

**DEPARTMENT OF COMMERCE****Patent and Trademark Office****37 CFR Parts 2 and 7**

[Docket No. 2003–T–010]

RIN 0651–AB45

**Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act****AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Final rule.

**SUMMARY:** The United States Patent and Trademark Office (Office) is adding new regulations to implement the Madrid Protocol Implementation Act of 2002 (MPIA), and is amending existing regulation both to implement the MPIA and to otherwise clarify and improve the procedures for processing trademark applications and conducting proceedings before the Trademark Trial and Appeal Board. The MPIA provides that: The owner of a U.S. application or registration may seek protection of its mark in any of the other 58 countries party to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) by submitting a single international application through the Office to the International Bureau of the World Intellectual Property Organization (IB); and the owner of an application or registration in a country party to the Madrid Protocol may obtain an international registration from the IB and request an extension of protection of its mark to the United States.

**DATES:** *Effective Date:* November 2, 2003.

*Applicability Dates:* New rules added as part 7 of 37 CFR and the amendments to rules in part 2 of 37 CFR shall apply to any application for international registration filed on or after November 2, 2003, and any application for registration in the United States under section 1, section 44 or section 66(a) of the Act filed on or after November 2, 2003, except as noted below.

*Drawing requirements under § 2.52:* Applicants with pending applications filed prior to November 2, 2003, will not be required to file amended drawings. However, applicants may voluntarily amend their drawings to comply with the new standard character or color drawing requirements. See discussion below of changes to § 2.52. The Office will consider voluntary amendments filed on or after November 2, 2003, in accordance with standard procedures for processing of amendments.

*Partial abandonment under § 2.65(a):* This rule as amended shall apply to all Office actions issued on or after November 2, 2003, even if the application was filed prior to that date. See discussion below of the changes to § 2.65.

*Requests to extend the time to file an opposition under § 2.102(c):* If a first request for an extension of time to oppose was filed before November 2, 2003, the rules in effect on the filing date of that first request will apply to the first request and any subsequent request filed by the same potential opposer or one in privity with it. If a first request for an extension of time to oppose is filed on or after November 2, 2003, the amended regulation will apply to the first request and any subsequent request filed by the same potential opposer or one in privity with it.

*Petitions to the Director under § 2.146(i):* For petitions filed on or after May 2, 2004, petitioners will be held to the new six-month standard of diligence in monitoring the status of applications and registrations. Petitions filed prior to May 2, 2004, will be reviewed under the one-year diligence standard, even if the application was filed on or after November 2, 2003. See the discussion below of changes to § 2.146(i).

**FOR FURTHER INFORMATION CONTACT:**

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

**SUPPLEMENTARY INFORMATION:** A Notice of Proposed Rule Making was published in the **Federal Register** (68 FR 15119) on March 28, 2003. A public hearing was held on May 30, 2003.

Four organizations, two law firms, seven attorneys, one business and three individuals submitted written comments. Two organizations and one attorney testified at the oral hearing.

The Madrid Protocol Implementation Act of 2002, Public Law 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 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 Concerning the International Registration of Marks and the Protocol Relating to that Agreement (April 1, 2002) (Common Regulations) are available on the World Intellectual Property Organization's (WIPO) Web site, currently at <http://www.wipo.int/madrid/en/>. The Common Regulations are the procedures agreed to by the parties to the Madrid Protocol regarding

the administration of the Madrid Protocol, pursuant to Article 10(2)(iii).

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. The “TMEP” referenced below is the *Trademark Manual of Examining Procedure* (3rd ed. Rev. 2, May 2003).

**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 Madrid Protocol, an applicant 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 Madrid Protocol (Contracting Parties). An international application must be based on 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 registration is sought.

The international application must be submitted through the trademark office of the Contracting Party in which the basic application is pending or basic 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 will review an 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.