

The Office is amending § 2.146(c) to delete reference to a petition to revive as an example of a situation where an affidavit or declaration is required in support of a petition. This is a technical correction to the rule. Effective October 30, 1999, § 2.66 was amended to delete the requirement for an affidavit or declaration in a petition to revive based on unintentional delay. An unverified statement is sufficient. See notices at 64 FR 48900 (Sept. 8, 1999) and 1226 TMOG 103 (Sept. 28, 1999). However, § 2.146(c) still requires a verified statement in other situations where facts are to be proven on petition. For example, if the petition arises from the loss or misplacement of a document submitted to the Office, it should be accompanied by the affidavit or declaration of the person who mailed the document, attesting to the date of submission and identifying the document filed with the petition as a true copy of the document previously filed. TMEP § 1705.03.

The Office is amending § 2.146(i) to change the standard for a showing of due diligence for petitions in which the petitioner seeks to reactivate an application or registration that was abandoned, cancelled or expired due to the loss or mishandling of papers. Currently, the rule requires that to be considered diligent, petitioners must check the status of pending matters within one year of the last filing or receipt of a notice from the Office for which further action by the Office is expected. The Office is shortening the time period from one year to six months. A showing of due diligence will require that a petitioner check the status of a pending application every six months between the filing date of the application and issuance of a registration; check the status of a registration every six months after filing an affidavit of use or excusable nonuse under section 8 or 71 of the Act, or a renewal application under section 9 of the Act, until the petitioner receives notice that the affidavit or renewal application has been accepted; and promptly request corrective action where necessary.

Third parties may be harmed by the removal and later reinsertion of an application or registration in the Office database. Hundreds of petitions are filed each month to reinstate applications and registrations. To minimize this problem, the Office is adopting stricter time limits for filing petitions to revive or reinstate abandoned applications and cancelled or expired registrations.

The Office is revising § 2.151 to add a reference to section 71 of the Act, which requires periodic affidavits of use

or excusable nonuse to maintain a registration based on an extension of protection of an international registration.

The Office is revising § 2.161(g)(2) and adding paragraph (g)(3), stating that an audio or video cassette tape recording, CD-ROM, or a specimen in another appropriate medium may be submitted in the absence of a non-bulky specimen, and that an electronically submitted specimen must be in .jpg format. The requirement that a specimen filed through TEAS be a digitized image in .jpg format is consistent with the specimen requirement in revised § 2.56(d)(4).

The Office is adding a new § 2.171(b), stating that when ownership of a registration has changed with respect to some but not all of the goods and/or services, the registrant(s) may file a request that the registration be divided into two or more separate registrations. The new owner(s) must pay a fee for each new separate registration created by the division (child registration), and record the change of ownership in the Office.

When the IB notifies the Office of the division of an international registration resulting from a partial change of ownership of the international registration with respect to some of the goods or services in the registered extension of protection to the United States, the Office will record the partial change of ownership, divide out the assigned goods or services from the registered extension of protection (parent registration), issue an updated certificate for the parent registration and publish notice of the parent registration in the *Official Gazette*. The Office will not issue a new certificate for the child registration or publish notice of the child registration until the assignee files a request to divide under § 2.171(b), and pays the required fee.

A U.S. registration based on an application under section 1 and/or section 44 of the Act may also be divided as a result of a partial change of ownership, if the partial change of ownership is recorded in the Assignment Services Division and the assignee files a request to divide under § 2.171(b), with the required fee.

Comments to Part 2 Rules

Comment: One comment indicated that the “relationship” of proposed § 2.17 and § 10.14(b) appears to need clarification. Another comment asked whether the Office would accept a response in which the written authorization for the attorney was not filed with the response.

Response: The requirement for written authorization in § 2.17(b) applies only to non-lawyers. The Office is changing the language of § 2.17(b) to make this clear. It is generally not necessary for an attorney as defined in § 10.1(c) to file a power of attorney or any other special authorization in a trademark case. Under §§ 2.17(a) and (c), an attorney who appears in person or signs a document on behalf of an applicant or registrant will be accepted as the representative of the applicant or registrant. See TMEP § 602.01.

Comment: One comment suggested that “written” be inserted before “notification” in § 2.19(a).

Response: The Office has adopted the suggestion.

Comment: Two comments suggested that the Office add the requirements for a verified statement under section 66(a) to the rules, and require that the IB send a copy of the signed verified statement with the request for extension of protection to the United States.

Response: The Office has adopted the suggestion to add the requirements for a verified statement in a section 66(a) application to the rules. These requirements have been added to § 2.33(e). However, the Office will not require that the IB send a copy of the signed verified statement with the request for extension of protection to the United States.

The Office has provided the IB with wording for a declaration of a bona fide intention to use the mark in commerce. The declaration will be made part of the official IB form for international applications and subsequent designations in which the United States is designated for an extension of protection, and will remain as part of the international registration on file at the IB. The wording of the declaration and instructions for who may sign the declaration comport with the requirements of section 66(a) of the Act and § 2.33. The IB will review the required declaration as part of the request for an extension of protection to the United States. The IB will not certify and forward a request for extension of protection to the United States, if: (1) The declaration is not signed and dated; (2) there have been any changes or modifications to the declaration; or (3) the declaration is not presented on the official IB form.

Comment: One comment suggests that the Office add the wording “on or in connection with the goods or services listed in the application,” to § 2.34(b).

Response: The Office has adopted that suggestion.

Comment: One comment requested clarification as to whether a priority