

# Chapter 1900 Madrid Protocol

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

The Madrid Protocol became effective in the United States on November 2, 2003. The Madrid Protocol Implementation Act of 2002, Pub. L. No. 107-273, 116 Stat. 1758, 1913-21 (MPIA) amended the Trademark Act to provide that: (1) the owner of a U.S. application and/or registration may seek protection of its mark in any of the countries or intergovernmental organizations party to the Madrid Protocol by submitting a single international application to the IB through the United States Patent and Trademark Office (USPTO); and (2) the holder of an international registration may request an extension of protection of the international registration to the United States. A notice of final rulemaking amending the Trademark Rules of Practice to incorporate the MPIA was published at 68 Fed. Reg. 55748 (Sept. 26, 2003).

The Madrid Protocol, *Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (Regulations Rule(s) or Regs. Rule(s)), *Guide to the Madrid System International Registration of Marks under the Madrid Protocol (Guide to International Registration)*, *Administrative Instructions for the Application of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (Administrative Instructions or Admin. Instrs.) are available on the IB's website, at <https://www.wipo.int/madrid/en/>. The Regulations are the procedures 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 (Madrid Agreement), which dates from 1891, and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol), which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996. The United States is party only to the Protocol.

The Madrid system is administered by the IB. To apply for an international registration under the Madrid system, an applicant must be a national of, be domiciled in, or have a real and effective industrial or commercial establishment in one of the countries or intergovernmental organizations that are members of the Madrid 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(s) and/or registration(s). 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(s) and/or registration(s) 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(s) and/or registration(s), and then forward the international application to the IB. If the

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

The international registration is dependent on the basic application(s) and/or registration(s) for five years from the international registration date. If the basic application(s) and/or registration(s) is abandoned, cancelled, or expired, in whole or in part, during this five-year period, the IB will cancel the international registration, in whole or in part, 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 international 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 Regulations Rules 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, in the United States, an extension of protection may be invalidated in accordance with the same procedures as for invalidating a national registration, e.g., by cancellation. See [TMEP §1904.07](#) for information about invalidation.

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

- *Office of Origin.* The USPTO is the Office of Origin if an international application and/or registration is based on one or more applications pending in or registrations issued by the USPTO. Article 2(2); Regs. Rule 1(xxvi).
- *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. Regs. Rule 1(xvi), (xxv).
- *Office of the Contracting Party of the Holder.* If the holder of an international registration is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States, the holder can file certain requests with the IB through the USPTO, such as requests to record changes of ownership (*see* [TMEP §1906.01\(a\)\(i\)](#)) and restrictions on the holder's right to dispose of an international registration (*see* [TMEP §1906.01\(b\)](#)). The expression "Contracting Party of the Holder" includes the "Office of Origin," as well as any other Contracting Party in which a holder is a national, is domiciled, or has a real and effective industrial or commercial establishment. Regs. Rule 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 for registration on the Principal or Supplemental Register pending in the USPTO and/or a registration issued by the USPTO on the Principal or Supplemental Register. See [TMEP §§1904-1904.15](#) 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 for registration on the Principal or Supplemental Register pending in the USPTO or a qualified owner of a basic registration issued by the USPTO on the Principal or Supplemental Register 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. Regs. Rule 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. §7.4\(a\)](#) and [§7.11](#).

#### *37 CFR §7.4 International applications and registrations originating from the USPTO – Requirements to electronically file and communicate with the Office.*

(a) Unless stated otherwise in this chapter, all correspondence filed with the USPTO relating to international applications and registrations originating from the USPTO must be submitted through TEAS and include a valid email address for correspondence.

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

...

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(9) The certification fee required by §7.6;

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

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

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

## 1902.02(a) Form of International Application

An international application must be filed either (1) using the Trademark Electronic Application System (TEAS) or (2) on the official paper form issued by the IB if permitted under [37 C.F.R. §7.4\(c\)](#) (see [TMEP §301.02\(c\)](#)) or accepted on petition pursuant to [37 C.F.R. §7.4\(d\)](#) (see [TMEP §301.02\(e\)](#)). [37 C.F.R. §7.11\(a\)](#).

### *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\(d\)](#), [\(e\)](#)).

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

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

### *Permitted Paper Form*

When permitted to be filed on paper (*see* [TMEP §301.02\(c\)](#)) or accepted on petition (*see* [TMEP §301.02\(e\)](#)), 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 <https://www.wipo.int/madrid/en/forms/>. The IB's Guide to International Registration has instructions for completing the international application form.

The IB will not accept paper applications that are not submitted on the official IB form. Article 3(1); Regs. Rules 9(2)(a), 11(4)(a)(i); Madrid Admin. Instrs. §2. The form may not be handwritten. Admin. Instrs. §6(a). The applicant should complete the MM2 form online, print the completed form, and submit it to the USPTO by mail, hand delivery, or courier service.

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

The applicant may mail the completed paper application form using the first-class mail service of the U.S. Postal Service (USPS) to the address in [TMEP §305.01](#). See [§§305.02-305.02\(h\)](#) regarding certificate of mailing procedures and [§§305.03-305.03\(e\)](#) regarding Priority Mail Express® procedures.

Alternatively, the applicant may deliver the application by hand or courier. See [TMEP §307](#) regarding hand delivery of documents to the USPTO.

International applications may not be filed by email or fax and, if submitted by such means, will not be accorded a date of receipt. See [37 C.F.R. §2.195\(c\)\(5\)](#).

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

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

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

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

If a basic application and/or registration has been divided, each serial number and/or registration number must be identified. If, after the international application is filed, a basic application and/or registration has been divided, the USPTO will notify the IB of the serial number of the new child application and/or the registration number. See [TMEP §§1110–1110.12](#) regarding dividing U.S. applications, [§§1615–1615.02](#) regarding dividing U.S. registrations, and [§1902.12](#) regarding dividing or merging a basic application or registration.

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

Only the owner of the basic application and/or registration may file an international application. [15 U.S.C. §1141a\(a\)](#). The international application must include the name, current address, and email address of the

applicant. [37 C.F.R. §§7.4\(a\), 7.11\(a\)\(2\)](#). The name and entity of the international applicant must be identical to the name and entity of the applicant/registrant in the basic application and/or registration. [37 C.F.R. §7.11\(a\)\(2\)](#).

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

When the applicant submits a free-text TEAS form or a permitted paper form (*see* [TMEP §1902.02\(a\)](#)), an MPU trademark specialist will check the Trademark database to verify that the name of the international applicant is identical to the name of the owner of the basic application and/or registration.

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

Because a delay in certifying and forwarding an international application to the IB may affect the date of the international registration, any request to record a change in ownership of a U.S. basic application and/or registration should be filed well in advance of the filing of the international application, to allow sufficient processing time. Requests to record documents may be filed electronically through Assignment Center at <https://assignmentcenter.uspto.gov> or on paper. *See* [37 C.F.R. §3.25\(c\)](#). Assignments filed electronically are recorded much faster than assignments filed on paper. If there is an unrecorded change in ownership, and the international applicant does not use Assignment Center to record the change, the USPTO may be unable to certify or forward the international application to the IB within two months after the application is received in the USPTO. In this situation, the date of the international registration will be the date of receipt of the application in the IB. *See* [TMEP §1902.04](#).

Applicants can search the Assignment Recordation Branch's database at <http://assignments.uspto.gov/assignments/?db=tm> to determine whether an assignment or other document of title has been recorded and can search the TSDR database at <https://tsdr.uspto.gov/> to determine whether the ownership information in the Trademark databases has been updated. *See* [TMEP §§504–504.04](#) regarding automatic updating of ownership information in the Trademark database.

If an international applicant is relying on an assignment (or other document transferring title) that has recently been filed for recordation, the applicant should wait until the Assignment Recordation Branch has recorded the assignment before filing the international application to ensure that the correct owner is reflected in the USPTO records.

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. The applicant may attach a copy of the recently filed assignment to the petition with an explanation that the assignment has not yet been recorded by the Assignment Recordation Branch. If the petition is granted, the international application will be reinstated with the original filing date. *See* [TMEP §1902.03\(a\)](#) regarding petitions to review refusal to certify.

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

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

For international applications filed electronically, an image of the mark taken from the Trademark database 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\(c\)](#).

For permitted paper submissions (*see* [TMEP §1902.02\(a\)](#)), 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. Regs. Rule 9(4)(a)(v); *Guide to International Registration*, B.II.13.07.37 *et seq.*

*Standard Character Reproductions.* If the mark in the basic application and/or registration is in standard characters, the reproduction of the mark in the international application must also be in standard characters. To claim standard characters, an applicant must check the appropriate box on the TEAS form or on the IB's official application form MM2 for a permitted paper submission (*see* [TMEP §1902.02\(a\)](#)). The applicant may not claim standard characters in the international application unless the mark in the basic application and/or registration is in standard character (or typed) format. See [TMEP §§807.03–807.03\(i\)](#) for information about standard character drawings in U.S. applications for registration of marks. The USPTO's chart of standard characters is available on the USPTO website at <https://www.uspto.gov>.

*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 also be in special form. See [TMEP §807.04\(a\)](#) for the characteristics of special form drawings in U.S. applications for registration of marks.

*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 a color reproduction of the mark that meets the requirements of [37 C.F.R. §2.52](#), [37 C.F.R. §7.11\(a\)\(3\)](#); Regs. Rule 9(4)(a)(vii). For example, if the basic application and/or registration includes a color claim and a black-and-white drawing that depicts the color by the use of color lining or by a statement describing the color, the applicant must include a color reproduction of the mark showing the claimed colors and a black-and-white reproduction of the mark that corresponds to the mark as it appears in the basic application and/or registration. See the note regarding color drawings in U. S. basic applications or registrations in [TMEP §1902.02\(e\)](#).

For permitted paper submissions (*see* [TMEP §1902.02\(a\)](#)), the applicant must place the drawing in the appropriate box 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 a substitute color reproduction of the mark. For the TEAS free-text form, however, the applicant must attach a digitized image of the color reproduction of the mark.

See [TMEP §§807–807.18](#) for general information about the requirements for drawings in U.S. applications for registration of marks.

### 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\(a\)\(4\)](#), [7.12\(a\)](#).

If the basic application and/or registration includes a black-and-white reproduction of the mark with a description of the mark indicating that color is used on the mark, or a reproduction that is lined for color (see Note below), the USPTO will presume that color is a feature of the mark, unless the basic application and/or registration includes a statement that “no claim is made to color” or “color is not a feature of the mark.” Thus, the basic application and/or registration will be presumed to have a color claim.

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

*Note Regarding Color Drawings in U. S. 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 was required to submit a black-and-white drawing with a statement identifying the color(s) and describing where it/they appeared in the mark. Alternatively, the applicant could submit a black-and-white drawing that showed color by using a lining system that previously appeared in [37 C.F.R. §2.52](#) but was deleted from the rule effective October 30, 1999. See *Trademark Law Treaty Implementation Act Changes*, [64 Fed. Reg. 48,900, 48,903](#) (effective Oct. 30, 1999) (codified at 37 pts. 1, 2, 3, and 6) (notice in 1226 TMOG 103, 106 (Sept. 28, 1999)). In such situations, it was presumed that an applicant was claiming color as a feature of the mark unless the applicant specifically stated that no claim was made to color, or that color was not claimed as a feature of the mark. The USPTO began accepting color drawings on November 2, 2003. Effective November 2, 2003, the USPTO stopped accepting 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 §§807.07–807.07\(g\)](#) regarding the current color drawing requirements.

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

An international application must include a list of goods/services that is identical to or narrower than the goods/services in the basic application and/or registration. [37 C.F.R. §7.11\(a\)\(7\)](#). If the applicant lists any goods/services that are broader in scope than the goods/services in the basic application or registration, 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 free-text TEAS form (and the MM2 paper form, if paper is permitted (see [TMEP §1902.02\(a\)](#)), the applicant must enter the goods/services manually and may omit goods or services, or revise the wording in the identification.

In general, semicolons should be used to separate distinct categories of goods/services within a class. See [TMEP §1402.01\(a\)](#). For example, “cleaners, namely, glass cleaners, oven cleaners, and carpet cleaners; deodorants for pets” is an acceptable identification in Class 3. In this example, the word “cleaners” names the category covering “glass cleaners, oven cleaners, and carpet cleaners.” The semicolon prior to “deodorants for pets” indicates that the deodorants are a separate category of goods from the cleaners.

Similarly, commas generally should be used to separate items within a particular category of goods/services. For example, “clothing, namely, hats, sweaters, and jeans” is an acceptable identification of goods in Class 25 and shows proper use of commas.

Colons and periods should not be used as punctuation within the identification of goods and services. Periods or “full stops” are allowed at the end of the identification in an international application.

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

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

The IB provides a database of properly classified terms, the Madrid Goods and Services Manager (MGSM), on WIPO’s website at <https://www.wipo.int/madrid/en/>. Applicants may refer to the MGSM to review the classification assigned by the IB to more than 40,000 goods and services as well as the translation of such goods/services into several languages.

### **1902.02(f)(i) House Marks and “Full Line of ...”**

It has been the practice in the United States to accept identifications of goods/services that include the wording “house mark for...” in certain limited circumstances. See [TMEP §1402.03\(b\)](#). Additionally, in rare circumstances, the USPTO may accept an identification of goods/services that refers to “a full line of” a genre of products or services. To qualify for the use of such terminology, the line of products or services must be in one class. See [TMEP §1402.03\(c\)](#).

If an international application includes the wording “house mark for” or “house mark for a full line of,” the IB will generally issue a notice of irregularity requiring the applicant to clarify or remove this wording. To avoid issuance of a notice of irregularity, an international applicant may set forth some or all of the goods or services following the wording “house mark” in the listing of goods or services in the international application. Removal of the wording “house mark” will not result in denial of certification of the international application.

### **1902.02(f)(ii) Providing a Website/Online Portal**

Any activity consisting of a service that ordinarily falls in classes 35-37, 39, 41, 44, and 45 (e.g., real-estate agency services in Class 36 or dating services in Class 45), and that happens to be provided over the Internet, is classified in the class of the underlying service. See [TMEP §1402.11\(a\)](#). It is not classified in Class 42 merely because the services involve the use of a computer. Similarly, the service of providing information via the Internet is classified in the class of the subject matter of the information. See [TMEP §1402.11\(b\)](#). Entities that provide these services by computer are considered to be “content providers,” that is, they provide the informational or substantive content of websites, homepages, or online portals.

If an international applicant identifies services with the introductory language “providing a website ...” or “providing an on-line portal ...,” regardless of the subject activities that follow, the IB is likely to issue a

notice of irregularity requiring the applicant to clarify the nature of the services and possibly suggesting “hosting of a website ...” and/or reclassification to Class 42. To avoid issuance of a notice of irregularity by the IB, an international applicant may wish to set forth its services with the principal activity first and then indicate that such services are “provided by means of a website” or “provided through an online portal,” or provided “via a website.”

For example, if the identification in the underlying application or registration is “providing an Internet website portal in the field of music” in Class 41, the services in the international application may be listed as “providing information in the field of music by means of an Internet website portal.” Note that the list of services in the international application must remain within the scope of the services in the basic application and/or registration or the MPU trademark specialist will deny certification.

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

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

The MPU does not certify classification of the goods/services in an international application. Therefore, the owner of the U. S. application or registration need not classify the goods/services in the international application in the same class(es) in which they are classified in the U. S. basic application and/or registration.

However, failure to properly classify goods or services in an international application according to the international classification system will result in issuance of a notice of irregularity from the IB. Because the final decision on the classification of the goods/services in an international application rests with the IB, the USPTO will not reclassify goods/services nor will USPTO employees give legal advice in response to specific inquiries regarding the reclassification of particular goods/services. The IB provides guidance on its website, at <https://www.wipo.int/classifications/nice/en/>. See [TMEP §§1401.02–1401.02\(c\)](#) for further information about international classes, and [§§1902.07–1907.02\(f\)](#) for further information about irregularities in the international application.

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

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

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

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

The IB provides a database of properly classified terms, the Madrid Goods and Services Manager (MGSM), on the WIPO's website at <https://www.wipo.int>. Applicants may refer to the MGSM to review the classification assigned by the IB to more than 40,000 goods and services as well as the translation of such goods/services into several languages.

## **1902.02(g)(ii) U. S. Classes A, B, and 200**

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

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

### *U. S. Classes A and B*

It has been the longstanding practice in the United States to accept identifications of goods or services for U.S. Classes A, B, and 200 that are broader than those that would be accepted in applications for goods/services in other classes. See [TMEP §§1304.02\(c\), 1306.02\(c\)](#). 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 “scientific laboratory 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.

### *U. S. Class 200*

U.S. Class 200 presents a similar problem and a similar solution. A broad identification of the subject organization in a collective membership mark application or registration is difficult to reclassify. For example, the wording “indicating membership in a conservative youth organization” is too broad and vague for classification in an international class. On the other hand, “indicating membership in an organization of consulting communications engineers” is easily classified in International Class 42. As with the certification marks, an applicant may have to clarify, specify, or narrow the description of the organization in the international application in order to classify the organization in an international class.

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

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

The USPTO permits registration of a kit or gift basket in a single international class, even if the identification of goods lists items that are classified in other classes. The IB and most foreign countries will not accept an identification of goods in a particular class that includes a reference to goods that are classified in other

classes. If an international application includes kits and/or gift baskets, and the identification of goods refers to items classified in more than one class, the IB is likely to issue a notice of irregularity requiring the applicant to separate the goods into their respective classes and to pay additional fees for added classes. To avoid issuance of a notice of irregularity by the IB, an international applicant may wish to either narrow the identification to refer only to items in a single international class, or submit additional fees for multiple international classes.

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

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

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

For international applications filed through TEAS, the online form enables applicants designating the European Community to claim seniority based upon registrations issued by Member States. The applicant must indicate: (1) the name of the Member State in or for which the earlier mark is registered; (2) the date from which the registration was effective; (3) the registration number; and (4) the goods and/or services covered by the earlier registration. Regs. Rule 9(5)(g)(i).

For international applications permitted to be filed on paper using form MM2 (*see* [TMEP §1902.02\(a\)](#)), a claim of seniority must be presented on the IB’s official form, MM17, and annexed to the international application. Regs. Rule 9(5)(g)(i). The applicant must complete both the MM2 and the MM17 forms, and mail them to the USPTO. See [TMEP §305](#) regarding the mailing of permitted paper filings to the USPTO.

An international applicant may not designate the United States as a Contracting Party. [15 U.S.C. §1141e\(b\)](#); Article 3 *bis*; [TMEP §1904.01\(h\)](#).

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

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

*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 permitted paper applications (*see* [TMEP §1902.02\(a\)](#)) must be paid directly to the IB, and may be paid either before or after the international application is submitted to the USPTO. [37 C.F.R. §7.7\(c\)](#). However, international fees paid after the IB receives the international application could result in a notice of irregularity issued by the IB (*see* [TMEP §1902.07\(b\)\(i\)](#)).

See [TMEP §1903.02](#) regarding payment of international fees.

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

An international application must include a statement that the applicant is entitled to file an international application, specifying that the applicant: (1) is a national of the United States; (2) has a domicile in the United States; or (3) has a real and effective industrial or commercial establishment in the United States. [15 U.S.C. §1141a](#); [37 C.F.R. §7.11\(a\)\(11\)](#). Where an applicant's address is not in the United States, the applicant must provide the address of the U.S. domicile or establishment. [37 C.F.R. §7.11\(a\)\(11\)](#).

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

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

If the basic application or registration includes a description of the mark, an international application must include the same description. [37 C.F.R. §7.11\(a\)\(5\)](#). The applicant cannot include a description of the mark in the international application if the basic application or registration does not contain a description of the mark. Regs. Rule 9(4)(a)(xi).

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

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

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

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

### **1902.02(m) Email Address of Applicant**

An international application must include the applicant's email address. Regs. Rule 9(4)(a)(ii). The email address also will be used for correspondence with the USPTO. [37 C.F.R. §§7.4\(a\)](#), [7.11\(a\)](#). *But see* [37 C.F.R. §7.4\(c\)](#) (providing an exception to the requirement to correspond electronically with the Office for a filer who is a national of a country that has acceded to the Trademark Law Treaty, but not to the Singapore Treaty on the Law of Trademarks).

See [TMEP §803.05\(b\)](#) for more information regarding the requirement for an applicant's email address.

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

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

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

Under Article 3(1) and Regulations Rule 9(5)(d), the USPTO must sign the international application and certify:

- The date on which the USPTO received the international application (Regs. Rule 9(5)(d)(i));
- That the mark in the international application is the same as the mark in the basic application or registration (Regs. Rule 9(5)(d)(iv));
- That the applicant is the same person or entity listed as the owner of the basic application or registration (Regs. Rule 9(5)(d)(ii));
- That the goods/services identified in the international application are covered by the basic application or registration (Regs. Rule 9(5)(d)(vi));
- That the applicant is qualified to file an international application under §61 of the Trademark Act and Article 2(1);
- That, if the international application includes a description of the mark, the description is consistent with the basic application or registration (Regs. Rules 9(4)(a)(xi), 9(4)(b)(vi), 9(5)(d)(iii));
- That, if the international application indicates that the mark consists of a color or combination of colors, this indication is consistent with the basic application or registration (Regs. Rules 9(4)(a)(vii<sup>bis</sup>), 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 (Regs. Rule 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 (Regs. Rules 9(4)(a)(viii), 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 (Regs. Rules 9(4)(a)(ix), 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 (Regs. Rules 9(4)(a)(x), 9(5)(d)(iii)).

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

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

An applicant should periodically check the status of the international application online, using TSDR. 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 TSDR 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 TEAS Petition to Director to Review Denial of Certification of International Application form under [37 C.F.R. §2.146\(a\)\(3\)](#). The petition must include the USPTO reference number, an explanation as to why the international application should be certified, any necessary corrective amendments or documents, and the petition fee required by [37 C.F.R. §2.6](#).

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); Regs. Rule 15. See [TMEP §1902.04](#).

If the denial of certification is due to an error in the international application that must be corrected, the petition must include a substitute paper international application (MM2). The MM2 form can be accessed on the WIPO website. If the denial was due to an error in the basic application or basic registration that requires correction, the applicant should immediately file the amendment in the basic application, or a Section 7 amendment in the registration, as well as filing the petition. As noted above, the USPTO must certify the international application within two months of the date of receipt of the international application in the USPTO or the date of international registration will be affected. Article 3(4); Regs. Rule 15. See [TMEP §1902.04](#).

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.

See [TMEP §1702](#), [§1703](#), and [§1705](#) regarding petitions to the Director under [37 C.F.R. §2.146\(a\)\(3\)](#).

### **1902.03(b) Petition for an International Application or Registration**

If an applicant or registrant discovers an error in the international application as filed, or the international registration as issued, the applicant or registrant may file a TEAS Petition to Director for an International Application/Registration under [37 C.F.R. §2.146\(a\)\(3\)](#).

The petition should be filed as soon as possible, but not more than two months after the issue date of the action, or date of the receipt of the filing, from which relief is requested. [37 C.F.R. §2.146\(d\)\(1\)](#). The petition should refer to the USPTO reference number, set forth the error that was made and the remedy requested, and include the petition fee required by [37 C.F.R. §2.6](#).

If the petition is denied, the petition fee will not be refunded. If the petition requests withdrawal of an international application, regardless of whether the application has been certified, the certification fees are not refundable. See [TMEP §1702](#), [§1703](#), and [§1705](#) regarding petitions to the Director under [37 C.F.R. §2.146\(a\)\(3\)](#).

### **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); Regs. Rule 15.

Regulations Rule 15(1) 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); Regs. Rule 15(1).

See [TMEP §§1902.07-1902.07\(f\)](#) 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 Regulations Rule 9. If the application meets the minimum requirements set forth in [37 C.F.R. §7.11\(a\)](#) (see [TMEP §§1902.02–1902.02\(m\)](#)), the USPTO will certify the application and send it to the IB. *The USPTO will not examine the international application to determine whether it is complete.* Only the IB will examine it for completeness. The requirements for a complete international application originating from the United States are:

- *Name and Address.* The name and address of the applicant;
- *Basic Application(s) or Registration(s).* The serial number(s) and filing date(s) of the basic application(s), and/or the registration number(s) and registration date(s) of the basic registration(s). The international application may be based on more than one basic application or registration;
- *Entitlement to File.* An indication that the applicant: (1) is a national of the United States; (2) is domiciled in the United States; or (3) has a real and effective industrial or commercial establishment in the United States (Regs. Rule 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), 8(2); Regs. Rules 9(4)(a)(xiv), 10(2), 34);
- *Goods/Services.* A list of the goods or services on or in connection with which the applicant seeks international registration (Article 3(2); Regs. Rule 9(4)(a)(xiii));
- *Class(es).* The international class(es) of goods or services, if known (Article 3(2); Regs. Rule 9(4)(a)(xiii));
- *Contracting Parties.* The name(s) of the Contracting Party or Parties in which an applicant seeks protection (Regs. Rule 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 (Regs. Rule 9(5)(f)). Under Regulations Rule 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. Regs. Rule 9(4)(a)(v); *Guide to International Registration*, B.II.13.07.37-38. The mark must be the same as the mark in the basic application or registration. If the mark in the basic application or registration has color, the mark in the international application must be in color. If the mark in the basic application or registration is black and white, the mark in the international application must be in black and white. If the mark in the basic application or registration is depicted in black and white, but contains a claim of color as a feature of the mark (see "Note" in [TMPEP §1902.02\(e\)](#) regarding color drawings in U.S. basic applications or registrations), the applicant must submit *both*: (1) a black-and-white image that is the same as the mark in the basic application or registration; and (2) a color reproduction depicting the color(s) claimed (Regs. Rule 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); Regs. Rule 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 (Regs. Rule 9(4)(a)(viii)) (see [TMPEP §§1202.05–1202.05\(i\)](#) 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 (Regs. Rule 9(4)(a)(xii));
- *Signature.* The USPTO must sign the international application. The IB does not require the applicant's signature (Regs. Rule 9(2)(b)) (*Note*: Signature may be replaced with seal or other mode of identification determined by the IB (*see* Admin. Instrs. §7));
- *Three-Dimensional Mark.* If the mark is three-dimensional, the indication "three-dimensional mark" (Regs. Rule 9(4)(a)(viii));
- *Sound Mark.* If the mark is a sound mark, the indication "sound mark" (Regs. Rule 9(4)(a)(ix));
- *Collective or Certification Mark.* If the mark is a collective mark or a certification mark, an indication to that effect (Regs. Rule 9(4)(a)(x));
- *Standard Characters.* If the mark is a standard character mark, an indication to that effect (Regs. Rule 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\(a\)\(5\)](#); Regs. Rule 9(4)(a)(xi));
- *Language.* International applications originating from the United States must be in English ([37 C.F.R. §7.3](#); Regs. Rules 6(1), 6(2)(iii));
- *Indication of Second Language.* If an applicant designates the European Community as a Contracting Party, applicant is required to indicate a second language, in addition to the language in the international application (Regs. Rule 9(5)(g)(ii)).

*Additional Elements that May Be Included in International Application.*

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

- *Translation.* If the mark consists of or contains non-English wording, an English translation (Regs. Rule 9(4)(b)(iii));

- *Citizenship/State of Incorporation or Organization.* 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 (Regs. Rules 9(4)(b)(i), (ii));
- *Disclaimer.* If an applicant wishes to disclaim any element of the mark, the applicant may do so (Regs. Rule 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. Paris Convention for the Protection of Industrial Property art. 4(2), Mar. 20, 1883; Regs. Rules 9(4)(a)(iv), 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 U.S. 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 (Regs. Rule 9(5)(g)(i)). For international applications permitted to be submitted on paper using the IB’s official form MM2 (see [TMEP §1902.02\(a\)](#)), this information must be submitted on the IB’s official MM17 form. The MM17 form should be annexed to the international application form.

## 1902.06 Examination of Application by IB

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

## 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](#); Regs. Rule 11.

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

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

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

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

For responses to IB notices of irregularities that may be submitted through the USPTO, applicants must file the response through TEAS. [37 C.F.R. §7.4\(a\)](#). *But see* [37 C.F.R. §7.4\(c\)](#) (a filer who is a national of a country that has acceded to the Trademark Law Treaty, but not to the Singapore Treaty on the Law of Trademarks, is not required to use TEAS). 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 submitted on paper, as permitted (*see* [TMEP §1902.02\(a\)](#)), is not presented on the official form or is not typed;
- Omission of reproduction of mark;
- Omission of list of goods/services;
- Omission of designation of Contracting Party or Parties;
- Insufficient identification of applicant;
- Irregularities relating to the entitlement of the applicant to file an international application (*see* [TMEP §1902.02\(j\)](#));
- Application not signed by USPTO ( *Note*: Signature may be replaced with seal or other mode of identification determined by the IB. *See* Admin. Instr. §7);
- Certification by USPTO is defective;
- Omission of date and number of basic application or registration.

Regs. Rules 11(4) 15(1); *Guide to International Registration*, B.II.09.19; Admin. Instrs. §6(a).

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

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

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

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

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

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

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

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

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

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

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

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

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

Under Article 3(2), the IB controls classification and has the final say on classification of goods/services. The IB may modify, withdraw, or maintain its proposal after reviewing the applicant's response. Regs. Rule 12; *see also* [TMEP §1401.03\(d\)](#).

### **1902.07(c)(ii) Identification (Indication) of Goods/Services**

If the IB determines that the identification of goods/services, referred to as the “indication of goods/services” by the IB, is too vague or is incomprehensible or linguistically incorrect, it will notify both the applicant and the USPTO. Regs. Rule 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\(a\)–\(b\)](#); Regs. Rule 13(2). See [TMEP §1902.07\(f\)](#) regarding responses to notices of irregularity submitted through the USPTO.

The applicant's response to the IB's notice should separately address each irregularity pertaining to the identification of goods/services, specifying which goods/services are to be deleted or amended, and providing any explanation or arguments deemed necessary. To avoid any misunderstanding by the examiners at the IB, the response should also include a separate final listing of the goods/services as it will appear in the international registration. If the applicant omits any goods/services from the final listing that were previously included in the identification of goods/services, the IB may remove such goods/services from the international registration.

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

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

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

Other irregularities to be remedied by applicant include, but are not limited to, insufficient information about the applicant's representative; missing transliteration; insufficient information about a priority claim; unclear

reproduction of the mark; and color claim with no color reproduction. The applicant must remedy any irregularities within three months of the date of the notification, or the international application may be abandoned. Regs. Rule 11(2)(b). See *Guide to International Registration*, B.II.33.09.23, for further information.

An applicant may file the response to these irregularities either directly with the IB or through the USPTO. To be considered timely, responses to IB notices of irregularities must be received by the IB before the end of the response period set forth in the IB's notice. Receipt 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 at <https://www.wipo.int/madrid/en/>. An applicant may contact the IB by telephone at 41 22 338 8686 or by filing an inquiry using the Contact Madrid form at <https://www3.wipo.int/contact/en/madrid/>.

### **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. **However, receipt in the USPTO does not fulfill the requirement that the response be received by the IB before the IB response deadline.** Therefore, applicants should submit responses to the USPTO as soon as possible, and at least one month before the end of the IB response period. The USPTO will not process any response received after the IB response deadline.

The IB does not have a form for responses to irregularity notices. The TEAS Response to a Notice of Irregularity form must be used for this purpose.

*Permitted Paper Responses.* Paper responses permitted to be filed with the USPTO for forwarding to the IB (see [TMEP §1902.02\(a\)](#)) should include with the response: (1) the USPTO control number (U.S. Reference No.) assigned to the international application; and (2) a copy of the IB's irregularity notice. The applicant may include a self-addressed, stamped postcard with the response. Upon receipt, the USPTO will place a label indicating the receipt date on the documents, and return the postcard to the applicant. However, to be considered timely, the response must be received by the IB before the end of the response period set forth in the IB's notice, and receipt in the USPTO does not fulfill the IB deadline requirement.

The applicant may mail the completed paper response form using the first-class mail service of the USPS to the address in [TMEP §305.01](#). See [§§305.02-305.02\(h\)](#) regarding certificate of mailing procedures and [§§305.03-305.03\(e\)](#) regarding Priority Mail Express® procedures.

Alternatively, the applicant may deliver the application by hand or courier. See [TMEP §307](#) regarding hand delivery of documents to the USPTO.

Responses may not be submitted by fax or email and, if submitted by such means, will not be accorded a date of receipt. See [37 C.F.R. §2.195\(c\)](#).

See [TMEP §1903.02](#) regarding payment of fees to the IB.

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 Regulations Rule 24. The holder may file the subsequent designation directly with the IB. There is a form for filing a subsequent designation, the MM4 form, on the IB website at <https://www.wipo.int/madrid/en/forms/>.

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

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

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

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

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

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

If the subsequent designation meets the requirements of Regulations Rule 24(8), the IB will record it and notify both the USPTO and the holder of the recordation. 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. Regs. Rule 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 must file using the TEAS Subsequent Designation form. See [37 C.F.R. §7.21\(b\)](#).

*Permitted Paper Filing.* When permitted to be filed on paper (see [TMEP §1902.02\(a\)](#)), the subsequent designation must be filed using the official IB form MM4 posted on the IB website at <https://www.wipo.int/madrid/en/forms/>. The IB's *Guide to International Registration*, available on the IB's website, has instructions for completing the subsequent designation form, at B.II.56.37.01–B.II.60.37.22.

The IB will not accept paper applications that are not submitted on the official IB form. Article 3 *ter*(2); Regs. Rule 24(2)(b); Admin. Instrs. §§2, 6(a). The form may not be handwritten. Article 3 *ter*(2); Regs. Rule 24(2)(b); Admin. Instrs. §§2, 6(a). The holder should complete the MM4 form online, print the completed form, and submit it to the USPTO by mail, hand delivery, or courier service. The holder should include a self-addressed, stamped postcard with the subsequent designation. Upon receipt of the subsequent designation, the USPTO will place a label indicating the receipt date on the documents and return the postcard to the holder.

The applicant may mail the completed paper application form using the first-class mail service of the USPS to the address in [TMEP §305.01](#). See [§§305.02-305.02\(h\)](#) regarding certificate of mailing procedures and [§§305.03-305.03\(e\)](#) regarding Priority Mail Express® procedures.

Alternatively, the applicant may deliver the application by hand or courier. See [TMEP §307](#) regarding hand delivery of documents to the USPTO.

Subsequent designations may not be submitted by fax or email and, if submitted by such means, will not be accorded a date of receipt. See [37 C.F.R. §2.195\(c\)](#).

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

See [TMEP §1903.02](#) regarding payment of international fees.

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

The requirements for a subsequent designation are set forth in Article 3<sup>ter</sup> (2) and Regulation Rule 24. If the subsequent designation meets the minimum requirements for a date of receipt set forth in [37 C.F.R. §7.21\(b\)](#) (see [TMEP §1902.08\(a\)](#)), the USPTO will forward the subsequent designation to the IB. *The USPTO will not examine it to determine whether it is complete.* The IB will examine it for completeness.

If the subsequent designation meets the applicable requirements, the IB will record it in the International Register and notify the holder and the Offices of the designated Contracting Parties. The IB will also notify the USPTO, if the subsequent designation was submitted through the USPTO. Regs. Rule 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. Regs. Rule 24(5)(a). Corrections of any irregularity in a subsequent designation must be sent directly to the IB, even if the subsequent designation was sent through the USPTO. [37 C.F.R. §7.21\(e\)](#). The USPTO will make note of receipt of the notice of irregularity in its automated records, but will not take any other action.

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

For a period of 5 years from the date of the international registration, the registration is dependent on the basic application or basic registration, including the child application or registration of a basic application or registration that has been divided or merged. Article 6(3). See [TMEP §1902.12](#) regarding division or merger of basic application or registration. Under §63 of the Trademark Act, [15 U.S.C. §1141c](#), and Article 6(4), the USPTO must notify the IB if the basic application and/or registration is restricted, abandoned, cancelled, or expired with respect to some or all of the goods/services listed in the international registration:

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

The IB will cancel (or restrict) the international registration accordingly. Article 6(4); Regs. Rule 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. Regs. Rules 22(1)(b), (c). The IB will record this notice in the International Register and notify the holder and the designated Contracting Parties.

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

action. See [TMEP §1712](#) for information regarding reinstatement of abandoned applications and cancelled registrations, and [TMEP §§1714-1714.01\(g\)](#) regarding petitions to revive abandoned applications.

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

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

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

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

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

See [TMEP §§1904.09-1904.09\(b\)](#) 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. Regs. Rule 3(2)(a). The applicant/holder may also appoint a representative in a subsequent communication submitted to the IB (*see* [TMEP §1906.01\(d\)](#)).

Regs. Rule 3(2)(b). Form MM12, for appointing a representative, may be found on the IB website at <https://www.wipo.int/madrid/en/forms/>.

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

Under Regulations Rule 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 §§1110-1110.12](#) regarding division of a U.S. application and [§§1615-1615.02](#) regarding division of a U.S. 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 U.S. dollars at the time of submission.

### 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 permitted to file on paper (*see* [TMEP §1902.02\(a\)](#)) must pay all international fees directly to the IB in Swiss currency. [37 C.F.R. §7.7\(c\)](#); *see* Regs. Rules 34–38 (regarding payment of fees). There is a fee calculator and a schedule of fees on the IB website at <https://www.wipo.int/madrid/en/>.

The IB will accept the following forms of payment:

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

*See Guide to International Registration*, B.I.12.08.05; Admin. Instrs. §19.

Effective January 1, 2008, the IB does not accept banker's checks as a mode of payment. *See Change in Practice Regarding Acceptance by USPTO of Bank Checks for Fees Payable to the International Bureau*, [1328 OG 199](#) (Mar. 25, 2008); *see also* IB Information Notice No. 20/2007, on the IB website at [https://www.wipo.int/edocs/madrdocs/en/2007/madrid\\_2007\\_20.doc](https://www.wipo.int/edocs/madrdocs/en/2007/madrid_2007_20.doc).

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

Questions concerning payment of international fees should be directed to the IB by telephone at 41 22 338 8686 or by filing an inquiry using the Contact Madrid form at <https://www.wipo.int/madrid/en/>. The USPTO cannot assist applicants/holders in calculating the appropriate international fees or in selecting a method of payment of fees to the IB.

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

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

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

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

#### **1904.01(a) §66(a) Basis for U.S. Applications**

Section 66(a) of the Trademark Act provides a basis for filing in the United States based on the Madrid Protocol. See [37 C.F.R. §§2.34\(a\)\(5\), 2.44\(a\)\(4\)\(v\), 2.45\(a\)\(4\)\(v\)](#). A basis under §66(a) may not be combined with any other basis. [37 C.F.R. §§2.34\(b\), 2.44\(c\), 2.45\(c\)](#). A §66(a) applicant may not change the basis unless the applicant meets the requirements for transformation under §70(c) of the Trademark Act, [15 U.S.C. §1141j\(c\)](#). [37 C.F.R. §2.35\(a\)](#). See [TMEP §1904.09](#) regarding transformation.

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

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

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

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

Section 66(a) of the Trademark Act requires that a request for extension of protection to the United States include a declaration of bona fide intention to use the mark in commerce. [15 U.S.C. §§1141f\(a\)](#). For a trademark or service mark application, such declaration must specify that the applicant/holder has a bona fide intention to use the mark in commerce that the U.S. Congress can regulate on or in connection with the goods or services specified in the international application/subsequent designation. [37 C.F.R. §§2.33\(e\)\(1\), 2.34\(a\)\(5\)](#); see [15 U.S.C. §§1127, 1141\(5\)](#). This declaration must also include a statement that: the signatory is properly authorized to execute the declaration on behalf of the applicant/holder; the signatory believes the applicant/holder to be entitled to use the mark in commerce on or in connection with the goods or services specified in the international application/subsequent designation; and to the best of his/her knowledge and

belief, no other person, firm, corporation, association, or other legal entity 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 or services of such other person, firm, corporation, association, or other legal entity, to cause confusion, or to cause mistake, or to deceive. [37 C.F.R. §§2.33\(e\)\(2\)-\(4\)](#), [2.34\(a\)\(5\)](#); *see* [15 U.S.C. §§1127](#), [1141\(5\)](#).

The declaration must be signed by: (1) a person with legal authority to bind the applicant; (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant; or (3) an attorney authorized to practice before the USPTO under [37 C.F.R. §11.14](#) who has an actual written or verbal power of attorney or an implied power of attorney from the applicant. [37 C.F.R. §2.193\(e\)\(1\)](#); [TMEP §611.03](#).

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

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

The verified statement remains part of the international registration on file with the IB. [37 C.F.R. §2.33\(e\)](#). Accordingly, 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 a trademark or service mark application on file with the IB. In cases where the applicant voluntarily files a substitute declaration with the USPTO, the substitute declaration will be examined according to the same standards used for examining any other declaration.

See [TMEP §1904.02\(d\)](#) for information regarding the verified statement for a §66(a) application for a collective trademark, collective service mark, collective membership mark, or certification mark.

See also [TMEP §804.05](#) for further information about declarations in §66(a) applications for trademarks and service marks, [§1303.01\(a\)\(v\)](#) and [§1303.01\(b\)\(ii\)](#) for information about declarations in §66(a) applications for collective trademarks and collective service marks, [§1304.02\(a\)\(v\)](#) and [§1304.02\(b\)\(ii\)](#) for declarations in §66(a) applications for collective membership marks, and [§1306.02\(a\)\(v\)](#) and [§1306.02\(b\)\(ii\)](#) for declarations in §66(a) applications for certification marks.

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

Use in commerce prior to registration is not required. [15 U.S.C. §1141h\(a\)\(3\)](#). However, after registration, a holder is required to periodically file an affidavit of use or excusable nonuse under §71 of the Trademark Act, [15 U.S.C. §1141k](#), to maintain a registered extension of protection. [37 C.F.R. §7.36\(b\)](#). See [TMEP §1613](#) for additional information about this affidavit.

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

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

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

[15 U.S.C. §1141g](#); Article 4(2); *see also* Paris Convention for the Protection of Industrial Property art. 4D, Mar. 20, 1883.

To be eligible for a claim of priority in a §66(a) application, the holder must file the request for extension of protection to the United States within 6 months of the date of the filing that forms the basis of the priority claim. If the United States is designated for an extension of protection in an international application, the international registration date cannot be later than 6 months after the date of the filing that formed the basis of the priority claim. If a request for extension of protection to the United States is made in a subsequent designation, the date of recordal of the subsequent designation cannot be later than 6 months after the date of the filing that formed the basis of the priority claim. The USPTO's electronic systems use the dates provided in the international registration to automatically calculate whether an application receives the benefit of a priority claim. If the "Priority Claimed" field indicates "YES," the "Priority Claimed Date" is to be treated as the effective filing date. See [TMEP §206.02](#) for information on claiming priority under §67, [15 U.S.C. §1141g](#). If the "Priority Claimed" field indicates "NO," this means the priority claim is outside the 6-month filing date that forms the basis of the priority claim, even if priority information is included in the §66(a) application. If otherwise issuing an Office action, an advisory may be included to notify the applicant that their priority claim will not be honored. However, the advisory is not necessary if the application is in condition for publication upon initial examination.

In some cases, another U.S. application filed after the §66(a) applicant's priority date may proceed to publication or registration because the request for extension of protection for the §66(a) application was not yet of record in the United States when the examining attorney searched USPTO records for conflicting marks. If the USPTO learns that a §66(a) application is entitled to priority over another pending application before the other mark registers, the USPTO will take appropriate action to give the §66(a) application the priority to which it is entitled. The §66(a) applicant may bring the priority-date issue to the USPTO's attention by submitting a letter of protest in the other pending application. See [TMEP §1715](#) regarding letters of protest.

If an examining attorney discovers a conflicting application entitled to priority under §66(a) after taking action in a case, the examining attorney must issue a supplemental action correcting the situation. If the mark has been published, the examining attorney must request jurisdiction before issuing the action. See [TMEP §1504.01](#) and [§1504.04\(a\)](#) regarding the examining attorney's jurisdiction.

However, if the conflicting mark has already registered, the USPTO does not act to cancel the registration *sua sponte*. The §66(a) applicant may seek to cancel the registration by filing a petition for cancellation with the Trademark Trial and Appeal Board.

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

The filing fee for a §66(a) application will be sent to the USPTO by the IB. The examining attorney should not require additional filing fees during examination, except where the application is divided due to a change

in ownership with respect to some but not all of the goods/services. See Article 8 and Regs. Rules 34–38 regarding international fees, and [TMEP §1110.11](#) regarding dividing a §66(a) application.

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

Under Trademark Act §66(b), 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), [15 U.S.C. §1057\(c\)](#), as of the earliest of the following:

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

### **1904.01(h) May Not 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) may not be used to obtain an extension of protection to the United States. [15 U.S.C. §1141e\(b\)](#); Article 3 *bis*. The IB will not send a request for extension of protection to the United States if the international registration is based on a USPTO basic application and/or registration.

### **1904.01(i) Requirement for Representation Based on Domicile of §66(a) Applicant**

*Foreign-domiciled applicants must be represented before the USPTO by a qualified U.S. attorney.* An applicant whose domicile is not located within the United States or its territories (see [TMEP §§601.01, 601.01\(b\)–\(b\)\(1\)](#) regarding domicile) must be represented before the USPTO by an attorney who is an active member in good standing of the bar of the highest court of a U.S. state, Commonwealth, or territory (see [TMEP §602](#) regarding persons authorized to practice before the USPTO in trademark matters). [37 C.F.R. §§2.11\(a\), 7.25\(a\)](#); see [TMEP §602](#). See [TMEP §601.01](#) regarding determining domicile and the examination procedure for requiring representation of foreign-domiciled applicants.

*Attorney identification information required.* If the applicant is represented by an attorney qualified under [37 C.F.R. §11.14](#) or is required to appoint such an attorney under [37 C.F.R. §2.11\(a\)](#) due to its foreign domicile, an applicant must include the individual attorney's name, postal address, email address, and bar information. [37 C.F.R. §§2.17\(b\)\(3\), 2.32\(a\)\(4\), 7.25\(a\)](#). See [TMEP §602.01\(a\)](#) regarding the requirement for attorney identification information.

The first Office action will generally include requirements to appoint a qualified U.S. attorney and to provide his or her bar information and postal and email addresses because there currently are no provisions for designating such an attorney, attorney's bar information, or postal and email addresses in a request for extension of protection received from the IB. See [37 C.F.R. §§2.11\(a\), 2.23\(b\), 2.32\(a\)\(4\), 7.25\(a\)](#); [TMEP §601](#). In addition, if the record is not clear that the applicant's domicile address is outside the United States, the first action will also include a requirement for the domicile address. See [TMEP §§601.01–601.01\(c\)](#). However, if the application is otherwise in condition for approval for publication upon first action, the application can be approved without requiring the §66(a) applicant to appoint a U.S.-licensed attorney and provide his or her bar information and postal and email addresses prior to publication.

### **1904.01(j) Requirement for Email Address of §66(a) Applicant**

Applicants must provide and maintain a valid email address for correspondence. [37 C.F.R. §§2.23\(b\), 2.32\(a\)\(2\)](#); see [37 C.F.R. §7.25\(a\)](#). Although providing an email address is required for applicants filing under Trademark Act Sections 1 and/or 44 ([37 C.F.R. §2.21\(a\)\(1\)](#); [TMEP §202](#)), this is not a filing date requirement for a Section 66(a) application because these are transmitted to the USPTO by the International Bureau (IB) and generally do not include an e-mail address for receiving USPTO correspondence. See [TMEP §803.05\(b\)](#) regarding the examination procedure for requiring an applicant's email address.

If a Section 66(a) application is otherwise in condition for approval for publication upon first action, the examining attorney will not require the owner to first provide an email address prior to publication. However, the TEAS forms will require an email address for the owner in any subsequent submissions.

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

#### **1904.02(a) Examined as Regular Application on the Principal Register**

Under §68(a)(1) of the Trademark Act, a request for extension of protection will be examined under the same standards as any other application for registration on the Principal Register. [15 U.S.C. §1141h\(a\)\(1\)](#). However, 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\(c\), 2.75\(c\)](#).

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. §§2.21, 2.22, 2.76, 2.88, 2.89, 2.130, 2.131, 2.160-2.166, 2.168, 2.173, 2.175, and 2.181-2.186](#), all rules in [37 C.F.R. Part 2](#) apply to a request for extension of protection of an international registration to the United States, including sections related to proceedings before the Trademark Trial and Appeal Board, unless stated otherwise. [37 C.F.R. §7.25\(a\)](#). All rules in [37 C.F.R. Part 11](#) relating to representation of others before the USPTO also apply to requests for extension of protection. See *id.*

See [TMEP §1904.02\(d\)](#) regarding specific examination issues relevant to a §66(a) application for a collective or certification mark.

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

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

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

- Changing classification (unless such change is to agree with a notice of correction from the IB that specifically changes classification);

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

[37 C.F.R. §2.85\(d\)](#); *see* [TMEP §1401.03\(d\)](#).

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

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

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

Although the IB determines the *classification* of the goods/services, for purposes of *identification*, the examining attorney will examine the identification of goods/services in a §66(a) application according to the same standards of specificity used in examining applications under §1 and §44 of the Trademark Act, [15 U.S.C. §§1051, 1126](#). *See* [37 C.F.R. §7.25\(a\)](#). Specifically, the examining attorney must follow the procedures set forth in the TMEP and identify the goods/services in accordance with the USPTO's *Acceptable Identification of Goods and Services Manual* (USPTO ID Manual) whenever possible. However, with respect to requests for extension of protection to the U.S., the assigned classes define the scope of the goods/services for the purpose of determining the extent to which the identification may be amended in accordance with [37 C.F.R. §2.71](#).

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

The language inside the parentheses should not be examined, but the goods/services preceding the parenthetical language should be examined and an acceptable amendment required that is definite and within the scope of the class assigned by the IB. For example, the §66(a) application identified the goods as "Accessories for domestic animals (in the opinion of the International Bureau, the terms are too vague for the purposes of classification - see Rule 13(2)(b) of the Regulations)," in Class 21. The wording "accessories for domestic animals" should be examined and an acceptable amendment within Class 21 suggested, such as "accessories for domestic animals, namely, pet bowls, litter trays, cleaning sponges, brushes, and cages." The parenthetical wording "(in the opinion of the International Bureau, the terms are too vague for the purposes of classification - see Rule 13(2)(b) of the Regulations)" and the parentheses must not be part of any suggested amendment and must not appear in the final identification of goods/services.

If the wording preceding the parenthetical language is definite according to USPTO practice, the identification should be accepted. The parenthetical language "(in the opinion of the International Bureau, the terms are too vague for the purposes of classification - see Rule 13(2)(b) of the Regulations)" and the parentheses must be removed and must not appear in the final identification of goods/services. If it is otherwise necessary to issue an Office action, the action must include notice that the parenthetical language and the parentheses will be removed from the identification. If it is otherwise unnecessary to issue an Office action, a no-call

examiner's amendment must be issued to document the removal of the wording. A no-call examiner's amendment is acceptable in this situation because the parenthetical language is provided to the USPTO for informational purposes only and documentation of the removal is for purposes of notice to the applicant only and does not "amend" the application.

If the initial identification of goods/services in the §66(a) application is definite, but misclassified under U.S. standards, the examining attorney must accept the identification, and cannot change the classification. If the initial identification of goods/services is not definite, the classification cannot be changed and the scope of the identification for purposes of permissible amendment is limited by the IB-assigned classification.

See [TMEP §§1401.03\(d\), 1402.01\(c\), 1402.07\(a\)](#). Because the international registration is limited to those classes assigned by the IB, the identification includes only those products or services falling within the identified classes. To propose an amendment outside of the scope of the classes would result in the lack of a basis for registration of such goods/services under U.S. law.

If a §66(a) applicant wants to seek registration for goods, services, or class(es) which are included in the international registration but were not originally included in the request for extension of protection to the United States, the §66(a) applicant must file a subsequent designation with the IB. Article 3 *ter*(2); *Guide to International Registration*, B.II.53.32.03. To seek registration for good/services not within the scope of the international registration, the applicant may file a separate application for the same mark under §1 and/or §44.

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

These examination procedures apply similarly to collective and certification marks. See [TMEP §1304.02\(c\)](#) regarding identifications in collective membership mark applications, [§1304.02\(d\)](#) regarding classification in §66(a) collective membership applications, [§1306.02\(c\)](#) regarding identifications in certification mark applications, and [§1306.02\(d\)](#) regarding classification in §66(a) certification mark applications.

Generally, there are three types of identifications: (1) acceptable identifications of goods/services; (2) indefinite identifications of goods/services with acceptable options within the scope of the class; and (3) indefinite identifications of goods/services that do not include any goods/services in the designated class.

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

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

An international registration may encompass goods/services that were classified under an earlier version of the Nice Agreement. If the IB's classification of goods/services in the §66(a) application is different from the classification currently set forth in the USPTO ID Manual, the examining attorney will not require amendment of the classification. However, the examining attorney should notify the Administrator for Trademark Classification Policy and Practice (Administrator) of the serial number, using the internal TM

Madrid ID/Class mailbox. The goods/services cannot be moved to another class identified in the application. [37 C.F.R. §2.85\(d\)](#).

With respect to acceptable goods/services that appear to be misclassified, if amendment to the identification would identify goods or services in the assigned class, the examining attorney may require an amendment for further specificity to limit the identification to goods/services that are in the class indicated in the international registration.

*Examples:*

- The goods are identified as “footwear” in Class 25. The wording is definite and the IB has assigned the correct class. No action necessary.
- The services are identified as “legal services,” but the IB has assigned Class 42. The wording is definite, but the class is not consistent with the current edition of the Nice Agreement. No action is necessary. The examining attorney should notify the Administrator of the serial number.
- The goods are identified as “tobacco,” but the IB has assigned Class 35. The Alphabetical List of the Nice Agreement classifies such goods in Class 34. The examining attorney will accept the goods in the assigned class. The examining attorney should notify the Administrator of the serial number.
- The goods are identified as “pasta,” but the IB has assigned Class 3. The Alphabetical List of the Nice Agreement classifies such goods in Class 30. The examining attorney will accept the goods in the assigned class, and notify the Administrator of the serial number.
- The goods are identified as “footwear” in Class 9. The wording is definite, but misclassified. It could refer to goods in the assigned class with further amendment. The examining attorney may require the applicant to amend these goods to “protective industrial footwear” and/or “protective footwear for the prevention of accident or injury.”

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

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

*Examples:*

- The goods are identified as “headgear” in Class 25. A requirement for greater specificity is issued, offering suggestions for more narrowly identified goods in Class 25, such as “headgear, namely hats, beanies, bathing caps.” The examining attorney should not suggest items within the scope of “headgear” that are not in Class 25, such as “protective helmets” in Class 9 or “orthodontic headgear” in Class 10. The Office action must include an advisory that only goods within the scope of the IB-assigned class will be accepted.
- The services are identified as “consultation services” in Class 36. A requirement for more specificity is issued, offering suggestions for more narrowly recited services in Class 36, such as “banking consultation,” “credit consultation,” or “financial consultation.” The Office action must include an advisory that only services within the scope of the IB-assigned class will be accepted.

- The goods are identified as “video games” in Class 28. The examining attorney may suggest that the applicant adopt “hand-held consoles for playing video games,” “stand alone video game machines,” or “video game machines for use with televisions” in Class 28. A proposed amendment including goods in the nature of “downloadable video game software,” or “video game cartridges” (both of which are Class 9 items under the current edition of the Nice Agreement) would be outside of the scope of the goods covered by the international registration, and such an amendment must be refused. The Office action must include an advisory that amendments may only include goods within the scope of the class assigned by the IB.

### **1904.02(c)(iii) Indefinite Identification of Goods/Services that Does Not Include Any Goods/Services Within the Class**

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

To be acceptable, any submitted amendment must be within the scope of the wording of the original goods/services.

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

#### *Examples:*

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

If it appears that there is an error in classification, the examining attorney may suggest the applicant contact the IB to request correction of or a limitation to the international registration. The USPTO will not suspend prosecution of the application unless the applicant requests suspension in a timely response to an Office action and supports the request with a copy of the request for correction or request to record a limitation filed with the IB. See [TMEP §716.02\(g\)](#). The applicant may also appeal the final identification requirement to the Trademark Trial and Appeal Board or petition the Director under [37 C.F.R. §2.146](#) to review the requirement, if permitted by [37 C.F.R. §2.63\(b\)\(2\)](#). See [TMEP §1501.01](#) regarding appealable matter and [§1704](#) regarding petitionable subject matter.

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

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

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

The examining attorney may suggest – but must not require – that the applicant delete an unacceptable term or phrase or proposed goods/services entry that fall outside the scope of the class. If the application contains acceptable goods/services that can be approved for publication, and would otherwise be in condition for a partial abandonment advisory, the examining attorney should indicate that if an acceptable response is not received, the unacceptable goods/services will be abandoned and the application will proceed with the acceptable items only. See [TMEP §718.02\(a\)](#) regarding partial abandonment.

If deletion or abandonment of an unacceptable term or phrase would result in deletion of all goods/services from the §66(a) application, the examining attorney must not suggest that the applicant delete the unacceptable wording. Instead, the examining attorney must continue to require an acceptable amendment, making the requirement final if appropriate.

If it appears that there is an error in classification, the examining attorney may suggest the applicant contact the IB to request correction of or a limitation to the international registration. The USPTO will not suspend prosecution of the application unless the applicant requests suspension in a timely response to an Office action and supports the request with a copy of the request for correction or request to record a limitation filed with the IB. See [TMEP §716.02\(g\)](#). The applicant may also appeal the final identification requirement to the Trademark Trial and Appeal Board or petition the Director under [37 C.F.R. §2.146](#) to review the requirement, if permitted by [37 C.F.R. §2.63\(b\)\(2\)](#). See [TMEP §1501.01](#) regarding appealable matter and [§1704](#) regarding petitionable subject matter.

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

Article 3 of the Madrid Protocol requires the goods and services of the international application to be classified according to the Nice Agreement. The IB uses the edition of the Nice Agreement in effect at the time international registration is sought to classify the goods and services. The opinion of the IB with respect to classification prevails over that of the applicant and the Office of origin in the event of disagreement. Article 3(2).

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

## 1904.02(d) Examination Issues Specific to Certification and Collective Marks

### *Clarification of Mark Type*

A §66(a) application may indicate that the mark is a “Collective, Certificate or Guarantee Mark.” In such a case, the examining attorney must require the applicant to clarify the type of mark for which it seeks protection, unless it is already clear from the record. However, if the §66(a) application does not indicate that the mark is a “Collective, Certificate or Guarantee Mark,” the applicant may not amend the application to seek registration of a collective or certification mark. Similarly, if the §66(a) application indicates that the mark is a “Collective, Certificate or Guarantee Mark,” the applicant may not amend the application to seek registration of a trademark or service mark. If the statement was omitted from or included in the application by mistake, the applicant may request a correction of the record from the IB. The applicant may also request suspension of the application and must include a copy of the request for correction filed with the IB. See [TMEP §716.02\(g\)](#).

### *Classification*

If a §66(a) applicant indicates that the mark is a certification mark or collective membership mark, the USPTO **will not** reclassify it into U.S. Class A, B, or 200. See [37 C.F.R. §§2.44\(a\)\(3\)\(ii\), 2.45\(a\)\(3\)](#). U.S. Classes A, B, and 200 are classes from the prior U.S. classification system that are still used in the United States to classify certification marks for goods (U.S. Class A), certification marks for services (U.S. Class B), and collective membership marks (U.S. Class 200). [37 C.F.R. §§6.3, 6.4](#). These classes are not included in the international classification system under the Nice Agreement.

### *Verified Statement*

The verified statement required for a §66(a) application, referenced in [TMEP §1904.01\(c\)](#), is *not* part of the international registration on file with the IB for a collective trademark, collective service mark, collective membership mark, or certification mark; therefore, the examining attorney must require the verified statement during examination. [TMEP §§1303.01\(a\)\(v\), \(b\)\(ii\), 1304.02\(a\)\(v\), \(b\)\(ii\), 1306.02\(a\)\(v\), \(b\)\(ii\)](#); see [37 C.F.R. §§2.44\(a\)\(4\)\(v\), \(b\)\(2\), 2.45\(a\)\(4\)\(v\)\(B\), \(b\)\(2\)](#).

### *Additional Requirements*

The examining attorney must also require the §66(a) applicant to comply with the additional requirements for the particular type of mark, i.e., collective trademark, collective service mark, collective membership mark, or certification mark. See [37 C.F.R. §§2.44, 2.45](#). See [TMEP §§1303–1303.02\(b\)](#) regarding the requirements for collective trademark and collective service mark applications, [§§1304–1304.03\(c\)](#) regarding

the requirements for collective membership mark applications, and [§§1306–1306.06\(c\)](#) regarding the requirements for certification mark applications.

## **1904.02(e) Corrections to an International Registration**

### **1904.02(e)(i) Corrections to Goods/Services/Classes**

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

Corrections that merely reclassify the originally identified goods/services may be accepted; however, any indefinite wording of the identification of such goods/services that was acceptably amended during the course of USPTO examination is not affected or changed by the correction issued by the IB. When an applicant amends the identification of goods/services in a manner that is acceptable to the examining attorney, including voluntary deletion of goods/services, the amendment replaces all previous identifications and thus restricts the scope of goods/services to the amended language. See [TMEP §1402.07\(e\)](#). However, if a correction adds goods/services that were omitted from the basic list of goods/services in error, they would be inserted into the identification and subject to USPTO practice with regard to definiteness.

See also [TMEP §1904.03\(f\)](#) regarding notifications of corrections in general, [§1904.14](#) regarding corrections to registered extensions of protection, and [§1906.01\(f\)](#) regarding filing requests for correction with the IB.

### **1904.02(f) Restrictions to Goods/Services**

A restriction is a narrowing amendment to the goods/services in some or all pending and registered extensions of protection. Some types of restrictions also impact the listing of goods/services in the international registration. Restrictions include limitations, cancellations, and ceasings of effect. A limitation is an amendment to some or all of the goods/services in one or more extensions of protection that the holder files with the IB. The listing of goods/services in the international registration are not impacted by limitations. Article 9 *bis*; Regs. Rule 25(1)(a)(ii); *Guide to International Registration*, B.II.70.53.01 and B.II.17.07.61. A cancellation is an amendment to some or all of the goods/services in the international registration that then affects all of the extensions of protection. A cancellation is filed by the holder with the IB. Article 9 *bis*; Regs. Rule 25(1)(a)(v). A ceasing of effect occurs when some or all of the goods/services have been removed from the basic application or registration due to a judicial action or proceeding or by voluntary action by the holder. For a period of five years from the date of the international registration, such changes to the listing of goods/services in the basic application or registration will result in a ceasing of effect of those goods/services in the international registration and all extensions of protection. The Office of origin notifies the IB of the ceasing of effect, and the IB then notifies all of the designated Contracting Parties. Article 6(3); Regs. Rule 22. The effective date of a restriction for determining priority of the filing is its date of recordal in the international register. Regs. Rule 27(1).

See [TMEP §1904.02\(f\)\(i\)](#) and [§1906.01\(e\)](#) regarding limitations, [§1904.02\(f\)\(iii\)](#), [§1904.08](#), and [§1906.01\(e\)](#) regarding cancellations, and [§1904.02\(f\)\(iv\)](#) and [§1904.15\(c\)](#) regarding ceasings of effect.

### **1904.02(f)(i) Limitations to Goods/Services**

The holder of an international registration may file with the IB a voluntary amendment of the goods/services that narrows the scope of the identification in one or more designations, called a limitation. A limitation does not remove the goods/services concerned from the international registration but simply narrows the goods/services for which the holder seeks protection in the particular designated Contracting Parties. See [TMEP §1906.01\(e\)](#) regarding the filing of a request to record a limitation with the IB.

An international application or subsequent designation may contain limitations of the listing of goods/services in respect of one or more designated Contracting Parties. Regs. Rule 9(4)(a)(xiii). A limitation also may be filed with the IB separately from the international application or subsequent designation. Article 9 *bis*(iii). Upon recordation, the IB will notify the USPTO if a U.S. application or registration is affected by the limitation. The limitation may appear in the §66(a) application form or in the application record as a separate filing. See [TMEP §1904.03\(g\)\(i\)](#) regarding limitations in pending requests for extension of protection (§66(a) applications) and [§1904.15\(a\)](#) regarding limitations in registered extensions of protection (§66(a) registrations).

A limitation may only restrict the scope of the goods/services; it may not broaden or extend the listing of goods/services in a pending or registered extension of protection beyond the scope of the listing of goods/services in the international registration or beyond the operative listing of goods/services. See [TMEP §1402.07\(a\)](#), [§1904.02\(c\)-\(c\)\(iv\)](#).

See also [TMEP §1904.03\(g\)\(i\)](#) regarding determining whether a limitation is within the scope of the basic goods/services and regarding assessing limited goods/services with respect to interceding amendments to the identification and any prior limitations.

### **1904.02(f)(ii) Limitations vs. Amendments to Goods and Services**

A limitation filed with the IB may affect pending or registered extensions of protection in some or all of the Contracting Parties. By contrast, an amendment to the identification of goods/services in a §66(a) application is comparable to a limitation affecting only the United States in that the amendment affects only the U.S. application. Any extensions of protection to other Contracting Parties are unaffected by amendments to a §66(a) application.

While a limitation filed with the IB may render the identification of goods/services in the §66(a) application sufficiently definite, merely recording a limitation with the IB is not considered a response to an Office Action. See [37 C.F.R. §§2.62, 2.65\(a\)](#); [TMEP §1904.03\(g\)\(i\)](#). If the examining attorney issued an Office action prior to notification of the limitation, a proper response to the Office action still must be received within the response time period. See [TMEP §1904.03\(g\)\(i\)](#).

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

### **1904.02(f)(iii) Partial Cancellation of an International Registration**

The holder of an international registration may request the removal or narrowing of some of the goods/services from the international registration by filing a cancellation request with the IB. If such a request complies with applicable requirements, the IB records the partial cancellation in the international registration and notifies all of the Offices of the designated contracting parties. As the cancelled goods are no longer part of

the international registration, they are no longer eligible for extension of protection. When the USPTO receives the notification of the partial cancellation, the USPTO will enter it into the record and amend the listing of goods/services to conform to the partial cancellation. See [TMEP §1904.03\(g\)\(ii\)](#) regarding partial cancellations in a pending request for extension of protection and [§1904.15\(b\)](#) regarding partial cancellations in registered extensions of protection to the United States.

### **1904.02(f)(iv) Partial Ceasing of Effect of a Basic Application/Registration**

A restriction to the listing of the goods/services in the international registration may occur due to the partial ceasing of effect of the basic application/registration on which the international registration is based. A partial ceasing of effect occurs when some of the goods/services have been removed from or narrowed in the basic application or registration. In such a case, the Office of origin notifies the IB, which in turn records the partial ceasing of effect in the international registration by amending the listing of goods/services in the international registration to reflect the listing in the basic application or registration. The IB then notifies all the Offices of the designated contracting parties. As the ceased goods/services are no longer part of the international registration, they are no longer eligible for extension of protection. Upon receipt of notification of ceasing of effect, the USPTO will enter it into the record and amend the listing of goods/services to conform to the partial ceasing of effect. See [TMEP §1904.03\(g\)\(iii\)](#) regarding partial ceasings of effect in a pending request for extension of protection and [§1904.15\(c\)](#) regarding partial ceasings of effect in registered extensions of protection to the United States.

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

Under §68(c) of the Trademark Act and Article 5(2) 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 Trademark database tracks the period of time within which the USPTO must notify the IB of a refusal of protection. This information appears in the §66(a) international registration data field "Auto Protection Date." If a refusal is not received by the IB as of this date, the mark receives automatic protection under Article 5(5) of the Protocol.

### **1904.02(h) Office Actions and Responses**

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. See Regs. Rule 17. If the provisional refusal meets the applicable requirements (see [TMEP §1904.03](#)), the IB will process the refusal and send it to the holder (i.e., the §66(a) applicant or their representative, if one is designated). Regs. Rule 17(4). The IB notifies the USPTO of the date on which it processed the refusal, and the USPTO updates the Trademark database with this information.

A response to the first and any subsequent Office action must be filed with the USPTO (using the Trademark Electronic Application System (TEAS); see [37 C.F.R. §§2.23\(a\), 7.25](#); [TMEP §301.01](#)), not with the IB, and is due in the USPTO 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. [15 U.S.C. §1062\(b\)\(2\)](#); [37 C.F.R. §2.62\(a\)\(1\)\(ii\)](#); [TMEP §1904.03\(c\)](#). Failure to respond to an Office action within the time provided will result in abandonment of the application. [15 U.S.C. §1062\(b\)\(2\)](#); [37 C.F.R. §2.65\(a\)](#). See [TMEP §711](#) regarding the deadline for response to an Office action and [§718.02](#) and [§§718.03-718.03\(a\)](#) regarding abandonment for failure to respond or incomplete response to an Office action.

A priority action generally may not be issued as a first Office action in a §66(a) application if the applicant has not yet appointed a qualified U.S. attorney. See [TMEP §§712-712.03](#). In addition, a suspension notice generally may not be issued as a first Office action in a §66(a) application. See [TMEP §§716, 716.02-.02\(i\)](#).

An examiner's amendment or a combined examiner's amendment and priority action (see [TMEP §§707-707.03, 708.05](#)) may not be issued as a first Office action because the IB will not accept such amendments. However, in rare circumstances, a no-call examiner's amendment may be issued in a first Office action, for example, to remove certain parenthetical wording from an identification of goods/services if the application is otherwise in condition for approval for publication. The examining attorney may approve the application for publication and should not require the applicant to appoint an attorney authorized to practice before the USPTO or to provide an email address. See [TMEP §601.01\(a\)](#) regarding applicants with a non-U.S. domicile, [§803.05\(b\)](#) regarding applicant's email address as a required element of an application, and [TMEP §1904.02\(c\)](#) regarding parenthetical language added by the International Bureau to the listing of goods/services. Examiner's amendments and combined examiner's amendments and priority actions may be issued as second and subsequent actions, if properly authorized. See [TMEP §707.01](#) regarding who can authorize examiner's amendments and [§708.02](#) regarding who can authorize priority actions.

If the applicant has appointed a qualified U.S. attorney in the §66(a) application, the USPTO will issue second and subsequent Office actions directly to the attorney. See [37 C.F.R. §2.11\(a\), 2.18\(a\)\(2\), 7.25\(a\)](#). If the applicant has not appointed a qualified U.S. attorney, second and subsequent Office actions will issue directly to the applicant. [37 C.F.R. §§2.18\(a\)\(1\), 7.25\(a\)](#). See [TMEP §§609.01-609.01\(a\)](#), and [§1904.02\(i\)](#) regarding second and subsequent Office actions and other correspondence in §66(a) applications.

### **1904.02(i) Correspondence Address**

The address of the international registration holder's designated representative is treated as the correspondence address, unless a change of correspondence address is filed in the USPTO. If the IB communicates that a §66(a) applicant has an appointed representative, the USPTO does not recognize this representative as the applicant's attorney without clarification of his or her qualifications under [37 C.F.R. §2.17](#) and [§11.14](#). [TMEP §602.03\(c\)](#). However, if the §66(a) applicant's domicile address in the application is outside the United States or its territories, the first Office action will include a requirement for the applicant to appoint an attorney authorized to practice before the USPTO under [37 C.F.R. §11.14\(a\)](#) and to provide the attorney's name, postal and email addresses, and bar information. See [37 C.F.R. §§2.11\(a\), 2.17\(b\)\(3\), 2.32\(a\)\(4\), 7.25\(a\); TMEP §602.03\(c\)](#). Additionally, the first Office action will include a requirement for the applicant's email address; which is not currently included in the application form. See [37 C.F.R. §§2.23\(b\), 2.32\(a\)\(2\), 7.25\(a\)](#). See [TMEP §§601-601.01\(e\)](#) regarding the requirement for representation based on foreign domicile of mark owner, [§§602-602.03\(b\)](#) regarding persons authorized to practice before the USPTO in trademark matters, [§602.03\(c\)](#) regarding representatives of holders of international registrations, and [§604.01](#) regarding recognition as a representative in a trademark matter.

If a qualified U.S. attorney is recognized as the applicant's representative, such attorney will be the correspondent in the application and will receive all USPTO communications. [37 C.F.R. §2.18\(a\)\(2\)](#).

The applicant must maintain current and accurate correspondence addresses for itself and its attorney. [37 C.F.R. §2.18\(c\)](#).

See [TMEP §609.01](#) regarding establishing the correspondence address in U.S. applications and [§609.01\(a\)](#) regarding correspondence in §66(a) applications. See [TMEP §1904.02\(h\)](#) regarding Office actions in §66(a) applications.

## 1904.02(j) Mark May Not Be Amended

The Madrid Protocol and the Regulations do not permit amendment of a mark in an international registration. If the holder of the international registration wants to change the mark in any way, even slightly, the holder must file a new international application. The IB's *Guide to International Registration*, B.II.93.81.02, provides as follows:

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

Accordingly, because an application under §66(a) is a request to extend protection of the mark in an international registration to the United States, the Trademark Rules of Practice make no provision for amendment of the mark in a §66(a) application, and the USPTO will not permit such amendments. See [37 C.F.R. §2.72](#); [TMEP §807.13\(b\)](#). Examples of such impermissible amendments include deletion of a color claim and deletion of entity designations or generic terms from the mark, even if otherwise immaterial. However, the applicant still must comply with U. S. requirements regarding drawings and descriptions of the mark. See [TMEP §1904.02\(k\)](#).

In limited circumstances, an applicant may amend a §66(a) application to add a standard character claim. See [TMEP §807.03\(g\)](#).

## 1904.02(k) Drawings and Descriptions of the Mark

Though the mark in a §66(a) application may not be amended, the applicant must comply with the U.S. requirements regarding drawings of the mark. [15 U.S.C. §1141h\(a\)](#); [37 C.F.R. §§2.52, 7.25\(a\)](#).

If the drawing does not meet U.S. 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 U.S. 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 §807.10](#) regarding drawings of three-dimensional marks and [Chapter 1700](#) regarding petitions.

If the international registration contains a color claim and/or color location statement, but it is incorrect, incomplete, or inconsistent with the color(s) shown on the drawing, the color claim and/or the color location statement must be corrected to conform to the color(s) depicted on the drawing. See [TMEP §§807.07\(a\)-\(a\)\(ii\), \(c\)](#).

*No color claim and color drawing.* 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 substitute drawing that is a black-and-white reproduction of the same mark depicted in the international registration. See [TMEP §807.07\(b\)](#).

*Color claim and black-and-white drawing.* If the international registration contains a color claim, but there is a black-and-white drawing in the international registration, the applicant must: (1) submit a substitute drawing that is a color reproduction of the same mark depicted in the international registration; (2) state for the record that the substitute drawing is a color reproduction of the same mark depicted in the international registration; and (3) submit a color location statement describing where the color(s) appear(s) in the mark.

See [TMEP §§807.07\(a\)–\(a\)\(ii\)](#). If the color claim and/or color location statement is incorrect, incomplete, or inconsistent with the color(s) shown on the substitute drawing, the color claim and/or the color location statement must be corrected to conform to the color(s) depicted on the substitute drawing. See [TMEP §§807.07\(a\)–\(a\)\(ii\)](#), [\(c\)](#). The applicant may not delete the color claim because it is part of the international registration. See 15 U.S.C. §1141e; Articles 3-4; Regs. Rules 9(4)(vii), 9(5)(d)(v), 14(2)(i). If the color claim was included in the §66(a) application by mistake, the applicant may request a correction of the record from the IB. The applicant may also request suspension of the application and must include a copy of the request for correction filed with the IB. See [TMEP §716.02\(g\)](#) regarding suspending an application pending receipt of a correction from the IB and [§1906.01\(f\)](#) regarding requesting correction of errors in the international registration.

A §66(a) applicant must also comply with U.S. requirements regarding descriptions of the mark. [37 C.F.R. §§2.37, 2.52\(b\)\(5\), 7.25\(a\)](#).

With respect to sound marks and other non-visual marks, if the international registration contains a visual depiction of some kind, such as a musical staff corresponding to the notes of a sound mark, the applicant will be required to comply with the U.S. requirements for a detailed description of the mark. See [TMEP §1011.04](#).

## **1904.02(l) Jurisdiction**

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

## **1904.03 Notice of Refusal**

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

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

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

[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. [15 U.S.C. §1141h\(c\)\(4\)](#); Article

5(5); Regs. Rules 17(2)(iv), 18(1)(a)(iii). 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. [15 U.S.C. §1141h\(c\)\(3\)](#).

If upon re-examination the examining attorney determines a new ground of refusal exists that should have been raised in the first Office action, 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 ensure that a notification of the new ground of refusal is sent to the IB.

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

A final decision is not necessary; a provisional refusal is sufficient to meet the 18-month requirement. Under Regulations Rule 17(2), a notice of provisional refusal must be dated and signed by the USPTO and must contain:

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

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

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

A holder of an international registration who applies for an extension of protection to the United States (also known as the §66(a) applicant) will receive an initial notification of refusal through the IB. The holder must respond directly to the USPTO, not the IB. Standard examination procedures are used to examine §66(a) applications. [15 U.S.C. §1141h](#).

See [TMEP §1904.02\(h\)](#) regarding Office actions and responses in §66(a) applications and [§1904.02\(i\)](#) regarding who can correspond with the USPTO in a §66(a) application.

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

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

Accordingly, [37 C.F.R. §2.65\(a\)\(1\)](#) provides that if a refusal or requirement is expressly limited to only certain goods/services and the applicant fails to respond, or respond completely, to the refusal or requirement, the application shall be abandoned only as to those particular goods/services. See [TMEP §718.02\(a\)](#) for further information about partial abandonment.

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

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

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

Regs. Rule 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. Regs. Rule 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. Regs. Rule 28(3).

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

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

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

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

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

### **1904.03(g)(i) Limitations to Goods/Services**

#### *Limitation Filed Separately from §66(a) Application*

The Madrid Processing Unit (MPU) reviews all separately filed limitations and will notify the examining attorney that a limitation was received.

Scope is determined according to the operative identification of goods and/or services when the limitation is examined. Limitations are processed in the order of their effective dates, which appears in the limitation form as the date of recordal in the international register. *See* Regs. Rule 27(1). The operative identification is the last acceptable amended identification, or the original identification if no amendment has been accepted. [TMEP §§1402.07\(d\)-\(e\)](#). Therefore, the applicant is not bound by the scope of the identification in a limitation that exceeds the scope of the application or any previously accepted amendments, but rather by the identification of goods and/or services that were operative prior to the recordal date of the limitation. [37 C.F.R §§2.71\(a\), 7.25\(a\); TMEP §1904.02\(c\)\(iv\)](#).

If the USPTO receives a limitation from the IB before the first Office action issues, the examining attorney will include any requirements arising from the limitation in the first Office action. If the separately filed limitation puts the application in condition for publication before a first Office action issues, the examining attorney still must issue an Office action raising all of the requirements based on the application as filed. The USPTO is required to notify the IB of all grounds for refusing registration of the application as filed. [15 U.S.C §1141h\(c\)](#); Article 5. The examining attorney must state in the Office action that the limitation resolves the requirements related to the original identification of goods and/or services. Once the MPU sends the Office action to the IB, the examining attorney may enter the limitation via an examiner's amendment, after securing approval of the amendment from the proper person. *See* [37 C.F.R §§2.32\(a\)\(4\), 2.62\(b\), 2.74\(b\); TMEP §§609.01\(a\), 707.01, 803.05\(b\), 811.01](#). Only an application itself that is in condition for approval for publication on first action may be approved without applicant's email address and attorney information of record. *See* [TMEP §§609.01\(a\), 803.05\(b\), 1904.02\(h\)](#). Even if a separately filed limitation would put an application in condition for publication, the application may not be approved for publication on first action because the USPTO is required to notify all grounds for refusing registration of the request for extension of protection to the IB. [15 U.S.C §1141h\(c\)](#); Article 5. Otherwise, the International Register will indicate that the USPTO granted protection to the extension of protection in its original condition, without requiring amendments to the original listing of goods and/or services in the Section 66(a) application.

If the USPTO receives a limitation from the IB after an Office action has issued, the limitation cannot be considered a response to the Office action because it does not meet the requirements of [37 C.F.R §2.62](#). The examining attorney will take action on the limitation after the USPTO receives a timely response to the outstanding Office action. However, if the limitation puts the application in condition for publication, the examining attorney may enter the amendments via an examiner's amendment after securing approval of the amendment from the proper person, if applicant's email address and attorney information have already been provided. *See* [37 C.F.R §§2.32\(a\)\(4\), 2.62\(b\), 2.74\(b\); TMEP §§609.01\(a\), 707.01, 803.05\(b\), 811.01](#). Otherwise, the applicant must file a timely response to the Office action to avoid abandonment of the application. [37 C.F.R §2.65; TMEP §718.02](#).

Once the USPTO receives a timely response to the outstanding Office action, the examining attorney will review the response to the Office action and the limitation together. When the response to the Office action

also contains amendments to the identification of goods and/or services, the examining attorney will review the amendments in the order of their effective dates to determine the scope of the resulting identification. The effective date of a limitation is the date of recordal in the International Register. *See* Regs. Rule 27(1). The effective date of a voluntary amendment or response to an Office action filed with the USPTO is its filing date. [37 C.F.R. §2.195](#), [TMEP §§303](#) *et seq.* When the USPTO receives more than one limitation from the IB before the examining attorney takes action on a response to an Office action, the examining attorney must examine the limitations in the order of their effective dates. Acceptable amendments in earlier filings determine the scope of the identification when reviewing later amendments in either an Office action or limitation. [TMEP §§1402.07\(d\)-\(e\)](#).

If the response to the Office action and the limitation place the application in condition for publication, the examining attorney must approve the application for publication. If the response to a nonfinal Office action and the limitation leave any refusals or requirements unresolved and do not raise any new issues, the examining attorney must state in any subsequent Office action whether the limitation and response to the Office action resolve any requirements related to the identification and must maintain and continue, or make final, any refusals and/or requirements that remain unresolved, as appropriate. *See* [TMEP §714.04](#). If the response to the Office action or limitation raises new issues, the new requirements must be made in a new nonfinal Office action. The new nonfinal Office action also must state whether the limitation and the response to the Office action resolve any requirements related to the identification and must maintain and continue any refusals and/or requirements that remain unresolved, as appropriate. The Office action should not be sent to the IB unless it raises new issues that should have been included in the first Office action. *See* [TMEP §§714.03](#) and [714.05](#) for further discussion of when an examining attorney should issue a nonfinal Office action rather than a final Office action.

If the response to a final Office action and the limitation leave any requirements unresolved and do not raise any new issues, the examining attorney must follow the procedures outlined in [TMEP §§715.03\(a\)\(ii\)](#), [\(b\)](#), and [715.04\(a\)](#), [\(b\)](#). An Office action issued in connection with those procedures must state whether the limitation and response to the Office action resolve any requirements related to the identification and should discuss any new evidence submitted with the request for reconsideration, regardless of whether it is significantly different from evidence previously submitted. If the response to a final Office action or the limitation raises new issues, the new refusals and/or requirements must be made in a new nonfinal Office action. The Office action should not be sent to the IB unless it raises new issues that should have been included in the first Office action. *See* [TMEP §§715.03\(a\)](#), [\(b\)](#), and [715.04–715.04\(b\)](#) for further information as to how examining attorneys should handle requests for reconsideration.

When the examining attorney must require an amendment to the identification based on a limitation, the applicant may respond by further clarifying any indefinite limited goods and/or services within the scope of the operative identification, or by deleting impermissible limited goods and/or services as outside the scope of the operative identification, if appropriate. Once an identification has been expressly amended to delete goods and/or services, those items generally may not be reinserted. [TMEP §1402.07\(e\)](#).

The applicant may also submit arguments in favor of accepting the limited goods and/or services that have been refused. If the issue is maintained and made final, the applicant may file an appeal to the Trademark Trial and Appeal Board pursuant to [37 C.F.R. §2.141](#) and [§2.142](#) or a petition to the Director pursuant to [37 C.F.R. §2.63\(b\)\(2\)\(iii\)](#).

Alternatively, the applicant may overcome the refusal of the limited goods and/or services by filing a new limitation with the IB listing goods and/or services that are within the scope of the operative identification for a fee. If the applicant chooses to file a new limitation, it must notify the examining attorney in a timely filed response to avoid abandonment of the §66(a) application. The response must indicate that another

limitation has been filed with the IB, which the applicant believes will resolve the issue, request suspension, and include a copy of the limitation filed with the IB. *See* [TMEP §716.02\(g\)](#). The examining attorney will then suspend action awaiting receipt of the notification of the limitation. The copy of the limitation in the response to the Office action serves to authenticate the limitation so that the examining attorney can take action on it once received from the IB. If notification of the limitation is not received within six months of the issuance of the suspension, the examining attorney must inquire as to the status of the limitation. *See* [TMEP §§716.02\(g\)](#), [716.05](#).

The following examples of limitations filed separately from the §66(a) application illustrate the procedures discussed above:

**Example :** The §66(a) application identifies the goods as "metal materials for building and construction" in International Class 6. The USPTO receives a separately filed limitation before the first Office action issues, which indicates that the limited goods are "metal materials for residential building and construction." Because the limited goods are not sufficiently definite under existing USPTO identification policy, the examining attorney must require the applicant to amend the ID to list the particular Class 6 metal materials for residential building and construction (e.g., "metal materials for residential building and construction, namely, soffits, fascia, and drywall corner bead").

**Example :** The §66(a) application identifies the goods as "medical instruments" in International Class 10. The USPTO receives a separately filed limitation before the first Office action issues, which indicates the limited goods are "medical instruments for use in surgery." The identification in the limitation is acceptable because "medical instruments for use in surgery" are within the scope of the ordinary meaning of "medical instruments" and are acceptably definite. The record indicates that applicant is foreign-domiciled, applicant's appointed U.S.-licensed attorney provided applicant's email address and all of the required attorney information via a voluntary amendment, and no other outstanding issues need to be raised in connection with the application. The examining attorney must issue an Office action requiring the applicant to amend the identification of goods in the application as filed because "medical instruments" are unacceptable without further specification. The Office action must indicate that the limitation resolves the deficiencies in the identification of goods in the application as filed. The Office action is required because the application, as filed, is not in condition for publication. Once the Office action has been sent to the IB, the examining attorney may enter the changes to the identification of goods via an examiner's amendment after securing the approval of the amendment from the proper person. [TMEP §707.01](#).

**Example :** The §66(a) application identifies the goods as "medical instruments" in International Class 10. The USPTO receives a separately filed limitation before the first Office action issues, which indicates the limited goods are "medical instruments for use in surgery." The identification in the limitation is acceptable because "medical instruments for use in surgery" are within the scope of the ordinary meaning of "medical instruments" and are acceptably definite. The record indicates that applicant is foreign-domiciled, and the record does not include applicant's email address or the required U.S.-licensed attorney information. The examining attorney must issue an Office action requiring the applicant to amend the identification, provide its email address, and provide the required information for its U.S.-licensed attorney. [TMEP §803.05\(b\)](#). The Office action is required because the application, as filed, is not in condition for publication. The Office action must indicate that the limitation resolves the deficiencies in the identification of goods in the application as filed.

**Example :** The §66(a) application identifies the goods as "medical apparatus" in International Class 10. The examining attorney issues an Office action requiring further specificity of the type of "medical apparatus," in accordance with USPTO policy. The USPTO then receives a limitation, which indicates that the limited goods are "medicine cabinets." Such goods exceed the scope of International Class 10 since "medicine cabinets" are properly classified in International Class 20. In addition, the wording "medicine cabinets" exceeds the scope of the ordinary meaning of "medical apparatus." "Medical apparatus" refers to "machines, tools, and equipment for doing something" related to medical activities, and this would not encompass a "small cupboard in a bathroom in which you keep soap, toothpaste etc." *See* Macmillan Dictionary, Macmillan Publishers Limited 2009-2017. No response to the Office action has been filed, but there is time remaining in the response period. The examining attorney should not take action on the limitation since a response to the Office action has not been received. If the applicant does not file a timely response to the Office action, the application will abandon.

If, however, the applicant amends the identification to "medical apparatus for use in orthopedic surgery" in a timely response to the Office action that is filed after the recordal date of the limitation, the proposed amendment is compared to the identification in the application to determine acceptability for scope purposes. As noted above, the identification in the limitation cannot be accepted because it exceeds the scope of the international registration. Therefore, the operative identification for purposes of amendment in response to the Office action remains the original identification in the application. Since "medical apparatus for use in orthopedic surgery" is within the scope of the original identification and is acceptably definite, the examining attorney will accept the amendment.

If there are no other outstanding issues, the examining attorney may approve the application for publication since the response to the Office action resolves the issue with the identification.

**Example :** The §66(a) application identifies the goods as "clothing, headgear, and footwear" in International Class 25. The examining attorney issues an Office action requiring further specificity of the type of "clothing" and "headgear," in accordance with USPTO policy. The applicant submits a timely response to the Office action, amending the goods to "clothing, namely, sportswear and formalwear; headgear, headsets, and headphones; footwear." The "sportswear," "formalwear," and "headgear" require further specificity, and the "headsets" and "headphones" are beyond the scope of the international registration because these goods are properly classified in Class 9. The examining attorney will issue a final Office action maintaining and making final the requirement to provide an acceptable identification. Before the expiration of the response period, and before the applicant files a request for reconsideration or notice of appeal, the USPTO receives a limitation with a recordal date that is later than the previous response to the Office action. The limitation indicates that the limited goods are "clothing, namely, sportswear; headgear, namely, headsets, and headphones; footwear." The limitation is unacceptable because it lists indefinite and misclassified goods. The examining attorney must not take action on the limitation until the applicant responds to the final Office action. If the applicant believes that the limitation places the application in condition for publication, the applicant must file a request for reconsideration so that the limitation will be reviewed by the examining attorney. If the applicant does not file a timely request for reconsideration or notice of appeal, the application will abandon.

**Example :** The §66(a) application identifies the goods as "hand tools" in International Class 8. The examining attorney issues an Office action requiring the applicant to specify the particular hand tools. The applicant subsequently amends the listing of goods/services to "hand tools, namely, manual can openers, kitchen scissors, kitchen knives, non-electric fruit peelers, egg slicers." Before the examining attorney takes action on the response to the Office action, the USPTO receives a limitation with a recordal date that is later than the filing date of the response to Office action. The limitation indicates that the limited goods are "hand tools for use in preparing food; hand tools for use in home repair." The examining attorney reviews the amended identification in the response to the Office action first since its filing date precedes the recordal date of the limitation and determines that the proposed identification in the response is acceptable. Therefore, the identification in the response to the Office action sets the scope for further amendments. The examining attorney then compares the goods in the limitation with the goods as amended by the applicant in the response to the Office action. Here, the "hand tools for use in home repair" in the limitation are beyond the scope of the operative listing of goods "hand tools, namely, manual can openers, kitchen scissors, kitchen knives, non-electric fruit peelers, egg slicers" since none of these goods are for use in home repair. Therefore, the examining attorney must issue a new, nonfinal Office action refusing the "hand tools for use in home repair" as beyond the scope of the application as amended in the response to the Office action. Further, the examining attorney must incorporate the acceptable wording from the limitation into the operative listing of goods and notify the applicant in the Office action that "hand tools for use in preparing food, namely, manual can openers, kitchen scissors, kitchen knives, non-electric fruit peelers, egg slicers" comprises the operative language of the identification for purposes of future amendment. The examining attorney must also maintain and continue any refusals and/or requirements that were not resolved by the response to Office action. The examining attorney must not send the Office action to the IB since the new issue is not based on the application as filed.

### *Limitation Within §66(a) Application*

When a holder includes a limitation of the goods and/or services within the international application or subsequent designation form and indicates that the limitation should apply to the extension of protection to the United States, the limitation appears within the §66(a) application, rather than as a separate filing. In this circumstance, the goods and/or services in the international registration are not extended to the United States for protection. Instead, only the limited goods and/or services are extended to the United States for protection. Accordingly, the limited goods and/or services, rather than the goods and/or services in the international registration, are treated as the original listing of goods and/or services in the §66(a) application. However, by law, the listing of goods and/or services in the international registration continues to set the scope of the goods and/or services that may be included in an extension of protection. [15 U.S.C. §1141e\(a\)](#); Article 3(1); Regs. Rule 9(5)(d)(vi). Therefore, the goods and/or services in a limitation that appear within a §66(a) application are refused if they exceed the scope of the goods and/or services in the international registration as listed in the application.

If the examining attorney determines that some or all of the limitation is not acceptable because the requested change would result in a broadening or extension, rather than a narrowing, of the goods and/or services in the international registration (*see* [TMEP §1402.06\(a\)-\(b\)](#)), he or she must issue an Office action: (1) refusing

to accept the listing of goods and/or services in the limitation, in whole or in part; (2) explaining the reasons for the finding; (3) stating the corresponding essential provisions of the law; and (4) indicating that the limited goods and/or services are not entitled to the benefits of extension of protection to the United States. *See* [15 U.S.C §1141h\(b\)](#).

When the limitation included within a §66(a) application exceeds the scope of the goods and/or services in the international registration as listed in the application, the examining attorney does not advise the applicant that the goods and/or services in the international registration remain operative for purposes of future amendment because the full listing of goods and/or services in the international registration were never extended to the United States. Instead, the examining attorney will advise the applicant that it must amend the goods and/or services to conform to the scope established by the limited goods and/or services as well as the scope of the goods and/or services in the international registration.

The applicant may respond to such a refusal by amending the limited goods and/or services to goods and/or services within the scope of the identification in the international registration and the scope of the limitation, if appropriate. The applicant may not add goods and/or services listed in the international registration that were deleted by the limitation. Where a conforming amendment cannot be submitted, the applicant can respond by deleting the limited goods and/or services that have been refused. Once an application has been expressly amended to delete goods and/or services, those items generally may not be reinserted. [TMEP §1402.07\(e\)](#).

The applicant may also submit arguments in favor of accepting the goods and/or services that have been refused. If the refusal is maintained and made final, the applicant may file an appeal to the Trademark Trial and Appeal Board pursuant to [37 C.F.R. §2.141 and §2.142](#) or petition to the Director pursuant to [37 C.F.R. §2.63\(b\)\(2\)\(iii\)](#).

Additionally, the applicant may overcome the refusal of the limited goods and/or services by filing a new limitation with the IB that lists goods and/or services that are within the scope of the goods and/or services in the international registration for a fee. If the applicant chooses to file a new limitation, it must notify the examining attorney in a timely filed response in order to avoid abandonment of the §66(a) application. The response must indicate that another limitation has been filed with the IB, which the applicant believes will resolve the issue, request suspension, and include a copy of the limitation filed with the IB. *See* [TMEP §716.02\(g\)](#). The examining attorney will then suspend action awaiting receipt of the notification of the limitation. The copy of the limitation in the response to the Office action authenticates the limitation so that the examining attorney can take action on it once received from the IB. If notification of the limitation is not received within six months of the issuance of the suspension, the examining attorney must inquire as to the status of the limitation. *See* [TMEP §§716.02\(g\), 716.05](#).

In rare circumstances, a limitation that exceeds the scope of the entire listing of goods and/or services in the international registration could result in there being no goods and/or services in the §66(a) application that are entitled to extension of protection to the United States. For example, this may happen if a limitation within the §66(a) application lists only goods and/or services that exceed the scope of the goods and/or services in the international registration and that cannot be amended to stay within the scope of the limitation as well as the international registration. In such case, the examining attorney must consult with his or her managing or senior attorney, who will notify the Office of the Deputy Commissioner for Trademark Examination Policy.

The following are examples of limitations filed within the §66(a) application that illustrate the procedures discussed above:

**Example** : The §66(a) application identifies the goods in the international registration as "pharmaceuticals" in International Class 5. The limitation included in the §66(a) application indicates that the limited goods are "pharmaceuticals being aspirin, allergy tablets, and adhesive bandages." Since "aspirin" and "allergy tablets" are within the scope of the ordinary meaning of "pharmaceuticals," such goods are within the scope of the goods in the international registration and are entitled to the benefits of extension of protection to the United States. However, as "adhesive bandages" are not within the scope of the ordinary meaning of "pharmaceuticals," the examining attorney must indicate in the first Office action that the limitation is refused "in part" as to the "adhesive bandages" because this wording exceeds the scope of the international registration. As the limitation otherwise acceptably narrows the goods to "pharmaceuticals being aspirin [and] allergy tablets," such wording comprises the operative language of the identification for purposes of future amendment.

**Example** : The §66(a) application identifies the services in the international registration as "advertising; business management; business administration; office functions" in International Class 35. The limitation included in the §66(a) application indicates that the limited services are "advertising, window dressing services for advertising purposes, production of advertising matter and commercials, business administration, office functions in the nature of filing documents." Such services are within the scope of the ordinary meaning of the wording of the services in the international registration and are in accordance with USPTO standards of acceptability. Thus, this wording comprises the operative language of the identification for purposes of future amendments. If the application is otherwise in condition for publication, the examining attorney may approve the application for publication. The requirements for the applicant's email address and, if applicable, for U.S. counsel are waived since the application, as received from the IB, is otherwise in condition for publication. [TMEP §803.05](#).

**Example** : The §66(a) application identifies the goods in the international registration as "artists' materials" in International Class 16. The limitation included in the §66(a) application indicates that the limited goods are "molds, brushes, pens, pencils, paint, sculptors' chisels and palette knives." The "paint, sculptor's chisels and palette knives" are properly classified in International Classes 2 and 8, respectively. The examining attorney's Office action must refuse registration as to the "paint, sculptors' chisels and palette knives" on the ground that these goods exceed the scope of the goods in the international registration and thus are not entitled to the benefits of extension of protection to the United States. While "molds, brushes" constitutes broad wording that may encompass goods in other International Classes, these goods are within the scope of the goods because this wording includes types of artists' materials that are classified in International Class 16. Therefore, the examining attorney must refuse "molds, brushes" as unacceptably indefinite and require the applicant to amend to goods that are properly classified in International Class 16 and that reflect the scope of the listing of goods in the international registration. For example, the examining attorney may suggest: "artists' materials, namely, molds for modeling clays, artists' brushes, pens, pencils" in International Class 16.

**Example** : The §66(a) application identifies the goods in the international registration as "clothing" in International Class 25 and "watches; necklaces" in International Class 14. The limitation included in the §66(a) application indicates that the limited goods are "watches; jewelry" in International Class 14 and "clothing" in International Class 25. In this case, "watches" in the limitation are within the scope of the goods in the international registration and would be accepted. However, "jewelry" in the limitation exceeds the scope of "necklaces" in the international registration and would not be accepted. Thus, while "watches" would remain in the identification of record for International Class 14 of the §66(a) application, "jewelry" would not be entitled to the benefits of extension of protection to the United States. The examining attorney must refuse "jewelry" as beyond the scope of the listing of goods in the international registration. However, the examining attorney may suggest that applicant simply amend this wording to "jewelry, namely, necklaces" to bring the limited goods into alignment with the scope of the goods in the international registration. Additionally, "clothing" in International Class 25 would remain in the application as it is the same as the listing in the international registration.

**Example** : The §66(a) application identifies the goods in the international registration as "clothing" in International Class 25. The limitation included in the §66(a) application lists "watches; jewelry" in International Class 25. The limited goods "watches; jewelry," exceed the scope of the listing of goods in the international registration. However, "clothing" would no longer be included in the identification in the §66(a) application because it was not included in the listing of limited goods, "watches; jewelry." In this case, because the applicant cannot amend the limited goods to bring them within the scope of the listing of goods in the international registration, the application contains no goods/services that are entitled to the benefits of extension of protection to the United States. The examining attorney must consult with his or her managing or senior attorney regarding how to proceed with this application.

See also [TMEP §1906.01\(e\)](#) for information about filing requests to record limitations with the IB and [§1904.15](#) regarding restrictions to goods/services with respect to registered extensions of protection.

### **1904.03(g)(ii) Partial Cancellation of an International Registration**

When the USPTO receives notification from the IB that the international registration has been restricted in part due to a partial cancellation, the MPU will determine what, if any, goods/services remain extended to the United States and amend the listing of goods/services in the relevant pending extension of protection to reflect the changes in the notice of cancellation. [15 U.S.C. §1141j\(a\)](#); [37 C.F.R. §7.30](#).

### **1904.03(g)(iii) Partial Ceasing of Effect of a Basic Mark**

When the USPTO receives notification from the IB that the international registration has been restricted in part due to the partial ceasing of effect of the basic registration, the MPU will determine what, if any, goods/services remain extended to the United States and amend the listing of goods/services in the relevant pending extension of protection to reflect the changes in the notice of ceasing of effect. [15 U.S.C. §1141j\(a\)](#); [37 C.F.R. §7.30](#).

## **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. 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. [15 U.S.C. §1141h\(c\)](#); Article 5; [TMEP §1904.03\(a\)](#).

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.” Regs. Rule 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) and may not be filed in paper form under any circumstances. [37 C.F.R. §2.101\(b\)\(2\)](#); *In re Börlind Gesellschaft für kosmetische Erzeugnisse mbH*, 73 USPQ2d 2019 (TTAB 2005). Once filed, an opposition to a §66(a) application may not be amended to add to the grounds for opposition, to add to the goods or services opposed, or to add a joint opposer. [37 C.F.R. §2.107\(b\)](#). The opposition is limited to those goods, services, grounds, and named opposers set forth in the ESTTA-generated opposition form cover sheet. [37 C.F.R. §§2.104\(c\), 2.107\(b\)](#) (“The grounds for opposition, the goods or services opposed, and the named opposers are limited to those identified in the ESTTA cover sheet regardless of what is contained in any attached statement.”). *CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1962-63 (TTAB 2011); *Hunt Control Sys., Inc. v. Koninklijke Philips Elec. N.V.*, 98 USPQ2d 1558, 1561-62 (TTAB 2011). The notice of opposition must also include all fees for each party opposer to oppose the registration in all classes specified in the opposition. [37 C.F.R. §2.101\(d\)](#).

*Request for Extension of Time to Oppose*. A request for extension of time to oppose a §66(a) application must be filed through ESTTA and may not be filed in paper form under any circumstances. [37 C.F.R. §2.102\(a\)\(1\)](#).

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](#) for further information about oppositions.

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

If the mark in a §66(a) application is published for opposition and is not opposed, or survives all oppositions filed, the USPTO will issue a certificate of extension of protection and publish notice of such certificate in the *Trademark Official Gazette*. [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. [15 U.S.C. §1141i\(b\)](#). The certificate of registration will look the same as the certificate issued for registrations resulting from applications under §1 and §44 of the Trademark Act. See [TMEP §1601.01\(a\)](#).

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

A registered extension of protection always remains part of and dependent upon the international registration.

In this respect, a registered extension of protection differs from a §44 registration, which is independent from the underlying foreign registration, pursuant to [15 U.S.C. §1126\(f\)](#).

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

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

Under §72 of the Trademark Act, [15 U.S.C. §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 either: (1) party to the Madrid Protocol, or (2) a member of an intergovernmental organization that is a party to the Madrid Protocol.

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

See [TMEP §§1906.01-1906.01\(i\)](#) regarding requests to record a change of ownership in the International Register.

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

## 1904.07 Invalidation of Protection in United States

A registered extension of protection to the United States may be invalidated. See Regs. Rule 19. “Invalidation” means a decision by a competent administrative or judicial authority of the United States, revoking or cancelling the effects, in the territory of the United States, of an international registration with regard to all or some of the goods/services covered by a registered extension of protection to the United States. Regs. Rule 1(xix *bis*); *see* Article 5(6). In other words, a registration is invalidated when it is revoked or cancelled, in whole or in part, pursuant to a decision of the USPTO or by order of a federal court of the United States.

Generally, there are five reasons invalidation of a registered extension of protection to the United States may occur: (1) cancellation proceedings instituted by a third party before the Trademark Trial and Appeal Board; (2) order of a federal court of the United States; (3) failure to file an acceptable §71 affidavit or declaration; (4) holder’s voluntary surrender of the registered extension of protection; or (5) an expungement proceeding instituted by the Director upon petition or upon the Director’s initiative. *See* Regs. Rule 19. Each of these reasons is discussed below.

Invalidation may be in whole or in part, that is, it may be as to all or some of the goods/services covered by the registered extension of protection to the United States. *See* Regs. Rule 19(1)(v). In the case of partial invalidation, the USPTO will not cancel the registered extension of protection but, instead, delete the relevant goods/services from the USPTO’s electronic records for the registration. An updated registration certificate will generally not issue. *But see* [TMEP §1716.04\(e\)](#) (providing that an updated registration certificate will issue for any registration cancelled in part due to an expungement proceeding).

The holder has the same rights and remedies as the owner of a national registration issued on the Principal Register by the USPTO. [15 U.S.C. §1141i\(b\)\(2\)](#); [37 C.F.R. §7.25](#). Accordingly, the cancellation procedures mentioned above that result in an invalidation of a registered extension of protection are governed by the substantive and procedural law of the United States, and are the same as for national marks registered by the USPTO. *See Guide to International Registration*, B.II.110.100.01–02.

### 1904.07(a) Invalidation Resulting From Cancellation Due to Third-Party Challenge

Invalidation may occur due to cancellation proceedings instituted by a third party before the TTAB, under §14 of the Trademark Act, because, for instance, the mark has become generic. *See* [15 U.S.C. §1064](#). If the third party is successful and the TTAB issues an order granting the cancellation of the registered extension of protection, the USPTO will cancel the registration in due course. *See* [TMEP §1607](#) and [TBMP §§303, 307–309](#) regarding cancellation of registration.

Invalidation may also occur pursuant to an order of a federal court of the United States cancelling the registered extension of protection, under §37 of the Trademark Act. *See* [15 U.S.C. §1119](#). Such order may result from, for example, infringement proceedings involving the holder and a third party, or the disposal of the holder’s assets. The USPTO will cancel the registration pursuant to the court order. *See* [TMEP §1610](#) regarding a court order concerning a registration.

Regardless of whether by order of the TTAB or a federal court of the United States, after cancellation, the USPTO will notify the IB that the registered extension of protection to the United States has been invalidated. *See* [TMEP § 1904.07\(d\)](#) regarding the issuance of the notice of invalidation.

### **1904.07(b) Invalidation Resulting From Cancellation for Failure to File §71 Affidavit or Declaration**

Invalidation may occur due to the holder's failure to timely file and meet the requirements of an affidavit or declaration under §71 of the Trademark Act, showing use of the registered mark in commerce in the United States. See [15 U.S.C. §1141k](#); [37 C.F.R. §§7.36–7.40](#); [TMEP §§1613, 1613.04–1613.05, 1904.10](#). Failure to timely file the §71 affidavit or declaration is a statutory requirement, and the Director has no authority to waive the deadline for filing. See [15 U.S.C. §1141k](#); [TMEP §1613.04](#). The USPTO typically waits until about one month after the expiration of the grace period before automatically cancelling the registered extension of protection, in order to avoid inadvertent cancellation of a registration due to a delay in entering a timely filed §71 affidavit or declaration into the USPTO records.

If a timely filed §71 affidavit or declaration does not meet the requirements for filing and is found unacceptable, the USPTO will issue an Office action notifying the holder of the refusal and stating the reasons the affidavit or declaration is deficient. Failure to timely respond to the Office action or failure to timely correct the deficiencies stated in the Office action will result in cancellation of the registered extension of protection to the United States. [37 C.F.R. §7.39](#); [TMEP §1613.15–1613.17\(c\)](#).

Once the registration is cancelled, the USPTO will notify the IB that the registered extension of protection to the United States has been invalidated. See [TMEP § 1904.07\(d\)](#) regarding the issuance of the notice of invalidation.

In a registered extension of protection for which an acceptable §71 affidavit or declaration was not filed, if the holder seeks to expedite cancellation, the holder may request in writing that the USPTO expedite the processing of the cancellation of the registered extension of protection. The request should be signed by the holder, someone with legal authority to bind the holder (e.g., a corporate officer or general partner of a partnership), or a qualified U.S. attorney (see [TMEP §602](#)), and should specifically state that an acceptable §71 affidavit or declaration was not filed on or before the end of the grace period. Such a request should be directed to the Post Registration Section; if it is sent to the examining attorney, the examining attorney should forward it to the Supervisor of the Post Registration Section.

See [TMEP §§1613–1613.19](#) for detailed information about §71 affidavits or declarations.

### **1904.07(c) Invalidation Resulting From Voluntary Surrender of Registered Extension of Protection**

Invalidation may occur when the holder of a registered extension of protection voluntarily surrenders the registration for cancellation under §7(e) of the Trademark Act. [15 U.S.C. §1057\(e\)](#). If the registered extension of protection is surrendered in its entirety, the registration will be cancelled in due course. If an acceptable §71 affidavit or declaration is filed for less than all the goods/services in the registered extension of protection, this is regarded as a surrender of the registration as to the good(s)/service(s) that are omitted. The relevant good(s)/service(s) will be deleted from the USPTO's electronic records for the registration. An updated registration certificate will not issue.

After cancellation, the USPTO will notify the IB that the registered extension of protection to the United States has been invalidated. See [TMEP § 1904.07\(d\)](#) regarding the issuance of the notice of invalidation. See [TMEP §1608](#) for information about surrender of registration for cancellation.

### **1904.07(d) Invalidation Resulting from Expungement Proceedings**

Invalidation may occur due to expungement proceedings instituted by the Director upon petition or upon the Director's initiative, under Section 16A of the Trademark Act, because the mark has never been used in commerce on or in connection with some or all of the goods or services in the registration. *See* [15 U.S.C. §1066a](#). If the Director issues an order cancelling the registered extension of protection, the USPTO will cancel the registration in due course. *See* [TMEP §1716.04\(e\)](#) regarding cancelling the registration.

After cancellation, the USPTO will notify the IB that the registered extension of protection to the United States has been invalidated. *See* [TMEP §1904.07\(e\)](#) regarding the issuance of the notice of invalidation.

### **1904.07(e) Issuance of Notice of Invalidation to the International Bureau**

Once the registered extension of protection has been cancelled by the USPTO, the Director shall issue to the IB a notice of invalidation of the registered extension of protection to the United States. *See* Article 5(6). The USPTO must notify the IB of the following information in the notice of invalidation: the administrative or judicial authority (i.e., the Director or federal court) that cancelled the registered extension of protection, the date on which the invalidation was pronounced and the effective date of the invalidation, and the fact that it is no longer subject to appeal; the number of the international registration and the name of the holder; and, if the invalidation does not concern all the goods/services, state those that are concerned (indicating either the goods/services that are no longer covered, or those that remain covered). Regs. Rule 19(1).

If the holder seeks to expedite the issuance of the notice of invalidation to the IB, the holder must file a petition to the Director for an International Application/Registration under 37 C.F.R. §2.146. *See* [TMEP §1702](#). The submission must include a request that the USPTO expedite the processing of the notice of invalidation of the registered extension of protection. The request must be signed by the holder, someone with legal authority to bind the holder (e.g., a corporate officer or general partner of a partnership), or a qualified U.S. attorney (*see* [TMEP §602](#)).

Upon receipt of the notice of invalidation from the USPTO, the IB will record the invalidation in the International Register, inform the holder, and inform the USPTO of the date on which the invalidation was recorded in the International Register. Regs. Rule 19(2).

After a registered extension of protection to the United States has been cancelled and inscribed in the International Register as invalidated, the holder may submit a subsequent designation seeking protection in the United States of the same mark for all or some of the goods/services in the international registration. The IB will not process a subsequent designation until the notice of invalidation has been recorded in the International Register. The holder may submit a subsequent designation prior to the recordal of the invalidation and request that it take effect immediately after the recording of the invalidation in the International Register. Regs. Rule 24(3)(c)(ii). Upon notification, the USPTO will examine the subsequent designation to determine if protection may be granted.

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

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

See [TMEP §1905](#) regarding renewal of international registrations in general, and [§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, to the extent applicable, the international registration and notify the USPTO of the cancellation. Article 6(4). See [TMEP §1902.09](#).

Thus, an Article 6(4) cancellation is a cancellation, in whole or in part, of the international registration by the IB at the request of an Office of Origin. Thereafter, the USPTO will cancel in whole, or restrict in part, the corresponding §66(a) registered extension of protection, or abandon, in whole or in part, the corresponding §66(a) application.

In this situation, the holder of the international registration may “transform” the goods and/or services to which the cancellation applies in the corresponding pending or registered §66(a) extension of protection to the United States into an application under §1 or §44 of the Trademark Act for registration of the same mark for any or all of the cancelled, restricted, or abandoned goods/services that were covered by the extension of protection. The effective filing date of the new §1 or §44 application is the international registration date, the date of recordal of the extension of protection if based on subsequent designation, or the date of priority of the request for extension of protection with the IB, whichever is applicable. [15 U.S.C. §1141j\(c\)](#); Article 9 *quinquies*.

A request for transformation must be filed within three months after the date on which the Article 6(4) cancellation was processed by the IB. [15 U.S.C. §1141j\(c\)](#); Article 9 *quinquies*(i). The deadline for filing a request for transformation is a statutory requirement. The Director cannot extend, suspend, or waive this statutory requirement for any reason, even for an extraordinary situation. See *In re Mother Tucker's Food Experience (Can.) Inc.*, 925 F.2d 1402, 1405, 17 USPQ2d 1795, 1797-98 (Fed. Cir. 1991); *In re Media Cent. IP Corp.*, 65 USPQ2d 1637, 1639 (Dir USPTO 2002); [TMEP §§1604.04, 1708](#).

An extension of protection can be transformed only in the event of an Article 6(4) cancellation of the international registration, that is, at the request of the Office of Origin 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, in whole or in part, at the request of the holder, or is cancelled, in whole or in part, for any other reason. [15 U.S.C. §1141j\(c\)](#); [37 C.F.R. §7.31](#); Article 9 *quinquies*. See [TMEP §1904.09\(a\)](#) for the requirements for transformation.

### 1904.09(a) Requirements for Transformation

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

- (1) The serial number or registration number of the extension of protection to the United States (i.e., the §66(a) application or registered extension of protection);
- (2) The name and address of the holder of the international registration;
- (3) The goods and/or services to be transformed, if other than all the goods and/or services that have been cancelled;

- (4) 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
- (5) An email address for receipt of correspondence from the USPTO.

[37 C.F.R. §7.31\(a\)](#).

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

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

Generally, a request for transformation must be filed electronically using TEAS by clicking on "Madrid Protocol forms" at <https://teas.uspto.gov>. See [37 C.F.R. §§2.23\(a\)](#), [7.25\(a\)](#); [TMEP §301.01](#). See [TMEP §301.02](#) regarding limited exceptions for paper submissions, [§305](#) regarding mailing permitted paper filings to the USPTO, and [§307](#) regarding hand delivery of documents to the USPTO.

Requests for transformation may not be submitted by email or fax and, if submitted by such means, will not be accorded a date of receipt. [37 C.F.R. §2.195\(c\)](#).

### **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 Trademark database (in the “Transformed To” field). Similarly, a notation of the serial number of the cancelled request for extension of protection appears in the Trademark database for the new transformed application (in the “Transformed From” field).

The “transformed” application will have the same filing date as the cancelled extension of protection, that is: (1) the international registration date, if the request for extension of protection to the United States was made in the international application; or (2) the date of recordal of the subsequent designation with the IB, if the request for extension of protection to the United States was made in a subsequent designation. If the extension of protection was entitled to priority under §67 of the Trademark Act, [15 U.S.C. §1141g](#), the new application is entitled to the same priority.

When a cancelled extension of protection is transformed into a new application under §1 or §44, the examining attorney must conduct a new search to determine whether any later-filed applications for conflicting marks were approved for publication or registration and place the search strategy in the record. If a later-filed application has been approved, the examining attorney should inform the examining attorney who approved the later-filed application of the transformed application, so that appropriate action may be taken. If the later-filed application has been published, the examining attorney handling that application should request jurisdiction (*see* [TMEP §1504.04\(a\)](#)) and suspend the application pending disposition of the transformed

application. If a later-filed application for a conflicting mark has matured into registration, the examining attorney must refuse registration of the transformed application under §2(d), even though the application for the registered mark was filed after the transformed application.

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

If it is unclear from the transformation request, the examining attorney must require the holder to clarify the goods/services to be transformed, if other than all the goods/services that were covered by the cancelled extension of protection. [37 C.F.R. §7.31\(a\)\(3\)](#).

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

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

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

Under §71 of the Trademark Act, [15 U.S.C. §1141k](#), a registered extension of protection to the United States will be cancelled if the holder of the international registration fails to periodically file affidavits of use in commerce or excusable nonuse. [37 C.F.R. §7.36\(b\)](#). See [TMEP §1613](#) for further information.

#### **1904.11 Incontestability**

Under §73 of the Trademark Act, [15 U.S.C. §1141m](#), if a holder files an affidavit that meets the requirements of §15 of the Trademark Act, a registered extension of protection to the United States may become “incontestable”. The period of continuous use on which an affidavit of incontestability may be based may begin no earlier than the date of issuance of the registered extension of protection, unless the holder owns a prior U.S. registration of the same mark for the same goods/services/collective membership organization. [15 U.S.C. §1141m-n](#). See [TMEP §§1605–1605.06](#) 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: (1) are owned by the same person; (2) identify the same mark; and (3) list the same goods/services/collective membership organization, then the extension of protection shall have the same rights as those accrued to the U.S. national registration at the time the certificate of extension of protection issues. [15 U.S.C. §1141n](#); [37 C.F.R. §7.28\(a\)](#); Article 4 *bis*. If all of the goods/services/collective membership organization in the national registration are covered by the listing of goods/services/collective membership organization in the extension of protection, they are considered to be the same for the purposes of replacement.

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 or pending extension of protection files a request that it do so. If the request to note replacement is filed in reference to a pending request for extension of protection, the request will not be processed until the extension of protection registers.

A request to note replacement of a U.S. national registration with a registered extension of protection must include:

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

[37 C.F.R. §7.28\(b\)](#). The fee is non-refundable.

The holder can file a request to note replacement of more than one U.S. national registration based on a single registered or pending extension of protection provided that all of the goods/services listed in each U.S. national registration are covered by the listing of goods/services in the relevant extension of protection. The request to note replacement will be denied if the U.S. national registration includes goods/services not covered by the relevant extension of protection. Therefore, filers should ensure that any goods/services that exceed the scope of the relevant extension of protection are deleted from the U.S. national registration before filing the request to note replacement. See [TMEP §1609.03](#) regarding amending the identification of goods/services in a registration.

If the original U.S. national registration is active on the date the registration based on the request for extension of protection issues, the USPTO will accept a request to note replacement that is not filed until after the U.S. national registration is cancelled or expired. However, if the original U.S. national registration is in the grace period for filing an affidavit of continued use under §8 or a combined affidavit of continued use and renewal under §§8 and 9, [15 U.S.C. §§1058, 1059](#), at the time the registered extension of protection issues, the USPTO will not note replacement unless the required affidavit is filed and accepted.

“Replacement” does not invalidate the U.S. national registration. The U.S. 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 U.S. national registration.

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

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

### 1904.13(a) Limited Amendments to Registered Extension of Protection

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

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

The mark in a registered extension of protection cannot be amended. See [TMEP §§1609.02, 1906.01\(i\)](#).

See also [TMEP §§1906.01-1906.01\(i\)](#) regarding requests to record changes at the IB.

### 1904.13(b) Corrections to Registered Extensions of Protection

Generally, all requests to record changes to an international registration must be filed at the IB, because an extension of protection of an international registration remains part of the international registration even after registration in the United States. However, in the limited circumstance where the holder of an international registration makes a mistake in a document filed during prosecution in the USPTO that affects only the extension of protection to the United States, the registrant may request correction of the error pursuant to [37 C.F.R. §2.175](#). For example, if there was a minor typographical error in an amendment to the identification of goods in a §66(a) application, and the mark registered with such an error, the owner of the registration could request correction. If the USPTO grants the request, the USPTO will notify the IB of the change to the extension of protection to the United States.

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

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

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

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

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

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

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

Upon receipt of a correction that would affect the rights deriving from the international registration, the USPTO is afforded a new period of 18 months within which to notify the IB of any newly arising grounds for refusal. To the extent any requirements or refusals are applicable to the corrected data, the examining attorney shall issue an Office action, which will be forwarded by the MPU to the IB, as required by Section 68(c)(1), [15 U.S.C. §1141h\(c\)\(1\)](#), and Rule 28(3) of the Regulations. The examining attorney must contact the MPU upon issuance of such an action so that it will be forwarded as required.

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

## **1904.15 Notification of Restrictions to Goods/Services with Respect to a Registered Extension of Protection**

### **1904.15(a) Limitations to Goods/Services**

The MPU reviews all limitations and enters any amendments to the listing of goods and services into the Trademark electronic record, as appropriate. If a limitation requires changes to the record, MPU ensures that an updated registration certificate is issued to the holder.

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

See also [TMEP §1904.02\(f\)\(i\)](#) regarding limitations in general, [§1904.03\(g\)\(i\)](#) regarding limitations of the goods/services in pending requests for extension of protection (§66(a) applications), and [§1906.01\(e\)](#) for information about filing a request to record a limitation with the IB.

### **1904.15(b) Partial Cancellation of an International Registration**

When the USPTO receives notification from the IB that the international registration has been restricted in part due to a partial cancellation, the MPU will determine what, if any, goods/services remain extended to the United States and delete the canceled goods/services from the U.S. registration. The USPTO will then issue an updated registration certificate. [15 U.S.C. §1141j\(a\)](#); [37 C.F.R. §7.30](#).

See also [TMEP §1904.02\(f\)\(iii\)](#) regarding partial cancellations in general, [§1904.03\(g\)\(ii\)](#) regarding partial cancellation of the goods/services in pending requests for extension of protection (§66(a) applications), and [§1906.01\(e\)](#) for information about filing a request to record a cancellation with the IB.

### **1904.15(c) Partial Ceasing of Effect of an International Registration**

When the USPTO receives notification from the IB that the international registration has been restricted in part due to a partial ceasing of effect of the basic registration, the MPU will determine what, if any, goods/services remain extended to the United States and delete the canceled goods/services from the U.S. registration. The USPTO will then issue an updated registration certificate. [15 U.S.C. §1141j\(a\)](#); [37 C.F.R. §7.30](#). See also [TMEP §1904.02\(f\)\(iv\)](#) regarding partial ceasings of effect in general and [§1904.03\(g\)\(iii\)](#) regarding partial ceasings of effect in pending requests for extension of protection (§66(a) applications).

## **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), 7(1). Renewal of international registrations must be made at the IB, in accordance with Article 7 and Regulations Rules 29-31. There is a renewal form, form MM11, on the IB website at <https://www.wipo.int/madrid/en/forms/>.

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

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

See [TMEP §1614](#) regarding renewal of a registered extension of protection to the United States.

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

Information about communicating directly with the IB is available on the WIPO website at <https://www.wipo.int/madrid/en/>. The IB can be contacted by telephone at 41 22 338 8686 or by filing an inquiry using the Contact Madrid form at <https://www.wipo.int/madrid/en/>.

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

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

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

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

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

[37 C.F.R. §7.22](#).

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

The IB will record a change in ownership by assignment, merger, court decision, or operation of law at the request of the holder, the Contracting Party of the holder, or an interested person. Article 9; Regs. Rule 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, 7.23](#). Form MM5 is available on the IB website at <https://www.wipo.int/madrid/en/forms/> for that purpose. The IB does not require copies of assignments or other supporting documents. See [TMEP §1906.01\(a\)\(i\)](#) regarding the limited circumstances in which a request to record a change in ownership may be filed with the IB through the USPTO.

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

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

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

See [37 C.F.R. §7.23](#).

No other requests to record changes of ownership may be filed through the USPTO. [37 C.F.R. §§7.22, 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 industrial or commercial establishment in the United States. Where an assignee's address is not in the United States, the assignee must provide the address of its U.S. domicile or establishment;
- A statement, signed and verified or supported by a declaration under [37 C.F.R. §2.20](#), that, for the request to record the assignment, either the assignee could not obtain the assignor's signature because the holder no longer exists, or after a good-faith effort, the assignee could not obtain the assignor's signature;
- An indication that the assignment applies to the designation to the United States or an international registration that is based on a U.S. application or registration;
- 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 complete an electronic copy of the official IB form MM5 available on the IB website at <https://www.wipo.int/madrid/en/forms/>. The IB will not accept requests that are not submitted on the official IB form. The form may not be handwritten. Regs. Rule 25(1)(a); Admin. Instrs. §6(a).

The holder should attach the electronic copy of the completed form to the TEAS Petition to the Director for an International Application/Registration form. For permitted paper filers (*see* [TMEP §1902.02\(a\)](#)), complete the MM5 form online, print the completed form and submit it to the USPTO by mail, hand delivery, or courier service. 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. The holder may mail the request using the first-class mail service of the USPS to the address in [TMEP §305.01](#). See [TMEP §§305.02-305.02\(h\)](#) regarding certificate of mailing procedures and [§§305.03-305.03\(e\)](#) regarding Priority Mail Express® procedures. Alternatively, the holder may deliver the request by hand or courier. See [TMEP §307](#) regarding hand delivery of documents to the USPTO.

Requests to record changes of ownership may not be submitted by fax or email and, if submitted by such means, will not be accorded a date of receipt. [37 C.F.R. §2.195\(c\)](#).

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. Regs. Rule 26(1). The holder must file a response to any notice of irregularity with the IB; the response may not be filed through the USPTO. [37 C.F.R. §7.23\(d\)](#).

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

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

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

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

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

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

### **1906.01(a)(iv) Dividing an International Registration After Change of Ownership with Respect to Some but Not All of the Goods/Services**

When ownership of an international registration changes with respect to some but not all of the goods/services for all designated Contracting Parties, the IB will create a separate new international registration for the goods/services that have been transferred, and notify the USPTO accordingly. See the IB's *Guide to International Registration*, B.II.84.67.01.

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

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

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

Under Regulations Rule 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 Regulations Rule 20(1)(b), the office of any designated Contracting Party may inform the IB that the holder's right of disposal has been restricted in the territory of that Contracting Party. Examples of restrictions on the holder's right to dispose are security interests and court orders concerning the disposal of the assets of the holder.

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

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

[37 C.F.R. §7.24\(a\)](#).

All other requests to record restrictions must be filed with the IB. [37 C.F.R. §§7.22, 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 U.S. 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, signed and verified or supported by a declaration under [37 C.F.R. §2.20](#), that, for the request to record the restriction, or release of the restriction, either the holder of the international registration could not obtain the signature of the party restricting the holder's right of disposal because the party restricting the holder's right of disposal no longer exists, or, after a good-faith effort, the holder of the international registration could not obtain the signature of the party restricting the holder's right of disposal;
- 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 or an international registration that is based on a U.S. application or registration; and
- The USPTO transmittal fee required by [37 C.F.R. §7.6](#).

[37 C.F.R. §7.24\(b\)](#).

The USPTO currently does not have a TEAS form available for requests to record a restriction of a holder's rights of disposal. A holder must complete an electronic copy of the official IB form MM19 available on the IB website at <https://www.wipo.int/madrid/en/forms/>. The IB will not accept requests that are not presented on the official IB form. The form may not be handwritten. Regs. Rule 25(1)(a); Admin. Instrs. §6(a).

The holder should attach the electronic copy of the completed form to the TEAS Petition to the Director for an International Application/Registration form. For permitted paper filers (*see* [TMEP §1902.02\(a\)](#)), complete the MM19 form online, print the completed form and submit it to the USPTO by mail, hand delivery, or courier service. The holder may mail the request using the first-class mail service of the USPS to the address in [TMEP §305.01](#). See [TMEP §§305.02-305.02\(h\)](#) regarding certificate of mailing procedures and [§§305.03-305.03\(e\)](#) regarding Priority Mail Express® procedures. Alternatively, the holder may deliver the form by hand or courier. See [TMEP §307](#) regarding hand delivery of documents to the USPTO.

Requests to record restrictions or releases may not be submitted by fax or email and, if submitted by such means, will not be accorded a date of receipt. See [37 C.F.R. §2.195\(c\)](#).

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. Regs. Rule 26(1). The holder must file a response to any notice of irregularity with the IB; the response may not 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](#). The request may be filed using Form MM9 on the IB website at <https://www.wipo.int/madrid/en/forms/>. Article 9 *bis*; Regs. Rule 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](#). The request may be filed using Form MM10 on the IB website at <https://www.wipo.int/madrid/en/forms/>.

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

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

Requests to record a limitation, cancellation, or renunciation of an international registration must be filed with the IB; they cannot be filed through the USPTO. [37 C.F.R. §7.22](#). The request may be filed using forms for such requests on the IB website at <https://www.wipo.int/madrid/en/forms/>. Under Article 9 *bis*, a holder may record the following restrictions:

- Limitation of some or all of the goods/services with respect to some or all of the designated Contracting Parties (Regs. Rule 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 (Regs. Rule 25(1)(a)(v));
- Renunciation with respect to some but not all of the designated Contracting Parties for all the goods/services (Regs. Rule 25(1)(a)(iii)).

See [TMEP §1904.02\(f\)\(i\)](#) regarding limitations in general, [§1904.03\(g\)\(i\)-\(ii\)](#) regarding limitations or partial cancellations in pending requests for extension of protection (§66(a) applications), and [§1904.15\(a\)–\(b\)](#) regarding limitations or partial cancellations in registered extensions of protection to the United States (§66(a) registrations).

### **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. Regs. Rule 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 Regulations Rules 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. Regs. Rule 28(3).

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

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

Where the same party is the holder of two or more international registrations of the same mark due to a partial change in ownership, that party may request the IB to record a merger of the registrations. Regs. Rule 27*ter* (1). 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 Regulations Rule 20*bis* (1), a holder may file a request to record a license, for amendment of the recording of a license, or for cancellation of the recording of a license with the IB; it cannot be filed through the USPTO. [37 C.F.R. §7.22](#). The request may be filed using forms for such requests on the IB website at <https://www.wipo.int/madrid/en/forms/>. 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. Regs. Rule 20 *bis*(5).

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

*Mark in International Registration Cannot Be Changed.* There is no provision for a mark to be amended in any way, at any time, even if the mark in the basic application or basic registration changes. *Guide to International Registration*, B.II.93.81.02.

*Goods/Services in International Registration Cannot be Expanded.* It is not possible to expand the list of goods/services, even if the added goods/services were listed in the basic application or registration. *Guide to International Registration*, B.II.93.81.03.