

USPTO Requires Non-US Trademark Applicants To Retain US-Licensed Attorneys

Description

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The U.S. Patent and Trademark Office (USPTO) has announced new rules that will go into effect **3 August 2019**. Under the new rules, all new applications and renewal applications filed by a person or entity not domiciled in the U.S. **must** be filed by an attorney licensed to practice before the USPTO.

Prior to 3 August 2019, non-U.S. applicants may continue to file applications with and respond to office actions from the USPTO without appointing a U.S. licensed attorney. But if the USPTO issues an office action prior to 3 August, the non-U.S. applicant will need to appoint a U.S. licensed attorney to respond to the office action after that date.

The proposed requirement is similar to the requirement that currently exists in many other countries, such as Brazil, Chile, the People's Republic of China, Israel, Japan, Jordan, Republic of Korea, Morocco, and South Africa, as well as the European Union.

Who is Affected by the New Rules?

The new rules affect all applicants for registration of trademarks, and those submitting declarations of use or renewal applications in the U.S. who are not domiciled in the U.S. This includes applicants attempting to extend international registrations to the U.S. via the Madrid Protocol, although for now such applicants will only be required to appoint a U.S. licensed attorney if the USPTO issues a provisional refusal or office action. The rules also apply to parties in opposition and cancellation proceedings before the Trademark Trial and Appeal Board.

The changes also affect Canadian applicants, Canadian patent agents and Canadian trademark attorneys and agents. In particular, Canadian patent agents will no longer be authorized to represent Canadian trademark applicants, registrants or parties before the USPTO. Canadian trademark attorneys and agents will continue to be eligible to be recognized as secondary appointed practitioners who can represent their Canadian clients, but Canadian applicants must also appoint a U.S. licensed attorney, and the USPTO will correspond only with the appointed U.S. licensed attorney.

Why is the USPTO Implementing These Rules?

The USPTO believes that the new rules will: (1) instill greater confidence in the public that U.S. registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims, and (2) enable the USPTO to more effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters. Contributing to the USPTO's concerns is the fact that filings from non-US applicants without an attorney nearly tripled between fiscal year 2015 and fiscal year 2017.

What Should You Do Before 3 August 2019?

Some U.S. attorneys already have received e-mails from persons in other countries, offering to pay to use the attorney's contact information in trademark filings. We strongly discourage this strategy, which could subject the U.S. attorneys to discipline by the USPTO and their state bar authorities. In addition, the USPTO could cancel any resulting registration or declare a pending application abandoned for circumvention of USPTO rules.

Non-U.S. applicants who do not wish to engage U.S. counsel should consider filing new U.S. applications or extensions of protection for international registrations prior to 3 August. If the filing is complete and no further action is required by the applicant, the USPTO has stated that it will not require the appointment of a U.S. licensed attorney as to that filing. However, if a further office action is issued, the office action will include a requirement for the appointment of a US licensed attorney. For this reason, we recommend that non-U.S. applicants engage a U.S. licensed attorney *prior* to filing such applications, to avoid the time and expense of responding to the office action.

Similarly, owners of U.S. registrations who file Section 8 or Section 71 declarations of use or Section 9 renewal applications prior to 3 August 2019 do not need to appoint a U.S. licensed attorney. Again, the USPTO has stated that if the filing is complete, and no further action is required by the applicant, the USPTO will not require such appointment unless a further office action is issued.

Non-U.S. applicants should also be aware that the USPTO has recently started a pilot program to audit declarations of use for registrations that include four or more items in a single class, or at least two classes with two or more goods and services. If the USPTO audits the declaration, the owner will receive an office action from the Examining Attorney, requesting proof of use of the mark, as of the date the declaration was submitted, for at least two additional goods for each audited class. The USPTO will provide the applicant a period of six months to respond to this request, as well as to any other issues raised by the Examining Attorney. For this reason we strongly recommend that *before* filing the Declaration, the non-U.S. applicant or its attorney confirm that the mark is being used in the U.S. on *each* item listed in the statement of use or registration. If the mark is not in use on an item, that item should be deleted from the application or registration unless there is an acceptable explanation (for which the standard is very high).

Contact Us for Assistance

Partridge Snow & Hahn LLP assists U.S.-based and non-U.S. based clients to protect trademark rights in the U.S., and assists U.S. based clients to expand and protect trademark rights outside the U.S. For information or to request our assistance, please contact [John E. Ottaviani](mailto:jottaviani@psh.com), Chair of our Intellectual Property and Technology Practice, at +1-401-861-8200 or jottaviani@psh.com.

Please let us know if you have any questions about the new rules or U.S. practice going forward. Also, we are happy to discuss the rules with any of your colleagues or clients who may not have U.S. offices or relationships and who may need to appoint U.S. licensed attorneys to represent their non-U.S. domiciled clients.

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