

Although the letter may sometimes contain fine print indicating that it is not an invoice or that the service is optional, the fine print is easily missed by a busy trademark owner.

If a trademark owner is working with an attorney to file an application, the USPTO will send all correspondence directly to the attorney. Unfortunately, this doesn't prevent scammers from sending mailings to the trademark owner. But, the attorney will keep the applicant apprised of all official communications, fees, and due dates. Trademark owners can thus rest easy knowing that the attorney is monitoring the case and can ignore these third-party mailings or send them to the attorney for review.

### How Can You Avoid Being Scammed?

- Review all correspondence carefully! Official correspondence will come from the "United States Patent and Trademark Office" in Alexandria, Virginia, with zip code 22313.
- Know ahead of time exactly what fees and services are necessary to obtain a federal trademark registration.
- Work with an attorney to file your trademark application.

If you're working with an attorney to file a trademark application, contact that attorney immediately if you receive a letter from anyone other than that attorney about your trademark. Never contact or send money to a third-party organization about a trademark application without first contacting your attorney. For more information about trademark applications or trademark scams, contact us.



## TRADEMARKS

### New Trademark Filing Rules: What You Need To Know

By: *Amanda Rosenfield Lippes*<sup>5</sup>

As of February 15, 2020, all documents electronically filed with the U.S. Trademark Office (USPTO) must include an email address for the applicant or registrant. This applies to any new trademark applications, any filings to prosecute an existing application, and any filings to maintain a registered mark.

A separate email address for the applicant or registrant is required even if the applicant or registrant is represented by an attorney and the email address cannot be identical to the listed primary correspondence email address of the attorney.

Even for in-house counsel and attorneys representing themselves, two separate email addresses are still required: one for the owner and another for the attorney and they cannot be identical.

Note, when this rule was initially launched, the email address provided by the applicant or registrant was viewable in the filed document in the TSDR documents tab. As a result, scammers could scrape this additional information to target trademark owners with solicitations. On April 24, 2020, the USPTO announced it is now masking the email addresses provided with "XXXX" in the owner email address field to address these concerns. This masking has been applied even to those filings that occurred between February 15, 2020 and April 24, 2020. Thus, while trademark owners should expect to receive solicitations from scammers in the mail, they should not expect to receive solicitations via email.

### What to do?

To comply with this requirement, trademark applicants and registrants can choose to use

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an already-existing email address they check regularly. Alternatively, applicants and registrants can choose to create a new email address specifically for the purpose of corresponding with the USPTO. For example, an applicant or registrant can create a new email address, such as, [trademarks@yourdomainname.com](mailto:trademarks@yourdomainname.com). For applicants and registrants that are represented by an attorney, the USPTO will correspond only with the attorney of record regarding the trademark application or registration so this new email address will only be used in case the applicant or registrant is no longer represented by counsel.



To make sure applicants and registrants are aware of any official communications received from the USPTO at this new email address, an automatic forwarding rule can be created. This automatic forwarding rule can be set up to identify all communications received from an email address ending in “@USPTO.gov” and forward all such emails to one or more other email addresses.

All official correspondence regarding a trademark application or registration will come from the “United States Patent and Trademark Office” in Alexandria, Virginia, with zip code 22313 by mail. All official emails will come from the domain “@USPTO.gov.” If an applicant or registrant receives any notice regarding their application or registration and is asked to provide payment to an address that does not belong to the USPTO do not pay it and send it to your attorney for proper verification.



## NEWS & HIGHLIGHTS

### COVID-19 and the USPTO: What to Know

By: *Erin S. Phillips*<sup>6</sup>

With the passing of the Coronavirus Aid, Relief, and Economic Security (CARES)

Act, the USPTO announced extensions of certain patent and trademark-related deadlines on March 31, 2020 and April 28, 2020.

Prior to March 31st, the USPTO announced both the closing of its offices and its position that the effects of COVID-19 qualify as an “extraordinary situation” under 37 C.F.R. § 1.183 and 37 C.F.R. § 2.146. With this qualification, the USPTO waived certain requirements, such as the fee to revive abandoned trademark and patent applications, the fee to reinstate canceled/expired trademark registrations, and the requirement for original handwritten signatures on certain correspondence and for certain payments with the USPTO.

Under the CARES Act, the USPTO provided a 30-day extension of time for certain Patent- and PTAB-related deadlines and certain Trademark and TTAB-related deadlines. If an eligible document or fee was due between (and including) March 27, 2020 and April 30, 2020, the filing is considered timely if made within 30 days of the original due date, provided that the filing is accompanied by a statement that the delay in filing or payment is due to the COVID-19 outbreak (e.g., through office closures, cash flow interruptions, inaccessibility of files, personal or family illness, and travel delays). Certain time extensions only apply to small and micro entities, such as 30-day extensions for maintenance fee payments.

On April 28, 2020, the USPTO further extended the time to file eligible patent and trademark-related documents and to pay certain required fees, which otherwise would have been due between March 27 and May 31, to June 1, 2020.

As the COVID-19 situation continues to evolve, the USPTO may choose to extend relief under the CARES Act. If you believe that you are in need of relief for patent and trademark matters, please contact us.

<sup>6</sup> See note 1.