IP Alert | USPTO Trademark Rule Changes: Electronic Filing, Email Addresses and More

By Liz Brodzinski

On Feb. 15, 2020, the U.S. Patent and Trademark Office's (USPTO) new rule changes regarding mandatory electronic filing of trademark applications went into effect. (See Changes to the Trademark Rules of Practice to Mandate Electronic Filing, 84 FR 69330)

In conjunction with the new rule changes, the USPTO published an examination guide specific to the new rules, titled "Mandatory Electronic Filing and Specimen Requirements." The 10-page document includes a list of exceptions to the electronic filing requirement, but also enumerates new requirements for applications, including changes to correspondence and specimen requirements.

Below are some key takeaways from the new rules.

Correspondence

Due to the mandatory electronic filing requirements, the USPTO's correspondence rules have been updated to reflect a requirement to have and maintain a valid email address for the applicant's receipt of correspondence from the USPTO.

It is typical for counsel of record to maintain an active email address for USPTO filings. However, the new rule requires that applicants also provide and maintain a separate email address on record, even if there is an appointed attorney. Acceptable email addresses include, but are not limited to:

- A personal email address;
- An email address created for the purpose of communicating with the USPTO (can be an email address maintained by the applicant's attorney);

- In-house counsel's email address for a juristic entity owner;
- An officer's or partner's individual email address for a corporate or partnership owner;
- A holding company officer's individual email address, if the holding company is a related company per TMEP §1201.03; or
- A juristic entity owner's email address, e.g., person@applicantcompany.com or info@applicantcompany.com (the email address does not have to be a corporate URL address).

The initial version of the Mandatory Electronic Filing and Specimen Requirements contained specific prohibitions against using email addresses controlled by outside counsel; foreign law firm email addresses; "black hole" email addresses that are never reviewed and which automatically delete emails; or any email address that the mark owner does not have direct access to monitor. The USPTO revised the guidelines the day before the new rules came into effect, presumably due to the backlash from trademark owners and practitioners regarding the increased likelihood that applicants' public email addresses would receive harassing and/or fraudulent messages.

The revised Mandatory Electronic Filing and Specimen Requirements no longer include lists of specific accepted and prohibited email address types. Moreover, the revised guidelines now state that trademark owners represented by counsel may use any email address of their choice, provided it is not identical to the correspondence email address. Note that this means even where in-house counsel is handling a trademark matter, the attorney correspondence email and the applicant email cannot be the same, apparently due to technical requirements. However, trademark applicants and registrants that are not represented by an attorney will have the same email address listed in the "applicant email" and "correspondence email" sections of the application.

Although the applicant/registrant email address will not be viewable in the status tab of the USPTO's Trademark Status and Document Retrieval (TSDR) site, the application documents themselves will still be public, and will still show the unredacted applicant email address.

Specimens

Filers must now include the URL and the access or print date for all webpage specimens filed for goods or services. (See Rule 2.56(c) as amended)

Moreover, if a label or tag is submitted as a specimen for a good, the label or tag must be shown attached to the goods themselves. It may be possible to submit a label or tag that is not attached to the goods, but only if such label or tag clearly shows use in commerce by including information, such as net weight, volume, UPC bar codes, lists of ingredients, etc., typical to the relevant goods.

Application Options

The TEAS RF filing option — which previously allowed filers to pay a reduced filing fee provided they accept the requirement to file and receive correspondence electronically — has been renamed "TEAS Standard." The filing fee for TEAS Standard will still be $275.

Exceptions for Paper Submissions

Generally, all formal correspondence regarding a trademark application or registration must be filed electronically through TEAS as of Feb. 15. If a party files a paper submission on or after Feb. 15, they will receive a notice from the USPTO that the submission was not processed, and that the submission will be destroyed. Refused paper-filed applications will not receive a filing date from the USPTO. Checks or money orders sent by mail will be returned with the USPTO notice.

However, there are some limited exceptions to the electronic filing rule. The following filing types that were filed before Feb. 15 will have a limited grandfathered paper filing allowance:

- **Applications filed on paper** before **Feb. 15, 2020** (exception ends once the application is registered);
- **TEAS regular applications filed** before **Feb. 15, 2020** (exception ends once the application is registered); and
- **Post-registration maintenance documents filed** before **Feb. 15, 2020** (exception ends once documents are accepted or finally rejected).

NOTE: Once a TEAS form is submitted online in a grandfathered application or post-registration maintenance document, the application or document loses its grandfathered status and all subsequent communications must be handled electronically.

There are other filing types that will have continued exceptions to the electronic filing requirement even when filed on or after Feb, 15, 2020. These include:

- **Submissions from parties that are the national of a country that is a member of the Trademark Law Treaty, but not the Singapore Treaty on the Law of Trademarks** (currently, this includes nationals of Bahrain, Bosnia and Herzegovina, Chile, Colombia, Costa Rica, Cyprus, Czech Republic, Dominican Republic, Egypt, El Salvador, Guatemala, Honduras, Hungary, Indonesia, Monaco, Montenegro, Morocco, Nicaragua, Oman, Panama, Slovenia, Sri Lanka, Turkey, and Uzbekistan);
- **Specimens for non-traditional marks** (for obvious reasons, scent and flavor mark specimens cannot be submitted electronically – but note this exception does not apply to sound, motion, or color marks); and
- **Documents approved pursuant to a petition to the director**

A petition to the director may be filed requesting an exception to the electronic filing requirement if:

(1) TEAS is unavailable on the date of a filing deadline;

(2) A timely filed submission was not processed or examined and cannot be refiled electronically before the deadline; or

(3) In an extraordinary situation as defined in 37 CFR § 2.146, including when justice requires and no other party would be injured by the exception.

What will change for trademark owners?

The majority of trademark applicants already file electronically, so for many trademark owners there will be little to no general change from the mandatory electronic filing requirement.

However, compliance with the updated specimen requirements may require additional effort from trademark owners and their counsel. To the extent trademark owners have historically relied on labels or tags as specimens for goods, they may need to adjust the format of their tags to include more information in order to meet the new, more stringent requirements. Moreover, the new website printout requirements may impact strategy for some trademark owners that have not been previously concerned with access dates for their specimens of use. Trademark owners should take care to ensure that the URL and access date information submitted with specimen filings is accurate.

The new trademark owner email address requirement may also create an extra burden on applicants and registered mark owners who will need to maintain an email address that will be publicly viewable in the trademark file, but must also be monitored for communications from the USPTO. Fortunately, this burden can be shifted to trademark counsel by choosing an email address that is monitored by counsel instead of the trademark owner.

Note, however, that although the USPTO has specifically allowed this workaround in its updated exam guidelines, using an email address monitored by counsel of record does not address the USPTO's stated goal of giving the USPTO a reliable way to contact mark owners once their attorneys have withdrawn or been removed. For this reason, we may see additional correspondence requirements come out of the USPTO going forward.

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