

**International Trademark Association Comments in Response to:  
Proposal to Require U.S. Licensed Attorney for Foreign Trademark  
Applicants and Registrants**

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The International Trademark Association (INTA) appreciates the opportunity to provide comments in response to the notice of *Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants* (the “Notice” for the “Proposed Rule(s)”) of the United States Patent and Trademark Office (“USPTO”) to amend the Rules of Practice in Trademark Cases regarding representation of others before the USPTO in trademark matters. The USPTO Subcommittee of INTA’s Trademark Office Practices Committee prepared the following comments.

**A. General Comments**

INTA commends the USPTO’s efforts to instill greater public confidence in the integrity and accuracy of the U.S. Trademark Register and submissions before the agency. INTA also supports the USPTO’s efforts to enforce compliance with U.S. Statutory and Regulatory Requirements. INTA supports the Proposed Rules to require applicants, registrants, and parties to proceedings before the USPTO without U.S. domicile to be represented by a qualified U.S. attorney. INTA recognizes the significant and increasing problem of the unlawful practice of law and pro se foreign trademark applicants and registrants filing inaccurate and possibly fraudulent applications and submissions before the USPTO in violation of the Trademark Act and rules. Further, INTA agrees that the current mechanisms and rules are inadequate to fully address these issues. With respect to the Proposed Rules, INTA offers the following questions and comments.

**B. Effective Date & Implementation of Proposed Rules**

The Notice is unclear on the effective date and how the Proposed Rules will be implemented or applied to: (1) newly-filed trademark applications; (2) pending trademark applications and existing registrations; (3) pending proceedings before

the Trademark Trial and Appeal Board (“TTAB”); and (4) letters of protest and other petitions and filings before the USPTO.

***1. Newly-Filed Trademark Applications Under Sections 1 and 44 of the Act***

With respect to newly-filed trademark applications under Sections 1 and/or 44 of the Act filed by a foreign domiciliary, INTA supports the proposal to issue an Office Action requiring a U.S. attorney appointment. The USPTO Office Action should give the usual six-month response period. INTA urges the USPTO to conduct a complete examination of such applications and to issue one Office Action that includes the U.S. attorney requirement along with any other refusals and requirements. This approach will avoid piecemeal prosecution, keep the application moving forward, and help overall pendency.

***2. Newly-Filed Trademark Applications Under Section 66(a) of the Act***

INTA supports a procedure where the USPTO conducts a complete examination of an application filed under Section 66(a) and issues an Office Action that includes the U.S. attorney requirement along with any other refusals and requirements. If the Section 66(a) application is in condition for first action publication, INTA supports the USPTO’s proposal to waive the U.S. attorney requirement in this limited situation, but only until such time as the Madrid system is updated to allow designation of a U.S. attorney upon filing.

***3. Pending Trademark Applications & Registrations***

The Proposed Rules should apply to trademark applications pending as of the effective date of any Final Rule (for example, an application suspended or pending with a First Action or Final Action refusal). For pending applications, the USPTO could consider raising the U.S attorney requirement as part of any subsequent Office Action that may issue before publication. If a subsequent Office Action is required in order to address the U.S. attorney requirement, an applicant should be allowed the usual six month response period, with failure to comply resulting in abandonment of the application.

With respect to existing registrations, INTA proposes that the USPTO consider issuing a post-registration Office Action with the U.S. attorney requirement upon

review of the Section 8/9 filings. A registrant should be allowed the usual six months to respond to the post-registration Office Action, with failure to comply resulting in surrender of the registration.

#### **4. *TTAB Proceedings & Petitions***

Proposed Rule §2.11(a) covers “[a]n applicant, registrant, or party to a proceeding...” INTA assumes that “a party to a proceeding” includes all parties involved in *ex parte* and *inter partes* (plaintiffs and defendants) proceedings before the Trademark Trial and Appeal Board (“TTAB”), Letters of Protest and other petitions filed before the USPTO. The comments to the Final Rule notice should clarify all “proceedings” and “part[ies]” covered under §2.11(a).

To the extent TTAB and petition proceedings are covered by §2.11(a), INTA supports a procedure where the TTAB and petition attorney may issue an order or Office Action addressing the U.S. attorney requirement during the pendency of those proceedings. Such orders should allow a reasonable response period and provide clear statements on the consequences for failure to comply.

#### **C. *Proposed Rule §2.11—Requirement for Representation***

INTA supports the Proposed Rules to amend §2.11(a) to require applicants, registrants, or parties to a proceeding whose *domicile or principal place of business* (§2.2) is not located within the U.S. or its territories to be represented by an attorney who is an active member in good standing of a bar of the highest court of any of the 50 states or the U.S., the District of Columbia, and any Commonwealth or territory of the U.S.

##### **1. *Confirming Accuracy of U.S. Domicile Under § 2.11(a) & (b) and Preventing Foreign Domiciliary From Circumventing Rules***

INTA is concerned that the Proposed Rules and comments do not fully address instances where, for example, foreign applicants or registrants use temporary or intermediary U.S. addresses for purposes of circumventing the Proposed Rules, all the while still representing themselves as pro se. INTA is aware of instances where foreign applicants have already used what appear to be temporary U.S. addresses upon filing applications.

INTA is also concerned that foreign applicants and registrants may, without permission or consent, fraudulently use the address and contact information of U.S. attorneys, but nonetheless continue to handle matters pro se. Because business before the USPTO is conducted primarily through email, and not mail to a physical address of record, foreign applicants and registrants may attempt to manipulate U.S. attorney information to circumvent the Proposed Rules.

The USPTO could consider alerting and training employees to identify suspicious domicile, attorney, and email issues. The USPTO could also use Proposed Rule §2.11(b) and existing §2.61(b) to require additional information or declarations regarding the accuracy of such domicile and contact information in appropriate cases. Similarly, the TTAB could consider using its inherent authority to manage cases on its docket to issue orders to show cause regarding suspicious domicile, attorney, or other representation issues.

## 2. *Confirming U.S. Attorney Qualifications*

The Proposed Rules and comments do not specify in detail how U.S. attorneys representing parties before the USPTO in trademark matters will be required to show active membership in good standing with a state bar. To the extent that the USPTO will require attorneys to submit state bar numbers or other membership information, INTA notes that some jurisdictions do not provide attorney bar numbers. The USPTO could consider providing qualified attorneys a unique “Trademark Attorney ID” number issued by the Office of Enrollment and Discipline (“OED”) upon a one-time submission of a certificate of good standing. This unique “Trademark Attorney ID” could be linked to one or more email addresses that must be kept updated in the system.

In addition, INTA is concerned that foreign parties may misuse U.S. attorney bar numbers or other identifiers that are made public to further the unlawful practice of law and circumvent the U.S. attorney requirement under the Proposed Rules. The USPTO may consider a future modification to its electronic filing systems to require insertion of a *masked* attorney bar number or other unique “Trademark Attorney ID” to be inserted by counsel upon filing documents before the USPTO. To further streamline prosecution, the USPTO should require U.S. attorneys make an appearance only once in an application, registration, or proceeding, subject to the rules governing the duration of and withdrawal from representation.

### **3. Clarify Duration & Withdrawal of U.S. Attorney Representation**

The USPTO should clarify the duration of U.S. attorney representation under §2.17(g), which currently provides that: “[f]or purposes of recognition as a representative, the Office considers a power of attorney filed while an application is pending to end when the mark registered, when ownership changes, or when the application is abandoned.” *See* TMEP §604.02. For example, the USPTO should clarify whether U.S. counsel making an appearance in an application under the Proposed Rules continues after registration and through any TTAB proceedings, unless properly withdrawn under §§2.19 and 11.116. *See* TMEP §607 and TBMP §116.02.

#### **D. Canadian Trademark Attorneys Under §11.14(c)**

INTA supports the USPTO’s Proposed Rule to remove authorization for Canadian patent agents to practice before the USPTO in trademark matters, with certain exceptions for those Canadian patent agents handling pending trademark matters on behalf of Canadian parties. INTA understands that the USPTO will still recognize and allow Canadian trademark attorneys and agents to represent Canadian parties in U.S. trademark matters.

### **Conclusion**

In conclusion, INTA supports the Proposed Rules requiring a U.S. licensed attorney for foreign trademark applicants, registrants and parties to proceedings before the USPTO. INTA believes, however, that further clarifications and/or amendments may be required to address the comments noted above. INTA is available to discuss the Proposed Rules further with the USPTO. Please contact Deborah Cohn at [dcohn@inta.org](mailto:dcohn@inta.org) for further information or clarification.