§ 1.761–3 [Corrected]

2. On page 2941, column 1, § 1.761–3(d)(2), *Example 3.,* paragraph (ii), line 10, the language, ''warrant comprise an investment unit with'' is corrected to read ''warrant comprise an investment unit within''.

Cynthia E. Grigsby,

Chief, Regulations Unit, Associate Chief Counsel (Procedure and Administration).

[FR Doc. 03–7525 Filed 3–27–03; 8:45 am]

BILLING CODE 4830–01–P

DEPARTMENT OF THE TREASURY

Internal Revenue Service

26 CFR Part 31

[REG–116641–01]

RIN 1545–BA17

Information Reporting and Backup Withholding for Payment Card Transactions; Correction

AGENCY: Internal Revenue Service (IRS), Treasury.

ACTION: Correction to notice of proposed rulemaking; notice of proposed rulemaking by cross-reference to temporary regulations; and notice of public hearing.

SUMMARY: This document contains corrections to a notice of proposed rulemaking; notice of proposed rulemaking by cross-reference to temporary regulations; and notice of public hearing. (REG–116641–01) which was published in the **Federal Register** on Friday, January 31, 2003 (68 FR 4970). This regulation relates to the IRS Taxpayer Identification Number (TIN) Matching Program. The text of the temporary regulations published in the Rules and Regulations section of this issue of the **Federal Register** serves as the text of this portion of the proposed regulations. This document also contains proposed regulations relating to the information reporting requirements, information reporting penalties, and backup withholding requirements for payment card transactions.

FOR FURTHER INFORMATION CONTACT: Donna Welch at (202) 622–4910 (not a toll-free number).

SUPPLEMENTARY INFORMATION:

Background

The proposed regulations that are the subject of these corrections are under section 3406 of the Internal Revenue Code.

Need for Correction

As published, this notice of proposed rulemaking contains errors that may prove to be misleading and are in need of clarification.

Correction of Publication

Accordingly, the publication of the notice of proposed rulemaking, (REG–116641–01), which is the subject of FR. Doc. 03–2208, is corrected as follows:

1. On page 4971, column 1, in the preamble, paragraph 1, line 4, the language ''payments. Section 1.6041–3(q)(1)'' is corrected to read ''payments. Section 1.6041–3(p)(1)''.

§ 31.3406(g)–1 [Corrected]

2. On page 4973, column 1, § 31.3406(g)–1(f)(1)(ii), line 7, the language ''payee is a not a qualified payee'' is corrected to read ''payee is not a qualified payee''.

Cynthia E. Grigsby,

Chief, Regulations Unit, Associate Chief Counsel (Procedure and Administration).

[FR Doc. 03–7267 Filed 3–27–03; 8:45 am]

BILLING CODE 4830–01–P

DEPARTMENT OF THE TREASURY

Alcohol and Tobacco Tax and Trade Bureau

27 CFR Parts 7 and 25

[Notice No. 4]

RIN 1512–AC11

Flavored Malt Beverages and Related Proposals (2001R–136P)

AGENCY: Alcohol and Tobacco Tax and Trade Bureau (TTB), Treasury.

ACTION: Notice of proposed rulemaking; correction.

SUMMARY: This document corrects the preamble to a proposed rule published in the **Federal Register** on March 24, 2003, regarding flavored malt beverages. We inadvertently published an incorrect telephone number for submitting comments by fax. This correction gives the correct telephone number for submitting comments by fax.

FOR FURTHER INFORMATION CONTACT: Charles N. Bacon, Alcohol and Tobacco Tax and Trade Bureau, Regulations and Procedures Division, 10 Causeway Street, Room 701, Boston, MA 02222; telephone 617–557–1323.

Correction

In proposed rule FR Doc. 03–6855, beginning on page 14292 in the issue of March 24, 2003, make the following correction in the **SUPPLEMENTARY INFORMATION** section. On page 14300, in the second column, under the heading C. How May I Submit Comments?, correct the second paragraph to read:

''*By fax:* You may submit comments by facsimile transmission to 202–927–8525. We will treat faxed transmissions as originals.''

Dated: March 25, 2003.

John J. Manfreda,

Acting Administrator.

[FR Doc. 03–7624 Filed 3–27–03; 8:45 am]

BILLING CODE 4810–31–P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 2 and 7

[Docket No. 2003–T–010]

RIN 0651–AB45

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

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking; Notice of hearing.

SUMMARY: The United States Patent and Trademark Office (Office) proposes to amend existing regulations and add new regulations to the rules of practice to implement the Madrid Protocol Implementation Act of 2002 (MPIA). The MPIA provides that: the owner of a U.S. application or registration may seek protection of its mark in any of the 57 countries party to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) by submitting a single international application through the Office to the International Bureau of the World Intellectual Property Organization (IB); and the owner of an application or registration in a country party to the Madrid Protocol may obtain an international registration from the IB and request an extension of protection of its mark to the United States.

DATES: Comments must be received by May 27, 2003 to ensure consideration. A public hearing will be held at 10 a.m., Friday, May 30, 2003, in the Patent Theater, 2121 Crystal Drive, Room 200, Arlington, Virginia. Submit requests to present oral testimony on or before May 20, 2003.

ADDRESSES: Submit comments by electronic mail (e-mail) to: *madridrules.comments@uspto.gov.* Written comments may also be

submitted by mail or hand delivery to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202, attention Cheryl L. Black. Copies of all comments will be available for public inspection in Suite 10B10, South Tower Building, 10th floor, 2900 Crystal Drive, Arlington, Virginia 22202–3513, from 8:30 a.m. until 5 p.m., Monday through Friday.

FOR FURTHER INFORMATION CONTACT: Cheryl L. Black, Office of the Commissioner for Trademarks, by telephone at (703) 308–8910, extension 153, by e-mail to *cheryl.black@uspto.gov,* or by facsimile at (703) 872–9292.

SUPPLEMENTARY INFORMATION: The Madrid Protocol Implementation Act of 2002, Pub. L. 107–273, 116 Stat. 1758, 1913–1921 (MPIA) amends the Trademark Act of 1946 to implement the provisions of the Madrid Protocol in the United States. The Madrid Protocol provides a process of filing an international application with requests for extensions of protection to any of the 57 member countries of the Protocol. The MPIA was enacted on November 2, 2002, and becomes effective on November 2, 2003.

The Madrid Protocol and the Common Regulations Under the Madrid Agreement and the Protocol (Common Regulations) are available online at *http://www.wipo.int/madrid/en/.*

References below to ''the Act,'' ''the Trademark Act,'' or ''the statute'' refer to the Trademark Act of 1946, 15 U.S.C. 1051 *et seq.*, as amended by the MPIA.

Filings under Madrid Protocol

Background

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

The international application must be submitted through the trademark office of the Contracting Party in which the basic application 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 or registration, and transmit the international application to the IB.

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

The holder of an international registration may designate additional Contracting Parties in a subsequent designation. A subsequent designation is a request by the holder of an international registration for an extension of protection of its international registration to additional Contracting Parties. Each Contracting Party designated in an international application or in a subsequent designation will examine the request for extension of protection as a national application under its laws.

Discussion of Specific Rules Changed or Added

The Office proposes to add new rules setting forth the requirements for submitting international applications and subsequent designations through the Office for forwarding to the IB. The Office also proposes to add new rules for processing requests for extension of protection of international registrations designating the United States.

The Office proposes to add rules 7.1, 7.3, 7.4, 7.6, 7.7, 7.11, 7.12, 7.13, 7.14, 7.21, 7.22, 7.23, 7.24, 7.25, 7.26, 7.27, 7.28, 7.29, 7.30, 7.31, 7.36, 7.37, 7.38, 7.39, 7.40, and 7.41; and designate part 7 of 37 CFR as the rules of practice in filings pursuant to the Madrid Protocol.

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

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

Proposed § 7.4 states that correspondence submitted electronically will be accorded the date and time the complete transmission is received in the Office based on Eastern Time.

Fees

The Office proposes to require fees for processing filings under the Madrid Protocol. Proposed § 7.6 sets forth the fees payable to the Office for processing correspondence relating to international applications and registrations. These fees must be paid in U.S. dollars at the time of submission.

The Office proposes to charge a fee: (1) For reviewing and certifying an international application; (2) for transmitting a subsequent designation; (3) for transmitting a request to record an assignment or restriction of a holder's right of disposal of an international registration; (4) for requesting a notice of replacement; and (5) for filing an affidavit of use in commerce or excusable nonuse for a mark in a registered extension of protection to the United States.

In addition to the fees required by the Office, there are international fees for processing international applications and registrations. Proposed § 7.7 sets forth the international fees payable to the IB in connection with international applications and registrations, and the requirements and procedures for submitting these fees through the Office. A schedule of the international fees is posted at *http://www.wipo.int/madrid/en/.* The international applicant or holder may pay the fees directly to the IB, or to the IB through the Office. Fees paid directly to the IB must be paid in Swiss francs, and fees paid through the Office must be paid in U.S. dollars. The fees that may be paid through the Office are listed in proposed § 7.7(b).

Under proposed § 7.7(c), international fees paid through the Office must be paid in U.S. dollars at the time of submission. To pay fees directly to the IB, the international applicant or holder must either: (1) Establish an account with the IB for debiting fees, and set forth the number of that account as proof of payment in its submission to the Office; or (2) pay the fees to the IB using any other method of payment, and include the IB receipt number for payment of the fees as proof of payment in its submission to the Office.

International Applications Originating from the United States

The requirements for granting a date of receipt to an international application submitted through the Office are set forth in proposed § 7.11(a). The Office proposes to require the submission of an international application through the Trademark Electronic Application System (TEAS). An international application must identify at least one basic application or registration. The international application may be based on more than one basic U.S. application and/or registration, provided that the owner and the mark are the same for each basic U.S. application or registration.

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

Proposed § 7.11(a)(3) requires a reproduction of the mark in the international application that is identical to the mark in the basic application or registration and that meets the drawing requirements of § 2.52. If the mark in the basic application or registration is depicted in black and white, the reproduction of the mark in the international application must be black and white. If the mark in the basic application or registration is in color, the mark in the international application must be in color. If a mark for which there is a claim of color is depicted in black and white in the basic application or registration, the international application must include both a black and white reproduction of the mark and a color reproduction of the mark.

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

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

Proposed § 7.11(a)(7) requires a list of goods and/or services in the international application that is identical to or narrower than the list of goods and/or services in the basic application or registration, and is classified according to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. The applicant may omit goods and/or services from the international application as long as the omission does not broaden the scope of the goods or services identified in the basic application or registration.

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

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

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

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

Correcting Irregularities in International Application—Proposed § 7.14

The IB will notify both the international applicant and the Office of any irregularities in the international application. The international applicant is responsible for correcting the irregularities before the end of the response period set forth in the IB's notice to avoid abandonment of the international application. Under rule 11 of the Common Regulations, there are some irregularities that must be corrected through the Office and some that must be corrected directly with the IB. Proposed § 7.14 sets forth the types of irregularities that must be corrected through the Office and the procedures for responding to these irregularities through the Office.

Under proposed § 7.14(d), the Office would require that applicants use TEAS to correct irregularities through the Office. To assist the Office in its efforts to timely transmit the response or fee to the IB, applicants should submit their responses or fee as early as possible, at least one month prior to the end of the IB's response period.

Irregularities in Classification and Identification of Goods/Services

Rules 12 and 13 of the Common Regulations provide that the IB will not consider a response to irregularities in classification and identification of goods and/or services that is not submitted through the office of origin. Proposed § 7.14(b) provides that an international applicant must respond to irregularities in classification and identification of goods and/or services through the Office. The Office will forward an applicant's response to the IB; however, the Office will not review the response or respond to an irregularity on behalf of an applicant.

Additional Fees for Correcting Irregularities in an International Application

The IB may require an international applicant to pay additional fees as a result of irregularities in the classification of goods or services, or because the international fees submitted with the application were insufficient. Under proposed § 7.14(c), the applicant may pay the additional fees directly to the IB or through the Office. The international applicant must correct the fee irregularities before the end of the response period set forth in the IB's notice, or the international application will abandon at the IB. Under proposed § 7.14(d), if the international applicant is paying the additional fees through the Office, the fees must be paid through TEAS and should be submitted at least one month before the end of the IB's response period.

Other Irregularities

Under proposed § 7.14(e), all other irregularities in the international application must be corrected directly at the IB. Failure to correct certain irregularities by the end of the IB's response period will result in the abandonment of the international application.

Subsequent Designations—Proposed § 7.21

Section 64 of the Act and proposed § 7.21 permit the holder of an international registration to submit a subsequent designation through the Office, if the holder is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States. The holder also has

the option of filing the subsequent designation directly with the IB.

Under proposed § 7.21, if the subsequent designation is submitted through the Office, it must be submitted through TEAS and include the international registration number, the name and address of the holder of the international registration, one or more Contracting Parties in which an extension of protection is sought, and a list of goods and/or services that is identical to or narrower than the goods and/or services listed in the international registration. The holder can omit goods and/or services listed in the international registration as long as the omission does not broaden the scope of the goods or services identified in the international registration. The holder must include the transmittal fee and all subsequent designation fees required by the IB at the time of submission. The Office is not required to certify the subsequent designation.

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

Recording Changes to International Registration

Most changes to international registrations can be recorded directly with the IB. Proposed § 7.22(a) requires that all requests to record changes to an international registration be filed at the IB, except in the limited circumstances in which they must be submitted through the Office, as set forth in proposed §§ 7.23 and 7.24.

Proposed § 7.22(b) provides that assignments or restrictions of a holder's rights of disposal of an international registration must be recorded by the IB, and that section 10 of the Act and part 3 of this chapter are not applicable to such assignments or restrictions.

Proposed § 7.22(c) provides that when the Office is notified by the IB of an assignment or restriction of a holder's right to dispose of an international registration with an extension of protection to the United States, the Office will take note of the assignment or restriction in its records. The Assignment Services Division of the Office will record only assignments and restrictions of extensions of protection to the United States that have been recorded at the IB.

Proposed § 7.23 sets forth the limited circumstances in which a request to record an assignment of an international registration may be submitted through the Office, and the requirements for submitting these requests. Under proposed § 7.23, the Office will forward a request to record an assignment of an international registration to the IB only if: (1) The request is submitted by an assignee who is a national of, is domiciled in or has a real and effective commercial or industrial establishment in the U.S.; and (2) the assignee cannot obtain the assignor's signature for the request to record the assignment.

Proposed § 7.24 sets forth the limited circumstances in which a request to record a restriction of a holder's right to dispose of an international registration may be submitted through the Office, and the requirements for submitting these requests. Under proposed § 7.24, the Office will forward a request to record a restriction of a holder's right of disposal of an international registration (usually a security interest) only if: (1) 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; (2) the party holding the restriction is a national of, is domiciled in or has a real and effective commercial or industrial establishment in the U.S.; and (3) the signature of the holder of the international registration cannot be obtained for the request to record the restriction. The Office proposes to charge a fee for transmitting a request to record an assignment or restriction to the IB.

Requests for Extension of Protection to the United States

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

The holder may make a request for extension of protection to the United States either in the international application or in a subsequent designation filed with the IB. Section 66(a) of the Act requires that a request for extension of protection to the United States include a declaration of bona fide intention to use the mark in commerce. The IB will certify that the request for extension of protection contains a declaration of bona fide intention to use the mark in commerce when it forwards the request to the Office. The declaration will remain as part of the international registration on file at the IB.

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

Proposed § 7.25 provides that for purposes of examination and opposition, a request for an extension of protection to the United States will be treated as an application for registration based on an extension of protection of an international registration under section 66(a) of the Act; and that references to ''applications'' and ''registrations'' in part 2 of this chapter include extensions of protection to the United States. With the exception of §§ 2.130–2.131, 2.160–2.166, 2.168 and 2.181–2.186, all the sections in part 2 apply to a request for extension of protection to the United States.

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

Under section 67 of the Act and proposed § 7.27, the holder of an international registration may claim priority under Article 4 of the Paris Convention for the Protection of Industrial Property if: (1) the request for an extension of protection contains a claim of priority; and (2) the international registration date or the date of recordal of the subsequent designation requesting an extension of protection to the United States is no later than 6 months after the filing date of the application that formed the basis of the claim of priority.

Replacement

Under section 74 of the Act and proposed § 7.28(a), a registered extension of protection to the United States has the same rights as a previously issued U.S. registration if: (1) both registrations are owned by the same person and identify the same mark; and (2) the goods/services in the previously issued U.S. registration are covered by the registered extension of protection. Under proposed § 7.28(b), the holder of a pending or registered

extension of protection may request that the Office note in its records replacement of the earlier U.S. registration by the extension of protection. The Office proposes to require a fee to note replacement.

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

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

Under section 70 of the Act and proposed § 7.30, the Office will cancel a pending or registered extension of protection to the United States if the IB notifies the Office of the cancellation or expiration of the corresponding international registration, in whole or in part.

Transformation

Under section 70(c) of the Act and proposed § 7.31(a), if an international registration is cancelled by the IB at the request of the office of origin under Article 6(4) of the Madrid Protocol (due to the cancellation or expiration of the basic application or registration), the holder of the international registration may file a request to transform the corresponding extension of protection to the United States into an application under section 1 or 44 of the Act. The requirements for transformation are set forth in proposed § 7.31(b).

The holder of an international registration must file the request for transformation through TEAS within 3 months of the cancellation date of the international registration. The request must include an application filing fee for at least one class of goods and/or services.

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

Under proposed § 7.31(e), if the holder does not meet the requirements of § 7.31(b), the Office will not process the request for transformation.

Maintaining an Extension of Protection to the United States

Section 71 of the Act and proposed § 7.36 require a holder of an international registration with a registered extension of protection to the United States to file an affidavit or declaration of use in commerce or excusable nonuse during the following time periods: (1) between the fifth and sixth year after registration; and (2) within the six-month period before the end of every ten-year period after the date of registration, or upon payment of a grace period surcharge, within the three-month grace period immediately following.

Under proposed § 7.41, renewal of an international registration must be made directly with the IB. A request for renewal of an international registration cannot be submitted through the Office. Renewal of international registrations is governed by Article 7 of the Madrid Protocol and Rules 29–31 of the Common Regulations. The term of an international registration is ten years, and it may be renewed for ten years upon payment of the renewal fee.

Amendment to Part 2 Rules

If an international registration is not renewed, the registration will lapse, and the IB will notify the Office. Pursuant to section 70(b) of the Act, the Office will cancel the extension of protection to the United States.

There is no requirement in the MPIA that the holder of a registered extension of protection to the United States renew the extension of protection in the Office under section 9 of the Act.

In addition to the new rules added as part 7 of 37 CFR, the Office proposes to amend rules and add new rules to part 2 of 37 CFR to bring the rules of practice in trademark cases into conformance with the MPIA and to set forth the requirements for examination of, registration of and proceedings before the Trademark Trial and Appeal Board relating to extensions of protection to the United States.

The Office proposes to amend rules 2.2, 2.11, 2.17, 2.18, 2.19, 2.21, 2.33, 2.34, 2.35, 2.37, 2.47, 2.51, 2.52, 2.65, 2.66, 2.72, 2.73, 2.75, 2.84, 2.101, 2.102, 2.104, 2.105, 2.107, 2.111, 2.112, 2.113, 2.118, 2.123, 2.127, 2.128, 2.130, 2.131, 2.142, 2.145, 2.146, 2.151, and 2.171; and to add rules 2.53, 2.54, and 2.126.

The Office proposes to amend § 2.2 to add definitions of ''ESTTA'' (Electronic System for Trademark Trials and Appeals), ''international application,'' and ''Office.''

The Office proposes to revise § 2.11 and its heading to indicate that representation before the Office is governed by § 10.14 of this chapter. It is redundant to have provisions governing representation before the Office in both parts 2 and 10.

The Office proposes to reword § 2.17(b) and to add a reference to § 10.14(b).

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

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

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

The Office proposes to amend § 2.33 by adding a new paragraph (e), stating that in an application under section 66(a) of the Act, the verified statement is part of the international registration on file at the IB.

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

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

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

The Office proposes to revise § 2.34(b) to provide that more than one basis can be claimed only in an application under

section 1 or 44 of the Act, and that a basis under section 66(a) of the Act cannot be combined with any other basis.

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

The Office proposes to revise § 2.35(b) to set forth the requirements for adding, substituting or deleting a basis in an application under section 1 or section 44 of the Act. This is consistent with current §§ 2.35(a) and 2.35(b).

The Office proposes to redesignate §§ 2.35(c) through 2.35(h) as §§ 2.35(b)(3) through 2.35(b)(8).

The Office proposes to add a new § 2.37(b), requiring that if a mark has color, the applicant must identify the color(s) and describe where they appear on the mark. This is consistent with the requirements for international applications under the Madrid Protocol.

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

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

The Office proposes to revise § 2.52 to clarify the types of drawings and format for drawings. There are two types of drawings: (1) Standard character (typed) drawings; and (2) special form drawings. Currently the rules refer to a standard character drawing as a ''typed drawing.'' The Office proposes to use the term ''standard character'' because this is the term used for international applications under the Madrid Protocol. Proposed § 2.52(a) sets forth the requirements for a standard character drawing, and proposed § 2.52(b) sets forth the requirements for a special form drawing. Additional requirements for drawings filed through TEAS are set forth in proposed § 2.53, and additional requirements for paper drawings are set forth in proposed § 2.54.

Proposed § 2.52(b)(1) requires that if color is claimed as a feature of the mark or if the mark consists only of color, the drawing must show the mark in color. Currently, the Office does not accept color drawings. Under current rules, to show color in a mark, an applicant must submit a black and white drawing, with a statement identifying the color(s) and describing where they appear in the mark. Alternatively, an applicant may show color by using the lining chart set forth in TMEP § 807.09(b).

Effective November 2, 2003, the Office will accept color drawings, and will require that applicants whose marks comprise color submit a drawing that shows color. The Office will no longer accept black and white drawings with a color claim, or drawings that are ''lined for color.''

Proposed § 2.52(b)(1) requires that an applicant submit a black and white drawing if color is not claimed as a feature of the mark. This is consistent with the requirements for international applications under the Madrid Protocol.

Proposed § 2.52(b)(1) further requires that applicant name the color(s) and describe where they appear on the mark.

The proposed rule does not prohibit the use of gray tones. The Office will process drawings with gray tones as black and white drawings unless the application includes a statement that applicant is claiming the color gray. Thus, an applicant must submit a color claim if applicant wants to show gray in the mark.

The Office proposes to add § 2.53, setting forth the requirements for a drawing filed through TEAS. Proposed § 2.53(b) requires that applicant attach a digitized image of the mark to the electronic submission. The image must be no larger than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide; must be in .jpg format; and must be scanned at no less than 250 and no more than 350 dots per inch. The image that is scanned must be made with a pen or by a process that will provide high definition when copied. These requirements are necessary to ensure that the Office database contains a clear and accurate reproduction of the mark. The 8 cm by 8 cm size requirement is consistent with the size requirement for an international application.

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

The Office proposes to amend § 2.65 to add a new paragraph (d), stating 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. This is a change in practice. Currently, failure to respond to a refusal that pertains to fewer than all the goods and services, or fewer than all the classes, in an application will result in abandonment of the entire application. See TMEP § 1403.05. This change will result in fewer abandonments and comports with sections 68(c) and 69(a) of the Act, which provide that an application under section 66(a) of the Act is automatically protected with respect to any goods or services for which the Office has not timely notified the IB of a refusal.

The Office proposes to amend § 2.66(a) to require that a petition to revive an abandoned application based on unintentional delay be filed within two months of the mailing date of the notice of abandonment. The Office proposes to remove § 2.66(a)(2), which provides that such a petition may be filed within two months of actual knowledge of the abandonment if the applicant did not receive the notice of abandonment and the applicant was diligent in checking the status of the application.

Effective October 30, 1999, the standard for reviving abandoned applications was changed from ''unavoidable delay'' to ''unintentional delay.'' See notices at 64 FR 48900 (Sept. 8, 1999) and 1226 TMOG 103 (Sept. 28, 1999). Since that time, there has been a substantial increase in the number of petitions to revive filed in the Office. Third parties may be harmed by the revival of a pending application many months after its abandonment and removal from the Office database. For example, a third party may have searched the Office database and commenced using a mark because the search showed no earlier-filed conflicting marks. Or an examining attorney may have searched the Office database and approved a later-filed application for a conflicting mark because the database indicated that the earlier-filed application was abandoned. To minimize this problem, the Office proposes to adopt a stricter time limit for filing petitions to revive under § 2.66. Moreover, the strict time limits for issuing refusals to requests for extension of protection under section 66(a) of the Act requires greater accuracy of the Office database.

The Office proposes to add a new § 2.72(d), stating that in an application under section 66(a) of the Act, the applicant may amend the description or drawing of the mark only if the proposed amendment does not materially alter the mark, and that the Office will determine whether a proposed amendment materially alters a

mark by comparing the proposed amendment with the description or drawing of the mark in the international application on file at the IB.

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

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

The Office proposes to revise §§ 2.84(a) and (b) to add references to the new filing basis under section 66(a) of the Act. The provisions with respect to jurisdiction over published section 66(a) applications are the same as those in applications under sections 1(a) and 44 of the Act.

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

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

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

The Office proposes to revise § 2.101(d)(1) through § 2.101(d)(3) and to add new § 2.101(d)(3)(i) through § 2.101(d)(3)(iii) to indicate that the Office will not accept an opposition submitted through ESTTA that does not include fees to cover all named party opposers and all classes opposed; that the Office will not institute an opposition proceeding if an opposition submitted on paper does not include a fee sufficient to pay for one person to oppose the registration of a mark in at least one class; and that the Office will no longer correspond with an opposer in an opposition submitted on paper to permit submission of additional fees or designation of party opposers and/or classes where an opposition is submitted with insufficient fees to pay for opposition by all party opposers and/or in all classes. The revision explains how the Office will apply a fee accompanying a paper submission that is insufficient to cover all classes and/or to cover all party opposers.

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

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

The Office proposes to revise § 2.102(c) to set out the time frames for extensions of time to oppose and to indicate that the Trademark Trial and Appeal Board will no longer extend a potential opposer's time to file an opposition beyond 120 days from the date the mark is published for opposition. The Office proposes to add §§ 2.102(c)(1) and (2) to state the requirements concerning the filing of permitted requests to extend the time for filing an opposition.

The Office proposes to remove §2.102(d), which requires submission of extension requests in triplicate.

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

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

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

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

The Office proposes to add a new § 2.107(b) to state that pleadings in an opposition proceeding against an application filed under section 66(a) of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court; except that, once filed, such opposition may not be amended to change or add to the grounds for opposition or to add to the goods or services opposed.

The Office proposes to revise § 2.111(b) to substitute ''person'' for ''entity'' to track the statutory language; to make the rule gender neutral; to clarify the definitions of ''attorney'' and ''authorized representative'' by reference to §§ 10.1(c) and 10.14(b), respectively; to clarify that an opposition must be signed; and to indicate that electronic signatures are required for electronically filed oppositions.

The Office proposes to revise § 2.111(c) to divide it into four paragraphs; to state that the Office will not accept a petition submitted through ESTTA that does not include fees to cover all named party petitioners and all classes; that the Office will not institute a cancellation proceeding if a petition submitted on paper does not include a fee sufficient to pay for one person for a cancellation in at least one class; and that the Office will no longer correspond with a petitioner in a cancellation submitted on paper to permit submission of additional fees or designation of party petitioners and/or classes where a cancellation is submitted with insufficient fees to pay for cancellation by all party petitioners and/or in all classes. The revision explains how the Office will apply a fee accompanying a paper submission that is insufficient to cover all classes and/or to cover all party petitioners.

The Office proposes to amend § 2.112(a) to substitute ''person'' for ''entity'' to track the statutory language; to make the rule gender neutral; and to remove the requirement that a duplicate copy of the petition, including exhibits, be filed with the petition.

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

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

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

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

The Office proposes to add new § 2.126, entitled ''Form of submissions to the Trademark Trial and Appeal Board,'' which includes paragraphs (a) through (d). Paragraphs (a) through (c) provide that submissions may be made to the Board on paper, CD-ROM, or electronically, as permitted by the rules contained in this part or Board practice; and specify the requirements for each type of submission. Paragraph (d) specifies the requirements for making a submission to the Board that is confidential in whole or in part.

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

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

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

The Office proposes to amend § 2.131 to change the term ''examiner'' to ''trademark examining attorney''; and to limit the applicability of this section to inter partes proceedings involving applications under sections 1 and 44 of the Act.

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

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

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

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

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

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

Third parties are harmed by the removal and later reinsertion of an application or registration in the Office database. To minimize this problem, the Office proposes to adopt stricter time limits for the filing of petitions to revive or reinstate abandoned applications and cancelled or expired registrations.

The Office proposes to revise § 2.151 to add a reference to section 71 of the Act, which requires periodic affidavits of use or excusable nonuse to maintain a registration based on an extension of protection of an international registration.

The Office proposes to add a new § 2.171(b), stating that when ownership of a registration has changed with respect to some but not all of the goods and/or services, the registrant(s) may file a request that the registration be physically divided into two or more separate registrations, upon payment of the required fee for each new separate registration created by the division.

Rule Making Requirements

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

Executive Order 12866: This rule making has been determined not to be significant for purposes of Executive Order 12866.

Regulatory Flexibility Act: The Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business

Administration that the proposed rule changes will not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The main purpose of the proposed rules is to implement legislation that provides an additional means for filing trademark applications. Additionally, the rules provide for some technical and other changes that will simplify the trademark application process. Hence, the rules merely provide all applicants for trademark registration, including small businesses, with additional benefits.

Paperwork Reduction Act: The proposed rules are in conformity with the requirements of the Paperwork Reduction Act of 1995 (PRA) (44 U.S.C. 3501 *et seq.*). Notwithstanding any other provision of law, no person is required to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the PRA unless that collection of information displays a currently valid OMB control number.

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

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

Send comments regarding this burden estimate, or any other aspect of this data collection, including suggestions for reducing the burden, to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202–3513 (Attn: Ari Leifman), and to the Office of Information and Regulatory Affairs, OMB, 725 17th Street, NW., Washington, DC 20230 (Attn: PTO Desk Officer).

List of Subjects

37 CFR Part 2

Administrative practice and procedure, Trademarks.

37 CFR Part 7

Administrative practice and procedure, Trademarks.

For the reasons given in the preamble and under the authority contained in 35 U.S.C. 2 and 15 U.S.C. 1123, as amended, the Office proposes to amend title 37 as follows:

PART 2—RULES OF PRACTICE IN TRADEMARK CASES

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

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

2. Amend § 2.2 to add new paragraphs (c) through (e), to read as follows:

§ 2.2 Definitions.

* * * * *

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

(d) The term international application as used in this part means an application for international registration that is filed under the Madrid Protocol.

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

3. Revise § 2.11 and its heading to read as follows:

§ 2.11 Representation before the Office.

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

4. Amend § 2.17 by revising paragraph (b) to read as follows:

§ 2.17 Recognition for representation.

* * * * *

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

* * * * *

5. Revise § 2.18 to read as follows:

§ 2.18 Correspondence, with whom held.

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

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

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

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

6. Revise § 2.19 and its heading to read as follows:

§ 2.19 Revocation of power of attorney; withdrawal.

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

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

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

§ 2.21 Requirements for receiving a filing date.

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

* * * * *

8. Amend § 2.33 by adding a new paragraph (e) to read as follows:

§ 2.33 Verified statement.

* * * * *

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

9. Amend § 2.34 by removing paragraphs (a)(1)(v), (a)(3)(iv) and (a)(4)(iv), revising paragraphs (a) introductory text, (a)(2), (a)(4)(i)(A), and (b), and adding a new paragraph (a)(5), to read as follows:

§ 2.34 Bases for filing.

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

(1) * * *

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

(3) * * *

(4) * * *

(i) * * *

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

* * * * *

(5) Extension of protection of an international registration under section 66(a) of the Act. In an application under section 66(a) of the Act, the international application or subsequent designation requesting an extension of protection to the United States must contain a verified statement that the 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.

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

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

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

* * * * *

10. Revise § 2.35 to read as follows:

§ 2.35 Adding, deleting, or substituting bases.

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

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

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

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

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

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

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

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

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

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

11. Revise § 2.37 to read as follows:

§ 2.37 Description of mark.

(a) A description of the mark, which must be acceptable to the trademark examining attorney, may be included in the application, and must be included if required by the examining attorney.

(b) If a mark is displayed in color or a color combination, the applicant must name the color(s), and describe where the color(s) appear on the mark.

12. Amend § 2.47 by redesignating paragraphs (c) and (d) as (d) and (e) and

adding a new paragraph (c) to read as follows:

§ 2.47 Supplemental Register.

* * * * *

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

* * * * *

13. Revise § 2.51 to read as follows:

§ 2.51 Drawing required.

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

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

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

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

14. Revise § 2.52 to read as follows:

§ 2.52 Types of drawings and format for drawings.

A drawing depicts the mark sought to be registered. The drawing must show only one mark. The applicant must include a clear drawing of the mark when the application is filed. There are two types of drawings:

(a) Standard character (typed) drawing. Applicants who seek to register words, letters, numbers, or any combination thereof without claim to any particular font style must submit a standard character drawing. An applicant may submit a standard character drawing if:

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

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

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

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

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

(b) Special form drawing. Applicants who seek to register a mark that includes a two or three-dimensional design; or color; or words, letters, or numbers in a particular style of lettering; or a mark that does not meet the requirements of paragraph (a) must submit a special form drawing.

(1) Color marks. When color is claimed as a feature of the mark or if the mark consists only of color, the drawing must show the mark in color, and the applicant must name the color(s), and describe where the color(s) appear on the mark. If color is not claimed as a feature of the mark, the applicant must submit a black and white drawing.

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

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

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

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

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

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

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

15. Add § 2.53 to read as follows:

§ 2.53 Requirements for drawings filed through the Trademark Electronic Application System (TEAS).

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

(a) Standard character drawings: If an applicant is filing a standard character drawing, the applicant must enter the mark in the appropriate box. The applicant must indicate that the mark is in standard characters and that no claim is made to any particular font style.

(b) Special form drawings: If an applicant is filing a special form drawing, the applicant must attach a digitized image of the mark to the electronic submission.

(c) Requirements for digitized images: The image must be no larger than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide; must be in .jpg format; and must be scanned at no less than 250 and no more than 350 dots per inch. The image that is scanned must be made with a pen or by a process that will provide high definition when copied. A photolithographic, printer's proof copy, or other high quality reproduction of the mark may be used. All lines must be clean, sharp and solid, and must not be fine or crowded.

16. Add § 2.54 to read as follows:

§ 2.54 Requirements for drawings submitted on paper.

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

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

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

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

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

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

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

§ 2.65 Abandonment.

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

* * * * *

18. Amend § 2.66 by revising paragraph (a) to read as follows:

§ 2.66 Revival of abandoned applications.

(a) An applicant may file a petition to revive an application abandoned because applicant did not timely respond to an Office action or notice of allowance, if the delay was unintentional. The applicant must file the petition within two months of the mailing date of the notice of abandonment.

* * * * *

19. Amend § 2.72 to add a new paragraph (d) to read as follows:

§ 2.72 Amendments to description or drawing of the mark.

* * * * *

(d) In an application under section 66(a) of the Act, the applicant may amend the description or drawing of the mark only if the proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark in the international registration.

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

§ 2.73 Amendment to recite concurrent use.

(a) An application under section 1(a), section 44, or section 66(a) of the Act may be amended to an application for concurrent use registration, provided the application as amended satisfies the requirements of § 2.42. The trademark examining attorney will determine whether the application, as amended, is acceptable.

* * * * *

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

§ 2.75 Amendment to change application to different register.

* * * * *

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

22. Revise § 2.84 to read as follows:

§ 2.84 Jurisdiction over published applications.

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

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

23. Revise § 2.101 to read as follows:

§ 2.101 Filing an opposition.

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

(b) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board. The opposition need not be verified, and must be signed by the opposer or the opposer's attorney, as specified in § 10.1(c) of this chapter, or other authorized representative, as specified in § 10.14(b) of this chapter. Electronic signatures pursuant to § 1.4(d)(1)(iii) of this chapter are required for oppositions submitted electronically under paragraphs (b)(1) or (2) of this section.

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

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

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

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

(2) A timely opposition submitted through ESTTA will not be accepted if it is accompanied by a fee that is insufficient to pay in full for each named party opposer to oppose the registration of a mark in each class specified in the opposition.

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

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

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

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

made at the time the party is joined, the fees submitted will be applied first on behalf of the first-named opposer against as many of the classes in the application as the submitted fees are sufficient to pay. Any excess will be applied on behalf of the second-named party to the opposition against the classes in the application in ascending numerical order.

24. Revise § 2.102 to read as follows:

§ 2.102 Extension of time for filing an opposition.

(a) Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file a written request to extend the time for filing an opposition. The written request must be signed by the potential opposer or by the potential opposer's attorney, as specified in § 10.1(c) of this chapter, or authorized representative, as specified in § 10.14(b) of this chapter. Electronic signatures pursuant to § 1.4(d)(1)(iii) of this chapter are required for electronically filed extension requests.

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

(2) A written request to extend the time for filing an opposition to an application filed under section 66(a) of the Act must be filed through ESTTA.

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

(c) A person may file no more than two requests to extend the time for filing an opposition. The time for filing an opposition shall not be extended beyond 120 days from the date of publication. A request to extend the time for filing an opposition must be filed in the Office and addressed to the Trademark Trial and Appeal Board.

(1) If two consecutive requests to extend the time for filing an opposition are filed:

(i) A first request for an extension of time for thirty days must be filed before thirty days have expired from the date of publication, and will be granted upon request; and

(ii) A second request for an extension of time for sixty days must be filed before the previously granted thirty-day extension of time has expired, and will be granted by the Board only for good cause shown. No further extensions of time to file an opposition will be granted under any circumstances.

(2) Alternatively, a potential opposer may file a single request for an extension of time for 90 days for good cause shown. Such a request must be filed before thirty days have expired from the date of publication, and will be granted by the Board only for good cause shown. If a potential opposer does not show good cause, the Board will treat the request as a first request for extension of time for thirty days under § 2.102(c)(1).

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

§ 2.104 Contents of opposition.

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

* * * * *

26. Revise § 2.105 and its heading to read as follows:

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

When an opposition in proper form has been filed and the correct fee(s) has been submitted, the Trademark Trial and Appeal Board shall prepare a notification, which shall identify the title and number of the proceeding and the application involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. A copy of the notification shall be forwarded to opposer's attorney, as defined in § 10.1(c) of this chapter, or other authorized representative, as defined in § 10.14(b) of this chapter, if any, or to opposer's domestic representative, if any, or to opposer. The Board shall forward a copy of the opposition and any exhibits with a copy of the notification to applicant's attorney, other authorized representative, or domestic representative, if any, or to the applicant.

27. Revise § 2.107 to read as follows:

§ 2.107 Amendment of pleadings in an opposition proceeding.

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

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

28. Revise § 2.111 to read as follows:

§ 2.111 Filing petition for cancellation.

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

(b) Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. The petition need not be verified, and must be signed by the petitioner or the petitioner's attorney, as specified in § 10.1(c) of this chapter, or other authorized representative, as specified in § 10.14(b) of this chapter. Electronic signatures pursuant to § 1.4(d)(1)(iii) of this chapter are required for petitions submitted electronically. * * *

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

(2) A petition submitted through ESTTA will not be accepted if it is accompanied by a fee that is insufficient to pay in full for each named party petitioner and for each class specified in the petition.

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

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

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

the registration for which sufficient fees have been submitted.

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

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

29. Revise § 2.112 to read as follows:

§ 2.112 Contents of petition for cancellation.

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

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

30. Revise § 2.113 and its heading to read as follows:

§ 2.113 Notification to parties of cancellation proceeding.

(a) When a petition for cancellation has been filed in proper form (*see* §§ 2.111 and 2.112), the Trademark Trial and Appeal Board shall prepare a notification which shall identify the title and number of the proceeding and the registration(s) involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. A copy of the notification shall be forwarded to petitioner's attorney, as defined in § 10.1(c) of this chapter, or other authorized representative, as defined in § 10.14(b) of this chapter, if any, or to petitioner's domestic representative, if any, or to the petitioner. The Board shall forward a copy of the petition to cancel and any exhibits with a copy of the notification to the respondent (*see* § 2.118).

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

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

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

31. Revise § 2.118 to read as follows:

§ 2.118 Undelivered Office notices.

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

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

§ 2.123 Trial testimony in inter partes cases.

* * * * *

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

* * * * *

33. Add new § 2.126 to read as follows:

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

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

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

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

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

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

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

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

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

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

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

parties. A copy of the submission with the confidential portions redacted must be submitted.

34. Revise § 2.127(a) to read as follows:

§ 2.127 Motions.

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

* * * * *

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

§ 2.128 Briefs at final hearing.

* * * * *

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

36. Revise § 2.130 and its heading to read as follows:

§ 2.130 New matter suggested by the trademark examining attorney.

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

37. Revise § 2.131 to read as follows:

§ 2.131 Remand after decision in inter partes proceeding.

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

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

§ 2.142 Time and manner of ex parte appeals.

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

(b) * * *

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

* * * * *

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

§ 2.145 Appeal to court and civil action.

* * * * *

(b) * * *

(3) The notice, if mailed to the Office, shall be addressed as follows: Office of the General Counsel, P.O. Box 15667, Arlington, Virginia 22215, and should include a duplicate copy addressed to the Trademark Trial and Appeal Board.

(c) * * *

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

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

* * * * *

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

§ 2.146 Petitions to the Director.

* * * * *

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

* * * * *

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

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

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

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

* * * * *

41. Revise § 2.151 to read as follows:

§ 2.151 Certificate.

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

42. Revise § 2.171 to read as follows:

§ 2.171 New certificate on change of ownership.

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

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

43. Add a new part 7, to read as follows:

PART 7—RULES OF PRACTICE IN FILINGS PURSUANT TO THE MADRID PROTOCOL

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

Subpart A—General Information

§ 7.1 Definitions of terms as used in this part.

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

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

(c) The acronym *TEAS* means the Trademark Electronic Application System available online through the Office's web site at: *www.uspto.gov.*

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

§ 7.3 Correspondence must be in English.

All correspondence relating to international applications and registrations and requests for extension of protection filed in the Office must be in English. The Office will not process correspondence that is in a language other than English.

§ 7.4 Receipt of correspondence.

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

§ 7.6 Schedule of U.S. process fees.

(a) The Office requires the following process fees:

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

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

(3) For transmitting a request to record an assignment or restriction under § 7.23 or § 7.24+$100.00

(4) For filing a notice of replacement, per class—$100.00

(5) For filing an affidavit under section 71 of the Act, per class—$100.00

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

(7) For transmitting a subsequent designation—$100.00

(b) The fees required in paragraph (a) of this section must be paid in U.S. dollars at the time of filing. See § 1.23 of this chapter for acceptable forms of payment and § 1.24 of this chapter for payments using a deposit account established in the Office.

§ 7.7 Payments of fees to International Bureau.

(a) The schedule of fees required by the International Bureau and fee calculator may be viewed online at: *http://www.wipo.int/madrid.*

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

(1) International application fee;

(2) Fee for correcting irregularities in an international application;

(3) Subsequent designation fee; and

(4) Recording fee for an assignment of or restriction to an international registration under § 7.23 or § 7.24.

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

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

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

(2) Through the Office. Fees paid through the Office must be paid in U.S. dollars at the time of submission. See § 1.23 of this chapter for acceptable forms of payment and § 1.24 of this chapter for payments using a deposit account established in the Office.

Subpart B—International Application Originating From the United States

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

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

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

registration date and registration number of the basic registration;

(2) The name and address of the international applicant that are identical to the name and address of the applicant or registrant as they appear in the basic application or basic registration;

(3) A reproduction of the mark that is identical to the mark in the basic application and/or registration and meets the requirements of § 2.52 of this chapter. If the mark in the basic application and/or registration is depicted in black and white, the mark in the international application must be black and white. If the mark in the basic application and/or registration is depicted in color, the mark in the international application must be in color;

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

(5) A description of the mark that is identical to 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 Contracting Parties designated for an extension of protection. If the goods and/or services in the international application are not the same for all Contracting Parties, the application must include a list of the goods and/or services in the international application that pertain to each designated Contracting Party;

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

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

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

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

§ 7.12 Claim of color.

(a) If color is claimed as a feature of the mark in the basic application and/or registration, the international applicant 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. If the basic application and/or registration claim color as a feature of the mark, but the mark is depicted in black and white, 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 § 2.52 of this chapter.

(b) If color is not claimed as a feature of the mark in the basic application and/or registration, color may not be claimed as a feature of the mark in the international application.

§ 7.13 Certification of international application.

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

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

§ 7.14 Correcting irregularities in international application.

(a) Upon receipt of a notice of irregularities in an international application from the International Bureau, the applicant must respond to the International Bureau within the period set forth in the notice. Failure to file a timely response to a notice of irregularities may result in the abandonment of the international application by the International Bureau.

(b) Classification and identification of goods and services. Responses to International Bureau notices of irregularities in the classification or identification of goods or services in an international application must be submitted through the Office for forwarding to the International Bureau. The Office will not review the response or respond to the irregularities on behalf of the international applicant.

(c) Fees. If the International Bureau notifies an international applicant that the fees filed in connection with the international application are insufficient or that irregularities in the classification of goods or services require additional fees, the international applicant must pay the additional fees directly to the International Bureau or through the Office for forwarding to the International Bureau.

(d) An international applicant submitting a response or paying additional fees to the International Bureau through the Office must use TEAS. The International Bureau must receive the response or fees before the end of the response period set forth in the International Bureau notice, even if the response or payment of fees is sent through the Office. To assist the Office in its efforts to timely transmit the response or fees to the International Bureau, the response or fees should be submitted as soon as possible, at least one month before the end of the response period in the International Bureau's notice.

(e) Other Irregularities. Except for irregularities mentioned in paragraphs (b) and (c) of this section, responses to irregularities must be filed directly at the International Bureau.

Subpart C—Subsequent Designation Submitted Through the Office

§ 7.21 Subsequent designation.

(a) A subsequent designation may be filed either directly with the International Bureau or submitted through the Office.

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

(1) The international registration number;

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

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

(4) A list of goods and/or services that is identical to or narrower than the list

of goods and/or services in the international registration;

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

(6) The U.S. transmittal fee required by § 7.6 and the subsequent designation fees required by the International Bureau (§ 7.7); and

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

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

(d) Correspondence to correct any irregularities in a subsequent designation must be made directly with the International Bureau, even if the subsequent designation is submitted through the Office. If such correspondence is sent to the Office, the Office will not process the correspondence.

Subpart D—Recording Changes to International Registration

§ 7.22 Recording changes to international registration.

(a) All requests to record changes to an international registration must be filed directly with the International Bureau, except for requests to record changes to an international registration under §§ 7.23 and 7.24. If a request to record an assignment or restriction of a holder's right of disposal of an international registration meets the requirements of § 7.23 or 7.24, the Office will forward the request to the International Bureau.

(b) Assignments or restrictions of a holder's rights of disposal of an international registration must be recorded by the International Bureau. Section 10 of the Act and part 3 of this chapter are not applicable to such assignments or restrictions.

(c) When the Office is notified by the International Bureau of an assignment or restriction of a holder's right of disposal of an international registration with an extension of protection to the United States, the Office will take note of the assignment or restriction in its records.

§ 7.23 Request to record assignment submitted through the Office.

(a) In limited circumstances, a request to record an assignment of an international registration may be submitted through the Office for forwarding to the International Bureau. The following conditions must apply:

(1) The assignee cannot obtain the assignor's signature on the request to record an assignment; and

(2) The assignee is a national of the United States, has a domicile in the United States, or has a real and effective industrial or commercial establishment in the United States.

(b) The assignee must submit a request to record an assignment under paragraph (a) of this section through the Office that includes all of the following:

(1) The international registration number;

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

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

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

(5) A list of the designated Contracting Parties with respect to which the international registration has been assigned;

(6) A list of the goods and/or services in the international registration that have been assigned and the designated Contracting Parties to which they pertain;

(7) A description of the interest conveyed; and

(8) The U.S. transmittal fee required by § 7.6 and the fees required by the International Bureau to record the assignment (See § 7.7).

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

(d) If the request fails to contain all of the elements set forth in paragraph (b) of this section, the Office will not forward the request. The Office will notify the assignee(s) of the refusal and the reason(s) for the refusal.

(e) Except for those assignments meeting the conditions set forth in paragraph (a) of this section, requests to record assignments may not be submitted through the Office.

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

(a) In limited circumstances, a request to record a security interest or other restriction of a holder's right to dispose of an international registration may be submitted through the Office for forwarding to the International Bureau. The following conditions must apply:

(1) 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 is not the result of a court order; and

(2) The signature of the holder of the international registration cannot be obtained for the request to record the restriction.

(b) The party who obtained a restriction of the holder's right of disposal must submit a request to record the restriction under paragraph (a) of this section through the Office that includes all the following:

(1) The international registration number;

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

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

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

(5) A summary of the main facts concerning the restriction; and

(6) A list of the Contracting Parties designated in the international registration to which the restriction applies.

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

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

(e) Except for restrictions meeting the conditions set forth in paragraph (a) of this section, restrictions on a holder's right to dispose of an international

registration may not be submitted through the Office.

Subpart E—Extension of Protection to the United States

§ 7.25 Applicability of part 2 to extension of protection.

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

(b) For purposes of examination, a request for an extension of protection to the United States is referred to as an application under section 66(a) of the Act, and references to applications and registrations in part 2 of this chapter include extensions of protection to the United States.

(c) Upon registration, an extension of protection to the United States is referred to as a registration or a registered extension of protection.

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

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

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

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

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

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

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

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

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

(a) A registered extension of protection shall have the same rights accrued to a previously issued U.S. registration if:

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

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

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

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

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

(3) The fee required by § 7.6.

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

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

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

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

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

§ 7.30 Effect of cancellation or expiration of international registration.

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

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

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

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

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

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

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

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

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

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

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

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

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

(a) Subject to the provisions of section 71 of the Act, a registered extension of protection shall remain in force for the term of the international registration upon which it is based unless the international registration expires or is cancelled by the International Bureau.

(b) During the following time periods, the holder of an international registration must file an affidavit or declaration of use or excusable nonuse,

or the registered extension of protection will be cancelled:

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

§ 7.38 Notice to holder of extension of protection.

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

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

(a) The Office will issue a notice that states whether an affidavit or declaration of use in commerce or excusable nonuse is acceptable, and if the affidavit or declaration is refused as unacceptable, the reasons for refusal.

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

§ 7.40 Petition to Director to review refusal.

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

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

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

Subpart G—Renewal of International Registration and Extension of Protection

§ 7.41 Renewal of international registration and extension of protection.

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

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

Dated: March 21, 2003.

Jon W. Dudas,

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

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ENVIRONMENTAL PROTECTION AGENCY

40 CFR Part 52

[PA202–4400b; FRL–7474–3]

Approval and Promulgation of Air Quality Implementation Plans; Philadelphia County, PA; Construction, Modification and Operation Permit Programs

AGENCY: Environmental Protection Agency (EPA).

ACTION: Proposed rule.

SUMMARY: EPA is taking direct final action to approve revisions to the Philadelphia County portion of the Pennsylvania State Implementation Plan (SIP). The revision approves Philadelphia County's regulations governing the construction of new and modified sources and the operation of existing sources of air pollution in the