

§ 2.142 Time and manner of ex parte appeals.

(a) Any appeal filed under the provisions of § 2.141 must be filed within six months from the date of the final refusal or the date of the action from which the appeal is taken. An appeal is taken by filing a notice of appeal in written form, as prescribed in § 2.126, and paying the appeal fee.

(b) * * *

(2) Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetical index of cited cases. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary.

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■ 41. Amend § 2.145 by revising paragraphs (b)(3), (c)(3) and (c)(4) to read as follows:

§ 2.145 Appeal to court and civil action.

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(b) * * *

(3) Notices of appeal directed to the Director shall be mailed to or served by hand on the General Counsel, according to part 104 of this chapter, with a duplicate copy mailed or served by hand on the Trademark Trial and Appeal Board.

(c) * * *

(3) Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding may file a notice with the Office, addressed to the Office of the General Counsel, according to part 104 of this chapter, within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in § 2.119.

(4) In order to avoid premature termination of a proceeding, a party who commences a civil action, pursuant to section 21(b) of the Act, must file written notice thereof at the Trademark Trial and Appeal Board.

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■ 42. Amend § 2.146 by revising paragraphs (c) and (i) to read as follows:

§ 2.146 Petitions to the Director.

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(c) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be

reviewed, the action or relief that is requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. When facts are to be proved in *ex parte* cases, proof in the form of affidavits or declarations in accordance with § 2.20, and any exhibits, shall accompany the petition.

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(i) Where a petitioner seeks to reactivate an application or registration that was abandoned, cancelled or expired because papers were lost or mishandled, the Director may deny the petition if the petitioner was not diligent in checking the status of the application or registration. To be considered diligent, a petitioner must:

(1) During the pendency of an application, check the status of the application every six months between the filing date of the application and issuance of a registration;

(2) After registration, check the status of the registration every six months from the filing of 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

(3) If the status check reveals that the Office has not received a document filed by the petitioner, or that the Office has issued an action or notice that the petitioner has not received, the petitioner must promptly request corrective action.

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■ 43. Revise § 2.151 to read as follows:

§ 2.151 Certificate.

When the Office determines that a mark is registrable, the Office will issue a certificate stating that the applicant is entitled to registration on the Principal Register or on the Supplemental Register. The certificate will state the application filing date, the act under which the mark is registered, the date of issue, and the number of the registration. A reproduction of the mark and pertinent data from the application will be sent with the certificate. A notice of the requirements of sections 8 and 71 of the Act will accompany the certificate.

■ 44. Amend § 2.161 by revising paragraph (g)(2) and adding a new paragraph (g)(3) to read as follows:

§ 2.161 Requirements for a complete affidavit or declaration of continued use or excusable nonuse.

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(g) * * *

(2) Be flat and no larger than 8.5 inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long. If a specimen exceeds these size requirements (a "bulky specimen"), the Office will create a facsimile of the specimen that meets the requirements of the rule (*i.e.*, is flat and no larger than 8.5 inches (21.6 cm.) wide by 11.69 inches (29.7 cm.) long) and put it in the record. In the absence of non-bulky alternatives, the Office may accept an audio or video cassette tape recording, CD-ROM, or a specimen in another appropriate medium.

(3) Be a digitized image in .jpg format, if transmitted through TEAS.

■ 45. Revise § 2.171 to read as follows:

§ 2.171 New certificate on change of ownership.

(a) If the ownership of a registered mark changes, the assignee may request that a new certificate of registration be issued in the name of the assignee for the unexpired part of the original period. The assignment must be recorded in the Office, and the request for the new certificate must be signed by the assignee and accompanied by the fee required by § 2.6(a)(8). If available, the original certificate of registration must be submitted.

(b) 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 fee required by § 2.6(a)(8) must be paid for each new registration created by the division, and the change of ownership must be recorded in the Office.

■ 1. Add a new part 7:

PART 7—RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**Subpart A—General Information**

Sec.

- 7.1 Definitions of terms as used in this part.
- 7.2 [Reserved]
- 7.3 Correspondence must be in English.
- 7.4 Receipt of correspondence.
- 7.5 [Reserved]
- 7.6 Schedule of U.S. process fees.
- 7.7 Payments of fees to International Bureau.

Subpart B—International Application Originating From The United States

- 7.11 Requirements for international application originating from the United States.
- 7.12 Claim of color.
- 7.13 Certification of international application.