

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

**FOR FURTHER INFORMATION CONTACT:**

Cheryl L. Black, Office of the Commissioner for Trademarks, by telephone at (703) 308-8910, extension 153, by e-mail to [cheryl.black@uspto.gov](mailto:cheryl.black@uspto.gov), or by facsimile at (703) 872-9292.

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

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

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

**Filings under Madrid Protocol**

*Background*

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

international application must designate one or more Contracting Parties in which an extension of protection of the international application is sought.

The international application must be submitted through the trademark office of the Contracting Party in which the basic application or registration is held (office of origin). The office of origin must certify that the information in the international application corresponds with the information in the basic application or registration, and transmit the international application to the IB.

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

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

*Discussion of Specific Rules Changed or Added*

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

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

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

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

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

*Fees*

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

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

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

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