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§ 6.2 Prior U.S. schedule of classes of goods and services.

Class	Title
GOODS	
1	Raw or partly prepared materials.
2	Receptacles.
3	Baggage, animal equipments, portfolios, and pocket books.
4	Abrasives and polishing materials.
5	Adhesives.
6	Chemicals and chemical compositions.
7	Cordage.
8	Smokers' articles, not including tobacco products.
9	Explosives, firearms, equipments, and projectiles.
10	Fertilizers.
11	Inks and inking materials.
12	Construction materials.
13	Hardware and plumbing and steamfitting supplies.
14	Metals and metal castings and forgings.
15	Oils and greases.
16	Protective and decorative coatings.
17	Tobacco products.
18	Medicines and pharmaceutical preparations.
19	Vehicles.
20	Linoleum and oiled cloth.
21	Electrical apparatus, machines, and supplies.
22	Games, toys, and sporting goods.
23	Cutlery, machinery, and tools, and parts thereof.
24	Laundry appliances and machines.
25	Locks and safes.
26	Measuring and scientific appliances.
27	Horological instruments.
28	Jewelry and precious-metal ware.
29	Brooms, brushes, and dusters.
30	Crockery, earthenware, and porcelain.
31	Filters and refrigerators.
32	Furniture and upholstery.
33	Glassware.
34	Heating, lighting, and ventilating apparatus.
35	Belting, hose, machinery packing, and nonmetallic tires.
36	Musical instruments and supplies.
37	Paper and stationery.
38	Prints and publications.
39	Clothing.
40	Fancy goods, furnishings, and notions.
41	Canes, parasols, and umbrellas.
42	Knitted, netted, and textile fabrics, and substitutes therefor.
43	Thread and yarn.
44	Dental, medical, and surgical appliances.
45	Soft drinks and carbonated waters.
46	Foods and ingredients of foods.
47	Wines.
48	Malt beverages and liquors.
49	Distilled alcoholic liquors.
50	Merchandise not otherwise classified.
51	Cosmetics and toilet preparations.
52	Detergents and soaps.
SERVICES	
100	Miscellaneous.
101	Advertising and business.
102	Insurance and financial.
103	Construction and repair.
104	Communication.
105	Transportation and storage.
106	Material treatment.
107	Education and entertainment.

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

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§ 6.3 Schedule for certification marks.

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

- A. Goods.
- B. Services.

[73 FR 67775, Nov. 15, 2008]

§ 6.4 Schedule for collective membership marks.

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

Class	Title
200	Collective Membership.

[73 FR 67775, Nov. 17, 2008]

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

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- 7.38 Notice to holder of extension of protection.
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- 7.40 Petition to Director to review refusal.

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- 7.41 Renewal of international registration and extension of protection.

AUTHORITY: 15 U.S.C. 1123, 35 U.S.C. 2, Pub. L. 116-260, 134 Stat. 1182, unless otherwise noted.

SOURCE: 68 FR 55769, Sept. 26, 2003, unless otherwise noted.

Subpart A—General Information

§ 7.1 Definitions of terms as used in this part.

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

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

(c) The acronym *TEAS* means the Trademark Electronic Application System, and, as used in this part, includes all related electronic systems required to complete an electronic submission through TEAS.

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

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

(f) The definitions specified in § 2.2 of this chapter apply to this part.

[68 FR 55769, Sept. 26, 2003, as amended at 80 FR 33190, June 11, 2015; 84 FR 31511, July 2, 2019; 84 FR 37098, July 31, 2019]

§ 7.2 [Reserved]

§ 7.3 Correspondence must be in English.

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

§ 7.4 International applications and registrations originating from the USPTO—Requirements to electronically file and communicate with the Office.

(a) Unless stated otherwise in this chapter, all correspondence filed with the USPTO relating to international

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applications and registrations originating from the USPTO must be submitted through TEAS and include a valid email address for correspondence.

(b) Applicants and registrants under this section must provide and maintain a valid email address for correspondence with the Office.

(c) If an applicant or registrant under this section is a national of a country that has acceded to the Trademark Law Treaty, but not to the Singapore Treaty on the Law of Trademarks, the requirements of paragraphs (a) and (b) of this section do not apply.

(d) If TEAS is unavailable, or in an extraordinary situation, an applicant or registrant under this section who is required to file a submission through TEAS may submit a petition to the Director under § 2.146(a)(5) and (c) of this chapter to accept the submission filed on paper.

[84 FR 37098, July 31, 2019]

§ 7.5 [Reserved]

§ 7.6 Schedule of U.S. process fees.

(a) The Office requires the following process fees:

(1) *Certification of international application based on single application or registration.* (i) For certifying an international application based on a single basic application or registration, filed on paper, per class—\$200.00

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

(2) *Certification of international application based on more than one application or registration.* (i) For certifying an international application based on more than one basic application or registration filed on paper, per class—\$250.00

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

(3) *Transmission of subsequent designation.* (i) For transmitting a subsequent designation under § 7.21, filed on paper—\$200.00

(ii) For transmitting a subsequent designation under § 7.21, filed through TEAS—\$100.00

(4) *Transmission of request to record an assignment or restriction.* (i) For transmitting a request to record an assignment or restriction, or release of a restriction, under § 7.23 or § 7.24 filed on paper—\$200.00

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

(5) *Notice of replacement.* (i) For filing a notice of replacement under § 7.28 on paper, per class—\$200.00

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

(6) *Affidavit under section 71.* (i) For filing an affidavit under section 71 of the Act on paper, per class—\$325.00

(ii) For filing an affidavit under section 71 of the Act through TEAS, per class—\$225.00

(iii) For deleting goods, services, and/or classes after submission and prior to acceptance of an affidavit under section 71 of the Act on paper, per class—\$350.00

(iv) For deleting goods, services, and/or classes after submission and prior to acceptance of an affidavit under section 71 of the Act through TEAS, per class—\$250.00

(7) *Filing affidavit under section 71 during grace period.* (i) Surcharge for filing an affidavit under section 71 of the Act during the grace period on paper, per class—\$200.00

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

(8) *Correcting deficiency in section 71 affidavit.* (i) For correcting a deficiency in a section 71 affidavit filed on paper—\$200.00

(ii) For correcting a deficiency in a section 71 affidavit filed through TEAS—\$100.00

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

[81 FR 72708, Oct. 21, 2016, as amended at 85 FR 73217, Nov. 17, 2020]

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EFFECTIVE DATE NOTE: At 86 FR 64333, Nov. 17, 2021, § 7.6 was amended by adding paragraph (a)(9), effective Dec. 1, 2022. At 87 FR 62032, Oct. 13, 2022, the effective date was delayed to Oct. 7, 2023. At 88 FR 62463, Sept. 12, 2023, the effective date was delayed indefinitely. For the convenience of the user, the added and revised text is set forth as follows:

§ 7.6 Schedule of U.S. process fees.

(a) * * *

(9) *Extension of time for filing a response to an Office action under § 7.39(b) or § 7.40(c).* (i) For filing a request for extension of time for filing a response to an Office action under § 7.39(b) or § 7.40(c) on paper—\$225.00.

(ii) For filing a request for extension of time for filing a response to an Office action under § 7.39(b) or § 7.40(c) via TEAS—\$125.00.

* * * * *

§ 7.7 Payments of fees to International Bureau.

(a) For documents filed through TEAS, the following fees may be paid either directly to the International Bureau or through the Office:

(1) International application fees;

(2) Subsequent designation fees; and

(3) Recording fee for an assignment of an international registration under § 7.23.

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

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

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

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

(c) All fees for paper filings must be paid directly to the International Bureau.

(d) The International Bureau fee calculator may be viewed on the Web site

of the World Intellectual Property Organization, currently available at: <http://www.wipo.int/madrid/en/>.

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

Subpart B—International Application Originating From the United States

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

(a) The Office will grant a date of receipt to an international application that is filed through TEAS in accordance with § 7.4(a), or typed on the official paper form issued by the International Bureau, if permitted under § 7.4(c) or accepted on petition pursuant to § 7.4(d). The international application must include all of the following:

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

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

(3) A reproduction of the mark that is the same as the mark in the basic application and/or registration and that meets the requirements of § 2.52 of this title.

(i) If the mark in the basic application and/or registration is depicted in black and white and the basic application or registration does not include a color claim, the reproduction of the mark in the international application must be black and white.

(ii) If the mark in the basic application or registration is depicted in black and white and includes a color claim, the international application must include both a black and white reproduction of the mark and a color reproduction of the mark.

(iii) If the mark in the basic application and/or registration is depicted in color, the reproduction of the mark in the international application must be in color.

(iv) If the international application is filed on paper, the mark must be no more than 3.15 inches (8 cm) high by

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3.15 inches (8 cm) wide, and must appear in the box designated by the International Bureau on the International Bureau's official form;

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

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

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

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

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

(9) The certification fee required by § 7.6;

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

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

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

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57185, Sept. 24, 2004; 73 FR 67775, Nov. 17, 2008; 84 FR 37098, July 31, 2019]

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§ 7.12 Claim of color.

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

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

§ 7.13 Certification of international application.

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

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

§ 7.14 Correcting irregularities in international application.

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

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

goods or services that are broader than the scope of the goods or services in the basic application or registration.

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

(d) *Other Irregularities Requiring Response from Applicant.* Except for responses to irregularities mentioned in paragraph (b) of this section and payment of fees for correcting irregularities mentioned in paragraph (c) of this section, all other responses may be submitted through the Office in accordance with § 7.14(e), or filed directly at the International Bureau. The Office will forward timely responses to the International Bureau, but will not review the responses or respond to any irregularities on behalf of the international applicant.

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

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

Subpart C—Subsequent Designation Submitted Through the Office

§ 7.21 Subsequent designation.

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

(b) The Office will grant a date of receipt to a subsequent designation that is filed through TEAS in accordance with § 7.4(a), or typed on the official

paper form issued by the International Bureau, if permitted under § 7.4(c) or accepted on petition pursuant to § 7.4(d). The subsequent designation must contain all of the following:

(1) The international registration number;

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

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

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

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

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

(7) The U.S. transmittal fee required by § 7.6; and

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

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

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

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

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004; 85 FR 37098, July 31, 2019]

Subpart D—Recording Changes to International Registration

§ 7.22 Recording changes to international registration.

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

§ 7.23 Requests for recording assignments at the International Bureau.

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

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

(1) The international registration number;

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

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

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

(5) A statement, signed and verified (sworn to) or supported by a declaration under § 2.20 of this chapter, that,

for the request to record the assignment, either the assignee could not obtain the assignor's signature because the holder no longer exists, or, after a good-faith effort, the assignee could not obtain the assignor's signature;

(6) An indication that the assignment applies to the designation to the United States or an international registration that is based on a U.S. application or registration;

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

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

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

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

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

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004; 80 FR 2313, Jan. 16, 2015]

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

(a) A party who obtained a security interest or other restriction of a holder's right to dispose of an international registration, or the release of such a

restriction, may submit a request to record the restriction or release through the Office for forwarding to the International Bureau only if:

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

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

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

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

- (1) The international registration number;

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

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

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

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

- (ii) Where the restriction is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, a statement, signed and verified (sworn to) or supported by a declaration under § 2.20 of this chapter, that, for the request to record the restriction, or release of the restriction, either the holder of the international registration could not obtain the signature of the party restricting the holder's right of disposal because the party restricting the holder's right of dis-

posal no longer exists, or, after a good-faith effort, the holder of the international registration could not obtain the signature of the party restricting the holder's right of disposal;

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

- (7) An indication that the restriction, or the release of the restriction, of the holder's right of disposal of the international registration applies to the designation to the United States or an international registration that is based on a U.S. application or registration; and

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

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

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

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

[68 FR 55769, Sept. 26, 2003, as amended at 80 FR 2313, Jan. 16, 2015]

Subpart E—Extension of Protection to the United States

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

(a) Except for §§ 2.21, 2.22, 2.76, 2.88, 2.89, 2.130, 2.131, 2.160 through 2.166, 2.168, 2.173, 2.175, and 2.181 through 2.186, all sections in parts 2 and 11 of this chapter shall apply to an extension of protection of an international registration to the United States, including sections related to proceedings

before the Trademark Trial and Appeal Board, unless otherwise stated.

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

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

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004; 70 FR 38774, July 6, 2005; 73 FR 47686, Aug. 14, 2008; 73 FR 67776, Nov. 17, 2008; 75 FR 35977, June 24, 2010; 78 FR 20197, Apr. 3, 2013; 80 FR 2313, Jan. 16, 2015; 84 FR 37099, July 31, 2019]

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

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

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

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

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

- (a) The request for extension of protection contains a claim of priority;
- (b) The request for extension of protection specifies the filing date, serial number and the country of the applica-

tion that forms the basis for the claim of priority; and

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

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

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

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

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

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

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

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

(3) The fee required by § 7.6.

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

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

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

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

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

§ 7.30 Effect of cancellation or expiration of international registration.

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

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

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

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

- (1) The serial number or registration number of the extension of protection to the United States;
- (2) The name and address of the holder of the international registration;
- (3) Identify the goods and/or services to be transformed, if other than all the goods and/or services that have been cancelled;
- (4) The application filing fee for at least one class of goods or services required by § 2.6(a)(1) of this chapter; and
- (5) An email address for receipt of correspondence from the Office.

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

was accorded to the extension of protection.

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

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

[68 FR 55769, Sept. 26, 2003, as amended at 69 FR 57186, Sept. 24, 2004; 80 FR 2313, Jan. 16, 2015]

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

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

(a) Subject to the provisions of section 71 of the Act, a registered extension of protection shall remain in force for the term of the international registration upon which it is based unless the international registration expires or is cancelled under section 70 of the Act due to cancellation of the international registration by the International Bureau.

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

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

(2) Within the year before the end of every ten-year period after the date of registration in the United States.

(3) The affidavit or declaration may be filed within a grace period of six months after the end of the deadline set forth in paragraphs (b)(1) and (b)(2) of this section, with payment of the grace period surcharge per class required by section 71(a)(3) of the Act and § 7.6.

(c) For the requirements for the affidavit or declaration, see § 7.37.

[68 FR 55769, Sept. 26, 2003, as amended at 75 FR 35977, June 24, 2010]

§ 7.37 Requirements for a complete affidavit or declaration of use in commerce or excusable nonuse; requirement for the submission of additional information, exhibits, affidavits or declarations, and specimens; and fee for deletions of goods, services, and/or classes from a registration.

(a) *Requirements for a complete affidavit or declaration.* A complete affidavit or declaration under section 71 of the Act must:

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

(2) Include a verified statement attesting to the use in commerce or excusable nonuse of the mark within the period set forth in section 71 of the Act. The verified statement must be executed on or after the beginning of the filing period specified in § 7.36(b). A person who is properly authorized to sign on behalf of the holder is:

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

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

(iii) An attorney, as defined in § 11.1 of this chapter, who has an actual written or verbal power of attorney or an implied power of attorney from the holder;

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

(4)(i) Include the fee required by § 7.6 for each class that the affidavit or declaration covers;

(ii) If the affidavit or declaration is filed during the grace period under section 71(a)(3) of the Act, include the grace period surcharge per class required by § 7.6;

(iii) If at least one fee is submitted for a multiple-class registration, but the fee is insufficient to cover all the classes, and the class(es) to which the fee(s) should be applied is not specified, the Office will issue a notice requiring either submission of the additional fee(s) or specification of the class(es) to which the initial fee(s) should be ap-

plied. Additional fees may be submitted if the requirements of § 7.39 are met. If the additional fee(s) is not submitted within the time period set out in the Office action, and the class(es) to which the original fee(s) should be applied is not specified, the Office will presume that the fee(s) covers the classes in ascending order, beginning with the lowest numbered class;

(5)(i) Specify the goods, services, or nature of the collective membership organization for which the mark is in use in commerce, and/or the goods, services, or nature of the collective membership organization for which excusable nonuse is claimed under paragraph (a)(6)(ii) of this section; and

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

(6)(i) State that the registered mark is in use in commerce; or

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

(7) Include one specimen showing how the mark is in use in commerce for each class in the registration, unless excusable nonuse is claimed under paragraph (a)(6)(ii) of this section. When requested by the Office, additional specimens must be provided. The specimen must meet the requirements of § 2.56 of this chapter.

(8) Additional requirements for a collective mark: In addition to the above requirements, a complete affidavit or declaration pertaining to a collective mark must:

(i) State that the holder is exercising legitimate control over the use of the mark in commerce; and

(ii) State the nature of the holder's control over the use of the mark by the

members in the first affidavit or declaration filed under paragraph (a)(1) of this section.

(9) Additional requirements for a certification mark: In addition to the above requirements, a complete affidavit or declaration pertaining to a certification mark must:

(i) Include a copy of the certification standards specified in § 2.45(a)(4)(i)(B) of this chapter;

(A) *Submitting certification standards for the first time.* In the first affidavit or declaration filed under paragraph (a)(1) of this section, include a copy of the certification standards; or

(B) *Certification standards submitted in prior filing.* If the certification standards in use at the time of filing the affidavit or declaration have not changed since the date they were previously submitted to the Office, include a statement to that effect. If the certification standards in use at the time of filing the affidavit or declaration have changed since the date they were previously submitted to the Office, include a copy of the revised certification standards;

(ii) State that the holder is exercising legitimate control over the use of the mark in commerce; and

(iii) Satisfy the requirements of § 2.45(a)(4)(i)(A) and (C) of this chapter.

(b) *Requirement for the submission of additional information, exhibits, affidavits or declarations, and specimens.* The Office may require the holder to furnish such information, exhibits, affidavits or declarations, and such additional specimens as may be reasonably necessary to the proper examination of the affidavit or declaration under section 71 of the Act or for the Office to assess and promote the accuracy and integrity of the register.

(c) *Fee for deletions of goods, services, and/or classes from a registration.* Deletions by the holder of goods, services, and/or classes from a registration after submission and prior to acceptance of the affidavit or declaration must be accompanied by the relevant fee in § 7.6(a)(6)(iii) or (iv).

[85 FR 73217, Nov. 17, 2020]

§ 7.38 Notice to holder of extension of protection.

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

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

The Office will issue a notice as to whether an affidavit or declaration is acceptable, or the reasons for refusal.

(a) 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 71(a) of the Act, whichever is later. The response must be signed by the holder, someone with legal authority to bind the holder (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

(b) If no response is filed within this time period, the extension of protection will be cancelled, unless time remains in the grace period under section 71(a)(3) of the Act. If time remains in the grace period, the holder may file a complete, new affidavit.

(c) If the affidavit or declaration is filed within the time periods set forth in section 71 of the Act, deficiencies may be corrected after notification from the Office, as follows:

(1) *Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 71(a)(1) and 71(a)(2) of the Act.* If the affidavit or declaration is timely filed within the relevant filing period set forth in section 71(a)(1) or section 71(a)(2) of the Act, deficiencies may be corrected before the end of this filing period without paying a deficiency surcharge. Deficiencies may be corrected after the end of this filing period with payment of the deficiency surcharge required by section 71(c) of the Act and § 7.6.

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(2) *Correcting deficiencies in affidavits or declarations filed during the grace period.* If the affidavit or declaration is filed during the six-month grace period provided by section 71(a)(3) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 71(c) of the Act and § 7.6.

(d) If the affidavit or declaration is not filed within the time periods set forth in section 71 of the Act, the registration will be cancelled.

[75 FR 35977, June 24, 2010, as amended at 76 FR 69133, Nov. 8, 2011]

EFFECTIVE DATE NOTE: At 86 FR 64333, Nov. 17, 2021, § 7.39 was revised, effective Dec. 1, 2022. At 87 FR 62032, Oct. 13, 2022, the effective date was delayed to Oct. 7, 2023. At 88 FR 62463, Sept. 12, 2023, the effective date was delayed indefinitely. For the convenience of the user, the revised text is set forth as follows:

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

The Office will issue a notice as to whether an affidavit or declaration is acceptable, or the reasons for refusal.

(a) A response to the refusal must be filed within three 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 response must be signed by the holder, someone with legal authority to bind the holder (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2) of this chapter.

(b) Unless notified otherwise in the Office action, the three-month response period designated in paragraph (a) of this section may be extended by three months up to a maximum of six months from the Office action issue date, upon timely request and payment of the fee set forth in § 7.6(a)(9). To be considered timely, a request for extension of time must be received by the Office on or before the deadline for response set forth in the Office action.

(c) When a timely response is a bona fide attempt to advance the examination of the affidavit or declaration and is a substantially complete response to the outstanding Office action, but consideration of some matter or compliance with a requirement has

been omitted, the holder may be granted 30 days, or to the end of the time period for response to the action to which the substantially complete response was submitted, whichever is longer, to explain and supply the omission before the cancellation is considered.

(d) If no response is filed within this time period, the extension of protection will be cancelled, unless time remains in the grace period under section 71(a)(3) of the Act. If time remains in the grace period, the holder may file a complete, new affidavit.

(e) If the affidavit or declaration is filed within the time periods set forth in section 71 of the Act, deficiencies may be corrected after notification from the Office, as follows:

(1) *Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 71(a)(1) and 71(a)(2) of the Act.* If the affidavit or declaration is timely filed within the relevant filing period set forth in section 71(a)(1) or section 71(a)(2) of the Act, deficiencies may be corrected before the end of this filing period without paying a deficiency surcharge. Deficiencies may be corrected after the end of this filing period with payment of the deficiency surcharge required by section 71(c) of the Act and § 7.6.

(2) *Correcting deficiencies in affidavits or declarations filed during the grace period.* If the affidavit or declaration is filed during the six-month grace period provided by section 71(a)(3) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 71(c) of the Act and § 7.6.

(f) If the affidavit or declaration is not filed within the time periods set forth in section 71 of the Act, the registration will be cancelled.

§ 7.40 Petition to Director to review refusal.

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

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

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

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

EFFECTIVE DATE NOTE: At 86 FR 64334, Nov. 17, 2021, § 7.40 was revised, effective Dec. 1, 2022. At 87 FR 62032, Oct. 13, 2022, the effective date was delayed to Oct. 7, 2023. At 88 FR 62463, Sept. 12, 2023, the effective date was delayed indefinitely. For the convenience of the user, the revised text is set forth as follows:

§ 7.40 Petition to Director to review refusal.

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

(b) If the examiner maintains the refusal of the affidavit or declaration, the holder may file a petition to the Director to review the examiner's action. The petition must be filed within the time periods specified in § 7.39(b) and (c).

(c) If no petition is filed within the time periods set forth in paragraphs (a) and (b) of this section, the registration will be cancelled.

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

Subpart G—Renewal of International Registration and Extension of Protection

§ 7.41 Renewal of international registration and extension of protection.

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

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

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EDITORIAL NOTE: This listing is provided for information purposes only. It is compiled and kept up-to-date by the Department of Commerce. This index is updated as of July 1, 2024.

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