

section 1 or 44 of the Act, and that a basis under section 66(a) of the Act cannot be combined with any other basis.

The Office proposes to revise § 2.35(a) to state that in an application under section 66(a) of the Act, the applicant may not add, substitute or delete a basis, unless the applicant meets the requirements for transformation under section 70(c) of the Act and proposed § 7.31.

The Office proposes to revise § 2.35(b) to set forth the requirements for adding, substituting or deleting a basis in an application under section 1 or section 44 of the Act. This is consistent with current §§ 2.35(a) and 2.35(b).

The Office proposes to redesignate §§ 2.35(c) through 2.35(h) as §§ 2.35(b)(3) through 2.35(b)(8).

The Office proposes to add a new § 2.37(b), requiring that if a mark has color, the applicant must identify the color(s) and describe where they appear on the mark. This is consistent with the requirements for international applications under the Madrid Protocol.

The Office proposes to amend § 2.47 to indicate that an application under section 66(a) of the Act is not eligible for registration on the Supplemental Register. Section 68(a)(4) of the Act provides that registration of an extension of protection of an international registration shall be refused to any mark not eligible for registration on the Principal Register.

The Office proposes to reword § 2.51(d) to simplify the rule and to add a provision that, in an application under section 66(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark that appears in the international registration.

The Office proposes to revise § 2.52 to clarify the types of drawings and format for drawings. There are two types of drawings: (1) Standard character (typed) drawings; and (2) special form drawings. Currently the rules refer to a standard character drawing as a "typed drawing." The Office proposes to use the term "standard character" because this is the term used for international applications under the Madrid Protocol. Proposed § 2.52(a) sets forth the requirements for a standard character drawing, and proposed § 2.52(b) sets forth the requirements for a special form drawing. Additional requirements for drawings filed through TEAS are set forth in proposed § 2.53, and additional requirements for paper drawings are set forth in proposed § 2.54.

Proposed § 2.52(b)(1) requires that if color is claimed as a feature of the mark or if the mark consists only of color, the drawing must show the mark in color.

Currently, the Office does not accept color drawings. Under current rules, to show color in a mark, an applicant must submit a black and white drawing, with a statement identifying the color(s) and describing where they appear in the mark. Alternatively, an applicant may show color by using the lining chart set forth in TMEP § 807.09(b).

Effective November 2, 2003, the Office will accept color drawings, and will require that applicants whose marks comprise color submit a drawing that shows color. The Office will no longer accept black and white drawings with a color claim, or drawings that are "lined for color."

Proposed § 2.52(b)(1) requires that an applicant submit a black and white drawing if color is not claimed as a feature of the mark. This is consistent with the requirements for international applications under the Madrid Protocol.

Proposed § 2.52(b)(1) further requires that applicant name the color(s) and describe where they appear on the mark.

The proposed rule does not prohibit the use of gray tones. The Office will process drawings with gray tones as black and white drawings unless the application includes a statement that applicant is claiming the color gray. Thus, an applicant must submit a color claim if applicant wants to show gray in the mark.

The Office proposes to add § 2.53, setting forth the requirements for a drawing filed through TEAS. Proposed § 2.53(b) requires that applicant attach a digitized image of the mark to the electronic submission. The image must be no larger than 3.15 inches (8 cm) high by 3.15 inches (8 cm) wide; must be in .jpg format; and must be scanned at no less than 250 and no more than 350 dots per inch. The image that is scanned must be made with a pen or by a process that will provide high definition when copied. These requirements are necessary to ensure that the Office database contains a clear and accurate reproduction of the mark. The 8 cm by 8 cm size requirement is consistent with the size requirement for an international application.

The Office proposes to add § 2.54, setting forth the requirements for a paper drawing. These requirements are necessary to ensure that the Office receives an image that can be scanned into its database without losing clarity.

The Office proposes to amend § 2.65 to add a new paragraph (d), stating that, if a refusal or requirement is expressly limited to only certain goods/services and the applicant fails to file a complete response to the refusal or requirement, the application shall be abandoned only as to those particular goods/services.

This is a change in practice. Currently, failure to respond to a refusal that pertains to fewer than all the goods and services, or fewer than all the classes, in an application will result in abandonment of the entire application. See TMEP § 1403.05. This change will result in fewer abandonments and comports with sections 68(c) and 69(a) of the Act, which provide that an application under section 66(a) of the Act is automatically protected with respect to any goods or services for which the Office has not timely notified the IB of a refusal.

The Office proposes to amend § 2.66(a) to require that a petition to revive an abandoned application based on unintentional delay be filed within two months of the mailing date of the notice of abandonment. The Office proposes to remove § 2.66(a)(2), which provides that such a petition may be filed within two months of actual knowledge of the abandonment if the applicant did not receive the notice of abandonment and the applicant was diligent in checking the status of the application.

Effective October 30, 1999, the standard for reviving abandoned applications was changed from "unavoidable delay" to "unintentional delay." See notices at 64 FR 48900 (Sept. 8, 1999) and 1226 TMOG 103 (Sept. 28, 1999). Since that time, there has been a substantial increase in the number of petitions to revive filed in the Office. Third parties may be harmed by the revival of a pending application many months after its abandonment and removal from the Office database. For example, a third party may have searched the Office database and commenced using a mark because the search showed no earlier-filed conflicting marks. Or an examining attorney may have searched the Office database and approved a later-filed application for a conflicting mark because the database indicated that the earlier-filed application was abandoned. To minimize this problem, the Office proposes to adopt a stricter time limit for filing petitions to revive under § 2.66. Moreover, the strict time limits for issuing refusals to requests for extension of protection under section 66(a) of the Act requires greater accuracy of the Office database.

The Office proposes to add a new § 2.72(d), stating that in an application under section 66(a) of the Act, the applicant may amend the description or drawing of the mark only if the proposed amendment does not materially alter the mark, and that the Office will determine whether a proposed amendment materially alters a