

USPTO Proposes to Require US Attorneys to Prosecute Trademark Applications Filed by Non-US Applicants

Description

Recently, the United States Patent and Trademark Office (USPTO) issued a [proposed rule](#) to require all applicants who have their domicile or principal place of business outside the United States to hire an attorney who is licensed to practice law to represent them in trademark matters before the USPTO. The new rule would apply to applicants filing their own applications, as well as to applicants filing through the Madrid Protocol and requesting to extend protection to the United States.

The USPTO believes that the new rule will: (1) instill greater confidence in the public that U.S. registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims, and (2) enable the USPTO to more effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters. Contributing to the USPTO's concerns is the fact that filings from non-US applicants without an attorney nearly tripled between fiscal year 2015 and fiscal year 2017.

The proposed requirement is similar to the requirement that currently exists in many other countries, such as Brazil, Chile, the People's Republic of China, Israel, Japan, Jordan, Republic of Korea, Morocco, and South Africa, as well as the European Union.

Currently, Canadian patent agents and trademark agents are permitted to practice before the USPTO through a reciprocal agreement between the Canadian Intellectual Property Office and the USPTO. The proposed rule would remove the authorization for reciprocally recognized Canadian **patent agents** to practice before the USPTO in trademark matters, but continues to allow reciprocal recognition of Canadian **trademark attorneys and agents** in trademark matters. Those Canadian patent agents already recognized to practice in U.S. trademark matters would continue to be authorized to practice in pending trademark matters on behalf of Canadian parties only: (1) so long as the patent agent remains registered and in good standing in Canada and (2) in connection with an application or post-registration maintenance filing pending before the Office on the effective date of the proposed rule, for which the recognized patent agent is the representative. Recognized Canadian trademark attorneys and agents would continue to be authorized to represent Canadian parties in U.S. trademark matters.

We do not know yet if or when this new rule will take effect. The USPTO is soliciting comments on the rule until 18 March 2019, and then will consider the comments before proposing the final rule. We expect the rule to be in place by Summer 2019, if not sooner.

Some U.S. attorneys already have received e-mails from persons in other countries, offering to pay to use the attorney's contact information in trademark filings. We do not recommend this strategy. Such a practice could subject the U.S. attorneys to discipline by the USPTO and their state bar authorities. In addition, the USPTO could cancel any resulting registration or declare a pending application abandoned for circumvention of USPTO rules.

We would be pleased to assist foreign attorneys and their clients with US trademark filings should the new rule be imposed. Please contact us for more information.

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