

## **Madrid Protocol Concerning the International Registration of Marks**

### **Requirement to be Represented by a U.S.-Licensed Attorney to Conduct Business Before the Office: United States of America**

1. The United States Patent and Trademark Office (USPTO) has provided to the International Bureau of the World Intellectual Property Organization (WIPO) information concerning a new requirement to be represented by a U.S.-licensed attorney to conduct business before the USPTO. This new requirement will come into effect on August 3, 2019.
2. The new requirement will apply to holders of international registrations only when conducting business directly with the USPTO, such as, for example, when responding to notifications of provisional refusal, both *ex-officio* and based on opposition, or when filing *Affidavits* of Continued use in Commerce directly with the USPTO, at prescribed intervals, after protection has been granted.
3. Users of the Madrid System are not required to be represented by a U.S.-licensed attorney when conducting business with the International Bureau of WIPO, such as, for example, when designating the United States of America, in an international application or subsequent to the international registration, when renewing an international registration or when filing requests for recording in the International Register in respect of this Contracting Party.
4. The communication sent by the USPTO reads as follows:

“All trademark applicants, registrants and parties to Trademark Trial and Appeal Board (TTAB) proceedings who are individuals with permanent legal residence outside the United States or its territories or who are legally-organized entities with their principal place of business (headquarters) outside the United States or its territories, including Canadian trademark filers, must be represented at the United States Patent and Trademark Office (USPTO) by an attorney who is licensed to practice law in the United States. For non-U.S.-domiciled applicants designating the United States through the Madrid Protocol under U.S. Trademark Act Section 66(a), the requirement for a U.S.-licensed attorney will be made in all provisional refusals. The USPTO does not recognize an International Registration holder’s representative before the International Bureau, unless he or she is a qualified U.S.-licensed attorney.

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Paper and electronic trademark submissions made after August 3, 2019, will require all U.S.-licensed attorneys representing applicants, registrants, including International Registration holders with registered extensions of protection to the United States, and parties to TTAB proceedings to provide their name, postal address and email address, a statement attesting to their active membership in good standing of a bar of the highest court of a U.S. state, commonwealth or territory, and information concerning bar membership details.

To appoint a U.S.-licensed attorney, an authorized signatory for an applicant may submit the required attorney information using the U.S. serial number or registration number by submitting the appropriate online form at <https://teas.uspto.gov/ccr/raa>. For more information on the requirements of the rule, see <https://www.uspto.gov/trademark/laws-regulations/trademark-rule-requires-foreign-applicants-and-registrants-have-us>.”

5. Information concerning the filing of *Affidavits* of Continued Use in Commerce with the USPTO can be found in information notice number 16/2010, available at: [https://www.wipo.int/edocs/madrdocs/en/2010/madrid\\_2010\\_16.pdf](https://www.wipo.int/edocs/madrdocs/en/2010/madrid_2010_16.pdf).
6. Users of the Madrid System may contact the USPTO at [MPU@uspto.gov](mailto:MPU@uspto.gov) for further information regarding the new requirement to be represented by a U.S.-licensed attorney.

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