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“Trading” on Your Personal Information: Preventing Fraud and Unsolicited Communications Under the New Trademark Requirements

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The United States Patent and Trademark Office (“USPTO”) released [new examination requirements](#) that went into effect on February 15, 2020. One of the new requirements is to include an email address for the mark’s owner in the application. Prior to these requirements, a trademark owner represented by an attorney did not have to provide its own email address. The new examination requirements have amended this rule, and now, even when an attorney represents an applicant, the application must include both its attorney’s email address and an email address for itself. The applicant may select an email address of its choice to comply with this new request, provided the email address is not identical to the attorney’s email address.

One option for the applicant is to use its own email address. However, an applicant choosing to use its own email address must keep in mind that the trademark application, including that email address, will become a public record. The new examination requirements indicate that the applicant’s email address will not appear on the status portion of the USPTO’s trademark document retrieval tab, but its email address will appear in filed documents on the USPTO’s publicly available document retrieval service. As a result, people and companies scouring the internet for personal information will have access to the applicant’s email address in order to spam a trademark owner’s inbox and potentially commit fraud.

The trademark rules already require inclusion of the physical address of the applicant, which is publicly available in documents uploaded to the USPTO’s document retrieval service. Using those physical addresses, organizations already have been reaching out to trademark applicants and registrants in order to falsely solicit services and/or payments. Oftentimes, the defrauder will ask the trademark owner to pay a fee allegedly associated with an upcoming maintenance filing for a registration or request the payment of a fee to include the mark in a directory of marks, creating the impression that listing in such a directory is a requirement to maintain the registration. Despite creating the impression of official correspondence, the senders of these materials are not part of or affiliated with the USPTO.

If, as a result of the new USPTO requirements, an applicant represented by an attorney chooses to include a personal email address in the filing, that email address can also be used to direct spam, at best, and these types of fraudulent scams at worst. As a result, we encourage our clients to be mindful of these particular types of solicitations when choosing to provide a personal email address as a means of contact for trademark applications. If you are unsure of whether any correspondence you receive regarding your trademark is legitimate, please do not hesitate to contact our intellectual property team so that we may assist with this determination before you directly pay requested fees.

To discuss the new trademark requirements and the ways you can protect your personal information further, please contact:

[India Vincent](#) in Birmingham at ivincen@burr.com or 205-458-5284;

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or the Burr & Forman attorney with whom you regularly work.

No representation is made that the quality of legal services to be performed is greater than the quality of legal services performed by other lawyers.