

Chapter 1900

Madrid Protocol

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The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("Madrid Protocol") is an international treaty that allows a trademark owner to seek registration in any of the countries or intergovernmental organizations that have joined the Madrid Protocol by submitting a single application, called an international application. The international registration system is administered by the International Bureau ("IB") of the World Intellectual Property Organization ("WIPO"), in Geneva, Switzerland.

The Madrid Protocol became effective in the United States on November 2, 2003. The Madrid Protocol Implementation Act of 2002, Pub. L. 107-273, 116 Stat. 1758, 1913-1921 ("MPIA") amended the Trademark Act to provide that: (1) the owner of a United States application and/or registration may seek protection of its mark in any of the countries or intergovernmental organizations party to the Madrid Protocol by submitting a single international application to the IB through the United States Patent and Trademark Office ("USPTO"); and (2) the holder of an international registration may request an extension of protection of the international registration to the United States. A notice of final rulemaking amending the Trademark Rules of Practice to incorporate the MPIA was published at [68 Fed. Reg. 55748 \(Sept. 26, 2003\)](#).

The Madrid Protocol, *Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement* ("Common Regs."), *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol* ("Guide to International Registration"), *Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto* ("Admin. Instrs.") are available on the IB's website, at <http://www.wipo.int/madrid/en/>. The Common Regs. are the procedures agreed to by the parties to the Madrid Protocol regarding the

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

References below to the Common Regs., *Guide to the International Registration*, and Admin. Instrs. refer to the September 2008 editions.

1901 Overview of the Madrid System of International Registration

The Madrid system of international registration is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and the Protocol Relating to the Madrid Agreement, which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996. The United States is party only to the Protocol, not to the Agreement.

The Madrid system is administered by the IB. 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 industrial or commercial establishment in one of the countries or intergovernmental organizations that are members of the Protocol (“Contracting Parties”). The application must be based on one or more trademark application(s) filed in, or registration(s) issued by, the trademark office of one of the Contracting Parties (“basic application(s)” or “basic registration(s)”). The international application must be for the same mark and include a list of goods/services that is identical to or narrower than the list of goods/services in the basic application and/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 applicant must submit the international application through the trademark office of the Contracting Party in which the basic application and/or 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 and/or registration, and then forward the international application to the IB. If the IB receives the international application within two months of the date of receipt in the Office of Origin, the date of the international registration is the date of receipt in the Office of Origin. If the IB does not receive the international application within two months of the date it was received by the Office of Origin, the date of the international registration is the date on which the international application is received by the IB. See TMEP §1902.04 for information regarding filing requirements that may affect the international registration date.

The international registration is dependent on the basic application and/or registration for five years from the international registration date. If the basic application and/or registration is abandoned, cancelled, or expired, in whole

or in part, during this five-year period, the IB will cancel the international registration accordingly. See TMEP §1902.09 for further information.

The holder of an international registration may request protection in additional Contracting Parties by submitting a subsequent designation. A subsequent designation is a request by the holder of an international registration for an extension of protection of the 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 trademark application under its domestic laws. Under Article 5 and Common Regs. 16 and 17, there are strict time limits (a maximum of 18 months) for the trademark office of a Contracting Party to refuse a request for extension of protection. If the Contracting Party does not notify the IB of a refusal within this time period, the mark is automatically protected. However, the extension of protection may be invalidated in accordance with the same procedures for invalidating a national registration, e.g., by cancellation.

The Madrid Protocol may apply to the USPTO in three ways:

- *Office of Origin.* The USPTO is the Office of Origin if an international application and/or registration is based on an application pending in or a registration issued by the USPTO. Common Reg. 1(xxvi). See TMEP §§1902 *et seq.*
- *Office of a Designated Contracting Party.* The USPTO is the office of a designated Contracting Party if the holder of an international registration requests an extension of protection of that registration to the United States. Common Regs. 1(xvi) and (xxv). See TMEP §§1904 *et seq.*
- *Office of the Contracting Party of the Holder.* If the holder of an 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 can file certain requests with the IB through the USPTO, such as requests to record changes of ownership (see TMEP §1906.01(a)(i)) and restrictions on the holder's right to dispose of an international registration (see TMEP §1906.01(b)). The expression "Contracting Party of the Holder" includes the "Office of Origin," as well as any other Contracting Party in which a holder is a national, is domiciled, or has a real and effective industrial or commercial establishment. Common Reg. 1(xxvi^{bis}).

1902 International Application Originating From the United States

This section covers international applications and registrations *originating from* the United States, i.e., international registrations based on an application

pending in the USPTO and/or a registration issued by the USPTO. See TMEP §§1904 *et seq.* for information about requests for extension of protection to the United States by the holder of an international registration originating in another country. International applications originating from the United States are processed by the USPTO's Madrid Processing Unit ("MPU").

1902.01 Who Can File

Under 15 U.S.C. §1141a and Article 2(1), a qualified owner of a basic application pending in the USPTO or a qualified owner of a basic registration issued by the USPTO may file an application for international registration through the USPTO. To qualify, the international applicant must:

- (1) Be a national of the United States;
- (2) Be domiciled in the United States; or
- (3) Have a real and effective industrial or commercial establishment in the United States.

If joint applicants file, each applicant must meet at least one of these requirements. Common Reg. 8(2).

1902.02 Minimum Requirements for Date of Receipt of International Application in USPTO

The minimum requirements for accordancy of a date of receipt of an international application in the USPTO are set forth in 37 C.F.R. §7.11.

§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 International 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.

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

1902.02(a) Form of International Application

Trademark Rule 7.11(a), 37 C.F.R. §7.11(a), requires that an international application be filed either through the Trademark Electronic Application System (“TEAS”), or on the official paper form issued by the IB.

TEAS Form

TEAS will require the applicant to select between two different forms, a prepopulated form or a free-text form. The applicant should use the prepopulated 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;
- Changing the classification;
- Changing the applicant’s address; and/or
- Attaching a color reproduction of the mark where the mark in the basic application or registration is in black and white with a color claim (see TMEP §§1902.02(d) and 1902.02 (e)).

The prepopulated form will automatically display the exact information that is in the USPTO database for one specific U.S. serial number or registration number. However, if the international application is based on a newly filed application that has not yet been uploaded into the USPTO’s automated records, the TEAS form will instruct the applicant to either wait for the USPTO to upload the data or use the free-text form. It normally takes 48 to 72 hours for the USPTO to upload a newly filed application. To determine whether the basic application data has been entered, the applicant should check the Trademark Applications and Registrations Retrieval (“TARR”) database on the USPTO website at: <http://tarr.uspto.gov>.

The applicant should use the free-text form if the applicant wishes to change other data in the international application, or if the international application is based on more than one basic application and/or registration.

Paper Form

When filing on paper, applicants must submit the official international application form issued by the IB, the MM2 form, to the USPTO. This form is available on the IB website at <http://www.wipo.int/madrid/en/>. The IB will not accept paper applications that are not presented on the official IB form. Article 3(1); Common Regs. 9(2)(a) and 11(4)(a)(i); Madrid Admin. Instr. §2. The form cannot be handwritten. Madrid Admin. Instr. §6(a). The applicant should complete the MM2 form online, print the completed form, and submit it to the USPTO by mail.

The applicant may mail the completed paper application form to the following address, using the First Class Mail Service of the United States Postal Service ("USPS"):

Madrid Processing Unit
600 Dulany Street
MDE-7B87
Alexandria, Virginia 22314-5793

37 C.F.R. §§2.190(e) and 7.4(b). Alternatively, the international applicant may deliver the application by hand or courier to the Trademark Assistance Center ("TAC"), at James Madison Building, East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. 37 C.F.R. §7.4(c). TAC is open 8:30 a.m. to 5:00 p.m., Eastern Time, Monday through Friday, except on Federal holidays within the District of Columbia.

If an international application is mailed to the USPTO via the Express Mail Service of the USPS, the USPTO will deem that the application was received in the USPTO on the day it was deposited with the USPS, provided that the applicant complies with the requirements of 37 C.F.R. §2.198 for correspondence sent by Express Mail. See TMEP §305.03 regarding Express Mail. The certificate of mailing or transmission procedures of 37 C.F.R. §2.197 do not apply to international applications. 37 C.F.R. §§2.197(a)(2)(ii) and 7.4(e).

The IB's *Guide to International Registration* contains instructions for completing the international application form.

The applicant should include a self-addressed, stamped postcard with the international application. Upon receipt of the international application, the USPTO will place a control number and a label indicating the receipt date on the documents and return the postcard to the applicant. The applicant should reference the control number whenever contacting the USPTO about the application.

International applications cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(1).

1902.02(b) Basic Application or Registration Number

The international application must include the filing date and serial number of the basic application, or the registration date and registration number of the basic registration. 37 C.F.R. §7.11(a)(1). The USPTO will not certify the international application if this information is incorrect or is omitted.

The international application must be based on an active application and/or registration. It cannot be based on an abandoned application, or on a cancelled or expired registration.

An international application may be based on multiple basic applications and/or basic registrations. The relevant dates and numbers of each application and/or registration must be included. The USPTO will not certify the international application if any of this information is incorrect or is omitted.

If a basic application and/or registration has been divided, each serial number and/or registration number must be identified. See TMEP §§1110 *et seq.* regarding division of U.S. applications and TMEP §§1615 *et seq.* regarding division of U.S. registrations.

1902.02(c) Name and Address of Applicant

Only the owner of the basic application and/or registration can file an international application. 15 U.S.C. §1141a(a). The international application must include the name and current address of the applicant. The name and entity of the international applicant must be identical to the name and entity of the applicant/registrant in the basic application and/or registration. 37 C.F.R. §7.11(a)(2).

On the prepopulated TEAS form, the applicant's name cannot be changed, so the international applicant's name will always be identical to the name of the owner of record for the basic application and/or registration.

When the applicant submits a paper form or a free-text TEAS form, an MPU trademark specialist will check the Trademark Reporting and Monitoring ("TRAM") System to verify that the name of the international applicant is identical to the name of the owner of the basic application and/or registration.

If the names are not identical, the trademark specialist will check the Assignment Services Branch's database to determine whether an assignment or other document affecting title that is not reflected in TRAM has been recorded. If assignment records do not show a clear chain of title to the international applicant, the USPTO will notify the applicant that the application cannot be certified. If the records of the Assignment Services Branch do show a clear chain of title, the trademark specialist will update the "Ownership" field in TRAM.

Because a delay in certifying and forwarding an international application to the IB may affect the date of the international registration, any request to record a change in ownership of a U.S. basic application and/or registration should be filed well in advance of the filing of the international application, to allow sufficient processing time. The USPTO strongly recommends use of the Electronic Trademark Assignment System ("ETAS"), at <http://etas.uspto.gov>. Assignments filed electronically are recorded much faster than assignments filed on paper. If there is an unrecorded change in ownership, and the international applicant does not use ETAS to record the change, the USPTO may be unable to certify or forward the international application to the IB within two months after the application is received in the

USPTO. In this situation, the date of the international registration will be the date of receipt of the application in the IB. See TMEP §1902.04.

Applicants can search the Assignment Services Branch's database at <http://assignments.uspto.gov/assignments/> to determine whether an assignment or other document of title has been recorded, and can search the TARR database at <http://tarr.uspto.gov/> to determine whether the ownership information in the Trademark databases has been updated. See TMEP §§504 *et seq.* regarding automatic updating of ownership information in the TRAM and TARR databases.

If an international applicant is relying on an assignment (or other document transferring title) that has recently been filed for recordation but has not yet been recorded by the Assignment Services Branch, the applicant should include a copy of the assignment with the international application.

If an international application is denied certification because the applicant is not the same party as the owner named in the basic application(s) and/or registration(s), the applicant may petition the Director to review the refusal to certify. See TMEP §1902.03(a) regarding petitions to review refusal to certify.

1902.02(d) Reproduction (Drawing) of Mark

An international application must include a reproduction of the mark that (1) is the same as the mark in the basic application and/or registration; and (2) meets the requirements of 37 C.F.R. §2.52. 37 C.F.R. §7.11(a)(3).

For paper filers, the mark must appear no larger than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide and must be placed in the box designated by the IB on the MM2 form. 37 C.F.R. §§2.52(d) and 2.54(b); Common Reg. 9(4)(a)(v); *Guide to International Registration*, Paras. B.II.14.01 *et seq.* For international applications filed electronically, an image of the mark taken from TRAM will appear automatically on the prepopulated TEAS form. If an applicant uses the free-text TEAS form, the applicant must either type the mark in the appropriate field, or attach a digitized image of the mark that meets the requirements of 37 C.F.R. §2.53(c).

Standard Character Reproductions. If the mark in the basic application and/or registration is in standard characters, the reproduction of the mark in the international application must be in standard characters. To claim standard characters, an applicant must check the appropriate box on the IB's official application form MM2, or on the TEAS form. The applicant may not claim standard characters in the international application unless the mark in the basic application and/or registration is in standard character (or typed) format. See TMEP §§807.03 *et seq.* for information about standard character drawings in applications for registration of marks in the United States. The USPTO's standard character chart is posted on the USPTO website at <http://teas.uspto.gov/standardCharacterSet.html>.

Special Form Reproductions. If the mark in the basic application or registration is in special form, the reproduction of the mark in the international application must be in special form. See TMEP §807.04(a) for characteristics of special form drawings in applications for registration of marks in the United States.

Use of Color. 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. See TMEP §1902.02(e) regarding color claims. 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. If the mark in the basic application or registration is depicted in black and white, and the basic application or registration 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 that meet the requirements of 37 C.F.R. §2.52, 37 C.F.R. §7.11(a)(3); Common Reg. 9(4)(a)(vii). For example, if the basic application and/or registration includes a color claim and a black-and-white drawing that depicts the color by the use of color lining or by a statement describing the color (see Note in TMEP §1902.02(e) regarding color drawings in United States basic applications or registrations), the applicant must include *both* a color reproduction of the mark showing the claimed colors and a black-and-white reproduction of the mark that corresponds to the mark as it appears in the basic application and/or registration. See the note regarding color drawings in United States basic applications or registrations in TMEP §1902.02(e). If filing on paper, the applicant must place the drawings in the appropriate boxes designated by the IB on the MM2 form. If using the TEAS prepopulated form, the black-and-white drawing will automatically prepopulate the form, and the applicant must attach the color reproduction of the mark. For the TEAS free-text form, however, the applicant must attach a digitized image of *both* the black-and-white reproduction of the mark and the color reproduction of the mark. See TMEP §§807 *et seq.* for general information about the requirements for drawings in applications for registration of marks in the United States.

1902.02(e) Color Claim

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. 37 C.F.R. §§7.11(a)(4) and 7.12(a).

If the basic application and/or registration includes a black-and-white reproduction of the mark with a description of the mark indicating that color is used on the mark, or a reproduction that is lined for color (see Note below), the USPTO will presume that color is a feature of the mark, unless the basic

application and/or registration includes a statement that “no claim is made to color” or “color is not a feature of the mark.” Thus, the basic application and/or registration will be presumed to have a color claim.

If color is not claimed as a feature of the mark in the basic application and/or registration, an applicant may not claim color as a feature of the mark in the international application. 37 C.F.R. §7.12(b).

Note Regarding Color Drawings in United States Basic Applications or Registrations: Prior to November 2, 2003, the USPTO did not accept color drawings. An applicant who wanted to show color in a mark had to submit a black-and-white drawing, with a statement identifying the color(s) and describing where it/they appeared in the mark. Alternatively, the applicant could submit a black-and-white drawing that showed color by using a lining system that previously appeared in 37 C.F.R. §2.52 but was deleted from the rule effective October 30, 1999. See notice at [64 Fed. Reg. 48900](#), 48903 (Sept. 8, 1999) and 1226 TMOG 103, 106 (Sept. 28, 1999). It was presumed that color was claimed as a feature of the mark, unless the applicant specifically stated that no claim was made to color, or that color was not claimed as a feature of the mark. The USPTO began accepting color drawings on November 2, 2003. Effective November 2, 2003, the USPTO no longer accepts black-and-white drawings with a color claim, or drawings that show color by use of lining patterns. 37 C.F.R. §2.52(b)(1). See TMEP §§807.07 et seq. regarding the current color requirements.

1902.02(f) Identification of Goods/Services

An international application must include a list of goods/services that is identical to or narrower than the goods/services in the basic application and/or registration. 37 C.F.R. §7.11(a)(7). If the applicant makes any change that broadens the scope of the identification of goods/services, the USPTO will not certify the international application.

The prepopulated TEAS form will include the listing of goods/services in the USPTO's electronic records for the basic application or registration as of the time the form is generated. An applicant may edit the list of goods/services by either deleting particular goods/services or revising the wording in the identification. On the MM2 paper form and the free-text TEAS form, the applicant must enter the goods/services manually and may omit goods or services, or revise the wording in the identification.

If the list of goods/services in an international application is not identical to the list of goods/services in the basic application and/or registration at the time the international application is reviewed, the MPU trademark specialist must determine whether the applicant has identified any goods/services that are broader than the goods/services covered in the basic application and/or registration.

When the MPU trademark specialist reviews an international application based on a basic application and/or registration that has been amended during the course of its examination, the list of goods/services in the international application must be within the scope of the goods/services in the basic application and/or registration as amended, and not as set forth in the original basic application and/or registration.

1902.02(g) Classification in International Applications

The goods/services should be classified according to the version of the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks* (“Nice Agreement”) that is in effect as of the filing date of the international application. 37 C.F.R. §7.11(a)(7). Both the prepopulated and the free-text TEAS forms will allow an applicant to change the classification of goods/services in an international application.

The MPU does not certify classification of the goods/services in an international application. Therefore, the owner of the United States application or registration need not classify the goods/services in the international application in the same class(es) in which they are classified in the United States basic application and/or registration. However, failure to properly classify goods or services in an international application according to the international classification system will result in an IB notice of irregularity. Because the final decision on the classification of the goods/services in an international application rests with the IB, the USPTO will not reclassify or give advice in response to specific inquiries regarding the reclassification of particular goods/services. The IB provides guidance on its website, at <http://www.wipo.int/classifications/en/>. See TMEP §§1401.02 *et seq.* for further information about the international classes, and TMEP §§1902.07 *et seq.* for further information about irregularities in the international application.

1902.02(g)(i) Reclassifying Goods/Services

If the goods or services in the basic application and/or registration are classified under the old U.S. classification system (see TMEP §1401.02), it is advisable to reclassify the goods/services into international classes in the international application, to avoid issuance of a notice of irregularity by the IB. Applicants using the prepopulated TEAS form must reclassify such goods/services into international classes because the form does not recognize U.S. class designations.

See TMEP §1902.02(g)(ii) regarding reclassification of goods/services in U.S. Classes A, B, or 200.

It is also advisable to reclassify the goods when the identification of goods in the basic application and/or registration comprises kits or gift baskets. See TMEP §1902.02(g)(iii) for further information.

1902.02(g)(ii) United States Classes A, B and 200

Classes A, B, and 200 are classes from the old United States classification system that are still used in the United States to classify certification marks for goods (Class A), certification marks for services (Class B), and collective membership marks (Class 200). These classes are not included in the international classes under the Nice Agreement. Therefore, an international application based on a U.S. application or registration in U.S. Classes A, B, or 200 should be reclassified based on the nature of the goods or services being certified or the area of activity of the members of the collective. If the applicant does not reclassify its goods or services into the proper international class, the IB will issue a notice of irregularity.

Amendment of the classification in the corresponding basic U.S. application and/or registration is not permitted.

United States Classes A and B

It has been the longstanding practice in the United States to accept identifications of goods or services for Classes A, B, and 200 that are broader than those that would be accepted in applications for goods/services in other classes. See TMEP §§1304.08(d) and 1306.06(e). In many situations, it will be difficult to reclassify these broad identifications into appropriate international classes. For example, a goods certification mark in U.S. Class A for “remanufactured, refurbished and reconditioned electrical equipment” could include goods in International Classes 7, 9, and/or 11, and possibly others. In such situations, the U.S. applicant should specify the type of electrical equipment that is being certified, and either apply and pay the fees for all appropriate classes, or limit the specification of “electric equipment” to cover goods in one class only.

In some certification mark applications/registrations, the goods/services will be easily classified in one class of the international classification system. For example, a services certification mark for “testing laboratory and calibration laboratory accreditation services” would be classified in International Class 42. However, it is important to be aware that multiple classes may be required when reclassifying goods/services from U.S. Classes A and B.

United States Class 200

Class 200 presents a similar problem and a similar solution. A broad identification of the subject organization in a collective membership mark application or registration is difficult to reclassify. For example, the wording “indicating membership in a conservative youth organization” is too broad and

vague for classification in an international class. On the other hand, “indicating membership in an organization of consulting communications engineers” is easily classified in International Class 42. As with the certification marks, an applicant may have to clarify, specify, or narrow the description of the organization in the international application in order to classify the organization in an international class.

1902.02(g)(iii) Kits and Gift Baskets

The USPTO policy regarding the identification and classification of kits and gift baskets differs from the policy of the IB regarding the classification of these goods.

The USPTO permits registration of a kit or gift basket in a single international class, even if the identification of goods lists items that are classified in other classes. The IB and most foreign countries will not accept an identification of goods in a particular class that includes a reference to goods that are classified in other classes. If an international application includes kits and/or gift baskets, and the identification of goods refers to items classified in more than one class, the IB is likely to issue a notice of irregularity requiring the applicant to separate the goods into their respective classes and to pay additional fees for added classes. To avoid issuance of a notice of irregularity by the IB, an international applicant may wish to either narrow the identification to refer only to items in a single international class, or submit additional fees for multiple international classes.

1902.02(h) List of Contracting Parties

An international application must list at least one Contracting Party (i.e., country or intergovernmental organization party to the Madrid Protocol) to which the applicant seeks an extension of protection of the international registration. If the goods/services in the international application are not the same for all designated Contracting Parties, the application must include a list of the goods/services in the international application that pertain to each designated Contracting Party. 37 C.F.R. §7.11(a)(8).

An international applicant designating the European Community for an extension of protection may claim seniority of one or more earlier registrations in or for a Member State of the European Community for the same mark covering the same goods or services in the international application. Common Reg. 9(5)(g)(i). See TMEP §1902.05 for further information about “seniority.”

For international applications filed through TEAS, the online form enables applicants designating the European Community to claim seniority based upon registrations issued by Member States. The applicant must indicate: (1) the name of the Member State in or for which the earlier mark is

registered; (2) the date from which the registration was effective; (3) the registration number; and (4) the goods and/or services covered by the earlier registration. Common Reg. 9(5)(g)(i).

For international applications filed on paper using form MM2, a claim of seniority must be presented on the IB's official form, MM17, and annexed to the international application. Common Reg. 9(5)(g)(i). The applicant must complete both the MM2 and the MM17 forms, and mail them to the USPTO.

An international applicant may not designate the United States as a Contracting Party. 15 U.S.C. §1141e(b); Article 3^{bis}; TMEP §1904.01(h).

1902.02(i) Fees

USPTO Certification Fee. An international application must include the USPTO certification fee for each class of goods/services for which international registration is sought, or it will not be certified. The certification fee per class increases if the international application is based on more than one basic application or registration. 37 C.F.R. §§7.6(a) and 7.11(a)(9).

International Fees. If an international application is submitted through TEAS, the international fees for all classes and all designated Contracting Parties must be paid at the time of submission. 37 C.F.R. §7.11(a)(10). International fees for paper applications must be paid directly to the IB, and may be paid either before or after the international application is submitted to the USPTO. 37 C.F.R. §7.7(c). However, international fees paid after the IB receives the international application could result in a notice of irregularity issued by the IB (see TMEP §1902.07(b)(i)).

See *also* TMEP §1903.02 regarding payment of international fees.

1902.02(j) Statement of Entitlement

An international application must include a statement that the applicant is entitled to file an international application, specifying that the applicant: (1) is a national of the United States; (2) has a domicile in the United States; or (3) 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 the United States domicile or establishment. 15 U.S.C. §1141a; 37 C.F.R. §7.11(a)(11).

For joint applicants, the application must include a statement of entitlement for each applicant.

1902.02(k) Description of Mark

If the basic application or registration includes a description of the mark, an international application must include the same description. 37 C.F.R.

§7.11(a)(5). The applicant cannot include a description of the mark in the international application if the basic application or registration does not contain a description of the mark. *Guide to International Registration*, Para. B.II.15.07.

If an international application is based on more than one basic application and/or registration, any description of the mark must be the same in each basic application and/or registration. If the descriptions are not the same, certification will be denied. 37 C.F.R. §§7.11(a)(5) and 7.13(a).

If the basic application or registration has been amended during the course of its examination, the description in the international application must be identical to the description in the basic application or registration as amended, not as set forth in the original basic application or registration.

1902.02(l) Indication of Type of Mark

If the mark in the basic application or registration is a three-dimensional mark, a sound mark, a collective mark, or a certification mark, the international application must include an indication of the type of mark. 37 C.F.R. §7.11(a)(6). Such an indication may be given only if it appears in the basic application or registration. Common Regs. 9(4)(a)(viii)-(x).

1902.02(m) E-Mail Address

An international application must include an e-mail address for receipt of correspondence from the USPTO, if the international application is filed through TEAS. 37 C.F.R. §7.11(a)(12). Applicants submitting international applications on paper are encouraged to include an e-mail address on the form.

1902.03 Certification of International Application by USPTO

If the information contained in an international application corresponds to the information in the basic application or basic registration, the USPTO will certify the international application and forward it to the IB. 15 U.S.C. §1141b.

If an applicant uses the prepopulated TEAS form without changing any of the information (see TMEP §1902.02(a)), the international application will be certified and forwarded to the IB without review by the MPU. In all other cases, an MPU trademark specialist must review the data in the international application to determine whether such data corresponds to the basic application or basic registration.

Under Article 3(1) and Common Reg. 9(5)(d), the USPTO must sign the international application and certify:

- The date on which the USPTO received the international application (Common Reg. 9(5)(d)(i));
- That the mark in the international application is the same as the mark in the basic application or registration (Common Reg. 9(5)(d)(iv));
- That the applicant is the same person or entity listed as the owner of the basic application or registration (Common Reg. 9(5)(d)(ii));
- That the goods/services identified in the international application are covered by the basic application or registration (Common Reg. 9(5)(d)(vi));
- That the applicant is qualified to file an international application under §61 of the Trademark Act and Article 2(1);
- That, if the international application includes a description of the mark, the description is consistent with the basic application or registration (Common Regs. 9(4)(a)(xi) and 9(5)(d)(iii));
- That, if the international application indicates that the mark consists of a color or combination of colors, this indication is consistent with the basic application or registration (Common Regs. 9(4)(a)(vii^{bis}) and 9(5)(d)(iii));
- That, if color is claimed as a feature of the mark in the basic application or registration, the same claim is included in the international application (Common Reg. 9(5)(d)(v));
- That, if the international application indicates that the mark is three-dimensional, this indication is consistent with the basic application or registration (Common Regs. 9(4)(a)(viii) and 9(5)(d)(iii));
- That, if the international application indicates that the mark is a sound mark, this indication is consistent with the basic application or registration (Common Regs. 9(4)(a)(ix) and 9(5)(d)(iii));
- That, if the international application indicates that the mark is a collective or certification mark, this indication is consistent with the basic application or registration (Common Regs. 9(4)(a)(x) and 9(5)(d)(iii)).

If the international application meets the requirements of 37 C.F.R. §7.11(a), the USPTO will certify the application and send it to the IB. 37 C.F.R. §7.13(a). The MPU will send a notice of certification to the applicant.

If the application does not meet the requirements of 37 C.F.R. §7.11(a), the USPTO will not certify the application or forward it to the IB. The USPTO will

notify the applicant of the reason(s) why the application cannot be certified. The USPTO will refund any international fees paid through TEAS. The USPTO certification fee will not be refunded. 37 C.F.R. §7.13(b).

An applicant should periodically check the status of the international application online, using TARR. If the applicant does not receive a notice of certification or refusal within two months of filing, the applicant should contact the MPU. However, once an international application is certified and forwarded to the IB, questions concerning the international application should be directed to the IB rather than the USPTO. See TMEP §1906 for information on contacting the IB. The USPTO will update TARR when the IB issues a certificate of international registration or a notice of irregularity concerning the international application. See TMEP §1902.06 regarding the IB's examination of international registrations.

1902.03(a) Petition to Review Refusal to Certify

If an applicant believes that a refusal to certify an international application was erroneous, the applicant may file a petition to the Director to review the refusal. The petition should refer to the USPTO control number, and include the petition fee required by 37 C.F.R. §2.6. If the denial of certification was due to USPTO error, the USPTO will grant the petition and refund the petition fee. In all other cases, whether the petition is granted or denied, the petition fee is not refundable, unless the petition is withdrawn before a decision issues. The petition should be filed immediately. If the international application is not certified within two months of the date of receipt of the application in the USPTO, the date of international registration will be affected. Article 3(4); Common Reg. 15. See TMEP §1902.04.

The petition should be mailed using the First Class Service of the USPS to:

Madrid Processing Unit
600 Dulany Street
MDE-7B87
Alexandria, Virginia 22314-5793

37 C.F.R. §§2.190(e) and 7.4(b). If the applicant is paying the petition fee using a USPTO deposit account, the applicant may e-mail the request to madridpetitions@uspto.gov, with an authorization to charge the petition fee to a deposit account. See TMEP Chapter 1700 for further requirements for petitions to the Director.

Alternatively, the applicant may use a courier service or hand-deliver the petition to the Trademark Assistance Center at James Madison Building, East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention MPU. TAC is open 8:30 a.m. to 5:00 p.m. Eastern Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c).

1902.04 Date of International Registration

If the IB receives an international application within two months of the date of receipt in the USPTO, the date of the international registration is the date of receipt in the USPTO. If the IB does not receive the international application within two months of the date of receipt in the USPTO, the date of the international registration is the date of receipt in the IB. Article 3(4); Common Reg. 15.

Common Reg. 15 sets forth the IB's minimum requirements that may affect the date of the international registration:

- Adequate identification of the applicant, with sufficient information to contact the applicant or the applicant's representative;
- Reproduction of the mark;
- Indication of the goods or services; and
- Designation of Contracting Party or Parties for which extension of protection is sought.

If any of these elements is omitted from the international application, the IB will notify both the applicant and the USPTO. If the missing element(s) is received in the IB within two months of the date of receipt of the international application in the USPTO, the international registration will bear the date of receipt of the international application in the USPTO. If the missing element(s) is not received in the IB within two months of the date of receipt of the international application in the USPTO, the date of the international registration is the date of receipt of the last of the missing elements in the IB. In either case, the missing element(s) must be received in the IB on or before the deadline specified in the notice of irregularity. Article 3(4); Common Reg. 15(1).

See TMEP §§1902.07 *et seq.* for information about correcting irregularities in an international application.

1902.05 IB Requirements for Complete International Application

The requirements for an international application are set forth in Article 3 and Common Reg. 9. If the application meets the minimum requirements set forth in 37 C.F.R. §7.11(a) (see TMEP §§1902.02 *et seq.*), the USPTO will certify the application and send it to the IB. *The USPTO will not examine the international application to determine whether it is complete.* Only the IB will examine it for completeness. The requirements for a complete international application originating from the United States are:

- *Name and Address.* The name and address of the applicant;

- *Basic Application(s) or Registration(s)*. The serial number(s) and filing date(s) of the basic application(s), and/or the registration number(s) and registration date(s) of the basic registration(s). The international application may be based on more than one basic application or registration;
- *Entitlement to File*. An indication that the applicant: (1) is a national of the United States; (2) is domiciled in the United States; or (3) has a real and effective industrial or commercial establishment in the United States (Common Reg. 9(5)(b));
- *Fees*. The international application must include the basic filing fee charged by the IB; the supplementary fee for each class of goods or services beyond 3 classes; the complementary fee for designation of each country to which extension of the international registration is sought; and the transmittal fee that the USPTO charges to process the international application. Articles 8(1) and 8(2); Common Regs. 9(4)(a)(xiv), 10(2) and 34;
- *Goods/Services*. A list of the goods or services on or in connection with which the applicant seeks international registration (Article 3(2); Common Reg. 9(4)(a)(xiii));
- *Class(es)*. The international class(es) of goods or services, if known (Article 3(2); Common Reg. 9(4)(a)(xiii));
- *Contracting Parties*. The name(s) of the Contracting Party or Parties in which an applicant seeks protection (Common Reg. 9(4)(a)(xv));
- *Declaration of Intent to Use*. A verified statement that applicant 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 any of the Contracting Parties designated in the international application require such a declaration (Common Reg. 9(5)(f)). Under Common Reg. 7(2), a Contracting Party may notify the IB that it requires a signed declaration of intention to use the mark;
- *Reproduction (Drawing) of Mark*. A clear reproduction of the mark that is no more than 8 cm high by 8 cm wide. Common Reg. 9(4)(a)(v). The mark must be the same as the mark in the basic application or registration. If the mark in the basic application or registration has color, the mark in the international application must be in color. If the mark in the basic application or registration is black and white, the mark in the international application must be in black and white. If the mark in the basic application or registration is depicted in black and white, but contains a claim of color as a feature of the mark (see Note in TMEP §1902.02(e) regarding color drawings in United States basic applications or registrations), the applicant

must submit *both*: (1) a black-and-white image that is the same as the mark in the basic application or registration; and (2) a color reproduction depicting the color(s) claimed. Common Reg. 9(4)(a)(vii);

- *Color*. If color is claimed as a distinctive feature of the mark in the basic application or registration, the international application must include an indication to that effect, and must set forth the name of the color(s) (Article 3(3); Common Reg. 9(4)(a)(vii)). If the mark in the basic application or registration consists of a color or a combination of colors, the international application must include a statement to that effect (Common Reg. 9(4)(a)(vii^{bis})) (see TMEP §§1202.05 *et seq.* regarding color as a mark);
- *Transliteration*. If the mark consists of or contains non-Latin characters or numerals other than Arabic or Roman numerals, a transliteration of that matter in Latin characters and Arabic numerals (Common Reg. 9(4)(a)(xii));
- *Signature*. The USPTO must sign the international application. The IB does not require the applicant's signature (Common Reg. 9(2)(b)) (*Note*: Signature may be replaced with seal or other mode of identification determined by the IB (see Admin. Instr. §7);
- *Three-Dimensional Mark*. If the mark is three-dimensional, the indication "three-dimensional mark" (Common Reg. 9(4)(a)(viii));
- *Sound Mark*. If the mark is a sound mark, the indication "sound mark" (Common Reg. 9(4)(a)(ix));
- *Collective or Certification Mark*. If the mark is a collective mark or a certification mark, an indication to that effect (Common Reg. 9(4)(a)(x));
- *Standard Characters*. If the mark is a standard character mark, an indication to that effect (Common Reg. 9(4)(a)(vi));
- *Description of Mark*. If there is a description of the mark in the basic application or registration, the international application must include the same description. 37 C.F.R. §7.11(a)(5) and Common Reg. 9(4)(a)(xi);
- *Language*. International applications originating from the United States must be in English. 37 C.F.R. §7.3; Common Regs. 6(1) and 6(2)(iii);
- *Indication of Second Language*. If an applicant designates the European Community as a Contracting Party, applicant is required to

indicate a second language, in addition to the language in the international application (Common Reg. 9(5)(g)(ii)).

Additional Elements That May Be Included in International Application

The following elements may also be included, but are not mandatory under the Common Regulations:

- *Translation.* If the mark consists of or contains non-English wording, an English translation (Common Reg. 9(4)(b)(iii));
- *Citizenship/State of Incorporation or Organization* (Common Regs. 9(4)(b)(i) and (ii)). The citizenship of the applicant(s); or if the applicant is a juristic person, the state or nation under the laws of which the applicant is organized;
- *Disclaimer.* If an applicant wishes to disclaim any element of the mark, the applicant may do so (Common Reg. 9(4)(b)(v));
- *Representative.* See TMEP §1902.11;
- *Priority.* An international applicant may claim a right of priority within the meaning of Article 4 of the Paris Convention if: (1) the international application contains a claim of priority; and (2) the filing date of the application that forms the basis of the priority claim (within the meaning of Article 4 of the Paris Convention) was not more than six months before the date of the international registration. Article 4(2); Common Regs. 9(4)(a)(iv) and 14(2)(i). The applicant must specify the serial number (if available), filing date, and country of the earlier filing. If the earlier filing does not relate to all the goods/services listed in the international application, the applicant must set forth the goods/services to which it does relate. *NOTE: If the applicant is claiming priority based upon the basic application, the applicant must list the United States application serial number and filing date in **both** the “Basic Application” and the “Priority Claimed” sections of the form;*
- *Seniority.* An applicant designating the European Community may claim seniority of one or more earlier registrations in or for a Member State of the European Community for the same mark covering the same goods or services in the international application by indicating the following four elements: (1) each Member State in or for which the earlier mark is registered; (2) the date from which the registration was effective; (3) the registration number; and (4) the goods/services covered by the earlier registration (Common Reg. 9(5)(g)(i)). For international applications submitted on paper using the IB’s official form MM2, this information must be submitted on the IB’s official

MM17 form. The MM17 form should be annexed to the international application form.

1902.06 Examination of Application by IB

Upon certification, the USPTO forwards the international application to the IB. If the international application meets the applicable requirements for a complete international application (see TMEP §1902.05), the IB will immediately register the mark and publish the registration in the *WIPO Gazette of International Marks*. The IB will send the certificate to the holder and notify the Office of Origin and the Offices of the designated Contracting Parties to which extension of the registration is sought. Article 3(4); Common Reg. 14(1). If an international application is unacceptable, the IB will notify both the applicant and the USPTO of the “irregularity” (see TMEP §§1902.07 *et seq.*)

1902.07 Irregularities in International Application

If an international application is unacceptable, the IB will notify both the applicant and the USPTO of the “irregularity.” Some types of irregularities must be remedied by the USPTO, some must be remedied by the applicant, and some may be remedied by either the applicant or the USPTO. See 37 C.F.R. §7.14 and Common Reg. 11.

The MPU trademark specialists review all incoming notices of irregularities. If the irregularity is one that must be remedied by the USPTO (see TMEP §1902.07(a)), the trademark specialist will respond to the notice and send the applicant a copy of the response.

If the irregularity is not one that must be remedied by the USPTO, the USPTO will note receipt of the notice of irregularity in its automated records, but will not take any other action. The USPTO will not respond to the notice on behalf of the applicant. The USPTO will not send a copy of the notice to the applicant, because the IB has already notified the applicant of the irregularity. A copy of the notice will be placed in the electronic record of the international application. The notice can be reviewed using the Trademark Document Retrieval (“TDR”) system on the USPTO website, by entering the control number assigned to the international application by the USPTO.

Applicants must file responses to irregularities in classification and identification of goods/services through the USPTO (see TMEP §§1902.07(c) *et seq.*). Fees for correcting irregularities in international applications must be paid directly to the IB in Swiss currency (see TMEP §1902.07(b)(i)). Responses to all other types of irregularities may be filed either directly at the IB or through the USPTO.

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 of the response in the USPTO does not satisfy this requirement.

For responses to IB notices of irregularities that may be submitted through the USPTO, applicants may file the response either through TEAS or on paper. When correcting irregularities through the USPTO, the applicant should submit the response as soon as possible, and at least one month before the end of the response deadline set forth in the IB's notice. The USPTO will not process any response filed after the IB response deadline. 37 C.F.R. §7.14(e). See TMEP §1902.07(f) regarding responses to notices of irregularity submitted through the USPTO.

1902.07(a) Irregularities that Must Be Remedied by the USPTO

The following irregularities must be remedied by the USPTO within three months of the date of notification of the irregularity:

- Application is not presented on the official form or is not typed;
- Omission of reproduction of mark;
- Omission of list of goods/services;
- Omission of designation of Contracting Party or Parties;
- Insufficient identification of applicant;
- Irregularities relating to the entitlement of the applicant to file an international application (see TMEP §1902.02(j));
- Application not signed by USPTO (*Note:* Signature may be replaced with seal or other mode of identification determined by the IB. See Admin. Instr. §7);
- Certification by USPTO is defective;
- Omission of date and number of basic application or registration.

Common Regs. 11(4) and 15(1); *Guide to International Registration*, Para. B.II.25.03.

If the USPTO does not cure the irregularity within three months, the international application is abandoned. Common Regs. 11(4)(b) and 11(5).

When responding to a notice of an irregularity that must be remedied by the USPTO, the MPU trademark specialist will send the applicant a copy of the response.

1902.07(b) Irregularities that Must Be Remedied by the Applicant – Applicant Must Respond Directly to the IB

1902.07(b)(i) Fee Irregularities

Where international fees for the international application are insufficient, the IB will notify both the applicant and the USPTO of the deficiency. The USPTO will not respond to the notice on behalf of applicant even if the international application fees were paid through TEAS.

Fees for correcting irregularities in an international application must be paid directly to the IB in Swiss currency, even if the applicant is filing a response to correct other irregularities through the USPTO. 37 C.F.R. §7.14(c). If any fees for correcting irregularities are submitted to the USPTO, the USPTO will return the fees to the applicant. The USPTO will not forward the fees to the IB. If the fees are not received by the IB on or before the deadline set forth in the IB's notice of irregularity, the international application may be abandoned. See TMEP §1903.02 for information about the payment of fees to the IB.

1902.07(c) Irregularities that Must Be Remedied by the Applicant – Applicant Must Respond Through the USPTO

1902.07(c)(i) Classification of Goods/Services

If the IB finds an irregularity in classification, it will make a proposal and send it to both the applicant and the USPTO. The notice will state whether any additional fees are due. Common Reg. 12(1). The USPTO will neither respond to the notice on behalf of applicant nor advise the applicant as to how to reclassify the goods/services.

If an irregularity notice indicates that the failure to resolve the irregularity will result in the abandonment of the international application, the applicant must respond and/or pay the necessary fees to avoid abandonment. If the irregularity notice merely indicates that "if no response, WIPO proceeds," the applicant need not respond if applicant agrees to the proposal by WIPO.

The applicant cannot send its response directly to the IB. The applicant must submit the response through the USPTO. The IB must receive the response within 3 months of the date of the IB notification. 37 C.F.R. §7.14(b); Common Reg. 12(2). See TMEP §1902.07(f) regarding responses to notices of irregularity submitted through the USPTO.

An MPU trademark specialist will review the applicant's response, but only to ensure that the response consists solely of an amendment to classification and that no amendments to the identification of the goods or services have been proposed. So long as the only proposed change is to classification, and such change in classification does not expand the listing of goods/services to

exceed the scope of the underlying basic application or registration, the USPTO will forward it to the IB and notify the applicant accordingly. See TMEP §1902.07(c)(ii) regarding proposed amendments to the identification of goods/services.

If additional fees are due as a result of reclassification of goods/services, the applicant must pay the fees directly to the IB in Swiss currency. See TMEP §1903.02 for further information about the payment of fees to the IB.

Under Article 3(2), the IB controls classification and has the final say on classification of goods/services. The IB may modify, withdraw, or maintain its proposal after reviewing the applicant's response. Common Reg. 12.

See *also* TMEP §1401.03(d).

1902.07(c)(ii) Identification of Goods/Services

If the IB determines that the identification of goods/services is too vague or is incomprehensible or linguistically incorrect, it will notify both the applicant and the USPTO. Common Reg. 13. The IB may include a suggested amendment in the notification. The USPTO will not respond to the notice on behalf of applicant or advise the applicant as to how to identify the goods/services.

The applicant cannot send a response directly to the IB. Any response regarding the identification of goods/services must be sent through the USPTO. The IB must receive the response within 3 months of the date of the IB notification. 37 C.F.R. §§7.14(a) and 7.14(b); Common Reg. 13(2). See TMEP §1902.07(f) regarding responses to notices of irregularity submitted through the USPTO.

An MPU trademark specialist will review the applicant's response to ensure that the goods/services identified in the response are within the scope of the identification in the basic application and/or registration at the time the response is filed. If an amendment to the goods/services in the basic application and/or registration has been entered into the trademark database since the date the international application was submitted to the USPTO, the goods/services in the response to the IB notice must be within the scope of the amended goods/services. If the goods/services in the response exceed the scope of the goods/services in the basic application and/or registration as amended, the trademark specialist will notify the applicant that the proposed amendment to the goods/services does not conform to the goods/services as identified in the basic application and/or registration and that the response will not be forwarded to the IB. If there is time remaining in the IB response period, the applicant may submit a corrected response. If the goods/services in the corrected response do not exceed the scope of the goods/services in the basic application or registration as amended, and the IB response period has not expired, the MPU will forward the response to the IB.

If no proposal acceptable to the IB for remedying the irregularity is made within 3 months, and all other requirements have been met, the IB will either: (1) include the term in the international registration with an indication that the IB considers the term to be unacceptable, provided that the class of the vague term was specified in the application; or (2) if the class was not specified, delete the term and notify both the USPTO and the applicant accordingly. Common Reg. 13(2)(b).

1902.07(d) Other Irregularities that Must Be Remedied By Applicant – Applicant May Respond Directly to the IB or Through the USPTO

Other irregularities to be remedied by applicant include, but are not limited to, insufficient information about the applicant's representative; missing transliteration; insufficient information about a priority claim; unclear reproduction of the mark; and color claim with no color reproduction. The applicant must remedy any irregularities within three months of the date of the notification, or the international application may be abandoned. Common Reg. 11(2)(b). See *Guide to International Registration*, Para. B.II.25.07, for further information.

An applicant may file the response to these irregularities either directly with the IB, or through the USPTO, either electronically or on paper. 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 USPTO does not fulfill this requirement.

If the response is filed through the USPTO, the USPTO will not review the response to the irregularity but will forward the response to the IB, and notify the applicant accordingly. See TMEP §1902.07(f) for information about responding to a notice of irregularity through the USPTO.

1902.07(e) Filing Response Directly With the IB

Information about filing responses directly with the IB is available on the WIPO website, currently at <http://www.wipo.int/madrid/en/>. An applicant may contact the IB by mail to 34 chemin des Colombettes, P.O. Box 18, 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.

1902.07(f) Responding to Notice of Irregularity Through the USPTO

Under Trademark Rule 7.14(e), 37 C.F.R. §7.14(e), an applicant may file a response to an IB notice of irregularity through the USPTO for forwarding to the IB before the IB's response deadline. The response may be filed electronically or on paper. **However, receipt in the USPTO does not fulfill the requirement that the response be received by the IB before the IB**

response deadline. Therefore, applicants should submit responses to the USPTO as soon as possible, and at least one month before the end of the IB response period. The USPTO will not process any response received after the IB response deadline.

The IB does not have a form for responses to irregularity notices. Applicants are strongly encouraged to use the TEAS form for responses to notices of irregularity. Applicants submitting paper responses to the USPTO for forwarding to the IB should include with the response: (1) the USPTO control number (U.S. Reference No.) assigned to the international application; and (2) a copy of the IB's irregularity notice. The applicant may include a self-addressed, stamped postcard with the response. Upon receipt, the USPTO will place a label indicating the receipt date on the documents, and return the postcard to the applicant. However, to be considered timely, the response must be received by the IB before the end of the response period set forth in the IB's notice, and receipt in the USPTO does not fulfill the IB deadline requirement.

Applicants submitting responses on paper should mail the document to the following address, using the First Class Service of the USPS:

Madrid Processing Unit
600 Dulany Street
MDE-7B87
Alexandria, Virginia 22314-5793

37 C.F.R. §§2.190(e) and 7.4(b). Alternatively, the response may be delivered by hand or courier to the Trademark Assistance Center, at James Madison Building, East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:30 a.m. to 5:00 p.m. Eastern Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c). The certificate of mailing or transmission procedures of 37 C.F.R. §2.197 and Express Mail provisions of 37 C.F.R. §2.198 do not apply to responses to notices of irregularity. 37 C.F.R. §§2.197(a)(2)(ii), 7.4(b)(2), and 7.4(e).

Please note that fees for correcting irregularities in an international application must be paid directly to the IB in Swiss currency, even if the applicant is filing a response to correct irregularities through the USPTO. 37 C.F.R. §7.14(c). See TMEP §1903.02 for further information about the payment of fees to the IB.

Responses to notices of irregularity cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(3).

The USPTO will not process any response filed after the IB response deadline. 37 C.F.R. §7.14(e).

1902.08 Subsequent Designation - Request for Extension of Protection Subsequent to International Registration

A subsequent designation is a request by the holder of an international registration for an extension of protection of the international registration to additional Contracting Parties, made after the IB registers the mark. The requirements for a subsequent designation are set forth in Article 3^{ter}(2) and Common Reg. 24. The holder may file the subsequent designation directly with the IB. There is a form for filing a subsequent designation, the MM4 form, on the IB website at <http://www.wipo.int/madrid/en/>.

A holder may file a subsequent designation through the USPTO if: (1) the international registration is based on a basic application filed with the USPTO and/or a basic registration issued by the USPTO; and (2) the holder is a national of, is domiciled in, or has a real and effective business or commercial establishment in the United States. 15 U.S.C. §1141d; 37 C.F.R. §§7.21(a) and (b).

1902.08(a) USPTO Requirements

The minimum requirements for a date of receipt of a subsequent designation in the USPTO are set forth in 37 C.F.R. §7.21(b), and are reproduced below:

- The international registration number;
- The serial number of the U.S. application and/or the registration number of the U.S. registration that formed the basis of the international registration;
- The name and address of the holder of the international registration;
- A statement that the holder is entitled to file a subsequent designation through the USPTO, specifying that the holder: (1) is a national of the United States; (2) has a domicile in the United States; or (3) has a real and effective industrial or commercial establishment in the United States. If a holder's address is not in the United States, the holder must provide the address of its United States domicile or establishment;
- A list of goods/services that is identical to or narrower than the goods/services in the international registration;
- A list of the Contracting Parties designated for an extension of protection;
- The USPTO transmittal fee;
- The international fees required by the IB, if the subsequent designation is filed through TEAS; and

- An e-mail address for receipt of correspondence from the USPTO, if the subsequent designation is filed through TEAS.

See TMEP §1902.08(b) regarding the form for filing a subsequent designation through the USPTO, and TMEP §1902.08(c) regarding the international fees for a subsequent designation.

The USPTO does not certify subsequent designations. If a subsequent designation meets the requirements set forth in 37 C.F.R. §7.21(b), the USPTO will forward it to the IB. 37 C.F.R. §7.21(c). If the subsequent designation does not meet these requirements, the USPTO will not forward the subsequent designation, and will notify the holder of the reasons. The USPTO transmittal fee is nonrefundable. 37 C.F.R. §7.21(d).

If the subsequent designation meets the requirements of Common Reg. 24, the IB will record it and notify both the USPTO and the holder of the recordation. Common Reg. 24(8). The subsequent designation will bear the date of receipt in the USPTO, provided that the IB receives it within two months of that date. If the IB does not receive the subsequent designation within two months of the date of receipt in the USPTO, the subsequent designation will bear the date of receipt in the IB. Common Reg. 24(6)(b).

1902.08(b) Form for Filing Subsequent Designation Through the USPTO

The holder of an international registration submitting a subsequent designation through the USPTO may file either through TEAS or on the official paper form issued by the IB. 37 C.F.R. §7.21(b).

When filing through TEAS, the holder must enter the required information in the data fields of the free-text TEAS form. Holders filing subsequent designations on paper through the USPTO should use the official IB form MM4 posted on the IB website at <http://www.wipo.int/madrid/en/>. The IB will not accept paper applications that are not presented on the official IB form. The form cannot be handwritten. Article 3^{ter}(2); Common Reg. 24(2)(b); Madrid Admin. Instrs. §§2 and 6(a). The holder should complete the MM4 form online, print the completed form, and submit it to the USPTO via mail, hand delivery or courier service.

The IB's *Guide to International Registration*, available on the IB's website at www.wipo.int/madrid/en/, contains instructions for completing the subsequent designation form, at B.II.43.01-44.03.

The subsequent designation form may be mailed to the USPTO at the following address, using the First Class Service of the USPS.

Madrid Processing Unit
600 Dulany Street

MDE-7B87
Alexandria, Virginia 22314-5793

37 C.F.R. §§2.190(e) and 7.4(b). Alternatively, subsequent designations may also be delivered by hand or courier to the Trademark Assistance Center, at James Madison Building, East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:30 a.m. to 5:00 p.m. Eastern Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c).

If a subsequent designation is mailed to the USPTO via the Express Mail Service of the USPS, the USPTO will deem that the subsequent designation was submitted on the day it was deposited as Express Mail, provided that the holder complies with the requirements for correspondence sent by Express Mail set forth in 37 C.F.R. §2.198. See TMEP §305.03 regarding Express Mail. The certificate of mailing or transmission procedures of 37 C.F.R. §2.197 do not apply to subsequent designations. 37 C.F.R. §§2.197(a)(2)(ii) and 7.4(e).

When submitting a paper subsequent designation, a holder should include a self-addressed, stamped postcard. Upon receipt of the subsequent designation, the USPTO will place a label indicating the receipt date on the documents, and return the postcard to the holder.

Subsequent designations cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(2).

1902.08(c) Fees for Subsequent Designation

USPTO Transmittal Fee. The subsequent designation must include the USPTO transmittal fee, or the USPTO will not forward it to the IB. 37 C.F.R. §7.21(a)(7).

International Fees. If the subsequent designation is filed through TEAS, all international fees for the subsequent designation must be paid at the time of submission. 37 C.F.R. §7.21(b)(8). International fees for subsequent designations filed on paper must be paid directly to the IB in Swiss currency, either before or after submission of the subsequent designation. However, international fees paid after the IB receives the subsequent designation could result in a notice of irregularity issued by the IB.

See TMEP §1903.02 regarding payment of international fees.

1902.08(d) IB Requirements for Subsequent Designation

The requirements for a subsequent designation are set forth in Article 3^{ter} and Common Reg. 24. If the subsequent designation meets the minimum requirements for a date of receipt set forth in 37 C.F.R. §7.21(b) (see TMEP

§1902.08(a)), the USPTO will forward the subsequent designation to the IB. *The USPTO will not examine it to determine whether it is complete.* The IB will examine it for completeness.

If the subsequent designation meets the applicable requirements, the IB will record it in the International Register and notify the holder and the Offices of the designated Contracting Parties. The IB will also notify the USPTO, if the subsequent designation was submitted through the USPTO. Common Reg. 24(8).

1902.08(e) Irregularities in Subsequent Designation

If a subsequent designation is sent to the IB through the USPTO, the IB will notify both the holder and the USPTO of any irregularity. Common Reg. 24(5)(a). Corrections of any irregularity in a subsequent designation must be sent directly to the IB, even if the subsequent designation was sent through the USPTO. 37 C.F.R. §7.21(e). The USPTO will make note of receipt of the notice of irregularity in its automated records, but will not take any other action.

1902.09 Dependence and “Central Attack”: Restriction, Abandonment, Cancellation, or Expiration of Basic Application or Registration During First 5 Years

For a period of 5 years from the date of the international registration, the registration is dependent on the basic application or basic registration. Article 6(3). Under §63 of the Trademark Act, 15 U.S.C. §1141c, and Article 6(4), the USPTO must notify the IB if the basic application and/or registration is restricted, abandoned, cancelled, or expired with respect to some or all of the goods/services listed in the international registration:

- (1) Within five years after the international registration date; or
- (2) More than five years after the international registration date if the restriction, abandonment, or cancellation of the basic application or basic registration resulted from an action that began before the end of the five-year period.

The IB will cancel (or restrict) the international registration accordingly. Article 6(4); Common Reg. 22(2)(b). This is sometimes called “central attack.”

The USPTO must notify the IB if there is an appeal, opposition, or cancellation proceeding (or a court proceeding, if the USPTO is aware of the proceeding) pending at the end of the five-year period. The USPTO must notify the IB of the final decision once the proceeding is concluded. Common Regs. 22(1)(b) and (c). The IB will record this notice in the International Register and notify the holder and the designated Contracting Parties.

In view of the above notification requirements, applicants and registrants are encouraged to exercise diligence in monitoring the status of their basic application and/or basic registration (see TMEP §1705.05). Once the IB cancels or restricts an international registration, it cannot be reinstated. If a problem arises with the basic application and/or registration, or a status inquiry reveals that the basic application and/or registration has become improperly abandoned or cancelled, the applicant or registrant should promptly take corrective action. See TMEP §§1712 *et seq.* for information regarding reinstatement of abandoned applications and cancelled registrations; and TMEP §§1714 *et seq.* regarding petitions to revive abandoned applications.

1902.10 Transformation When the USPTO Is the Office of Origin

If the IB cancels an international registration as a result of the cancellation or restriction of the USPTO basic application and/or USPTO basic registration under Article 6(4) (see TMEP §1902.09), the holder may “transform” the international registration into national applications in the offices of the Contracting Parties that were designated for extension(s) of protection in the international registration. Transformation must be requested within three months from the date of cancellation of the international registration. Article 9^{quinquies}. The filing date for the new national application(s) that results from the transformation of an extension of protection will be the international registration date (or the date of recordal of the subsequent designation requesting an extension of protection to that Contracting Party).

The goods/services in the national application(s) must have been covered by the cancelled international registration. Transformation may be requested for some or all of the goods/services that are cancelled or restricted from an international registration. Transformation may not be requested for goods/services that exceed the scope of those cancelled or restricted from the international registration.

Transformation of an extension of protection may take place only if the IB cancels or restricts the international registration at the request of the USPTO, due to cancellation of the USPTO basic application or USPTO basic registration. It is not available if the international registration is cancelled at the request of the holder, or expires for failure to renew. Transformation is not available at the Office of Origin.

The request for transformation must be filed directly with the designated Contracting Party, and will be examined as a national application under the laws of that Contracting Party. The USPTO and the IB are not involved.

See TMEP §§1904.09 *et seq.* regarding transformation of a request for extension of protection to the United States into an application under §1 or §44 of the Trademark Act.

1902.11 Representative

An applicant for or holder of an international registration may appoint a representative to represent the applicant or holder before the IB by indicating the representative's name in the appropriate box on the international application or subsequent designation form. Common Reg. 3(2)(a). The applicant/holder may also appoint a representative in a subsequent communication submitted to the IB (see TMEP §1906.01(d)). Common Reg. 3(2)(b). Form MM12, for appointing a representative, may be found on the IB website at <http://www.wipo.int/madrid/en/>.

1902.12 USPTO Must Notify IB of Division or Merger of Basic Application or Registration

Under Common Reg. 23, an Office of Origin must notify the IB if the basic application or registration is divided into several applications or registrations, or if several applications or registrations are merged into a single application or registration, within 5 years after the date of the international registration. See TMEP §§1110 *et seq.* regarding division of a United States application and TMEP §§1615 *et seq.* regarding division of a United States registration.

1903 Payment of Fees

1903.01 Payment of USPTO Fees

The fees required by the USPTO for processing correspondence relating to international applications and registrations under the Madrid Protocol are set forth in 37 C.F.R. §7.6. The USPTO charges a fee for processing the following Madrid-related documents:

- International applications under 37 C.F.R. §7.11;
- Subsequent designations under 37 C.F.R. §7.21;
- Requests to record assignments, restrictions, or release of restrictions of an international registration under 37 C.F.R. §§7.23 and 7.24;
- Notices of replacement under 37 C.F.R. §7.28; and
- Affidavits under §71 of the Act (see 37 C.F.R. §7.36).

These fees must be paid in United States dollars at the time of submission, regardless of whether the document is submitted electronically or on paper.

1903.02 Payment of International Fees

In addition to the fees required by the USPTO, there are international fees for processing international applications and registrations required by the IB. For international applications, subsequent designations, and requests to record changes of ownership of international registrations that are filed through TEAS, fees may be paid either directly to the IB or through the USPTO. 37 C.F.R. §7.7(a). Applicants/holders filing on paper must pay all international fees directly to the IB in Swiss currency. 37 C.F.R. §7.7(c); see Common Regs. 34 to 38 regarding payment of fees. There is a fee calculator and a schedule of fees on the IB website at <http://www.wipo.int/madrid/en/>.

The IB will accept the following forms of payment:

- Debit to a current account established with the IB;
- Payment into the Swiss postal check account or to any of the specified bank accounts of the IB; and
- Credit card where, in the context of an electronic communication, an electronic interface for online payment has been made available by the IB.

See *Guide to International Registration*, Para. B.I.08.05. Admin. Instr. §19.

Effective January 1, 2008, the IB does not accept banker's checks as a mode of payment. See *Change in Practice Regarding Acceptance by USPTO of Bank Checks for Fees Payable to the International Bureau*, [1328 OG 199](#) (March 25, 2008). See also IB Information Notice No. 20/2007, on the IB website at http://www.wipo.int/edocs/madrdocs/en/2007/madrid_2007_20.doc.

The conditions for opening, using, and closing a current account with the IB are posted on the IB website at http://www.wipo.int/madrid/en/guide/part_d/pdf/wipo_account.pdf. The IB has introduced an e-payment service on its website for payment of fees notified in irregularity notices and other WIPO communications concerning the Madrid System. Users are invited to make payments by credit card (American Express,[®] Mastercard,[®] Visa[®]) or through a WIPO Current Account. See the WIPO website at <https://webaccess.wipo.int/epayment/> for further information about e-payment.

Questions concerning payment of international fees should be directed to the IB by mail to the World Intellectual Property Organization, 34 chemin des Colombettes, P.O. Box 18, 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. The USPTO cannot assist applicants/holders in calculating the appropriate international fees or in selecting a method of payment of fees to the IB.

Failure to send a fee to the IB before the IB receives a form could result in issuance of a notice of irregularity by the IB. See TMEP §§1902.02(i), 1902.08(c), and 1906.01(a)(ii).

1904 Request for Extension of Protection of International Registration to the United States

1904.01 Filing Request for Extension of Protection to United States

The holder of an international registration may file a request for extension of protection of that registration to the United States under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a). The request for extension of protection to the United States may be included in the international application, or in a subsequent designation made after the IB registers the mark. The IB will transmit the request for extension of protection to the United States to the USPTO electronically. The USPTO refers to a request for extension of protection to the United States as a “§66(a) application.” 37 C.F.R. §7.25(b).

1904.01(a) Section 66(a) Basis

Section 66(a) of the Trademark Act provides a basis for filing in the United States. See 37 C.F.R. §2.34(a)(5). A basis under §66(a) cannot be combined with any other basis. 37 C.F.R. §2.34(b)(3). A §66(a) applicant may not change the basis unless the applicant meets the requirements for transformation under §70(c) of the Trademark Act, 15 U.S.C. §1141j(c). 37 C.F.R. §2.35(a). See TMEP §1904.09 regarding transformation.

Section 66(a) requires transmission of a request for extension of protection by the IB to the USPTO and cannot be added or substituted as a basis in an application originally filed under §1 or §44.

1904.01(b) Filing Date

If a request for extension of protection of an international registration to the United States is made in an international application, the filing date of the §66(a) application is the international registration date. If a request for extension of protection to the United States is made in a subsequent designation, the filing date of the §66(a) application is the date on which the subsequent designation was recorded by the IB. 15 U.S.C. §1141f(b); 37 C.F.R. §7.26.

1904.01(c) Declaration of Intent to Use Required

Section 66(a) of the Trademark Act requires that a request for extension of protection to the United States include a declaration that the applicant has a bona fide intention to use the mark in commerce that can be controlled by the

United States Congress. The declaration must include a statement that the person making the declaration believes the applicant to be entitled to use the mark in commerce; and that to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, 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, to cause confusion, or to cause mistake, or to deceive. 15 U.S.C. §1141(5).

The declaration must be signed by: (1) a person with legal authority to bind the applicant; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or (3) an attorney authorized to practice before the USPTO under 37 C.F.R. §11.14 who has an actual written or verbal power of attorney or an implied power of attorney from the applicant. 37 C.F.R. §§2.33(a) and 2.193(e)(1).

The USPTO has provided the IB with wording for the declaration of the applicant's bona fide intention to use the mark in commerce, which is part of the official IB form for international applications and subsequent designations in which the United States is designated for an extension of protection (IB Form MM18). Instructions as to who is a proper party to sign the declaration have also been provided to the IB.

The IB will check to ensure that the MM18 form is annexed to the international application or subsequent designation in which there is a request for extension of protection to the United States, that the wording of the declaration has not been altered, and that the document has been signed before forwarding the request for extension of protection to the USPTO. The IB does not send the verified statement to the USPTO.

The verified statement remains part of the international registration on file at the IB. 37 C.F.R. §2.33(e). The examining attorney will not review the international registration to determine whether there is a proper declaration of intent to use, or issue any inquiry regarding the verification of the application on file with the IB. However, if the applicant voluntarily files a substitute declaration with the USPTO, it will be examined according to the same standards used for examining any other declaration. See TMEP §804.05 for further information about declarations in §66(a) applications.

1904.01(d) Use Not Required

Use in commerce prior to registration is not required. Section 68(a)(3) of the Trademark Act, 15 U.S.C. §1141h(a)(3). However, after registration, periodic affidavits of use or excusable nonuse are required to maintain a registered extension of protection. Section 71 of the Trademark Act, 15 U.S.C. §1141k. See TMEP §1613 for information about these affidavits.

1904.01(e) Priority

A holder may claim a right of priority within the meaning of Article 4 of the Paris Convention if:

- (1) The request for extension of protection contains a claim of priority;
- (2) The request for extension of protection specifies the filing date, serial number, and country of the application that forms the basis for the claim of priority; *and*
- (3) The date of international registration or the date of the recordal of the subsequent designation requesting an extension of protection to the United States is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention).

Section 67 of the Trademark Act, 15 U.S.C. §1141g; Article 4(2). *See also* Paris Convention Article 4(D).

To be eligible for a claim of priority in a §66(a) application, the holder must file the request for extension of protection to the United States within 6 months of the date of the filing that forms the basis of the priority claim. If the United States is designated for an extension of protection in an international application, the international registration date cannot be later than 6 months after the date of the filing that formed the basis of the priority claim. If a request for extension of protection to the United States is made in a subsequent designation, the date of recordal of the subsequent designation cannot be later than 6 months after the date of the filing that formed the basis of the priority claim. The Office's electronic systems use the dates provided in the international registration to automatically calculate whether an application receives the benefit of a priority claim. If the "Priority Claimed" field indicates "YES," the "Priority Claimed Date" is to be treated as the effective filing date. *See* TMEP §206.02 for information on claiming priority under §67, 15 U.S.C. §1141g.

1904.01(f) Filing Fee

The filing fee for a §66(a) application will be sent to the USPTO by the IB. The examining attorney should not require additional filing fees during examination, except where the application is divided due to a change in ownership with respect to some but not all of the goods/services. *See* Article 8 and Common Regs. 34 through 38 regarding international fees, and TMEP §1110.11 regarding dividing a §66(a) application.

1904.01(g) Constructive Use

Under §66(b) of the Trademark Act, unless extension of protection is refused, the filing of the request for extension of protection constitutes constructive use of the mark, conferring the same rights as those specified in §7(c) of the Trademark Act, 15 U.S.C. §1057(c), as of the earliest of the following:

- (1) The international registration date, if the request for extension of protection to the United States was filed in the international application;
- (2) The date of recordal of the subsequent designation requesting extension of protection, if the request for extension of protection to the United States was made after the international registration date; or
- (3) The date of priority claimed pursuant to §67 of the Trademark Act.

1904.01(h) Cannot be Based on USPTO Basic Application or Registration

An international registration in which the United States is the Office of Origin (i.e., an international registration based on a basic application pending in the USPTO or a basic registration issued by the USPTO) cannot be used to obtain an extension of protection to the United States. 15 U.S.C. §1141e(b); Article 3^{bis}. The IB will not send a request for extension of protection to the United States if the international registration is based on a USPTO basic application and/or registration.

1904.02 Examination of Request for Extension of Protection to the United States

1904.02(a) Examined as Regular Application

Under §68(a) of the Trademark Act, a request for extension of protection will be examined under the same standards as any other application for registration on the Principal Register. 15 U.S.C. §1141h. It is unnecessary for the examining attorney to review the international registration on file at the IB, since the IB will forward all the necessary information with the request for extension of protection or in subsequent notifications, such as notices of correction, limitation, or change to the name or address of the holder or holder's representative.

Except for 37 C.F.R. §§2.22-2.23, 2.130-2.131, 2.160-2.166, 2.173, and 2.181-2.186, all rules in 37 C.F.R. Part 2 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. All rules in 37 C.F.R. Parts 10 and 11

relating to representation of others before the USPTO also apply to requests for extension of protection. 37 C.F.R. §7.25(a).

1904.02(b) Examination of Classification of Goods/Services in §66(a) Applications

In a §66(a) application, the IB controls the classification. Article 3(2). The §66(a) application (and any resulting registration) remains part of the international registration, and a change of classification in the United States would have no effect on the international registration. Any classification change made during examination would ultimately be refused by the IB upon notification of the final grant of protection.

Therefore, in a §66(a) application, the following types of amendments are prohibited:

- Changing the classification of goods/services from the classification assigned by the IB;
- Adding a class to the application that is not the subject of the request for extension of protection to the United States; or
- Transferring goods/services between classes in a multiple-class application.

37 C.F.R. §2.85(d). See TMEP §1401.03(d).

The only instance in which classification in a §66(a) application can be altered is upon the receipt of a correction from the IB. See TMEP §1904.02(e)(i) regarding IB corrections.

If the classification of a §66(a) application is inadvertently changed during examination, the USPTO will issue corrections to the holder and to the IB.

1904.02(c) Examination of Identification of Goods/Services in §66(a) Applications

Although the IB determines *classification* of the goods/services, for purposes of *identification*, the examining attorney will examine the identification of goods/services in a §66(a) application according to the same standards of specificity used in examining applications under §§1 and 44 of the Trademark Act, 15 U.S.C. §§1051 and 1126. Specifically, the examining attorney must follow the procedures set forth in the TMEP and identify the goods/services in accordance with the USPTO's *Acceptable Identification of Goods and Services Manual* ("USPTO ID Manual") whenever possible. However, with respect to requests for extension of protection to the U.S., the assigned classes define the scope of the goods/services for the purpose of determining

the extent to which the identification may be amended in accordance with 37 C.F.R. §2.71.

When the IB is unable to determine if the classification assigned to particular goods/services by an applicant's Office of origin is correct, the IB will request clarification. If no clarification is provided, the IB will include the unclear wording from the international application in the international registration and will indicate, in parentheses, that the wording is "considered too vague for classification," "incomprehensible," or "linguistically incorrect." Although included in the listing of goods/services of the request for extension of protection, the parenthetical language is not part of the scope of the identification and must not be part of any application that is eventually approved for publication.

If the initial identification of goods/services in the §66(a) application is definite, but misclassified under United States standards, the examining attorney must accept the identification, and cannot change the classification. If the initial identification of goods/services is not definite, the classification cannot be changed and the scope of the identification for purposes of permissible amendment is limited by the IB-assigned classification. See TMEP §§1401.03(d), 1402.01(c), and 1402.07(a). Because the international registration is limited to those classes assigned by the IB, the identification includes only those products or services falling within the identified classes. To propose an amendment outside of the scope of the classes would result in the lack of a basis for registration of such goods/services under U.S. law.

If a §66(a) applicant wants to seek registration for goods, services, or class(es) which are included in the international registration but were not originally included in the request for extension of protection to the United States, the §66(a) applicant must file a subsequent designation with the IB. Article 3^{ter}(2); *Guide to International Registration*, B.II.38.03. To seek registration for good/services not within the scope of the international registration, the applicant may file a separate application for the same mark under §1 and/or §44.

The identification of goods/services must be specific, definite, clear, accurate, and concise. See TMEP §1402.01 and cases cited therein. The USPTO has discretion to require the degree of particularity deemed necessary to clearly identify the goods or services covered by the mark. *In re Omega SA*, 494 F.3d 1363, 83 USPQ2d 1541 (Fed. Cir. 2007) (noting that the USPTO has discretion to require greater particularity than an entry in WIPO's Alphabetical List of Goods and Services). Even if the IB characterizes terms as "too vague," "incomprehensible," or "linguistically incorrect," the USPTO has discretion to consider them *de novo* based on established policies regarding specificity within the context of the class assigned.

Generally, there are three types of identifications: (1) acceptable identifications of goods/services; (2) indefinite identifications of

goods/services with acceptable options within the scope of the class; and
(3) indefinite identifications of goods/services that do not include any goods/services in the designated class.

1904.02(c)(i) Acceptable Identifications of Goods/Services

When the identification of goods/services is definite in accordance with USPTO policies, the identification is acceptable, regardless of the class assigned. If the goods/services are classified in accordance with the current edition of the Nice Agreement, no further requirements are necessary.

An international registration may encompass goods/services that were classified under an earlier version of the Nice Agreement. If the IB's classification of goods/services in the §66(a) application is different from the classification currently set forth in the USPTO ID Manual, the examining attorney will not require amendment of the classification. However, the examining attorney should notify the Administrator for Trademark Identifications, Classification and Practice ("Administrator") of the serial number, using the internal TM Madrid ID/Class mailbox. The goods/services cannot be moved to another class identified in the application. 37 C.F.R. §2.85(d).

With respect to acceptable goods/services that appear to be misclassified, if the examining attorney determines that the class would be proper were the goods/services amended with further clarifying language, the examining attorney may require an amendment for further specificity to limit the identification to goods/services that are in the class indicated in the international registration.

Examples:

- The goods are identified as "footwear" in Class 25. The wording is definite and the IB has assigned the correct class. No action necessary.
- The services are identified as "legal services," but the IB has assigned Class 42. The wording is definite, but the class is not consistent with the current edition of the Nice Agreement. No action is necessary. The examining attorney should notify the Administrator of the serial number.
- The goods are identified as "tobacco," but the IB has assigned Class 35. The Alphabetical List of the Nice Agreement classifies such goods in Class 34. The examining attorney will accept the goods in the assigned class. The examining attorney should notify the Administrator of the serial number.

- The goods are identified as “pasta,” but the IB has assigned Class 3. The Alphabetical List of the Nice Agreement classifies such goods in Class 30. The examining attorney will accept the goods in the assigned class, and notify the Administrator of the serial number.
- The goods are identified as “nutritional supplements as included in this class,” but the IB has assigned Class 29. Even with the wording added to “nutritional supplements,” the identification of goods remains definite, but the class is not consistent with the USPTO Identification and Classification of Goods and Services Manual. The examining attorney will accept the goods in the assigned class, and notify the Administrator of the serial number.

1904.02(c)(ii) Indefinite Identification of Goods/Services with Acceptable Options Within the Scope of the Class

When the identification of goods/services is unacceptable as indefinite, and more specific language that identifies goods/services in the class can be suggested, the examining attorney must require amendment of the wording and advise the applicant that any proposed amendment must be within the scope of the class of the international registration. The examining attorney should suggest acceptable identification(s) within the class. Any proposed amendment must *also* be within the scope of the wording of the identification as originally written (37 C.F.R. §2.71(a)).

Examples:

- The goods are identified as “headgear” in Class 25. A requirement for greater specificity is issued, offering suggestions for more narrowly identified goods in Class 25, such as “headgear, namely hats, beanies, bathing caps.” The examining attorney should not suggest items within the scope of “headgear” that are not in Class 25, such as “helmets” in Class 9 or “headgear for orthodontic appliances” in Class 10. The Office action must include an advisory that only goods within the scope of the IB-assigned class will be accepted.
- The services are identified as “consultation services” in Class 36. A requirement for more specificity is issued, offering suggestions for more narrowly recited services in Class 36, such as “banking consultation,” “credit consultation,” or “financial consultation.” The Office action must include an advisory that only services within the scope of the IB-assigned class will be accepted.
- The goods are identified as “video games” in Class 28. The examining attorney may suggest that the applicant adopt “hand held unit for playing video games” or “stand alone video game machines” or “arcade-type electronic video games” in Class 28. Any proposed amendment including goods in the nature of “video game software”

or “video game machines for use with external display screens” (both of which are Class 9 items under the current edition of the Nice Agreement) would be outside of the scope of the goods covered by the international registration, and such an amendment must be refused. The Office action must include an advisory that amendments may only include goods within the scope of the class assigned by the IB.

1904.02(c)(iii) Indefinite Identification of Goods/Services that Does not Include any Goods/Services Within the Class

In the rare situation where the identification is indefinite, and there appear to be no goods/services that are within the scope of the identification as presently worded that are properly classified in the indicated class, the examining attorney must nevertheless require the applicant to submit an acceptably definite identification. To be acceptable, any submitted amendment must be within the scope of the wording of the original goods/services.

The examining attorney should explain that he/she is unable to suggest substitute wording. The examining attorney may offer the applicant the option of deleting the unacceptable language from the application, but must not issue a requirement for the applicant to do so.

Examples:

- The services are identified as “food services” in Class 36. The identification is too broad to be acceptable, yet does not encompass any services that currently would be properly classified in Class 36, as restaurant services and other similar food and beverage services are in Class 43. The examining attorney need not make any suggestions as to acceptable wording, but must require the applicant to amend the recitation within the scope of services properly classified in Class 36 in accordance with the current edition of the Nice Agreement, and notify the Administrator of the serial number.
- The goods are identified as “engine pumps” in Class 12. The identification is too broad to be acceptable, yet does not encompass any goods that currently would be properly classified in Class 12, as water and oil pumps for land vehicle engines are in Class 7. The examining attorney need not make any suggestions as to acceptable wording, but must require the applicant to amend the identification within the scope of goods properly classified in Class 12 in accordance with the current edition of the Nice Agreement, and notify the Administrator of the serial number.

1904.02(c)(iv) Examination of Proposed Amendments and Issuance of Final Requirements For an Acceptable Identification

If, in response to the Office action, an applicant proposes an amendment that: (1) remains unacceptably indefinite; (2) is beyond the scope of the original wording; or (3) is beyond the scope of the class, the examining attorney must refuse to accept the amendment. If the proposed amendment raises no new issues and the application is otherwise in condition for a final action, the examining attorney must issue a final requirement for an acceptable identification.

The basis for refusing an unacceptably indefinite identification is the requirement for a list of “particular goods and services” in a complete application. 37 C.F.R. §2.32(a)(6). Trademark Rule 2.71(a) provides the basis for refusal of a proposed amendment that exceeds the scope of the originally identified goods/services, including wording beyond the scope of the class of the international registration. The applicant is not bound by the scope of the language in the unacceptable amendment but, rather, by the language of the identification before the proposed amendment. See TMEP §1402.07(d). The examining attorney should also advise the applicant that the previous items listed in the existing identification (not the unacceptable substitute) remain operative for purposes of future amendment. Once an applicant amends the identification of goods/services in a manner that is acceptable to the examining attorney, the amendment replaces all previous identifications, and thus restricts the scope of goods/services to that amended language. See TMEP 1402.07(e).

The examining attorney may suggest – but must not require – that the applicant delete an unacceptable term or phrase or proposed goods/services entry that fall outside the scope of the class. However, if deletion of an unacceptable identification would result in deletion of all goods/services from the §66(a) application, the examining attorney must not suggest that the applicant delete the unacceptable wording. Instead, the examining attorney must continue to require an acceptable amendment, making the requirement final if appropriate. If the application contains acceptable goods/services that can be approved for publication, and would otherwise be in condition for a partial abandonment advisory, the examining attorney should indicate that if an acceptable response is not received, the unacceptable goods/services will be abandoned and the application will proceed with the acceptable items only. See TMEP §718.02(a) regarding partial abandonment.

If it appears that there is an error in classification, the examining attorney may suggest the applicant contact the IB to request correction of or a limitation to the international registration. The USPTO will not suspend prosecution of the application unless the applicant requests suspension in a timely response to an Office action and supports the request with a copy of the request for correction filed with the IB. See TMEP §716.02(g). The applicant may also appeal the final identification requirement to the Trademark Trial and Appeal

Board, or petition to the Director to review the requirement, if permitted by 37 C.F.R. §2.63.

1904.02(c)(v) Effect of Indicated Classes – No Precedential Value on Later-Filed Applications

Because the IB determines classification assigned to goods and services encompassed by the international registration, and because registered extensions of protection may be based upon international registrations issued under previous editions of the Nice Agreement, the assigned classes in registered extensions of protection will not be considered as controlling in any later-filed U.S. applications to the extent such classification is contrary to USPTO policy. The classification of goods/services in registered extensions of protection and published applications under §66(a) is only relevant to the particular goods and services identified therein, and should not be relied upon in other applications to support classification or identification of goods or services that are otherwise unacceptable under current USPTO practice. See TMEP §1402.14.

1904.02(d) Certification and Collective Marks

Classes A, B, and 200 are classes from the old United States classification system that are still used in the United States to classify certification marks for goods (Class A), certification marks for services (Class B), and collective membership marks (Class 200). These classes are not included in the international classification system under the Nice Agreement.

However, a §66(a) application may indicate that the mark is a “Collective, Certificate or Guarantee Mark.” In such a case, the examining attorney will require the applicant to clarify for the record the type of mark for which it seeks protection. The examining attorney must also require the applicant to comply with the requirements for the particular type of mark, i.e., collective trademark, collective service mark, collective membership mark, or certification mark. See TMEP §§1303 *et seq.* regarding collective trademarks and collective service marks, TMEP §§1304 *et seq.* regarding collective membership marks, and TMEP §§1306 *et seq.* regarding certification marks.

If a §66(a) applicant indicates that the mark is a certification mark or collective membership mark, the USPTO **will not** reclassify it into United States Class A, B, or 200. However, the examining attorney must ensure that the applicant complies with all other United States requirements for certification or collective membership marks. See TMEP §§1304 *et seq.* and §§1306 *et seq.*

1904.02(e) Corrections and Limitations to the International Registration

1904.02(e)(i) Corrections

When the IB determines that there is an error concerning an international registration in the International Register, it corrects that error ex officio. Requests for correction may be submitted to the IB by the holder (i.e., a §66(a) applicant seeking protection in U.S.), the Office of Origin of the international application, or in some cases by the USPTO Administrator for Trademark Identifications, Classification and Practice.

Corrections that merely reclassify the originally identified goods/services may be accepted; however, any indefinite wording of the identification of such goods/services that was acceptably amended during the course of USPTO examination will remain as amended, that is, the amended wording is not affected or changed by the correction issued by the IB. When an applicant amends the identification of goods/services in a manner that is acceptable to the examining attorney, including voluntary deletion of goods/services, the amendment replaces all previous identifications, and thus restricts the scope of goods/services to that amended language. See TMEP 1402.07(e).

1904.02(e)(ii) Limitations

The holder of an international registration may record a limitation of the good/services, which may affect some or all of the designated Contracting Parties. Article 9^{bis}(iii). Upon recordation, the IB will notify the USPTO if the U.S. is affected by the limitation. The recording of a limitation does not remove the goods/services concerned from the international registration, but simply narrows the goods/services for which the holder seeks protection in the particular countries affected.

A limitation may set forth particular goods/services narrower in scope than the goods/services as identified in the international registration. For example, if the international registration covers “clothing,” the holder may limit the goods to “sweaters and pants” with respect to the U.S. Upon notification by the IB, if the examining attorney considers that the change requested is not in fact a limitation but an expansion of the list of goods/services, or is otherwise unacceptable, then the USPTO may declare that the limitation has no effect in the United States. Common Regs. 27(5)(a)-(c). For example, if the goods are identified as “clothing” in the international registration, and the limitation specifies “sweaters and hair bows,” the examining attorney must refuse to apply the “hair bows” portion of the limitation to the request for extension of protection to the United States because it expands, rather than limits, the scope of the goods of the international registration.

See TMEP §1906.01(e) regarding the filing of a request to record a limitation with the IB; TMEP §1904.03(g) regarding limitations in pending §66(a)

applications; and TMEP §1904.15 regarding limitations in registered extensions of protection to the United States.

1904.02(e)(iii) Limitations vs. Amendments

To the extent that an amendment of the identification in a §66(a) application narrows or restricts the goods/services, an amendment is comparable to a limitation affecting only the United States. A limitation filed at the IB by the applicant clarifying the nature of the goods/services may render the identification of goods/services in the §66(a) application sufficiently definite. Nevertheless, if the examining attorney has issued an Office action requiring amendment of the identification of goods/services, a proper response to the Office action must be received in the allowed time period. Simply recording a limitation with the IB is not a response to an Office action. The applicant must file a response with the USPTO within six months of the date on which the USPTO issued the Office action, stating that the applicant has recorded a limitation that will resolve the outstanding issue(s).

See TMEP §1906.01(e) regarding the filing of a request to record a limitation with the IB; TMEP §1904.03(g) regarding limitations in pending §66(a) applications; and TMEP §1904.15 regarding limitations in registered extensions of protection to the United States.

1904.02(f) Mark Must Be Registrable on Principal Register

There is no provision in the Trademark Act for registration of a mark in a request for an extension of protection on the Supplemental Register. If the proposed mark is not registrable on the Principal Register, the extension of protection must be refused. 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c).

1904.02(g) Refusal Must Be Made Within 18 Months

Under §68(c) of the Trademark Act and Article 5 of the Protocol, the USPTO must notify the IB of any refusal entered in a §66(a) application within 18 months of the date the IB transmits the request for extension of protection to the USPTO. See TMEP §1904.03(a).

The TRAM database tracks the period of time within which the USPTO must notify the IB of a refusal of protection. This information appears in the §66(a) International Registration data field "Auto Protection Date." If a refusal is not received by the IB as of this date, the mark receives automatic protection under Article 5(5) of the Protocol.

1904.02(h) Issuing Office Actions

The USPTO will send the first Office action in a §66(a) application to the IB. The first Office action is known as a provisional refusal and must be reviewed by the IB. If the provisional refusal meets the applicable requirements (see TMEP §§1904.03 *et seq.*), the IB will process the refusal and send it to the holder (i.e., the §66(a) applicant). The IB notifies the USPTO of the date on which it processed the refusal, and the USPTO updates the TRAM database with this information. A response to the Office action issued by the USPTO is due within six months of the date on which the USPTO sent the action to the IB, *not* the date on which the refusal was processed by the IB.

An examiner's amendment or a combined examiner's amendment/priority action (see TMEP §§707 *et seq.* and 708.05) may not be issued as a first Office action because the IB will not accept such amendments. Examiner's amendments and combined examiner's amendments/priority actions may be issued as second and subsequent actions if authorized by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner authorized to practice before the USPTO pursuant to 37 C.F.R. §11.14 ("qualified practitioner"). See TMEP §§602 *et seq.* regarding persons who are authorized to represent applicants, registrants, and parties to proceedings before the USPTO.

The USPTO will send second and subsequent Office actions directly to the applicant, at the correspondence address set forth in the request for extension of protection to the United States, or to the correspondence address provided in a subsequent communication filed in the USPTO. See TMEP §§609.01(a) and 1904.02(i) regarding correspondence in §66(a) applications.

1904.02(i) Correspondence Address

The address of the international registration holder's designated representative is treated as the correspondence address, unless a change of correspondence address is filed in the USPTO.

The USPTO will send second and subsequent Office actions, and other notices, directly to the §66(a) applicant's correspondence address of record.

In a §66(a) application or a registered extension of protection, the USPTO will accept a notice of change of the correspondence address, signed by the applicant or registrant, someone with legal authority to bind the applicant/registrant (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner, and will send correspondence to the new address. See 37 C.F.R. §§2.18(b)(2) and 2.193(e)(9) and TMEP §§609 *et seq.* regarding the procedures for establishing and changing the correspondence address in the USPTO.

A change of the correspondence address in the USPTO records will not affect the address of the holder's representative designated in the international registration, to which the IB sends correspondence. A request to record a change of the name or address of the representative designated in the international registration must be filed with the IB; it cannot be filed through the USPTO. See TMEP §1906.01(d). There are forms for changing the name or address of the representative on the IB website at <http://www.wipo.int/madrid/en/>. See also Common Reg. 36(i).

See TMEP §§602.03 *et seq.* regarding foreign attorneys and agents, TMEP §609.01(a) regarding correspondence in §66(a) applications, and TMEP §609.04 regarding correspondence with parties not domiciled in the United States.

1904.02(j) Mark Cannot Be Amended

The Madrid Protocol and the Common Regulations do not permit 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. The IB's *Guide to International Registration*, Para. B.II.69.02, provides as follows:

[T]here is no provision for a mark that is recorded in the International Register to be amended in any way, either on renewal or at any other time. If the holder wishes to protect the mark in a form which differs, even slightly, from the mark as recorded, he must file a new international application. This is true even if the mark has been allowed to be changed in the basic application, the registration resulting from the basic application or the basic registration, as the case may be....

Accordingly, because an application under §66(a) is a request to extend protection of the mark in an international registration to the United States, the Trademark Rules of Practice make no provision for amendment of the mark in a §66(a) application, and the USPTO will not permit such amendments. See 37 C.F.R. §2.72; TMEP §807.13(b). However, the applicant still must comply with the United States requirements regarding drawings and descriptions of the mark. See TMEP §1904.02(k).

1904.02(k) Drawings and Descriptions of the Mark

Though the mark in a §66(a) application cannot be amended, the applicant must comply with the United States requirements regarding drawings of the mark. 15 U.S.C. §1141h(a); 37 C.F.R. §§2.52 and 7.25(a).

If the drawing does not meet United States requirements (e.g., due to the improper inclusion of the federal registration symbol ® or the unacceptable reproductive quality of the image), the examining attorney will require a

substitute drawing. Furthermore, if the reproduction of the mark in the international registration consists of multiple renditions of a three-dimensional mark, the applicant will be required to either: (1) comply with the United States requirement to depict the mark in a single rendition, 37 C.F.R. §2.52(b)(2); or (2) petition the Director to waive this requirement. See TMEP Chapter 1700 regarding petitions, and TMEP §807.10 regarding drawings of three-dimensional marks.

If the international registration contains no color claim, but there is a color drawing in the international registration, the applicant must either: (1) submit a claim of the color(s) featured in the mark and describe their location; or (2) state for the record that no claim of color is made with respect to the international registration, and submit a black-and-white reproduction of the same mark depicted in the international registration. See TMEP §807.07(b).

A §66(a) applicant must also comply with United States requirements regarding descriptions of the mark. 37 C.F.R. §§2.37, 2.52(b)(5), and 7.25(a).

With respect to sound marks and other non-visual marks, if the international registration contains a visual depiction of some kind, such as a musical staff corresponding to the notes of a sound mark, the applicant will be required to comply with the United States requirements for a detailed description of the mark. See TMEP §807.09.

1904.02(I) Jurisdiction

The provisions with respect to requesting jurisdiction over published §66(a) applications are similar to those for applications under §§1(a) and 44 of the Trademark Act. 37 C.F.R. §2.84. However, when deciding whether to grant a request to restore jurisdiction in a §66(a) application, the Director must also consider the time limits for notifying the IB of a refusal, set forth in Article 5(2) of the Protocol and §68(c) of the Trademark Act, 15 U.S.C. §1141h(c).

1904.03 Notice of Refusal

1904.03(a) Notice Must be Sent Within 18 Months

Within 18 months of the date the IB forwards a request for extension of protection, the USPTO must transmit:

- (1) A notification of refusal based on examination;
- (2) A notification of refusal based on the filing of an opposition; or
- (3) A notification of the possibility that an opposition may be filed after expiration of the 18-month period. If the USPTO notifies the IB of the possibility of opposition, it must send the notification of refusal within

7 months after the beginning of the opposition period, or within one month after the end of opposition period, whichever is earlier.

Section 68(c) of the Trademark Act, 15 U.S.C. §1141h(c); Article 5.

If the USPTO does not send a notification of refusal of the request for extension of protection to the IB within 18 months, the request for extension of protection cannot be refused. Section 68(c)(4) of the Trademark Act; Article 5(5); Common Reg. 17(2)(iv). If the USPTO sends a notification of refusal, no grounds of refusal other than those set forth in the notice can be raised more than 18 months after the date on which the IB forwards the request for extension of protection to the USPTO. Section 68(c)(3) of the Trademark Act.

If upon re-examination the examining attorney determines a new ground of refusal exists, a second Office action raising this new ground may be issued only if time remains in the 18-month period. In such a case, the examining attorney must contact the MPU upon issuance of the Office action, so that a notification of the new ground of refusal can be sent to the IB.

1904.03(b) Requirements for Notice of Refusal

A final decision is not necessary; a provisional refusal is sufficient to meet the 18-month requirement. Under Common Reg. 17, a notice of provisional refusal must be dated and signed by the USPTO and must contain:

- The number of the international registration, preferably accompanied by an indication of the mark;
- All grounds of refusal;
- If there is a conflicting mark, the filing date, serial number, priority date (if any), registration date and number (if available), name and address of the owner, reproduction of the conflicting mark, and list of goods/services;
- A statement that the provisional refusal affects all the goods/services, or a list of the goods/services affected;
- The procedures and time limit for contesting the refusal, i.e., period for response or appeal of the refusal, and the authority with which an appeal can be filed;
- If the refusal is based on an opposition, the name and address of the opposer.

Common Reg. 17(2).

The IB will record the provisional refusal in the International Register and transmit it to the holder of the registration. Article 5(3); Common Reg. 17(4).

1904.03(c) §66(a) Applicant Must Respond to Notification of Refusal

A holder of an international registration who applies for an extension of protection to the United States will receive an initial notification of refusal through the IB. The holder must respond directly to the USPTO. The holder may be represented by an attorney, but only if such attorney meets the requirements of 37 C.F.R. §11.14 (see TMEP §§602 *et seq.*). Standard examination procedures are used to examine §66(a) applications. 15 U.S.C. §1141h.

A foreign attorney who does not meet the requirements of 37 C.F.R. §11.14 cannot represent the applicant before the USPTO or sign a response to an Office action on behalf of the applicant. 37 C.F.R. §11.5(b)(2). See TMEP §§602.03 *et seq.*, 611.02, 712.01, and 712.03.

1904.03(d) Refusal Pertaining to Less Than All the Goods/Services

If a notification of refusal in a §66(a) application does not pertain to all the goods/services, the mark may be protected for the remaining goods/services, even if the holder does not respond to the notification of refusal. Sections 68(c) and 69(a) of the Trademark Act, 15 U.S.C. §§1141h(c) and 1141i(a), provide that an application under §66(a) of the Trademark Act is automatically protected with respect to any goods or services for which the USPTO has not timely notified the IB of a refusal by either *ex officio* examination or opposition.

Accordingly, 37 C.F.R. §2.65(a) provides that if a refusal or requirement is expressly limited to only certain goods/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/services. See TMEP §718.02(a) for further information about partial abandonment.

1904.03(e) Confirmation or Withdrawal of Provisional Refusal

If the USPTO has sent a notice of provisional refusal, once the procedures regarding the refusal are complete, the USPTO must notify the IB that:

- (1) protection is refused for all goods/services;
- (2) the mark is protected for all goods/services; or
- (3) the mark is protected for some specified goods/services.

Common Reg. 17(5). The IB will record this notice and send it to the holder.

1904.03(f) Notification of Correction in the International Register with Respect to a Pending Request for Extension of Protection

When the IB determines that there is an error concerning an international registration in the International Register, it corrects that error *ex officio*. The IB will also correct an error at the request of the holder or the Office of Origin. Common Reg. 28(1). If the IB notifies the USPTO of a correction with regard to an international registration, the USPTO may declare in a notification to the IB that protection cannot, or can no longer, be granted to the international registration as corrected. Such a declaration must be sent to the IB within 18 months of notification of the correction. This may be done where there are grounds for refusal of the international registration as corrected which did not apply to the international registration as originally notified to the USPTO. Common Reg. 28(3).

Unlike limitations, which affect only the listing of goods and/or services, a correction can involve any element of the international registration, including the mark for which registration is sought, the effective filing date, or the claim of priority. Corrections are not to be treated as amendments from the applicant. They are also not responses to Office actions and do not toll the statutory response period.

If the MPU determines that a correction does have effect in the United States and does not require review by the examining attorney, the correction will be entered into the USPTO's database. The MPU trademark specialist will update the prosecution history in TRAM to reflect that the processing of the correction has been completed.

If the MPU determines that review by the examining attorney is required, the MPU will notify the examining attorney of the correction and the examining attorney will determine whether the correction raises any new grounds for refusal or basis for a new requirement. If the examining attorney determines that the correction raises new issues, he or she must issue an Office action refusing registration or making the necessary requirements and indicating the reasons why, supported by evidence, where appropriate. The examining attorney must also notify the MPU that a new Office action has been issued, and the MPU will ensure that the IB is notified of the new grounds for refusal. The applicant may argue against the refusal or requirement, and, if such refusal or requirement is made final, file an appeal to the Trademark Trial and Appeal Board or petition to the Director pursuant to 37 C.F.R. §2.146.

See *also* TMEP §1904.14 regarding corrections to registered extensions of protection, and TMEP §1906.01(f) for information about filing requests for correction with the IB.

1904.03(g) Notification of Limitation of the List of Goods/Services with Respect to a Pending Request for Extension of Protection

Limitation Due to Partial Cancellation of International Registration

When the USPTO receives notification from the IB that the international registration has been cancelled in part due to the ceasing of effect of the basic registration, the USPTO will partially cancel the pending request for extension of protection by limiting or removing the cancelled goods and/or services from the USPTO's trademark database. 15 U.S.C. §1141j(a); 37 C.F.R. §7.30. The MPU trademark specialist will determine what, if any, goods and/or services remain extended to the United States and narrow the listing of goods and/or services accordingly.

Voluntary Limitation by Holder of International Registration

Upon receipt of notification from the IB that a voluntary limitation of the list of goods/services may affect an extension of protection to the United States, the USPTO may declare that the limitation has no effect. Such a declaration must be sent to the IB within 18 months of notification of the limitation. The USPTO will indicate the reasons why the limitation has no effect, the corresponding essential provisions of the law, and whether the declaration is subject to review or appeal. Common Regs. 27(5)(a)-(c).

If the MPU determines that a limitation does have effect in the U.S., the limitation shall be entered into the trademark database with respect to the goods/services as identified at the time of receipt of the notification of limitation.

If the MPU determines that review by the examining attorney is required, the MPU will notify the examining attorney, and the examining attorney will determine whether the limited goods/services are within the scope of the identification of goods/services as originally identified in the §66(a) application. For example, if the request for extension of protection originally lists goods as "clothing" in International Class 25, and the applicant submits a response to an Office action proposing to amend such goods to "clothing, namely pants, shirts, and dresses," and the USPTO later receives a voluntary limitation that lists the goods as "clothing for women," the consideration of scope is against the original identification of "clothing." If it is determined that the limitation is not an expansion of the scope of the original listing, the limited goods/services will then be considered in light of any interim amendments proposed by the applicant during prosecution of the application. In the example above, the proposed wording "clothing, namely, pants, shirts, and dresses" will be further limited to "clothing *for women*, namely, pants, shirts, and dresses."

If the examining attorney determines that the limitation is not acceptable (e.g., because he or she determines that the change requested results in an extension rather than a limitation of the goods/services), he or she must issue an Office action refusing the limitation and indicating the reasons why the limitation is unacceptable. If the listing of goods/services is not an expansion of the original goods/services but is itself indefinite by USPTO standards (e.g., “clothing for women”), the examining attorney must issue a new requirement for a sufficiently definite identification and may supersede any previously issued requirement to the extent it remains outstanding at the time of examination of the limitation. If the examining attorney issues a new Office action relating to the limitation of goods/services, he/she must also notify the MPU, and the MPU will ensure that the IB is notified when a limitation is found to have no effect in the United States. The applicant may argue against the refusal of the limitation, and, if such refusal is made final, file an appeal to the Trademark Trial and Appeal Board or petition to the Director pursuant to 37 C.F.R. §2.63(b).

If an Office action requiring only that the identification be amended is outstanding, it is possible that a limitation notice processed before the end of the response period would resolve the issue. If the examining attorney determines that the identification proposed in the limitation is acceptable and puts the application in condition for approval for publication, the examining attorney may issue a no-call examiner’s amendment that acknowledges receipt of the limitation and states that the requirement for a more definite identification is satisfied and may then approve the application for publication.

If a limitation results in the deletion of all goods/services identified in the §66(a) application, the application will be abandoned.

See *also* TMEP §1906.01(e) for information about filing requests to record limitations with the IB, and TMEP §1904.15 regarding limitations in the list of goods/services in registered extensions of protection.

1904.04 Opposition

Section 68(a)(2) of the Trademark Act, 15 U.S.C. §1141h(a)(2), provides that a request for extension of protection is subject to opposition under §13 of the Trademark Act. As noted above, the USPTO must notify the IB within 18 months of the date the IB sends the request for extension of protection to the USPTO of: (1) a notification of refusal based on the filing of an opposition; or (2) a notification of the possibility that an opposition may be filed after expiration of the 18-month period.

The notice must state the dates on which the opposition period begins and ends, if known. If the dates are unknown, the USPTO must communicate them to the IB “at the latest at the same time as any notification of a provisional refusal based on an opposition.” Common Reg. 16(1)(b).

Any notification of refusal on the basis of opposition must be received by the IB within 7 months after the beginning of the opposition period or within one month after the end of the opposition period, whichever is earlier. 15 U.S.C. §1141h(c)(2); Article 5(2)(c)(ii).

An opposition to a §66(a) application must be filed through the Electronic System for Trademark Trials and Appeals (“ESTTA”). 37 C.F.R. §2.101(b)(2). *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005). The notice of opposition must include all fees for each party opposer to oppose the registration in all classes specified in the opposition. 37 C.F.R. §2.101(d)(2). Once filed, an opposition to a §66(a) application may not be amended to change or add to the grounds for opposition, or to add to the goods or services opposed. 37 C.F.R. §2.107(b).

Request for Extension of Time to Oppose. A request for extension of time to oppose a §66(a) application must be filed through ESTTA. 37 C.F.R. §2.102(a)(2).

No more than three requests to extend the time for filing an opposition may be filed. The time for filing an opposition may not be extended beyond 180 days from the date of publication. 37 C.F.R. §2.102(c).

See TMEP §§1503 *et seq.* for further information about oppositions.

1904.05 Certificate of Extension of Protection

If the mark in a §66(a) application is published for opposition and is not opposed, or survives all oppositions filed, the USPTO will issue a certificate of extension of protection and publish notice of such certificate in the *Official Gazette*. Section 69(a) of the Trademark Act, 15 U.S.C. §1141i(a). From the date of issuance of the certificate, the extension of protection has the same effect and validity as a registration on the Principal Register, and the holder of the international registration has the same rights and remedies as the owner of a registration on the Principal Register. Section 69(b) of the Trademark Act, 15 U.S.C. §1141i(b). The certificate of registration will look the same as the certificate issued for registrations resulting from applications under §§1 and 44 of the Trademark Act (see TMEP §1601.01(a)).

Upon registration, the USPTO will refer to an extension of protection to the United States as a “registration,” “registered extension of protection,” or a “§66(a) registration.” 37 C.F.R. §7.25(c).

A registered extension of protection always remains part of and dependent upon the international registration. In this respect, a registered extension of protection differs from a §44 registration, which is independent from the underlying foreign registration, pursuant to 15 U.S.C. §1126(f).

See TMEP §§1613 and 1904.10 regarding the requirement for an affidavit of use or excusable nonuse under §71 of the Trademark Act, 15 U.S.C. §1141k; TMEP §1905 regarding renewal and expiration of international registrations in general; and TMEP §1614 for information about renewal of registered extensions of protection.

1904.06 Assignment of Extension of Protection to the United States

Under §72 of the Trademark Act, 15 U.S.C. §1141*l*, an extension of protection to the United States may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment in a country that is either: (1) party to the Madrid Protocol, or (2) a member of an intergovernmental organization that is a party to the Madrid Protocol.

Because an extension of protection remains part of the international registration, assignments of extensions of protection to the United States must first be recorded at the IB. A holder or assignee cannot file an assignment (or other document transferring title) of an extension of protection to the United States directly with the Assignment Services Branch of the USPTO. The USPTO will record only those assignments (or other documents transferring title) that have been recorded with the IB. The IB will notify the USPTO of any changes in ownership recorded in the International Register, and the USPTO will automatically update the trademark database and the assignment database to reflect the change(s). See TMEP §501.07.

See TMEP §§1906.01 *et seq.* regarding requests to record a change of ownership in the International Register.

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to §66(a) applications or registered extensions of protection. 37 C.F.R. §7.22.

1904.07 Invalidity of Protection in United States

An extension of protection to the United States may be invalidated in an administrative or judicial proceeding governed by United States law, such as a cancellation proceeding before the Trademark Trial and Appeal Board or a federal court proceeding. The USPTO must notify the IB if an extension of protection to the United States is invalidated. Article 5(6). The requirements for a notice of invalidation are set forth in Common Reg. 19.

1904.08 Cancellation of International Registration By IB

If the IB notifies the USPTO that an international registration has been cancelled with respect to some or all of the goods/services, the USPTO will cancel the extension of protection of that international registration to the

United States with respect to such goods/services as of the date on which the IB cancelled the international registration. 15 U.S.C. §1141j(a); 37 C.F.R. §7.30.

See TMEP §1905 regarding renewal of international registrations in general, and TMEP §1614 for information about renewal of registered extensions of protection to the United States.

1904.09 Transformation to Application Under §1 or §44

An international registration is dependent on the basic application and/or basic registration for five years after the date of the international registration. Article 6(3). If the basic application or registration is restricted, abandoned, cancelled, or expired with respect to some or all of the goods or services listed in the international registration, the Office of Origin will notify the IB, and the IB will cancel or restrict the international registration and notify the USPTO of the cancellation or restriction. Article 6(4). See TMEP §1902.09. The USPTO will cancel, in whole or in part, the corresponding §66(a) application or registered extension of protection.

In this situation, the holder of the international registration may “transform” the cancelled §66(a) application or registered extension of protection into an application under §1 or §44 of the Trademark Act for registration of the same mark for any or all of the cancelled goods/services that were covered by the extension of protection. 15 U.S.C. §1141j; Article 9^{quinquies}.

A §66(a) application can be transformed only if the international registration is cancelled or restricted at the request of the Office of Origin under Article 6(4), due to the cancellation of the basic application and/or registration. It is not available if the international registration expires for failure to renew, is cancelled or restricted at the request of the holder, or is cancelled or restricted for any other reason. Article 9^{quinquies}; 15 U.S.C. §1141j(c); 37 C.F.R. §7.31. See TMEP 1904.09(a) for the requirements for transformation.

1904.09(a) Requirements for Transformation

A request for transformation must be filed within three months after the date on which the international registration was cancelled, in whole or in part. Article 9^{quinquies}(i); 15 U.S.C. §1141j(c). The request must include:

- (1) The serial number or registration number of the extension of protection to the United States (i.e., the §66(a) application or registered extension of protection);
- (2) The name and address of the holder of the international registration;
- (3) The domestic application filing fee required by 37 C.F.R. §2.6(a)(1) for at least one class of goods or services; and

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

37 C.F.R. §7.31(a).

The holder must file the request for transformation directly with the USPTO, and the transformed application will be examined as a domestic application.

Under §70(c) of the Trademark Act, 15 U.S.C. §1141j(c), and Article 9^{quinquies}, transformation may take place only if the international registration is cancelled or restricted *at the request of the Office of Origin under Article 6(4), due to the cancellation of the basic application and/or registration*. It is not available if the international registration expires for failure to renew, is cancelled or restricted at the request of the holder, or is cancelled or restricted for any other reason.

The request for transformation should be mailed using the First Class Service of the USPS to the following address:

Madrid Processing Unit
600 Dulany Street
MDE-7B87
Alexandria, Virginia 22314-5793

37 C.F.R. §§2.190(e) and 7.4(b). Alternatively, the request may be delivered by hand or courier to the Trademark Assistance Center, at James Madison Building, East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:30 a.m. to 5:00 p.m. Eastern Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c). The certificate of mailing or transmission procedures of 37 C.F.R. §2.197 and Express Mail provisions of 37 C.F.R. §2.198 do not apply to requests for transformation. 37 C.F.R. §§2.197(a)(2)(ii), 7.4(b)(2), and 7.4(e).

Requests for transformation cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(6).

1904.09(b) Examination of Transformed Application

A “transformed” application under §1 or §44 of the Trademark Act resulting from the transformation of a cancelled extension of protection must comply with all the requirements of the Trademark Act and Trademark Rules of Practice. 37 C.F.R. §7.31(c). The USPTO will assign a new serial number, and will link the prosecution history of the cancelled extension of protection to the new “transformed” application. A notation of the serial number to which the cancelled extension of protection is transformed appears in the electronic record of the cancelled extension of protection, under “Other Information” in the TRAM database (in the “Transformed To” field). Similarly, a notation of the serial number of the cancelled request for extension of protection appears

in the TRAM record for the new transformed application (in the “Transformed From” field).

The “transformed” application will have the same filing date as the cancelled extension of protection, that 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 of recordal of the subsequent designation with the IB, if the request for extension of protection to the United States was made in a subsequent designation. If the extension of protection was entitled to priority under §67 of the Trademark Act, 15 U.S.C. §1141g, the new application is entitled to the same priority.

If an examining attorney has already searched USPTO records for conflicting marks, the examining attorney assigned to the transformed application does not have to conduct a new search, since the effective filing date will not change. The examining attorney must either ensure that a copy of the search statement is placed in the electronic record of the transformed application, or make a note, in the “Notes-to-the-File” section of the record, indicating the date on which the search was conducted and the serial number of the §66(a) application in which the search statement is of record.

The examining attorney must require the applicant to submit a verified statement in support of the application that relates back to the filing date of the transformed application. See TMEP §804.02 regarding the essential allegations required to verify an application for registration of a mark under §1 or §44, and TMEP §804.04 regarding persons properly authorized to sign a verification on behalf of an applicant.

If it is unclear from the transformation request, the examining attorney must require the holder to clarify whether the holder seeks registration for all of the goods/services that were covered by the cancelled extension of protection.

Even if the mark in the extension of protection was already published or registered, republication will be required, due to the substitution of a new basis for registration. 37 C.F.R. §2.35(b)(2).

Generally, in examining a “transformed” application where the extension of protection was published or registered, the USPTO will only issue requirements or refusals related to the new §1 or §44 basis. However, in some cases, where a significant length of time has elapsed since the initial examination of the request for extension of protection, refusal of registration may be appropriate due to changed circumstances. For example, the mark may have become descriptive or generic as applied to the goods/services.

1904.10 Affidavits of Use or Excusable Nonuse Required

Under §71 of the Trademark Act, 15 U.S.C. §1141k, a registered extension of protection to the United States will be cancelled if the holder of the

international registration fails to periodically file affidavits of use in commerce or excusable nonuse. See TMEP §1613 for further information.

1904.11 Incontestability

Under §73 of the Trademark Act, 15 U.S.C. §1141m, if a holder files an affidavit that meets the requirements of §15 of the Trademark Act, a registered extension of protection to the United States may become “incontestable”. The period of continuous use on which an affidavit of incontestability may be based may begin no earlier than the date of issuance of the registered extension of protection, unless the holder owns a prior U.S. registration of the same mark for the same goods/services. 15 U.S.C. §1141m-n. See TMEP §§1605 *et seq.* regarding the requirements for an affidavit of incontestability under §15 of the Trademark Act.

1904.12 Replacement

If a United States national registration and a subsequently issued certificate of extension of protection of an international registration to the United States are: (1) owned by the same person; (2) identify the same mark; and (3) list the same goods/services, then the extension of protection shall have the same rights as those accrued to the United States national registration at the time the certificate of extension of protection issues. Section 74 of the Trademark Act, 15 U.S.C. §1141n; 37 C.F.R. §7.28(a); Article 4^{bis}.

Legally, replacement takes place automatically, by operation of law. However, the USPTO will note the replacement in its records (and notify the IB accordingly) only if the holder of a registered extension of protection files a request that it do so. A request to note replacement of a United States national registration with a registered extension of protection must include:

- (1) The serial number or registration number of the extension of protection to the United States (i.e., the §66(a) application or registered extension of protection);
- (2) The registration number of the replaced United States registration;
and
- (3) The fee required by 37 C.F.R. §7.6.

37 C.F.R. §7.28(b).

The holder cannot file the request to note replacement of the United States national registration until the registration based on the request for extension of protection issues.

“Replacement” does not invalidate the United States national registration. The United States national registration remains on the register, with all the

rights attaching to such a registration, as long as the holder renews the registration under §9 of the Trademark Act and files the necessary affidavits of use or excusable nonuse under §8 of the Trademark Act. 37 C.F.R. §7.29. It is up to the holder to decide whether to maintain the replaced United States national registration.

1904.13 Amendment and Correction of Registered Extension of Protection to the United States

All requests to record changes to an international registration and associated extensions of protection must be filed at the IB. Accordingly, the holder of a registered extension of protection of an international registration to the United States may file a request for amendment or correction under §7 of the Trademark Act with the USPTO only in limited circumstances, where the change will affect only the extension of protection to the United States. See TMEP §§1609.01(a), 1609.02, 1904.13(a), and 1904.13(b) for further information.

1904.13(a) Limited Amendments to Registered Extension of Protection

The holder of a registered extension of protection may request certain changes under §7 of the Trademark Act, 15 U.S.C. §1057, that will affect only the extension of protection in the U.S. For example, an applicant may request to amend the registered extension of protection to add a voluntary disclaimer, to amend the translation of the mark as provided during examination, or to limit or partially delete goods, services, or classes. TMEP §1609.01(a). If the USPTO grants the §7 request, the USPTO will notify the IB of the change to the extension of protection to the United States.

The USPTO will not accept an amendment of a registered extension of protection involving the holder's name or address that has not been recorded with the IB. 37 C.F.R. §7.22; TMEP §1906.01(c).

The mark in a registered extension of protection cannot be amended. See TMEP §§1609.02 and 1906.01(i).

See *also* TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB.

1904.13(b) Corrections to Registered Extensions of Protection

Generally, all requests to record changes to an international registration must be filed at the IB, because an extension of protection of an international registration remains part of the international registration even after registration in the United States. However, in the limited circumstance where the holder of an international registration makes a mistake in a document filed during

prosecution in the USPTO that affects only the extension of protection to the United States, the registrant may request correction of the error pursuant to 37 C.F.R. §2.175. For example, if there was a minor typographical error in an amendment to the identification of goods in a §66(a) application, and the mark registered with such an error, the owner of the registration could request correction. If the USPTO grants the request, the USPTO will notify the IB of the change to the extension of protection to the United States.

If a clerical error occurred through the fault of the USPTO, which is apparent from a review of USPTO records, the USPTO will correct the error without charge. See TMEP §1609.10(a) for procedures for requesting correction of a USPTO error and §1609.10(b) regarding correction of a registrant's error.

1904.14 Notification of Correction in the International Register with Respect to Registered Extension of Protection

When the IB determines that there is an error concerning an international registration in the International Register, it corrects that error *ex officio*. The IB will also correct errors at the request of the holder or the Office of Origin. Common Reg. 28(1). See TMEP §1906.01(f). If the IB notifies the USPTO of a correction of an international registration, the USPTO may declare in a notification to the IB that protection cannot, or can no longer, be granted to the international registration as corrected. This may be done where there are grounds for refusal of the international registration as corrected which did not apply to the international registration as originally notified to the USPTO. Common Reg. 28(3).

Upon receipt of a notification of correction in a registered extension of protection, the MPU shall determine whether the correction would require republication of the mark. If republication would not be required, the MPU will enter the correction in the trademark database and ensure that a certificate of correction is issued to the holder.

When a notification of correction received from the IB prior to registration is not acted upon in sufficient time or is received too late to withdraw the application from issuance of a registration, the resulting registration generally will be treated as inadvertently issued. However, to the extent possible given the nature of the correction, the holder will be given the opportunity to keep the registration as issued and the USPTO will create a child application for any corrected goods/services/classes. The USPTO will notify the holder via the last correspondence address of record as to the receipt of the correction and the options for processing. To the extent a correction involves issues that cannot be handled by the creation of a child application, such as a material alteration of the mark, the registration will be cancelled as inadvertently issued and examined in accordance with Office policy and procedures.

When a notification of correction is received after the USPTO has issued a registered extension of protection, the correction will be reviewed in the MPU to determine if the registration may be corrected, as no republication would be required to implement the correction. When the correction would not trigger a requirement for republication, the MPU will make the correction and schedule the issuance of an updated registration certificate, as necessary.

If the MPU determines that entry of the correction would require further examination, the holder will be given the opportunity to keep the registration as issued and to divide any corrected goods, services, and/or classes affected into a child application pursuant to 37 C.F.R. §2.87. See TMEP §§1110-1110.12. The holder may also request the entire file be restored to pendency and the application will be re-examined as corrected.

Upon receipt of a correction that would affect the rights deriving from the international registration, the USPTO is afforded a new period of 18 months within which to notify the IB of any newly arising grounds for refusal. To the extent any requirements or refusals are applicable to the corrected data, the examining attorney shall issue an Office action, which will be forwarded by the MPU to the IB, as required by Section 68(c)(1), 15 U.S.C. §1141h(c)(1), and Rule 28(e) of the Common Regulations. The examining attorney must contact the MPU upon issuance of such an action so that it will be forwarded as required.

See *also* TMEP §1904.03(f) regarding corrections to pending §66(a) applications, and TMEP §1906.01(f) for information about filing a request for correction with the IB.

1904.15 Notification of Limitation of the List of Goods/Services with Respect to Registered Extension of Protection

Limitation Due to Partial Cancellation of International Registration

When the USPTO receives notification from the IB that the international registration has been cancelled in part due to the ceasing of effect of the basic registration, the USPTO will partially cancel the registered extension of protection by updating the USPTO's trademark database and issuing an updated registration certificate. 15 U.S.C. §1141j(a); 37 C.F.R. §7.30 The MPU will determine what, if any, goods and/or services remain extended to the United States and narrow the listing of goods and/or services accordingly.

Voluntary Limitation by Holder of International Registration

Upon receipt of notification from the IB that a voluntary limitation of the list of goods/services affects the United States, the USPTO may declare that the limitation has no effect. Such a declaration must be sent to the IB within 18 months of notification of the limitation. The USPTO will indicate the reasons for which the limitation has no effect, the corresponding essential provisions

of the law, and whether the declaration is subject to review or appeal. Common Regs. 27(5)(a)-(c).

If the MPU trademark specialist determines that the limitation has no effect in the United States (e.g., because he or she determines that the change requested results in an extension rather than a limitation of the goods/services), the MPU will forward the case to the Post Registration division to issue a post-registration Office action refusing the limitation as an unacceptable amendment of the registered extension of protection under Section 7. 15 U.S.C. §1057. See TMEP §1609.03 regarding amendment of the identification of goods or services in a registered extension of protection. Once issued, the MPU will forward a copy of the Office action declaring the limitation to have no effect to the IB within 18 months of the date of the IB's notification of the limitation.

If the MPU trademark specialist determines that the limitation does have effect in the United States, the MPU trademark specialist will enter the limitation into the trademark database and ensure that an updated registration certificate is issued to the holder.

If a limitation results in the deletion of all goods/services identified in the registered extension of protection, the registration will be cancelled.

See *also* TMEP §1904.03(g) regarding limitations of the goods/services in pending §66(a) applications, and TMEP §1906.01(e) for information about filing a request to record a limitation with the IB.

1905 Renewal of International Registrations

The term of an international registration is ten years, and it may be renewed for ten years upon payment of the renewal fee. Articles 6(1) and 7(1). Renewal of international registrations must be made at the IB, in accordance with Article 7 and Common Regs. 29 - 31. There is a renewal form, form MM11, on the IB website at <http://www.wipo.int/madrid/en/>.

The USPTO will not process a request to renew an international registration nor forward it to the IB. 37 C.F.R. §7.41.

The USPTO does not issue inquiries to the owner of a §66(a) application or registered extension of protection as to whether an international registration has been renewed. Under §70(b) of the Trademark Act, 15 U.S.C. §1141j(b), and Article 3^{ter}(2) of the Protocol, if the international registration is not renewed, the IB will notify the USPTO that the registration has expired. The USPTO will then cancel the registered extension of protection or abandon the §66(a) application as of the expiration date of the international registration.

See TMEP §1614 regarding renewal of a registered extension of protection to the United States.

1906 Communications With International Bureau Regarding International Registrations

Information about communicating directly with the IB is available on the WIPO website at <http://www.wipo.int/madrid/en/>. The IB can be contacted by mail to 34 chemin des Colombettes, P.O. Box 18, 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.

1906.01 Recording Changes in International Register

The IB will record changes and other matters concerning international registrations in the International Register. Such requests are governed by Articles 9 and 9^{bis} and Common Reg. 25. Some of the changes that can be recorded in the International Register are:

- Change in ownership of the registration;
- Change of holder's name and address;
- Change in name or address of holder's representative;
- Limitation, renunciation, or cancellation of international registration.

Most requests to record changes must be filed with the IB on the IB's forms, available on the IB website at <http://www.wipo.int/madrid/en/>. There are only two limited situations in which a request to record a change may be filed with the IB through the USPTO:

- (1) an assignment that meets the requirements of 37 C.F.R. §7.23(a) (see TMEP §1906.01(a)(i)); or
- (2) a security interest or other restriction of a holder's right to dispose of an international registration (or the release of such a restriction) that meets the requirements of 37 C.F.R. §§7.24(a) and (b) (see TMEP §1906.01(b)).

37 C.F.R. §7.22.

1906.01(a) Change in Ownership of International Registration

The IB will record a change in ownership by assignment, merger, court decision, or operation of law at the request of the holder, the Contracting Party of the holder, or an interested person. Article 9; Common Reg. 25(1)(a)(i). The change may relate to some or all of the goods/services in some or all of the designated Contracting Parties. A fee is required.

Most requests to record changes of ownership must be filed directly with the IB. 37 C.F.R. §§7.22 and 7.23. Form MM5 is available on the IB website at

<http://www.wipo.int/madrid/en/> for that purpose. The IB does not require copies of assignments or other supporting documents. See TMEP §1906.01(a)(i) regarding the limited circumstances in which a request to record a change in ownership may be filed with the IB through the USPTO.

1906.01(a)(i) Requirements for Submitting Changes in Ownership of International Registration Through the USPTO

The USPTO will accept for submission and forward to the IB a request to record a change of ownership only if *all* of the following conditions have been met:

- (1) the assignee cannot obtain the assignor's signature on the request to record the change;
- (2) the assignee is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States; and
- (3) the assigned goods/services applies to the designation to the United States.

37 C.F.R. §7.23.

No other requests to record changes of ownership can be filed through the USPTO. 37 C.F.R. §§7.22 and 7.23.

A request to record a change of ownership filed through the USPTO must also include:

- The international registration number;
- The name and address of the holder of the international registration;
- The name and address of the assignee of the international registration;
- A statement that the assignee: (i) is a national of the United States; (ii) has a domicile in the United States; or (iii) 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 United States domicile or establishment;
- A statement that the assignee could not obtain the assignor's signature for the request to record the assignment;
- An indication that the assignment applies to the designation to the United States;

- A statement that the assignment applies to all the goods/services in the international registration, or if less, a list of the goods/services in the international registration that have been assigned that pertain to the designation to the United States; and
- The USPTO transmittal fee required by 37 C.F.R. §7.6.

37 C.F.R. §7.23(a).

The USPTO currently does not have a TEAS form available for requests to record a change of ownership of an international registration. A holder must use the official IB form MM5 available on the IB website at: <http://www.wipo.int/madrid/en>. The IB will not accept paper requests that are not presented on the official IB form. The form cannot be handwritten. Comm Reg. 25(1)(a); Madrid Admin. Instr. §6(a). The holder should complete the form online, print the completed form and submit it to the USPTO by mail, hand delivery, or courier service.

The completed form submitted through the USPTO must be mailed using the First Class Service of the USPS to:

Madrid Processing Unit
600 Dulany Street
MDE-7B87
Alexandria, Virginia 22314-5793

37 C.F.R. §§2.190(e) and 7.4(b). Alternatively, requests to record changes of ownership may be delivered by hand or courier to the Trademark Assistance Center at James Madison Building, East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:30 a.m. to 5:00 p.m. Eastern Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c).

Requests to record changes of ownership cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(4).

If a request to record a change of ownership is mailed to the USPTO via the Express Mail Service of the USPS, the USPTO will deem that the request to record was submitted on the day it was deposited as Express Mail, provided that the holder complies with the requirements for correspondence sent by Express Mail set forth in 37 C.F.R. §2.198. See TMEP §305.03 regarding Express Mail.

The holder should include a self-addressed, stamped postcard with the paper-filed request to record a change of ownership. Upon receipt, the USPTO will place a label indicating the receipt date on the postcard and return it to the holder.

If the request meets the requirements of 37 C.F.R. §7.23(a), the USPTO will forward it to the IB. 37 C.F.R. §7.23(b). If the request does not meet these requirements, the USPTO will not forward the request to the IB, and will notify the holder of the reasons. The USPTO will not refund the transmittal fee. 37 C.F.R. §7.23(c).

If the IB determines that a request to record a change sent through the USPTO is irregular, the IB will notify both the USPTO and the holder. Common Reg. 26(1). The holder must file a response to any notice of irregularity with the IB; the response cannot be filed through the USPTO. 37 C.F.R. §7.23(d).

Occasionally, extraordinary circumstances render the assignee of an international registration for which the USPTO was the Office of Origin unable to secure the signature of the holder of that registration. In that instance, the assignee may petition the Director to waive the requirements of 37 C.F.R. §§7.23(a)(6) and (7), pursuant to 37 C.F.R. §2.146. See TMEP Chapter 1700 regarding petitions to the Director.

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to assignments of an international registration. 37 C.F.R. §7.22.

1906.01(a)(ii) International Fees for Recording Changes of Ownership of International Registration

The international fee for a request to record a change of ownership must be paid directly to the IB in Swiss currency, and may be paid either before or after submission of the request to record. 37 C.F.R. §7.7(c). However, fees paid after the document is received by the IB could result in a notice of irregularity. See TMEP §1903.02 regarding payment of international fees to the IB.

1906.01(a)(iii) Effect of Change of Ownership of International Registration

The validity of a change in ownership with respect to a particular Contracting Party is governed by the law of that Contracting Party. The office of a designated Contracting Party may declare that a change in ownership has no effect in its territory. The declaration must be sent to the IB within 18 months of the date of IB's notification of the change. Common Reg. 27(4).

1906.01(a)(iv) Dividing an International Registration After Change of Ownership With Respect to Some But Not All of the Goods/Services

When ownership of an international registration changes with respect to some but not all of the goods/services for all designated Contracting Parties, the IB

will create a separate new international registration for the goods/services that have been transferred, and notify the USPTO accordingly. See the IB's *Guide to International Registration*, Para. B.II.65.01.

When the IB notifies the USPTO of the division of an international registration resulting from a change of ownership with respect to some but not all of the goods or services, the USPTO will construe the IB's notice as a request to divide. See 37 C.F.R. §§2.87(g) and 2.171(b)(2).

See TMEP §1110.11 regarding division of a pending §66(a) application after a partial change of ownership, TMEP §1615.02 regarding division of a registered extension of protection after a partial change of ownership, and TMEP §501.07 regarding assignment of extensions of protection.

1906.01(b) Restriction of Holder's Rights of Disposal

Under Common Reg. 20(1)(a), a holder of an international registration or a Contracting Party of the holder (i.e., a Contracting Party in which the holder is a national, is domiciled, or has a real and effective business or commercial establishment) may inform the IB that the holder's right to dispose of the international registration has been restricted in whole or in part. Also, under Common Reg. 20(1)(b), the office of any designated Contracting Party may inform the IB that the holder's right of disposal has been restricted in the territory of that Contracting Party. Examples of restrictions on the holder's right to dispose are security interests and court orders concerning the disposal of the assets of the holder.

The USPTO will accept for submission and forward to the IB a request to record a restriction of a holder's right to dispose of an international registration, or the release of such a restriction, *only if all of the following conditions have been met*:

- (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;
- (3) the restriction or release applies to the holder's right to dispose of the international registration in the United States; and
- (4) the restriction or release applies to the designation to the United States.

37 C.F.R. §7.24(a).

All other requests to record restrictions must be filed with the IB. 37 C.F.R. §§7.22 and 7.24(a).

A request to record a restriction filed through the USPTO must include:

- The international registration number;
- The name and address of the holder of the international registration;
- The name and address of the party who obtained the restriction;
- A statement that the party who submitted the request: (i) is a national of the United States; (ii) has a domicile in the United States; or (iii) 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 United States domicile or establishment;
- A statement that (i) 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;
- A summary of the main facts concerning the restriction;
- An indication that the restriction, or the release of the restriction, of the holder's right to dispose of the international registration applies to the designation to the United States; and
- The United States transmittal fee required by 37 C.F.R. §7.6.

37 C.F.R. §7.24(b).

A request to record a restriction or release submitted through the USPTO must be mailed using the First Class Service of the USPS to:

Madrid Processing Unit
600 Dulany Street
MDE-7B87
Alexandria, Virginia 22314-5793

37 C.F.R. §§2.190(e) and 7.4(b). Alternatively, requests to record restrictions or releases may be delivered by hand or courier to the Trademark Assistance Center, at James Madison Building, East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:30 a.m. to 5:00 p.m. Eastern Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c).

Requests to record restrictions or releases cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(5).

If a request to record a restriction or release is mailed to the USPTO via the Express Mail Service of the USPS, the USPTO will deem that the request was submitted on the day it was deposited as Express Mail, provided that the holder complies with the requirements for correspondence sent by Express Mail set forth in 37 C.F.R. §2.198. See TMEP §305.03 regarding Express Mail.

If the request meets the requirements of 37 C.F.R. §7.24(b), the USPTO will forward it to the IB. 37 C.F.R. §7.24(c). If the request does not meet these requirements, the USPTO will refuse to forward the request to the IB, and will notify the holder of the reasons. The USPTO will not refund the transmittal fee. 37 C.F.R. §7.24(d).

If the IB determines that a request to record a restriction sent through the USPTO is irregular, the IB will notify both the USPTO and the holder. Common Reg. 26(1). The holder must file a response to any notice of irregularity with the IB; the response cannot be filed through the USPTO. 37 C.F.R. §7.24(e).

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to restrictions of a holder's right to dispose of an international registration. 37 C.F.R. §7.22.

1906.01(c) Change of the Holder's Name or Address

A request to record a change of the holder's name or address must be filed with the IB; it cannot be filed through the USPTO. 37 C.F.R. §7.22. Form MM9 is available for this purpose on the IB website at <http://www.wipo.int/madrid/en/>. Article 9^{bis}; Common Reg. 25(2).

1906.01(d) Change of Name or Address of Representative

A request to record a change of the representative's name or address must be filed with the IB; it cannot be filed through the USPTO. 37 C.F.R. §7.22. Form MM10 is available for such requests on the IB website at <http://www.wipo.int/madrid/en/>. See also Common Reg. 36(i).

See TMEP §§609.01(a) and 1904.02(i) regarding the correspondence address in a request for extension of protection to the United States.

1906.01(e) Limitation, Renunciation, or Cancellation of International Registration

Requests to record a limitation, renunciation or cancellation of an international registration must be filed with the IB; they cannot be filed through the USPTO.

37 C.F.R. §7.22. There are forms for such requests on the IB website at <http://www.wipo.int/madrid/en/forms>. Under Article 9^{bis}, a holder may record the following restrictions:

- Limitation of the list of goods/services with respect to some or all of the designated Contracting Parties (Common Reg. 25(1)(a)(ii));
- Cancellation of the international registration with respect to all the designated Contracting Parties for some or all of the goods/services (Common Reg. 25(1)(a)(v));
- Renunciation with respect to some but not all of the designated Contracting Parties for all the goods/services (Common Reg. 25(1)(a)(iii)).

The office of a designated Contracting Party may declare that a limitation has no effect in its territory, e.g., because it determines that the change requested results in an extension rather than a limitation. Such declaration must be sent to the IB within 18 months of the date of the IB's notification of the limitation. Common Reg. 27(5).

See TMEP §1904.03(g) regarding limitations in pending §66(a) applications, and TMEP §1904.15 regarding limitations in registered extensions of protection to the United States. See *also* TMEP §1904.02(e)(ii).

1906.01(f) Correction of Errors in International Registration

The IB will correct errors in an international registration at the request of the holder or the Office of Origin. Common Reg. 28(1). Requests to correct errors in international registrations in which the USPTO was the Office of Origin must be filed directly with the IB, unless the error was made by the USPTO.

The office of a designated Contracting Party may declare in a notification of provisional refusal that protection can no longer be granted to an international registration as corrected. A new refusal period under Article 5 of the Protocol and Common Regs. 16-17 starts to run from the date of the correction, but only in respect to grounds that did not exist prior to the correction. Common Reg. 28(3).

See TMEP §1904.03(f) regarding corrections to §66(a) applications, and TMEP §1904.14 regarding corrections to registered extensions of protection.

1906.01(g) Merger of International Registrations

Where the same party is the holder of two or more international registrations of the same mark due to a partial change in ownership, that party may request the IB to record a merger of the registrations. Common Reg. 27(3).

The request must be filed with the IB; it cannot be filed through the USPTO. 37 C.F.R. §7.22.

1906.01(h) License

Under Common Reg. 20^{bis}(1), a holder may file a request to record a license, a request for amendment of the recording of a license, or a request for cancellation of the recording of a license. Requests to record a license, or to cancel or amend the recording of a license, cannot be filed through the USPTO. 37 C.F.R. §7.22. There are forms for these requests on the IB website at <http://www.wipo.int/madrid/en/>. A designated Contracting Party may declare that the recording of a license has no effect in its territory. The declaration must be sent within 18 months of the IB's notification of recording of the license. Common Reg. 20^{bis}(5).

1906.01(i) Changes That Cannot Be Made to International Registration

Mark in International Registration Cannot Be Changed. There is no provision for a mark to be amended in any way, at any time, even if the mark in the basic application or basic registration changes. *Guide to International Registration*, Para. B.II.69.02.

Goods/Services in International Registration Cannot be Expanded. It is not possible to expand the list of goods/services, even if the added goods/services were listed in the basic application or registration. *Guide to International Registration*, Para. B.II.69.03.