

July 2019

Foreign Trademark Applicants Now Need U.S. Attorneys, Says Trademark Office

By James H. Donoian and Susan Okin Goldsmith

The United States Patent and Trademark Office has announced that all foreign trademark applicants and registrants and all parties to Trademark Trial and Appeal Board proceedings must be represented by a U.S.-licensed attorney. The new rule applies to any party filing in the Trademark Office or appearing before the Trademark Board whose permanent legal residence or principal place of business is outside the United States. This new rule is meant to maintain the accuracy and integrity of the register as well as to combat fraudulent filings. Trademark applications filed by foreign entities through a procedure known as the Madrid Protocol are unaffected by this rule change, but further prosecution of those applications and contested matters in the United States must now be handled only by U.S.-qualified lawyers.

The new requirements are effective **August 3, 2019**. McCarter & English can assist and answer any questions you may have about how this rule change could affect your trademark applications and pending trademark actions in the Trademark Office.



James H. Donoian
212.609.6817
jdonoian@mccarter.com



Susan Okin Goldsmith
732.867.9670
sgoldsmith@mccarter.com

If you would like additional information on this topic, please contact the authors, or your lawyer at McCarter & English, LLP.