

International Applications Originating from the United States

The requirements for granting a date of receipt to an international application submitted through the Office are set forth in proposed § 7.11(a). The Office proposes to require the submission of an international application through the Trademark Electronic Application System (TEAS). An international application must identify at least one basic application or registration. The international application may be based on more than one basic U.S. application and/or registration, provided that the owner and the mark are the same for each basic U.S. application or registration.

Under section 61 of the Act, and proposed § 7.11(a)(10), the international applicant must specify that applicant is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States.

Proposed § 7.11(a)(3) requires a reproduction of the mark in the international application that is identical to the mark in the basic application or registration and that meets the drawing requirements of § 2.52. If the mark in the basic application or registration is depicted in black and white, the reproduction of the mark in the international application must be black and white. If the mark in the basic application or registration is in color, the mark in the international application must be in color. If a mark for which there is a claim of color is depicted in black and white in the basic application or registration, the international application must include both a black and white reproduction of the mark and a color reproduction of the mark.

Under proposed §§ 7.11(a)(4) and 7.12, if color is claimed as a feature of the mark, the same color claim must be made in the international application. If color is not claimed as a feature of the mark in the basic application or registration, the international application may not include a claim of color.

Under proposed § 7.11(a)(6), if the mark in the basic application or registration is a three-dimensional mark, sound mark, collective mark or certification mark, the international application must indicate the type of mark.

Proposed § 7.11(a)(7) requires a list of goods and/or services in the international application that is identical to or narrower than the list of goods and/or services in the basic application or registration, and is

classified according to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. The applicant may omit goods and/or services from the international application as long as the omission does not broaden the scope of the goods or services identified in the basic application or registration.

Under proposed § 7.11(a)(8), an international applicant must designate at least one Contracting Party in which it seeks an extension of protection.

Under proposed § 7.11(a)(9), the international applicant must pay the U.S. certification fee and the fees required by the IB for all classes and all designated Contracting Parties at the time of submission.

Proposed § 7.13 sets forth the requirements for certifying and forwarding an international application to the IB. Under proposed § 7.13(a), if an international application meets the requirements of proposed § 7.11(a), the Office will grant a date of receipt and certify that the information contained in the international application corresponds to the basic application or registration. The Office will forward the international application electronically to the IB.

Proposed § 7.13(b), states that if the Office cannot certify that the information contained in the international application corresponds with the information in the basic application or registration, the Office will notify the applicant that the international application cannot be certified. Any IB fees submitted through the Office will be refunded; however, the Office will not refund the certification fee.

Correcting Irregularities in International Application—Proposed § 7.14

The IB will notify both the international applicant and the Office of any irregularities in the international application. The international applicant is responsible for correcting the irregularities before the end of the response period set forth in the IB's notice to avoid abandonment of the international application. Under rule 11 of the Common Regulations, there are some irregularities that must be corrected through the Office and some that must be corrected directly with the IB. Proposed § 7.14 sets forth the types of irregularities that must be corrected through the Office and the procedures for responding to these irregularities through the Office.

Under proposed § 7.14(d), the Office would require that applicants use TEAS to correct irregularities through the

Office. To assist the Office in its efforts to timely transmit the response or fee to the IB, applicants should submit their responses or fee as early as possible, at least one month prior to the end of the IB's response period.

Irregularities in Classification and Identification of Goods/Services

Rules 12 and 13 of the Common Regulations provide that the IB will not consider a response to irregularities in classification and identification of goods and/or services that is not submitted through the office of origin. Proposed § 7.14(b) provides that an international applicant must respond to irregularities in classification and identification of goods and/or services through the Office. The Office will forward an applicant's response to the IB; however, the Office will not review the response or respond to an irregularity on behalf of an applicant.

Additional Fees for Correcting Irregularities in an International Application

The IB may require an international applicant to pay additional fees as a result of irregularities in the classification of goods or services, or because the international fees submitted with the application were insufficient. Under proposed § 7.14(c), the applicant may pay the additional fees directly to the IB or through the Office. The international applicant must correct the fee irregularities before the end of the response period set forth in the IB's notice, or the international application will abandon at the IB. Under proposed § 7.14(d), if the international applicant is paying the additional fees through the Office, the fees must be paid through TEAS and should be submitted at least one month before the end of the IB's response period.

Other Irregularities

Under proposed § 7.14(e), all other irregularities in the international application must be corrected directly at the IB. Failure to correct certain irregularities by the end of the IB's response period will result in the abandonment of the international application.

Subsequent Designations—Proposed § 7.21

Section 64 of the Act and proposed § 7.21 permit the holder of an international registration to submit a subsequent designation through the Office, if the holder is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States. The holder also has