

# You've Got Email: USPTO Imposes New Applicant Email Requirement for Trademark Submissions

INTELLECTUAL PROPERTY | FEBRUARY 24, 2020



**William Giltinan**

Last summer, the U.S. Patent and Trademark Office (USPTO) approved a controversial rule regarding email addresses. In the past, when an applicant was represented by counsel, the attorney would provide an email address to be used for official communications with the USPTO. If the attorney was not reachable, the USPTO would send paper mail to the client address listed on the filing, if the need arose.

The USPTO has now implemented a new rule requiring an attorney to provide an email address for the applicant or registrant, in addition to a mailing address, so that the USPTO can communicate directly with the client by email should the need arise. This change is intended to facilitate easier and less expensive communication with trademark applicants and registrants after they are no longer represented by counsel.

This rule has been widely criticized by the trademark community due to privacy concerns and because some believe that it will lead to disreputable companies obtaining applicant and registrant email addresses and using them to sell unnecessary or fraudulent services. Despite the efforts of intellectual property owner advocacy groups, however, the new rule has now gone into effect.

## **What does this mean for you?**

Each new filing with the USPTO will now require an email address that goes directly to the applicant or registrant. This is in addition to the email address the USPTO uses to communicate with your attorney. The next time we prepare a filing for you, we will be asking you for an email address to provide to the USPTO for this purpose. Unless you instruct us otherwise, we will then use that same email address for all future filings.

## **Does this mean that I will get a copy of all USPTO correspondence?**

Probably not. According to a comment response published in the Code of Federal Regulations on July 31, 2019, the USPTO will communicate directly with the attorney for a represented client and will not send duplicate communications to the applicant's or registrant's email. That email will only be used when the attorney of record cannot be reached or is no longer representing the applicant or registrant. Of course, you can always view the status of your filing and official communications online using the Trademark Status and Document Retrieval (TSDR) system.

## **Will my email address be publicly available?**

Maybe. According to the same comment, the applicant and registrant emails will be "masked" from public view. This is consistent with the TSDR as of the date of this alert, which does not show the address. It is possible, however, that such information will be available from a public records request. In addition, recent articles have noted the email addresses will be available publicly, which suggests that this is under consideration or may occur at some point.

## **What email address should I use?**

For privacy reasons, and to address possible future personnel changes, we do not recommend using the email address of an employee or representative. Instead, we recommend creating a custom email address such as 'trademarks@company.com' specifically for this purpose. For small businesses with limited email addresses at their company domain, you may wish to consider creating an email account on a free email service such as 'AcmeTrademarks@gmail.com.' As is noted below, if you wish to reduce the chances of receiving spam email at this account, you may wish to choose an email address that is more difficult to guess, such as 'tradem123@company.com' instead of 'trademarks@company.com.' Recent comments from the USPTO indicate that creating a special email address for trademarks is permissible, so long as it is monitored.

## **Who should have access to the new email address?**

The new email address should be restricted to the person(s) responsible for trademarks in your organization. In the event of a change in personnel, access will need to be updated.

## **What should we do with notices sent to this email address?**

Nothing, so long as you are represented by U.S. counsel. The USPTO is required to send your U.S. counsel copies of all official communications. So long as we represent you in connection with a given trademark filing, we will continue to receive official communications and will contact you in the event action is needed. In the event you are no longer represented by U.S. counsel for a filing, however, you will then need to begin monitoring the email address for official communications from the USPTO.

### **I received an urgent notice in my trademarks from an official-sounding address. What should I do?**

Contact your trademark attorney. Many third-party companies monitor public trademark filings and attempt to obtain contact information for the filer. They then send official-looking letters requesting money for various services. The letters are designed to look like official notices, in the hopes that the recipient will believe the service being offered is a legal requirement when, in truth, it is not. Examples we have seen in the past include: (1) bogus notices saying that a third party has registered your trademark as a domain name in China; (2) offers to have your trademark included in a third-party catalog or guide; and (3) very early renewal notices encouraging the filer to pay an often inflated fee to renew early. While the USPTO appears to be attempting to mask email addresses to avoid this risk, it is unclear at this time how successful it will be and whether spammers will ultimately find a way to access the direct email addresses. It is also possible that spammers will attempt to email common addresses such as 'trademarks@company.com' under the assumption that such an address will have been created. Therefore, if you receive any notice you do not understand, or that asks for a credit card or other payment information, please contact us before taking any action.

### **I am working with counsel outside the United States for my filings. Can that counsel use their email address instead?**

While it is possible the USPTO would accept such an email address in its forms, the rule appears to require that filers provide an email address that goes directly to the applicant or registrant. Therefore, we must ask that you please provide a direct email for use on USPTO filings.

### **What happens if I file an international application that designates the United States? Do I still have to provide an email address?**

International filings may not require an applicant email address, at least for now. The USPTO has indicated that it is working with international filing offices to update their systems so that they can require the direct email address. For those offices that have not yet updated their systems, the international filing will still be accepted by the USPTO.

### **Is this legal?**

Under U.S. privacy laws, there appears to be no barrier to the USPTO requiring this information. If you are subject to the European Union's General Data Protection Regulation or another privacy regime, the question whether the USPTO can require this information and make it public will be governed by applicable treaties. Please contact us if you are concerned about this aspect of the rule.

### **Might this change?**

Possibly. A number of organizations have criticized this rule and have sought to curtail it. At this point, those efforts have not been widely successful. We do expect challenges, however. Therefore, it is possible that this rule will change in time. Until then, we will comply with it.

### **What should I do if I have more questions?**

Please contact [trademarks@carltonfields.com](mailto:trademarks@carltonfields.com) if you have any questions regarding this change, or if there is anything we can do to assist you with it.