



# Memorandum

July 31, 2019

## USPTO Announces New Rule Requiring US-Licensed Attorneys For Foreign-Domiciled Trademark Owners

On August 3, 2019, the U.S. Patent & Trademark Office (USPTO) will implement its new rule mandating that all foreign-domiciled trademark applicants and registrants retain representation by an attorney who is licensed to practice law in the United States. The new regulation will prohibit foreign-domiciled applicants and registrants from prosecuting applications or registrations and from engaging in Trademark Trial and Appeal Board (TTAB) proceedings absent an attorney who is U.S.-barred. As such, neither individuals permanently residing outside of the United States or its territories, nor parties with a principal place of business outside of the United States or its territories, will be able to file submissions with the USPTO or the TTAB unless they are represented by an attorney licensed in the United States.

The new rule is largely in response to the recent and substantial increase in the number of bad-faith filings received by the USPTO. Ultimately, in an attempt to maintain the integrity of the U.S. federal trademark register, the USPTO is endeavoring to significantly reduce the number of foreign *pro se* applicants and registrants and in turn negate potentially fraudulent claims, spurious specimens, and the incorrect identification of practitioners who are not accredited or sanctioned to represent foreign applicants and registrants before the USPTO. Given the various nuances of U.S. trademark law including, by way of example, the local rules and intricacies associated with use-in-commerce and bona fide intent-to-use requirements, the new rule will safeguard the accuracy and legitimacy of the information populating the U.S. federal register and of the trademark registration process in general.

The rule also changes the scope of work permitted by Canadian patent and trademark agents in the U.S. Canadian patent agents may no longer represent parties before the USPTO. Certain Canadian trademark attorneys and agents may be recognized as additionally appointed practitioners. However, only U.S.-licensed attorneys are authorized to correspond with the USPTO on trademark matters.

The regulation is applicable to all filings after August 3, 2019, indicating that all future filings to the USPTO and submissions to the TTAB will need to be filed by U.S.-licensed attorneys. To ensure compliance, the USPTO will now require that all attorneys submit their U.S. state bar membership and verification that they are in good standing. While the USPTO will not require a U.S.-licensed attorney to be appointed if an

application was filed or a registration was issued prior to August 3, those filings which are submitted by foreign-domiciled individuals and entities after the August 3 effective date will be suspended and an order will issue necessitating the appointment of a U.S.-domestic attorney.

With the deadline rapidly approaching, those foreign-domiciled parties that have not yet done so would be well advised to seek U.S. counsel quickly. For more information about this new trademark regulation, and to retain U.S. counsel as required by the USPTO, please contact your COJK attorney.

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This memorandum is not intended to provide legal advice, and no legal or business decision should be based on its content. Questions concerning issues addressed in this memorandum should be directed to:

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