

Examination Guide 4-19

Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants

August 2019

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On July 2, 2019, the United States Patent and Trademark Office (USPTO) published a final rule (*Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants*, 84 FR 31498) requiring applicants, registrants, or parties to a trademark proceeding whose domicile is not located within the United States (U.S.) or its territories (hereafter foreign applicants, registrants, or parties) to be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the U.S. (including the District of Columbia or any commonwealth or territory of the U.S.) (hereafter U.S. attorney). In addition, the final rule requires U.S. attorneys to provide their bar information when representing applicants and registrants, whether domiciled inside or outside the U.S. It also removes the ability of foreign patent attorneys or agents to seek reciprocal recognition to practice before the USPTO. The changes become effective August 3, 2019 and supersede the current edition of the Trademark Manual of Examining Procedure (TMEP) to the extent any inconsistency exists.

I. REQUIREMENT FOR REPRESENTATION

Under this rule, the USPTO amended Trademark Rule 2.11 to require foreign applicants, registrants, or parties to a trademark proceeding to be represented by a U.S. attorney. 37 C.F.R. §2.11(a). Further, the USPTO may require such applicants, registrants, or parties to: (1) furnish information or declarations necessary to the proper determination of whether the applicant, registrant, or party is subject to the requirement for a U.S. attorney, and (2) to state whether assistance was received in a trademark matter before the USPTO and, if so, to disclose the name(s) of the person(s) providing such assistance and whether any compensation was given or charged. 37 C.F.R. §2.11(b), (c).

All applications must include the applicant's domicile address and foreign applicants must appoint a U.S. attorney for the application to meet the requirements for a complete application. See 37 C.F.R. §§2.11(a), 2.32(a)(2), (a)(4), 2.189. Foreign applicants submitting an application using the TEAS Plus filing option will be required to designate a U.S. attorney in the application in order to complete the submission of the application. 37 C.F.R. §2.22(a)(21).

A. Determining Domicile

The term "domicile" means 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 "principal place of business" is 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). Under this rule, applicants and registrants must provide and keep current the address of their domicile. 37 C.F.R. §§2.22(a)(1), 2.32(a)(2), 2.189.

The initial determination of whether an applicant's, registrant's, or party's domicile is within or outside the U.S. is based on its physical address. A post-office box cannot be a domicile address. When necessary, the USPTO will require an applicant or registrant to verify its domicile. For example, in the situations listed below, the USPTO will implement the following procedures on the effective date of the rule:

1. U.S. or foreign citizen/entity with foreign address

If the applicant or registrant is not represented, the examining attorney or post-registration specialist will issue an Office action that requires the applicant or registrant to appoint a U.S. attorney as its representative. The Office action will also include any other applicable refusals and/or requirements. If the applicant responds, but does not appoint U.S. counsel, the examining attorney will issue a final action as to the requirement for U.S. counsel and all other unresolved refusals/requirements. The post-registration specialist will issue a second action maintaining the requirement for U.S. counsel and maintaining all prior unresolved refusals and/or requirements.

2. U.S. citizen/entity with U.S. post-office box address

The examining attorney will contact the applicant, or its attorney if the applicant is represented, or issue an Office action to require the applicant's domicile address. 37 C.F.R. §2.32(a). Examining attorneys may enter the address into the record by an examiner's amendment if the domicile address and potential requirement for U.S. counsel are the only issues to be addressed, or if all other issues can also be addressed by examiner's amendment. If the examining attorney is unable to obtain the address from the applicant or

its attorney by phone or email, or if there are other requirements or refusals, he or she will issue an Office action requiring the domicile address and requiring appointment of U.S. counsel if domicile is outside the U.S. and the applicant is pro se.

If the submission is a post-registration maintenance document, the post-registration specialist will issue an Office action requiring the domicile address and, if the registrant is pro se, requiring appointment of U.S. counsel if domicile is outside the U.S.

3. Foreign citizen/entity with U.S. street address

Foreign citizens must comply with U.S. visa immigration laws to claim the U.S. as their permanent legal residence. When the applicant or registrant is a foreign citizen/entity with a U.S. street address, it is necessary to determine whether the U.S. street address is the applicant's or registrant's domicile because domicile dictates whether an applicant or registrant is required to have an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory represent them at the USPTO. See 37 C.F.R. §§2.2(o), 2.11(a), 2.189. Establishing for the record that the U.S. street address is the applicant's or registrant's domicile is necessary even if the applicant or registrant is represented by U.S. counsel when the application or post-registration document is filed. Therefore, the examining attorney or post-registration specialist will issue an Office action requiring the applicant or registrant to provide *all* of the following:

- (1) An explanation of the basis for claiming that the U.S. address provided in the "Owner Information" section of the application or post-registration document is applicant's/registrant's lawful permanent residence (if an individual) or business headquarters (if a juristic entity).
- (2) Documentation showing that the address is applicant's or registrant's address of residence (for an individual) or business headquarters (for a juristic entity).
- (3) Appointment of U.S. counsel if domicile is outside the U.S. and the applicant or registrant is pro se.

The Office action will also include all other applicable refusals and/or requirements.

If the applicant or registrant responds by amending its address to a *foreign street address* and appointing U.S. counsel (if pro se), the requirements regarding domicile have been satisfied.

If the applicant responds but does not provide the information necessary to verify its U.S. domicile, the examining attorney will issue a final action as to the requirements regarding domicile, U.S. counsel (if appropriate), and all other unresolved refusals and/or requirements, if the application is otherwise in condition for final. If the registrant responds but does not provide the information necessary to verify its U.S. domicile, the post-registration specialist will issue a second action maintaining the requirements regarding domicile, U.S. counsel (if appropriate), and all other unresolved refusals and/or requirements.

If a pro se applicant responds by appointing U.S. counsel, but does not amend to a foreign address or provide the information necessary to verify its U.S. domicile, the examining attorney will issue a final action as to the requirements regarding domicile and all other unresolved refusals and/or requirements, if the application is otherwise in condition for final. If a pro se registrant responds by appointing U.S. counsel, but does not amend to a foreign

address or provide the information necessary to verify its U.S. domicile, the post-registration specialist will issue a second action maintaining the requirements regarding domicile and all other unresolved refusals and/or requirements.

4. Foreign citizen/entity with U.S. post-office box address

When the applicant or registrant is a foreign citizen/entity with a U.S. post-office box address, the examining attorney or post-registration specialist will issue an Office action requiring the applicant or registrant to provide *all* of the following:

- (1) The applicant's/registrant's domicile address.
- (2) If a U.S. street address is provided in the response, an explanation of the basis for claiming that the U.S. address is applicant's/registrant's lawful permanent residence (if an individual) or business headquarters (if a juristic entity). See Section I.A.3.
- (3) Documentation showing that the U.S. street address is applicant's or registrant's address of residence (for an individual) or business headquarters (for a juristic entity). *Id.*
- (4) Appointment of U.S. counsel if domicile is outside the U.S. and the applicant or registrant is pro se.

As noted in Section I.A.3, establishing for the record that a U.S. street address is the applicant's or registrant's domicile is necessary even if the applicant or registrant is represented by U.S. counsel when the application or post-registration document is filed. The Office action will also include all other applicable refusals and/or requirements.

If the applicant or registrant responds by amending its address to a foreign street address and appointing U.S. counsel (if pro se), the requirements regarding domicile have been satisfied.

If the applicant responds by amending to a U.S. street address, but does not provide the information necessary to verify its U.S. domicile, the examining attorney will issue a final action as to the requirements regarding domicile, U.S. counsel (if appropriate), and all other unresolved refusals and/or requirements, if the application is otherwise in condition for final. If the registrant responds by amending to a U.S. street address, but does not provide the information necessary to verify its U.S. domicile, the post-registration specialist will issue a second action maintaining the requirements regarding domicile, U.S. counsel (if appropriate), and all other unresolved refusals and/or requirements.

If a pro se applicant responds by appointing U.S. counsel and amending to a U.S. street address, but does not provide the information necessary to verify its U.S. domicile, the examining attorney will issue a final action as to the requirements regarding domicile and all other unresolved refusals and/or requirements, if the application is otherwise in condition for final. If a pro se registrant responds by appointing U.S. counsel and amending to a U.S. street address, but does not provide the information necessary to verify its U.S. domicile, the post-registration specialist will issue a second action maintaining all prior unresolved refusals and/or requirements.

5. Joint owners

If there are joint owners, and one joint owner is U.S. domiciled, a U.S. attorney is not required. However, if, for example, there are multiple foreign-domiciled owners and a single foreign owner (i.e., foreign citizen) with a U.S. street address or post-office box, the examining attorney or post-registration specialist will follow the procedures in Sections I.A.3 or I.A.4.

6. Government entities/federally recognized Indian tribes with U.S. street or U.S. post-office box address

No inquiry regarding domicile is required.

B. Determining Whether U.S. Attorney Is Required

Since the requirement for a U.S. attorney is based solely on domicile, if an applicant's, registrant's, or party's domicile is outside the U.S. or its territories, a U.S. attorney is required. With regard to documents filed prior to, and on or after the effective date, the USPTO will implement the following procedures.

1. Application and Registration Documents Filed Prior to Effective Date

When a new application, or an application- or registration-related document, is submitted prior to the effective date of the rule, but is not examined until on or after the effective date:

- If the document requires no further action by the applicant or registrant, the examining attorney or post-registration specialist will not require appointment of a U.S. attorney *as to that filing*.
- If the examining attorney or post-registration specialist must issue a first or supplemental Office action, the Office action will include the requirements regarding domicile and appointment of U.S. counsel, when appropriate, per Section I.A. 37 C.F.R. §§2.11, 2.32(a)(2), 2.189. If the requirement is made in a supplemental Office action, it raises a new issue that requires a nonfinal action.

However, if a petition, request for reinstatement, or post-publication amendment is submitted prior to the effective date of the rule, but is not decided or examined until on or after the effective date, the USPTO will follow the current procedures for such documents and will not require appointment of a U.S. attorney *as to those filings*.

2. Application and Registration Documents Filed on or After Effective Date

a. Trademark Act Section 1 and/or Section 44 Applications

When the USPTO receives a trademark application filed on or after August 3, 2019 by a foreign domiciliary, with a filing basis under Section 1 and/or Section 44, 15 U.S.C. §§1051, 1126, the examining attorney will conduct a complete review of the application and issue an Office action that includes the requirement for domicile, and for U.S. counsel, when appropriate, as well as any other refusals and/or requirements.

If, after a complete review of an application filed by a foreign domiciliary, the examining attorney determines that it would otherwise be in condition for publication upon first action,

the examining attorney must nevertheless issue an Office action requiring the applicant to appoint a U.S. attorney. The applicant will have six months to respond to the Office action. 37 C.F.R. §2.65(a).

To appoint or designate a U.S. attorney, the applicant should (1) submit a Trademark Electronic Application System (TEAS) Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative form and (2) promptly notify the examining attorney that this TEAS form was submitted. If there are no other refusals and/or requirements, submission of a form appointing a U.S. attorney is an acceptable response to the Office action. Alternatively, if the applicant has already retained a U.S. attorney and no recognized practitioner (e.g., a reciprocally recognized Canadian trademark attorney or agent) is already of record in the application, the U.S. attorney can respond to the Office action by using the appropriate TEAS response form and provide his or her attorney information in the form and sign it as applicant's attorney. See 37 C.F.R. §2.17(b)(1)(ii). Note that if the applicant is properly represented by a recognized Canadian trademark attorney or agent, the U.S. attorney cannot appear by signing a response to the Office action and must first be appointed using the TEAS Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative form *before* submitting a response to the Office action. See Section III below.

b. Trademark Act Section 66(a) Applications

Foreign-domiciled applicants who submit an application based on Section 66(a) (Madrid application), 15 U.S.C. §1141f, are also subject to the requirement to appoint a U.S. attorney. Madrid applications are initially filed with the International Bureau (IB) of the World Intellectual Property Organization and subsequently transmitted to the USPTO. There is currently no provision for designating a U.S. or any other local attorney in an application filed with the IB. Therefore, until an application submitted to the IB provides for such designation, the USPTO will not enforce the requirement to appoint a U.S. attorney prior to publication for those Madrid applications that comply with all formalities and statutory requirements when received by the USPTO, such that the application is in condition for publication upon first action.

However, if the examining attorney issues an Office action that includes any substantive refusals and/or requirements, the examining attorney will also include a requirement to appoint a U.S. attorney or otherwise follow the procedures in Sections I.A.1-I.A.5, as appropriate.

c. Statements of Use

Statements of use are reviewed by the ITU/Divisional Unit to determine whether they are timely and in compliance with the minimum filing requirements listed in Rule 2.88(c). 37 C.F.R. §2.88(c); TMEP §1109.02. The USPTO will follow its current procedures regarding statements of use that are untimely. TMEP §1109.02. A statement of use filed by a foreign applicant that is timely and meets the minimum filing requirements under Rule 2.88(c) will be referred to the examining attorney for examination on the merits. The examining attorney will conduct a complete review of the statement of use and issue an Office action that includes the requirements regarding domicile and appointment of U.S. counsel discussed in Section I.A, when appropriate, as well as any other refusals and/or requirements. 37 C.F.R. §§2.11, 2.32(a)(2), 2.189.

d. Post-Registration Documents

When the USPTO receives a post-registration document under Sections 7, 8, 9, 15, or 71, 15 U.S.C. §§1057, 1058, 1059, 1065, 1141(k), filed by a foreign domiciliary, the post-registration specialist will examine the filing in accordance with current examination guidelines by conducting a complete review of the document and issuing an Office action that includes the requirement for domicile, and for U.S. counsel, when appropriate, as well as any other refusals and/or requirements. 37 C.F.R. §2.11(b).

e. Petitions to the Director, Requests for Reinstatement, and Post-Publication Amendments

When the USPTO receives a petition to the Director, a request for reinstatement, or a post-publication amendment filed by a foreign domiciliary, an attorney or paralegal in the Office of the Deputy Commissioner for Trademark Examination Policy will notify the petitioner that appointment of U.S. counsel is required and of any other deficiencies. The applicant or registrant will be granted 60 days to appoint U.S. counsel and to supplement the petition or request for reinstatement, as appropriate. If the applicant or registrant does not appoint U.S. counsel and submit any additional necessary information within the time allowed, the petition or request for reinstatement will be denied or the amendment will not be entered.

3. Trademark Trial and Appeal Board (TTAB) Proceedings

Regarding proceedings before the TTAB, if it is necessary to require a foreign party to obtain a U.S. attorney, the TTAB will suspend the proceedings and inform the party of the time frame within which it must obtain a U.S. attorney.

4. Review on Petition of Requirement for a U.S. Attorney

When the USPTO issues an Office action that maintains only a requirement for U.S. counsel and/or additional information under Rule 2.11 (a), (b), and/or (c), or maintains only the requirement for the TEAS Plus processing fee under Rule 2.22(c) in addition to one or all of those requirements, an applicant's or registrant's recourse for seeking review is limited to a petition to the Director under Rule 2.146. 37 C.F.R. §§2.11(f), 2.146, 2.165, 2.186, 7.40.

II. RECOGNITION OF REPRESENTATIVES AND REQUIREMENT FOR BAR INFORMATION

Under amended Rules 2.22(a)(21) and 2.32(a)(4), a U.S. attorney must provide his or her bar information as a requirement for a TEAS Plus application or a complete trademark application. 37 C.F.R. §§2.22(a)(21), 2.32(a)(4). Moreover, amended Rule 2.17(b)(3) makes the requirement for bar information applicable to recognized attorneys in all trademark filings. 37 C.F.R. §2.17(b)(3).

On the effective date of this rule, the majority of the TEAS forms will include specific fields to enter attorney bar information for the attorney of record. The information will not be required for other appointed attorneys. If attorney bar information and/or the attestation that the attorney is an active member in good standing of the referenced bar is omitted or incomplete, the examining attorney will issue an Office action requiring the bar information and/or attestation of active bar membership in good standing.

III. RECIPROCAL RECOGNITION

Foreign attorneys and agents must be granted reciprocal recognition by the USPTO pursuant to Rule 11.14(c) and (f) in order to practice before the USPTO in trademark matters. In any trademark matter where a reciprocally recognized foreign trademark attorney or agent is representing an applicant, registrant, or party to a proceeding whose domicile is not in the U.S., a qualified U.S. attorney must also be appointed as the representative who will file documents with the USPTO and with whom the USPTO will correspond. 37 C.F.R. §11.14(c)(2).

Currently, only Canadian attorneys and agents are reciprocally recognized under Rule 11.14(c)(1) to represent applicants, registrants, and parties located in Canada (Canadians). The final rule removes reciprocal recognition of foreign patent attorneys and agents to practice before the USPTO in trademark matters. Thus, on the effective date of the rule, Canadian patent attorneys and agents whose recognition to represent Canadians in trademark matters before the USPTO is solely based on their recognition to practice in patent matters in Canada will not be authorized to handle new trademark matters before the USPTO. Currently recognized Canadian patent attorneys and agents will continue to be authorized to represent Canadian parties in connection with an application or post-registration maintenance filing, for which they are listed as the representative, which was pending before the USPTO before the effective date of the rule. Recognized Canadian trademark attorneys and agents continue to be authorized to represent Canadian parties in U.S. trademark matters as "other appointed attorneys."

With regard to documents filed before the effective date of the rule by a reciprocally recognized Canadian trademark or patent attorney/agent, the USPTO will follow the same procedures as those discussed above:

- If the document requires no further action by the applicant or registrant, the USPTO will not require appointment of a U.S. attorney *as to that filing*.
- If a first or supplemental Office action must be issued, the Office action will include the requirement for appointment of a U.S. attorney. If the requirement is made in a supplemental Office action, it raises a new issue that requires a nonfinal action.

After the effective date of the rule, reciprocally recognized Canadian trademark attorneys and agents may:

- Prepare, sign, and file new applications (TEAS Plus applications require designation of a U.S. attorney)
- Prepare and sign other application- and registration-related submissions, including responses and other formal communications; a U.S. attorney must file the submissions with the USPTO
- Receive courtesy copies of USPTO communications