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[Trademark Attorneys & Verified USPTO Statements](#)

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"Just because you can," is rarely a good reason to support a decision that really matters. This principle is no less true in the trademark world than it is elsewhere.

So, relying on your own navigation of the U.S. Patent and Trademark Office's (USPTO) [online search database](#) without also seeking a trademark attorney's competent analysis of the search results, can be a dangerous plan, even though you can go it alone. Likewise, just because you can file a trademark application yourself doesn't make it a smart business decision to avoid engaging a professional with day-to-day working knowledge of all the USPTO [nuances and pitfalls](#).

There are, however, limits on what outside trademark attorneys should do for their trademark owner clients. For example, another decision in the trademark world that really matters, but doesn't get enough attention, is who should sign verified statements filed with the U.S. Patent and Trademark Office (USPTO). The [Trademark Rules](#) liberally permit certain attorneys, among more obviously appropriate persons, to sign such statements on behalf of the trademark owner:

- (i) A person with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership);
- (ii) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or
- (iii) An attorney as defined in [Section 11.1 of this chapter](#) who has an actual written or verbal power of attorney or an implied power of attorney from the owner.

But, again, just because a trademark attorney can sign verified statements with the USPTO on behalf of the trademark owner doesn't make it a good idea. In fact, it should be a last resort for a trademark owner to have its outside trademark counsel sign verified statements with the USPTO.



As a result, I continue to be amazed how many outside trademark counsel continue to make it a regular practice of signing verified statements on behalf of their trademark owner clients. While I fully recognize it may provide a convenience to have outside trademark counsel sign such statements, and there may well be times when the urgency of a looming deadline requires it, the frequency of validity and fraud challenges in trademark oppositions, cancellations, and district court litigation, should be enough to encourage trademark owners to first consider these risks:

- The person signing the verified statements becomes a potential fact witness;
- If outside trademark counsel becomes a witness, he/she may be disqualified and precluded from representing the trademark owner in a dispute involving the filing;
- Concerning the factual accuracy of the statements made to the USPTO, outside trademark counsel will rarely have firsthand knowledge and never be closest to the true facts;
- Trademark owners are unlikely to successfully defend any false statements made by their trademark counsel that are based on legal misunderstanding (i.e., "bona fide intent to use," "use in commerce," "interstate commerce," "substantially exclusive" use, and [misuse of the federal registration symbol](#)); and
- The TTAB appears inclined to adopt "[reckless disregard](#)" as sufficient culpability to justify an inference of intent to deceive the USPTO in trademark fraud challenges.

So, can you think of and share any additional reasons not to have outside trademark counsel signing verified statements with the USPTO? Where do you stand on the issue with in-house trademark counsel? How about in-house corporate counsel who lacks trademark expertise?

And, what about the reasons in favor of outside trademark counsel signing such documents, are there any beyond convenience and deadline urgency? Finally, do you agree that outside trademark counsel should be the one designated to sign verified statements only as a last resort?

