

claim for a Section 66(a) application is part of an international registration or an additional basis for filing in the Office.

*Response:* If a claim of priority is part of an international registration and meets the requirements of § 7.27, the priority claim is part of the application under Section 66(a), not a separate filing basis.

*Comment:* Three comments recommended that the Office eliminate the requirement to petition the Director to review a post-publication amendment of the basis under § 2.35(b)(2), and delegate the responsibility to trademark examining attorneys. Two of the comments suggested that republication of a mark may not be necessary in every instance.

*Response:* The recommendation cannot be adopted at this time. Although routinely granted, amendments to change the basis after publication require special manual and automated processing, including republication of the mark.

*Comment:* One comment suggests that the Office permit section 66(a) applications to register on the Supplemental Register.

*Response:* The suggestion cannot be adopted because the Act provides only for registration on the Principal Register. See section 68(a)(4) of the Act.

*Comment:* Three comments requested clarification of the term “standard character” drawing, and asked whether a “standard character drawing” is the equivalent of a “typed drawing” under current practice. One of the comments also requested that the Office delete the requirement for a statement that no claim is made to a particular font style or size.

*Response:* In the United States, a “standard character drawing” under revised § 2.52(a), is the equivalent in its effect of a “typed drawing” under current § 2.52(a)(1). The requirement for a statement that no claim is made to a particular font style, size, or color ensures that there is no ambiguity as to whether the applicant seeks registration of a mark in standard characters. See changes to § 2.52(a) discussed above.

*Comment:* One comment suggested that the Office make the requirement to name the colors and describe where they appear on the mark optional for applications under sections 1 and 44 of the Act.

*Response:* The Office has not adopted this suggestion. Applications under sections 1 and 44 of the Act are required to name the colors and describe where the colors appear in the marks under current § 2.52. Moreover, requirements for applications under sections 1 and 44

of the Act should be consistent with the requirements for section 66(a) applications, since they may serve as the basis for an international application.

*Comment:* One comment asked whether marks with gray tones but no claim of color will publish with gray tones or be converted to black and white.

*Response:* The Office will not convert drawings that contain gray tones to black and white drawings. Drawings with gray tones will be processed as color drawings. If the application does not contain a color claim, the examining attorney will inquire whether gray is a feature of the mark. If gray is a feature of the mark, the examining attorney will require a color claim, and the Office will publish the mark in color. If gray is not a feature of the mark, the examining attorney will require a black and white drawing.

*Comment:* Two comments opposed the requirement in § 2.53 that a digitized image of a drawing be in .jpg format. The comments suggested that the Office amend the rule to allow flexibility in accepting other digital formats as they develop.

*Response:* That suggestion has not been adopted. The Office will only accept .jpg format for digitized images at this time. The Office is concerned about the level of stability, uniformity and quality of images that are received and entered into the Office database. The Office currently accepts the .jpg format and has had success handling images in this format. Both the applicant and the Office can be assured that a visible image is attached to the submission because the applicant can view the image in the browser before it is transmitted to the Office. The .jpg format is user friendly and non-proprietary, and it is available to all potential applicants. The Office has not foreclosed the possibility of accepting other formats in the future, and will continue to assess image formats that are currently available and new ones as they develop.

*Comment:* One comment requested information as to the consequences of excluding the caption “Drawing Page” from the top of a paper drawing page.

*Response:* The Office encourages applicants to include the caption “Drawing Page” so that the Office can properly flag the mark when the drawing is scanned into the database. The caption is not mandatory, but its omission may delay processing of the application.

*Comment:* Six comments opposed the proposed amendment of § 2.66(a), to limit the time period for filing a petition

to revive to two months from the mailing date of the notice of abandonment.

*Response:* The Office is withdrawing the proposal to remove § 2.66(a)(2). Section 2.66(a)(2) is instead amended to change the standard for a showing of due diligence in a petition to revive from one year to six months as set forth in § 2.146(i). Under § 2.146(i), as amended, an applicant will be considered diligent if the applicant checks the status of the application every six months between the filing date of the application and issuance of a registration. The modification to § 2.66(a)(2) provides recourse for applicants who are diligent in monitoring the status of the application. However, if a petition to revive an abandoned application that forms the basis of an international registration is filed more than two months after the mailing date of the notice of abandonment, it is likely that the international registration will be cancelled. A cancelled international registration will not be revived even if the basic application is revived. See discussion above of changes to § 2.66.

*Comment:* One comment asked if a concurrent use application or registration can be the basis of an international application.

*Response:* An international application submitted through the Office can be based on a concurrent use application or registration.

*Comment:* Three comments noted that oppositions with insufficient fees appear to be treated differently for documents filed electronically via ESTTA and those filed on paper; and requested that the rules be amended to allow for uniform treatment for notices of opposition with insufficient fees regardless of the manner in which they are filed. One of the three comments suggested that the Office implement a mechanism in ESTTA to ensure that all required fees are paid as part of the electronic filing of a notice of opposition.

*Response:* The language of § 2.101(d)(2) has been modified to more clearly reflect the fact that a potential opposer may not submit a notice of opposition electronically via ESTTA with an insufficient fee, *i.e.*, the sender will immediately receive an electronic message that the transmission is not possible because the fee is insufficient. To be able to transmit the electronic notice of opposition, a potential opposer filing via ESTTA may then elect to submit the correct fee for the number of parties and classes set forth in the electronic notice of opposition, or delete classes and/or parties from the