



ARE Trademark Law Alert: US Patent & Trademark Office Considers Rule Change for Foreign Trademark Applicants

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(October 24, 2018) In a September 24, 2018 address to the Intellectual Property Owners' Association, US Patent & Trademark Office ("USPTO") Director Andrei Iancu announced that he was considering a rule change to restrict *pro se* trademark applications by foreign nationals. Current rules allow foreign nationals to file US trademark applications without having legal representation. The new rule would change this by requiring foreign trademark applicants to be represented by US attorneys.

The change is intended to address the marked increase in *pro se* trademark applications by foreign nationals, especially from China. Over the past 6 years, the number of trademark applications from China has risen almost 1100 percent. Many of these applications have been filed without the benefit of legal advice. As a result, the USPTO has needed to hire, train, and integrate within a short time period a large number of new Trademark Examining Attorneys.

Complicating the issue is the fact that many of the foreign *pro se* applications are of questionable quality. Some include long and improbable lists of goods and services to be covered by the application. Others seek protection for close variants of world-famous trademarks, such as "iFone." Such applications underscore how important it is for US trademark owners to be vigilant in monitoring the US Trademark Register for applications that may confuse consumers.

We think the change that is now being considered—requiring foreign applicants to retain US legal counsel in order to file trademark applications—may alleviate the USPTO's problems. But in any event, whether or not this change eases the total number of trademark applications filed, requiring foreign applicants to obtain US legal representation should at least ensure that such applicants obtain the benefit of trained legal advice.

We will continue to monitor this possible rule change and will issue further ARE Trademark Law Alerts as developments occur. In the meantime, please contact us if you have questions



about how this possible rule change may affect your trademark rights.

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