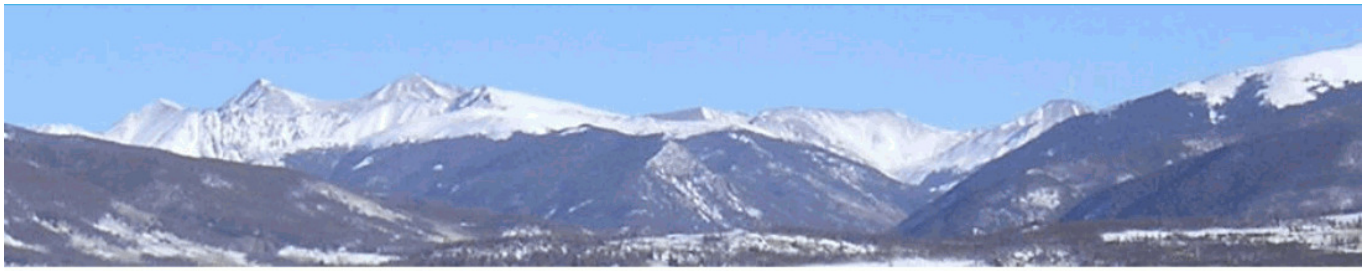

Current status of “tell us where you sleep at night?” (https://blog.oppedahl.com/?p=6075)

29th May, 2020 (https://blog.oppedahl.com/?p=6075) (https://blog.oppedahl.com/?author=1)

On July 2, 2019, the Trademark Office at the USPTO published a Final Rule stating that as of August 3, 2019, a trademark applicant would be required to reveal where he or she sleeps at night. I found this shocking at the time, and even now after the passage of almost a year, my sense of shock has not subsided.

What is this current status of this “tell us where you sleep at night?” requirement? Where did it come from exactly? To what extent can an applicant somehow protect his or her privacy and hold back from having to reveal where he or she sleeps at night?

In this much-too-long blog article I do the best I can to answer these questions.

What is this current status of this “tell us where you sleep at night?” requirement?

The situation in May of 2020 is that any owner of a US trademark registrant seeking to renew the registration will be faced with a place in the TEAS form that requires the owner to reveal where he or she sleeps at night.

If the owner is a natural person, then the information that the owner is required to provide is indeed “where he or she sleeps at night”.

If the owner is a legal person, then the information demanded by the Trademark Office (termed “domicile address”) is the revelation of the place where “the entity’s senior executives or officers ordinarily direct and control the entity’s activities and is usually the center from where other locations are controlled”. It will be appreciated that for many small startup businesses, there may be only one or two senior executives or officers, and the place where these things happen is extremely likely to be someone’s home. In other words, for many small startup businesses, when the Trademark Office demands to know the domicile address of the legal entity this works out to be the same thing as demanding to know where some natural person sleeps at night.

I will mention by the way that I am a named inventor on nine granted US patents, and in none of those application files did the Patent Office at the USPTO ever demand to know where I sleep at night. The relevant law and rules for US patents has never required that the inventor reveal more detail than merely the city and state where the inventor sleeps at night. (The rules also require that the inventor provide an address at which the inventor can receive postal mail, but those rules in no way require that the place where the inventor receives that postal mail be the same as the place where the inventor sleeps at night.)

There are many other parts of the world of intellectual property in which the domicile of a participant in the system is important or even crucial to some element of the system. For example under the Patent Cooperation Treaty (which is the international filing system for utility patents), the very question of whether an applicant is or is not eligible to make use of the Treaty turns specifically on whether the applicant is or is not a domiciliary or citizen of a country that belongs to the Treaty. Argentina, for example, does not belong to the PCT. If an applicant were, for example, a citizen of Argentina but a domiciliary of, say, the United States (which does belong to the PCT), then the only way that the applicant would be able to move forward through the PCT system would be by making of record the fact of the applicant being a domiciliary of the US. But I must point out that the level of detail required of the applicant is nothing more than naming the ***country*** where the applicant sleeps at night. Nothing about the PCT treaty or its rules requires that the applicant reveal where exactly within that country the applicant sleeps at night. And while the PCT does require that the applicant provide an address at which mail may be delivered, there is no requirement that this address be linked in any way with the domicile location.

The same is true of the Madrid Protocol (which is the international filing system for trademarks), and the same is true of the Hague Agreement (which is the international filing system for industrial designs). Yes, the applicant will have no choice but to reveal his or her country of domicile if the applicant wishes to rely upon his or her domicile to establish eligibility to make use of the relevant filing system. But nothing in the treaty or its rules will require that the applicant reveal where exactly within that country the applicant sleeps at night. (Each system does, however, require that the applicant provide an address at which the applicant can receive delivery of mail. Neither system requires that the address for delivery of mail be linked in any way to the location of domicile.)

But starting on August 3, 2019, the owner of a US trademark registration was required to reveal to the USPTO his or her street address of domicile as a precondition to renewal of the trademark registration.

Before August 3, 2019, the only level of detail required by the Trademark Office was that the owner reveal the state and country where the owner slept at night. But on and after August 3, the Trademark Office demanded to know the street address where the owner slept at night.

From the outset of this rule change, the Trademark Office did point out that there has always been a rule that says that anybody can petition the Commissioner for Trademarks for waiver of any rule. If you do not might paying $100, and if you can convince the Commissioner that you have some extraordinary circumstance, then the Commissioner will take your $100 and will waive the rule.

The rule taking effect August 3, 2019 applied not only to registrants seeking to renew trademark

registrations. It also applied to applicants seeking to obtain trademark registrations. Thus for example one of the new rules said that for a trademark application to be complete, it had to contain the domicile address of the applicant. One has no difficulty imagining that TYFNIL an adversary would take this as an invitation to inquire most invasively into the sleeping habits of the applicant at the time the application was filed, in an attempt to show that the supposed domicile address that had been set forth in the application-as-filed was not the true domicile address, and thus that the application should be deemed void *ab initio*.

Where did this "where you sleep at night?" inquiry come from exactly? As I described above, for the first many decades of the federal trademark registration system, the only level of detail required to be disclosed by the trademark applicant or registrant as to his or her domicile was the country, and in the case of the United States, the state and country. That level of required disclosure was (and remains to this day) statutory in nature. Then on August 3, 2019 for the first time the Trademark Office required a much more detailed detail of disclosure, not only to the name of the city where he or she sleeps at night but also the street address where he or she sleeps at night. But this new requirement was not statutory in nature. It was merely rule-based. (Which means that it is within the ability of the Commissioner for Patents to waive it, a point that surfaces at many points in this discussion.)

The Notice of Proposed Rulemaking that eventually led to this rule gave a single reason why it was supposedly necessary to drill down so deeply into the question of where the applicant sleeps at night — that single reason was an effort to smoke out the foreign applicant who might be attempting to use a "mail drop" located in the United States as a way of circumventing the brand-new requirement that foreign applicants must hire US trademark counsel.

By way of background, in previous years there had been many trademark applications coming into the Trademark Office which the Trademark Office felt to be improper, most of which were from China. The Trademark Office had arrived at several lines of attack to try to reduce the number of such applications. Nearly all such applications had been filed *pro se* and so one line of attack was a new rule that all foreign applicants would henceforth be required hire US trademark counsel.

It is easy enough to imagine what the Trademark Office would worry about with this new rule that all foreign applicants would henceforth be required hire US trademark counsel. The Trademark Office would worry that the foreign applicant would rent a box at a Commercial Mail Receiving Agency ("CMRA") such as a UPS store, or would get a post office box at a US post office, with the hope that this would permit the applicant to avoid having to hire US trademark counsel.

And this is exactly the reason the Trademark Office gave, in its Notice of Proposed Rulemaking, as to why it was asking the "where you sleep at night?" question. The idea would be that if the applicant is actually foreign, and if the place where the applicant sleeps at night is outside of the US, then the Trademark Office would have successfully identified an applicant that would need to be forced to hire US trademark counsel.

A bit of common sense can then be applied to this situation. If a trademark applicant hires US trademark counsel, or indeed if the application was filed in the first place by US trademark counsel, then ***there is no need to try to smoke out whether there is a need to force the applicant to hire US trademark counsel.*** And if a trademark applicant hires US trademark counsel, or indeed

if the application was filed in the first place by US trademark counsel, then ***it ceases to be relevant whether the applicant's domicile is in the US or outside the US***.

A bit more common sense could also be applied to this situation. To the extent that the Trademark Office feels that it is important to identify applicants who (a) have not hired US counsel and (b) have listed a Commercial Mail Receiving Agency or post office as their address, this is the sort of thing that is trivially easy for computers to do. The reason is that the US Postal Service provides an API (application programming interface) that rats out any address that is a CMRA or post office address. The API is provided free of charge by the USPS to any and all users. (I have blogged about this API here (https://blog.oppedahl.com/?p=5382) and here (https://blog.oppedahl.com/?p=5783) and here (https://blog.oppedahl.com/?p=5773).) Astonishingly, the Trademark Office has not made use of this API.

This leads us to the next question.

To what extent can an applicant somehow protect his or her privacy and attempt to limit disclosure of the place where he or she sleeps at night? One measure which the Trademark Office has taken is to provide "the check box". An applicant or registrant can fill out a TEAS form called CAR ("Change Address or Representation") and *uncheck* a box. This permits the filer to complete a field in the CAR form to indicate a domicile address that is not the same as the mailing address. The form states that the unchecking of the box will lead to the entered domicile address being "not publicly viewable in the USPTO's TSDR database". The information provided by the filer about where the filer sleeps at night goes somewhere — the form's instructions do not really say where — but according to the instructions the information will supposedly not be "publicly viewable".

A moment's thought reveals that this path provides only a limited amount of protection. The applicant or registrant who follows this path is still vulnerable to unknown privacy risks. Nowhere in this CAR form, nor anywhere else on the Trademark Office web site, is it explained where this "where you sleep at night" information gets stored. Suppose a member of the public files a Freedom of Information Act request for which a responsive document contains this information? Nowhere has the Trademark Office committed to redacting the "where you sleep at night" information before handing over the FOIA document to the party who made the FOIA request. Nor has the Trademark Office committed to notifying the party whose "where you sleep at night" information will imminently be disclosed that such a request has been made. The Trademark Office has also not clarified whether it would or would not routinely forward this "where you sleep at night" information to the Department of Commerce as described in the Federal Register notice of July 11, 2019 (https://www.federalregister.gov/documents/2019/07/16/2019-15222/collecting-information-about-citizenship-status-in-connection-with-the-decennial-census).

Those who work regularly with the Trademark Office are aware that there are many public-facing systems in addition to TSDR that disclose information about trademark filings. Nowhere in the CAR form nor anywhere else on the Trademark Office web site does the Trademark Office commit to protecting the "where you sleep at night" information from disclosure on those other non-TSDR systems.

Presumably the "where you sleep at night" information which a filer provides in the CAR form goes

somewhere, to some storage location within the computer systems of the USPTO. The Trademark Office has said nothing about where exactly within the USPTO's computer systems the "where you sleep at night" information goes, and has said nothing about the numbers and categories of USPTO employees with access to the "where you sleep at night" information. I suspect the number of USPTO employees and USPTO contractors who are able to gain access to the "where you sleep at night" information is at least in the hundreds and probably in the thousands. But in any event, USPTO has been silent about what protections, if any, it has set up for protection of the "where you sleep at night" information within the USPTO.

Consider the various categories of people who might feel it necessary to use this CAR form and to uncheck the box as a preliminary step before revealing to the Trademark Office where they sleep at night, out of a desire to prevent disclosure in TSDR of the "where you sleep at night" information. Such people include:

- victims of domestic violence
- celebrities
- persons who are concerned about risk of a family member being kidnapped
- wealthy persons

It is easy to imagine that a database filled with such sensitive information would be an extremely attractive target for a wide range of parties having many different intentions. A person concerned about privacy or safely might feel that the mere fact of having one's information stored in this database would itself be a substantial risk factor.

As was mentioned earlier the statutory authority for collecting "where you sleep at night" information is limited to *the country* where the filer sleeps at night, or if that country is the US, the country and *the state*. To the extent the Trademark Office has authority to require any "where you sleep at night" information in more detail than merely the state, such authority is derived solely from the Rule that was newly put into force on August 3, 2019. It is possible to file a petition requesting that the Commissioner for Trademarks waive a Rule. Thus, the filer who is concerned about the privacy or safety consequences of revealing to the Trademark Office his or her "where you sleep at night" address has the option of filing such a petition. If the Commissioner agrees that an "extraordinary" situation has been established, then the Commissioner can waive that rule and the filer can proceed with the filing process, disclosing merely the state in which the filer sleeps at night.

Applicants and registrants started filing such petitions soon after the "tell us where you sleep at night" rule went into effect, and by spring of 2020, hundreds of such petitions had been filed and not one such petition had been ruled upon. Within recent weeks, the petitions office has been slowly taking up a few of those petitions. Here (https://blog.oppedahl.com/wp-content/uploads/2020/05/85713838.pdf) for example is a grant on May 23, 2020 of such a petition filed by a person named Robert De Niro. I have filed several such petitions, one on my own behalf and several on behalf of clients of my firm. Some have been pending since as long ago as December of 2019; not one of them has yet been granted or dismissed. Only within recent days has any of my petitions been acted upon in any way, and for those petitions the only action by the Trademark Office has been to write a letter stating that the petition is supposedly incomplete and to request further information, failing which the petition would "likely be denied".

As one example of a "further information" letter, for one of our clients we filed a petition in

December of 2019, just like Mr. De Niro's petition. Mr. De Niro filed his petition December 18, 2019. We filed our petition December 29, 2019. Mr. De Niro's petition was granted May 23, 2020. On May 19, 2020 what we received from our petition examiner was not a grant of a petition but instead a letter telling us that our petition was incomplete. The reason that our petition was incomplete was that when we filed it, we failed to explain why "unchecking the box" in the CAR form did not satisfy our privacy and safety concerns.

There are two annoying things about this. First, we wonder why Mr. De Niro was not asked to explain why "unchecking the box" in the CAR form would not satisfy *his* privacy and safety concerns.

Second, at the time that we filed this petition on behalf of our client (December 2019), the CAR form did not yet exist. In December of 2019 there was no box to uncheck. The USPTO made this "uncheck the box" option available only in February of 2020. It would not have been possible for for the client to explain, in December of 2019, why the "uncheck the box" option was not sufficient to satisfy his concerns.

There is also the simple fact that even if eventually the Trademark Office were to arrive at some consistent approach for deciding who is or is not worthy of having this kind of petition granted, it seems unfair that the price to pay to protect one's privacy and safety is $100.

In one of our cases in which we filed a petition to try to avoid having to tell the Trademark Office where our client sleeps at night, the named applicant is an LLC. The petition examiner expressed skepticism that an LLC could even have any "safety and privacy concerns" and skepticism that forcing the LLC to reveal to the Trademark Office its "business domicile address" would be revealing anything sensitive at all. In response we pointed out that the Trademark Office defines the "business domicile address" as the location where the "senior executives or officers ordinarily direct and control the entity's activities." For many newly formed LLCs, there is but one senior executive, and the senior executive ordinarily directs and controls the entity's activities from his home. We pointed out that the Trademark Office's effort to force the LLC to reveal to the Trademark Office its business domicile address is the same thing as trying to force the senior executive to reveal to the Trademark Office where he sleeps at night. We further pointed out that any effort to force any natural person to reveal to the Trademark office where he or she sleeps at night is, by definition, an effort that presents extraordinary safety and privacy concerns.

How, in practical terms, does the Trademark Office actually enforce its requirement that the filer reveal to the Trademark Office where he or she sleeps at night? At present, the Office proceeds in a very simple way. First, a post office box is a red flag. Second, an "in care of" address is a red flag. In September of 2019 the Commissioner for Trademarks was quoted as saying "a post office box address is not a domicile because you can't live in a PO box." Whenever a Trademark Office person is examining an application or renewal where the applicant address or owner address is a post office box or an "in care of" address, an Office Action gets mailed that demands that the applicant or owner reveal to the Trademark Office where he or she sleeps at night.

Those who can afford it can, of course, do things like setting up a corporation to be the owner of the trademark, and arranging for a rented office for the corporation.

But there is also the reality that the Trademark Office fails to detect many cases where the filer did

not reveal where he or she slept at night. As a first example, it is possible to make use of the street address of a post office as a way to receive mail. This eliminates the telltale characters “p o box” in the mailing address. Just by clicking around in TSDR I have found cases where the Trademark Office failed to detect just such uses of a street address of a post office. In such cases, the Trademark Office will have failed to find out where the filer sleeps at night.

As a second example, many filers use a rented box at a UPS Store or other Commercial Mail Receiving Agency. Just by clicking around in TSDR I have found cases where the Trademark Office failed to note that the address used by the filer was this kind of address. In such cases, the Trademark Office will have failed to find out where the filer sleeps at night.

As discussed above, it would be a simple matter for the Trademark Office to make use of the Postal Service API to detect such mailing addresses. It is puzzling to wonder why the Trademark Office has failed to do so.

Again, the only level of scrutiny required *by statute* is that the Trademark Office is supposed to find out *the state* where the filer sleeps at night. It is only a mere rulemaking that led to the Trademark Office’s newfound interest in knowing the city and street address where the filer sleeps at night. But let’s circle back around to the sole reason that the Trademark Office has given for prying more deeply into the details of where a trademark filer sleeps at night than Congress seemed to think was necessary. That sole reason was to make sure that foreigners are being forced to hire US trademark counsel. Again, this means that if an applicant or owner has already hired US trademark counsel, then the goal of forcing the applicant or owner to hire US trademark counsel has already been achieved. What further need, not disclosed anywhere in the Notice of Proposed Rulemaking or in the Notice of the Final Rule, could there be for this nonstatutory deep dive into the details of where filers sleep at night for filers who have already hired US trademark counsel?

If the Trademark Office could articulate why exactly it supposedly needs to know the city and street address where trademark filers who have already hired US trademark counsel sleep at night, then it would be possible for members of the trademark community to react in a more informed way. Indeed depending on the reason or reasons articulated by the Trademark Office, maybe the trademark community would be able to suggest different approaches for accomplishing whatever it is that the Trademark Office wishes to accomplish.

Perhaps the most important single thing that the Trademark Office needs to understand is that the “uncheck the box” option in the CAR form comes nowhere close to addressing the safety and privacy concerns of many trademark filers who are natural persons. Maybe the filer’s “where you sleep at night” street address is routinely forwarded to the Department of Commerce as described in the July 11, 2019 Federal Register notice, even if the box in the CAR form is unchecked. Maybe members of the public could obtain the “where you sleep at night” street address simply by filing FOIA requests. Until such things are clarified, filers are going to feel they have no choice but to file petitions just like Mr. De Niro’s petition.

Quite frankly what really needs to happen is that the Rule calling for inquiry into the city and street address of the place where the trademark filer sleeps at night needs to be scrapped, at least for filers who have hired US trademark counsel. As I say, I am a named inventor on nine US patents, and in none of those patent application files did the Commissioner for Patents ever feel the need to

inquire more deeply into where I sleep at night than to ask for the city and state where I live. I simply cannot come up with any good reason why the Commissioner for Trademarks should feel the need to inquire so deeply.

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