

Registration by the IB does not mean that the mark is automatically granted protection in the designated Contracting Parties.

The holder of an international registration may designate additional Contracting Parties in a subsequent designation. A subsequent designation is a request by the holder of an international registration for an extension of protection of its international registration to additional Contracting Parties. Each Contracting Party designated in an international application or subsequent designation will examine the request for extension of protection as a national application under its laws, and if it complies with the requirements for registration, grant protection of the mark in its country. A Contracting Party must notify the IB of the refusal of a request for extension of protection within the time limits set forth in Article 5(2) of the Madrid Protocol. If a notification of refusal is not sent to the IB within the required time limits, the Contracting Party must grant protection of the mark in its country.

Discussion of Specific Rules Added or Changed

The Office is adding new rules setting forth the requirements for submitting international applications and subsequent designations through the Office for forwarding to the IB. The Office is also adding new rules for processing requests for extension of protection of international registrations to the United States, and changing current regulations to bring the rules of practice in trademark cases into conformance with the MPIA.

New Rules Added as Part 7

The Office is adding rules 7.1, 7.3, 7.4, 7.6, 7.7, 7.11, 7.12, 7.13, 7.14, 7.21, 7.22, 7.23, 7.24, 7.25, 7.26, 7.27, 7.28, 7.29, 7.30, 7.31, 7.36, 7.37, 7.38, 7.39, 7.40, and 7.41; and designating part 7 of 37 CFR as the rules of practice in filings pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

Section 7.1 defines certain terms used in this part. Terms defined in the MPIA are not included in the list of definitions in § 7.1.

Section 7.3 requires that correspondence relating to international applications and registrations be in English.

Section 7.4 states that correspondence submitted through the Trademark Electronic Application System (TEAS) will be accorded the date and time the complete transmission is received in the Office based on Eastern Time.

Fees

Section 7.6 sets forth the fees required by the Office for processing correspondence relating to international applications and registrations under the Madrid Protocol. These fees must be paid in U.S. dollars at the time of submission.

The Office is charging fees for: (1) Reviewing and certifying an international application; (2) transmitting a subsequent designation; (3) transmitting a request to record an assignment or restriction (usually a security interest), or the release of a restriction, of a holder's right of disposal of an international registration; (4) requesting a notice of replacement; and (5) filing an affidavit of use in commerce or excusable nonuse for a mark in a registered extension of protection to the United States.

In addition to the fees required by the Office, there are international fees for processing international applications and registrations. Section 7.7 sets forth the international fees that may be paid to the IB through the Office in connection with international applications and registrations, and the requirements and procedures for submitting those fees through the Office. A schedule of the international fees is currently posted on the WIPO Web site, available at <http://www.wipo.int/madrid/en/>. An international applicant or holder may pay the fees directly to the IB, or to the IB through the Office. Fees paid directly to the IB must be paid in Swiss francs, and fees paid through the Office must be paid in U.S. dollars.

Under § 7.7(b), if an international applicant or holder pays the international fees through the Office, payment must be made at the time of submission by any of the acceptable payment methods set forth in §§ 2.207 and 2.208. If the international fees are paid directly to the IB using an acceptable form of payment established by the IB, the international applicant or holder must include the IB account number for debiting fees or the IB receipt number as proof of payment of fees in its submission to the Office. The fee calculator and acceptable methods for paying fees to the IB may currently be viewed on the WIPO Web site at <http://www.wipo.int/madrid/en/>.

International Applications Originating From the United States

The requirements for granting a date of receipt to an international application are set forth in § 7.11(a). An international application must identify at least one basic application or registration. The international

application may be based on more than one U.S. application and/or registration, provided that the owner and the mark are the same for each basic application or registration.

An international application must be submitted through TEAS. The Office has developed a TEAS form for filing an application for international registration that conforms to the official IB form created by WIPO. TEAS will require the applicant to select between two different types of forms, namely, a pre-populated form containing information from the basic application or registration, or a free-text form. The applicant can use the pre-populated form if: (1) The international application is based on a single basic application or registration; and (2) applicant's changes to the international application are limited to narrowing the list of goods or services. For all other international applications, the applicant must fill in all the fields in the free text form.

Section 7.11(a)(3) requires a reproduction of the mark in the international application that is the same as 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 and does not include a color claim, the reproduction of the mark in the international application must be black and white. If a mark is depicted in black and white in the basic application or registration but there is a claim of color, the international application must include both a black and white reproduction of the mark and a color reproduction of the mark. If the mark in the basic application or registration is in color, the reproduction of the mark in the international application must be in color.

Under §§ 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 § 7.11(a)(5), if the basic application or registration includes a description of the mark, the international application must include the same description of the mark.

Under § 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.

Section 7.11(a)(7) requires a list of goods and/or services in the international application that is