

The holder may file with the IB a request for extension of protection to the United States in either an international application or a subsequent designation. Section 66(a) of the Act requires that a request for extension of protection to the United States include a declaration of bona fide intention to use the mark in commerce that the United States Congress can regulate. The allegations in a verified statement required by an international applicant or holder seeking an extension of protection of an international registration to the United States are set forth in § 2.33(e). See discussion below of new § 2.33(e). The IB will certify that the request for extension of protection contains a properly signed declaration of bona fide intention to use the mark in commerce when it forwards the request to the Office. The declaration will remain part of the international registration on file at the IB.

The IB will forward the request for extension of protection to the Office electronically. A holder cannot file a request for extension of protection to the United States directly with the Office.

Section 7.25 provides that for purposes of examination and opposition, a request for an extension of protection to the United States will be referred to as an application for registration under section 66(a) of the Act; that references to "applications" and "registrations" in 37 CFR part 2 include extensions of protection to the United States; and that upon registration, an extension of protection will be referred to as a "registration," a "registered extension of protection," or a "section 66(a) registration." With the exception of §§ 2.130–2.131, 2.160–2.166, 2.168, 2.172, 2.173, 2.175 and 2.181–2.186, all the sections in 37 CFR parts 2 and 10 apply to a request for extension of protection to the United States.

Under § 7.26, the filing date of a request for extension of protection to the United States for purposes of examination in the Office is: (1) The international registration date, if the request for extension of protection to the United States was made in the international application, or (2) the date the IB recorded the subsequent designation, if the request for extension of protection to the United States was made in a subsequent designation. Under section 66(b) of the Act, the filing date of the extension of protection will be considered the date of constructive notice pursuant to section 7(c) of the Act.

Under section 67 of the Act and § 7.27, the holder of an international registration may claim priority under

Article 4 of the Paris Convention for the Protection of Industrial Property if: (1) The request for an extension of protection contains a claim of priority; and (2) the international registration date or the date of recordal of the subsequent designation at the IB requesting an extension of protection to the United States is no later than six months after the filing date of the application that formed the basis of the claim of priority.

Replacement

Under Article 4^{bis} of the Madrid Protocol, where a mark that is the subject of a national or regional registration in the Office of a Contracting Party is also the subject of an international registration and both registrations are in the name of the same person, the international registration is deemed to replace the national or regional registration, without prejudice to any rights acquired by virtue of the latter, provided that: (1) The protection resulting from the international registration extends to that Contracting Party; (2) all the goods and services listed in the national or regional registration are also listed in the international registration with respect to that Contracting Party; and (3) the extension of protection takes effect after the date of the national or regional registration.

Under section 74 of the Act and § 7.28(a), a registered extension of protection to the United States affords the same rights as a previously issued U.S. registration if: (1) Both registrations are owned by the same person and identify the same mark; and (2) the goods/services in the previously issued U.S. registration are covered by the registered extension of protection. Under § 7.28(b), the holder of a registered extension of protection may request that the Office note in its records replacement of the earlier U.S. registration by the extension of protection. The Office will require a fee to note replacement.

Under § 7.29, the replaced U.S. registration will remain in force, unless cancelled, expired or surrendered, as long as the owner files affidavits or declarations of use or excusable nonuse under section 8 of the Act and renews the registration under section 9 of the Act.

Effect of Cancellation or Expiration of International Registration on Extension of Protection

Under section 70 of the Act and § 7.30, the Office will cancel a pending or registered extension of protection to the United States, in whole or in part,

if the IB notifies the Office of the cancellation or expiration of the corresponding international registration, in whole or in part.

Transformation

Under section 70(c) of the Act and § 7.31, if an international registration is cancelled, in whole or in part, by the IB at the request of the office of origin under Article 6(4) of the Madrid Protocol (due to the cancellation or expiration of the basic application or registration), the holder of the international registration may file a request to transform the corresponding extension of protection to the United States into an application under sections 1 and/or 44 of the Act. If only a portion of the cancelled goods and services in the international registration pertains to the extension of protection to the United States, the Office will not cancel the entire extension of protection, but will instead delete the cancelled goods or services from the extension of protection. The holder of the extension of protection may request transformation only as to the cancelled goods or services.

The requirements for transformation are set forth in § 7.31(a). The holder of an international registration must file the request for transformation through TEAS within three months of the date of cancellation of the international registration. The request must include an application filing fee for at least one class of goods and/or services.

Under § 7.31(b), if a request for transformation contains all the elements in § 7.31(a), the cancelled extension of protection to the United States will be transformed into an application under sections 1 and/or 44 of the Act. The application will be accorded the same filing date and same priority (if any) as the cancelled extension of protection to the United States. The application resulting from the transformation will be examined as a new application under part 2 and, if approved for publication, published for opposition. The application must meet all the requirements of the Act and rules for an application under section 1 and/or section 44 of the Act, as appropriate.

If the holder does not meet the requirements of § 7.31(a), the Office will not process the request for transformation.

Maintaining an Extension of Protection to the United States

Section 71 of the Act and § 7.36 require the holder of an international registration with a registered extension of protection to the United States to file an affidavit or declaration of use in