

# **U.S. TRADEMARKS NOW REQUIRE A U.S. ATTORNEY**



## **U.S. Trademarks Now Require a U.S. Attorney**

The United States Patent and Trademark Office (USPTO) has changed its rules regarding filings by foreign individuals and companies. Effective August 3, 2019, all foreign domiciled parties must be represented by a U.S. licensed attorney in connection with trademark-related submissions to the USPTO.

Any individual with a permanent legal residence outside the United States or entity with its principal place of business outside the United States now needs a U.S. licensed attorney to file documents with

the USPTO on their behalf.

This new requirement applies to:

- Applications and registrations to the United States Patent & Trademark Office (USPTO)
- Proceedings before the Trademark Trial and Appeal Board (TTAB)
- All foreign domiciled parties who wish to file new trademark or service mark applications in the United States

### **Filings prior to August 3, 2019**

Applications filed prior to the effective date of this rule will remain valid, but a U.S. attorney must be appointed for any future filings – such as Office Action responses or Statements of Use. Similarly, maintenance filings for registrations issued prior to August 3 must also be submitted by a U.S. attorney.

### **Madrid Protocol**

International applications with extensions to the U.S. filed through the World Intellectual Property Organization using the Madrid Protocol may initially be filed without a U.S. attorney, but the requirement for a U.S. attorney will be made in all Office Actions.

### **Canada**

Canadian trademark attorneys and agents who are reciprocally recognized by the USPTO's Office of Enrollment and Discipline can still be listed as "additionally appointed practitioners," however, their clients must also appoint a U.S. licensed attorney to serve as the primary point of contact with the USPTO.

### **Background**

The USPTO adopted this rule in response to an increasing number of foreign parties filing inaccurate and fraudulent submissions that did not comply with U.S. law or USPTO rules. The rule is intended to help maintain the integrity of the U.S. trademark register and help the USPTO ensure compliance with relevant laws and regulations.

This information is provided as an educational service by Hoge Fenton for clients and friends of the firm. This communique is an overview only, and should not be construed as legal advice or advice to take any specific action. Please be sure to consult a knowledgeable professional with assistance with your particular legal issue.



Please contact Hoge Fenton Trademark Attorney **Dana Brody-Brown** at **[dana.brodybrown@hogequenton.com](mailto:dana.brodybrown@hogequenton.com)** for more information.

Find out more about our **Trademark Counseling and Protection Group**

## Related Attorneys

- Dana Brody-Brown