

REPORT

UNITED STATES CHANGES TRADEMARK RULES TO IMPLEMENT TECHNICAL CORRECTIONS ACT

January 8, 2003

Effective December 30, 2002, the U.S. Patent and Trademark Office (USPTO) has revised its rules to implement changes made by the Technical Corrections in Trademark Law Act of 2002. These changes include simplification of certain rules to reduce costs and delays for foreign applicants, as well as other minor modifications and corrections to prior rules.

I. CERTIFIED COPIES OF HOME COUNTRY REGISTRATIONS NO LONGER REQUIRED

Under the changes, it is no longer necessary to submit a certified copy of the registration from applicant's country of origin. Applicants can now submit "a true copy, a photocopy, a certification, or a certified copy of the registration in the country of origin of the applicant." (Some Examiners had already begun to implement this practice prior to the effective date of the rule change.) This should reduce expenses for applicants claiming the benefit of a home country registration. Additionally, when desired, this should enable issuance of a U.S. registration based on a home country registration sooner without the need to await the certified copy in applicant's home country. Upon issuance of the home country registration, please forward a copy, and a translation if necessary, for submission to the USPTO.

With the USPTO's stated goal of mandatory electronic filing, as discussed in our October 15, 2001 Special Report, the elimination of the requirement for a certified copy will assist the USPTO in that transition to electronic filing because an electronic copy of a home country registration can now be provided.

II. DESIGNATION OF DOMESTIC REPRESENTATIVE

The Technical Corrections Act also amended certain provisions of the Trademark Act to state a non-U.S. domiciliary "may designate" a U.S. representative which changes the requirement to designate a U.S. representative. Similarly, a designation of domestic representative is no longer required when filing a Section 8 Affidavit of Use or a Section 9 Renewal Application. Unless otherwise instructed, we will continue to designate our firm as the domestic representative for our clients; since, without such designation, notices involving a registration or application could be served on the Director of the USPTO which may not ensure timely notification of the actual trademark owner.

The elimination of the requirement for a domestic representative could be most advantageous when recording a chain of assignments, or other transfers of trademark rights, particularly where some transfers might have been to companies that are no longer in

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business. Past practice required a domestic representative to record each step in a chain of title. The new rules should simplify recordation; however, for the reason mentioned above, a domestic representative is desirable to record any transfer to the current owner.

III. OTHER CHANGES

Other minor changes were also made to the format of an application. Most notably, corrections were made to require applicants under 15 U.S.C. §1051(b) (intent to use) or 15 U.S.C. §1126 (home country application/registration) to include an allegation that applicant is entitled to use the mark "in commerce". The rule had previously erroneously omitted the language "in commerce". Our application format had already included this wording. Likewise, the USPTO rules are changed so that the verification of an application under these bases refers to the "applicant" rather than the "trademark owner." Our application format had already followed the requirements of the Trademark Act, rather than the inconsistent verbiage in the prior rules. We can revise any applications prepared by our clients that inadvertently omit the new language required by the Trademark Act and the rules, as revised.

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Although these technical changes do not create significant changes to trademark practice, they suggest a USPTO trend in relaxing certain requirements as the United States moves towards electronic filing and participation in the Madrid Protocol. We will provide further comments as additional changes are implemented.

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