

USPTO Requires U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants

Earlier in July 2019, the United States Patent and Trademark Office (USPTO) issued a final rule amending the Rules of Practice in Trademark Cases, the Rules of Practice in Filings Pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, and the rules regarding Representation of Others Before the USPTO. This new rule requires foreign-domiciled trademark applicants, registrants, and parties to a Trademark Trial and Appeal Board proceeding to be represented by a U.S. licensed attorney. This rule will go into effect August 3, 2019.

A “foreign-domiciled” trademark applicant, registrant, or party is either or both: a) an individual with a permanent legal residence outside the United States or its territories; b) an entity with its principal place of business (headquarters) outside the United States or its territories. This requirement also applies to all Canadian applicants, registrants, and parties. This rule does not impact individuals and companies from the United States.

The USPTO believes that this requirement for using a U.S. licensed attorney will ensure that the agency “can effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters; provide greater confidence to foreign applicants and the public that registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims; and aid USPTO efforts to improve accuracy of the U.S. Trademark Register.” This will ultimately aid U.S. applicants, registrants and parties as it will reduce costs for assessing any conflicts and reduce any disputes over a mark.

If you would like additional information about this new USPTO rule, please contact any of the professionals listed below:

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