

**§6.3**

Class	Title
34	Heating, lighting, and ventilating apparatus.
35	Belting, hose, machinery packing, and nonmetallic tires.
36	Musical instruments and supplies.
37	Paper and stationery.
38	Prints and publications.
39	Clothing.
40	Fancy goods, furnishings, and notions.
41	Canes, parasols, and umbrellas.
42	Knitted, netted, and textile fabrics, and substitutes therefor.
43	Thread and yarn.
44	Dental, medical, and surgical appliances.
45	Soft drinks and carbonated waters.
46	Foods and ingredients of foods.
47	Wines.
48	Malt beverages and liquors.
49	Distilled alcoholic liquors.
50	Merchandise not otherwise classified.
51	Cosmetics and toilet preparations.
52	Detergents and soaps.
SERVICES	
100	Miscellaneous.
101	Advertising and business.
102	Insurance and financial.
103	Construction and repair.
104	Communication.
105	Transportation and storage.
106	Material treatment.
107	Education and entertainment.

[24 FR 10383, Dec. 22, 1959. Redesignated at 38 FR 14681, June 4, 1973]

**§6.3 Schedule for certification marks.**

In applications for registration of certification marks based on sections 1 and 44 of the Trademark Act and registrations resulting from such applications, goods and services are classified in two classes as follows:

- A. Goods.
- B. Services.

[73 FR 67775, Nov. 15, 2008]

**§6.4 Schedule for collective membership marks.**

All collective membership marks in applications based on sections 1 and 44 of the Trademark Act and registrations resulting from such applications are classified as follows:

Class	Title
200 .....	Collective Membership.

[73 FR 67775, Nov. 17, 2008]

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

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- 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.

SOURCE: 68 FR 55769, Sept. 26, 2003, 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](http://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.

(a) *Correspondence Filed Through TEAS.* 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.

(b) *Correspondence Filed By Mail.* International applications under § 7.11, subsequent designations under § 7.21, responses to notices of irregularity under § 7.14, requests to record changes in the International Register under § 7.23 and § 7.24, requests to note replacement under § 7.28, requests for transformation under § 7.31, and petitions to the Director to review an action of the Office's Madrid Processing Unit, when filed by mail, must be addressed to: Madrid Processing Unit, 600 Dulany Street, MDE-7B87, Alexandria, VA 22314-5793.

(1) International applications under § 7.11, subsequent designations under § 7.21, requests to record changes in the International Register under § 7.23 and § 7.24, and petitions to the Director to review an action of the Office's Madrid Processing Unit, when filed by mail, will be accorded the date of receipt in the Office, unless they are sent by Express Mail pursuant to § 2.198 of this title, in which case they will be accorded the date of deposit with the United States Postal Service.

(2) Responses to notices of irregularity under § 7.14, requests to note replacement under § 7.28, and requests for transformation under § 7.31, when filed by mail, will be accorded the date of receipt in the Office.

(c) *Hand-Delivered Correspondence.* International applications under § 7.11, subsequent designations under § 7.21, responses to notices of irregularity under § 7.14, requests to record changes in the International Register under §§ 7.23 and 7.24, requests to note replacement under § 7.28, requests for

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transformation under § 7.31, and petitions to the Director to review an action of the Office's Madrid Processing Unit, may be delivered by hand during the hours the Office is open to receive correspondence. Madrid-related hand-delivered correspondence must be delivered to the Trademark Assistance Center, James Madison Building—East Wing, Concourse Level, 600 Dulany Street, Alexandria, VA 22314, Attention: MPU.

(d) *Facsimile Transmission Not Permitted.* The following documents may not be sent by facsimile transmission, and will not be accorded a date of receipt if sent by facsimile transmission:

- (1) International applications under § 7.11;
- (2) Subsequent designations under § 7.21;
- (3) Responses to notices of irregularity under § 7.14;
- (4) Requests to record changes of ownership under § 7.23;
- (5) Requests to record restrictions of the holder's right of disposal, or the release of such restrictions, under § 7.24; and
- (6) Requests for transformation under § 7.31.

(e) *Certificate of Mailing or Transmission Procedure Does Not Apply.* The certificate of mailing or transmission procedure provided in § 2.197 does not apply to the documents specified in paragraph (d) of this section.

[69 FR 57185, Sept. 24, 2004, as amended at 69 FR 63321, Nov. 1, 2004; 72 FR 18908, Apr. 16, 2007]

## § 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

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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) For documents filed through TEAS, 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) All fees for paper filings must be paid directly to the International Bureau.

(d) 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/>.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57185, Sept. 24, 2004]

### 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 either filed through TEAS, or typed on the official paper form issued by the International Bureau. The international application must include 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 and entity of the international applicant that is identical to the name and entity of the applicant or registrant in the basic application or basic registration, and the 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 that meets the requirements of § 2.52 of this title.

(i) 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.

(ii) 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.

(iii) 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.

(iv) If the international application is filed on paper, the mark must be no more than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide, and must appear in the box designated by the Inter-

national Bureau on the International Bureau's official form;

(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;

(10) If the application is filed through TEAS, the international application fees for all classes, and the fees for all designated Contracting Parties identified in the international application (see § 7.7);

(11) 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

(12) If the international application is filed through TEAS, an e-mail address for receipt of correspondence from the Office.

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

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57185, Sept. 24, 2004; 73 FR 67775, Nov. 17, 2008]

### § 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

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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.* 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's 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 received in the Office after the International Bureau's response deadline.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004; 73 FR 67776, Nov. 17, 2008]

## 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 Office will grant a date of receipt to a subsequent designation that is either filed through TEAS, or typed on the official paper form issued by the International Bureau. The subsequent designation must contain 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;

(8) If the subsequent designation is filed through TEAS, the subsequent designation fees (*see* § 7.7); and

(9) If the subsequent designation is filed through TEAS, 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 des-

ignation 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.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004]

### 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.

(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.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004]

**§ 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 §§ 2.22–2.23, 2.130–2.131, 2.160–2.166, 2.168, 2.173, and 2.181–2.186, all sections in parts 2, 10, and 11 of this chapter shall apply to an extension of protection of an international registration to the United States, including sections related to proceedings before the Trademark Trial and Appeal Board, unless otherwise stated.

(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.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004; 70 FR 38774, July 6, 2005; 73 FR 47686, Aug. 14, 2008; 73 FR 67776, Nov. 17, 2008]

#### § 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 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.

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004]

**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 § 11.1 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

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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.

[68 FR 55769, Sept. 26, 2003, as amended at 73 FR 47686, Aug. 14, 2008]

### § 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 date of issuance 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 exten-

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sion of protection if no response is filed within this time period.

[68 FR 55769, Sept. 26, 2003, as amended at 73 FR 67776, Nov. 17, 2008]

### § 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 date of issuance 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.

[68 FR 55769, Sept. 26, 2003, as amended at 73 FR 67776, Nov. 17, 2008]

## 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.

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EDITORIAL NOTE: This listing is provided for information purposes only. It is compiled and kept up-to-date by the Department of Commerce. This index is updated as of July 1, 2009.

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