

New USPTO Rule Requires Foreign Applicants, Registrants, and Parties to TTAB Proceedings to Be Represented by U.S. Counsel

July 31, 2019

A new USPTO rule recently came into effect that impacts foreign applicants, registrants, and parties to proceedings before the Trademark Trial and Appeal Board (“TTAB”). The new rule requires all foreign applicants, registrants, and parties¹ to be represented by a U.S.-licensed attorney in any dealings with the USPTO or the TTAB that take place after August 3, 2019. An individual or entity is “foreign-domiciled” if its permanent legal residence or principal place of business is located outside the U.S. or its territories.

The USPTO’s new rule aims to increase compliance with U.S. trademark law and USPTO regulations, as well as increase public confidence in U.S. trademark registrations. In passing this rule, the U.S. follows multiple other jurisdictions that have adopted similar requirements, including Brazil, Chile, China, the European Union, Israel, Japan, Jordan, Republic of Korea, Morocco, and South Africa. The full text of the rule change can be found in the [Federal Register](#).

The New Rule’s Impact on Foreign Applicants

Whether the USPTO’s new procedure will immediately impact a foreign applicant’s trademark application depends on when the application was filed and whether any further action is required to prosecute the application. For foreign-owned applications filed before the effective date, the USPTO will not require the appointment of U.S. counsel if no further action is required as to that filing. If, however, an application was filed before the effective date and an Office action issues or is responded to after the effective date, the USPTO will require the appointment of a U.S.-licensed attorney. Trademark applications submitted on behalf of foreign applicants after the effective date must be filed by a U.S.-licensed attorney. In the event a foreign applicant’s application does not meet this requirement, an Office action will issue that will include the requirement.

One exception to the new rule applies with respect to Madrid applications, which are initially filed with the International Bureau of the World Intellectual Property Organization and are then transmitted to the USPTO. Because there is currently no mechanism for designating a U.S. attorney in an application submitted through this process, the USPTO will waive the requirement for Madrid applications that are submitted in condition for publication until the Madrid system can be updated.

Requirements for Current Registrations

The same procedure applicable to applications will be followed for post-registration maintenance and renewal filings. Maintenance and renewal filings submitted before the effective date will not require appointment of a U.S. attorney if no further action is required. If, however, a post-registration Office action issues or is

¹ Notably, third parties who submit a letter of protest regarding pending applications pursuant to section 1715 of the Trademark Manual of Examining Procedure are not applicants, registrants, or parties to a proceeding before the TTAB. Therefore, they are not subject to the requirement of this rule to appoint U.S. counsel.

responded to after the effective date, the foreign registrant will need to retain U.S. counsel to respond to the post-registration Office action. Any maintenance or renewal filing submitted after the effective date must be submitted by a U.S.-licensed attorney.

Foreign Parties Engaged in TTAB Proceedings

With regard to proceedings before the TTAB, the new rule will be applied to all proceedings filed on or after the effective date as well as to any proceedings that are pending on the effective date and require further action by a foreign party. If a foreign party is not currently represented by U.S. counsel, the TTAB will suspend the proceeding and inform the party of the timeframe in which it must retain U.S. counsel.

Because the USPTO and TTAB are unlikely to grant foreign applicants, registrants, and parties to proceedings substantial time to obtain U.S. counsel once warranted, affected foreign individuals or entities should seek U.S. counsel as soon as possible.

•••••

This alert was authored by Lee J. Eulgen (312-269-8485, leulgen@nge.com) and Kara Smith (312-269-5283, ksmith@nge.com).

If you have any questions related to this article or would like additional information, please reach out to your contact in the [Intellectual Property group](#) or the authors.

Please note that this publication should not be construed as legal advice or a legal opinion on any specific facts or circumstances. The contents of this publication are intended solely for general purposes, and you are urged to consult a lawyer concerning your own situation and any specific legal questions you may have.

The alert is not intended and should not be considered as a solicitation to provide legal services. However, the alert or some of its content may be considered advertising under the applicable rules of the supreme courts of Illinois and certain other states.