

identical to or narrower than the list of goods and/or services in the basic application or registration, and is classified according to the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*. An applicant may omit or revise goods and/or services from the international application as long as the omission or revision does not broaden the scope of the goods or services identified in the basic application or registration.

The pre-populated form will include the list of goods/services in the basic application or registration. The applicant may edit the list of goods and/or services by either omitting particular goods or services or revising the description of goods or services populated from the basic application or registration. In the free text form, the applicant must enter the goods/services manually. The applicant may omit goods or services, or revise the list of goods/services. The list of goods and services for each designated Contracting Party must be identical to or narrower than the list of goods or services in the international application.

Both the pre-populated form and the free-text form will also allow an applicant to change the classification of goods and services in an international application. If the goods or services in the basic application or registration are classified in U.S. Classes A, B or 200 or entirely under the U.S. classification system, an applicant may want to reclassify goods or services into international classes. Classes A, B and 200 are not part of the international classification system under the *Nice Agreement*. Failure to properly classify goods or services in an international application according to the international classification system under the *Nice Agreement* may result in an IB notice of irregularity. The Office will issue an examination guide regarding classification on or before November 2, 2003.

Under § 7.11(a)(8), an international applicant must designate at least one Contracting Party in which it seeks an extension of protection.

Under § 7.11(a)(9), the international applicant must pay the U.S. certification fee and the international fees (*see* § 7.7) for all classes and all designated Contracting Parties at the time of submission.

Under section 61 of the Act, and § 7.11(a)(10), an international applicant must specify that applicant is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States. If

the applicant is not a national of the United States and the applicant's address on the application is outside of the United States, the applicant will be required to provide the address of the U.S. domicile or establishment.

Section 7.13 sets forth the requirements for certifying and forwarding an international application to the IB. Under § 7.13(a), if an international application meets the requirements of § 7.11(a), the Office will grant a date of receipt, certify that the information contained in the international application corresponds to the basic application or registration, and forward the international application electronically to the IB.

The Office must certify and forward an international application to the IB within two months of the date of receipt in the Office in order to provide the applicant with an international registration date as of the date of receipt of the international application in the Office. The Office will automatically certify and forward to the IB all international applications based on a single basic application or registration, with no limitations on the goods/services and no color claim, that meet the requirements of § 7.11(a). Limited review by the Madrid Processing Unit (MPU) is required for international applications where the goods or services have been narrowed or a color drawing is attached. International applications that are completed on free text forms are reviewed by the MPU. The use of a fully automated filing system expedites the processing of international applications because information is either pre-populated from Office records or entered by the applicant directly into the Office's automated systems, and electronically reviewed for certification.

Section 7.13(b) states that if the Office cannot certify that the information contained in the international application corresponds with the information in the basic application or registration, the Office will notify the applicant that the international application cannot be certified. Any international fees (*see* § 7.7) paid through the Office will be refunded; however, the Office will not refund the certification fee.

#### Correcting Irregularities in International Application—§ 7.14

The IB will notify both the international applicant and the Office of any irregularities in an international application. Under Rule 11 of the Common Regulations, the international applicant must correct certain irregularities through the Office. Fees for correcting irregularities in an

international application must be paid directly to the IB. All other irregularities requiring applicant's response may either be submitted through the Office or filed directly at the IB. Section 7.14(b) sets forth the types of irregularities that must be corrected through the Office, and § 7.14(e) sets forth the procedures for responding to irregularities through the Office.

To be considered timely, responses to IB notices of irregularities must be received by the IB before the end of the response period set forth in the IB's notice. Receipt in the Office does not fulfill this requirement.

Information about filing directly with the IB is available on the WIPO Web site, currently at <http://www.wipo.int/madrid/en/>. The applicant may contact the IB by mail to the World Intellectual Property Organization, 34 chemin des Colombettes, PO Box 18, CH-1211 Geneva 20, Switzerland; by telephone at 41 22 338 9111; by fax to 41 22 740 1429; or by e-mail to [intreg.mail@wipo.int](mailto:intreg.mail@wipo.int).

#### Irregularities in Classification and Identification of Goods/Services

Rules 12 and 13 of the Common Regulations provide that the IB will not consider a response to irregularities in classification or identification of goods and/or services unless the response is submitted through the office of origin. Section 7.14(b) therefore requires that an international applicant respond to irregularities in classification and identification of goods and/or services through the Office. Because the Office must certify that the goods or services in an applicant's response are within the scope of the basic application or registration at the time the response is filed, responses to irregularities in the identification will be reviewed by the MPU.

If the goods or services in the basic application or registration have been amended since the date the international application was submitted to the Office, the goods and services in the response to the IB notice must be within the scope of the amended goods and services. If the response includes goods and services that exceed the scope of the goods and services in the basic application or registration as amended, the MPU will reject the response and notify the applicant. If there is time remaining in the IB response period, the applicant may submit a corrected response. If the goods and services in an applicant's response do not exceed the scope of the goods and services in the basic application or registration as amended, and the IB response period has not