

# Chapter 600

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## **601 Applicant May Be Represented by Attorney at Law**

The owner of a mark may file and prosecute his or her own application for registration of the mark, or may be represented by a practitioner authorized under 37 C.F.R. §10.14 to practice before the United States Patent and Trademark Office ("USPTO") in trademark cases. 37 C.F.R. §§2.11, 10.1(c) and 10.14. See TMEP

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§§602 *et seq.* regarding persons who may practice before the USPTO in trademark cases.

### **601.01 USPTO Cannot Aid in Selection of Attorney**

The USPTO cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

If it is apparent that an applicant is unfamiliar with the proper preparation and prosecution of an application and needs more detailed or technical assistance than the examining attorney is permitted to give, the examining attorney may suggest to the applicant that it may be desirable to employ an attorney who is familiar with trademark matters. The following language may be used in the Office action:

The applicant may wish to hire a trademark attorney because of the technicalities involved in the application. The United States Patent and Trademark Office cannot aid in the selection of an attorney.

### **601.02 Communications With Applicant Who Is Represented By Attorney**

If an applicant is represented by a practitioner authorized under 37 C.F.R. §10.14 to practice before the USPTO in trademark cases (see TMEP §§602 *et seq.*), the USPTO will conduct business only with the practitioner, unless that representation is terminated. If the applicant contacts the USPTO regarding the application, the applicant will be advised that the USPTO will only conduct business regarding the application with applicant's attorney. USPTO employees may discuss the application file record with the applicant or answer questions about the procedures for obtaining and maintaining a registration, and are encouraged to refer the applicant to publicly available information on the USPTO's web site. See TMEP §1805 regarding general inquiries from the public.

The applicant may not authorize examiner's amendments or changes of correspondence address, and the USPTO will not accept responses or amendments signed by the applicant if there is an attorney of record. See TMEP §§605 *et seq.* regarding signature of documents filed in the USPTO.

If the applicant wishes to revoke the power of attorney, the applicant should be encouraged to file the revocation through the Trademark Electronic Application System ("TEAS"). See TMEP §602.04 regarding revocation.

See TMEP §602.07 regarding changes of attorney.

## **602 Persons Who May Practice Before Office in Trademark Matters**

*37 C.F.R. §10.14. Individuals who may practice before the Office in trademark and other non-patent cases.*

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(a) *Attorneys.* Any individual who is an attorney may represent others before the Office in trademark and other non-patent cases. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent cases.

(b) *Non-lawyers.* Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent cases, except that individuals not attorneys who were recognized to practice before the Office in trademark cases under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark cases.

(c) *Foreigners.* Any foreign attorney or agent not a resident of the United States who shall prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases, provided: The patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent and Trademark Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.

(d) Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.

(e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office.

### *Attorneys Licensed to Practice in the United States*

An attorney who is a member in good standing of the bar of the highest court of any State may practice before the USPTO in trademark matters. 37 C.F.R. §10.1(c) (definition of attorney limited to individuals licensed to practice in the United States); 37 C.F.R. §10.14(a). No application for recognition to practice before the USPTO is necessary. The USPTO does not give an examination for eligibility or maintain a register of persons entitled to practice in trademark cases. An attorney meeting the requirements of 37 C.F.R. §10.14 who appears in person or signs a document on behalf of an applicant or registrant will be accepted as the representative of the applicant or registrant. 37 C.F.R. §§2.17(a) and (c). A telephone call from an attorney does not satisfy the “appearance” requirements of 37 C.F.R. §2.17(c).

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Only individuals, not law firms, are entitled to be recognized to represent others. Generally, attorneys who have not specifically been mentioned in a power of attorney may discuss but not conclude business with the USPTO over the telephone. However, if an attorney from the same firm as the attorney of record claims to be authorized by the attorney of record to conduct business and approve amendments with respect to a specific application, the examining attorney will permit the attorney to conclude business, and will note this fact in any resulting Office action.

### *Foreign Attorneys*

Generally, only an attorney as defined in 37 C.F.R. §10.1(c) may represent an applicant, registrant, or party to a proceeding before the USPTO. 5 U.S.C. §500(d); 37 C.F.R. §§10.14(c) and (e). In very limited circumstances, Canadian agents or attorneys registered or in good standing before the Canadian Intellectual Property Office may request recognition from the USPTO's Office of Enrollment and Discipline ("OED") to represent Canadian parties in trademark matters before the USPTO. See TMEP §§602.06 *et seq.* for further information about foreign attorneys.

### *Non-Attorneys*

Non-attorneys are not permitted to practice except under the limited circumstances specified in 37 C.F.R. §10.14(b). 5 U.S.C. §500(d); 37 C.F.R. §10.14(e). See TMEP §602.03.

See TMEP §§605 *et seq.* regarding signature of documents filed in the USPTO.

### **602.01 Powers of Attorney**

*37 C.F.R. §2.17(c). To be recognized as a representative, an attorney as defined in §10.1(c) of this chapter may file a power of attorney, appear in person, or sign a document on behalf of an applicant or registrant that is filed with the Office in a trademark case.*

*37 C.F.R. §2.17(d) A party may file a power of attorney that relates to more than one trademark application or registration, or to all existing and future applications and registrations of that party. A party relying on such a power of attorney must:*

*(1) Include a copy of the previously filed power of attorney; or*

*(2) Refer to the power of attorney, specifying the filing date of the previously filed power of attorney; the application serial number (if known), registration number, or inter partes proceeding number for which the original power of attorney was filed; and the name of the party who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy of the mark, and specify the filing date.*

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Generally, as long as no other attorney or firm has been previously appointed, it is not necessary for an attorney to file a power of attorney or any other special authorization in a trademark case. An attorney meeting the requirements of 37 C.F.R. §10.14 who appears in person or signs a document on behalf of an applicant or registrant will be accepted as the representative of the applicant or registrant. 37 C.F.R. §§2.17(a) and (c). A telephone call from an attorney does not satisfy the “appearance” requirements of 37 C.F.R. §2.17(c). Such an attorney will not be recognized as applicant’s/registrant’s representative, and he/she cannot authorize amendments to the application/registration by telephone.

If an attorney meeting the requirements of 37 C.F.R. §10.14 files a proper power of attorney from the party he/she represents, the USPTO will accept the power. To be acceptable as a power of attorney, the power must identify an individual attorney(s) by name, not merely specify the name of a law firm. If a power specifies only the name of a law firm, the USPTO will treat it as a correspondence address rather than an authorization to conduct business. See TMEP §§603 *et seq.* regarding the correspondence address.

To expedite processing, the USPTO recommends that powers of attorney be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. When powers of attorney are filed electronically, the data is automatically entered into the USPTO’s Trademark Reporting and Monitoring (“TRAM”) System.

An attorney cannot sign an original power of attorney on behalf of his/her client. An original power of attorney, other than one associating an additional attorney with an already recognized attorney (see TMEP §602.01(b)), must be signed by the individual applicant, or by someone with legal authority to bind a juristic applicant (e.g., a corporate officer or partner of a partnership). See TMEP §804.05 regarding signature of documents transmitted electronically.

If a power of attorney is signed by an improper person (e.g., the applicant’s attorney) and no other attorney has been previously appointed, the examining attorney generally does not have to require a properly signed power, because the filing of a power of attorney is not mandatory in a trademark case. See 37 C.F.R. §2.17(c). However, if an applicant is already represented by an attorney authorized to practice before the USPTO pursuant to 37 C.F.R. §10.14, and a new attorney from a different U.S. firm wishes to take action with respect to the application, the new attorney must file a new power of attorney signed by the applicant before the USPTO will accept filings by or correspond with the new attorney. See TMEP §§602.07 and 603.02(a).

If no power of attorney is filed, the USPTO will presume that an attorney meeting the requirements of 37 C.F.R. §10.14 is the attorney of record in an application if: (1) the original application is accompanied by a cover letter or transmittal letter that is signed by an attorney and identifies the name and address of that attorney; (2) the application is filed electronically using TEAS, and an attorney is identified in the attorney information section; or (3) the application is filed by a *pro se* applicant (*i.e.*,

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an applicant who does not have an attorney who meets the requirements of 37 C.F.R. §10.14), and correspondence is subsequently filed that is signed by an attorney and identifies the name and address of that attorney, either on the correspondence itself or on the transmittal letter that accompanies the correspondence. The USPTO presumes that documents filed by attorneys are authorized to be filed.

The USPTO considers a power of attorney to end with respect to a particular application when the mark is registered, when ownership changes, or when the application is abandoned. See TMEP §602.01(c) regarding the processing of powers of attorney filed after registration.

If an attorney is suspended or excluded by the Director of the USPTO, a power of attorney should be regarded as void as of the date of suspension or exclusion, and no oral or written communication should be made with the attorney on or after that date. Any correspondence filed by a suspended or excluded attorney should be treated as correspondence filed by an unauthorized person, pursuant to TMEP §§605.05 *et seq.* See TMEP §602.08 for further information about individuals excluded or suspended from practice before the USPTO.

See *also* TMEP §602.04 regarding revocation of a power of attorney, and TMEP §§603.02 *et seq.* regarding changes in the correspondence address.

### **602.01(a) Power of Attorney Relating to More Than One Application or Registration**

Using TEAS, at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html), an owner may appoint an attorney for up to 20 applications or registrations that have the identical owner and attorney. A power of attorney relating to future applications cannot be filed through TEAS.

An applicant or registrant may file a power of attorney *on paper* that relates to more than one trademark application or registration, or to all existing and future applications and registrations. Someone relying on such a power of attorney must: (1) include a copy of the previously filed power of attorney; or (2) refer to the previously filed power of attorney, specifying: the filing date of the power; the application serial number (if known), registration number, or *inter partes* proceeding number for which the original power of attorney was filed; and the name of the party who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy of the mark, and specify the filing date. 37 C.F.R. §2.17(d). If the applicant or registrant meets these requirements, the examining attorney should accept the power of attorney.

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### **602.01(b) Associate Powers of Attorney**

Once the applicant has designated an attorney, the attorney may sign an associate power of attorney, appointing another attorney as an additional person authorized to prosecute the application. If the applicant revokes the original power of attorney, this revocation also discharges any associate power signed by the attorney whose power has been revoked. See TMEP §602.04 regarding revocation of a power of attorney.

### **602.01(c) Powers of Attorney Filed After Registration**

To expedite processing, the USPTO recommends that powers of attorney be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. When a power of attorney is filed through TEAS, the data is automatically entered into the USPTO's TRAM database.

The USPTO considers a power of attorney to end with registration.

When a new power of attorney is filed *on paper* after registration, the USPTO scans an image of the document into the record, but does not change the attorney of record in the TRAM database unless the owner of the registration concurrently takes an action, such as filing an affidavit of use or excusable nonuse under 15 U.S.C. §1058 (“§8 affidavit”), an affidavit of incontestability under 15 U.S.C. §1065 (“§15 affidavit”), a renewal application under 15 U.S.C. §1059, or a request to amend or correct the registration under 15 U.S.C. §1057. Likewise, when the owner of a registration files a *paper* request to revoke a power of attorney, or an attorney files a request to withdraw as attorney of record, the USPTO scans an image of the document into the record but does not change the attorney of record in TRAM unless the owner concurrently takes an action. See TMEP §602.04 regarding revocation of powers of attorney and TMEP §602.05 regarding withdrawal.

When the owner of a registration files an affidavit, renewal application, or request to amend or correct a registration through an attorney, the USPTO will update TRAM to indicate the name and address of the attorney who filed the affidavit, renewal application, or amendment.

See *also* TMEP §1612 regarding powers of attorney filed after registration.

### **602.02 Standards of Conduct**

*37 C.F.R. §10.15. Refusal to recognize a practitioner. Any practitioner authorized to appear before the Office may be suspended or excluded in accordance with the provisions of this part. Any practitioner who is suspended or excluded under this subpart or removed under section 10.11(b) shall not be entitled to practice before the Office.*



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37 C.F.R. §10.20. *Canons and Disciplinary Rules.*

(a) *Canons are set out in §§10.21, 10.30, 10.46, 10.56, 10.61, 10.76, 10.83, 10.100, and 10.110. Canons are statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession.*

(b) *Disciplinary Rules are set out in §§10.22 - 10.24, 10.31 - 10.40, 10.47 - 10.57, 10.62 - 10.68, 10.77, 10.78, 10.84, 10.85, 10.87 - 10.89, 10.92, 10.93, 10.101 - 10.103, 10.111, and 10.112. Disciplinary Rules are mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action.*

Part 10 of Title 37 of the Code of Federal Regulations pertains to representation of others before the USPTO. Part 10 identifies and defines individuals entitled to practice before the USPTO, establishes a mandatory Code of Professional Responsibility, and defines a procedure for investigations and disciplinary proceedings.

### **602.03                    Actions by Unauthorized Persons Not Permitted**

An individual who is not authorized under 37 C.F.R. §10.14(a), (b), or (c) to practice before the USPTO in trademark cases (see TMEP §602) is not permitted to represent a party in the prosecution of a trademark application, maintenance of a registration, or in a proceeding before the USPTO. 5 U.S.C. §500(d); 37 C.F.R. §10.14(e).

An individual who is not authorized under 37 C.F.R. §10.14 cannot: prepare an application, response, or other paper to be filed in the USPTO; sign amendments, responses to Office actions, petitions, or letters of express abandonment; authorize examiner's amendments, priority actions, or changes of correspondence address; or otherwise represent an applicant, registrant, or party to a proceeding in the USPTO. Presenting an amendment to an application, or submitting legal arguments in response to a requirement or refusal constitutes representation of the applicant.

When an applicant is represented by counsel, the USPTO encourages the practice of direct communication with the appointed attorney(s). Although paralegals and legal assistants may relay information between the examining attorney and the appointed attorney(s), they are not authorized to conduct business before the USPTO. Paralegals and legal assistants cannot authorize examiner's amendments or priority actions, even if only conveying the appointed attorney's approval by indicating that the appointed attorney has approved the amendment or action.

Once the USPTO recognizes an attorney(s) as representing an applicant/registant, a new attorney from a different firm is not permitted to represent the

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applicant/registrant until the applicant/registrant revokes the power of attorney of the previously recognized representative. See TMEP §602.07.

An individual who is not authorized under 37 C.F.R. §10.14 may transmit and receive correspondence. Such an individual may also sign a verification on behalf of an applicant, if he/she meets the requirements of 37 C.F.R. §2.33(a) (see TMEP §804.04). Any person, whether a practitioner or non-practitioner, who presents a paper to the USPTO (whether by signing, filing, submitting, or later advocating the paper) is subject to 37 C.F.R. §10.18(b). See TMEP §605.01.

If the examining attorney suspects that an individual who does not meet the requirements of 37 C.F.R. §10.14 is representing an applicant, the examining attorney should bring the matter to the attention of the Administrator for Trademark Policy and Procedure in the Office of the Commissioner for Trademarks (“Administrator”).

See TMEP §§605 *et seq.* regarding signature of papers filed in the USPTO.

### **602.04 Revocation of Power of Attorney**

*37 C.F.R. §2.19(a). Authority to represent an applicant, registrant or a party to a proceeding may be revoked at any stage in the proceedings of a case upon written notification to the Director; and when it is revoked, the Office will communicate directly with the applicant, registrant or party to the proceeding, or with the new attorney or domestic representative if one has been appointed. The Office will notify the person affected of the revocation of his or her authorization.*

An applicant/registrant may revoke a power of attorney by filing a written revocation. The USPTO will acknowledge the revocation and will no longer recognize the attorney in that case unless he/she is again specifically appointed.

To expedite processing, the USPTO recommends that revocations of powers of attorney be filed through TEAS, at <http://www.uspto.gov/teas/index.html>.

The revocation must be personally signed by the individual applicant/registrant, or by someone with legal authority to bind a juristic applicant/registrant (e.g., a corporate officer or partner of a partnership). A new attorney cannot sign a revocation of the previous power of attorney. See TMEP §602.07 regarding changes of attorney. A new attorney may submit a revocation and new appointment of power of attorney through TEAS by e-mailing the text form to the applicant/registrant for electronic signature from within TEAS, or by attaching a .jpg or .pdf image of a handwritten pen-and-ink revocation/appointment signed by the applicant/registrant. See TMEP §804.05 regarding electronic signature. A new attorney should not directly sign the TEAS revocation/appointment form.

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If the applicant/registrant files a new power of attorney with the revocation, the address contained in the new power of attorney becomes the correspondence address of record. If the applicant/registrant files a revocation of the previous power of attorney without a new power of attorney, correspondence will be sent either to: (1) the applicant's address or any other address designated by the applicant; or (2) the attorney signing the cover letter or action accompanying the revocation. See TMEP §603.01.

If the applicant/registrant files a new power of attorney naming a new attorney as its representative, this will be treated as a revocation of any previous power of attorney, even if the applicant/registrant does not specifically revoke the previous power.

The USPTO considers a power of attorney to end with registration. After registration, if the owner of a registration files a *paper* request to revoke a power of attorney appointed before registration, the USPTO scans an image of the revocation into the record but does not change the attorney of record in TRAM, unless the owner concurrently files a §8, §15, or §71 affidavit, §9 renewal application, or request to amend or correct the registration under §7 of the Act. See TMEP §1612.

### **602.05                    Withdrawal of Attorney of Record**

*37 C.F.R. §2.19(b). If the requirements of §10.40 of this chapter are met, an attorney authorized under §10.14 to represent an applicant, registrant or party in a trademark case may withdraw upon application to and approval by the Director.*

An attorney may withdraw from representing an applicant or registrant, but may not withdraw in a way that would prejudice the applicant or registrant. *In re Legendary, Inc.*, 26 USPQ2d 1478 (Comm'r Pats. 1992) (attorney's request to withdraw denied where the request was filed on the last day of the period for response to an Office action and attorney stated neither that the applicant was given due notice of the attorney's withdrawal from employment nor that the attorney had delivered all papers and property in his file concerning the prosecution of the application to the applicant). See 37 C.F.R. §10.40 regarding mandatory and permissive withdrawal from employment by an attorney.

To expedite processing, the USPTO recommends that all requests to withdraw as the attorney of record be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. The TEAS form can be used to request withdrawal on any application or registration that is currently active. For registrations, the form requires entry of the original application serial number rather than the registration number.

A request to withdraw must include the following:

- (1) A statement of the reason(s) for the request to withdraw;

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- (2) A statement that the attorney has given due notice to the applicant or registrant that the attorney is withdrawing from employment and will be filing the necessary papers with the USPTO; and that the applicant or registrant was given notice of the withdrawal at least two months before the expiration of the response period;
- (3) A statement that the attorney has delivered to the applicant or registrant all papers and property in the attorney's file concerning the prosecution of the application or registration; and
- (4) A statement that the attorney notified the applicant or registrant of any responses that may be due, and of the deadline for response.

37 C.F.R. §10.40. These requirements apply to all requests to withdraw, whether withdrawal is mandatory or permissive. A request to withdraw should be filed soon after the representative notifies the applicant or registrant of his/her intent to withdraw. If an applicant or registrant was notified of the attorney's withdrawal from employment at least two months before the expiration of the response period, and the request to withdraw meets all the requirements listed above, the request will be granted. *In re Slack*, 54 USPQ2d 1504 (Comm'r Pats. 2000).

The request for withdrawal should also contain the following:

- (1) The application serial number or registration number;
- (2) The law office to which the application is assigned, in a pending application;
- (3) The name of the examining attorney or Post Registration examiner assigned; and
- (4) The present mailing address of the attorney who is withdrawing and the present mailing address of the applicant or registrant.

If filed on paper, the request should be titled "Request for Permission to Withdraw as Attorney of Record."

Requests to withdraw that are filed through TEAS are processed electronically, and are automatically granted if they meet the requirements listed above.

For paper filings, a request for permission to withdraw as attorney filed before registration will be handled by the appropriate managing attorney, or, if a notice of allowance has issued and the application is awaiting the filing of a statement of use, by the Supervisor of the ITU/Divisional Unit. After registration, a paper request for permission to withdraw as attorney will be handled by the Supervisor of the Post Registration Section of the Office.

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The managing attorney or supervisor will approve or deny the paper request, notify the applicant or registrant and the attorney of the approval or denial of the request, and place a record of this notification (*i.e.*, a copy of the written communication or telephone call record) in the record. If the request is approved, the managing attorney or supervisor should ensure that the correspondence address is changed in the USPTO's automated records. It is the responsibility of the managing attorneys or supervisors to establish procedures that permit withdrawal requests to be given priority and acted on promptly.

For paper filings, if the attorney who seeks to withdraw is also the domestic representative, the managing attorney or supervisor should inquire as to whether the attorney intends to withdraw as domestic representative. This inquiry should be made by phone or e-mail, if possible. If the attorney withdraws as domestic representative, the managing attorney or supervisor should ensure that the domestic representative field in TRAM is updated accordingly. See TMEP §604 regarding designations of domestic representative, and TMEP §603.04 regarding correspondence with parties not domiciled in the United States.

If an attorney appointed before registration files a paper request to withdraw after registration, the USPTO scans an image of the request into the record but does not change the attorney of record in TRAM. See TMEP §§602.01(c) and 1612.

The USPTO will not process a request for permission to withdraw in an abandoned application. When an attorney files a request to withdraw in an abandoned application, the USPTO scans an image of the request into the record but does not change the TRAM database. See TMEP §1612 regarding withdrawal of attorney after registration.

### **602.06 Foreign Attorneys and Agents**

*37 C.F.R. §10.14(c). Foreigners. Any foreign attorney or agent not a resident of the United States who shall prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases, provided: The patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent and Trademark Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.*

Generally, only an attorney as defined in 37 C.F.R. §10.1(c) may represent an applicant, registrant, or party to a proceeding before the USPTO. 5 U.S.C. §500(d); 37 C.F.R. §§10.14(c) and (e). A foreign attorney or agent who is not a resident of the United States may be recognized under 37 C.F.R. §10.14(c) to represent parties

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located in the country in which the foreign attorney resides and practices, only if: (1) he/she proves to the satisfaction of OED prior to representing a party before the USPTO that he/she is registered or in good standing before the patent or trademark office of the country in which he/she resides and practices; and (2) the patent or trademark office of that foreign country allows substantially reciprocal privileges to those permitted to practice before the USPTO. Currently, a Canadian attorney or agent who is registered or in good standing with the Canadian Intellectual Property Office is the only foreign attorney or agent who may be recognized as meeting the qualification criteria of 37 C.F.R. §10.14(c). See TMEP §602.06(a) regarding Canadian attorneys, and TMEP §602.06(b) regarding attorneys from other countries.

### **602.06(a) Canadian Attorneys**

Currently, a Canadian attorney or agent who is registered or in good standing with the Canadian Intellectual Property Office is the only foreign attorney or agent who may qualify to be recognized as meeting the qualification criteria of 37 C.F.R. §10.14(c). OED maintains a list of attorneys and agents who have been recognized as qualified to represent parties located in Canada, which is available on the USPTO's internal computer network. To be recognized under 37 C.F.R. §10.14(c), an individual must file a written request prior to representing a party before the USPTO, with proof that he/she satisfies the requirements of 37 C.F.R. §10.14(c), addressed to the Director of OED, Mail Stop OED, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. A Canadian attorney or agent recognized under 37 C.F.R. §10.14(c) may only represent parties located in Canada.

A Canadian patent agent who is registered with the USPTO as a patent agent under 37 C.F.R. §11.6(b) may also represent parties located in Canada. The USPTO includes the names of these agents with other registered patent practitioners on the USPTO website at <http://des.uspto.gov/OEDCI/>. Registered practitioners located in Canada, including U.S. attorneys and agents in Canada, may be identified by selecting Canada under "country." Alternatively, to ascertain whether a particular agent is registered, type in the agent's surname, and a list of registered practitioners having the same surname will appear. Upon matching the surname and first name, additional information may be obtained via the link in the surname.

If a Canadian attorney or agent is designated or acts as a representative of a party in a trademark matter, the examining attorney or Post Registration examiner should verify that the attorney or agent is recognized by the Director of OED. If the individual appears on an OED list, the examiner should make an appropriate note to the file. If the individual does not appear on the list, the examiner should treat any paper filed by that individual as a paper filed by an unauthorized person. See TMEP §§605.05 *et seq.*

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A Canadian attorney or agent who has been recognized under 37 C.F.R. §10.14(c) can only represent parties located in Canada. Thus, even if the attorney or agent is on the OED list, he/she cannot represent a party located in the United States or in another foreign country before the USPTO.

### **602.06(b) Foreign Attorneys and Agents From Countries Other Than Canada**

A foreign attorney or agent who resides and practices in a foreign country other than Canada and who is not a member in good standing of the bar of the highest court of a state in the United States may not practice before the USPTO. 5 U.S.C. §500(d); 37 C.F.R. §10.14. Any such attorney or agent who wishes to represent a party in a trademark matter must file a written request to do so with OED. This request must be filed prior to representing a party before the USPTO and should include proof that the attorney or agent is in good standing with the foreign patent or trademark office, and that the foreign patent or trademark office provides substantially reciprocal rights to United States attorneys.

### **602.06(c) Papers Filed by Foreign Attorneys and Agents**

A foreign attorney or agent who is not authorized to practice before the USPTO under 37 C.F.R. §10.14 may transmit and receive correspondence. Thus, a foreign attorney or agent may sign a cover letter that does nothing more than transmit properly signed papers to the Office (see TMEP §605.03), or receive correspondence from the Office and transmit it to the applicant. However, a foreign attorney or agent cannot prepare an application, response, or other paper to be filed in the USPTO, sign responses to Office actions, or authorize examiner's amendments and priority actions. Preparing a paper, authorizing an amendment to an application, or submitting legal arguments in response to a requirement or refusal constitutes representation of a party in a trademark matter. See TMEP §602.03.

If a foreign attorney or agent who does not meet the requirements of 37 C.F.R. §10.14(c) is designated or acts as a representative of a party in a trademark matter, the examining attorney or Post Registration examiner should follow the procedures in TMEP §§605.05 *et seq.*

### **602.06(d) Representatives of Holders of International Registrations**

In the case of an application under Trademark Act §66(a), 15 U.S.C. §1141(f)(a), or a registered extension of protection, the applicant's appointed representative as communicated from the International Bureau of the World Intellectual Property Organization ("IB") is considered the correspondence address of record only. If a person with an address outside the United States is identified, the representative will not be recognized by the USPTO without further clarification of his/her qualifications under 37 C.F.R. §10.14. See TMEP §603.01(a) regarding correspondence in §66(a)

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applications, and TMEP §§605 *et seq.* regarding signature of documents filed in the USPTO.

### **602.06(e) Identification of Foreign Attorney in Original Application**

If the attorney section of an application identifies a person with an address outside the United States, the examining attorney should advise in an Office action that unless the person meets the requirements of 37 C.F.R. §10.14, that person is not authorized to practice before the USPTO in trademark matters and may not represent the applicant in the particular trademark application, and that any power of attorney to the person is void *ab initio*. The Office action should be sent to the correspondence address of record as established in the original application.

If an Office action is not necessary (*i.e.*, the application is otherwise eligible for approval for publication or registration on the Supplemental Register), the examining attorney should ensure that the USPTO database does not include the identified person in the “Attorney” field. The correspondence address should remain unchanged.

See TMEP §603.04 regarding correspondence with parties not domiciled in the United States.

### **602.07 Change of Attorney**

Once the USPTO recognizes an attorney meeting the requirements of 37 C.F.R. §10.14 as representing an applicant/registrant, a new attorney from a different firm is not permitted to represent the applicant/registrant until either: (1) the applicant/registrant revokes the previous power of attorney; or (2) the previously recognized attorney files a request to withdraw. Thus, the new attorney cannot sign responses to Office actions, authorize examiner’s amendments or priority actions, expressly abandon an application, authorize a change of correspondence address, or otherwise represent the applicant/registrant.

If an applicant/registrant is already represented by an attorney, and a new attorney from a different firm wishes to take action with respect to the application/registration, the new attorney must file a revocation of the previous power, signed by a person with legal authority to bind the applicant/registrant, before the USPTO will accept filings by or correspond with the new attorney. See TMEP §602.04 regarding revocation of power of attorney.

If the new attorney signs a response or amendment, the examining attorney or Post Registration examiner will follow the procedures in TMEP §§605.05 *et seq.* regarding papers filed by unauthorized parties.

The USPTO considers a power of attorney to end with respect to a particular application when the mark is registered, or when ownership changes. In these



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situations, it is unnecessary to file a revocation of the previous power before a new attorney takes an action. See TMEP §602.01(c) regarding the processing of powers of attorney filed after registration.

### **602.08                    Individuals Excluded or Suspended From Practice Before the USPTO**

Occasionally, the Director of the USPTO suspends or excludes a particular individual from practice before the USPTO. Notice of the suspension or exclusion is published in the *Official Gazette*. In these cases, the Administrator shall notify examiners accordingly.

If an examiner receives a response signed by such a person, the examiner must prepare a notice of incomplete response, granting the applicant/registrant additional time to perfect the response. See TMEP §§605.05 *et seq.* and TMEP §718.03(b). The examiner should also notify the Administrator of the receipt of a response from an excluded or suspended person.

The notice of incomplete response should indicate that:

- (1) The excluded or suspended individual is not entitled to practice before the USPTO in trademark matters, and, therefore, may not represent the applicant/registrant;
- (2) Any power of attorney is void *ab initio*;
- (3) The excluded or suspended individual may not sign responses to Office actions;
- (4) All correspondence concerning the application/registration will be sent to the applicant's/registrant's domestic representative if one has been designated, or, alternatively, to the applicant/registrant at its address of record; and
- (5) A properly signed response must be submitted within: (1) the period of time left in the original six-month response period; or (2) thirty days of the issuance of the notice, whichever is longer. The response must be signed by someone with legal authority to bind the applicant/registrant (see TMEP §§712.01 *et seq.*), or by an attorney who is authorized to practice before the USPTO under 37 C.F.R. §10.14 (see TMEP §602).

A properly signed response may be submitted via fax (unless it is excluded by 37 C.F.R. §2.195(c)) or through TEAS (using the response to Office action form). In a TEAS Plus application, the applicant must file the response through TEAS, or the applicant will lose TEAS Plus status (see TMEP §819.02(b)). Failure to comply with the requirements of the notice will result in abandonment of the application for incomplete response.

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If the improper signer has submitted a change of correspondence address identifying that person as the new recipient of correspondence, the examiner should ensure that the correspondence address in the TRAM database is changed to that of the applicant, registrant, or domestic representative, as applicable.

### **603 Correspondence, With Whom Held**

*37 C.F.R. §2.18 Correspondence, with whom held.*

*(a) If documents are transmitted by an attorney, or a written power of attorney is filed, the Office will send correspondence to the attorney transmitting the documents, or to the attorney designated in the power of attorney, provided that the attorney is an attorney as defined in §10.1(c) of this chapter.*

*(b) The Office will not undertake double correspondence. If two or more attorneys appear or sign a document, the Office's reply will be sent to the address already established in the record until the applicant, registrant or party, or its duly appointed attorney, requests in writing that correspondence be sent to another address.*

*(c) If an application, registration or proceeding is not being prosecuted by an attorney but a domestic representative has been appointed, the Office will send correspondence to the domestic representative, unless the applicant, registrant or party designates in writing another correspondence address.*

*(d) If the application, registration or proceeding is not being prosecuted by an attorney and no domestic representative has been appointed, the Office will send correspondence directly to the applicant, registrant or party, unless the applicant, registrant or party designates in writing another correspondence address.*

#### **603.01 Establishing the Correspondence Address**

When a trademark application is filed, the USPTO enters into its automated records an address (consisting of a name, street address or post office box, city, state and postal code, and an e-mail address if provided) where correspondence from the USPTO will be sent. This often differs from the applicant's address.

Correspondence will be sent to any address that the applicant selects. See TMEP §603.04 regarding correspondence with applicants who are not domiciled in the United States, and TMEP §603.01(a) regarding correspondence in §66(a) applications.

The USPTO may send communications concerning an application by e-mail, if the applicant or the applicant's attorney authorizes e-mail communications. See TMEP §304.03.

When the application includes a power of attorney that designates attorney(s) who may practice before the USPTO pursuant to 37 C.F.R. §10.14 and an address, or a form that has the appearance of a power of attorney that designates the name and address of an attorney who may practice before the USPTO pursuant to 37 C.F.R.

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§10.14, the USPTO will correspond with the designated attorney. In addition, the USPTO will presume that the applicant wishes correspondence to be sent to an attorney's address rather than directly to the applicant when:

- (1) The name and address of an attorney who may practice before the USPTO pursuant to 37 C.F.R. §10.14 appears in the original application papers;
- (2) The original application is accompanied by a transmittal letter on letterhead that identifies an attorney who may practice before the USPTO pursuant to 37 C.F.R. §10.14;
- (3) The application is filed through TEAS, and the attorney information section identifies an attorney with a U.S. address; or
- (4) The original application is written on paper that identifies the name and address of an attorney who may practice before the USPTO pursuant to 37 C.F.R. §10.14.

The above procedures are also used to establish the correspondence address when a registrant files an affidavit under §8, §15, or §71, a §9 renewal application, or a request for amendment or correction of a registration under 15 U.S.C. §1057. The USPTO will update TRAM to indicate the name of the attorney who filed the affidavit, renewal application, or amendment.

When an attorney who may practice before the USPTO pursuant to 37 C.F.R. §10.14 transmits a document on behalf of an applicant/registrant, the USPTO will send correspondence to the attorney transmitting the documents. 37 C.F.R. §2.18(a). If an application or other submission is signed by an attorney on behalf of the applicant/registrant, but the submission does not contain a separate address for that attorney, the USPTO will correspond with the attorney in care of the correspondence address of record and direct such correspondence to the attorney's attention. If an Office action is required, the examining attorney will require the attorney to either specify his/her address for correspondence or affirmatively state that the USPTO should continue to address correspondence to his/her attention in care of the previously submitted correspondence address.

See TMEP §603.02(a) for information about changing the correspondence address in a pending application, and TMEP §603.02(c) for information about changing the correspondence address after registration.

### **603.01(a) Correspondence in §66(a) Applications**

The USPTO will send the first Office action in an application under §66(a) of the Trademark Act to the IB. The IB will send it to the applicant. The USPTO will send second and subsequent Office actions directly to the applicant, at the

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correspondence address set forth in the request for extension of protection to the United States, or to any correspondence address provided in a subsequent communication filed by the applicant in the USPTO. See TMEP §1904.02(e) for further information about Office actions in §66(a) applications.

The USPTO will accept a notice of change of the correspondence address in a §66(a) application or a registered extension of protection of an international registration to the United States, and will send correspondence to the new address. However, this will not change the representative designated in the international registration, to which the IB sends correspondence. A request to record a change of the name or address of the representative designated in the international registration must be filed with the IB; it cannot be filed through the USPTO. Forms for changing the name or address of the designated representative are available on the IB website at <http://www.wipo.int/madrid/en/>. See Madrid Protocol Common Reg. 36(i).

See TMEP §§1906.01 *et seq.* regarding requests to record changes with the IB, and TMEP §§602.06 *et seq.* regarding foreign attorneys.

### **603.02 Changing the Correspondence Address**

To expedite processing, notices of change of correspondence address (including changes of e-mail correspondence address) should be filed through TEAS, at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html). When a notice is filed electronically, the USPTO receives it within seconds after filing, and TEAS almost immediately displays a “Success” page confirming receipt. The TEAS form can be used to change the correspondence address on any application or registration that is currently active. The data from the form is inputted directly into the automated records of the USPTO.

If the applicant/registrant is represented by an attorney who may practice before the USPTO pursuant to 37 C.F.R. §10.14, the attorney must sign the request to change the correspondence address. If the applicant/registrant is not represented by an attorney, the request must be signed by the individual applicant/registrant, or by someone with legal authority to bind the applicant/registrant. See TMEP §605.02.

See TMEP §603.02(a) *et seq.* for further information.

#### **603.02(a) Changing the Correspondence Address Before Registration**

Once the correspondence address is established for a particular application, the USPTO will not change it unless there is a written request by the applicant or the attorney of record to change the address. The mere transmittal of a response to an Office action bearing a new address for an applicant or an applicant’s attorney does not effect a change in a correspondence address.

Once an applicant is represented by an attorney who may practice before the USPTO pursuant to 37 C.F.R. §10.14, the USPTO will not accept a change of

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correspondence address signed by the applicant, unless the applicant revokes the power of attorney.

If an applicant is represented by an attorney authorized to practice before the USPTO under 37 C.F.R. §10.14 (“A”), and another attorney from a different firm (“B”) later responds on behalf of the applicant and requests that correspondence be sent to B, B will be required to submit a revocation and new appointment of power of attorney signed by the applicant before the USPTO will accept filings by or correspond with the new attorney. Attorney B cannot sign a revocation of the previous power or request to change the correspondence address on behalf of the applicant. See TMEP §602.07 regarding change of attorney.

The USPTO will construe the following as a written request to change the correspondence address:

- (1) A revocation and new appointment of power of attorney, signed by someone authorized to bind the applicant, is filed (however, the filing of an “associate power of attorney” or similar document does not change the correspondence address); or
- (2) The application is filed by a *pro se* applicant (*i.e.*, an applicant who is not represented by an attorney authorized to practice before the USPTO under 37 C.F.R. §10.14), and correspondence is subsequently filed that identifies the name and address of an attorney who may practice before the USPTO pursuant to 37 C.F.R. §10.14, either on the correspondence itself or on the transmittal letter that accompanies the correspondence, even if no power of attorney is filed.

In these two situations, the USPTO will change the correspondence address to the address of the new attorney. In all other situations, a written request to change the correspondence address, signed by the applicant or the attorney of record, is required.

To expedite processing, the USPTO recommends that the notice of change of address be filed through TEAS, at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html). The TEAS form can be used to change the correspondence address on any application or registration that is currently active. When the notice is filed electronically, the USPTO receives it within seconds after filing, and TEAS almost immediately displays a “Success” page confirming receipt. The data from the form is inputted directly into the automated records of the USPTO. See TMEP §603.02(b) for information about how to change the correspondence address in multiple applications or registrations.

When a request to change the correspondence address is filed *on paper*, the USPTO manually enters the new correspondence address into its automated records and places the request in the application record, but does not send a

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confirmation or other acknowledgment of the request to change the correspondence address. The applicant may check the Trademark Applications and Registrations Retrieval (“TARR”) database at <http://tarr.uspto.gov> to determine whether the change of address has been entered into the automated records of the USPTO.

A change of correspondence address cannot be entered by examiner’s amendment.

When ownership of an application changes and the proper document is recorded in the Assignment Services Branch, the USPTO will update its automated records to reflect the address of the assignee or the assignee’s attorney, even if the assignee does not specifically request a change of address.

The USPTO will not process a request to change the correspondence address in an abandoned application, unless submitted in conjunction with a petition to revive or request for reinstatement. When an applicant files a request to change the correspondence address in an abandoned application, the USPTO simply places the request in the record.

The USPTO will not undertake double correspondence with the applicant and the applicant’s attorney, or with more than one attorney or representative.

### **603.02(b) Changing the Correspondence Address in Multiple Applications or Registrations**

The TEAS change of correspondence address form can be used to change the correspondence address for more than one application or registration. An applicant/registrant may submit up to twenty (20) application serial numbers at one time. Requests to change the address for more than twenty files cannot be submitted in a single TEAS form. Global address updates, *i.e.* requests to change an address in every file in which it appears, will not be accepted. Parties must identify the original application serial number of each file, whether pending or registered, for which a change of correspondence address is requested.

### **603.02(c) Changing the Correspondence Address After Registration**

Owners of registrations are encouraged to promptly notify the USPTO of any changes of address. To expedite processing, the USPTO recommends that the notice of change of address be filed through TEAS, at [www.uspto.gov/teas/index.html](http://www.uspto.gov/teas/index.html). The TEAS form can be used to change the correspondence address on any registration that is currently active, but requires submission of the original application serial number rather than the registration number. When the notice is filed electronically, the USPTO receives it within seconds after filing, and TEAS almost immediately displays a “Success” page confirming receipt. The data from the form is inputted directly into the USPTO’s automated system.

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When the owner of a registration files a request *on paper* to change the correspondence address after registration, the USPTO scans an image of the request into the record, but does not update the TRAM System unless the owner concurrently takes an action, such as filing an affidavit under §8, §15, or §71, a §9 renewal application, or a request to amend or correct a registration under 15 U.S.C. §1057. If the owner wants the new address entered into the TRAM system, the owner must file the notice of change of address through TEAS.

When the owner of the registration files an affidavit under §8, §15, or §71, a §9 renewal application, or a request to amend or correct a registration through an attorney meeting the requirements of 37 C.F.R. §10.14, the USPTO will update TRAM to indicate the name of the attorney who filed the affidavit, renewal application or request, and update the correspondence address to that of the attorney, if provided. If the owner of the registration does not have an attorney, the USPTO will update TRAM to indicate the owner's address as shown in the affidavit, renewal application or amendment as the correspondence address of record.

The USPTO will not process a request to change the correspondence address in a cancelled or expired registration, unless submitted in conjunction with a petition or request for reinstatement of the registration. When a registrant files a request to change the correspondence address in a cancelled or expired registration, the USPTO simply places the request in the record.

See TMEP §602.07 regarding change of attorney.

### **603.03            Applicant Has Duty to Maintain Current and Accurate Correspondence Address**

It is the applicant's responsibility to maintain a current and accurate correspondence address in its application. If the correspondence address changes, the USPTO must be promptly notified in writing, preferably through TEAS. 37 C.F.R. §2.18. This also applies to e-mail addresses, if the applicant has authorized the Office to send correspondence by e-mail (see TMEP §304.03).

### **603.04            Correspondence with Parties Not Domiciled in the United States**

If an applicant, registrant, or party to a proceeding before the USPTO has not clearly stated a preferred correspondence address, the USPTO will process correspondence as follows:

- If an applicant, registrant, or party to a proceeding before the USPTO has appointed a practitioner authorized to practice before the USPTO in trademark cases under 37 C.F.R. §10.14, the USPTO will send correspondence to that attorney. Currently, Canadian attorneys and agents

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are the only foreigners recognized as meeting the qualification criteria in 37 C.F.R. §10.14(c) (see TMEP §§602.06 *et seq.*).

- If the applicant, registrant, or party is not represented by an attorney authorized under 37 C.F.R. §10.14, and the applicant/registrant/party has appointed a domestic representative, the USPTO will send correspondence to the domestic representative, unless the applicant/registrant/party designates in writing another correspondence address. However, the domestic representative is not authorized to prosecute an application or represent a party in a proceeding before the USPTO, unless the domestic representative is a practitioner authorized under 37 C.F.R. §10.14 who has been recognized by the USPTO as the applicant/registrant/party's representative. 37 C.F.R. §2.24. See TMEP §604 regarding domestic representatives.
- If the applicant, registrant, or party is not represented by a practitioner authorized under 37 C.F.R. §10.14, and the applicant/registrant/party does not designate a domestic representative, the USPTO will send correspondence directly to the applicant/registrant/party's foreign address, unless the applicant/registrant/party designates in writing another correspondence address.

See TMEP §603.01(a) regarding correspondence in §66(a) applications.

### **604 Designation of Domestic Representative by Parties Not Domiciled in the United States**

An applicant, registrant, or party to a proceeding before the USPTO who is not domiciled in the United States may file a document designating the name and address of a domestic representative on whom may be served notices or process in proceedings affecting the mark. 15 U.S.C. §§1051(e), 1058(f), 1059(c), 1060(b), and 1141h(d). The USPTO encourages parties who do not reside in the United States to designate domestic representatives, but it is not mandatory. If the applicant, registrant, or party does not designate a domestic representative, the USPTO will not require a designation.

To expedite processing, the USPTO recommends that designations of domestic representative be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. TEAS can also be used to revoke a designation of a domestic representative.

The designation is not the same as a power of attorney. The designation serves a different purpose, namely, to bring foreign applicants, registrants, and parties under the jurisdiction of the United States legal system. The designation of a domestic representative does not authorize the person designated to prosecute the application or to represent a party in a proceeding before the USPTO. 37 C.F.R. §2.24. Similarly, a power of attorney does not serve as a designation of a domestic



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representative, unless the power of attorney specifically states that the attorney is also the domestic representative on whom may be served notices or process in proceedings affecting the mark.

If a party designates a domestic representative, the designation should include the name and address of the person designated and a clear statement that the party intends to designate this person as a domestic representative upon whom notices or process affecting the mark may be served. The designation must be in writing. A person who is properly authorized to sign a designation of domestic representative is:

- (1) A person with legal authority to bind the applicant or party; or
- (2) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant or party; or
- (3) An attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney from the applicant or party.

37 C.F.R. §2.33(a); TMEP §804.04. See TMEP §804.05 regarding signature of documents transmitted electronically.

The person designated as a domestic representative may be a natural person or a juristic person as defined in 15 U.S.C. §1127.

If an applicant, registrant, or party to a proceeding before the USPTO does not file a document designating a domestic representative, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. 15 U.S.C. §§1051(e), 1058(f), 1059(c), 1060(b), and 1141h(d).

See TMEP §603.04 regarding correspondence with parties who are not domiciled in the United States.

### **605 Signature on Correspondence Filed in the United States Patent and Trademark Office**

#### **605.01 Signature and Certificate**

*37 C.F.R. §10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.*

*(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the*

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provisions of §1.4(d), §1.4(e), or §2.193(c)(1) of this chapter.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that-

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the [Director], or the [Director's] designee, which may include, but are not limited to, any combination of-

(1) Holding certain facts to have been established;

(2) Returning papers;

(3) Precluding a party from filing a paper, or presenting or contesting an issue;

(4) Imposing a monetary sanction;

(5) Requiring a terminal disclaimer for the period of the delay; or

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(6) *Terminating the proceedings in the Patent and Trademark Office.*

(d) *Any practitioner violating the provisions of this section may also be subject to disciplinary action. See §10.23(c)(15).*

### **605.02 Signatures By Authorized Parties Required**

Papers filed in the USPTO must be properly signed. The examining attorney or Post Registration examiner must review the application/registration file record to determine whether the applicant/registrant is represented by a practitioner authorized to practice before the USPTO under 37 C.F.R. §10.14), and must ensure that all papers are properly signed.

Verifications of facts on behalf of an applicant/registrant must be signed by someone meeting the requirements of 37 C.F.R. §2.33(a). See TMEP §§605.03 and 804.04.

Other papers must be signed by the applicant/registrant or by a practitioner meeting the requirements of 37 C.F.R. §10.14. This includes amendments, responses to Office actions, petitions, letters of express abandonment, and requests to change the correspondence address. Generally, if the applicant/registrant is represented by an attorney authorized to practice before the USPTO under 37 C.F.R. §10.14, the attorney must sign. 37 C.F.R. §10.18(a); TMEP §712.01. If the applicant/registrant is not represented by an attorney, the paper must be signed by: (1) the applicant/registrant; or (2) someone with legal authority to bind the applicant/registrant (*e.g.*, a corporate officer or general partner of a partnership). See TMEP §§712.01 *et seq.* regarding the proper person to sign a response to an Office action on behalf of various types of legal entities, and TMEP §605.04 for examples of authorized and potentially unauthorized parties.

An authorized signatory must personally sign his/her name. Another person (*e.g.*, paralegal, legal assistant, secretary) may not sign the name of an attorney or other authorized signatory. In cases of submissions through TEAS, all required electronic signatures must be entered manually by the person(s) identified as the signer(s). Just as signing the name of another person on paper does not serve as the signature of the person whose name is written, typing the electronic signature of another person is not a valid signature by that person.

On the TEAS response to Office action form, the person signing the response must confirm that he/she is authorized to sign the response by clicking one of three buttons indicating that he/she is: (1) an unrepresented applicant who has not previously been represented in this matter, or was previously represented by an attorney who has withdrawn or whose power has been revoked; (2) an attorney who is a member in good standing of the bar of the highest court of a U.S. state, and that if the applicant was previously represented by a different attorney, the previous power has been revoked, or the previously appointed attorney has withdrawn; or (3) an authorized Canadian attorney/agent who has been granted recognition by

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OED, and if the applicant was previously represented by a different attorney, the previous power has been revoked, or the previously appointed attorney has withdrawn. The examiner should accept these statements unless there is conflicting information in the record.

*Example:* If an attorney lists a foreign address and checks the box indicating that he/she is a member in good standing of the bar of the highest court of a U.S. state, the examiner will accept this statement, as long as there is no conflicting information in the record.

*Example:* If an attorney indicates that the applicant was previously unrepresented, or that the applicant was previously represented by another attorney who has withdrawn or whose power has been revoked, when in fact there is another attorney of record whose power has not been revoked, the examiner must inquire into the signatory's authority to sign.

*Exception:* If the signatory indicates that he/she is a qualified Canadian attorney/agent who has been granted recognition by OED, the examiner must still check the OED list to verify this information. See TMEP §602.06(a) for further information about Canadian attorneys.

### 605.03 Signatures on Verifications and Cover Letters

*Verifications.* A person who is not authorized to represent an applicant/registrant under 37 C.F.R. §10.14 may sign applications, allegations of use, and other verifications on behalf of an applicant/registrant, if he/she meets the requirements of 37 C.F.R. §2.33(a), e.g., has firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant/registrant. For example, a corporate manager or foreign in-house counsel might meet this criteria. Generally, the Office does not question the authority of the person who signs a verification. See TMEP §804.04 for further information about verifications.

The broad definition of a "person properly authorized to sign on behalf of an applicant" in 37 C.F.R. §2.33(a) applies *only* to verifications of facts by the applicant or registrant, such as applications for trademark registration, affidavits under §8 or §71 of the Trademark Act, allegations of use, and declarations in support of specimens or claims of acquired distinctiveness. It does **not** apply to powers of attorney, revocations of powers of attorney, responses to Office actions, amendments to applications, letters of express abandonment, petitions, or changes of correspondence address. For example, the "Trademark Administrator" of the applicant, who has firsthand knowledge of the facts alleged in the application, may sign the verified statement in support of the application, but unless that person has legal authority to bind the applicant, or is an attorney as defined in 37 C.F.R. §10.1(c) who has been recognized by the USPTO as the applicant's representative,

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he/she may not sign responses to Office actions or agree to examiner's amendments.

Any person, whether a practitioner or non-practitioner, who presents a paper to the USPTO (whether by signing, filing, submitting, or later advocating the paper) is subject to 37 C.F.R. §10.18(b). See TMEP §605.01.

The signatory must personally sign his or her name. It is unacceptable for a person to sign another person's name to a declaration pursuant to a general power of attorney. See *In re Dermahose Inc.*, 82 USPQ2d 1793 (TTAB 2007).

*Cover Letters.* Even though a person is not authorized to represent an applicant/registrant, he/she may sign a cover letter that merely accompanies properly signed papers. The USPTO does not question the authority of a person who signs a cover letter that does nothing more than transmit papers. However, if the cover letter contains legal arguments or amendments, it must be signed by: (1) an attorney meeting the requirements of 37 C.F.R. §10.14; or (2) by someone with legal authority to bind the applicant/registrant, if the applicant/registrant does not have an attorney.

### **605.04            Examples of Authorized and Potentially Unauthorized Signatories**

Set forth below is a list of examples of parties who are authorized and potentially unauthorized to sign responses, petitions, amendments, letters of express abandonment, and other papers on behalf of an applicant, registrant, or party to a proceeding before the Office. This list is not exhaustive.

*Authorized Parties.* In the following situations, a signatory is presumed to be authorized to represent an applicant, registrant, or party to a proceeding before the Office:

- Person identifies him/herself as an officer of a *pro se* applicant/registrant ("President," "Vice President," "Treasurer," "Secretary," of a domestic corporation or the equivalent for another type of business entity, e.g., "Partner" for a partnership, "Member" or "Principal" for a Limited Liability Company).
- Person signing for a previously *pro se* applicant/registrant identifies him/herself as an attorney in good standing of the bar of the highest court of any state in the United States who is practicing abroad (e.g., Mary Smith, member of New York State Bar, with offices in Nassau, Bahamas).
- Person signing for a foreign corporation identifies him/herself as "general counsel" or "in-house counsel" **AND** a "corporate officer" or another corporate officer position (e.g., "Secretary," "Treasurer," "Vice President").

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- Person signing for a previously *pro se* applicant/registrant identifies him/herself as an attorney with a U.S. law firm or as “general counsel” or “in-house counsel” of a U.S. applicant.
- Person signing is a different attorney from the same U.S.-based firm as the current attorney of record.
- Person signing on behalf of a Canadian applicant/registrant is a Canadian trademark attorney or agent whom OED has recognized as qualified to represent parties located in Canada (see TMEP §602.06(a)).

*Potentially Unauthorized Parties.* In the following situations, a signatory is presumed to be unauthorized to represent an applicant, registrant, or party to a proceeding before the Office:

- Person signing provides no title or position (e.g., applicant is Jack Smith, an individual of the United States, and Mary Jones signs the response; or applicant is ABC Corporation, and Bill Miller, President, signs the original application, but Dave Wilson, with no listed title or position, signs the response).
- Person signing appears to be a foreign attorney (e.g., “solicitor” or “barrister” for a foreign entity), or is a foreign law consultant with a law firm in the United States.
- Person signing identifies him/herself as a non-attorney representing applicant/registrant in some other capacity (e.g., accountant, paralegal, trademark administrator, business manager, personal assistant, legal secretary).
- Person signing provides the address of a foreign firm.
- Person signing in an application/registration owned by a foreign entity identifies him/herself as “attorney for applicant,” “attorney at law,” or similar language, but does not specify an address or firm.
- Person signing identifies him/herself as “attorney-in-fact.”
- Person signing in an application/registration owned by a foreign entity identifies him/herself as “in house counsel” or “general counsel,” with no other indication of officer status or recognition to practice in the United States or before the USPTO per 37 C.F.R. §§10.14(a) or (c).
- Person signing identifies him/herself as “representative of,” “agent for” or “representing” applicant/registrant, with no other explanation.

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- Person signing identifies him/herself as an “authorized signatory” but provides no other indication of the nature of the signer’s relationship to applicant/registrant.
- When an applicant/registrant had previously appointed an attorney authorized to practice before the USPTO pursuant to 37 C.F.R. §10.14 and no new power of attorney or revocation of the previously appointed power has been made of record, and the person signing is a new attorney from a different firm.

### **605.05                    Processing Papers Signed by Someone Other Than the Applicant or the Applicant’s Designated Attorney**

During the examination of a trademark application or Post Registration filing, the examining attorney or Post Registration examiner must ensure that papers are signed by the proper party. See TMEP §605.02.

When it appears that a response to an Office action is signed by an improper party, the examining attorney or Post Registration examiner should treat the response as incomplete. See TMEP §§605.05(a) *et seq.*

When it appears that a paper other than a response to an Office action (*e.g.*, a proposed amendment to an application that is not responsive to an Office action, a petition, or an express abandonment) is signed by an improper party, the examiner should notify the applicant/registrant that no action will be taken on the paper, unless the applicant/registrant either: (1) establishes the signatory’s authority; or (2) submits a properly signed document.

### **605.05(a)                Notice of Incomplete Response When Authority of Person Signing Response is Unclear**

If it appears that a response to an Office action is signed by an improper party, the examining attorney should treat the response as an incomplete response, and should grant the applicant additional time to perfect the response, pursuant to 37 C.F.R. §2.65(b). See TMEP §718.03(b). The applicant must submit a response signed by someone with legal authority to bind the applicant (*e.g.*, a corporate officer or general partner of a partnership), or by an attorney who is authorized to practice under 37 C.F.R. §10.14. These same principles and procedures apply to responses to Office actions issued by Post Registration examiners.

See *also* TMEP §712.03.

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### **605.05(b) Replying to a Notice of Incomplete Response**

If the person who signed the response is an authorized signer, the person may simply telephone or send an e-mail message to the examining attorney or Post Registration examiner to clarify the record, and the examiner will make an appropriate note to the file, review the previously submitted response, and take the appropriate action.

A proper reply to a notice of incomplete response should state the nature of the relationship of the signer to the applicant/registrant. If the signer has legal authority to bind the applicant/registrant, the person should so state, and should set forth his/her title or position. If the signer is an attorney who may practice before the USPTO pursuant to 37 C.F.R. §10.14(a), the attorney should identify him/herself as an attorney and indicate the bar of the U.S. state of which he/she is a member in good standing. If the signer meets the requirements of either §§10.14(b) or (c), the person should explain how he/she meets these requirements. For example, a Canadian attorney or agent recognized to practice before the USPTO in trademark cases by OED (see TMEP §602.06(a)) may simply state he/she has received recognition by OED as a Canadian practitioner under §10.14(c).

In a pending application, if the person who signed the response is not an authorized signer, and all proposed amendments in the improperly signed response can be resolved by an examiner's amendment, a person with legal authority to bind the applicant may telephone the examiner to authorize such an amendment. Otherwise, when the person who signed the response is not an authorized signer, the applicant/registrant must submit a response signed by someone with legal authority to bind the applicant/registrant, or by an attorney who may practice before the USPTO under 37 C.F.R. §10.14.

### **605.05(c) Unsatisfactory Response or Failure to Respond**

*Pending Applications.* In a pending application, if an unsatisfactory response or no response is received to the notice of incomplete response, the examining attorney will abandon the application for incomplete response. See TMEP §718.03(a) for procedures for holding an application abandoned for failure to respond completely.

*Post Registration.* If there is an inadequate response or no response to a notice of incomplete response issued in connection with an affidavit of use or excusable nonuse under §8 or §71, or a §9 renewal application, the registrant must be notified that the affidavit or renewal application remains unacceptable, and that the registration will be cancelled in due course. In the case of a proposed amendment under §7, the trademark specialist must notify the registrant that the request for amendment is abandoned.