ARE Trademark Law Alert: USPTO Revises Rule Requiring Public Email Addresses for Applicant/Registrant Trademark Filings

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On February 7, the U.S. Patent and Trademark Office (USPTO) issued its new guidelines regarding electronic filing and electronic communications with attorneys and trademark owners.

The most significant change under the rule, which was implemented on February 15 after a revised guidance was issued the day prior due to various attorney concerns, will require all trademark applicants, registrants and parties to provide an email address for all U.S. Trademark Office filings and submissions, which must be different than the email address of the attorney for the trademark applicant, registrant or party.

The email address supplements the correspondence information for a trademark owner's attorney and would be used by the Trademark Office in case representation of the mark owner ends.

This email will be publicly available and viewable in documents filed electronically through the Trademark Electronic Application System (TEAS), raising privacy concerns and the likelihood of an increase in fraudulent spam that will be sent to such publicly available e-mails as phony companies often mine USPTO databases for targets.

Faced with backlash to the new rules, the USPTO released a revised guidance document the day before the new trademark filing rules were set to take effect and noted that it is "continuing to explore additional improvements, including potentially masking email addresses."

The revised guidance now permits the outside counsel or foreign counsel for a trademark owner to establish an email address for the trademark owner. However, this email address "cannot be identical to the listed primary correspondence email address of their attorney." The trademark owner's email address may be created by the trademark owners or their attorney and the trademark owner no longer needs to regularly monitor the email address provided.

We are now offering our clients the convenience of the creation and maintenance of a client's e-mail address to comply with this rule. Please contact us to find out more about how we can help you manage this change.

We will continue to update you on related developments.

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