

# U.S. Attorney Required for Foreign Trademark Applicants and Registrants, Beginning August 3, 2019

July 2, 2019

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Today, the U.S. Patent and Trademark Office (USPTO) announced that, beginning August 3, 2019, an applicant, registrant, or party to a trademark proceeding whose domicile is not located within the United States or its territories must be represented by a qualified U.S. attorney. This new requirement is reflected in [amendments to the federal trademark regulations at 37 C.F.R. § 2.11](#).

Foreign trademark owners and practitioners should familiarize themselves with this new rule and the key provisions outlined below so that they will be ready to comply as of August 3, 2019.

## **1. *Applies to Individuals or Entities Domiciled Outside the U.S. or its Territories.***

The requirement for U.S. counsel applies only to applicants, registrants or parties to a trademark proceeding whose "domicile" is not located within the U.S. or its territories. "Domicile" is now defined as "the permanent legal place of residence of a natural person or the principal place of business of a juristic entity." 37 C.F.R. § 2.2(o). The term "principal place of business" is defined as "the location of a juristic entity's headquarters where the entity's senior executives or officers ordinarily direct and control the entity's activities and is usually the center from where other locations are controlled." 37 C.F.R. § 2.2(p).

## **1. *Applies to New Applications or Proceedings Filed On or After August 3, 2019***

The requirement to appoint U.S. counsel applies to all foreign applications or proceedings filed by covered individuals or entities on or after August 3, 2019. Specifically, original applications filed with the USPTO under Section 1 of the U.S. Trademark Act (the Lanham Act) must be filed by U.S. counsel to be considered complete. The new rule also applies to applicants claiming priority to a foreign application (Section 44(d)) or relying on ownership of a foreign registration (Section 44(e)). If a foreign applicant is not represented by a U.S. attorney when filing a new application under Sections 1 or 44 of the Lanham Act, all is not lost. The USPTO will issue an Office Action requiring that a U.S. attorney be appointed, leaving the applicant with 6 months from the date of the Office Action to comply with the new rule, while maintaining the original filing date.

The new requirement also applies to a request for extension of protection transmitted by the International Bureau (IB) of the World Intellectual Property Organization to the USPTO pursuant to the [Madrid Protocol \(Section 66\)](#). There is currently no mechanism at the IB by which a U.S. attorney may be designated. As a result, for the time being, the USPTO will take a lenient approach to Madrid filings. Specifically, for Madrid filings in which all other formalities are met, the USPTO will waive the U.S. attorney requirement and allow the application to proceed.

The new rule requiring U.S. counsel also applies to proceedings at the USPTO, such as Oppositions, Cancellations or Appeals before the Trademark Trial and Appeal Board.

1. ***Applies to Applications, Registrations and Proceedings Pending as of August 3, 2019***

If they have not already done so, foreign individuals or entities who own U.S. trademark applications and registrations filed or issued prior to August 3, 2019 must appoint U.S. counsel by the time of the next filing. One method of compliance is to submit a Power of Attorney with the next required filing, such as a response to Office Action, Statement of Use, or Application for Renewal of Registration. For foreign entities that own several trademark applications and registrations, another option is to file a single Power of Attorney for all trademark applications and registrations owned by that entity, thus satisfying the new rule in one easy step.

1. ***Must Designate a Qualified U.S. Attorney***

The new rule requires appointment of an attorney qualified to practice under 37 C.F.R. § 11.14. Specifically, a qualified U.S. attorney is an active member in good standing of the bar of any of the 50 states of the U.S., the District of Columbia, or any Commonwealth or territory of the U.S.

As part of ensuring compliance with the new rule, beginning August 3, 2019, U.S. qualified attorneys submitting filings with the USPTO on behalf of foreign parties must provide additional information about themselves. Specifically, the U.S. attorney must provide the name of the State in which he or she is an active member in good standing, the date of admission to that state bar, and the bar license number.

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In order to avoid delays in the prosecution or maintenance of U.S. trademarks, it is important to consult with U.S. counsel prior to August 3, 2019 to ensure compliance with the new rule requirements. Goulston & Storrs is available to assist foreign trademark owners with any U.S. trademark matters.

*If you have a question about this development, we invite you to reach out directly to the authors, [Andrew Ferren](#) or [Andrew O'Connor](#), or any member of our [Intellectual Property Group](#).*

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