night" addresses of its trademark applicants. Again we do not mean to question the intentions of those who manage these computer systems. We simply recognize that none of us is perfect.

The harm that can come to a trademark applicant if the Office publishes his or her private email address is of some magnitude. Perhaps the email address will make it possible for a spammer to send spam to the trademark applicant. Perhaps the email address will make it possible for a spearphisher to sent a highly targeted spearphishing email that will trick the recipient into "clicking here" and infecting the recipient's computer with a computer virus, or worse. At a minimum, the applicant might have to spend some money to pay for a different email hosting service, reprinting stationery and business cards, and spending hours communicating a new email address to colleagues.

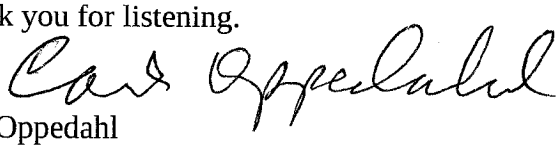
But the harm that can come to a trademark applicant if the Office publishes his or her "sleep at night" address might be far worse. It might be worse not merely in degree but in kind. The victim of such a revelation might come to bodily harm. The victim of such a revelation might find that

there is no choice but to pick up sticks and move, perhaps at great economic and social and emotional cost not only to the trademark applicant himself or herself but also to his or her family.

Again, if there were a good reason to force applicants to reveal this "sleep at night" information, then we could talk about where it ought to be stored, and how it ought to be protected, and who should have access to it. But there is no good reason, so it should not be collected or stored. If it is not collected or stored, then we do not need to face the seemingly inevitable day when some error or mistake would reveal it publicly, like what happened on May 24, 2022 with 20837 supposedly masked and private trademark applicant email addresses.

We ask that you stop requiring trademark applicants to reveal where they sleep at night. We ask that you return to a more sensible (pre-2019) interpretation of the statutory term "domicile", which for a patent applicant calls for a mere disclosure of a city and state. We ask that the "sleep at night" information now stored in the Office's systems be expunged.

Thank you for listening.



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