Foreign Trademark Applicants and Registrants Must Now Be Represented By US Counsel

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Intellectual Property Alert
7.16.19

Effective August 3, 2019, all foreign-domiciled trademark applicants, registrants and parties to proceedings before the Trademark Trial and Appeal Board must be represented by an attorney who is licensed to practice law in the United States pursuant to a new rule announced in early July by the Trademark Office.

The stated purpose of the rule is to combat fraud and improve the quality of submissions to the Trademark Office. Therefore, U.S.-licensed attorneys representing the trademark filers must provide their contact information, bar membership information and show they are an active member in good standing of their bar. Foreign-domiciled applicants which file Madrid applications are subject to the requirement in connection with all provisional refusals, *i.e.* Office Actions, but not for their initial application with the International Bureau of the World Intellectual Property Organization.

Current submissions filed by non-U.S. attorneys will be accepted until the effective date only. It is best practice for all foreign-domiciled applicants, registrants and parties to retain a U.S.-licensed attorney immediately.

It's been a busy year in the U.S. trademark world. In addition to the new rule discussed above, the Trademark office published guidelines on cannabis-related goods, and the U.S. Supreme Court recently ruled that the Lanham Act's prohibition on the registration of "immoral" or "scandalous" trademarks violates the First Amendment. For now, hire U.S. counsel.

For further information on trademark issues, please contact a member of the Intellectual Property group.

This correspondence should not be construed as legal advice or legal opinion on any specific facts or circumstances. The contents are intended for general informational purposes only and you are urged to consult a lawyer concerning your own situation and legal questions.