

USPTO Requires That Foreign Trademark Applicants Engage a U.S. Licensed Attorney

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On July 2, the United States Patent and Trademark Office ("USPTO" or "Office") adopted a rule requiring all non-U.S. individuals and businesses seeking a trademark registration to retain U.S. licensed attorneys. The rule's representation requirement, which takes effect August 3, 2019, applies to individuals and businesses whose permanent legal residence or principal place of business is not in the United States.

The USPTO rule uses the term "attorney" to describe individuals licensed to practice law. Non-U.S. jurisdictions may describe such licensed individuals by a different term than "attorney." Consequently, some non-U.S. individuals and businesses may not be familiar with that meaning of the word. For example, Canadians are accustomed to using the term "lawyer" to identify those licensed to practice law. Under the rule the meaning of the term "attorney" is the same as "lawyer" or any other non-U.S. jurisdiction term that identifies one licensed to practice law.

The USPTO provides that the rule was adopted in response to the vast increase in the number of fraudulent pro se applications filed by non-U.S. individuals and businesses with the USPTO. The requirements of the new rule are consistent with those of many other industrialized states, such as the European Union and Japan.

The representation requirement also applies to any Statement of Use, Statement of Continued Use (5-6 year maintenance filing) and Renewal Application filings as well as Trademark Trial and Appeal Board proceedings relative to applied for or registered trademarks of non-U.S. individuals and businesses.

The rule also requires that U.S. attorneys representing clients in trademark matters before the USPTO confirm they are an active member in good standing of their state bar and provide their bar license and other information.

What do you need to do?

Non-U.S. applicants with pending applications who have not retained U.S. counsel should retain U.S. counsel and file the engagement information with the USPTO. Applicants that have not engaged U.S. counsel by August 2, 2019, will be informed in an Office action that they must appoint a qualified U.S. attorney. The applicant will have the usual six-month period to engage U.S. counsel and respond to the Office action. Failure to comply will result in abandonment of the application.

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