



## American Intellectual Property Law Association

The Honorable Andre Iancu  
Under Secretary of Commerce for Intellectual Property and  
Director of U.S. Patent and Trademark Office  
U.S. Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

*Attn: Catherine Cain*  
*Office of Deputy Commissioner for Trademark Examination Policy*  
*Via email: [TMFRNotices@uspto.gov](mailto:TMFRNotices@uspto.gov)*

**Re: AIPLA Comments on Proposed Rulemaking for Requirement of U.S.  
Licensed Attorney for Foreign Trademark Applicants and Registrants**

Dear Under Secretary Iancu:

The American Intellectual Property Law Association (AIPLA) is pleased to offer comments in response to the Notice of the U.S. Patent and Trademark Office (USPTO) proposed rulemaking for “Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants.” Written comments were requested in a Federal Register Notice dated February 15, 2019, Vol. 84, No. 32.

AIPLA is a national bar association of approximately 13,500 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

AIPLA supports the Trademark Office's efforts to ensure an accurate and reliable Trademark Register that minimizes needless costs and burdens on trademark owners who increasingly face the problem of fraudulent filings. AIPLA believes that the USPTO's proposed rule requiring the appointment of U.S. counsel to guide non-U.S. applicants, registrants, and parties in trademark matters is a useful and necessary first step in minimizing problematic filings, but is concerned that it will not fully address the issue. For example, some concern has been raised that implementation of the proposed rule may create an influx of U.S. based "trademark" companies with business models that are based on low fees for high volume and which, perhaps, do not provide adequate legal advice – thereby failing to eliminate the problem of fraudulent filings. Nevertheless, AIPLA supports the proposed rule and expects that it will help to decrease

the number of fraudulent filings by foreign applicants, registrants, or parties, and will more easily permit the USPTO to take disciplinary action, as needed, once the party is represented by U.S. counsel.

#### *Examination of National Applications by Foreign Applicants*

For those applicants who are subject to the proposed rule, the USPTO is considering whether to (1) defer full examination of an application filed by a foreign applicant until the applicant complies with the U.S. counsel rule; or (2) conduct a complete examination of the application and issue an Office action that includes the U.S. counsel requirement along with other refusals and requirements.

AIPLA favors deferring full examination of the application until the foreign applicant complies with the U.S. counsel rule. The USPTO should not expend valuable resources examining applications that the applicant may choose to abandon, rather than comply with the U.S. counsel requirement. In the Office action raising the requirement, AIPLA suggests making it clear that (1) applicant has six months to retain U.S. counsel and comply with the requirement and (2) failure to comply with the requirement will result in the abandonment of the application and forfeiture of the application filing fee.

#### *Examination of Applications based on Section 66(a)*

Although the proposed U.S. counsel rule applies to applications based on section 66(a) of the Act (Madrid Applications), the USPTO is considering waiving the requirement for a small subset of applications in which all formalities and statutory requirements have been satisfied and are therefore ready for publication.

AIPLA supports the waiver in this limited circumstance, especially since there is no current mechanism for designating a U.S. counsel or any other local attorney, with the International Bureau when an application is initially filed. This issue should be revisited once the Madrid system is updated to allow for the designation of a U.S. attorney at the timing of filing.

#### *Reciprocal Recognition*

Reciprocity under §11.14 would continue to be recognized, but only for registered and active foreign attorneys or agents who are in good standing before the trademark office of the country in which the attorney or agent resides and practices, and only for the purpose of representing parties located in such country, provided the trademark office of such country and the USPTO have reached an official understanding to allow substantially reciprocal privileges. Currently, only Canadian attorneys and agents are reciprocally recognized under § 11.14(c). The proposed change effectively removes authorization for reciprocally recognized Canadian patent agents to practice before the USPTO in trademark matters although those with trademark matters before the USPTO on the effective date of the proposed rule would be grandfathered in so long as the patent agent remains registered and in good standing in Canada. Canadian trademark agents would continue to be allowed to practice before the Office.

AIPLA supports reciprocity for registered and active Canadian attorneys and trademark agents in good standing before the Canadian Intellectual Property Office and agrees that Canadian

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patent agents, except those grandfathered in as proposed by the USPTO, should not be deemed to meet the new standard.

AIPLA appreciates the opportunity to provide comments regarding proposed changes to the Trademark Rules of Practice to require that foreign applicants, registrants, or parties be represented by U.S. counsel. Please let us know if AIPLA can offer any additional comments or input.

Sincerely,

A handwritten signature in blue ink, appearing to read "Sheldon Klein", with a stylized flourish at the end.

Sheldon Klein

President

American Intellectual Property Law Association