NEW USPTO REQUIREMENT: MANDATORY ELECTRONIC TRADEMARK SUBMISSIONS AND PHYSICAL ADDRESSES

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U.S. IP Procurement and Portfolio Management Alert

On Tuesday, July 31, 2019, the United States Patent and Trademark Office (USPTO) issued new Rules and Regulations under Title 37 of the Code of Federal Regulations (CFR) Parts 2, and 7. They were to take effect on December 21, 2019, but will now take effect of February 15, 2020.

The impact of the rule, as implemented, is a new requirement for all trademark applicants and registrants to: 1) electronically file trademark applications, subsequent documents concerning trademark applications, and documents regarding registrations; 2) provide and maintain a working e-mail address for receiving correspondence from the USPTO for each trademark application and registration; and 3) provide and maintain an accurate physical address as a backup for the USPTO to contact if an e-mail correspondence address fails to work.

The new rule does not apply to applications based on Section 66(a) of the Lanham Act (15 U.S.C. §1141f), often referred to as applications under the Madrid Protocol, because those applications are initially filed with the International Bureau of the World Intellectual Property Organization (WIPO) and thereafter transmitted electronically to the USPTO. However, Section 66(a) applicants and registrants are required to: 1) electronically file all subsequent submissions concerning such applications or registrations; and 2) designate an e-mail address for receiving USPTO correspondence.

When proposing this new rule in May 2018, the USPTO had originally noted that more than 99% of all initial applications based on Section 1 and/or Section 44 of the Lanham Act were being filed electronically. Notably, only 144 of the 468,926 applications filed in 2018 were on paper. Thus, the USPTO reasoned, the requirement to file all submissions electronically would not be impracticable or burdensome. There are minor exceptions to the paper filing rule applicable to specific jurisdictions having treaties with the US or in the case of specimens applicable to non-traditional marks (i.e., Scent, Flavor, or Other Non-Traditional Marks) but these limited exceptions should not be expected to result in a large number of manually processed filings.

The USPTO cited an increase in administrative efficiency by facilitating electronic file management, optimizing workflow processes, and reducing processing errors. Such administrative efficiency was one important consideration cited by the USPTO related to end-to-end electronic processing of applications and related submissions, as well as registration maintenance filings.

The USPTO also noted that paper submissions hinder efficiency and accuracy. Paper submissions are costlier for the USPTO to process than electronic submissions due to scanning and manually uploading documents into the USPTO electronic records system. Manual entry of data in the documents can lead to a decrease in accuracy as well. At present, just under 88% of applications are entirely processed electronically - which means that close to

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12% of such filings still require burdensome, and potentially less accurate, paper processing at some point in the application process.

Moreover, electronic submissions can be received quicker than paper correspondence and can be answered more expeditiously as well. Such expediency would be another important consideration for the USPTO with respect to submissions filed and processed electronically, as well as any related electronic correspondence with the USPTO.

Interestingly, to obtain a filing date for a new trademark application under Section 1 and/or Section 44 of the Lanham Act that is electronically filed, the application will need to be written in the English language and will need to include all of the following: 1) the applicant's name, domicile address, and e-mail address; and 2) any qualified practitioner's name, postal address, and e-mail address. These are new requirements with respect to applicants. The USPTO noted that the applicant information is apparently important in situations where an appointed practitioner is no longer able to respond to the USPTO - due to technical reasons, retirement, or other reasons for unavailability.

The final rule also implements changes regarding the submissions of specimens of use (which, except in limited circumstances, must also be submitted electronically). At least one specimen per class showing the mark as actually used in commerce (for the goods or services identified) is required for any new trademark application based on actual use in commerce, any amendment to allege use in an application, any statement of use, and any affidavit or declaration of continued use or excusable nonuse. As before, an electronic reproduction of an acceptable specimen of use can be based upon a clear and legible photocopy, photograph, or web page printout. However, a web page must now include the URL and access or print date.

With respect to the contents of specimens: 1) a trademark specimen must show use of the mark on the goods, on containers or packaging for the goods, on labels or tags affixed to the goods, or on a display associated with the goods (to constitute a display associated with the goods, a specimen must show use of the mark directly associated with the goods and such use must be of a point-of-sale nature); 2) a service mark specimen must show the mark as used in the sale of the services, including use in the performance or rendering of the services, or in the advertising of the services (and the specimen must show a direct association between the mark and the services). Given the growing submissions of web page printouts for proof of use, a lack of familiarity with the new rules could lead to growing numbers of rejections by the USPTO.

In sum, the rule means that new applications filed after February 15 should comply with the new requirements or they will not receive a filing date from the USPTO and will be rejected. Moreover, after February 15, any electronically filed specimen of use which includes webpage evidence will need to include both a URL and an access or print date, or the USPTO will likely issue an office action rejecting the submission.

The full text of the original Federal Register publication can be viewed here.

The correction to the rule can be found in the Federal Register publication here.

The delayed implementation of the rule can be found in the Federal Register publication here.

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