

Client Alert

No Registration Without Representation: U.S. Requires Foreign Trademark Owners to Engage U.S.-Licensed Attorneys

July 24, 2019

Effective August 3, 2019, the U.S. Patent and Trademark Office (USPTO) will require all foreign-domiciled trademark applicants, registrants, and parties to a trademark proceeding to be represented by an attorney who is licensed to practice law in the United States. This requirement will apply to any entity with a principal place of business outside of the United States and its territories and any individual with a permanent legal residence outside of the United States and its territories.

This new rule is one of the USPTO's responses to an increasing number of inaccurate, overbroad, and in some instances, possibly fraudulent trademark submissions, some of which originate abroad. The goal of this rule (and other USPTO efforts not focused solely on foreign trademark owners) is to help improve the accuracy of the U.S. trademark register and increase compliance with U.S. trademark law.

According to the USPTO, "increasing numbers of foreign applicants are likely receiving inaccurate or no information about the legal requirements for trademark registration in the U.S., such as the standards for use of a mark in commerce, who can properly aver to matters and sign for the mark owner, or even who the true owner of the mark is under U.S. law." As further explained by Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of the USPTO, "Businesses rely on the U.S. trademark register to make important legal decisions about their brands. In order to maintain the accuracy and integrity of the register, for the benefit of all its users, the USPTO must have the appropriate tools to enforce compliance by all applicants and registrants. This rule is a significant step in combatting fraudulent submissions."

Currently pending applications and submissions filed by someone other than a U.S.-licensed attorney will be considered by the USPTO as-is. However, applicants and registrants may not respond after August 3, 2019 to USPTO office actions without first appointing U.S. counsel. Further, for ongoing TTAB proceedings where a foreign-domiciled party is not currently represented by a U.S.-licensed attorney, the TTAB will suspend the proceeding and require appointment of a U.S.-licensed attorney.

Further guidance can be found [here](#).

For more information, please contact the professional(s) listed below, or your regular Crowell & Moring contact.

Anne Elise Herold Li

Partner – New York

Phone: +1.212.895.4279

Email: ali@crowell.com

Deirdre Long Absolonne

Senior Counsel – New York

Phone: +1.212.803.4065

Email: dabsolonne@crowell.com

Michelle Chipetine

Associate – New York

Phone: +1.212.895.4221

Email: mchipetine@crowell.com