

the option of filing the subsequent designation directly with the IB.

Under proposed § 7.21, if the subsequent designation is submitted through the Office, it must be submitted through TEAS and include the international registration number, the name and address of the holder of the international registration, one or more Contracting Parties in which an extension of protection is sought, and a list of goods and/or services that is identical to or narrower than the goods and/or services listed in the international registration. The holder can omit goods and/or services listed in the international registration as long as the omission does not broaden the scope of the goods or services identified in the international registration. The holder must include the transmittal fee and all subsequent designation fees required by the IB at the time of submission. The Office is not required to certify the subsequent designation.

The IB will review the subsequent designation for completeness before forwarding the request for extension of protection to the designated Contracting Parties. If there are any irregularities in the subsequent designation, the IB will notify both the holder and the Office. The holder must file any responses to the notice directly with the IB. The Office will not forward any responses to irregularities in a subsequent designation to the IB, even if the subsequent designation was submitted through the Office.

Recording Changes to International Registration

Most changes to international registrations can be recorded directly with the IB. Proposed § 7.22(a) requires that all requests to record changes to an international registration be filed at the IB, except in the limited circumstances in which they must be submitted through the Office, as set forth in proposed §§ 7.23 and 7.24.

Proposed § 7.22(b) provides that assignments or restrictions of a holder's rights of disposal of an international registration must be recorded by the IB, and that section 10 of the Act and part 3 of this chapter are not applicable to such assignments or restrictions.

Proposed § 7.22(c) provides that when the Office is notified by the IB of an assignment or restriction of a holder's right to dispose of an international registration with an extension of protection to the United States, the Office will take note of the assignment or restriction in its records. The Assignment Services Division of the Office will record only assignments and restrictions of extensions of protection

to the United States that have been recorded at the IB.

Proposed § 7.23 sets forth the limited circumstances in which a request to record an assignment of an international registration may be submitted through the Office, and the requirements for submitting these requests. Under proposed § 7.23, the Office will forward a request to record an assignment of an international registration to the IB only if: (1) The request is submitted by an assignee who is a national of, is domiciled in or has a real and effective commercial or industrial establishment in the U.S.; and (2) the assignee cannot obtain the assignor's signature for the request to record the assignment.

Proposed § 7.24 sets forth the limited circumstances in which a request to record a restriction of a holder's right to dispose of an international registration may be submitted through the Office, and the requirements for submitting these requests. Under proposed § 7.24, the Office will forward a request to record a restriction of a holder's right of disposal of an international registration (usually a security interest) only if: (1) 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; (2) the party holding the restriction is a national of, is domiciled in or has a real and effective commercial or industrial establishment in the U.S.; and (3) the signature of the holder of the international registration cannot be obtained for the request to record the restriction. The Office proposes to charge a fee for transmitting a request to record an assignment or restriction to the IB.

Requests for Extension of Protection to the United States

Under section 65 of the Act, the holder of an international registration may request an extension of protection of the international registration to the United States, provided the international registration is not based on a U.S. basic application or registration.

The holder may make a request for extension of protection to the United States either in the international application or in a subsequent designation filed with the IB. Section 66(a) of the 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. The IB will certify that the request for extension of protection contains a declaration of bona fide intention to use the mark in commerce when it forwards the request to the Office. The declaration will remain as part of the

international registration on file at the IB.

The IB will forward the request for extension of protection to the Office electronically. The holder cannot file a request for extension of protection to the United States directly with the Office.

Proposed § 7.25 provides that for purposes of examination and opposition, a request for an extension of protection to the United States will be treated as an application for registration based on an extension of protection of an international registration under section 66(a) of the Act; and that references to "applications" and "registrations" in part 2 of this chapter include extensions of protection to the United States. With the exception of §§ 2.130–2.131, 2.160–2.166, 2.168 and 2.181–2.186, all the sections in part 2 apply to a request for extension of protection to the United States.

Under proposed § 7.26, the filing date of a request for extension of protection to the United States for purposes of examination in the Office 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 the IB recorded the subsequent designation, if the request for extension of protection to the United States was made in a subsequent designation. Under section 66(b) of the Act, the filing date of the extension of protection will be considered the date of constructive notice pursuant to section 7(c) of the Act.

Under section 67 of the Act and proposed § 7.27, the holder of an international registration may claim priority under Article 4 of the Paris Convention for the Protection of Industrial Property if: (1) the request for an extension of protection contains a claim of priority; and (2) the international registration date or the date of recordal of the subsequent designation requesting an extension of protection to the United States is no later than 6 months after the filing date of the application that formed the basis of the claim of priority.

Replacement

Under section 74 of the Act and proposed § 7.28(a), a registered extension of protection to the United States has the same rights as a previously issued U.S. registration if: (1) both registrations are owned by the same person and identify the same mark; and (2) the goods/services in the previously issued U.S. registration are covered by the registered extension of protection. Under proposed § 7.28(b), the holder of a pending or registered