



IMPORTANT CHANGES IN THE US PATENT & TRADEMARK OFFICE

The United States Patent and Trademark Office (USPTO) recently announced a new rule **effective August 3, 2019, requiring all foreign-domiciled trademark applicants, registrants, and parties to Trademark Trial and Appeal Board (TTAB) proceedings to be represented by an attorney who is licensed to practice law in the United States**. This requirement applies to applications, post-registration maintenance documents, provisional refusals in Madrid applications and TTAB proceedings.

Under the rule, **the USPTO will correspond only with representatives who are qualified U.S. attorneys**. If an application is filed without complying with this new rule, the USPTO will issue an Office Action that appointment of a qualified US Attorney is required. **Failure to comply will result in the abandonment of the application.**

Foreign-domiciled applicants who submit an application based on section 66(a) of the Act (Madrid applications) are subject to the requirement in all provisional refusals (i.e. Office Actions). However, provided the initial application with the International Bureau of the World Intellectual Property Organization complies with all other requirements for registration, the initial application will be exempt from the requirement.

This rule also removes from the regulations the authorization for reciprocally recognized Canadian patent agents to practice before the USPTO in trademark matters but continues to allow reciprocal recognition of Canadian trademark attorneys representing Canadian parties in U.S. trademark matters.

Finally, please note that the USPTO has instituted a program to perform random audits of US trademark registrations upon renewal. Registrations are randomly selected for audit to generally determine whether marks are in use with the goods and services identified in the registration. If a renewal is audited, the USPTO will require the owner to submit proof of use for at least two additional goods or services per class. If proof of use for the goods and/or services identified is not available, the identified goods and any other goods not currently in use will be deleted from the registration. Accordingly, it is important to be accurate when listing the goods and services sold in connection with the US-based trademark registration.

Please contact us if you have any questions about the above changes and requirements.