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18 March 2019

Ms. Mary Boney Denison  
The Commissioner for Trademarks  
United States Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

VIA Email – [TMFRnotices@uspto.gov](mailto:TMFRnotices@uspto.gov)

**Re: Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, Docket No. PTO–T–2018–0021**

Dear Commissioner Denison:

Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the United States Patent and Trademark Office’s request for comments on the “Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants” (Docket No. PTO–T–2018–0021) published in the Federal Register on 15 February 2019. We thank you for the opportunity to provide these comments.

IPO is an international trade association representing companies and individuals in all industries and fields of technology who own, or are interested in, intellectual property rights. IPO’s membership includes about 200 companies and close to 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO membership spans over 30 countries.

IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of IP rights.

The proposed rulemaking would require applicants, registrants, or parties to a proceeding whose domicile or principal place of business is not located within the United States or its territories 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. IPO supports this rule as a measure to protect the integrity of the trademark register. IPO recognizes that further rule changes may be needed in the future to protect the register, depending on whether this measure achieves its intended result. Below, IPO provides additional comments on the examination of applications filed by foreign-domiciled applicants.

For those applicants that the USPTO identifies as being subject to the rule, the USPTO is considering whether to: (1) defer full examination of the application until the

applicant complies with the requirement to appoint U.S. counsel or (2) issue an Office Action that includes the requirement along with other applicable refusals and requirements.

IPO is in support of the latter option, whereby the USPTO would issue an Office Action that includes the requirement along with other applicable refusals and requirements. This approach would offer benefits to the foreign-domiciled applicant, its U.S. counsel, and third parties. An examination at the outset of the process would enable U.S. counsel to fully assess the grounds for refusal and provide the foreign-domiciled applicant with a reliable cost estimate for responding to the Office Action. An Office Action issued as the result of such an examination could also help inform the foreign-domiciled applicant's choice of U.S. counsel, which could vary depending on the substantive grounds for refusal cited in the Office Action.

In addition, this manner of proceeding will enable third parties to know sooner if the application is subject to refusal, perhaps based on the third party's own rights, and to have its enforcement efforts guided accordingly. In turn, applicants, registrants, and third parties could more accurately assess whether they need to investigate the actual use of a mark to assess any conflict, initiate proceedings to oppose an application, engage in civil litigation to resolve a dispute over a mark, or change business plans to avoid use of a chosen mark.

Moreover, it has not been proposed that the foreign-domiciled applicant be required to appoint U.S. counsel as a pre-requisite to obtain a filing date and serial number. Therefore, following payment of the application fee, the foreign-domiciled applicant should be entitled to an examination of its application.

The alternative, deferring examination until U.S. counsel is appointed, could keep these types of applications pending in the system longer. While such an application was in the system, it would pose an obstacle for trademark clearance by others and could be cited as a prior pending application, even if the applicant had no intention of appointing U.S. counsel or did not file the application in good faith. This highlights the questions of how long a foreign-domiciled applicant would have to appoint U.S. counsel — and whether a failure to appoint U.S. counsel would result in abandonment that could be cured by filing a Petition to Revive. A long time period and a Petition to Revive would only exacerbate the problem of the application languishing in the system.

Although IPO supports an examination at the outset for applications filed by foreign-domiciled applicants, a deferred examination process for these applications would nonetheless be an improvement over the current system by requiring that such applicants ultimately be represented by a qualified U.S. attorney. In this case, a shortened time period (e.g., two months instead of the usual six months) to respond to the Office Action and appoint U.S. counsel could help the USPTO efficiently manage, and try to regulate and enforce a good faith basis in, applications filed by foreign-domiciled applicants.

We again thank the U.S. Patent and Trademark Office for permitting IPO to provide comments and would welcome any further dialogue or opportunity to provide additional information.

Sincerely,

A handwritten signature in black ink, appearing to read "Mark Lauroesch", written in a cursive style.

Mark Lauroesch  
Executive Director