

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 2 and 7

[Docket No. 2003-T-010]

RIN 0651-AB45

Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The United States Patent and Trademark Office (Office) is adding new regulations to implement the Madrid Protocol Implementation Act of 2002 (MPIA), and is amending existing regulation both to implement the MPIA and to otherwise clarify and improve the procedures for processing trademark applications and conducting proceedings before the Trademark Trial and Appeal Board. The MPIA provides that: The owner of a U.S. application or registration may seek protection of its mark in any of the other 58 countries party to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) by submitting a single international application through the Office to the International Bureau of the World Intellectual Property Organization (IB); and the owner of an application or registration in a country party to the Madrid Protocol may obtain an international registration from the IB and request an extension of protection of its mark to the United States.

DATES: *Effective Date:* November 2, 2003.

Applicability Dates: New rules added as part 7 of 37 CFR and the amendments to rules in part 2 of 37 CFR shall apply to any application for international registration filed on or after November 2, 2003, and any application for registration in the United States under section 1, section 44 or section 66(a) of the Act filed on or after November 2, 2003, except as noted below.

Drawing requirements under § 2.52: Applicants with pending applications filed prior to November 2, 2003, will not be required to file amended drawings. However, applicants may voluntarily amend their drawings to comply with the new standard character or color drawing requirements. See discussion below of changes to § 2.52. The Office will consider voluntary amendments filed on or after November 2, 2003, in accordance with standard procedures for processing of amendments.

Partial abandonment under § 2.65(a): This rule as amended shall apply to all Office actions issued on or after November 2, 2003, even if the application was filed prior to that date. See discussion below of the changes to § 2.65.

Requests to extend the time to file an opposition under § 2.102(c): If a first request for an extension of time to oppose was filed before November 2, 2003, the rules in effect on the filing date of that first request will apply to the first request and any subsequent request filed by the same potential opposer or one in privity with it. If a first request for an extension of time to oppose is filed on or after November 2, 2003, the amended regulation will apply to the first request and any subsequent request filed by the same potential opposer or one in privity with it.

Petitions to the Director under § 2.146(i): For petitions filed on or after May 2, 2004, petitioners will be held to the new six-month standard of diligence in monitoring the status of applications and registrations. Petitions filed prior to May 2, 2004, will be reviewed under the one-year diligence standard, even if the application was filed on or after November 2, 2003. See the discussion below of changes to § 2.146(i).

FOR FURTHER INFORMATION CONTACT: Cheryl L. Black, Office of the Commissioner for Trademarks, by telephone at (703) 308-8910, ext. 153, or by e-mail to cheryl.black@uspto.gov.

SUPPLEMENTARY INFORMATION: A Notice of Proposed Rule Making was published in the **Federal Register** (68 FR 15119) on March 28, 2003. A public hearing was held on May 30, 2003.

Four organizations, two law firms, seven attorneys, one business and three individuals submitted written comments. Two organizations and one attorney testified at the oral hearing.

The Madrid Protocol Implementation Act of 2002, Public Law 107-273, 116 Stat. 1758, 1913-1921 (MPIA) amends the Trademark Act of 1946 to implement the provisions of the Madrid Protocol in the United States. The MPIA was enacted on November 2, 2002, and becomes effective on November 2, 2003.

The Madrid Protocol and the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (April 1, 2002) (Common Regulations) are available on the World Intellectual Property Organization's (WIPO) Web site, currently at <http://www.wipo.int/madrid/en/>. The Common Regulations are the procedures agreed to by the parties to the Madrid Protocol regarding

the administration of the Madrid Protocol, pursuant to Article 10(2)(iii).

References below to "the Act," "the Trademark Act," or "the statute" refer to the Trademark Act of 1946, 15 U.S.C. 1051, *et seq.*, as amended by the MPIA. The "TMEP" referenced below is the *Trademark Manual of Examining Procedure* (3rd ed. Rev. 2, May 2003).

Filings Under Madrid Protocol

Background

The Madrid Protocol provides a system for obtaining an international registration. The IB maintains the system in accordance with the guidelines set forth in the Common Regulations. To apply for an international registration under the Madrid Protocol, an applicant must be a national of, be domiciled in, or have a real and effective business or commercial establishment in one of the countries that are members of the Madrid Protocol (Contracting Parties). An international application must be based on a trademark application or registration in one of the Contracting Parties (basic application or basic registration). The international application must be for the same mark and include a list of goods and/or services identical to or narrower than the list of goods and/or services in the basic application or registration. The international application must designate one or more Contracting Parties in which an extension of protection of the international registration is sought.

The international application must be submitted through the trademark office of the Contracting Party in which the basic application is pending or basic registration is held (office of origin). The office of origin must certify that the information in the international application corresponds with the information in the basic application or registration, and transmit the international application to the IB.

The IB will review an international application to determine whether the Madrid Protocol filing requirements have been met and the required fees have been paid. If an international application is unacceptable, the IB will notify both the applicant and the office of origin of the "irregularity." If the Madrid Protocol requirements have been met and the fees have been paid, the IB will immediately register the mark, publish the international registration in the *WIPO Gazette of International Marks*, send a certificate to the holder, and notify the offices of the designated Contracting Parties in which an extension of protection of the international registration is sought.

Registration by the IB does not mean that the mark is automatically granted protection in the designated Contracting Parties.

The holder of an international registration may designate additional Contracting Parties in a subsequent designation. A subsequent designation is a request by the holder of an international registration for an extension of protection of its international registration to additional Contracting Parties. Each Contracting Party designated in an international application or subsequent designation will examine the request for extension of protection as a national application under its laws, and if it complies with the requirements for registration, grant protection of the mark in its country. A Contracting Party must notify the IB of the refusal of a request for extension of protection within the time limits set forth in Article 5(2) of the Madrid Protocol. If a notification of refusal is not sent to the IB within the required time limits, the Contracting Party must grant protection of the mark in its country.

Discussion of Specific Rules Added or Changed

The Office is adding new rules setting forth the requirements for submitting international applications and subsequent designations through the Office for forwarding to the IB. The Office is also adding new rules for processing requests for extension of protection of international registrations to the United States, and changing current regulations to bring the rules of practice in trademark cases into conformance with the MPIA.

New Rules Added as Part 7

The Office is adding rules 7.1, 7.3, 7.4, 7.6, 7.7, 7.11, 7.12, 7.13, 7.14, 7.21, 7.22, 7.23, 7.24, 7.25, 7.26, 7.27, 7.28, 7.29, 7.30, 7.31, 7.36, 7.37, 7.38, 7.39, 7.40, and 7.41; and designating part 7 of 37 CFR as the rules of practice in filings pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

Section 7.1 defines certain terms used in this part. Terms defined in the MPIA are not included in the list of definitions in § 7.1.

Section 7.3 requires that correspondence relating to international applications and registrations be in English.

Section 7.4 states that correspondence submitted through the Trademark Electronic Application System (TEAS) will be accorded the date and time the complete transmission is received in the Office based on Eastern Time.

Fees

Section 7.6 sets forth the fees required by the Office for processing correspondence relating to international applications and registrations under the Madrid Protocol. These fees must be paid in U.S. dollars at the time of submission.

The Office is charging fees for: (1) Reviewing and certifying an international application; (2) transmitting a subsequent designation; (3) transmitting a request to record an assignment or restriction (usually a security interest), or the release of a restriction, of a holder's right of disposal of an international registration; (4) requesting a notice of replacement; and (5) filing an affidavit of use in commerce or excusable nonuse for a mark in a registered extension of protection to the United States.

In addition to the fees required by the Office, there are international fees for processing international applications and registrations. Section 7.7 sets forth the international fees that may be paid to the IB through the Office in connection with international applications and registrations, and the requirements and procedures for submitting those fees through the Office. A schedule of the international fees is currently posted on the WIPO Web site, available at <http://www.wipo.int/madrid/en/>. An international applicant or holder may pay the fees directly to the IB, or to the IB through the Office. Fees paid directly to the IB must be paid in Swiss francs, and fees paid through the Office must be paid in U.S. dollars.

Under § 7.7(b), if an international applicant or holder pays the international fees through the Office, payment must be made at the time of submission by any of the acceptable payment methods set forth in §§ 2.207 and 2.208. If the international fees are paid directly to the IB using an acceptable form of payment established by the IB, the international applicant or holder must include the IB account number for debiting fees or the IB receipt number as proof of payment of fees in its submission to the Office. The fee calculator and acceptable methods for paying fees to the IB may currently be viewed on the WIPO Web site at <http://www.wipo.int/madrid/en/>.

International Applications Originating From the United States

The requirements for granting a date of receipt to an international application are set forth in § 7.11(a). An international application must identify at least one basic application or registration. The international

application may be based on more than one U.S. application and/or registration, provided that the owner and the mark are the same for each basic application or registration.

An international application must be submitted through TEAS. The Office has developed a TEAS form for filing an application for international registration that conforms to the official IB form created by WIPO. TEAS will require the applicant to select between two different types of forms, namely, a pre-populated form containing information from the basic application or registration, or a free-text form. The applicant can use the pre-populated form if: (1) The international application is based on a single basic application or registration; and (2) applicant's changes to the international application are limited to narrowing the list of goods or services. For all other international applications, the applicant must fill in all the fields in the free text form.

Section 7.11(a)(3) requires a reproduction of the mark in the international application that is the same as the mark in the basic application or registration, and that meets the drawing requirements of § 2.52. If the mark in the basic application or registration is depicted in black and white and does not include a color claim, the reproduction of the mark in the international application must be black and white. If a mark is depicted in black and white in the basic application or registration but there is a claim of color, the international application must include both a black and white reproduction of the mark and a color reproduction of the mark. If the mark in the basic application or registration is in color, the reproduction of the mark in the international application must be in color.

Under §§ 7.11(a)(4) and 7.12, if color is claimed as a feature of the mark, the same color claim must be made in the international application. If color is not claimed as a feature of the mark in the basic application or registration, the international application may not include a claim of color.

Under § 7.11(a)(5), if the basic application or registration includes a description of the mark, the international application must include the same description of the mark.

Under § 7.11(a)(6), if the mark in the basic application or registration is a three-dimensional mark, sound mark, collective mark or certification mark, the international application must indicate the type of mark.

Section 7.11(a)(7) requires a list of goods and/or services in the international application that is

identical to or narrower than the list of goods and/or services in the basic application or registration, and is classified according to the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*. An applicant may omit or revise goods and/or services from the international application as long as the omission or revision does not broaden the scope of the goods or services identified in the basic application or registration.

The pre-populated form will include the list of goods/services in the basic application or registration. The applicant may edit the list of goods and/or services by either omitting particular goods or services or revising the description of goods or services populated from the basic application or registration. In the free text form, the applicant must enter the goods/services manually. The applicant may omit goods or services, or revise the list of goods/services. The list of goods and services for each designated Contracting Party must be identical to or narrower than the list of goods or services in the international application.

Both the pre-populated form and the free-text form will also allow an applicant to change the classification of goods and services in an international application. If the goods or services in the basic application or registration are classified in U.S. Classes A, B or 200 or entirely under the U.S. classification system, an applicant may want to reclassify goods or services into international classes. Classes A, B and 200 are not part of the international classification system under the *Nice Agreement*. Failure to properly classify goods or services in an international application according to the international classification system under the *Nice Agreement* may result in an IB notice of irregularity. The Office will issue an examination guide regarding classification on or before November 2, 2003.

Under § 7.11(a)(8), an international applicant must designate at least one Contracting Party in which it seeks an extension of protection.

Under § 7.11(a)(9), the international applicant must pay the U.S. certification fee and the international fees (*see* § 7.7) for all classes and all designated Contracting Parties at the time of submission.

Under section 61 of the Act, and § 7.11(a)(10), an international applicant must specify that applicant is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States. If

the applicant is not a national of the United States and the applicant's address on the application is outside of the United States, the applicant will be required to provide the address of the U.S. domicile or establishment.

Section 7.13 sets forth the requirements for certifying and forwarding an international application to the IB. Under § 7.13(a), if an international application meets the requirements of § 7.11(a), the Office will grant a date of receipt, certify that the information contained in the international application corresponds to the basic application or registration, and forward the international application electronically to the IB.

The Office must certify and forward an international application to the IB within two months of the date of receipt in the Office in order to provide the applicant with an international registration date as of the date of receipt of the international application in the Office. The Office will automatically certify and forward to the IB all international applications based on a single basic application or registration, with no limitations on the goods/services and no color claim, that meet the requirements of § 7.11(a). Limited review by the Madrid Processing Unit (MPU) is required for international applications where the goods or services have been narrowed or a color drawing is attached. International applications that are completed on free text forms are reviewed by the MPU. The use of a fully automated filing system expedites the processing of international applications because information is either pre-populated from Office records or entered by the applicant directly into the Office's automated systems, and electronically reviewed for certification.

Section 7.13(b) states that if the Office cannot certify that the information contained in the international application corresponds with the information in the basic application or registration, the Office will notify the applicant that the international application cannot be certified. Any international fees (*see* § 7.7) paid through the Office will be refunded; however, the Office will not refund the certification fee.

Correcting Irregularities in International Application—§ 7.14

The IB will notify both the international applicant and the Office of any irregularities in an international application. Under Rule 11 of the Common Regulations, the international applicant must correct certain irregularities through the Office. Fees for correcting irregularities in an

international application must be paid directly to the IB. All other irregularities requiring applicant's response may either be submitted through the Office or filed directly at the IB. Section 7.14(b) sets forth the types of irregularities that must be corrected through the Office, and § 7.14(e) sets forth the procedures for responding to irregularities through the Office.

To be considered timely, responses to IB notices of irregularities must be received by the IB before the end of the response period set forth in the IB's notice. Receipt in the Office does not fulfill this requirement.

Information about filing directly with the IB is available on the WIPO Web site, currently at <http://www.wipo.int/madrid/en/>. The applicant may contact the IB by mail to the World Intellectual Property Organization, 34 chemin des Colombettes, PO Box 18, CH-1211 Geneva 20, Switzerland; by telephone at 41 22 338 9111; by fax to 41 22 740 1429; or by e-mail to intreg.mail@wipo.int.

Irregularities in Classification and Identification of Goods/Services

Rules 12 and 13 of the Common Regulations provide that the IB will not consider a response to irregularities in classification or identification of goods and/or services unless the response is submitted through the office of origin. Section 7.14(b) therefore requires that an international applicant respond to irregularities in classification and identification of goods and/or services through the Office. Because the Office must certify that the goods or services in an applicant's response are within the scope of the basic application or registration at the time the response is filed, responses to irregularities in the identification will be reviewed by the MPU.

If the goods or services in the basic application or registration have been amended since the date the international application was submitted to the Office, the goods and services in the response to the IB notice must be within the scope of the amended goods and services. If the response includes goods and services that exceed the scope of the goods and services in the basic application or registration as amended, the MPU will reject the response and notify the applicant. If there is time remaining in the IB response period, the applicant may submit a corrected response. If the goods and services in an applicant's response do not exceed the scope of the goods and services in the basic application or registration as amended, and the IB response period has not

expired, the MPU will certify the goods and services and forward the response to the IB.

Fees To Correct Irregularities Must Be Paid Directly to the IB

Section 7.14(c) provides that fees for correcting irregularities in an international application must be paid directly to the IB. This is true even if the applicant is filing a response to correct other irregularities through the Office. At this time, the Office's automated system cannot process fees to correct irregularities in an international application.

Other Irregularities Requiring Response From Applicant

Under § 7.14(d), applicants may respond to all other irregularities either through the Office in accordance with § 7.14(e), or directly at the IB. The Office will not respond to any irregularities on behalf of an applicant. Except for an applicant's response to irregularities in the identification of goods and services, the Office will not review responses to IB notices of irregularities.

Procedures for Responding to IB Notices of Irregularities Through the Office

To be considered timely, responses to IB notices of irregularities must be received by the IB before the end of the response period set forth in the IB's notice. Receipt in the Office does not fulfill the requirement for timely submission to the IB.

Under § 7.14(e), the Office requires that applicants use TEAS to submit responses through the Office. Responses submitted through the Office for forwarding to the IB should be submitted as soon as possible, but at least one month before the end of the response deadline set forth in the IB's notice. The Office will not process any response submitted to the Office after the IB response deadline.

Subsequent Designations—§ 7.21

Section 64 of the Act and § 7.21 permit the holder of an international registration to submit a subsequent designation through the Office, if: (1) The international registration is based on a U.S. application or registration; and (2) the holder of the international registration is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States. The holder also has the option of filing a subsequent designation directly with the IB.

Under § 7.21, if a subsequent designation is submitted through the Office, it must be submitted through TEAS and include the international

registration number, the name and address of the holder of the international registration, one or more Contracting Parties in which an extension of protection is sought, and a list of goods and/or services that is identical to or narrower than the goods and/or services listed in the international registration. The holder can omit or revise goods and/or services from the subsequent designation as long as the omission or revision does not broaden the scope of the goods or services identified in the international registration. The holder must include the U.S. transmittal fee and all subsequent designation fees (*see* § 7.7) at the time of submission. The Office is not required to certify a subsequent designation.

The IB will review a subsequent designation for compliance with Rule 24 of the Common Regulations before forwarding the request for extension of protection to the designated Contracting Parties. If there are any irregularities in the subsequent designation, the IB will notify both the holder and the Office. The holder must file any responses to the notice or irregularities directly with the IB. The Office will not forward any responses to irregularities in a subsequent designation to the IB, even if the subsequent designation was submitted through the Office.

Recording Changes to International Registration

The IB shall record changes to international registrations pursuant to Articles 9 and 9^{bis} of the Madrid Protocol. Section 7.22 requires that all requests to record changes to an international registration be filed at the IB, except in the limited circumstances in which an assignment, or restriction of a holder's right of disposal of an international registration or the release of such a restriction, must be submitted through the Office, as set forth in §§ 7.23 and 7.24. Section 10 of the Act and 37 CFR part 3 are not applicable to such assignments or restrictions.

The Office will not take note of an assignment or restriction of a holder's right of disposal of an international registration in its records unless the IB notifies the Office that the assignment or restriction has been recorded in the International Register. When the IB sends notice of an assignment of an international registration with an extension of protection to the United States, the MPU will update the ownership information in the Trademark database and forward the IB notice to the Assignment Services Division to update its automated records. An assignment of an extension

of protection that has not been recorded at the IB will not be reflected in the Trademark database, even if the assignment has been inadvertently recorded by the Assignment Services Division.

Section 7.23 sets forth the limited circumstances in which a request to record an assignment of an international registration may be submitted through the Office. The Office will accept and forward to the IB a request to record an assignment of an international registration by an assignee who is a national of, is domiciled in or has a real and effective commercial or industrial establishment in the U.S. only if the assignee cannot obtain the assignor's signature for the request to record the assignment and the request meets the requirements of § 7.23.

Section 7.24 sets forth the limited circumstances in which a request to record a restriction of a holder's right of disposal of an international registration, or the release of such a restriction, may be submitted through the Office. Under § 7.24, the Office will accept for submission and forward to the IB a request to record a restriction of a holder's right of disposal of an international registration (usually a security interest), or the release of such a restriction, by a party holding the restriction who is a national of, is domiciled in or has a real and effective commercial or industrial establishment in the U.S. only if: (1) (i) The restriction is the result of a court order; or (ii) the restriction is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, and the signature of the holder of the international registration cannot be obtained; (2) the party who obtained the restriction is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States; and (3) the restriction or release applies to the holder's right to dispose of the international registration in the United States. The request must meet the requirements of § 7.24(b). The Office will charge a fee for transmitting a request to record an assignment or restriction, or the release of a restriction, to the IB.

Requests for Extension of Protection to the United States

Under section 65 of the Act, the holder of an international registration may request an extension of protection of the international registration to the United States, provided the international registration is not based on a U.S. application or registration.

The holder may file with the IB a request for extension of protection to the United States in either an international application or a subsequent designation. Section 66(a) of the Act requires that a request for extension of protection to the United States include a declaration of bona fide intention to use the mark in commerce that the United States Congress can regulate. The allegations in a verified statement required by an international applicant or holder seeking an extension of protection of an international registration to the United States are set forth in § 2.33(e). See discussion below of new § 2.33(e). The IB will certify that the request for extension of protection contains a properly signed declaration of bona fide intention to use the mark in commerce when it forwards the request to the Office. The declaration will remain part of the international registration on file at the IB.

The IB will forward the request for extension of protection to the Office electronically. A holder cannot file a request for extension of protection to the United States directly with the Office.

Section 7.25 provides that for purposes of examination and opposition, a request for an extension of protection to the United States will be referred to as an application for registration under section 66(a) of the Act; that references to "applications" and "registrations" in 37 CFR part 2 include extensions of protection to the United States; and that upon registration, an extension of protection will be referred to as a "registration," a "registered extension of protection," or a "section 66(a) registration." With the exception of §§ 2.130–2.131, 2.160–2.166, 2.168, 2.172, 2.173, 2.175 and 2.181–2.186, all the sections in 37 CFR parts 2 and 10 apply to a request for extension of protection to the United States.

Under § 7.26, the filing date of a request for extension of protection to the United States for purposes of examination in the Office is: (1) The international registration date, if the request for extension of protection to the United States was made in the international application, or (2) the date the IB recorded the subsequent designation, if the request for extension of protection to the United States was made in a subsequent designation. Under section 66(b) of the Act, the filing date of the extension of protection will be considered the date of constructive notice pursuant to section 7(c) of the Act.

Under section 67 of the Act and § 7.27, the holder of an international registration may claim priority under

Article 4 of the Paris Convention for the Protection of Industrial Property if: (1) The request for an extension of protection contains a claim of priority; and (2) the international registration date or the date of recordal of the subsequent designation at the IB requesting an extension of protection to the United States is no later than six months after the filing date of the application that formed the basis of the claim of priority.

Replacement

Under Article 4^{bis} of the Madrid Protocol, where a mark that is the subject of a national or regional registration in the Office of a Contracting Party is also the subject of an international registration and both registrations are in the name of the same person, the international registration is deemed to replace the national or regional registration, without prejudice to any rights acquired by virtue of the latter, provided that: (1) The protection resulting from the international registration extends to that Contracting Party; (2) all the goods and services listed in the national or regional registration are also listed in the international registration with respect to that Contracting Party; and (3) the extension of protection takes effect after the date of the national or regional registration.

Under section 74 of the Act and § 7.28(a), a registered extension of protection to the United States affords the same rights as a previously issued U.S. registration if: (1) Both registrations are owned by the same person and identify the same mark; and (2) the goods/services in the previously issued U.S. registration are covered by the registered extension of protection. Under § 7.28(b), the holder of a registered extension of protection may request that the Office note in its records replacement of the earlier U.S. registration by the extension of protection. The Office will require a fee to note replacement.

Under § 7.29, the replaced U.S. registration will remain in force, unless cancelled, expired or surrendered, as long as the owner files affidavits or declarations of use or excusable nonuse under section 8 of the Act and renews the registration under section 9 of the Act.

Effect of Cancellation or Expiration of International Registration on Extension of Protection

Under section 70 of the Act and § 7.30, the Office will cancel a pending or registered extension of protection to the United States, in whole or in part,

if the IB notifies the Office of the cancellation or expiration of the corresponding international registration, in whole or in part.

Transformation

Under section 70(c) of the Act and § 7.31, if an international registration is cancelled, in whole or in part, by the IB at the request of the office of origin under Article 6(4) of the Madrid Protocol (due to the cancellation or expiration of the basic application or registration), the holder of the international registration may file a request to transform the corresponding extension of protection to the United States into an application under sections 1 and/or 44 of the Act. If only a portion of the cancelled goods and services in the international registration pertains to the extension of protection to the United States, the Office will not cancel the entire extension of protection, but will instead delete the cancelled goods or services from the extension of protection. The holder of the extension of protection may request transformation only as to the cancelled goods or services.

The requirements for transformation are set forth in § 7.31(a). The holder of an international registration must file the request for transformation through TEAS within three months of the date of cancellation of the international registration. The request must include an application filing fee for at least one class of goods and/or services.

Under § 7.31(b), if a request for transformation contains all the elements in § 7.31(a), the cancelled extension of protection to the United States will be transformed into an application under sections 1 and/or 44 of the Act. The application will be accorded the same filing date and same priority (if any) as the cancelled extension of protection to the United States. The application resulting from the transformation will be examined as a new application under part 2 and, if approved for publication, published for opposition. The application must meet all the requirements of the Act and rules for an application under section 1 and/or section 44 of the Act, as appropriate.

If the holder does not meet the requirements of § 7.31(a), the Office will not process the request for transformation.

Maintaining an Extension of Protection to the United States

Section 71 of the Act and § 7.36 require the holder of an international registration with a registered extension of protection to the United States to file an affidavit or declaration of use in

commerce or excusable nonuse during the following time periods: (1) Between the fifth and sixth year after the date of registration in the United States; and (2) within the six-month period before the end of every ten-year period after the date of registration in the United States, or upon payment of a grace period surcharge, within the three-month grace period immediately following.

There is no requirement in the MPIA that the holder of a registered extension of protection to the United States renew the extension of protection in the Office under section 9 of the Act. Renewal of international registrations is governed by Article 7 of the Madrid Protocol and Rules 29–31 of the Common Regulations. The term of an international registration is ten years, and it may be renewed for ten years upon payment of the renewal fee.

Under § 7.41, renewal of an international registration and its extension of protection to the United States must be made directly with the IB. A request for renewal of an international registration cannot be submitted through the Office. If an international registration is not renewed at the IB, the registration will lapse, and the IB will notify the Office. Pursuant to section 70(b) of the Act, the Office will cancel the corresponding extension of protection to the United States.

Comments to Part 7 Rules

Comment: One comment voiced a concern that people who reside in the West will be disadvantaged by the Office's adherence to Eastern Time for according date and time of receipt of correspondence under § 7.4.

Response: The Office currently uses Eastern Time to accord a date and time of receipt to trademark-related correspondence, even when documents are submitted by customers on the West Coast and overseas. Under the current practice, the Office is able to consistently accord a receipt date to the thousands of documents it receives daily, without regard to the time zone in which the correspondence originated. This ensures effective and expeditious processing of incoming correspondence. Applying the same practice to correspondence related to international applications and registrations will provide continuity to the incoming correspondence process.

Comment: One comment requested an explanation of the Office's fees for transmitting IB filings submitted electronically by applicants and the associated burden on the Office in comparison with the fees and associated burden on other national trademark offices.

Response: The fees for processing IB filings under the Madrid Protocol reflect not only the "handling fee" but also the cost of redesigning the Office's automated systems so that it can receive documents from and transmit documents to the IB, and maintain electronic copies of documents sent to and received from the IB; the cost of reprogramming and expanding TEAS to add new forms for filings related to the Madrid Protocol; and the expense associated with establishing, staffing and operating a new business unit, the Madrid Processing Unit (MPU). Each Contracting Party sets their own transmittal fees. The Office does not provide information about other national trademark offices.

Comment: Two comments opposed mandatory electronic filing and requested that the Office provide an alternative to electronic filing.

Response: It is imperative that the Office process international applications expeditiously because the Office must certify and forward an international application meeting the requirements of § 7.11 to the IB within two months of the date of receipt in the Office in order to provide the applicant with an international registration date as of the date of receipt of the international application in the Office. Electronic filing saves the Office time in processing international applications and provides greater assurance to customers and the Office that the information contained in the electronic application is accurate. The pre-populated form takes information directly from the Office records, and the information entered by an applicant in the free text form is entered directly into the Office's automated system. The use of a completely automated system eliminates the additional time and work steps involved in scanning a paper application into electronic form and reduces the possibility of the paper application becoming lost within the Office.

Comment: Four comments requested that the Office eliminate the requirement for an address that is identical to the address in the basic application or registration.

Response: The Office has eliminated that requirement.

Comment: Two comments suggested that the Office adopt a mechanism to link the trademark automated records with the assignment automated records to avoid ownership discrepancies in the Office records.

Response: The Office has created an interface between the automated system in the Assignment Services Division of the Office and the Trademark database

that will enable the Office to update ownership information in the Trademark database when an assignment of the entire interest and goodwill, a name change or a merger has been recorded in the Assignment Services Division. This change in practice will apply only to documents recorded on and after the date on which the new procedures are implemented. The Office will implement these new procedures on or before November 2, 2003. A notice with detailed guidelines will be published in the *Official Gazette* and posted on the Office's Web site prior to November 2, 2003.

Comment: One comment asked if the TEAS form will permit an international applicant to authorize some charges to a U.S. deposit account and other charges to an IB account in a single filing.

Response: The TEAS form is designed to permit an international applicant to authorize some charges to a U.S. deposit account and other charges to an IB account in a single filing.

Comment: Two comments requested that the Office treat international applications that do not meet the requirements of § 7.11(a) as informal and allow applicants an opportunity to correct any deficiencies.

Response: Setting up a docketing system for informal international applications is unnecessary and inefficient. Since an international application is filed in "real" time through TEAS, if required information is omitted from an international application, the applicant will immediately receive a TEAS error message. If the Office cannot certify an international application, the MPU will send an e-mail message. In either case, the applicant may immediately re-file the international application with the correct information through TEAS.

Comment: One comment suggested that § 7.14 identify the irregularities that the Office must correct under the Common Regulations.

Response: The suggestion has not been adopted. The irregularities that the Office must remedy are set forth in Rule 11(4) of the Common Regulations, and are not repeated in part 7 of these rules.

Comment: One comment requested that the Office change the applicant's deadline for submitting responses to IB notices of irregularities through TEAS from one month to seven days prior to the IB deadline.

Response: The one-month response period set forth in § 7.14(e) is a suggestion, not a deadline. Only responses to correct irregularities in classification and identification of goods and services must be submitted through the Office. Early submission is

encouraged to allow the Office sufficient time to process responses to irregularities in classification and identification of goods and/or services through the Office. Fees for correcting irregularities must be paid directly to the IB. All other responses to correct irregularities can be filed directly at the IB or submitted through the Office for forwarding to the IB. See discussion above of § 7.14.

Comment: One comment stated that the Office should be willing to assist international applicants in resolving classification or identification issues raised by the IB.

Response: The IB will propose changes to the identification and classification of goods and services in its notice of irregularities concerning goods and services. Because the final decision on classification and identification for an international application rests with the IB, the Office recommends that applicants adopt suggestions offered by the IB, if accurate.

Comment: One comment requested that the Office treat deficient requests to record an assignment or restriction (*see* §§ 7.23 and 7.24) as informal and allow the filer an opportunity to correct deficiencies within a reasonable time.

Response: Setting up a docketing system for deficient requests is unnecessary and inefficient. If the request is deficient, the Office will inform the filer of the deficiency in an e-mail message. The applicant/holder will have the opportunity to immediately re-file.

Comment: One comment stated that noting replacement of an extension of protection before registration could cause confusion as to the effect of such notice.

Response: The Office has revised § 7.28. Under Article 4^{bis} of the Madrid Protocol and section 74 of the Act, replacement does not take effect until the extension of protection matures into a registration. Therefore, the Office will not note replacement of an extension of protection unless the mark has registered.

Comment: Two comments stated that the grace period for affidavits of use under § 7.36 should be changed from three months to six months.

Response: The grace period for filing an affidavit of use of a registered extension of protection is set forth in section 71 of the Act and will require a statutory amendment.

Amendment to Part 2 Rules

In addition to the new rules added as part 7 of 37 CFR, the Office is amending rules and adding new rules to part 2 of

37 CFR to bring the rules of practice in trademark cases into conformance with the MPIA, to set forth the requirements for examination and registration of extensions of protection to the United States, as well as proceedings before the Trademark Trial and Appeal Board relating to them, and to otherwise clarify and improve the procedures for processing trademark applications and conducting proceedings before the Trademark Trial and Appeal Board.

The Office is amending rules 2.2, 2.11, 2.17, 2.18, 2.19, 2.21, 2.33, 2.34, 2.35, 2.37, 2.47, 2.51, 2.52, 2.56, 2.65, 2.66, 2.73, 2.75, 2.84, 2.88, 2.101, 2.102, 2.104, 2.105, 2.107, 2.111, 2.112, 2.113, 2.118, 2.121, 2.123, 2.127, 2.128, 2.130, 2.131, 2.142, 2.145, 2.146, 2.151, 2.161, and 2.171; and adding rules 2.53, 2.54, and 2.126.

The Office is amending § 2.2 to add definitions of “ESTTA” (Electronic System for Trademark Trials and Appeals) and “international application.”

The Office is revising § 2.11 and its heading to indicate that representation before the Office is governed by 37 CFR 10.14. It is redundant to have provisions governing representation before the Office in both parts 2 and 10.

The Office is rewording § 2.17(b) by adding a reference to § 10.14(b), and rewording § 2.17(a) and (c) by replacing “paper” with “document.”

The Office is amending § 2.18 to clarify procedures for establishing a correspondence address in trademark cases. The amendment does not change current practice.

The Office is amending § 2.19(a) to clarify procedures for sending correspondence after a power of attorney is revoked, and amending § 2.19(b) to indicate that the procedures for permissive withdrawal of an attorney are governed by § 10.40.

The Office is amending § 2.21(a) to indicate that § 2.21 sets forth the minimum filing requirements only for applications under sections 1 and 44 of the Act. The filing date of an application under section 66(a) of the Act is governed by section 66(b) of the Act and § 7.26.

Section 2.33(d)(1) is amended to delete the requirement that a party who signs a trademark document electronically print, sign, date and maintain a paper copy of the electronic submission. It is burdensome and inefficient to require parties who file electronically to maintain both paper and electronic records of the filings.

The Office is also amending § 2.33 by adding paragraph (e), setting forth the requirements for a verified statement for an application under section 66(a) of the

Act, and stating that the verified statement is part of the international registration on file at the IB.

The Office is removing §§ 2.34(a)(1)(v), 2.34(a)(2)(ii), 2.34(a)(3)(iv) and 2.34(a)(4)(iv), which state that an application may list more than one item of goods or more than one service, provided that the applicant has used or has a bona fide intention to use the mark in commerce on or in connection with all the specified goods or services. This is stated in §§ 2.32(a)(6), 2.33(b)(1) and 2.33(b)(2), and it is unnecessary to repeat it in § 2.34.

The Office is amending § 2.34(a)(4)(i)(A) to require that an application based on section 44(d) of the Act specify the serial number of the foreign application. This incorporates a requirement of Article 4(D)(5) of the Paris Convention, and codifies current practice, as stated in TMEP § 1003.

The Office is adding a new § 2.34(a)(5), setting forth a request for extension of protection of an international registration under section 66(a) of the Act as a fifth basis for filing a trademark application.

The Office is revising § 2.34(b) to provide that more than one basis can be claimed only in an application under section 1 or 44 of the Act, and that a basis under section 66(a) of the Act cannot be combined with any other basis.

The Office is revising § 2.35(a) to state that in an application under section 66(a) of the Act, the applicant may not add, substitute or delete a basis, unless the applicant meets the requirements for transformation under section 70(c) of the Act and § 7.31.

The Office is revising § 2.35(b) to clarify that the requirements for adding, substituting or deleting a basis apply only to applications under sections 1 and 44 of the Act. This does not change current practice.

The Office is redesignating § 2.35(c) through 2.35(h) as § 2.35(b)(3) through 2.35(b)(8).

The Office is amending § 2.37(b) to delete the requirement for a description of a mark that has color. The requirement for a description of color for marks where color is claimed as a feature of the mark is already set forth in § 2.52, and it is unnecessary to repeat the requirement in § 2.37.

The Office is amending § 2.47 to indicate that an application under section 66(a) of the Act is not eligible for registration on the Supplemental Register. Section 68(a)(4) of the Act provides that registration of an extension of protection of an international registration shall be

refused to any mark not eligible for registration on the Principal Register.

The Office is rewording § 2.51 to simplify the rule and to add a provision that, in an application under section 66(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark that appears in the international registration.

The Office is revising § 2.52 to clarify the types of drawings and format for drawings. There are two types of drawings: (1) Standard character drawings; and (2) special form drawings. Currently the rules refer to "typed drawings." The Office is using the term "standard character" in the amended rules instead of the term "typed" because this is the term used for international applications under the Madrid Protocol. Section 2.52(a) sets forth the requirements for a standard character drawing, and § 2.52(b) sets forth the requirements for a special form drawing.

Section 2.52(a) permits an applicant to submit a standard character drawing, if the applicant seeks to register words, letters, and/or numbers without claim to any particular font style, size, or color, and the mark does not include a design element. Only Latin characters, Roman or Arabic numerals and common punctuation and diacritical marks may be used in a standard character drawing. The Office has created a chart of acceptable characters that may be included in a standard character drawing. The Office's standard characters set is attached as an appendix to this notice and will be published on the Office's Web site and linked to TEAS forms.

A standard character drawing does not have to display the mark in all upper case letters, but may display the mark in any font style. To avoid any confusion as to whether an applicant is seeking registration of a mark in standard characters or in the particular font style depicted in the drawing, § 2.52(a)(1) requires an applicant seeking registration of a mark in standard characters to submit a statement that the mark is in standard characters and that no claim is made to any particular font style, size, or color. If a drawing displays a mark in all capital letters or includes the wording "typed drawing," the Office will treat the drawing as a standard character drawing and the examining attorney will amend the application to include a standard characters statement by Examiner's Amendment. No prior authorization from the applicant is required for this type of Examiner's Amendment. If it is unclear whether the drawing is a standard character drawing

or a special form drawing, the examining attorney will require the applicant to clarify the type of drawing during examination.

Section 2.52(b) requires a special form drawing if an applicant seeks to register a design, a mark that contains color, or a mark comprised of words, letters and/or numbers in a particular font style or size.

Section 2.52(b)(1) requires that if a mark includes color, the drawing must show the mark in color and the applicant must claim color as a feature of the mark, name the color(s) and describe where the color(s) appear in the mark.

Currently, the Office does not accept color drawings. Under the current rules, to show color in a mark, an applicant must submit a black and white drawing, with a statement identifying the color(s) and describing where they appear in the mark. Alternatively, an applicant may show color by using the lining chart set forth in TMEP § 807.09(b).

Effective November 2, 2003, the Office will accept color drawings, and will require that applicants whose marks include color submit a drawing that shows color. The Office will no longer accept black and white drawings with a color claim, or drawings that are "lined for color." Under § 2.52(b)(1), if color is not claimed as a feature of the mark, the applicant must submit a black and white drawing. This is consistent with the requirements for international applications under the Madrid Protocol.

The new requirements under § 2.52(b)(1) do not prohibit the use of stippling in a black and white drawing. The Office will continue to process drawings with stippling as black and white drawings. However, if shading in a mark produces gray tones or gray is a feature of the mark, the Office will process the drawing as a color drawing and require a color claim.

The Office is adding § 2.53, setting forth additional requirements for drawings filed through TEAS, and § 2.54, setting forth additional requirements for drawings submitted on paper.

Section 2.53(a) requires an applicant submitting a standard character drawing to type the mark in the appropriate field on the TEAS form or attach a digitized image of the mark that meets the requirements of § 2.53(c). If the applicant enters the mark in the appropriate text field on the TEAS form and the standard characters in the applicant's mark are all included in the Office's standard character set (see Appendix), the Office will create a digitized image of the mark in .jpg format and attach the image to the TEAS

submission. If the applicant enters a mark that includes characters not in the Office's standard character set, an error message will appear. The applicant will then be required to attach a digitized image of the mark that meets the requirements of § 2.53(c).

Section 2.53(b) requires an applicant filing a special form drawing to attach to its TEAS submission a digitized image of the mark that meets the requirements of § 2.53(c).

Section 2.53(c) requires a digitized image of the mark that is in .jpg format and scanned at no less than 300 dots per inch and no more than 350 dots per inch with a length and width of no less than 250 pixels and no more than 944 pixels. The image must be clear and produce a high quality image when copied. These requirements are necessary to ensure that the Office database contains a clear and accurate reproduction of the mark and meets the 8 cm by 8 cm size limit that is required for an international application.

The Office is adding § 2.54, setting forth the requirements for a paper drawing. These requirements are necessary to ensure that the Office receives an image that can be scanned into its database without losing clarity.

The Office is amending § 2.56(d)(4) to require that a specimen transmitted electronically be a digitized image in .jpg format.

The Office is amending § 2.65(a) to add a statement that if a refusal or requirement is expressly limited to only certain goods and/or services and the applicant fails to file a complete response to the refusal or requirement, the application shall be abandoned only as to those particular goods and/or services. This is a change in practice. Currently, failure to respond to a refusal that pertains to fewer than all the goods and/or services, or fewer than all the classes, will result in abandonment of the entire application. See TMEP § 1403.05. This change in practice will result in fewer abandoned applications and comports with sections 68(c) and 69(a) of the Act, which provide that an application under section 66(a) of the Act is automatically protected with respect to any goods or services for which the Office has not timely notified the IB of a refusal.

Proposed § 2.66(a) required an applicant to file a petition to revive an abandoned application based on unintentional delay within two months of the mailing date of the notice of abandonment. The proposed rule removed § 2.66(a)(2), which provides that such a petition may be filed within two months of actual knowledge of the abandonment if the applicant did not

receive the notice of abandonment and the applicant was diligent in checking the status of the application. This change in practice was proposed to improve the accuracy and integrity of the Office database, to prevent harm to third parties who have searched Office records, and to prevent the loss of international registrations due to the abandonment of the basic application.

The strict time limits imposed by Article 5(2) of the Madrid Protocol for issuing refusals of requests for extension of protection of international registrations to the United States increase the importance of the accuracy and integrity of the Office database. Moreover, because of the dependency of an international registration on a basic application under Article 6 of the Madrid Protocol, filing a petition to revive an abandoned application that serves as the basis of an international registration, more than two months after the date of abandonment may result in the loss of the international registration. If the basic application is abandoned, and a petition to revive is not filed within two months of the mailing date of the notice of abandonment, the Office will notify the IB of the abandonment of the application. The IB will then cancel the international registration that was based on the U.S. application. Once the IB cancels an international registration, it cannot be revived, even if the basic application is revived.

However, in view of several comments objecting to the proposed amendment, the Office has reconsidered this proposed change and is not removing § 2.66(a)(2). Instead, the Office is revising § 2.66(a)(2) to require that an applicant, who files a petition to revive within two months of actual knowledge of the abandonment of the application and who did not receive a notice of abandonment of the application, must have been diligent in checking the status of the application every six months from the filing date of the application to the issuance of a registration in accordance with § 2.146(i).

The Office is not adopting proposed § 2.72(d), which would have provided that in an application under section 66(a) of the Act, the applicant could amend the description or drawing of the mark if the proposed amendment does not materially alter the mark. The Madrid Protocol and the Common Regulations do not permit the amendment of a mark in an international registration. If the holder of the international registration wants to change the mark in any way, even slightly, the holder must file a new international application. See the IB's

Guide to International Registration, Para. B.II.69.02 (2002). Because an application under section 66(a) of the Act is a request to extend protection of the mark in an international registration to the United States, the Office will not permit any amendment to the mark in a section 66(a) application.

Section 2.73 sets forth the requirements for amendment of an application to recite concurrent use under section 2(d) of the Act. The Office is amending § 2.73(a) to add references to applications under sections 44 and 66(a) of the Act.

The Office is adding a new § 2.75(c), stating that in an application under section 66(a) of the Act, the applicant may not amend the application to the Supplemental Register. As noted above, section 68(a)(4) of the Act provides that registration of an extension of protection of an international registration shall be refused to any mark not eligible for registration on the Principal Register.

The Office is revising § 2.84(a) and (b) to add references to the new filing basis under section 66(a) of the Act. The provisions with respect to requesting jurisdiction over published section 66(a) applications are similar to those in applications under sections 1(a) and 44 of the Act. However, when deciding whether to grant requests for jurisdiction of section 66(a) applications, the Director must also consider the strict time limits for notifying the IB of a refusal of an application under section 66(a) of the Act, set forth in Article 5(2) of the Madrid Protocol and section 68(c) of the Act.

Section 2.88(i)(3) is amended to correct a cross-reference.

The Office is amending §§ 2.101(a), 2.111(a), 2.118 and 2.145(c)(4) to refer to the United States Patent and Trademark Office as Office.

The Office is amending § 2.101(b) to substitute "person" for "entity" to track the statutory language; to make the rule gender neutral; to clarify the definitions of "attorney" and "other authorized representative" by reference to §§ 10.1(c) and 10.14(b), respectively; to clarify that an opposition must be signed; and to indicate that electronic signatures are required for electronically filed oppositions.

The Office is adding a new § 2.101(b)(1) and a new § 2.101(b)(2) stating that an opposition to an application based on section 1 or 44 of the Act must be filed either on paper or electronically through ESTTA, but that an opposition to an application based on section 66(a) of the Act must be filed only through ESTTA.

The Office is revising § 2.101(d)(1) through § 2.101(d)(3) and adding new § 2.101(d)(3)(i) through § 2.101(d)(3)(iii) to indicate that the Office will not accept an opposition submitted through ESTTA that does not include fees to cover all named party opposers and all classes opposed; and that the Office will not institute an opposition proceeding if an opposition submitted on paper does not include a fee sufficient to pay for one person to oppose the registration of a mark in at least one class. Prior to instituting an opposition, the Board will no longer correspond with an opposer in an opposition submitted on paper to permit submission of additional fees or designation of party opposers and/or classes where an opposition is submitted with insufficient fees to pay for opposition by all party opposers and/or in all classes. The amended regulation explains how the Office will apply a fee accompanying a paper submission that is insufficient to cover all classes and/or to cover all party opposers. The Board will notify opposer when the opposition is instituted and will indicate in the notification the opposers and classes opposed, *i.e.*, for which the required fees were submitted.

The Office is amending § 2.102(a) to make the rule gender neutral; to clarify the definitions of "attorney" and "authorized representative" by reference to §§ 10.1(c) and 10.14(b), respectively; to clarify that a request to extend the time for filing an opposition must be signed; and to indicate that electronic signatures are required for electronically filed requests to extend the time for filing oppositions.

The Office is adding a new § 2.102(a)(1) and a new § 2.102(a)(2) stating that a written request to extend the time for filing an opposition to an application based on section 1 or 44 of the Act must be filed either on paper or electronically through ESTTA, but stating that a request to extend the time for filing an opposition to an application based on section 66(a) of the Act must be filed only through ESTTA.

The Office is revising § 2.102(c) to set out the time frames for extensions of time to oppose and to indicate that the Trademark Trial and Appeal Board will no longer extend a potential opposer's time to file an opposition beyond 180 days from the date the mark is published for opposition. The Office is adding § 2.102(c)(1), (2) and (3) to state the requirements concerning the filing of permitted requests to extend the time for filing an opposition.

The Office is removing § 2.102(d), which requires submission of extension requests in triplicate.

The Office is revising § 2.104(a) to remove the requirement that a duplicate copy of the opposition, including exhibits, be filed with an opposition.

The Office is rewording the heading for § 2.105 to specify that notification of opposition proceedings is to the parties.

The Office is revising § 2.105 to clarify the definitions of “attorney” and “authorized representative” by reference to §§ 10.1(c) and 10.14(b), respectively; and to indicate that, if no attorney or other authorized representative is appointed, notification will be sent to a party’s domestic representative, or, if there is no domestic representative, notification will be sent to the party.

The Office is redesignating § 2.107 as § 2.107(a); and revising it to limit this paragraph to oppositions against an application filed under section 1 or 44 of the Act; and to incorporate in the rule the existing Board practice which prohibits an opposer in a proceeding against an application filed under section 1 or 44 of the Act from adding to the goods or services in an opposition after the period for filing the opposition has closed.

The Office is adding a new § 2.107(b) to state that pleadings in an opposition proceeding against an application filed under section 66(a) of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court; except that, once filed, such opposition may not be amended to add to the goods or services opposed, or to add to the grounds for opposition. Thus, opposer may not add an entirely new ground for opposition or add an additional claimed registration to a previously stated section 2(d) ground. An opposer may make amendments to grounds asserted in the notice of opposition, for example, for clarification.

The Office is revising § 2.111(b) to substitute “person” for “entity” to track the statutory language; to make the rule gender neutral; to clarify the definitions of “attorney” and “authorized representative” by reference to §§ 10.1(c) and 10.14(b), respectively; to clarify that a petition for cancellation must be signed; and to indicate that electronic signatures are required for electronically filed petitions for cancellation.

The Office is revising § 2.111(c) to divide it into four paragraphs; to state that the Office will not accept a petition for cancellation submitted through ESTTA that does not include fees to cover all named party petitioners and all classes; that the Office will not institute a cancellation proceeding if a petition for cancellation submitted on paper

does not include a fee sufficient to pay for one person for a petition for cancellation against at least one class; and that prior to instituting a cancellation proceeding, the Office will no longer correspond with the petitioner named in a petition for cancellation submitted on paper to permit submission of additional fees or designation of party petitioners and/or classes where a petition for cancellation is submitted with insufficient fees to pay for cancellation by all party petitioners and/or in all classes. The revision explains how the Office will apply a fee accompanying a paper submission that is insufficient to cover all classes and/or to cover all party petitioners.

The Office is amending § 2.112(a) to make the rule gender neutral and to remove the requirement that a duplicate copy of the petition for cancellation, including exhibits, be filed with the petition for cancellation.

The Office is rewording the heading for § 2.113 to specify that notification of cancellation proceedings is to the parties.

The Office is revising § 2.113 to divide it into paragraphs (a), (b), (c) and (d) for clarity; to clarify the definitions of “attorney” and “authorized representative” by reference to §§ 10.1(c) and 10.14(b), respectively; and to indicate that, if no attorney or other authorized representative is appointed by a party, notification will be sent to that party’s domestic representative, or, if there is no domestic representative for that party, notification will be sent to the party.

The Office is amending § 2.118 to delete reference to a party residing abroad and his representative in the United States in order to clarify that when any notice sent by the Office to a registrant is returned to the Office, notice may be given by publication in the *Official Gazette*, regardless of whether that registrant resides in the United States or elsewhere.

The Office is amending § 2.121(d) to eliminate the requirement for multiple copies of a stipulated/consent motion to extend the discovery or testimony periods in view of the fact that the Board is no longer stamping copies as “approved” and returning the copies to the parties.

The Office is amending § 2.123(g)(1) to require that depositions be in written form, but to delete reference to specific requirements that may vary depending upon the media used for submission. Requirements for submissions are specified in § 2.126.

The Office is adding new § 2.126, entitled “Form of submissions to the

Trademark Trial and Appeal Board,” which includes paragraphs (a) through (d). Paragraphs (a) through (c) provide that submissions may be made to the Board on paper, CD-ROM, or electronically, as permitted by the rules contained in this part or Board practice; and specify the requirements for each type of submission. Paragraph (d) specifies the requirements for making a submission to the Board that is confidential in whole or in part.

The Office is amending § 2.127(a) to delete the specifications for filing on paper a brief in support of, or response to, a motion, referring instead to § 2.126.

The Office is amending § 2.128(b) to require that briefs be in written form and to delete the specifications for filing a brief on paper, referring instead to § 2.126.

The Office is amending both the heading and the body of § 2.130 to change “Examiner of Trademarks” to “trademark examining attorney.” The Office is revising § 2.130 to provide that during an inter partes proceeding, only applications under section 1 or section 44 of the Act may be remanded, at the request of the trademark examining attorney, for consideration of facts which appear to render the mark unregistrable.

The Office is amending § 2.131 to change the term “examiner” to “trademark examining attorney” and to limit the applicability of this section to inter partes proceedings involving applications under sections 1 and 44 of the Act.

The Office is revising § 2.142(a) and (b)(2) to state that notices of appeal and briefs must be filed in written form, as prescribed in § 2.126, and to delete the specifications for filing a brief on paper.

The Office is amending § 2.145(b)(3) to indicate that notices of appeal to the U.S. Court of Appeals for the Federal Circuit should be sent to the Office of the General Counsel, with a duplicate copy addressed to the Board.

The Office is amending § 2.145(c)(3) to indicate that any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding who files a notice with the Office as provided in section 21(b) of the Act, must address that notice to the Office of the General Counsel.

The Office is amending § 2.145(c)(4) to indicate that, in order to avoid premature termination of a Board proceeding, a party who commences a civil action, pursuant to section 21(b) of the Act, must file written notice thereof at the Trademark Trial and Appeal Board.

The Office is amending § 2.146(c) to delete reference to a petition to revive as an example of a situation where an affidavit or declaration is required in support of a petition. This is a technical correction to the rule. Effective October 30, 1999, § 2.66 was amended to delete the requirement for an affidavit or declaration in a petition to revive based on unintentional delay. An unverified statement is sufficient. See notices at 64 FR 48900 (Sept. 8, 1999) and 1226 TMOG 103 (Sept. 28, 1999). However, § 2.146(c) still requires a verified statement in other situations where facts are to be proven on petition. For example, if the petition arises from the loss or misplacement of a document submitted to the Office, it should be accompanied by the affidavit or declaration of the person who mailed the document, attesting to the date of submission and identifying the document filed with the petition as a true copy of the document previously filed. TMEP § 1705.03.

The Office is amending § 2.146(i) to change the standard for a showing of due diligence for petitions in which the petitioner seeks to reactivate an application or registration that was abandoned, cancelled or expired due to the loss or mishandling of papers. Currently, the rule requires that to be considered diligent, petitioners must check the status of pending matters within one year of the last filing or receipt of a notice from the Office for which further action by the Office is expected. The Office is shortening the time period from one year to six months. A showing of due diligence will require that a petitioner check the status of a pending application every six months between the filing date of the application and issuance of a registration; check the status of a registration every six months after filing an affidavit of use or excusable nonuse under section 8 or 71 of the Act, or a renewal application under section 9 of the Act, until the petitioner receives notice that the affidavit or renewal application has been accepted; and promptly request corrective action where necessary.

Third parties may be harmed by the removal and later reinsertion of an application or registration in the Office database. Hundreds of petitions are filed each month to reinstate applications and registrations. To minimize this problem, the Office is adopting stricter time limits for filing petitions to revive or reinstate abandoned applications and cancelled or expired registrations.

The Office is revising § 2.151 to add a reference to section 71 of the Act, which requires periodic affidavits of use

or excusable nonuse to maintain a registration based on an extension of protection of an international registration.

The Office is revising § 2.161(g)(2) and adding paragraph (g)(3), stating that an audio or video cassette tape recording, CD-ROM, or a specimen in another appropriate medium may be submitted in the absence of a non-bulky specimen, and that an electronically submitted specimen must be in .jpg format. The requirement that a specimen filed through TEAS be a digitized image in .jpg format is consistent with the specimen requirement in revised § 2.56(d)(4).

The Office is adding a new § 2.171(b), stating that when ownership of a registration has changed with respect to some but not all of the goods and/or services, the registrant(s) may file a request that the registration be divided into two or more separate registrations. The new owner(s) must pay a fee for each new separate registration created by the division (child registration), and record the change of ownership in the Office.

When the IB notifies the Office of the division of an international registration resulting from a partial change of ownership of the international registration with respect to some of the goods or services in the registered extension of protection to the United States, the Office will record the partial change of ownership, divide out the assigned goods or services from the registered extension of protection (parent registration), issue an updated certificate for the parent registration and publish notice of the parent registration in the *Official Gazette*. The Office will not issue a new certificate for the child registration or publish notice of the child registration until the assignee files a request to divide under § 2.171(b), and pays the required fee.

A U.S. registration based on an application under section 1 and/or section 44 of the Act may also be divided as a result of a partial change of ownership, if the partial change of ownership is recorded in the Assignment Services Division and the assignee files a request to divide under § 2.171(b), with the required fee.

Comments to Part 2 Rules

Comment: One comment indicated that the "relationship" of proposed § 2.17 and § 10.14(b) appears to need clarification. Another comment asked whether the Office would accept a response in which the written authorization for the attorney was not filed with the response.

Response: The requirement for written authorization in § 2.17(b) applies only to non-lawyers. The Office is changing the language of § 2.17(b) to make this clear. It is generally not necessary for an attorney as defined in § 10.1(c) to file a power of attorney or any other special authorization in a trademark case. Under §§ 2.17(a) and (c), an attorney 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. See TMEP § 602.01.

Comment: One comment suggested that "written" be inserted before "notification" in § 2.19(a).

Response: The Office has adopted the suggestion.

Comment: Two comments suggested that the Office add the requirements for a verified statement under section 66(a) to the rules, and require that the IB send a copy of the signed verified statement with the request for extension of protection to the United States.

Response: The Office has adopted the suggestion to add the requirements for a verified statement in a section 66(a) application to the rules. These requirements have been added to § 2.33(e). However, the Office will not require that the IB send a copy of the signed verified statement with the request for extension of protection to the United States.

The Office has provided the IB with wording for a declaration of a bona fide intention to use the mark in commerce. The declaration will be made part of the official IB form for international applications and subsequent designations in which the United States is designated for an extension of protection, and will remain as part of the international registration on file at the IB. The wording of the declaration and instructions for who may sign the declaration comport with the requirements of section 66(a) of the Act and § 2.33. The IB will review the required declaration as part of the request for an extension of protection to the United States. The IB will not certify and forward a request for extension of protection to the United States, if: (1) The declaration is not signed and dated; (2) there have been any changes or modifications to the declaration; or (3) the declaration is not presented on the official IB form.

Comment: One comment suggests that the Office add the wording "on or in connection with the goods or services listed in the application," to § 2.34(b).

Response: The Office has adopted that suggestion.

Comment: One comment requested clarification as to whether a priority

claim for a Section 66(a) application is part of an international registration or an additional basis for filing in the Office.

Response: If a claim of priority is part of an international registration and meets the requirements of § 7.27, the priority claim is part of the application under Section 66(a), not a separate filing basis.

Comment: Three comments recommended that the Office eliminate the requirement to petition the Director to review a post-publication amendment of the basis under § 2.35(b)(2), and delegate the responsibility to trademark examining attorneys. Two of the comments suggested that republication of a mark may not be necessary in every instance.

Response: The recommendation cannot be adopted at this time. Although routinely granted, amendments to change the basis after publication require special manual and automated processing, including republication of the mark.

Comment: One comment suggests that the Office permit section 66(a) applications to register on the Supplemental Register.

Response: The suggestion cannot be adopted because the Act provides only for registration on the Principal Register. See section 68(a)(4) of the Act.

Comment: Three comments requested clarification of the term “standard character” drawing, and asked whether a “standard character drawing” is the equivalent of a “typed drawing” under current practice. One of the comments also requested that the Office delete the requirement for a statement that no claim is made to a particular font style or size.

Response: In the United States, a “standard character drawing” under revised § 2.52(a), is the equivalent in its effect of a “typed drawing” under current § 2.52(a)(1). The requirement for a statement that no claim is made to a particular font style, size, or color ensures that there is no ambiguity as to whether the applicant seeks registration of a mark in standard characters. See changes to § 2.52(a) discussed above.

Comment: One comment suggested that the Office make the requirement to name the colors and describe where they appear on the mark optional for applications under sections 1 and 44 of the Act.

Response: The Office has not adopted this suggestion. Applications under sections 1 and 44 of the Act are required to name the colors and describe where the colors appear in the marks under current § 2.52. Moreover, requirements for applications under sections 1 and 44

of the Act should be consistent with the requirements for section 66(a) applications, since they may serve as the basis for an international application.

Comment: One comment asked whether marks with gray tones but no claim of color will publish with gray tones or be converted to black and white.

Response: The Office will not convert drawings that contain gray tones to black and white drawings. Drawings with gray tones will be processed as color drawings. If the application does not contain a color claim, the examining attorney will inquire whether gray is a feature of the mark. If gray is a feature of the mark, the examining attorney will require a color claim, and the Office will publish the mark in color. If gray is not a feature of the mark, the examining attorney will require a black and white drawing.

Comment: Two comments opposed the requirement in § 2.53 that a digitized image of a drawing be in .jpg format. The comments suggested that the Office amend the rule to allow flexibility in accepting other digital formats as they develop.

Response: That suggestion has not been adopted. The Office will only accept .jpg format for digitized images at this time. The Office is concerned about the level of stability, uniformity and quality of images that are received and entered into the Office database. The Office currently accepts the .jpg format and has had success handling images in this format. Both the applicant and the Office can be assured that a visible image is attached to the submission because the applicant can view the image in the browser before it is transmitted to the Office. The .jpg format is user friendly and non-proprietary, and it is available to all potential applicants. The Office has not foreclosed the possibility of accepting other formats in the future, and will continue to assess image formats that are currently available and new ones as they develop.

Comment: One comment requested information as to the consequences of excluding the caption “Drawing Page” from the top of a paper drawing page.

Response: The Office encourages applicants to include the caption “Drawing Page” so that the Office can properly flag the mark when the drawing is scanned into the database. The caption is not mandatory, but its omission may delay processing of the application.

Comment: Six comments opposed the proposed amendment of § 2.66(a), to limit the time period for filing a petition

to revive to two months from the mailing date of the notice of abandonment.

Response: The Office is withdrawing the proposal to remove § 2.66(a)(2). Section 2.66(a)(2) is instead amended to change the standard for a showing of due diligence in a petition to revive from one year to six months as set forth in § 2.146(i). Under § 2.146(i), as amended, an applicant will be considered diligent if the applicant checks the status of the application every six months between the filing date of the application and issuance of a registration. The modification to § 2.66(a)(2) provides recourse for applicants who are diligent in monitoring the status of the application. However, if a petition to revive an abandoned application that forms the basis of an international registration is filed more than two months after the mailing date of the notice of abandonment, it is likely that the international registration will be cancelled. A cancelled international registration will not be revived even if the basic application is revived. See discussion above of changes to § 2.66.

Comment: One comment asked if a concurrent use application or registration can be the basis of an international application.

Response: An international application submitted through the Office can be based on a concurrent use application or registration.

Comment: Three comments noted that oppositions with insufficient fees appear to be treated differently for documents filed electronically via ESTTA and those filed on paper; and requested that the rules be amended to allow for uniform treatment for notices of opposition with insufficient fees regardless of the manner in which they are filed. One of the three comments suggested that the Office implement a mechanism in ESTTA to ensure that all required fees are paid as part of the electronic filing of a notice of opposition.

Response: The language of § 2.101(d)(2) has been modified to more clearly reflect the fact that a potential opposer may not submit a notice of opposition electronically via ESTTA with an insufficient fee, *i.e.*, the sender will immediately receive an electronic message that the transmission is not possible because the fee is insufficient. To be able to transmit the electronic notice of opposition, a potential opposer filing via ESTTA may then elect to submit the correct fee for the number of parties and classes set forth in the electronic notice of opposition, or delete classes and/or parties from the

electronic notice of opposition. For a paper filing with insufficient fees, the Board will notify opposer when the opposition is instituted and will indicate in the notification the opposers and classes opposed, *i.e.*, for which the required fees were submitted. There will be no opportunity to submit additional fees for a paper filing.

Comment: Seven comments disagreed with the proposed 120-day limitation from the date of publication on extensions of time to oppose an application, noting that a longer period of time is necessary to facilitate settlement negotiations. Of these comments, four comments recommended that the 120-day limitation on extensions of time to oppose be extended to 180 days; one comment recommended that the 120-day limitation on extensions of time to oppose pertain only to applications filed under section 66(a); and one comment recommended both that the limitation on extensions of time to oppose pertain only to applications filed under section 66(a) and that the limitation be extended to 180 days.

Response: The Office has adopted the recommendation that potential opposers be permitted to extend the time for filing an opposition to up to 180 days from the date of publication. The Office has not adopted the recommendation that this limitation pertain only to section 66(a) applications. The Office encourages use of its electronic systems and does not have the resources at this time to develop an electronic opposition filing system that can handle different filing deadlines for different types of applications. Further, different opposition filing deadlines for different types of applications would be difficult for the Board to handle administratively and would be likely to confuse potential opposers. Finally, the Board will discontinue its practice of suspending a potential opposer's time to file a notice of opposition when a letter of protest or an amendment to the application has been filed. However, the Board is continuing its practice of permitting suspension of an opposition, once filed, to facilitate and encourage settlement negotiations.

Comment: Two comments expressed concern that § 2.105 is not written clearly and could be easily misconstrued. The comments recommended that § 2.105 be rewritten to clarify to whom notification will be sent in each instance.

Response: The section has been rewritten to parallel § 2.18, as appropriate, and to clarify its intent.

Comment: Three comments noted that petitions to cancel with insufficient fees

for documents filed electronically via ESTTA are treated differently from those filed on paper; and requested that the rules be amended to allow for uniform treatment for petitions to cancel with insufficient fees regardless of the manner in which they are filed. One of the three comments suggested that the Office implement a mechanism in ESTTA to ensure that all sufficient fees are paid as part of the electronic filing of a petition to cancel.

Response: The language of § 2.111(c)(2) has been modified to more clearly reflect the fact that a potential cancellation petitioner may not submit a petition to cancel electronically via ESTTA with an insufficient fee. In addition to not being able to transmit the petition for cancellation via ESTTA with an insufficient fee, the sender should receive an immediate electronic message that the transmission is not possible and the reason why transmission is not possible. A potential cancellation petitioner filing via ESTTA must either submit the correct fee for the numbers of parties and classes set forth in the electronic petition to cancel, or delete classes and/or parties from the electronic petition to cancel. If a paper filing is submitted with insufficient fees for at least one party to petition for cancellation against at least one class, the Board will simply return the papers to the sender. If a paper filing is submitted with sufficient fees for at least one party to petition for cancellation against at least one class in the registration sought to be cancelled but with insufficient fees for all stated parties and/or all classes, the Board will institute the cancellation proceeding with respect to the number of parties and classes for which fees have been submitted, according to § 2.111(b)(3), and send notification of the petition for cancellation to the parties. The notification will list only the parties and classes for which the required fees were submitted.

Comment: Two comments expressed concern that § 2.113(a) is not written clearly and could be easily misconstrued. The comments recommended that § 2.113(a) be rewritten to clarify to whom notification will be sent in each instance.

Response: The section has been rewritten to parallel § 2.18, as appropriate, and to clarify its intent. Sections 2.113(b), (c) and (d) have been relabeled accordingly.

Comment: One comment pertaining to § 2.118 recommended that all correspondence be sent to the correspondence address of record.

Response: This recommendation has not been adopted. In relation to § 2.118,

this is essentially a recommendation to send notification of a petition to cancel to the attorney of record during the prosecution of an application that subsequently registered and is now the subject of a petition for cancellation, rather than sending such notification directly to respondent. The practice under the existing rule, and this provision has not been changed by this regulation, is for the Office to correspond directly with the registrant until notified otherwise by the registrant. The Office considers the appointment of an attorney to prosecute the application to lapse once the registration issues. The Board will send the notification to the registrant of record in the Office at the registrant's address of record, or if registrant is located outside the United States and a domestic representative is of record, to the registrant at the address of the domestic representative.

Comment: One comment recommended that § 12.126(a)(4) permit paper submissions to the Board to be bound or fastened if the contents can be easily separated. The comment expressed concern that after scanning, the papers will not be replaced in the file in their original order.

Response: This recommendation has not been adopted. All paper submissions are scanned electronically into the Board's Trademark Trials and Appeals Information System (TTABIS). When the papers are scanned, the Board's scanning equipment keeps pages in their original order throughout the scanning process. Where papers are filed with pages simply clipped together, the scanning process has not been adversely affected. On the other hand, removing staples or binding prior to scanning has been difficult and time-consuming, especially where papers have been bound by machine. Moreover, disassembling stapled or bound papers can damage pages, resulting in misfeeds to the scanning equipment and increasing the likelihood that pages will become disordered during scanning.

Comment: One comment recommended, with respect to § 2.127(a) regarding motions in inter partes proceedings at the Board, that, rather than retaining discretion to consider reply briefs, the Board should consider all reply briefs; and reduce the time for filing a reply brief, if a reply brief is filed, from fifteen to ten days from the date of service of a brief in response to the motion.

Response: This recommendation was not accepted. The recommendation to consider all reply briefs, including reply briefs that improperly address matters outside a proper response to statements

in the brief responding to the motion, would be burdensome. Therefore, the Board will retain its discretion to consider reply briefs with respect to motions. There is no reason stated for the recommendation to shorten the time for filing a reply brief; and, at this time, the Board considers the existing fifteen-day period for filing a reply brief to be reasonable.

Comment: Four comments opposed the proposal to shorten the due diligence standard from one year to six months in § 2.146(i).

Response: The Office's electronic systems for records are readily available over the Internet 24 hours a day, seven days a week. Applicants and registrants have immediate and free access to information concerning their applications and registrations. An applicant or registrant can check the status of a pending application or registration using the TARR (Trademark Application Registration Retrieval) database. If the application is newly filed, applicant can search TESS (Trademark Electronic Search System) to see if the mark was loaded into the Office's automated database. Moreover, allegations of use under section 1 of the Act, responses to Office actions, changes to correspondence address and affidavits of use under section 8 of the Act and renewal applications under section 9 of the Act can be filed through TEAS.

In most cases, the Office will take action on filings related to a trademark application or registration within six months of receipt of the correspondence for which action is expected. Therefore, it is reasonable to require applicants and registrants to check the status of their application or registration at least twice a year until a final outcome (that is, registration for a pending application or notice of acceptance of an affidavit under section 8 of the Act or grant of renewal under section 9 of the Act) is reached. By monitoring the application or registration every six months, an applicant or registrant can take corrective action more quickly if the Office did not receive applicant's or registrant's correspondence or if correspondence sent by the Office was not received.

Rule Making Requirements

Executive Order 13132: This rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

Executive Order 12866: This rule making has been determined not to be

significant for purposes of Executive Order 12866.

Regulatory Flexibility Act: The Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that the rule changes will not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The main purpose of the rule change is to implement legislation that provides an additional means for filing trademark applications. Additionally, the rules provide for some technical and other changes that will simplify the trademark application process. Hence, the rules merely provide all applicants for trademark registration, including small businesses, with additional benefits.

Paperwork Reduction Act: The final rules are in conformity with the requirements of the Paperwork Reduction Act of 1995 (PRA) (44 U.S.C. 3501 *et seq.*).

Notwithstanding any other provision of law, no person is required to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the PRA unless that collection of information displays a currently valid OMB control number.

This final rule contains collections of information requirements subject to the PRA. This rule adds provisions allowing parties to (1) file applications for international trademark registration with the IB through the Office; (2) file subsequent designations with the IB through the Office; (3) file responses to notices of irregularities in international applications issued by the IB through the Office; (4) request the Office to note in its records that a registered extension of protection of an international registration to the United States replaces a previously issued U.S. registration; (5) file requests to record assignments or restrictions of a holder's right to dispose of an international registration, or the release of such a restriction, with the IB through the Office; and (6) file a request that the Office transform an extension of protection that was cancelled by the IB into an application for registration in the United States under section 1 or section 44 of the Act. Additionally, the rule sets forth requirements for submitting an affidavit of continued use or excusable nonuse under section 71 of the Act and discusses changes in the information required from the public to file notices of opposition, petitions to cancel, and requests for extensions of time to oppose.

An information collection package supporting the changes to the above information requirements, as set forth in this rule, has been approved by the Office of Management and Budget under 0651-0051. Previously, a separate information package, 0651-0040, was submitted in support of oppositions, requests for extensions of time to file oppositions, and petitions to cancel. The public reporting burden is estimated to average as follows: Fifteen minutes for international trademark applications; three minutes for subsequent designations; ten minutes to respond to notices of irregularities issued by the IB in connection with international applications; two minutes to request that the Office replace a United States registration with a subsequently registered extension of protection to the United States; five minutes for a request to record an assignment or restriction of a holder's right to dispose of an international registration, or the release of such a restriction; five minutes for a request that the Office transform a cancelled extension of protection into an application for registration under section 1 or 44 of the Act; fourteen minutes for an affidavit of continued use or excusable nonuse under section 71 of the Act; ten minutes to forty-five minutes for notices of opposition and petitions to cancel, depending on the particular circumstances; and ten minutes for requests for extensions of time to oppose. These time estimates include the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collection of information. Comments are invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency, (2) the accuracy of the agency's estimate of the burden, (3) ways to enhance the quality, utility, and clarity of the information to be collected, and (4) ways to minimize the burden of the collection of information to respondents.

Send comments regarding this burden estimate, or any other aspect of this data collection, including suggestions for reducing the burden, to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514 (Attn: Ari Leifman), and to the Office of Information and Regulatory Affairs, OMB, 725 17th Street, NW., Washington, DC 20503 (Attn: USPTO Desk Officer).

Comment: One comment asked for an explanation for the time estimates and stated that the time periods for filing electronically should be increased to

account for documents filed by attorneys where the signature of an applicant or registrant must be obtained or a specimen that must be attached to the electronic submission is not scanned according to Office requirements prior to filing the document.

Response: The estimates given are meant to describe the overall average of time expended by all filers. The Office recognizes that the time parties expend in preparing submissions may vary, depending on the particular circumstances. However, the Office is confident that the estimates are reasonable descriptions of the average time expended by all filers.

List of Subjects

37 CFR Part 2

Administrative practice and procedure, Trademarks.

37 CFR Part 7

Administrative practice and procedure, Trademarks.

■ For the reasons given in the preamble and under the authority contained in 35 U.S.C. 2 and 15 U.S.C. 1123, as amended, the Office is amending part 2 and adding part 7 of title 37 as follows:

PART 2—RULES OF PRACTICE IN TRADEMARK CASES

■ 1. The authority citation for 37 CFR part 2 continues to read as follows:

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

■ 2. Amend § 2.2 to add new paragraphs (g) and (h) to read as follows:

§ 2.2 Definitions.

* * * * *

(g) The acronym *ESTTA* means the Electronic System for Trademark Trials and Appeals, available at www.uspto.gov.

(h) The term *international application* means an application for international registration that is filed under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

■ 3. Revise § 2.11 to read as follows:

§ 2.11 Representation before the Office.

Representation before the Office is governed by § 10.14 of this chapter. The Office cannot aid in the selection of an attorney.

■ 4. Amend § 2.17 by revising paragraphs (a), (b) and (c) to read as follows:

§ 2.17 Recognition for representation.

(a) When an attorney as defined in § 10.1(c) of this chapter acting in a

representative capacity appears in person or signs a document in practice before the United States Patent and Trademark Office in a trademark case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that, under the provisions of § 10.14 and the law, he or she is authorized to represent the particular party in whose behalf he or she acts. Further proof of authority to act in a representative capacity may be required.

(b) Before any non-lawyer, as specified in § 10.14(b) of this chapter, will be allowed to take action of any kind with respect to an application, registration or proceeding, a written authorization from the applicant, registrant, party to the proceeding, or other person entitled to prosecute such application or proceeding must be filed.

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

* * * * *

■ 5. Revise § 2.18 to read as follows:

§ 2.18 Correspondence, with whom held.

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

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

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

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

party designates in writing another correspondence address.

■ 6. Revise § 2.19 to read as follows:

§ 2.19 Revocation of power of attorney; withdrawal.

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

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

■ 7. Amend § 2.21 by revising paragraph (a), introductory text, to read as follows:

§ 2.21 Requirements for receiving a filing date.

(a) The Office will grant a filing date to an application under section 1 or section 44 of the Act that contains all of the following:

* * * * *

■ 8. Amend § 2.33 by revising paragraph (d)(1) and adding a new paragraph (e) to read as follows:

§ 2.33 Verified statement.

* * * * *

(d) * * *

(1) Place a symbol comprised of numbers and/or letters between two forward slash marks in the signature block on the electronic submission; or

* * * * *

(e) In an application under section 66(a) of the Act, the verified statement is part of the international registration on file at the International Bureau. The verified statement must allege that:

(1) The applicant/holder has a bona fide intention to use the mark in commerce that the United States Congress can regulate on or in connection with the goods/services identified in the international application/subsequent designation;

(2) The signatory is properly authorized to execute this declaration on behalf of the applicant/holder;

(3) The signatory believes the applicant/holder to be entitled to use the mark in commerce that the United States Congress can regulate on or in connection with the goods/services

identified in the international application/registration; and

(4) To the best of his/her knowledge and belief, no other person, firm, corporation, association, or other legal entity has the right to use the mark in commerce that the United States Congress can regulate, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive.

■ 9. Amend § 2.34 as follows:

- a. By removing paragraphs (a)(1)(v), (a)(3)(iv), and (a)(4)(iv);
- b. By revising paragraphs (a), introductory text, (a)(2), (a)(4)(i)(A), and (b); and
- c. By adding new paragraph (a)(5).

§ 2.34 The revisions and addition read as follows: Bases for filing.

(a) The application must include one or more of the following five filing bases:

* * * * *

(2) *Intent-to-use under section 1(b) of the Act.* In an application under section 1(b) of the Act, the applicant must verify that it has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the initial application, the verified statement must allege that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the filing date of the application.

* * * * *

(4) * * *

(i) * * *

(A) Specify the filing date, serial number and country of the first regularly filed foreign application; or

* * * * *

(5) *Extension of protection of an international registration under section 66(a) of the Act.* In an application under section 66(a) of the Act, the international application or subsequent designation requesting an extension of protection to the United States must contain a signed declaration that meets the requirements of § 2.33.

(b)(1) In an application under section 1 or section 44 of the Act, an applicant may claim more than one basis, provided the applicant satisfies all requirements for the bases claimed. However, the applicant may not claim both sections 1(a) and 1(b) for the identical goods or services in the same application.

(2) In an application under section 1 or section 44 of the Act, if an applicant claims more than one basis, the applicant must list each basis, followed by the goods or services to which that basis applies. If some or all of the goods or services are covered by more than one basis, this must be stated.

(3) A basis under section 66(a) of the Act cannot be combined with any other basis.

* * * * *

■ 10. Revise § 2.35 to read as follows:

§ 2.35 Adding, deleting, or substituting bases.

(a) In an application under section 66(a) of the Act, an applicant may not add, substitute or delete a basis, unless the applicant meets the requirements for transformation under section 70(c) of the Act and § 7.31 of this chapter.

(b) In an application under section 1 or section 44 of the Act:

(1) Before publication for opposition, an applicant may add or substitute a basis, if the applicant meets all requirements for the new basis, as stated in § 2.34. The applicant may delete a basis at any time.

(2) After publication, an applicant may add or substitute a basis in an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board, but only with the express permission of the Director, after consideration on petition. Republication will be required. The amendment of an application that is the subject of an *inter partes* proceeding before the Board is governed by § 2.133(a).

(3) When an applicant substitutes one basis for another, the Office will presume that there was a continuing valid basis, unless there is contradictory evidence in the record, and the application will retain the original filing date, including a priority filing date under section 44(d), if appropriate.

(4) If an applicant properly claims a section 44(d) basis in addition to another basis, the applicant will retain the priority filing date under section 44(d) no matter which basis the applicant perfects.

(5) The applicant may add or substitute a section 44(d) basis only within the six-month priority period following the filing date of the foreign application.

(6) When the applicant adds or substitutes a basis, the applicant must list each basis, followed by the goods or services to which that basis applies.

(7) When the applicant deletes a basis, the applicant must also delete any goods or services covered solely by the deleted basis.

(8) Once an applicant claims a section 1(b) basis as to any or all of the goods or services, the applicant may not amend the application to seek registration under section 1(a) of the Act for those goods or services unless the applicant files an allegation of use under section 1(c) or section 1(d) of the Act.

■ 11. Revise § 2.37 to read as follows:

§ 2.37 Description of mark.

A description of the mark may be included in the application and must be included if required by the trademark examining attorney.

■ 12. Amend § 2.47 by redesignating paragraphs (c) and (d) as paragraphs (d) and (e) and adding a new paragraph (c) to read as follows:

§ 2.47 Supplemental Register.

* * * * *

(c) An application under section 66(a) of the Act is not eligible for registration on the Supplemental Register.

* * * * *

■ 13. Revise § 2.51 to read as follows:

§ 2.51 Drawing required.

(a) In an application under section 1(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

(b) In an application under section 1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once an amendment to allege use under § 2.76 or a statement of use under § 2.88 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

(c) In an application under section 44 of the Act, the drawing of the mark must be a substantially exact representation of the mark as it appears in the drawing in the registration certificate of a mark duly registered in the applicant's country of origin.

(d) In an application under section 66(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as it appears in the international registration.

■ 14. Revise § 2.52 to read as follows:

§ 2.52 Types of drawings and format for drawings.

A drawing depicts the mark sought to be registered. The drawing must show only one mark. The applicant must include a clear drawing of the mark

when the application is filed. There are two types of drawings:

(a) *Standard character (typed) drawing.* Applicants who seek to register words, letters, numbers, or any combination thereof without claim to any particular font style, size, or color must submit a standard character drawing that shows the mark in black on a white background. An applicant may submit a standard character drawing if:

(1) The application includes a statement that the mark is in standard characters and no claim is made to any particular font style, size, or color;

(2) The mark does not include a design element;

(3) All letters and words in the mark are depicted in Latin characters;

(4) All numerals in the mark are depicted in Roman or Arabic numerals; and

(5) The mark includes only common punctuation or diacritical marks.

(b) *Special form drawing.* Applicants who seek to register a mark that includes a two or three-dimensional design; color; and/or words, letters, or numbers or the combination thereof in a particular font style or size must submit a special form drawing. The drawing must show the mark in black on a white background, unless the mark includes color.

(1) *Color marks.* If the mark includes color, the drawing must show the mark in color, and the applicant must name the color(s), describe where the color(s) appear on the mark, and submit a claim that the color(s) is a feature of the mark.

(2) *Three dimensional marks.* If the mark has three-dimensional features, the drawing must depict a single rendition of the mark, and the applicant must indicate that the mark is three-dimensional.

(3) *Motion marks.* If the mark has motion, the drawing may depict a single point in the movement, or the drawing may depict up to five freeze frames showing various points in the movement, whichever best depicts the commercial impression of the mark. The applicant must also describe the mark.

(4) *Broken lines to show placement.* If necessary to adequately depict the commercial impression of the mark, the applicant may be required to submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. The applicant must also use broken lines to show any other matter not claimed as part of the mark. For any drawing using broken lines to indicate placement of the mark, or

matter not claimed as part of the mark, the applicant must describe the mark and explain the purpose of the broken lines.

(5) *Description of mark.* If a drawing cannot adequately depict all significant features of the mark, the applicant must also describe the mark.

(c) *TEAS drawings.* A drawing filed through TEAS must meet the requirements of § 2.53.

(d) *Paper drawings.* A paper drawing must meet the requirements of § 2.54.

(e) *Sound, scent, and non-visual marks.* An applicant is not required to submit a drawing if the mark consists only of a sound, a scent, or other completely non-visual matter. For these types of marks, the applicant must submit a detailed description of the mark.

■ 15. Add § 2.53 to read as follows:

§ 2.53 Requirements for drawings filed through the TEAS.

The drawing must meet the requirements of § 2.52. In addition, in a TEAS submission, the drawing must meet the following requirements:

(a) *Standard character drawings:* If an applicant is filing a standard character drawing, the applicant must enter the mark in the appropriate field or attach a digitized image of the mark to the TEAS submission that meets the requirements of paragraph (c) of this section.

(b) *Special form drawings:* If an applicant is filing a special form drawing, the applicant must attach a digitized image of the mark to the TEAS submission that meets the requirements of paragraph (c) of this section.

(c) *Requirements for digitized image:* The image must be in .jpg format and scanned at no less than 300 dots per inch and no more than 350 dots per inch with a length and width of no less than 250 pixels and no more than 944 pixels. All lines must be clean, sharp and solid, not fine or crowded, and produce a high quality image when copied.

■ 16. Add § 2.54 to read as follows:

§ 2.54 Requirements for drawings submitted on paper.

The drawing must meet the requirements of § 2.52. In addition, in a paper submission, the drawing should:

(a) Be on non-shiny white paper that is separate from the application;

(b) Be on paper that is 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long. One of the shorter sides of the sheet should be regarded as its top edge. The image must be no larger than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide;

(c) Include the caption "DRAWING PAGE" at the top of the drawing beginning one inch (2.5 cm.) from the top edge; and

(d) Depict the mark in black ink, or in color if color is claimed as a feature of the mark.

(e) Drawings must be typed or made with a pen or by a process that will provide high definition when copied. A photolithographic, printer's proof copy, or other high quality reproduction of the mark may be used. All lines must be clean, sharp and solid, and must not be fine or crowded.

■ 17. Amend § 2.56 by revising paragraph (d)(4) to read as follows:

§ 2.56 Specimens.

* * * * *

(d) * * *

(4) For a TEAS submission, the specimen must be a digitized image in .jpg format.

■ 18. Amend § 2.65 by revising paragraph (a) to read as follows:

§ 2.65 Abandonment.

(a) If an applicant fails to respond, or to respond completely, within six months after the date an action is mailed, the application shall be deemed abandoned unless the refusal or requirement is expressly limited to only certain goods and/or services. If the refusal or requirement is expressly limited to only certain goods and/or services, the application will be abandoned only as to those particular goods and/or services. A timely petition to the Director pursuant to §§ 2.63(b) and 2.146, if appropriate, is a response that avoids abandonment of an application.

* * * * *

■ 19. Amend § 2.66 by revising paragraph (a)(2) to read as follows:

§ 2.66 Revival of abandoned applications.

(a) * * *

(2) Within two months of actual knowledge of the abandonment, if the applicant did not receive the notice of abandonment, and the applicant was diligent in checking the status of the application every six months in accordance with § 2.146(i).

* * * * *

■ 20. Amend § 2.73 by revising paragraph (a) to read as follows:

§ 2.73 Amendment to recite concurrent use.

(a) An application under section 1(a), section 44, or section 66(a) of the Act may be amended to an application for concurrent use registration, provided the application as amended satisfies the

requirements of § 2.42. The trademark examining attorney will determine whether the application, as amended, is acceptable.

* * * * *

■ 21. Amend § 2.75 by adding a new paragraph (c) to read as follows:

§ 2.75 Amendment to change application to different register.

* * * * *

(c) In an application under section 66(a) of the Act, the applicant may not amend the application to the Supplemental Register.

■ 22. Revise § 2.84 to read as follows:

§ 2.84 Jurisdiction over published applications.

(a) The trademark examining attorney may exercise jurisdiction over an application up to the date the mark is published in the *Official Gazette*. After publication of an application under section 1(a), 44 or 66(a) of the Act, the trademark examining attorney may, with the permission of the Director, exercise jurisdiction over the application. After publication of an application under section 1(b) of the Act, the trademark examining attorney may exercise jurisdiction over the application after the issuance of the notice of allowance under section 13(b)(2) of the Act. After publication, and prior to issuance of a notice of allowance in an application under section 1(b), the trademark examining attorney may, with the permission of the Director, exercise jurisdiction over the application.

(b) After publication, but before the certificate of registration in an application under section 1(a), 44 or 66(a) of the Act is printed, or before the notice of allowance in an application under section 1(b) of the Act is printed, an application that is not the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board may be amended if the amendment does not necessitate republication of the mark or issuance of an Office action. Otherwise, an amendment to such an application may be submitted only upon petition to the Director to restore jurisdiction over the application to the trademark examining attorney for consideration of the amendment and further examination. The amendment of an application that is the subject of an *inter partes* proceeding before the Trademark Trial and Appeal Board is governed by § 2.133.

■ 23. Amend § 2.88 by revising paragraph (i)(3) to read as follows:

§ 2.88 Filing statement of use after notice of allowance

* * * * *

(i) * * *

(3) The statement of use may be accompanied by a separate request to amend the identification of goods or services in the application, as stated in the notice of allowance, in accordance with § 2.71(a).

* * * * *

■ 24. Revise § 2.101 to read as follows:

§ 2.101 Filing an opposition.

(a) An opposition proceeding is commenced by filing a timely opposition, together with the required fee, in the Office.

(b) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board. The opposition need not be verified, but must be signed by the opposer or the opposer's attorney, as specified in § 10.1(c) of this chapter, or other authorized representative, as specified in § 10.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c)(1)(iii) are required for oppositions submitted electronically under paragraphs (b)(1) or (2) of this section.

(1) An opposition to an application based on section 1 or 44 of the Act must be filed either on paper or through ESTTA.

(2) An opposition to an application based on section 66(a) of the Act must be filed through ESTTA.

(c) The opposition must be filed within thirty days after publication (§ 2.80) of the application being opposed or within an extension of time (§ 2.102) for filing an opposition.

(d)(1) The opposition must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed (*see* § 2.6).

(2) An otherwise timely opposition will not be accepted via ESTTA unless the opposition is accompanied by a fee that is sufficient to pay in full for each named party opposer to oppose the registration of a mark in each class specified in the opposition.

(3) If an otherwise timely opposition is submitted on paper, the following is applicable if less than all required fees are submitted:

(i) If the opposition is accompanied by no fee or a fee insufficient to pay for one person to oppose the registration of a mark in at least one class, the opposition will be refused.

(ii) If the opposition is accompanied by fees sufficient to pay for one person

to oppose registration in at least one class, but fees are insufficient to oppose registration in all the classes in the application, and the particular class or classes against which the opposition is filed is not specified, the opposition will be presumed to be against the class or classes in ascending numerical order, including only the number of classes in the application for which sufficient fees have been submitted.

(iii) If persons are joined as party opposers, each must submit a fee for each class for which opposition is sought. If the fees submitted are sufficient to pay for one person to oppose registration in at least one class, but are insufficient for each named party opposer, the first-named party will be presumed to be the party opposer. Additional parties will be deemed to be party opposers only to the extent that the fees submitted are sufficient to pay the fee due for each party opposer. If persons are joined as party opposers against a multiple class application, the fees submitted are insufficient, and no specification of opposers and classes is made at the time the party is joined, the fees submitted will be applied first on behalf of the first-named opposer against as many of the classes in the application as the submitted fees are sufficient to pay. Any excess will be applied on behalf of the second-named party to the opposition against the classes in the application in ascending numerical order.

(4) The filing date of an opposition is the date of receipt in the Office of the opposition together with the required fee.

■ 25. Revise § 2.102 to read as follows:

§ 2.102 Extension of time for filing an opposition.

(a) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file in the Office a written request, addressed to the Trademark Trial and Appeal Board, to extend the time for filing an opposition. The written request need not be verified, but must be signed by the potential opposer or by the potential opposer's attorney, as specified in § 10.1(c) of this chapter, or authorized representative, as specified in § 10.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c)(1)(iii) are required for electronically filed extension requests.

(1) A written request to extend the time for filing an opposition to an application filed under section 1 or 44 of the Act must be filed either on paper or through ESTTA.

(2) A written request to extend the time for filing an opposition to an

application filed under section 66(a) of the Act must be filed through ESTTA.

(b) A written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted. An opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

(c) The time for filing an opposition shall not be extended beyond 180 days from the date of publication. Any request to extend the time for filing an opposition must be filed before thirty days have expired from the date of publication or before the expiration of a previously granted extension of time, as appropriate. Requests to extend the time for filing an opposition must be filed as follows:

(1) A person may file a first request for either a thirty-day extension of time, which will be granted upon request, or a ninety-day extension of time, which will be granted only for good cause shown.

(2) If a person was granted a thirty-day extension of time, that person may file a request for an additional sixty-day extension of time, which will be granted only for good cause shown.

(3) After receiving one or two extensions of time totaling ninety days, a person may file one final request for an extension of time for an additional sixty days. The Board will grant this request only upon written consent or stipulation signed by the applicant or its authorized representative, or a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, or a showing of extraordinary circumstances. No further extensions of time to file an opposition will be granted under any circumstances.

■ 26. Revise § 2.104(a) to read as follows:

§ 2.104 Contents of opposition.

(a) The opposition must set forth a short and plain statement showing why the opposer believes he, she or it would be damaged by the registration of the opposed mark and state the grounds for opposition.

* * * * *

■ 27. Revise § 2.105 to read as follows:

§ 2.105 Notification to parties of opposition proceeding(s).

(a) When an opposition in proper form has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notification, which shall identify the title and number of the proceeding and the application involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed.

(b) The Board shall forward a copy of the notification to opposer, as follows:

(1) If the opposition is transmitted by an attorney, or a written power of attorney is filed, the Board will send the notification to the attorney transmitting the opposition or to the attorney designated in the power of attorney, provided that the person is an "attorney" as defined in § 10.1(c) of this chapter.

(2) If opposer is not represented by an attorney in the opposition, but opposer has appointed a domestic representative, the Board will send the notification to the domestic representative, unless opposer designates in writing another correspondence address.

(3) If opposer is not represented by an attorney in the opposition, and no domestic representative has been appointed, the Board will send the notification directly to opposer, unless opposer designates in writing another correspondence address.

(c) The Board shall forward a copy of the opposition and any exhibits with a copy of the notification to applicant, as follows:

(1) If the opposed application contains a clear indication that the application is being prosecuted by an attorney, as defined in § 10.1(c) of this chapter, the Board shall send the documents described in this section to applicant's attorney.

(2) If the opposed application is not being prosecuted by an attorney but a domestic representative has been appointed, the Board will send the documents described in this section to the domestic representative, unless applicant designates in writing another correspondence address.

(3) If the opposed application is not being prosecuted by an attorney, and no domestic representative has been appointed, the Board will send the documents described in this section directly to applicant, unless applicant designates in writing another correspondence address.

■ 28. Revise § 2.107 to read as follows:

§ 2.107 Amendment of pleadings in an opposition proceeding.

(a) Pleadings in an opposition proceeding against an application filed under section 1 or 44 of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, after the close of the time period for filing an opposition including any extension of time for filing an opposition, an opposition may not be amended to add to the goods or services opposed.

(b) Pleadings in an opposition proceeding against an application filed under section 66(a) of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, once filed, the opposition may not be amended to add to the grounds for opposition or to add to the goods or services subject to opposition.

■ 29. Revise § 2.111 to read as follows:

§ 2.111 Filing petition for cancellation.

(a) A cancellation proceeding is commenced by the filing of a timely petition for cancellation, together with the required fee, in the Office.

(b) Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part. The petition for cancellation need not be verified, but must be signed by the petitioner or the petitioner's attorney, as specified in § 10.1(c) of this chapter, or other authorized representative, as specified in § 10.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c)(1)(iii) are required for petitions submitted electronically via ESTTA. The petition for cancellation may be filed at any time in the case of registrations on the Supplemental Register or under the Act of 1920, or registrations under the Act of 1881 or the Act of 1905 which have not been published under section 12(c) of the Act, or on any ground specified in section 14(3) or (5) of the Act. In all other cases, the petition for cancellation and the required fee must be filed within five years from the date of registration of the mark under the Act or from the date of publication under section 12(c) of the Act.

(c)(1) The petition for cancellation must be accompanied by the required fee for each party joined as petitioner for each class in the registration for which cancellation is sought (*see* § 2.6).

(2) An otherwise timely petition for cancellation will not be accepted via ESTTA unless the petition for

cancellation is accompanied by a fee that is sufficient to pay in full for each named party petitioner to petition for cancellation of the registration of a mark in each class specified in the petition for cancellation.

(3) If an otherwise timely petition for cancellation is submitted on paper, the following is applicable if less than all required fees are submitted:

(i) If the petition for cancellation is accompanied by no fee or a fee insufficient to pay for one person to petition for cancellation against at least one class in the registration, the petition for cancellation will be refused.

(ii) If the petition for cancellation is accompanied by fees sufficient to pay for one person to petition for cancellation against at least one class in the registration, but fees are insufficient for a petition for cancellation against all the classes in the registration, and the particular class or classes against which the petition for cancellation is filed is not specified, the petition for cancellation will be presumed to be against the class or classes in ascending numerical order, including only the number of classes in the registration for which sufficient fees have been submitted.

(iii) If persons are joined as party petitioners, each must submit a fee for each class for which cancellation is sought. If the fees submitted are sufficient to pay for one person to petition for cancellation of the registration in at least one class but are insufficient for each named party petitioner, the first-named party will be presumed to be the party petitioner. Additional parties will be deemed to be party petitioners only to the extent that the fees submitted are sufficient to pay the fee due for each party petitioner. If persons are joined as party petitioners against a multiple class registration, the fees submitted are insufficient, and no specification of parties and classes is made at the time the party is joined, the fees submitted will be applied first on behalf of the first-named petitioner against as many of the classes in the registration as the submitted fees are sufficient to pay. Any excess will be applied on behalf of the second-named party to the cancellation against the classes in the registration in ascending numerical order.

(4) The filing date of a petition for cancellation is the date of receipt in the Office of the petition for cancellation together with the required fee.

■ 30. Revise § 2.112 to read as follows:

§ 2.112 Contents of petition for cancellation.

(a) The petition for cancellation must set forth a short and plain statement showing why the petitioner believes he, she or it is or will be damaged by the registration, state the ground for cancellation, and indicate, to the best of petitioner's knowledge, the name and address of the current owner of the registration.

(b) When appropriate, petitions for cancellation of different registrations owned by the same party may be joined in a consolidated petition for cancellation. The required fee must be included for each party joined as a petitioner for each class sought to be cancelled in each registration against which the petition for cancellation is filed.

■ 31. Revise § 2.113 to read as follows:

§ 2.113 Notification to parties of cancellation proceeding.

(a) When a petition for cancellation has been filed in proper form (see §§ 2.111 and 2.112), the Trademark Trial and Appeal Board shall prepare a notification which shall identify the title and number of the proceeding and the registration(s) involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed.

(b) The Board shall forward a copy of the notification to petitioner, as follows:

(1) If the petition for cancellation is transmitted by an attorney, or a written power of attorney is filed, the Board will send the notification to the attorney transmitting the petition for cancellation or to the attorney designated in the power of attorney, provided that person is an "attorney" as defined in § 10.1(c) of this chapter.

(2) If petitioner is not represented by an attorney in the cancellation proceeding, but petitioner has appointed a domestic representative, the Board will send the notification to the domestic representative, unless petitioner designates in writing another correspondence address.

(3) If petitioner is not represented by an attorney in the cancellation proceeding, and no domestic representative has been appointed, the Board will send the notification directly to petitioner, unless petitioner designates in writing another correspondence address.

(c) The Board shall forward a copy of the petition for cancellation and any exhibits with a copy of the notification to the respondent (see § 2.118). The respondent shall be the party shown by the records of the Office to be the

current owner of the registration(s) sought to be cancelled, except that the Board, in its discretion, may join or substitute as respondent a party who makes a showing of a current ownership interest in such registration(s).

(d) When the party alleged by the petitioner, pursuant to § 2.112(a), as the current owner of the registration(s) is not the record owner, a courtesy copy of the petition for cancellation shall be forwarded with a copy of the notification to the alleged current owner. The alleged current owner may file a motion to be joined or substituted as respondent.

(e) If the petition for cancellation is found to be defective as to form, the party filing the petition for cancellation shall be advised and allowed reasonable time for correcting the informality.

■ 32. Revise § 2.118 to read as follows:

§ 2.118 Undelivered Office notices.

When a notice sent by the Office to any registrant is returned to the Office undelivered, additional notice may be given by publication in the Official Gazette for the period of time prescribed by the Director.

■ 33. Amend § 2.121 by revising paragraph (d) to read as follows:

§ 2.121 Assignment of times for taking testimony.

* * * * *

(d) When parties stipulate to the rescheduling of testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board.

■ 34. Amend § 2.123 by revising paragraph (g)(1) to read as follows:

§ 2.123 Trial testimony in inter partes cases.

* * * * *

(g) *Form of deposition.* (1) The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. A deposition must be in written form. The questions propounded to each witness must be consecutively numbered unless the pages have numbered lines. Each question must be followed by its answer.

* * * * *

■ 35. Add new § 2.126 to read as follows:

§ 2.126 Form of submissions to the Trademark Trial and Appeal Board.

(a) Submissions may be made to the Trademark Trial and Appeal Board on paper where Board practice or the rules in this part permit. A paper submission, including exhibits and depositions, must meet the following requirements:

(1) A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;

(2) A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;

(3) If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;

(4) A paper submission must not be stapled or bound;

(5) All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in § 2.123(g)(2);

(6) Exhibits pertaining to a paper submission must be filed on paper or CD-ROM concurrently with the paper submission, and comply with the requirements for a paper or CD-ROM submission.

(b) Submissions may be made to the Trademark Trial and Appeal Board on CD-ROM where the rules in this part or Board practice permit. A CD-ROM submission must identify the parties and case number and contain a list that clearly identifies the documents and exhibits contained thereon. This information must appear in the data contained in the CD-ROM itself, on a label affixed to the CD-ROM, and on the packaging for the CD-ROM. Text in a CD-ROM submission must be in at least 11-point type and double-spaced. A brief filed on CD-ROM must be accompanied by a single paper copy of the brief. A CD-ROM submission must be accompanied by a transmittal letter on paper that identifies the parties, the case number and the contents of the CD-ROM.

(c) Submissions may be made to the Trademark Trial and Appeal Board electronically via the Internet where the rules in this part or Board practice permit, according to the parameters established by the Board and published on the Web site of the Office. Text in an electronic submission must be in at least 11-point type and double-spaced. Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission.

(d) To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to § 2.125(e) must be submitted under a separate cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission with the confidential portions redacted must be submitted.

■ 36. Amend § 2.127 by revising paragraph (a) to read as follows:

§ 2.127 Motions.

(a) Every motion must be submitted in written form and must meet the requirements prescribed in § 2.126. It shall contain a full statement of the grounds, and shall embody or be accompanied by a brief. Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within fifteen days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. If a motion for an extension is denied, the time for responding to the motion remains as specified under this section, unless otherwise ordered. The Board may, in its discretion, consider a reply brief. Except as provided in paragraph (e)(1) of this section, a reply brief, if filed, shall be filed within fifteen days from the date of service of the brief in response to the motion. The time for filing a reply brief will not be extended. No further papers in support of or in opposition to a motion will be considered by the Board. The brief in support of a motion and the brief in response to the motion shall not exceed twenty-five pages in length, and a reply brief shall not exceed ten pages in length. Exhibits submitted in support of or in opposition to a motion shall not be deemed to be part of the brief for purposes of determining the length of the brief. When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded. An oral hearing will not be held on a motion except on order by the Board.

* * * * *

■ 37. Amend § 2.128 by revising paragraph (b) to read as follows:

§ 2.128 Briefs at final hearing.

* * * * *

(b) Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetical index

of cited cases. Without prior leave of the Trademark Trial and Appeal Board, a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety.

■ 38. Revise § 2.130 to read as follows:

§ 2.130 New matter suggested by the trademark examining attorney.

If, while an inter partes proceeding involving an application under section 1 or 44 of the Act is pending, facts appear which, in the opinion of the trademark examining attorney, render the mark in the application unregistrable, the facts should be called to the attention of the Trademark Trial and Appeal Board. The Board may suspend the proceeding and refer the application to the trademark examining attorney for an ex parte determination of the question of registrability. A copy of the trademark examining attorney's final action will be furnished to the parties to the inter partes proceeding following the final determination of registrability by the trademark examining attorney or the Board on appeal. The Board will consider the application for such further inter partes action as may be appropriate.

■ 39. Revise § 2.131 to read as follows:

§ 2.131 Remand after decision in inter partes proceeding.

If, during an inter partes proceeding involving an application under section 1 or 44 of the Act, facts are disclosed which appear to render the mark unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may remand the application to the trademark examining attorney for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon remand, the trademark examining attorney shall reexamine the application in light of the reference by the Board. If, upon reexamination, the trademark examining attorney finally refuses registration to the applicant, an appeal may be taken as provided by §§ 2.141 and 2.142.

■ 40. Amend § 2.142 by revising paragraphs (a) and (b)(2) to read as follows:

§ 2.142 Time and manner of ex parte appeals.

(a) Any appeal filed under the provisions of § 2.141 must be filed within six months from the date of the final refusal or the date of the action from which the appeal is taken. An appeal is taken by filing a notice of appeal in written form, as prescribed in § 2.126, and paying the appeal fee.

(b) * * *

(2) Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetical index of cited cases. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary.

* * * * *

■ 41. Amend § 2.145 by revising paragraphs (b)(3), (c)(3) and (c)(4) to read as follows:

§ 2.145 Appeal to court and civil action.

* * * * *

(b) * * *

(3) Notices of appeal directed to the Director shall be mailed to or served by hand on the General Counsel, according to part 104 of this chapter, with a duplicate copy mailed or served by hand on the Trademark Trial and Appeal Board.

(c) * * *

(3) Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding may file a notice with the Office, addressed to the Office of the General Counsel, according to part 104 of this chapter, within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in § 2.119.

(4) In order to avoid premature termination of a proceeding, a party who commences a civil action, pursuant to section 21(b) of the Act, must file written notice thereof at the Trademark Trial and Appeal Board.

* * * * *

■ 42. Amend § 2.146 by revising paragraphs (c) and (i) to read as follows:

§ 2.146 Petitions to the Director.

* * * * *

(c) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be

reviewed, the action or relief that is requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. When facts are to be proved in *ex parte* cases, proof in the form of affidavits or declarations in accordance with § 2.20, and any exhibits, shall accompany the petition.

* * * * *

(i) Where a petitioner seeks to reactivate an application or registration that was abandoned, cancelled or expired because papers were lost or mishandled, the Director may deny the petition if the petitioner was not diligent in checking the status of the application or registration. To be considered diligent, a petitioner must:

(1) During the pendency of an application, check the status of the application every six months between the filing date of the application and issuance of a registration;

(2) After registration, check the status of the registration every six months from the filing of an affidavit of use or excusable nonuse under section 8 or 71 of the Act, or a renewal application under section 9 of the Act, until the petitioner receives notice that the affidavit or renewal application has been accepted; and

(3) If the status check reveals that the Office has not received a document filed by the petitioner, or that the Office has issued an action or notice that the petitioner has not received, the petitioner must promptly request corrective action.

* * * * *

■ 43. Revise § 2.151 to read as follows:

§ 2.151 Certificate.

When the Office determines that a mark is registrable, the Office will issue a certificate stating that the applicant is entitled to registration on the Principal Register or on the Supplemental Register. The certificate will state the application filing date, the act under which the mark is registered, the date of issue, and the number of the registration. A reproduction of the mark and pertinent data from the application will be sent with the certificate. A notice of the requirements of sections 8 and 71 of the Act will accompany the certificate.

■ 44. Amend § 2.161 by revising paragraph (g)(2) and adding a new paragraph (g)(3) to read as follows:

§ 2.161 Requirements for a complete affidavit or declaration of continued use or excusable nonuse.

* * * * *

(g) * * *

(2) Be flat and no larger than 8.5 inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen exceeds these size requirements (a "bulky specimen"), the Office will create a facsimile of the specimen that meets the requirements of the rule (*i.e.*, is flat and no larger than 8.5 inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the record. In the absence of non-bulky alternatives, the Office may accept an audio or video cassette tape recording, CD-ROM, or a specimen in another appropriate medium.

(3) Be a digitized image in .jpg format, if transmitted through TEAS.

■ 45. Revise § 2.171 to read as follows:

§ 2.171 New certificate on change of ownership.

(a) If the ownership of a registered mark changes, the assignee may request that a new certificate of registration be issued in the name of the assignee for the unexpired part of the original period. The assignment must be recorded in the Office, and the request for the new certificate must be signed by the assignee and accompanied by the fee required by § 2.6(a)(8). If available, the original certificate of registration must be submitted.

(b) When ownership of a registration has changed with respect to some, but not all, of the goods and/or services, the registrant(s) may file a request that the registration be divided into two or more separate registrations. The fee required by § 2.6(a)(8) must be paid for each new registration created by the division, and the change of ownership must be recorded in the Office.

■ 1. Add a new part 7:

PART 7—RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**Subpart A—General Information**

Sec.

- 7.1 Definitions of terms as used in this part.
- 7.2 [Reserved]
- 7.3 Correspondence must be in English.
- 7.4 Receipt of correspondence.
- 7.5 [Reserved]
- 7.6 Schedule of U.S. process fees.
- 7.7 Payments of fees to International Bureau.

Subpart B—International Application Originating From The United States

- 7.11 Requirements for international application originating from the United States.
- 7.12 Claim of color.
- 7.13 Certification of international application.

7.14 Correcting irregularities in international application.

Subpart C—Subsequent Designation Submitted Through the Office

7.21 Subsequent designation.

Subpart D—Recording Changes to International Registration

7.22 Recording changes to international registration.

7.23 Requests for recording assignments at the International Bureau.

7.24 Requests to record security interest or other restriction of holder's rights of disposal or release of such restriction submitted through the Office.

Subpart E—Extension of Protection to the United States

7.25 Sections of part 2 applicable to extension of protection.

7.26 Filing date of extension of protection for purposes of examination in the Office.

7.27 Priority claim of extension of protection for purposes of examination in the Office.

7.28 Replacement of U.S. registration by registered extension of protection.

7.29 Effect of replacement on U.S. registration.

7.30 Effect of cancellation or expiration of international registration.

7.31 Requirements for transformation of an extension of protection to the United States into a U.S. application.

Subpart F—Affidavit Under Section 71 of the Act for Extension of Protection to the United States

7.36 Affidavit or declaration of use in commerce or excusable nonuse required to avoid cancellation of an extension of protection to the United States.

7.37 Requirements for a complete affidavit or declaration of use in commerce or excusable nonuse.

7.38 Notice to holder of extension of protection.

7.39 Acknowledgment of receipt of affidavit or declaration of use in commerce or excusable nonuse.

7.40 Petition to Director to review refusal.

Subpart G—Renewal of International Registration and Extension of Protection

7.41 Renewal of international registration and extension of protection.

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

Subpart A—General Information

§ 7.1 Definitions of terms as used in this part.

(a) *the Act* means the Trademark Act of 1946, 60 Stat. 427, as amended, codified in 15 U.S.C. 1051 *et seq.*

(b) *Subsequent designation* means a request for extension of protection of an international registration to a Contracting Party made after the International Bureau registers the mark.

(c) The acronym *TEAS* means the Trademark Electronic Application

System available on-line through the Office's Web site at: www.uspto.gov.

(d) The term *Office* means the United States Patent and Trademark Office.

(e) All references to sections in this part refer to 37 Code of Federal Regulations, except as otherwise stated.

§ 7.2 [Reserved]

§ 7.3 Correspondence must be in English.

International applications and registrations, requests for extension of protection and all other related correspondence with the Office must be in English. The Office will not process correspondence that is in a language other than English.

§ 7.4 Receipt of correspondence.

Correspondence relating to international applications and registrations and requests for extension of protection submitted through TEAS will be accorded the date and time on which the complete transmission is received in the Office based on Eastern Time. Eastern Time means eastern standard time or eastern daylight time, as appropriate.

§ 7.5 [Reserved]

§ 7.6 Schedule of U.S. process fees.

(a) The Office requires the following process fees:

(1) For certifying an international application based on a single basic application or registration, per class—\$100.00

(2) For certifying an international application based on more than one basic application or registration, per class—\$150.00

(3) For transmitting a subsequent designation under § 7.21—\$100.00

(4) For transmitting a request to record an assignment or restriction, or release of a restriction, under § 7.23 or § 7.24—\$100.00

(5) For filing a notice of replacement under § 7.28, per class—\$100.00

(6) For filing an affidavit under § 71 of the Act, per class—\$100.00

(7) Surcharge for filing an affidavit under § 71 of the Act during the grace period, per class—\$100.00

(b) The fees required in paragraph (a) of this section must be paid in U.S. dollars at the time of submission of the requested action. See § 2.207 of this chapter for acceptable forms of payment and § 2.208 of this chapter for payments using a deposit account established in the Office.

§ 7.7 Payments of fees to International Bureau.

(a) The following fees may be paid either directly to the International Bureau or through the Office:

(1) International application fees;
(2) Subsequent designation fees; and
(3) Recording fee for an assignment of an international registration under § 7.23.

(b) The fees in paragraph (a) of this section may be paid as follows:

(1)(i) Directly to the International Bureau by debit to a current account with the International Bureau. In this case, an applicant or holder's submission to the Office must include the International Bureau account number; or

(ii) Directly to the International Bureau using any other acceptable method of payment. In this case, an applicant or holder's submission to the Office must include the International Bureau receipt number for payment of the fees; or

(2) Through the Office. Fees paid through the Office must be paid in U.S. dollars at the time of submission. See § 2.207 of this chapter for acceptable forms of payment and § 2.208 of this chapter for payments using a deposit account established in the Office.

(c) The International Bureau fee calculator may be viewed on the Web site of the World Intellectual Property Organization, currently available at: <http://www.wipo.int/madrid/en/>.

Subpart B—International Application Originating From the United States

§ 7.11 Requirements for international application originating from the United States.

(a) The Office will grant a date of receipt to an international application that is submitted through TEAS and contains all of the following:

(1) The filing date and serial number of the basic application and/or the registration date and registration number of the basic registration;

(2) The name of the international applicant that is identical to the name of the applicant or registrant as it appears in the basic application or basic registration and applicant's current address;

(3) A reproduction of the mark that is the same as the mark in the basic application and/or registration and meets the requirements of § 2.52 of this chapter. If the mark in the basic application and/or registration is depicted in black and white and the basic application or registration does not include a color claim, the reproduction of the mark in the international application must be black and white. If the mark in the basic application or registration is depicted in black and white and includes a color claim, the international application

must include both a black and white reproduction of the mark and a color reproduction of the mark. If the mark in the basic application and/or registration is depicted in color, the reproduction of the mark in the international application must be in color;

(4) A color claim as set out in § 7.12, if appropriate;

(5) A description of the mark that is the same as the description of the mark in the basic application or registration, as appropriate;

(6) An indication of the type of mark if the mark in the basic application and/or registration is a three-dimensional mark, a sound mark, a collective mark or a certification mark;

(7) A list of the goods and/or services that is identical to or narrower than the list of goods and/or services in each claimed basic application or registration and classified according to the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*;

(8) A list of the designated Contracting Parties. If the goods and/or services in the international application are not the same for each designated Contracting Party, the application must list the goods and/or services in the international application that pertain to each designated Contracting Party;

(9) The certification fee required by § 7.6, the international application fees for all classes, and the fees for all designated Contracting Parties identified in the international application (see § 7.7);

(10) A statement that the applicant is entitled to file an international application in the Office, specifying that applicant: Is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where an applicant's address is not in the United States, the applicant must provide the address of its U.S. domicile or establishment; and

(11) An e-mail address for receipt of correspondence from the Office.

(b) For requirements for certification, see § 7.13.

§ 7.12 Claim of color.

(a) If color is claimed as a feature of the mark in the basic application and/or registration, the international application must include a statement that color is claimed as a feature of the mark and set forth the same name(s) of the color(s) claimed in the basic application and/or registration.

(b) If color is not claimed as a feature of the mark in the basic application and/

or registration, color may not be claimed as a feature of the mark in the international application.

§ 7.13 Certification of international application.

(a) When an international application contains all the elements set forth in § 7.11(a), the Office will certify to the International Bureau that the information contained in the international application corresponds to the information contained in the basic application(s) and/or basic registration(s) at the time of certification, and will then forward the international application to the International Bureau.

(b) When an international application does not meet the requirements of § 7.11(a), the Office will not certify or forward the international application. If the international applicant paid the international application fees (see § 7.7) through the Office, the Office will refund the international fees. The Office will not refund the certification fee.

§ 7.14 Correcting irregularities in international application.

(a) *Response period.* Upon receipt of a notice of irregularities in an international application from the International Bureau, the applicant must respond to the International Bureau within the period set forth in the notice.

(b) *Classification and Identification of Goods and Services.* Responses to International Bureau notices of irregularities in the classification or identification of goods or services in an international application must be submitted through the Office for forwarding to the International Bureau. The Office will review an applicant's response to a notice of irregularities in the identification of goods or services to ensure that the response does not identify goods or services that are broader than the scope of the goods or services in the basic application or registration.

(c) *Fees.* If the International Bureau notice of irregularities requires the payment of fees, the fees for correcting irregularities in the international application must be paid directly to the International Bureau.

(d) *Other Irregularities Requiring Response from Applicant.* Except for responses to irregularities mentioned in paragraph (b) of this section and payment of fees for correcting irregularities mentioned in paragraph (c) of this section, all other responses may be submitted through the Office in accordance with § 7.14(e), or filed directly at the International Bureau. The Office will forward timely responses to

the International Bureau, but will not review the responses or respond to any irregularities on behalf of the international applicant.

(e) *Procedure for response.* An international applicant submitting a response to the International Bureau through the Office must use TEAS. To be considered timely, a response must be received by the International Bureau before the end of the response period set forth in the International Bureau notice. Receipt in the Office does not fulfill this requirement. Any response submitted through the Office for forwarding to the International Bureau should be submitted as soon as possible, but at least one month before the end of the response period in the International Bureau's notice. The Office will not process any response submitted to the Office after the IB response deadline.

Subpart C—Subsequent Designation Submitted Through the Office

§ 7.21 Subsequent designation.

(a) A subsequent designation may be filed directly with the International Bureau, or, if it meets the requirements of paragraph (b) of this section, submitted through the Office.

(b) The date of receipt in the Office of a subsequent designation is the date that the subsequent designation is submitted through TEAS, if it contains all of the following:

(1) The international registration number;

(2) The serial number of the U.S. application or registration number of the U.S. registration that formed the basis of the international registration;

(3) The name and address of the holder of the international registration;

(4) A statement that the holder is entitled to file a subsequent designation in the Office, specifying that holder: Is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where a holder's address is not in the United States, the holder must provide the address of its U.S. domicile or establishment;

(5) A list of goods and/or services that is identical to or narrower than the list of goods and/or services in the international registration;

(6) A list of the designated Contracting Parties. If the goods and/or services in the subsequent designation are not the same for each designated Contracting Party, the holder must list the goods and/or services covered by the subsequent designation that pertain to each designated Contracting Party;

(7) The U.S. transmittal fee required by § 7.6 and the subsequent designation fees (*see* § 7.7); and

(8) An e-mail address for receipt of correspondence from the Office.

(c) If the subsequent designation is accorded a date of receipt, the Office will then forward the subsequent designation to the International Bureau.

(d) If the subsequent designation fails to contain all the elements set forth in paragraph (b) of this section, the Office will not forward the subsequent designation to the International Bureau. The Office will notify the holder of the reason(s). If the holder paid the subsequent designation fees (*see* § 7.7) through the Office, the Office will refund the subsequent designation fees. The Office will not refund the transmittal fee.

(e) Correspondence to correct any irregularities in a subsequent designation must be made directly with the International Bureau.

Subpart D—Recording Changes to International Registration

§ 7.22 Recording changes to international registration.

Except as provided in §§ 7.23 and 7.24, requests to record changes to an international registration must be filed with the International Bureau. If a request to record an assignment or restriction of a holder's right of disposal of an international registration or the release of such a restriction meets the requirements of § 7.23 or 7.24, the Office will forward the request to the International Bureau. Section 10 of the Act and part 3 of this chapter are not applicable to assignments or restrictions of international registrations.

§ 7.23 Requests for recording assignments at the International Bureau.

A request to record an assignment of an international registration may be submitted through the Office for forwarding to the International Bureau only if the assignee cannot obtain the assignor's signature for the request to record the assignment.

(a) A request to record an assignment submitted through the Office must include all of the following:

(1) The international registration number;

(2) The name and address of the holder of the international registration;

(3) The name and address of the assignee of the international registration;

(4) A statement that the assignee: Is a national of the United States; has a domicile in the United States; or has a real and effective industrial or

commercial establishment in the United States. Where an assignee's address is not in the United States, the assignee must provide the address of its U.S. domicile or establishment;

(5) A statement that the assignee could not obtain the assignor's signature for the request to record the assignment;

(6) An indication that the assignment applies to the designation to the United States;

(7) A statement that the assignment applies to all the goods and/or services in the international registration, or if less, a list of the goods and/or services in the international registration that have been assigned that pertain to the designation to the United States; and

(8) The U.S. transmittal fee required by § 7.6 and the international fee required to record the assignment (*see* § 7.7).

(b) If a request to record an assignment contains all the elements set forth in paragraph (a) of this section, the Office will forward the request to the International Bureau. Forwarding the request to the International Bureau is not a determination by the Office of the validity of the assignment or the effect that the assignment has on the title of the international registration.

(c) If the request fails to contain all the elements set forth in paragraph (a) of this section, the Office will not forward the request to the International Bureau. The Office will notify the assignee(s) of the reason(s). If the assignee paid the fees to record the assignment (*see* § 7.7) through the Office, the Office will refund the recording fee. The Office will not refund the transmittal fee.

(d) Correspondence to correct any irregularities in a request to record an assignment must be made directly with the International Bureau.

§ 7.24 Requests to record security interest or other restriction of holder's rights of disposal or release of such restriction submitted through the Office.

(a) A party who obtained a security interest or other restriction of a holder's right to dispose of an international registration, or the release of such a restriction, may submit a request to record the restriction or release through the Office for forwarding to the International Bureau only if:

(1) The restriction or release:

(i) Is the result of a court order; or

(ii) Is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, and the signature of the holder cannot be obtained for the request to record the restriction or release;

(2) The party who obtained the restriction is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States; and

(3) The restriction or release applies to the holder's right to dispose of the international registration in the United States.

(b) A request to record a restriction or the release of a restriction must be submitted by the party who obtained the restriction of the holder's right of disposal and include all the following:

(1) The international registration number;

(2) The name and address of the holder of the international registration;

(3) The name and address of the party who obtained the restriction;

(4) A statement that the party who submitted the request: Is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where a party's address is not in the United States, the party must provide the address of its U.S. domicile or establishment;

(5) (i) A statement that the restriction is the result of a court order, or

(ii) Where the restriction is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, a statement that the signature of the holder of the international registration could not be obtained for the request to record the restriction or release of the restriction;

(6) A summary of the main facts concerning the restriction;

(7) An indication that the restriction, or the release of the restriction, of the holder's right of disposal of the international registration applies to the designation to the United States; and

(8) The U.S. transmittal fee required by § 7.6.

(c) If a request to record a restriction, or the release of a restriction, contains all the elements set forth in paragraph (b) of this section, the Office will forward the request to the International Bureau. Forwarding the request to the International Bureau is not a determination by the Office of the validity of the restriction, or its release, or the effect that the restriction has on the holder's right to dispose of the international registration.

(d) If the request fails to contain all the elements set forth in paragraph (b) of this section, the Office will not forward the request. The Office will notify the party who submitted the request of the reason(s). The Office will not refund the transmittal fee.

(e) Correspondence to correct any irregularities in a request to record a restriction of a holder's right to dispose of an international registration or the release of such a restriction must be made directly with the International Bureau.

Subpart E—Extension of Protection to the United States

§ 7.25 Sections of part 2 applicable to extension of protection.

(a) Except for §§ 2.130–2.131, 2.160–2.166, 2.168, 2.172, 2.173, 2.175, and 2.181–2.186, all sections in part 2 and all sections of part 10 of this chapter apply to a request for extension of protection of an international registration to the United States, including sections related to proceedings before the Trademark Trial and Appeal Board, unless stated otherwise.

(b) The Office will refer to a request for an extension of protection to the United States as an application under section 66(a) of the Act, and references to applications and registrations in part 2 of this chapter include extensions of protection to the United States.

(c) Upon registration in the United States under section 69 of the Act, an extension of protection to the United States is referred to as a registration, a registered extension of protection, or a section 66(a) registration.

§ 7.26 Filing date of extension of protection for purposes of examination in the Office.

(a) If a request for extension of protection of an international registration to the United States is made in an international application and the request includes a declaration of a bona fide intention to use the mark in commerce as set out in § 2.33(e) of this chapter, the filing date of the extension of protection to the United States is the international registration date.

(b) If a request for extension of protection of an international registration to the United States is made in a subsequent designation and the request includes a declaration of a bona fide intention to use the mark in commerce as set out in § 2.33(e), the filing date of the extension of protection to the United States is the date that the International Bureau records the subsequent designation.

§ 7.27 Priority claim of extension of protection for purposes of examination in the Office.

An extension of protection of an international registration to the United States is entitled to a claim of priority under section 67 of the Act if:

(a) The request for extension of protection contains a claim of priority;

(b) The request for extension of protection specifies the filing date, serial number and the country of the application that forms the basis for the claim of priority; and

(c) The date of the international registration or the date of recording of the subsequent designation at the International Bureau of the request for extension of protection to the United States is not later than six months after the filing date of the application that forms the basis for the claim of priority.

§ 7.28 Replacement of U.S. registration by registered extension of protection.

(a) A registered extension of protection affords the same rights as those afforded to a previously issued U.S. registration if:

(1) Both registrations are owned by the same person and identify the same mark; and

(2) All the goods and/or services listed in the U.S. registration are also listed in the registered extension of protection.

(b) The holder of an international registration with a registered extension of protection to the United States that meets the requirements of paragraph (a) of this section may file a request to note replacement of the U.S. registration with the extension of protection. If the request contains all of the following, the Office will take note of the replacement in its automated records:

(1) The serial number or registration number of the extension of protection;

(2) The registration number of the replaced U.S. registration; and

(3) The fee required by § 7.6.

(c) If the request to note replacement is denied, the Office will notify the holder of the reason(s) for refusal.

§ 7.29 Effect of replacement on U.S. registration.

A U.S. registration that has been replaced by a registered extension of protection under section 74 of the Act and § 7.28 will remain in force, unless cancelled, expired or surrendered, as long as:

(a) The owner of the replaced U.S. registration continues to file affidavits or declarations of use in commerce or excusable nonuse under section 8 of the Act; and

(b) The replaced U.S. registration is renewed under section 9 of the Act.

§ 7.30 Effect of cancellation or expiration of international registration.

When the International Bureau notifies the Office of the cancellation or expiration of an international registration, in whole or in part, the

Office shall cancel, in whole or in part, the corresponding pending or registered extension of protection to the United States. The date of cancellation of an extension of protection or relevant part shall be the date of cancellation or expiration of the corresponding international registration or relevant part.

§ 7.31 Requirements for transformation of an extension of protection to the United States into a U.S. application.

If the International Bureau cancels an international registration in whole or in part, under Article 6(4) of the Madrid Protocol, the holder of that international registration may file a request to transform the corresponding pending or registered extension of protection to the United States into an application under section 1 or 44 of the Act.

(a) The holder of the international registration must file a request for transformation through TEAS within three months of the date of cancellation of the international registration and include:

(1) The serial number or registration number of the extension of protection to the United States;

(2) The name and address of the holder of the international registration;

(3) The application filing fee for at least one class of goods or services required by § 2.6(a)(1) of this chapter; and

(4) An e-mail address for receipt of correspondence from the Office.

(b) If the request for transformation contains all the elements set forth in paragraph (a) of this section, the extension of protection shall be transformed into an application under section 1 and/or 44 of the Act and accorded the same filing date and the same priority that was accorded to the extension of protection.

(c) The application under section 1 and/or 44 of the Act that results from a transformed extension of protection will be examined under part 2 of this chapter.

(d) A request for transformation that fails to contain all the elements set forth in paragraph (a) of this section will not be accepted.

Subpart F—Affidavit Under Section 71 of the Act for Extension of Protection to the United States

§ 7.36 Affidavit or declaration of use in commerce or excusable nonuse required to avoid cancellation of an extension of protection to the United States.

(a) Subject to the provisions of section 71 of the Act, a registered extension of protection shall remain in force for the term of the international registration

upon which it is based unless the international registration expires or is cancelled under section 70 of the Act due to cancellation of the international registration by the International Bureau.

(b) During the following time periods, the holder of an international registration must file an affidavit or declaration of use or excusable nonuse, or the registered extension of protection will be cancelled under section 71 of the Act:

(1) On or after the fifth anniversary and no later than the sixth anniversary after the date of registration in the United States; and

(2) Within the six-month period preceding the end of each ten-year period after the date of registration in the United States, or the three-month grace period immediately following, with payment of the grace period surcharge required by section 71(a)(2)(B) of the Act and § 7.6.

§ 7.37 Requirements for a complete affidavit or declaration of use in commerce or excusable nonuse.

A complete affidavit or declaration under section 71 of the Act must:

(a) Be filed by the holder of the international registration within the period set forth in § 7.36(b);

(b) Include a statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 of this chapter by a person properly authorized to sign on behalf of the holder, attesting to the use in commerce or excusable nonuse of the mark within the period set forth in section 71 of the Act. The verified statement must be executed on or after the beginning of the filing period specified in § 7.36(b). A person who is properly authorized to sign on behalf of the holder is:

(1) A person with legal authority to bind the holder; or

(2) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the holder; or

(3) An attorney as defined in § 10.1(c) of this chapter who has an actual written or verbal power of attorney or an implied power of attorney from the holder.

(c) Include the U.S. registration number;

(d)(1) Include the fee required by § 7.6 for each class of goods or services that the affidavit or declaration covers;

(2) If the affidavit or declaration is filed during the grace period under section 71(a)(2)(B) of the Act, include the grace period surcharge per class required by § 7.6;

(3) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. If the required fee(s) are not submitted within the time period set out in the Office action and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;

(e)(1) Specify the goods or services for which the mark is in use in commerce, and/or the goods or services for which excusable nonuse is claimed under § 7.37(f)(2);

(2) Specify the goods or services being deleted from the registration, if the affidavit or declaration covers less than all the goods or services or less than all the classes in the registration;

(f)(1) State that the registered mark is in use in commerce on or in connection with the goods or services in the registration; or

(2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark; and

(g) Include a specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed under § 7.37(f)(2). The specimen must meet the requirements of § 2.56 of this chapter.

§ 7.38 Notice to holder of extension of protection.

The registration certificate for an extension of protection to the United States includes a notice of the requirement for filing the affidavit or declaration of use or excusable nonuse under section 71 of the Act. However, the affidavit or declaration must be filed within the time period required by section 71 of the Act regardless of whether this notice is received.

§ 7.39 Acknowledgment of receipt of affidavit or declaration of use in commerce or excusable nonuse.

(a) The Office will issue a notice that states an affidavit or declaration of use

in commerce or excusable nonuse is acceptable or if the affidavit or declaration is refused, an Office action that states the reason(s) for refusal.

(b) A Response to a refusal under paragraph (a) of this section must be filed within six months of the mailing date of the Office action, or before the end of the filing period set forth in section 71(a) of the Act, whichever is later. The Office will cancel the extension of protection if no response is filed within this time period.

§ 7.40 Petition to Director to review refusal.

(a) A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition to the Director, unless the examiner directs otherwise. See § 7.39(b) for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal of the affidavit or declaration, the holder may file a petition to the Director to review the examiner's action. The petition must be filed within six months of the mailing date of the action maintaining the refusal, or the Office will cancel the registration.

(c) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

Subpart G—Renewal of International Registration and Extension of Protection

§ 7.41 Renewal of international registration and extension of protection.

(a) Any request to renew an international registration and its extension of protection to the United States must be made at the International Bureau in accordance with Article 7 of the Madrid Protocol.

(b) A request to renew an international registration or extension of protection to the United States submitted through the Office will not be processed.

Dated: September 10, 2003.

James E. Rogan,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

Note: The following appendix will not appear in the Code of Federal Regulations.

BILLING CODE 3510-16-P

Trademark Standard Character Set

Character	DESCRIPTION
	space
!	exclamation mark
"	(double) quotation mark
#	number sign
\$	dollar sign
%	percent sign
&	ampersand
'	apostrophe,
(left parenthesis
)	right parenthesis
*	asterisk
+	plus sign
,	comma
-	minus sign, hyphen
.	period, decimal point
^	caret
/	slash, virgule, solidus
0	digit 0
1	digit 1
2	digit 2
3	digit 3
4	digit 4
5	digit 5
6	digit 6
7	digit 7
8	digit 8
9	digit 9
:	colon
;	semicolon
<	less-than sign
=	equal sign
>	greater-than sign
?	question mark
@	commercial at sign
A	capital A
B	capital B
C	capital C

Character	DESCRIPTION
D	capital D
E	capital E
F	capital F
G	capital G
H	capital H
I	capital I
J	capital J
K	capital K
L	capital L
M	capital M
N	capital N
O	capital O
P	capital P
Q	capital Q
R	capital R
S	capital S
T	capital T
U	capital U
V	capital V
W	capital W
X	capital X
Y	capital Y
Z	capital Z
[left square bracket
\	backslash, reverse solidus
]	right square bracket
^	spacing circumflex accent
_	spacing underscore, low line,
a	small a
b	small b
c	small c
d	small d
e	small e
f	small f
g	small g
h	small h
i	small i
j	small j
k	small k
l	small l
m	small m

Character	DESCRIPTION
n	small n
o	small o
p	small p
q	small q
r	small r
s	small s
t	small t
u	small u
v	small v
w	small w
x	small x
y	small y
z	small z
{	left brace (curly bracket)
}	right brace (curly bracket)
~	tilde accent
€	Euro
‘	low left rising single quote
ƒ	small italic f, function of,
”	low left rising double quote
...	low horizontal ellipsis
‰	per thousand (mille) sign
Š	capital S caron or hacek
‹	left single angle quote mark
Œ	capital OE ligature
Ž	
‘	left single quotation mark,
’	right single quote mark
“	left double quotation mark,
”	right double quote mark
–	en dash
—	em dash
ˆ	small spacing tilde accent
š	small s caron or hacek
›	right single angle quote mark
œ	small oe ligature
ž	
ÿ	capital Y dieresis or umlaut
¡	inverted exclamation mark
¢	cent sign
£	pound sterling sign

Character	DESCRIPTION
¤	general currency sign
¥	yen sign
§	section sign
¨	spacing dieresis or umlaut
ª	feminine ordinal indicator
¸	left (double) angle quote
°	degree sign
±	plus-or-minus sign
´	spacing acute accent
µ	micro sign
·	middle dot, centered dot
¸	spacing cedilla
º	masculine ordinal indicator
¸	right (double) angle quote
¿	inverted question mark
À	capital A grave
Á	capital A acute
Â	capital A circumflex
Ã	capital A tilde
Ä	capital A dieresis or umlaut
Å	capital A ring
Æ	capital AE ligature
Ç	capital C cedilla
È	capital E grave
É	capital E acute
Ê	capital E circumflex
Ë	capital E dieresis or umlaut
Ì	capital I grave
Í	capital I acute
Î	capital I circumflex
Ï	capital I dieresis or umlaut
Ð	capital ETH
Ñ	capital N tilde
Ò	capital O grave
Ó	capital O acute
Ô	capital O circumflex
Õ	capital O tilde
Ö	capital O dieresis or umlaut
×	multiplication sign
Ø	capital O slash
Ù	capital U grave

Character	DESCRIPTION
Ú	capital U acute
Û	capital U circumflex
Ü	capital U dieresis or umlaut
Ý	capital Y acute
Þ	capital THORN
ß	small sharp s, sz ligature
à	small a grave
á	small a acute
â	small a circumflex
ã	small a tilde
ä	small a dieresis or umlaut
å	small a ring
æ	small ae ligature
ç	small c cedilla
è	small e grave
é	small e acute
ê	small e circumflex
ë	small e dieresis or umlaut
ì	small i grave
í	small i acute
î	small i circumflex
ï	small i dieresis or umlaut
ð	small eth
ñ	small n tilde
ò	small o grave
ó	small o acute
ô	small o circumflex
õ	small o tilde
ö	small o dieresis or umlaut
÷	division sign
ø	small o slash
ù	small u grave
ú	small u acute
û	small u circumflex
ü	small u dieresis or umlaut
ý	small y acute
þ	small thorn
ÿ	small y dieresis or umlaut
Ā	Amacr - latin capital letter A with macron
ā	amacr - latin small letter a with macron
Ă	Acaron - latin capital letter A with caron (breve)

Character	DESCRIPTION
ă	acaron - latin small letter a with caron (breve)
Ȧ	Acedil - latin capital letter A with cedilla
ȧ	acedil - latin small letter a with cedilla
Ć	Cacute - latin capital letter C with acute
ć	cacute - latin small letter c with acute
Č	Ccaron - latin capital letter C with caron
č	ccaron - latin small letter c with caron
Ď	Dcaron - latin capital letter D with caron
Đ	Dstrok - latin capital letter D with stroke
đ	dstrok - latin small letter d with stroke
Ě	Emacr - latin capital letter E with macron
ě	emacr - latin small letter e with macron
É	Edot - latin capital letter E with dot above
é	edot - latin small letter e with dot above
Ě	Ecedil - latin capital letter E with cedilla
ę	ecedil - latin small letter e with cedilla
Ě	Ecaron - latin capital letter E with caron
ě	ecaron - latin small letter e with caron
Ĝ	Gcaron - latin capital letter G with caron (breve)
ĝ	gcaron - latin small letter e with caron (breve)
Ġ	Gcedil - latin capital letter G with cedilla
Ħ	gapos - latin small letter g with cedilla above
Ī	Imacr - latin capital letter I with macron
ī	imacr - latin small letter i with macron
Ĭ	Icedil - latin capital letter I with cedilla
ķ	Kcedil - latin capital letter K with cedilla
ķ	kcedil - latin small letter k with cedilla
Ĺ	Lacute - latin capital letter L with acute
ĺ	lacute - latin small letter l with acute
Ļ	Lcedil - latin capital letter L with cedilla
ļ	lcedil - latin small letter l with cedilla
Ł	Lstrok - latin capital letter L with stroke
ł	lstrok - latin small letter l with stroke
Ń	Nacute - latin capital letter N with acute
ń	nacute - latin small letter n with acute
Ņ	Ncedil - latin capital letter N with cedilla
ņ	ncedil - latin small letter n with cedilla
Ñ	Ncaron - latin capital letter N with caron
ñ	ncaron - latin small letter n with caron
Ō	Omacr - latin capital letter O with macron
ō	omacr - latin small letter o with macron

Character	DESCRIPTION
Ö	Odblac - latin capital letter O with double acute
ö	odblac - latin small letter o with double acute
Ŕ	Rcedil - latin capital letter R with cedilla
ř	rcedil - latin small letter r with cedilla
Ř	Rcaron - latin capital letter R with caron
ř	rcaron - latin small letter r with caron
Ś	Sacute - latin capital letter S with acute
ś	sacute - latin small letter s with acute
Ş	Scedil - latin capital letter S with cedilla
ş	scedil - latin small letter s with cedilla
Š	Scaron - latin capital letter S with caron
š	scaron - latin small letter s with caron
Ť	Tcedil - latin capital letter T with cedilla
ť	tcedil - latin small letter t with cedilla
Ť	Tcaron - latin capital letter T with caron
ť	tcaron - latin small letter t with caron
Ū	Umacr - latin capital letter U with macron
ū	umacr - latin small letter u with macron
Ů	Uring - latin capital letter U with ring above
ů	uring - latin small letter u with ring above
Ü	Udblac - latin capital letter U with double acute
ü	udblac - latin small letter u with double acute
Ů	Ucedil - latin capital letter U with cedilla
ů	ucedil - latin small letter u with cedilla
Ź	Zacute - latin capital letter Z with acute
ź	zacute - latin small letter z with acute
Ž	Zdot - latin capital letter Z with dot above
ž	zdot - latin small letter z with dot above
Ž	Zcaron - latin capital letter Z with caron
ž	zcaron - latin small letter z with caron