CHANGES AT THE USPTO FOR INDIVIDUAL APPLICANTS AND FOREIGN BUSINESSES

September 9, 2019

By: Heidi Howard Tandy and Geoffrey Lottenberg

During July 2019, the US Trademark Office (the "Trademark Office") issued a new rule requiring disclosure of a trademark applicant's home address, and requiring that US attorneys file applications, responses and other pleadings for all individuals that are not US citizens or residents, and all non-US businesses. The rule was modified and updated on September 6, 2019[1], but significant unresolved issues still remain for US residents and businesses, as well as for foreign corporate entities and individuals.

Address Requirements

The Trademark Office has required for the first time all "human" applicants and registrants (in contrast to corporate entities) to provide their home address. Those addresses are made public when an application is filed or updated. In response, an outcry against this new rule has come from trademark lawyers in the US and abroad, because, in part, the new rule will require public disclosure of the home address of all sorts of individuals whose privacy would otherwise be protected, such as minors, people who have restraining orders against abusive spouses, celebrities who may wish to keep their personal addresses private, and anyone who has concerns for their personally identifying information.

Therefore, human applicants impacted by the new rule have three limited choices when filing an application at the Trademark Office:

1. Enter "Petition" in the street address field of the trademark application form and separately file a petition requesting the Trademark Office to waive the requirement to make public their home address (aka their domicile); if the petition is granted, the applicant must provide an address at which he or she can receive mail;
2. Incorporate an entity and have the application filed in the name of that entity, while also making sure that any assignments to that entity have been properly created and any tax implications have been taken into consideration; or
3. Allow the information to be made public, where it is easily accessed by unscrupulous spammers and database creators.

None of these are good options, but the presence of the Petition option at least shows that the Trademark Office recognizes that there are good reasons to not share one's personal home address with the public. Many individuals have used business addresses for their trademark applications, or have used PO Boxes; both address options are now barred. Trademark applications are reviewed by an "Examining Attorney", and the Trademark Office's official guide also now states that if an individual applicant's address "looks incorrect" to an Examining Attorney (possibly one who has access to Google Maps) the individual will have to supply a "signed rental, lease or mortgage statement," "homeowner's, renter's or motor vehicle insurance policy" or a "computer-generated bill from a utility company." Generally, documents submitted to the Trademark Office are made public, and no provision exists at this point for redaction of personally identifying information, or a way to remove information that may be submitted to the Trademark Office by an uninformed or confused applicant.

Trademark attorneys have suggested that rather than obligate individuals to submit such personally identifying documents to the Trademark Office via the online filing system, an *in camera* review process could be instituted.

There are real reasons for the Trademark Office to require individuals with non-US domiciles and non-US businesses to use US attorneys to file trademark applications; thousands of applications have been submitted to the USPTO in the last 18 months with fraudulent specimens, and debatably accurate lists of goods or services, and the Trademark Office has reasonable justification to reduce those numbers. However, demanding US residents and citizens prove their "snail mail" address is seen as an over-arching response to that issue.

Further, it is not in step with how many American citizens and businesses work in 2019.

The rule was released while a swath of North Carolina is being battered by Hurricane Dorian. During and after hurricanes, people are out of their domiciles the same way they are after forest fires, earthquakes and volcanoes. American citizens in Puerto Rico are still having issues with mail delivery and their legal domiciles. Given that almost all correspondence with the Trademark Office is required to be via email and electronic filings, the reasoning behind this demand from the Trademark Office is not to ensure that correspondence is going to applicants.

In addition, businesses that have as their primary address a WeWork or other collective office location, or whose owners and operators are nomadic will have to spend extra time, money and possibly legal fees to create an office location specifically to receive one or two pieces of mail from the US Trademark Office.

Requirement to Use a US Attorney

The requirement that individuals who are neither US citizens nor residents, and businesses that are not incorporated or otherwise doing business in the United States use a US attorney to file, manage and maintain applications at the Trademark Office grew out of an influx of thousands of applications filed by non-US attorneys that do not meet the Trademark Office's standards or requirements. The Trademark Office stated that requiring applications be filed by US attorneys "instill[s] greater confidence in the public that US trademark registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims." They also noted that large numbers of non-US applicants are apparently receiving inaccurate information about the legal requirements for trademark registration in the US, "such as the standards for use of a mark in commerce, who can properly aver to matters and sign for the mark owner, or even who the true owner of a mark is under U.S. law."

When a mark is registered at the US Trademark Office, its presence means that marks that are likely to be confused with it cannot be registered; when invalid marks are listed on the Trademark Office's Principal Register of registered trademarks, their presence bars otherwise-viable and valid applications from obtaining trademark registration status. If trademark registrations result from improper or invalid applications, the Trademark Office states that this can "negatively impacts the integrity" of the Principal Register and the Trademark Office.

Accordingly, non-US companies that have previously used their General Counsel or non-US law firm to file applications at the Trademark Office for them now need to seek US counsel to file applications, respond to questions from an Examining Attorney renew trademark registrations and manage assignment recordation, among other tasks and practices.

If you would like additional information about this topic, please contact Heidi Howard Tandy and Geoffrey Lottenberg, both of whom are board certified in intellectual property.

---

[1] https://www.uspto.gov/sites/default/files/documents/Exam%20Guide%2004-19.pdf?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery

Related Practices

Intellectual Property

Related Practice Teams

Dispute Resolution

Related Team Member(s)

Heidi Howard Tandy

Geoffrey Lottenberg

Topics

Trademark