

# Chapter 600

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*NOTE: This chapter sets forth the procedures for recognition of representatives, signature of documents, and establishing and maintaining the correspondence address in pending applications for registration, and documents filed with the Post Registration Section of the Office. For a statement of practice concerning representation of others, signature of documents, and establishing and maintaining the correspondence address in proceedings before the Trademark Trial and Appeal Board (“Board”), parties should refer to the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), Chapter 100, available on the United States Patent and Trademark Office (“USPTO”) website at <http://www.uspto.gov>, or contact the Board at (571) 272-8500.*

## **601 Owner of Mark May Be Represented by an Attorney at Law**

The owner of a mark may represent himself or herself in prosecuting an application or maintaining a registration, or may be represented by a practitioner authorized under 37 C.F.R. §11.14 to practice in trademark cases (“qualified practitioner”). 37 C.F.R. §2.11. See TMEP §§602 *et seq.* regarding persons authorized to practice before the USPTO in trademark cases.

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

The USPTO cannot aid in the selection of a qualified practitioner. 37 C.F.R. §2.11.

If it is apparent that an applicant or registrant is unfamiliar with the procedures for prosecuting an application or maintaining a registration and needs more detailed or technical assistance than the USPTO staff is permitted to give, the USPTO staff may suggest that it may be desirable to employ an attorney who

is familiar with trademark matters. The following is an example of language that 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. 37 C.F.R. §2.11.

## **601.02                    Communications With Applicant or Registrant Who Is Represented by an Attorney**

*37 C.F.R. §2.18(a)(7). Once the Office has recognized a practitioner qualified under §11.14 of this chapter as the representative of an applicant or registrant, the Office will communicate and conduct business only with that practitioner, or with another qualified practitioner from the same firm. The Office will not conduct business directly with the applicant or registrant, or with another practitioner from a different firm, unless the applicant or registrant files a revocation of the power of attorney under §2.19(a), and/or a new power of attorney that meets the requirements of §2.17(c). A written request to change the correspondence address does not revoke a power of attorney.*

If an applicant or registrant is represented by a qualified practitioner, the USPTO will conduct business only with the practitioner, unless that representation is terminated. 37 C.F.R. §2.18(a)(7). If the applicant or registrant contacts the USPTO regarding the application or registration, he or she will be advised that the USPTO will only conduct business with the qualified practitioner. USPTO employees may answer general questions about the application or registration record and the procedures for obtaining and maintaining a registration, and are encouraged to refer the applicant or registrant to publicly available information on the USPTO's website. See TMEP §1805 regarding general inquiries from the public.

An applicant or registrant may not authorize an examiner's amendment or change of correspondence address, and the USPTO will not accept responses or amendments signed by the applicant or registrant if there is a qualified practitioner of record. See TMEP §§611 *et seq.* regarding signature of documents filed in the USPTO.

If the applicant or registrant wishes to revoke the power of attorney, the applicant or registrant should be encouraged to file the revocation through the Trademark Electronic Application System ("TEAS"). See TMEP §606 regarding revocation.

See TMEP §604.03 regarding changes of attorney, TMEP §604.02 regarding the duration of recognition as a representative, and TBMP §§114 *et seq.* regarding representation of parties to proceedings before the Board.

**Persons Authorized to Practice Before USPTO in Trademark Matters**

*37 C.F.R. §11.14. Individuals who may practice before the Office in trademark and other non-patent matters.*

*(a) Attorneys. Any individual who is an attorney as defined in §11.1 may represent others before the Office in trademark and other non-patent matters. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent matters. Registration as a patent practitioner does not itself entitle an individual to practice before the Office in trademark matters.*

*(b) Non-lawyers. Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent matters, except that individuals not attorneys who were recognized to practice before the Office in trademark matters under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark matters. Except as provided in the preceding sentence, registration as a patent agent does not itself entitle an individual to practice before the Office in trademark matters.*

*(c) Foreigners. Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal recognition under paragraph (f) of this section and prove to the satisfaction of the OED 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 and is possessed of good moral character and reputation, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark matters, provided: the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark matters before the 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 matters on behalf of a client. Any individual may appear in a trademark or other non-patent matter in his or her own behalf. Any individual may appear in a trademark matter for:*

*(1) A firm of which he or she is a member,*

*(2) A partnership of which he or she is a partner, or*

*(3) A corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, partnership, corporation, or association is a party to a trademark proceeding pending before the Office.*

*(f) Application for reciprocal recognition. An individual seeking reciprocal recognition under paragraph (c) of this section, in addition to providing evidence satisfying the provisions of paragraph (c) of this section, shall apply in writing to the OED Director for reciprocal recognition, and shall pay the application fee required by §1.21(a)(1)(i) of this subchapter.*

Under 37 C.F.R. §11.14, only the following individuals may represent an applicant or registrant in a trademark case:

- An attorney as defined in 37 C.F.R. §11.1, i.e., an attorney who is a member in good standing of the bar of the highest court of a state in the United States;
- A Canadian patent agent who is registered with the USPTO's Office of Enrollment and Discipline ("OED") and in good standing as a patent agent under 37 C.F.R. §11.6(c) for the limited purpose of representing parties located in Canada;
- A Canadian attorney or agent who has been granted recognition by the Director of Enrollment and Discipline ("OED Director") for the limited purpose of representing parties located in Canada, pursuant to 37 C.F.R. §11.14(f); or
- An individual who is not an attorney but was recognized to practice before the USPTO in trademark cases prior to January 1, 1957.

See TMEP §602.03(a) regarding Canadian attorneys and agents, and TBMP §§114 *et seq.* regarding representation of parties to Board proceedings.

## **602.01 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. §§11.1 (definition of attorney) and 11.14(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 United States attorneys entitled to practice in trademark cases. An attorney meeting the requirements of 37 C.F.R. §11.14 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(b). A telephone call from an attorney does not satisfy the "appearance" requirements of 37 C.F.R. §2.17(b).

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 United States 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 or registration, the USPTO will permit the attorney to conclude business, and will note this fact in any resulting examiner's amendment, priority action, or Office action.

## **602.02 Non-Attorneys**

*37 C.F.R. §2.17(f). Non-lawyers. A non-lawyer may not act as a representative except in the limited circumstances set forth in §11.14(b) of this chapter. Before any non-lawyer who meets the requirements of §11.14(b) of this chapter may take action of any kind with respect to an application, registration or proceeding, a written authorization must be filed, signed by the applicant, registrant, or party to the proceeding, or by someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer or general partner of a partnership).*

*37 C.F.R. §11.14(b). Non-lawyers. Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent matters, except that individuals not attorneys who were recognized to practice before the Office in trademark matters under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark matters. Except as provided in the preceding sentence, registration as a patent agent does not itself entitle an individual to practice before the Office in trademark matters.*

Non-attorneys are not permitted to practice except under the limited circumstances specified in 37 C.F.R. §11.14(b), set forth above. 5 U.S.C. §§500(b) and (d); 37 C.F.R. §§2.17(f) and 11.14(e).

See TMEP §608.01 regarding unauthorized practice and TMEP §§611 *et seq.* regarding signature of documents filed in the USPTO.

## **602.03 Foreign Attorneys and Agents**

*37 C.F.R. §11.14(c). Foreigners. Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal recognition under paragraph (f) of this section and prove to the satisfaction of the OED 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 and is possessed of good moral character and reputation, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark matters, provided: the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.*

*37 C.F.R. §11.14 (f). Application for reciprocal recognition. An individual seeking reciprocal recognition under paragraph (c) of this section, in addition to*

*providing evidence satisfying the provisions of paragraph (c) of this section, shall apply in writing to the OED Director for reciprocal recognition, and shall pay the application fee required by §1.21(a)(1)(i) of this subchapter.*

Generally, only an attorney as defined in 37 C.F.R. §11.1 may represent an applicant or registrant before the USPTO. 5 U.S.C. §§500(b) and (d); 37 C.F.R. §§2.17, 11.14(c), and (e). In very limited circumstances, Canadian agents or attorneys registered or in good standing before the Canadian Intellectual Property Office may file an application for reciprocal recognition to represent parties located in Canada.

A foreign attorney or agent may be recognized to represent parties located in the country in which the foreign attorney resides and practices, only if:

- (1) He or she applies in writing for reciprocal recognition and pays the fee required by 37 C.F.R. §1.21(a)(1)(i);
- (2) He or she proves to the satisfaction of the OED 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 and is possessed of good moral character and reputation; and
- (3) The patent or trademark office of that foreign country allows substantially reciprocal privileges to those permitted to practice before the USPTO.

37 C.F.R. §§11.14(c) and (f). The application for reciprocal recognition must be filed prior to practicing before the USPTO in trademark matters. A foreign attorney or agent may not practice before the USPTO in trademark matters prior to being recognized by the OED Director. Practice before the USPTO in trademark matters includes preparing and prosecuting applications for trademark registration and otherwise representing a party before the USPTO. See 37 C.F.R. §11.5(b)(2). The OED Director grants recognition only in the form of a written communication. A foreign attorney or agent not recognized to practice before the USPTO in trademark cases should allow adequate time to file and obtain recognition before representing a party 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 above criteria. See TMEP §602.03(a) regarding Canadian attorneys and agents.

### **602.03(a) Canadian Attorneys and Agents**

*37 C.F.R. §2.17(e). Canadian attorneys and agents. (1) A Canadian patent agent who is registered and in good standing as a patent agent under §11.6(c) may represent parties located in Canada before the Office in trademark matters.*

(2) A Canadian attorney or agent who is registered or in good standing with the Canadian Intellectual Property Office, but not registered as a patent agent under §11.6(c), may represent parties located in Canada if he or she has been authorized to do so by the Director of the Office of Enrollment and Discipline, pursuant to §11.14(f) of this chapter.

*Written Application and Fee Required.* A Canadian attorney or agent may represent parties located in Canada only if:

- (1) He or she is registered with the USPTO and in good standing as a patent agent under 37 C.F.R. §11.6(c); or
- (2) He or she files an application for and is granted recognition by the OED Director under 37 C.F.R. §11.14(c). To be recognized under 37 C.F.R. §11.14(c), an individual must file a written application and pay the fee required by 37 C.F.R. §1.21(a)(1)(i) prior to representing a party before the USPTO. The application must include proof that the individual meets the requirements of 37 C.F.R. §11.14(c), and must be addressed to the OED Director, Mail Stop OED, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. 37 C.F.R. §11.14(f).

37 C.F.R. §2.17(e).

*May Only Represent Parties Located in Canada.* Once recognized by OED, a Canadian attorney or agent can only represent parties located in Canada. 37 C.F.R. §2.17(e)(1). Thus, even if the attorney or agent is on the OED list, he or she cannot represent a party located in the United States or in another foreign country before the USPTO. For example, he or she cannot represent a Canadian national who resides in California and has access to a mailing address in Canada.

*Lists of Canadian Attorneys and Agents Who Have Been Recognized by OED.* OED maintains two separate lists of attorneys and agents who have been recognized as qualified to represent parties located in Canada:

- (1) The names of Canadian patent agents who are registered with the USPTO under 37 C.F.R. §11.6(c) are listed with other registered patent practitioners on the USPTO website at <https://oedci.uspto.gov/OEDCI/GeoRegion.jsp>. Registered practitioners located in Canada, including United States 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;

- (2) OED maintains a separate list of attorneys and agents who are not registered as patent agents but have been recognized under 37 C.F.R. §§11.14(c) and (f) as qualified to represent parties located in Canada. This list is available only on the USPTO's internal computer network.

If a Canadian attorney or agent is designated or acts as a representative of a party in a trademark matter, the USPTO staff must verify that the attorney or agent is recognized by OED by checking these lists. USPTO staff must check these lists even if the individual files a document through TEAS and checks a box indicating that he or she is an authorized Canadian attorney or agent who has been granted recognition by OED. See TMEP §611.02(a) regarding TEAS checkoff boxes.

If the individual appears on one of the lists, the USPTO staff should make an appropriate note in the "Notes-to-the-File" section of the record. If the individual does not appear on either list, the USPTO will treat any document filed by that individual as a document filed by an unauthorized person. See TMEP §§611.05 et seq. for information about processing these documents.

If a USPTO employee suspects that an individual who does not meet the requirements of 37 C.F.R. §§11.6(c) or 11.14(c) is engaging in widespread unauthorized practice by representing applicants or registrants, he or she should bring the matter to the attention of the Administrator for Trademark Policy and Procedure in the Office of the Deputy Commissioner for Trademark Examination Policy ("Administrator").

### **602.03(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 unless he or she establishes that he or she meets the requirements of 37 C.F.R. §11.14. 5 U.S.C. §§500(b) and (d). Any such attorney or agent who attempts to represent a party in a trademark matter should be advised that he or she must file a written application for reciprocal recognition with OED and pay the fee required by 37 C.F.R. §1.21(a)(1)(i); that the application must be filed and granted prior to representing a party before the USPTO; and that the application must include proof that the attorney or agent is in good standing with the foreign patent or trademark office in the country in which the attorney or agent resides, that the attorney or agent is possessed of good moral character and reputation, and that the USPTO Director has recognized that the foreign patent or trademark office provides substantially reciprocal rights to United States attorneys. 37 C.F.R. §§11.14(c) and (f).

### **602.03(c) Documents 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. §11.14 may receive correspondence from the USPTO and transmit it to the applicant or registrant. However, a foreign attorney or agent cannot prepare an application, response, or other document to be filed in the USPTO, sign responses to Office actions, or authorize issuance of examiner's amendments and priority actions. Preparing a document, authorizing an amendment to an application, and submitting legal arguments in response to a requirement or refusal all constitute examples of representation of a party in a trademark matter. See 37 C.F.R. §11.5(b)(2); TMEP §608.01.

If a foreign attorney or agent who does not meet the requirements of 37 C.F.R. §11.14(c) is designated or acts as a representative of a party in a trademark matter, the USPTO will treat any document submitted by the attorney or agent as a document filed by an unauthorized party and follow the procedures in TMEP §§611.05 *et seq.*

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

In the case of an application under Trademark Act §66(a), 15 U.S.C. §1141f(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 person will not be recognized by the USPTO as a representative without further clarification of his or her qualifications under 37 C.F.R. §11.14. See TMEP §609.01(a) regarding correspondence in §66(a) applications, and TMEP §§611 *et seq.* regarding signature on correspondence filed in the USPTO.

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

If a new application identifies an attorney or agent with an address outside the United States (e.g., if a foreign address is set forth in the "attorney" section of a TEAS form), the examining attorney must advise in an Office action that unless the person meets the requirements of 37 C.F.R. §11.14, he or she 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 the identified person can establish that he or she is a qualified attorney, e.g., a member in good standing of the bar of the highest court of a U.S. state, who has an address abroad, then he or she is a qualified practitioner under 37 C.F.R. §§11.1 and 11.14(a).

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

See TMEP §609.04 regarding correspondence with parties not domiciled in the United States.

## **603 Standards of Conduct**

*37 C.F.R. §11.15. Any practitioner authorized to appear before the Office may be suspended, excluded, or reprimanded in accordance with the provisions of this Part. Any practitioner who is suspended or excluded under this Part shall not be entitled to practice before the Office in patent, trademark, or other non-patent matters while suspended or excluded.*

*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.*

Parts 10 and 11 of Title 37 of the Code of Federal Regulations pertain to representation of others before the USPTO. Part 11 identifies and defines individuals entitled to practice before the USPTO, and sets forth a procedure for investigations and disciplinary proceedings. Part 10 establishes a mandatory Code of Professional Responsibility.

## **604 Recognition as a Representative**

### **604.01 Three Ways to Be Recognized**

*37 C.F.R. §2.17(b).*

*(1) Recognition of practitioner as representative. To be recognized as a representative in a trademark case, a practitioner qualified under §11.14 of this chapter may:*

*(i) File a power of attorney that meets the requirements of paragraph (c) of this section;*

*(ii) Sign a document on behalf of an applicant, registrant, or party to a*

*proceeding who is not already represented by a practitioner qualified under §11.14 of this chapter from a different firm; or*

*(iii) Appear in person on behalf of an applicant, registrant, or party to a proceeding who is not already represented by a practitioner qualified under §11.14 of this chapter from a different firm.*

*(2) Signature as certificate of authorization to represent. When a practitioner qualified under §11.14 of this chapter appears in person or signs a document pursuant to paragraph (b) of this section, his or her personal appearance or signature shall constitute a representation to the Office that he or she is authorized to represent the person or entity on whose behalf he or she acts. The Office may require further proof of authority to act in a representative capacity.*

To be recognized as a representative, a qualified practitioner may:

- File a power of attorney signed by the individual applicant or registrant or someone with legal authority to bind a juristic applicant or registrant (e.g., a corporate officer or general partner of a partnership);
- Sign a document on behalf of an applicant or registrant who is not already represented by a qualified practitioner from a different firm; or
- Appear in person on behalf of an applicant or registrant who is not already represented by a qualified practitioner from a different firm.

37 C.F.R. §2.17(b). A foreign attorney or agent who has not been recognized by the OED Director pursuant to 37 C.F.R. §11.14(c) or registered as a patent agent pursuant to 37 C.F.R. §11.6(c) may not be recognized as a representative.

Generally, as long as no other qualified practitioner from a different firm has been previously appointed, it is not necessary for a qualified practitioner to file a power of attorney or any other special authorization in a trademark case. A qualified practitioner 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. A telephone call from a qualified practitioner does not satisfy the “appearance” requirements of 37 C.F.R. §2.17(b). Such a practitioner will not be recognized as a representative, and he or she may not authorize amendments to an application by telephone.

Once the USPTO has recognized a qualified practitioner as the representative of an applicant or registrant, the USPTO will communicate and conduct business only with that practitioner or with another qualified practitioner from the same United States firm. The USPTO will not conduct business directly with the applicant or registrant, or with a qualified practitioner from a different firm, unless the applicant or registrant files a new power of attorney or revokes the previous power, or the previously recognized

practitioner files a request to withdraw. 37 C.F.R. §2.18(a)(7). See TMEP §604.02 regarding duration of recognition, and TMEP §606 regarding revocation of power of attorney.

See TMEP §§609.01 and 609.02 *et seq.* regarding the correspondence address, and TBMP §§114 *et seq.* regarding representation of parties to Board proceedings.

## **604.02 Duration of Recognition**

*37 C.F.R. §2.17(g). Duration of power of attorney. (1) For purposes of recognition as a representative, the Office considers a power of attorney filed while an application is pending to end when the mark registers, when ownership changes, or when the application is abandoned.*

*(2) The Office considers a power of attorney filed after registration to end when the mark is cancelled or expired, or when ownership changes. If the power was filed in connection with an affidavit under section 8, 12(c), 15 or 71 of the Trademark Act, renewal application under section 9 of the Act, or request for amendment or correction under section 7 of the Act, the power is deemed to end upon acceptance or final rejection of the filing.*

*Pending Applications.* For purposes of recognition as a representative, the USPTO considers a power of attorney filed while an application is pending to end when the mark is registered, when ownership changes, or when the application is abandoned. 37 C.F.R. §2.17(g)(1).

*Post Registration.* For purposes of recognition as a representative by the Post Registration Section of the Office, the USPTO considers a power of attorney filed in connection with an affidavit under 15 U.S.C. §1058, §1062(c), §1065, or §1141k (“affidavit under §8, §12(c), §15, or §71”), a renewal application under 15 U.S.C. §1059 (“§9 renewal application”), or a request for amendment or correction under 15 U.S.C. §1057 (“§7 request”) to end upon acceptance or final rejection of the filing. 37 C.F.R. §2.17(g)(2). Due to the length of time that may elapse between the filing of these documents (which could be 10 years or more), the USPTO will recognize a qualified practitioner who transmits one of these documents even absent a new power of attorney or revocation of a previous power.

*Example 1:* A qualified practitioner (Attorney A) transmits an affidavit under §8, and the USPTO issues an Office action in connection with the affidavit. If another qualified practitioner from a different firm (Attorney B) wants to respond to the Office action, Attorney B must file a new power of attorney and/or revocation of the previous power, signed by the registrant or someone with legal authority to bind the registrant (e.g., a corporate officer or general partner of a partnership), before the USPTO will act on the response or correspond with Attorney B.

*Example 2:* A qualified practitioner (Attorney A) transmits an affidavit under §8, and the USPTO accepts the affidavit. If another qualified practitioner from a different firm (Attorney B) later files a §7 request, the USPTO will recognize and correspond with Attorney B regardless of whether a new power of attorney or revocation of the previous power is filed.

*Example 3:* A qualified practitioner (Attorney A) transmits an affidavit under §8, and the USPTO issues an action in connection with the affidavit. If another qualified practitioner from a different firm (Attorney B) wants to file a §7 request before the USPTO accepts or issues a final rejection of the §8 affidavit, Attorney B must file a new power of attorney and/or revocation of the previous power, signed by the registrant or someone with legal authority to bind the registrant (e.g., a corporate officer or general partner of a partnership), before the USPTO will act on the §7 request or correspond with Attorney B.

The USPTO also considers a power of attorney filed after registration to end when the registration is cancelled or expired. 37 C.F.R. §2.17(g)(2). Therefore, the USPTO will not enter a request to withdraw as attorney or revocation of a power of attorney filed in connection with a cancelled or expired registration, unless it is accompanied by a petition to reinstate the registration. See TMEP §605.04 regarding powers of attorney filed after registration.

*Change of Ownership.* For purposes of recognition as a representative, the USPTO considers a power of attorney filed in connection with an application or registration to end when ownership changes. 37 C.F.R. §2.17(g). After a change in ownership has been recorded, if a new qualified practitioner appears on behalf of the new owner, the USPTO will communicate and conduct business with that practitioner even absent a new power of attorney or revocation of the previous power. If the previously recognized practitioner appears on behalf of the new owner (which might occur when the new owner is a related company), the USPTO will continue to conduct business and correspond with that practitioner. The previously recognized practitioner does not have to file a new power of attorney signed by the new owner. See TMEP §609.02(f) regarding correspondence after recordation of a change of ownership.

*Effect on Attorney and Correspondence Information in USPTO Records.* In the situations discussed above, when the USPTO deems a power of attorney to end for purposes of recognition as a representative, the USPTO does not automatically change the attorney and correspondence address in its automated records (i.e., the Trademark Reporting and Monitoring (“TRAM”) System and Trademark Applications and Registrations Retrieval (“TARR”) database), because it is possible that the previously recognized practitioner still represents the applicant or registrant and wants to continue receiving

correspondence. The USPTO will continue to recognize the previously recognized practitioner if he or she appears or signs a document on behalf of the applicant or registrant. However, if a new qualified practitioner appears in person or signs a document, the Office will recognize the new qualified practitioner pursuant to 37 C.F.R. §2.17(b), without requiring a new power of attorney or revocation of the previous power. See TMEP §§609.02 *et seq.* regarding changes of correspondence address.

These practices also apply where a qualified practitioner is recognized by appearing in person or filing a document on behalf of the party whom he or she represents. See 37 C.F.R. §2.17(b); TMEP §604.01.

*Board Proceedings.* See TBMP §§114 *et seq.* regarding representation of parties to Board proceedings, and TBMP §§117 *et seq.* regarding correspondence in Board proceedings.

### **604.03            Change of Attorney**

Once the USPTO recognizes a qualified practitioner as the representative of an applicant or registrant, a new qualified practitioner from a different firm is not permitted to represent the applicant or registrant until: (1) the applicant or registrant revokes the previous power of attorney; (2) the applicant or registrant submits a new power of attorney naming the new qualified practitioner; or (3) the previously recognized practitioner files a request to withdraw. 37 C.F.R. §2.18(a)(7). Until such action is taken, the new qualified practitioner cannot sign responses to Office actions, authorize issuance of examiner's amendments or priority actions, expressly abandon an application, authorize a change of correspondence address, or otherwise represent the applicant or registrant.

If an applicant or registrant is already represented by a qualified practitioner, and a new qualified practitioner from a different firm wishes to take action with respect to the application or registration, the new practitioner must file a revocation of the previous power of attorney or new power of attorney naming the new qualified practitioner, signed by the individual applicant or registrant or a person with legal authority to bind a juristic applicant or registrant (e.g., a corporate officer or general partner of a partnership), before the USPTO will accept filings by or correspond with the new practitioner. 37 C.F.R.

§2.18(a)(7). The new practitioner may not sign the revocation of the previous power him or herself. See TMEP §605.01 regarding requirements for power of attorney, and TMEP §606 regarding revocation of power of attorney.

Absent a revocation or new power, if the new qualified practitioner signs a response, amendment, or request to change the correspondence address, the USPTO will treat this as a document filed by an unauthorized party and follow the procedures in TMEP §§611.05 *et seq.*

For purposes of recognition as a representative of an applicant or registrant, the USPTO considers a power of attorney filed while an application is pending to end with respect to a particular application when the mark is registered or abandoned, or when ownership changes. 37 C.F.R. §2.17(g)(1). The USPTO considers a power of attorney filed after registration to end when the registration is cancelled or expired, or when ownership changes. If the power is filed in connection with an affidavit under §8, §12(c), §15, or §71, a §9 renewal application, or a §7 request, the power is deemed to end upon acceptance or final rejection of the filing. 37 C.F.R. §2.17(g)(2). See TMEP §604.02. In these situations, it is unnecessary to file a new power of attorney or revocation of the previous power before a new qualified practitioner takes an action. See TMEP §605.04 regarding the processing of powers of attorney filed after registration.

See TBMP §§114 *et seq.* regarding representation of parties to Board proceedings, and TBMP §§117 *et seq.* regarding correspondence in Board proceedings

## **605 Powers of Attorney**

### **605.01 Requirements for Power of Attorney**

*37 C.F.R. §2.17(c). Requirements for power of attorney. A power of attorney must:*

*(1) Designate by name at least one practitioner meeting the requirements of §11.14 of this chapter; and*

*(2) Be signed by the individual applicant, registrant, or party to a proceeding pending before the Office, or by someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer or general partner of a partnership). In the case of joint applicants or joint registrants, all must sign. Once the applicant, registrant, or party has designated a practitioner(s) qualified to practice under §11.14 of this chapter, that practitioner may sign an associate power of attorney appointing another qualified practitioner(s) as an additional person(s) authorized to represent the applicant, registrant, or party. If the applicant, registrant, or party revokes the original power of attorney (§2.19(a)), the revocation discharges any associate power signed by the practitioner whose power has been revoked. If the practitioner who signed an associate power withdraws (§2.19(b)), the withdrawal discharges any associate power signed by the withdrawing practitioner upon acceptance of the request for withdrawal by the Office.*

A power of attorney must: (1) designate by name at least one individual qualified practitioner; and (2) be signed by the individual applicant or registrant or someone with legal authority to bind a juristic applicant or registrant (e.g., a corporate officer or partner of a partnership). In the case of joint applicants or registrants, all must sign. 37 C.F.R. §§2.17(c) and

2.193(e)(3). See TMEP §611.01(c) regarding signature of documents transmitted electronically.

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 §§609 *et seq.* regarding the correspondence address.

A qualified practitioner cannot sign an original power of attorney on behalf of his or her client. An original power of attorney, other than one associating an additional attorney with an already recognized attorney (see TMEP §605.03), must be signed by the individual applicant or registrant or someone with legal authority to bind a juristic applicant or registrant.

However, the filing of a power of attorney is not mandatory in a trademark case. Thus, if a power of attorney is signed by an improper person (e.g., by the named attorney) and no other qualified practitioner has been previously appointed, the USPTO generally does not require a properly signed power. If the improperly signed power is accompanied by a document that is signed by a qualified practitioner or includes the name and address of a qualified practitioner, the USPTO may recognize that qualified practitioner under 37 C.F.R. §2.17(b), separate and apart from the improperly signed power. See TMEP §604.01 regarding the three ways that a qualified practitioner can be recognized as a representative, TMEP §609.01 regarding establishment of the correspondence address in a new application, and TMEP §609.02(a) regarding the limited situations in which the USPTO will change the correspondence address to that of a qualified practitioner absent a written request to change the correspondence address.

*Example:* If the original application contains the name and address of a qualified practitioner (e.g., if the “Attorney” section of a TEAS application contains the name and address of an attorney from a United States firm or a Canadian attorney or agent who has been recognized by the OED Director), and the application includes a power of attorney signed by the named practitioner, the USPTO will disregard the improperly signed power. However, the USPTO will recognize and correspond with the named qualified practitioner, pursuant to 37 C.F.R. §2.17(b).

However, if an applicant or registrant is already represented by a qualified practitioner, and a new qualified practitioner wishes to take action with respect to the application or registration, the new qualified practitioner must file a new power of attorney or revocation of the previous power, signed by the individual applicant or registrant or someone with legal authority to bind a juristic applicant or registrant, before the USPTO will accept filings by or correspond with the new qualified practitioner. 37 C.F.R. §2.18(a)(7). See TMEP §604.03 regarding change of attorney, and TMEP §606 regarding revocation of power of attorney.

If two or more qualified practitioners are named in a power of attorney, any of the named practitioners can sign and submit a notice of change of correspondence address setting forth a new address, even if the new address is at a new firm. It is not necessary to submit a new power signed by the applicant or registrant when a named practitioner(s) changes firms. See TMEP §§609.02 *et seq.* regarding changes of address.

To expedite processing, the USPTO recommends that powers of attorney be filed through TEAS, at <http://www.uspto.gov>. When powers of attorney are filed through TEAS, the data is automatically entered into the USPTO's automated records.

## **605.02 Power of Attorney Relating to More Than One Application or Registration**

*37 C.F.R. §2.17(d). Power of attorney relating to multiple applications or registrations. (1) The owner of an application or registration may appoint a practitioner(s) qualified to practice under §11.14 of this chapter for up to twenty applications or registrations that have the identical owner name and attorney through TEAS.*

*(2) The owner of an application or registration 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 owner, on paper. A person relying on such a power of attorney must:*

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

*(ii) 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 person 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.*

Using TEAS, at <http://www.uspto.gov>, an applicant or registrant may appoint a qualified practitioner for up to 20 existing applications or registrations that have the identical owner and qualified practitioner. 37 C.F.R. §2.17(d)(1). 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)(2). If the applicant or registrant meets these requirements, the USPTO will accept the power of attorney.

### **605.03 Associate Powers of Attorney**

Once the applicant or registrant has designated a qualified practitioner, the practitioner may sign an associate power of attorney, appointing another qualified practitioner -- including one from a different law firm -- as an additional person authorized to represent the applicant or registrant. 37 C.F.R. §2.17(c)(2).

If the applicant or registrant revokes the original power of attorney, the revocation also discharges any associate power signed by the practitioner whose power has been revoked. 37 C.F.R. §2.17(c)(2).

If the practitioner who signed an associate power withdraws, the withdrawal discharges any associate power signed by the withdrawing practitioner upon acceptance of the request for withdrawal by the USPTO. 37 C.F.R. §2.17(c)(2).

### **605.04 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>. When powers of attorney are filed through TEAS, the data is automatically entered into the USPTO's automated records (i.e., TRAM and TARR).

When a new power of attorney is filed *on paper* after registration, the USPTO scans an image of the document into the Trademark Image Capture and Retrieval System ("TICRS") and Trademark Document Retrieval ("TDR") portal, but does not change the attorney information in the USPTO's automated records unless the registrant concurrently takes a separate action, such as filing an affidavit under §8.

For purposes of recognition as a representative, the USPTO considers a power of attorney filed while an application is pending to end with registration. 37 C.F.R. §2.17(g)(1). If the power is filed in connection with an affidavit under §8, §12(c), §15, or §71, a §9 renewal application, or a §7 request, the power is deemed to end upon acceptance or final rejection of the filing. 37 C.F.R. §2.17(g)(2). See TMEP §604.02.

See *also* TMEP §1612 regarding powers of attorney filed after registration, and TMEP §609.02 *et seq.* regarding changing the correspondence address after registration.

**Revocation of Power of Attorney**

*37 C.F.R. §2.19(a). Revocation. (1) Authority to represent an applicant, registrant or party to a proceeding before the Office may be revoked at any stage in the proceedings of a trademark case, upon written notification signed by the applicant, registrant, or party to the proceeding, or by someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer or general partner of a partnership). In the case of joint applicants or joint registrants, all must sign.*

*(2) When a power of attorney 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 appropriate.*

*(3) A request to change the correspondence address does not revoke a power of attorney.*

*(4) A new power of attorney that meets the requirements of §2.17(c) will be treated as a revocation of the previous power.*

Once a qualified practitioner has been recognized as the representative of an applicant or registrant, the applicant or registrant may revoke the power by filing a written revocation. To expedite processing, the USPTO recommends that revocations of powers of attorney be filed through TEAS, at <http://www.uspto.gov>.

*Signature.* The revocation must be personally signed by the individual applicant or registrant, or by someone with legal authority to bind a juristic applicant or registrant (e.g., a corporate officer or partner of a partnership). In the case of joint applicants or registrants, all must sign. 37 C.F.R. §§2.19(a) and 2.193(e)(3).

A new qualified practitioner cannot sign a revocation of the previous power. A new qualified practitioner may submit a revocation and new appointment of power of attorney through TEAS by e-mailing the text form to the applicant or 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 or registrant. See TMEP §611.01(c) regarding electronic signature. A new qualified practitioner should not directly sign the TEAS revocation form.

*Effect on Correspondence Address.* If the applicant or 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 or registrant files a revocation of the previous power of attorney without a new power of attorney, correspondence will be sent either: (1) directly to the applicant or registrant or to the correspondence address designated by the applicant or registrant; or (2) if the revocation is transmitted by a qualified practitioner, to the qualified practitioner who signed the cover

letter or action accompanying the revocation. See TMEP §§609.02 and 609.02(a).

*New Power Treated as Revocation.* If the applicant or registrant files a new power of attorney naming a new qualified practitioner as its representative, this will be treated as a revocation of any previous power of attorney, even if the applicant or registrant does not specifically revoke the previous power. 37 C.F.R. §2.19(a)(4).

*Request to Change Correspondence Address Does Not Revoke Power of Attorney.* A written request to change the correspondence address does not revoke a power of attorney. 37 C.F.R. §§2.18(a)(7) and 2.19(a)(3). See TMEP §604.03 regarding changes of attorney, and TMEP §§609.02 *et seq.* regarding changes of address.

*Processing Revocations Filed After Registration.* For purposes of recognition as a representative, the USPTO considers a power of attorney to end with registration. If the power is filed in connection with an affidavit under §8, §12(c), §15, or §71, a §9 renewal application, or a §7 request, the power is deemed to end upon acceptance or final rejection of the filing. 37 C.F.R. §2.17(g)(2). See TMEP §604.02.

After registration, if the registrant files a *paper* request to revoke a power of attorney appointed before registration, the USPTO scans an image of the revocation into TICRS and TDR but does not update the attorney information in its automated records (i.e., TRAM and TARR) unless the registrant concurrently takes an action such as filing an affidavit under §8. See TMEP §1612. When a request to revoke a power of attorney is filed through TEAS after registration, the data from the form is inputted directly into the automated records of the USPTO.

*Board Proceedings.* See TBMP §116.01 regarding revocation of authority to represent parties to Board proceedings.

## **607                      Withdrawal of Attorney of Record**

*37 C.F.R. §2.19(b) Withdrawal of attorney. If the requirements of §10.40 of this chapter are met, a practitioner authorized to represent an applicant, registrant, or party to a proceeding in a trademark case may withdraw upon application to and approval by the Director or, when applicable, upon motion granted by the Trademark Trial and Appeal Board. The practitioner should file the request to withdraw soon after the practitioner notifies the client of his/her intent to withdraw. The request must include the following:*

*(1) The application serial number, registration number, or proceeding number;*

*(2) A statement of the reason(s) for the request to withdraw; and*

*(3) Either*

(i) A statement that the practitioner has given notice to the client that the practitioner is withdrawing from employment and will be filing the necessary documents with the Office; that the client was given notice of the withdrawal at least two months before the expiration of the response period, if applicable; that the practitioner has delivered to the client all documents and property in the practitioner's file concerning the application, registration or proceeding to which the client is entitled; and that the practitioner has notified the client of any responses that may be due, and of the deadline for response; or

(ii) If more than one qualified practitioner is of record, a statement that representation by co-counsel is ongoing.

*May Not Prejudice Applicant or Registrant.* A qualified practitioner may withdraw from representing an applicant or registrant, but may not withdraw in a way that would prejudice the applicant or registrant. 37 C.F.R. §10.40(a). *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 documents and property in his file concerning the prosecution of the application to the applicant). See 37 C.F.R. §§10.40(b) and (c) regarding mandatory and permissive withdrawal from employment by an attorney.

*Form.* To expedite processing, the USPTO recommends that all requests to withdraw be filed through TEAS, at <http://www.uspto.gov>. 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. If filed on paper, the request should be titled "Request for Permission to Withdraw as Attorney of Record."

*Requirements for Request.* A request to withdraw must include the following:

- (1) A statement of the reason(s) for the request to withdraw;
- (2) The application serial number or registration number; and
- (3) Either of the following;
  - A statement that the practitioner has given due notice to the client that the practitioner is withdrawing from employment and will be filing the necessary documents with the USPTO; that the client was given notice of the withdrawal at least two months before the expiration of the response period, if applicable; that the practitioner has delivered to the client all documents and property in the practitioner's file concerning the application or

registration to which the client is entitled; and that the practitioner has notified the client of any responses or other filings that may be due, and of the deadline (37 C.F.R. §10.40(a)). See *In re Slack*, 54 USPQ2d 1504 (Comm'r Pats. 2000); or

- If there is more than one qualified practitioner of record, a statement that representation by co-counsel is ongoing.

37 C.F.R. §2.19(b). The request should also include the present mailing address of the practitioner who is withdrawing and the present mailing address of the applicant or registrant.

The requirement for a statement that the client was given notice of the withdrawal at least two months before the expiration of any outstanding response period does not apply where the practitioner states that his or her representation was terminated by the applicant/registrant when less than two months remained in the response period.

The request should be filed soon after the practitioner notifies the applicant or registrant of his or her intent to withdraw. 37 C.F.R. §2.19(b).

These requirements apply to all requests to withdraw, whether withdrawal is mandatory or permissive. They also apply where a qualified practitioner was recognized by appearing in person or by filing a document on behalf of the party whom he or she represents (see TMEP §604.01).

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

*Processing Paper Requests.* For paper filings, a request for permission to withdraw 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 will be handled by the Supervisor of the Post Registration Section.

The managing attorney or supervisor will approve or deny the paper request, notify the applicant or registrant and the practitioner of the approval or denial of the request, and place a copy of this notification 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 practitioner who seeks to withdraw is also the domestic representative, the managing attorney or supervisor should inquire as to whether the practitioner intends to withdraw as domestic representative. This inquiry should be made by phone or e-mail, if possible. If the practitioner withdraws as domestic representative, the managing attorney or supervisor must ensure that the “Domestic Representative” field in the USPTO’s automated records is updated.

*Requests Filed After Registration.* For purposes of recognition as a representative, the USPTO considers a power of attorney to end with registration. If the power is filed in connection with an affidavit under §8, §12(c), §15, or §71, a §9 renewal application, or a §7 request, the power is deemed to end upon acceptance or final rejection of the filing. 37 C.F.R. §2.17(g)(2). See TMEP §604.02.

After registration, if a practitioner appointed before registration files a *paper* request to withdraw, the USPTO scans an image of the request into TICRS and TDR but does not update the attorney information in its automated records (i.e., TRAM and TARR) unless the registrant concurrently takes an action such as filing an affidavit under §8. When a proper request to withdraw is filed through TEAS after registration, the request is automatically granted, and the data from the form is inputted directly into the automated records of the USPTO. See TMEP §§605.04 and 1612.

*Requests Filed in Abandoned Application.* The USPTO will not process a request for permission to withdraw in an abandoned application. When a qualified practitioner files a request to withdraw in an abandoned application, the USPTO scans an image of the request into TICRS and TDR but does not update the attorney information in its automated records. See TMEP §1612 regarding withdrawal after registration.

*Board Proceedings.* See TBMP §§116.02-116.05 regarding withdrawal as the representative of a party to a Board proceeding.

## **608                      Unauthorized Practice**

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

*37 C.F.R. §11.5(b)(2). Practice before the Office in trademark matters. Practice before the Office in trademark matters includes, but is not limited to, consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office; preparing and prosecuting an application for trademark registration; preparing an amendment which may require written argument to establish the registrability of the mark; and conducting an opposition, cancellation, or concurrent use proceeding; or conducting an appeal to the Trademark Trial and Appeal Board.*

An individual who is not authorized under 37 C.F.R. §11.14 to practice before the USPTO in trademark cases (see TMEP §§602 *et seq.*) is not permitted to represent a party in the prosecution of a trademark application, in the maintenance of a registration, or in a proceeding before the USPTO. 5 U.S.C. §§500(b) and (d); 37 C.F.R. §11.14(e).

An individual who does not meet the requirements of 37 C.F.R. §11.14 cannot: prepare an application, response, or other document to be filed in the USPTO; sign amendments, responses to Office actions, petitions to the Director under 37 C.F.R. §2.146, requests to change the correspondence address, or letters of express abandonment; authorize issuance of examiner's amendments and priority actions; or otherwise represent an applicant, registrant, or party to a proceeding in the USPTO. Presenting an amendment to an application and submitting legal arguments in response to a refusal are examples of representation of the applicant or registrant. 37 C.F.R. §11.5(b)(2).

*Exception:* A paralegal, legal assistant, or other employee of a qualified practitioner may prepare documents for review and signature by the practitioner.

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

Once the USPTO recognizes a qualified practitioner(s) as representing an applicant or registrant, a new qualified practitioner from a different firm is not permitted to represent the applicant or registrant until the applicant or registrant revokes the power of attorney of the previously recognized representative, or the previously recognized representative withdraws. See TMEP §604.03.

An individual who is not authorized under 37 C.F.R. §11.14 may transmit and receive correspondence. Such an individual may also sign a verification on behalf of an applicant or registrant, if he or she meets the requirements of 37 C.F.R. §2.193(e)(1), e.g., has firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant or registrant (see TMEP §§611.03(a) and 804.04).

Any person, whether a practitioner or non-practitioner, who presents a document to the USPTO (whether by signing, filing, submitting, or later

advocating the document), is subject to 37 C.F.R. §11.18(b). See TMEP §611.01(a).

If a USPTO employee suspects that an individual who does not meet the requirements of 37 C.F.R. §11.14 is engaging in widespread unauthorized practice by representing applicants or registrants, he or she should bring the matter to the attention of the Administrator for Trademark Policy and Procedure in the Office of the Deputy Commissioner for Trademark Examination Policy (“Administrator”).

See TMEP §§611 *et seq.* regarding signature on correspondence filed in the USPTO.

## **608.02                    Individuals Excluded, Suspended, or Unauthorized to 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* and the decision is posted in the FOIA Reading Room <http://des.uspto.gov/Foia/OEDReadingRoom.jsp>. A suspended or excluded individual is not a qualified practitioner.

Also, the USPTO sometimes learns that a person who does not meet the requirements of 37 C.F.R. §11.14 is engaged in the widespread unauthorized practice of representing applicants and registrants before the USPTO.

In these cases, the Administrator will notify the USPTO staff accordingly, and the USPTO will send a written notice to the affected applicant or registrant, indicating that:

- (1) The individual is not entitled to practice before the USPTO in trademark matters, and, therefore, may not represent the applicant or registrant;
- (2) Any power of attorney is void *ab initio*;
- (3) The individual may not sign responses to Office actions, conduct interviews with USPTO employees or otherwise represent an applicant, registrant, or party before the Office; and
- (4) All correspondence concerning the application or registration will be sent to the domestic representative if appropriate, or, alternatively, to the applicant or registrant at its address of record.

The USPTO will change the correspondence address to that of the applicant, registrant, or domestic representative, as appropriate.

If an Office action is outstanding and no response has been received, the examining attorney or Post Registration staff must issue a supplemental

action, addressed to the applicant or registrant, that restates any outstanding refusals and/or requirements, includes a new six-month response period, and states that a response signed by the individual applicant or registrant, someone with legal authority to bind a juristic applicant or registrant (see TMEP §§611.06 *et seq.*), or a qualified practitioner (see TMEP §§602 *et seq.*) must be submitted within the response period. See TMEP §711.02 regarding supplemental Office actions.

If the examining attorney or Post Registration staff receives a response to an Office action signed by an excluded or suspended practitioner, or a person who appears to be engaged in deliberate or widespread unauthorized practice of law, he or she must prepare a notice of incomplete response, granting the applicant or registrant additional time to perfect the response, pursuant to 37 C.F.R. §2.65(b). See TMEP §§611.05 *et seq.*, 712.03, and 718.03(b) for further information.

USPTO employees must also notify the Administrator of the receipt of a document signed by such a person.

## **609 Correspondence, With Whom Held**

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

*(a) Establishing the correspondence address. (1) If a written power of attorney that meets the requirements of §2.17 is filed, the Office will send correspondence to the practitioner designated in the power.*

*(2) If a practitioner qualified under §11.14 of this chapter transmits a document(s) on behalf of an applicant, registrant, or party to a proceeding who is not already represented by another qualified practitioner from a different firm, the Office will send correspondence to the practitioner transmitting the documents.*

*(3) If an application, registration or proceeding is not being prosecuted by a practitioner qualified under §11.14 of this chapter and the applicant, registrant, or party to the proceeding designates a correspondence address in writing, the Office will send correspondence to the designated address if appropriate.*

*(4) If an application, registration or proceeding is not being prosecuted by a practitioner qualified under §11.14 of this chapter and the applicant, registrant, or party to the proceeding has not designated a correspondence address in writing, but a domestic representative has been appointed, the Office will send correspondence to the domestic representative if appropriate.*

*(5) If the application, registration or proceeding is not being prosecuted by a practitioner qualified under §11.14 of this chapter, the applicant, registrant, or party to the proceeding has not designated a correspondence address, and no domestic representative has been appointed, the Office will send correspondence directly to the applicant, registrant, or party to the proceeding.*

*(6) The Office will send correspondence to only one address in an ex parte*

matter.

(7) Once the Office has recognized a practitioner qualified under §11.14 of this chapter as the representative of an applicant or registrant, the Office will communicate and conduct business only with that practitioner, or with another qualified practitioner from the same firm. The Office will not conduct business directly with the applicant or registrant, or with another practitioner from a different firm, unless the applicant or registrant files a revocation of the power of attorney under §2.19(a), and/or a new power of attorney that meets the requirements of §2.17(c). A written request to change the correspondence address does not revoke a power of attorney.

(b) Changing the correspondence address. (1) If a physical or e-mail correspondence address changes, the applicant, registrant, or party to a proceeding must file a written request to change the correspondence address. The request should be promptly filed.

(2) A request to change the correspondence address must be made in writing, signed by the applicant, registrant, or party to a proceeding, someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter, in accordance with §2.193(e)(9).

(3) If an applicant or registrant files a new power of attorney that meets the requirements of §2.17(c), the Office will change the correspondence address to that of the practitioner named in the power.

(4) If a practitioner qualified under §11.14 of this chapter transmits a document(s) on behalf of an applicant, registrant, or party to a proceeding who is not already represented by another qualified practitioner, the Office will construe this as including a request to change the correspondence address to that of the practitioner, and will send correspondence to the practitioner.

(c) Post registration filings under sections 7, 8, 9, 12(c), 15, and 71. (1) Even if there is no new power of attorney or written request to change the correspondence address, the Office will change the correspondence address upon the examination of an affidavit under section 8, 12(c), 15 or 71 of the Trademark Act, renewal application under section 9 of the Act, or request for amendment or correction under section 7 of the Act. If a practitioner qualified under §11.14 of this chapter transmits the affidavit, renewal application, or section 7 request, the Office will send correspondence to the practitioner. If the owner of the registration is not represented by a qualified practitioner, the Office will send correspondence directly to the owner, or to the domestic representative if appropriate, in accordance with paragraph (a).

(2) Once the Office establishes a correspondence address upon examination of an affidavit, renewal application, or section 7 request, a written request to change the address in accordance with the requirements of paragraph (b)(2) of this section is required to change the address during the pendency of that filing.

See TBMP §§117 *et seq.* for information about correspondence in Board proceedings.

### **609.01                    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, foreign country (if applicable), and an e-mail address if provided) where correspondence from the USPTO will be sent. This often differs from the applicant's address.

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

The USPTO uses the following guidelines in entering the correspondence address in a new application:

- If the application is transmitted by a qualified practitioner, includes a power of attorney designating a qualified practitioner, or includes the name and address of a qualified practitioner, the USPTO will send correspondence to the practitioner;
- If an application is not being prosecuted by a qualified practitioner, but the applicant designates in writing a correspondence address other than its own address, the USPTO will send correspondence to that address if appropriate;
- If an application is not being prosecuted by a qualified practitioner and the applicant has not designated a correspondence address, but a domestic representative has been appointed, the USPTO will send correspondence to the domestic representative if appropriate; or
- If the application is not being prosecuted by a qualified practitioner, no domestic representative has been appointed, and the applicant has not designated a different address for correspondence, the USPTO will send correspondence directly to the applicant at its address of record.

37 C.F.R. §2.18(a).

The USPTO uses these same guidelines to reestablish the correspondence address when a registrant files an affidavit under §8, §12(c), §15, or §71 of the Trademark Act, a §9 renewal application, or a §7 request. 37 C.F.R. §2.18(c). The USPTO will update its automated records to indicate the name of the qualified practitioner who filed the affidavit, renewal application, or §7 request. Due to the length of time that may elapse between the filing of these documents (which could be ten years or more), the USPTO will recognize a qualified practitioner who transmits one of these documents even absent a

new power of attorney or revocation of the previous power. See TMEP §604.02 regarding the duration of recognition as a representative.

The USPTO will not undertake double correspondence with the applicant or registrant and the applicant's or registrant's qualified practitioner, or with more than one qualified practitioner. 37 C.F.R. §2.18(a)(6).

If an application or other document is signed by a qualified practitioner, but the submission does not contain a separate address for that practitioner, the USPTO will correspond with the qualified practitioner in care of the correspondence address of record and direct such correspondence to the practitioner's attention. If an Office action is required, the USPTO will ask the practitioner to either specify his or her address for correspondence or affirmatively state that the USPTO should continue to address correspondence to his or her attention in care of the previously submitted correspondence address. If the practitioner does not respond to the request, the USPTO will continue to send correspondence to the attention of the practitioner at the correspondence address of record.

See TMEP §609.04 regarding correspondence with parties who are not domiciled in the United States, TMEP §609.01(a) regarding correspondence in §66(a) applications, TMEP §§609.02 *et seq.* for information about changing the correspondence address, and TBMP §§117 *et seq.* for information about correspondence in Board proceedings.

### **609.01(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 subsequent Office actions directly to the applicant, at the correspondence address set forth in the request for extension of protection to the United States, or to any correspondence address provided in a properly signed request to change the correspondence address. See TMEP §1904.02(h) for further information about Office actions in §66(a) applications.

The USPTO will accept a properly signed 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/forms>.

See TMEP §§1906.01 *et seq.* regarding requests to record changes with the IB, and TMEP §§602.03 *et seq.* regarding foreign attorneys.

## **609.02 Changing the Correspondence Address**

Once the correspondence address is established, the USPTO will generally send correspondence to that address until a written request to change the address is submitted, signed by the practitioner whom the USPTO has recognized, or, if the applicant or registrant is not represented by a qualified practitioner, by the individual applicant or registrant or someone with legal authority to bind a juristic applicant or registrant (e.g., a corporate officer or general partner of a partnership). 37 C.F.R. §§2.18(b)(2) and 2.193(e)(9).

The mere transmittal of a response to an Office action bearing a new address does not effect a change in a correspondence address, except when a new owner takes an action in an application or registration (e.g., files a response to an Office action or statement of use) after recordation of a change of ownership, as discussed in TMEP §609.02(f).

The USPTO will not undertake double correspondence with the applicant or registrant and the applicant's or registrant's qualified practitioner, or with more than one qualified practitioner. 37 C.F.R. §2.18(a)(6).

A written request to change the correspondence address does not revoke a power of attorney. 37 C.F.R. §§2.18(a)(7) and 2.19(a)(3). See TMEP §606 regarding revocation.

See *also* TBMP §§117 *et seq.* for information about correspondence in Board proceedings.

### **609.02(a) Request to Change Correspondence Address Presumed**

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

- (1) If a qualified practitioner transmits documents on behalf of an applicant or registrant who is not already represented by another qualified practitioner from a different firm, the USPTO will construe this as including a request to change the correspondence address to that of the practitioner (however, the filing of an "associate power of attorney" or similar document does not change the correspondence address); or
- (2) If an applicant or registrant files a properly signed power of attorney (see TMEP §605.01) designating a qualified practitioner, the USPTO will change the correspondence address to that of the practitioner named in the power, even if the applicant or registrant does not file a separate request to change the address.

37 C.F.R. §§2.18(b)(3) and (4). In these two situations, the USPTO will change the correspondence address to the address of the new qualified practitioner. In all other situations, a written request to change the

correspondence address, signed by the individual applicant or registrant, someone with legal authority to bind a juristic applicant or registrant (e.g., a corporate officer or general partner of a partnership), or the qualified practitioner of record, is required. 37 C.F.R. §2.18(b)(2) and 2.193(e)(9). See TMEP §609.02(b) regarding the requirements for a written request to change the correspondence address.

See also TBMP §§117 *et seq.* for information about correspondence in Board proceedings.

### **609.02(b) Requirements for Request to Change Correspondence Address**

A request to change the correspondence address must be in writing. 37 C.F.R. §2.18(b)(2). Once the USPTO recognizes a qualified practitioner as the representative of an applicant or registrant, only that practitioner or another qualified practitioner from the same United States firm may sign a request to change the address, unless the applicant or registrant files a revocation of the previous power and/or a new power of attorney, or the previously recognized practitioner files a request to withdraw. 37 C.F.R. §§2.193(e)(9)(i) and 11.18(a).

If the applicant or registrant is not represented by a qualified practitioner, the request must be signed by the individual applicant or registrant or someone with legal authority to bind a juristic applicant or registrant (e.g., a corporate officer or general partner of a partnership). In the case of joint applicants or registrants, all must sign. See 37 C.F.R. §§2.193(e)(9)(ii) and 11.14(e); TMEP §611.02.

A request to change the correspondence address cannot be entered by examiner's amendment.

To expedite processing, notices of change of correspondence address (including changes of e-mail correspondence address) should be filed through TEAS, at <http://www.uspto.gov>. The TEAS form can be used to change the correspondence address on any application or registration that is currently active. When a notice is filed through TEAS, the data from the form is inputted directly into the automated records of the USPTO.

If two or more qualified practitioners are named in a power, any of the named practitioners can sign and submit a notice of change of correspondence address setting forth a new address, even if the new address is at a new firm. It is not necessary to submit a new power signed by the applicant or registrant when a named practitioner(s) changes firms.

See TBMP §§117 *et seq.* for information about correspondence in Board proceedings.

### **609.02(c) Processing Requests to Change the Correspondence Address Before Registration**

Once the correspondence address is established for a particular application, the USPTO will generally not change it unless there is a written request to do so, signed by the applicant or the qualified practitioner of record. 37 C.F.R. §§2.18(a)(7) and (b)(2). The mere transmittal of a response to an Office action bearing a new address for an applicant or an applicant's qualified practitioner does not effect a change in a correspondence address. See TMEP §609.02(b) for further information about the requirements for a written request to change the correspondence address, and TMEP §609.02(a) for discussion of situations in which a request to change the correspondence address is presumed.

When the request is filed through TEAS, the data from the form is inputted directly into the automated records of the USPTO. 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 confirmation or other acknowledgment of the request to change the correspondence address. The applicant may check the TARR database at <http://tarr.uspto.gov> to determine whether the change of address has been entered into the USPTO's automated records.

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.

### **609.02(d) 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 or registrant may submit up to twenty (20) application serial numbers at one time. For registered marks, the TEAS form requires entry of the original application serial number rather than the registration number. Requests to change the address for more than twenty applications/registrations cannot be submitted in a single TEAS form.

Global address updates, i.e. requests to change an address in every application or registration in which it appears, will not be accepted.

### **609.02(e) Changing the Correspondence Address After Registration**

As noted in TMEP §609.01, the USPTO reestablishes the correspondence address upon the examination of an affidavit under §8, §12(c), §15, or §71 of

the Trademark Act, a §9 renewal application, or a §7 request, even if there is no new power of attorney or request to change the correspondence address. The USPTO will update its automated records to indicate the name of the qualified practitioner who filed the affidavit, renewal application, or §7 request, and update the correspondence address to that of the qualified practitioner. 37 C.F.R. §§2.17(g)(2) and 2.18(c). If the registrant is not represented by a qualified practitioner, the USPTO will update its automated records to indicate the registrant's address as shown in the affidavit, renewal application, or §7 request as the correspondence address of record. See TMEP §604.02 regarding the duration of recognition as a representative.

Once the USPTO establishes a correspondence address upon examination of an affidavit, renewal application, or §7 request, a written request to change the address is required to effect a change of address during the pendency of that filing. 37 C.F.R. §§2.18(b)(2) and (c)(2). TMEP §604.02. See TMEP §609.02(b) regarding the requirements for a written request to change the correspondence address.

Owners of registrations are encouraged to promptly notify the USPTO of any changes of address. 37 C.F.R. §2.18(b). To expedite processing, the USPTO recommends that the notice of change of address be filed through TEAS, at <http://www.uspto.gov>. 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 through TEAS, the data from the form is inputted directly into the USPTO's automated records.

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 §604.03 regarding change of attorney, and TBMP §§117 *et seq.* for information about correspondence in Board proceedings.

#### **609.02(f) Correspondence After Recordation of Change of Ownership**

For purposes of recognition as a representative, the USPTO considers a power of attorney to end when ownership changes. 37 C.F.R. §2.17(g). TMEP §604.02.

Recordation of an assignment (or other document changing title) with the Assignment Services Branch does not automatically update the correspondence address in the automated records of the Trademark Operation (i.e., TRAM and TARR). See TMEP §503.01(b). To ensure that the automated records of the Trademark Operation are updated to reflect the

correct correspondence address, new owners should file a separate written request with the Trademark Operation to change the address, preferably through TEAS.

If the new owner does not file a separate written request with the Trademark Operation to change the correspondence address, but instead takes an action in connection with an application or registration by filing a properly signed communication (e.g., a response to an Office action or statement of use) bearing a new correspondence address, the USPTO may update its automated records to reflect the address of the new owner or the new owner's qualified practitioner even if the new owner does not specifically request a change of the correspondence address. In this situation, the USPTO will reestablish the correspondence address, using the guidelines set forth in TMEP §609.01. If the new owner is not represented by a qualified practitioner, the correspondence address will be changed to reflect the address of the applicant or registrant, as set forth in the written communication.

If a new qualified practitioner appears in person or signs a document on behalf of the new owner, the USPTO will recognize the new practitioner even absent a new power of attorney or revocation of the previous power, pursuant to 37 C.F.R. §2.17(b). See TMEP §604.02. However, if the previously recognized qualified practitioner appears on behalf of the new owner (which might occur when the new owner is a related company), the USPTO will continue to conduct business and correspond with that practitioner. The previously recognized practitioner does not have to file a new power of attorney signed by the new owner.

See *also* TMEP §§505 *et seq.* regarding requests to update ownership information after recordation of a change of ownership, and TBMP §§117 *et seq.* regarding correspondence in Board proceedings.

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

The owner of an application or registration has a duty to maintain a current and accurate correspondence address. If the correspondence address changes, the USPTO must be promptly notified in writing, preferably through TEAS. See 37 C.F.R. §2.18(b)(1). This also applies to e-mail addresses, if the applicant or registrant has authorized the USPTO to send correspondence by e-mail (see TMEP §304.03).

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

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

- If an applicant or registrant has appointed a qualified practitioner (see TMEP §§602 *et seq.*), the USPTO will send correspondence to that practitioner.
- If the applicant or registrant is not represented by a qualified practitioner, and the applicant or registrant has appointed a domestic representative, the USPTO will send correspondence to the domestic representative if appropriate, unless the applicant or registrant 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 qualified practitioner who has been recognized by the USPTO as the representative of the applicant or registrant. See TMEP §610 regarding domestic representatives.
- If the applicant or registrant is not represented by a qualified practitioner, and the applicant or registrant does not designate a domestic representative, the USPTO will send correspondence directly to the applicant or registrant at its foreign address, unless the applicant or registrant designates in writing another correspondence address.

See TMEP §609.01(a) regarding correspondence in §66(a) applications.

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

*37 C.F.R. §2.24 Designation and revocation of domestic representative by foreign applicant.*

*(a)(1) If an applicant is not domiciled in the United States, the applicant may designate a domestic representative (i.e., a person residing in the United States on whom notices or process in proceedings affecting the mark may be served) by either:*

*(i) Setting forth the name and address of the domestic representative in the initial application; or*

*(ii) Filing a separate designation setting forth the name and address of the domestic representative, signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter.*

*(2) If the applicant does not file a document designating the name and address of a person residing in the United States on whom notices or process in proceedings affecting the mark may be served, 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.*

*(3) The mere designation of a domestic representative does not authorize*

*the person designated to represent the applicant unless qualified under §11.14 of this chapter.*

*(b) A request to change or revoke a designation of domestic representative must be signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter.*

*37 C.F.R. §2.193(e)(8). Designations and revocations of domestic representative. A designation or revocation of a domestic representative must be signed by the applicant or registrant, someone with legal authority to bind the applicant or registrant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under §11.14 of this chapter. In the case of joint applicants or registrants, all must sign.*

*Designation of Domestic Representative Encouraged.* 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.

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

*Not the Same as Power of Attorney.* The designation is not the same as a power of attorney. The designation serves a different purpose, namely, to provide a contact and address for service of process. The designation of a domestic representative does not authorize the person designated to practice before the USPTO, e.g., to prepare or prosecute the application, or represent a party in a proceeding before the USPTO. 37 C.F.R. §§2.24(a)(3) and 11.5(b)(2). Similarly, a power of attorney does not serve as a designation of a domestic 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.

*Requirements.* A designation of domestic representative must 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. 37 C.F.R. §2.24(a)(1).

*Signature.* The designation must be in writing. If set forth in the initial application, a designation of domestic representative may be signed by a

person properly authorized to sign the application on behalf of applicant. A person who is properly authorized to sign an application is:

- (1) A person with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership);
- (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. §11.1 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. §2.193(e)(1); TMEP §804.04.

If filed apart from the initial application, the designation should be signed by the individual applicant or registrant, someone with legal authority to bind a juristic applicant or registrant (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner. In the case of joint applicants or registrants who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §§2.24(b) and 2.193(e)(8).

*Duration.* An appointment of domestic representative remains in effect unless specifically revoked or supplanted by appointment of a new domestic representative.

*Revocation.* An applicant or registrant may revoke a designation of domestic representative. A revocation should be signed by the individual applicant or registrant, someone with legal authority to bind a juristic applicant or registrant, or a qualified practitioner. In the case of joint applicants or registrants who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §§2.24(b) and 2.193(e)(8).

*Withdrawal.* A domestic representative may withdraw, in a written document signed by an individual domestic representative, or by someone legally authorized to bind a juristic domestic representative.

*Form.* To expedite processing, the USPTO recommends that designations and revocations of domestic representative be filed through TEAS, at <http://www.uspto.gov>.

See TMEP §609.04 regarding correspondence with parties who are not domiciled in the United States.

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

**611.01 Signature and Certificate**

**611.01(a) Signature as Certificate**

*37 C.F.R. §2.193(f). Signature as certification. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by any person, whether a practitioner or non-practitioner, constitutes a certification under §11.18(b) of this chapter. Violations of §11.18(b) of this chapter may jeopardize the validity of the application or registration, and may result in the imposition of sanctions under §11.18(c) of this chapter. Any practitioner violating §11.18(b) of this chapter may also be subject to disciplinary action. See §§10.23(c)(15) and 11.18(d) of this chapter.*

*37 C.F.R. §11.18 Signature and certificate for correspondence filed in the Office.*

*(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed or inserted by such practitioner, in compliance with §1.4(d)(1), §1.4(d)(2), or §2.193(a) of this chapter.*

*(b) By presenting to the Office or hearing officer in a disciplinary proceeding (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 Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully 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 any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and*

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

*(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 any proceeding before the Office;*

*(ii) The 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 any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of--*

*(1) Striking the offending paper;*

*(2) Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;*

*(3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;*

*(4) Affecting the weight given to the offending paper; or*

*(5) Terminating the proceedings in the Office.*

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

### **611.01(b) Requirements for Signature**

All correspondence that requires a signature must bear either a handwritten signature personally signed in permanent ink by the person named as the signatory, or an "electronic signature" that meets the requirements of 37 C.F.R. §2.193(c), personally entered by the signatory. The USPTO will accept a signature that meets the requirements of 37 C.F.R. §2.193(c) on all correspondence, whether filed on paper, by fax, or through TEAS or the Electronic System for Trademark Trials and Appeals ("ESTTA"). 37 C.F.R. §2.193(a)(2). See TMEP §611.01(c) regarding the signature of documents filed electronically.

All documents must be personally signed. 37 C.F.R. §§2.193(a)(1) and (c)(1). Another person (e.g., paralegal, legal assistant, secretary) may not sign the name of an attorney or other authorized signatory. See *In re Dermahose Inc.*, 82 USPQ2d 1793 (TTAB 2007); *In re Cowan*, 18 USPQ2d 1407 (Comm'r Pats. 1990).

The name of the person who signs a document must be set forth in printed or typed form immediately below or adjacent to the signature, or identified elsewhere in the filing (e.g., in a cover letter or other document that

accompanies the filing). 37 C.F.R. §2.193(d). If the signatory's name is not set forth in a document, the USPTO may require that it be stated for the record. This information can be entered through a note in the "Notes-to-the-File" section of the record.

Documents must be signed by a proper party. See TMEP §§611.02 and 611.03 *et seq.* for further information.

See TBMP §106.02 regarding signature of documents filed in Board proceedings, and TBMP §106.03 regarding the form of submissions in Board proceedings.

### **611.01(c) Signature of Documents Filed Electronically**

*Extract from 37 C.F.R. §2.193. Trademark correspondence and signature requirements.*

. . .

*(c) Requirements for electronic signature. A person signing a document electronically must:*

*(1) Personally enter any combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash ("/") symbols in the signature block on the electronic submission; or*

*(2) Sign the verified statement using some other form of electronic signature specified by the Director.*

*(d) Signatory must be identified. The name of the person who signs a document in connection with a trademark application, registration, or proceeding before the Trademark Trial and Appeal Board must be set forth in printed or typed form immediately below or adjacent to the signature, or identified elsewhere in the filing (e.g., in a cover letter or other document that accompanies the filing).*

In a document filed in connection with a trademark application, registration, or proceeding before the Trademark Trial and Appeal Board through TEAS or ESTTA, the party filing the document does not apply a conventional signature. Instead, the filer does one of the following:

- (1) The filer enters any combination of letters, numbers, spaces, and/or punctuation marks that the filer has adopted as a signature, placed between two forward slash ("/") symbols. 37 C.F.R. §2.193(c). Examples of acceptable signatures include */john doe/*, */drll/*, and */544-4925/*. The signatory's name must be set forth beneath the signature;
- (2) The document is filled out online, printed in text form, and mailed or faxed to the signatory. The signatory signs the printed document in

the traditional pen-and-ink manner. The signature portion, along with a declaration, if required, is scanned to create a .jpg or .pdf image file and attached to the document for electronic submission;

- (3) The document is completed online, and e-mailed to the signatory for electronic signature from within TEAS. The signatory signs the document and it is automatically returned via TEAS to the party who requested the signature.

The USPTO will also accept a signature that meets the requirements of paragraph (1) above on documents that are filed on paper. 37 C.F.R. §2.193(a)(2).

All documents must be personally signed. 37 C.F.R. §2.193(c)(1). The person(s) identified as the signatory must manually enter the elements of the electronic signature. Another person (e.g., paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory. 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.

The Trademark Trial and Appeal Board has held that an electronic signature on an electronic transmission through ESTTA pertains to all the attachments to the transmission. *PPG Industries, Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926 (TTAB 2005).

See TBMP §106.02 regarding signature of documents filed in Board proceedings, and TBMP §106.03 regarding the form of submissions in Board proceedings.

## **611.02 Signatures by Authorized Parties Required**

All documents filed in the USPTO must be properly signed. The USPTO staff must review the application or registration record to determine whether the applicant or registrant is represented by a qualified practitioner, and must ensure that all documents are properly signed.

Verifications of facts on behalf of an applicant or registrant must be personally signed by someone meeting the requirements of 37 C.F.R. §2.193(e)(1). See TMEP §§611.03(a) and 804.04.

Other documents must be personally signed by the applicant or registrant, someone with legal authority to bind a juristic applicant or registrant (e.g., a corporate officer or general partner of a partnership), or by a qualified practitioner. This includes amendments, responses to Office actions, petitions to the Director under 37 C.F.R. §2.146, letters of express abandonment, requests to divide, and requests to change the

correspondence address. Generally, if the applicant or registrant is represented by a qualified practitioner, the practitioner must sign. 37 C.F.R. §§2.193(e)(2)(i), 2.193(e)(5)(i), 2.193(e)(9)(i), and 11.18(a). This applies to both in-house and outside counsel. If the applicant or registrant is not represented by a qualified practitioner, the document must be signed by the individual applicant or registrant or someone with legal authority to bind a juristic applicant or registrant (e.g., a corporate officer or general partner of a partnership). In the case of joint applicants or registrants who are not represented by a qualified practitioner, all must sign. 37 C.F.R. §§2.193(e)(2)(ii), 2.193(e)(5)(ii), 2.193(e)(9)(ii), and 11.14(e).

See TMEP §§611.03 *et seq.* for guidelines as to the proper person to sign specific documents, TMEP §§611.06 *et seq.* for guidelines on persons with legal authority to bind various types of legal entities, and TMEP §611.04 for examples of authorized and potentially unauthorized parties.

### **611.02(a) TEAS Checkoff Boxes**

On some of the TEAS forms, the person signing the response must confirm that he or she is authorized to sign the document by clicking one of three buttons indicating that he or she is: (1) an unrepresented applicant or registrant who has not previously been represented in this matter, or was previously represented by a qualified practitioner 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 or registrant was previously represented by a different qualified practitioner, the previous power has been revoked, or the previously appointed practitioner has withdrawn; or (3) an authorized Canadian attorney or agent who has been granted recognition by OED, and if the applicant or registrant was previously represented by a different qualified practitioner, the previous power has been revoked, or the previously appointed practitioner has withdrawn. The USPTO will accept these statements unless there is conflicting information in the record or the USPTO is otherwise made aware of conflicting information.

*Example:* If an attorney lists a foreign address and checks the box indicating that he or she is a member in good standing of the bar of the highest court of a U.S. state, the USPTO 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 USPTO must inquire into the

signatory's authority to sign, because there is inconsistent information in the record.

*Example:* If the signatory identifies himself or herself as an "attorney," but does not check the box confirming that he or she is a member in good standing of the bar of the highest court of a U.S. state, the USPTO will inquire into the signatory's authority to sign, because there is inconsistent information in the record.

*Example:* If the signatory checks the box indicating that he or she is a person with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership), but sets forth a title that the USPTO would not normally accept (e.g., accountant, paralegal, or trademark administrator), the USPTO will inquire into the signatory's authority to sign, because there is inconsistent information in the record.

*Example:* If, instead of checking the "attorney in good standing" box, a United States attorney checks one of the other boxes (i.e., indicating that the applicant is not represented by an attorney, or that the attorney is an authorized Canadian, representing a Canadian applicant), an issue of signatory authority arises, and the USPTO will inquire into the signatory's authority to sign, because there is inconsistent information in the record.

*Exception:* If the signatory indicates that he or she is a Canadian attorney or agent who has been granted recognition by OED, the USPTO staff must still check the OED list to verify this information. See TMEP §602.03(a) for further information about Canadian attorneys and agents.

See TMEP §§611.05 (a) and 712.03 regarding issuance of a notice of incomplete response where there is a question as to a signatory's authority to sign.

### **611.03 Proper Person to Sign**

This section provides guidelines as to the proper person to sign various documents. Unless otherwise specified by law, the following guidelines should be followed.

#### **611.03(a) Verification**

A verification must be sworn to or supported by a declaration signed by the owner of the application or registration or a person properly authorized to verify facts on behalf of the owner. A person who is properly authorized to verify facts on behalf of an owner is:

- A person with legal authority to bind the owner;

- A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or
- A qualified practitioner who has an actual written or verbal power of attorney or an implied power of attorney from the owner.

See 37 C.F.R. §2.193(e)(1). Generally, the Office does not question the authority of the person who signs an affidavit or declaration verifying facts, unless there is an inconsistency in the record as to the signatory's authority to sign. See TMEP §804.04.

The broad definition of a “person properly authorized to sign on behalf of an owner” in 37 C.F.R. §2.193(e)(1) applies *only* to verifications of facts, such as applications for trademark registration, affidavits under §8 or §71 of the Trademark Act, amendments to allege use under 37 C.F.R. §2.76, statements of use under 37 C.F.R. §2.88, and declarations in support of substitute 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 to the Director under 37 C.F.R. §2.146, consent agreements, 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 he or she has legal authority to bind the applicant (e.g., is a corporate officer or general partner of a partnership), or is a qualified practitioner, he or she may not sign responses to Office actions or agree to examiner's amendments.

**611.03(b) Responses, Amendments to Applications, Requests for Express Abandonment, Requests for Reconsideration of Final Actions, and Requests to Divide**

These documents must be signed by the individual applicant or registrant, someone with legal authority to bind a juristic applicant or registrant, or a qualified practitioner, in accordance with the following guidelines:

- If the applicant or registrant is represented by a qualified practitioner, the practitioner must sign, except where the owner is required to sign the correspondence; or
- If the applicant or registrant is not represented by a qualified practitioner, the individual applicant or registrant or someone with legal authority to bind a juristic applicant or registrant must sign. In the case of joint applicants or registrants who are not represented by a qualified practitioner, all must sign.

See 37 C.F.R. §§2.62(b), 2.68(a), 2.74(b), 2.87(f), 2.163(b), 2.171(b)(1), 2.184(b)(2), 2.193(e)(2), 11.14(e), and 11.18(a).

See TMEP §712.01 for further guidance as to who may sign a response to an examining attorney's Office action.

### **611.03(c) Powers of Attorney and Revocations of Powers of Attorney**

Powers of attorney and revocations of powers of attorney must be signed by the individual applicant or registrant or someone with legal authority to bind a juristic applicant or registrant. In the case of joint applicants or registrants, all must sign. 37 C.F.R. §§2.17(c)(2), 2.19(a), and 2.193(e)(3). Once the applicant or registrant has designated a qualified practitioner(s), the named practitioner may sign an associate power of attorney appointing another qualified practitioner(s) as an additional person(s) authorized to prosecute the application or registration. 37 C.F.R. §2.17(c)(2). See TMEP §§605.01, 605.03, and 606.

### **611.03(d) Petitions to Revive**

A petition to revive under 37 C.F.R. §2.66 must be signed by someone with firsthand knowledge of the facts regarding unintentional delay. 37 C.F.R. §§2.66(b)(2), 2.66(c)(2), and 2.193(e)(4); TMEP §1714.01(e). Any response to an Office action accompanying the petition must be signed by a qualified practitioner, or by the individual applicant or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership) if the applicant is not represented by an authorized practitioner (see TMEP §611.03(b)).

### **611.03(e) Petitions to the Director**

A petition to the Director under 37 C.F.R. §2.146 must be signed by the petitioner, someone with legal authority to bind the petitioner, or a qualified practitioner, in accordance with the following guidelines:

- If the petitioner is represented by a qualified practitioner, the practitioner must sign; or
- If the petitioner is not represented by a qualified practitioner, the individual petitioner or someone with legal authority to bind a juristic petitioner must sign. In the case of joint petitioners, all must sign.

37 C.F.R. §§2.146(c), 2.193(e)(5), 11.14(e), and 11.18(a); TMEP §1705.07.

### **611.03(f) Amendment, Correction, or Surrender of Registration**

A request for correction or amendment of a registration or a surrender of a registration must be signed by the individual owner of the registration, someone with legal authority to bind a juristic owner, or a qualified practitioner. In the case of joint owners who are not represented by a

qualified practitioner, all must sign. 37 C.F.R. §§2.171(a), 2.173(b)(2), 2.175(b)(2), and 2.193(e)(6).

### **611.03(g) Renewal Applications**

A renewal application must be signed by the registrant or the registrant's representative. 37 C.F.R. §§2.183(a) and 2.193(e)(7). See TMEP §§1606.06 and 1606.07 regarding filing and execution of renewal applications.

### **611.03(h) Designations and Revocations of Domestic Representative**

*Designation.* An applicant or registrant may designate a domestic representative by either:

- Setting forth the name and address of the domestic representative in the initial application for registration; or
- Filing a separate designation setting forth the name and address of the domestic representative, signed by the individual applicant or registrant, someone with legal authority to bind a juristic applicant or registrant, or a qualified practitioner. In the case of joint applicants or registrants, all must sign.

37 C.F.R. §§2.24(a)(1) and 2.193(e)(8).

*Revocation.* A revocation of domestic representative should be signed by the individual applicant or registrant, someone with legal authority to bind a juristic applicant or registrant, or a qualified practitioner. 37 C.F.R. §§2.24(b) and 2.193(e)(8).

See TMEP §610.

### **611.03(i) Requests to Change Correspondence Address in an Application or Registration**

A request to change the correspondence address in an application or registration must be signed by the individual applicant or registrant, someone with legal authority to bind a juristic applicant or registrant, or a qualified practitioner, in accordance with the following guidelines:

- If the applicant or registrant is represented by a qualified practitioner, the practitioner must sign; or
- If the applicant or registrant is not represented by a qualified practitioner, the individual applicant or registrant or someone with legal authority to bind a juristic applicant or registrant must sign. In the case of joint applicants or joint registrants, all must sign.

See 37 C.F.R. §§2.18(b)(2), 2.193(e)(9), 11.14(e), and 11.18(a); TMEP §609.02(b).

#### **611.04 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 to the Director under 37 C.F.R. §2.146, amendments, requests for express abandonment, and other documents that must be signed by the applicant or registrant, or by someone with legal authority to bind the applicant or registrant. This list is not exhaustive.

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

- Person identifies him/herself as an officer of a *pro se* applicant or registrant (e.g., “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 or 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,” or “Vice President”).
- Person signing for a previously *pro se* applicant or registrant identifies him/herself as an attorney with a United States law firm or as “general counsel” or “in-house counsel” of a United States applicant.
- Person signing is a different attorney from the same United States-based firm as the current attorney of record.
- Person signing on behalf of a Canadian applicant or registrant is a Canadian trademark attorney or agent whom OED has recognized as qualified to represent parties located in Canada (see TMEP §602.03(a)).
- Person signing identifies him/herself as an “officer” of a *pro se* corporate applicant.

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

- Person signing provides no title or position (e.g., applicant is Jack Smith, an individual citizen 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 or registrant in some other capacity (e.g., accountant, paralegal, trademark administrator, business manager, personal assistant, or legal secretary).
- Person signing provides the address of a foreign firm.
- Person signing in an application or 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 or 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. §§11.14(a) or (c).
- Person signing identifies him/herself as “representative of,” “agent for,” or “representing” applicant or registrant, with no other explanation.
- Person signing identifies him/herself as an “authorized signatory” but provides no other indication of the nature of the signer’s relationship to applicant or registrant.
- Person signing is a new attorney from a different firm, when the applicant or registrant had previously appointed a qualified practitioner and no new power of attorney or revocation of the previously appointed power has been made of record.

## **611.05 Processing Documents Signed by Someone Other Than the Applicant or the Applicant's Designated Attorney**

When examining a document filed in connection with a trademark application or registration, the USPTO staff must ensure that all documents are signed by a proper party. See TMEP §611.02.

When it appears that a response to an Office action is signed by an improper party, the USPTO staff must treat the response as incomplete. See TMEP §611.05(a).

When it appears that a document 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 to the Director under 37 C.F.R. §2.146, or an express abandonment) is signed by an improper party, the USPTO will notify the applicant or registrant that no action will be taken on the document, unless the applicant or registrant either: (1) establishes the signatory's authority; or (2) submits a properly signed document.

See TBMP §106.02 for information about signature of documents filed in Board proceedings.

### **611.05(a) Notice of Incomplete Response When Authority of Person Signing Response Is Unclear**

If it appears that a response to an examining attorney's Office action is signed by an improper party, the examining attorney must treat the response as an incomplete response, and 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 the individual applicant, someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner. These same principles and procedures apply to responses to Office actions issued by other USPTO employees (e.g., staff in the Post Registration Section, ITU/Divisional Unit, Madrid Processing Unit, or Office of Petitions).

See *also* TMEP §712.03.

### **611.05(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 clarify the record, and the USPTO staff will make an appropriate note in the "Notes-to-the-File" section of the record, 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 or registrant. If the signer has

legal authority to bind the applicant or registrant, the person should so state, and should set forth his or her title or position. If the signer is an attorney who may practice before the USPTO pursuant to 37 C.F.R. §11.14(a), the attorney should identify himself or herself as an attorney and indicate the bar of the U.S. state of which he or she is a member in good standing. If the signer meets the requirements of either 37 C.F.R. §§11.14(b) or (c), the person should explain how he or she meets these requirements. For example, a Canadian attorney or agent recognized to practice before the USPTO in trademark cases by OED (see TMEP §602.03(a)) may simply state he or she has received recognition by OED as a Canadian practitioner under §§11.14(c) and (f).

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, the individual applicant or a person with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner of a partnership) may telephone the examining attorney to authorize such an amendment. Otherwise, when the person who signed the response is not an authorized signer, the applicant must submit a response signed by the individual applicant, someone with legal authority to bind a juristic applicant, or a qualified practitioner. See TMEP §§611.03(b), 611.06 *et seq.*, and 712.01 regarding the proper party to sign a response to an Office action.

See TMEP §604.03 regarding changes of attorney.

### **611.05(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 USPTO 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 USPTO will notify the registrant that the affidavit or renewal application remains unacceptable, and that the registration will be cancelled in due course. In the case of a §7 request, the USPTO will notify the registrant that the request for amendment or correction is abandoned.

## **611.06 Guidelines on Persons With Legal Authority to Bind Certain Juristic Entities**

### **611.06(a) Joint Owners**

Joint owners are individual parties and not a single entity. Where a document must be signed by someone with legal authority to bind joint owners, the document must be signed by all the owners. See 37 C.F.R. §§2.17(c)(2), 2.19(a)(1), 2.193(e)(2)(ii), 2.193(e)(3), 2.193(e)(5), 2.193(e)(6), 2.193(e)(8), and 2.193(e)(9).

### **611.06(b) Signature by Partnership**

Where a document must be signed by someone with legal authority to bind a partnership, a general partner must sign. Signature by all the general partners is not necessary. If the partnership is comprised of general partners who are juristic entities (e.g., the general partners are corporations), someone with legal authority to bind that type of juristic entity must sign.

In appropriate cases, a document filed by a partnership may be signed by an official other than a general partner, if the record contains an explanation or documentation indicating that the person signing the document has legal authority to bind the partnership.

### **611.06(c) Signature by Joint Venture**

Where a document must be signed by someone with legal authority to bind a joint venture, each party to the venture must sign. Although a joint venture has many attributes of a partnership, it is a special partnership, which is very limited in nature and scope. Generally, signature by each party to the joint venture is necessary.

In appropriate cases, a document filed by a joint venture may be signed by a general manager or other official rather than by each of the joint venturers, if the applicant or registrant states that the person who signed has legal authority to bind the joint venture under relevant state law.

### **611.06(d) Signature by Corporation**

Where a document must be signed by someone with legal authority to bind a corporation, a corporate officer must sign. An officer is a person who holds an office established in the articles of incorporation or corporate bylaws.

The usual titles for officers are President, Vice-President, Secretary, Treasurer, Chief Executive Officer, Chief Operating Officer, and Chief Financial Officer. In some organizations, the Treasurer is called a

Comptroller or Controller, and these terms are acceptable. In Maine and Massachusetts the term “Clerk” identifies an officer of a corporation.

Modifications of these basic titles are acceptable if they include the officer title. Titles such as Vice-President for Sales, Executive Vice-President, Assistant Treasurer, Executive Secretary, and Administrative Secretary are acceptable.

The signature of the “Chairman” or “Chairman of the Board of Directors” is also acceptable, but not the signature of an individual director (e.g., the Vice-Chairman of the Board). The terms “Executive Secretary” and “Administrative Secretary” are acceptable because they include the officer-title “Secretary.”

Some titles are generally *not* accepted because they usually do not identify officers. For instance, a General Manager, or any other type of manager, is usually merely an employee, not an officer.

If the applicant or registrant states that the person who signed the response is authorized to bind the applicant or registrant under the articles of incorporation or bylaws, the USPTO will accept the signature.

A corporation cannot delegate authority to sign to someone who is not a corporate officer. *In re Textron, Inc.*, 183 USPQ 301 (Comm'r Pats. 1974). Therefore, documents purporting to authorize representation, even if signed by officers, will not be accepted as establishing authority of a person who does not have authority to legally bind the corporation under its bylaws or articles of incorporation.

When the applicant or registrant is a corporation, a statement that the signatory is an “officer” or “duly authorized officer” of the corporation is acceptable. However, it is unacceptable to state that the person who signed the verification is an “authorized signatory.”

#### **611.06(e) Signature by Foreign Companies and Corporations**

There are significant differences between the legal entities established under the laws of the United States and legal entities established and recognized under the laws of foreign countries, and the titles and duties of officers of foreign corporations and companies often differ from those in the United States. In the case of foreign entities that are in the nature of corporations, the USPTO will accept the signature of a person considered to be equivalent to an officer under the law of the foreign country. Indication of a title identifying the signer as a type of officer – such as “Legal Officer” or “Information Officer” – is also sufficient.

In foreign countries, a person who holds the title “Manager” or “Director” is normally an officer or the equivalent of an officer.

The term “Procurist” is used in a number of countries to indicate an officer. For British companies, the terms “Registrar” and “Confidential Clerk” are the equivalent of officers.

If the applicant or registrant states that the person who signed the response holds a position that is the equivalent of an officer of a United States corporation, the USPTO will accept the signature.

Simply stating that a person has been granted authority to act on behalf of the applicant or registrant is insufficient. Documents purporting to authorize representation, even if signed by officers, will not be accepted as establishing the authority of a person who is not the equivalent of an officer. The applicant or registrant must state that the signatory has authority to legally bind the applicant or registrant under its bylaws or articles of incorporation.

#### **611.06(f) Signature by Unincorporated Association**

For organizations that are less formally organized than corporations (e.g., fraternal societies, unions, unincorporated associations, and governmental bodies), the titles for officers are less standardized. These organizations frequently use more individualistic terms for titles than the terms customarily used by corporations, and the officer positions themselves may not be as clearly or as formally provided for as is the case with corporations. Regardless of how unfamiliar the title is or how informal the position seems to be, the USPTO will accept the signature if the applicant or registrant states on the record that the signer has, within the framework of the particular organization, authority equivalent to that of an officer to act on behalf of the organization, i.e., has authority to legally bind the applicant or registrant under its bylaws or articles of formation. Some titles that have been accepted are Director, National Director, National Commander, Permanent Chairman, International Sponsor, Supreme Ruler, Royal Impresario, and Chairman of the Steering Committee.

#### **611.06(g) Signature by Limited Liability Company**

A limited liability company (“LLC”) has attributes of both a corporation and a partnership. See TMEP §803.03(h). Laws vary to some extent as to the authority conferred on various individuals associated with the limited liability company. Generally, a “manager” has authority equivalent to an officer in a corporation. Therefore, anyone identified as a manager, or equivalent, may sign. In addition, anyone with a corporate-officer-type title may sign. In some states, the members, who are the owners, also have authority to act on behalf of the limited liability company.

### **611.06(h) Signature by Limited Liability Partnership**

A limited liability partnership (“LLP”) has attributes of both a partnership and a corporation. See TMEP §803.03(k). Laws vary to some extent as to the authority conferred on various partners associated with the limited liability partnership. Generally, all partners are recognized as having general agency authority to bind the partnership in the ordinary course of business. Therefore, anyone identified as a partner may sign.

Many states provide for the filing of a Statement of Partnership Authority which specifically names partners having authority and/or limits the authority of certain individuals. If an individual who is not a named partner of the LLP has been recognized as having authority to bind the LLP, that person may sign, and should indicate his or her position as an individual designated in the LLP’s Statement of Partnership Authority.