KAIZEN CPA LIMITED
啓源會計師事務所有限公司
Rooms 2101-05, 21/F., Futura Plaza
111 How Ming Street, Kwun Tong, Hong Kong
香港觀塘巧明街111號富利廣場21樓2101-05室
T: +852 2341 1444
E: info@kaizencpa.com

# U.S. Trademark Registration Essentials II: Foreign Applicants Must Retain a U.S.-Licensed Attorney

The United States Patent and Trademark Office (USPTO) implemented major reforms to its trademark rules in 2019. One of the most core changes is the mandatory requirement for applicants, registrants, or parties to a proceeding whose domicile is not located within the United States or its territories to be represented by an attorney:

> *"An applicant, registrant, or party to a proceeding whose domicile is not located within the United States or its territories must be represented by an attorney... who is qualified to practice under § 11.14 of this chapter." (37 C.F.R. § 2.11)*

Undoubtedly, this policy has directly increased the compliance costs for cross-border businesses, overseas enterprises, and startups planning to enter the U.S. market. However, reviewing the background and aftermath of this policy reveals an imperative regulatory restructuring.

## 1. Origins of the Reform: From "Pro Se Filings" to the Cross-Border Fraud Crisis

Before the new rules took effect, foreign applicants could choose to file trademark applications directly with the USPTO (known as *Pro se* applications) or retain non-U.S. local agencies/intermediaries. Because online electronic filing was permitted at the time without requiring a domestic U.S. correspondence address, the USPTO communicated with applicants primarily via email.

While this convenience lowered the barrier to entry for overseas enterprises, it sparked two major critical problems:

(1) **Poor Document Quality and Wasted Administrative Resources:** Due to unfamiliarity with U.S. trademark laws, numerous foreign applicants submitted application forms filled with errors. Examining attorneys had to frequently issue Office Actions requiring corrections, severely dragging down examination progress.

(2) **Cross-Border Fraud and Abuse Crisis (2017–2018 Boom):** To break into cross-border e-commerce platforms such as Amazon, certain overseas sellers and unscrupulous agencies

SHENZHEN 深圳
Rooms 1203-06, 12/F.
Di Wang Commercial Centre
5002 Shennan Road East
Luohu District, Shenzhen, China
中國深圳市羅湖區深南東路5002號
地王商業中心12樓1203-06室
T: +86 755 8268 4480

SHANGHAI 上海
Room 1201, 12/F., Tower A
Guangqi Culture Plaza
2899A Xietu Road, Xuhui District
Shanghai, China
中國上海市徐匯區斜土路2899甲號
光啓文化廣場A座12樓1201室
T: +86 21 6439 4114

BEIJING 北京
Room 303, 3/F.
Interchina Commercial Building
33 Dengshikou Street
Dongcheng District, Beijing, China
中國北京市東城區燈市口大街33號
國中商業大廈3樓303室
T: +86 10 6210 1890

TAIPEI 台北
Rooms 7F-702, 7/F., 188 Section 5
Nanjing East Road
Songshan District, Taipei
Taiwan 105411
台灣台北市松山區南京東路五段
188號7樓7F-702室
郵編: 105411
T: +886 2 2711 1324

TOKYO 東京
Rooms 502-03, 5/F.,
Lions Mansion Matsugaya
1-4-6 Matsugaya, Taito, Tokyo
Japan 111-0036
日本東京都台東區松谷1-4-6
獅子大廈5樓502-03室
郵編: 111-0036
T: +81 50 5538 0687

SINGAPORE 新加坡
138 Cecil Street, #13-02 Cecil Court
Singapore 069538
T: +65 6438 0116

KUALA LUMPUR 吉隆坡
Menara Suezcap, Tower 2
E-13A-3A, No. 2 Jalan Kerinchi
Gerbang Kerinchi Lestari
59200 Kuala Lumpur, Malaysia
T: +60 19 2177 344

NEW YORK 紐約
202 Canal Street, Suite 303, 3/F.
New York, NY 10013, USA
T: +1 646 850 5888

LONDON 倫敦
Room 5, 2/F., 39-41 High Street
New Malden, Surrey
KT3 4BY, UK
T: +44 20 3910 8392

began engaging in malicious practices such as identity theft, unauthorized use of attorney signatures, and even fabricating U.S. specimens to submit fraudulent Statements of Use.

However, because the U.S. government lacks direct extraterritorial jurisdiction, the USPTO was often unable to hold non-U.S. intermediaries, applicants, or entities legally accountable or prosecute them when violations occurred. To safeguard the integrity of the trademark database and combat fraudulent activities, the USPTO amended its regulations to mandate that non-U.S. domiciled applicants must appoint U.S.-licensed attorneys.

## 2. Effective Date and Scope of Application for Existing Cases

This mandatory representation requirement officially took effect on **August 3, 2019**.

For applications or registrations filed prior to this date, immediate appointment of a U.S. attorney is not unconditionally required. However, once they enter subsequent proceedings (such as responding to Office Actions, filing 5–6 year Declarations of Use, trademark renewals, changing names/addresses, or handling assignments), appointing a U.S.-licensed attorney becomes mandatory to proceed.

## 3. Weighing Pros and Cons: Analysis of the Mandatory Attorney Requirement

### (1) Cons: Increased Costs and Communication Friction

(a) **Financial Burden:** Applicants must pay additional U.S. attorney representation fees, consultation fees, and costs associated with responding to Office Actions.

(b) **Extended Processes:** An extra layer of attorney relay and review is added. Differences in time zones or overlapping public holidays between regions may extend preliminary preparation timelines.

### (2) Pros: Protecting Rights, Filtering Junk Filings, and Preserving Trademark Value

(a) **Significantly Lowering Violation and Rejection Risks:** U.S. attorneys are legally accountable for the cases they represent; thus, they strictly vet the specimens submitted by clients and filter out falsified materials.

(b) **Preventing Invalid Hoarding and Trademark Gridlock:** This effectively curbs the malicious practice of "hoarding trademarks without actual use," ensuring that brands genuinely operating in the U.S. are not blocked from registration by prior deadwood marks.

(c) **Professional Gatekeeping to Avoid Dual Losses of Time and Money:** Professional attorneys provide precise regulatory advice, preventing companies from blindly filing without understanding local laws—ultimately saving them from the painful consequences of application refusals or forced brand renames.

(d) **Shielding Against Illegitimate Agency Scandals:** Many enterprises that previously entrusted non-compliant agencies later faced USPTO sanction orders, resulting in tens of thousands of approved or pending trademarks being directly invalidated. This not only wasted official fees and agency service charges but also destroyed hard-earned brand goodwill.

## 4. What Kind of Attorney Complies with USPTO Regulations?

According to USPTO regulations, individuals representing foreign applicants must be qualified U.S.-licensed attorneys:

> *"Attorney or lawyer means an individual who is an active member in good standing of the bar of the highest court of any State." (37 C.F.R. § 11.1)*

In other words, the attorney must be an active member in good standing of the bar of the highest court of any U.S. State, territory, or the District of Columbia, and must explicitly list their practicing state and bar membership number in the trademark application form.

## 5. Practical Advice for Foreign Applicants

If you are an enterprise or individual from Hong Kong or other regions without direct personal connections to U.S. lawyers, it is recommended to seek assistance from reputable, comprehensive intellectual property (IP) agencies or consultancy firms.

Excellent agencies typically possess long-term cooperative resources with U.S.-licensed attorneys, offering "one-stop" cross-border application services. By communicating through a single window in a familiar language (eliminating language barriers), the agency translates complex legal jargon into plain, understandable terms. This not only significantly reduces communication costs when entering the U.S. market but also ensures the compliance and security of your trademark portfolio.

*If you wish to obtain more information or assistance, please visit the official website of Kaizen CPA Limited at **www.kaizencpa.com** or contact us through the following and talk to our professionals:*

*Email: info@kaizencpa.com*
*Tel: +852 2341 1444*
*Mobile : +852 5616 4140, +86 152 1943 4614*
*WhatsApp/ Line/ Wechat: +852 5616 4140*
*Skype: kaizencpa*