

extension of protection may request that the Office note in its records replacement of the earlier U.S. registration by the extension of protection. The Office proposes to require a fee to note replacement.

Under proposed § 7.29, the replaced U.S. registration will remain in force, unless cancelled, expired or surrendered, as long as the owner files affidavits or declarations of use or excusable nonuse under section 8 of the Act and renews the registration under section 9 of the Act.

Effect of Cancellation or Expiration of International Registration on Extension of Protection

Under section 70 of the Act and proposed § 7.30, the Office will cancel a pending or registered extension of protection to the United States if the IB notifies the Office of the cancellation or expiration of the corresponding international registration, in whole or in part.

Transformation

Under section 70(c) of the Act and proposed § 7.31(a), if an international registration is cancelled by the IB at the request of the office of origin under Article 6(4) of the Madrid Protocol (due to the cancellation or expiration of the basic application or registration), the holder of the international registration may file a request to transform the corresponding extension of protection to the United States into an application under section 1 or 44 of the Act. The requirements for transformation are set forth in proposed § 7.31(b).

The holder of an international registration must file the request for transformation through TEAS within 3 months of the cancellation date of the international registration. The request must include an application filing fee for at least one class of goods and/or services.

Under proposed § 7.31(c), if a request for transformation contains all the elements in § 7.31(b), the cancelled extension of protection to the United States will be transformed into an application under section 1 or 44 of the Act. The application will be accorded the same filing date and same priority (if any) as the cancelled extension of protection to the United States. The application resulting from the transformation will be examined as a new application under part 2 and, if approved for publication, published for opposition. The application must meet all the requirements of the Act and rules for an application under section 1 or section 44 of the Act.

Under proposed § 7.31(e), if the holder does not meet the requirements of § 7.31(b), the Office will not process the request for transformation.

Maintaining an Extension of Protection to the United States

Section 71 of the Act and proposed § 7.36 require a holder of an international registration with a registered extension of protection to the United States to file an affidavit or declaration of use in commerce or excusable nonuse during the following time periods: (1) between the fifth and sixth year after registration; and (2) within the six-month period before the end of every ten-year period after the date of registration, or upon payment of a grace period surcharge, within the three-month grace period immediately following.

Under proposed § 7.41, renewal of an international registration must be made directly with the IB. A request for renewal of an international registration cannot be submitted through the Office. Renewal of international registrations is governed by Article 7 of the Madrid Protocol and Rules 29–31 of the Common Regulations. The term of an international registration is ten years, and it may be renewed for ten years upon payment of the renewal fee.

Amendment to Part 2 Rules

If an international registration is not renewed, the registration will lapse, and the IB will notify the Office. Pursuant to section 70(b) of the Act, the Office will cancel the extension of protection to the United States.

There is no requirement in the MPIA that the holder of a registered extension of protection to the United States renew the extension of protection in the Office under section 9 of the Act.

In addition to the new rules added as part 7 of 37 CFR, the Office proposes to amend rules and add new rules to part 2 of 37 CFR to bring the rules of practice in trademark cases into conformance with the MPIA and to set forth the requirements for examination of, registration of and proceedings before the Trademark Trial and Appeal Board relating to extensions of protection to the United States.

The Office proposes to amend rules 2.2, 2.11, 2.17, 2.18, 2.19, 2.21, 2.33, 2.34, 2.35, 2.37, 2.47, 2.51, 2.52, 2.65, 2.66, 2.72, 2.73, 2.75, 2.84, 2.101, 2.102, 2.104, 2.105, 2.107, 2.111, 2.112, 2.113, 2.118, 2.123, 2.127, 2.128, 2.130, 2.131, 2.142, 2.145, 2.146, 2.151, and 2.171; and to add rules 2.53, 2.54, and 2.126.

The Office proposes to amend § 2.2 to add definitions of “ESTTA” (Electronic System for Trademark Trials and

Appeals), “international application,” and “Office.”

The Office proposes to revise § 2.11 and its heading to indicate that representation before the Office is governed by § 10.14 of this chapter. It is redundant to have provisions governing representation before the Office in both parts 2 and 10.

The Office proposes to reword § 2.17(b) and to add a reference to § 10.14(b).

The Office proposes to amend § 2.18 to clarify procedures for establishing a correspondence address in trademark cases. The proposed amendment does not change current practice.

The Office proposes to amend § 2.19(a) to clarify procedures for sending correspondence after a power of attorney is revoked, and to amend § 2.19(b) to indicate that the procedures for permissive withdrawal of an attorney are governed by § 10.40.

The Office proposes to amend § 2.21(a) to indicate that § 2.21 sets forth the minimum filing requirements only for applications under sections 1 and 44 of the Act. The filing date of an application under section 66(a) of the Act is governed by section 66(b) of the Act and proposed § 7.26.

The Office proposes to amend § 2.33 by adding a new paragraph (e), stating that in an application under section 66(a) of the Act, the verified statement is part of the international registration on file at the IB.

The Office proposes to remove §§ 2.34(a)(1)(v), 2.34(a)(2)(ii), 2.34(a)(3)(iv) and 2.34(a)(4)(iv), which state that an application may list more than one item of goods or more than one service, provided that the applicant has used or has a bona fide intention to use the mark in commerce on or in connection with all the specified goods or services. This is stated in §§ 2.32(a)(6), 2.33(b)(1) and 2.33(b)(2), and it is unnecessary to repeat it in § 2.34.

The Office proposes to amend § 2.34(a)(4)(i)(A) to require that an application based on section 44(d) of the Act specify the serial number of the foreign application. This incorporates a requirement of Article 4(D)(5) of the Paris Convention, and codifies current practice, as stated in Trademark Manual of Examining Procedure (TMEP) § 1003.

The Office proposes to add a new § 2.34(a)(5), setting forth a request for extension of protection of an international registration under section 66(a) of the Act as a fifth basis for filing a trademark application.

The Office proposes to revise § 2.34(b) to provide that more than one basis can be claimed only in an application under