



ARE Trademark Law Alert: New U.S. Patent & Trademark Office Rule Requires Foreign Trademark Applicants and Registrants to Be Represented by U.S. Attorneys

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A new rule introduced by the U.S. Patent & Trademark Office (“USPTO”) and taking effect on August 3, 2019 requires foreign trademark applicants and registrants to be represented by licensed U.S. attorneys.

After that date, the USPTO will no longer accept trademark applications, renewal applications, statements or declarations of use, or any other trademark filings from individuals and organizations outside the U.S. who are not represented by U.S. attorneys. In other words, foreign trademark owners will not be able to make any trademark-related filings with the USPTO on their own (“pro se”). This change was made to combat the rapidly increasing number of fraudulent pro se trademark filings made by foreign applicants, which constitutes a significant problem for the USPTO and legitimate trademark owners alike. From now on, foreign owners of trademark rights wishing to seek, secure and maintain trademark protection in the United States should either retain services and work directly with U.S. counsel or have their local trademark counsel retain qualified U.S. attorneys to represent them.

Foreign applicants who designate the United States for trademark protection as part of International Registration under the Madrid Protocol are also subject to this requirement. The World Intellectual Property Organization (“WIPO”) does not presently offer an option in the Madrid Protocol application form to designate U.S. counsel to represent the applicant. Therefore, until such time as WIPO changes its practices and forms to accommodate this new rule, the USPTO will waive the requirement for the small subset of Madrid applications that are submitted with all other U.S. formalities and statutory requirements satisfied, so that they are in condition for acceptance and publication for opposition purposes. For the vast majority (97%) of Madrid Protocol applications designating the United States, however, foreign applicants will be informed in the first Office Action of the requirement to appoint a qualified U.S. attorney to represent them, and such applications will be deemed abandoned if the Office Action is not addressed within the prescribed six-month response period by a U.S. attorney.

All official communications that require a response (e.g., Office Actions) that the USPTO issues with respect to pro se U.S. trademark applications, renewals, or maintenance filings pending or due as of August 3, 2019, regardless of their application or registration basis, will include the requirement to retain services of U.S. counsel.



To combat fraud, the USPTO has set up internal auditing policies to detect foreign pro se applicants or registrants who would attempt to get around this rule by using temporary or false U.S. addresses, or by alleging that they are represented by U.S. attorneys whom they have not actually engaged. The USPTO may sanction foreign applicants or registrants who seek to circumvent the rule in this manner by deeming their applications to be abandoned or cancelling their registrations.

The USPTO anticipates that this rule change will decrease the amount of fraudulent pro se trademark applications filed by foreign applicants, and will increase the overall quality and integrity of registered U.S. trademarks by ensuring that foreign applicants and registrants have the benefit of the expertise of qualified U.S. attorneys subject to the higher standards of professional care as well as rules of professional ethics and USPTO's disciplinary authority. Although this change may increase the cost of obtaining and maintaining U.S. trademarks for parties who previously acted pro se, the USPTO anticipates that this rule should ultimately benefit all legitimate trademark owners as they will enjoy cost savings on prosecution as well as enforcement proceedings involving fraudulent trademark applications or registrations.

Please contact us if you have any questions regarding this issue. We will continue to monitor and report on further developments in this area of the law as they occur.

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