

Featured Professionals

Cynthia A. Moyer

Related Services

Trademarks & Copyrights

Important Change at the Trademark Office – U.S. Attorney Required

Legal Update

08.05.2019

By Cynthia A. Moyer

Beginning August 3, 2019, all foreign-domiciled trademark applicants, registrants and parties will be required to have a U.S. attorney appear on their behalf in the U.S. Trademark Office. “Foreign-domiciled” means either (1) an individual with a permanent legal residence outside the United States or its territories; or (2) an entity with its principal place of business (headquarters) outside the United States or its territories.

What does this mean in practice?

Any new trademark application filed on or after August 3, 2019, with a Section 1 or Section 44 filing basis for a foreign-domiciled applicant must be filed by a U.S. attorney, or the U.S. Trademark Office will issue an office action and the applicant will have six months to respond and appoint a U.S. attorney.

If an application was filed before August 3, 2019, is currently pending in the USPTO and an office action is outstanding, the applicant must appoint an attorney in order to respond to the office action.

That said, for pending applications that were filed before August 3, 2019, if someone other than a U.S.-licensed attorney filed an application or application-related or registration-related submission with the U.S. Trademark Office before the effective date of this new rule, and the submission is otherwise acceptable, the submission will be accepted without the requirement to retain a U.S. attorney.

For registered marks, the registrant is not required to immediately appoint a U.S. attorney. Rather, the registrant need not appoint a U.S. attorney until/unless there is a filing to be made (Section 8, Section 71 and Section 15 declarations, for example), but be aware that the registrant cannot make any filings in the U.S. Trademark Office without a U.S. attorney.

What about Madrid applications?

According to the final rule, there is currently no provision for designating a U.S. attorney in an application submitted to the IB. Therefore, the U.S. Trademark Office will waive the requirement to appoint a qualified U.S. practitioner prior to publication for the small subset of Madrid applications (2.9 percent of all Madrid applications in fiscal year 2017) submitted with all formalities and statutory requirements already satisfied and in condition for publication upon first action until the Madrid system is updated to allow for the designation of a U.S. attorney. If an office action is issued in connection with a Madrid application, however, the applicant will be required to appoint a U.S. attorney in order to respond.

Does this apply in the Trademark Trial and Appeal Board (TTAB)?

Yes, a foreign-domiciled party will be required to appear through a U.S. attorney. If a foreign-domiciled party is currently participating in a TTAB proceeding without a U.S. attorney, the TTAB will suspend the proceeding to allow the foreign-domiciled party to retain U.S. counsel.

If you have questions about this new rule, please let us know.