

that allow payment of fees charged by the International Bureau of the World Intellectual Property Organization (IB) to be submitted through the USPTO, and those provisions of the Trademark Rules of Practice that require that all fees for international trademark applications and subsequent designations be paid at the time of filing.

The temporary postponements and the temporary suspensions of the Rules of Practice, as well as the modifications to these postponements and suspensions that are announced herein, are in effect from November 2, 2003, to January 2, 2004. If it becomes necessary to extend the suspensions and postponements, and/or the modifications thereto, the USPTO will issue a notice announcing these extensions at least 10 business days before the extensions commence.

The modifications announced herein are procedural in nature and do not affect any substantive rights.

DATES: The applicability date for regulations at 37 CFR 2.190(a), 2.198(a)(1), 7.7(a) and (b), 7.11(a) introductory text and (a)(9), 7.14(e), 7.21(b) introductory text and (b)(7) remains suspended from November 2, 2003, to January 2, 2004.

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SUPPLEMENTARY INFORMATION:

Background

The Madrid Protocol provides a system for obtaining an international trademark registration. The Madrid Protocol Implementation Act of 2002, Pub. L. 107-273, 116 Stat. 1758, 1913-1921 (MPIA) amends the Trademark Act of 1946 to implement the provisions of the Madrid Protocol in the United States.

On September 26, 2003, the USPTO published new regulations to implement the MPIA. 68 FR 55748, posted on the USPTO Web site at <http://www.uspto.gov/web/offices/com/sol/notices/68fr55748.pdf>. These regulations take effect on November 2, 2003. The regulations require that certain submissions that are made to the USPTO in connection with the Madrid Protocol be transmitted using the Trademark Electronic Application System (TEAS). Specifically, 37 CFR 7.11(a) requires that an international application be submitted through TEAS; 37 CFR 7.21(b) requires that a subsequent designation (a request that protection be extended to countries not

identified in the original international application) be submitted through TEAS; and 37 CFR 7.14(e) requires that where the International Bureau of the World Intellectual Property Organization (IB) has issued a notice of irregularity to an international applicant, and the international applicant submits a response to that notice through the USPTO, the response must be transmitted through TEAS.

Madrid Submissions Must Be Prepared Using Paper

On October 24, 2003, the USPTO published a notice in which it announced that it would permit international applications, responses to irregularity notices, and subsequent designations to be submitted on paper rather than through TEAS, for a temporary period of time. The notice accordingly postponed the applicability of 37 CFR 7.11(a), 7.21(b), and 7.14(e), to the extent that those provisions require transmission through TEAS. The notice further provided that this postponement would remain in effect until January 2, 2004, and that if the postponement was extended beyond January 2, 2004, a notice announcing such an extension would be published at least ten days before the extension commenced.

The postponement remains in effect, but is modified. The notice of the postponement provided that applicants could make their submission either on paper or through TEAS. However, certain technical difficulties will delay the deployment of those TEAS forms that will be used for Madrid submissions until some time after November 2, 2003. Therefore, the USPTO hereby announces that all Madrid submissions must be made on paper, until such time as the TEAS forms are posted on the USPTO web site.

The USPTO will issue a notice announcing the posting of the TEAS forms at least five days before such posting occurs.

If the TEAS forms are posted while the postponement of the applicability dates of 37 CFR 7.11(a), 7.21(b), and 7.14(e) is still in effect, then notwithstanding the modifications to the postponements that are announced herein, applicants will be able to file international applications, responses to irregularity notices, and subsequent designations either on paper or through TEAS. Under any circumstances, there will be a transition period during which the USPTO will accept both electronic and paper submissions.

International Fees Must Be Paid Directly to the IB

In addition to requiring that certain submissions that are made to the USPTO in connection with the Madrid Protocol be transmitted using TEAS, the Rules of Practice that take effect on November 2, 2003, also require that international application fees be paid at the time of submission. However, with respect to Madrid submissions that are to be made on paper, the notice of October 24, 2003, temporarily suspended the applicability of those requirements. Thus, the notice suspended 37 CFR 7.11(a)(9), to the extent that it requires that international application fees for all classes and the fees for all designated Contracting Parties identified in an international application be paid at the time of submission. Likewise, the notice suspended 37 CFR 7.21(b)(7), to the extent that it requires that all international fees for a subsequent designation be paid at the time of submission.

The notice of October 24, 2003, further provided that (1) applicants who file Madrid submissions on paper must pay the USPTO certification fee at the time of submission, but must pay the international fees directly to the IB, and that (2) applicants who submit a subsequent designation on paper must pay the USPTO transmittal fee at the time of submission, but must pay the international fees directly to the IB. Additionally, the notice provided that applicants may pay the international fees to the IB either before or after submission of the international application or subsequent designation.

All provisions of the notice of October 24, 2003, that pertain to payment of fees remain in effect. However, the following is noted: these provisions of the notice of October 24, 2003, apply in cases where Madrid submissions are made using paper. Pursuant to the present notice, all Madrid submissions must be made on paper. Hence, the provisions of the notice of October 24, 2003, regarding the payment of fees now apply in all cases where Madrid submissions are made.

If the TEAS forms are posted while the postponement of the effective dates of 37 CFR 7.11(a)(9) and 7.21(b)(7) remains in effect, then applicants who elect to use those forms will pay the international fees (1) at the time of submission, and (2) through the USPTO.

Applicants Should Utilize Madrid Forms Provided by the IB

Applicants making Madrid submissions should use forms provided