

encouraged to allow the Office sufficient time to process responses to irregularities in classification and identification of goods and/or services through the Office. Fees for correcting irregularities must be paid directly to the IB. All other responses to correct irregularities can be filed directly at the IB or submitted through the Office for forwarding to the IB. See discussion above of § 7.14.

Comment: One comment stated that the Office should be willing to assist international applicants in resolving classification or identification issues raised by the IB.

Response: The IB will propose changes to the identification and classification of goods and services in its notice of irregularities concerning goods and services. Because the final decision on classification and identification for an international application rests with the IB, the Office recommends that applicants adopt suggestions offered by the IB, if accurate.

Comment: One comment requested that the Office treat deficient requests to record an assignment or restriction (see §§ 7.23 and 7.24) as informal and allow the filer an opportunity to correct deficiencies within a reasonable time.

Response: Setting up a docketing system for deficient requests is unnecessary and inefficient. If the request is deficient, the Office will inform the filer of the deficiency in an e-mail message. The applicant/holder will have the opportunity to immediately re-file.

Comment: One comment stated that noting replacement of an extension of protection before registration could cause confusion as to the effect of such notice.

Response: The Office has revised § 7.28. Under Article 4^{bis} of the Madrid Protocol and section 74 of the Act, replacement does not take effect until the extension of protection matures into a registration. Therefore, the Office will not note replacement of an extension of protection unless the mark has registered.

Comment: Two comments stated that the grace period for affidavits of use under § 7.36 should be changed from three months to six months.

Response: The grace period for filing an affidavit of use of a registered extension of protection is set forth in section 71 of the Act and will require a statutory amendment.

Amendment to Part 2 Rules

In addition to the new rules added as part 7 of 37 CFR, the Office is amending rules and adding new rules to part 2 of

37 CFR to bring the rules of practice in trademark cases into conformance with the MPIA, to set forth the requirements for examination and registration of extensions of protection to the United States, as well as proceedings before the Trademark Trial and Appeal Board relating to them, and to otherwise clarify and improve the procedures for processing trademark applications and conducting proceedings before the Trademark Trial and Appeal Board.

The Office is amending rules 2.2, 2.11, 2.17, 2.18, 2.19, 2.21, 2.33, 2.34, 2.35, 2.37, 2.47, 2.51, 2.52, 2.56, 2.65, 2.66, 2.73, 2.75, 2.84, 2.88, 2.101, 2.102, 2.104, 2.105, 2.107, 2.111, 2.112, 2.113, 2.118, 2.121, 2.123, 2.127, 2.128, 2.130, 2.131, 2.142, 2.145, 2.146, 2.151, 2.161, and 2.171; and adding rules 2.53, 2.54, and 2.126.

The Office is amending § 2.2 to add definitions of “ESTTA” (Electronic System for Trademark Trials and Appeals) and “international application.”

The Office is revising § 2.11 and its heading to indicate that representation before the Office is governed by 37 CFR 10.14. It is redundant to have provisions governing representation before the Office in both parts 2 and 10.

The Office is rewording § 2.17(b) by adding a reference to § 10.14(b), and rewording § 2.17(a) and (c) by replacing “paper” with “document.”

The Office is amending § 2.18 to clarify procedures for establishing a correspondence address in trademark cases. The amendment does not change current practice.

The Office is amending § 2.19(a) to clarify procedures for sending correspondence after a power of attorney is revoked, and amending § 2.19(b) to indicate that the procedures for permissive withdrawal of an attorney are governed by § 10.40.

The Office is amending § 2.21(a) to indicate that § 2.21 sets forth the minimum filing requirements only for applications under sections 1 and 44 of the Act. The filing date of an application under section 66(a) of the Act is governed by section 66(b) of the Act and § 7.26.

Section 2.33(d)(1) is amended to delete the requirement that a party who signs a trademark document electronically print, sign, date and maintain a paper copy of the electronic submission. It is burdensome and inefficient to require parties who file electronically to maintain both paper and electronic records of the filings.

The Office is also amending § 2.33 by adding paragraph (e), setting forth the requirements for a verified statement for an application under section 66(a) of the

Act, and stating that the verified statement is part of the international registration on file at the IB.

The Office is removing §§ 2.34(a)(1)(v), 2.34(a)(2)(ii), 2.34(a)(3)(iv) and 2.34(a)(4)(iv), which state that an application may list more than one item of goods or more than one service, provided that the applicant has used or has a bona fide intention to use the mark in commerce on or in connection with all the specified goods or services. This is stated in §§ 2.32(a)(6), 2.33(b)(1) and 2.33(b)(2), and it is unnecessary to repeat it in § 2.34.

The Office is amending § 2.34(a)(4)(i)(A) to require that an application based on section 44(d) of the Act specify the serial number of the foreign application. This incorporates a requirement of Article 4(D)(5) of the Paris Convention, and codifies current practice, as stated in TMEP § 1003.

The Office is adding a new § 2.34(a)(5), setting forth a request for extension of protection of an international registration under section 66(a) of the Act as a fifth basis for filing a trademark application.

The Office is revising § 2.34(b) to provide that more than one basis can be claimed only in an application under section 1 or 44 of the Act, and that a basis under section 66(a) of the Act cannot be combined with any other basis.

The Office is revising § 2.35(a) to state that in an application under section 66(a) of the Act, the applicant may not add, substitute or delete a basis, unless the applicant meets the requirements for transformation under section 70(c) of the Act and § 7.31.

The Office is revising § 2.35(b) to clarify that the requirements for adding, substituting or deleting a basis apply only to applications under sections 1 and 44 of the Act. This does not change current practice.

The Office is redesignating § 2.35(c) through 2.35(h) as § 2.35(b)(3) through 2.35(b)(8).

The Office is amending § 2.37(b) to delete the requirement for a description of a mark that has color. The requirement for a description of color for marks where color is claimed as a feature of the mark is already set forth in § 2.52, and it is unnecessary to repeat the requirement in § 2.37.

The Office is amending § 2.47 to indicate that an application under section 66(a) of the Act is not eligible for registration on the Supplemental Register. Section 68(a)(4) of the Act provides that registration of an extension of protection of an international registration shall be