

expired, the MPU will certify the goods and services and forward the response to the IB.

Fees To Correct Irregularities Must Be Paid Directly to the IB

Section 7.14(c) provides that fees for correcting irregularities in an international application must be paid directly to the IB. This is true even if the applicant is filing a response to correct other irregularities through the Office. At this time, the Office's automated system cannot process fees to correct irregularities in an international application.

Other Irregularities Requiring Response From Applicant

Under § 7.14(d), applicants may respond to all other irregularities either through the Office in accordance with § 7.14(e), or directly at the IB. The Office will not respond to any irregularities on behalf of an applicant. Except for an applicant's response to irregularities in the identification of goods and services, the Office will not review responses to IB notices of irregularities.

Procedures for Responding to IB Notices of 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 the requirement for timely submission to the IB.

Under § 7.14(e), the Office requires that applicants use TEAS to submit responses through the Office. Responses submitted through the Office for forwarding to the IB should be submitted as soon as possible, but at least one month before the end of the response deadline set forth in the IB's notice. The Office will not process any response submitted to the Office after the IB response deadline.

Subsequent Designations—§ 7.21

Section 64 of the Act and § 7.21 permit the holder of an international registration to submit a subsequent designation through the Office, if: (1) The international registration is based on a U.S. application or registration; and (2) the holder of the international registration is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States. The holder also has the option of filing a subsequent designation directly with the IB.

Under § 7.21, if a subsequent designation is submitted through the Office, it must be submitted through TEAS and include the international

registration number, the name and address of the holder of the international registration, one or more Contracting Parties in which an extension of protection is sought, and a list of goods and/or services that is identical to or narrower than the goods and/or services listed in the international registration. The holder can omit or revise goods and/or services from the subsequent designation as long as the omission or revision does not broaden the scope of the goods or services identified in the international registration. The holder must include the U.S. transmittal fee and all subsequent designation fees (*see* § 7.7) at the time of submission. The Office is not required to certify a subsequent designation.

The IB will review a subsequent designation for compliance with Rule 24 of the Common Regulations before forwarding the request for extension of protection to the designated Contracting Parties. If there are any irregularities in the subsequent designation, the IB will notify both the holder and the Office. The holder must file any responses to the notice or irregularities directly with the IB. The Office will not forward any responses to irregularities in a subsequent designation to the IB, even if the subsequent designation was submitted through the Office.

Recording Changes to International Registration

The IB shall record changes to international registrations pursuant to Articles 9 and 9^{bis} of the Madrid Protocol. Section 7.22 requires that all requests to record changes to an international registration be filed at the IB, except in the limited circumstances in which an assignment, or restriction of a holder's right of disposal of an international registration or the release of such a restriction, must be submitted through the Office, as set forth in §§ 7.23 and 7.24. Section 10 of the Act and 37 CFR part 3 are not applicable to such assignments or restrictions.

The Office will not take note of an assignment or restriction of a holder's right of disposal of an international registration in its records unless the IB notifies the Office that the assignment or restriction has been recorded in the International Register. When the IB sends notice of an assignment of an international registration with an extension of protection to the United States, the MPU will update the ownership information in the Trademark database and forward the IB notice to the Assignment Services Division to update its automated records. An assignment of an extension

of protection that has not been recorded at the IB will not be reflected in the Trademark database, even if the assignment has been inadvertently recorded by the Assignment Services Division.

Section 7.23 sets forth the limited circumstances in which a request to record an assignment of an international registration may be submitted through the Office. The Office will accept and forward to the IB a request to record an assignment of an international registration by an assignee who is a national of, is domiciled in or has a real and effective commercial or industrial establishment in the U.S. only if the assignee cannot obtain the assignor's signature for the request to record the assignment and the request meets the requirements of § 7.23.

Section 7.24 sets forth the limited circumstances in which a request to record a restriction of a holder's right of disposal of an international registration, or the release of such a restriction, may be submitted through the Office. Under § 7.24, the Office will accept for submission and forward to the IB a request to record a restriction of a holder's right of disposal of an international registration (usually a security interest), or the release of such a restriction, by a party holding the restriction who is a national of, is domiciled in or has a real and effective commercial or industrial establishment in the U.S. only if: (1) (i) The restriction is the result of a court order; or (ii) the restriction is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, and the signature of the holder of the international registration cannot be obtained; (2) the party who obtained the restriction is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States; and (3) the restriction or release applies to the holder's right to dispose of the international registration in the United States. The request must meet the requirements of § 7.24(b). The Office will charge a fee for transmitting a request to record an assignment or restriction, or the release of a restriction, to the IB.

Requests for Extension of Protection to the United States

Under section 65 of the Act, the holder of an international registration may request an extension of protection of the international registration to the United States, provided the international registration is not based on a U.S. application or registration.