

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) is suspended until November 2, 2004.

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SUPPLEMENTARY INFORMATION:

Background

As set forth below, the USPTO is extending the postponement of the applicability date of those regulations that require use of electronic forms in connection with certain Madrid Protocol submissions *until November 2, 2004*. Additionally, the USPTO is likewise extending to *November 2, 2004*, the postponement of the applicability date of those regulations that require that international fees be paid concurrently with Madrid filings, and that these fees be paid through the USPTO.

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 took 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 document 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 document 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 document further provided that this postponement would remain in effect until January 2, 2004.

Thereafter, on November 7, 2003, the USPTO published a second document in which it announced that the postponement remained in effect but was modified. The original postponement had provided that applicants could make their submission either on paper or through TEAS. However, the document of November 7, 2003, provided that all Madrid submissions *must* be made on paper. That modification was necessary, because technical difficulties had prevented the deployment of TEAS.

Some of these difficulties have not yet been resolved, and the TEAS forms cannot yet be posted. Therefore, the postponement of the applicability date of 37 CFR 7.11(a), 7.21(b), and 7.14(e) *is hereby extended to November 2, 2004*.

If the TEAS forms are posted while the extended postponement of the applicability dates of 37 CFR 7.11(a), 7.21(b), and 7.14(e) is still in effect, then 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. This additional period will give applicants the flexibility and the opportunity to become comfortable with the electronic system when it becomes available.

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 took effect on November 2, 2003, also require that international application fees be paid at the time of submission. However, the document of November 7, 2003, temporarily suspended the applicability of those requirements, until January 4, 2004. Thus, the document 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 document 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 document of November 7, 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.

These provisions of the document of November 7, 2003, are hereby extended to November 2, 2004.

If the TEAS forms are posted while the postponement of the applicability 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 by the IB for that purpose. These forms may be downloaded from the IB Web site <http://www.wipo.int/madrid/en/>. Please note that the IB will not process paper submissions that are not prepared using IB forms.

Applicants Should Mail Madrid Submissions to a Designated Address

Pursuant to 37 CFR 2.190(a), all trademark-related documents submitted on paper must be mailed to a designated USPTO address. However, the document of November 7, 2003, waived that rule with respect to international applications, subsequent designations, and responses to notices of irregularities that are filed on paper. The document further provided that all Madrid submissions made on paper should be mailed to the following address: Commissioner for Trademarks, P.O. Box 16471, Arlington, Virginia 22215-1471, Attn: MPU.