

Cantor Colburn Client Alert:

Important Changes to U.S. Trademark Registration Process

This past Thursday, February 6th, the U.S. Patent and Trademark Office (“USPTO”) published Exam Guide 1-20, which contained a number of significant changes to the process for obtaining and maintaining federal trademark registrations, three of which we summarize below. The full text of Exam Guide 1-20 can be accessed online at <https://www.uspto.gov/sites/default/files/documents/TM-ExamGuide-MEF-1-20.pdf>. **Please note that, as of now, all of the changes will become effective this Saturday, February 15, 2020.**

Email Address for Applicant Now Required

The most surprising announcement (there was no advance notice and no meaningful opportunity for public comment) is a new requirement that a trademark applicant must provide the USPTO with a valid current email address, even if the applicant is represented by an attorney. Moreover, the applicant email address will become part of the public record of the application. The purpose of the new rule ostensibly is to enable the USPTO to communicate directly with an applicant if and when the attorney’s representation ends. But the rule raises a host of issues, such as providing a fresh incentive for spammers, scammers, and phishers to scrape and exploit the trove of new email addresses, and applicants whose contact information would likely be subject to widespread abuse, such as athletes, actors, musicians, and other celebrities. The new rule has already prompted widespread objections from the trademark legal community, but unless the USPTO suspends or cancels the rule by the end of this week, it will become effective on February 15th.

Requirement to File Electronically

With only narrow exceptions, all trademark applications, registration maintenance and renewal filings, and other formal documents and correspondence must be filed with the USPTO electronically. This rule essentially eliminates the ability to file anything on paper.

Specimens of Use

In most cases, specimens of use must be filed electronically as well. But facing a substantial rise in the submission of fraudulent (fake or doctored) specimens, the USPTO has also tightened the requirements for what specimens of use will be accepted. While there are many nuances to the changes, in general the USPTO wants to see a more direct and obvious connection between the specimen submitted and actual use of the mark in commerce. For example, no longer will it be acceptable practice to submit a label bearing the mark in isolation, without any context showing the actual use.

For Further Information and Assistance

The attorneys in the Trademark & Copyright Department of Cantor Colburn LLP will be happy to answer any questions you may have about this Client Alert and provide you with specific advice and guidance. Please do not hesitate to contact any of the individuals listed below:

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Please note that each situation has its own unique circumstances and ramifications. This Client Alert is for informational purposes only and is not legal advice.