

# Chapter 1900

## Madrid Protocol

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### **1901 Overview of the Madrid System of International Registration**

### **1902 International Application Originating From the United States**

#### 1902.01 Who Can File

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

##### 1902.02(a) Form of International Application

##### 1902.02(b) Basic Application or Registration Number

##### 1902.02(c) Name and Address of Applicant

##### 1902.02(d) Reproduction (Drawing) of Mark

##### 1902.02(e) Color Claim

##### 1902.02(f) Identification of Goods/Services

##### 1902.02(g) Classification in International Applications

##### 1902.02(g)(i) Reclassifying Goods/Services

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

##### 1902.02(g)(iii) Kits, Gift Baskets

##### 1902.02(h) List of Contracting Parties

##### 1902.02(i) Fees

##### 1902.02(j) Statement of Entitlement

##### 1902.02(k) Description of Mark

##### 1902.02(l) Indication of Type of Mark

##### 1902.02(m) E-Mail Address

#### 1902.03 Certification of International Application in USPTO

##### 1902.03(a) Petition to Review Refusal to Certify

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1902.04 Date of International Registration
- 1902.05 IB Requirements for Complete International Application
- 1902.06 Examination of Application by IB
- 1902.07 Irregularities in International Application
  - 1902.07(a) Irregularities that Must Be Remedied by the USPTO
  - 1902.07(b) Irregularities that Must Be Remedied by the Applicant – Applicant Must Respond Directly to the IB
    - 1902.07(b)(i) Fee Irregularities
  - 1902.07(c) Irregularities that Must Be Remedied by the Applicant – Applicant Must Respond Through the USPTO
    - 1902.07(c)(i) Classification of Goods and Services
    - 1902.07(c)(ii) Identification of Goods and Services
  - 1902.07(d) Other Irregularities that Must Be Remedied By Applicant – Applicant May Respond Directly to the IB or Through the USPTO
  - 1902.07(e) Filing Response Directly With the IB
  - 1902.07(f) Responding to Notice of Irregularity Through the USPTO
- 1902.08 Subsequent Designation - Request for Extension of Protection Subsequent to International Registration
  - 1902.08(a) USPTO Requirements
  - 1902.08(b) Form for Filing Subsequent Designation Through the USPTO
  - 1902.08(c) Fees for Subsequent Designation
  - 1902.08(d) IB Requirements for Subsequent Designation
  - 1902.08(e) Irregularities in Subsequent Designation
- 1902.09 Dependence & “Central Attack”: Restriction, Abandonment, Cancellation or Expiration of Basic Application or Registration During First 5 Years
- 1902.10 Transformation When the USPTO is the Office of Origin
- 1902.11 Representative

## MADRID PROTOCOL

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

### **1903 Payment of Fees**

1903.01 Payment of USPTO Fees

1903.02 Payment of International Fees

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

1904.01 Filing Request for Extension of Protection to United States

1904.01(a) Section 66(a) Basis

1904.01(b) Filing Date

1904.01(c) Declaration of Intent to Use Required

1904.01(d) Use Not Required

1904.01(e) Priority

1904.01(f) Filing Fee

1904.01(g) Constructive Use

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

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

1904.02(a) Examined as Regular Application

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

1904.02(c) Mark Must Be Registrable on Principal Register

1904.02(d) Refusal Must Be Made Within 18 Months

1904.02(e) Issuing Office Actions

1904.02(f) Correspondence Address

1904.02(g) Mark Cannot Be Amended

1904.02(h) Drawings and Descriptions of the Mark

1904.02(i) Jurisdiction

1904.03 Notice of Refusal

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- 1904.03(a) Notice Must be Sent Within 18 Months
- 1904.03(b) Requirements for Notice of Refusal
- 1904.03(c) §66(a) Applicant Must Respond to Notification of Refusal
- 1904.03(d) Refusal Pertaining to Less Than All the Goods/Services
- 1904.03(e) Confirmation or Withdrawal of Provisional Refusal
- 1904.03(f) Notification of Correction in the International Register with Respect to a Pending Request for Extension of Protection
- 1904.03(g) Notification of Limitation of the List of Goods/Services with Respect to a Pending Request for Extension of Protection
- 1904.04 Opposition
- 1904.05 Certificate of Extension of Protection
- 1904.06 Assignment of Extension of Protection to the United States
- 1904.07 Invalidation of Protection in United States
- 1904.08 Cancellation of International Registration By IB
- 1904.09 Transformation to Application Under §1 or §44
  - 1904.09(a) Requirements for Transformation
  - 1904.09(b) Examination of Transformed Application
- 1904.10 Affidavits of Use or Excusable Nonuse Required
- 1904.11 Incontestability
- 1904.12 Replacement
- 1904.13 Amendment of Registered Extension of Protection to the United States
- 1904.14 Notification of Correction in the International Register with Respect to Registered Extension of Protection
- 1904.15 Notification of Limitation of the List of Goods/Services with Respect to Registered Extension of Protection
- 1905 Renewal of International Registrations**
- 1906 Communications With International Bureau Regarding International Registrations**
  - 1906.01 Recording Changes in International Register

## MADRID PROTOCOL

- 1906.01(a) Change in Ownership of International Registration
  - 1906.01(a)(i) Requirements for Submitting Changes in Ownership of International Registration Through the USPTO
  - 1906.01(a)(ii) International Fees for Recording Changes of Ownership of International Registration
  - 1906.01(a)(iii) Effect of Change of Ownership of International Registration
  - 1906.01(a)(iv) Dividing an International Registration After Change of Ownership With Respect to Some But Not All of the Goods
- 1906.01(b) Restriction of Holder's Rights of Disposal
- 1906.01(c) Change of the Holder's Name or Address
- 1906.01(d) Change of Name or Address of Representative
- 1906.01(e) Limitation, Renunciation, Cancellation of International Registration
- 1906.01(f) Correction of Errors in International Registration
- 1906.01(g) Merger of International Registrations
- 1906.01(h) License
- 1906.01(i) Changes That Cannot Be Made to International Registration

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

The Madrid Protocol became effective in the United States on November 2, 2003. The Madrid Protocol Implementation Act of 2002, Pub. L. 107-273, 116 Stat. 1758, 1913-1921 ("MPIA") amended the Trademark Act to provide that: (1) the owner of a U.S. application or registration may seek protection of its mark in any of the countries or intergovernmental organizations party to the Madrid Protocol, by submitting a single international application to the IB through the United States Patent and Trademark Office ("USPTO"); and (2) the holder of an international registration may request an extension of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

protection of the international registration to the United States. A notice of final rulemaking amending the Trademark Rules of Practice to incorporate the MPIA was published at [68 Fed. Reg. 55748 \(Sept. 26, 2003\)](#). A notice of final rulemaking amending some of the rules governing the submission of documents under the Madrid Protocol was published at [69 Fed. Reg. 57181 \(Sept. 24, 2004\)](#). See correction notice published at [69 Fed. Reg. 63320 \(Nov. 1, 2004\)](#).

The Madrid Protocol, *Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement* (“Common Regs.”), *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol* (“Guide to International Registration”), *Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto* (“Admin. Instrs.”) are available on the IB’s website, at <http://www.wipo.int/madrid/en/>. The Common Regs. are the procedures agreed to by the parties to the Madrid Protocol regarding the administration of the Madrid Protocol, pursuant to Madrid Protocol Article (“Article”) 10(2)(iii).

### **1901 Overview of the Madrid System of International Registration**

The Madrid system of international registration is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and the Protocol Relating to the Madrid Agreement, which became effective December 1, 1995. The United States is party only to the Protocol, not to the Agreement.

The Madrid system is administered by the IB. To apply for an international registration under the Madrid Protocol, an applicant must be a national of, be domiciled in, or have a real and effective business or commercial establishment in one of the countries or intergovernmental organizations that are members of the Protocol (“Contracting Parties”). The application must be based on one or more trademark application(s) filed in, or registration(s) issued by, the trademark office of one of the Contracting Parties (“basic application(s)” or “basic registration(s)”). The international application must be for the same mark and include a list of goods/services that is identical to or narrower than the list of goods/services in the basic application or registration. The international application must designate one or more Contracting Parties in which an extension of protection of the international registration is sought.

The applicant must submit the international application through the trademark office of the Contracting Party in which the basic application or registration is held (“Office of Origin”). The Office of Origin must certify that the information in the international application corresponds with the information in the basic application or registration, and then forward the international application to the

## MADRID PROTOCOL

IB. If the IB receives the international application within two months of the date of receipt in the Office of Origin, the date of the international registration is the date of receipt in the Office of Origin. If the IB does not receive the international application within two months of the date it was received by the Office of Origin, the date of the international registration is the date on which the international application is received by the IB. See TMEP §1902.04 for information regarding filing requirements that may affect the international registration date.

The international registration is dependent on the basic application or registration for five years from the international registration date. If the basic application or registration is abandoned, cancelled or expired, in whole or in part, during this five-year period, the IB will cancel the international registration accordingly. See TMEP §1902.09 for further information.

The holder of an international registration may request protection in additional Contracting Parties by submitting a subsequent designation. A subsequent designation is a request by the holder of an international registration for an extension of protection of the registration to additional Contracting Parties.

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

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

- *Office of Origin.* The USPTO is the Office of Origin if an international application or registration is based on an application pending in or a registration issued by the USPTO. See TMEP §§1902 *et seq.*
- *Office of a Designated Contracting Party.* The USPTO is the Office of a Designated Contracting Party if the holder of an international registration requests an extension of protection of that registration to the United States. See TMEP §§1904 *et seq.*
- *Office of the Contracting Party of the Holder.* If the holder of an international registration is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States, the holder can file certain requests with the IB through the USPTO, such as requests to record changes of ownership (see TMEP §1906.01(a)(i)) and restrictions on the holder's right to dispose of an international registration (see TMEP §1906.01(b)). The

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

expression “Contracting Party of the Holder” includes the “Office of Origin,” as well as any other Contracting Party in which a holder is a national, is domiciled, or has a real and effective industrial or commercial establishment. Common Reg. 1(xxvi<sup>bis</sup>).

### **1902 International Application Originating From the United States**

This section covers international applications and registrations *originating from* the United States, *i.e.*, international registrations based on an application pending in the USPTO or a registration issued by the USPTO. See TMEP §§1904 *et seq.* for information about requests for extension of protection to the United States by the holder of an international registration originating in another country. International applications originating from the United States are processed by the USPTO’s Madrid Processing Unit (“MPU”).

#### **1902.01 Who Can File**

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

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

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

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

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

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

*(a) The Office will grant a date of receipt to an international application that is either filed through TEAS, or typed on the official paper form issued by the International Bureau. The international application must include all of the following:*

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

## MADRID PROTOCOL

(2) *The name of the international applicant that is identical to the name of the applicant or registrant as it appears in the basic application or basic registration and 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.*

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

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

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

(iv) *If the international application is filed on paper, the mark must be no more than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide, and must appear in the box designated by the International Bureau on the International Bureau's official form;*

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

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

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

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

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

(9) *The certification fee required by §7.6;*

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

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

(12) *If the international application is filed through TEAS, an e-mail address for*

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

*receipt of correspondence from the Office.*

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

### **1902.02(a) Form of International Application**

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

#### *TEAS Form*

TEAS will require the applicant to select between two different forms, a prepopulated form or a free-text form. The applicant should use the prepopulated form if: (1) the international application is based on a single basic application or registration; and (2) applicant’s changes to the international application are limited to:

- Narrowing the list of goods or services;
- Changing the classification;
- Changing the applicant’s address; and/or
- Attaching a color reproduction of the mark where the mark in the basic application or registration is in black and white with a color claim (see TMEP §1902.02(d)).

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

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

#### *Paper Form*

When filing on paper, applicants must submit the official international application form issued by the IB, the MM2 form, to the USPTO. This form is available on the IB website at <http://www.wipo.int/madrid/en/>. The IB will not accept paper applications that are not presented on the official IB form. The

## MADRID PROTOCOL

form cannot be handwritten. Article 3(1); Common Regs. 9(2)(a) and 11(4)(a)(i); Madrid Admin. Instr. §2(b). The applicant should complete the MM2 form online, print the completed form, and submit it to the USPTO by mail.

The completed paper application form must be mailed to the following address:

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

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

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

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

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

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

### **1902.02(b) Basic Application or Registration Number**

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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

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

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

### **1902.02(c) Name and Address of Applicant**

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

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

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

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

Because a delay in certifying and forwarding an international application to the IB may affect the date of the international registration, any request to record a change in ownership of a U.S. basic application or registration should be filed well in advance of the filing of the international application, to allow sufficient processing time. The USPTO strongly recommends use of the Electronic Trademark Assignment System ("ETAS"), at <http://etas.uspto.gov>. Assignments filed electronically are recorded much faster than assignments filed on paper. If there is an unrecorded change in

## MADRID PROTOCOL

ownership, and the international applicant does not use ETAS to record the change, the USPTO may be unable to certify or forward the international application to the IB within two months after the application was received in the USPTO. In this situation, the date of the international registration will be the date of receipt of the application in the IB. See TMEP §1902.04.

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

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

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

### **1902.02(d)      Reproduction (Drawing) of Mark**

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

For paper filers, the mark must appear no larger than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide and must be placed in the box designated by the IB on the MM2 form. 37 C.F.R. §§2.52(d) and 2.54(b); Common Reg. 9(4)(a)(v); *Guide to International Registration*, Paras. B.II.14.01 *et seq.* (2004) For international applications filed electronically, an image of the mark taken from TRAM will appear automatically on the prepopulated TEAS form. If an applicant uses the free-text TEAS form, the applicant must either type the mark in the appropriate field, or attach a digitized image of the mark that meets the requirements of 37 C.F.R. §2.53(c).

*Standard Character Reproductions.* If the mark in the basic application or registration is in standard characters, the reproduction of the mark in the international application must be in standard characters. To claim standard characters, an applicant must check the appropriate box on the IB's official application form MM2, or on the TEAS form. The applicant may not claim standard characters in the international application unless the mark in the basic application or registration is in standard character (or typed) format. See TMEP §§807.03 *et seq.* for information about standard character

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

drawings in applications for registration of marks in the United States. The USPTO's standard character chart is posted on the USPTO website at <http://teas.uspto.gov/standardCharacterSet.html>.

*Special Form Reproductions.* If the mark in the basic application or registration is in special form, the reproduction of the mark in the international application must be in special form.

*Use of Color.* If the mark in the basic application or registration is depicted in black and white and does not include a color claim, the reproduction of the mark in the international application must be black and white. See TMEP §1902.02(e) regarding color claims. If the mark in the basic application or registration is in color, the reproduction of the mark in the international application must be in color. If the mark in the basic application or registration is depicted in black and white, and the basic application or registration includes a color claim, the international application must include *both* a black-and-white reproduction of the mark *and* a color reproduction of the mark that meet the requirements of 37 C.F.R. §2.52, 37 C.F.R. §7.11(a)(3); Common Reg. 9(4)(a)(vii). For example, if the basic application or registration includes a color claim and a black-and-white drawing that depicts the color by the use of color lining or by a statement describing the color, the applicant must include both a color reproduction of the mark showing the claimed colors and a black-and-white reproduction of the mark that corresponds to the mark as it appears in the basic registration. See the note regarding color drawings in United States basic applications or registrations in TMEP §1902.02(e). If filing on paper, the applicant must place the drawings in the appropriate boxes designated by the IB on the MM2 form. If using the TEAS prepopulated form, the black-and-white drawing will automatically prepopulate the form, and the applicant must attach the color reproduction of the mark. For the TEAS free-text form, however, the applicant must attach a digitized image of both the black-and-white reproduction of the mark and the color reproduction of the mark. See TMEP §§807 *et seq.* for general information about the requirements for drawings in applications for registration of marks in the United States.

### **1902.02(e) Color Claim**

If color is claimed as a feature of the mark in the basic application and/or registration, the international application must include a statement that color is claimed as a feature of the mark, and set forth the same name(s) of the color(s) claimed in the basic application and/or registration. 37 C.F.R. §§7.11(a)(4) and 7.12(a).

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

## MADRID PROTOCOL

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

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

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

### **1902.02(f) Identification of Goods/Services**

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

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

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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

### **1902.02(g) Classification in International Applications**

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

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

### **1902.02(g)(i) Reclassifying Goods/Services**

If the goods or services in the basic application or registration are classified in Classes A, B or 200 (which are not part of the international classification system) (see TMEP §1902.02(g)(ii)), or are classified in other classes under the old U.S. classification system (see TMEP §1401.02), it is advisable to reclassify the goods/services into international classes in the international application. Applicants using the prepopulated TEAS form will have to reclassify goods or services in Classes A, B or 200, or other U.S. classes, into international classes because the form does not recognize these class designations.

In addition, if the identification of goods in the basic application or registration comprises kits or gift baskets (see TMEP §1902.02(g)(iii)), it is advisable for the international applicant to either narrow the identification in order to classify

## MADRID PROTOCOL

the goods in a single international class, or pay additional fees for additional international classes.

In the situations discussed below, it is advisable for the international applicant to reclassify the goods/services in the international application, in order to avoid issuance of a notice of irregularity by the IB.

### **1902.02(g)(ii) United States Classes A, B & 200**

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

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

#### *United States Classes A & B*

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

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

#### *United States Class 200*

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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

### **1902.02(g)(iii) Kits, Gift Baskets**

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

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

### **1902.02(h) List of Contracting Parties**

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

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

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

## MADRID PROTOCOL

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

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

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

### **1902.02(i) Fees**

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

*International Fees.* If an international application is submitted through TEAS, the international fees for all classes and all designated Contracting Parties must be paid at the time of submission. 37 C.F.R. §7.11(a)(10). International fees for paper applications must be paid directly to the IB, and may be paid either before or after the international application is submitted to the USPTO. 37 C.F.R. §7.7(c). However, international fees paid after the IB receives the international application could result in a notice of irregularity issued by the IB (see TMEP §1902.07(b)(i)). Applicants filing on paper may submit a bank check for the international fees in Swiss francs made payable to the IB with the international application. If the international application meets the requirements for certification, the USPTO will forward the check with the international application to the IB. If the USPTO denies certification, the check will be returned with the international application to the applicant.

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

### **1902.02(j) Statement of Entitlement**

An international application must include a statement that the applicant is entitled to file an international application, specifying that the applicant: (i) is a national of the United States; (ii) has a domicile in the United States; or (iii) has a real and effective industrial or commercial establishment in the United States. Where an applicant's address is not in the United States, the applicant must provide the address of the United States domicile or establishment. 15 U.S.C. §1141a; 37 C.F.R. §7.11(a)(11).

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1902.02(k) Description of Mark**

If the basic application or registration includes a description of the mark, an international application must include the same description. 37 C.F.R. §7.11(a)(5). The applicant cannot include a description of the mark in the international application if the basic application or registration does not contain a description of the mark. *Guide to International Registration*, Para. B.II.15.07 (2004).

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

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

### **1902.02(l) Indication of Type of Mark**

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

### **1902.02(m) E-Mail Address**

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

### **1902.03 Certification of International Application in USPTO**

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

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

## MADRID PROTOCOL

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

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

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the application does not meet the requirements of 37 C.F.R. §7.11(a), the USPTO will not certify the application, or forward it to the IB. The USPTO will notify the applicant of the reason(s) why the application cannot be certified. The USPTO will refund any international fees paid through TEAS. The USPTO certification fee will not be refunded. 37 C.F.R. §7.13(b).

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

### **1902.03(a) Petition to Review Refusal to Certify**

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

The petition should be mailed to:

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

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

The applicant can also hand-deliver the petition to the Trademark Assistance Center at James Madison Building, East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention MPU. TAC is open 8:30 a.m. to 8:00

## MADRID PROTOCOL

p.m. Eastern Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c).

### **1902.04 Date of International Registration**

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

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

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

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

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

### **1902.05 IB Requirements for Complete International Application**

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

examine it for completeness. The requirements for a complete international application originating from the United States are:

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

## MADRID PROTOCOL

and white, the mark in the international application must be in black and white. If the mark in the basic application or registration is depicted in black and white, but contains a claim of color as a feature of the mark, the applicant must submit *both* (1) a black-and-white image that is the same as the mark in the basic application or registration; and (2) a color reproduction depicting the color(s) claimed. Common Reg. 9(4)(a)(vii);

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- *Indication of Second Language.* If an applicant designates the European Community as a Contracting Party, applicant is required to indicate a second language, in addition to the language in the international application (Common Reg. 9(5)(g)(i)).

### *Additional Elements That May Be Included in International Application*

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

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

## MADRID PROTOCOL

form MM2, this information must be submitted on the IB's official MM17 form. The MM17 form should be annexed to the international application form.

### **1902.06 Examination of Application by IB**

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

### **1902.07 Irregularities in International Application**

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

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

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

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

**To be considered timely, responses to IB notices of irregularities must be received by the IB before the end of the response period set forth in the IB's notice. Receipt of the response in the USPTO does not satisfy this requirement.**

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

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

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

- Application is not presented on the official form or is not typed (Common Reg. 11(4)(a)(i); *Guide to International Registration*, Para. B.II.25.03(a) (2004));
- Omission of reproduction of mark;
- Omission of list of goods/services;
- Omission of designation of Contracting Party or Parties;
- Insufficient identification of applicant;
- Irregularities relating to the entitlement of the applicant to file an international application;
- Application not signed by USPTO (Signature may be replaced with seal);
- Certification by USPTO is defective;
- Omission of date and number of basic application or registration.

Common Regs. 11(4) and 15(1).

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

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

## MADRID PROTOCOL

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

#### **1902.07(b)(i) Fee Irregularities**

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

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

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

#### **1902.07(c)(i) Classification of Goods and Services**

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

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

An MPU trademark specialist will review the applicant's response, but only to ensure that the response consists solely of an amendment to classification and that no amendments to the identification of the goods or services have been proposed. So long as the only proposed change is to classification, and such change in classification does not expand the listing of goods/services to exceed the scope of the underlying basic application or registration, the USPTO will forward it to the IB and notify the applicant accordingly. See TMEP §1902.07(c)(ii) regarding proposed amendments to the identification of goods/services.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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

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

See also TMEP §1401.03(d).

### **1902.07(c)(ii) Identification of Goods and Services**

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

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

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

If no proposal acceptable to the IB for remedying the irregularity is made within 3 months, and all other requirements have been met, the IB will either: (1) include the term in the international registration with an indication that the IB considers the term to be unacceptable, if the class of the vague term was

## MADRID PROTOCOL

specified in the application; or (2) if the class was not specified, delete the term and notify both the USPTO and the applicant accordingly. Common Reg. 13(2)(b).

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

Other irregularities to be remedied by applicant include, but are not limited to, insufficient information about the applicant's representative; missing transliteration; insufficient information about a priority claim; unclear reproduction of the mark; and color claim with no color reproduction. The applicant must remedy the irregularities within three months of the date of the notification. Common Reg. 11(2).

An applicant may file the response to these irregularities either directly with the IB, or through the USPTO either electronically or on paper. To be considered timely, responses to IB notices of irregularities must be received by the IB before the end of the response period set forth in the IB's notice. Receipt in the USPTO does not fulfill this requirement.

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

### **1902.07(e) Filing Response Directly With the IB**

Information about filing responses directly with the IB is available on the WIPO website, currently at <http://www.wipo.int/madrid/en/>. An applicant may contact the IB by mail to 34 chemin des Colombettes, P.O. Box 18, 1211 Geneva 20, Switzerland; by telephone at 41 22 338 9111; by fax to 41 22 740 1429; or by e-mail to [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int).

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

Under Trademark Rule 7.14(e), 37 C.F.R. §7.14(e), an applicant may file a response to an IB notice of irregularity through the USPTO for forwarding to the IB before the IB's response deadline. The response may be filed electronically or on paper. **However, receipt in the USPTO does not fulfill the requirement that the response be received by the IB before the IB response deadline.** Therefore, applicants should submit responses to the USPTO as soon as possible, at least one month before the end of the IB response period.

The IB does not have a form for responses to irregularity notices. Applicants are strongly encouraged to use the TEAS form for responses to notices of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

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

Applicants submitting responses on paper should mail the document to the following address:

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

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

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

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

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

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

A subsequent designation is a request by the holder of an international registration for an extension of protection of the international registration to additional Contracting Parties, made after the IB registers the mark. The requirements for a subsequent designation are set forth in Article 3<sup>ter</sup>(2) and

## MADRID PROTOCOL

Common Reg. 24. The holder may file the subsequent designation directly with the IB. There is a form for filing a subsequent designation on the IB website at <http://www.wipo.int/madrid/en/>.

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

### **1902.08(a) USPTO Requirements**

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

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

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

The USPTO does not certify subsequent designations. If a subsequent designation meets the requirements set forth in 37 C.F.R. §7.21(b), the USPTO will forward it to the IB. 37 C.F.R. §7.21(c). If the subsequent

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

designation does not meet these requirements, the USPTO will not forward the subsequent designation, and will notify the holder of the reasons. The USPTO transmittal fee is nonrefundable. 37 C.F.R. §7.21(d).

If the subsequent designation meets the requirements of Common Reg. 24, the IB will record it and notify both the USPTO and the holder of the recordation. Common Reg. 24(7). The subsequent designation will bear the date of receipt in the USPTO, provided that the IB receives it within two months of that date. If the IB does not receive the subsequent designation within two months of the date of receipt in the USPTO, the subsequent designation will bear the date of receipt in the IB. Common Reg. 24(6)(b).

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

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

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

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

Once the subsequent designation form is completed, it may be mailed to the USPTO at the following address:

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

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

## MADRID PROTOCOL

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

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

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

### **1902.08(c) Fees for Subsequent Designation**

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

*International Fees.* If the subsequent designation is filed through TEAS, all international fees for the subsequent designation must be paid at the time of submission. 37 C.F.R. §7.21(a)(8). International fees for subsequent designations filed on paper must be paid directly to the IB in Swiss currency, either before or after submission of the subsequent designation. However, international fees paid after the IB receives the subsequent designation could result in a notice of irregularity issued by the IB. When submitting the subsequent designation on paper to the USPTO, the holder may submit a bank check for international fees in Swiss francs made payable to the IB. The USPTO will forward the check with the subsequent designation to the IB.

See TMEP §1903.02 regarding payment of international fees.

### **1902.08(d) IB Requirements for Subsequent Designation**

The requirements for a subsequent designation are set forth in Article 3<sup>ter</sup> and Common Reg. 24. If the subsequent designation meets the minimum requirements for a date of receipt set forth in 37 C.F.R. §7.21(b) (see TMEP §1902.08(a)), the USPTO will forward the subsequent designation to the IB. *The USPTO will not examine it to determine whether it is complete.* The IB will examine it for completeness.

If the subsequent designation meets the applicable requirements, the IB will record it in the International Register and notify the holder, the Offices of the

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

designated Contracting Parties and the USPTO, if the subsequent designation was submitted through the USPTO. Common Reg. 24(8).

### **1902.08(e) Irregularities in Subsequent Designation**

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

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

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

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

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

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

In view of the above notification requirements, applicants and registrants are encouraged to exercise diligence in monitoring the status of their basic application or basic registration (see TMEP §1705.05). Once the IB cancels or restricts an international registration, it cannot be reinstated. If a problem arises with the basic application or registration, or a status inquiry reveals that the basic application or registration has become improperly abandoned or cancelled, the applicant or registrant should promptly take corrective action.

## MADRID PROTOCOL

See TMEP §§1712 *et seq.* for information regarding reinstatement of abandoned applications and cancelled registrations; and TMEP §§1714 *et seq.* regarding petitions to revive abandoned applications.

### **1902.10 Transformation When the USPTO is the Office of Origin**

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

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

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

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

### **1902.11 Representative**

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

See TMEP §§603.01(a) and 1904.02(f) regarding the correspondence address in a request for extension of protection to the United States.

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

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

### **1903 Payment of Fees**

#### **1903.01 Payment of USPTO Fees**

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

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

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

#### **1903.02 Payment of International Fees**

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

## MADRID PROTOCOL

The IB will accept the following forms of payment:

- Debit to a current account established with the IB;
- Payment into the Swiss postal check account or to any of the specified bank accounts of the IB;
- Banker's check in Swiss currency; and
- Payment in cash at the IB.

Admin. Instr. §19.

The conditions for opening, using, and closing a current account with the IB are posted on the IB website at <http://www.wipo.int/madrid/en>.

When submitting international applications, subsequent designations and requests to record changes of ownership of international registrations on paper to the IB through the USPTO, the applicant/holder may include a banker's check payable to the IB in Swiss francs for forwarding to the IB with the submission.

Questions concerning payment of international fees should be directed to the IB by mail to the World Intellectual Property Organization, 34 chemin des Colombettes, P.O. Box 18, 1211 Geneva 20, Switzerland; by telephone at 41 22 338 9111; by fax to 41 22 740 1429; or by e-mail to [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int). The USPTO cannot assist applicants/holders in calculating the appropriate international fees or in selecting a method of payment of fees to the IB.

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

#### **1904.01 Filing Request for Extension of Protection to United States**

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1904.01(a) Section 66(a) Basis**

Section 66(a) of the Trademark Act provides a basis for filing in the United States. See 37 C.F.R. §2.34(a)(5). A §66(a) applicant cannot change the basis or claim more than one basis. 37 C.F.R. §§2.34(b)(3) and 2.35(a).

### **1904.01(b) Filing Date**

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

### **1904.01(c) Declaration of Intent to Use Required**

Section 66(a) of the Trademark Act requires that a request for extension of protection to the United States include a declaration that the applicant has a bona fide intention to use the mark in commerce that can be controlled by the United States Congress. The declaration must include a statement that the person making the declaration believes the applicant to be entitled to use the mark in commerce; and that to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive. 15 U.S.C. §1141(5).

The declaration must be signed by: (1) a person with legal authority to bind the applicant; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or (3) an attorney authorized to practice before the USPTO under 37 C.F.R. §10.14 who has an actual written or verbal power of attorney or an implied power of attorney from the applicant. 37 C.F.R. §2.33(a).

The USPTO has provided the IB with wording for the declaration of the applicant's bona fide intention to use the mark in commerce, which is part of the official IB form for international applications and subsequent designations in which the United States is designated for an extension of protection (IB Form MM18). Instructions as to who is a proper party to sign the declaration pursuant to 37 C.F.R. §2.33(a) have also been provided to the IB.

The IB will check to ensure that the MM18 form is annexed to the international application or subsequent designation in which there is a request for extension of protection to the United States, that the wording of the

## MADRID PROTOCOL

declaration has not been altered, and that the document has been signed before forwarding the request for extension of protection to the USPTO. The IB will not send the verified statement to the USPTO with the request for extension of protection.

The verified statement remains part of the international registration on file at the IB. 37 C.F.R. §2.33(e). The examining attorney will not review the international registration to determine whether there is a proper declaration of intent to use, or issue any inquiry regarding the verification of the application on file with the IB. However, if the applicant voluntarily files a substitute declaration with the USPTO, it will be examined according to the same standards used for examining any other declaration. See TMEP §804.06 for further information about declarations in §66(a) applications.

### **1904.01(d) Use Not Required**

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

### **1904.01(e) Priority**

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

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

Section 67 of the Trademark Act, 15 U.S.C. §1141g; Madrid Protocol Article 4(2).

To be eligible for a claim of priority in a 66(a) application, a holder must file a request for extension of protection to the United States within 6 months of the date of the filing that forms the basis of the priority claim. If the United States is designated for an extension of protection in an international application, the international registration date cannot be later than 6 months after the date of

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

the filing that formed the basis of the priority claim. If a request for extension of protection to the United States is made in a subsequent designation, the date of recordal of the subsequent designation cannot be later than 6 months after the date of the filing that formed the basis of the priority claim.

### **1904.01(f) Filing Fee**

The filing fee for a §66(a) application will be sent to the USPTO by the IB. The examining attorney should not require additional filing fees during examination, except where the application is divided due to a change of ownership with respect to some but not all of the goods/services. See Article 8 and Common Regs. 34 through 38 regarding international fees, and TMEP §1110.08 regarding dividing a §66(a) application after a change of ownership.

### **1904.01(g) Constructive Use**

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

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

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

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

## MADRID PROTOCOL

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

#### **1904.02(a) Examined as Regular Application**

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

Except for 37 C.F.R. §§2.22-2.23, 2.130-2.131, 2.160-2.166, 2.168, 2.173, 2.175, 2.181-2.186 and 2.197, all rules in 37 C.F.R. Part 2 apply to a request for extension of protection of an international registration to the United States, including sections related to proceedings before the Trademark Trial and Appeal Board, unless stated otherwise. All rules in 37 C.F.R. Part 10 relating to representation of others before the USPTO also apply to requests for extension of protection. 37 C.F.R. §7.25(a).

#### **1904.02(b) Examination of Identification and Classification of Goods/Services in §66(a) Applications**

The examining attorney will examine the identification of goods/services in a §66(a) application according to the same standards of specificity used in examining applications under §1 and §44 of the Trademark Act, 15 U.S.C. §§1051 and 1126. Specifically, the examining attorney must follow the procedures set forth in the TMEP and identify the goods/services in accordance with the USPTO's *Manual of Acceptable Identification of Goods and Services* ("USPTO ID Manual") whenever possible.

However, the international classification of goods/services in a §66(a) application **cannot be changed** from the classification given to the goods/services by the IB. Under Article 3(2), the IB controls classification. The §66(a) application (and any resulting registration) remains part of the international registration, and a change of classification in the United States would have no effect on the international registration. TMEP §1401.03(d). Any change in classification inadvertently made during examination will ultimately be refused by the IB upon notification of the final grant of protection. The USPTO will issue corrections to the holder and to the IB.

Accordingly, if the initial identification of goods/services in the §66(a) application is definite, but misclassified under United States standards, the examining attorney must accept the identification, and cannot change the classification. If the initial identification of goods/services is not definite, the classification cannot be changed and the scope of the identification for

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

purposes of permissible amendment *is* limited by the classification. See TMEP §§1401.03(d), 1402.01(c) and 1402.07(a).

An international registration may encompass goods/services that were classified under an earlier version of the Nice Agreement. If the IB's classification of goods/services in the §66(a) application is different from the classification currently set forth in the USPTO ID Manual, the examining attorney will not request an amendment of the classification. The goods/services cannot be moved to another class identified in the application.

Accordingly, if the mark in a §66(a) application appears to be a certification or collective membership mark, the USPTO **will not** reclassify it into United States Class A, B or 200. However, the applicant must comply with all other United States requirements for certification and collective membership marks, regardless of the classification chosen by the IB. See TMEP §§1304 *et seq.* and 1306 *et seq.*

### **1904.02(c) Mark Must Be Registrable on Principal Register**

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

### **1904.02(d) Refusal Must Be Made Within 18 Months**

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

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

### **1904.02(e) Issuing Office Actions**

The USPTO will send the first Office action in a §66(a) application to the IB. The first Office action is known as a provisional refusal and must be reviewed by the IB. If the provisional refusal meets the applicable requirements, (see TMEP §1904.03 *et seq.*), the IB will process the refusal and send it to the holder (*i.e.*, the §66(a) applicant). The IB notifies the USPTO of the date on which it processed the refusal, and the USPTO updates the TRAM database with this information. A response to the Office action issued by the USPTO is

## MADRID PROTOCOL

due within six months of the date on which the USPTO sent the action to the IB, not the date on which the refusal was processed by the IB.

An examiner's amendment or a combined examiner's amendment/priority action (see TMEP §§707 *et seq.* and 708.05) may not be issued as a first Office action because the IB will not accept such amendments. Examiner's amendments and combined examiner's amendments/priority actions may be issued as second and subsequent actions if authorized by the applicant, someone with legal authority to bind the applicant, or a practitioner authorized to practice before the USPTO pursuant to 37 C.F.R. §10.14.

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

### **1904.02(f) Correspondence Address**

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

The USPTO will send second and subsequent Office actions, and other notices to the §66(a) applicant's correspondence address of record. The USPTO will accept a notice of change of the correspondence address in a §66(a) application or a registered extension of protection to the United States, and will send correspondence to the new address. See TMEP §§603 *et seq.* regarding the procedures for establishing and changing the correspondence address in the USPTO.

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

See TMEP §603.04 regarding correspondence with parties not domiciled in the United States, and §§602.06 *et seq.* regarding foreign attorneys.

### **1904.02(g) Mark Cannot Be Amended**

The Madrid Protocol and the Common Regulations do not permit amendment of a mark in an international registration. If the holder of the international registration wants to change the mark in any way, even slightly, the holder

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

must file a new international application. The IB's *Guide to International Registration*, Para. B.II.69.02 (2004), provides as follows:

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

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

### **1904.02(h) Drawings and Descriptions of the Mark**

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

If the drawing does not meet United States requirements (*e.g.*, due to the improper inclusion of the federal registration symbol ®, or the unacceptable reproductive quality of the image), the examining attorney will require a substitute drawing. Furthermore, if the reproduction of the mark in the international registration consists of multiple renditions of a three-dimensional mark, the applicant will be required to either: (1) comply with the United States requirement to depict the mark in a single rendition, 37 C.F.R. §2.52(b)(2)); or (2) petition the Director to waive this requirement. See TMEP Chapter 1700 regarding petitions, and TMEP §807.10 regarding drawings of three-dimensional marks.

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

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

## MADRID PROTOCOL

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

### **1904.02(i) Jurisdiction**

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

### **1904.03 Notice of Refusal**

#### **1904.03(a) Notice Must be Sent Within 18 Months**

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

- (1) A notification of refusal based on examination;
- (2) A notification of refusal based on the filing of an opposition; or
- (3) A notification of the possibility that an opposition may be filed after expiration of the 18-month period. If the USPTO notifies the IB of the possibility of opposition, it must send the notification of refusal within 7 months after the beginning of the opposition period or within one month after the end of opposition period, whichever is earlier.

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

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

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1904.03(b) Requirements for Notice of Refusal**

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

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

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

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

A holder of an international registration who applies for an extension of protection to the United States will receive any notification of refusal through the IB. The holder must respond directly to the USPTO. The holder may be represented by an attorney, but only if such attorney meets the requirements of 37 C.F.R. §10.14 (see TMEP §§602 *et seq.*). Standard examination procedures are used to examine §66(a) applications.

A foreign attorney who does not meet the requirements of 37 C.F.R. §10.14 cannot represent the applicant before the USPTO or sign a response to an Office action on behalf of the applicant. See TMEP §§602.03, 602.06 *et seq.*, 605.02, 712.01 and 712.03.

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

If a notification of refusal in a §66(a) application does not pertain to all the goods/services, the mark is protected for the remaining goods/services, even

## MADRID PROTOCOL

if the holder does not respond to the notification of refusal. Sections 68(c) and 69(a) of the Trademark Act, 15 U.S.C. §§1141h(c) and 1141i(a), provide that an application under §66(a) of the Trademark Act is automatically protected with respect to any goods or services for which the USPTO has not timely notified the IB of a refusal.

Accordingly, 37 C.F.R. §2.65(a) provides that if a refusal or requirement is expressly limited to only certain goods/services and the applicant fails to file a complete response to the refusal or requirement, the application shall be abandoned only as to those particular goods/services. See TMEP §718.02(a) for further information about partial abandonment.

### **1904.03(e) Confirmation or Withdrawal of Provisional Refusal**

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

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

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

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

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

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the MPU determines that review by the examining attorney is required, the MPU will notify the examining attorney of the correction and the examining attorney will determine whether the correction can be accepted. If the examining attorney determines that the correction is not acceptable, he or she must issue an Office action refusing the correction, indicating the reasons why the correction is unacceptable. The examining attorney must also notify the MPU that a new refusal has been made, and the MPU will ensure that the IB is notified of the new grounds for refusal. The applicant may argue against the refusal, and, if such refusal is made final, appeal to the Trademark Trial and Appeal Board or petition to the Director pursuant to 37 C.F.R. §2.146.

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

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

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

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

If the MPU determines that review by the examining attorney is required, the MPU will notify the examining attorney, and the examining attorney will determine whether the limited goods/services are within the scope of the identification of goods/services as presently identified in the §66(a) application. If the examining attorney determines that the limitation is not acceptable (*e.g.*, because he or she determines that the change requested results in an extension rather than a limitation of the goods/services), he or she must issue an Office action refusing the limitation, indicating the reasons why the limitation is unacceptable. The examining attorney must also notify the MPU that a new refusal has been made, and the MPU will ensure that the IB is notified that the limitation has no effect in the United States. The applicant may argue against the refusal of the limitation, and, if such refusal is made final, appeal to the Trademark Trial and Appeal Board or petition to the Director pursuant to 37 C.F.R. §2.63(b).

## MADRID PROTOCOL

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

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

### **1904.04            Opposition**

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

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

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

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

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

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

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1904.05 Certificate of Extension of Protection**

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

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

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

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

### **1904.06 Assignment of Extension of Protection to the United States**

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

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

## MADRID PROTOCOL

trademark database and the assignment database to reflect the change(s). See TMEP §501.07.

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

Section 10 of the Trademark Act and 37 C.F.R. Part 3 do not apply to assignments of international registrations or extensions of protection to the United States. 37 C.F.R. §7.22.

### **1904.07           Invalidation of Protection in United States**

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

### **1904.08           Cancellation of International Registration By IB**

If the IB notifies the USPTO that an international registration has been cancelled with respect to some or all of the goods/services, the USPTO will cancel the extension of protection of that international registration to the United States with respect to such goods/services as of the date that the IB cancelled the international registration. 15 U.S.C. §1141j(a); 37 C.F.R. §7.30.

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

### **1904.09           Transformation to Application Under §1 or §44**

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

In this situation, the holder of the international registration may “transform” the cancelled registered extension of protection (or request for extension of protection) into an application under §1 or §44 of the Trademark Act for

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

registration of the same mark for any or all of the cancelled goods/services that were covered by the extension of protection. 15 U.S.C. §1141j; Article 9<sup>quinquies</sup>.

### 1904.09(a) Requirements for Transformation

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

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

37 C.F.R. §7.31(a).

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

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

The request for transformation should be mailed to the following address:

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

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

## MADRID PROTOCOL

Requests for transformation cannot be filed by fax. 37 C.F.R. §§2.195(d)(5) and 7.4(d)(6). Requests for transformation should not be submitted through TEAS until a TEAS transformation form is available.

### **1904.09(b) Examination of Transformed Application**

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

The “transformed” application will have the same filing date as the cancelled extension of protection, that is: (1) the international registration date, if the request for extension of protection to the United States was made in the international application; or (2) the date of recordal of the subsequent designation with the IB, if the request for extension of protection to the United States was made in a subsequent designation. If the extension of protection was entitled to priority under §67 of the Trademark Act, the new application is entitled to the same priority.

If an examining attorney has already performed a search for conflicting marks, he or she does not have to conduct a new search, since the effective filing date will not change. The examining attorney should either ensure that a copy of the search statement is placed in the electronic record of the transformed application, or make a note to the file indicating the date on which the search was conducted and the serial number of the §66(a) application in which the search statement is of record.

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

Even if the mark in the extension of protection was already published or registered, republication will be required, due to the substitution of a new basis. 37 C.F.R. §2.35(b)(2). The examining attorney must require the applicant to submit a verified statement in support of the application that relates back to the filing date of the transformed application. See TMEP §804.02 regarding the essential allegations required to verify an application

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

for registration of a mark and TMEP §804.04 regarding persons properly authorized to sign a verification on behalf of an applicant.

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

### **1904.10 Affidavits of Use or Excusable Nonuse Required**

Under §71 of the Trademark Act, 15 U.S.C. §1141k, a registered extension of protection to the United States will be cancelled if the holder of the international registration fails to periodically file affidavits of use in commerce or excusable nonuse. See TMEP §1613 for further information.

### **1904.11 Incontestability**

Under §73 of the Trademark Act, 15 U.S.C. §1141m, if a holder files an affidavit that meets the requirements of §15 of the Trademark Act, a registered extension of protection to the United States may become “incontestable”. See TMEP §§1605 *et seq.* regarding the requirements for an affidavit of incontestability under §15 of the Trademark Act.

### **1904.12 Replacement**

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

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

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

## MADRID PROTOCOL

(3) The fee required by 37 C.F.R. §7.6.

37 C.F.R. §7.28(b).

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

“Replacement” does not invalidate the United States national registration. The United States national registration remains on the register, with all the rights attaching to such a registration, as long as the holder renews the registration under §9 of the Trademark Act and files the necessary affidavits of use or excusable nonuse under §8 of the Trademark Act. 37 C.F.R. §7.29. It is up to the holder to decide whether to maintain the replaced United States national registration.

### **1904.13 Amendment of Registered Extension of Protection to the United States**

All requests to record changes to an international registration and associated extensions of protection must be filed at the IB. Accordingly, the holder of a registered extension of protection of an international registration to the United States cannot file an amendment under §7 of the Trademark Act. TMEP §§1609.01(a) and 1609.02. The USPTO will not accept an amendment of a registered extension of protection that has not been recorded in the International Register. See TMEP §§1906.01 *et seq.* regarding requests to record changes at the IB.

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

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

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

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

If the MPU trademark specialist determines that protection can no longer be granted to the international registration as corrected, the MPU trademark specialist will issue a post registration refusal, by sending a declaration to the IB within 18 months of the IB's notification of the correction.

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

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

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

If the MPU trademark specialist determines that the limitation has no effect in the United States (*e.g.*, because he or she determines that the change requested results in an extension rather than a limitation of the goods/services), the MPU trademark specialist will issue a post registration refusal of the limitation, by sending a declaration to the IB within 18 months of the date of the IB's notification of the limitation.

If a notification of limitation is received after registration of the §66(a) application, and the MPU trademark specialist determines that the limitation does have effect in the United States, the MPU trademark specialist will enter the limitation into the trademark database and ensure that an updated registration certificate is issued to the holder.

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

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

### **1905 Renewal of International Registrations**

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

## MADRID PROTOCOL

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

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

### **1906                      Communications With International Bureau Regarding International Registrations**

Information about communicating directly with the IB is available on the WIPO website at <http://www.wipo.int/madrid/en/>. The IB can be contacted by mail to 34 chemin des Colombettes, P.O. Box 18, 1211 Geneva 20, Switzerland; by telephone at 41 22 338 9111; by fax to 41 22 740 1429; or by e-mail to [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int).

#### **1906.01                      Recording Changes in International Register**

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

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

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

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

37 C.F.R. §7.22.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1906.01(a) Change in Ownership of International Registration**

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

Most requests to record changes of ownership must be filed directly with the IB. 37 C.F.R. §§7.22 and 7.23. There is a form available on the IB website at <http://www.wipo.int/madrid/en/>. The IB does not require copies of assignments or other supporting documents. See TMEP §1906.01(a)(i) regarding the limited circumstances in which a request to record a change in ownership may be filed with the IB through the USPTO.

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

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

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

37 C.F.R. §7.23.

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

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

- The international registration number;
- The name and address of the holder of the international registration;
- The name and address of the assignee of the international registration;
- A statement that the assignee: (i) is a national of the United States; (ii) has a domicile in the United States; or (iii) has a real and effective

## MADRID PROTOCOL

industrial or commercial establishment in the United States. Where an assignee's address is not in the United States, the assignee must provide the address of its United States domicile or establishment;

- A statement that the assignee could not obtain the assignor's signature for the request to record the assignment;
- An indication that the assignment applies to the designation to the United States;
- A statement that the assignment applies to all the goods/services in the international registration, or if less, a list of the goods/services in the international registration that have been assigned that pertain to the designation to the United States; and
- The USPTO transmittal fee required by 37 C.F.R. §7.6.

37 C.F.R. §7.23(a).

The USPTO currently does not have a TEAS form available for requests to record a change of ownership of an international registration. A holder must use the official IB form MM5 available on the IB website at:

<http://www.wipo.int/madrid/en>. The IB will not accept paper requests that are not presented on the official IB form. The form cannot be handwritten. Comm Regs. 25(1)(a); Madrid Admin. Instr. §4(a). The holder should complete the form online, print the completed form and submit it to the USPTO by mail, hand delivery or courier services.

The completed form submitted through the USPTO must be mailed to:

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

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

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

If a request to record a change of ownership is mailed to the USPTO via the Express Mail Service of the USPS, the USPTO will deem that the request to record was submitted on the day it was deposited as Express Mail, provided that the holder complies with the requirements for correspondence sent by

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

Express Mail set forth in 37 C.F.R. §2.198. See TMEP §305.03 regarding the requirements for submission of documents by Express Mail.

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

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

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

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

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

The international fee for a request to record a change of ownership must be paid directly to the IB in Swiss currency, and may be paid either before or after submission of the request to record. 37 C.F.R. §7.7(c). However, fees paid after the document is received by the IB could result in a notice of irregularity. Holders submitting requests to record a change of ownership through the USPTO (see TMEP §1906.01(a)(i)) may submit a bank check for international fees in Swiss francs, payable to the IB, with the request to record. The USPTO will forward the check with the request to record to the IB.

See TMEP §1903.02 regarding payment of international fees.

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

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

## MADRID PROTOCOL

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

When ownership of an international registration changes with respect to some but not all of the goods/services for all designated Contracting Parties, the IB will create a separate new international registration for the goods/services that have been transferred, and notify the USPTO accordingly. See the IB's *Guide to International Registration*, Para. B.II.65.01 (2004).

See TMEP §1110.08 regarding division of a pending §66(a) application after ownership of an international registration has changed with respect to some but not all of the goods/services, and TMEP §1615.02 regarding division of a registered extension of protection to the United States after ownership of an international registration has changed with respect to some but not all of the goods/services.

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

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

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

- (1) (i) the restriction is the result of a court order; or (ii) the restriction is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, and the signature of the holder of the international registration cannot be obtained;
- (2) the party who obtained the restriction is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States;
- (3) the restriction or release applies to the holder's right to dispose of the international registration in the United States; and

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

- (4) the restriction or release applies to the designation to the United States.

37 C.F.R. §7.24(a).

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

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

- The international registration number;
- The name and address of the holder of the international registration;
- The name and address of the party who obtained the restriction;
- A statement that the party who submitted the request: (i) is a national of the United States; (ii) has a domicile in the United States; or (iii) has a real and effective industrial or commercial establishment in the United States. Where a party's address is not in the United States, the party must provide the address of its United States domicile or establishment;
- A statement that (i) the restriction is the result of a court order, or (ii) where the restriction is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, a statement that the signature of the holder of the international registration could not be obtained for the request to record the restriction or release of the restriction;
- A summary of the main facts concerning the restriction;
- An indication that the restriction, or the release of the restriction, of the holder's right to dispose of the international registration applies to the designation to the United States; and
- The United States transmittal fee required by 37 C.F.R. §7.6.

37 C.F.R. §7.24(b).

A request to record a restriction or release submitted through the USPTO must be mailed to:

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

37 C.F.R. §§2.190(e) and 7.4(b). Requests to record restrictions or releases may be delivered by hand or courier to the Trademark Assistance Center, at

## MADRID PROTOCOL

James Madison Building, East Wing, Concourse Level, 600 Dulany Street, Alexandria, Virginia, Attention: MPU. TAC is open 8:30 a.m. to 8:00 p.m. Eastern Time, Monday through Friday, except on Federal holidays within the District of Columbia. 37 C.F.R. §7.4(c).

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

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

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

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

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

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

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

### **1906.01(d) Change of Name or Address of Representative**

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

See TMEP §§603.01(a) and 1904.02(f) regarding the correspondence address in a request for extension of protection to the United States.

## TRADEMARK MANUAL OF EXAMINING PROCEDURE

### **1906.01(e)      Limitation, Renunciation, Cancellation of International Registration**

Requests to record a limitation, renunciation or cancellation of an international registration must be filed with the IB; they cannot be filed through the USPTO. 37 C.F.R. §7.22. There are forms for such requests on the IB website at <http://www.wipo.int/madrid/en/>. Under Article 9<sup>bis</sup>, a holder may record the following restrictions:

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

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

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

### **1906.01(f)      Correction of Errors in International Registration**

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

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

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

## MADRID PROTOCOL

### **1906.01(g) Merger of International Registrations**

Where the same party is the holder of two or more international registrations of the same mark due to a partial change in ownership, that party may request the IB to record a merger of the registrations. Common Reg. 27(3). The request must be filed with the IB; it cannot be filed through the USPTO. 37 C.F.R. §7.22.

### **1906.01(h) License**

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

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

*Mark in International Registration Cannot Be Changed.* There is no provision for a mark to be amended in any way, at any time, even if the mark in the basic application or basic registration changes. *Guide to International Registration*, Para. B.II.69.02 (2004).

*Goods/Services in International Registration Cannot be Expanded.* It is not possible to expand the list of goods/services, even if the added goods/services were listed in the basic application or registration. *Guide to International Registration*, Para. B.II.69.03 (2004).