

USPTO Announces New Trademark Rule: U.S. Attorney Representation Required for Foreign-Domiciled Parties



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The United States Patent and Trademark Office (USPTO) just yesterday announced a new rule requiring all foreign-domiciled trademark applicants, registrants and parties to Trademark Trial and Appeal Board (TTAB) proceedings to be represented by an attorney who is licensed to practice law in the United States. The new rule takes effect on August 3, 2019.

Starting August 3, all foreign applicants and registrants *must* be represented by a U.S. attorney. Furthermore, all new applications, renewal filings and TTAB disputes filed on behalf of any foreign entity must be filed by a U.S. attorney.

This rule applies to all current and any new filings. If a trademark application was filed (or if a registration was obtained), prior to the rule being implemented, the USPTO will *not* require a U.S. attorney be appointed. However, if the USPTO issues an Office Action, the response must be filed by a U.S. attorney. Similarly, any statement of use due after August 3, 2019 must also be filed by a U.S. attorney. Accordingly, in most cases, even filings made prior to the new rule will need a U.S. attorney.

Foreign-domiciled applicants who submit an application based on section 66(a) of

the Act (Madrid application) are also subject to the requirement to appoint a qualified U.S. attorney.

Of immediate concern are TTAB proceedings where a foreign-domiciled party is not currently represented by a U.S. attorney. In this case, the TTAB will suspend the proceeding and will require appointment of a U.S. attorney.

The new rule will take effect on August 3, 2019. Since it is unlikely that the USPTO will grant any extensions, foreign-domiciled entities with trademark matters before the USPTO should immediately make plans to seek U.S. attorney representation.

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