

Concerns About USPTO's Proposed E-Filing Rules For TMs

By **Roger LaLonde** (January 22, 2019, 12:59 PM EST)

During the summer of 2018, the U.S. Patent and Trademark Office solicited public comments regarding proposed changes to the USPTO's Rules of Practice in Trademark Cases that would: (1) make electronic filing mandatory for trademark applications and all related submissions (e.g., responses to office actions, maintenance and renewal filings); and (2) require applicants, registrants and any parties involved in Trademark Trial and Appeal Board proceedings to provide and maintain an email address for correspondence.[1] While these changes may seem modest, they could have a significant impact on how attorneys, their clients, and others interact with the USPTO.



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The International Trademark Association, American Intellectual Property Law Association, members of the E-Trademarks Listserv, and the American Bar Association have all weighed in on the proposed rule changes.[2] Although there is sympathy for the USPTO's goal of increasing administrative efficiency, a number of concerns were raised about unforeseen consequences that could be created by the proposed changes.

Why are email addresses required for applicants and registrants?

The ABA and the E-Trademarks Listserv took exception to the proposed rule change that would require email addresses for each applicant and registrant, even if the applicant or registrant is represented by counsel and counsel's full contact information is listed for correspondence purposes. Current practice only requires an email address for the applicant or registrant if that entity is not represented by counsel. Even though most trademark attorneys continue to represent their clients after a registration issues, this proposed change is presumably influenced by a long-standing rule that states that "the Office considers a power of attorney filed while an application is pending to end when the mark registers, when ownership changes, or when the application is abandoned." [3]

Both groups cited the prevalence of scams, spam, and other fraudulent mailings that are "received by anyone who reveals an email address to the USPTO." [4] The office itself acknowledged this problem in July 2017 at its public roundtable regarding fraudulent solicitations and the resulting criminal convictions of certain scammers. [5] Generally, all contact information provided to the USPTO is automatically made available to the public through the USPTO's databases. Fearing that clients would become subject to the same fraudulent solicitations received by attorneys and nonrepresented applicants and registrants, the ABA and the E-Trademarks Listserv asserted there is no need to change the current practice of only publishing an attorney's or qualified practitioner's email address, provided the applicant or registrant employs such a person. [6]

On a positive note, at the ABA's Trademark Day event, which was held at the USPTO on Sept. 20, 2018, Commissioner for Trademarks Mary Boney Denison informed attorneys that email addresses for represented parties would be hidden from public viewing under the final rule. However, the details of how such email addresses will be processed in a way that keeps them safe from public viewing are unclear.

The ABA's Section of Intellectual Property Law also raised concerns regarding another proposed rule change related to email addresses, which states that if an "email transmission were to fail ... the

USPTO would not attempt to contact the correspondent by other means.”[7] Noting the transient nature of email addresses and the potential for an electronic communication to be disrupted due to malfunctions or hacking, the ABA strongly encouraged the USPTO to continue its practice at the time under the Trademark Manual of Examining Procedure.[8] Until recently, the TMEP required USPTO examining attorneys to send a paper copy to the correspondence address of record if the listed email address did not work.[9] Despite the ABA’s appeal, in its October 2018 revisions, the USPTO changed the pertinent sections of the TMEP to state that paper copies will not be sent if email notifications are returned as undeliverable.[10]

Another commenter, Allison Ricketts of Fross Zelnick Lehrman & Zissu PC, observed that email is already being surpassed by text messaging and social media services as the preferred means of electronic communication for many people. Ricketts suggested that to avoid another change of the rule in the near future, the office should consider amending the rule more broadly to include “an email address or other alphanumeric identifier that is capable of receiving electronic communications.”[11]

Is the current electronic filing system reliable enough?

The proposed rule changes allow for three scenarios where paper submissions may still be permitted, pending acceptance of a petition to the director of the USPTO. Each scenario could arise whenever the USPTO’s e-filing program, known as the Trademark Electronic Application System, is unavailable due to technical difficulties.

The USPTO’s proposed rule changes would require applicants and registrants to prove that filings could not be made electronically because TEAS was unavailable due to a technical problem on either the USPTO’s end or the user’s end.[12] INTA, AIPLA, the E-Trademarks Listserv and the ABA all had comments regarding the proposed requirements of a petition under such circumstances, which generally includes payment of additional fees, and proof in the event that TEAS is simply not working.

Members of the E-Trademarks Listserv provided the most pointed criticism, noting that the proposed rule appears to “assume that the causes for paper filings lie outside of the USPTO” and are based on “discretionary decisions to paper-file.”[13] Recalling the total outage of the USPTO’s e-commerce systems for five days in December 2015, the E-Trademarks Listserv asserted that the reason paper filings persist is because TEAS is just “broken” sometimes.[14] The Listserv noted “the USPTO has been repeatedly urged to set up a contingency e-filing server” as backup for whenever a TEAS outage occurs, and posited that “such a contingency server ... would greatly reduce the need for paper filings.”[15] Technical problems are common enough with TEAS (or underlying components of TEAS such as the payment processing system) that it might be asking too much of applicants and registrants to hastily prepare a petition because TEAS is broken and the USPTO knows that it is broken. The ABA appears to agree with the E-Trademarks Listserv, as its comments state that the “USPTO should consider waiving the requirement for a Petition ... in the case of known TEAS outages.”[16]

In August 2018, the Patent Application Locating and Monitoring database, which is a pivotal component of the USPTO’s electronic filing system for patents, experienced a weeklong outage due to an internal systems failure that caused considerable frustration among patent professionals. The director of the USPTO, Andrei Iancu, conceded in September that “[m]ost of the legacy systems we operate have not had a major upgrade in years.”[17] After such a long outage period with the patent e-filing system, there is some apprehension among trademark practitioners about shifting to an entirely electronic system on the trademark side.

INTA and AIPLA were also curious about the lack of guidance regarding what kinds of proof would be needed for a successful petition in such scenarios. Both of those groups requested clarification that evidence in the form of screenshots and/or a declaration would be acceptable.[18]

Do the currently available electronic forms cover all situations?

AIPLA and the E-Trademarks Listserv observed that the standard electronic forms available on TEAS do not address all situations that can arise in connection with an application or post-registration filing. This can be due to unusual filing needs, such as an applicant who wishes to expressly abandon

an application and include a statement as to why the application is being abandoned.[19] The TEAS form does not currently allow for the entry of such statements in connection with an express abandonment.

Alternatively, the appropriate electronic form could be unavailable due to USPTO error. The AIPLA mentioned several examples where problems arose in this context, including a situation where an office action was issued after an extension request was filed. The response to the office action was timely filed, but the response was not processed in time for the next extension deadline and “[a]s a result, the Trademark Office’s online filing system would not allow the extension request form to be accessed or filed.”[20]

To address concerns over the limitations of TEAS and other USPTO forms, the E-Trademarks Listserv, AIPLA and INTA all recommended that “miscellaneous” or “other/free form” sections be implemented to allow for special circumstances.[21]

Do we have to wait for a deadline to request a paper filing alternative?

Finally, some of the commenters noted that the USPTO’s “exception” scenarios for paper filings all seem to relate to “deadline day” complications, rather than problems that would arise on any given date that an applicant or registrant is ready to file. The ABA and the E-Trademarks Listserv took issue with the suggestion that if TEAS is not available on the day an applicant or registrant wishes to file something, “then the filer should simply wait (perhaps for one or more days) until TEAS is restored to service.”[22] Noting that “[t]he USPTO generally encourages early submissions” and that “a decision ... to wait could potentially lead to loss of substantive rights,” these groups requested clarification that the option of a paper filing in the event of a TEAS outage be available on any day, and not just on a “deadline” day.[23]

The USPTO is currently considering the comments to the proposed rule changes and is expected to formulate a final rule this spring.

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[1] Changes to the Trademark Rules of Practice to Mandate Electronic Filing, 83 Fed. Reg. 24701 (proposed May 30, 2018), available at <https://www.gpo.gov/fdsys/pkg/FR-2018-05-30/pdf/2018-11353.pdf>.

[2] Comments on Proposed Rulemaking related to Changes to the Trademark Rules of Practice to Mandate Electronic Filing, available at <https://www.uspto.gov/trademark/trademark-updates-and-announcements/comments-proposed-rulemaking-related-changes-trademark>.

[3] 37 C.F.R. § 2.17(g)(1).

[4] E-Trademarks Listserv Comments at p. 5, available at <https://www.uspto.gov/sites/default/files/documents/Comment%20-%20ETrademarksListserv.pdf>

[5] See Notice of Roundtable Related to Fraudulent Solicitations, 82 Fed. Reg. 29535 (proposed June 29, 2017), available at <https://www.gpo.gov/fdsys/pkg/FR-2017-06-29/pdf/2017-13612.pdf>.

[6] See ABA Comments at p. 2, available at <https://www.uspto.gov/sites/default/files/documents/Comment%20-%20ABA-IPL.pdf>; see also Listserv Comments at p. 5.

[7] Changes to the Trademark Rules of Practice to Mandate Electronic Filing, 83 Fed. Reg. at 24704.

[8] ABA Comments at p. 3.

[9] TMEP §§ 403, 717.01 (Oct. 2017).

[10] TMEP §§ 403, 717.01 (Oct. 2018).

[11] Allison Ricketts Comments at p. 1, available at <https://www.uspto.gov/sites/default/files/documents/Comment%20-%20Ricketts.pdf>.

[12] See Changes to the Trademark Rules of Practice to Mandate Electronic Filing, 83 Fed. Reg. at 24704.

[13] Listserv Comments at p. 2.

[14v] Id.

[15] Id.

[16] ABA Comments at p. 2.

[17] Remarks delivered at the PPAC Public Hearing on Proposed Patent Fee Schedule (September 6, 2018), available at <https://www.uspto.gov/about-us/news-updates/remarks-director-andrei-iancu-ppac-public-hearing-proposed-patent-fee-schedule>.

[18] INTA Comments available at <https://www.uspto.gov/sites/default/files/documents/Comment%20-%20INTA.pdf>; AIPLA Comments available at <https://www.uspto.gov/sites/default/files/documents/Comment%20-%20AIPLA.pdf>.

[19] Listserv Comments at p. 5.

[20] AIPLA Comments at p. 2.

[21] See Listserv Comments at p. 5; AIPLA Comments at p. 3; INTA Comments at pp. 1-2.

[22] See ABA Comments at p. 2; Listserv Comments at p. 3.

[23] Id.