Insights: Alerts

TM Client Advisory on Changes to US Trademark Prosecution at the USPTO Effective February 15, 2020

FEBRUARY 13, 2020 Written by Phillip A. Rosenberg

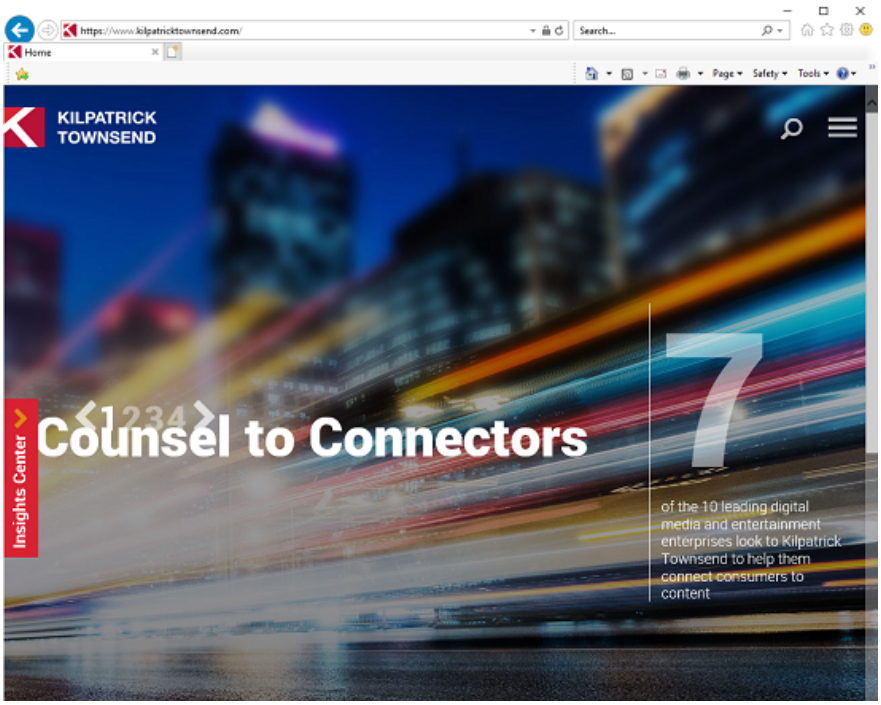
Executive Summary: Changes to the Trademark Rules of Practice at the U.S. Patent and Trademark Office (USPTO) are going into effect on February 15, 2020[1]:

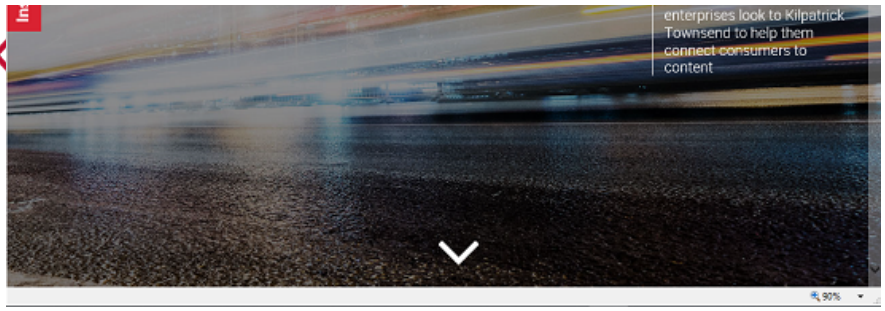
I. Trademark specimens showing use of a mark on a web page will need to include the web page URL and the date that the web page was either accessed or printed;
II. Trademark specimens must show the entire specimen or enough of the specimen for proper examination;
III. The USPTO will require electronic filing for all documents, with limited exceptions;
IV. Each trademark applicant and their attorney must provide an email address for official correspondence.

84 FR 37081. Details of each of these changes and some practical considerations follow.

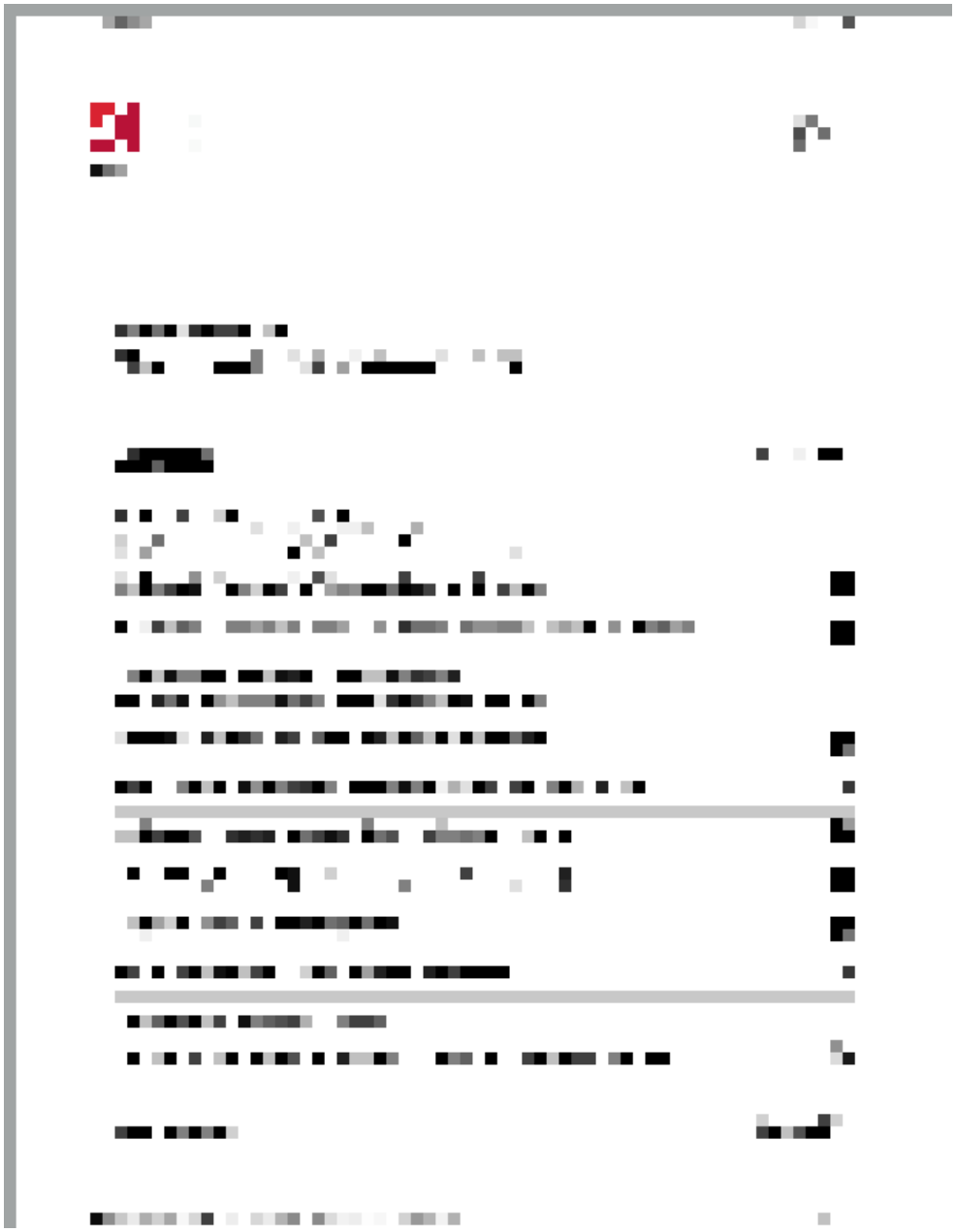
I. Website specimens must include the web page URL and access or print date.

- **New requirements**: Trademark specimens showing use of a mark on a website will need to include the **URL** and the **access or print date** in order to be accepted.
  - URL: A URL is the webpage address that appears in the address bar of a web browser (example shown below).





- Access or print date: The access or print date is the date on which the image of the web page showing the specimen was captured. See example below:



- **Where to include the information**: Parties can provide the URL and access or print date in one of four ways: (1) on the specimen itself; (2) within the USPTO's TEAS electronic form; (3) in a later-filed response; or (4) in an Examiner's Amendment.
- **Web pages only**: This new rule does not apply to specimens that show screen shots from app marketplaces, in-app

activities, or from other online browser software for which there is no URL. The new requirements will affect only traditional web page specimens (i.e. accessed through a traditional web browser).

- ***Practice point***: Some computer programs convert a web page to PDF and automatically provide a URL, along with the access or print date. However, if the software that you use does not capture that information, consider entering the required URL and access or print date in the "Specimen Description" field in the TEAS Statement of Use or Declaration of Use form. Alternatively, you may want to consider entering the information directly into the PDF, .jpeg, or other acceptable file format that you intend to submit to the USPTO, if your software permits you to.

II. Specimens must show enough of the goods or services on which the mark is used so that the goods or services are easily identifiable.

- **Acceptable specimens**: The USPTO will accept a clear and legible photocopy, photograph, web page printout (*with URL and access or print date*), or other similar type of reproduction of an actual specimen. It must show the entire specimen or enough of the specimen such that **the mark** and **the good or service with which the mark is used** are identifiable.
- ***Practice point***: While the new rule seems self-explanatory, in practice it will require applicants and registrants to provide more context for the way in which they use their marks in commerce. For example, if the specimen is a t-shirt, a photograph of the mark on a hangtag is unlikely to suffice without a clear showing that the hangtag is attached to a t-shirt. Please note that tags and labels that show use of the mark in commerce, even if not attached to goods, may be acceptable if it includes sufficient information to show the mark used on goods in commerce. Mere mock-ups of tags or labels will not be accepted. From an enforcement perspective, these newly articulated requirements could provide an interested party who suspects that an applicant is committing fraud on the USPTO to submit a letter of protest to the USPTO in an effort to flag the non-compliant specimen to an examiner's attention.

III. Electronic filing mandatory for all documents, with limited exceptions.

- **New requirements**: Trademark applicants will be required to file all §1 and §44 applications and subsequent prosecution documents through TEAS, the USPTO's electronic filing system.
- **All types of marks affected**: The new rule affects any trademark, service mark, certification mark, collective membership mark, or collective trademark or service mark application.
- **Relevant applications**: All U.S. trademark applications asserting a filing basis of use in commerce (§1(a)), intent-to-use (§1(b)), reliance on a foreign application (§44(d)), and reliance on a foreign registration (§44(e)) will need to be filed electronically with the USPTO. All subsequent documents supporting the application and resulting registration must be filed electronically as well.
    - If an applicant, registrant, or party to a proceeding before the Trademark Trial and Appeal Board (TTAB) filed documents with the USPTO prior to February 15, 2020, the documents will be "grandfathered in" and not subject to these new requirements. **However, any subsequent TEAS forms submitted on or after February 15, 2020 – even to an existing application, registration, or proceeding – will be subject to the new requirements.**
- **Fees**: The TEAS standard filing fee will remain $275 per class; applications filed through TEAS Plus will remain $225 per class. There will be no more "standard" application, thereby removing the $400 per class filing fee (except for foreign-based applicants relying on the Madrid Protocol, who will continue to pay $400 per class in filing fees).

Limited exceptions to electronic filing.

The USPTO will *only* accept non-electronic applications or submissions in extremely limited situations, including:

- **USPTO filing system error** preventing the applicant from filing the required documentation with the USPTO on a deadline (in which case the applicant may petition the Director for relief).
    - *This will not apply to regularly scheduled website maintenance, which typically takes place between midnight and 5:30 am Eastern Time on weeknights, and at all hours on weekends and holidays. The USPTO will post advanced notice of website maintenance on its website at https://www.uspto.gov/blog/ebiz/.*
- Specimens for **scent, flavor, or non-traditional marks which cannot be transmitted online due to the nature of the mark** (this does **not** include sound or motion marks, which can and must be submitted via the TEAS filing system).
- Informal communications between an applicant or registrant (or their attorney) and an examining attorney, which will still be allowed by phone or email.
- Applications from nationals of countries that are signatories of the Trademark Law Treaty (TLT), but not signatories to the Singapore Treaty on the Law of Trademarks (STLT).
    - *As of July 31, 2019, the list includes nationals of Bahrain, Bosnia and Herzegovina, Burkina Faso, Chile, Colombia, Costa Rica, Cyprus, Czech Republic, Dominican Republic, Egypt, El Salvador, Guatemala, Guinea, Honduras, Hungary, Indonesia, Monaco, Montenegro, Morocco, Nicaragua, Oman, Panama, Slovenia, Sri Lanka, Trinidad and Tobago, Turkey, and Uzbekistan.*

IV. Each applicant, registrant, or party to a proceeding must provide an active email address for official correspondence.

- **New requirements**: TEAS forms will be updated and all new applications must include a live email address for each applicant, and the name, email address and postal address of an attorney, if the applicant is represented by one. **Notably, no two addresses on a single form can be identical**. Valid email addresses are also required for all registrants and parties to a proceeding TTAB.
    - If an applicant, registrant, or party to a proceeding is represented by counsel, emails will be directed to counsel. Pro se applicants, registrants or parties (those not represented by counsel) will receive USPTO emails directly.
    - *Applicants, registrants or parties must provide their email addresses even if they are represented by counsel, so that the USPTO can contact the relevant person if their attorney representation ends.*
- **Emails will be public**: While an applicant, registrant, or party's email addresses will not appear in the Trademark Status and Document Retrieval (TSDR) *status tab*, email addresses will be publicly available in the TSDR *documents tab*.
    - *Applicants, registrants, or parties may petition the USPTO to redact email addresses in extraordinary circumstances.*
    - **This new development is quickly generating controversy given that the USPTO is potentially enabling the harvesting of sensitive in-house contact information**. Applicants, registrants, or parties might consider using an in-house department email alias that is monitored to avoid exposing sensitive contact details to the public.
- **Acceptable email addresses** must be addresses that are regularly accessed and reviewed by the applicant, registrant or party. This can include:
    - A personal email;
    - An email created specifically to communicate with the USPTO;
    - In-house counsel's email;

- An officer or partner's email for a business entity;
- A general contact email address if it is regularly monitored by the trademark owner (e.g.: trademark@applicantcompany.com).

- **Unacceptable email addresses** include:
  - Outside counsel's email address;
  - Email address of a foreign law firm;
  - "Black hole" email addresses that are never checked, or from which messages are routinely deleted without being read;
  - Any email address the applicant or registrant does not have direct access to monitor.
- ***Practice point***: If an email to an applicant, registrant, or party fails for any reason, the USPTO will not contact the correspondent in any other way. Make sure to include at least one email address that will be regularly checked internally, but is not tied to a specific personal email account. In the event any of the named applicant, registrant, or party leaves their role during the trademark application, registration, or proceeding process, the correspondent's successor will still be able to receive up-to-date information from the USPTO.

See more specific information about email requirements in the Examination Guide 1-20 Mandatory Electronic Filing and Specimen Requirements February 2020.

Conclusion

- Starting February 15, 2020, all specimens showing use of a mark on a website must include the web page's URL and print or access date, applied in one of four acceptable ways (on the specimen itself, within the TEAS form that describes the specimen, in a later-filed response, or in an Examiner's Amendment). Applicants should determine which method is most convenient for their practice.
- When submitting specimens showing use of your mark in commerce, consider whether there is sufficient context showing the mark in use with the applied-for goods or services to avoid a specimen rejection.
- The all-electronic filing requirement should improve speed and efficiency of filing applications, but applicants, registrants, and parties to TTAB proceedings must remember to check their TEAS account, the email associated with their application, registration, or proceeding, and stay on top of all digital communications.
- Note that the new rule changes are more extensive, including changes to TEAS application forms. Many of the additional changes largely codify a number of developments in USPTO practice. We summarize those rule changes that are likely to affect your daily trademark prosecution practice. You can read the full rule changes in the Federal Register here.

Please contact us with any questions.

Footnotes

[1]The amended rules of practice were initially planned to go into effect on October 5, 2019, but the USPTO delayed the effective date to December 21, 2019, and then further delayed it to the current effective date, February 15, 2020. See here for more details on the delayed effective date.

Related People





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