

REPORT

UPDATES TO REVISED TRADEMARK EXAMINATION GUIDE 1-20: NEW STANDARDS FOR SPECIMENS & REQUIREMENT FOR OWNER EMAILS

February 26, 2020

I. Introduction

On February 6, 2020, the United States Patent and Trademark Office (USPTO) published Examination Guide 1-20 (EG1-20), which provides information and instructions on several rule changes effective February 15, 2020. After nearly 200 trademark practitioners delivered a signed petition to the Acting Commissioner of Trademarks on the potential for negative impact to mark owners brought on by some of the impending changes, the USPTO published a Revised version of EG1-20 on February 14, 2020. These revisions primarily relate to a final rule published on July 31, 2019, which requires that all trademark filings must now be submitted electronically. The other significant changes of particular interest in EG1-20 relate to the higher standards for submission and analysis of specimens and changes to the correspondence information required for different applicants, registrants, or parties. These changes and their practical effects are summarized in relevant part below.

II. New Standards for Specimens

Trademark Rule 2.56, which provides the standard for specimen submissions made to the USPTO, was amended to more clearly state the

requirement that specimens must show actual use in commerce of the stated goods or services. The rule also sets out a more rigid standard for specimen submissions and the USPTO's subsequent examination of the same.

These new standards apply to all specimens or substitute specimens submitted on or after February 15, 2020 under any new-application or post-registration-maintenance filings, including: a new application under Trademark Act § 1(a); an amendment to allege use or a statement of use for § 1(b) filings; and affidavits or declarations of continued use or excusable nonuse under §§ 8 or 71. Standards specific to certain types of specimens were also provided based on the frequent issues presented by these categories to the USPTO.

A. Labels and Tags

Labels and tags bearing just the mark and submitted as specimens must now be physically attached to the goods to be considered sufficient. When not physically attached to the goods, labels and tags must clearly show the mark being used in actual commerce to still satisfy the standard.

To "clearly show actual use in commerce" the label or tag must show the mark with

February 26, 2020

information that typically appears for such goods when actually being sold to consumers. Examples of such information include net weight, volume, UPC bar codes, lists of contents or ingredients, and other information that is separate from the mark but specific to the goods.

B. Websites and Web-pages

All specimens that show goods or services by relying on a website or web-page must now provide both the URL of the site/page and the date of access by the one who captured it. This information can be provided to the USPTO in three ways: (1) directly on the specimen, appearing anywhere on the page itself; (2) within the electronic form submitted to the USPTO that contains the specimen; or (3) in an appropriate verified statement, if filed in a later response.

C. Unacceptable Specimens: Mark Depictions and Digital Alterations/Creations

The USPTO's changes include an illustrative list of items that are not acceptable as specimens because they fail to show actual use of the mark in commerce. These enumerated unacceptable specimens include: (1) a photocopy of the drawing of the mark; (2) an artist's rendering; (3) a printer's proof; (4) a computer illustration; (5) a digital image; or (6) a similar mockup of how the mark may be displayed.

D. Enquiries for Additional Info via Trademark Rule 2.61(b)

Under these rule changes, the USPTO and Examiners have been given more power to investigate actual use in commerce of an applicant or registrant, enquire further on the veracity of a specimen, and issue refusals for the same. Where specimens are refused for being insufficient or merely appear to be suspicious in some way — such as retouched photos appearing

on a white background or images where a mark appears to float over a product — Examiners may issue requests for more information under Trademark Rule 2.61(b). Furthermore, labels or tags that do not clearly show actual use in commerce because they appear to be a mock-up, or were otherwise created only for purposes of the application or post-registration process, are unacceptable and registration will be refused for failure to show the mark in actual use in commerce in connection with the goods.

This revision allows for a wide range of requests, such as for new specimens showing additional items named in a class, details on manufacturing procedures, or historical proof of sales. The USPTO has already begun to implement such requests through its Specimen Audit Program, so mark owners can now expect the same queries at various stages in prosecution of their mark based on this heightened standard. This procedure increases the risk that a mark may be refused for specimen-related reasons overall or that certain items may be invalidated under an application or registration. Mark owners can anticipate potentially greater effort needed to adequately respond to an Office Action or otherwise prosecute their mark successfully where such requests are made.

III. Email Requirement

Under EG1-20, the USPTO required that *all* mark owners *must* provide a unique email address for their own correspondence, regardless of whether represented by counsel already serving that role. The USPTO also provided a very specific list of what would qualify as an acceptable email for mark owners. The immediate and overwhelming negative feedback from trademark practitioners, however, prompted the USPTO to make changes in light of the response, leading to the revised version of the Guide.

February 26, 2020

Under the Revised EG1-20 rules, the USPTO now requests that where mark owners (whether applicant, registrant, or party to a proceeding) *are* represented by an appointed attorney, they *may* provide an email address of their choice. In such circumstances, the email address used by the mark owner *cannot* be identical to the email address listed for the primary Correspondent address of their attorney. The named Attorney of Record will remain the primary Correspondent for represented mark owners. For those mark owners who are *not* represented by an appointed attorney, they will be required to submit an owner email address that is identical to their information under the Correspondent address.

The standard for the mark owner's unique address was also relaxed from the original EG1-20 to provide that email addresses created specifically for communication and correspondence related to USPTO filings would be acceptable in both circumstances. Mark owners are encouraged to create such an email for this purpose so as to avoid unsolicited or fraudulent communications at a personal or business address.

IV. Recommendations & Conclusion

Under these rule changes, applicants and registrants can expect a greater number of specimen-based refusals and detailed enquiries into the sufficiency of the same from the USPTO. By consulting with U.S. counsel about adhering to the new rules for certain specimens, applicants and registrants can increase their chances of a successful submission on the first attempt. We recommend, for example, that mark owners be

mindful of affixing tags and labels to goods, or providing the additional information now required when not directly attached. Applicants and registrants should provide counsel with a URL and date of access for web-based specimens, even if impractical to place on the specimen files directly. Another best practice is to avoid submitting specimens that have been deemed unacceptable by the USPTO, such as printer's proofs or digital renderings of products. We also recommend that mark owners maintain records related to their use of specimens in anticipation of any enquiries from the USPTO under Trademark Rule 2.61(b).

Mark owners should also plan to create/provide a separate email address to use solely in connection with USPTO filings, especially if unrepresented by counsel. For those mark owners who are represented by an appointed attorney, they should discuss with their counsel how communications will best be handled procedurally going forward. Furthermore, where owners do provide a personal email address they should also expect to see a greater number of scam attempts, fraudulent letters, and the like. Mark owners should be diligent in contacting their counsel about any such correspondence received and should never submit payment to an unknown or unrecognized third party.

Please contact Oliff PLC with any questions at trademarkgroup@oliff.com.

* * * * *

Prepared by Holly M. Ford Lewis, Of Counsel and J.R. LoMonaco, Associate in our Alexandria, Virginia office. Holly and J.R. are members of our Trademark Group.

February 26, 2020

Oloff PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.

This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oloff PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.

For further information, please contact us by telephone at (703) 836-6400, facsimile at (703) 836-2787, email at email@oliff.com or mail at 277 South Washington Street, Suite 500, Alexandria, Virginia 22314. Information about our firm can also be found on our website, www.oliff.com.

スペシャルレポートの日本語版は、英語版の発行後、三週間以内にウェブサイトでご覧いただけます。