

John E. Ottaviani Comments On Unintended Consequences In USPTO's Questioning Of Trademark Applicants

Description

[John E. Ottaviani](#), Partner in the Intellectual Property & Technology Practice Group, provided some context to *World Trademark Review* on the issue of some trademark applicants suddenly being asked to show “proof of legal residence in the U.S.” The U.S. Patent and Trademark Office (USPTO) is suffering backlash from its examining attorneys, who are now required by new examination instructions to ask for the information, as they believe the question has no place in the trademark approval process.

In the *World Trademark Review* article, “‘Shaky legal ground’ – the unintended consequences of USPTO requests for proof of legal residence,” John noted that this type of question should only be asked in narrow circumstances, “if there is something to cause suspicion” such as “different individuals using the same PO box number” or “an individual with a ‘.cn’ email address claiming residence in the U.S.”

Other unintended consequences grow out of a new rule that requires a trademark applicant to declare a physical address (which then becomes publicly available information). John pointed out that “many people in the US have PO boxes for entirely legitimate reasons.” He continued noting, “For example, students and young professionals living in cities rent apartments on an annual basis and want a more permanent address for mailing purposes. Secondly, some professionals and businesses do not have a business office and work from home or a shared office space and use a PO box for the business address in order to look more professional or to shield their home address from clients/customers. Thirdly, domestic violence victims often use PO boxes and do not disclose their home address for fear of being victimized again. Ultimately, there is no need for the USPTO to become involved in requiring disclosure of the physical addresses, and in some cases, such disclosure could cause harm.”

Following the negative feedback from the USPTO's own staff as well as applicants, John suggested that the USPTO engage in dialogue leading to some explanation or clarification. John said that the USPTO could face problems in the future, “When the new rules were proposed, it said nothing about requiring applicants to state their domicile or principal place of business. The requirement was added when the new rule was promulgated, and then expanded upon when the USPTO issued its guidelines to examiners earlier this month. Therefore, trademark practitioners and the public have not been given any input into the rule and the unintended consequences it may cause. In my opinion, then, the USPTO may be on shaky legal ground unless until it follows the proper rule-making procedure.”

To read the *World Trademark Review* article, please click [here](#).

Date Created

September 5, 2019