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INTA Meets with USPTO Officials on New Email Rule

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Trademark Office Practices Committee

INTA members have expressed concern over recently published details regarding the new rule of the U.S. Patent and Trademark Office (USPTO) requiring all trademark owners to submit an email address for the owner, even if represented by counsel. Following the initial release of a detailed Examination Guide for the rule on February 6, members of the trademark community were opposed to some of the guidelines, including that the owner's email had to be "accessible and regularly reviewed by" the applicant, and that the email addresses would be viewable to the public in some sections of the USPTO online database. The USPTO acted swiftly and issued a revised Examination Guide on February 14 to clarify some issues, including that trademark owners could choose to coordinate with their outside counsel in choosing any email of their preference to include in the filing, and removing the "accessible and regularly reviewed by" language.

On March 9, three members of the Trademark Office Practices Committee (TOPC) USPTO Subcommittee met with USPTO officials in Alexandria, Virginia, to discuss member concerns over the new rule requiring trademark owners to submit an email address with trademark filings. INTA was represented by TOPC USPTO Subcommittee Chairperson Scott Woldow of Smith, Gambrell & Russell LLP, Subcommittee member Matt Frisbee of Leason Ellis LLP, and INTA's Director of Government Relations Jennifer McDowell. USPTO representatives included recently sworn-in Commissioner for Trademarks David Gooder as well as senior officials Sharon Marsh, Branden Ritchie, Catherine Cain, Robert Lavache, and Tanya Amos.

Even following the revised Examination Guide, trademark owners still had some questions and concerns regarding the email requirement. For example, some proposed that the email requirement be withdrawn entirely. Some were concerned that the USPTO

would issue a subsequent Examination Guide with more stringent rules. Many were still concerned that the email addresses would only be masked on certain sections of the USPTO's online Trademark Status and Document Retrieval database or not masked at all, thereby allowing scammers to easily obtain them.

TOPC representatives requested a meeting with USPTO officials in order to have a collaborative dialogue regarding the lingering issues, provide feedback on the revised Examination Guide, and answer questions about INTA's position. The meeting was constructive and helped to establish an open communication with the new Commissioner and other top USPTO officials. However, TOPC representatives also provided details that trademark practitioners found problematic and which were not addressed in the final rule.

The TOPC representatives appreciated the swift response to clarify issues in the revised Examination Guide based on feedback from the trademark community. The representatives also expressed that the community was quite concerned about increased spam and solicitations as a result of the email requirement and strongly encouraged complete masking of the email addresses.

USPTO officials were receptive to this concern and confirmed that they were already considering efficient ways to mask the data. With these concerns in mind, the USPTO quickly developed a protocol for completely masking the email addresses of represented parties, which it implemented on April 24. The USPTO also confirmed that there are no plans to make the email rule more stringent. They further advised that they could not provide legal opinions on the owner's use of a law firm email address and that law firms must exercise their own discretion in determining compliance.

The meeting and subsequent move to completely mask owner emails made clear that the USPTO is receptive to issues raised by the trademark community and is interested in keeping an ongoing dialogue regarding new policies. In particular, INTA representatives were encouraged that Commissioner Gooder was highly engaged and is interested in a collaborative and open approach to trademark policymaking. The tenor of the meeting bodes well for INTA advocacy on future issues.

Although every effort has been made to verify the accuracy of items in the *INTA Bulletin*, readers are urged to check independently on matters of specific concern or interest.

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