

reconsideration of final actions, notices of change of address, requests to divide, and petitions under § 2.146. The applicant or registrant, someone with legal authority to bind the applicant or registrant (e.g., a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 10.14 of this chapter must sign responses to Office actions, amendments to applications, requests for express abandonment, requests for reconsideration of final actions, notices of change of address, requests to divide, and petitions under § 2.146, in accordance with the following guidelines:

(i) If the applicant or registrant is represented by a practitioner authorized to practice before the Office under § 10.14 of this chapter, the practitioner must sign, except where correspondence is required to be signed by the applicant or registrant; or

(ii) If the applicant or registrant is not represented by a practitioner authorized to practice before the Office under § 10.14 of this chapter, the individual applicant or registrant, or someone with legal authority to bind the applicant or registrant (e.g., a corporate officer or general partner of a partnership) must sign. In the case of joint applicants or joint registrants who are not represented by a practitioner authorized to practice before the Office under § 10.14 of this chapter, all must sign.

(3) *Powers of attorney and revocations of powers of attorney.* The individual applicant or registrant or someone with legal authority to bind the applicant or registrant (e.g., a corporate officer or general partner of a partnership) must sign powers of attorney and revocations of powers of attorney. In the case of joint applicants or joint registrants, all must sign. Once the applicant or registrant has designated a qualified practitioner(s), the named practitioner may sign an associate power of attorney appointing another qualified practitioner(s) as an additional person(s) authorized to prosecute the application or registration. If the applicant or registrant revokes the original power of attorney, this revocation also discharges any associate power signed by the practitioner whose power has been revoked.

(4) *Petition to revive under § 2.66.* Someone with firsthand knowledge of the facts regarding unintentional delay must sign a petition to revive under § 2.66.

(5) *Renewal applications.* The registrant or the registrant's representative must sign a renewal application.

(6) *Requests for correction, amendment or surrender of registrations.* The owner of the registration, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner authorized to practice before the Office under § 10.14 of this chapter must sign a request for correction, amendment or surrender of a registration. In the case of joint owners who are not represented by a practitioner authorized to practice before the Office under § 10.14 of this chapter, all must sign.

(7) *Designations and revocations of domestic representative.* A designation or revocation of a domestic representative must be signed by the applicant or registrant, someone with legal authority to bind the applicant or registrant (e.g., a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 10.14 of this chapter.

(8) *Cover letters.* The person transmitting documents to the Office may sign a cover letter or transmittal letter. The Office neither requires cover letters nor questions the authority of a person who signs a communication that merely transmits documents.

(f) *Signature as certification.* The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by any person, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of § 10.18(b) of this chapter may jeopardize the validity of the application or registration, and may result in the imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) of this chapter may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15) of this chapter.

(g) *Separate copies for separate files.* (1) Since each file must be complete in itself, a separate copy of every document to be filed in connection with a trademark application, registration, or *inter partes* proceeding must be furnished for each file to which the document pertains, even though the contents of the documents filed in multiple files may be identical.

(2) Parties should not file duplicate copies of correspondence in a single application, registration, or proceeding file, unless the Office requires the filing of duplicate copies. The Office may dispose of duplicate copies of correspondence.

(h) *Separate documents for separate branches of the Office.* Since different branches or sections of the Office may consider different matters, each distinct

subject, inquiry or order must be contained in a separate document to avoid confusion and delay in answering correspondence.

(i) *Certified documents required by statute.* When a statute requires that a document be certified, a copy or facsimile transmission of the certification is not acceptable.

Dated: June 4, 2008.

Jon W. Dudas,

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

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DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 2, 3, 6 and 7

[Docket No. PTO-T-2005-0018]

RIN 0651-AB89

Miscellaneous Changes to Trademark Rules of Practice

AGENCY: United States Patent and Trademark Office, Commerce.

ACTIONS: Proposed rule.

SUMMARY: The United States Patent and Trademark Office ("Office") proposes to amend the Trademark Rules of Practice to clarify certain requirements for applications, intent to use documents, amendments to classification, requests to divide, and Post Registration practice; to modernize the language of the rules; and to make other miscellaneous changes. For the most part, the proposed rule changes are intended to codify existing practice, as set forth in the *Trademark Manual of Examining Procedure* ("TMEP").

DATES: Comments must be received by August 11, 2008 to ensure consideration.

ADDRESSES: The Office prefers that comments be submitted via electronic mail message to TMRules@uspto.gov. Written comments may also be submitted by mail to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, attention Mary Hannon; by hand delivery to the Trademark Assistance Center, Concourse Level, James Madison Building-East Wing, 600 Dulany Street, Alexandria, Virginia, attention Mary Hannon; or by electronic mail message via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions on providing

comments via the Federal eRulemaking Portal. The comments will be available for public inspection on the Office's Web site at <http://www.uspto.gov>, and will also be available at the Office of the Commissioner for Trademarks, Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia.

FOR FURTHER INFORMATION CONTACT:

Mary Hannon, Office of the Commissioner for Trademarks, by telephone at (571) 272-9569.

SUPPLEMENTARY INFORMATION: 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. References to "TMPEP" or "Trademark Manual of Examining Procedure" refer to the 5th edition, September 2007. References to the *Trademark Trial and Appeal Board Manual of Procedure* refer to the 2nd edition, Rev. 1, March 12, 2004.

Where appropriate, the Office proposes to reword or reorganize the rules for clarity, and to add headings to make it easier to navigate through the rules.

Applications for Registration

The Office proposes to amend § 2.21(a) to require that an application must be in the English language to receive a filing date.

The Office proposes to amend § 2.23(a)(2), which requires that a TEAS Plus applicant continue to receive communications from the Office by electronic mail during the pendency of the application, to add a requirement that a TEAS Plus applicant maintain a valid e-mail correspondence address in order to maintain TEAS Plus status. If the e-mail address changes, the applicant must notify the Office of the new e-mail address. If applicant chooses to receive correspondence on paper, applicant will have to pay the processing fee required by §§ 2.6(a)(1)(iv) and 2.23(b).

The Office proposes to amend § 2.32(a)(3)(iii) to indicate that the requirement for inclusion of the names and citizenship of the general partners in an application by a partnership applies only to domestic partnerships. Because the Office does not track the varying legal effects of partnership status in foreign countries, and the relevance of this additional information has not been established, this requirement does not apply to foreign partnerships. This is consistent with TMPEP section 803.03(b).

The Office proposes to add new § 2.32(a)(3)(iv) to provide that if the applicant is a domestic joint venture, the application must include the names

and citizenship of all active members of the joint venture. This is consistent with TMPEP section 803.03(b).

The Office proposes to amend §§ 2.32(a)(7) and (a)(8) to change periods to semi-colons.

The Office proposes to add new § 2.32(a)(9), providing that if a mark includes non-English wording, the applicant must submit an English translation of that wording; and new § 2.32(a)(10), providing that if the mark includes non-Latin characters, the applicant must submit a transliteration of those characters and either a translation of the corresponding non-English word(s) or a statement that the transliterated term has no meaning in English. This is consistent with the long-standing practice of the Office. TMPEP sections 809 *et seq.*

The Office proposes to amend § 2.33(b)(1) to remove the requirement that an application include a verified statement that the applicant "has adopted" the mark. This language is not required by statute and is deemed unnecessary.

The Office proposes to amend §§ 2.34(a)(1)(i), (a)(2), (a)(3)(i), and (a)(4)(ii) to change "must allege" to "must also allege." This makes it clear that the requirement for an allegation of current use or bona fide intention to use the mark in commerce, applies to verifications filed after the application filing date.

The Office proposes to add new § 2.34(a)(1)(v) to provide that if more than one item of goods or services is specified in a section 1(a) application, the dates of use need be for only one of the items specified in each class, provided that the particular item to which the dates apply is designated. This requirement for section 1(a) applications previously appeared in § 2.33(a)(2), but was inadvertently removed effective October 30, 1999, by the final rule published at 64 FR 48900 (Sept. 8, 1999). This requirement is consistent with the requirements for allegations of use under §§ 2.76(c) and 2.88(c).

The Office proposes to amend §§ 2.44(b) and 2.45(b), which pertain to collective and certification marks, to add a reference to section 66(a) applications. This corrects an oversight.

The Office proposes to amend § 2.47(a) to remove the requirement for a specific allegation that a mark has been in "lawful" use in commerce in an application for registration on the Supplemental Register. Because the definition of "commerce" in section 45 of the Trademark Act is "all commerce which may lawfully be regulated by Congress," the Office presumes that an

applicant who alleges that "the mark is in use in commerce," is claiming lawful use. The Office generally questions the lawfulness of the alleged use in commerce only where the record shows a clear violation of law, such as the sale or transportation of a controlled substance. TMPEP section 907.

The Office proposes to add new § 2.48 to provide that the Office does not issue duplicate registrations. If two applications on the same register would result in registrations that are exact duplicates, the Office will permit only one application to mature into registration, and will refuse registration in the other application. This codifies the long-standing practice of the Office. TMPEP section 703. The Office will normally refuse registration in the later-filed application. The applicant may overcome the refusal by abandoning the earlier-filed application or surrendering the registration.

The Office proposes to amend § 2.52(b) to provide that special form drawings of marks that do not include color "should" show the mark in black on a white background, rather than that the drawing "must" show the mark in black on a white background. This gives examining attorneys discretion to accept a drawing that shows the mark in white on a black background, if this will more accurately depict the mark.

The Office proposes to amend § 2.52(b)(1) to change the heading "Color marks" to "Marks that include color." This corrects an error. Color marks are marks that consist *solely* of one or more colors used on particular objects, and § 2.52(b)(1) applies to all marks that include color.

The Office proposes to amend § 2.53(a) to remove the reference to submission of a digitized image of a standard character mark as a drawing in an application filed via the Trademark Electronic Application System ("TEAS"). This is no longer an option. An applicant who wants to apply for a standard character mark through TEAS must enter the mark in the appropriate field on the TEAS form, and check the box to claim that the mark consists of standard characters. TEAS generates the drawing. The Office also proposes to combine §§ 2.53(a)(1) and (2), because the requirements for standard character drawings in TEAS and TEAS Plus applications are now the same.

The Office proposes to amend § 2.56(b)(1) to add a reference to "displays associated with the goods." This makes the rule consistent with the definition of "use in commerce" in section 45 of the Act.

The Office proposes to amend § 2.56(d)(2) to add a provision that

where an applicant files a paper specimen that exceeds the size requirements of paragraph (d)(1), and the Office creates a digital facsimile copy of the specimen, the Office will destroy the original bulky specimen. This is consistent with current practice. TMEP section 904.02(b).

The Office proposes to amend § 2.56(d)(4) to provide that specimens filed through TEAS may be in .pdf format. This provides TEAS filers with an additional option for filing specimens, and is consistent with current practice.

The Office proposes to amend § 2.62 and its heading to add a requirement that a response to an Office action be signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 10.14 ("qualified practitioner"). This is consistent with TMEP section 712.01.

The Office proposes to amend § 2.64(c)(1) to state that the filing of an amendment to allege use does not extend the deadline for filing a response to an outstanding Office action, appeal to the Trademark Trial and Appeal Board, or petition to the Director. This is consistent with current practice. TMEP section 1104.

The Office proposes to amend § 2.65(a) to add a reference to a notice of appeal as a response that avoids abandonment of an application. This is consistent with section 12(b) of the Act.

The Office proposes to revise § 2.73 to provide that only an application that includes section 1(a) of the Trademark Act as a filing basis, or for which an acceptable allegation of use under § 2.76 or § 2.88 has been filed, may be amended to seek concurrent use registration. The rule currently provides that applications under section 44 or section 66(a) of the Act may be amended to recite concurrent use. However, because section 2(d) of the Act requires concurrent lawful use in commerce by the parties to a concurrent use proceeding, the Office deems it inappropriate to allow amendment to seek concurrent use absent allegations and evidence of use in commerce. The Office also proposes to add a statement to § 2.99(g) that applications based solely on section 44 or section 66(a) are not subject to concurrent use registration proceedings.

The Office proposes to revise § 2.74 to modernize the language, and to add a provision that an amendment to an application must be signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate

officer or general partner of a partnership), or a qualified practitioner. This is consistent with TMEP section 605.02.

Intent To Use

The Office proposes to amend § 2.76(d) to provide that an amendment to allege use ("AAU") should be captioned "Allegation of Use" rather than "amendment to allege use." This is consistent with the language on the Office's TEAS form. The term "allegation of use" encompasses both AAUs under § 2.76 and statements of use ("SOU") under § 2.88. The principal difference between AAUs and SOUs is the time of filing, and the same TEAS form is used for both filings. The proposed rule merely sets forth the preferred title. The Office will still accept documents titled "amendment to allege use" or "statement of use."

The Office proposes to amend § 2.77 to add a provision that amendments deleting a basis in a multiple-basis application, notices of change of attorney, and notices of change of address can be entered in a section 1(b) application during the period between the issuance of the notice of allowance and the submission of a statement of use. This is consistent with current practice. TMEP section 1107.

The Office proposes to amend § 2.88(b)(1)(ii) to make it clearer that the dates of use specified in a statement of use must pertain to the goods or services identified in the notice of allowance.

The Office proposes to amend § 2.88(b)(3) to provide that the applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the statement of use, or the application will be abandoned. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant must specify the classes to be abandoned. If the applicant submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid to the lowest numbered class(es) in ascending order, and will delete the goods/services in the higher class(es) from the application. This is consistent with current practice.

The Office proposes to amend § 2.88(d) to provide that an SOU should

be captioned "Allegation of Use" rather than "statement of use." This is consistent with the proposed amendment to § 2.76(d), discussed above.

The Office proposes to amend § 2.88(i)(2) to remove the provision that if any goods or services specified in the notice of allowance are omitted from the identification of goods or services in the SOU, the examining attorney will inquire about the discrepancy and permit the applicant to reinsert the omitted goods/services, and substitute a provision that the Office will delete the omitted goods/services from the application and will not permit the applicant to reinsert them. Currently, if goods/services identified in the application are omitted from a paper SOU, but the applicant has not indicated an intention to delete those goods/services from the application or filed a request to divide the application, the examining attorney will contact the applicant to confirm that the applicant intends to delete the omitted goods/services, and will permit the applicant to amend the SOU to claim use on or in connection with the omitted goods/services. However, when an SOU is filed electronically, the TEAS form requires the applicant to expressly indicate an intention to delete a class, or to delete goods/services within a class. Therefore, if any of the goods/services identified in the application do not appear in the identification of goods/services in a TEAS SOU, the examining attorney does not inquire about the discrepancy and the applicant may not reinsert the omitted goods/services. TMEP section 1109.13. There have been cases in which these inquiries concerning paper SOUs caused unnecessary delay in applications after the applicant intentionally omitted goods/services. Therefore, the Office is changing its practice with paper SOUs, and will discontinue issuing inquiries about omitted goods/services. Under the proposed rule, the practice with paper SOUs would be consistent with the current practice for electronically filed SOUs. Applicants are responsible for setting forth (or incorporating by reference) the goods/services on or in connection with which the mark is in use. This is consistent with the Office's long-standing practice with respect to requests for extensions of time to file a statement of use, set forth in § 2.89(f).

The Office proposes to revise §§ 2.89(a)(2) and (b)(2) to add a provision that if an applicant timely submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not

specified the class(es) to which the fee applies, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid to the lowest numbered class(es) in ascending order, and will delete the goods/services in the higher class(es) from the application. This is consistent with current practice. TMEP section 1108.02(c).

Amendments to Classification

The Office proposes to amend § 2.85(a) to add a reference to amendments to adopt international classification.

The Office proposes to combine §§ 2.85(b) and (c), pertaining to the United States classification, and to add a reference to amendments to adopt international classification.

The Office proposes to redesignate § 2.85(f), pertaining to certification marks and collective membership marks, as § 2.85(c), and to add a statement that the classes set forth in §§ 6.3 and 6.4 do not apply to applications based on section 66(a) of the Trademark Act and registered extensions of protection. This is consistent with current practice. TMEP section 1904.02(b). Classes A, B, & 200 are classes from the old United States classification system that are still used in the United States to classify certification and collective membership marks, but are not included in the international classes under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks ("Nice Agreement"). Therefore, they do not apply to section 66(a) applications and registered extensions of protection, in which classification is determined by the International Bureau of the World Intellectual Property Organization ("IB"). The Office proposes to make conforming amendments to §§ 6.3 and 6.4, indicating that these sections apply only to applications based on sections 1 and 44 of the Trademark Act and registrations resulting from such applications.

The Office proposes to redesignate § 2.85(d), which now provides that renewals filed on registrations issued under a prior classification system will be processed on the basis of that system, as § 2.183(f), and amend it to add an exception for registrations that have been amended to adopt international classification pursuant to § 2.85(e)(3).

Proposed § 2.85(d) provides that in an application under section 66(a) of the Act or registered extension of protection, the classification cannot be changed from the classification assigned by the IB; classes cannot be added; and goods or services cannot be transferred from one class to another in a multiple-class application. This is consistent with current practice. TMEP sections 1401.03(d) and 1904.02(b). Under Article 3(2) of the Madrid Protocol, the IB controls classification. A section 66(a) application and any resulting registration remains part of the international registration, and a change of classification in the United States would have no effect on the international registration.

The Office proposes to remove § 2.85(e), which now pertains to appeal and renewal fee deficiencies in multiple-class applications and registrations, and move the provisions on appeal fees to § 2.141(b). Procedures for processing renewal fee deficiencies in multiple-class registrations are already covered in § 2.183(e).

Proposed § 2.85(e) provides for changes in classification pursuant to the Nice Agreement. The international classification changes periodically, and these changes are listed in the *International Classification of Goods and Services for the Purposes of the Registration of Marks*, which is published by the World Intellectual Property Organization. The Nice Agreement edition currently in effect is the 9th edition, 2006, which became effective January 1, 2007.

Proposed § 2.85(e)(1) provides that when international classification changes, the new requirements apply only to applications filed on or after the effective date of the change.

Proposed § 2.85(e)(2) provides that in section 1 and 44 applications filed before the effective date of a change in classification, and registrations resulting from such applications, the applicant or registrant may reclassify the goods or services in accordance with the current edition, upon payment of the required fees. Proposed § 2.85(e)(3) sets forth the requirements for amendment of a pending application, and proposed § 2.85(e)(4) sets forth the requirements for amendment of a registration to reclassify the goods or services in accordance with the current edition of the Nice Agreement. This is consistent with current practice, set forth in TMEP sections 1401.11 and 1609.04.

The Office proposes to redesignate § 2.85(g), which provides that classification schedules shall not limit or extend the applicant's rights, as § 2.85(f), and amend it to note an

exception that in section 66(a) applications, the scope of the identification of goods or services for purposes of permissible amendments is limited by the class, because the classification assigned by the IB cannot be changed. This is consistent with TMEP section 1402.07(a).

Requests To Divide

The Office proposes to break the current § 2.87(c) into subsections 2.87(c)(1) and (c)(2).

The Office proposes to add new § 2.87(c)(3) to provide that an applicant may file a request to divide out one or more bases of a multiple-basis application during the period between the issuance of the notice of allowance under section 13(b)(2) of the Act and the filing of a statement of use under § 2.88. This is consistent with current practice.

The Office proposes to add § 2.87(e) to provide that any outstanding time period for action by the applicant in the original application at the time of the division will be applicable to each new separate application created by the division. This provision appeared in § 2.87(a) when the rule was first enacted in 1989, but was inadvertently removed when the rules were amended to adjust application filing fees on January 19, 2005. See notices at 54 FR 37562 (Sept. 11, 1989) and 70 FR 2952 (Jan. 19, 2005). The Office proposes to add certain specified exceptions, consistent with current practice, as set forth in TMEP sections 1110.04 and 1110.05.

The Office proposes to add new § 2.87(f) to add a requirement that a request to divide be signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner. This is consistent with TMEP section 1110.

The Office proposes to add new § 2.87(g), setting forth the procedures for division of a section 66(a) application after a change in ownership with respect to some, but not all, of the goods or services. This incorporates existing practice, set forth in TMEP section 1110.08.

The Office proposes to add § 2.171(b)(2), providing for division of registered extensions of protection upon notification by the IB that ownership of an international registration has changed with respect to some, but not all, of the goods or services. This reflects current practice. TMEP section 1615.02.

Post Registration

The Office proposes to amend § 2.153 to remove the requirement for specification of the type of commerce in

an affidavit claiming the benefits of section 12(c) of the Trademark Act of 1946 for a registration issued under the Trademark Acts of 1881 or 1905. Because the definition of “commerce” in section 45 of the Act is “all commerce which may lawfully be regulated by Congress,” the Office presumes that a registrant who alleges that the mark is in use in commerce is alleging that the mark is in use in a type of commerce that Congress can regulate. The Office amended the Trademark Rules of Practice to remove the requirement for a specification of the type of commerce in applications for registration under section 1(a) of the Act, allegations of use in applications under section 1(b) of the Act, and affidavits under sections 8 and 15 of the Act, effective October 30, 1999 (*see* notice at 64 FR 48900 (Sept. 8, 1999)), but inadvertently overlooked § 2.153.

The Office proposes to amend the center heading immediately after § 2.158 to delete the wording “DURING SIXTH YEAR.” This corrects an oversight. The heading covers rules pertaining to affidavits or declarations under section 8 of the Act (“section 8 affidavits”). Effective October 30, 1999, such affidavits must be filed every tenth year after registration as well as during the sixth year.

The Office proposes to amend § 2.161(g)(3) to provide that specimens filed through TEAS may be in .pdf format. This provides TEAS filers with an additional option for filing specimens, and is consistent with current practice.

The Office proposes to amend § 2.163(b) to provide that a registration will be cancelled for failure to respond to an Office action issued in connection with a section 8 affidavit only if there is no time remaining in the grace period under section 8(c)(1) of the Act. This corrects an oversight in the current rule. It would be inappropriate to cancel a registration under section 8 before expiration of the grace period. If there is time remaining in the grace period, the owner may file a complete new affidavit.

The Office proposes to amend § 2.167 to provide that an affidavit or declaration of incontestability under section 15 of the Trademark Act must be filed in the name of the owner of the registration, and verified by the owner or a person properly authorized to sign on behalf of the owner (§ 2.161(b)). This is consistent with TMEP section 1605.04.

The Office proposes to amend § 2.171(a) to remove the requirement that a request for a new certificate of registration upon change of ownership

include the original certificate of registration. This is consistent with current practice, and with Office practice in connection with requests to amend or correct registrations under section 7 of the Trademark Act. *See* notice at 69 FR 51362 (Aug. 29, 2004), removing the requirement that the original certificate be included with a section 7 request.

The Office further proposes to add a statement to § 2.171(a) that in a registered extension of protection, the assignment must be recorded with the IB before it can be recorded in the Office. This is consistent with current § 7.22.

The Office proposes to redesignate § 2.171(b) as (b)(1), and amend it to indicate that it applies only to registrations resulting from applications based on section 1 or 44 of the Act.

The Office proposes to add § 2.171(b)(2), providing for division of registered extensions of protection upon notification by the IB that ownership of an international registration has changed with respect to some, but not all, of the goods or services. This reflects current practice. TMEP section 1615.02.

The Office proposes to reorganize § 2.173, pertaining to amendment of registrations. The current paragraph (a) is broken into proposed paragraphs (a) through (d).

Proposed § 2.173(a) provides that the owner of a registration may file a written request to amend a registration or to disclaim part of the mark in the registration; and that if the registration is involved in an inter partes proceeding before the Trademark Trial and Appeal Board (“TTAB”), the request must be filed by appropriate motion to the Board. This is consistent with the current § 2.173(a) and TMEP section 1609.01(b).

The current paragraph (b) is broken into proposed paragraphs (e) and (g).

Proposed § 2.173(b) sets forth the requirements for the request for amendment.

Proposed § 2.173(b)(2) requires that the request be filed by the owner and signed by the owner, someone with legal authority to bind the owner (*e.g.*, a corporate officer or general partner of a partnership), or a qualified practitioner. The requirement for filing in the name of the owner is consistent with current practice. However, the requirement for signature by someone with legal authority to bind the owner or by a qualified practitioner changes current practice slightly. TMEP section 1609.01(b) now permits signature by a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner, which could

include someone without legal authority to bind the owner. The Office believes that the better practice would be to require that a request to amend a registration be signed by someone with legal authority to bind the owner or by a qualified practitioner.

Proposed § 2.173(b)(3) provides that an amendment to change the mark include: A specimen showing the mark as used on or in connection with the goods or services; an affidavit or a declaration under § 2.20 stating that the specimen was in use in commerce at least as early as the filing date of the amendment; and a new drawing of the amended mark. This is consistent with current § 2.173(a) and TMEP section 1609.02(c).

Proposed § 2.173(c) provides that the registration must still contain registrable matter, and proposed § 2.173(d) provides that the amendment may not materially alter the mark. This is consistent with current § 2.173(a).

Proposed § 2.173(e) provides that no amendment to the identification of goods or services in a registration will be permitted, except to restrict the identification or change it in ways that would not require republication of the mark. This is consistent with current § 2.173(b).

The Office proposes to add new § 2.173(f) to provide that if the registration includes a disclaimer, description of the mark, or miscellaneous statement, any amendment must include a request to make any necessary conforming amendments to the disclaimer, description, or other miscellaneous statements. For example, if the mark is XYZ INC., with a disclaimer of the entity designator “INC.,” and the owner of the registration proposes to amend the mark to remove “INC.,” the proposed amendment should also request that the disclaimer be deleted. If an amendment is filed that does not include all necessary conforming amendments, the examiner will issue an Office action requiring the amendments.

Proposed § 2.173(g) provides that an amendment seeking the elimination of a disclaimer will not be permitted, unless deletion of the disclaimed portion of the mark is also sought. The proposed rule provides an exception to the general prohibition against amendments to delete disclaimers, currently set forth in § 2.173(b), in the limited situation where the mark is amended to delete the disclaimer.

The Office proposes to amend § 2.175(b)(2) to require that a request to correct the owner’s error in a registration be filed by the owner and signed by the owner, someone with

legal authority to bind the owner (*e.g.*, a corporate officer or general partner of a partnership), or a qualified practitioner. This is consistent with proposed § 2.173(b)(2), discussed above.

The Office proposes to redesignate § 2.184(b) as § 2.184(b)(1), and amend it to provide that a registration will expire for failure to respond to an Office action issued in connection with a renewal application only if there is no time remaining in the grace period under section 9(a) of the Act. This corrects an oversight in the current rule. It would be inappropriate to cancel a registration for failure to renew prior to expiration of the renewal grace period. If there is time remaining in the grace period, the registrant may file a complete new renewal application.

The Office proposes to add new § 2.183(f) to provide that applications for renewal of registrations issued under a prior classification system will be processed on the basis of that system, except where the registration has been amended to adopt international classification. The provision that applications for renewal of registrations issued under a prior classification system are processed on the basis of that system is currently set forth in § 2.85(d). The reference to amendment of classification is consistent with proposed § 2.85(e)(3), discussed above.

The Office proposes to add § 2.184(b)(2), requiring that a response to an Office action issued in connection with a renewal application be signed by the registrant, someone with legal authority to bind the registrant (*e.g.*, a corporate officer or general partner of a partnership), or a qualified practitioner. This is consistent with TMEP section 1606.12.

Madrid Protocol

The Office proposes to amend § 7.11(a)(2) to provide that the applicant's entity in an application for international registration must be identical to the entity listed as owner of the basic application or registration. This is consistent with current practice. TMEP section 1902.02(c). Under section 61(a) of the Trademark Act, only the owner of the basic application or registration can file an international application.

The Office proposes to amend the last sentence of § 7.14(e) to change "submitted to" to "received in," for clarity.

The Office proposes to amend § 7.25(a) to remove §§ 2.175 and 2.197 from the list of rules in part 2 that do not apply to an extension of protection of an international registration to the United States. Section 2.175 pertains to

correction of mistakes by a registrant. Generally, all requests to record changes to an international registration must be filed at the IB, because an extension of protection of an international registration remains part of the international registration even after registration in the United States. However, in the limited circumstance where the holder of an international registration makes a mistake in a document filed during prosecution in the Office that affects only the extension of protection to the United States, the registrant may request correction of the error pursuant to § 2.175. For example, if there were a minor typographical error in an amendment to the identification of goods in a section 66(a) application, and the mark registered, the owner of the registration could request correction under § 2.175. If the Office grants the request, the Office will notify the IB of the change to the extension of protection to the United States.

Section 2.197 provides a "certificate of mailing or transmission" procedure to avoid lateness due to mail delay. This procedure may currently be used by section 66(a) applicants during prosecution of applications. The procedure may also be available to owners of registered extensions of protection who file affidavits of use or excusable nonuse under section 71 of the Trademark Act. Therefore, its inclusion in § 7.25(a) was an error. Under §§ 2.197(a)(2)(ii) and 7.4(e), the certificate of mailing or transmission procedure remains inapplicable to international applications under § 7.11, responses to notices of irregularity under § 7.14, subsequent designations under § 7.21, requests to record changes of ownership under § 7.23, requests to record restrictions of the holder's right of disposal (or the release of such restrictions) under § 7.24, and requests for transformation under § 7.31. **Note:** *On February 29, 2008, the Office published a notice of proposed rulemaking that would prohibit the use of certificates of mailing or transmission for certain specified documents for which an electronic form is available in the Trademark Electronic Application System ("TEAS"). See notice at 73 FR 11079. The Office is currently reviewing the comments received in response to this proposal.*

Assignment Cover Sheet

The Office proposes to amend § 3.31 to add a new paragraph (a)(8), requiring that a cover sheet submitted with a request to record a change of ownership of a trademark application or registration must include the citizenship of the party receiving the interest; and

that if the party receiving the interest is a domestic partnership or domestic joint venture, the cover sheet must include the names, legal entities, and national citizenship (or state or country of organization) of all general partners or active members that compose the partnership or joint venture. Currently, § 3.31(f) provides that the cover sheet "should" include this information, but the Office proposes to make it mandatory. This will allow for more efficient processing of trademark applications and registrations.

The applicant's entity and citizenship is required in an application for registration under § 2.32(a)(3)(iii) and must be submitted before the Office can issue a registration certificate in the name of the new owner. It is also required when the new owner of a registration wants to change ownership in the trademark database and/or obtain a new certificate of registration in the name of the new owner. Requiring the information whenever a change of ownership is recorded will eliminate the need for the examining attorney or the Post Registration examiner to issue an Office action requiring that it be submitted, which can cause substantial delay. Furthermore, in many cases, having complete information about the receiving party will ensure that the trademark database is automatically updated at the time of recordation or shortly thereafter. See TMEP sections 504 et seq. regarding automatic updating of the trademark database upon recordation of a change of ownership. This will often ensure that the original certificate of registration issues in the name of the new owner.

References to "Paper"

The Office proposes to amend §§ 2.6(b)(6), 2.21(b), 2.21(c), 2.27(d), 2.87(d), 2.146(e)(1), 2.146(e)(2), and 2.146(i) to delete references to "papers" and substitute "documents" where appropriate, in order to encompass documents filed or issued electronically.

The Office proposes to amend §§ 2.6(a)(19), 2.6(b)(3), and 2.56(d)(2) to delete references to "file wrapper" and substitute "record" or "official record." The Office now maintains electronic records of applications and registrations.

The Office proposes to amend §§ 2.62, 2.65(a), 2.66(a)(1), 2.66(d), 2.66(f)(1), 2.81(b), 2.89(a), 2.89(a)(3), 2.89(g), 2.93, 2.99(d)(2), 2.146(d), 2.146(e)(1), 2.146(e)(2), 2.146(j)(1), 2.163(b), 2.165(b), 2.176, 2.184(b), 2.186(b), 7.39(b) and 7.40(b) to change references to "mailing" to "issuance," to encompass Office actions and

communications that are issued electronically.

The Office proposes to amend § 2.81(b) to remove the sentence stating that “The mailing date that appears on the notice of allowance will be the issue date of the notice of allowance,” because it is unnecessary. The rule already states that the notice of allowance will include the issue date.

The Office proposes to amend §§ 2.84(b), 2.173, 2.174, and 2.175 to delete references to “printed,” and substitute “issued” where appropriate, in order to encompass documents issued electronically.

The Office proposes to amend §§ 2.87(d), 2.146(e)(i), and 2.146(i) to delete references to “paper” and to substitute “document,” to encompass documents filed through TEAS.

The Office proposes to remove the references in § 2.173(c), 2.174, and 2.175(c) to printed copies of amendments and corrections under section 7 of the Act.

Appeal Fees

The Office proposes to reorganize § 2.141 to move the provisions pertaining to appeal fees, some of which were previously set forth in § 2.85(e), to § 2.141(b). The proposed rule is consistent with current practice, set forth in *Trademark Trial and Appeal Board Manual of Procedure* section 1202.04.

Other Changes

The Office proposes to amend §§ 2.6(a)(12) and (13), 2.38(b), 2.41(a), 2.44(a) and (b), 2.46, 2.47, 2.61(a), 2.64(c)(1), 2.65(c), 2.75(a) and (b), 2.81(a) and (b), 2.85(b), 2.88(a), 2.99(g), 2.146(b), and 2.167, to replace section symbols with the word “section.” This is consistent with references to the statute in other rules, and with the format recommended in the *Federal Register Document Drafting Handbook*, National Archives and Records Administration, Office of the **Federal Register** (Oct. 1998). Section symbols are used in rules and **Federal Register** notices only to refer to other sections of the CFR.

The Office proposes to amend § 2.6(a)(8) to delete “assignee” and substitute “registrant.” This makes it clear that any registrant can request a new certificate of registration, upon payment of the required fee.

The Office proposes to revise § 2.25 to provide that documents filed in the Office by the applicant or registrant become part of the official record and will not be returned or removed. The rule currently provides only for applications, and the Office proposes to

revise it to encompass all documents filed in connection with an application or registration. This is consistent with current practice. See TMEP section 404. The Office proposes to make an exception for documents ordered to be filed under seal pursuant to a protective order issued by a court or by the TTAB.

The Office proposes to remove § 2.26, which provides that a drawing from an abandoned application may be transferred to and used in a new application, if the file has not been destroyed. This rule is no longer in use and is deemed unnecessary.

The Office proposes to amend § 2.32(a)(6) to delete the word “and” after the semicolon, and to amend § 2.32(a)(7) to change a period to a semicolon.

The Office proposes to amend § 2.86(a)(2) to delete the period and substitute a semicolon, followed by the word “and” (“; and”).

The Office proposes to amend § 2.146(c) to add a provision that a petition to the Director be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a qualified practitioner. The proposed rule further provides that when facts are to be proved on petition, the petitioner must submit proof in the form of affidavits or declarations in accordance with § 2.20, signed by someone with firsthand knowledge of the facts to be proved. This is consistent with TMEP sections 1705.03 and 1705.07.

The Office proposes to amend § 2.195(b) to delete the phrase, “In addition to being mailed,” because it is unnecessary.

The Office proposes to amend § 2.195(e) to clarify the procedures for filing a petition to the Director to consider correspondence filed on the date of attempted filing by Express Mail during a postal service interruption or emergency within the meaning of 35 U.S.C. 21(a). Proposed § 2.195(e)(1) provides that a person who attempted to file correspondence by Express Mail, but was unable to deposit the correspondence with the United States Postal Service due to the interruption or emergency, may petition the Director to consider the correspondence to have been filed on the date of attempted filing. Proposed § 2.195(e)(2) sets forth the requirements for the petition. Proposed § 2.195(e)(3) notes that this procedure does not apply to correspondence that is excluded from the Express Mail procedure pursuant to § 2.198(a)(1). This is consistent with current practice.

Rule Making Requirements

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

Administrative Procedure Act: This rule merely involves rules of agency practice and procedure within the meaning of 5 U.S.C. 553(b)(A). Therefore, this rule may be adopted without prior notice and opportunity for public comment under 5 U.S.C. 553(b) and (c), or thirty-day advance publication under 5 U.S.C. 553(d). However, the Office has chosen to seek public comment before implementing the rule.

Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), neither a regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is required. See 5 U.S.C. 603.

The proposed rules clarify certain requirements for trademark applications and other trademark-related documents, modernize the language of the rules, and make some other miscellaneous procedural changes. In large part, the proposed rule changes are intended to codify existing practice. Although the proposed rules may affect any trademark applicant or registrant, because they would merely codify the existing practice of the Office, or concern relatively minor procedural matters, the changes proposed in this notice will not have a significant economic impact on a substantial number of small entities.

Unfunded Mandates: The Unfunded Mandates Reform Act requires, at 2 U.S.C. 1532, that agencies prepare an assessment of anticipated costs and benefits before issuing any rule that may result in expenditure by State, local, and tribal governments, in the aggregate, or by the private sector, of \$100 million or more (adjusted annually for inflation) in any given year. This rule would have no such effect on State, local, and tribal governments or the private sector.

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

Paperwork Reduction Act: This proposed rule involves information collection requirements which are subject to review by the Office of Management and Budget under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information in this proposed rule have been reviewed and previously approved

by OMB under control numbers 0651-0009, 0651-0050, 0651-0051, 0651-0054, 0651-0055, and 0651-0056.

The United States Patent and Trademark Office is not resubmitting any information collection package to OMB for its review and approval because the changes in this proposed rule would not affect the information collection requirements associated with the information collections under the OMB control numbers listed above. The changes in this notice are limited to amending the rules of practice to simplify and clarify the requirements for amendments to applications and registrations, reword and reorganize the rules for clarity purposes, and codify current practices and procedures.

Interested persons are requested to send comments regarding these information collections, including suggestions for reduction of this burden to: (1) The Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10202, 725 17th Street, NW., Washington, DC 20503, Attention: Desk Officer for the Patent and Trademark Office; and (2) Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 (Attn: Mary Hannon).

Notwithstanding any other provision of law, no person is required to respond 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 Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects

37 CFR Part 2

Administrative practice and procedure, Trademarks.

37 CFR Part 3

Administrative practice and procedure, Trademarks.

37 CFR Part 6

Administrative practice and procedure, Trademarks, Classification.

37 CFR Part 7

Administrative practice and procedure, Trademarks, International Registration.

For the reasons given in the preamble and under the authority contained in 15 U.S.C. 1123 and 35 U.S.C. 2, as amended, the Office proposes to amend parts 2, 3, 6, and 7 of title 37 as follows:

PART 2—RULES OF PRACTICE IN TRADEMARK CASES

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

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

2. Revise §§ 2.6(a)(8), (12), (13) and (19), and §§ 2.6(b)(3) and (6) to read as follows:

§ 2.6 Trademark fees.

* * * * *

(a) * * *

(8) For issuing a new certificate of registration upon request of registrant—\$100.00.

* * * * *

(12) For filing an affidavit under section 8 of the Act, per class—\$100.00.

(13) For filing an affidavit under section 15 of the Act, per class—\$200.00.

* * * * *

(19) Dividing an application, per new application created—\$100.00.

* * * * *

(b) * * *

(3) Certified or uncertified copy of a trademark-related official record—\$50.00.

* * * * *

(6) For recording each trademark assignment, agreement or other document relating to the property in a registration or application.

* * * * *

3. Revise paragraphs 2.21(a) introductory text, (b), and (c) 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 is in the English language and contains all of the following:

* * * * *

(b) If the applicant does not submit all the elements required in paragraph (a) of this section, the Office will deny a filing date and issue a notice explaining why the filing date was denied.

(c) If the application was filed on paper, the applicant may correct and resubmit the application and fee. If the resubmitted papers and fee meet all the requirements of paragraph (a) of this section, the Office will grant a filing date as of the date the Office receives the corrected document.

4. Revise § 2.23(a)(2) to read as follows:

§ 2.23 Additional requirements for TEAS Plus application.

(a) * * *

(2) Maintain a valid e-mail correspondence address, and continue to receive communications from the Office by electronic mail.

* * * * *

5. Revise § 2.25 to read as follows:

§ 2.25 Documents not returnable.

Except as provided in § 2.27(e), documents filed in the Office by the applicant or registrant become part of the official record and will not be returned or removed.

6. Remove § 2.26.

7. Revise § 2.27(d) to read as follows:

§ 2.27 Pending trademark application index; access to applications.

* * * * *

(d) Except as provided in paragraph (e) of this section, the official records of applications and all proceedings relating thereto are available for public inspection and copies of the documents may be furnished upon payment of the fee required by § 2.6.

* * * * *

8. Revise §§ 2.32(a)(3)(iii), (a)(6), (a)(7), and (a)(8), and add new §§ 2.32(a)(3)(iv), 2.32(a)(9), and (10) to read as follows:

§ 2.32 Requirements for a complete application.

(a) * * *

(3) * * *

(iii) If the applicant is a domestic partnership, the names and citizenship of the general partners;

(iv) If the applicant is a domestic joint venture, the names and citizenship of the active members of the joint venture;

* * * * *

(6) A list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark. In a United States application filed under section 44 of the Act, the scope of the goods and/or services covered by the section 44 basis may not exceed the scope of the goods and/or services in the foreign application or registration;

(7) The international class of goods or services, if known. See § 6.1 of this chapter for a list of the international classes of goods and services;

(8) If the mark is not in standard characters, a description of the mark;

(9) If the mark includes non-English wording, an English translation of that wording; and

(10) If the mark includes non-Latin characters, a transliteration of those characters, and either a translation of the transliterated term in English, or a statement that the transliterated term has no meaning in English.

* * * * *

9. Revise § 2.33(b)(1) to read as follows:

§ 2.33 Verified statement.

* * * * *

(b)(1) In an application under section 1(a) of the Act, the verified statement must allege:

That the applicant is using the mark shown in the accompanying drawing; that the applicant believes it is the owner of the mark; that the mark is in use in commerce; that to the best of the declarant's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used on or in connection with the goods or services; and that the facts set forth in the application are true.

* * * * *

10. Revise §§ 2.34(a)(1)(i), (a)(2), (a)(3)(i) and (a)(4)(ii), and add new § (a)(1)(v), to read as follows:

§ 2.34 Bases for filing.

(a) (1) * * *

(i) The trademark owner's verified statement that the mark is in use 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 also allege that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date;

* * * * *

(v) If more than one item of goods or services is specified in the application, the dates of use required in paragraphs (ii) and (iii) of this section need be for only one of the items specified in each class, provided that the particular item to which the dates apply is designated.

(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 also allege that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application.

(3) * * *

(i) The applicant's verified statement 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 also allege that the applicant had a bona fide intention to use the mark in commerce as of the filing date of the application.

* * * * *

(4) (i) * * *

(ii) Include the applicant's verified statement 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 also allege that the applicant had a bona fide intention to use the mark in commerce as of the filing date of the application.

* * * * *

11. Revise § 2.38(b) to read as follows:

§ 2.38 Use by predecessor or by related companies.

* * * * *

(b) If the mark is not being used by the applicant but is being used by one or more related companies whose use inures to the benefit of the applicant under section 5 of the Act, this must be indicated in the application.

* * * * *

12. Amend § 2.41 by revising the heading and paragraph (a) to read as follows:

§ 2.41 Proof of distinctiveness under section 2(f).

(a) When registration is sought of a mark which would be unregistrable by reason of section 2(e) of the Act but which is said by applicant to have become distinctive in commerce of the goods or services set forth in the application, applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, affidavits, or declarations in accordance with § 2.20, depositions, or other appropriate evidence showing duration, extent and nature of use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and affidavits, or declarations in accordance with § 2.20, letters or statements from the trade or public, or both, or other appropriate evidence tending to show that the mark distinguishes such goods.

* * * * *

13. Revise § 2.44 to read as follows:

§ 2.44 Collective mark.

(a) In an application to register a collective mark under section 1(a) of the Act, the application shall specify and contain all applicable elements required by the preceding sections for trademarks, but shall also specify the class of persons entitled to use the mark, indicating their relationship to the applicant, and the nature of the applicant's control over the use of the mark.

(b) In an application to register a collective mark under section 1(b), section 44 or section 66(a) of the Act, the application shall specify and contain all applicable elements required by the preceding sections for trademarks, but shall also specify the class of persons intended to be entitled to use the mark, indicating what their relationship to the applicant will be, and the nature of the control applicant intends to exercise over the use of the mark.

14. Revise § 2.45(b) to read as follows:

§ 2.45 Certification mark.

(a) * * *

(b) In an application to register a certification mark under section 1(b), section 44 or section 66(a) of the Act, the application shall include all applicable elements required by the preceding sections for trademarks. In addition, the application must: specify the conditions under which the certification mark is intended to be used; allege that the applicant intends to exercise legitimate control over the use of the mark; and allege that the applicant will not engage in the production or marketing of the goods or services to which the mark is applied. When the applicant files an allegation of use under § 2.76 or § 2.88, the applicant must submit a copy of the standards that determine whether others may use the certification mark on their goods and/or in connection with their services.

15. Revise § 2.46 to read as follows:

§ 2.46 Principal Register.

All applications will be treated as seeking registration on the Principal Register unless otherwise stated in the application. Service marks, collective marks, and certification marks are registered on the Principal Register, if they are registrable in accordance with the applicable provisions of section 2 of the Act.

16. Revise §§ 2.47(a), (b), (d) and (e) to read as follows:

§ 2.47 Supplemental Register.

(a) In an application to register on the Supplemental Register under section 23 of the Act, the application shall so

indicate and shall specify that the mark has been in use in commerce, specifying the nature of such commerce, by the applicant.

(b) In an application to register on the Supplemental Register under section 44 of the Act, the application shall so indicate. The statement of use in commerce may be omitted.

* * * * *

(d) A mark in an application to register on the Principal Register under section 1(b) of the Act is eligible for registration on the Supplemental Register only after the applicant files an acceptable allegation of use under § 2.76 or § 2.88.

(e) An application for registration on the Supplemental Register must conform to the requirements for registration on the Principal Register under section 1(a) of the Act, so far as applicable.

17. Add new § 2.48, to read as follows:

§ 2.48 Office does not issue duplicate registrations.

If two applications on the same register would result in registrations that are exact duplicates, the Office will permit only one application to mature into registration, and will refuse registration in the other application.

18. Revise §§ 2.52(b) and (b)(1) to read as follows:

§ 2.52 Types of drawings and format for drawings.

* * * * *

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

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

* * * * *

19. Revise § 2.53(a) to read as follows:

§ 2.53 Requirements for drawings filed through the TEAS.

* * * * *

(a) *Standard character drawings.* If an applicant seeks registration of a standard character mark, the applicant must enter the mark in the appropriate field on the TEAS form, and check the

box to claim that the mark consists of standard characters.

* * * * *

20. Revise §§ 2.56(b)(1), (d)(2) and (d)(4) to read as follows:

§ 2.56 Specimens.

* * * * *

(b)(1) A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is impracticable to place the mark on the goods, packaging for the goods, or displays associated with the goods.

* * * * *

(d)(1) * * *

(2) If the applicant files a specimen exceeding these size requirements (a “bulky specimen”), the Office will create a digital facsimile of the specimen that meets the requirements of the rule (i.e., is flat and no larger than 8½ inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the record. The Office will destroy the original bulky specimen.

* * * * *

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

21. Revise § 2.61(a) to read as follows:

§ 2.61 Action by examiner.

(a) Applications for registration, including amendments to allege use under section 1(c) of the Act and statements of use under section 1(d) of the Act, will be examined and, if the applicant is found not entitled to registration for any reason, applicant will be notified and advised of the reasons therefor and of any formal requirements or objections.

* * * * *

22. Revise § 2.62 to read as follows:

§ 2.62 Procedure for filing response.

(a) *Deadline.* The applicant’s response to an Office action must be received within six months from the date of issuance.

(b) *Signature.* The applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 10.14 of this chapter must sign the response.

23. Revise § 2.64(c)(1) to read as follows:

§ 2.64 Final action.

* * * * *

(c)(1) If an applicant in an application under section 1(b) of the Act files an amendment to allege use under § 2.76

during the six-month response period after issuance of a final action, the examiner shall examine the amendment. The filing of an amendment to allege use does not extend the deadline for filing a response to an outstanding Office action, appeal to the Trademark Trial and Appeal Board, or petition to the Director.

* * * * *

24. Revise §§ 2.65(a) and (c) 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 issued, the application shall be deemed abandoned unless the refusal or requirement is expressly limited to only certain goods and/or services. If the refusal or requirement is expressly limited to only certain goods and/or services, the application will be abandoned only as to those particular goods and/or services. A timely petition to the Director pursuant to §§ 2.63(b) and 2.146 or notice of appeal to the Trademark Trial and Appeal Board (§ 2.142), if appropriate, is a response that avoids abandonment of an application.

* * * * *

(c) If an applicant in an application under section 1(b) of the Act fails to timely file a statement of use under § 2.88, the application shall be deemed to be abandoned.

25. Revise §§ 2.66(a)(1), (d) and (f)(1) to read as follows:

§ 2.66 Revival of abandoned applications.

(a) * * *

(1) Within two months of the date of issuance of the notice of abandonment; or

* * * * *

(d) In an application under section 1(b) of the Act, the Director will not grant the petition if this would permit the filing of a statement of use more than 36 months after the date of issuance of the notice of allowance under section 13(b)(2) of the Act.

* * * * *

(f) * * *

(1) Files the request within two months of the date of issuance of the decision denying the petition; and

* * * * *

26. Revise § 2.73 to read as follows:

§ 2.73 Amendment to recite concurrent use.

An application that includes section 1(a) of the Trademark Act as a filing basis, or for which an acceptable allegation of use under § 2.76 or § 2.88

has been filed, may be amended to an application for concurrent use registration, provided that the application as amended meets the requirements of § 2.42. The trademark examining attorney will determine whether the application, as amended, is acceptable.

27. Revise § 2.74 and its heading to read as follows:

§ 2.74 Form and signature of amendment.

(a) *Form of Amendment.* Amendments should be set forth clearly and completely. Applicant should either set forth the entire wording, including the proposed changes, or, if it would be more efficient, indicate which words should be added and which words should be deleted. The examining attorney may require the applicant to rewrite the entire amendment if necessary for clarification of the record.

(b) *Signature.* The applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 10.14 must sign the request for amendment. If the amendment requires verification, the verification must be sworn to or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant (§ 2.33(a)).

28. Revise §§ 2.75(a) and (b) to read as follows:

§ 2.75 Amendment to change application to different register.

(a) An application for registration on the Principal Register under section 1(a) or 44 of the Act may be changed to an application for registration on the Supplemental Register and vice versa by amending the application to comply with the rules relating to the appropriate register.

(b) An application under section 1(b) of the Act may be amended to change the application to the Supplemental Register only after the applicant submits an acceptable allegation of use under § 2.76 or § 2.88. When such an application is changed from the Principal Register to the Supplemental Register, the effective filing date of the application is the filing date of the allegation of use.

* * * * *

29. Revise § 2.76(d) to read as follows:

§ 2.76 Amendment to allege use.

* * * * *

(d) The title "Allegation of Use" should appear at the top of the document.

* * * * *

30. Revise § 2.77 to read as follows:

§ 2.77 Amendments between notice of allowance and statement of use.

(a) The only amendments that can be entered in an application between the issuance of the notice of allowance and the submission of a statement of use are:

- (1) The deletion of specified goods or services from the identification of goods/services; (2) the deletion of a basis in a multiple-basis application; and (3) a change of attorney or change of address.

(b) Other amendments filed during this period will be placed in the application file and considered when the statement of use is examined.

31. Revise § 2.81 to read as follows:

§ 2.81 Post publication.

(a) Except in an application under section 1(b) of the Act for which no amendment to allege use under § 2.76 has been submitted and accepted, if no opposition is filed within the time permitted or all oppositions filed are dismissed, and if no interference is declared and no concurrent use proceeding is instituted, the application will be prepared for issuance of the certificate of registration as provided in § 2.151.

(b) In an application under section 1(b) of the Act for which no amendment to allege use under § 2.76 has been submitted and accepted, if no opposition is filed within the time permitted or all oppositions filed are dismissed, and if no interference is declared, a notice of allowance will issue. The notice of allowance will state the serial number of the application, the name of the applicant, the correspondence address, the mark, the identification of goods and/or services, and the issue date of the notice of allowance. Thereafter, the applicant must submit a statement of use as provided in § 2.88.

32. Revise § 2.84(b) to read as follows:

§ 2.84 Jurisdiction over published applications.

* * * * *

(b) After publication, but before the certificate of registration is issued in an application under section 1(a), 44 or 66(a) of the Act, or before the notice of allowance is issued in an application under section 1(b) of the Act, 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.

33. Revise § 2.85 to read as follows:

§ 2.85 Classification schedules.

(a) *International classification system.* Section 6.1 of this chapter sets forth the international system of classification for goods and services, which applies for all statutory purposes to:

(1) applications filed in the Office on or after September 1, 1973, and resulting registrations; and

(2) registrations resulting from applications filed on or before August 31, 1973, that have been amended to adopt international classification pursuant to § 2.85(e)(3).

(b) *Prior United States classification system.* Section 6.2 of this chapter sets forth the prior United States system of classification for goods and services, which applies for all statutory purposes to registrations resulting from applications filed on or before August 31, 1973, unless:

(1) the registration has been amended to adopt international classification pursuant to § 2.85(e)(3); or

(2) the registration was issued under a classification system prior to that set forth in § 6.2.

(c) *Certification marks and collective membership marks.* Sections 6.3 and 6.4 specify the system of classification which applies to certification marks and collective membership marks in applications based on sections 1 and 44 of the Trademark Act, and to registrations resulting from applications based on sections 1 and 44. These sections do not apply to applications under section 66(a) or to registered extensions of protection.

(d) *Section 66(a) applications and registered extensions of protection.* In an application under section 66(a) of the Act or registered extension of protection, the classification cannot be changed from the classification assigned by the International Bureau of the World Intellectual Property Organization, unless the International Bureau corrects the classification. Classes cannot be added, and goods or services cannot be transferred from one class to another in a multiple-class application.

(e) *Changes to Nice Agreement.* The international classification system changes periodically, pursuant to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. These changes are

listed in the *International Classification of Goods and Services for the Purposes of the Registration of Marks*, which is published by the World Intellectual Property Organization.

(1) If international classification changes pursuant to the Nice Agreement, the new classification applies only to applications filed on or after the effective date of the change.

(2) In a section 1 or section 44 application filed before an effective date of a change to the Nice Agreement, the applicant may amend the application to comply with the requirements of the current edition. The applicant must comply with the current edition for all goods or services identified in the application. The applicant must pay the fees for any added class(es).

(3) In a registration resulting from a section 1 or section 44 application that was filed before an effective date of a change to the Nice Agreement, the owner may amend the registration to comply with the requirements of the current edition. The owner must reclassify all goods or services identified in the registration to the current edition. The owner must pay the fee required by § 2.6 for amendments under section 7 of the Trademark Act. The owner may reclassify registrations from multiple United States classes (§ 2.85(b)) into a single international classification, where appropriate.

(f) Classification schedules shall not limit or extend the applicant's rights, except that in a section 66(a) application, the scope of the identification of goods or services for purposes of permissible amendments (see § 2.71(a)) is limited by the class, pursuant to § 2.85(d).

34. Revise § 2.86(a)(2) to read as follows:

§ 2.86 Application may include multiple classes.

(a) * * *

(2) Submit an application filing fee for each class, as set forth in § 2.6(a)(1); and
* * * * *

35. Revise § 2.87 to read as follows:

§ 2.87 Dividing an application.

(a) *Application may be divided.* An application may be physically divided into two or more separate applications upon the payment of a fee for each new application created and submission by the applicant of a request in accordance with paragraph (d) of this section.

(b) *Fee.* In the case of a request to divide out one or more entire classes from an application, only the fee for dividing an application as set forth in § 2.6(a)(19) will be required. However, in the case of a request to divide out

some, but not all, of the goods or services in a class, the applicant must submit the application filing fee as set forth in § 2.6(a)(1) for each new separate application to be created by the division, in addition to the fee for dividing an application.

(c) *Time for filing.* (1) An applicant may file a request to divide an application at any time between the application filing date and the date on which the trademark examining attorney approves the mark for publication; or during an opposition, concurrent use, or interference proceeding, upon motion granted by the Trademark Trial and Appeal Board.

(2) An applicant may file a request to divide an application under section 1(b) of the Act with a statement of use under § 2.88 or at any time between the filing of a statement of use and the date on which the trademark examining attorney approves the mark for registration.

(3) An applicant may file a request to divide out one or more bases of a multiple-basis application during the period between the issuance of the notice of allowance under section 13(b)(2) of the Act and the filing of a statement of use under § 2.88.

(d) *Form.* A request to divide an application should be made in a separate document from any other amendment or response in the application. The title "Request to Divide Application" should appear at the top of the first page of the document.

(e) *Outstanding time periods apply to newly created applications.* Any time period for action by the applicant which is outstanding in the original application at the time of the division will be applicable to each separate new application created by the division, except as follows:

(1) If an Office action pertaining to less than all the classes in a multiple-class application is outstanding, and the applicant files a request to divide out the goods, services, or class(es) to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application;

(2) If an Office action pertaining to only one basis in a multiple-basis application is outstanding, and the applicant files a request to divide out the basis to which the Office action does not pertain before the response deadline, a response to the Office action is not due in the new (child) application(s) created by the division of the application; or

(3) In a multiple-basis application in which a notice of allowance has issued,

if the applicant files a request to divide out the basis or bases to which the notice of allowance does not pertain before the deadline for filing the statement of use, the new (child) applications created by the division are not affected by the notice of allowance.

(f) *Signature.* The applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 10.14 must sign the request to divide.

(g) *Section 66(a) applications—change of ownership with respect to some but not all of the goods or services.*

(1) When the International Bureau of the World Intellectual Property Organization notifies the Office that an international registration has been divided as the result of a change of ownership with respect to some but not all of the goods or services, the Office will construe the International Bureau's notice as a request to divide. The Office will record the partial change of ownership in the Assignment Services Branch, and divide out the assigned goods/services from the original (parent) application. The Office will create a new (child) application serial number, and enter the information about the new application in its automated records.

(2) To obtain a certificate of registration in the name of the new owner for the goods/services that have been divided out, the new owner must pay the fee(s) for the request to divide, as required by § 2.6 and paragraph (b) of this section. The examining attorney will issue an Office action in the child application requiring the new owner to pay the required fee(s). If the owner of the child application fails to respond, the child application will be abandoned. It is not necessary for the new owner to file a separate request to divide.

(3) The Office will not divide a section 66(a) application based upon a change of ownership unless the International Bureau notifies the Office that the international registration has been divided.

36. Revise §§ 2.88(a), (b)(1)(ii), (b)(3), (d), and (i)(2) to read as follows:

§ 2.88 Filing statement of use after notice of allowance.

(a) In an application under section 1(b) of the Act, a statement of use under section 1(d) of the Act must be filed within six months after issuance of a notice of allowance under section 13(b)(2) of the Act, or within an extension of time granted under § 2.89. A statement of use that is filed prior to issuance of a notice of allowance is premature.

(b) * * *
(1) * * *

(ii) The mark is in use in commerce, specifying the date of the applicant's first use of the mark and first use of the mark in commerce on or in connection with goods or services identified in the notice of allowance as based on intent to use, and those goods or services specified in the notice of allowance based on intent to use on or in connection with which the applicant uses the mark in commerce;

* * * * *

(3) The fee per class required by § 2.6. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the statement of use, or the application will be abandoned. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant must specify the classes to be abandoned. If the applicant submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to be abandoned, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid to the lowest numbered class(es) in ascending order, and will delete the goods/services in the higher class(es) from the application.

* * * * *

(d) The title "Allegation of Use" should appear at the top of the first page of the document.

* * * * *

(i) * * *

(2) If any goods or services specified in the notice of allowance are omitted from the identification of goods or services in the statement of use, the Office will delete the omitted goods/services from the application. The applicant may not thereafter reinsert these goods/services.

* * * * *

37. Revise § 2.89(a) introductory text, (a)(2), (a)(3), (b)(2) and (g) to read as follows:

§ 2.89 Extensions of time for filing a statement of use.

(a) The applicant may request a six-month extension of time to file the statement of use required by § 2.88. The extension request must be filed within six months of the date of issuance of the notice of allowance under section

13(b)(2) of the Act and must include the following:

(1) * * *

(2) The fee per class required by § 2.6. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the extension request, or the request will be denied. If the applicant timely submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid to the lowest numbered class(es) in ascending order, and will delete the goods/services in the higher class(es) from the application; and

(3) A statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 by a person properly authorized to sign on behalf of the applicant (§ 2.33(a)) that the applicant still has a bona fide intention to use the mark in commerce, specifying the relevant goods or services. If the verification is unsigned or signed by the wrong party, the applicant must submit a substitute verification within six months of the date of issuance of the notice of allowance.

(b) * * *

(2) The fee per class required by § 2.6. The applicant must pay a filing fee sufficient to cover at least one class within the statutory time for filing the extension request, or the request will be denied. If the applicant submits a fee insufficient to cover all the classes in a multiple-class application, the applicant must specify the classes to be abandoned. If the applicant submits a fee sufficient to pay for at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Office will issue a notice granting the applicant additional time to submit the fee(s) for the remaining classes, or specify the class(es) to be abandoned. If the applicant does not submit the required fee(s) or specify the class(es) to be abandoned within the set time period, the Office will apply the fees paid to the lowest numbered class(es) in ascending order, and will delete the goods/services in the higher class(es) from the application;

* * * * *

(g) The applicant will be notified of the grant or denial of a request for an

extension of time, and of the reasons for a denial. Failure to notify the applicant of the grant or denial of the request prior to the expiration of the existing period or requested extension does not relieve the applicant of the responsibility of timely filing a statement of use under § 2.88. If, after denial of an extension request, there is time remaining in the existing six-month period for filing a statement of use, applicant may submit a substitute request for extension of time. Otherwise, the only recourse available after denial of a request for an extension of time is a petition to the Director in accordance with § 2.66 or § 2.146. A petition from the denial of an extension request must be filed within two months of the date of issuance of the denial of the request. If the petition is granted, the term of the requested six-month extension that was the subject of the petition will run from the date of the expiration of the previously existing six-month period for filing a statement of use.

* * * * *

38. Revise § 2.93 to read as follows:

§ 2.93 Institution of interference.

An interference is instituted by the issuance of a notice of interference to the parties. The notice shall be sent to each applicant, in care of the applicant's attorney or other representative of record, if any, and if one of the parties is a registrant, the notice shall be sent to the registrant or the registrant's assignee of record. The notice shall give the name and address of every adverse party and of the adverse party's attorney or other authorized representative, if any, together with the serial number and date of filing and publication of each of the applications, or the registration number and date of issuance of each of the registrations, involved.

39. Revise §§ 2.99(d)(2) and (g) to read as follows:

§ 2.99 Application to register as concurrent user.

* * * * *

(d)(1) * * *

(2) An answer to the notice is not required in the case of an applicant or registrant whose application or registration is specified as a concurrent user in the application, but a statement, if desired, may be filed within forty days after the issuance of the notice; in the case of any other party specified as a concurrent user in the application, an answer must be filed within forty days after the issuance of the notice.

* * * * *

(g) Registrations and applications to register on the Supplemental Register and registrations under the Act of 1920

are not subject to concurrent use registration proceedings. Applications under section 1(b) of the Act of 1946 are subject to concurrent use registration proceedings only after the applicant files an acceptable allegation of use under § 2.76 or § 2.88. Applications based solely on section 44 or section 66(a) of the Act are not subject to concurrent use registration proceedings.

* * * * *

40. Revise § 2.141 to read as follows:

§ 2.141 Ex parte appeals from action of trademark examining attorney.

(a) An applicant may, upon final refusal by the trademark examining attorney, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken, within six months of the date of issuance of the final action. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.

(b) The applicant must pay an appeal fee for each class from which the appeal is taken. If the applicant does not pay an appeal fee for at least one class of goods or services before expiration of the six-month statutory filing period, the application will be abandoned. In a multiple-class application, if an appeal fee is submitted for fewer than all classes, the applicant must specify the class(es) in which the appeal is taken. If the applicant timely submits a fee sufficient to pay for an appeal in at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Board will issue a written notice setting a time limit in which the applicant may either pay the additional fees or specify the class(es) being appealed. If the applicant does not submit the required fee or specify the class(es) being appealed within the set time period, the Board will apply the fee(s) to the classes in ascending order, beginning with the lowest numbered class.

41. Revise § 2.146(b), (c), (d), (e), (i) introductory text and (j)(1) to read as follows:

§ 2.146 Petitions to the Director.

* * * * *

(b) Questions of substance arising during the ex parte prosecution of applications, including but not limited to questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act, are not considered to be appropriate subject matter for petitions to the Director.

(c) Every petition to the Director must include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested,

and the fee required by § 2.6. Any brief in support of the petition should be embodied in or accompany the petition. The petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 10.14 of this chapter must sign the petition. When facts are to be proved on petition, the petitioner must submit proof in the form of affidavits or declarations in accordance with § 2.20, signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.

(d) A petition must be filed within two months of the date of issuance of the action from which relief is requested, unless a different deadline is specified elsewhere in this chapter.

(e)(1) A petition from the grant or denial of a request for an extension of time to file a notice of opposition must be filed within fifteen days from the date of issuance of the grant or denial of the request. A petition from the grant of a request must be served on the attorney or other authorized representative of the potential opposer, if any, or on the potential opposer. A petition from the denial of a request must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition must be made as provided by § 2.119. The potential opposer or the applicant, as the case may be, may file a response within fifteen days from the date of service of the petition and must serve a copy of the response on the petitioner, with proof of service as provided by § 2.119. No further document relating to the petition may be filed.

(2) A petition from an interlocutory order of the Trademark Trial and Appeal Board must be filed within thirty days after the date of issuance of the order from which relief is requested. Any brief in response to the petition must be filed, with any supporting exhibits, within fifteen days from the date of service of the petition. Petitions and responses to petitions, and any documents accompanying a petition or response under this subsection must be served on every adverse party pursuant to § 2.119.

* * * * *

(i) Where a petitioner seeks to reactivate an application or registration that was abandoned, cancelled or expired because documents 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) * * *

(j) * * *

(1) Files the request within two months of the date of issuance of the decision denying the petition; and

* * * * *

42. Revise § 2.153 to read as follows:

§ 2.153 Publication requirements.

A registrant of a mark registered under the provisions of the Acts of 1881 or 1905 may at any time prior to the expiration of the period for which the registration was issued or renewed, upon the payment of the prescribed fee, file an affidavit or declaration in accordance with § 2.20 setting forth those goods stated in the registration on which said mark is in use in commerce, and stating that the registrant claims the benefits of the Trademark Act of 1946.

§§ 2.260–2.166 [Amended]

43. Immediately preceding § 2.160, revise the center heading to read as follows:

Cancellation for Failure To File Affidavit or Declaration

44. Revise § 2.161(g)(3) to read as follows:

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

* * * * *

(g) * * *

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

45. Revise § 2.163(b) to read as follows:

§ 2.163 Acknowledgment of receipt of affidavit or declaration.

* * * * *

(b) A response to the refusal must be filed within six months of the date of issuance of the Office action, or before the end of the filing period set forth in section 8(a) or section 8(b) of the Act, whichever is later. If no response is filed within this time period, the registration will be cancelled, unless there is time remaining in the grace period under section 8(c)(1) of the Act. If there is time remaining in the grace period, the owner may file a complete new affidavit.

46. Revise § 2.165(b) to read as follows:

§ 2.165 Petition to Director to review refusal.

* * * * *

(b) If the examiner maintains the refusal of the affidavit or declaration, a petition to the Director to review the action may be filed. The petition must

be filed within six months of the date of issuance of the action maintaining the refusal, or the Office will cancel the registration and issue a notice of the cancellation.

* * * * *

47. Amend § 2.167 by revising the heading, introductory text and paragraphs (a) and (f) to read as follows:

§ 2.167 Affidavit or declaration under section 15.

The owner of a mark registered on the Principal Register or a mark registered under the Act of 1881 or 1905 and published under § 12(c) of the Act (§ 2.153) may file an affidavit or declaration of incontestability under section 15 of the Act. The affidavit or declaration must:

(a) Be verified (sworn to) or supported by a declaration under § 2.20, signed by the owner of the registration or a person properly authorized to sign on behalf of the owner (§ 2.161(b));

* * * * *

(f) Be filed within one year after the expiration of any five-year period of continuous use following registration or publication under section 12(c). The Office will notify the owner of the receipt of the affidavit or declaration.

* * * * *

48. Revise § 2.171 to read as follows:

§ 2.171 New certificate on change of ownership.

(a) *Full change of ownership.* 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). In a registered extension of protection, the assignment must be recorded with the International Bureau of the World Intellectual Property Organization before it can be recorded in the Office (*see* § 7.22).

(b) *Partial change of ownership.* (1) In a registration resulting from an application based on section 1 or 44 of the Act, if ownership of a registration has changed with respect to some but not all of the goods and/or services, the owner(s) may file a request that the registration be divided into two or more separate registrations. The owner(s) must pay the fee required by § 2.6(a)(8) for each new registration created by the division, and the change of ownership must be recorded in the Office.

(2) (i) When the International Bureau of the World Intellectual Property Organization notifies the Office that an

international registration has been divided as the result of a change of ownership with respect to some but not all of the goods or services, the Office will construe the International Bureau's notice as a request to divide. The Office will record the partial change of ownership in the Assignment Services Branch, and divide out the assigned goods/services from the registered extension of protection (parent registration), issue an updated certificate for the parent registration, and publish notice of the parent registration in the *Official Gazette*.

(ii) The Office will create a new registration number for the child, and enter the information about the new registration in its automated records. The Office will notify the new owner that the new owner must pay the fee required by § 2.6 to obtain a new registration certificate for the child registration. It is not necessary for the new owner to file a separate request to divide.

(iii) The Office will not divide a registered extension of protection unless the International Bureau notifies the Office that the international registration has been divided.

49. Revise § 2.173 to read as follows:

§ 2.173 Amendment of registration.

(a) *Form of amendment.* The owner of a registration may apply to amend a registration or to disclaim part of the mark in the registration. The owner must submit a written request specifying the amendment or disclaimer. If the registration is involved in an inter partes proceeding before the Trademark Trial and Appeal Board, the request must be filed by appropriate motion to the Board.

(b) *Requirements for request.* A request for amendment or disclaimer must:

(1) Include the fee required by § 2.6;

(2) Be signed by the owner of the registration, someone with legal authority to bind the owner (*e.g.*, a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 10.14 of this chapter, and verified or supported by a declaration under § 2.20; and

(3) If the amendment involves a change in the mark: a new specimen showing the mark as used on or in connection with the goods or services; an affidavit or a declaration under § 2.20 stating that the specimen was in use in commerce at least as early as the filing date of the amendment; and a new drawing of the amended mark.

(c) *Registration must still contain registrable matter.* The registration as amended must still contain registrable

matter, and the mark as amended must be registrable as a whole.

(d) *Amendment may not materially alter the mark.* An amendment or disclaimer must not materially alter the character of the mark.

(e) *Amendment of identification of goods.* No amendment in the identification of goods or services in a registration will be permitted except to restrict the identification or to change it in ways that would not require republication of the mark.

(f) *Conforming amendments may be required.* If the registration includes a disclaimer, description of the mark, or other miscellaneous statement, any request to amend the registration must include a request to make any necessary conforming amendments to the disclaimer, description, or other statement.

(g) *Elimination of disclaimer.* No amendment seeking the elimination of a disclaimer will be permitted, unless deletion of the disclaimed portion of the mark is also sought.

50. Revise § 2.174 to read as follows:

§ 2.174 Correction of Office mistake.

Whenever Office records clearly disclose a material mistake in a registration, incurred through the fault of the Office, the Office will issue a certificate of correction stating the fact and nature of the mistake, signed by the Director or by an employee designated by the Director, without charge. Thereafter, the corrected certificate shall have the same effect as if it had been originally issued in the corrected form. In the discretion of the Director, the Office may issue a new certificate of registration without charge.

51. Revise § 2.175(b)(2) to read as follows, and remove paragraph (c):

§ 2.175 Correction of mistake by registrant.

* * * * *

(b) * * *

(2) Be signed by the owner of the registration, someone with legal authority to bind the owner (*e.g.*, a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 10.14 of this chapter, and verified or include a declaration in accordance with § 2.20; and

* * * * *

52. Revise § 2.176 to read as follows:

§ 2.176 Consideration of above matters.

The matters in §§ 2.171 to 2.175 will be considered in the first instance by the Post Registration examiners, except for requests to amend registrations involved in inter partes proceedings before the

Trademark Trial and Appeal Board, as specified in § 2.173(a), which shall be considered by the Board. If an action of the examiner is adverse, registrant may petition the Director to review the action under § 2.146. If the registrant does not respond to an adverse action of the examiner within six months of the date of issuance, the matter will be considered abandoned.

53. Amend § 2.183 by adding a new paragraph (f), to read as follows:

§ 2.183 Requirements for a complete renewal application.

* * * * *

(f) Renewals of registrations issued under a prior classification system will be processed on the basis of that system, unless the registration has been amended to adopt international classification pursuant to § 2.85(e)(3).

54. Revise § 2.184(b) to read as follows:

§ 2.184 Refusal of renewal.

* * * * *

(b)(1) A response to the refusal of renewal must be filed within six months of the date of issuance of the Office action, or before the expiration date of the registration, whichever is later. If no response is filed within this time period, the registration will expire, unless there is time remaining in the grace period under section 9(a) of the Act. If there is time remaining in the grace period, the registrant may file a complete new renewal application.

(2) The registrant, someone with legal authority to bind the registrant (e.g., a corporate officer or general partner of a partnership), or a practitioner who meets the requirements of § 10.14 must sign the response.

* * * * *

55. Revise § 2.186(b) to read as follows:

§ 2.186 Petition to Director to review refusal of renewal.

* * * * *

(b) If the examiner maintains the refusal of the renewal application, a petition to the Director to review the refusal may be filed. The petition must be filed within six months of the date of issuance of the Office action maintaining the refusal, or the renewal application will be abandoned and the registration will expire.

* * * * *

56. Revise §§ 2.195(b) and (e) to read as follows:

§ 2.195 Receipt of trademark correspondence.

* * * * *

(b) *Correspondence delivered by hand.* Correspondence may be delivered

by hand during hours the Office is open to receive correspondence.

* * * * *

(e) *Interruptions in U.S. Postal Service.* (1) If the Director designates a postal service interruption or emergency within the meaning of 35 U.S.C. 21(a), any person attempting to file correspondence by “Express Mail Post Office to Addressee” service who was unable to deposit the correspondence with the United States Postal Service due to the interruption or emergency may petition the Director to consider such correspondence as filed on a particular date in the Office.

(2) The petition must:

(i) Be filed promptly after the ending of the designated interruption or emergency;

(ii) Include the original correspondence or a copy of the original correspondence; and

(iii) Include a statement that the correspondence would have been deposited with the United States Postal Service on the requested filing date but for the designated interruption or emergency in “Express Mail” service; and that the correspondence attached to the petition is the original correspondence or a true copy of the correspondence originally attempted to be deposited as Express Mail on the requested filing date.

(3) Paragraphs (e)(1) and (2) of this section do not apply to correspondence that is excluded from the Express Mail procedure pursuant to § 2.198(a)(1).

PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

57. The authority citation for part 3 continues to read as follows:

Authority: 15 U.S.C. 1112, 1123; 35 U.S.C. 2, unless otherwise noted.

58. In § 3.31, add paragraph (a)(8) and revise paragraph (f) to read as follows:

§ 3.31 Cover sheet content.

(a) * * *

(8) For trademark assignments, the entity and citizenship of the party receiving the interest. In addition, if the party receiving the interest is a domestic partnership or domestic joint venture, the cover sheet must set forth the names, legal entities, and national citizenship (or the state or country of organization) of all general partners or active members that compose the partnership or joint venture.

* * * * *

(f) Each trademark cover sheet should include the citizenship of the party conveying the interest.

* * * * *

PART 6—CLASSIFICATION OF GOODS AND SERVICES UNDER THE TRADEMARK ACT

59. The authority citation for part 6 continues to read as follows:

Authority: 15 U.S.C. 1112, 1123; 35 U.S.C. 2, unless otherwise noted.

60. Revise § 6.3 to read as follows:

§ 6.3 Schedule for certification marks.

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

- A. Goods
- B. Services

61. Revise § 6.4 to read as follows:

§ 6.4 Schedule for collective membership marks.

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

| Class | Title |
|-----------|------------------------|
| 200 | Collective Membership. |

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

62. The authority citation for 37 CFR part 7 continues to read as follows:

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

63. Revise § 7.11(a)(2) to read as follows:

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

(a) * * *

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

* * * * *

64. Revise § 7.14(e) to read as follows:

§ 7.14 Correcting irregularities in international application.

* * * * *

(e) *Procedure for response.* To be considered timely, a response must be received by the International Bureau before the end of the response period set forth in the International Bureau’s notice. Receipt in the Office does not

fulfill this requirement. Any response submitted through the Office for forwarding to the International Bureau should be submitted as soon as possible, but at least one month before the end of the response period in the International Bureau's notice. The Office will not process any response received in the Office after the International Bureau's response deadline.

65. Revise § 7.25(a) to read as follows:

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

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

* * * * *

66. Revise § 7.39(b) to read as follows:

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

* * * * *

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

67. Revise § 7.40(b) to read as follows:

§ 7.40 Petition to Director to review refusal.

* * * * *

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

* * * * *

Dated: June 4, 2008.

Jon W. Dudas,

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

[FR Doc. E8–12909 Filed 6–11–08; 8:45 am]

BILLING CODE 3510–16–P

DEPARTMENT OF HOMELAND SECURITY

Federal Emergency Management Agency

44 CFR Part 67

[Docket No. FEMA–B–7784]

Proposed Flood Elevation Determinations

AGENCY: Federal Emergency Management Agency, DHS.

ACTION: Proposed rule.

SUMMARY: Comments are requested on the proposed Base (1 percent annual-chance) Flood Elevations (BFEs) and proposed BFE modifications for the communities listed in the table below. The purpose of this notice is to seek general information and comment regarding the proposed regulatory flood elevations for the reach described by the downstream and upstream locations in the table below. The BFEs and modified BFEs are a part of the floodplain management measures that the community is required either to adopt or show evidence of having in effect in order to qualify or remain qualified for participation in the National Flood Insurance Program (NFIP). In addition, these elevations, once finalized, will be used by insurance agents, and others to calculate appropriate flood insurance premium rates for new buildings and the contents in those buildings.

DATES: Comments are to be submitted on or before September 10, 2008.

ADDRESSES: The corresponding preliminary Flood Insurance Rate Map (FIRM) for the proposed BFEs for each community are available for inspection at the community's map repository. The respective addresses are listed in the table below.

You may submit comments, identified by Docket No. FEMA–B–7784, to William R. Blanton, Jr., Chief, Engineering Management Branch, Mitigation Directorate, Federal Emergency Management Agency, 500 C Street, SW., Washington, DC 20472, (202) 646–3151 or (e-mail) bill.blanton@dhs.gov.

FOR FURTHER INFORMATION CONTACT:

William R. Blanton, Jr., Chief, Engineering Management Branch, Mitigation Directorate, Federal Emergency Management Agency, 500 C Street, SW., Washington, DC 20472, (202) 646–3151 or (e-mail) bill.blanton@dhs.gov.

SUPPLEMENTARY INFORMATION: The Federal Emergency Management Agency (FEMA) proposes to make

determinations of BFEs and modified BFEs for each community listed below, in accordance with section 110 of the Flood Disaster Protection Act of 1973, 42 U.S.C. 4104, and 44 CFR 67.4(a).

These proposed BFEs and modified BFEs, together with the floodplain management criteria required by 44 CFR 60.3, are the minimum that are required. They should not be construed to mean that the community must change any existing ordinances that are more stringent in their floodplain management requirements. The community may at any time enact stricter requirements of its own, or pursuant to policies established by other Federal, State, or regional entities. These proposed elevations are used to meet the floodplain management requirements of the NFIP and are also used to calculate the appropriate flood insurance premium rates for new buildings built after these elevations are made final, and for the contents in these buildings.

Comments on any aspect of the Flood Insurance Study and FIRM, other than the proposed BFEs, will be considered. A letter acknowledging receipt of any comments will not be sent.

Administrative Procedure Act Statement. This matter is not a rulemaking governed by the Administrative Procedure Act (APA), 5 U.S.C. 553. FEMA publishes flood elevation determinations for notice and comment; however, they are governed by the Flood Disaster Protection Act of 1973, 42 U.S.C. 4105, and the National Flood Insurance Act of 1968, 42 U.S.C. 4001 *et seq.*, and do not fall under the APA.

National Environmental Policy Act. This proposed rule is categorically excluded from the requirements of 44 CFR part 10, Environmental Consideration. An environmental impact assessment has not been prepared.

Regulatory Flexibility Act. As flood elevation determinations are not within the scope of the Regulatory Flexibility Act, 5 U.S.C. 601–612, a regulatory flexibility analysis is not required.

Executive Order 12866, Regulatory Planning and Review. This proposed rule is not a significant regulatory action under the criteria of section 3(f) of Executive Order 12866, as amended.

Executive Order 13132, Federalism. This proposed rule involves no policies that have federalism implications under Executive Order 13132.

Executive Order 12988, Civil Justice Reform. This proposed rule meets the applicable standards of Executive Order 12988.